UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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RPX CORPORATION
Petitioner

v.

MACROSOLVE, INC.
Patent Owner

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Case IPR2014-00140
Patent 7,822,816 B2

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Before SALLY C. MEDLEY, TREVOR M. JEFFERSON, and
PETER P. CHEN, *Administrative Patent Judges*.

CHEN, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

RPX Corporation ("Petitioner") filed a Petition requesting an *inter partes* review of claims 1-14 of U.S. Patent No. 7,822,816 (Ex. 1001, "the '816 patent"). Paper 3 ("Pet."). MacroSolve ("Patent Owner") filed a Corrected Preliminary Response on February 25, 2014. Paper 8 ("Prelim. Resp."). We have jurisdiction under 35 U.S.C. § 314.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides as follows:

> THRESHOLD.—The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

Upon consideration of the Petition and Preliminary Response, we are persuaded the information presented by Petitioner has established a reasonable likelihood that Petitioner would prevail in showing the unpatentability of claims 1-14 of the '816 patent. Accordingly, we authorize an *inter partes* review of these claims to be instituted.

A. Related Proceedings

The Patent Owner states that the '816 patent is involved in the following pending proceedings in the District Court for the Eastern District of Texas: *MacroSolve, Inc.* v. *Carlson Hotels, Inc.* (6-13-cv-00666); *MacroSolve, Inc.* v. *Five Guys Enterprises, LLC* (6-13-cv-00671); *MacroSolve, Inc. v. Meetup, Inc.* (6-13-cv-00674); *MacroSolve, Inc. v. Chipotle Mexican Grill, Inc.* (6-13-cv-0667); *MacroSolve, Inc. v. Discover*

Financial Services, Inc. (6-13-cv-00669); *MacroSolve, Inc. v. Home Box Office, Inc.* (6-13-cv-00672); *MacroSolve, Inc. v. Box, Inc.* (6-13-cv-00665); *MacroSolve, Inc.* v. *Dropbox, Inc.* (6-13-cv-00670); *MacroSolve, Inc. v. MediaFire, LLC* (6-13-cv-00673); *MacroSolve, Inc.* v. *GEICO Insurance Agency, Inc.* (6-12-cv-00074); *MacroSolve, Inc. v. newegg* (6-12-cv-00046); *MacroSolve, Inc. v. American Airlines, Inc.* (6-11-cv-00685); *MacroSolve, Inc. v. Antenna Software*, *Inc.* (6-11-cv-00287).

The '816 patent is also the subject of *Ex Parte* Reexamination No. 90/012,829, filed April 3, 2013, by GEICO Corporation, GEICO Casualty Company, GEICO General Insurance Company, GEICO Indemnity Company and Government Employees Insurance Company. A non-final Office Action rejecting all claims was mailed in the reexamination on September 13, 2013. Patent Owner's response to the non-final Office Action was e-filed November 13, 2013.

B. Real Party-in-Interest

In the Preliminary Response, Patent Owner argues for dismissal of this proceeding, for failure of the Petitioner to identify real parties-in-interest, and also because Petitioner allegedly is in privity with entities time-barred from initiating this *inter partes* review. Prelim. Resp. 5-16.

Patent Owner contends dismissal is warranted because there are "at least seven entities which are both defendants in E.D. Texas litigation involving the '816 patent and members of Petitioner RPX . . . . [I]t is beyond mere speculation that one or more of these parties are a real party-in-interest to Petitioner." *Id*. at 9-10. Mere membership in Petitioner RPX

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Corporation, however, does not demonstrate the requisite control over Petitioner by the alleged unnamed real parties-in-interest.

