

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAS INSTITUTE, INC.
Petitioner

v.

COMPLEMENTSOFT, LLC
Patent Owner

Case IPR2013-00581
Patent 7,110,936 B2

Before KEVIN F. TURNER, JUSTIN T. ARBES, and JENNIFER S. BISK,
Administrative Patent Judges.

BISK, *Administrative Patent Judge.*

DECISION

Denying Institution of *Inter Partes* Review
Dismissing Motion for Joinder
37 C.F.R. §§ 42.108, 42.122

I. INTRODUCTION

A. Background

SAS Institute, Inc. (“SAS”) filed a corrected petition (Paper 7, “Pet.”) to institute an *inter partes* review of claims 1–16 of Patent 7,110,936 B2 (“the ’936 patent”) pursuant to 35 U.S.C. § 311 *et seq.* and a motion for joinder with Case IPR2013-00226¹ (Paper 1, “Mot.”). ComplementSoft, LLC (“ComplementSoft”) filed a preliminary response (Paper 14, “Prelim. Resp.”) and an opposition to SAS’s motion (Paper 8, “Opp.”). We have jurisdiction under 35 U.S.C. § 314.

In IPR2013-00226, the Board instituted a trial for claims 1 and 3–10 of the ’936 patent on the following grounds:

- 1) obviousness of claim 1 over Coad, Oracle Primer, and Oracle8 Primer;
 - 2) obviousness of claims 1, 3, 5, 6, 8, and 10 over Antis and Coad;
 - 3) obviousness of claim 4 obvious over Antis, Coad, and Burkwald;
 - 4) obviousness of claim 7 over Antis, Coad, and Eick; and
 - 5) obviousness of claim 9 over Antis, Coad, and “Building Applications.
- Decision to Institute, Paper 9 IPR2013-00226 (“Prior Decision”) at page 3. In the current petition, SAS contends that the challenged claims are unpatentable under 35 U.S.C. § 103 based on the following specific grounds (Pet. 22, 41, 43–48, 51–58):

¹ The decision to institute an *inter partes* review in Case IPR2013-00226 was entered August 12, 2013, based on a petition for *inter partes* review filed March 29, 2013.

References ²	Claims challenged
Grounds Based on Polo	
Polo, Coad, Oracle Primer, and Oracle8 Primer	1–3, 6, 8, 10–12, 15, and 16
Polo, Coad, Oracle Primer, Oracle8 Primer, and Burkwald	2 and 4
Polo, Coad, Oracle Primer, Oracle8 Primer, and Antis	5
Polo, Coad, Oracle Primer, Oracle8 Primer, and Eick	7
Polo, Coad, Oracle Primer, Oracle8 Primer, and “Building Applications”	9, 11, and 12
Polo, Coad, Oracle Primer, Oracle8 Primer, and Corda	13
Polo, Coad, Oracle Primer, Oracle8 Primer, and Access 97 Visual Basic	14
Grounds Primarily Based on Coad	
Coad, Oracle Primer, and Oracle8 Primer	2, 3, 6, 8, 10–12, 15, and 16
Coad, Oracle Primer, Oracle8 Primer, and Burkwald	2 and 4
Coad, Oracle Primer, Oracle8 Primer, and Antis	5
Coad, Oracle Primer, Oracle8 Primer, and Eick	7
Coad, Oracle Primer, Oracle8 Primer, and “Building Applications”	9, 11, and 12
Coad, Oracle Primer, Oracle8 Primer, and Corda	13

² U.S. Patent 5,572,650 (Ex. 1005) (“Antis”); U.S. Patent 6,851,107 (Ex. 1006) (“Coad”); U.S. Patent 6,356,285 (Ex. 1007) (“Burkwald”); U.S. Patent 5,937,064 (Ex. 1008) (“Eick”); Evan Callahan, MICROSOFT ACCESS 97 VISUAL BASIC STEP BY STEP (1997) (Ex. 1009) (“Access 97 Visual Basic”); U.S. Patent 5,782,122 (Ex. 1010) (“Corda”); Microsoft Corporation, BUILDING APPLICATIONS WITH MICROSOFT ACCESS 97 (1996) (Ex. 1011) (“Building Applications”); Rajshekhar Sunderraman, ORACLE PROGRAMMING: A PRIMER (1999) (Ex. 1012) (“Oracle Primer”); and Rajshekhar Sunderraman, ORACLE8 PROGRAMMING: A PRIMER (2000) (Ex. 1013) (“Oracle8 Primer”).

