

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

KEWAZINGA CORP.,
Patent Owner.

IPR2021-00527
Patent 9,055,234 B2

Before PATRICK M. BOUCHER, JOHN D. HAMANN, and
STACY B. MARGOLIES, *Administrative Patent Judges*.

HAMANN, *Administrative Patent Judge*.

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

I. INTRODUCTION

Google LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 4–7, 9, 12, 17, 19, 20, 22, 24, 27, and 30 of U.S. Patent No. 9,055,234 B2 (Ex. 1001, “the ’234 patent”) pursuant to 35 U.S.C. § 311. Kewazinga Corp. (“Patent Owner”) filed a Patent Owner Preliminary Response (Paper 11, “Prelim. Resp.”). With our authorization (Paper 13), Petitioner filed a Preliminary Reply (Paper 14, “Prelim. Reply”) and Patent Owner filed a Preliminary Sur-reply (Paper 15, “Prelim. Sur-reply”), addressing, *inter alia*, discretion under 35 U.S.C. § 325(d).

Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any response . . . 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.” 35 U.S.C. § 314(a); *see* 37 C.F.R. § 42.108 (2020). Having considered the Petition, Preliminary Response, Preliminary Reply, and Preliminary Sur-reply, and evidence of record, for the reasons below, we exercise our discretion to deny institution of an *inter partes* review of the ’234 patent under 35 U.S.C. § 325(d).

A. Real Party-in-Interest

Petitioner identifies itself as the real party-in-interest. Pet. 2. Petitioner also states that “Google LLC is a subsidiary of XXVI Holdings Inc., which is a subsidiary of Alphabet Inc.,” and that “XXVI Holdings Inc. and Alphabet Inc. are not real parties in interest to this proceeding.” *Id.* at 2 n.1. Patent Owner identifies itself as the real party-in-interest. Paper 9, 1.

B. Related Matters

The parties identify the following district court proceedings in which the ’234 patent is asserted and which may affect, or be affected by, a

decision in this proceeding: *Kewazinga Corp. v. Google LLC*, 1:20-cv-01106-LGS (S.D.N.Y.) and *Kewazinga Corp. v. Microsoft Corp.*, 1:18-cv-04500-GHW (S.D.N.Y.). Pet. 2; Paper 9, 1. In addition, the parties collectively identify the following matters pending in front of the Board: (i) IPR2021-00524, which challenges claims 1–3, 8, 10–16, 18, 21, 23, 25, 26, 28, and 29 of the ’234 patent; and (ii) IPR2021-00525 and IPR2021-00526, which challenge patents related to the ’234 patent. Pet. 2, 1; Paper 9, 1.

C. Family History of the Challenged Patent

The ’234 patent issued from Application No. 14/505,208, which is a continuation of Application No. 13/949,132, which is a continuation of Application No. 12/610,188, which is a continuation of Application No. 11/359,233 (issued as U.S. Pat. No. 7,613,999), which is a continuation of Application No. 10/308,230, which is a continuation of Application No. 09/419,274 (issued as U.S. Pat. No. 6,522,325 (the “’325 patent”)), which is a continuation-in-part of Application No. 09/283,413 (issued as U.S. Pat. No. 6,535,226 (the “’226 patent”)). Ex. 1001, codes (21), (63), 1:7–21.

D. The Challenged Patent

The ’234 patent relates generally to a telepresence method and system that “permits one or more users to navigate through imagery of an environment.” Ex. 1001, 3:9–11. The ’234 patent discloses that, to provide this functionality, the “system receives electronic imagery of progressively different perspectives of the environment having overlapping fields of view and generates electronic mosaic imagery from the electronic imagery of the environment.” *Id.* at 3:18–22, 3:30–32, 4:45–51. The ’234 patent further discloses performing “image output mixing, such as mosaicing and tweening” to enable “seamless motion throughout the environment.” *Id.* at

4:54–56. “[M]osaicing” refers to a process in which a mosaic is generated from a plurality of images, and “tweening” enables the structure of a view to be processed from two or more camera outputs of the view. *Id.* at 17:31–36, 17:64–18:4.

Figure 1 of the ’325 patent is reproduced below.

