

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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HOTEL TONIGHT, INC., HOTWIRE, INC.,
KAYAK SOFTWARE CORP., OPENTABLE, INC., ORBITZ, LLC,
PAPA JOHN'S USA, INC., STUBHUB, INC., TICKETMASTER, LLC, LIVE
NATION ENTERTAINMENT, INC., TRAVELOCITY.COM LP,
WANDERSPOT LLC, AGILYSYS, INC., DOMINO'S PIZZA, INC.,
DOMINO'S PIZZA, LLC, HILTON RESORTS CORPORATION,
HILTON WORLDWIDE, INC., HILTON INTERNATIONAL CO.,
MOBO SYSTEMS, INC., PIZZA HUT OF AMERICA, INC.,
PIZZA HUT, INC., and USABLENET, INC.,
Petitioner

v.

AMERANTH, INC.,
Patent Owner

Case CBM2015-00095
Patent No. 8,146,077

PETITIONER'S REQUEST FOR REHEARING
PURSUANT TO 37 C.F.R. § 42.71

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Pursuant to 37 C.F.R. § 42.71(c) and (d), Petitioner hereby requests rehearing of the Decision Denying Institution of Covered Business Method (“CBM”) Review in the above-captioned matter. (Paper No. 11, “Decision.”)

I. Introduction

Petitioner respectfully submits that the Board erred in denying institution of CBM Review on the ground that claims 1-18 of U.S. Patent 8,146,077 (“the ’077 patent”) are obvious in view of the Micros 8700 HMS Version 2.10 User’s Manual (Ex. 1027, “Micros 8700 UM”) and Timothy W. Bickmore, Digestor: Device-Independent Access to the World Wide Web, Computer Networks and ISDN Systems (Ex. 1022, “Digestor”).

First, the Board concluded that a person of ordinary skill in the art (“POSITA”) would not have been motivated to *modify* the proprietary Micros system to use Internet technologies and existing wireless devices as taught by Digestor. Decision at 27-29. However, the Board misapprehended Petitioner’s contention: Petitioner did not contend that it would have been obvious to *modify* the existing proprietary Micros system for use on the Internet; rather, Petitioner contends that in designing a system based upon the teachings of the two references it would have been obvious to a POSITA to *implement* the system using Internet technologies and existing mobile devices. Furthermore, the Board overlooked evidence set forth in the Petition explaining why a POSITA would have been

motivated to do so (*e.g.*, “to take advantage of existing hardware and software to minimize development costs”). Petition at 25; Ex. 1002 at ¶ 566; *see also id.* at ¶¶ 643, 662, 708, 716, 731. And, in faulting Petitioner for failing to show that Digester’s “existing” wireless devices could be used with the proprietary Micros system, the Board applied an incorrect legal standard, requiring physical combinability of the references’ teachings. Under the correct legal standard (*i.e.* what the combined teachings of the references would have suggested to a POSITA), the Petition establishes that claims 1-18 of the ’077 patent are obvious in view of Micros 8700 UM and Digester.

Second, the Board concluded that the combination of Micros 8700 UM and Digester failed to disclose a “different number of user interface screens from at least one other wireless handheld computing device in the system.” Decision at 29-31. However, as set forth in the Petition, Digester plainly discloses various wireless devices with different display sizes and a re-authoring technique designed “to achieve the best looking document for a given display size.” Petition at 38-39; Ex. 1022 at 1075. And, the Board overlooked evidence set forth in the Petition explaining why it would have been obvious to utilize such devices with different display sizes (*e.g.*, to work with various devices available in the market). Furthermore, in concluding that Digester does not disclose re-authoring techniques that *necessarily* generate a different number of user interface screens for different

wireless device, the Board again applied an incorrect legal analysis. Establishing obviousness does not require that each claim element be necessarily disclosed; rather common sense may be relied on to fill in the gap. While Digestor may not expressly teach that applying re-authoring techniques for two devices with different sized screens would necessarily result in different numbers of screens, common sense provides that such a result would have been obvious to a POSITA, particularly in view of Digestor's express teaching of devices with different display sizes and optimization (*i.e.* achieving the "best looking document") for any given display size. *See, e.g.*, Petition at 38-39 (quoting Ex. 1022 at 1075). Thus, under the correct legal standard, the Petition establishes that claims 1-18 of the '077 patent are obvious in view of Micros 8700 UM and Digestor.

