

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

IKORONGO TECHNOLOGY LLC and IKORONGO TEXAS LLC,
Patent Owner.

IPR2021-00127
Patent RE45,543 E

Before BRYAN F. MOORE, CHARLES J. BOUDREAU, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

BELISLE, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Case Posture

Google LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 32, 34, 36, 38, 39, 41, 43–49, 51, 53–62, 72, and 76 (“Challenged Claims”) of U.S. Patent No. RE45,543 E (Ex. 1001, “the ’543 patent”). Petitioner identifies itself, along with LG Electronics Inc., LG Electronics U.S.A., Inc., Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc., as real parties in interest. Pet. 83. Ikorongo Technology LLC and Ikorongo Texas LLC (collectively “Patent Owner”) identify themselves as the joint owners of the ’543 patent and real parties in interest for Patent Owner (Paper 4, 1), and timely filed a Preliminary Response to the Petition (Paper 8, “Prelim. Resp.”). In addition, with prior authorization from the Board, the parties filed supplemental briefing concerning the Preliminary Response. Paper 11 (“Reply”); Paper 13 (“Sur-Reply”).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314(b) (2018); 37 C.F.R. § 42.4(a) (2020). We may not institute an *inter partes* review “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a).

Applying those standards, and upon consideration of the information presented in the Petition, Preliminary Response, and supplemental briefing, we determine that Petitioner has not demonstrated a reasonable likelihood of prevailing with respect to any of challenged claims 32, 34, 36, 38, 39, 41, 43–49, 51, 53–62, 72, and 76 of the ’543 patent. *See* 35 U.S.C. § 314;

37 C.F.R. § 42.4(a). Accordingly, constrained by the record before us, we deny institution of an *inter partes* review of the '543 patent.

B. Related Proceedings

The parties indicate that the '543 patent is involved in five U.S. district court actions, namely, *Ikorongo Texas LLC v. Bumble Trading Inc.*, No. 6:20-cv-00256 (W.D. Tex.); *Ikorongo Texas LLC v. LG Electronics, Inc.*, No. 6:20-cv-00257 (W.D. Tex.); *Ikorongo Texas LLC v. Lyft, Inc.*, No. 6:20-cv-00258 (W.D. Tex.); *Ikorongo Texas LLC v. Samsung Electronics Co.*, No. 6:20-cv-00259 (W.D. Tex.); and *Ikorongo Texas LLC v. Uber Technologies, Inc.*, No. 6:20-cv-00843 (W.D. Tex.). Pet. 83; Paper 4, 1.

In addition, Patent Owner indicates that the '543 patent is a reissue of U.S. Patent No. 7,080,139, and a different reissue application of that same patent is pending as U.S. Patent Application No. 14/550,100. Paper 4, 1–2. Patent Owner also indicates that another reissue patent (RE47,704) of that same '139 patent is involved in pending IPR2021-00058, and yet another reissue patent (RE41,450) of that same '139 patent is involved in pending IPR2021-00084. *Id.* at 2.

The '543 patent also was involved in *Unified Patents, LLC v. Ikorongo Technology LLC*, IPR2020-01379, Paper 21 (PTAB Feb. 11, 2021), in which the Board denied institution. *See* Pet. 84; Paper 4, 1.

C. The '543 Patent

The '543 patent is titled “Method and Apparatus For Selectively Sharing and Passively Tracking Communication Device Experiences,” and reissued on June 2, 2015, from U.S. Reissue Application No. 13/894,009,

filed May 14, 2013. Ex. 1001, codes (10), (21), (22), (45), (54). The '543 patent, through a series of continuation applications, is a reissue of U.S. Patent No. 7,080,139, issued July 18, 2006, from an application filed April 24, 2001. *Id.* at code (64).

