Trials@uspto.gov
Tel: 571–272–7822

Paper 10
Entered: October 10, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

IRON DOME LLC,
Petitioner,

v.

CHINOOK LICENSING DE LLC,
Patent Owner.

IPR2014-00674
Patent 7,047,482 B1

Before WILLIAM V. SAINDON, JAMES P. CALVE, and TRENTON A. WARD, *Administrative Patent Judges*.

SAINDON, *Administrative Patent Judge*.

DECISION
Denial of Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

A. Background

Petitioner filed a Petition requesting an *inter partes* review of claims 1–7 and 9–20 of U.S. Patent No. 7,047,482 B1 (Ex. 1001, "the '482 patent"). Paper 1 ("Pet."). Patent Owner filed a Revised Preliminary Response. Paper 8 ("Prelim. Resp.").

We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." For the reasons given below, we do not institute an *inter partes* review.

B. Related Matters

Petitioner represents that, although not itself a party, Patent Owner alleged infringement of the '482 patent in various district court proceedings. Pet. 2. Patent Owner states that these matters are: *Chinook v. Scribd, Inc.*, No. 13-cv-02078 (D. Del); *Chinook v. StumbledUpon, Inc.*, No. 3:13-cv-02079 (D. Del); *Chinook v. Hulu, Inc.*, 3:14-cv-00074 (D. Del); and *Chinook v. Zoosk, Inc.*, No. 3:14-cv-00077 (D. Del). Paper 5.

C. The Challenged Patent

The '482 patent is directed to computer software that "automatically finds, saves, and displays links to documents topically related to [other] document[s] . . . without a user having to search." Ex. 1001, Abstract. This software is understood best by way of an example.

Figure 6 of the ’482 patent is reproduced below and depicts an example of the results the computer software produces:

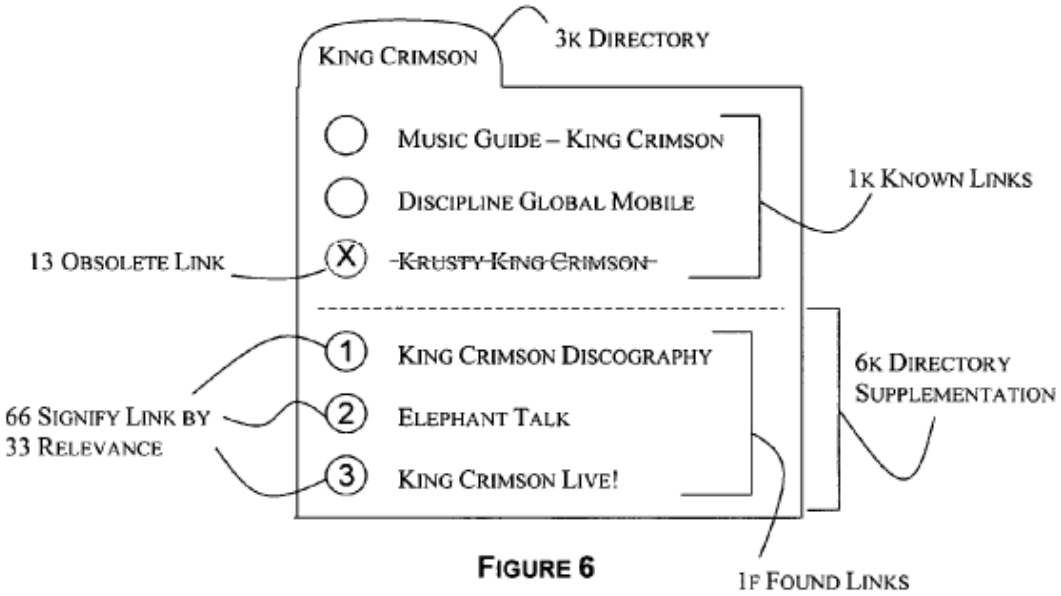

FIGURE 6

Figure 6 of the ’482 patent depicts an example directory, Directory 3K, of links relating to the musical group King Crimson. *Id.* at 5:59–60. Directory 3K includes known links 1K and supplemented links 6K, which includes found links 1F signified by relevance 33. *Id.* at 5:64–67. The software program finds found links 1F by performing a search using keywords derived from content found at known links 1K. *See, e.g.*, *id.* at 4:35–5:58 (stepping through a process for finding supplemental links).

Claims 1, 11, and 16 are independent. Claim 1, reproduced below with emphasis added to some limitations discussed in more detail below, is illustrative:

> 1. A computer-implemented method for augmenting a directory without contemporaneous user input comprising:
> ***accessing at least a first document via a first directory without contemporaneous user selection*** of said first

> document, said first document comprising at least in part topical textual content;
> deriving at least one keyword indicative of at least one topical content from said first document;
> ***searching*** as a background operation a plurality of documents in storage in at least one computer ***without contemporaneous user input of a search location***, such that said search comprises searching for documents related by said at least one keyword to said first document, thereby accessing a second document;
> determining relevance of said second document to said at least one keyword; and
> adding a reference to said second document in a results directory.