Accordingly, it is respectfully submitted that the Board's conclusions amount to an abuse of discretion that warrants modification of the Decision.

II. Legal Standard

In considering a request for rehearing under 37 C.F.R. § 42.71(d), the Board reviews a prior decision "for an abuse of discretion." 37 C.F.R. § 42.71(c). "An abuse of discretion occurs when a 'decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.'" *Illumina, Inc. v. Trustees of Columbia University*, IPR2013-00011, Paper 44 at 2 (Patent Tr. & App. Bd. May 10, 2013) (citing *PPG Indus. Inc. v. Celanese Polymer*

Specialties Co. Inc., 840 F.2d 1565, 1567 (Fed. Cir. 1988)). “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.” 37 C.F.R. § 42.71(d).

III. Argument

A. The Board Legally Erred in Concluding that One Skilled in the Art Would Not Have Combined Micros 8700 UM and Digestor

1. The Board Misapprehended Petitioner's Obviousness Position

The Board's conclusion that a POSITA would not have been motivated to combine the teachings of Micros 8700 UM and Digestor appears to be based upon a misapprehension of Petitioner's arguments. Specifically, the Decision states:

“Petitioner argues that *modifying* the Micros 8700 HMS for use on the Internet would have been obvious...” Decision at 27.¹

However, Petitioner did not contend that a POSITA would have been motivated to *modify* the existing proprietary Micros 8700 HMS system (with its proprietary UWS workstation and HHT device) for use on the Internet. Rather, as set forth in the following passage excerpted in the Decision, Petitioner contends that it would have been obvious to a POSITA to *implement* a system based on the teachings of Micros 8700 UM using well known Internet technologies:

“[I]t would have been obvious to a POSITA to *implement* that system

¹ Unless otherwise indicated, all emphasis herein was added by Petitioner.

using well-known Internet technologies. . . .” Decision at 27 (quoting Petition at 25).

As established in the Petition and confirmed by Petitioner's expert, Dr. Don Turnbull, a POSITA designing a system based on the teachings of Micros 8700 UM and Digestor would have been motivated to *implement* the system using well-known Internet technologies “in order to take advantage of existing hardware and software to minimize development costs.” Petition at 25; Ex. 1002 at ¶ 566; *see also id.* at ¶¶ 643, 662, 708, 716, 731 (further explaining motivation to implement Micros system using known Internet technologies and existing wireless devices). This is consistent with the prosecution history of the '077 Patent, during which the Examiner recognized it would be obvious to implement the Micros system using known Internet technologies and existing wireless devices. *See, e.g.,* Ex. 1012 (6/26/2009 Office Action) at 450, 462; *id.* (1/20/2010 Final Rejection) at 780, 796.

2. The Board Overlooked Evidence Relating to the Motivation to Combine Micros 8700 UM And Digestor

The Board also appears to have overlooked evidence set forth in the Petition and Dr. Turnbull's declaration. Specifically, the Decision states:

“Petitioner has not addressed, for example, why a POSITA would have substituted re-authored web pages for the existing touchscreen menus designed specifically for use on the HHTs and USWs.”
Decision at 28-29.

The reference to “existing touchscreen menus” illustrates the distinction between

modifying a system and implementing one. To a POSITA seeking to implement the proprietary system described in the Micros 8700 UM, the disclosed HHT and USW touchscreen menus were not “existing” because they were proprietary and thus not available. A POSITA thus had a choice if she wanted to implement a system with workstations and hand-held devices as taught by the Micros 8700 UM. She could design and build the workstations and hand-held devices, design protocols for communicating menus to those devices, and write software necessary to implement the communications protocols and display menus on those devices. Alternatively, she could – and as explained in the Petition would have been motivated to – implement the system using existing devices and web technologies, such as the re-authored web page technique for displaying documents on wireless devices taught by Digester, to avoid reinventing the wheel:

“[I]t would have been obvious to a POSITA to implement that system using well-known Internet technologies such as hypertext transport protocol (HTTP) for communications (including transmission of menus, selections from menus, and updates relating to the same) among the system components, and hypertext markup language (HTML) and web browsers for authoring and displaying menus and other data at the user workstations and the HHTs... ***A POSITA would have been motivated to do so in order to take advantage of existing hardware and software to minimize development costs.***” Petition at 25 (citing Ex. 1002 at ¶ 566); *see also* Ex. 1002 ¶¶ 643, 662, 708, 716,

731.

