

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ORACLE CORPORATION
Petitioner

v.

Patent of CLOUDING IP, LLC
Patent Owner

Case IPR2013-00073 (JL)
Patent 6,738,799

Before JAMESON LEE, MICHAEL W. KIM, and RAMA G. ELLURU,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

**ORDER
DENYING CERTAIN GROUNDS**

Petitioner indicates in the petition that the alleged grounds of unpatentability extend beyond those specifically identified and particularly discussed in the petition and includes unspecified combinations of prior art. According to the Petitioner, the specifically identified grounds are just representative and not exhaustive. The first paragraph of Section VII of the petition states:

VII. REPRESENTATIVE PROPOSED REJECTIONS SHOWING THAT PETITIONER HAS A REASONABLE LIKELIHOOD OF PREVAILING

The references addressed below each provide the teaching believed by the Examiner to be missing from the prior art and variously anticipate or render obvious the claimed subject matter. It should be understood that rejections may be premised on alternative combinations of these same references.

At the outset, we note that it is the Petitioner in an inter partes review who challenges or seeks to cancel claims of the involved patent. 35 U.S.C. § 311(b). Inter partes review is a trial under the procedures of 37 C.F.R. § 42.100, *et. seq.*, and is not itself a reexamination proceeding or a continued prosecution of the involved patent by the USPTO. The Petitioner bears the burden of proof. 37 C.F.R. § 42.20. It is incorrect to refer to Petitioner's alleged grounds of unpatentability as a proposed rejection to be made by the Board.

The petition must identify with particularity each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that support the grounds for the challenge to each claim. 35 U.S.C. § 312(a)(3). Per 37 C.F.R. § 42.22(a), each petition must include a statement of the precise relief requested and a full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence including material facts, the governing law, rules, and precedent. Under 37 C.F.R. § 42.104(b)(4), the petition must specify where each element of a challenged claim is found in the prior art patents or printed publications. In accordance with 37 C.F.R. § 104(b)(5), the relevance of the evidence supporting the challenge must be provided including identification of specific portions of the evidence that support the challenge.

Petitioner's suggestion that certain additional unspecified grounds may be premised on alternative combinations of the prior art fails to satisfy any of the above-noted requirements. Such vagueness and generality do not support any specific ground of unpatentability against any claim. Petitioner has failed to demonstrate a reasonable likelihood that it would prevail on any such non-specifically identified ground of unpatentability.

Accordingly, it is

ORDERED that all non-specifically identified grounds of unpatentability are herein *denied*;

FURTHER ORDERED that the Patent Owner need not speculate, address, or otherwise respond to alleged grounds which have already been denied; and

FURTHER ORDERED that the only surviving grounds now still remaining in the petition for consideration are the Group 1 to Group 4 grounds specifically identified in the petition:

Group 1

Claim 37 as anticipated by Balcha under 35 U.S.C. § 102(e)

Claims 1, 5, 9, 10, 23, and 24 as obvious over Balcha and Miller under 35 U.S.C. § 103

Claims 6-8 as obvious over Balcha, Miller, and Freivald under 35 U.S.C. § 103

Group 2

Claims 1, 5-10, 23, 24, and 37 as obvious over Miller and Freivald under 35 U.S.C. § 103

Group 3

Claim 37 as anticipated by Freivald under 35 U.S.C. § 102(e)

Group 4

Claims 1, 23, 24, and 37 as anticipated by William under
35 U.S.C. § 102(e)

Claims 5-10 as obvious over William and Miller under
35 U.S.C. § 103

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