

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SPOTIFY USA INC.,
Petitioner,

v.

S.I.SV.EL. SOCIETA ITALIANA PER LO SVILUPPO
DELL'ELETTRONICA, S.P.A.
Patent Owner.

Case IPR2019-00520
Patent 7,734,680 B1

Before TERRENCE W. MCMILLIN, AMANDA F. WIEKER, and
MONICA S. ULLAGADDI, *Administrative Patent Judges*.

MCMILLIN, *Administrative Patent Judge*.

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

I. INTRODUCTION

Spotify USA Inc. (“Petitioner”) filed a petition to institute an *inter partes* review of claims 11, 12, 16, and 17 of U.S. Patent No. 7,734,680 B1 (the “’680 patent”) pursuant to 35 U.S.C. § 311 *et seq.* Paper 2 (“Petition” or “Pet.”). S.I.SV.EL. Societa Italiana Per Lo Sviluppo Dell’elettronica S.p.A. (“Patent Owner”) filed a preliminary response to the Petition. Paper 8 (“Preliminary Response” or “Prelim. Resp.”).

We have authority under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the Petition and the Preliminary 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. § 42.4(a) (“The Board institutes the trial on behalf of the Director.”). For the reasons that follow, we do not institute an *inter partes* review of any of the claims in the ’680 patent.

A. Related Matters

The parties indicate that the ’680 patent has been asserted in three cases filed in the United States District Court for the District of Delaware, on January 8, 2018:

S.I.SV.EL. Societa Italiana Per Lo Sviluppo Dell’elettronica S.p.A. v. Rakuten Kobo Inc., No. 1: 18-cv-00068;

S.I.SV.EL. Societa Italiana Per Lo Sviluppo Dell’elettronica S.p.A. v. Rhapsody International Inc., No. 1: 18-cv-00069; and

S.I.SV.EL. Societa Italiana Per Lo Sviluppo Dell’elettronica S.p.A. v. Spotify USA Inc., No. 1: 18-cv-00070. Pet. 74–75; Paper 5, 2.

The ’680 patent is also the subject of IPR2019-00471.

B. The '680 Patent

The '680 patent is titled, "Method and Apparatus for Realizing Personalized Information from Multiple Information Sources." Ex. 1001, (54). "A meta-browser presents personalized collections of information from multiple sources of different media types in a single browser space." *Id.* at 2:37–39. Figure 4 of the '680 patent is reproduced below.

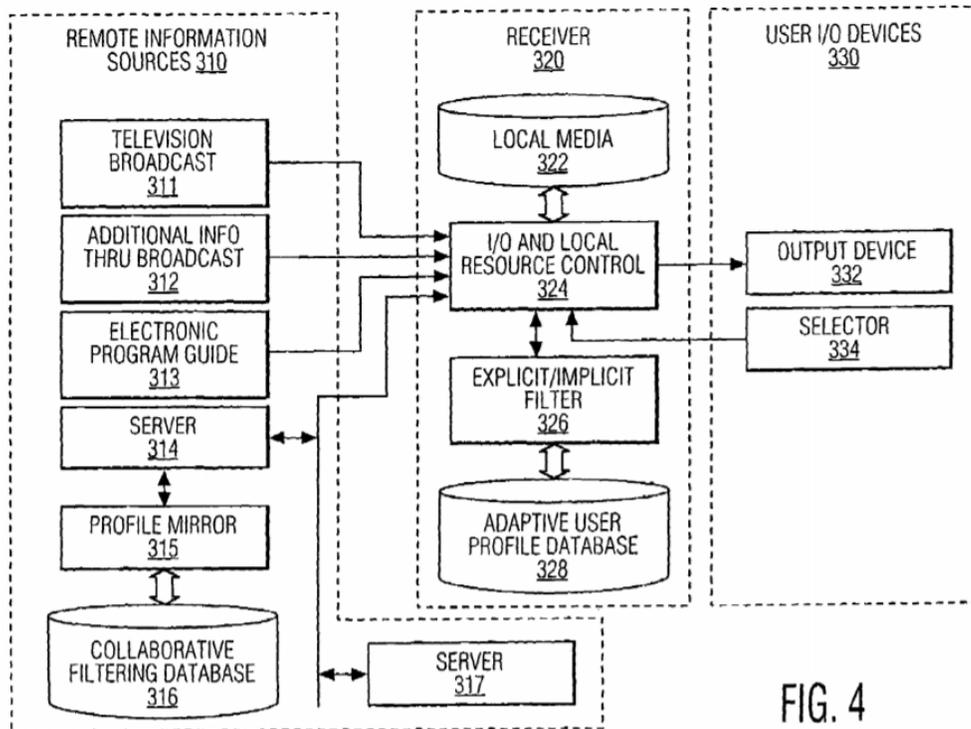


FIG. 4

Figure 4 depicts "a block schematic diagram of a meta-browser system." *Id.* at 2:28–29. The system shown in Figure 4 includes remote information sources 310 comprised of collaborative filtering database 316 and other sources of information. *Id.* at 7:24–27. Figure 4 also depicts receiver 320 with explicit/implicit filter 326 and adaptive user profile database 328. *Id.* at 5:41–6:17. Figure 4 further depicts user I/O devices 330 including output device 332 and selector 334. *Id.* at 5:16–40.

