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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO. Includes application details for 90/014,760 and 94761, 7590, 09/19/2023, listing Hudnell Law Group P.C. as the attorney and Desai, Rachna Singh as the examiner.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KANNUPTY., LTD.
Patent Owner and Appellant

Appeal 2023-003831
Reexamination Control 90/014,760
Patent 8,676,852 B2
Technology Center 3900

Before JOHN A. JEFFERY, KRISTEN L. DROESCH, and
MICHAEL J. ENGLE, *Administrative Patent Judges*.

ENGLE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. §§ 134(a) and 306, Appellant appeals from the Examiner’s rejection of claims 1–22 of U.S. Patent No. 8,676,852 B2 (“’852 patent”). We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

TECHNOLOGY

The ’852 patent relates to “selecting an item from a database,” and more specifically “rapidly selecting items from a list of items identified by a

text field.” ’852 patent, 1:19–23. For example, the Specification discloses “selecting a contact from an address book,” which can be accomplished by “presenting one or more word sections” (e.g., a button showing the letters “An”) and “when a word section is selected, a new list of word sections is presented to form a continuation of the text selection based on the word sections selected so far” (e.g., after the button for “An” is selected, showing new buttons that all start with “An” such as “Andrew” or “Anne”). *Id.* at 1:29–31, 2:49–52, 2:60–67, Figs. 7–9.

ILLUSTRATIVE CLAIM

Claim 1 is illustrative and reproduced below with indentations added:

1. A computer-implemented method of selecting an item from a plurality of items, the method comprising:

generating, by at least one computer processor, a first display, the first display comprises:

a part of an item identifier for at least a first set of items and

a part of an item identifier for at least a second set of items in a database;

enabling, by the at least one computer processor, selection of one of the two parts of the item identifiers by a user using a user interface;

generating, by the at least one computer processor, in response to the selection of the one of the two parts, a further display; wherein the further display comprises:

an additional part of an item identifier for at least a third set of items and an additional part of an item identifier for at least a fourth set of items; and

the previously selected one of the two parts of the item identifiers;

enabling, by the at least one computer processor, selection of one of the two additional parts of the item identifiers by the user using the user interface;

combining, by the at least one computer processor, the selected one of the two parts of the item identifiers with the selected one of the two additional parts of the item identifiers to create a larger part of the item identifiers; and

displaying, by the at least one computer processor, the larger part of the item identifiers; wherein

the parts of the item identifiers and the additional parts of the item identifiers are text symbols and the additional parts of the item identifiers are shorter than complete item identifiers; and

the first set of items identifiers and the second set of item identifiers are mutually exclusive of one another and the third set of item identifiers and the fourth set of item identifiers are mutually exclusive subsets of the first set of item identifiers or the second set of item identifiers.

RELATED PROCEEDINGS

According to Appellant, the '852 patent and four related patents are in pending district court litigation titled *Kannuu Pty., Ltd. v. Samsung Electronics Co.*, No. 1:19-cv-04297 (S.D.N.Y.). Appeal Br. 3. The same five patents have also been involved in the following USPTO proceedings:

Case	Patent	Prior Art	Status
IPR2020-00736	9,697,264 B2	Dostie Krohn Perlman Pu	Institution denied
IPR2020-00737	9,436,354 B2		Claims 1–14 unpatentable Fed. Cir. Appeal 2022-1526
IPR2020-00738	8,370,393 B2		Claims 1–16 unpatentable Fed. Cir. Appeal 2022-1527
IPR2020-00739	8,996,579 B2		Institution denied
IPR2020-00740	8,676,852 B2		Institution denied
90/014,759	9,697,264 B2	Badarneh	PTAB Appeal 2023-003163

Case	Patent	Prior Art	Status
		Dostie Josenhans Krohn Perlman Schroeder	
90/014,760	8,676,852 B2	Badarneh	PTAB Appeal 2023-003831
90/014,761	8,996,579 B2	Josenhans Schroeder	PTAB Appeal 2023-002979

REFERENCES

The Examiner relies on the following references as prior art:

Name	Number	Date
Badarneh	WO 02/091160 A1	Nov. 14, 2002
Josenhans	US 2002/0078013 A1	June 20, 2002
Schroeder	US 5,797,098	Aug. 18, 1998

REJECTIONS

The Examiner makes the following rejections under 35 U.S.C. § 103:

Claims	References	Final Act.
1-4, 6-14, 17-22	Badarneh, Josenhans	3-10
1-10, 12-21 ¹	Schroeder, Josenhans	10-19

ISSUES

1. Did the Examiner err in finding a person of ordinary skill in the art would have had reason to combine Josenhans with either Badarneh or Schroeder as set forth by the Examiner for purposes of claim 1?