The '543 patent generally relates to “methods and devices for sharing communication device usage experiences, including computer usage experiences.” Ex. 1001, 1:50–52. The '543 patent summarizes the invention as follows:

A common theme among aspects of the present invention is *collecting* data regarding a user's computer usage experience and *sharing* that data. So-called “buddies” identified on buddy lists of instant messaging products can share selected aspects of their computer usage experiences. Administrative tools and processes can be provided to set up selective collection and sharing of data. Collection tools and processes operate on a variety of computer usage activities and user responses to their computer usage experiences. Processing tools and methods filter, integrate and correlate the collected data. Display tools and processes make portions of the data accessible on a pre-defined basis, such as according to defined rights of buddies. Aggregation tools and processes assemble statistics about user experiences across different bases, such as buddy lists, categories of users, and all service participants.

Id. at 2:45–59 (emphases added).

According to the '543 patent, certain embodiments include a “visited location database (‘VLD’),” which “stores . . . information for locations visited by users or participants carrying portable [location-aware] devices.” Ex. 1001, 3:27–31. The VLD may “store geographic information regarding the location, such as geo-coded data,” visited by location-aware devices. *Id.* at 3:44–47. Certain embodiments also include “[a]ccess control lists (‘ACLs’),” which identify “buddies” and control their access to visited

geographic location data stored in the VLD. *Id.* at 4:4–7. The ACL and VLD may interoperate to enable users to control who may have access to geographic information visited by the users’ location-aware devices. *Id.* at 4:4–12, 6:42–52 (“When sharing is on, rights defined in the ACL provide access for buddies to the user’s activity.”), 15:38–16:28. The location-aware devices may rely on “Bluetooth, GPS or any other location detection technology,” and interact with a “location network directory,” which “contains information such as the devices’ location address, location description, a timestamp, and user ID.” *Id.* at 16:52–17:7.

According to the ’543 patent, sharing of communication device user experiences with buddies “may depend on registration by a user with a registration server” (Ex. 1001, 17:42–61) and rely upon “a registration server and a tracking server” (*id.* at 20:1–8). Such shared data may include “visited geographic location data,” which comprises, for example, “visited geographic locations,” “rating[s] assigned to the visited geographic locations,” “comment[s] on the visited geographic locations,” “emoticon[s] assigned to the visited geographic locations,” and “thumbs up rating[s] assigned to the visited geographic locations.” *Id.* at 22:17–31; *see id.* at 17:5–27, 18:61–64 (“Activities related to location may include visiting the location, rating, commenting on it, assigning an emoticon, or connecting with another buddy or buddy of a buddy at the location.”), Fig. 13.

D. Illustrative Claim

Claim 76, reproduced below, is illustrative of the claimed subject matter:

76. A system for collecting and sharing visited geographic location data, comprising:

a location-aware device adapted to:

record geographic location data while visiting geographic locations using a satellite-based location-fixing protocol;

enable access to one or more lists of other users to identify one or more other users with whom the geographic location data may be shared;

enable definition of rights of the one or more other users to access the geographic location data; and

send at least a portion of the geographic location data to a tracking server; and

the tracking server adapted to:

receive the at least a portion of the geographic location data from the location-aware device; and

share the at least a portion of the geographic location data with the one or more other users in accordance with the rights of the one or more other users.

Ex. 1001, 28:48–66.

E. Applied References

Petitioner relies upon the following references:

Callegari, U.S. Patent Application Pub. No. US 2003/0055983 A1 (Ex. 1005, “Callegari”), filed March 19, 2002, published March 20, 2003. Callegari claims priority to U.S. Provisional Patent Application Nos. (i) 60/277,174 (Ex. 1006), (ii) 60/277,187 (Ex. 1007), and (iii) 60/277,200 (Ex. 1008), each filed March 19, 2001. *See* Ex. 1005, code (60).

Friedman, U.S. Patent No. 6,714,791 B2 (Ex. 1009, “Friedman”), filed February 23, 2001, issued March 30, 2004.

Eschenbach, U.S. Patent No. 6,373,429 B1 (Ex. 1010, “Eschenbach”), filed February 6, 2001, issued April 16, 2002.

Pet. 3–14.

