



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Table with columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO., EXAMINER, ART UNIT, PAPER NUMBER, MAIL DATE, DELIVERY MODE. Includes application details for 90/014,759 and 94761, 7590.

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KANNUPTY., LTD.
Patent Owner and Appellant

Appeal 2023-003163
Reexamination Control 90/014,759
Patent 9,697,264 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 1–18 of U.S. Patent No. 9,697,264 B2 (“’264 patent”). We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

TECHNOLOGY

The ’264 patent relates to “selecting an item from a database,” and more specifically “rapidly selecting items from a list of items identified by

an informational field.” ’264 patent, 1:26–30. For example, the Specification discloses displaying “parts of item identifiers for selection” and “in response to selection of the one or more parts, . . . enabling selection of . . . further . . . parts . . . to build a larger part.” *Id.* at 2:56–64.

ILLUSTRATIVE CLAIM

Claim 1 is illustrative and reproduced below:

1. A method of selecting items from at least two collections of items, said at least two collections of items being individually indexed by a list of respective item identifiers, the method comprising:

generating, on a device, an initial display including a plurality of parts of said item identifiers for selection, wherein said plurality of parts of said item identifiers include at least one part of an item identifier corresponding to a first collection of items and at least one part of an item identifier corresponding to a second collection of items;

enabling selection of one of said plurality of parts of said item identifiers;

identifying, based at least in part on the part of the item identifier selected, which of the at least two collections of items the selected part of the item identifier corresponds to;

generating, on said device, a display of a further plurality of parts of said item identifiers for selection in response to selection of said one of said plurality of parts of said item identifiers, wherein said further plurality of parts of item identifiers include at least one further part of said item identifiers corresponding to the one or more collections of items identified based on the selection of said one of said plurality of parts of said item identifiers; and

enabling selection of one of said further plurality of parts of said item identifiers in order to add to said selected one of said

plurality of parts of said item identifiers to build a larger part or whole of said selected item identifier;

wherein generating said initial display comprises selecting said one or more parts of said item identifiers to be displayed based on a dynamic prioritization scheme that adjusts priorities of said item identifiers based on the number of times a particular item identifier from said list of item identifiers was previously selected.

RELATED PROCEEDINGS

According to Appellant, the '264 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, and the three PTAB appeals involve substantially similar arguments.

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 Dostie Josenhans Krohn Perlman Schroeder	PTAB Appeal 2023-003163
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
Dostie	US 2004/0021691 A1	Feb. 5, 2004
Josenhans	US 2002/0078013 A1	June 20, 2002
Krohn	US 6,593,913 B1	July 15, 2003
Perlman	US 2002/0113825 A1	Aug. 22, 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.
1–8, 11, 12, 15–18	Perlman, Dostie, Josenhans	10–25
9, 10	Perlman, Dostie, Josenhans, Krohn	25–27
13, 14	Perlman, Dostie, Josenhans, Badarneh	27–28
1–6, 8, 11–15, 17, 18	Badarneh, Josenhans	28–39
1–6, 8, 11, 16, 17	Schroeder, Josenhans	40–57

ISSUES

1. Did the Examiner err in finding a person of ordinary skill in the art would have had reason to combine (A) Perlman with Dostie and (B) Josenhans with the other references, as set forth by the Examiner for purposes of claim 1?

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

ANALYSIS

Reason to Combine Perlman with Dostie

The Examiner finds that “[i]t would have been obvious to incorporate Dostie’s tree structure into Perlman . . . because Dostie itself recognizes that

use of a candidate tree helps ‘to rapidly predict potential completion candidates’ and ‘provides a mechanism for supporting enhanced data entry techniques such as character prediction.’” Ans. 4 (citing or quoting Forlines Decl.; Dostie ¶ 97). According to the Examiner, these are “the same techniques described by Perlman, so a POSITA would have found it natural to incorporate Dostie’s candidate tree into the character selection system of Perlman.” *Id.* (citing or quoting Forlines Decl.).

Appellant argues that “one of skill in the art would not have sought to utilize hierarchical trees with the system described by *Perlman*” because “*Perlman* is not deficient without hierarchical trees.” Appeal Br. 7; *see also* Reply Br. 2. According to Appellant, “there is not a motivation to combine when a reference is not ‘deficient.’” Appeal Br. 6. Appellant contends that “Perlman’s approach is *different* from using a hierarchical tree” and “[t]here are advantages and disadvantages to different methods of processing the database items, and creating an interim, derivative list or tree is just one method.” Reply Br. 3; Appeal Br. 7.

