IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Cheng et al. Case: IPR2013-00034
U.S. Patent No.: 7,970,674 Attorney Docket No.: 30693-0090IP1
Issue Date: June 28, 2011
Appl. Serial No.: 11/347,024
Title: AUTOMATICALLY DETERMINING A CURRENT VALUE FOR A REAL ESTATE PROPERTY, SUCH AS A HOME, THAT IS TAILORED TO INPUT FROM A HUMAN USER, SUCH AS ITS OWNER

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REQUEST FOR REHEARING PURSUANT TO 37 C.F.R. § 42.71

Pursuant to 37 C.F.R. § 42.71, MicroStrategy Incorporated ("Petitioner" or "MicroStrategy") requests rehearing on the decision by the Board to deny institution of *inter partes* review of claims 18-25 of the '674 patent. Petitioner respectfully submits that, when taken as a whole, the revised petition of November 13, 2012 ("the Petition") addresses how Dugan and Kim disclose all of the limitations of claim 18. Claims 19-25 depend from claim 18. Since the Board did not address claims 19-25 separately from claim 18, Petitioner respectfully requests that the Board also reconsider instituting *inter partes* review of claims 19-25 in connection with the Board's reconsideration of instituting *inter partes* review of claim 18.

In the Decision to Institute *Inter Partes* Review of April 2, 2013 ("the Decision"), the Board found that the Petition failed to address how Dugan and Kim disclose or suggest the following two limitations of claim 18:

> wherein the adjustment of the obtained user input includes altering the home attributes indicated by an external data source to be possessed by the distinguished home, and
>
> wherein the determined refined valuation is based at least in part on applying the geographically-specific home valuation model to the altered attributes

Decision, p. 20. For this reason, the Board concluded that "MicroStrategy has not demonstrated a reasonable likelihood that it would prevail on the alleged ground that claim[] 18 . . . of the '674 patent [is] unpatentable for obviousness over Dugan and Kim." *Id.*

A petition for *inter partes* review must "[p]rovide a statement of the precise relief re-

quested for each claim challenged." 37 C.F.R. § 42.104(b). The statement must identify the specific statutory grounds on which the challenge is based and how the claim is unpatentable under the statutory grounds. *Id.* 37 C.F.R. § 42.104(b)(4) requires that "[t]he petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon."

However, and notably, Part 42 of Title 37, Code of Federal Regulations, which governs proceedings before the Board, does not require that the petition conform to a specific manner or order in demonstrating that each element of a challenged claim is found in the relied upon prior art. Part 42 also does not require that the petition redundantly identify relevant teachings from the relied upon prior art in demonstrating how the relied upon prior art satisfies redundant claim features. As such, when the same or similar feature is recited in multiple claims, it is not improper for a petition to establish where the feature is found in the relied upon prior art only a single time instead of redundantly addressing the feature in connection with each claim within which it is recited.

In accordance with the Part 42, the Petition established that claim 18 was challenged as being "[o]bvious under § 103(a) by Dugan in view of Kim." Petition, p. 3. Moreover, the Petition included claim charts specifying where all of the elements of claim 18, including the aforementioned "wherein" clauses, are found in the combination of Dugan and Kim. *See* Petition, pp. 29-30, 33.

Specifically, although the subsection of the Petition's claim charts featuring aspects

of claim 18 did not explicitly list the final two "wherein" clauses of claim 18, the claim charts nevertheless addressed these "wherein" clauses in their treatment of claims 30 and 32, which recite two "wherein" clauses that are nearly identical to those recited by claim 18. *See id.* As such, Petitioner respectfully submits that the Petition, taken as a whole, addressed how Dugan and Kim meet all of the elements of claim 18, including its final two "wherein" clauses.

To make this clearer, the following table is provided to facilitate a comparison of the relevant "wherein" clauses found in claims 18 and 32:

Claim 18 (Dependent on claim 15)	Claim 32 (Dependent on claims 15 and 30)
wherein the adjustment of the obtained user input includes altering the home attributes indicated by an external data source to be possessed by the distinguished home	wherein the adjustment of the obtained user input further includes altering the home attributes indicated by the external data source to be possessed by the distinguished home
wherein the determined refined valuation is based at least in part on applying the geographically-specific home valuation model to the altered attributes.	wherein the constructed new geographically-specific home valuation model is applied to altered attributes.

From this table, it is evident that the first "wherein" clause of claim 32 is a perfect match of the first "wherein" clause of claim 18, as the exact same words appear in each. Similarly, the second "wherein" clause of claim 32, while using slightly divergent terminology, also is substantively consistent in scope with the second "wherein" clause of claim 18. Indeed, at their core, these two "wherein" clauses both require the application of a geo-

graphically-specific home valuation model to altered attributes.

In fact, the only distinction between these two "wherein" clauses is the suggestion by claim 18 that a valuation is based on application of a geographically-specific home valuation model to the altered attributes. However, this feature is also embodied in claim 32 by virtue of its dependency on claim 30, which recites "wherein the determined refined valuation is based at least in part on the obtained result [from applying the constructed new geographically-specific home valuation model to altered attributes]." At pages 32-33, the Petition demonstrated that this feature is found in the combination of Dugan and Kim. As such, the claim charts clearly demonstrated that both of the final two "wherein" clauses of claim 18 are present in the relied upon prior art.

In greater detail, the Petition set forth grounds explaining why these two "wherein" clauses are rendered obviousness by the combination of Dugan and Kim when addressing claims 30 and 32. *See* Petition, pp. 31-33. In view of this, the Board found that the Petition demonstrated a reasonable likelihood that Petitioner would prevail on the alleged grounds that claims 30 and 32 of the '674 patent are obvious over the combination of Dugan and Kim. Decision, pp. 13, 20-21. Because the final two "wherein" clauses of claim 18 are found in claims 30 and 32, the grounds of obviousness for claims 30 and 32 set forth in the Petition and endorsed by the Board are equally applicable to the final two "wherein" clauses of claim 18. Thus, the sections of the claim charts devoted to claims 18, 30, and 32 collectively demonstrated "[h]ow the [final two 'wherein' clauses of] claim [18 are] unpatentable

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