F. Asserted Grounds of Unpatentability

Petitioner challenges the patentability of claims 32, 34, 36, 38, 39, 41, 43–49, 51, 53–62, 72, and 76 of the ’543 patent based on the following grounds.

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
76	103(a) ¹	Callegari
32, 34, 36, 39, 41, 43–49, 51, 53–62, 72	103(a)	Callegari, Friedman
38	103(a)	Callegari, Friedman, Eschenbach

Pet. 20. Petitioner relies upon the Declaration of David Hilliard Williams (Ex. 1003).

II. ANALYSIS

A. Applicable Law

Petitioner challenges the patentability of claims 32, 34, 36, 38, 39, 41, 43–49, 51, 53–62, 72, and 76 of the ’543 patent on the grounds that the claims would have been obvious under 35 U.S.C. § 103 in light of various references including: Callegari, Friedman, and Eschenbach. “In an [*inter partes* review], the petitioner has the burden from the onset to show *with particularity* why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 103. Because the ’543 patent was filed before March 16, 2013, the effective date of the relevant amendment, the pre-AIA version of § 103 applies.

each claim”)) (emphasis added). This burden never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof in *inter partes* review).

A claim is unpatentable under 35 U.S.C. § 103 if “the differences between the subject matter sought to be patented 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.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) when of record, objective evidence of obviousness or non-obviousness, i.e., secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). Secondary considerations may include the following: “commercial success, long felt but unsolved needs, failure of others, etc.”² *Id.* The totality of the evidence submitted may show that the challenged claims would not have been obvious to one of ordinary skill in the art. *In re Piasecki*, 745 F.2d 1468, 1471–72 (Fed. Cir. 1984). When evaluating a combination of teachings, we must also “determine whether there was an apparent reason to combine the known elements in the

² Neither party has presented such objective evidence at this stage of the proceeding.

fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

We analyze the challenges presented in the Petition in accordance with the above-stated principles.

B. Level of Ordinary Skill in the Art

Petitioner contends that a person of ordinary skill in the art, at the time of the effective filing date of the ’543 patent:

would have had either: (1) a Bachelor of Science degree in Electrical Engineering or an equivalent field, with at least three years of academic or industry experience in the wireless mobile location industry or comparable industry experience; or (2) a Master of Science degree in Electrical Engineering or an equivalent field, with at least two years of academic or industry experience in the same field. With more education, for example, postgraduate degrees and/or study, less experience is needed to attain an ordinary level of skill in the art. Similarly, more experience can substitute for formal education.

Pet. 19 (internal citations omitted) (citing Ex. 1003 ¶¶ 35–38). Patent Owner does not present an alternative definition at this stage of the proceeding. Prelim. Resp. 23.

We regard Petitioner’s proposed definition as reasonable, and consistent with the prior art before us. *See In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (determining that the Board of Patent Appeals and Interferences did not err in concluding that the level of ordinary skill in the art was best determined by the references of record). Accordingly, we apply the level of skill set forth above, which also is consistent with the testimony of Mr. Williams (Ex. 1003 ¶¶ 35–38).

C. Claim Construction

Neither Petitioner nor Patent Owner proposes any claim terms for construction. Pet. 19; Prelim. Resp. 23. We do not find that the construction of any terms is necessary for this decision. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (“[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.”); *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (applying *Vivid Techs.* in the context of an *inter partes* review).

D. Obviousness Grounds Involving Callegari (Grounds 1–3)

The '543 patent claims an effective filing date of April 24, 2001. Ex. 1001, codes (63), (64); Pet. 3; Prelim. Resp. 3. Petitioner relies on Callegari, solely or in combination with other references, in all asserted grounds of unpatentability, namely Grounds 1 through 3, in the Petition. *See* Section I.F, *supra*. Callegari was filed March 19, 2002, and published March 20, 2003, both *after* the '543 patent's claimed effective filing date, but as noted in Section I.E. above, also claims the benefit of priority to three U.S. Provisional Patent Applications, namely Nos. 60/277,174 (Ex. 1006), 60/277,187 (Ex. 1007), and 60/277,200 (Ex. 1008), each filed March 19, 2001. Ex. 1005, codes (22), (43), (60). Petitioner does not challenge the entitlement of the '543 patent to the claimed April 24, 2001, filing date (Pet. 3), but argues Callegari is 35 U.S.C. § 102(e) prior art to the '543 patent because Callegari allegedly is entitled to the benefit of priority to the filing date of at least U.S. Provisional Patent Application No. 60/277,187

