

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTERNATIONAL BUSINESS MACHINES CORPORATION,
Petitioner,

v.

INTELLECTUAL VENTURES I LLC,
Patent Owner.

Case IPR2015-01543
Patent 6,519,581 B1

Before MEREDITH C. PETRAVICK, BEVERLY M. BUNTING, and
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

BUNTING, *Administrative Patent Judge*.

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

I. INTRODUCTION

International Business Machines Corporation (“Petitioner”) filed a Petition on July 02, 2015 pursuant to 35 U.S.C. §§ 311–319, requesting an *inter partes* review of claims 11–19 and 39–47 (the “challenged claims”) of U.S. Patent No. 6,519,581 B1 (Ex. 1004, “the ’581 patent”). Paper 2, (“Pet.”). Pursuant to our December 7, 2015 Order (Paper 16), Intellectual Ventures I LLC (“IV”), timely filed a Preliminary Response to the Petition on January 20, 2016 (Paper 17, “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.”

Taking into account the arguments and evidence presented in the Petition and Preliminary Response, and for the reasons explained below, we conclude that the Petition does not establish a reasonable likelihood that Petitioner would prevail in challenging the patentability of claims 11–19 and 39–47 of the ’581 patent. We, therefore, *deny* the Petition.

II. BACKGROUND

A. *Related Proceedings*

The parties identify the following proceedings in which infringement of the ’581 patent has been alleged:

- *Intellectual Ventures I LLC et al. v. Erie Indemnity Company, et al*, Civ. No. 1:14-cv-00220 (W.D. Pa).
- *Intellectual Ventures I LLC et al. v. Old Republic General Insurance Group, Inc., et al*, Civ. No. 2:14-cv-01130 (W.D. Pa); and

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- *Intellectual Ventures I LLC et al. v. Highmark, Inc., et al*, Civ. No. 2:14-cv-01131 (W.D. Pa)

Pet. 1; *see also* Paper 7, 3. On March 18, 2016, in an email correspondence to the Board, Petitioner indicated that IV settled its matter with Highmark, Inc., but the appeal to the United States Court of Appeals for the Federal Circuit involving Petitioner remains pending. Ex. 3001.

The '581 Patent is also the subject of another *inter partes* review petition filed by Petitioner in IPR2015-01542 and two other *inter partes* review petitions, IPR2015-01956 and IPR2015-01957, filed collectively by Old Republic General Insurance Group, Inc., Old Republic Insurance Company, Old Republic Title Insurance Group, Inc., and Old Republic National Title Insurance Company.

B. The '581 Patent (Ex. 1004)

The '581 patent, titled "Collection of Information Regarding a Device or a User of a Device Across a Communication Link," issued February 11, 2003, from U.S. Patent Application No. 09/844,858 filed on April 27, 2001, and is a continuation of U.S. Patent Application No. 09/017,112 filed on January 31, 1998, now U.S. Patent No. 6,236,983. Ex. 1004, [54], [45], [21], [22], and [63]. The '581 patent is directed to a system and method for collecting information about a device or user of the device. *Id.* at 1:13–15. The system is implemented on a client and server as shown in Figure 1, reproduced below:

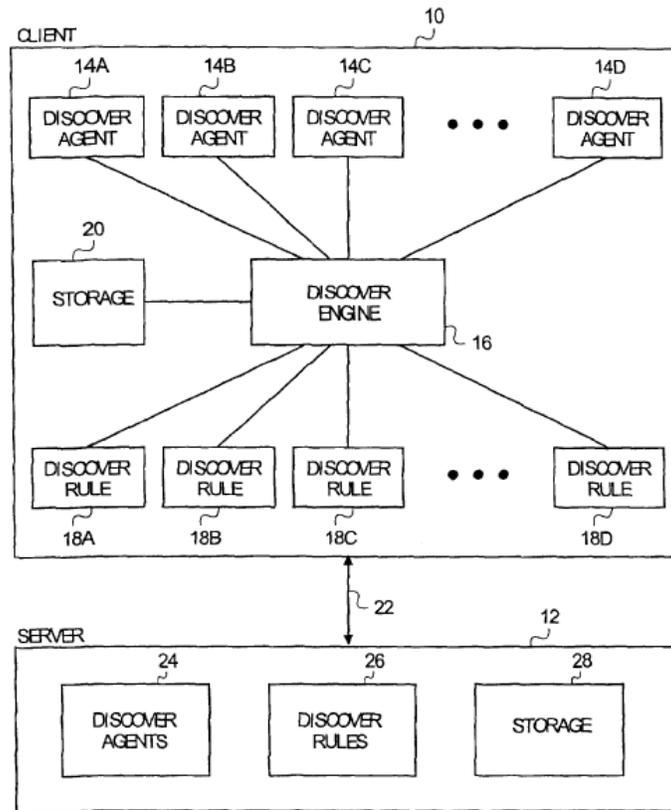


Figure 1 is a diagrammatic view of the information collection system. *Id.* at 4:8–10. Client 10 is coupled to server 12 via communication link 22, such as a local area network (LAN), a wide area network (WAN), or the Internet. *Id.* at 5:19–25. As shown, client 10 may include one or more discovery agents 14a–14d, one or more discovery rules 18a–18d, and discovery engine 16. *Id.* at 4:10–16, 4:33–35.

Each of discovery agents 14a–14d collects client and/or user information (e.g., hardware and software configurations of client 10 and the user’s interests), and communicates this information to discovery engine 16. *Id.* at 4:16–25. Discovery engine 16 uses the received data to execute one or more discovery rules 18a–18d. *Id.* at 4:39–42. Examples of discovery rules includes “a series of Boolean operations, mathematical equations, or other

comparisons or evaluations of the collected data.” *Id.* at 3:19–21. The ’581 patent contemplates that “the discovery rules and discovery agents are independent of one another.” *Id.* at 4:38–39. The result obtained by applying a particular discovery rule “may store the received data, invoke another discovery rule, or combine the received data with previously stored data (e.g., performing data averaging).” *Id.* at 4:50–53. The ’581 patent also discloses that the result “may trigger one or more activities or events.” *Id.* at 4:63–64.

Server 12 likewise includes one or more discovery agents 24, one or more discovery rules 26, and a storage mechanism 28. *Id.* at 5:25–27. For example, server 12 may store various discovery agents 24 and discovery rules 26 for transmission to one or more clients, which are then activated or executed by the discovery engine contained in the client. *Id.* at 5:30–33. Additionally, storage device 28 can store various information regarding clients coupled to the server and the various discovery rules and discovery agents already installed on each client. *Id.* at 5:34–37.

C. Illustrative Claim

Of the challenged claims, claims 11 and 39 are independent. Claims 12–19 depend directly or indirectly from claim 11, and claims 40–47 depend directly or indirectly from claim 39. Claim 11, reproduced below, is illustrative of the subject matter of the ’581 patent:

11. In a computer system, method of collecting information comprising:
 - receiving a discovery rule across a communication link from a sender,

applying the discovery rule to data about the computer system or a user to generate information, and wherein the data is collected by a discovery agent located in the computer system when the discovery agent is activated and without requiring action by the user; and

communicating the information across the communication link back to the sender of the discovery rule.

Ex. 1004, 11:34–44.

D. Prior Art Relied Upon

Petitioner relies on the following prior art references (Pet. 3):

Reference	Patent/Printed Publication No.	Date (Issued)	Exhibit
Seiffert	U.S. Patent No. 5,729,472	Mar. 17, 1998	1005
Fawcett	U.S. Patent No. 5,678,002	Oct. 14, 1997	1006
Wahlquist	U.S. Patent No. 5,367,667	Nov. 22, 1994	1007
Ghezzi	Fundamentals of Software Engineering	1991	1008
Berry	U.S. Patent No. 5,668,944	Sept. 16, 1997	1009

E. The Asserted Grounds

Petitioner challenges claims 11–19 and 39–47 of the '581 patent based on the asserted grounds of unpatentability set forth in the table below. Pet. 4.¹ In support of the grounds of unpatentability referenced below, Petitioner relies on the Declaration of Dr. Richard N. Taylor. Ex. 1001.

¹ We observe that the three grounds asserted by Petitioner are in actuality 7 separate grounds and treat them as such. Pet. 4.