References ³	Claims challenged
Coad, Oracle Primer, Oracle8 Primer, and Access 97 Visual Basic	14
Grounds Primarily Based on Antis	
Antis and Coad	2, 11, 12, 15, and 16
Antis, Coad, and Corda	13
Antis, Coad, and Access 97 Visual Basic	14
Antis, Coad, and “Building Applications”	11 and 12

We conclude that SAS has not shown, under 35 U.S.C. § 314(a), that there is a reasonable likelihood that it would prevail on: (1) any of the grounds based on Polo; (2) any of the grounds primarily based on Antis; or (3) obviousness of claims 2 and 11–16 primarily based on Coad.

Further, based on the record before us and exercising our discretion under 35 U.S.C. § 325(d) we deny the petition as to the grounds listed below because these grounds are based upon substantially the same prior art and arguments as set forth in IPR2013-00226:

- 1) obviousness of claims 3, 6, 8, and 10 over Coad, Oracle Primer, and Oracle8 Primer;
- 2) obviousness of claim 4 over Coad, Oracle Primer, Oracle8 Primer, and

³ U.S. Patent 5,572,650 (Ex. 1005) (“Antis”); U.S. Patent 6,851,107 (Ex. 1006) (“Coad”); U.S. Patent 6,356,285 (Ex. 1007) (“Burkwald”); U.S. Patent 5,937,064 (Ex. 1008) (“Eick”); Evan Callahan, MICROSOFT ACCESS 97 VISUAL BASIC STEP BY STEP (1997) (Ex. 1009) (“Access 97 Visual Basic”); U.S. Patent 5,782,122 (Ex. 1010) (“Corda”); Microsoft Corporation, BUILDING APPLICATIONS WITH MICROSOFT ACCESS 97 (1996) (Ex. 1011) (“Building Applications”); Rajshekhar Sunderraman, ORACLE PROGRAMMING: A PRIMER (1999) (Ex. 1012) (“Oracle Primer”); and Rajshekhar Sunderraman, ORACLE8 PROGRAMMING: A PRIMER (2000) (Ex. 1013) (“Oracle8 Primer”).

- Burkwald;
- 3) obviousness of claim 5 over Coad, Oracle Primer, Oracle8 Primer, and Antis;
 - 4) obviousness of claim 7 over Coad, Oracle Primer, Oracle8 Primer, and Eick; and
 - 5) obviousness of claim 9 over Coad, Oracle Primer, Oracle8 Primer, and “Building Applications.”

Therefore, the Board has determined not to institute an *inter partes* review. As a result of this determination, the petition is denied and SAS’s motion for joinder is dismissed as moot.

B. The '936 Patent

The technology of the '936 patent is described in the Prior Decision at page 4. For the purposes of this decision, we adopt that prior description.

Claim 1, reproduced below, is the '936 patent’s only independent claim:

1. An integrated development environment, comprising:
 - a document manager for retrieving source code programmed using one of a plurality of types of data manipulation languages;
 - an editor for displaying the retrieved source code and providing a means for a user to edit the retrieved source code;
 - a parser layer which detects the one of the plurality of types of data manipulation languages in which the retrieved source code is programmed and which activates rules and logic applicable to the detected one of the plurality of types of data manipulation languages; and
 - a visualizer dynamically linked to the editor for displaying graphical representations of flows within the retrieved source code using the rules and logic applicable to the detected one of the plurality of types of data manipulation languages and activated by the parser,

wherein the editor, parser layer and visualizer cooperate such that edits made to the source code using the editor are automatically reflected in the graphical representations of flows displayed by the visualizer and edits made to the graphical representations of flows in the visualizer are automatically reflected in the source code displayed by the editor.

We note that the '936 patent is asserted currently in *ComplementSoft, LLC v. SAS Institute, Inc.*, Docket No. 1:12-cv-07372 (N.D. Ill. Sept. 14, 2012). *See* Pet. 1; Paper 10 at 2.

C. Claim Construction

As a step in our analysis for determining whether to institute a trial, we determine the meaning of the claims. Consistent with the statute and the legislative history of the America Invents Act (AIA), the Board will interpret claims using the broadest reasonable construction. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48766 (Aug. 14, 2012); 37 C.F.R. § 42.100(b). The parties do not dispute that for purposes of this decision, the Board should use the construction of “data manipulation language” adopted in the Prior Decision—“a programming language used to access data in a database, such as to retrieve, insert, delete, or modify data in the database.” Pet. 9 (citing Prior Decision 6–8); Prelim. Resp. 16. The parties appear to agree that for this decision, the Board should use the construction of “graphical representation of flows” adopted in the Prior Decision—“a diagram that depicts a map of the progression (or path) through the source code.” *See, e.g.*, Pet. 31-32; Prelim. Resp. 32.