(Ex. 1007, “Callegari ’187 Provisional”).³ Pet. 3–12. Patent Owner argues “Petitioner *did not even allege*, let alone demonstrate, that the relied upon disclosures in Callegari are sufficiently supported in [the Callegari ’187 Provisional] so as to qualify as prior art under pre-AIA § 102(e).”

Prelim. Resp. 2. Based on our review of the record before us, we are persuaded by Patent Owner’s argument and determine that Petitioner has not demonstrated a reasonable likelihood that it would prevail in showing that any of claims 32, 34, 36, 38, 39, 41, 43–49, 51, 53–62, 72, and 76 is unpatentable as obvious over Callegari, alone or in combination with the other asserted references, as discussed below.

1. Applicable Law Regarding Entitlement to the Filing Date of a Provisional Application

A reference patent or published patent application can be entitled to the benefit of its provisional application’s filing date for pre-AIA 35 U.S.C. § 102(e) prior art purposes on two conditions:

First, the provisional application must provide sufficient support for at least one claim in the reference patent or published patent application. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1382 (Fed. Cir. 2015) (“A provisional application’s effectiveness as prior art depends on its written description support for the claims of the issued patent of which it was a provisional.”); *Ex parte Mann*, 2016 WL 7487271, at *6

³ Petitioner contends Callegari is “supported by the provisional applications” (plural) and “entitled to the filing date of its provisional applications” (again, plural), but in its Petition only relies upon and cites to the Callegari ’187 Provisional (Ex. 1007) for such support and entitlement. Pet. 3–11; *see* Prelim. Resp. 3 n.6 (“[T]he Petition does not cite to any disclosures in Ex. 1006 or 1008.”).

(PTAB Dec. 21, 2016) (discussing whether *Dynamic Drinkware* requires “support in the provisional . . . for *all* claims, *any* claim, or something in between.”).

Second, the provisional application must provide sufficient support for the subject matter relied upon for prior art purposes in the reference patent or published patent application. *See In re Giacomini*, 612 F.3d 1380, 1383 (Fed. Cir. 2010) (“[A]n applicant is not entitled to a patent if another’s patent discloses the same invention, which was carried forward from an earlier U.S. provisional application or U.S. non-provisional application.”); *Dynamic Drinkware*, 800 F.3d at 1377, 1381–82 (acknowledging that the Board found Petitioner failed to show the Raymond provisional application supported subject matter relied upon in the Raymond reference, but affirming the Board by also determining that “[n]owhere” does Petitioner show the Raymond provisional application supported claims of the Raymond patent (i.e., the first condition discussed above)); *Ex parte Mann*, 2016 WL 7487271, at *5 (explaining that “[t]his subject matter test is in addition to the comparison of claims required by *Dynamic Drinkware*,” and that “absurd results would be reached if a subject matter test were not required”); *Comcast Cable Commc’ns, LLC v. Promptu Sys. Corp.*, IPR2018-00345, Paper 10 at 25–26 (PTAB July 2, 2018) (agreeing with Patent Owner that Petitioner’s “barebones analysis” in its Petition is insufficient to show “how the [provisional underlying the asserted reference] provides support for the subject matter relied upon [in the asserted reference]”).

