

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.
Petitioner

v.

B.E. TECHNOLOGY, LLC
Patent Owner

Case IPR2014-00031
Patent 6,771,290 B1

**PETITIONER GOOGLE INC.'S REPLY TO PATENT OWNER'S
RESPONSE TO PETITION
(*INTER PARTES* REVIEW OF U.S. PATENT NO. 6,771,290 B1)**

Before SALLY C. MEDLEY, KALYAN K. DESHPANDE, and LYNNE E.
PETTIGREW, Administrative Patent Judges.

Mail Stop **Patent Board**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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I. Introduction

In its Institution Decision of April 9, 2014, the Board determined that there is a reasonable likelihood that claims 2 and 3 of the '290 Patent are anticipated under 35 U.S.C. § 102 over *Kikinis*. Paper 9 ("Institution Decision") at 16. In response, Patent Owner BE Tech alleges that *Kikinis* does not disclose (1) "a program stored on said non-volatile data storage device" that performs the functions of claim 2; (2) "[a] file associated with [a] selected user link;" and (3) a "user profile." Paper 23 ("Response") at pp. 1-3. BE Tech misinterprets Google and the Board's positions, misreads *Kikinis*, and misstates the scope of the claims of the '290 Patent. Accordingly, the Board should cancel claims 2 and 3 of the '290 Patent.

II. Kikinis Discloses a "Program Stored on Said Non-Volatile Data Storage Device"

BE Tech argues that *Kikinis* does not disclose a "'program stored on [a] non-volatile data storage device' capable of ... accessing a file in responses to selection of a user-selectable item that is associated with the file" because "Kikinis utilizes programs stored on servers to perform these functions." Response at p. 2. BE Tech's arguments fail for at least the following reasons.

A. *Kikinis*' Browser Accesses Remotely Stored Files

While BE Tech concedes that the web browser of *Kikinis* provides access to the user's home page, it argues that "[t]he browser does not access the electronic

document data base without additional software programs stored on remote servers.” Response at 15. BE Tech’s rationale is that the browser “cannot access data sets or files in responses to the selection of associated user-selectable items without initiating additional server-based programs[.]” *Id.* at 2.

By making this argument, BE Tech appears to be improperly importing additional features into the claim. *See, e.g.,* MPEP 2111.01(II); *Ir re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989). For example, BE Tech appears to be incorporating “directly access” or “accessing without any intermediate steps whatsoever” into the feature of “program further being operable ... to access[.]”¹ In fact, BE Tech’s expert, Dr. Cory Plock, admitted that his opinion that *Kikinis’* browser cannot correspond to the claimed “program” is because *Kikinis’* browser does not “*directly access*” the data bases. Ex. 1015 (“Cross-Examination of Plock”) at 24:3-

¹ Because BE Tech did not file a preliminary response nor set forth any alternative construction of the claimed features in its response, it cannot later argue or advance alternative constructions. *See, e.g.,* 35 U.S.C. §§ 313, 316(a)(8); 77 Fed. Reg. 157 (August 14, 2012) at 48766 (“The [patent owner] response should identify all the involved claims that are believed to be patentable and state the basis for that belief.”)

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