Several of the challenged claims include the language “means” or “means for” and, therefore, are presumed to invoke 35 U.S.C. § 112 ¶ 6.⁴ *Personalized*

⁴ Section 4(c) of the AIA re-designated 35 U.S.C. § 112 ¶ 6, as 35 U.S.C. § 112(f). Because the '936 patent has a filing date before September 16, 2012 (effective

Media Commc 'ns LLC v. Int'l Trade Comm'n, 161 F.3d 696, 702–04 (Fed. Cir. 1998). This presumption is not conclusive. *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1427–28 (Fed. Cir. 1997). For example, section 112 is not implicated when a claim uses the word “means” but does not specify a corresponding function. *Id.* Section 112 also is not implicated when a claim recites a corresponding function, but the claim also recites sufficient structure, material, or acts to perform entirely the recited function. *Id.*

In the Prior Decision, we determined that the phrase “means for a user to edit” in claim 1 did not implicate section 112. Prior Decision 9–10. As to claim 11, however, because the claim uses the words “means for” modified by functional language and the limitation is not modified by any structure recited in the claim to perform the claimed function—“allowing source code to be executed both locally and remotely”—we interpreted this limitation to be a means-plus-function limitation. *Id.* Moreover, in the Prior Decision, because SAS did not identify what structure in the Specification it believed corresponded to the means-plus-function limitation of claim 11, we declined to institute *inter partes* review on any proposed ground for claim 11 and claims 12–16, which depend from claim 11. *Id.* at 11.

In this petition, SAS proposes a structure corresponding to the means-plus-function limitation of claim 11: “one or more general purpose local computers and one or more general purpose remote computers (*see* '936 patent at col. 4, lines 46–53), with the local and remote computers programmed to perform an algorithm for allowing source code to be executed both locally and remotely, and equivalents of the foregoing.” Pet. 10–11. The corresponding structure of a means-plus-function limitation, however, must be more than simply a general-purpose computer or

date), we will refer to the pre-AIA version of 35 U.S.C. § 112.

microprocessor to avoid pure functional claiming. *Aristocrat Techs. Austl. Pty Ltd. v. Int'l Game Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008). That is, the specification must disclose to a person of ordinary skill in the art “enough of an algorithm to provide the necessary structure under § 112, ¶ 6,” or a disclosure that can be expressed in any understandable terms (e.g., a mathematical formula, in prose, or as a flowchart). *Finisar Corp. v. The DirectTV Group*, 523 F.3d 1323, 1340 (Fed. Cir. 2008).

SAS’s proposed structure is composed entirely of general purpose computers “programmed to perform an algorithm” for the claimed function. SAS, however, does not identify what the algorithm is, or where it is disclosed in the Specification. The language proposed by SAS does not provide enough of an algorithm to provide the necessary structure, and, therefore, does not qualify as the corresponding structure for performing the claimed function.

ComplementSoft proposes a different structure from the Specification as corresponding to the means-plus-function limitation of claim 11, “a means for allowing the source code to be executed both locally and remotely,” pointing to the following language:

In addition, the user has the option of executing edited code on a remote computer 22a, by employing the server module 160, in connection with the site manager 70, to connect the local computer 22b to the remote computer 22a, as will be described in more detail below. Once a session is opened, a terminal tab for the respective session can be created and displayed to the user by the server module 160, as illustrated in FIG. 10. It should be understood by those with skill in the art that the server module 160, the site manager 70 and the document manager 60 all preferably interact with one another to effectuate the transfer of code between the remote server computers 22a and the local computer 22b. It should also be understood that each of these modules could be combined or further divided to form one single module or 50 additional modules.

Ex. 1001, col. 8, ll. 35–50

Thus, the site manager 70 creates a virtual computing environment by expanding the computing boundary of the local computer 22b to include remote computers 22a and making various computing resources across the LAN/WAN seamlessly available for use by the local computer 22b.

Ex. 1001, col. 8, ll. 62–67.

For purposes of this decision, we agree with ComplementSoft, and identify the corresponding structure for performing the function of the “means for allowing” in claim 11—namely, allowing source code to be executed both locally and remotely—to be server module 160 in connection with site manager 70 and document manager 60, which are programs being run on a specially programmed general computing device.

II. ANALYSIS

A. Grounds Based on Polo

1. Overview of Polo

Polo discloses a computer-implemented method for analyzing the data flow of a database query. Ex. 1045, Abstract, col. 1, ll. 56–58. Polo discloses a Structured Query Language (SQL) Query Tool implemented as a software program, preferably including query input module 14, graphical interface module 16, and data flow analysis module 18. *Id.* at col. 3, ll. 13–30. Data flow analysis module 18 analyzes the sections of a database query to determine what role each section has in the overall query. *Id.* at col. 4, ll. 33–35. Module 18 detects blocking conditions and other query-related cases of interest to users using a generate-and-execute approach. *Id.* at ll. 47–51.

Graphical interface module 16 converts the complex logic of an SQL query into a graphical paradigm based on the concept of water passing through a

plumbing system. *Id.* at col. 5, ll. 10–19. Figure 2 of Polo is reproduced below.

