

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.,
Petitioner,

v.

ALMONDNET, INC.,
Patent Owner.

IPR2022-01436
Patent 8,244,582 B2

Before KEN B. BARRETT, THOMAS L. GIANNETTI, and
LYNNE H. BROWNE, *Administrative Patent Judges*.

BROWNE, *Administrative Patent Judge*.

DECISION
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 314

I. INTRODUCTION

We have authority to hear this *inter partes* review under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, we determine that Petitioner, Meta Platforms, Inc., has shown by a preponderance of the evidence that claims 11, 13–16, 19, and 20 (the “challenged claims”) of U.S. Patent No. 8,244,582 B2 (Ex. 1001, “the ’582 Patent”) are unpatentable. *See* 35 U.S.C. § 316(e) (2018); 37 C.F.R. § 42.1(d) (2019).

A. *Procedural History*

The Petition (Paper 1, “Pet.” or “Petition”) requested *inter partes* review of the challenged claims of the ’582 Patent. Patent Owner, Almondnet, Inc., filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). Based upon the record at that time, we instituted *inter partes* review on all challenged claims on the grounds presented in the Petition. Paper 9 (“Institution Decision” or “Dec.”).

After institution, Patent Owner filed a Response (Paper 17, “PO Resp.”), Petitioner filed a Reply (Paper 20, “Pet. Reply”), and Patent Owner filed a Sur-reply (Paper 22, “PO Sur-reply”).

On January 3, 2024, an oral hearing was held. The transcript of this hearing was entered in the record of this proceeding as Paper 29 (“Tr.”).

B. *Real Parties in Interest*

Petitioner identifies itself as the real party-in-interest in this proceeding. Pet. 8. Patent Owner identifies itself as the real party-in-interest. Paper 3, 1.

C. Related Matters

The parties identify *AlmondNet, Inc. and Intent IQ, LLC v. Meta Platforms, Inc.*, 6:21-cv-00896 (W.D. Tex.); *AlmondNet, Inc., et al. v. Microsoft Corporation*, 6:21-cv-00897 (W.D. Tex.); *AlmondNet, Inc., et al. v. Amazon.com, Inc., et al.*, 6:21-cv-00898 (W.D. Tex.); *AlmondNet, Inc. v. Samsung Electronics Co.*, 6-21-cv-00891 (W.D. Tex.); *AlmondNet, Inc. v. Roku, Inc.*, 6-21-cv-00876 (W.D. Tex.); *AlmondNet, Inc. v. Oath Holdings Inc.*, 1-19-cv-00247 (D. Del.) (terminated); *AlmondNet, Inc. v. Roku, Inc.*, 1:22-cv-01540 (D. Del.); *AlmondNet, Inc. et al. v. Meta Platforms, Inc.*, 4:22-cv-08911 (N.D. Cal.); and *AlmondNet, Inc. et al. v. Samsung Electronics Co., Ltd. et al.*, 3:22-cv-07515 (N.D. Cal.) as civil litigations involving the '582 Patent. Pet. 7; Paper 3, 1; Paper 6, 1. The parties also identify *Samsung Electronics Co. v. AlmondNet, Inc.*, IPR2022-01260 (PTAB) (denied); *Yahoo! Inc. v. AlmondNet, Inc.*, CBM2017-00052 (PTAB) (denied); and *Amazon.com, Inc. et al. v. AlmondNet, Inc.*, IPR2022-01455 (PTAB) (denied) as proceedings involving the '582 Patent. Pet. 8–9; Paper 3, 1; Paper 6, 1.

D. The '582 Patent

The '582 Patent relates to a mercantile method directed to brokerage of attributes of information. Ex. 1001, 1:29–31.

The method includes the steps of: from a user, receiving a transaction having therein a first partial profile; using the first partial profile, searching a databank having a plurality of second partial profiles, wherein is included in said data bank at least one null profile so that said searching will always yield at least one proximate second partial profile to the first partial profile; and between the user and the databank, contracting: (I) for the databank to own or represent a right to a first mutually agreed portion of the first partial profile, and substantially thereafter said

databank incorporating the agreed portion of the first profile into at least one second partial profile; or (II) for the user to own or represent a right to a second mutually agreed portion of at least one said proximate second partial profile, and substantially thereafter the databank transmitting to the user the second mutually agreed portion of the second profile.

