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Paper 13
Entered: March 18, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

ALEX IS THE BEST, LLC,
Patent Owner.

Case IPR2017-02058
Patent 8,581,991 B1

Before DANIEL N. FISHMAN, MINN CHUNG, and JESSICA C. KAISER, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge.*

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Petitioner, Google LLC ("Petitioner"), filed a Request for Rehearing (Paper 11, "Request" or "Req. Reh'g") of the Decision (Paper 10, "Dec."), in which, based on the information presented in the Petition (Paper 2, "Pet."), we denied institution of an *inter partes* review of claims 1–3, 10–14, and 21 (the "challenged claims") of U.S. Patent No. 8,581,991 B1 (Ex. 1001, "the '991 patent"). In its Request, Petitioner contends that our Decision overlooked or misapprehended certain teachings of Inoue (Ex. 1005) and Kusaka (Ex. 1009) about a "website archive and review [center] (WSARC)" or an "account associated with an Internet direct device" recited in independent claims 1 and 13. *See* Req. Reh'g 3–4. The Request also asserts that the Decision overlooked certain "background" discussion by Petitioner's declarant, Dr. Madisetti. *Id.* at 2. For the reasons stated below, Petitioner's Request for Rehearing is *denied*.

II. STANDARD OF REVIEW

"The burden of showing a decision should be modified lies with the party challenging the decision," and the challenging party "must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed" in a paper of record. 37 C.F.R. § 42.71(d). Because Petitioner seeks rehearing of our Decision denying institution of trial based on the Petition, it must show an abuse of discretion. *See* 37 C.F.R. § 42.71(c) ("When rehearing a decision on petition, a panel will review the decision for an abuse of discretion."). An abuse of discretion occurs when a "decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a

clear error of judgment." *PPG Indus., Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988).

III. ANALYSIS

A. Arguments in the Request Regarding Inoue

We first address Petitioner's contention that our Decision overlooked certain teachings in Inoue about the claimed "WSARC." Req. Reh'g 3. In the Decision, we found that, although the Petition appears to map Inoue's file server to the claimed "WSARC" by mentioning "WSARC (Inoue's file server)" (Dec. 16–17 (citing Pet. 17)), aside from that single mention, the Petition does not discuss the term "WSARC" or "website archive and review center" in relation to Inoue, and does not explain adequately why Inoue's file server teaches or suggests the "WSARC" recited in the claims (*id.* at 17, 19 (citing Pet. 15–18)). Thus, based on the record presented, we determined that simply stating "a WSARC (Inoue's file server)" in the Petition without any elaboration does not satisfy Petitioner's burden required for institution of a review in this case (*id.* at 19–20 (citations omitted)).

In its Request, Petitioner does *not* argue that we misapprehended or overlooked Petitioner's arguments or explanations presented in the Petition. Nor does the Request assert that the Decision applied incorrect standards for Petitioner's burden required for institution of an *inter partes* review. Instead, the Request focuses on additional discussion of Inoue's disclosures. In the Request, Petitioner contends that the Decision overlooked "the broader context of Inoue's disclosure regarding the file server" (Req. Reh'g 6) and presents a lengthy discussion of Figures 3 and 13 of Inoue and their

associated description, arguing that Inoue's file server discloses the claimed "WSARC" (*id.* at 6–8).

Much of the Request's discussion of Inoue, however, appears to be new arguments that were not presented initially in the Petition. Although the Request cites pages 12–21 of the Petition generally, it does not specifically identify where the arguments in the Request were presented in the Petition. *See* Req. Reh'g 6–8. For example, the Request does not identify, nor do we discern, where in the Petition the following arguments were made: "Inoue's file server 100 performs all the functions of the WSARC recited in the challenged claims" (*id.* at 7); Inoue describes the "web-related function" performed by Inoue's file server (*id.* at 7–8); and Inoue teaches "[s]etting up file server 100's user interface as a website" because "Figure 13's user interface . . . depicts a web page" (*id.* at 8). Nor does the Request point to any testimony in the Declaration of Dr. Madisetti (Ex. 1010) on claims 1 and 13 that discusses these arguments. *See* Ex. 1010 ¶¶ 426–436, 443–446.

The Request also asserts that Figure 13 of Inoue shows a web page because "as Dr. Madisetti explained in the *background* for his opinions, a website is a common means of sharing images among a variety of devices connected to the Internet." Req. Reh'g 8 (emphasis added) (citing Ex. 1010 ¶¶ 67, 70, 72–73, 82). Again, Petitioner does not identify, nor do we discern, where in the Petition this argument was presented. Nor does Petitioner identify where in the Petition paragraphs 67, 70, 72–73, and 82 of Dr. Madisetti's Declaration were cited or discussed.

Plainly, we could not have misapprehended or overlooked arguments or evidence that were not presented or developed in the Petition.

To the extent Petitioner argues that we nonetheless should have credited Dr. Madisetti's testimony in the "background" paragraphs, we are not persuaded for the reasons explained in what follows. First, we note that these "background" paragraphs were *not* cited or discussed in the Petition or in Dr. Madisetti's testimony on claims 1 and 13 submitted in support of Petitioner's contention that Inoue teaches a "WSARC" recited in the claims. *See* Pet. 12–21, 24–26; Ex. 1010 ¶¶ 426–436, 443–446. Second, Dr. Madisetti's Declaration spans over 490 pages and includes over 900 paragraphs. The voluminous nature of the Madisetti Declaration appears to be largely due to Petitioner's decision to prepare and submit a single Declaration for *all eight petitions* Petitioner filed in Cases IPR2017-02052, IPR2017-02053, IPR2017-02054, IPR2017-02055, IPR2017-02056, IPR2017-02057, IPR2017-02058, and IPR2017-02059. *See* Ex. 1010 ¶¶ 2–11. Further, within the single Madisetti Declaration, there exists only one "background" section (*see id.* at 25 n.4), titled "OVERVIEW OF THE STATE OF THE ART RELEVANT TO THE PATENTS-AT-ISSUE," that discusses what was purportedly known to a person of ordinary skill in the art before the filing date of any of the patents at issue in these eight petitions. In the "background" paragraphs cited in the Request, Dr. Madisetti does not discuss any specific challenged claim of any specific patent at issue in these eight proceedings. *See* Ex. 1010 ¶¶ 67, 70, 72–73, 82. Dr. Madisetti's discussion of claim 1 of the '991 patent in relation to Inoue appears about 200 pages later, separated by over 300 paragraphs from the "background" discussion. *See* Ex. 1010 ¶ 426.

By asserting that our Decision overlooked Dr. Madisetti's "background" discussion (*see* Req. Reh'g 2, 8), Petitioner apparently argues

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