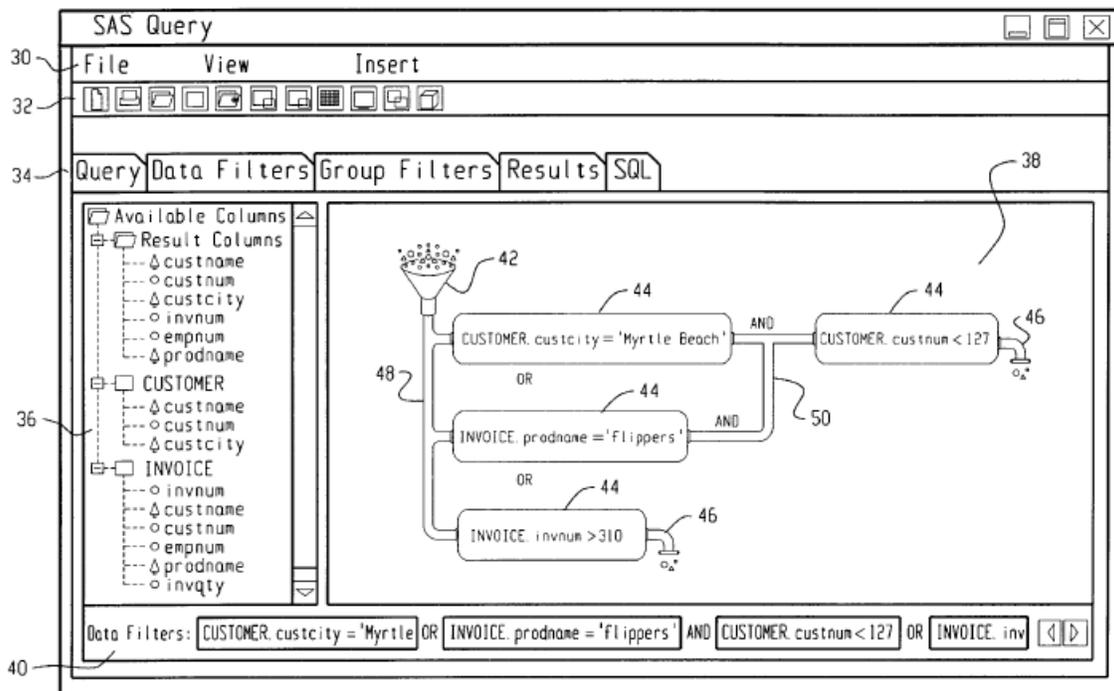


Fig. 2

Figure 2, above, illustrates the plumbing paradigm that graphically depicts complex data filter 38 as a network of filter nodes 44 that are linked by pipes 48 and 50, and which includes originating node 42 and one or more terminating nodes 46. *Id.* at col. 5, ll. 19–26. Each filter node 44 represents a condition of expression of the SQL clause. *Id.*

2. Overview of Coad

Coad discloses a software development tool that allows a developer to view and modify simultaneously textual and graphical displays of source code, regardless of the programming language in which the code is written. Ex. 1006, Abstract, col. 4, ll. 38–41. The details of Coad are described in the Prior Decision at pages 11–12. For the purposes of this decision, we adopt that prior description.

3. Obviousness Grounds Based on Polo Combined with Coad, Oracle Primer, and Oracle8 Primer

SAS asserts that claims 1–3, 6, 8, 10–12, 15, and 16 would have been obvious over Polo combined with Coad, Oracle Primer, and Oracle8 Primer (Pet. 22–41); claims 2 and 4 would have been obvious over Polo combined with Coad, Oracle Primer, Oracle8 Primer, and Burkwald (Pet. 41–43); claim 5 would have been obvious over Polo combined with Coad, Oracle Primer, Oracle8 Primer, and Antis (Pet. 43–44); claim 7 would have been obvious over Polo combined with Coad, Oracle Primer, Oracle8 Primer, and Eick (Pet. 44–45); claims 9, 11, and 12 would have been obvious over Polo combined with Coad, Oracle Primer, Oracle8 Primer, and “Building Applications” (Pet. 45–46, 57–58); claim 13 would have been obvious over Polo combined with Coad, Oracle Primer, Oracle8 Primer, and Corda (Pet. 46–47); and claim 14 would have been obvious over Polo combined with Coad, Oracle Primer, Oracle8 Primer, and Access 97 Visual Basic (Pet. 47–48).

We are not persuaded that a person of ordinary skill in the art would have combined Polo with Coad, Oracle Primer, and Oracle8 Primer as asserted by SAS. Pet. 16–17. SAS explains that all four references are directed to software development tools, generally, and to programming languages used to access data in a database, specifically, and, therefore, the similar purposes and overlapping teachings would have motivated a person of ordinary skill in the art to combine the teachings of the references. Pet. 17. Further, SAS asserts that a person of ordinary skill “would have been motivated to supplement Polo’s software development tool with Coad’s teaching of a parser layer used to detect one of a plurality of types of programming languages, and to apply rules and logic specific to the detected language, because this would increase the functionality of the system of Polo by

enabling analysis of multiple programming languages.” *Id.* (citing Ex. 1046 ¶ 306).