Indeed, as explained in the Petition (and further evidenced by Digestor), all of the technologies claimed in the '077 patent, including the use of wireless devices and web pages, were well known to those skilled in the art. Petition at 17-19 (citing Ex. 1002 at ¶¶ 99-106). Dr. Turnbull's declaration further makes clear that:

- Web technologies were well-known and widely used. Ex. 1002 at ¶¶ 91-92.
- Existing hardware and software for implementing web technologies (*e.g.*, web servers and web browsers) provided convenient easy-to-use graphical user interfaces, and enabled synchronization of information between various devices through a common web interface. *Id.* at ¶¶ 92, 94, 96, 97.
- Numerous wireless devices, such as the Apple Newton, Sony MagicLink, and others, were well known and commercially available. *Id.* at ¶¶ 93, 95. And, each of these mobile devices supported the use of web browsers. *Id.*
- Despite the widespread use of web technology, “legacy” systems, such as the Micros 8700 HMS system, continued in use due to costs involved in converting them to web-based systems. *Id.* at ¶ 99. Nonetheless, a POSITA **implementing** a system based on the teachings of Micros 8700 UM and Digestor, would have been motivated to utilize existing web technology and mobile devices to minimize development costs. *Id.* at ¶¶ 99, 566.

Thus, as established in the Petition and confirmed by Dr. Turnbull, a POSITA

would have been motivated to combine the teachings of Micros 8700 UM and Digestor in a manner that renders the claims of the '077 patent obvious. Petition at 17-19, 21-26; Ex. 1002 at ¶¶ 91-106, 566.

3. The Board Applied an Erroneous Physical Combinability Standard in Its Obviousness Analysis

Finally, the Board applied an erroneous legal standard in its obviousness analysis. Specifically, the Decision states:

“Nor has Petitioner persuaded us that any wireless handheld computing device, other than the HTT, could have been used in the proprietary Micros 8700 HMS.” (Decision at 29.)

This statement reflects a physical combinability analysis, which has repeatedly been held to be an erroneous test for obviousness. *In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012) (“It is well-established that a determination of obviousness based on teachings from multiple references does not require an actual, physical substitution of elements.”); *In re Etter*, 756 F.2d 852, 859 (Fed. Cir. 1985) (the appropriate inquiry is “not whether the references could be physically combined but whether the claimed inventions are rendered obvious by the teachings of the prior art as a whole.”); *In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983).

Rather, the proper focus of the obviousness inquiry as advocated in the Petition is “what the combined teachings of the references would have suggested to those having ordinary skill in the art.” *In re Mouttet*, 686 F.3d at 1333. As

established in the Petition, Digestor discloses that numerous wireless devices were commercially available and that web pages could be displayed on these devices. Petition at 39 (citing Ex. 1022 at 1075). As further established in the Petition, design incentives and market forces (*i.e.*, minimizing development costs) would have motivated a POSITA to utilize existing web technology and wireless devices to implement a system based on the teachings of Micros 8700 UM and Digestor. Petition at 25 (citing Ex. 1002 at ¶ 566); *KSR Intern. Co. v. Teleflex, Inc.*, 550 U.S. 398, 417-18 (2007). Thus, under the proper legal standard, the Petition establishes that a POSITA would have been motivated to combine the teachings of Micros 8700 UM and Digestor to implement a system for displaying menus on commercially available wireless handheld devices and workstations.

B. The Board Legally Erred in Concluding that the Combination of Micros 8700 UM and Digestor Failed to Disclose the “Different Number of User Interface Screens” Limitation

The Decision sets forth three reasons why the combination of Micros 8700 UM and Digestor fails to disclose the limitation “wherein a cascaded set of linked graphical user interface screens for a wireless handheld computing device in the system includes a different number of user interface screens from at least one other wireless handheld computing device in the system.” Decision at 30. However, in reaching these conclusions, the Board overlooked evidence cited in the Petition and applied erroneous legal standards in its obviousness analysis.