Reference(s)	Basis	Challenged Claims
Seiffert	§ 102	11, 16–19, 39, and 44–47
Seiffert, Wahlquist	§ 103	12–15, and 40–43
Fawcett	§ 102	11–15, 17, 19, 39–43, 45, and 47
Fawcett, Ghezzi	§ 103	16 and 44
Fawcett, Berry	§ 103	18 and 46
Fawcett, Ghezzi	§ 103	11–17, 19, 39–45, and 47
Fawcett, Ghezzi, Berry	§ 103	18 and 46

III. ANALYSIS

A. Claim Interpretation

In an *inter partes* review, claim terms are given their broadest reasonable interpretation in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Technologies, LLC*, 793 F.3d 1268, 1278–79 (Fed. Cir. 2015), *cert. granted sub nom. Cuozzo Speed Techs., LLC v. Lee*, 84 U.S.LW. 3218 (U.S. Jan. 15, 2016) (No. 15-446). Under the broadest reasonable interpretation standard, and absent any special definitions, claims 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). Any special definitions for claim terms or phrases must be set forth with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). In the absence of such a

definition, limitations are not to be read from the specification into the claims. *See In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

Against this backdrop, we consider the parties' claim construction arguments. Petitioner proposes a claim construction for each of the following claim terms: "discovery rule," "discovery agent," "separate code sequences," and "passively." Pet. 4–10. IV challenges Petitioner's proposed construction of "discovery agent" and proffers its own construction. Prelim. Resp. 8–10. We, however, need not assess the parties' proposed constructions because they are not necessary to resolve the dispositive issues discussed *infra*. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) ("only those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy").

B. Grounds Based on Seiffert

Petitioner challenges claims 11, 16–19, 39, and 44–47 as anticipated under 35 U.S.C. § 102(b) by Seiffert. Pet. 17–26, 30–33. In addition, Petitioner challenges claims 12–15, and 40–43 as obvious under 35 U.S.C. § 103(a) based on Seiffert and Wahlquist. *Id.* at 27–31, 33–34. Petitioner explains how Seiffert, or Seiffert and Wahlquist describes the subject matter of the challenged claims, and cites the Declaration of Dr. Taylor in support of the analysis advocated in the Petition. Pet. 17–34. IV counters that Seiffert does not disclose that the generated information is communicated back to the sender of the discovery rule. Prelim. Resp. 13–18.

We have reviewed the parties' explanations and supporting evidence. Given the evidence of record, we are not persuaded that Petitioner has

demonstrated a reasonable likelihood of prevailing on its assertion that challenged claims 11, 16–19, 39, and 44–47 are anticipated by Seiffert. Nor are we persuaded by Petitioner that claims 12–15, and 40–43 would be obvious based on the combination of Seiffert with Wahliquist. We begin our analysis with a brief overview of Seiffert, and then we address the parties’ contentions in turn.

1. Overview of Seiffert (Ex. 1005)

Seiffert, titled “Monitoring Architecture,” was filed on May 17, 1996 and issued on March 17, 1998. Ex. 1005 [54], [22], and [45]. Seiffert is directed to an automated method of monitoring a plurality of remotely located managed systems using rules. *Id.* at 1:9–11. As shown in Figure 1, reproduced below, computer system 100 includes subsystem 10, referred to as control point C, and subsystems 20, 30, referred to as Managed Subsystem A and Managed Subsystem B.

