

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

CONTENTGUARD HOLDINGS, INC.,  
Patent Owner.

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Case IPR2015-00440  
Patent 6,963,859 B2

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Before PATRICK R. SCANLON, KERRY BEGLEY, and  
KEVIN W. CHERRY, *Administrative Patent Judges*.

CHERRY, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review  
35 U.S.C. § 314(a) and 37 C.F.R. § 42.108

## I. INTRODUCTION

Petitioner, Apple Inc., filed a Petition requesting an *inter partes* review of claims 1, 3, 5, 8, 13, 15, 16, 19–21, 24, 29, 31, 33, 36, 40, 42, 43, 46–48, 51, 58, 60, 62, 65, 69, 71, 72, 75–77, and 81 (“the challenged claims”) of U.S. Patent No. 6,963,859 B2 (Ex. 1001, “the ’859 patent”). Paper 1 (“Pet.”). Patent Owner, ContentGuard Holdings, Inc., filed a Preliminary Response pursuant to 35 U.S.C. § 313. Paper 10 (“Prelim. Resp.”).

We have jurisdiction under 35 U.S.C. § 314. Section 314 provides that an *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . 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.”

For the reasons that follow, we deny institution of *inter partes* review.

### A. Related Matters

Petitioner indicates that the ’859 patent was asserted against it and other defendants by Patent Owner in several lawsuits pending in various U.S. district courts. *See* Pet. 2; Paper 9, 3.

Petitioner filed two other petitions seeking *inter partes* review of the ’859 patent: Cases IPR2015-00441 and IPR2015-00442. Petitioner also filed petitions in Cases IPR2015-00351–358, 399, 400, and 443–458, challenging related U.S. Patent Nos. 7,225,160; 7,269,576; 7,523,072; 7,774,280; 8,001,053; 8,370,956; 8,393,007; and 8,583,556. Paper 9, 2–3.

*B. The '859 Patent*

The subject matter of the '859 patent relates to distribution of and usage rights enforcement for digitally encoded works. Ex. 1001, 1:12–13. According to the '859 patent, an issue facing the publishing and information industries is “how to prevent the unauthorized and unaccounted distribution or usage of electronically published materials.” *Id.* at 1:16–19. In particular, a major concern is “[t]he ease with which electronically published works can be ‘perfectly’ reproduced and distributed.” *Id.* at 1:30–31. One way to curb unaccounted distribution is to prevent unauthorized copying and transmission. *Id.* at 1:49–51. Another way is to distribute software, which requires a “key” to enable its use. *Id.* at 1:65–66. However, the '859 patent discloses that, although such distribution and protection schemes prevent unauthorized distributions, they do so by sacrificing the potential for subsequent revenue bearing uses. *Id.* at 2:61–65. For example, the '859 patent discloses that “it may be desirable to allow the lending of a purchased work to permit exposure of the work to potential buyers,” “permit the creation of a derivative work for a fee,” or “permit copying the work for a fee.” *Id.* at 2:65–3:3.

The '859 patent discloses that it solves these problems by both permanently attaching usage rights to digital works, and placing elements in repositories, which enforce usage rights and store and control the digital works. *Id.* at 6:11–21. Repositories are trusted systems, which support usage rights. *Id.* at 6:22–44, 11:63–12:63, 49:63–67.

*C. Illustrative Claim*

Claims 1, 29, and 58 are independent. Claim 1 is reproduced below:

1. A rendering system adapted for use in a distributed system for managing use of content, said rendering system being operative to rendering content in accordance with usage rights associated with the content, said rendering system comprising:

a rendering device configured to render the content; and

a distributed repository coupled to said rendering device and including a requester mode of operation and server mode of operation,

wherein the server mode of operation is operative to enforce usage rights associated with the content and permit the rendering device to render the content in accordance with a manner of use specified by the usage rights,

the requester mode of operation is operative to request access to content from another distributed repository, and

said distributed repository is operative to receive a request to render the content and permit the content to be rendered only if a manner of use specified in the request corresponds to a manner of use specified in the usage rights.

Ex. 1001, 51:16–38.

