

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,
Petitioners,

v.

INTELLECTUAL VENTURES I LLC,
Patent Owner.

IPR2016-00019
Patent 6,510,434 B1

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

McSHANE, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Old Republic General Insurance Group, Inc., Old Republic Insurance Company, Old Republic Title Insurance Group, Inc., and Old Republic National Title Insurance Company, (collectively, “Old Republic” or “Petitioners”) filed a Petition (“Pet.”) requesting *inter partes* review of claims 1–6 (“the challenged claims”) of U.S. Patent No. 6,510,434 B1 (Ex. 1001, “the ’434 patent”) pursuant to 35 U.S.C. §§ 311–319. Paper 1 (“Pet.”).

Pursuant to 35 U.S.C. § 314, we instituted an *inter partes* review as to claims 1–6 of the ’434 patent on April 18, 2016. Paper 8 (“Dec. on Inst.” or “Institution Decision”).

During the course of trial, Intellectual Ventures I (“IV”) filed a Patent Owner Response (Paper 12, “PO Resp.”), and Old Republic filed a Reply to the Patent Owner Response (Paper 16, “Pet. Reply”). IV filed a Motion to Exclude (Paper 20, “Mot. to Exclude”); with Old Republic filing an Opposition to the Motion to Exclude (Paper 21, “Opp. to Mot. to Exclude”); and IV filing a Reply to Old Republic’s Opposition to the Motion to Exclude (Paper 23, “Reply to Opp. to Mot. to Exclude”).

We held a consolidated oral hearing on January 10, 2017, in relation to this proceeding as well as Case IPR2016-00020, which is a proceeding also related to the ’434 patent. A transcript (Paper 26, “Tr.”) of the oral hearing has been entered into the record, as well as copies of the demonstratives the parties referred to at the oral hearing (Ex. 1037; Ex. 2004).

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision, issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73, addresses issues and arguments raised during trial.

For the reasons discussed below, we determine that Old Republic has shown by a preponderance of the evidence that claims 1–6 of the '434 patent are unpatentable under 35 U.S.C. § 103(a). We *dismiss* the Motion to Exclude Exhibits 1028 and 1029 as moot.

B. Related Proceedings

The parties indicate that the '434 patent was at issue in *Intellectual Ventures I LLC v. Erie Indemnity Co.*, Case No. 1:14-cv-000220, *Intellectual Ventures I LLC v. Old Republic Gen. Ins. Grp., Inc.*, Case No 2:14-cv-01130, and *Intellectual Ventures I LLC et al. v. Highmark, Inc.*, Case No. 2:14-cv-01131, all in the U.S. District Court for the Western District of Pennsylvania. Pet. 1; Paper 4, 2.

IV indicates that in September 2015, the District Court in the Western District of Pennsylvania found the asserted claims patent ineligible under 35 U.S.C. § 101. Paper 4, 2. IV appealed the dismissal to the Court of Appeals for the Federal Circuit, and the Federal Circuit affirmed that the asserted claims are patent ineligible under 35 U.S.C. § 101. *See* Paper 27; *Intellectual Ventures I LLC v. Erie Indemnity Co.*, No. 12-1128, 2017 WL 900018 (Fed. Cir. March 7, 2017).

Old Republic indicates that the '434 patent was the subject of an *inter partes* review petition filed by International Business Machines Corporation in June 2015 (IPR2015-01481) (“the IBM case”), and another *inter partes* review petition filed by Old Republic (IPR2016-00020). Pet. 2. The Board issued a final written decision in Case IPR2015-01481, finding that claims

1–3, 5, and 6 of the '434 patent are unpatentable. *Int'l Bus. Machines Corp., v. Intellectual Ventures I LLC*, Case IPR2015-01481 (PTAB Jan. 9, 2017) (Paper 40). We issue a final written decision in Case IPR2016-00020 at the same time as this decision, determining that claims 7, 8, 12, and 14 of the '434 patent are unpatentable.

C. The Instituted Grounds of Unpatentability

We instituted the instant *inter partes* review of claims 1–6 of the '434 patent on the following grounds of unpatentability (Dec. on Inst. 24):

Reference(s)	Basis	Claims
Okamoto ^{1,2}	§ 103(a)	1–3, 5, and 6
Okamoto and XML Specification ³	§ 103(a)	1–3, 5, and 6
Okamoto and Payne ⁴	§ 103(a)	4

D. 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. 1001, [22], [45], [54].

The '434 patent discloses a method of “[r]etrieving information from a database using XML (eXtensible Markup Language) tags and metafiles.” Ex. 1001, Abstract. Each record in the database contains an alpha

¹ U.S. Patent No. 6,377,946 B1 (issued April 23, 2002) (Ex. 1005).

² For clarity and ease of reference, we only list the first named inventor.

³ W3C XML Specification, Version 1 (allegedly published February 10, 1998, and allegedly captured by the Internet Wayback Machine on February 13, 1998) (Ex. 1006; Ex. 1015).

⁴ U.S. Patent No. 5,715,314 (issued February 3, 1998) (Ex. 1010).

component and an index component. *Id.* at 10:9–14. The alpha component contains identifying information for the record, and the index component contains XML domain tags and XML category tags. *Id.* Figure 4B of the '434 patent is reproduced below.

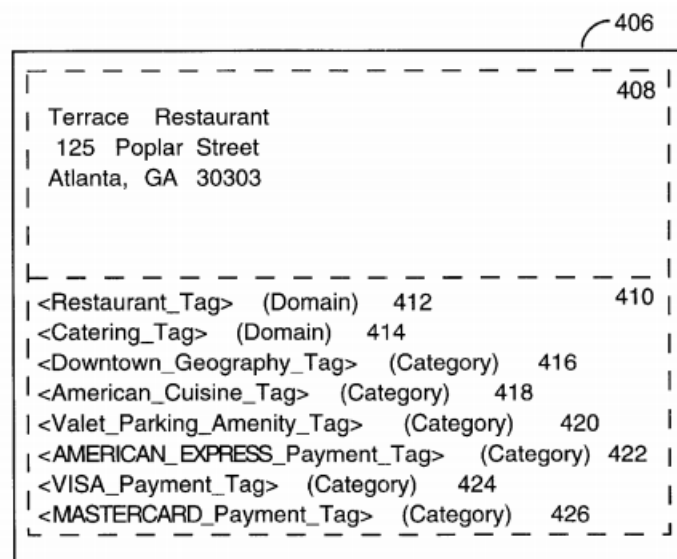


FIG. 4B

Figure 4B depicts an example of a database record. Ex. 1001, 10:9–16. In the example depicted in Figure 4B, alpha component 408 contains the name and address of the Terrace Restaurant and index component 410 includes, among others, Restaurant domain tag 412 and American Cuisine category tag 418. *Id.* at 10:16–51. Restaurant domain tag 412 identifies the Terrace Restaurant as a restaurant, and American Cuisine category tag 418 indicates that it serves American Cuisine. *Id.* at 10:36–42.

An index defines the tags and associates metafiles with many of the tags. *See* Ex. 1001, 4:11–40, 10:7, 10:18–22. The metafile provides additional information about the tag and includes related tags and the relationship between related tags. *Id.* at 9:18–58. Figure 3B of the '434 patent is reproduced below.

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