UNITED STATES PATENT AND TRADEMARK OFFICE

———————————

BEFORE THE PATENT TRIAL AND APPEAL BOARD

———————————

EVERNOTE CORPORATION,
Petitioner,

v.

TALSK RESEARCH, INC.,
Patent Owner.

———————————

Case IPR2017-01154
Patent 7,178,097 B1

———————————

Before SALLY C. MEDLEY, GARTH D. BAER, and
CHRISTOPHER L. OGDEN, *Administrative Patent Judges.*

OGDEN, *Administrative Patent Judge*.

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

Petitioner Evernote Corporation filed a Petition ("Pet.") to institute an *inter partes* review of claims 1–28 of U.S. Patent No. 7,178,097 (Ex. 1001, "the '097 patent") pursuant to 35 U.S.C. § 311 *et seq.* Patent Owner Talsk Research, Inc. filed a preliminary response ("Prelim. Resp.") to the Petition. We have authority under 35 U.S.C. § 314.

Institution of an *inter partes* review is authorized by statute when "the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a); *see also* 37 C.F.R. § 42.108.

Upon consideration of the Petition, we conclude that the information presented shows there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of claims 1–28 of the '097 patent.

I. BACKGROUND

A. THE '097 PATENT (EX. 1001)

The '097 patent issued on February 13, 2007, based on U.S. Patent Application No. 09/711,791, filed Nov. 13, 2000. *See* Ex. 1001, front page. The patent is directed to "a method and system for using a communications network such as the Internet to archive and retrieve bibliography information and reference material cited in a manuscript." *Id.* at 1:10–13.

The '097 patent states that "[a]uthors of manuscripts and documents such as books and research papers frequently cite material such as articles and other books in a bibliography section," *id.* at 1:17–19, and that "[a]uthors and researchers are now starting to cite information from websites in their manuscripts," *id.* at 1:48–49. However, according to the '097 patent,

"[t]he problem with citing a website is that the fluid, ever modifiable potential of the content of the website does not guarantee availability and true verification of the material actually used by the author." *Id.* at 2:16–19; *see also* Prelim. Resp. 3. Sources may, for example, be modified, moved, removed from the Internet, or made inaccessible, often without notice. *See* Ex. 1001, 1:58–63; *see also* Prelim Resp. 3.

The '097 patent states that "in light of the [e]ffect the cited web based material might have had on a given manuscript, it becomes important for referees, editors, other researchers, and the audience of the manuscript to ascertain the credibility of the cited information available on those Internet websites (sources)." *Id.* at 2:41–45. Therefore, the '097 patent describes a method and system to "protect the cited information from continuous modification and removal of the reference material by providing an avenue for the audience to gain access to an exact copy of the reference material cited by the author of the manuscript," and to "provide a means of verification of the reference material." *Id.* at 4:57–62. The system includes a database that acts as the bibliography of the manuscript, and that stores a verbatim copy of the website as it existed as of the date of access by the author. *See id.* at 5:46–56.

An embodiment is depicted in Figure 1 of the '097 patent, reproduced below:
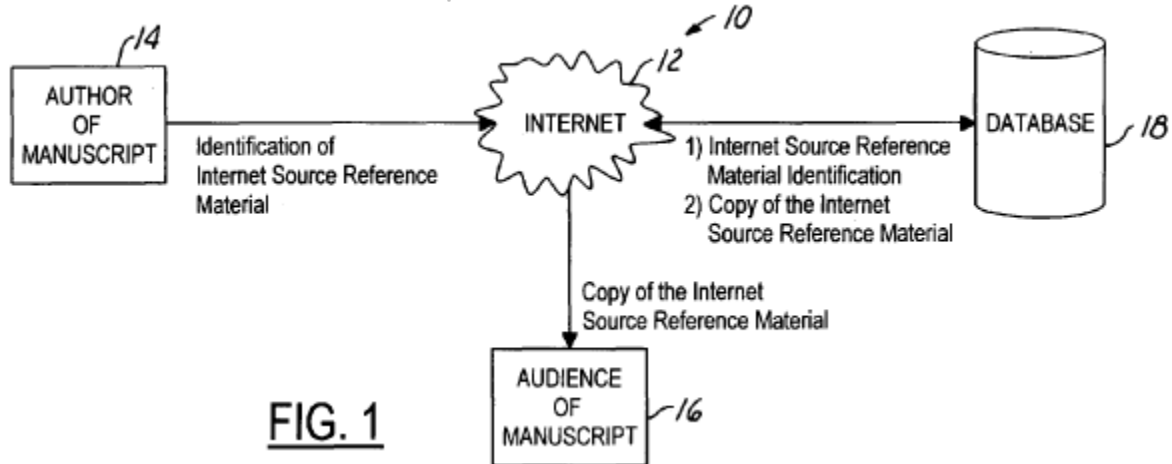
FIG. 1

Figure 1 is a block diagram depicting a system **10**, which includes a communications network such as Internet **12**, author **14** of a manuscript, audience **16** of the manuscript, and database **18**. *See id.* at 5:64–6:4. As the patent describes, author **14** cites reference material from a source on Internet **12** in a bibliography that contains an identification of the cited reference material, while audience **16** may use the identification to obtain, review, and verify a copy of the material from database **18**. *See id.* at 6:4–12. The system assigns a "distinctive key" to the website identification and to the copy of the website on database **18**. *See id.* at 6:34–50.

B.   EXEMPLARY CLAIMS

Claims 8 and 17 of the '097 patent illustrate the subject matter at issue in the Petition:

8. A method for archiving reference material cited in a bibliography of a manuscript by an author of the manuscript, the method comprising:

(a) an author of a manuscript using a web site on the Internet as a reference for the manuscript;

(b) the author transmitting the address of the webs site to a database connected to the Internet using a first communications device connected to the Internet;

(c) the database obtaining a copy of the web site from the Internet upon receiving the web site address from the author such that the copy of the web site obtained by the database is verbatim to the web site as on the Internet at the time the author transmitted the web site address to the database;

(d) associating a distinctive key to the copy of the web site;

(e) storing at the database the copy of the web site with the distinctive key;

(f) the author citing the web site as being a reference for the manuscript by listing identification of the web site along with the distinctive key in the bibliography of the manuscript;

(g) an audience of the manuscript obtaining the distinctive key from the bibliography of the manuscript;

(h) the audience transmitting the distinctive key to the database using a second communications device connected to the Internet in order to request the database for the copy of the web site; and

(i) the database transmitting a copy of the stored copy of the web site to the audience via the Internet and the second communications device in response to the database receiving the distinctive key from the audience such that the copy of the web site transmitted from the database to the audience is verbatim to the web site as on the Internet at the time the author transmitted the web site address to the database.

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.