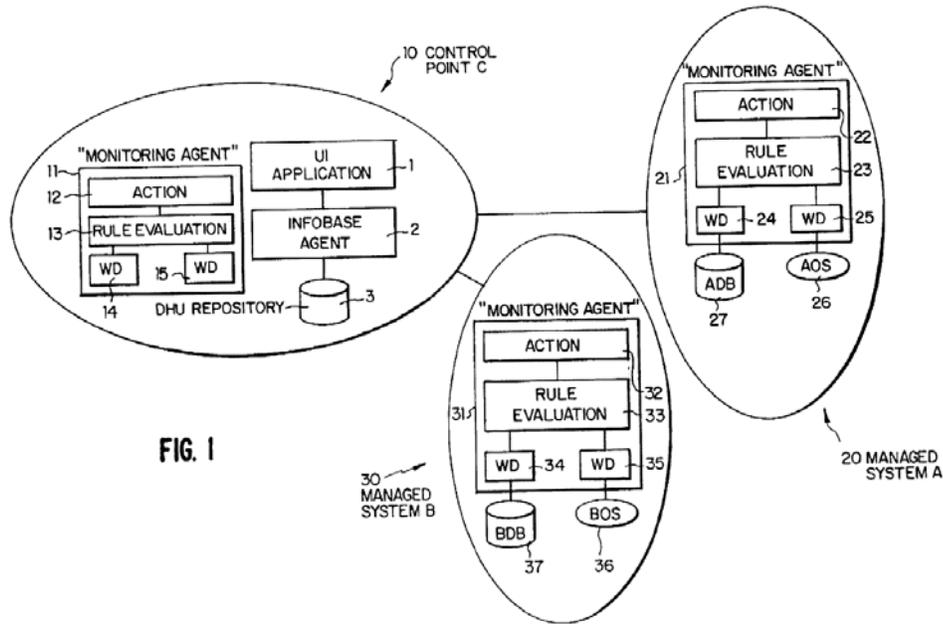


Figure 1 is a diagrammatic view of computer system 100.

Id. at 4:21–23. Monitoring agent 11 is part of control point C and includes action agent 12, rule evaluator module 13, and watchdog agents 14, 15. *Id.* at 4:56–59. Similarly, monitoring agent 21 includes action agent 22, rule evaluator module 23, and watchdog agents 24, 25 (*id.* at 5:13–15) and monitoring agent 31 includes action agent 32, rule evaluator module 33, and watchdog agents 34, 35 (*id.* at 5:27–29). Monitoring agents 11, 21 and 31 enable the system administrator to monitor computer system 100 using watchdogs, i.e. “a process, which operates on one of the watchdog agents.” *Id.* at 5:36–37. The system administrator programs rule evaluator modules 13, 23, 33 with one or more watchdog rules, i.e., “a condition or set of conditions evaluated based on the values returned by one or more watchdog checks.” *Id.* at 5:52–54.

In operation, after the system administrator defines the watchdog check, it is transferred to infobase agent 2 and stored in data repository 3 until determined to transfer to the watchdog agent, and the watchdog agent is configured to execute the watchdog check. *Id.* at 6:15–29. Watchdog rules defined by the system administrator are transferred to infobase agent 2, and stored in data repository 3, until determined time to transfer to the global or local rule evaluator. *Id.* at 6:37–67. By way of example, the steps performed by the system administrator to monitor log-ins to Managed System A is described. *Id.* at 8:20–11:65.

2. Discussion

Petitioner relies on Seiffert to describe each of the limitations recited in challenged independent claims 11 and 39. Common to each of independent claims 11 and 39 is the “communicating the information across

the communication link back to the sender of the discovery rule” (“communicating”) limitation.² Ex. 1004, 11:43–44, 13:21–22.

a. Anticipation by Seiffert

A claim is anticipated if each limitation of the claim is disclosed in a single prior art reference arranged as in the claim. *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008). As recently reiterated by the Federal Circuit, “a reference can anticipate a claim even if it ‘d[oes] not expressly spell out’ all the limitations arranged or combined as in the claim, if a person of skill in the art, reading the reference, would ‘at once envisage’ the claimed arrangement or combination.” *Kennametal, Inc. v. Ingersoll Cutting Tool Co.*, 780 F.3d 1376, 1381 (Fed. Cir. 2015) (citing *In re Petering*, 301 F.2d 676, 681 (CCPA 1962)). We analyze the ground based on anticipation in accordance with the above-stated principles.

Claims 11 and 39

Relying on the testimony of Dr. Taylor, Petitioner asserts that the “communicating” limitation is satisfied by the disclosure in Seiffert of how an exemplary system prohibits further logins when the managed system is overloaded. Pet. 24–25 (citing Ex. 1001 ¶¶ 112–113, 176). To support its contention that Seiffert discloses that the generated information is provided to the appropriate action agent(s), i.e., “one or more of action agent 12 on Control Point C, action agent 22 on Managed System A, or action agent 32 on Managed System B” (*id.* at 25 (citing Ex. 1005, 5:56–58; Ex. 1001 ¶ 112)), Petitioner directs our attention to the passage in Seiffert describing how “[t]he action(s) specified by the rule evaluator is carried out by at least

² Claim 11 is a method claim, and claim 39 is an apparatus claim directed to a computer readable medium.

one of the action agents 12, 22, 32.” Ex. 1005, 5:56–58 (emphasis omitted). Relying again on the testimony of Dr. Taylor and this same passage from Seiffert, Petitioner argues “[w]hen the generated information relates to an action to be taken by the control point, performance issues, or the system as a whole, then the action agent of the control point receives the generated information.” Pet 26 (citing Ex. 1001 ¶¶ 113–114, Ex. 1005, 5:56–58.). Because control point C has a user interface enabling the system administrator to interact with and manage other subsystems, as well as maintain a repository of information about the managed systems, Petitioner surmises that “any changes resulting from a rule would be received by the control point and reflected in the repository.” *Id.* (citing Ex. 1001 ¶ 114; Ex. 1005, 4:47–55, 6:9–14).