“The meta-browser presents personalized collections of information from multiple sources of different media types as different media collections in [a] unified browser space.” *Id.* at 57 (Abstract). “[P]ersonalized recommendations . . . are generated based on a profile of the user’s interests captures across multiple media sources.” *Id.* “Collaborative filtering, which uses multiple user profiles to compute co-relations between the user’s profile and others, is also used to make recommendations.” *Id.*

C. Challenged Claims

Petitioner challenges claims 11, 12, 16, and 17 of the ’680 patent. Pet. 2, 17. Of the challenged claims, claim 11 is an independent apparatus claim, and claim 16 is an independent computer program product claim. Ex. 1001, 11:32–12:61. Claim 11 recites:

11. A receiver apparatus for obtaining content from multiple information sources for viewing by a viewer, comprising:
 - an input/output (“I/O”) controller including an Internet connection input, a video output, and a selector input;
 - an adaptive user profile database;
 - a filter coupled to the adaptive user profile database, the filter being coupled to the I/O controller for filtering information from the Internet connection input in accordance with the adaptive user profile database, wherein said filtering comprises explicit and implicit filtering, wherein said explicit filtering provides filtering of information from said plurality of different media collections and said implicit filtering draws from collaborative data among said plurality of different media collections and similar user profiles,
 - an output display device configured to display a virtual unified space including a virtual library transmitted through the video output;
 - a populator that populates the virtual library with virtual multiple media collections using the filtered information from the filter;

- a browser that browses the virtual library by moving between multiple media collections in accordance with the selector input;
- and a recommender that recommends virtual media in the virtual multiple media collections in the virtual library to a user based on a user profile for the user, and
- an updater for updating the user profile based on at least one selection of the recommended virtual media, wherein said updating is reflected in a ratio in responding to said user's current programming choice or specific requests.

Id. at 11:32–65. Claim 16 recites:

16. A computer program product comprising a computer readable medium having program logic recorded thereon for enabling a computer-enabled apparatus to display personalized information for a user from multiple information sources, comprising:
 - a populator for populating a virtual library with a plurality of different virtual media collections in accordance with a user profile, wherein the virtual library is populated with different types of media obtained from different media sources; and
 - a browser for browsing the virtual library by moving between the plurality of different media collections under user control;
 - a search engine for searching the virtual library under user control; and
 - a filter for filtering the results of the searching step in accordance with the user profile and said browsing step, wherein said filtering comprises explicit and implicit filtering, wherein said explicit filtering provides filtering of information from said plurality of different media collections and said implicit filtering draws from collaborative data among said plurality of different media collections and similar user profiles;
 - a prioritizer for prioritizing results of the filtering step; and
 - an updater for updating the user profile in accordance with at least one selection of the results of the filtering step, wherein

said updating is reflected in a ratio in responding to said user's current programming choice or specific requests.

Id. at 12:25–53.

D. The Asserted Grounds

Petitioner challenges claims 11, 12, 16, and 17 of the '680 patent on the following grounds:

Claims 11 and 12 under 35 U.S.C. § 103(a) as unpatentable over Herz;¹ and

Claims 16 and 17 under 35 U.S.C. § 103(a) as unpatentable over Herz and Herz '796.² Pet. 17.

Petitioner relies on the Declaration of Dr. Benjamin Goldberg (Ex. 1003). Patent Owner relies on the Declaration of Dr. Michael J. Pazzani (Ex. 2001). At this stage of this proceeding, any genuine issue of material fact created by this testimonial evidence will be viewed in the light most favorable to the Petitioner. *See* 37 C.F.R. § 42.108(c) (“The Board’s decision will take into account a patent owner preliminary response where such a response is filed, including any testimonial evidence, but a genuine issue of material fact created by such testimonial evidence will be viewed in the light most favorable to the petitioner solely for purposes of deciding whether to institute an *inter partes* review.”)

¹ US 5,758,257 (Ex. 1004) issued May 26, 1998.

² WO 97/16796 (Ex. 1006) published May 9, 1997.