D. Petitioner's Grounds for Challenge

Petitioner presents the following grounds challenging the patentability of claims 1–7 and 9–20 of the '482 patent:

Reference(s)	Basis	Claims Challenged
Chen[1]	§ 103	1–7, 9–19
Chen and Lieberman[2]	§ 103	20

[1] Liren Chen & Katia Sycara, "WebMate: A Personal Agent for Browsing and Searching" *Proceedings of the Second Int'l Conference on Autonomous Agents* (Katia P. Sycara & Michael Wooldridge, eds. 1998), at 132 (Ex. 1002) ("Chen").
[2] Henry Lieberman, "Letizia: An Agent That Assists Web Browsing" *Proceedings of the Fourteenth Int'l Joint Conference on Artificial Intelligence,* Vol. I (Chris S. Mellish, ed. 1995), at 924 (Ex. 1003) ("Lieberman").

II. ANALYSIS

A. Petitioner's Proposed Construction of the "Accessing" Step

Independent claims 1, 11, and 16 of the '482 patent include a step of "accessing" at least one document "without contemporaneous user selection." After accessing the document, the independent claims require that a step of keyword derivation is performed.

Petitioner points to Chen's disclosure of "keyword extraction from documents that the user selects by marking them as 'I like it'" to meet the "accessing" step of the claims. Pet. 11–12; *see also id.* at 20, 25–26 (addressing independent claims 11 and 16). Specifically, Petitioner cites to the following disclosure in Chen:

> This algorithm is run whenever a user marks a document as "I like it". Thus, the user profile is incrementally, unobtrusively and continuously updated.

Ex. 1002, 134, left col. (cited at Pet. 11).

As can be seen from this disclosure, the algorithm is run (i.e., the document is accessed) *when the user marks the document* as "I like it." The claims, in contrast, require that the document is accessed "without contemporaneous user selection."

To read the "accessing . . . without contemporaneous user selection" limitation on Chen, Petitioner proposes that "without contemporaneous user selection" means that there is "no user input of search parameters" and "no user input of search locations." Pet. 6 (proposing a construction for "without contemporaneous user input"); *id.* at 12 (applying the construction for "without contemporaneous user input" to "without contemporaneous user selection").

Petitioner's basis for this construction is a statement made by the inventor,[3] during prosecution of the application that issued as the '482 patent, that "searching without user input" meant "no user input of search parameters" and "no user input of search locations." *Id.* at 6. According to Petitioner, therefore, because marking a document as "I like it" is not providing search parameters or search locations, Chen discloses accessing the document without contemporaneous user selection, in the manner required by the claims. *Id.* at 11–12. The sufficiency of Petitioner's assertion turns on the adequacy of its claim construction.

B. Claim Construction of the "Accessing" Step

We interpret claims of an unexpired patent using the broadest reasonable interpretation in light of the specification of the patent. 37 C.F.R. § 42.100(b). Under the broadest reasonable interpretation standard, claim terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech. Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Further, "the specification and prosecution history only compel departure from the plain meaning in two instances: lexicography and disavowal." *GE Lighting Solutions, LLC v. Agilight, Inc.*, No. 2013-1267, slip op. at 5 (Fed. Cir. May 1, 2014) (citing *Thorner v. Sony Computer Entm't Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012)). We first discuss the plain meaning of the "accessing" step, and then turn to the prosecution history on which Petitioner has relied.

[3] The inventor prosecuted the application leading to the '482 patent *pro se*. Thus, we refer to the "inventor" rather than "applicant" or "appellant" in our discussion of the prosecution history.

The specification of the ’482 patent does not provide meaningful guidance for construing the phrase “without contemporaneous user selection.” In fact, the phrase “without contemporaneous user selection” does not appear anywhere in the specification of the ’482 patent. The plain meaning of “accessing [a document] without contemporaneous user selection” is accessing a document, but not at the same time or period that a user selects that document.[4] We are not apprised of any evidence in the record before us indicating that a person of ordinary skill in the art would understand the phrase differently from the plain meaning identified above. Thus, “accessing [a document] without contemporaneous user selection,” as read by a person of ordinary skill in the art at the time of the invention upon review of the claims and specification, means *accessing a document, but not at the same time or period that a user selects that document*. We now turn to the prosecution history of the ’482 patent.