We are not persuaded by this reasoning. It is not evident, nor does SAS explain sufficiently, why a person of ordinary skill in the art would combine a general software development tool used for viewing and modifying source code, independent of programming language, with a significantly more specialized tool for analyzing the internal data flow of a database query. Petitioner must set forth sufficient articulated reasoning with rational underpinning to support its proposed obviousness ground. *See KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007). This SAS has not done. Moreover, the expert testimony relied upon by SAS similarly is lacking in sufficient rationale, is conclusory, and lacks sufficient factual support. Ex. 1046, ¶ 306.

On this record, we are not persuaded that SAS has shown a reasonable likelihood of prevailing on its asserted grounds of obviousness over Polo combined with Coad, Oracle Primer, and Oracle8 Primer by themselves or combined with the other asserted references.

B. Grounds Primarily Based on Coad

1. Obviousness Over Coad, Oracle Primer, and Oracle8 Primer

SAS asserts that claims 2, 3, 6, 8, 10–12, 15, and 16 would have been obvious over Coad combined with Oracle Primer and Oracle8 Primer. Pet. 48–51. In the Prior Decision, the Board determined that SAS had shown, in its petition, a reasonable likelihood of prevailing in its assertion that claim 1 would have been obvious over this same combination of references. Prior Decision 13–15. Here, SAS relies on that determination to support the assertion that this combination of references shows all the limitations of claim 1. Pet. at 48 (“As explained in the Petition for *Inter Partes* Review for IPR2013-00226, and as recognized by the

Board in its IPR2013-00226 Institution Decision, claim 1 is obvious over Coad, Oracle Primer, and Oracle 8 Primer.”). SAS relies on Coad as disclosing each of the additional limitations recited by claims 2, 3, 6, 8, 10–12, 15, and 16, all of which depend from claim 1 either directly or indirectly. *Id.* at 48–51.

a. Claim 2

Claim 2 depends directly from claim 1 and recites the additional limitation “wherein the graphical representations of flows depicts data flows.” In the Prior Decision, we determined that it was “unclear exactly which view [of Coad] SAS equates to the claimed ‘graphical representation’ of a ‘data flow,’” and also that it was not clear on its face that Coad disclosed this limitation as claimed. Prior Decision 19.

Here, SAS explains that Figure 14’s sequence diagram discloses this limitation. Pet. 30. According to SAS, the horizontal dimension of Figure 14 represents different objects, and to transition between those objects, various functions are invoked with data being passed to those objects by parameters of the function calls. *Id.* at 30–31. SAS asserts that “because it shows which pieces of data . . . are accessed by which pieces of source code . . . [f]igure 14 of Coad thus depicts a data flow, *i.e.*, a diagram that depicts a map of the progression of data through the source code.” *Id.* at 31. We are not persuaded by this argument. As explained by Coad, Figure 14 depicts the movement of parameters through objects, not data moving between steps of executing source code, as required by the claims. SAS does not explain sufficiently why a set of messages exchanged among objects is equivalent to the flow of data moving through the steps of executing source code.

SAS also asserts that Figure 16’s statechart diagram discloses a graphical representation of data flows. Pet. 31. According to SAS, a person of ordinary skill

would understand that the statechart diagram of Figure 16 discloses this limitation, asserting that “information of a statechart diagram can be translated into a data flow diagram.” Pet. 31 (quoting Ex. 1030 at 1). We also are not persuaded by this argument. Coad describes the statechart diagram as depicting the sequences of states that “an object or interaction goes through during its life in response to stimuli.” Ex. 1006, col. 17, ll. 16–20. This is not the same as a path of data through source code. As pointed out by ComplementSoft (Prelim. Resp. 33–34), SAS’s reliance on reference material stating that “a statechart diagram can be *translated* into a data flow diagram” is evidence that a statechart diagram does not support SAS’s position. This statement is, in fact, evidence that Figure 16 is *not* a data flow diagram.

Finally, SAS asserts that Figure 17’s activity diagram discloses a graphical representation of data flows. Pet. 32. According to SAS, because Figure 17 is a special case of a statechart diagram, a person of ordinary skill would understand this diagram to include graphical representations of data flows for the same reasons as SAS relied upon for Figure 16. *Id.* We are not persuaded that Figure 17 discloses a graphical representation of data flows for the same reasons we are not persuaded that Figure 16 discloses a graphical representation of data flows.

