UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EVERNOTE CORPORATION,

Petitioner

v.

TALSK RESEARCH, INC.,

Patent Owner

Case IPR2017-01154

U.S. Patent No. 7,178,097

PATENT OWNER PRELIMINARY RESPONSE

PURSUANT TO 37 C.F.R. § 42.107(a)

Patent Owner, TALSK RESEARCH, INC. ("Talsk"), respectfully submits this Preliminary Response to Petitioner's petition seeking *inter partes* review of claims 1-24 of U.S. Patent No. 7,178,097 ("the '097 patent"). This filing is timely under 35 U.S.C. § 313 and 37 C.F.R. § 42.107 because it is within three months of the April 6, 2017 date of the Notice granting the Petition a filing date. (Paper No. 3.)

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LIST OF EXHIBITS

2001 Declaration of Jon Scarbrough

I. INTRODUCTION

Petitioner's proposed obviousness grounds are incomprehensible. Not only are the proposed grounds internally conflicting as to which of the primary or secondary reference is being modified, but no articulable rationale is provided anywhere as to how or *why* one reference would be modified in view of another. Rather than addressing the *Graham Factors*, as is its burden, petitioner shrugs off its obligation in the form of a "feature list" concluding that any combination of such features is obvious. (*Graham v. John Deere Co.*, 383 U.S. 1, 17 (U.S. Feb. 21, 1966).)

Stated simply, Petitioner hopes to convince the Board that if individual patent claim elements can be demonstrated as old, any claimed *combinations* of those elements must be considered obvious. But, a proper obviousness showing requires far more than the litigation inspired short-cuts that comprise the petition. The Federal Circuit has famously denounced such piecemeal obviousness analyses since its inception:

> That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art.

Environmental Designs, Ltd. V. Union Oil Co., 713 F.2d 693, 698 (Fed. Cir. 1983).

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