In response, IV contends that Seiffert does not disclose the “communicating” limitation. Prelim. Resp. 13–18. Specifically, IV argues that Seiffert describes how information generated by local watchdog rules remains at the local Managed System, thus such information “is never communicated back to the Control Point.” *Id.* at 14. Based on Petitioner’s reliance on control point C as the “sender” of the discovery rule (Pet. 18), IV argues that “any reliance in the Petition of communicating the generated information to Managed System A or Managed System B is misplaced since this would not be a communication of the generated information back to the *sender* of the discovery rule.” Prelim. Resp. 15 (emphasis added). IV contends that the petition’s assertion that “the control point user interface receives watchdog check values” (Pet. 26), improperly confuses claim elements. *Id.* at 16. Additionally, IV challenges Petitioner’s assertion that “watchdog check values equate to the claimed ‘data [that] is collected by the

discovery agents’ (Petition at 23) while the output of the rule evaluators is the claimed ‘information’ generated by a discovery rule (Petition at 21).” Prelim. Resp. 16. According to IV, information generated by the local watchdog rule in Seiffert is not sent to control point C or any other Managed System. *Id.* at 17 (citing Ex. 1005, 6:59–67).

Petitioner does not direct us to, nor can we find, any recitation in Seiffert expressing that the information generated by transmitting a watchdog rule from control point C to Managed System A and applying the rule to values returned by watchdog checks within Managed System A, is also communicated back to control point C. *See* Pet. 24–26. Indeed, the passage of Seiffert cited by Petitioner is silent with respect to any correlation between action agent 12, 22, and 33 that carries out the specified action(s) and a particular rule evaluator module 13, 23, and 33. *See* Ex. 1005, 5:49–58. Petitioner’s argument, i.e., because control point C maintains information about Managed Systems A and B and the computer system as a whole, it would receive any changes resulting from a rule, is not supported by a sufficient factual basis. *See* Pet. 26 (citing Ex. 1001 ¶ 114; Ex. 1005, 4:47–55, 6:9–14).

We also are not persuaded by Dr. Taylor’s supporting testimony because it is not supported by underlying facts. *See* 37 C.F.R. § 42.65. For example, Dr. Taylor testifies that

one of ordinary skill in the art would have understood, even when a particular action is not required of the control point subsystem, the information generated is received there to facilitate system management.

(Ex. 1001 ¶113). In addition, Dr. Taylor testifies that:

one of ordinary skill would understand, any changes to the system resulting from a rule's action would be reflected in updates to this database.

(*Id.* ¶ 114). Thus, we understand Dr. Taylor to testify that Seiffert's control point C necessarily could perform the same function of receiving the information from Managed System A. "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745 (Fed Cir. 1999). Although Seiffert's system may indeed be capable of communicating the generated information, mere probabilities or possibilities fall short of demonstrating that the missing descriptive matter is necessarily present in Seiffert, as is required for a ground based on anticipation.

More persuasive, however, is IV's contention that the information would not be communicated from Managed System A to control point C because "[t]he entire purpose of Seiffert's local watchdog rules is actually to permit a managed system to operate *independently* to reduce network bandwidth usage and reduce the processing load by the central point." Prelim. Resp. 3. As such, we are not persuaded that Petitioner has demonstrated sufficiently the "communicating" limitation recited in independent claims 11 and 39.

Based on the record before us, Petitioner has not demonstrated a reasonable likelihood that it will prevail on its assertion that independent claims 11 and 39 are anticipated by Seiffert.