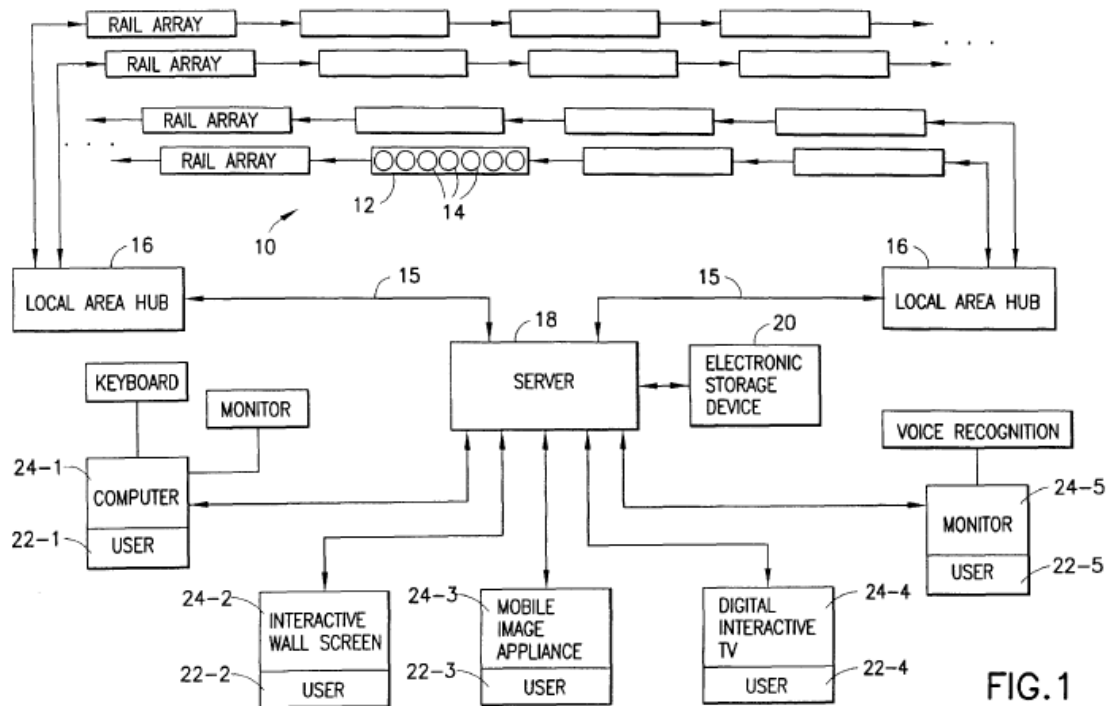


Figure 1 provides an overall schematic of a telepresence system. *Id.* at 3:36–37. The ’234 patent discloses that “telepresence system 100 generally includes an array 10 of cameras 14 coupled to a server 18, which in turn is coupled to one or more users 22 each having a user interfaced/display device 24.” *Id.* at 4:67–5:3. The ’234 patent also discloses that “[t]he output from the microcameras 14 are coupled to the server 18” and that “coupled to the server 18 is an electronic storage device 20.” *Id.* at 5:35–37, 5:48–49. The ’234 patent adds that “[t]he server 18 transfers the outputs to the electronic storage device 20.” *Id.* at 5:49–50.

In one embodiment, the '234 patent discloses that “user inputs allow each user 22 to move or navigate independently through the array 10.” *Id.* at 6:32–34. More particularly, the '234 patent discloses that “[t]he user inputs allow each user to not only select particular cameras, but also to select relative movement or navigational paths through the array 10.” *Id.* at 6:39–42. In another embodiment, the '234 patent discloses that “[n]avigation is effectuated by accessing the input of the storage nodes by a user interface device 24.” *Id.* at 24:12–13; *see also id.* at 23:50–53. The '234 patent further discloses the following:

[I]t is to be understood that virtually any configuration of rails 12 and cameras 14 is within the scope of the present invention. For example, the array 10 may be a linear array of cameras 14, a 2-dimensional array of cameras 14, a 3-dimensional array of cameras 14, or any combination thereof. Furthermore, the array 10 need not be comprised solely of linear segments, but rather may include curvilinear sections.

The array 10 is supported by any of a number of support means. For example, the array 10 can be fixedly mounted to a wall or ceiling; the array 10 can be secured to a moveable frame that can be wheeled into position in the environment or supported from cables.

Id. at 7:43–56; *see also id.* at 24:46–49 (disclosing that camera arrays 12 “may be other shapes other than cylindrical” and that “it is not essential . . . that the camera arrays 12 surround the entire environment”).