Id. at code (57).

E. Illustrative Claim

Petitioner challenges claims 11, 13–16, 19, and 20. Pet. 10. Claim 11 is an independent claim.

Claim 11 is reproduced below.

11. A tangible, non-transitory data storage medium comprising indicia of instructions for a processor to perform a method of collecting profiles of Internet-using entities, the method comprising:

(a) electronically receiving at a programmed computer system coupled to a global computer network, from at least one server controlled by one of a plurality of unaffiliated third parties, a partial profile of an entity that uses a user computer coupled to the global computer network and accessing a website, which partial profile is available to one of the third parties and contains at least one profile attribute related to the entity, and automatically with the computer system storing the received partial profile;

(b) wherein receiving the partial profile is achieved as a result of automatic electronic URL redirection from a portion of a page of the website accessed by the user computer;

(c) automatically with the computer system electronically adding the received partial profile to a maintained profile believed to be related to the same entity;

(d) automatically with the computer system generating and storing an electronic record of which of the plurality of unaffiliated third parties contributed to the maintained profile particular profile attributes;

(e) wherein the maintained profile, including the added partial profile, comprises data used in targeting third party advertisements to the user computer over the global computer network.

Ex. 1001, 17:45–18:8.

F. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
11, 13–15, 19, 20	103	Rosenberg, ¹ Zeff, ² Sterne ³
16	103	Rosenberg, Zeff, Sterne, Farber ⁴
11, 13–15, 19, 20	103	Rosenberg, Zeff, Sterne, Merriman ⁵
16	103	Rosenberg, Zeff, Sterne, Merriman, Farber

Pet. 10.

G. E. Evidence

Petitioner supports its challenge with the Declarations of Christopher M. Schmandt (Ex. 1002, Ex. 1019). Patent Owner supports its response with the Declaration of Robert J. Sherwood (Ex. 2001).

¹ Rosenberg et al., U.S. Patent No. 6,073,241, issued June 6, 2000 (Ex. 1003) (“Rosenberg”).

² Zeff, R., et al., *Advertising on the Internet*, John Wiley & Sons, Inc., pp. 1–27, 89–109, 1997 (Ex. 1004) (“Zeff”).

³ Sterne, Jim, *What Makes People Click: Advertising on the Web*, Que Corporation, pp. 1–41, 145–256, 375–386, 1997 (Ex. 1005) (“Sterne”).

⁴ Farber et al., U.S. Patent No. 5,978,791, issued Nov. 2, 1999 (Ex. 1007) (“Farber”).

⁵ Merriman et al., U.S. Patent No. 8,566,154 B2, issued Oct. 22, 2013 (Ex. 1008) (“Merriman”).

II. ANALYSIS

A. *Principles of Law: Obviousness*

A claim is unpatentable as obvious under 35 U.S.C. § 103 if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) objective evidence of nonobviousness, i.e., secondary considerations.⁶ *See Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966).

The Supreme Court has made clear that we apply “an expansive and flexible approach” to the question of obviousness. *KSR*, 550 U.S. at 415. Whether a patent claiming the combination of prior art elements would have been obvious is determined by whether the improvement is more than the predictable use of prior art elements according to their established functions. *Id.* at 417. Reaching this conclusion, however, requires more than a mere showing that the prior art includes separate references covering each separate limitation in a claim under examination. *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011). Rather, obviousness requires the additional showing that a person of ordinary skill would have

⁶ The current record does not present or address any evidence of nonobviousness.

selected and combined those prior art elements in the normal course of research and development to yield the claimed invention. *Id.*

B. Level of Ordinary Skill in the Art

In determining the level of skill in the art, we consider the type of problems encountered in the art, the prior art solutions to those problems, the rapidity with which innovations are made, the sophistication of the technology, and the educational level of active workers in the field. *Custom Accessories, Inc. v. Jeffrey-Allan Indus. Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986); *Orthopedic Equip. Co. v. U.S.*, 702 F.2d 1005, 1011 (Fed. Cir. 1983).

