

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSTRATEGY, INC.

Petitioner

v.

ZILLOW, INC.

Patent Owner

Case IPR2013-00034

Patent 7,970,674

Before JAMESON LEE, JOSIAH C. COCKS, and MICHAEL W. KIM
Administrative Patent Judges.

KIM, *Administrative Patent Judge.*

DECISION
ON REQUEST FOR REHEARING
37 C.F.R. § 42.71

Introduction

On April 16, 2013, MicroStrategy filed a request for rehearing of the Board's decision ("Decision"), dated April 2, 2013, which instituted *inter partes* review of claims 2, 5-17, and 26-40 of Zillow's Patent 7,970,674. MicroStrategy contends that the Board also should have instituted review on claims 18-25.

In the Decision, the Board denied MicroStrategy's petition with respect to claims 18-25, because the petition failed to address how references Dugan and Kim collectively meet the following two limitations of claim 18, on which claims 19-25 depend:

- [1] wherein the adjustment of the obtained user input includes altering the home attributes indicated by an external data source to be possessed by the distinguished home, and
- [2] wherein the determined refined valuation is based at least in part on applying the geographically-specific home valuation model to the altered attributes.

The request for rehearing is *denied*.

Discussion

It is not in dispute that within the claim chart provided in MicroStrategy's petition, in the space provided for addressing the limitations of claim 18, no explanation is included for the two above-identified "wherein" limitations of claim 18. MicroStrategy, however, contends that it is an exercise of free choice in the form of presentation, to place arguments for claim 18 elsewhere, at a location designated for other claims, without indicating that those arguments also apply to claim 18, so long as an argument appears once somewhere in the petition. Specifically, MicroStrategy states (Rhg. Req. 2:6-14):

However, and notably, Part 42 of Title 37, Code of Federal Regulations, which governs proceedings before the Board, does not require that the petition conform to a specific manner or order in

demonstrating that each element of a challenged claim is found in the relied upon prior art. Part 42 also does not require that the petition redundantly identify relevant teachings from the relied upon prior art in demonstrating how the relied upon prior art satisfies redundant claim features. As such, when the same or similar feature is recited in multiple claims, it is not improper for a petition to establish where the feature is found in the relied upon prior art only a single time instead of redundantly addressing the feature in connection with each claim within which it is recited.

MicroStrategy's position is misplaced. If done properly, we agree that it is not improper to eliminate redundant text. But it is improper to omit arguments from where they are expected, based on explicit caption in the petition, and locate them where they are not expected, without leaving an explanatory notation. It might even be acceptable if an argument presented elsewhere is accompanied by an indication that that argument also applies at a different location in the petition to another claim, but that is not the circumstance here. MicroStrategy has pointed to nothing in its petition, which provides notice to either Zillow as the patent owner or the Board, that the arguments it presented for claims 30 and 32 also are made with respect to claim 18.

In any event, the second of the two "wherein" limitations of claim 18 does not appear in, and thus has no literal counterpart, in claims 30 and 32. The differences in terminology are not without substantive significance. As the petitioner, MicroStrategy bears the burden of proof that it is entitled to the relief requested in its petition. 37 C.F.R. § 42.20(c). Neither Zillow nor the Board has an obligation to evaluate the similarities and differences in claim limitations of different claims, for the purpose of determining whether the limitations are sufficiently similar, or insufficiently different, such that MicroStrategy's arguments directed to one should be deemed automatically as also directed to another. As stated in the Trial Practice Guide, the proceeding "begin[s] with the

filing of a petition that identifies all of the claims challenged and the grounds and supporting evidence on a claim-by-claim basis.” 77 Fed. Reg. 48756, 48757 (Aug. 14, 2012).

Zillow opposes MicroStrategy’s request for rehearing. During the initial telephone conference call conducted on April 18, 2013, counsel for Zillow noted that because of MicroStrategy’s omission of arguments from the context of claim 18, Zillow was provided insufficient notice as to MicroStrategy’s newly stated contentions with respect to claims 18-25. We agree.

Per 37 C.F.R. § 42.71, when rehearing a decision on petition, a panel will review the decision for an abuse of discretion. For all of the reasons discussed above, including (1) the reasons pertinent arguments for claim 18 were omitted, (2) the difference in language between claim 18, and claims 30 and 32, and (3) potential prejudice on patent owner Zillow, MicroStrategy has not shown an abuse of discretion in the non-institution of *inter partes* review of claims 18-25.

Conclusion

MicroStrategy’s request for rehearing is *denied*.

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