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Paper 7
Entered: December 11, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WOODWARD/WHITE, INC.,
Petitioner,

v.

THOMAS REUTERS (LEGAL) INC.,
Patent Owner.

Case IPR2014-00854
Patent 8,412,564 B1

Before JONI Y. CHANG, TREVOR M. JEFFERSON, and JAMES A. TARTAL, *Administrative Patent Judges.*

JEFFERSON, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Woodward/White, Inc. ("Petitioner") filed a Petition (Paper 1, "Pet.") to institute an *inter partes* review of claims 1–13 of U.S. Patent No.

8,412,564 B1 (Ex. 1,[1] "the '564 patent"). *See* 35 U.S.C. § 311. Thomas Reuters (Legal), Inc. ("Patent Owner") filed a Preliminary Response (Paper 6, "Prelim. Resp.").

We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted "unless . . . the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition."

Upon consideration of the Petition, we conclude that Petitioner has not established a reasonable likelihood that it would prevail with respect to any one of claims 1–13 of the '564 patent. Accordingly, we do not authorize an *inter partes* review to be instituted as to the '564 patent.

B. Related Matters

The parties indicate that there are no matters related to the '564 patent. Pet. 1; Paper 5, 1.

C. References Relied Upon

Petitioner relies upon the following prior art references:

Ex. 6	Lederman	US 2008/0040130 A1	Feb. 14, 2008
Ex. 7	Mann	US 2002/00197765	Feb. 14, 2002

Ex. 3 STEVEN NAIFEH & GREGORY WHITE SMITH, THE BESTLAWYERS IN AMERICA, FIRST EDITION (1983) ("Best Lawyers 1983")

Ex. 4 STEVEN NAIFEH & GREGORY WHITE SMITH, THE BEST LAWYERS IN AMERICA, FIRST EDITION (1987) ("BEST LAWYERS 1987")

[1] The parties are reminded that exhibits must be uniquely numbered sequentially in the appropriate range (1001-1999 for a petitioner and 2001-2999 for a patent owner). *See* 37 C.F.R. § 42.63(c).

EX. 5 STEVEN NAIFEH & GREGORY WHITE SMITH, THE BEST LAWYERS IN AMERICA, FIRST EDITION (1989)

D. The Asserted Grounds

Petitioner contends that the challenged claims are unpatentable based on the following ground (Pet. 6):

References	Basis	Claims Challenged
Lederman (Ex. 6), Mann (Ex. 7), Best Lawyers 1987 (Ex. 4), and Best Lawyers 1983 (Ex. 3)[2]	§ 103	1–13

E. The '564 Patent

The '564 Patent, titled "System and Method for Identifying Excellence Within a Profession," relates to identifying excellent performance by individuals within a profession by using data searching and mining to provide objective indications of peer recognition and/or professional achievement. Ex. 1, 1:13–18. The system and methods provide "rules and monitoring for a nomination and balloting process to identify and evaluate excellent performing candidates by one or more selected groups of peer professionals." *Id*. at 2:47–49. Figure 1, reproduced below, illustrates the disclosed method of identifying excellent performance of professionals within a profession group.

[2] Although Petitioner cites a "Best Lawyers® method" described in Exhibits 3, 4, and 5 as the prior art relied upon (Pet. 6), *inter partes* review is supported on the basis of prior art consisting of patents or printed publications (35 U.S.C. § 311(b)). In identifying the challenges, we refer to the printed publications cited in support of "Best Lawyers® method" in the Petition when such citations are provided. For example, the Petition refers to Best Lawyers 1987 (Ex. 4) for claim 1 (Pet. 12, 14) and Best Lawyers 1983 (Ex. 3) for claim 2 (Pet. 14–15).