*D. Evidence Relied Upon*

Petitioner relies upon the following prior art references:

Hartrick	EP 0 567 800 A1	Nov. 3, 1993	Ex. 1021
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Liam Comerford & Steve R. White, *ABYSS: A Trusted Architecture for Software Protection* (1987) (Ex. 1016, “ABYSS”).<sup>1</sup>

DOROTHY ELIZABETH ROBLING DENNING, *CRYPTOGRAPHY AND DATA SECURITY* (1983) (Ex. 1017, “Denning”).

Petitioner also relies upon the Declaration of Alan Sherman Regarding U.S. Patent Nos. 6,963,859; 7,523,072; 8,370,956; 8,393,007; 7,269,576, dated December 20, 2014 (Ex. 1013, “Sherman Declaration”).

*E. Asserted Grounds of Unpatentability*

Petitioner asserts the following grounds of unpatentability:

References	Basis	Challenged Claims
ABYSS and Denning	§ 103(a)	1, 3, 5, 8, 13, 15, 16, 19–21, 24, 29, 31, 33, 36, 40, 42, 43, 46–48, 51, 58, 60, 62, 65, 69, 71, 72, 75–77, and 81
ABYSS, Denning, and Hartrick	§ 103(a)	1, 3, 5, 8, 13, 15, 16, 19–21, 24, 29, 31, 33, 36, 40, 42, 43, 46–48, 51, 58, 60, 62, 65, 69, 71, 72, 75–77, and 81

## II. ANALYSIS

### A. Ground Relying on ABYSS and Denning

#### 1. Procedural Defects

As a threshold matter, we note that the Petition has several significant procedural defects. For instance, a petition for *inter partes* review must “identif[y], in writing and with particularity, each claim challenged, the grounds on

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<sup>1</sup> The Petition does not provide any further information about where ABYSS was published.

which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3). According to 37 C.F.R. § 42.104(b)(4), a petition for *inter partes* review “must identify how the construed claim is unpatentable under the statutory grounds on which the petitioner challenges the claims, and must specify where each element of the claim is found in the prior art patents or printed publications relied upon,” and 37 C.F.R. § 42.104(b)(5) adds that the Petition must “identify[] specific portions of the evidence that support the challenge,” 37 C.F.R. § 42.104(b)(5). Similarly, 37 C.F.R. § 42.22(a)(2) states that each petition must include “[a] full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence including material facts, and the governing law, rules, and precedent.” The Office Patent Trial Practice Guide suggests that parties requesting *inter partes* review should “avoid submitting a repository of all the information that a judge could possibly consider, and instead focus on concise, well-organized, easy-to-follow arguments supported by readily identifiable evidence of record.” 77 Fed. Reg. 48,756, 48,763 (Aug. 14, 2012). For the reasons discussed below, we agree with Patent Owner’s assertions that the Petition fails to comply with each of these requirements in addressing the asserted ground based on ABYSS and Denning.<sup>2</sup> See Prelim. Resp. 4–9.

Indeed, the Petition fails to satisfy these fundamental requirements at every level. For example, the Petition contains numerous nested string citations to broad

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<sup>2</sup> Although our discussion is focused on the ground of ABYSS and Denning, this analysis applies equally to the ground based on ABYSS, Denning, and Hartrick.

swaths of the references, the Sherman Declaration, and internal cross-references to whole sections of the Petition. *See, e.g.*, Pet. 47–48 (discussing the first “element” of claim 1 and citing, *inter alia*, “*See* Ex. 1016, 39–40, 44–45, 49; §§ IV.A2, E.1; Ex. 1013 at ¶ C6, C34–43, C123–24” and “*See* § IV.E.1–2; Ex. 1016 at 42, 43, 47, 49, 50; Ex. 1017 at 178–79; Ex. 1013 at ¶ C173, C68–73, C80–85”). The analysis of what the Petition identifies as the first of six elements of claim 1 spans a little more than one page of the Petition, but cites to 56 paragraphs of the Sherman Declaration, 11 pages of the 13-page ABYSS reference, and at least 16 pages of internal sections of the Petition. Our count does not include the further internal citations and cross references contained in the cross-cited portions of Petition. The same problem continues for the remaining five elements. For example, although the unpatentability analysis of the second element is only five lines in the Petition (*see* Pet. 49), it cites over 30 paragraphs of the Sherman Declaration, 9 pages of ABYSS, and 5 other pages of the Petition. These nested citations to so much of the record obscure what exactly Petitioner is relying on as teaching or suggesting these elements. The remaining elements each include citations that are no better: “*See* § IV.E.2; Ex. 1016 at 44, 49, 50; Ex. 1013 at ¶ C106–09, C123–26, C174” (Pet. 50); “*See* § IV.A.4; Ex. 1016 at 40, 42–45; Ex. 1013 at ¶ C48–53, C104–05” (Pet. 51); “*See* § IV.A.3–4; Ex. 1016 at 38–40, 42–45, 50; Ex. 1013 at ¶ C6–10, C55–58” (Pet. 51). *See* Pet. 49–57.

