

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GUARDIAN ALLIANCE TECHNOLOGIES, INC.,
Petitioner,

v.

TYLER MILLER,
Patent Owner.

IPR2020-00031
Patent 10,043,188 B2

Before SALLY C. MEDLEY, DAVID C. McKONE,
and JOHN R. KENNY, *Administrative Patent Judges*.

McKONE, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. *Background and Summary*

Guardian Alliance Technologies, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1, 5, 9, and 15 of U.S. Patent No. 10,043,188 B2 (Ex. 1001, “the ’188 patent”). Pet. 1. Petitioner indicates that Guardian Alliance Holdings, Inc., and the City of Oklahoma City are real parties-in-interest. *Id.* Tyler Miller (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314; 37 C.F.R. § 42.4(a) (2019). The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Under the circumstances of this case, for the reasons explained below, we deny institution of an *inter partes* review of the ’188 patent.

Petitioner also filed a Motion to Correct a Clerical Mistake in the Petition Under 37 C.F.R. § 42.104(c) (Paper 11, “Mot. to Correct”) and Patent Owner filed a Motion to Terminate IPR Proceeding (Paper 10, “Mot. to Terminate”).

B. *Related Matters*

The parties indicate that Patent Owner’s exclusive licensee, Miller Mendel, Inc., has asserted the ’188 patent against Petitioner’s real party-in-interest, the City of Oklahoma City, in *Miller Mendel, Inc. v. City of Oklahoma City*, Case No. 5:18-cv-00990-M (W.D. Ok.). Pet. 1; Paper 3, 1.

C. The '188 Patent

The '188 patent describes software related to facilitating the process of performing background investigations on, for example, job applicants. Ex. 1001, 1:14–16. Figure 1, reproduced below, illustrates an example:

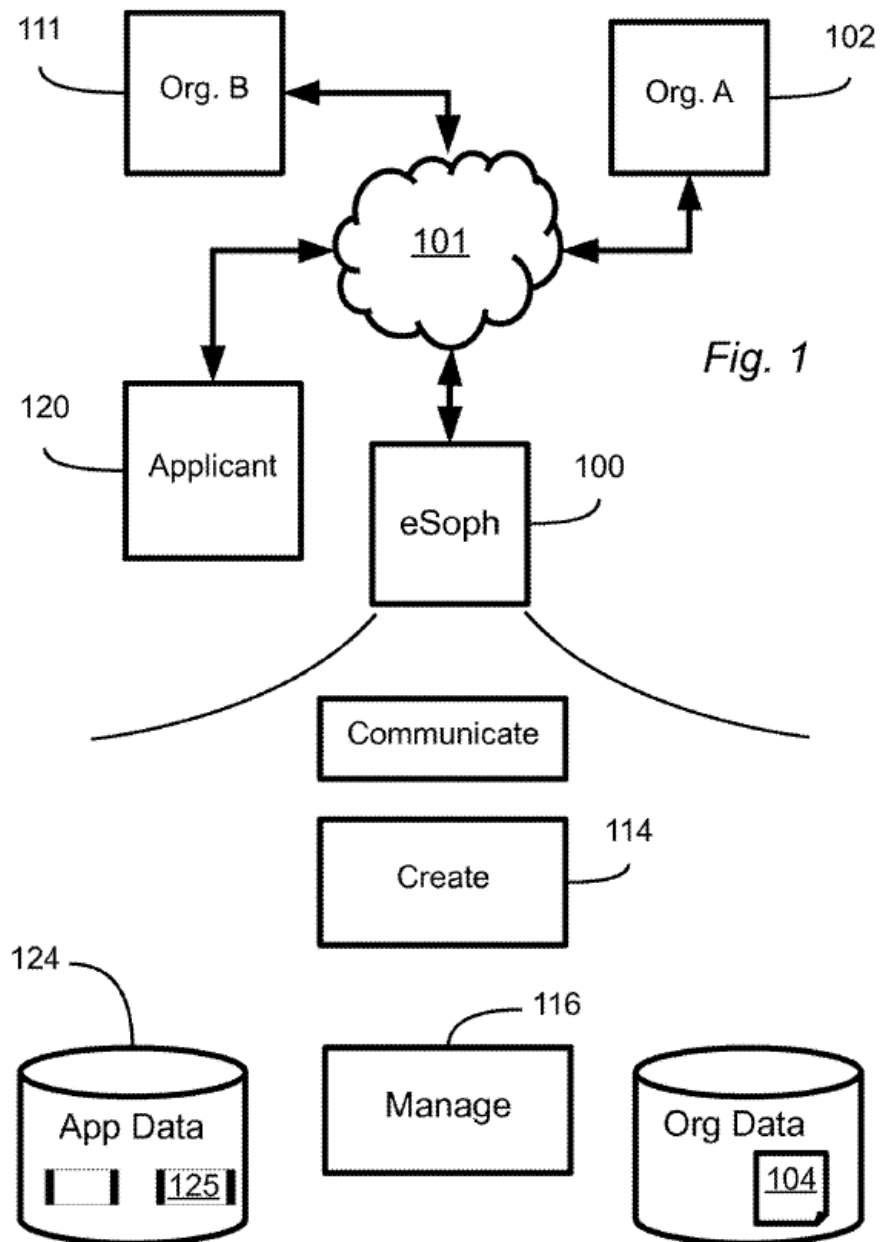


Figure 1 is a block diagram of core components of a background investigation management system. *Id.* at 1:48–51.

Using software system 100, Organization A can create and customize electronic documents 104 to send to applicants, who complete documents via software system 100 and return them to software system 100. *Id.* at 4:5–9. Software system 100 includes document creation component 114 and document management component 116. *Id.* at 4:9–11. In one feature, applicant information 124 can be shared between Organization A and Organization B. *Id.* at 4:15–21. Organization A can send electronic documents 104 to applicant 120 by emailing applicant 120 a link to log into software system 100. *Id.* at 5:29–35. Organization A can send and receive documents (e.g., questionnaires) to and from references (e.g., relatives, employers, co-workers, and neighbors) in a similar manner. *Id.* at 8:31–39. The software system also can include a feature that will retrieve law enforcement and court names, addresses, and phone numbers for a pre-defined radius around an address for the applicant, the applicant’s employer, or the applicant’s relatives. *Id.* at 9:48–52.

Claim 1, reproduced below, is illustrative of the invention:

1. A method for a computing device with a processor and a system memory to assist an investigator in conducting a background investigation of an applicant for a position within a first organization, comprising the steps of:

receiving a first set of program data comprising information identifying the applicant, the position, the first organization, and the investigator;

storing a new applicant entry in the system memory, the new applicant entry associated with the first set of program data;

transmitting an applicant hyperlink to an applicant email address associated with the applicant, the applicant hyperlink for viewing an applicant set of electronic documents;

receiving an applicant electronic response with a reference set of program data, wherein the reference set of program data comprises information regarding a reference source, wherein the reference source is a person, the program data including a reference email address associated with the reference source;

determining a reference class of the reference source based on the reference set of program data;

selecting a reference set of electronic documents based on the reference class of the reference source;

transmitting a reference hyperlink to the reference email address, the reference hyperlink for viewing the reference set of electronic documents;

receiving a reference electronic response to the reference set of electronic documents from the reference source;

storing the reference electronic response in the system memory, associating the reference electronic response with the new applicant entry; and

generating a suggested reference list of one or more law enforcement agencies based on an applicant residential address.

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