

## Commerce Bancshares, Compass Bank, and First National Bank of Omaha v. Intellectual Ventures II LLC, Denying Institution IPR2014-00801

Article By:

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*Takeaway: An important consideration in determining whether a non-party should be identified as a real-party-in-interest is whether the non-party exercises, or could have exercised, control over a party's participation in the proceeding.*

In its [Decision](#), the Board found that Petitioner had shown a reasonable likelihood that it would prevail in demonstrating that claims 26, 28, and 30-33 of the '084 patent are unpatentable on at least one challenged ground. Accordingly, the Board instituted *inter partes* review of these claims. The Board did not, however, authorize any other grounds of unpatentability alleged in the Petition.

The '084 patent relates to, for example, a method of alerting at least one of multiple devices in a networked computer system an anomaly, with at least one of the plurality of devices having a firewall. The asserted grounds of unpatentability included Aucsmith as applied to claims 1-9 and 11-33 under 35 U.S.C. § 102(e); and Aucsmith and Gleichauf as applied to claims 1-33 under 35 U.S.C. § 103.

Patent Owner asserted that the Petition should be denied because Petitioner failed to name Banco Bilbao Vizcaya Argentaria, S.A. (BBVA) and IBM as real parties-in-interest. But the Board found that Patent Owner had not sufficiently demonstrated that either BBVA or IBM exercised, or could have exercised, control over the filing of the Petition, or that BBVA or IBM funded, directed, and controlled the filing of the Petition. Thus, the Board did not deny the Petition as failing to identify all real parties-in-interest under 35 U.S.C. § 312(a)(2).

The Board construed the claim term “anomaly” as meaning “departure from the usual or expected; an abnormality or irregularity,” and construed “determining which of the plurality of devices are anticipated to be affected by the anomaly” (“the determining limitation”) as meaning “deciding or ascertaining which devices are expected or foreseen to be affected by the anomaly.”

The Board then addressed Petitioner’s challenge to claims 1-9 and 11-33 as being anticipated by Aucsmith, a reference which “discloses an intrusion detection system to help discover illicit attempts to access resources and actual security breaches.” The Board denied Petitioner’s Aucsmith-based anticipation challenge to claims 1-9, 11-25, 27, and 29 because the Board did not find the

determining limitation to be expressly or inherently disclosed by Aucsmith. The Board found that Petitioner had established that there is a reasonable likelihood that claim 26, which does not recite the aforementioned determining limitation, is anticipated by Aucsmith. The Board also concluded that Petitioner had established that there is a reasonable likelihood that claims 28 and 30-33 are anticipated by Aucsmith.

In response to Petitioner's assertion that claims 1-33 are unpatentable as obvious over Aucsmith and Gleichauf, the Board found that Petitioner's proposed rationale for combining these two references ("it would have been obvious to one having ordinary skill in the art at the time of the alleged invention to include any aspect of one identified prior [art] reference in any other identified prior art reference") to be sufficiently specific. The Board found that Petitioner's proposed proffered rationale for combining Aucsmith and Gleichauf was based on hindsight reasoning, as well. Thus, the Board was not persuaded that Petitioner had established a reasonable likelihood that claims 1-33 would have been obvious over Aucsmith and Gleichauf.

***Commerce Bancshares, Inc., Compass Bank, and First National Bank of Omaha v. Intellectual Ventures II LLC, IPR2014-00801***

**Paper 7: Decision on Institution of *Inter Partes* Review**

**Date: December 1, 2014**

**Patent 6,715,084 B2**

**Before: Kristen L. Driesch, Jennifer S. Bisk, and Justin Busch**

**Written by: Bisk**

**Related Proceedings: IPR2014-00681; IPR2014-00682; IPR2014-00793; also, "Petitioner indicates that the '084 patent is the subject of concurrent proceedings in various district courts, several of which name one or more of the named petitioners as a defendant."**

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