The problem of nested citations is not limited to the Petition itself. The Sherman Declaration makes further use of internal cross references. For example, paragraphs C153–70 of the Sherman Declaration purport to explain how ABYSS shows use of a repository. *See* Ex. 1013 ¶¶ C153–70. These 18 paragraphs cite to

a further 62 paragraphs. Petitioner’s claim charts, which appear only in the Sherman Declaration, are supported exclusively by internal cross-references, generally to vast sections of the Declaration. *See id.* ¶ C174 (e.g., element [1.a] of the ’859 patent citing ¶¶ C23–C59, C76–C126, or 88 paragraphs of the Sherman Declaration); *id.* at ¶ C175.

The clarity problems caused by the nested citations are exacerbated by the labyrinthine-way Petitioner has structured the Petition. A brief description of the structure of the Petition will illustrate this problem. The Petition’s unpatentability analysis is divided into roughly five sections. First, the Petition presents a synopsis of each reference, describing what Petitioner contends each of the three principal references relied upon in the Petition generally discloses. *See* Pet. 23–37 (§§ IV.A–IV.C). Although this section quotes heavily from each reference, it also includes extensive citations to the Sherman Declaration and various characterizations of the references. *See, e.g., id.* at 25 (citing Ex. 1006, 38–40, 43, 49, 50, Ex. 1013 ¶¶ C6, C34–45, C74–75, C147–48). Second, the Petition constructs an “implementation” of the ABYSS system using certain encryption techniques (public-key encryption (“PKI”)) taught in a second reference, Denning, which Petitioner contends would be incorporated into at least four aspects of ABYSS. *See* Pet. 37–40. Third, the Petition then describes the “operation” of the “implemented” system. *See id.* at 40–43. Fourth, the Petition next discusses how, based on the “operation” of the “implemented” system, the implementation discloses “repositories” and “usage rights,” as Petitioner has construed those terms. *See id.* at 43–47. Fifth, the Petition maps this “operation” of the “implementation” of ABYSS onto the challenged claims. *See id.* at 47–57. This mapping relies on



all the previous summaries and descriptions. *Id.* Thus, the unpatentability analysis relies on the description of the hypothetical operation of a hypothetical implementation of a system relying, in part, on Petitioner's description and characterization of the disclosed system. The result of all these layers of analysis is that the final unpatentability analysis is two or three levels removed from the actual disclosure of the references. Petitioner's approach completely blurs the line between the actual teachings of each asserted reference, Petitioner's modifications to the teachings, and Petitioner's characterizations of those teachings. This approach improperly shifts the burden of deciphering Petitioner's arguments onto Patent Owner and the Board.<sup>3</sup>

The lack of clarity in the Petition is further compounded by the improper incorporation by reference of the Sherman Declaration. The Petition is full of conclusory statements that cite to broad swathes of the lengthy Sherman Declaration.<sup>4</sup> Indeed, without referring heavily to the Sherman Declaration many sections of the Petition would be unintelligible. Patent Owner properly directs our attention to the Board's informative decision in *Cisco Systems, Inc. v. C-Cation Techs., LLC*, Case IPR2014-00454 (PTAB Aug. 29, 2014) (Paper 12) (informative). Prelim. Resp. 7. As explained in *Cisco*, citations to "large portions of another document, without sufficient explanation of those portions, amounts to

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<sup>3</sup> We also note the record is larded with 69 exhibits submitted by Petitioner totaling almost 30,000 pages, most of which are not cited or relied on in the Petition.