This two-prong requirement to show entitlement to the benefit of a provisional application's filing date in the prior art context also is expressly embodied in the MPEP:

The pre-AIA 35 U.S.C. 102(e) date of a reference that did not result from, nor claimed the benefit of, an international application is its earliest effective U.S. filing date, taking into consideration any proper benefit claims to prior U.S. applications under 35 U.S.C. 119(e) or 120. *For all benefit claims, the prior application(s) must properly support the subject matter used to make the rejection* in compliance with pre-AIA 35 U.S.C. 112, first paragraph or 35 U.S.C. 112(a). See MPEP § 2136.02. *In addition, for benefit claims under 35 U.S.C. 119(e), at least one claim of the potential reference must be supported by the written description of the relied upon provisional application* in compliance with pre-AIA 35 U.S.C. 112, first paragraph, or 35 U.S.C. 112(a), in order for the potential reference to be usable as prior art under pre-AIA 35 U.S.C. 102(e) as of a relied upon provisional application's filing date.

MANUAL OF PATENT EXAMINING PROCEDURE ("MPEP"), § 2136(I), Ninth Edition, Rev. 10.2019 (Last Revised June 2020) (emphases added); *see* MPEP § 2136.03(III) (explaining that prior art effect under § 102(e) requires (1) "at least one of the claims in the reference patent . . . is supported by the written description of the provisional application"; and (2) the "provisional application must also describe . . . the subject matter relied upon in the reference patent or publication to make the rejection"); MPEP § 2136, Examples 2, 4, and 7.

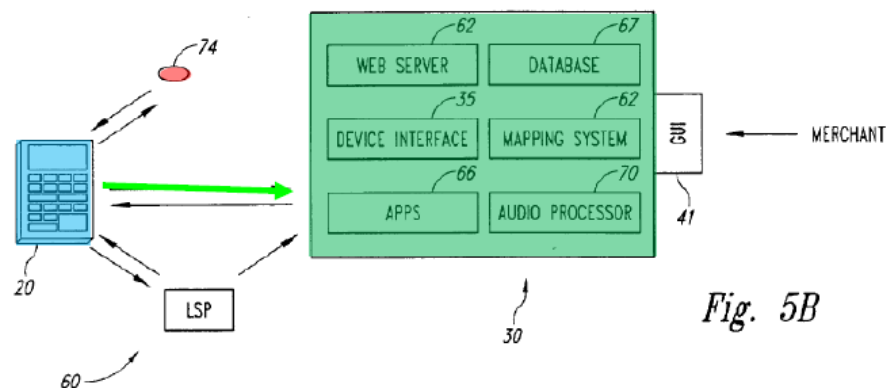
2. *Whether Petitioner Has Shown With Particularity That the Subject Matter Relied Upon in Callegari Is Sufficiently Supported in the Callegari '187 Provisional*

To satisfy the first condition discussed above, Petitioner provides a chart purporting to show how the Callegari '187 Provisional (Ex. 1007)

supports claim 1 of *Callegari* (Ex. 1005). Pet. 4–11. To satisfy the second condition discussed above, in presenting its grounds of unpatentability in the Petition, Petitioner discusses or quotes and provides citations to subject matter purportedly disclosed in *Callegari*, and concurrently lists *unexplained string citations* to the *Callegari* '187 Provisional. See, e.g., Pet. 21–76.

For example, Petitioner contends:

Fig. 5B [below] shows the architecture of *Callegari*'s system. As shown in Figure 5B, *Callegari*'s system enables a mobile consumer device to determine its location via position determining equipment ("PDE") including a "GPS." The PDE "allows the user's location to be tracked" and transmitted periodically from the consumer device to a presence server. *Callegari*, ¶¶[0024], [0044], [0050], [0057]–[0058]; *Ex-1007*, 1, 5, 11, 13-14, 19-20, 25-26, and Fig. 3.



Pet. 21 (emphasis altered). Even were we to agree that Petitioner satisfies the first condition (which we do not address herein), Petitioner's reliance on the *Callegari* '187 Provisional in this example, and throughout the Petition, is deficient in several respects and fails to comply with the second condition, as discussed below.