II. ANALYSIS

We analyze Petitioner’s asserted grounds of unpatentability and Patent Owner’s arguments in its preliminary response to determine whether Petitioner has met the threshold standard of 35 U.S.C. § 314(a).

A. Claim Construction

“[I]n an *inter partes* review proceeding, a claim of a patent . . . shall be construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b). In applying a district court-type claim construction, we are guided by the principle that the words of a claim “are generally given their ordinary and customary meaning,” as understood by a person of ordinary skill in the art at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc) (citation omitted). “In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17). There is a “heavy presumption,” however, that a claim term carries its ordinary and customary meaning. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002) (citation omitted).

We are also guided by the principle that we only construe claim terms if, and to the extent that, it is necessary for the purpose of the proceeding, here, to determine whether to institute an *inter partes* review. *See, e.g.*,

Wellman, Inc. v. Eastman Chem. Co., 642 F.3d 1355, 1361 (Fed. Cir. 2011) (“[C]laim terms need only be construed ‘to the extent necessary to resolve the controversy.’”) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)). On this record, we do not find it necessary to construe explicitly any of the claim terms in order to determine whether to institute *inter partes* review.³

B. Legal Standard

A patent claim is unpatentable as obvious if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness.⁴ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review

³ Neither party proposes that the term “selector input” needs to be construed explicitly (Pet. 9, Prelim. Resp. 21), but there is a dispute between the parties relating to whether Petitioner has shown this element is taught by the cited art. *See infra* Section II.D.2. We resolve this dispute using the plain and ordinary meaning of “selector input.” *See id.*

⁴ Neither party presents any objective evidence of nonobviousness or any related arguments for us to consider.

petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”). Petitioners cannot satisfy their burden of proving obviousness by employing “mere conclusory statements.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

C. Level of Skill in the Art

With regard to the level of ordinary skill in the art, Petitioner contends, “[a] person of ordinary skill in the art (“POSITA”) of the ’680 patent would hold a bachelor’s degree (or higher) in computer science, electrical engineering, computer engineering, or a related field and have either (1) two years of industry experience, or research, in software development or (2) the equivalent educational experience (e.g., a master’s degree or Ph.D. in computer science, electrical engineering, computer engineering, or a related field).” Pet. 8 (citing Ex. 1003 (Goldberg Decl.) ¶ 62). Patent Owner contends the applicable level of ordinary skill in the art is, “(i) a B.S. in Computer Science or a closely related field with three or more years of experience in either embedded systems or recommendation systems or (ii) at least an M.S. in Computer Science. Additional education or experience may serve as a substitute for these requirements.” Prelim. Resp. 20–21 (citing Ex. 2001 (Pazzani Decl.) ¶ 24). Although these contentions differ in the amount of experience, they are very similar. We do not find it necessary to resolve the differences between these contentions in order to determine whether to institute *inter partes* review. In other words, our conclusions herein would not differ under either party’s proposed assessment of the appropriate level of skill in the art.

D. Challenge Based on Herz

Petitioner contends that claims 11 and 12 would have been obvious in view of Herz. Pet. 17–53. We determine that Petitioner does not establish that Herz teaches or suggests all the limitations of independent claim 11, or would have rendered those limitations obvious, and, therefore, we do not institute *inter partes* review on this challenge.

1. Herz

Herz issued on May 26, 1998. Ex. 1004, [22]. The earliest priority date claimed for the '680 patent is based on its filing date of September 30, 1999. Ex. 1001, [22]. Therefore, Herz is prior art to the '680 patent under 35 U.S.C. §102(b). Patent Owner does not contest the prior art status of Herz. *See generally* Prelim. Resp.

Herz is titled “System and Method for Scheduling Broadcast of and Access to Video Programs and Other Data Using Customer Profiles.” Ex. 1004, [54]. Herz is directed to “[a] system and method for scheduling the receipt of desired movies and other forms of data from a network which simultaneously distributes many sources of data to many customers, as in a cable television system.” *Id.* at [57] (Abstract). Figure 1 of Herz is reproduced below.

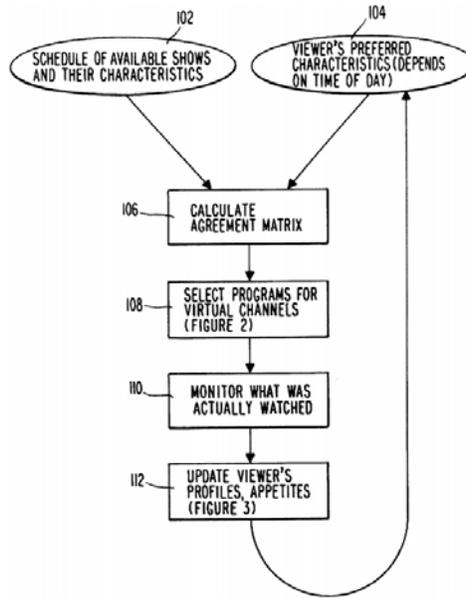


Fig. 1

Figure 1 depicts “the flow of processing of the customer and profile data.”