For its “deficiency” theory, Appellant relies primarily on *Apple Inc. v. Voip-Pal.com, Inc.*, 976 F.3d 1316 (Fed. Cir. 2020). Appeal Br. 6. 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. Instead, “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007).

Here, Appellant does not dispute that Dostie’s trees were a known method with predictable results. Moreover, the Examiner finds that “using the trees of Dostie” is not a “change” but rather “a use of a known means for effecting the features described in Perlman.” Ans. 5. “At the time of Perlman, this form of search was almost always performed using a hierarchical search tree” and “[b]ecause of the well-known benefits of using

hierarchical search trees to search a database, these trees would have been ‘a trivial and routine addition’ to Perlman that would have permitted simple and efficient searching based on a known prefix of database entries.” *Id.* at 6.

Even if we were to agree with Appellant that Perlman’s approach was “different” from Dostie’s trees, Appellant expressly acknowledges that this is merely a tradeoff with “advantages and disadvantages to different methods.” Appeal Br. 7. “The fact that the motivating benefit comes at the expense of another benefit, however, should not nullify its use as a basis to modify the disclosure of one reference with the teachings of another. Instead, the benefits, both lost and gained, should be weighed against one another.” *Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 n.8 (Fed. Cir. 2000). Yet Appellant does not sufficiently address the balancing of any tradeoffs here, particularly in light of the Examiner’s findings that any modifications would be minor and intuitive.

Thus, Appellant’s “deficient” argument is insufficient to persuade us of error in the Examiner’s combination of Perlman with Dostie.

Appellant also argues that “the problems presented by *Perlman* are quite unlike those presented in *Dostie*” because “*Dostie* relates to the challenges of using pen-based computing systems” rather than “remote controllers using up, down, left, right directional keys.” 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); *see also* Ans. 7–8. “Prior art is analogous where . . . the art

Appeal 2023-003163
Reexamination Control 90/014,759
Patent 9,697,264 B2

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 ’264 patent discloses it relates to “selecting items from a collection of items . . . indexed by a list of item identifiers,” and it discusses embodiments on “a mobile telephone.” ’264 patent, Abstract, 4:5–10; *see also id.* at Title (“SELECTING AN ITEM FROM A DATABASE”), 8:1–4.

Dostie similarly discloses that with its invention, “a user can rapidly enter and search for data, such as text,” and similarly discloses embodiments on “mobile telephones” or “a personal digital assistant.” Dostie, Abstract, ¶ 73.

To the extent Appellant seeks to limit Dostie to input using a “pointing device” such as a stylus or finger (Appeal Br. 8), 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, LLC v. Google Inc.*, 841 F.3d 995, 1001 (Fed. Cir. 2016). Moreover, “[a] reference must be considered for everything that it teaches, not simply the described invention or a preferred embodiment.” *In re Applied Materials, Inc.*, 692 F.3d 1289, 1298 (Fed. Cir. 2012). The hierarchical trees of Dostie relied upon by the Examiner are not tied to or limited to pointing devices. Regardless, the ’264

patent also discloses “embodiments[] where the device has a touch screen, such as, for example, on a PDA or Tablet PC . . . pointing at the labels with either a finger or stylus.” ’264 patent, 4:1–4; *see also* Dostie ¶71 (“pointing devices . . . include, by way of example, a pen, stylus, or finger”). Thus, Appellant fails to provide sufficient evidence that Dostie is not in the same field of endeavor as the ’264 patent or that Dostie’s teachings on hierarchical trees should otherwise be limited to pointing devices outside the scope of the ’264 patent.

Finally, Appellant argues that certain benefits (e.g., “rapidly predict potential completion candidates” and “supporting enhanced data entry techniques such as character prediction and the rapid navigation system 32”) “do[] not concern combining the method of *Dostie* with those of others, but is an internal reference to the method disclosed in *Dostie* itself.” Appeal Br. 8. Appellant fails to sufficiently explain this argument. As set forth by the Examiner, Dostie’s hierarchical trees help achieve such rapid navigation, and Appellant has not explained sufficiently how those benefits would not apply to the Examiner’s proposed combination. *See* Ans. 4–6.

