

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTERNATIONAL BUSINESS MACHINES CORP.,
Petitioner,

v.

INTELLECTUAL VENTURES I LLC,
Patent Owner.

IPR2015-01481
Patent 6,510,434 B1

Before MEREDITH C. PETRAVICK, JENNIFER S. BISK, and
SHEILA F. McSHANE, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

International Business Machine Corp. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–3, 5–8, 12, 14, and 16 of U.S. Patent No. 6,510,434 B1 (Ex. 1004, “the ’434 patent”). Paper 2 (“Pet.”). Petitioner proffered a Declaration of H. V. Jagadish to support its analysis regarding patentability in the Petition. Ex. 1001.

We instituted *inter partes* review of claim 1–3, 5, and 6 as being obvious over Wical¹ and Lassila² and as being obvious over Morita³ and Lassila. Paper 12, 25. We denied institution of *inter partes* review of claims 7, 8, 12, 14, and 16 as being anticipated by Wical and as being anticipated by Morita. *Id.* at 8–17.

Intellectual Ventures I LLC (“Patent Owner”) filed a Patent Owner’s Response to the Petition. Paper 17 (“PO Resp.”). Patent Owner proffered a Declaration of Dr. Yannis Papakonstantinou to support its argument in the Patent Owner’s Response. Ex. 2001.

Petitioner filed a Corrected Reply to the Patent Owner’s Response (Paper 24) and proffered a Responsive Declaration of H. V. Jagadish for support (Ex. 1022).⁴

¹ U.S. Patent No. 6,038,560 (issued Mar. 14, 2000) (Ex. 1006).

² Ora Lassila, *Web Metadata: A Matter of Semantics*, IEEE Internet Computing, Vol. 2, Number 4 (allegedly published July/Aug. 1998) (Ex. 1008).

³ U. S. Patent No. 5,168,565 (issued Dec. 1, 1992) (Ex. 1007).

⁴ On August 16, 2016, Patent Owner objected to the Corrected Reply to the Patent Owner’s Response and the Responsive Declaration of H.W. Jagadish as containing new argument not raised in the Petition. *See* Paper 36. After reviewing the record, we determine that the Reply and Responsive Declaration did not contain new arguments. *Id.* Patent Owner raised the objection again during oral argument. *See* Tr. 21–22. In any event, Patent

Patent Owner filed a Motion for Observations on Cross-Examination of Dr. H.V. Jagadish (Paper 29) and Petitioner filed an opposition to the motion (Paper 35).

An oral hearing in this proceeding was held on September 14, 2016. A transcript of the hearing is included in the record (Paper 39, “Tr.”).

We have jurisdiction under 35 U.S.C. § 6 This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 1–3, 5, and 6 of the ’434 patent are unpatentable.

A. Related Proceedings

The parties indicate that the ’434 patent is at issue in *Intellectual Ventures I LLC et al. v. Erie Indemnity Co., et al.*, Case No. 1:14-cv-000220, *Intellectual Ventures I LLC et al. v. Old Republic Gen. Ins. Grp., Inc., et al.*, Case No 2:14-cv-01130, and *Intellectual Ventures I LLC et al. v. Highmark, Inc. et al.*, Case No. 2:14-cv-01131, all in the U.S. District Court for the Western District of Pennsylvania. Pet. 1; Paper 5, 2.

Patent Owner indicated that, on September 25, 2015, in each of the above proceedings, the District Court in the Western District of Pennsylvania dismissed the claims for infringement of the ’434 patent because the court found the asserted claims patent ineligible under 35 U.S.C. § 101. Paper 8, 2; Exs. 2010, 2011. Patent Owner appealed the dismissal to

Owner’s objection is now moot as we do not rely upon the Corrected Reply to the Patent Owner’s Response and the Responsive Declaration of H.W. Jagadish in our analysis below.

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the Court of Appeals for the Federal Circuit. *Intellectual Ventures I LLC et al. v. Erie Indemnity Co., et al.*, Case No. 12-1128 (Fed. Cir. filed Oct. 27, 2015). The Court of Appeals for the Federal Circuit has not yet issued a decision.

The '434 patent is the subject of two additional *inter partes* reviews, *Old Republic Gen. Ins. Grp., Inc. v. Intellectual Ventures I LLC*, Case IPR2016-00019 (PTAB filed Oct. 6, 2015) and *Old Republic Gen. Ins. Grp., Inc. v. Intellectual Ventures I LLC*, Case IPR2016-00020 (PTAB filed Oct. 6, 2015) (together, “the Old Republic IPRs”). The Board has not yet issued a final written decision in either *inter partes* review.

B. The '434 Patent

The '434 patent is titled “System and Method for Retrieving Information From a Database Using an Index of XML Tags and Metafiles” and issued on January 21, 2003, from an application filed on December 29, 1999. Ex. 1004, (22), (45), (54). One embodiment of the '434 patent discloses a method of “[r]etrieving information from a database using [eXtensible Markup Language (“XML”)] tags and metafiles.” *Id.* at Abstract. The method of retrieving information uses “an index that includes tags and metafiles to locate the desired information.” *Id.* at 4:11–13; *see also id.* at 7:19–20 (“The index includes a number of tags and metafiles associated with the tags.”)

The '434 patent also discloses an embodiment of a method of creating a database and an index for searching the database. All the challenged claims, 1–3, 5, and 6, are directed to the method of creating the database and index.

Figure 5 of the '434 patent is reproduced below.

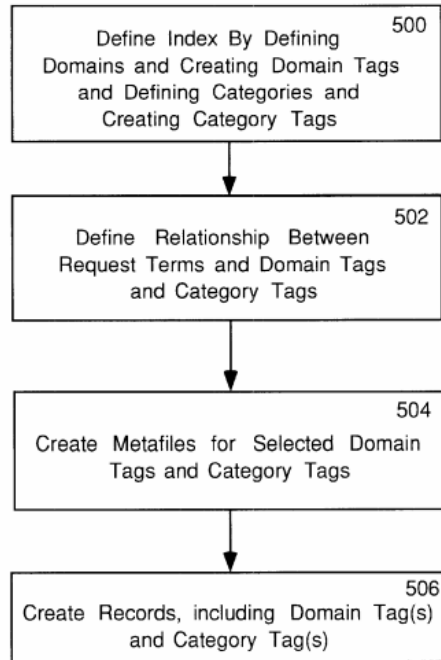


FIG. 5

Figure 5 “illustrates the steps for creating an index, including XML tags and metafiles, that can be used to search a database.” *Id.* at 11:5–8. In step 500, the index is defined by defining the XML tags for the index. *Id.* at 5:8–9. The XML tags include domain tags and category tags. For example, a domain may be “Restaurants” and a category may be “Cuisine,” which includes the terms “Mexican” and “American.” *Id.* at 4:18–33.

In step 504, “metafiles are created for selected domain tags and category tags that were defined in step 500.” *Id.* at 11:45–46. The metafile can be created manually by using data gathered from observing the types of information that a user typically considers. *Id.* at 11:50–52. The metafile

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