On this record, we are not persuaded that SAS has shown a reasonable likelihood of prevailing on its asserted ground of obviousness of claim 2 over Coad combined with Oracle Primer and Oracle8 Primer.

b. Claims 3, 6, 8, 10

Claims 3, 6, 8, and 10 depend directly from claim 1. SAS asserts that Coad discloses the additional limitations recited by these claims. Pet. 49–50. We discuss these challenges in Section II.D below.

c. Claims 11, 12, 15, and 16

Claim 11 depends directly from claim 1, claim 12 depends from claim 11, and claims 15 and 16 depend indirectly from claim 11. All of these claims include the means-plus-function limitation construed above—“means for allowing the source code to be executed both locally and remotely.” SAS asserts that Coad discloses this limitation because “the ICE editor includes functionality for allowing retrieved source code to be executed locally (*i.e.*, from a local memory) or remotely (*i.e.*, from a remote computer accessible via a network such as the Internet).” Pet. 37 (citing Ex. 1006, col. 5, ll. 31–49).

ComplementSoft argues that the language of Coad relied upon by SAS for this limitation does not disclose the ability to execute source code either locally or remotely, but instead only describes storing of files locally or remotely. Prelim. Resp. 46. We agree with ComplementSoft. The portion of Coad relied upon by SAS is reproduced below:

FIG. 6 depicts a data processing system 600 suitable for practicing methods and systems consistent with the present invention. Data processing system 600 comprises a memory 602, a secondary storage device 604, an I/O device 606, and a processor 608. Memory 602 includes the improved software development tool 610. The software development tool 610 is used to develop a software project 612, and create the TMM 200 in the memory 602. The project 612 is stored in the secondary storage device 604 of the data processing system 600. One skilled in the art will recognize that data processing system 600 may contain additional or different components.

Although aspects of the present invention are described as being stored in memory, one skilled in the art will appreciate that these aspects can also be stored on or read from other types of computer-readable media, such as secondary storage devices, like hard disks, floppy disks or CD-ROM; a carrier wave from a network, such as Internet; or other forms of RAM or ROM either currently known or later developed.

Ex. 1006, col. 5, ll. 31–49. We do not see, and SAS has not pointed to, anything in

the quoted language that discusses where source code will be executed.

On this record, we are not persuaded that SAS has shown a reasonable likelihood of prevailing on its asserted ground of obviousness of claims 11, 12, 15, and 16 over Coad combined with Oracle Primer and Oracle8 Primer.

2. *Obviousness Over Coad, Oracle Primer, Oracle8 Primer, and Other References*

a. *Claims 2 and 4*

SAS asserts that claims 2 and 4 would have been obvious over Coad combined with Oracle Primer, Oracle8 Primer, and Burkwald. Pet. 51–52. SAS asserts that Burkwald also discloses claim 2’s limitation of “graphical representations of flows [that] depict data flows.” Pet. 14, 51. Specifically, SAS points to the Prior Decision’s determination that there was a reasonable likelihood that SAS would prevail in its challenge that claim 4 would have been obvious over a combination of Antis, Coad, and Burkwald. Pet. 41 (citing Prior Decision 19–20). SAS also cites several sections of Burkwald that refer to “data flow analysis.” *Id.* at 41–42.

We are not persuaded that the language SAS relies upon in Burkwald discloses the limitation “graphical representations of flows [that] depict data flows” recited in claim 2. SAS does not explain sufficiently how the subsystems and complexity metrics displayed in the bar charts of Burkwald equate to the claimed data flows. Pet. 41–42. Moreover, it is not clear on its face that Burkwald discloses this limitation as claimed. SAS has failed to demonstrate a reasonable likelihood that it would prevail on a challenge of claim 2 based on obviousness over Coad combined with Oracle Primer, Oracle8 Primer, and Burkwald.

We discuss the challenge to claim 4 in Section II.D below.

b. Claims 5, 7, and 9

Claims 5, 7, and 9 depend directly from claim 1. SAS asserts that claim 5 would have been obvious over Coad, Oracle Primer, Oracle 8 Primer, and Antis (Pet. 52–53); claim 7 would have been obvious over Coad, Oracle Primer, Oracle 8 Primer, and Eick (Pet. 53); and claim 9 would have been obvious over Coad, Oracle Primer, Oracle 8 Primer, and “Building Applications” (Pet. 53). SAS asserts that the added reference in each ground discloses the additional limitation recited by each dependent claim. Pet. 52–53. We discuss these challenges in Section II.D below.

c. Claims 11–14

SAS asserts that claims 11 and 12 would have been obvious over Coad, Oracle Primer, Oracle 8 Primer, and “Building Applications” (Pet. 57–59); claim 13 would have been obvious over Coad, Oracle Primer, Oracle 8 Primer, and Corda (Pet. 53–54); and claim 14 would have been obvious over Coad, Oracle Primer, Oracle 8 Primer, and Access 97 Visual Basic (Pet. 54). As discussed above, we are not persuaded that Coad discloses the limitation of claim 11—“means for allowing the source code to be executed both locally and remotely”—included in all these claims. SAS does not assert that Corda or Access 97 Visual Basic discloses this limitation.