¹ We note that claims 15 and 16 are included in the introductory paragraph of the rejection (Appeal Br. 10) but omitted from the subsequent discussion (*see id.* at 10-19). Appellant lists claims 15 and 16 as rejected and does not separately challenge them. *See, e.g.*, Appeal Br. 6. We likewise treat claims 15 and 16 as rejected and leave it to the Examiner to determine if any further analysis of those claims is required.

2. Is the denial of Appellant’s Petition to the Director appealable to the Board?

ANALYSIS

Reason to Combine

Appellant argues “there would not have been a motivation to combine *Josenhans* with either *Badarneh* or with *Schroeder*.” Appeal Br. 8.

Appellant divides this argument into three sub-arguments. Reply Br. 1–2.

First, Appellant argues that “neither of the primary references [i.e., *Badarneh* or *Schroeder*] is ‘deficient’ such that a POSITA would have been motivated to combine either of them with a secondary reference [i.e., *Josenhans*].” Reply Br. 1. According to Appellant, the Examiner “focuses on how the primary references could be improved” by a combination with *Josenhans*, but the Examiner’s analysis “does not contain any discussion of how the primary references are ‘deficient.’” *Id.* at 2.

For its “deficiency” theory, Appellant relies primarily on *Apple Inc. v. Voip-Pal.com, Inc.*, 976 F.3d 1316 (Fed. Cir. 2020). Appeal Br. 7. However, the Federal Circuit in that case never held that a “deficiency” was required in every reason to combine and instead merely addressed the specific reason to combine raised by the petitioner in that case. In particular, the petitioner’s “underlying premise to combine the teachings” was that the first reference’s interface was “less ‘intuitive’ and less ‘user-friendly’” because it “had a dialing deficiency that did not permit short-form phone number dialing” and instead required long and “fully formatted” numbers such as “+1-202-555-1234.” *Apple*, 976 F.3d at 1325. The Board “rejected the premise that [the first reference’s] interface was any less intuitive or

user-friendly” as “conclusory” and instead “credited the unrefuted testimony of [the patent owner’s] expert, . . . who explained that [the first reference’s] operation . . . was not ‘inadequate or unintuitive’” because it “provided all the features of ordinary phones . . . and *in addition*, supported the dialing of private extension numbers.” *Id.* (quotations omitted). The Federal Circuit found “no error in the Board’s decision to credit the opinion of [the patent owner’s] expert” and therefore held “[s]ubstantial evidence supports the Board’s finding that [the first reference] did not disclose a dialing deficiency.” *Id.* at 1325–26. Thus, the petitioner in that case chose to base its combination on an “underlying premise” that the first reference was deficient yet failed to adequately support that argument. At no point, however, did the Federal Circuit hold that *every* motivation to combine in *every* case must show that a prior art reference is “deficient” in some way. Nor would such a requirement be consistent with Supreme Court precedent. *E.g., KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007) (“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

Instead, “[a]ny motivation to combine references, whether articulated in the references themselves or supported by evidence of the knowledge of a skilled artisan, is sufficient to combine those references to arrive at the claimed process.” *Outdry Techs. Corp. v. Geox S.p.A.*, 859 F.3d 1364, 1370–71 (Fed. Cir. 2017). “For the technique’s use to be obvious, the skilled artisan need only be able to recognize, based on her background knowledge, its potential to improve the device and be able to apply the technique.” *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1003 (Fed.

Cir. 2016). Here, the Examiner identified multiple benefits expressly discussed in *Josenhans*. *E.g.*, Ans. 5 (“there is an advantage to searching multiple databases as simply as searching one database in that it is more efficient, faster, convenient, and utilizes low memory capacity and low transferrates”) (citing *Josenhans* ¶¶ 10–12), 6 (further citing *Josenhans* ¶ 13). This satisfies the Examiner’s initial burden.

In the Reply Brief, Appellant alternatively argues that “the paragraphs of *Josenhans* to which the Examiner cites . . . are not advantages of searching multiple databases as compared to a single database (i.e., why searching a single database should be considered a deficiency) but rather are advantages to using *Josenhans*’ particular method for searching multiple databases.” Reply Br. 3. However, “[a]ny argument raised in the reply brief which was not raised in the appeal brief, or is not responsive to an argument raised in the examiner’s answer, . . . will not be considered by the Board for purposes of the present appeal, unless good cause is shown.” 37 C.F.R. § 41.41(b)(2). This is in part because an examiner only has an opportunity to respond to arguments in an appeal brief, not a reply brief. Here, Appellant has not shown good cause, so we do not consider its new arguments in the Reply Brief. Nevertheless, we note that this argument fails to rebut that Badarneh or Schroeder would be improved by “*Josenhans*’ particular method.”

