

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLKSWAGEN GROUP OF AMERICA, INC.
Petitioner,

v.

WEST VIEW RESEARCH, LLC,
Patent Owner.

Case IPR2016-00156
Patent 8,296,146

**PATENT OWNER'S REPLY TO PETITIONER'S RESPONSE TO
MOTION TO AMEND**

Mail Stop Patent Board

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

TABLE OF CONTENTS

I. Introduction	1
II. The Proposed Claims are Directed to Patentable Subject Matter	1
III. The Proposed Claims do not Enlarge the Scope of the '146 Patent	5
IV. The Proposed Claims are not Indefinite.....	6
V. The Proposed Claims are Reasonable	7
VI. The Proposed Claims are Fully Supported by the Original Disclosure.....	9
VII. The Proposed Claims are Patentable over the Prior Art	9

CASES

Alice Corp. Pty. v. CLS Bank Int'l,
134 S. Ct. 2347 (2014)..... 1,2,3
Amdocs (Israel) Ltd. v. Openet Telecom, Inc.,
2015-1180, slip op. (Fed. Cir. 2016) 1,2,3,4
Bascom Global Internet v. AT&T Mobility LLC,
827 F.3d 1341 (Fed. Cir. 2016) 1,2,4
Enfish LLC v. Microsoft Corp.,
822 F.3d 1327 (Fed Cir. 2016) 1,2,3
McRO, Inc. v. Bandai Namco Games Amer., Inc., et al.,
837 F.3d 1299 (Fed. Cir. 2016) 1,2,3
Sonix Tech. Co. v. Publications Int'l, LTD et al.,
2016-1449, slip op. (Fed. Cir. Jan. 5, 2017).....6

STATUTES

35 U.S.C. § 1011, 3
35 U.S.C. § 112.....2,6

I. Introduction

In *Volkswagen Group of America, Inc. v. West View Research, LLC*, IPR 2016-00156, Petitioner’s Response to Patent Owner’s Motion to Amend (“Response”), Paper 15, November 14, 2016, Petitioner fails to refute (i) the eligibility of the proposed substitute and new claims (“substitute claims”) under §101; (ii) the patentability of the substitute claims over the art; (iii) that the amendments of the substitute claims are fully supported; (iv) that the amendments are responsive to a basis for patentability; and (v) that the substitute claims do not enlarge claim scope.

II. The Proposed Claims are Directed to Patentable Subject Matter

Petitioner completely ignores the most recent and relevant precedent (i.e., the *Amdocs*, *Enfish*, *Bascom*, or *McRO* opinions from the CAFC¹) in its Section 101 analysis of its Response. All such precedent clearly cuts against both of Petitioner’s positions that 1) the claimed subject matter is abstract under *Alice* Step One, and 2) there is no “inventive concept” under *Alice* Step Two.

¹ *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 2015-1180, slip op. (Fed. Cir. 2016); *Enfish LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed Cir. 2016); *Bascom Global Internet v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed Cir. 2016); *McRo, Inc. v. Bandai Namco Games Amer., Inc., et al.*, 837 F.3d 1299 (Fed. Cir. 2016).

Moreover, the District Court’s analyses of the challenged ‘146 claims upon which Petitioner heavily relies had none of the benefit of any of the *later* guidance of *Amdocs*, *Enfish*, *Bascom*, or *McRo*, and was flawed in numerous ways, by: (i) adopting the position that any computer that provides information to a user is abstract under *Alice* Step 1, **a clear error under the later guidance of the CAFC**; (ii) failing to even *consider* that combinations of allegedly generic components may represent novel/non-obvious subject matter (in contravention of *Amdocs*, *Bascom* and *Enfish*); and (iii) failing to properly construe Patent Owner’s claims in light of the disclosed data structures, hardware, and algorithmic flowcharts – **explicitly dismissing the latter as having no probative value.**

Moreover, no 112(6) inquiry was performed for ‘146 claim 18, **in direct contravention of *Amdocs***. (see *Amdocs* slip op. at 8, n.3), nor was the requisite “pre-emption” analysis under Step 1 or Step 2. Patent Owner’s substitute claims are narrowly drawn and pre-empt only specific configurations.

To summarize the CAFC holdings supporting patentability of the claims:

1) Per *Enfish*, computer technology is not inherently abstract. *Enfish*, 822 F.3d at 1335. Nor is software, including associated logical structures and processes. *Id.* Petitioner cannot reconcile these holdings with the District Court’s position that any computer that provides information is abstract under *Alice* Step 1. Petitioner’s characterizing all the substitute claims as “collecting information,

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.