Petitioner contends that a person of ordinary skill in the art at the time of the invention of the '582 Patent “would have possessed a bachelor’s degree in electrical engineering or computer science, and two years of work experience in the field of network-based computer systems, such as systems for sending and receiving information over local networks and wide area networks (such as the Internet or World Wide Web).” Pet. 12. (citing Ex. 1002 ¶¶ 10–14). Petitioner asserts further that “[a] person could also have qualified with more formal education and less technical experience, or vice versa.” *Id.* Patent Owner does not challenge this definition of the level of skill. PO Resp. 5.

For purposes of this Decision, we also adopt Petitioner’s proposal as reasonable and consistent with the prior art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (the prior art may reflect an appropriate level of skill in the art).

C. Claim Construction

We apply the same claim construction standard used in district court actions under 35 U.S.C. § 282(b), namely that articulated in *Phillips v. AWH*

Corp., 415 F.3d 1303 (Fed. Cir. 2005) (en banc). *See* 37 C.F.R. § 42.100(b) (2021). In applying that standard, claim terms generally are given their ordinary and customary meaning as would have been understood by a person of ordinary skill in the art at the time of the invention and in the context of the entire patent disclosure. *Phillips*, 415 F.3d at 1312–13. “In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17).

Petitioner states that it “does not believe an express claim construction is necessary at this time for this IPR” and Patent Owner “agrees that claim construction is not necessary to resolve any issue . . . and that the plain and ordinary meaning of the claim language should be applied.” *See* Pet. 13 (citing Ex. 1002 ¶ 37); PO Resp. 6.

We agree with the parties that no claim terms require express construction. *See Vivid Techs.*, 200 F.3d at 803 (holding that only terms that are in controversy need to be construed, and “only to the extent necessary to resolve the controversy”). To the extent that the meaning of any claim term is addressed, we use its ordinary and customary meaning as discussed in our analysis below.

D. Overview of the Asserted Prior art

1. Rosenberg

Rosenberg is a U.S. Patent for an “Apparatus and Method for Tracking World Wide Web Browser Requests Across Distinct Domains Using Persistent Client-Side State” that issued June 6, 2000. Ex. 1003,

codes (45), (54). Rosenberg describes a method that “allows a web browser to be passively tracked so that content preferences and interests associated with the individual using the web browser can be identified.” *Id.* at 3:25–28. In particular, the method “allows all cooperating servers to share information via a database” in which “persistent client-side state information can be combined with authentication data in the database to provide demographic information and passive tracking information regarding the individual using the web browser.” *Id.* at 3:28–32. “This information can be used to provide responses tailored toward the individual using the web browser” and also “would allow editors and advertisers to tailor their content to users.” *Id.* at 3:35–36, 3:7–8.

Rosenberg’s method is performed by the system shown in Figure 1 reproduced below:

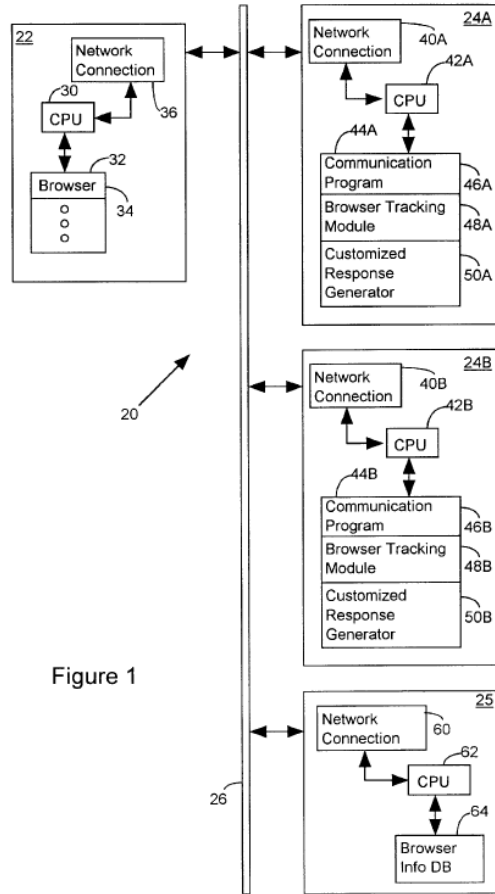


Figure 1

Figure 1 shows computer network 20 including client computer 22, server computer 24A, server computer 24B (although computer network 20 can have many server computers such as server computers 24A–24N), and database server computer 25. Ex. 1003, 3:66–4:24. “[C]omputer network 20 may be considered as a simplified representation of the WWW” in which “a web browser is used to communicate with” remote server computers 24A, 24B. *Id.* at 4:1–2, 4:11–12. Server computers 24A, 24B cooperatively observe a common protocol that “relies upon a common database of information, such as that available in” database server computer 25, to track web browsers across distinct domains. *Id.* at 4:52–59.