Reason to Combine with Josenhans

Appellant also argues “none of [the other cited references] have deficiencies that a POSITA would have sought to fix by looking to *Josenhans*.” Appeal Br. 8–9. This again relies upon Appellant’s assertion that “[u]nder the *Apple v. VOIP-Pal.com* case, the lack of a deficiency precludes the motivation to combine.” *Id.* This is not persuasive for the reasons discussed above, including because it misstates the holding in *Apple v. Voip-Pal.com* and the test required.

To the contrary, the Federal Circuit has held that “[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*, 841 F.3d at 1003. Here, the Examiner identified benefits expressly discussed in *Josenhans*. *E.g.*, Ans. 8–10 (citing *Josenhans* ¶ 10). This satisfies the Examiner’s initial burden.

Next, Appellant argues that “*Josenhans* addresses an entirely different problem than the cited 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. 9. Further, Appellant argues *Josenhans* is not necessarily related to “character prediction” or a “text entry technique.” *Id.* at 9–10.

As discussed above, however, the test for analogous art “must compare the reference to the challenged patent,” *Sanofi-Aventis*, 66 F.4th at 1377, and “[p]rior art is analogous where . . . the art is from the same field of endeavor, *regardless of the problem addressed.*” *Ethicon*, 844 F.3d at 1349 (quotation omitted) (emphasis added).

“[H]ere *Josenhans* clearly teaches ‘a method for searching for data in at least two databases’, while appreciating the benefit of searching all databases at the same time rather than each individually.” Ans. 8–9 (citing

Josenhans ¶¶ 1, 9, 10). 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 ’264 patent discloses that it relates to “selecting items from a collection of items . . . indexed by a list of item identifiers,” and just like Josenhans, the ’264 patent discusses embodiments on “a mobile telephone.” ’264 patent, Abstract, 4:5–10; *see also id.* at 8:1–4.

Even if Appellant were right that Josenhans and the ’264 patent were directed to solving slightly different problems within the context of searching databases 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 ’264 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.

Regardless of whether Perlman, Badameh, or Schroeder alone disclose searching multiple databases (*see* Appeal Br. 10–11), the Examiner relies on Josenhans for teaching multiple databases (Ans. 8–9), and

Appeal 2023-003163
Reexamination Control 90/014,759
Patent 9,697,264 B2

Appellant fails to persuade us those combinations of references would not have been obvious.

Accordingly, we sustain the Examiner's rejections of claims 1–18, 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. 12. 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 13. 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.* at 12–13.

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

Ans. 17.

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 any claim by the primary examiner,” 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

Appeal 2023-003163
Reexamination Control 90/014,759
Patent 9,697,264 B2

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. 5–6), 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) (discussing on appeal *to the Federal Circuit* the OPLA’s denial of a “§ 1.181 petition raising 35 U.S.C. § 325(d)” in addition to addressing the Board’s affirmance of a final rejection that “did not address § 325(d)”). But Appellant has not shown that *the Board* can hear an appeal from OPLA’s 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
1–8, 11, 12, 15–18	103	Perlman, Dostie, Josenhans	1–8, 11, 12, 15–18	
9, 10	103	Perlman, Dostie, Josenhans, Krohn	9, 10	
13, 14	103	Perlman, Dostie, Josenhans, Badarneh	13, 14	
1–6, 8, 11–15, 17, 18	103	Badarneh, Josenhans	1–6, 8, 11–15, 17, 18	
1–6, 8, 11, 16, 17	103	Schroeder, Josenhans	1–6, 8, 11, 16, 17	
Overall Outcome			1–18	

REQUESTS FOR EXTENSIONS OF TIME

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

Appeal 2023-003163
Reexamination Control 90/014,759
Patent 9,697,264 B2

APPELLANT:

HUDNELL LAW GROUP P.C.
800 WEST EL CAMINO REAL, STE 180
MOUNTAIN VIEW, CA 94040

THIRD PARTY REQUESTER:

MARISSA DUCCA, ESQ.
QUINN EMANUEL URQUHART & SULLIVAN LLP
1300 I Street NW, Suite 900
Washington, DC 20005