E. The Challenged Claims

Petitioner challenges claims 4–7, 9, 12, 17, 19, 20, 22, 24, 27, and 30 of the '234 patent. Claims 1 and 13 are independent claims, from which the challenged claims depend. Claim 1 is illustrative of the challenged claims and is reproduced below:

1. A system for providing at least a first user with a first view of multiple locations through a remote environment and a second

user with a second view of multiple locations through the environment, the first view being different than the second view, the system comprising:

- one or more electronic storage devices;
- one or more processing elements configured to:
 - receive, from a first user interface device associated with the first user, first user inputs associated with the first view through the environment;
 - receive, from a second user interface device associated with the second user, second user inputs associated with the second view through the environment;
 - store electronic imagery of progressively different perspectives of the environment having overlapping fields of view in the one or more electronic storage devices;
 - generate mosaic imagery from the electronic imagery of the environment;
 - based on the first user inputs, sequentially provide to the first user interface device mosaic imagery along the first view, thereby allowing the first user to navigate along the first view of the environment;
 - based on the second user inputs, sequentially provide to the second user interface device mosaic imagery along the second view, thereby allowing the first user and second user to navigate simultaneously and independently along the first view and second view of the environment, respectively.

Ex. 1001, 25:7–34.

F. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability:

Claim(s) Challenged	35 U.S.C. §¹	Reference(s)/Basis
4, 9	103(a)	Moezzi-1, ² Moezzi-2, ³ Kellogg ⁴
5	103(a)	Moezzi-1, Moezzi-2, Kellogg, Peleg ⁵
6	103(a)	Moezzi-1, Moezzi-2, Kellogg, Kumar ⁶
7	103(a)	Moezzi-1, Moezzi-2, Kellogg, Kumar, Hanna ⁷
12	103(a)	Moezzi-1, Moezzi-2, Kellogg, Conley ⁸
17, 27	103(a)	Moezzi-1, Moezzi-2
22	103(a)	Moezzi-1, Moezzi-2, Peleg, Taylor ⁹
24	103(a)	Moezzi-1, Moezzi-2, Peleg, Lewis ¹⁰
19	103(a)	Moezzi-1, Moezzi-2, Kumar
20	103(a)	Moezzi-1, Moezzi-2, Kumar, Hanna
30	103(a)	Moezzi-1, Moezzi-2, Conley

¹ The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. §§ 102, 103 that became effective on March 16, 2013. Because the ’234 patent issued from an application having an effective filing date before March 16, 2013, we apply the pre-AIA version of the statutory basis for unpatentability.

² US 5,745,126, issued Apr. 28, 1998 (Ex. 1005, “Moezzi-1”).

³ US 5,850,352, issued Dec. 15, 1998 (Ex. 1006, “Moezzi-2”).

⁴ Christopher James Kellogg, *Visual Memory*, (May 1993) (B.S. & M.S. thesis, Massachusetts Institute of Technology) (Ex. 1007, “Kellogg”).

⁵ US 6,532,036 B1, issued Mar. 11, 2003 (Ex. 1008, “Peleg”).

⁶ US 6,522,787 B1, issued Feb. 18, 2003 (Ex. 1016, “Kumar”).

⁷ US 5,259,040, issued Nov. 2, 1993 (Ex. 1018, “Hanna”).

⁸ US 7,843,497 B2, issued Nov. 30, 2010 (Ex. 1017, “Conley”).

⁹ US 5,659,323, issued Aug. 19, 1997 (Ex. 1014, “Taylor”).

¹⁰ US 4,918,526, issued Apr. 17, 1990 (Ex. 1015, “Lewis”).

Pet. 3–4, 26–70. Petitioner submits the Declaration of John R. Grindon, D.Sc. (Ex. 1004); Declaration of Christopher James Bailey-Kellogg, Ph.D. (Ex. 1009); the Declaration of Katherine Zimmerman (Ex. 1011); the Declaration of Christopher R. Abidin, Esq. (Ex. 1012); and the Declaration of James L. Mullins, Ph.D. (Ex. 1013) in support of its arguments. Patent Owner submits the Declaration of Jeffrey Lubin, Ph.D. (Ex. 2001) and the Declaration of Kenneth L. Stein (Ex. 2010) in support of its arguments.

II. DISCRETION UNDER 35 U.S.C. § 325(d)

The parties present arguments about exercising discretion under 35 U.S.C. § 325(d). Prelim. Resp. 3–24; Prelim. Reply 1–4; Prelim. Sur-reply 1–4. We find that these arguments present a threshold issue which is dispositive of our decision of whether to institute *inter partes* review. For the reasons discussed below, we are persuaded by Patent Owner to exercise our discretion to deny institution of *inter partes* review under 35 U.S.C. § 325(d).