Claims 16–19, and 44–47

As explained above, claims 16–19, and 44–47 depend directly or indirectly from independent claims 11 or 39 respectively. By virtue of their

dependency, each of claims 16–19 and 44–47 incorporate the same limitations as their underlying base claim. For the reasons discussed *supra* with respect to claims 1 and 39, Petitioner has not demonstrated a reasonable likelihood that it will prevail on its assertion that claims 16–19, and 44–47 that depend from claim 1 and 39 respectively are anticipated by Seiffert.

b. Obviousness Based on Seiffert and Wahlquist

Petitioner contends that dependent claims 12–15 and 40–43 are unpatentable under 35 U.S.C. § 103 over the combination of Seiffert and Wahlquist. Pet. 27–30, 33–34. Petitioner does not rely on Wahlquist to remedy the deficiencies of Seiffert with respect to the “communicating” limitation, as discussed above in the context of the ground of anticipation asserted against independent claims 11 and 39. *Id.* Consequently, Petitioner has not demonstrated a reasonable likelihood that it will prevail on its assertion that claims 12–15, and 40–43 would have been obvious over the combination of Seiffert and Wahlquist.

C. Grounds Based on Fawcett

Next, Petitioner challenges claims 11–15, 17, 19, 39–43, 45, and 47 as anticipated under 35 U.S.C. § 102 by Fawcett. Pet. 34–42, 45–46, and 47. Additionally, Petitioner challenges claims 16 and 44 as obvious under 35 U.S.C. § 103(a) based on the combination of Fawcett and Ghezzi (*id.* at 42–45, 47–49); and claims 18 and 46 as obvious under 35 U.S.C. § 103(a) based on the combination of Fawcett and Berry (*id.* at 46–47, 49–51). Petitioner alternatively challenges the patentability of claims 11–17, 19, 39–45, and 47 as obvious under 35 U.S.C. § 103(a) based on Fawcett and Ghezzi, and claims 18 and 46 as obvious based on Fawcett, Ghezzi and Berry. *Id.* at 51–

52. As previously noted, Petitioner further cites the Declaration of Dr. Taylor in support of the analysis advocated in the Petition. Ex. 1001. IV counters that Fawcett does not disclose transmission of a discovery rule across a communication link to a computer system. Prelim. Resp. 24–28.

We have reviewed the parties’ contentions and supporting evidence. Given the evidence of record, we are not persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing on its assertion that challenged claims 11–15, 17, 19, 39–43, 45, and 47 are anticipated by Fawcett. Nor are we persuaded that claims 16 and 44 are obvious based on the combination of Fawcett and Ghezzi, nor that claims 18 and 46 are obvious based on the combination of Fawcett and Berry. Likewise unpersuasive are Petitioner’s alternative arguments challenging claims 11–17, 19, 39–45, and 47 as obvious based on the combination of Fawcett and Ghezzi, and claims 18 and 46 as obvious based on the combination of Fawcett, Ghezzi and Berry. After a brief overview of Fawcett, we address the parties’ contentions in turn.

1. Overview of Fawcett (Ex. 1006)

Fawcett, titled “System and Mothed for Providing Automated Customer Support,” was filed on July 18, 1995 and issued on October 14, 1997. Ex. 1006, [54], [22], and [45]. Fawcett is directed to automated support for computer products, and in particular to providing support using a voice/data modem. *Id.* at 1:5–7. The product support services (“PSS”) system includes client 38 (e.g., computer center) and server 40 (e.g., customer’s personal computer) in communication via socket connection 36. *Id.* at 3:60–64, 4:1–3. The server includes diagnostic interpreters 48 (e.g., client software that initiates diagnostic command and interprets the results)

and diagnostic agents 50 (e.g., server software that executes commands issued by the diagnostic interpreter and returns results to the PSS). *Id.* at 4:34–41. The PSS can command the diagnostic agent 50 on customer computer 40 to perform tasks, such as downloading a diagnostic application, or executing a resident diagnostic application, receiving and reviewing results. *Id.* at 10:25–51.