Id. at 8:32–33. Herz provides:

Customer profiles are developed for the recipient describing how important certain characteristics of the broadcast video program, movie or other data are to each customer. From these profiles, an “agreement matrix” is calculated by comparing the recipient's profiles to the actual profiles of the characteristics of the available video programs, movies, or other data. The agreement matrix thus characterizes the attractiveness of each video program, movie, or other data to each prospective customer. “Virtual” channels are generated from the agreement matrix to produce a series of video or data programming which will provide the greatest satisfaction to each customer. Feedback paths are also provided so that the customer's profiles and/or the profiles of the video programs or other data may be modified to reflect actual usage.

Id. at [57] (Abstract).

2. *Analysis of Unpatentability Showing*

Selector Input Limitation

Claim 11 of the '680 patent is directed to a receiver apparatus. Ex. 1001, 11:32–65. The first recited element is, “an input/output (‘I/O’) controller including an Internet connection input, a video output, and **a selector input.**” *Id.* (emphasis added). The sixth recited element is, “a browser that browses the virtual library by moving between multiple media collections in accordance with **the selector input.**” *Id.* (emphasis added). Thus, these two elements refer to the same element, i.e., “selector input.” However, Petitioner points to different teachings related to separate and distinct structures in Herz for the recited “selector input.”

With regard to the first recited element, Petitioner contends the “controller including . . . a **selector input**” is the cable television system controller 606 at the head end of the cable television shown in Figure 6. Pet. 25. The Petition states:

As in Figure 6, Herz is directed to “an actual cable television distribution system for a cable television implementation of the present invention” that receives a variety of inputs and that transmits outputs, so it is “an input/output (‘I/O’) controller” as required by claim [11a]. (*See* Ex. 1004 at 42:25-27, Fig. 6.)

The system includes “at the head end . . . a cable television (CATV) system controller 606 which designates which programs are to be delivered to each node.” (*Id.* at 42:30-32, Fig. 6; Goldberg Decl. at ¶ 90.) And “[t]he video signal . . . is . . . transmitted . . . to the customers’ homes.” (Ex. 1004 at 42:33-37.) Thus, there is a video output. (Goldberg Decl. at ¶ 90.)

Herz also includes a dynamic program matrix switch 604, and Herz explains that “[o]nce the ‘optimum’ desirable programming is determined, the CATV system controller (506, 606) selects, then ‘routes’, the appropriate source programs

through the Dynamic Program Matrix Switch 604” so there is a *selector input*. (See Ex. 1004 at 42:28-30, 43:20-24, Fig. 6; Goldberg Decl. at ¶ 91.)

Id. (emphasis added). Figure 6 of Herz is reproduced below.