A. Legal Framework of 35 U.S.C. § 325(d)

The Director has discretion to institute an *inter partes* review, and has delegated that discretion to the Board. *See* 35 U.S.C. § 314(a); *see also* 37 C.F.R. § 42.4(a). Under § 325(d), in determining whether to institute an *inter partes* review, we “may take into account whether, and reject the petition . . . because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d).

For guidance in exercising this discretion, the Director designated as precedential a portion of the Board’s decision in *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first para.), which provides six *non-*

exclusive factors for us to consider when deciding whether to exercise discretion to deny review under 35 U.S.C. § 325(d).

The six non-exclusive *Becton Dickinson* factors are:

(a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art; (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson, Paper 8 at 17–18.

Subsequently, the Director designated as precedential *Advanced Bionics, LLC v. Med-El Electromedizinische Geräte GMBH*, IPR2019-01469, Paper 6 at 10 (Feb. 13, 2020) (“*Advanced Bionics*”) (precedential), which groups the *Becton Dickinson* factors for consideration. Namely, *Advanced Bionics* groups factors (a), (b), and (d) as relating to whether the art and arguments presented in the petition are the same (or substantially the same) as those previously presented to the Office; and groups factors (c), (e), and (f) as relating to whether the petitioner has demonstrated error by the Office. *Id.* In accordance with these groupings, *Advanced Bionics* provides us with the following two-part framework to apply for our § 325(d) analysis:

- (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and
- (2) if either condition of first part of the framework is satisfied,

whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Id. at 8.

B. Whether the Same or Substantially the Same Art Was Presented to the Office

We first consider whether Petitioner asserts the same or substantially the same art that was presented previously to the Office. *Advanced Bionics*, Paper 6 at 10. Here, across eleven grounds, Petitioner asserts nine references in arguing that the challenged claims are unpatentable: Moezzi-1, Moezzi-2, Kellogg, Peleg, Hanna, Kumar, Conley, Taylor, and Lewis. *E.g.*, Pet. 3–4. Patent Owner argues that six of these references are the same or substantially the same art that was presented previously to the Office: Moezzi-1, Moezzi-2, Kellogg, Hanna, Kumar, and Taylor. Prelim. Resp. 4–16; Prelim. Sur-reply 1–2. Petitioner disputes Patent Owner’s arguments. Prelim. Reply 1–3. For the reasons discussed below, we agree with Patent Owner.

1. Moezzi-1

During prosecution of the ’226 patent (the first issued patent in the ’234 patent’s priority chain), Patent Owner submitted an Information Disclosure Statement (“IDS”) listing US 5,729,471 (Ex. 2009, “Moezzi-1 Parent”), which issued from the parent application of Moezzi-1.¹¹ Ex. 2004, 278; Prelim. Resp. 6; *supra* Section I(C) (family history of ’234 patent). Patent Owner also included Moezzi-1 Parent on an additional IDS during prosecution of the ’325 patent (the second issued patent in the ’234 patent’s

¹¹ US 5,729,471 issued from Moezzi-1’s parent application (No. 08/414,437). Ex. 1005, 1:9–10. Moezzi-1’s application (No. 08/667,372) was a divisional of the parent application. *Id.* at codes (21), (62), 1:9–10.

priority chain). Ex. 2006, 157; Prelim. Resp. 6. The Examiner initialed the listing of Moezzi-1 Parent on the IDSs, indicating that the Examiner considered it. Ex. 2004, 278 (form PTO-1449 stating “EXAMINER: Initial if reference considered”); Ex. 2006, 157 (same). Our precedent establishes that “[p]reviously presented art includes . . . art provided to the Office by an applicant, such as on an [IDS].” *Advanced Bionics*, Paper 6 at 7–8.

Accordingly, we find that Patent Owner previously presented Moezzi-1 Parent to the Office during the prosecution of the ’226 and ’325 patents.

Furthermore, the version of the Manual of Patent Examining Procedure (“MPEP”) in effect when the ’234 patent application was filed provides the following:

The examiner will consider information which has been considered by the Office in a parent application when examining: (A) a continuation application . . . , (B) a divisional application . . . , or (C) a continuation-in-part application A listing of the information need not be resubmitted in the continuing application unless the applicant desires the information to be printed on the patent.

