

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OLD REPUBLIC GENERAL INSURANCE GROUP, INC.; OLD
REPUBLIC INSURANCE COMPANY; OLD REPUBLIC TITLE
INSURANCE GROUP, INC.; and OLD REPUBLIC NATIONAL TITLE
INSURANCE COMPANY,
Petitioner,

v.

OWNER¹ OF U.S. PATENT NO. 6,519,581 B1²,
Patent Owner.

Case IPR2015-01957
Patent 6,519,581 B1

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

IPPOLITO, *Administrative Patent Judge*.

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

¹ The Federal Circuit determined that Intellectual Ventures I LLC is not the owner of U.S. Patent No. 6,519,581 B1 (“the ’581 patent”) because of a defective assignment in the chain of title. *Intellectual Ventures I LLC v. Erie Indem. Co.*, Case No. 2016-1128, 2017 WL 900018, at *1–*5 (Fed. Cir. Mar. 7, 2017). At the Federal Circuit, there was no dispute that AllAdvantage.com was the last known assignee of the ’581 patent. *Id.* After its agent for service of process was notified, AllAdvantage.com did not make an appearance as patent owner in these proceedings. *See* Ex. 3003.

² The caption for this proceeding has been changed to remove Intellectual Ventures I LLC as the Patent Owner. *See* Paper 37.

I. INTRODUCTION

Old Republic General Insurance Group, Inc.; Old Republic Insurance Company; Old Republic Title Insurance Group, Inc.; and Old Republic National Title Insurance Company (collectively “Petitioner”) filed a Petition on September 28, 2015, requesting an *inter partes* review of claims 11–19 and 39–47 of U.S. Patent No. 6,519,581 B1 (Ex. 1001, “the ’581 patent”). (Paper 1, “Pet.”). Petitioner supports its challenge with a Declaration from Dr. Michael Mitzenmacher (Ex. 1003) and a Reply (Paper 26 “Reply”). On April 18, 2016, we instituted an *inter partes* review of claims 11–19 and 39–47 of the ’581 patent. Paper 28 (“Dec. on Inst.”). An oral hearing was held on December 19, 2016, and a transcript of the oral hearing is of record. Paper 34 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This Decision is a final written decision under 35 U.S.C. § 318(a) as to the patentability of the challenged claims. For the reasons that follow, we determine Petitioner has shown by a preponderance of the evidence that claims 11–19 and 39–47 of the ’581 patent are unpatentable.

A. *Related Proceedings*

Petitioner indicates that the ’581 patent is involved in the following United States District Court proceedings:

- *Intellectual Ventures I LLC v. Old Republic General Insurance Group, Inc.*, No. 2:14-cv-01130 (W.D. Pa.);
- *Intellectual Ventures I LLC v. Highmark, Inc.*, No. 2:14-cv-01131 (W.D. Pa.); and
- *Intellectual Ventures I LLC v. Erie Indemnity Company*, No. 1:14-cv-00220 (W.D. Pa.).

Pet. 2. In these above-referenced cases, the district court dismissed Intellectual Ventures I LLC's ("IV") patent infringement claims based on the '581 patent for lack of standing. Ex. 1017, 24. IV appealed the district court's decision to the United States Court of Appeals for the Federal Circuit. *See Intellectual Ventures I LLC v. Erie Indem. Co.*, Case Nos. 2016-1128, -1129, -1132, 2017 WL 900018, at *1 (Fed. Cir. Mar. 7, 2017). On March 18, 2016, in email correspondence to the Board, Petitioner indicated that IV settled its matter with Highmark, Inc. Further, in Petitioner's updated mandatory notices, we are informed that the Federal Circuit issued a decision on March 7, 2017 in IV's consolidated Appeal Nos. 2016-1128, -1129, and -1132, affirming the district court's dismissal of IV's patent infringement suit against Petitioner based on a lack of standing. Paper 36, 1; *see Intellectual Ventures I LLC*, 2017 WL 900018, at *1-*5.

The '581 patent is also the subject of another *inter partes* review petition filed by Petitioner in IPR2015-01956.