SAS also asserts that this limitation is disclosed by “Building Applications.” Pet. 57. Specifically, SAS asserts that “Building Applications” discloses a distributed system in the form of a client/server environment and uses pass-through queries that are communicated from a client to a server computer. *Id.* We are not persuaded that the passages in “Building Applications” relied upon by SAS disclose the limitation at issue. We are not persuaded that the language in these passages discloses the structure “server module 160 in connection with site

manager 70 and document manager 60, which are programs being run on a specially programmed general computing device” or its equivalent. SAS does not explain sufficiently how the distributed system described by “Building Applications” equates to the structure identified in the Specification. Pet. 57–58.

On this record, we are not persuaded that SAS has shown a reasonable likelihood of prevailing on its asserted grounds of obviousness of claims 11–14 over Coad combined with Oracle Primer, Oracle8 Primer, and any of the other asserted references.

C. Antis

1. Overview of Antis

Antis is described in the Prior Decision at pages 15–16. For the purposes of this decision, we adopt that prior description.

2. Obviousness Over Antis and Coad

SAS asserts that claims 2, 11, 12, 15, and 16 would have been obvious over Antis combined with Coad. Pet. 54–56. In the Prior Decision, the Board determined that SAS had shown, in its petition, a reasonable likelihood of prevailing in its assertion that claim 1 would have been obvious over this same combination of references. Prior Decision 18–19. Here, SAS relies on that determination to support the assertion that this combination of references shows all the limitations of claim 1. Pet. at 54 (“As explained in the Petition for *Inter Partes* Review for IPR2013-00226, and as recognized by the Board in its IPR2013-00226 Institution Decision, claim 1 would have been obvious over Antis in view of Coad.”). SAS relies on Coad as disclosing each of the additional limitations recited by claims 2, 11, 12, 15, and 16, all of which depend either directly or indirectly dependent from claim 1. *Id.* at 54–56.

a. Claim 2

As discussed above, claim 2 depends directly from claim 1 and recites the additional limitation “wherein the graphical representations of flows depicts data flows.” SAS relies on Coad as disclosing this limitation. Pet. at 54. As discussed above, SAS has not persuaded us that Coad discloses this limitation. On this record, we are not persuaded that SAS has shown a reasonable likelihood of prevailing on its asserted ground of obviousness of claim 2 over Antis combined with Coad.

b. Claims 11, 12, 15, and 16

Claim 11 depends directly from claim 1, claim 12 depends from claim 11, and claims 15 and 16 depend indirectly from claim 11. As discussed above, all of these claims include the means-plus-function limitation of claim 11 construed above—“means for allowing the source code to be executed both locally and remotely.” SAS asserts that both Coad and Antis disclose the structure corresponding to the claimed function. Pet. 55. As discussed above, we are not persuaded that Coad discloses this limitation. As to Antis, SAS asserts that “at col. 7, lines 55–61, Antis discloses a distributed system with remote execution of source code.” *Id.* The portion of Antis relied upon by SAS is reproduced below:

If there are multiple applications that use the same relation, the result will be multiple code sub-trees in the code view, as sub-trees 805 and 809. For the purposes of the code view, application code executing on multiple separate processors in a distributed system is considered to be multiple separate applications, each of which may be examined as a separate code sub-tree.

Ex. 1005, col. 7, ll. 55–61.

SAS does not explain how this language, which explains how source code is to be viewed in a user interface, relates in any way to the structure “server module 160 in connection with site manager 70 and document manager 60, which are

programs being run on a specially programmed general computing device” or its equivalent. On this record, we are not persuaded that SAS has shown a reasonable likelihood of prevailing on its asserted ground of obviousness of claims 11, 12, 15, and 16 over Antis combined with Coad.

3. Obviousness Over Antis, Coad, and Other References

SAS asserts that claims 11 and 12 would have been obvious over Antis, Coad, and “Building Applications” (Pet. 57–59); claim 13 would have been obvious over Antis, Coad, and Corda (Pet. 56); and claim 14 would have been obvious over Antis, Coad, and Access 97 Visual Basic (Pet. 56). As discussed above, we are not persuaded that Coad or “Building Applications” discloses the limitation of claim 11—“means for allowing the source code to be executed both locally and remotely”—included in all these claims. SAS does not assert that Corda or Access 97 Visual Basic discloses this limitation.

On this record, we are not persuaded that SAS has shown a reasonable likelihood of prevailing on obviousness of claims 11–14 over Antis combined with Coad and any of the other asserted references.

