

Filed on behalf of:
Google LLC

Paper No. 11
Date: March 22, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC¹,

Petitioner,

v.

ALEX IS THE BEST, LLC,

Patent Owner.

IPR2017-02058

U.S. Patent 8,581,991

PETITIONER'S REQUEST FOR REHEARING

Under 37 C.F.R. § 42.71(c) and (d)

Before DANIEL N. FISHMAN, MINN CHUNG, and JESSICA C. KAISER,
Administrative Patent Judges

¹ As indicated in the Petitioner's updated mandatory notices, Petitioner Google Inc. is now Google LLC.

I. INTRODUCTION

On September 7, 2017, Petitioner Google LLC (“Google”) filed a Petition requesting an *inter partes* review of claims 1-3, 10-14 and 21 of U.S. Patent No. 8,581,991 B1 (Ex. 1001, “the ‘991 patent”) on the following grounds:

Ground	Claims Challenged	Basis	References
1	1–3, 10–14, and 21	35 U.S.C. §103(a)	Inoue and Nair ²
2	1–3, 10–14, and 21	35 U.S.C. §103(a)	Yamazaki and Nicholas
3	1–3, 10–14, and 21	35 U.S.C. §103(a)	Yamazaki and Nair
4	10 and 11	35 U.S.C. §103(a)	Yamazaki, Nicholas and Nair
5	1–3, 12-14, and 21	35 U.S.C. §103(a)	Kusaka and Nicholas
6	10 and 11	35 U.S.C. §103(a)	Kusaka, Nicholas and Nair

Patent Owner Alex is the Best, LLC (“AITB”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”).

On March 9, 2018, the Board denied Google’s request to institute an *inter partes* review of the challenged claims. The Board instituted trial as to certain other challenged claims of the ‘991 patent, however, in a different Petition (the

² For convenience, we refer to each reference by the first named inventor. “**Inoue**” refers to U.S. Patent Application Pub. No. 2004/0109066 A1 (published June 10, 2004) (Ex. 1005); “**Nair**” refers to U.S. Patent Application Pub. No. 2004/0127208 A1 (published July 1, 2004) (Ex. 1006); “**Yamazaki**” refers to U.S. Patent Application Pub. No. 2004/0105008 A1 (published June 3, 2004) (Ex. 1007); “**Nicholas**” refers to U.S. Patent Application Pub. No. 2004/0133668 A1 (published July 8, 2004) (Ex. 1008); and “**Kusaka**” refers to U.S. Patent Application Pub. No. 2004/0109063 A1 (published June 10, 2004) (Ex. 1009).

“Other ‘991 Petition”). *See* IPR2007-02059, Paper 8. As discussed below, the prior art in the Other ‘991 Petition that was instituted overlaps with the prior art in the instant ‘991 Petition. Google now respectfully requests that the Board partially reconsider its decision not to institute *inter partes* review of the remaining challenged claims of the ‘991 patent presented in the instant ‘991 Petition.

Specifically, Google requests that the Board reconsider Google’s challenges under Grounds 1, 5, and 6. It appears that the Board may have overlooked certain teachings in the Inoue prior art reference regarding the claimed “WSARC” and in the Kusaka prior art reference concerning the WSARC and the claimed “account associated with an Internet direct device.” The Board also may have overlooked pertinent discussions by Dr. Madisetti regarding these references in the background for his detailed analysis. Indeed, although the Patent Owner made several arguments opposing institution of this IPR, it did not argue that either Inoue or Kusaka failed to disclose a WSARC or that Kusaka failed to disclose an “account associated with an Internet direct device.” *See* Paper 7, pp. 1-4 (outlining seven arguments opposing institution).

This request is timely under 37 C.F.R. 42.71(d)(2) because it was filed within 30 days of the Board’s decision not to institute review on the challenged claims. The arguments presented in this motion were also made in the Petition,

although we highlight certain matters in hopes of addressing what we perceive as the Board's concerns regarding the Inoue and Kusaka references.

II. PRECISE RELIEF REQUESTED

The Board should institute *inter partes* review of all challenged claims under Grounds 1, 5, and 6.

For Ground 1, Google respectfully suggests that the Board may have overlooked pertinent details in Inoue's description of an image server that includes an image display accessed via the Internet (*e.g.*, the web). *See, e.g.*, Ex. 1005, Figs. 3 & 13; Abstract, ¶¶ 18, 56, 59-60, 79-80, 80-82. The evidence from Inoue cited in the Petition is responsive to the concerns raised by the Board regarding whether Inoue's "file server 100" is web-related and/or a website. *See* Paper 10, pp. 17-19. Inoue's teachings, as cited in Google's Petition, disclose the claimed WSARC. Petition (Paper 1), pp. 11-27. An *inter partes* review should be instituted for claims 1-3, 10-14, and 21 under Ground 1.

As for Grounds 5 and 6, Google respectfully suggests that Kusaka in fact describes both an WSARC and the claimed account associated with the Internet direct device. *See, e.g.*, Ex. 1009, Abstract, ¶¶ 3, 219-221, 234, 236. Kusaka's web-based image server has all of the attributes and performs all of the functions described in the specification of the '991 patent and required by independent claims 1 and 13, as the examiner of a parent application for the '991 patent found.

See id.; *see also* Petition, pp. 58-59 & Ex. 1003, p. 192. Google also respectfully suggests that Kusaka’s disclosure of user identification information associated with an WSARC account that is also associated with Kusaka’s digital camera is a disclosure of an account at the WSARC “associated with” the camera, and is responsive to the concerns described at pages 27-31 of the Decision. Google cited to this relevant disclosure in Kusaka in its Petition, and Dr. Madiseti provided further information regarding Kusaka in his declaration. Petition, pp. 54-67; Ex. 1010, ¶¶ 135-141, 497-522. An *inter partes* review should be instituted for claims 1–3, 12–14, and 21 under Ground 5 and as to claims 10 and 11 under Ground 6.

III. LEGAL STANDARDS

“A party dissatisfied with a decision may file a request for rehearing, without prior authorization from the Board.” 37 C.F.R. §42.71(d). “The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.* The Board reviews a decision for an abuse of discretion. 37 C.F.R. §42.71(c).

The Board has granted requests for rehearing and instituted grounds that were not previously instituted after determining that it did not consider a disclosure in the prior art and/or evidence that was previously cited by the Petitioner. *See, e.g., Asustek Computer, Inc., et al. v. Avago Technologies General IP (Singapore)*

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