1. The Patent Owner Argued, and the Board Adopted, the Wrong Legal Standard Requiring Physical Combinability

The Decision first states that Petitioner failed to establish that known wireless devices could have been used in the proprietary Micros system:

“First, as asserted by Patent Owner, the Micros 8700 HMS has only a single type of wireless handheld computing device—the HHT.... Therefore, *because Petitioner has not shown that any other wireless handheld computing device could have been used in the proprietary Micros 8700 HMS*, Petitioner also has not shown that a different number of graphical user interface screens would have been used on any other wireless handheld computing device.” Decision at 30.

The Board's conclusion is again based upon an improper obviousness analysis. As discussed above, the proper test for obviousness is not whether the wireless devices disclosed by Digestor could be physically combined with the Micros 8700 system, but rather what the combined teachings of the references would have suggested to one skilled in the art. *In re Mouttet*, 686 F.3d at 1332-33; *In re Etter*, 756 F.2d at 859; *In re Sneed*, 710 F.2d at 1550. As demonstrated in the Petition, a POSITA would have been aware of numerous commercially available wireless devices, and been motivated to implement a system using these various types of wireless devices based upon the teachings of Micros 8700 UM and Digestor. *See, e.g.*, Petition at 25 (citing Ex. 1002 at ¶ 566); *see also* Section III.B.2, *infra*.

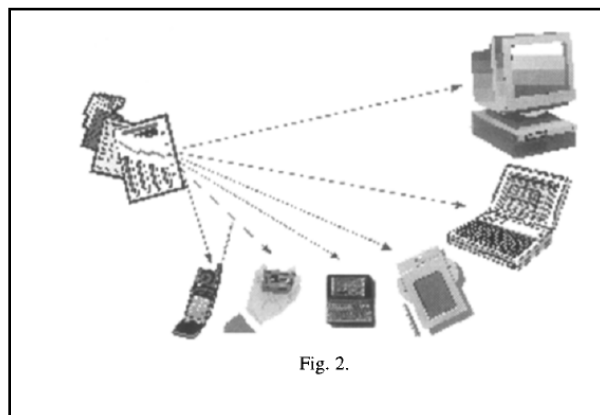
2. The Board Overlooked Argument and Supporting Facts Relating to the Use of Different Wireless Devices

The Decision further states that Petitioner failed to explain why a POSITA would have utilized handheld devices having different display screen sizes:

“Second, Petitioner has not explained why a POSITA would have selected, or designed, handheld devices having different display screen sizes for use in the Micros 8700 HMS.” Decision at 30.

However, the Petition provides that explanation and evidence supporting the same, which the Board appears to have overlooked. Specifically, the Petition explains:

- Digester discloses numerous commercially available wireless handheld devices, such as the Sony MagicLink, Apple Newton, and Nokia 9000 Communicator. Petition at 39 (citing Ex. 1022 at 1075); Ex. 1002 at ¶ 634.
- Digester discloses that these devices each had different display sizes. Petition at 39 (citing Ex. 1022 at 1075 (describing the various devices as being illustrated in Fig. 2)). As illustrated in Fig. 2 (reproduced below), these devices each clearly have different display sizes.



- Indeed, Digestor explains that the goal of the disclosed software system is to “provid[e] device independent access to the web,” (*i.e.* for devices of different display sizes) by using a dynamic re-authoring technique specifically designed to “to achieve the best looking document *for a given display size.*” Petition at 38 (quoting Ex. 1022 at 1075); Ex. 1002 at ¶ 627.
- Thus, it would have “been obvious to a POSITA to generate customized display layouts for other types of handheld devices, as disclosed for example in Digestor, to enable the Micros 8700 HMS system to work with the various types of portable handheld devices available in the market.” Petition at 38; Ex. 1002 at ¶ 627.