See Ex. 2008, 8 (MPEP § 609.02 (9th ed., Mar. 2014)); *see also* Prelim. Resp. 5 (citing same). In other words, the Examiner was required to consider Moezzi-1 Parent during the prosecution of the ’234 patent. *See* Ex. 2008, 8. Moreover, the same examiner conducted the examinations for the ’226, ’325, and ’234 patents. *See, e.g.*, Ex. 1002, 78, 82; Ex. 2004, 280; Ex. 2007, 23; Prelim. Resp. 5. And during the prosecution of the ’234 patent, the Examiner did not reject the challenged claims over any prior art. *See generally* Ex. 1002. Rather, the Examiner only rejected the challenged claims “on the ground of nonstatutory double patenting as being unpatentable over claims 1–30” of the ’325 patent in view of the ’226 patent. *See generally* Ex. 1002; *id.* at 81; *see also* Prelim. Resp. 5 (citing same). In

particular, the Examiner found that the challenged claims “are not patentably distinct from each other because the current claimed features have been claimed previously in one or more of the patents.” Ex. 1002, 81. We find that this further evidences that the Examiner considered the prosecution of the ’226 and ’325 patents during the prosecution of the ’234 patent. In response to the rejection, Patent Owner filed a terminal disclaimer, and the challenged claims issued thereafter. *Id.* at 43–44, 70.

We also agree with Patent Owner that previous Board decisions applying § 325(d) looked to what art was presented in the prosecution of priority patents or applications, rather than limiting the inquiry to the prosecution of just the challenged patent. Prelim. Resp. 5 (collecting cases); *see, e.g., Becton, Dickinson*, Paper 8 at 16, 22–23; *Microsoft Corp. v. IPA Techs., Inc.*, IPR2019-00840, Paper 9 at 15–17 (PTAB Nov. 12, 2019); *R.J. Reynolds Vapor Co. v. Fontem Holdings I B.V.*, IPR2018-00632, Paper 9 at 20–21 (PTAB Sept. 28, 2018); *SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00733, Paper 11 at 40 (PTAB Oct. 6, 2020). We likewise follow the approach provided in these cases, and consider the prosecution histories of the ’226 and ’325 priority patents in our § 325(d) analysis.

Moreover, we are not persuaded by Petitioner’s argument that “Patent Owner does not rely at all on the prosecution of the [’]234 [p]atent,” but rather relies on the prosecution of the ’226 and ’325 patents, which are distant ancestors of the ’234 patent. Prelim. Reply 1. This argument is contrary to, and fails to address, MPEP § 609.02 and prior Board decisions, such as those cited by Patent Owner, where the Board looked to the prosecution of priority patents or applications for purposes of § 325(d). Accordingly, for the foregoing reasons, we find that Moezzi-1 Parent was before the Office during the examination of the ’234 patent.

In addition, we agree with Patent Owner that Moezzi-1 is substantially the same as Moezzi-1 Parent. Prelim. Resp. 6. More specifically, we agree with Patent Owner and find that “Moezzi-1 and Moezzi-1[]Parent have nearly identical specifications and exactly the same figures.” *Id.* (emphases omitted); *compare generally* Ex. 1005, *with* Ex. 2009. In support of this finding, we credit the redline comparison of the specifications of Moezzi-1 Parent and Moezzi-1, where the “language found in Moezzi-1 but not in Moezzi-1[]Parent is shown in blue underline and language found in Moezzi-1[]Parent but not in Moezzi-1 is shown in red strikethrough.” *See* Ex. 2010 ¶ 4, App. A. It is apparent from reviewing the redline comparison that the specifications are substantially the same. *See* Ex. 2010, App. A. We also find persuasive Patent Owner’s argument that “everything Petitioner relies on in Moezzi-1 is found in Moezzi-1[]Parent” in view of the table Patent Owner provides, which identifies, *inter alia*, citations to Moezzi-1 in the Petition, and where corresponding language appears in Moezzi-1 Parent. Prelim. Resp. 6; Ex. 2010 ¶ 6, App. B. Petitioner does not dispute that Moezzi-1 and Moezzi-1 Parent are substantially the same art. *See generally* Prelim. Reply.

Accordingly, for the foregoing reasons, we are persuaded that Moezzi-1 is substantially the same art previously presented to the Office for the ’234 patent prosecution.¹²

¹² Because we find that Moezzi-1 Parent is substantially the same art previously presented to the Office, we do not reach Patent Owner’s argument that Moezzi-1 also is substantially the same as Patrick H. Kelly, et al., “An Architecture for Multiple Perspective Interactive Video,” ACM Multimedia 95 - Elec. Proc., in San. Fran., CA (Nov. 5–9, 1995) (Ex. 2011, “Kelly”). Prelim. Resp. 7–14.

