

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.)

TABLE OF CONTENTS

LIST OF EXHIBITS.....	iii
I. INTRODUCTION.....	1
II. THE ‘097 PATENT.....	3
III. CLAIM CONSTRUCTION.....	6
IV. THE PETITION FAILS TO ADEQUATELY ARTICULATE THE ASSERTED GROUNDS OF REJECTION.....	7
A. THE PETITION FAILS TO PRESENT COHERENT OBVIOUSNESS GROUNDS, LEAVING IT TO THE PATENT OWNER TO GUESS AS TO THE INTENDED COMBINATION AND/OR RATIONALES.....	7
V. PETITIONER’S MOTIVATIONS TO COMBINE ARE INCORRECT OR INAPPLICABLE TO THE ASSERTED COMBINATIONS OF ART.....	12
A. “SIMILAR FUNCTIONALITY” IS NOT A PROPER MOTIVATION TO COMBINE CAPLAN AND KAHN (GROUND 1).....	12
B. “ANALOGOUS-ART” IS NOT A PROPER MOTIVATION TO COMBINE CAPLAN AND KAHN (GROUND 1).....	13
C. “SAME FIELD OF ENDEAVOR” IS NOT A PROPER MOTIVATION TO COMBINE CAPLAN AND KAHN (GROUND 1).....	15
D. “REASONABLE EXPECTATION OF SUCCESS” IS NOT A PROPER MOTIVATION TO COMBINE CAPLAN AND KAHN (GROUND 1).....	15
E. “SAME FIELD OF ENDEAVOR” IS NOT A PROPER MOTIVATION TO COMBINE THE APA, GEMTEQ, AND KAHN (GROUND 2).....	16

Case IPR2017-01154
Patent Owner Preliminary Response

F.	PETITIONER TAKES MOTIVATION FROM THE ‘097 PATENT USING IMPERMISSIBLE HINDSIGHT (GROUND 2).....	18
G.	THERE IS NO MOTIVATION TO COMBINE KAHN WITH THE APA AND GEMTEQ (GROUND 2).....	19
VI.	PETITIONER HAS FAILED TO SHOW A REASONABLE LIKELIHOOD OF SUCCESS FOR ANY OF ITS GROUNDS	21
A.	PETITIONER FAILED TO SHOW THAT CAPLAN’S AND KAHN’S DATABASES USE IDENTIFIERS TO RETRIEVE STORED WEB SITES (GROUND 1, CLAIM 8).....	21
B.	APA, IN VIEW OF GEMTEQ AND KAHN, DOES NOT DISCLOSE OR SUGGEST “LISTING IDENTIFICATION OF THE WEB SITE ALONG WITH THE DISTINCTIVE KEY IN THE BIBLIOGRAPHY OF THE MANUSCRIPT” (GROUND 2, CLAIM 8).....	28
C.	CLAIMS 1-7 AND 9-28	31
VII.	CONCLUSION.....	32

Case IPR2017-01154
Patent Owner Preliminary Response

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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