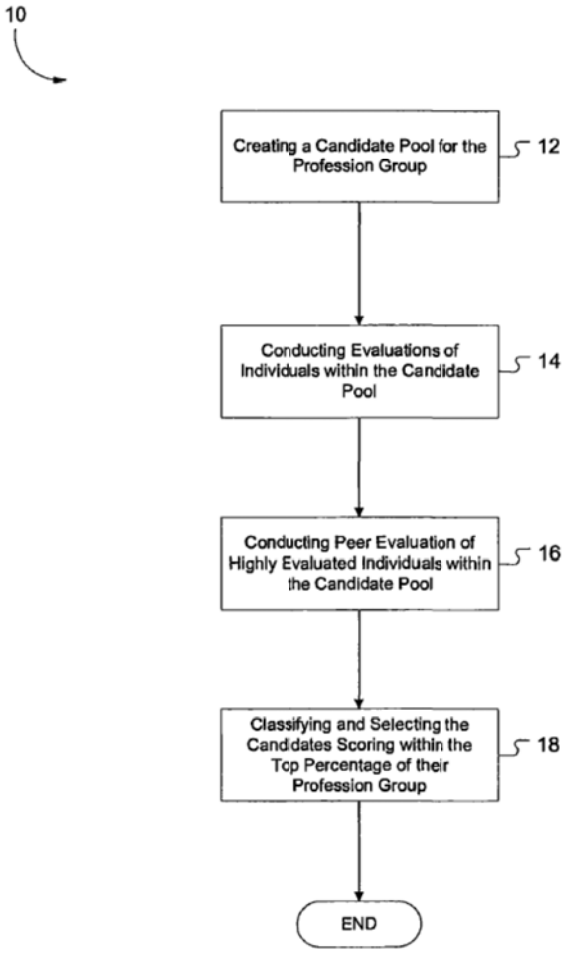

FIG. 1

Figure 1 is a flowchart illustrating a method of identifying excellent performance of professionals within a profession group that includes the steps of creating a candidate pool 12; evaluating individuals within the candidate pool 14; conducting peer evaluations of individual candidates in candidate pools defined by professional group 16; and final selection of individual candidates that demonstrate excellent performance within a particular group 18. *Id*. at 3:64–4:6

F. Illustrative Claim

Claims 1, 12, and 13 are independent, and claims 2–11 depend from claim 1. Independent claim 1, reproduced below, is illustrative of the claimed subject matter:

> 1. A method on a processing device for identifying excellent performance of candidates within a profession group, the processing device comprising a processor, a user interface device, and a data storage device, the method comprising:
>
> creating a candidate pool by selecting individuals from a profession group, including:
>
> receiving and processing a survey of peer professionals working within the profession group, wherein the peer professionals nominate other individuals within the profession group, wherein a minimum set of qualifications exist for each of the peer professionals to provide nominations;
>
> performing independent research to identify individuals, the independent research comprising data mining to identify the individuals who satisfy predefined criteria for outstanding performance within the profession group, wherein the data mining includes querying electronic data sources containing relevant biographical information for the individuals within the profession group; and
>
> selecting candidates for the candidate pool based on a combination of the results produced by the survey of peer professionals and the independent research, wherein the combination is performed using a computer operation which removes duplicate candidates;
>
> wherein biographical information about individuals identified via the survey and the independent research is compiled for each individual within the candidate pool and stored in the data storage device;
>
> evaluating the candidates individuals within the candidate pool, including:
>
> performing, by the processor, independent research to evaluate performance of the candidates, the independent research comprising retrieval of performance information for

the candidates relevant to objective criteria specific to the profession group, wherein the retrieval of performance information is performed independent of input from the individuals in the profession group and the peer professionals, and wherein the performance information is compiled for each candidate in the candidate pool and added to the information compiled for each candidate stored within the data storage device;

for each candidate within the candidate pool, storing in the data storage device a score for each objective criterion based on the performance information of each candidate stored in the data storage device;

for each candidate within the candidate pool, compiling with the processor a point total from the scores of each objective criterion; and

identifying candidates with point totals in a first predetermined top percentage of candidates in the candidate pool;

conducting peer evaluations of only the candidates with point totals in the first predetermined top percentage of candidates in the candidate pool, including:

selecting peer evaluators from among the candidates having point totals in the first predetermined top percentage of candidates in the candidate pool;

obtaining, from the user interface device, peer evaluation scores from the selected peer evaluators; and

producing, with the processor, an averaged peer evaluation score for each candidate in the first predetermined top percentage; and

identifying, with the processor, candidates in a second predetermined top percentage of candidates in the candidate pool based on a function of the point totals compiled from the scores of each objective criterion and the peer evaluation scores obtained from the selected peer evaluators.

Ex. 1, 14:59–15:61.