Rosenberg’s Figure 2 is reproduced below:

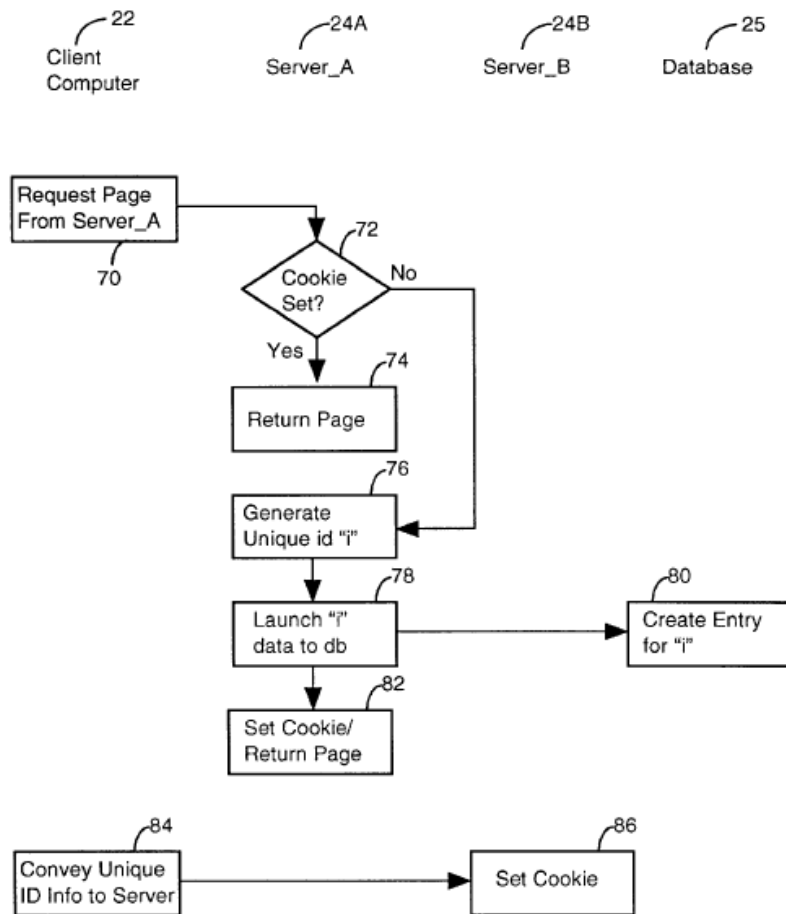


Figure 2

Figure 2 shows operations performed relative to client computer 22, server computer 24A (Server_A), server computer 24B (Server_B), and database server computer 25 (Database 25). Ex. 1003, 4:65–5:1. In first step 70, client computer 22’s browser requests a page of information from a first server so that “Server 24A receives the request and determines if it has set a cookie for this browser” via step 72. *Id.* at 5:1–6. If there is such a cookie, “the requested page is simply returned” in step 74, and if not, “Server 24A generates a unique identification value ‘i’” in step 76. *Id.* at

5:7–9. The unique identification value “i” “is then launched to a database” in step 78 so that Database 25 creates an entry for unique identification value “i” in step 80. *Id.* at 5:9–12. Unique identification value “i” “is accessible by each server computer 24 in the network” and a cookie is set “corresponding to the unique identification value and return . . . page of the requested information” in step 82 (detailed in steps 84, 86). *Id.* at 5:14–19. The cookie is the “persistent client-side state information” and “the return[] page includes instructions to convey the unique identification information to additional server computers that are observing the same protocol” in step 84. *Id.* at 5:19–24. Thus, client computer 22 receives the return page from Server 24A with a header that “includes the cookie with the unique identification information” and “an instruction to convey the unique identification information to each server in the network of servers that is operating in accordance with” computer network 20. *Id.* at 5:24–31.

