

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OLD REPUBLIC GENERAL INSURANCE GROUP, INC.;
OLD REPUBLIC INSURANCE COMPANY;
OLD REPUBLIC TITLE INSURANCE GROUP, INC.;
and OLD REPUBLIC NATIONAL TITLE INSURANCE COMPANY;
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

Case CBM2015-00184
Patent 6,546,002 B1

Before GREGG I. ANDERSON, JON B. TORNQUIST, and
ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

TORNQUIST, *Administrative Patent Judge*.

DECISION

Denying Institution of Covered Business Method Patent Review
37 C.F.R. § 42.208

I. INTRODUCTION

A. Background

Old Republic General Insurance Group, Inc., Old Republic Insurance Company, Old Republic Title Insurance Group, Inc., and Old Republic National Title Insurance Company (collectively “Petitioner”) filed a Petition to institute a covered business method patent review of claim 1–49 of U.S. Patent No. 6,546,002 B1 (Ex. 1001, “the ’002 patent”). Paper 1 (“Pet.”). Intellectual Ventures II LLC (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”) to the Petition.

We apply 35 U.S.C. § 324(a), which provides that a post-grant review may not be instituted “unless . . . the information presented in the petition . . . would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.” For the reasons that follow, we do not institute a covered business method patent review.

B. Related Matters

Petitioner and Patent Owner identify the following district court proceedings related to the ’002 patent: *Intellectual Ventures I LLC v. Old Republic General Insurance Group, Inc.*, Case No. 2-14-cv-01130 (W.D. Pa.); *Intellectual Ventures I LLC v. Highmark, Inc.*, Case No. 2-14-cv-01131 (W.D. Pa.); *Intellectual Ventures I LLC v. Erie Indemnity Company*, Case No. 1-14-cv-00220 (W.D. Pa.); *Intellectual Ventures I LLC v. Citigroup, Inc.*, Case No. 1-14-cv-04638 (S.D.N.Y.); *Intellectual Ventures I LLC v. PNC Financial Services Group, Inc.*, Case No. 2-14-cv-00832 (W.D. Pa.); *Intellectual Ventures I LLC v. Capital One Financial Corporation*, Case No. 8-14-cv-00111 (D. Md.). Pet. 1–2; Paper 4, 1–2. Petitioner and Patent

Owner also identify IPR2015-00089, IPR2015-00092, and IPR2015-01992 as relating to the '002 patent. Pet. 2; Paper 4, 2.

C. The '002 Patent

The '002 patent describes a system and method for using a mobile interface agent (“MIA”) to access information of a user. Ex. 1001, Abstract. The MIA may be used on a computer, cable set top box, cellular phone, or other device, so long as the device on which the mobile interface agent is running can be connected to a network. *Id.* at 4:44–46, Abstract.

Figure 1B of the '002 patent, reproduced below, illustrates a graphic interface of the MIA:

FIG. 1B

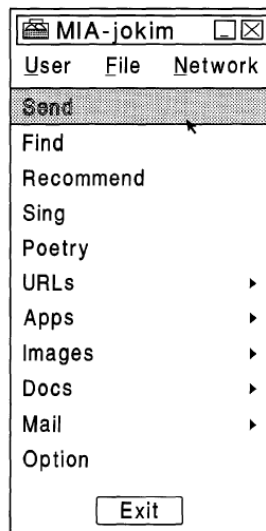


Figure 1B illustrates a graphic interface of the MIA.

As shown in Figure 1B, menu items displayed within the MIA “can be used to access and retrieve user specific resources and information.” *Id.* at 6:13–16, 14:33–34. For example, using the MIA, a user can “access documents, files, programs, applications, URL bookmarks, IP addresses, telephone numbers, television channels, radio stations, and other menu items” that are specific to the user. *Id.* at 4:49–54.

Figure 15 of the '002 patent is reproduced below:

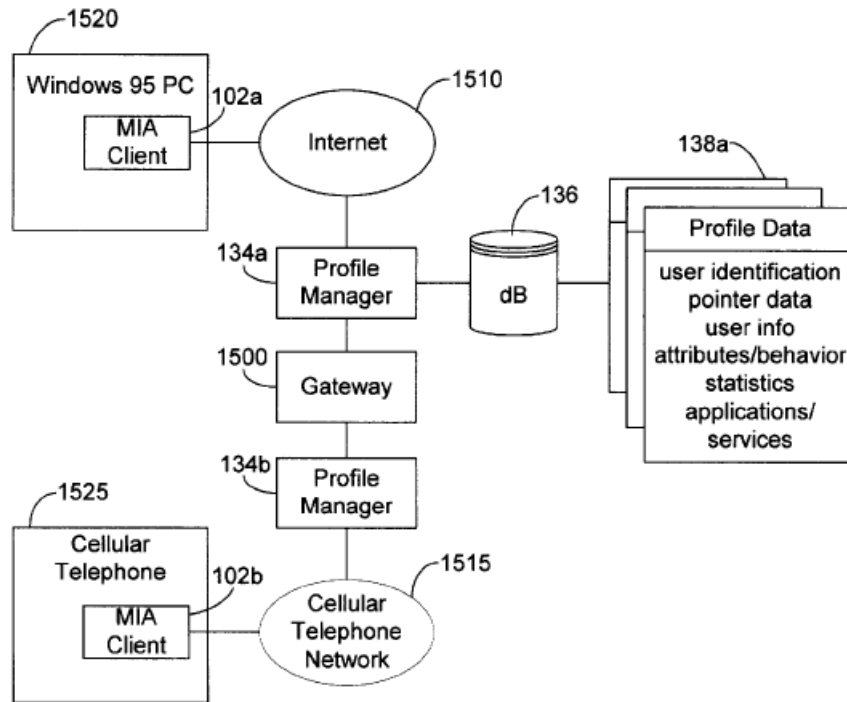


FIG. 15

Figure 15 is a block diagram showing profile managers of multiple communication networks connected by a gateway.

Figure 15 shows MIA 102a running on a Windows 95 PC and MIA 102b running on a cellular telephone. *Id.* at 16:36–54. Depending on the platform, geographical location, etc., of the user’s connection, MIA 102 downloads the appropriate information of the user. *Id.* at 14:50–54. “For example, if a user has purchased a Windows 98 only license for MS Word and moved to an Apple MacOS device, then the MS Word menu item may be disabled or not downloaded.” *Id.* at 14:54–57.

The '002 patent notes that “[m]ost software programs and applications are currently licensed on either a node locked paradigm in which the software is usable on a per device basis or as a floating license in which a fixed number of licenses are available to a certain group of users limited by

the number of concurrent users.” *Id.* at 3:23–28. The ’002 patent notes, however, that:

The trend in the future is that many software programs and the like may be licensed per user rather than per device/platform or number of concurrent users in a network. In this case, the user has a license to use such programs from any computer that is capable of running such programs. The present invention provides a system and method for implementing such a licensing model so that the user can access and run programs from any computer and from any geographical location.

Id. at 3:48–56.

D. Illustrative Claim

Claim 1 of the ’002 patent is illustrative of the challenged claims and is reproduced below:

1. A method for retrieving user specific resources and information stored either on a local device or a network server, the method comprising the steps of:

retrieving a mobile interface from the network server to the local device;

displaying the mobile interface on the local device, the mobile interface including a plurality of pointers corresponding to the user specific resources and information; and

retrieving the user specific resources and information using the plurality of pointers displayed on the mobile interface.

Ex. 1001, 17:9–21.

E. The Asserted Ground of Unpatentability

Petitioner challenges claims 1–49 as directed to unpatentable subject matter under 35 U.S.C. § 101. Pet. 3.

II. ANALYSIS

Section 18 of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”) provides for the creation of a transitional

program for reviewing covered business method patents. A “covered business method patent” is a patent that “claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.” AIA § 18(d)(1); 37 C.F.R. § 42.301(a).

In determining whether a patent is a covered business method patent, our focus is on the claims. AIA § 18(d)(1); *see also* Transitional Program for Covered Business Method Patents—Definitions of Covered Business Method Patent and Technological Invention, 77 Fed. Reg. 48,734, 48,736 (Aug. 14, 2012) (noting that a “determination of whether a patent is a covered business method patent will be made based on the claims”). A patent needs only one claim directed to a covered business method to be eligible for review. *See* 77 Fed. Reg. at 48,736.

As noted above, technological inventions are excluded from the definition of a “covered business method patent.” AIA § 18(d)(1); 37 C.F.R. § 42.301(a). In determining whether a patent is for a technological invention, we consider whether “the claimed subject matter as a whole recites a technological feature that is novel and unobvious over the prior art; and solves a technical problem using a technical solution.” 37 C.F.R. § 42.301(b). Whether a patent is for a technological invention is “determined on a case-by-case basis.” *Id.*

A. Does the claimed subject matter of the '002 patent—as a whole—recite a technological feature that is novel and unobvious over the prior art?

Petitioner contends the claims of the '002 patent do not recite a technological feature that is novel and unobvious over the prior art.

According to Petitioner, the claims of the '002 patent “recite only generic structures, well known in the prior art” that are “used for their ordinary purposes ‘to achieve the normal, expected, or predictable result of that combination.’” Pet. 20 (quoting 77 Fed. Reg. at 48,764). In support, Petitioner presents evidence that user interfaces “were well known before the 1999 priority date of the '002 Patent, as were user interfaces that could be accessed on different computing devices.” *Id.* (citing Ex. 1027, 50–53; Ex. 1005, 5:31–39; Ex. 1003 ¶ 89). Petitioner further argues that pointers “are as old as the hills” and the claimed networks, such as the Internet and cellular networks, are simply “conventional, prior art networking technology.” *Id.* at 21–22 (citing Ex. 1003 ¶¶ 91, 109, 111, 113).