2. Discussion

Petitioner asserts that Fawcett describes each of the limitations recited in challenged independent claims 11 and 39, as well as the claims that depend therefrom. IV challenges the sufficiency of Petitioner’s proofs in several respects that we discuss *infra*.

a. Anticipation by Fawcett

Independent claims 11 and 39 each recites in relevant part, “receiving a discovery rule across a communication link from a sender.” Ex. 1004, 11:36–37. Petitioner argues that the disclosure in Fawcett regarding sending “data evaluation code of a diagnostic agent” across a communication link from the PSS center satisfies this limitation. Pet. 35–36 (citing Ex. 1001 ¶¶ 85, 212–215, and 264; Ex. 1006, 3:60–4:6, 4:64–5:1–4, and Figure 4). Specifically, that the diagnostic agents include both collection code and data evaluation code because “[t]he diagnostic agents perform both collection tasks and data evaluation tasks.” *Id.* at 36 (citing Ex. 1001 ¶¶ 213–214; Ex. 1006, 10:27–50). Petitioner asserts that “[t]he data evaluation code of a diagnostic agent (i.e., discovery rule) is applied to data about the customer’s computer to generate diagnostic information.” *Id.* at 36–37 (citing Ex. 1001 ¶ 213; Ex. 1006, 10:27–50). Petitioner thus maintains that “[b]ased on the evaluation of collected data, the data evaluation code of the diagnostic agent

can trigger additional actions to facilitate remote diagnostics of the customer's computer.” *Id.* at 37. Petitioner additionally cites this same disclosure in Fawcett regarding the diagnostic agent to demonstrate that Fawcett satisfies the “discovery agent” claim term. *Id.* at 38–40. Specifically, that the data collection code of the diagnostic agent collects data about the customer's computer. *Id.* at 38 (citing Ex. 1001 ¶¶ 225–227, 266).

IV counters that Fawcett does not disclose a discovery agent because Fawcett does not describe the diagnostic agent as having data evaluation code. Prelim. Resp. 24. This terminology was coined by Petitioner's expert, Dr. Taylor, according to IV, “to divide Fawcett's single diagnostic agent into two separate components to enable Petitioner to simultaneously read Fawcett's diagnostic agent on both the claimed ‘discovery agent’ and the claimed ‘discovery rule.’” *Id.* According to IV, the explicit disclosure in Fawcett regarding the diagnostic interpreter performing the evaluation of data, and not the diagnostic agent, contradicts Petitioner's interpretation of Fawcett's diagnostic agent. *Id.* at 25 (citing Ex. 1006 4:33–40). IV supports its position by pointing out that “Fawcett notes that the functionality of updating an operating system ‘is implemented in diagnostic applications, each consisting of a diagnostic interpreter and a diagnostic agent.’” *Id.* at 26 (citing Ex. 1006, 10:51–53).

We are not persuaded by Petitioner that Fawcett discloses the “discovery rule” claim element recited in challenged claim 11 and 39. Petitioner's arguments and evidence do not explain sufficiently how the disclosure in Fawcett regarding the diagnostic agent satisfies both the “discovery rule” and “discovery agent” claim elements. Like IV, our review

of Fawcett does not reveal disclosure of “data evaluation code” as part of the diagnostic agent. The mere probability or possibility of “data evaluation code” residing within the diagnostic agent of Fawcett falls short of demonstrating that the missing descriptive matter is necessarily present in Fawcett, as is required for a ground based on anticipation.

Moreover, the conclusory analysis proffered by Petitioner’s declarant, Dr. Taylor, is not supported adequately by evidence demonstrating that one of skill in the art would understand Fawcett’s diagnostic agent as including “data evaluation code.” *See* 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 294 (Fed. Cir. 1985) (stating a lack of objective support for an expert opinion “may render the testimony of little probative value in [a patentability] determination.”). In particular, Dr. Taylor testifies that “[t]he diagnostic agent [of Fawcett] includes data evaluation code” (Ex. 1001 ¶ 212 (citing Ex. 1006, 10:27–50)); “[t]he data evaluation code of a diagnostic agent is a discovery rule” (*id.* ¶ 213 (citing Ex. 1006, 10:27–50)); and “[b]ased on the results of its application to the data, the data evaluation code of a diagnostic agent can also trigger additional actions to facilitate remote diagnostics of the customer’s computer” (*id.*). Our review of this passage from Fawcett reveals a list of exemplary tasks the PSS 38 can command the remote diagnostic agent 38 to perform. Dr. Taylor does not explain sufficiently how one of skill in the art would understand this task list to disclose the “diagnostic rule” limitation as recited in claims 11 and 39. *See Id.* ¶¶ 214, 264.