II. ANALYSIS

A. Claim Construction

We determine the meaning of the claims as the first step of our analysis. The Board interprets claims of an unexpired patent using the broadest reasonable construction. *See* 37 C.F.R. § 42.100(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,764 (Aug. 14, 2012). If an inventor acts as his or her own lexicographer, the definition must be set forth in the specification with reasonable clarity, deliberateness, and precision. *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998). Claim terms generally 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. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

Petitioner contends that the inventor did not provide any special meanings for any of the claim terms and proposes that the terms be given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art. Pet. 6. Patent Owner does not dispute Petitioner's contention. Prelim. Resp. 4. Based on the record before us, we agree and find that none of the claim terms require express construction at this stage of the proceeding.

B. Asserted Ground of Unpatentability

1. Obviousness of Claims 1–13 Based on Lederman (Ex. 6), Mann (Ex. 7), Best Lawyers (1983) (Ex. 3), and Best Lawyers (1986) (Ex. 4)

Petitioner contends that claims 1–13 are rendered obvious by a combination of Lederman, Mann, Best Lawyers (1983), and Best Lawyers

(1986). Pet. 6. Petitioner relies on the arguments and evidence presented for independent claim 1 to support the challenges to independent claims 12 and 13. Pet. 17.

A petition must identify "in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim." 35 U.S.C. § 312(a)(3). Petitioner relies solely on the printed publications and petition argument in support of its contentions. Petitioner provides no affidavits, declarations, supporting evidence, or expert opinion in support of its grounds of unpatentability.

With respect to independent claim 1, the Petition does not address the claims, as issued, in the '564 patent. Instead, the Petition addresses the claims as they existed prior to amendment during prosecution. *See* Prelim. Resp. 9. For example, the Petition refers to "deriving a numerical evaluation for each individual within the candidate pool" (Pet. 10), as a claim limitation, but that claim language was amended and does not exist in claim 1, as issued. *Compare* Pet. 10, *with* Ex. 1, 14:59–15:61.

Petitioner's contentions also restate, almost *verbatim*, the pre-amendment Examiner's rejection from the Non-Final Office Action of June 14, 2011. *Compare* Pet. 6–17, *with* Ex. 2, '564 Prosecution History, Office Action Summary, at 6–19 (providing Examiner's rejections of pending claims under 35 U.S.C. § 103 starting on unnumbered page 324 of Ex. 2). Thus, the Petition does not address any claim limitations added or amended after the Examiner's Non-Final Office Action, such as the "selecting peer evaluators from among the candidates having point totals in the first predetermined top percentage of candidates in the candidate pool"

limitation, which was added by amendment to claim 1. Ex 2, '564 Prosecution History, April 25, 2008 Amendment and Response to Office Action, at 3 (unnumbered page 350 of Ex. 2); *see* Ex. 1, 15:48–50 (claim 1). Petitioner both fails to address claim limitations that were added to claim 1 during prosecution, and erroneously addresses claim limitations that are not present in issued claim 1. Accordingly, Petitioner fails to show that the limitations of independent claim 1, and related independent claims 12 and 13, are taught or suggested by the cited prior art references.

Furthermore, Petitioner's contentions fail to explain how the cited references, such as the Best Lawyer printed publications, correspond to the challenged claim limitations. *See* Prelim. Resp. 9–13. With respect to the Best Lawyer references, at several instances, Petitioner offers only conclusory statements that "the Best Lawyer® method" teaches the claim limitations of independent claim 1 without providing any citations to the actual publications. Pet. 8 (stating that "[t]he Best Lawyers® method, however, expressly teaches developing candidate lists by 'adding and removing names, until a clear consensus emerged'"); *id.* at 14(stating that "the Best Lawyers® method expressly builds its lists of selected lawyers by calling/polling these lawyers already listed in the previous edition of Best Lawyers®"). However, even to the extent Petitioner provides citations to the Best Lawyers 1987 (Ex. 4) or Best Lawyers 1983 (Ex. 3) publications (Pet. 12, 14), Petitioner fails to provide sufficient argument or supporting evidence that explains how the citations correspond to the limitations of claim 1.

Based on the foregoing, we are not persuaded that Petitioner has demonstrated a reasonable likelihood that Petitioner would prevail in

showing the unpatentability of independent claim 1, related independent claims 12 and 13, or claims 2–11, which depend from claim 1.

III. CONCLUSION

For the foregoing reasons, we determine that the information presented in the Petition does not establish a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of any claim of the ’564 patent. Thus, we do not institute an *inter partes* review of the ’564 patent.

IV. ORDER

Accordingly, it is

ORDERED that the Petition is *denied* and no trial is instituted.

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