Petitioner relies on statements made during prosecution of the ’482 patent to construe the “accessing . . . without contemporaneous user selection” limitation to mean “no user input of search parameters” and “no user input of search locations.” Pet. 6. The statements Petitioner relies on are found in an Appeal Brief, which discusses the phrase “without user input” of the “searching” limitation. *Id.* In the portion of the Appeal Brief cited by Petitioner,[5] the inventor states:

[4] “contemporaneous,” adjective: “existing or happening at the same time or period,” *Chambers 21st Century Dictionary* (2001) (Ex. 3001).
[5] Ex. 1004, Appeal Brief, received February 18, 2005 during the prosecution of U.S. Appl’n No. 09/796,235, at page 14. Pages 21–23 provide a listing of the claims at that point in time. Citations are to the Exhibit page numbers, not the page numbers of the original document.

> So, Examiner . . . tacitly concurred with appellant, that, in context, the two limitations applicable to the meaning of 'without user input' comprise:
>
> 1. no user input of search parameters;
>
> 2. no user input of search locations.
>
> That is exactly what appellant had explained in his 08/27/2004 reply to the first office action rejection.

To put these statements made by the inventor in the Appeal Brief into context, however, we must consider the claim language that existed at the time the statements were made, and how that claim language differs from the claim language of the issued '482 patent. The table below highlights those differences, with emphasis added:

Limitation	Language in claim 1, as it existed in the Appeal Brief of Feb. 18, 2005[6]	Language in claim 1, as in the issued '482 patent
"accessing"	"accessing at least a first document via a first directory"	"accessing at least a first document via a first directory *without contemporaneous user selection* of said first document, . . ."
"searching"	"searching a plurality of documents in storage in at least one computer *without user input* of a search location"	"searching as a background operation a plurality of documents in storage in at least one computer *without contemporaneous user input* of a search location, . . ."

The statements made by the inventor during prosecution of the '482 patent, relied on by Petitioner to construe the "accessing" limitation, do not support sufficiently Petitioner's proposed construction. First, Petitioner is proposing a construction of the "accessing" limitation using statements of the inventor that were directed to the "searching" limitation. Further, the "accessing" limitation, at

[6] Ex. 1004, 21.

the time the statements were made, did not include a "without user input" phrase. Indeed, the "accessing" limitation of the '482 patent requires accessing without user *selection*, rather than without user *input*. Lastly, neither limitation, as it existed at the time of the Appeal Brief in Exhibit 1004, included a limitation directed to "contemporaneous" selection or input. Thus, the prosecution history cited by Petitioner is directed to what is "searching . . . without user input" rather than "accessing . . . without contemporaneous user selection." Petitioner does not explain these incongruities and, indeed, simply equates, without explanation, "accessing [a document] without contemporaneous user selection" to "searching [a document] without contemporaneous user input." *See* Pet. 12.

Consequently, we do not adopt Petitioner's proposed construction of the "accessing" step. Instead, based on the record before us, we determine that the broadest reasonable interpretation of "accessing . . . without contemporaneous user selection" is simply the plain meaning arrived at above: *accessing a document, but not at the same time or period that a user selects that document*.

C. Petitioner's Asserted Grounds

Petitioner's proposed challenges read the "accessing [a document] without contemporaneous user selection," limitation of each independent claim on Chen's description of accessing the document when the user marks it as "I like it." Pet. 11–12, 20, 25–26 (citing Ex. 1002, 134, left col.). Marking a document as "I like it," however, is *selecting* that document as a liked document. When that document is selected, Chen, because of that selection, *then runs* its algorithm. Ex. 1002, 134, left col. Thus, the cited portions of Chen disclose accessing a document *at the same time or period* that the user selects the document, rather than "accessing [the document] without contemporaneous user selection," as required by the

independent claims. Each of Petitioner's challenges relies upon either Chen alone or Chen in view of Lieberman, and Petitioner does not rely on Lieberman to teach this limitation. *See* Pet. 29–31.

Accordingly, based on the record before us, we determinate that Petitioner has not demonstrated a reasonable likelihood of showing that the teachings of Chen and Lieberman render obvious the step of "accessing [a document] without contemporaneous user selection," as required by each independent claim. As such, Petitioner has not demonstrated a reasonable likelihood of showing that the subject matter of any of the challenged claims is unpatentable over Chen, or Chen in view of Lieberman.

III.ORDER

In view of the foregoing, it is hereby ORDERED that *inter partes* review is denied and no trial is instituted.

For Petitioner:

Steven Yu
ROZMED LLC
syu@patent-intercept.com

John J. Yim
JOHN J. YIM & ASSOCIATES LLC
jyim@yimassociates.com

For Patent Owner:

Eugenio J. Torres-Oyola
Víctor M. Rodríguez-Reyes
Rafael Rodríguez-Muriel
José A. Medina
Cristina Arenas Solís
FERRAIUOLI LLC
etorres@ferraiuoli.com
vrodriguezreyes@ferraiuoli.com
rrodriguez@ferraiuoli.com
jmedina@ferraiuoli.com
carenas@ferraiuoli.com