While the performance of these tasks may involve rules in actual operation, again, mere possibilities or probabilities fall short of demonstrating that Fawcett necessarily discloses the diagnostic rule, as is required for a ground based on anticipation. Instead, IV argues persuasively that based on Petitioner's interpretation of Fawcett, using the diagnostic interpreter to update the operating system would be unnecessary if the diagnostic agent alone performed data collection and evaluation. Prelim. Resp. 26.

Based on the record before us, Petitioner has not demonstrated a reasonable likelihood that it will prevail on its assertion that claims 11 and 39 are anticipated by Fawcett. By virtue of their dependency from claims 11 and 39 respectively, claims 12–15, 17, 19, 40–43, 45, and 47 are likewise not anticipated by Fawcett for the same reasons.

b. Obviousness Based on Fawcett and Ghezzi

Petitioner contends that dependent claims 16 and 44 are unpatentable over the combination of Fawcett and Ghezzi. Pet 42–45, 47–49. In this asserted ground based on obviousness, Petitioner does not apply the teachings of Ghezzi in such a way that remedies the deficiencies of Fawcett with regards to the “discovery rule” claim element.³ Therefore, for essentially the same reasons as discussed above, Petitioner has not demonstrated a reasonable likelihood that it will prevail on its assertion that claims 16 and 44 would have been obvious over the combination of Fawcett and Ghezzi.

³ Because Petitioner's arguments regarding Ghezzi are not persuasive, we need not consider IV's contentions disputing the public accessibility of Ghezzi. Prelim. Resp. 28–32.

c. Obviousness Based on Fawcett and Berry

Petitioner contends that dependent claims 18 and 46 are unpatentable over the combination of Fawcett and Berry. Pet. 46–47, 49–51. Likewise, in this asserted ground based on obviousness, Petitioner does not apply the teachings of Berry in such a way that remedies the deficiencies in Fawcett with regards to the “discovery rule” claim element. Therefore, for essentially the same reasons discussed above, Petitioner has not demonstrated a reasonable likelihood that it will prevail on its assertion that claims 18 and 46 would have been obvious over the combination of Fawcett and Berry.

d. Alternative Obviousness Ground based on Fawcett

Recognizing that the ’581 patent describes “a distinct separation between the discovery rule and discovery agent,” Petitioner asserts that the combination of Fawcett and Ghezzi renders claims 11–17, 19, 39–45, and 47 as obvious, and “further in view of Berry renders obvious [claims] 18 and 46.” Pet. 51.

A claim is unpatentable under § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966). We

analyze this ground based on obviousness in accordance with the above-stated principles.

To support its position, Petitioner directs us to consider its arguments regarding the combined teaching of Fawcett and Ghezzi in relation to claims 16 and 44, and well as Fawcett, Ghezzi and Berry in relation to claims 18 and 46. Pet. 51–52. We decline this invitation to review each of the references, as well as Petitioner’s arguments with respect to each of these references, in search of the scope and content of the prior art as well as any differences between the relevant claim limitations and a particular reference.

Moreover, a ground of obviousness must include “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). “[T]his analysis should be made explicit” and it “can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR*, 550 U.S. at 418. We have considered Petitioner’s arguments (Pet. 51–52), however, Petitioner does not articulate sufficiently why or how one of ordinary skill in the art would have combined or modified the teachings and suggestions of Fawcett and Ghezzi, or Fawcett, Ghezzi or Berry, to address with sufficient specificity the differences between the claimed invention and the prior art.

Based on the record before us, Petitioner has not demonstrated a reasonable likelihood that it will prevail on its assertion that claims 11–17, 19, 39–45, and 47 would have been obvious over the combination of Fawcett and Ghezzi. Nor has Petitioner demonstrated a reasonable

likelihood that it will prevail on its assertion that claims 18 and 46 would have been obvious over the combination of Fawcett, Ghezzi, and Berry.

D. Participation by IV

Because the information presented in the Petition does not demonstrate a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims, we need not address the parties' contentions regarding the participation of IV in this proceeding.

IV. SUMMARY

For the foregoing reasons, we conclude that Petitioner has not demonstrated a reasonable likelihood that at least one of the challenged claims is unpatentable based on the asserted grounds. We, therefore, do not institute an *inter partes* review on any of the asserted grounds as to any of the challenged claims.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is DENIED and no trial is instituted.

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