2. *Moezzi-2*

During prosecution of the '226 patent, Patent Owner listed Moezzi-2 on an IDS. Ex. 2004, 147; Prelim. Resp. 15. Patent Owner also included Moezzi-2 on an additional IDS during prosecution of the '325 patent. Ex. 2006, 157; Prelim. Resp. 15. The Examiner initialed the listing of Moezzi-2 on the IDSs, indicating that the Examiner considered it. Ex. 2004, 147; Ex. 2006, 157; *see also* Prelim. Resp. 15 (citing same) (arguing that Moezzi-2 was considered during the prosecution of the '226 and '325 patents). Accordingly, we are persuaded that Moezzi-2 is the same art previously presented to the Office for the '234 patent prosecution. *See Advanced Bionics*, Paper 6 at 7–8; *supra* Section II(B)(1) (considering the prosecution history of priority patents).

3. *Kellogg*

Patent Owner argues that Jasnoch¹³ was considered previously by the Office, and is cumulative of Kellogg. Prelim. Resp. 15; Prelim. Sur-reply 2–3. The parties agree that the Examiner relied on Jasnoch in the prosecution of the '226 patent. Prelim. Resp. 15; Prelim. Reply 2 (“Jasnoch was applied during the prosecution of the [']226 [p]atent”); *see also* Ex. 2005, 190–92 (rejecting claims under § 103 based, in part, on Jasnoch). The parties dispute, however, whether Jasnoch, in relevant part, is substantially the same art as Kellogg.

Patent Owner argues that “Petitioner relies on Kellogg only for its ‘multi-user teachings’ that purportedly ‘provides a capability for first and second users to navigate . . . simultaneously and independently.’” Prelim.

¹³ Uwe Jasnoch et al., “Shared 3D Environments within a Virtual Prototyping Environment,” IEEE Proc. WET ICE 1996, at 274–79 (Ex. 2012, “Jasnoch”).

Resp. 15 (citing Pet. 49). Petitioner argues that “Kellogg discloses a visual memory for storing video data that supports concurrent users and independent, concurrent read/write access . . . [and] that ‘supports computer vision applications’” Prelim. Reply 2 (citing Pet. 16). We find the parties’ characterizations of Kellogg to be consistent with each other.

As to Jasnoch, Patent Owner agrees with the Examiner’s finding and argues that Jasnoch teaches “a shared 3D environment, wherein multiple users simultaneously and independently navigate the shared 3D environment.” Prelim. Resp. 15 (quoting Ex. 2005, 191–92). Petitioner argues that Jasnoch teaches “a ‘Virtual Prototyping Environment’ for long-distance collaboration including a shared 3D environment for CAD development of objects.” Prelim. Reply 2 (citing Ex. 2012, 1–3). Petitioner adds that “Jasnoch was applied during the prosecution of the [’]226 [p]atent to incorporate its distributed network into the Kelly system . . . , which is different from how Kellogg is applied in the [Petition] for its multi-user video database with the desired concurrency control.” *Id.* at 2 (citing Pet. 35, 38–39, 45–46, 49; Ex. 2005, 190–92).

We agree with Patent Owner and the Examiner that Jasnoch teaches “a shared 3D environment, wherein multiple users simultaneously and independently navigate the shared 3D environment.” Ex. 2005, 191–92 (citing Ex. 2012, Fig. 2); Ex. 2012, 1–3, Fig. 2. And we find that this teaching from Jasnoch is cumulative of Kellogg’s teaching of a visual memory for storing video data that supports concurrent users and independent, concurrent read/write access for computer vision applications. Ex. 1007, Fig. 4–1, 11, 19. In other words, both of Jasnoch’s and Kellogg’s cited teachings are directed to having multiple users simultaneously and independently manipulate a shared visual environment. *Compare* Ex. 2012,

1–3, Fig. 2, *with* Ex. 1007, Fig. 4-1, 11, 19. Petitioner incorrectly limits - Jasnoch’s teachings to a long-distance collaboration tool having a shared 3D environment for CAD development, and does not address Jasnoch’s teachings of allowing multiple users simultaneously and independently to navigate its shared 3D environment. Prelim. Reply 2; Ex. 2012, 1–3, Fig. 2.

Accordingly, we are persuaded that the relied-upon portion of Kellogg is substantially the same art previously presented to the Office.