<sup>4</sup> The Sherman Declaration is about 470 pages long. Although most of it relates to patents and references not at issue in this proceeding, the portion relating to this proceeding is about 200 pages long. *See* Ex. 1013 §§ I–VI.D (i.e., pages 1–228).

incorporation by reference.” *Cisco*, Case IPR2014-00454, slip op. at 8. Similarly, *Cisco* explains that the “practice of citing [a] Declaration to support conclusory statements that are not otherwise supported in the Petition also amounts to incorporation by reference.” *Id.* at 9. Such incorporation by reference is improper: “[a]rguments must not be incorporated by reference from one document into another document.” 37 C.F.R. § 42.6(a)(3); *see also DeSilva v. DiLeonardi*, 181 F.3d 865, 866–67 (7th Cir. 1999) (Incorporation by reference “amounts to a self-help increase in the length of the [] brief . . . . A brief must make all arguments accessible to the judges, rather than ask them to play archeologist with the record.”). For example, in its two-page argument that ABYSS and Denning teach a repository (Pet. 46–47), the Petition collectively cites to paragraphs C1–22, C82–89, C95–103, and C146–170 of the Sherman Declaration, corresponding to approximately 25 pages of testimony.

In sum, the Petition’s conclusory analysis with supporting citations to an incomprehensible web of internal cross-references to the Petition and the Sherman Declaration, and imprecise citations to ABYSS and Denning, leaves us “to play archeologist with the record.” *Cisco Sys., Inc.*, IPR2014-00454, at 10 (Paper 12) (informative). Based on the deficiencies addressed above, the Petition fails: (1) to specify sufficiently where the limitations of the challenged claims of the ’859 patent are taught or suggested by ABYSS or Denning; and (2) to provide a sufficiently detailed explanation of the significance of the citations to these references and the Sherman Declaration—as required under 35 U.S.C. § 312(a)(3), 37 C.F.R. § 42.22(a)(2), and 37 C.F.R. § 42.104(b)(4) – (5). We, therefore, deny institution of the asserted ground of obviousness over ABYSS and Denning.

## 2. *Obviousness Analysis*

In addition to these serious procedural defects in the Petition, we also find the obviousness analysis to be deficient on the merits. In particular, we determine that the Petition’s obviousness analysis suffers two flaws: (1) it fails to provide an adequate explanation of the differences between the prior art and the claimed invention; and (2) it is driven by improper hindsight and lacks sufficient articulated reasons with rational underpinning to support the modifications it proposes.

### *i. Legal Standards*

A patent claim is unpatentable as obvious under 35 U.S.C. § 103(a)<sup>5</sup> if “the differences between” the claimed subject matter and the prior art “are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103(a); *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The Supreme Court has explained that:

Under § 103, [(1)] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such [(4)] secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

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<sup>5</sup> The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), revised 35 U.S.C. § 103, effective March 16, 2013. Because the ’859 patent was filed before March 16, 2013, our references and citations to § 103 in this decision are to the pre-AIA version.

*Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

In addition, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). The reason for this is that, “[w]hile the Supreme Court made clear that a mechanical application of the teaching-suggestion-motivation test, requiring an explicit teaching in the prior art, is inappropriate, ‘[w]e must still be careful not to allow hindsight reconstruction of references to reach the claimed invention without any explanation as to how or why the references would be combined to produce the claimed invention.’” *Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1343, 1368 (Fed. Cir. 2012) (quoting *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1374 n.3 (Fed. Cir. 2008)); *see also KSR*, 550 U.S. at 421 (“A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.”); *Graham*, 383 U.S. at 36 (warning against a “temptation to read into the prior art the teachings of the invention in issue” and instructing courts to “guard against slipping into use of hindsight” (citation omitted)). Thus, “[c]are must be taken to avoid hindsight reconstruction by using ‘the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.’” *Grain Processing Corp. v. Am.–Maize Prods. Co.*, 840 F.2d 902, 907 (Fed. Cir. 1988) (quoting *Orthopedic Equip. Co. v. United States*, 702 F.2d 1005, 1012 (Fed. Cir. 1983)).

