

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.

Petitioner

- vs. -

VILOX TECHNOLOGIES, LLC

Patent Owner

IPR2018-00044

U.S. Patent 7,302,423

PETITIONER'S OPPOSITION

TO PATENT OWNER'S MOTION TO AMEND

PETITIONER'S EXHIBIT LIST

September 24, 2018

EX1001	U.S. Patent 7,302,423 to De Bellis (“423 Patent”)
EX1002	Prosecution File History of U.S. Patent 7,302,423 (“423 PH”)
EX1003	Excerpts from Prosecution File History of U.S. Patent 6,760,720 (“720 PH”)
EX1004	Prosecution File History of U.S. Provisional Appl. 60/227,305
EX1005	Declaration of Dr. Philip Greenspun Under 37 C.F.R. § 1.68 (“Greenspun”)
EX1006	US Patent 5,701,453 to Maloney et al. (“Maloney”)
EX1007	US Patent 7,168,039 to Bertram (“Bertram”)
EX1008	US Patent 6,300,947 to Kanevsky (“Kanevsky”)
EX1009	John Walkenbach, <u>Microsoft Excel 2000 Bible</u> (IDG Books Worldwide, Inc. 1999). (“Excel”)
EX1010	IBM Dictionary of Computing, Tenth Edition (1993) (“IBM”)
EX1011	Declaration of Ingrid Hsieh-Yee
EX1012	Curriculum Vitae of Dr. Philip Greenspun
EX1013	Declaration of Dr. Philip Greenspun Under 37 C.F.R. § 1.68 in Support of Petitioner's Opposition to Patent Owner's Motion to Amend (“Greenspun-MtA”)
EX1014	US Patent 6,452,597 to Goldberg et al. (“Goldberg”)
EX1015	Deposition Transcript of Dr. Wesley Chu (“Chu Deposition”)

I. INTRODUCTION.

The Board should deny entry of the proposed claims in Patent Owner's Motion to Amend ("Motion to Amend") (Paper 27). None of the proposed claims are supported by the original disclosure of the '423 Patent or its parent '720 Patent.

In particular, the proposed independent claims recite "displaying a truncated portion of *each entry in the selected database field...*" (proposed claim 24) or "displaying the reduced number of characters for *each entry from the selected data field*" (proposed claim 25). But the '423 Patent does not provide written description support for such a feature. In the identified support for the display of a truncated portion or reduced number of characters, there is no display of "each entry [from/in] the selected data[base] field" but instead, a subset of the entries from the selected data[base] field is displayed, and not *each entry*. For this reason alone, proposed claims 24-27 cannot be entered.

Further, the proposed claims are not patentable over the art of record. Patent Owner rests on its arguments as to the original claims, and does not specifically argue any feature of the proposed claims as patentable over the art applied in the Petition. Indeed, the amendments to the independent claims are no more than obvious variations of the previously-recited limitations; for example, proposed claim 24 adds a limitation that requires "truncating each entry..." but as established in the Petition, "*Bertram teaches...performing a truncation.*" Petition

at 34. The limitations of the proposed dependent claims are similarly taught by the prior art of record or by additional prior art, and for this additional reason, the proposed claims cannot be entered.

II. THE PROPOSED CLAIMS ARE UNSUPPORTED BY THE SPECIFICATION.

A. Proposed Claim 24 is Not Supported by the Identified Portions of the '423 Patent.

Limitation [24.5] of independent proposed claim 24 recites “truncating each entry having a number of characters determined to be greater than a specified number of characters and displaying a truncated portion of each entry in the selected database field, the displayed truncated portion truncated to reduce a number of characters to be less than or equal to the specified number of characters.” Motion to Amend Appendix, p. 1. Patent Owner asserts that this limitation is supported by the '423 Patent¹ from column 8, line 48 to column 9, line 2, and column 9 at lines 20-24.

¹ The Rules require an identification of support in the “original disclosure of the application,” and the Board has consistently held that “citation should be made to the original disclosure of the application, as filed, rather than to the patent as issued.” *Western Digital Corp. v. SPEX Technologies, Inc.*, Case IPR2018-00082, Paper 13 (informative). Patent Owner does not identify support in the “original disclosure” as required.

But these portions of the '423 Patent do not provide the requisite written description support for the amended limitation. Patent Owner asserts that the "patents provide an example of such a truncation process" and quotes the '423 Patent as follows:

If the maximum number of displayable results is three (3), and the database contains the names of six cities "Armandia, Armonk, New Orleans, New York Riverhead, Riverdale," then the first attempt to "resolve" the result list will stop after a result list display is created with the full name of the cities:

Armandia, Armonk, New Orleans ... (the limit was reached)

Try again with 7 characters:

Armandia, Armonk, New Orl, New Yor, (limit reached again)

Again with 5 characters:

Armandia, Armonk, New O, New Y, (limit reached again)

Again with 3 characters:

Arm (...), New (...), Riv (...). These results may now be displayed on the terminal. The display of Arm, New, Riv can then be used to conduct a further search-on-the-fly.

Motion to Amend, pp. 9-10. This passage reveals the lack of support for the claimed limitations.

In particular, using Patent Owner's example as a starting point and mapping it to the proposed claim language, the "plurality of entries" (recited in limitation

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