

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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BANK OF AMERICA, N.A.,  
PNC FINANCIAL SERVICES GROUP, INC., and PNC BANK, N.A.,  
Petitioners,

v.

INTELLECTUAL VENTURES I LLC,  
Patent Owner.

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Case CBM2014-00030  
Patent 7,603,382 B2

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Before THOMAS L. GIANNETTI, HYUN J. JUNG, and  
GREGG I. ANDERSON, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

DECISION  
Request for Rehearing  
*37 CFR § 42.71(d)*

## INTRODUCTION

Bank of America, N.A., PNC Financial Services Group, Inc., and PNC Bank, N.A. (“Petitioners”) requested institution of a covered business method patent review of claims 1–23 of U.S. Patent 7,603,382 B2 (“the ’382 patent”) pursuant to 35 U.S.C. § 321. Paper 6 (“Petition” or “Pet.”). Patent Owner, Intellectual Ventures I LLC, filed a preliminary response. Paper 12 (“Prelim. Resp.”). We granted the Petition and instituted a trial as to all challenged claims. Paper 14 (“Institution Decision”).

After institution, Patent Owner filed a Response (Paper 19, “PO Resp.”), and Petitioners filed a Reply (Paper 22, “Pet. Reply”). In addition, both parties relied upon expert testimony. Petitioners proffered the Declaration of Brad Myers, Ph.D. (Ex. 1004, “Myers Decl.”) with the Petition. Patent Owner proffered the Declaration of Peter Martin (Ex. 2003, “Martin Decl.”) with its Response. In addition, a transcript of Mr. Martin’s deposition (Ex. 1037, “Martin Dep.”) was submitted by Petitioners. No deposition transcript was filed for Dr. Myers.

Oral Hearing was held on March 2, 2015. A transcript of the argument was entered in the record as Paper 31 (“Hearing Tr.”).

In our Final Written Decision entered April 24, 2015 (Paper 32, “Final Decision”), we determined that Petitioners had shown by a preponderance of the evidence that all claims of the ’382 patent are unpatentable because they are directed to patent-ineligible subject matter under 35 U.S.C. § 101.

Patent Owner requests rehearing of our Final Written Decision. Paper 33 (“Req. Reh’g”). Patent Owner challenges the conclusion that the claims of the ’382 patent are not patentable under § 101. Req. Reh’g 1.

Patent Owner's grounds for rehearing are that: (1) the Board misapprehended or overlooked "unrebutted expert testimony" in determining that the claims are not eligible under § 101 (Req. Reh'g 1) and (2) the Board "misapprehended or overemphasized" certain testimony from Patent Owner's expert, Peter Martin. *Id.* at 2.

For at least the reasons that follow, Patent Owner's Request for Rehearing is denied.

## ANALYSIS

### 1. Overview

The applicable standard for a request for rehearing is set forth in 37 C.F.R. § 42.71(d), which provides in relevant part:

A party dissatisfied with a decision may file a request for rehearing, without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, opposition, or a reply.

In *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014), the Supreme Court followed the two-step framework set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289 (2012), "for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts." *Alice*, 134 S. Ct. at 2355. In the first step, "we determine whether the claims at issue are directed to one of those patent-ineligible concepts." *Id.* (citing *Mayo*, 132 S. Ct. at 1296–1297). In

the second step, we consider the elements of each claim both individually and as an ordered combination to determine whether the additional elements transform the nature of the claim into a patent-eligible application. *Id.*

Step two of the analysis may be described as a search for an “inventive concept”—i.e., an element or combination of elements that is sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the ineligible concept itself. *Id.* (citing *Mayo*, 132 S. Ct. at 1294).

## 2. Evidence of “Inventiveness” Was Not Overlooked

According to Patent Owner’s rehearing request, we overlooked the argument, from Patent Owner’s response, that “there was no evidence to support a finding that the combination of tailoring a web page based on web site navigation data was conventional.” Req. Reh’g 3. According to Patent Owner, “Petitioners never rebutted these points in Reply or in oral argument.” *Id.* Without such evidence, according to Patent Owner, the patentability of claims 1–6 and 16–23 should have been upheld. *Id.* at 4.

We disagree that Patent Owner’s “inventive concept” argument was “never rebutted” (Req. Reh’g 3); in fact, it was challenged in Petitioners’ Reply:

[Patent Owner’s] supposed “inventive concept”—“delivering tailored web pages through an interactive interface as a function of web site navigation history”—fails to meet this standard. It is merely a restatement of the ’382 patent’s abstract idea (i.e., “tailoring an information provider’s web pages based on data about a particular information user”). This “concept” fails to include *how* to tailor web pages or use the web site navigation data. It therefore cannot “ensure that the patent in practice amounts to significantly more than a patent upon the ineligible

concept itself,” as required by *Alice Corp.*

Pet. Reply 5–6 (footnote omitted). Nor are we persuaded that the argument was overlooked or misapprehended by the Board. The Board considered all arguments presented. The Board was not persuaded by Patent Owner’s argument on this issue. In fact, this argument was rejected by the Federal Circuit in *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 714 (Fed. Cir. 2014). The patent owner there argued “abstract ideas remain patent-eligible under §101 as long as they are new ideas, not previously well known, and not routine activity.” *Ultramercial*, 772 F.3d at 714. The Federal Circuit rejected this argument, concluding “[w]e agree with [defendant] that the claims of the ’545 patent are not directed to patent-eligible subject matter.” *Id.* Petitioners cite this very holding of *Ultramercial* in their response to Patent Owner’s “inventive concept” argument. Pet. Reply 5, n.1.

We, therefore, did not overlook or misapprehend the “inventive concept” argument put forth by Patent Owner. We simply found Petitioners’ argument more persuasive under the prevailing legal authorities, including *Ultramercial*.

Finally, we are not persuaded by Patent Owner’s attempt to reargue the applicability of *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), to the facts of this case. Req. Reh’g 5–7. *DDR Holdings* was discussed in our Final Decision at pages 15–17. There, we concluded that the facts of this case are closer to *Ultramercial* than *DDR Holdings*. *Id.* at 16. Patent Owner’s Rehearing Request takes issue with our conclusion but does not point to anything that was misapprehended or overlooked in our analysis. We, therefore, do not grant rehearing on that basis.

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