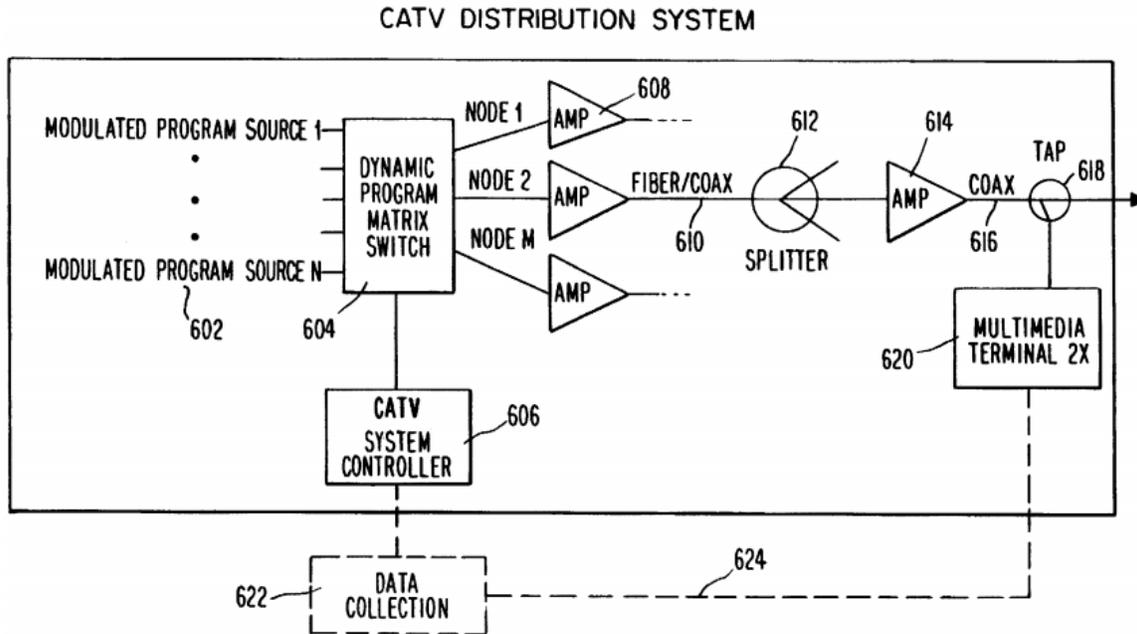


Fig. 6

Figure 6 depicts a cable television distribution system. Ex. 1004, 42:25–26.

The detailed description of Figure 6 states:

As illustrated, a variety of modulated program sources 602 are provided. The programs are selectively (and dynamically) provided to each node via a dynamic program matrix switch 604 at the cable head end. Also at the head end is a cable television (CATV) system controller 606 which designates which programs are to be delivered to each node.

Id. at 42:27–32.⁵ Thus, for the first element of claim 11, Petitioner relies on the output of the CATV system controller as teaching the “controller . . .

⁵ Figure 6 also depicts a “Multimedia Terminal 2X” 620 (far right) as a separate and distinct component of the system.

manner or reordered for the customer's perusal and selection of the desired programming. Once the customer has selected the desired virtual channel from a highlighted program guide or a listing of the programs available on the virtual channels using the customer's remote control unit, processor 906 then accordingly instructs channel selector 912 to tune the channels for the programming determined in accordance with the techniques of the invention to be most desirable to that customer.

Ex. 1004, 45:38–49.

Patent Owner argues:

The CATV system controller is not a “selector input” because it is located with the cable provider. ([Ex. 2001] at ¶ 70.) The CATV system controller is outside of the residence determining which channels a customer is permitted to receive. (*Id.* at ¶ 70.) It is not an input selector like a mouse or remote. (*Id.* at ¶ 70.)

As expressly taught within the '680 patent specification, examples of a “selector” include “a keyboard and mouse, a mouse style or joystick style handheld device (if the receiver 320 supports a mouse pointer), a remote control touchscreen, or function or select buttons on a remote control handheld unit.” (Ex. 1001 at 5:36–40.) Petitioner has not pointed to anything resembling an input selector. (Pazzani Decl. at ¶ 71.)

Prelim. Resp. 43. Thus, Patent Owner argues Petitioner has failed to establish that Herz teaches a “controller including . . . a *selector input*” as recited in the first element of claim 11.

We agree with Patent Owner that the plain and ordinary meaning of “selector input” in claim 11 in light of the Specification of the '680 patent renders Petitioner's contention that the CATV system controller 606 includes a selector input unreasonable, because it is located with the cable provider, away from the user. In addition, Petitioner's showing as to the “selector input” in claim 11 is inconsistent with this first contention, and its

related contentions are irreconcilable. For these reasons, we determine that Petitioner has failed to establish that Herz teaches or suggests a “selector input” as recited in independent claim 11 and dependent claim 12.

Internet Connection Input Limitation

Claim 11 twice recites an “Internet connection input.” Ex. 1001, 11:32–65. The first element of claim 11 recites, “an input/output (‘I/O’) controller including *an Internet connection input.*” *Id.* at 11:35–36 (emphasis added). With regard to this element, the Petitioner contends, “a POSITA would be motivated to combine Herz’s teachings to form the Internet connection input because Herz states that it can apply to ‘information which can be downloaded over networks such as the Internet.’” Pet. 25 (citing Ex. 1004, 50:66–1:7). The third limitation of claim 11 recites a “filter being coupled to the I/O controller for filtering information from *the Internet connection input.*” Ex. 1001, 11:40–41 (emphasis added). With regard to this element, Petitioner contends, “a POSITA would understand that Herz’s teachings apply to ‘information which can be downloaded over networks such as the Internet,’ so the filter is ‘coupled to the I/O controller for filtering information from the Internet connection input.’” Pet. 28 (citing Ex. 1004, 50:66–1:7). The passage from Herz that Petitioner cites in both instances states:

Those skilled in the art will appreciate that the method of generating agreement matrices for selecting preferred video programming as described herein may be generalized for use in other types of data retrieval systems besides video and music. For example, the techniques of the invention may be used for the optimum selection of any chunks of information such as stock market data, print information (e.g., for personalized newspapers), or multimedia information which can be

downloaded over networks such as the **Internet**.

