

Google Scores Rare Rehearing In AIA Review

By **Matthew Bultman**

Law360, New York (June 16, 2016, 2:49 PM ET) -- Google Inc. won a rare rehearing at the Patent Trial and Appeal Board on Wednesday, when the board conceded to having misapprehended some of the internet search giant's arguments about the obviousness of certain claims in a web patent.

The board had agreed in April to institute an America Invents Act covered business method review of Brite Smart Corp. CEO Patrick Zuili's patent on the grounds that some of its claims covered only abstract ideas.

But PTAB refused to institute trial on Google's argument that those claims were also made obvious by some earlier writings. The board reversed course Wednesday, saying that after further review, PTAB was convinced Google was likely to win on those arguments too.

"Petitioner has persuaded us that we misapprehended its arguments in regards to the disclosures" of some prior art references, the board wrote.

The patent is one of four that Brite Smart had accused Google in 2014 of infringing with its pay-per-click advertising services and systems, including those used in connection with its search engine, AdWords, DoubleClick and AdSense.

U.S. District Judge Beth Labson Freeman in San Jose, California, dismissed the lawsuit in March 2016, after the case was transferred from Texas. The judge said Brite Smart failed to obtain local counsel by a court-imposed deadline. Local counsel was necessary because Brite Smart's attorney was not admitted to the Northern District of California bar.

Prior to the case's dismissal, Google filed petitions with PTAB and challenged claims in three of the four patents asserted by Brite Smart. The board agreed to institute a covered business method review of all three.

Google's rehearing request focused on one of PTAB's April institution decisions. In it, the board said Google was likely to win on its arguments the challenged claims in one patent were invalid because they were directed toward the abstract concept of "detecting invalid clicks based on the time between two requests by the same device."

The board declined to institute trial, however, on arguments that some claims were also obvious when viewed in light of a 2001 ad measurement study. Google made additional obviousness arguments based

on a combination of the study and a 1998 book called “Cookies.”

Urging the board to reconsider instituting trial on the obvious arguments, Google said the board’s initial analysis overlooked evidence about some of the study’s disclosures. When properly taken into account, the prior art teaches the limitations of the challenged claims, it said.

“Petitioner respectfully requests that the board reconsider ... because the petition demonstrated how the one alleged missing limitation of independent claim 1 was disclosed in the [study],” Google wrote in its filing last month.

“We are persuaded by petitioner’s arguments and evidence,” the board said Wednesday, instituting review on Google’s suggested grounds.

Such reversals are uncommon at PTAB. By some accounts the board has granted less than 10 percent of motions for reconsideration in AIA inter partes and covered business method reviews.

Zuili and an attorney for Google could not immediately be reached for comment Thursday.

The patent-in-suit is U.S. Patent Number 8,671,057.

Google is represented by Saqib Siddiqui of Mayer Brown LLP.

Zuili is representing himself.

The case is Google Inc. v. Zuili, case number CBM2016-00008, before the Patent Trial and Appeal Board.

--Editing by Edrienne Su.

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