*ii. Failure to Perform a Graham Analysis*

As Patent Owner points out, the Petition fails to identify sufficiently the differences between any claim of the '859 patent and the asserted prior art references, ABYSS and Denning. *See* Pet. 22–57; Prelim. Resp. 6–7, 42. Rather than address these differences, the Petition creates a hypothetical ABYSS-Denning system—based on how a person of ordinary skill in the art allegedly “would” or “could” combine the two references into an integrated system—in an analysis that is divorced from the language of the challenged '859 patent claims. *See* Pet. 35–43 (§ IV.D). The Petition plucks out certain claim terms “usage rights” and “repositories” and argues that ABYSS and Denning teach these concepts. *See id.* at 44–47 (§ IV.E). The Petition then argues, in conclusory fashion, that this hypothetical system “would” meet each of the limitations of the challenged claims. *See id.* at 47–57 (§ IV.F). This analysis—which compares the challenged claims to a hypothetical integrated system that allegedly implements elements of both ABYSS and Denning as well as the knowledge of one of ordinary skill in the art—obscures any comparison of the individual prior art references to the claim limitations. It does not explain with any particularity which claim limitations are absent from ABYSS or Denning. *See* Prelim. Resp. 6, 42. Therefore, the Petition fails to perform an adequate *Graham* analysis, and leaves us unable to conduct a proper *Graham* analysis as required to determine whether the challenged claims are unpatentable.

Accordingly, we determine that the Petition does not show a reasonable likelihood that Petitioner would prevail in showing that the challenged claims of the '859 patent would have been obvious over ABYSS and Denning. *See*

*Apple Inc. v. SmartFlash LLC*, Case CBM2015-00029, slip op. at 16–18 (PTAB May 28, 2015) (Paper 11) (denying institution of an asserted obviousness ground based on Petitioner’s failure to explain adequately any differences between the asserted prior art and the claimed invention); *Liberty Mut. Ins. Co. v. Progressive Casualty Ins. Co.*, Case CBM2012-00003, slip op. at 3 (PTAB Oct. 25, 2012) (Paper 7) (representative) (“A petitioner who does not state the differences between a challenged claim and the prior art, and relies instead on the Patent Owner and the Board to determine those differences . . . risks having the corresponding ground of obviousness not included for trial for failing to adequately state a claim for relief.”).

*iii. Lack of Adequate Rationale/Improper Hindsight*

As discussed above, Petitioner proposes modifying the system disclosed in ABYSS in light of Denning to achieve an “implemented” system, which Petitioner then reads onto the challenged claims of the ’859 patent. Pet. 37–47 (implementation); *id.* at 47–57 (unpatentability analysis). The Petition asserts that it is making four primary changes to the ABYSS system to achieve its hypothetical implementation. *Id.* at 37–40. Although the Petition provides some rationale and basis, namely an explicit suggestion in the ABYSS reference, for the first of these changes (*id.* at 37–38), the remaining of the changes are justified only as allegedly being “routine” (*id.* at 38) or “obvious implementation choice[s]” (*id.* at 40). For example, the third modification, using public key encryption to encrypt the Right-To-Execute of ABYSS, is justified only because, according to the Petition, “[t]his would allow symmetric supervisor keys to be replaced by public-private pairs and

digital certificates” (*id.* at 39), without any further explanation and with only a citation to the Sherman Declaration (5 pages of it) for support.

Many of these modifications include what appear to be additional modifications that are supported with only the most threadbare reasoning.<sup>6</sup> For example, in the second modification the Petition proposes, i.e., using public-key encryption to protect the integrity of software, the Petition further asserts that a person of ordinary skill “also would have understood that the same technique should be applied to system software, such as updates to the supervisor software that operated the protected processor, as this would improve system integrity.” *Id.* at 38–39. In addition to the problem that Petitioner appears to be trying to obscure the sheer number of changes, this reasoning is deficient. The Petition already explained that the processor in ABYSS is protected. *Id.* at 24. The Petition provides no rationale why a person of ordinary skill would seek additional integrity in this circumstance.

More seriously deficient are the unsupported hidden modifications that appear to litter the section titled, “The Operation of the Implemented System.” Pet. 40–43. In one paragraph, Petitioner proposes that a vendor “operating” the implemented system “could create a Right-To-Execute using the ‘targeted distribution’ technique described in ABYSS,” “could restrict distribution to processors that had a digital certificate issued by a particular authority for the group,” and “could specify a condition that the Right-To-Execute can only be

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<sup>6</sup> To the extent the Sherman Declaration provides additional arguments and explanation not mentioned in the Petition, we need not and do not consider this testimony for the reasons stated above in Part II.A.1.

installed by workstations that have obtained a digitally signed receipt from the vendor.” *Id.* at 40–41. Although some of these choices are contained in different examples in ABYSS, the Petition fails to explain where these choices are and whether they represent the same embodiment of ABYSS. Moreover, the Petition never explains whether a “vendor” is a person of ordinary skill, whether the series of specific operational choices the Petition proposes are necessary to create a system that practices the claimed invention, and why a “vendor” would make all those operational choices or provide some rationale or explanation for operating the system in the manner the Petition proposes.