In support of its argument for dismissal based on time-barred entities in privity with Petitioner, Patent Owner asserts there are "affiliates" of three venture capital firms that own 10%, 10%, and 12%, respectively, of the publicly traded common stock of Petitioner, and that these affiliates of the venture capital firms also own, or previously owned, some of the publicly traded common stock of companies being sued in the district court proceedings brought by Patent Owner. Prelim. Resp. 15. Patent Owner concludes that the defendants in the district court proceedings control members of the board of Petitioner, without directing us to evidentiary support, other than the past or present ownership of defendants' stock by some of the owners of Petitioner's stock. *Id*. We do not agree with Patent Owner's argument that control of Petitioner arises from such circumstances.

Alternatively, Patent Owner seeks a stay of this proceeding pending either receipt of discovery on the identity of real parties in the district court proceedings, or additional discovery herein. We deny Patent Owner's request for a stay. The time for Patent Owner to have sought discovery on this issue was during the three months between Patent Owner's receipt of the Petition in November 2013 and Patent Owner's filing of its Preliminary Response. Instead, Patent Owner waited until its Preliminary Response to raise the issue of a stay. The stay request is denied.

C. The '816 Patent

The '816 patent is titled "System and Method for Data Management." The subject matter of the '816 patent is the distribution of electronic forms

via the Internet or to mobile devices, and in particular, a method for the management of data collected from a remote computing device. Ex. 1001, Abstract. The '816 patent describes using computerized questionnaires to allow a user to complete a form on a wireless device for transmission to a server. *Id.* at col. 10 ll. 28-37. In particular, a client designs a questionnaire by creating a list of questions, and can assign tokens to the questionnaire, e.g., for follow up questions depending on responses to other questions. *Id.* at col. 8 ll. 40-51. When the questionnaire is complete, the questions and tokens are transmitted to a handheld device, whose user provides responses to the questions. The responses are stored on the handheld device and transmitted to the server, and the server stores the data in a database. *Id.* at col. 8 ll. 57-66, col. 9 ll. 44-63.

Figure 1 of the '816 patent is reproduced below.

Fig. 1
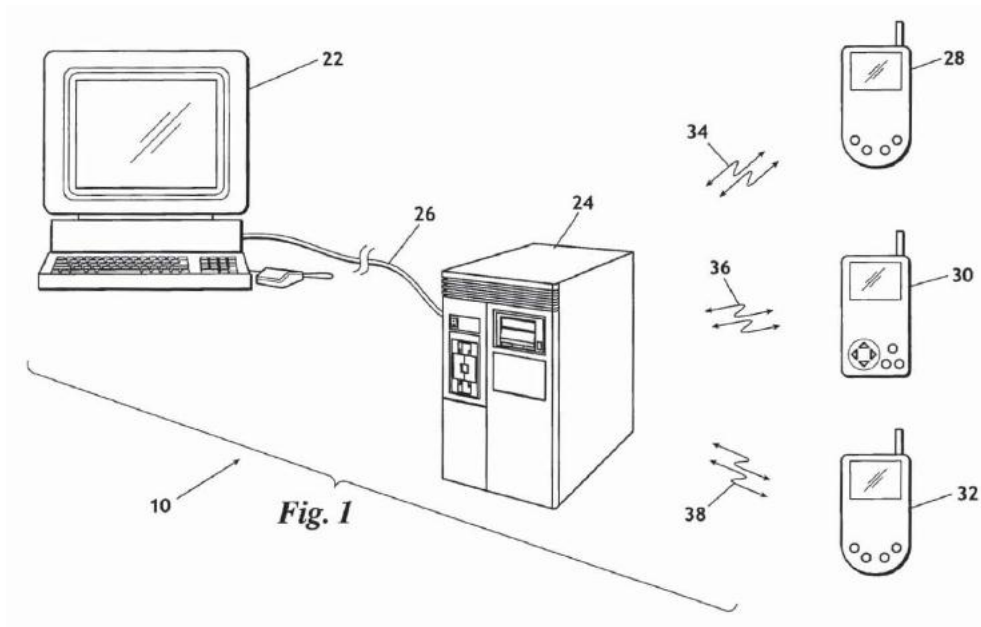
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