

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TERADATA OPERATIONS, INC.,
Petitioner,

v.

BERKELEY*IEOR,
Patent Owner.

CBM2019-00009 and
CBM2019-00013
Patent 7,882,137 B2
and
CBM2019-00011 and
CBM2019-00014
Patent 8,612,316 B2

Before JOSIAH C. COCKS, MEREDITH C. PETRAVICK, and
JON B. TORNQUIST, *Administrative Patent Judges*.

TORNQUIST, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Requests on Rehearing of Decisions
Denying Institution of *Inter Partes* Review
35 U.S.C. § 42.71(d)

I. INTRODUCTION

Teradata Operations, Inc. (“Petitioner”) filed requests for rehearing of our decisions denying institution of covered business method (“CBM”) patent review of claims 1, 3, and 8–24 (CBM2019-00009) and claims 2, 4–7, and 25–30 (CBM2019-00013) of U.S. Patent No. 7,882,137 B2 and claims 1, 3, and 8–24 (CBM2019-00011) and claims 2, 4–7, and 25–30 (CBM2019-00014) of U.S. Patent No. 8,612,316 B2 under Section 18 of the Leahy-Smith America Invents Act (“AIA”) (Paper 7, “Institution Decision” or “Inst. Dec.”).¹ *See* CBM2019-00009, Paper 8 (“Req. Reh’g”); CBM2019-00011, Paper 8; CBM2019-00013, Paper 8; CBM2019-00014, Paper 8.

Petitioner argues in its requests for rehearing that: the institution decisions incorrectly construed the term “using the relational database management system² to . . . calculate” (Req. Reh’g 1–5); misapprehended or overlooked the “technical invention” standard for CMB review eligibility (*id.* at 5–9); and misapprehended or overlooked Petitioner’s arguments that performing profitability calculations in an RDBMS was known and obvious (*id.* at 10–15).

For the reasons discussed below, we deny Petitioner’s requests for rehearing.

¹ Petitioner’s requests for rehearing are substantively identical in each case. Accordingly, we focus our analysis and citations on Petitioner’s arguments in CBM2019-00009.

² The parties refer to this elements as “an RDBMS.” Inst. Dec. 7.

II. STANDARD FOR REHEARING

Pursuant to 37 C.F.R. § 42.71(d):

A party dissatisfied with a decision may file a single request for rehearing without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. 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.

When reconsidering a decision on institution, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion exists where a “decision [i]s based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus. Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988).

III. ANALYSIS

A. Claim Construction

In its Preliminary Response, Patent Owner construed the term “using the relational database management system to . . . calculate” as requiring that the recited calculations be performed “in the RDBMS.” Inst. Dec. 8–10. Petitioner did not provide an express construction for this claim term in the Petition. *Id.* at 7.

For purposes of deciding whether to institute trial, and after reviewing the claim language, the written description of the involved patents, and the relevant prosecution history, we adopted Patent Owner’s proposed construction. *Id.* at 8–10. Petitioner contends the construction adopted by the panel is incorrect because the claims on their face are broad enough to encompass “[a]ny use of the RDBMS,” for example using the RDBMS to

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access data for calculations. Req. Reh’g 5. Petitioner further contends that the portions of the claims, written description, and prosecution history discussed in the Institution Decision do not support the “unduly narrow” construction adopted by the panel. *Id.* at 1–5.

We are not persuaded by Petitioner’s arguments. First, because the Petition did not provide a proposed construction for the term “using the relational database management system to . . . calculate,” we could not have overlooked or misapprehended Petitioner’s current arguments with respect to whether the claims, written description, and prosecution history support such a construction. Second, a request for rehearing is not an opportunity to provide a construction in the first instance, nor is it an opportunity to support an implied construction that was not explained or supported by citation to intrinsic evidence in the Petition. *See* 37 C.F.R. § 42.304(b)(3) (requiring a petition to set forth “[h]ow the challenged claim is to be construed”).

In view of the foregoing, we are not persuaded that Petitioner has demonstrated that we misapprehended or overlooked content in the Petition that warrants a change in the claim construction adopted in the Institution Decision.