Thus, Appellant’s “deficient” argument is insufficient to persuade us of error in the Examiner’s findings that Badarneh or Schroeder would be improved by *Josenhans*.

Second, Appellant argues that “*Josenhans* addresses an entirely different problem than the two primary references and the challenged patent” because it “pertains to the problem of how to search across multiple devices,” not “speeding up entry of a search query.” Appeal Br. 8.

We are not persuaded by Appellant’s argument because it again applies the wrong test. “The scope of the prior art includes all analogous art.” *Donner Tech., LLC v. Pro Stage Gear, LLC*, 979 F.3d 1353, 1359 (Fed. Cir. 2020). “Prior art is analogous where . . . the art is from the same field of endeavor, *regardless of the problem addressed . . .*” *In re Ethicon, Inc.*, 844 F.3d 1344, 1349 (Fed. Cir. 2017) (quotation omitted) (emphasis added). “In evaluating whether a reference is analogous, we have consistently held that a patent challenger must compare the reference to the challenged patent,” not the other prior art references. *Sanofi-Aventis Deutschland GmbH v. Mylan Pharms. Inc.*, 66 F.4th 1373, 1377 (Fed. Cir. 2023).

Here, the Examiner explains that “*Josenhans* discloses simultaneous access to two or more databases in order to perform a search.” Ans. 5. For example, *Josenhans* discloses that its “invention relates to a method for searching for data in at least two databases . . . , in particular for searching for telephone directory, address book or appointments diary entries or the like in at least two telephone directory, address book or appointments diary databases.” *Josenhans*, Abstract. Moreover, *Josenhans* discloses a preferred embodiment of performing this search on a “mobile telephone.” *Id.* ¶ 22.

Similarly, the ’852 patent discloses that it relates to “selecting database items from a database,” and just like *Josenhans*, the ’852 patent

discusses a preferred embodiment of “selection of a contact from an address book of a mobile telephone.” ’852 patent, Abstract, 4:11–13.

Even if Appellant were right that Josenhans and the ’852 patent were directed to solving slightly different problems within the context of searching address books on mobile phones, the Federal Circuit is clear that “[t]he field of endeavor of a patent is not limited to the specific point of novelty, the narrowest possible conception of the field, or the particular focus within a given field.” *Unwired Planet*, 841 F.3d at 1001. Thus, Appellant fails to provide sufficient evidence that Josenhans is not in the same field of endeavor as the ’852 patent. Appellant therefore fails to persuade us that it would not have been obvious to a person of ordinary skill in the art to combine these improvements to the same field of endeavor.

Third, Appellant argues:

the Office Action relies solely on the primary references [Badarneh or Schroeder] for the limitation “. . . the first set of items identifiers and the second set of item identifiers are mutually exclusive of one another.” Given that this and other similar limitations were deemed to be satisfied by the primary references with no discussion of Josenhans and given that the primary references do not disclose the “second set of item identifiers,” Patent Owner respectfully suggests that this is another reason that all claims should be confirmed.

Appeal Br. 9; *see also* Reply Br. 5. Appellant categorizes this as a “sub-argument” against the “reason to combine” Josenhans with either Badarneh or Schroeder. Reply Br. 1–2. However, it is unclear how this relates to any reason to combine analysis.

Regardless, even if we treated this as an argument that the references fail to teach or suggest certain limitations, it is not persuasive because

“[n]on-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references.” *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). For teaching “mutually exclusive,” the Examiner relies on Badarneh or Schroeder, not Josenhans; conversely, for teaching multiple databases, the Examiner relies on Josenhans, not Badarneh or Schroeder. Ans. 8 (“Badarneh or Schroeder are relied upon to disclose the first and second item identifiers are mutually exclusive of one another; whereas, Josenhans is relied upon to teach simultaneous access to two or more databases in order to perform a search in which two sets of identifiers may exist in separate databases.”). Appellant arguing each reference individually does not address the Examiner’s *combination* of these references. *Id.*

Accordingly, we sustain the Examiner’s rejections of claims 1–22, which Appellant does not argue separately. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Denial of Petition to the Director

Appellant previously “filed a Petition to the Director under 37 C.F.R. section 1.181 . . . requesting that the Director vacate the ex parte reexaminations” based on Samsung’s prior petitions for *inter partes* review. Appeal Br. 9. Appellant’s petition was denied by “a Senior Patent Attorney in the Office of Patent Legal Administration” (“OPLA”) on February 23, 2022. *Id.* Appellant argues that because the petition was decided after “Director Iancu already had left” but before “Director Vidal had . . . been appointed,” “[t]he absence of a Constitutionally appointed Director during this period is significant in light of . . . *U.S. v. Arthrex, Inc.*, 141 S. Ct. 1970 (2021).” *Id.* According to Appellant, “the issue here is not whether

authority to consider the Petition was properly delegated” to the OPLA but rather “whether any properly delegated authority was exercised under the direction and supervision of a Constitutionally appointed Director.” *Id.* at 10. Appellant argues “it would be appropriate for the Board to remand the matter to the Examiner so that Director Vidal can consider Kannuu’s Petitions” or “for Director Vidal to exercise her unilateral discretion under 37 C.F.R. 41.35 to enter an order *sua sponte* remanding the proceeding to the Examiner and for the Director to then consider Kannuu’s Petitions.” *Id.*