B. Intellectual Ventures I LLC

During the course of this proceeding, IV has participated as the purported Patent Owner of the '581 patent. *See* Dec. on Inst. 3-6. IV has maintained that it is the patent owner of the '581 patent through a series of assignments including an assignment between AllAdvantage.com and Alset, Inc. ("the Alset Agreement."). *Id.* As discussed in greater detail in our Order (Paper 37) filed concurrently herewith, on March 7, 2017, the Federal Circuit affirmed a district court's dismissal of IV's patent infringement claims for lack of standing. In doing so, the Federal Circuit determined that the Alset Agreement did not convey any rights to the '581 patent. *Intellectual Ventures I LLC*, 2017 WL 900018, at *1-*5. IV has maintained

that it was entitled to ownership rights arising from a series of assignments after the Alset Agreement. *See* Ex. 1017, 5–24. However, because the Federal Circuit has determined that the Alset Agreement did not convey any rights to the '581 patent to Alset, Inc., we are not persuaded that IV received any ownership rights to the '581 patent from subsequent assignments. *See* Paper 37, 4–5; *see also* 37 C.F.R. § 3.54 (“[w]hen necessary, the Office will determine what effect a document has, including whether a party has the authority to take an action in a matter pending before the Office.”).

Accordingly, for the purposes of this final written decision, we do not consider IV to be the Patent Owner of the '581 patent, and further do not consider the filings, arguments, and evidence submitted by IV in this record as the purported Patent Owner for this proceeding. Additionally, as discussed in greater detail in our Order, an agent for service of process for AllAdvantage.com was provided notice of this proceeding. Paper 37, 7–9. However, AllAdvantage.com has not made an appearance as Patent Owner in this proceeding, and has declined to participate in this *inter partes* review. *Id.*; *see* Ex. 3003. Therefore, we proceed to Final Written Decision without a substitute Patent Owner.

C. The '581 Patent

The '581 patent is directed to systems and methods for collecting information about a computer system or user. Ex. 1001, Abstract. Figure 1 of the '581 patent is reproduced below.

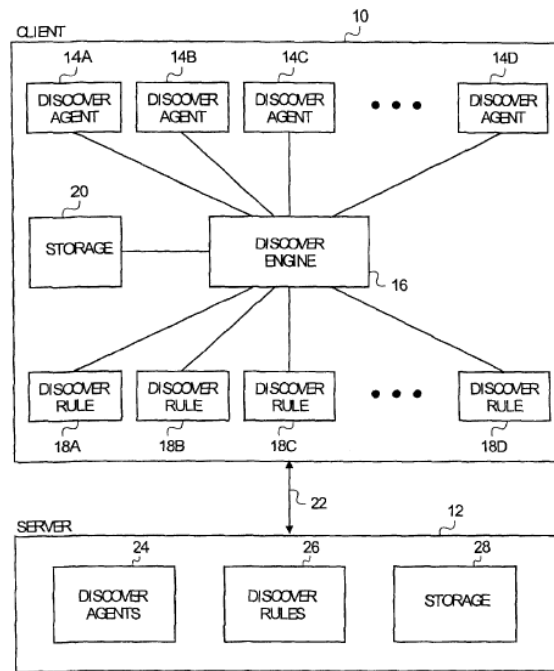


FIG. 1

Figure 1 shows client 10 coupled to server 12 via communication link 22 such as a local area network (LAN), a wide area network (WAN), or the Internet. Ex. 1001, 4:8–9, 5:19–25. As shown, client 10 may include one or more discovery agents 14a–d that are coupled to discovery engine 16. *Id.* at 4:10–14. Each of discovery agents 14a–d 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 receives information collected by one or more discovery agents 14a–d and uses the received data to execute one or more discovery rules 18a–d. *Id.* at 4:39–42. The discovery rules determine what, if any, action is to be taken based on the collected data. *Id.* at 3:17–18. Discovery rules may be a series of Boolean operations, mathematical equations, or other comparisons or evaluations of the collected data. *Id.* at 3:18–21. Discovery agents are separate programs from the discovery rules

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