D. 35 U.S.C. § 325(d)

After considering the petition and all papers concerning joinder, we do not institute an *inter partes* review in this case. In determining whether to institute an *inter partes* review, the Board may “deny some or all grounds for unpatentability for some or all of the challenged claims.” 37 C.F.R. § 42.108(b); *see* 35 U.S.C. § 314(a). Furthermore, 35 U.S.C. § 325(d) reads as follows (emphasis added):

MULTIPLE PROCEEDINGS.—Notwithstanding sections 135(a), 251, 252, and chapter 30, during the pendency of any post-grant review under this chapter, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the post-grant review or other proceeding or matter may proceed, including providing for

the stay, transfer, consolidation, or termination of any such matter or proceeding. *In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.*

In addition to all of the grounds of unpatentability asserted by SAS, which we deny for the reasons explained above, SAS asserts the following grounds under 35 U.S.C. § 103(a):

- 1) obviousness of claims 3, 6, 8, and 10 over Coad, Oracle Primer, and Oracle8 Primer;
- 2) obviousness of claim 4 over Coad, Oracle Primer, Oracle8 Primer, and Burkwald;
- 3) obviousness of claim 5 over Coad, Oracle Primer, Oracle8 Primer, and Antis;
- 4) obviousness of claim 7 over Coad, Oracle Primer, Oracle8 Primer, and Eick; and
- 5) obviousness of claim 9 over Coad, Oracle Primer, Oracle8 Primer, and “Building Applications.

In IPR2013-00226, we initiated an *inter partes* review on claims 1 and 3–10. Prior Decision 21. For the claims challenged in this petition not disposed of above (claims 3 and 5–10), the grounds on which the trial was initiated in IPR2013-00226 were very similar to those remaining in this petition and listed above. For example, in this petition, the remaining proposed combinations with a base combination of Coad, Oracle Primer, and Oracle8 Primer, while the *inter partes* review was instituted on grounds based on Antis and Coad with the same additional references for the *same claims*. Specifically, as described above, the Board in IPR2013-00226 instituted a trial for claims 3 and 5–10 on the following

grounds:

- 1) obviousness of claim 1 over Coad, Oracle Primer, and Oracle8 Primer;
- 2) obviousness of claims 1, 3, 5, 6, 8, and 10 over Antis and Coad;
- 3) obviousness of claim 4 obvious over Antis, Coad, and Burkwald;
- 4) obviousness of claim 7 over Antis, Coad, and Eick; and
- 5) obviousness of claim 9 over Antis, Coad, and “Building Applications.

Thus, SAS’s petition in this case presents substantially the same prior art and arguments previously presented in its petition in IPR2013-00226. SAS provides no explanation as to why the grounds of unpatentability newly offered in this petition for claims already involved in an *inter partes* review afford any benefit over those on which we have begun proceedings. Indeed, SAS’s newly asserted grounds are based on essentially the same combinations of references with Antis replaced by the combination of Oracle Primer and Oracle8 Primer. SAS does not explain why, even though both Oracle Primer and Oracle8 Primer were included in the first petition, these newly presented combinations were not raised in the prior petition.

ComplementSoft argues that it would be prejudiced by the institution of this second petition because it would require ComplementSoft to respond and defend against challenges, either in an entirely separate second trial, or in a compressed time-frame—should the two proceedings be joined. Prelim. Resp. 30–31.

Pursuant to 35 U.S.C. § 316(b), rules for *inter partes* review were promulgated that take into account their effect on “the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings.” The Board’s rules provide that they are to be “construed to secure the just, speedy, and inexpensive resolution of every

proceeding.” 37 C.F.R. § 42.1(b). The practice of a particular petitioner filing serial petitions challenging claims already involved in an instituted proceeding and asserting arguments and prior art previously considered by the Board is contrary to the goals set forth in our statutory mandate and implementing rules. Under these circumstances, based on the record before us, and exercising our discretion under 35 U.S.C. §§ 314(a), 325(d), and 37 C.F.R. § 42.108(b), we deny the petition as to the remaining four grounds listed above because they are based upon substantially the same prior art and arguments as set forth in IPR2013-00226.

III. CONCLUSION

Upon consideration of the petition and preliminary response, we are not persuaded that there is a reasonable likelihood that SAS will prevail on at least one alleged ground of unpatentability with respect to the '936 patent that is not already the subject of a substantially equivalent challenge in IPR2013-00226. We, therefore, deny the petition for *inter partes* review and decline to institute trial on any of the asserted grounds as to any of the challenged claims. 37 C.F.R. § 42.108. We also dismiss SAS's motion for joinder as moot.

IV. ORDER

For the reasons given, it is

ORDERED that the petition is denied and no trial is instituted.

FURTHER ORDERED that the motion for joinder is dismissed as moot.

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