First, Petitioner relies on Figure 5B of *Callegari*, but Figure 5B *does not appear* in the *Callegari* '187 Provisional. Petitioner instead cites to

Figure 3 of the Callegari '187 Provisional, but that figure is entirely different than Callegari's Figure 5B and is described as a "Buddy Lists Main Setup Page" (Ex. 1007, 40). Petitioner does not explain sufficiently (let alone explain with particularity) how Figure 3 or the many cited disparate pages in the Callegari '187 Provisional sufficiently support the subject matter of Callegari's Figure 5B. Indeed, as argued by Patent Owner, Callegari's Figure 5B is reproduced *ten times* in the Petition in support of various alleged prior art teachings (*see* Pet. 12, 21, 22, 30, 33, 34, 39, 47, 73, and 76), but as noted above, this figure does not appear in the Callegari '187 Provisional and nowhere does Petitioner explain how the Callegari '187 Provisional sufficiently supports the subject matter of this figure (or its associated text). *See* Prelim. Resp. 21.

Second, Petitioner quotes Callegari for teaching a PDE (i.e., position determining equipment) that "allows the user's location to be tracked," which is explicitly recited in cited Callegari paragraph 44. However, based on a word-search, this quoted language does not appear anywhere in the Callegari '187 Provisional. Petitioner also does not explain sufficiently (let alone explain with particularity) how the many cited disparate pages in the Callegari '187 Provisional sufficiently support this quoted language (or the subject matter thereof) in Callegari paragraph 44. *See Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351–52 (Fed. Cir. 2010) (en banc) (while *in haec verba* recitation is not necessary to determine whether an inventor has possession of the claimed subject matter as of the filing date, the disclosure must do more than "merely render[] the invention obvious").

Third, in this example, Petitioner cites as support to *five paragraphs* in Callegari (i.e., paragraphs 24, 44, 50, 57, and 58), but cites to *nine pages*

in the Callegari '187 Provisional (i.e., pages 1, 5, 11, 13, 14, 19, 20, 25, and 26). Petitioner does not explain sufficiently (let alone explain with particularity) how these nine disparate pages in the Callegari '187 Provisional sufficiently support the relied-upon subject matter in the five cited paragraphs in Callegari. More generally, as argued by Patent Owner, Petitioner also does not identify or sufficiently explain any alleged correspondence between citations to Callegari and those to the Callegari '187 Provisional. *See* Prelim. Resp. 25–26 (“For every limitation where Callegari is relied upon, the Petition discusses subject matter allegedly disclosed in Callegari, followed by string citations to Callegari and the '187 provisional application [i.e., the Callegari '187 Provisional]. Yet, the Petition fails to explain how any of the string-cited pages *of the '187 provisional* allegedly rendered obvious the claim language in question.”). Although parallel citations may be sufficient in cases where a provisional application is shown to have identical or nearly identical disclosure to the portions of an application or patent relied upon, in this case, Petitioner has not shown any such identity between Callegari and the Callegari '187 Provisional. *See, e.g., Unified Patents, Inc. v. Longhorn HD LLC*, IPR2020-00879, Paper 10 at 15–16 (PTAB Nov. 12, 2020) (institution decision) (“adequate showing” to support priority where Petitioner “provides parallel citations . . . to demonstrate that the relevant disclosures of [a patent] were carried over from the provisionals [to which the patent claimed priority].”).

Furthermore, based on our review of Callegari and the Callegari '187 Provisional, we find no readily apparent identity between the two documents. Indeed, Callegari, titled “Methods for Providing a Virtual