B. The “Technological Invention” Standard

Petitioner contends the panel “misapprehended and misapplied” the “Technological Invention” standard for CBM review eligibility. Req. Reh’g 5–9. In particular, Petitioner asserts the claims recite the use of “known RDBMS technology to calculate profits” and therefore the panel failed to follow the standard set forth in the Office Trial Practice Guide and controlling precedent in determining the claims, as a whole, recite a technological invention. *Id.* at 6–7. Petitioner also contends the claims do

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not solve a technical problem using a technical solution, but instead are “directed to solving a business problem using a business solution.” *Id.* at 7–9.

As explained in the Institution Decision, Petitioner’s arguments with respect to whether the challenged claims recite a technological feature that is novel and unobvious over the prior art relied on a claim construction that we did not adopt. Inst. Dec. 13–14. As such, the Petition did not adequately explain why it was not novel and obvious to use an RDBMS itself to perform the claimed profit calculations. *Id.* at 14. Although Petitioner disagrees with our conclusion, and now cites to disparate portions of the Petition to support its argument, a mere disagreement is not the proper basis for rehearing, and a rehearing request is not the proper vehicle to make arguments that were not clearly set forth in the Petition.

With respect to the question of whether the claims solve a technical problem with a technical solution, in the Institution Decision we found persuasive Patent Owner’s arguments and supporting evidence that the claimed invention provides improved speed and efficiency compared to conventional database technology. Inst. Dec. 15. In its request for rehearing, Petitioner asserts the claims do not recite an improvement to prior art database technology, but instead recite the use of conventional RDBMS functionality “to carry out the described mathematical formulas.” Req. Reh’g 9.

As noted in the Institution Decision, the petition did not adequately explain why the use of an RDBMS itself to more quickly and efficiently calculate profit was not a technical solution to a technical problem. Inst. Dec. 15. And although Petitioner presents multiple reasons in its request for

rehearing as to why using an RDBMS to actually perform calculations is not a technical solution to a technical problem, a request for rehearing is not an opportunity to address this question in the first instance.

In view of the foregoing, we are not persuaded that we misapprehended or overlooked Petitioner's arguments regarding whether the claimed subject matter as a whole "solves a technical problem using a technical solution."

C. Anticipation or Obviousness over the Recited Prior Art

Petitioner contends the panel overlooked or misunderstood its arguments and evidence that the asserted prior art, including Blain (Ex. 1006), SAP-IS-B (Ex. 1007), and E&Y (Ex. 1005), anticipate or render obvious using an RDBMS to perform profitability calculations. Req. Reh'g 10–14.

With respect to Blain, Petitioner contends the Institution Decision recognized that Blain "uses a database to store transactions and a database management system to search the database and generate reports," but failed to recognize that when such a database generates reports using profitability rules, "it is the RDBMS itself calculating profit." Req. Reh'g 11 (citing Inst. Dec. 13). We did not overlook or misapprehend this argument. As we noted in the Institution Decision, the Petition simply failed to explain sufficiently why the identified disclosures demonstrate that it is the RDBMS itself that is performing the recited profit calculations. Inst. Dec. 13. A request for rehearing is not an opportunity to provide such an explanation.

Petitioner also contends that E&Y's disclosure of using relational databases to process information demonstrates that it is the RDBMS itself that performs the profitability calculations. Req. Reh'g 13 (quoting Ex.

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1016 ¶ 262). In the identified portion of the Petition, Petitioner argued that E&Y discloses “using the database to process information” and then calculating profit at a granular level. Pet. 52; *see also id.* at 58 (asserting E&Y discloses “the use of relational databases”). Petitioner did not explain sufficiently, however, why such a disclosure indicates that it is the RDBMS itself that is performing the calculations, and a request for rehearing is not an opportunity to do so in the first instance.

Petitioner also contends that the Board failed to consider its obviousness arguments. Req. Reh’g 14–15. We considered these arguments, but ultimately found them unpersuasive. Inst. Dec. 13–14. In short, Petitioner presumed a construction of “using the relational database management system to . . . calculate” that we did not adopt, and did not explain sufficiently why the prior art of record would have rendered the challenged claims obvious under the adopted claim construction. A request for rehearing is not an opportunity to remedy these deficiencies.

D. Conclusion

We have considered Petitioner’s requests for rehearing, but we are not persuaded that we misapprehended or overlooked any matter in declining to institute a covered business method review of the above-identified patents based on the record that was before us.

IV. ORDER

It is

ORDERED that Petitioner’s Requests for Rehearing in CBM2019-00009; CBM2019-00013; CBM2019-00011; and CBM2019-00014 are *denied*.

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