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Paper 20
Entered: August 2, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETSIRV and LOCAL MOTION MN,
Petitioner,

v.

BOXBEE, INC.,
Patent Owner.

PGR2015-00009
Patent 8,756,166 B2

Before WILLIAM V. SAINDON, JUSTIN T. ARBES, and CHRISTOPHER L. CRUMBLEY, *Administrative Patent Judges*.

SAINDON, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 328(a)

I. INTRODUCTION

We have jurisdiction under 35 U.S.C. § 6(b)(4). This Final Written Decision is entered pursuant to 35 U.S.C. § 328.

Netsirv and Local Motion MN ("Petitioner") filed a corrected Petition (Paper 6, "Pet.") requesting a post-grant review of all claims (1–21) of U.S. Patent No. 8,756,166 B2 (Ex. 1001, "the '166 patent") under 35 U.S.C. §§ 101, 102(a), and 103(a). Pet. 12–13. Boxbee, Inc. ("Patent Owner") waived its preliminary response. Paper 8. We instituted a post-grant review of the '166 patent on the § 101 ground only. Paper 10, 18 ("Dec. on Inst."). Patent Owner then filed its Response (Paper 17, "PO Resp.") to which Petitioner filed its Reply (Paper 18, "Pet. Reply"). No oral argument was held. Paper 19.

For the reasons discussed below, we determine that Petitioner has shown by a preponderance of the evidence that all claims of the '166 patent are unpatentable.

A. Related Matters

The parties assert that there are no related matters. Pet. 10; Paper 9.

B. The '166 Patent

The '166 patent, entitled "SYSTEM AND METHOD FOR STORAGE CONTAINER TRACKING AND DELIVERY," was filed on August 26, 2013 and issued on June 17, 2014. Ex. 1001, (54), (22), (45). The '166 patent characterizes itself as relating to "storage container tracking and delivery in the physical storage field." *Id.* at 1:6–9. In conventional storage systems, according to the '166 patent, a user rents a single large container (e.g., using the PODS® storage system) and stores various personal

property items therein. *Id.* at 1:13–33. The '166 patent explains that a single large container is inefficient in that a user may not always need that much storage space or a user may not remember all that was in that storage space, or because large storage containers require specialized equipment to move, such as lifts and trucks. *Id.* at 1:34–40. The '166 patent purportedly improves on conventional storage systems by allowing a user to identify individual items stored in one or more relatively small storage containers. *Id.* at 2:36–51.

The '166 patent also describes a computerized method of coordinating such a system. *See id.* at 3:11–13. A benefit to this system is that empty containers retrieved from a customer can be immediately put back to use and given to another customer. *See id.* at 2:57–3:3. The '166 patent characterizes this feature as "dynamic adjustment" or "dynamic disassociat[ion]." *See id.* at 2:64, 3:5.

C. Challenged Claims

Claim 1 is the sole independent claim and is reproduced below, with step identifiers (a)–(m) added for reference purposes.

> 1. A method for stored item distribution to a user, the user associated with a user identifier, the method comprising:
>
> by a computing system:
>
> (a) receiving a delivery request associated with the user identifier comprising a requested time, a requested location, and a requested number of containers;
>
> (b) facilitating delivery of a set of containers to the requested location at the requested time, the set of containers comprising at least the requested number of containers, each container of the set associated with a unique storage identifier;

(c) receiving a set of storage identifiers from a delivery device remote from the computing system, each storage identifier of the set of storage identifiers associated with one of the set of containers;
(d) associating the set of storage identifiers comprising a first storage identifier with the user identifier in response to receipt of the set of storage identifiers from the delivery device;
(e) receiving a media description in association with the first storage identifier from a user device associated with the user identifier, the user device remote from the computing system;
(f) storing the media description as a storage description for the first storage identifier;
(g) setting a fill status of the first storage identifier to packed;
(h) receiving a removal request comprising storage identifiers associated with empty fill statuses from a pickup device remote from the computing system;
(i) removing the storage identifiers having an empty fill status from the set of storage identifiers associated with the user identifier;
(j) receiving a summary request associated with the user identifier;
(k) in response to receipt of the summary request, sending the storage description of the first storage identifier;
(l) receiving a retrieval request associated with the user identifier comprising a selection associated with the storage description, a retrieval location, and a retrieval time; and
(m) facilitating delivery of a first container identified by the first storage identifier to the retrieval location at the retrieval time.

D. Instituted Ground

We instituted on the ground of whether claims 1–21 of the '166 patent are unpatentable as directed to patent-ineligible subject matter under 35

U.S.C. § 101. Dec. on Inst. 18; *see also id.* at 7–12 (setting forth our analysis of Petitioner's ground); Pet. 18–34 (setting forth Petitioner's § 101 ground).

II. ANALYSIS

A. Eligibility for Post-Grant Review

In our Institution Decision, we determined that the '166 patent was eligible for post-grant review because, *inter alia*, it has an effective filing date after March 16, 2013 and the Petition was filed within 9 months from the '166 patent's issuance. Dec. on Inst. 5–6. No arguments challenging the eligibility of the '166 patent for post-grant review have been raised by Patent Owner.

B. Claim Construction

We interpret the claims of an unexpired patent using the broadest reasonable interpretation in light of the specification of the patent. 37 C.F.R. § 42.200(b); *see also Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation standard in *inter partes* reviews). Under that standard, a claim term generally is given its ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Although our claim interpretation "'cannot be divorced from the specification,'" *see Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015) (citing *In re NTP, Inc.*, 654 F.3d 1279, 1288 (Fed. Cir. 2011)), we must be careful not to import limitations from the specification that are not part of the claim language, *see SuperGuide Corp. v. DirecTV*

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