Allowing a customer to use devices with different sized screens in a system like the Micros 8700 system is the kind of design choice that is obvious under *KSR*. *KSR*, 550 U.S. at 401 (“When a work is available in one field, design incentives and other market forces can prompt variations of it . . . If a person of ordinary skill in the art can implement a predictable variation, and would see the benefit of doing so, §103 likely bars its patentability.”) Indeed, given Digestor’s ability to support these different types of devices by automatically re-authoring a workstation menu to display appropriately on their respective screens, it is hard to see why a POSITA would deny her customer a choice of wireless devices. Thus, because the Board overlooked the explanation and supporting evidence set forth in the Petition

regarding why a POSITA would have used devices with different display sizes as taught by Digester, the Board's conclusion was erroneous.

3. The Board Applied the Wrong Legal Standard in Requiring that Each Claim Element Be Expressly or Necessarily Disclosed in One of the Prior Art References

Finally, the Decision states that Petitioner failed to identify any teaching in Digester that re-authoring web pages would have *necessarily* generated a different number of user interfaces screens:

“Third, even assuming that a wireless handheld computing device having a different display screen size from the HTT would have been used in the Micros 8700 HMS, Petitioner has not directed us to any teaching in Digester that re-authoring a web page would have generated, *necessarily*, a number of graphical user interface screens for that handheld computing device different from the number for the HTT.” Decision at 30.

The Board's rationale appears to be that establishing obviousness requires that each claim element be expressly or necessarily (*i.e.*, inherently) disclosed in one of the prior art references relied on in the obviousness challenge.

This rationale is legal error. Under the correct legal standard, the common sense of a POSITA can be relied on for a claim element missing from the prior art. In this regard, the Federal Circuit decision in *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324 (Fed. Cir. 2009) is instructive. The method claim at issue in *Perfect Web* included 4 steps labeled (A) through (D). *Id.* at 1326. The fourth step

(D) recited “repeating steps (A)-(C)” until certain conditions were satisfied. *Id.* The Federal Circuit affirmed the District Court’s determination that a prior art reference which disclosed steps (A)-(C), but did not expressly disclose step (D), nevertheless rendered the claim obvious, because the “final step of the claimed method is merely the logical result of the common sense application of the maxim ‘try, try again.’” *Id.* at 1327, 1331. Thus, under *Perfect Web*, not every claim limitation need be present in the prior art in order to establish obviousness, and common sense may be relied on to fill the gap.

Here, while Digestor may not expressly teach that applying re-authoring techniques for two handheld devices with different sized screens would result in different numbers of screens for the two devices, common sense indicates that such a result would have been obvious to a POSITA. As established in the Petition, Digestor discloses a dynamic re-authoring technique, which could be applied to devices with different screen sizes. Petition at 39 (citing Ex. 1022 at 1075). Digestor’s re-authoring technique divides single large web pages into sets of linked user interface screens for display on devices with smaller display screens. Petition at 19, 24; Ex. 1022 at 1075, 1078; Ex. 1002 at ¶¶ 564. And, as the Board recognized, Digestor discloses that the re-authoring algorithm uses heuristic information to determine when the re-authored document is “good enough” to stop the transformation process, *i.e.* “the search is stopped when the area required by a

document version is 2.5 times the screen area of the client display.” Decision at 26-27 (citing Ex. 1022 at 1079, 1080). Given devices with different screen sizes as taught by Digestor, it is at least likely (and therefore obvious) that the application of Digestor’s technique would result in different numbers of user interface screens. Thus, as established in the Petition, it would have been obvious to apply the Digestor re-authoring techniques to devices with different display sizes (*e.g.*, re-author the menu for a first device with one size screen, and then again for a second device with a different size screen), such that a different number of user interface screens would be generated. Petition at 39; Ex. 1002 at ¶¶ 634. Therefore, under the proper legal standard, the Petition establishes the combination of Micros 8700 UM and Digestor renders this limitation obvious.

IV. Conclusion

Petitioner respectfully submits the Board misapprehended and overlooked arguments and facts set forth in the Petition, and applied incorrect legal standards in its obviousness analysis. The Board’s denial of the Petition was therefore an abuse of discretion. Accordingly, Petitioner requests modification of the Decision and institution of CBM review for all claims of the ’077 patent.

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Respectfully Submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Petitioner's Request for Rehearing Pursuant to 37 C.F.R. § 42.71 was served by electronic mail on September 21, 2015 as follows:

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