Takeaway: Referring to an exhibit that includes simple shorthand identifiers for limitations in the claims was not found to be an improper incorporation by reference.

The Board began its analysis by disagreeing with Patent Owner’s argument that the Petition should be denied because it generally does not comply with the Board’s rules. Specifically, the Board stated that “Petitioner’s use of a separate, four page exhibit, which provides a simple shorthand identifier for each limitation in the independent claims, is not impermissible incorporation by reference,” because there was no substantive argument or evidence in that exhibit to be incorporated by reference. The Board also did not agree that the Petition failed to account for differences in the claim language. Finally, the Board did not agree that citing to single paragraphs of a declaration was improper incorporation by reference.

Regarding claim construction, the Board agreed with Petitioner that the terms should be construed in a manner similar to the previously decided related IPR proceedings for this and related patents.

The Board analyzed each alleged ground of unpatentability. The Board determined that Patent Owner’s arguments against obviousness in each of the grounds of unpatentability were generally directed to the issue of whether it would have been obvious to one of ordinary skill in the art to combine the teachings of the references cited by Petitioner. Disagreeing with Patent Owner, the Board found that Petitioner articulated reasoning with sufficient rational underpinnings to support its allegations of obviousness. The Board noted that the specifications of the ’822 patent and the prior art were written at a high, functional level, without presenting much, if any technical explanation for the particular software and hardware works, and that this weighs toward a conclusion of obviousness. Accordingly, the Board found that Petitioner had shown a reasonable likelihood that it would prevail in showing that claims 1-29 of the ’822 patent are unpatentable.
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