4. *Hanna*

During prosecution of the ’226 patent, Patent Owner listed Hanna on an IDS. Ex. 2004, 223; Prelim. Resp. 15. Patent Owner also included Hanna on an additional IDS during prosecution of the ’325 patent. Ex. 2006, 157; Prelim. Resp. 15. The Examiner initialed the listing of Hanna on the IDSs, indicating that the Examiner considered it. Ex. 2004, 223; Ex. 2006, 157; *see also* Prelim. Resp. 15 (citing same) (arguing that Hanna was considered during the prosecution of the ’226 and ’325 patents). Accordingly, we are persuaded that Hanna is the same art previously presented to the Office for the ’234 patent prosecution. *See Advanced Bionics*, Paper 6 at 7–8; *supra* Section II(B)(1) (considering the prosecution history of priority patents). In addition, the ’234 patent’s Specification clearly and unambiguously incorporates Hanna by reference. Ex. 1001, 17:65–18:2. The nature of incorporation by reference connotes that all of Hanna would have been considered to be part of the ’234 patent Specification and would have been considered by the Examiner. *See* 37 C.F.R. § 1.57(e).

5. *Kumar*

Patent Owner argues that Hanna is cumulative of Kumar. Prelim. Resp. 16. In particular, Patent Owner argues that “Petitioner relies on

[Kumar] *only* as purportedly teaching a ‘tweening process.’” *Id.* (citing Pet. 59). Patent Owner adds that during prosecution of the ’325 patent, “the Examiner relied on Hanna for the exact same purpose and no more, stating that it discloses ‘the tweening process.’” *Id.* (citing Ex. 2007, 30).

The ’234 patent, which incorporates Hanna by reference for Hanna’s “tweening process,” teaches that “[t]weening enables . . . process[ing] the structure of a view from two or more camera outputs of the view.” Ex. 1001, 17:65–18:4; *see also id.* at 18:5–38 (describing applying Hanna’s tweening process to the ’234 patent’s telepresence system). We agree with Patent Owner and the Examiner that Hanna teaches a tweening process. *See, e.g.,* Ex. 1018, 3:21–48. We also agree with Patent Owner and find that Petitioner relies on Kumar for its tweening process. Pet. 58–59 (ground adding Kumar to Moezzi-1, Moezzi-2, and Kellogg), 59–60 (ground adding Kumar to Moezzi-1, Moezzi-2, Kellogg, and Hanna), 67–68 (ground adding Kumar to Moezzi-1 and Moezzi-2), 68–69 (ground adding Kumar to Moezzi-1, Moezzi-2, and Hanna). Petitioner does not dispute that Kumar and Hanna are substantially the same art. *See generally* Prelim. Reply.

Accordingly, we are persuaded that the relied-upon portion of Kumar is substantially the same art previously presented to the Office.

6. Taylor

During prosecution of the ’226 patent, Patent Owner listed Taylor on an IDS. Ex. 2004, 224; Prelim. Resp. 15. Patent Owner also included Taylor on an additional IDS during prosecution of the ’325 patent. Ex. 2006, 157; Prelim. Resp. 15. The Examiner initialed the listing of Taylor on the IDSs, indicating that the Examiner considered it. Ex. 2004, 224; Ex. 2006, 157; *see also* Prelim. Resp. 15 (citing same) (arguing that Taylor was considered during the prosecution of the ’226 and ’325 patents).

Accordingly, we are persuaded that Taylor is the same art previously presented to the Office for the '234 patent prosecution. *See Advanced Bionics*, Paper 6 at 7–8; *supra* Section II(B)(1) (considering the prosecution history of priority patents).

C. Whether the Office Erred in a Manner Material to Patentability

As discussed above, we determine that Moezzi-1, Moezzi-2, Kellogg, Hanna, Kumar, and Taylor are the “same or substantially the same prior art” that previously was presented to the Office. *See supra* Section II(B).

Accordingly, for these references, the first condition of the first part of the *Advanced Bionics* framework is satisfied, and we need not reach whether the “same or substantially the same arguments”¹⁴ previously were presented to the Office. We now turn to whether Petitioner demonstrates that the Office erred in a manner material to the patentability of the corresponding challenged claims. *Advanced Bionics*, Paper 6 at 8, 10.

“Petitioner must demonstrate that the Examiner erred in the evaluation of the prior art, for example, by showing that the Examiner misapprehended or overlooked specific teachings in the relevant prior art such that the error by the Office was material to the patentability of the challenged claims.” *Id.* at 21. Petitioner does not identify any specific teaching in any reference that the Examiner misapprehended or overlooked. Prelim. Reply 1–4. Rather,

¹⁴ In light of the first condition being met, we do not reach the parties’ arguments about whether Petitioner makes the same arguments for what Moezzi-1 teaches that Patent Owner already overcame during the prosecution of the '226 patent in traversing a § 103 rejection over Kelly and Jasnoch. Prelim. Resp. 6–14; Prelim. Reply 1–2; Prelim. Sur-reply 2. For the same reason, we also do not reach the parties’ arguments about whether the arguments before the Examiner during prosecution were focused on an “array of cameras,” and thus, are different than the arguments provided in the Petition. Prelim. Reply 1–4; Prelim. Sur-reply 3–4.