But even if all these individual modifications, both large and small, and choices that Petitioner contends would be obvious were supported, individually, by articulated reasoning with rational underpinning, nowhere in its analysis in the Petition does Petitioner provide adequate articulated reasoning for making all of these changes at once. Petitioner merely claims that “[e]ach of these would have been an obvious implementation choice for a person of ordinary skill based on the guidance within ABYSS and Denning.” Pet. 40. Petitioner also justifies why a person of ordinary skill would use PKI security generally, but does not explain why a person of ordinary skill would make all of these choices and create the particular implementation that Petitioner has put forward. We see no difference between conclusory statements that these are “design choices,” and stating that these changes are “common sense,” which, without more, is insufficient to support an obviousness analysis. *See Mintz v. Dietz & Watson*, 679 F.3d 1372, 1377 (Fed. Cir. 2012) (“The mere recitation of the words ‘common sense’ without any support adds nothing to the obviousness equation.”). The mere fact that individual changes



might have been minor or even obvious does not make doing all of the changes at once obvious. *See In re Irani*, 427 F.2d 806, 809 (CCPA 1970) (“Obviousness, however, must not be judged by hindsight, and a ‘little modification’ can be a most unobvious one.”).

Without sufficient reason why a person of ordinary skill would engage in, what appears to us to be, a nearly wholesale reconstruction of ABYSS, we conclude that Petitioner is simply using Patent Owner’s claims as a guide in constructing a system loosely based on ABYSS that resembles the claimed invention. *See Plantronics v. Aliph, Inc.*, 724 F.3d 1343, 1355 (Fed. Cir. 2013) (“Where, as here, the necessary reasoning is absent, we cannot simply assume that ‘an ordinary artisan would be awakened to modify prior art in such a way as to lead to an obviousness rejection.’ It is in such circumstances, moreover, that it is especially important to guard against the dangers of hindsight bias.” (citation omitted)); *see also W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1552 (Fed. Cir. 1983) (“The result is that the claims were used as a frame, and individual, naked parts of separate prior art references were employed as a mosaic to recreate a facsimile of the claimed invention. At no point did the district court, nor does Garlock, explain why that mosaic would have been obvious to one skilled in the art . . . .”). This analysis that we determine is infected with impermissible hindsight cannot form the basis of an obviousness finding. *See KSR*, 550 U.S. at 421 (“A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.”); *Graham*, 383 U.S. at 36 (warning against a “temptation to read into the prior art the teachings of the invention in issue” and instructing courts to “guard against

slipping into use of hindsight” (citation omitted)). Because Petitioner has failed to support its obviousness analysis with articulated reasoning with rational underpinning, its obviousness analysis is deficient and cannot establish a reasonable likelihood of success. *See Kahn*, 441 F.3d at 988. Therefore, we determine that the Petition does not establish a reasonable likelihood that Petitioner would prevail in showing that any of the challenged claims of the ’859 patent would have been obvious over ABYSS and Denning.

#### *B. Additional Ground*

Petitioner also argues that the challenged claims would have been obvious over the combination of ABYSS, Denning, and Hartrick. Pet. 57–60. Hartrick, which is relied upon only for teaching “usage rights language” (Pet. 57), does not cure the deficiencies noted above. Thus, Petitioner has failed to establish a reasonable likelihood of success on the ground of obviousness over ABYSS, Denning, and Hartrick, as well.

### III. CONCLUSION

We determine that the Petition fails to show there is a reasonable likelihood that Petitioner would prevail with respect to at least one of the claims challenged in the Petition. *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.108(b)(2).

### IV. ORDER

Accordingly, it is

ORDERED that the Petition is denied and no trial is instituted.

IPR2015-00440  
Patent 6,963,859 B2

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