Ex. 1004, 50:66–1:7 (emphasis added). This passage contains no teaching of either “an input/output (‘I/O’) controller including an *Internet connection input*” or a “filter being coupled to the I/O controller for filtering information from the *Internet connection input*” as recited in claim 11.

Petitioner provides no reasoning or explanation as to how this single reference to the Internet in Herz teaches or suggests the recited “controller” or “filter”—both of which are physical structures—of claim 11.

In addition, Petitioner fails to show that the later recited “populater,” “browser,” and “recommender” elements in claim 11, or the “identifier” limitation in claim 12, use the filtered information from an Internet connection input. The “populater” limitation recites, “a populater that populates the virtual library with virtual multiple media collections *using the filtered information from the filter.*” Ex. 1001, 11:52–54 (emphasis added). As shown above, the “filter” limitation recites “filtering information from the *Internet connection input.*” *Id.* at 11:40–41 (emphasis added). The “browser browses the virtual library,” the “recommender . . . recommends virtual media in the virtual multiple media collections in the virtual library,” and the “identifier . . . identifies a selection of one of the information items by the user from one of the media collections. *Id.* at 11:55–60, 12:4–6. Accordingly, the recited “populater,” “browser,” “recommender,” and “identifier” act on the filtered information from the Internet connection input. Petitioner fails to show that any of these elements do so.

For example, with regard to the “populater” element, Petitioner contends, “Herz populates virtual channels, that form the ’680 patent’s

virtual library, by ‘creat[ing] ‘virtual channels’ as a collection of the received programming data from one or more of the customized programming channels’ and by ‘composit[ing] several source materials or programs which may or may not change during respective time periods to reflect the programming most desirable to the customer during that time period.’” Pet. 36 (quoting Ex. 1004, 3:2–13). With regard to the “browser” element, Petitioner contends, “Herz teaches this limitation because Herz provides ‘[a]n electronic program or display guide 914 listing the available selections.’” *Id.* at 37 (quoting Ex. 1004, 45:36–38). With regard to the “recommender” limitation, Petitioner contends, “Herz’s system ‘create[s] “virtual channels” of recommended programming for each customer.’” *Id.* at 39 (quoting Ex. 1004, 4:11–14). With regard to the “identifier” limitation, Petitioner contends, “[a] user of Herz’s system has the ability to select an information item from one of the media collections, and Herz uses that selection to update customer profiles.” *Id.* at 49.

With regard to these elements, Petitioner makes no contention that there is any use of the filtered information from an Internet connection input. And, the passages in Herz that are relied upon as teaching these elements make no reference to the use of any filtered information from an Internet connection input.

3. *Summary*

We determine that Petitioner’s showing is inadequate to establish that Herz teaches or suggests all the limitations recited in independent claim 11 and dependent claim 12. We do not find Petitioner’s attempt to show claims 11 and 12 to be unpatentable as obvious to be well-supported or persuasive.

E. Challenge Based on Herz and Herz '796

Petitioner contends that claims 16 and 17 are unpatentable over Herz and Herz '796. Pet. 17, 53–74.

1. Herz '796

Herz '796 was published on May 9, 1997. Ex. 1005, (43). The earliest priority date claimed for the '680 patent is based on its filing date of September 30, 1999. Ex. 1001, (22). Therefore, Herz '796 is prior art to the '680 patent under 35 U.S.C. §102(b). Patent Owner does not contest the prior art status of Herz '796. *See generally* Prelim. Resp.

Herz '796 is titled, “System for Customized Electronic Identification of Desirable Objects.” Ex. 1005, (54). Herz '796 “relates to customized electronic identification of desirable objects, such as news articles, in an electronic media.” Ex. 1005, (57) (Abstract). The system automatically constructs a profile for each target object based “on the frequency with which each word appears in an article relative to its overall frequency of use in all articles.” *Id.* For each user, the system also constructs a “target profile interest summary [which] describes the user’s interest level in various types of target objects.” *Id.* “The system then evaluates the target profiles against the users’ target profile interest summaries to generate a user-customized rank ordered listing of target objects most likely to be of interest to each user.” *Id.*

2. Analysis of Unpatentability Showing

Populater Limitation

Claim 16 is directed to “[a] computer program product comprising a computer readable medium having program logic recorded thereon.” Ex. 1001, 12:25–26. The first element is “a populater for populating a

virtual library with a plurality of different virtual media collections in accordance with a user profile, wherein the virtual library is populated with different types of media obtained from different media sources.” *Id.* at 12:30–34. With regard to this element, Petitioner contends, “[t]his limitation is comparable” to the “populater” element in claim 11 and “[t]he differences are minor” so the “populater element” in claim 16 “is taught by Herz for all the same reasons” as the “populater” element in claim 11.⁶ Pet. 61.