Petitioner argues that Moezzi-1 Parent was not applied in an office action during the prosecution of the '226 patent. *Id.* Nor were the asserted combinations from the Petition or Patent Owner's "allegedly equivalent prior art combinations" the basis for rejection in the prosecution of the '226, '325, and '234 patents, according to Petitioner. *Id.* We evaluate these arguments that particular references and combinations were not applied by the Examiner, which corresponds to *Becton, Dickinson* factor (c) (i.e., "the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection"), in weighing whether the Examiner erred in the evaluation of the prior art. For example, whether a reference was the basis for a rejection may be probative of whether the Examiner misapprehended or overlooked a specific teaching contained in the reference. But whether a reference was a basis for a rejection is not dispositive, especially here where Petitioner does not identify any specific teaching that the Examiner misapprehended or overlooked.

We also are not persuaded by the argument Petitioner provides for *Becton, Dickinson* factor (e) (i.e., "whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art") that "Patent Owner's argument is improperly grounded in the [']226 [p]atent's 'array of cameras' limitation not found in the [']234 [p]atent." Prelim. Reply 3. This argument is inapposite for our analysis because it does not point out how the Examiner erred in evaluating the same or substantially the same prior art that previously was presented to the Office, such as by identifying what specific teaching the Examiner misapprehended or overlooked. *Id.*

Becton, Dickinson factor (f) asks whether new evidence that was not before the Examiner justifies the Office reconsidering the patentability of the

claims. *Becton, Dickinson*, Paper 8 at 17–18. Petitioner argues that it presents new testimonial evidence in the form of the declaration of Dr. John R. Grindon. Prelim. Reply 4 (citing Ex. 1004). Petitioner, however, does not explain how this testimony serves to show, if at all, that the Examiner erred.

Having considered the parties’ arguments and the evidence of record, we find that Petitioner does not identify or explain sufficiently how the Office materially erred.

D. § 325(d) and the Asserted Grounds

The Petitioner asserts eleven grounds in arguing that the challenged claims are unpatentable. *E.g.*, Pet. 3–4. Moezzi-1 and Moezzi-2 are common to all eleven grounds. *E.g.*, Pet. 3–4. Accordingly, in addressing each of the eleven asserted grounds, we would need to consider art (i.e., at least Moezzi-1 and Moezzi-2) that is the same or substantially the same as art that previously was presented to the Office. *Id.* And we would need to find that the Office erred to find for Petitioner; we are not persuaded that the Office erred. *See* Section II(C).

In addition, although the Petition does not include independent claims 1 and 13 as challenged claims, Petitioner addresses them, as it is required to do, because the challenged claims depend from them. *Id.*; 37 C.F.R. § 1.75(c). In doing so, Petitioner argues that Moezzi-1 teaches independent claims 1 and 13, or alternatively that (i) the combination of Moezzi-1, Moezzi-2, and Kellogg teaches claim 1; and (ii) the combination of Moezzi-1 and Moezzi-2 teaches claim 13. Pet. 3–4, 26–50. Again, Moezzi-1, Moezzi-2, and Kellogg are the same or substantially the same as art that was presented previously to the Office. *See supra* Section II(B). Thus, we also need to consider art that is the same or substantially the same

as art that previously was presented to the Office for each of the independent claims' limitations.

Moreover, six of the asserted grounds rely only on combinations of Moezzi-1, Moezzi-2, Kellogg, Hanna, Kumar, or Taylor. *Id.* Thus, for each of these six grounds, all of the art we would need to consider is the same or substantially the same as art that previously was presented to the Office.

Accordingly, in view of the above, we find that the statutory purpose of 35 U.S.C. § 325(d) is implicated¹⁵ for each of the eleven asserted grounds.

III. CONCLUSION

For the reasons discussed above, we exercise our discretion under 35 U.S.C. § 325(d) to deny institution of trial.

IV. ORDER

In consideration of the foregoing, it is hereby

ORDERED that the Petition is denied as to all challenged claims of the '234 patent for all asserted grounds, and no trial is instituted.

¹⁵ See SAS Q&As, D1 (June 5, 2018) (available at https://www.uspto.gov/sites/default/files/documents/sas_qas_20180605.pdf).

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