Journal,” includes 119 numbered paragraphs spanning 13 pages of single-spaced, dual-column, published application text (*see* Ex. 1005), whereas the Callegari ’187 Provisional includes (1) about 30 paragraphs spanning 6 pages of double-spaced, single-column, application text, and (2) a 25-page, stand-alone, article-like document titled, “A Wireless Service Network and Platform for Geolocation Applications and Services: A virtual infrastructure for the physical world” (*see* Ex. 1007). As Patent Owner argues, determining the significance of Petitioner’s citations to the Callegari ’187 Provisional would require us to “play archaeologist with the record,” and we decline to do so. Prelim. Resp. 26 (quoting *DeSilva v. DiLeonardi*, 181 F.3d 865, 866–67 (7th Cir. 1999)). Patent Owner also argues, and we agree, “Patent Owner should not be required to guess as to what Petitioner might have argued had it attempted to explain how the [Callegari ’187 Provisional] *itself* renders the claim language obvious or provides sufficient written description support for the alleged subject matter of Callegari relied upon in the Petition. The Board should not guess either.” *Id.* at 26–27 (citing *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016) (“[W]e find no support for the PTO’s position that the Board is free to adopt arguments on behalf of petitioners that could have been, but were not, raised by the petitioner during an IPR.”)); *see Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, 1286 (Fed. Cir. 2017) (“It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify with particularity the evidence that supports the grounds for the challenge to each claim.” (quoting *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016))).

Fourth, given Petitioner has not shown any identity between Callegari and the Callegari '187 Provisional as discussed above, Petitioner's citations themselves to the Callegari '187 Provisional are unclear. In the foregoing example from the Petition, Petitioner cites to page "1" of Exhibit 1007 (i.e., the Callegari '187 Provisional), but page 1 according to Petitioner's own numbering of the exhibit (i.e., "Page 1 of 44") is a "Provisional Application Cover Sheet," which does not appear to lend any support for the cited and relied-upon subject matter in Callegari. *See* Ex. 1007, 1. This leaves two possibilities—either the inclusion of page 1 in the string cite is erroneous, or Petitioner intends page "1" to refer to the first page of the '187 provisional application as originally marked when filed, which is "Page 5 of 44" of Exhibit 1007. But if Petitioner intends the latter, then, for example, its citation to page "7" (*see* Pet. 30) of the '187 provisional application as originally marked when filed (i.e., "Page 11 of 44" of Exhibit 1007) is unclear, as this page is merely a title page that does not appear to support the relied-upon subject matter in Callegari. *See* Pet. 30–31. As such, we again decline to "play archaeologist with the record" to attempt to decipher the answer here for each of the many citations to Exhibit 1007. *See DeSilva*, 181 F.3d at 866–67; Prelim. Resp. 29 ("It is unclear how [Petitioner's citations to Exhibit 1007] correspond to the actual [Exhibit] 1007. Exhibit 1007 Page 1 is the application data cover sheet and provides no useful disclosure. Page 1 of the application itself (page 5 of the exhibit) does not appear to be relevant at all").

For the foregoing reasons, we determine that Petitioner has not shown that the cited and relied-upon portions of Callegari are entitled to benefit of priority to the filing date of the Callegari '187 Provisional, and therefore, on

this record, that Callegari does not qualify as prior art to the '543 patent. Because each of Petitioner's asserted grounds of unpatentability in the Petition relies on Callegari in whole or in part (*see* Pet. 20–76), we determine that Petitioner has not demonstrated a reasonable likelihood of success in establishing the unpatentability of claim 76 as obvious over Callegari; of claims 32, 34, 36, 39, 41, 43–49, 51, 53–62, or 72 as obvious over the combination of Callegari and Friedman; or of claim 38 as obvious over the combination of Callegari, Friedman, and Eschenbach.

E. Discretionary Denial Under 35 U.S.C. § 314(a)

Because we deny institution upon consideration of the merits of Petitioner's challenges, Patent Owner's argument that we should exercise our discretion under 35 U.S.C. § 314(a) to deny institution is moot.

III. CONCLUSION

Petitioner has not demonstrated a reasonable likelihood of prevailing with respect to any of claims 32, 34, 36, 38, 39, 41, 43–49, 51, 53–62, 72, and 76 of the '543 patent under any of proffered Grounds 1–3.

IV. ORDER

For the reasons given, it is:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review is not instituted for claims 32, 34, 36, 38, 39, 41, 43–49, 51, 53–62, 72, and 76 of U.S. Patent No. RE45,543 E.

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