However, we believe this contention is contradicted by the differences in the recitation of the “populater” elements in claims 11 and 16. The “populater” element in claim 11 is “a populater that populates the virtual library with virtual media collections using the filtered information from the filter.” *Id.* at 11:52–54. Thus, claim 16 recites, “populating . . . in accordance with a user profile,” whereas claim 11 recites “populating . . . using the filtered information from the filter.” And, as noted above, the “filter” in claim 11 is required to filter “information from the Internet connection input.” The Petition also states, “Herz ’796 teaches this limitation,” but fails to support this statement with any explanation or reasoning. Pet. 62.⁷ Petitioner cites Figure 5 of Herz ’796 which relates to generating document profiles (as opposed to user profiles) as shown at step 502 (“Calculate Document Profiles”). *See also* Ex. 1005, 10:29–30 (“Figure 5 illustrates . . . a method for automatically generating article profiles.”). And, Petitioner provides no showing that Herz ’796 teaches or suggests a “virtual library [that] is populated with different types of media obtained

⁶ As noted previously, we do not believe Petitioner has adequately shown that Herz teaches the “populater” element of claim 11.

⁷ Petitioner cites paragraph 203 of the Goldberg Declaration (Ex. 1003) but the cited testimony is conclusory as it is unsupported by evidence.

from different media sources” as recited in the “wherein” clause of claim 16. *See* Pet. 62. We do not find Petitioner’s showing with regard to the “populater” limitation of claim 16 to be persuasive.

Search Engine Limitation

Claim 16 recites, “a search engine for searching the virtual library under user control.” Ex. 1001, 12:38–39. Petitioner acknowledges that Herz does not teach or suggest this limitation⁸ and does not persuasively establish that Herz ’796 teaches or suggests this limitation. *See* Pet. 64–67.

With regard to Herz, the Petition states, “[a]lthough Herz does not provide much detail on how a user performs ‘perusal’ or ‘look up,’ Herz explains that search functionality was well-known in the art.” Pet. 64 (citing Ex. 1004, 1:23–40).⁹ The cited passage in Herz does not support this statement. *See* Ex. 1004, 1:23–40. There is no mention at all of search functionality (or “perusal” or “look up”) and nothing that could be reasonably interpreted as explaining that search functionality was well-known in the art. *Id.*

With regard to Herz ’796, the Petition states:

Herz ’796 . . . teaches the ability for users to “provide[] a query consisting of textual and/or other attributes, from which query the system constructs a profile” that is “similar to the search

⁸ Claim 11 does not have a limitation corresponding to the “search engine” limitation of claim 16.

⁹ Petitioner also cites to paragraph 211 of the Goldberg Declaration (Ex. 1003) in which additional passages (Ex. 1004, 2:6–12, 45:36–43, 49:64–50:3, 50:46–50) from Herz are cited in support of this statement. None of these additional passages from Herz, individually or collectively, could be interpreted as reasonably supporting the statement in the Petition regarding Herz, and Petitioner presents no persuasive reasoning.

profiles in a user's search profile set, except that their attributes are explicitly specified by a user." (*See* Ex. 1005 at 90:30-91:3; Goldberg Decl. at ¶ 211; *supra* V.B.2.) In other words, Herz '796 provides that a user may control a search, i.e., a query, of the materials presented to the user in a virtual library, as in Figure 16, which "illustrates in flow diagram form the use of the system for accessing information in response to a user query."

Pet. 64. The cited passage and Figure 16 do not support Petitioner's contention as they do not relate to "a search engine for searching the virtual library under user control." The cited passage (Ex. 1005, 90:30–91:3) relates to a query from which the system constructs a profile and not to "searching the virtual library under user control." In this passage, Herz '796 states, "the user optionally provides a query consisting of textual and/or other attributes, from which query the system constructs a profile." *Id.* at 90:30–31. Figure 16 of Herz '796 is reproduced below.