The Examiner responds that “[t]his is not an appealable issue and is outside the merits of this appeal and thus will not be addressed further by the Examiner.” Ans. 9.

We agree with the Examiner. The Board has limited jurisdiction as established by Congress or delegated by the Director. The statutory basis for jurisdiction in *ex parte* reexaminations comes from 35 U.S.C. §§ 6(b) and 306, which authorize the Board to “review appeals of reexaminations pursuant to section 134(b).” Under 35 U.S.C. § 134(b), “[a] patent owner in a reexamination may appeal from the final rejection of any claim by the primary examiner to the Patent Trial and Appeal Board.” However, a denial of a petition to the Director is *not* a final rejection of the claims, and thus there is no statutory basis for the Board to hear this issue.

In addition to jurisdiction statutes set by Congress, the Board can also decide matters that have been properly delegated to it by, for example, the Director or Chief Judge. In *ex parte* reexamination, authority has been delegated to Board panels to review an examiner’s determination of a substantial new question of patentability if certain procedural requirements

have been met. *See* MPEP §§ 2274(VI), 1002.02(f). However, Appellant’s petition to the Director is not challenging a determination of a substantial new question of patentability, nor has Appellant met the procedural requirements for such an argument. Thus, there is no readily apparent delegation of authority to hear Appellant’s issue.

Appellant argues that the Examiner has offered no explanation why this issue is not appealable (*see* Reply Br. 5), but the burden of establishing jurisdiction generally rests on the party invoking that jurisdiction, which here is Appellant, not the Examiner. *See, e.g., Cardinal Chem. Co. v. Morton Int’l, Inc.*, 508 U.S. 83, 98 (1993) (“the initial burden of establishing the trial court’s jurisdiction rests on the party invoking that jurisdiction”); *McNutt v. Gen. Motors Acceptance Corp. of Ind.*, 298 U.S. 178, 182 (1936) (“It is incumbent upon the plaintiff properly to allege the jurisdictional facts”); *Grit Energy Sols., LLC v. Oren Techs., LLC*, 957 F.3d 1309, 1319 (Fed. Cir. 2020) (“As the party invoking federal jurisdiction, Grit Energy bears the burden of establishing standing” “in an appeal from a final written decision in an inter partes review” from the Board). Appellant offers no basis—whether by statute, delegation, or otherwise—for why the Board has jurisdiction to address a denial of a petition to the Director.

As the Manual of Patent Examining Procedure explains:

The line of demarcation between appealable matters for the Board and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director) should be carefully observed. The Board will not ordinarily hear a question that should be decided by the Director on petition, and the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board.

MPEP § 1201.

Similarly, the Board will not hear or decide issues pertaining to objections and formal matters which are not properly before the Board. These formal matters should not be combined in appeals to the Board.

MPEP § 706.01.

Contrary to Appellant’s assertions, the issue here is not *whether* Appellant has an “avenue for raising an Appointments Clause violation” (Reply Br. 6), but rather *who* can hear such a challenge. Appellant may well be able to raise this issue in a petition *to the Director*, an appeal *to the Federal Circuit*, or a challenge *in a federal district court*. See, e.g., *In re Vivint, Inc.*, 14 F.4th 1342, 1346–48 & n.1 (Fed. Cir. 2021) (addressing on appeal *to the Federal Circuit* both the Board’s affirmance of a final rejection that “did not address § 325(d)” and the OPLA’s denial of a “§ 1.181 petition raising 35 U.S.C. § 325(d)”). Rather, the issue here is that Appellant has provided no basis for *the Board* to hear on appeal a denial of a petition to the Director.

OUTCOME

The following table summarizes the outcome of each rejection:

Claim(s) Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–4, 6–14, 17–22	103	Badarneh, Josenhans	1–4, 6–14, 17–22	
1–10, 12–21	103	Schroeder, Josenhans	1–10, 12–21	
Overall Outcome			1–22	

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TIME TO RESPOND

Requests for extensions of time in this *ex parte* reexamination proceeding are governed by 37 C.F.R. § 1.550(c). *See* 37 C.F.R. § 41.50(f).

AFFIRMED

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