Patent Owner argues in response that Petitioner has failed to consider the claims as a whole. Prelim. Resp. 31–32. According to Patent Owner, the claims of the '002 patent integrate known elements into “a novel ‘mobile interface’ that can ‘retriv[e] user specific resources and information stored either on a local device or a network server.’” *Id.* at 31–32, 33–34, 37 (“While remote access to and retrieval of files from multiple devices may seem common today, it was not common at the time of the '002 Patent . . .”), 41 (asserting that, “[i]nstead of the conventional use of pointers, which limited access to a local machine and were therefore useful only within a local context, the claimed ‘mobile interface’ overrides the routine use of pointers” to allow “access to files and other user-specific resources from any location”).

As noted by Patent Owner, Petitioner focuses on the individual components of the '002 patent, without analyzing how each claim of the '002 patent combines these individual components into an ordered whole.

Indeed, Petitioner fails to analyze any claim of the '002 patent to assess whether its individual components are arranged or utilized in a novel or unobvious manner. Such a cursory analysis is insufficient to demonstrate that the '002 patent claims, as a whole, do not recite a technological feature that is novel and unobvious.¹ *See Apple, Inc. v. ContentGuard Holdings, Inc.*, CBM2015-00046, slip op. at 10 (PTAB June 3, 2015) (Paper 12) (“Petitioner does not even mention the claimed subject matter as a whole, but instead merely points to discrete pieces of the claim, each taken out of context and dissected separately.”); *Emnos USA Corp. v. Dunnhumby Ltd.*, CBM2015-00116, slip op. at 8 (PTAB Nov. 10, 2015) (Paper 8) (finding petitioner’s showing under the technological invention exclusion to be insufficient where “Petitioner addresses only certain elements of the claims and fails to assess any of the claims as a whole”); *Experian Mktg. Sols., Inc. v. RPost Commc’ns Ltd.*, CBM2014-00010, slip op. 9 (PTAB Apr. 22, 2014) (Paper 20) (noting Petitioner’s failure to examine each claim as a whole).

Thus, we agree with Patent Owner that Petitioner has not demonstrated sufficiently that the claims of the '002 patent do not recite a technological feature that is novel and unobvious.

B. Does the '002 patent solve a technical problem using a technical solution?

Petitioner also contends—in an argument that spans one paragraph—that the '002 patent neither solves a technological problem nor provides a

¹ In IPR2015-01992, Petitioner demonstrated a reasonable likelihood that claims 1–49 of the '002 patent would have been obvious over the prior art of record in that case. We do not, however, import or rely upon the evidence and argument presented in that proceeding to satisfy the requirements of 37 C.F.R. § 42.304(a). *See, e.g.*, 37 C.F.R. § 42.6(a)(3).

technological solution to this problem. Pet. 22–23. Petitioner reasons that the problem addressed in the '002 patent—that prior art pointers, bookmarks, and software licenses were limited to a single machine—is not a technological problem, but one of “personal mobility,” and the claimed solution—storing the user’s information in a central location and sending it to where it is needed—is “a logistical issue, not a technical one.” *Id.*

Patent Owner contends Petitioner’s argument is nonsensical as the “the alleged logistical issue of accessing data via a mobile interface from multiple devices or locations” is a technical problem requiring a technical solution. Prelim. Resp. 32. According to Patent Owner, “[b]y Petitioners’ reasoning, the telephone was not a technological invention, but merely solved the logistical problem of having a conversation when two people were in different places.” *Id.*

The '002 patent addresses a problem wherein users could not access their files, applications, or profiles on multiple computers or from multiple locations. Ex. 1001, 1:52–65; Pet. 22–23; Prelim. Resp. 33, 37, 41. The '002 patent purports to solve this problem by providing a mobile interface that may be downloaded to any electronic device with access to a network. *See* Prelim. Resp. 8. This mobile interface, which contains pointers with the ability to reference files and applications stored either on the local machine or at various network locations, then allows a user to access his or her information from virtually any location having a connection to the Internet or network server. *Id.* at 32–33, 41.

Petitioner provides no reasoned explanation as to why the problem of accessing electronic information from multiple locations using multiple types of electronic devices is not a technical problem, nor a reasoned

explanation as to why the use of a mobile interface with improved pointers is not a technical solution to this problem. Simply labeling the problem addressed in the '002 patent as “one of personal mobility” and the resulting solution as “a logistical issue,” is not sufficient to demonstrate that the claims of the '002 patent do not solve “a technical problem using a technical solution.”

C. Conclusion

Having considered both prongs of the technological invention exclusion, we conclude that Petitioner has not established that the '002 patent is a “covered business method patent” under § 18(d)(1) of the AIA. Accordingly, we do not institute a covered business method patent review as to any of the challenged claims.

III. ORDER

Based on the foregoing, it is
ORDERED that the Petition is *denied* as to all challenged claims; and
FURTHER ORDERED that no covered business method patent review is instituted.

CBM2015-00184
Patent 6,546,002 B1

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