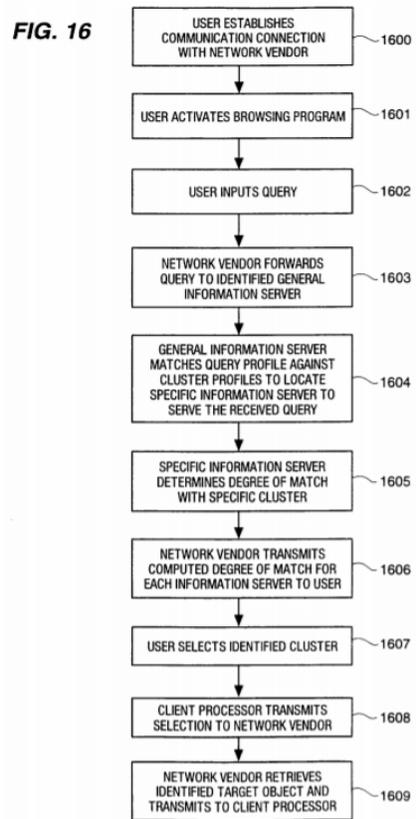


Figure 16 depicts a flow diagram in which the “User Inputs Query” at the third step 1602. This step is not preceded by any step that relates to populating or creation of a “virtual library” which would be available to be searched. The two preceding steps are “User Establishes Communication Connection with Network Vendor” at first step 1600 and “User Activates Browsing Program” at second step 1601. *See* Figure 16. Petitioner provides no reasoning or explanation as to how or why Figure 16 teaches or suggests “a search engine for searching the virtual library under user control” as recited in claim 16. With regard to how the query referenced in Figure 16 is used, the Petition states:

The query is processed in Herz '796 using the same “method of section ‘Searching for Target Objects’ . . . to automatically locate a small set of one or more clusters with profiles similar to the query profile.” (Ex. 1005 at 91:5-9;

Goldberg Decl. at ¶ 212.) Herz '796's system searches for target objects with target profiles similar to the search profile, or query profile. (See Ex. 1005 at 33:28-31, 33:27-35:1; Goldberg Decl. at ¶ 212.) Users view "menus on a computer screen or terminal screen and select[] from them with a keyboard or mouse." (Ex. 1005 at 87:22-24; Goldberg Decl. at ¶ 212.) These menus represent "[h]ierarchical trees allow[ing] rapid selection of one target object." (Ex. 1005 at 87:20-21; Goldberg Decl. at ¶ 212.)

Pet. 65–66. In this passage, Petitioner does not explain how or why Herz '796 teaches or suggests "a search engine for searching the virtual library under user control." As noted with regard to the "populater" limitation, the "virtual library" of claim 16 "is populated with different types of media obtained from different media sources." Petitioner has not pointed to any teaching or suggestion of searching such a "virtual library." And, after reviewing the material cited in support, we do not discern any such teaching or suggestion. We determine that Petitioner has not shown that it is reasonably likely to establish that the cited art teaches or suggests "a search engine for searching the virtual library under user control" as recited in claim 16.

Filter Element

With regard to the "filter" element of claim 16, Petitioner contends that "because this limitation is comparable" to the "filter" element of claim 11, the "filter" element of claim 16 "is taught by Herz for the same reasons."¹⁰ Pet. 67. Petitioner argues the differences between the "filter"

¹⁰ As noted previously, we do not believe that Petitioner has shown that Herz teaches "filtering information from the Internet connection input" as recited in claim 11.

elements of claims 11 and 16 are minor. *Id.* at 68. We do not believe Petitioner’s contentions regarding the similarity between “filter” elements of claims 11 and 16 are persuasive. Claim 11 recites, “filtering information from the Internet connection input” and claim 16 recites, “filtering the results of the searching step.” Ex. 1001, 11:40–41, 12:40. There is no searching step in claim 11.¹¹ *Id.* at 11:32–65. And, in discussing the “filter” elements in its presentations relating to claims 11 and 16, Petitioner provides no explanation or reasoning as to how Herz teaches or suggests “filtering the results of the searching step” as recited in claim 16. *See* Pet. 26–33, 67–69. Petitioner has not shown it is likely to establish Herz teaches or suggests the “filter” element of claim 16.

Petitioner also contends that Herz ’796 teaches the “filter” element. Pet. 67. However, Petitioner fails to persuasively show Herz ’796 teaches or suggests “filtering the results of the searching step.” *See id.* at 67–69. As noted above, we do not believe that Petitioner has persuasively established that the cited art teaches or suggests the “searching step” of claim 16 such that the results are available to be filtered as recited in claim 16.

3. Summary

We determine that Petitioner has not established a reasonable likelihood of showing claims 16 and 17 are unpatentable over Herz and Herz ’796.

F. Conclusion

For the foregoing reasons, we conclude that Petitioner has not

¹¹ Claim 11 is an apparatus claim and thus is not comprised of steps. And, while some of the elements in claim 11 are recited using functional language, there is no element that corresponds to the “searching step” of claim 16. Claim 11 does not contain the words “search” or “searching.”

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demonstrated a reasonable likelihood of prevailing on the grounds of unpatentability asserted in the Petition. *See* Pet. 17.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), no *inter partes* review as to any claim of U.S. Patent No. 7,734,680 B1 is instituted.

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