Rosenberg’s Figure 3 reproduced below:

Cookie ID #	Last Visit to Server_A	Content Requested			Last Visit to Server_B	Content Requested		
		News	Product Info	Feature Story		News	Product Info	Feature Story
123	4-9-96;18:25	2	5	0	7-4-96;16:23	1	7	3

Figure 3

Figure 3 shows “a data structure that may be used to store information regarding the interaction between” a browser and Server 24. Ex. 1003, 5:55–57. “[T]he information associated with this data structure is stored in the access logs of each” server computer 24 and is passed to the database server computer 25, “typically at the end of a day or at other times when network traffic is light.” *Id.* at 5:57–62. In the first column, a “cookie ID #”

is indicative of the unique identification number, which is separate for an “entry for server A and for server B.” *Id.* at 5:63–66. “In particular, the data structure tracks the content requested during the last visit to the server A” and content requested during the last visit to server B. *Id.* at 5:66–6:5. “In this example, the user of the web browser requested two pages of news and five page of product information” in the visit to server A. *Id.* at 6:2–4.

Rosenberg explains that a browser tracking module “creates a page and embeds within it HTML that references a specific URL on another server computer, say server computer B 24B, which is referred to as B-correlate” in which the URL has a form that includes “i” “where i’ is an encoding of the identifier ‘i’ (the unique identification information).” Ex. 1003, 8:12–17. The browser tracking module “delivers an HTTP header that sets the cookie to i and returns any additional data that is required” and “[t]here are several ways in which an HTML reference to another site can be embedded in a page.” *Id.* at 8:30–35. Rosenberg further discloses:

An HTML cross-site reference with a frame tag may also be used. With this method, the page contains frames, one of which references a page on another site. For example,

```
<FRAMESET COLS=“12”>  
< FRAME SRC = “http://www.search.com/cnet.cgi?3676778”>  
<FRAME SRC=column2.html”>  
</FRAME>
```

An advantage of this approach is that the request will be made automatically, without the need for human action.

Id. at 8:55–65.

2. *Zeff*

Zeff is a book titled “Advertising on the Internet.” Ex. 1004. *Zeff* discloses that “Firefly” is a technology that is “known as a smart or

intelligent agent [which] combines information provided through registration with the capability to make inferences based on user tastes and preferences pooled from a group.” *Id.* at 105.⁷ Zeff discloses:

When a user joins the Firefly network, he or she is issued a Firefly Passport. Users must log in each time they return to Firefly’s site. Firefly uses this to track a user’s actions and learn[s] the user’s preferences; the Passport stores demographic and preference information, and follows the user on any Firefly-enhanced site that he or she visits. Nearly a million consumers registered for a Firefly Passport in 1996.

Any site can be enhanced to be part of the Firefly network. For an advertiser, this means going beyond general demographic targeting and delivering ads to individuals who have indicated (through their actions) an interest in the product.

Id. at 105–106.

3. *Sterne*

Sterne is a book titled “What Makes People Click: Advertising on the Web.” Ex. 1005. *Sterne* describes a technology called “Passport” that is created by “Firefly” and states:

Think of them as the Secretary of State. They know who’s who and they keep all of the basic profile information in Firefly Central which they describe on their site as “a rapid cache of Firefly Passports which can be used by any site to recognize existing Passport holders and exchange Passport profiles with other sites.”

Id. at 251.⁸

⁷ Petitioner refers to its added page numbers to Zeff. We refer to the original page numbers of Zeff.

⁸ Petitioner refers to its added page numbers to *Sterne*. We refer to the original page numbers of *Sterne*.

4. *Farber*

Farber is a U.S. Patent for “Data Processing System Using Substantially Unique Identifiers to Identify Data Items, Whereby Identical Data Items Have the Same Identifiers,” that issued on November 2, 1999. Ex. 1007, codes (45), (54). Farber discloses that “when a processor (or some location) obtains a data item from another location in the DP [(data processing)] system, it is possible that this obtained data item is already present in the system (either at the location of the processor or at some other location accessible by the processor) and therefore a duplicate of the data item is created.” *Id.* at 2:46–52. Farber describes “mechanisms” that depend on underlying data management mechanisms to create, copy, read, and delete data items in a “True File registry” which includes a “primitive mechanism” called “Calculate True Name.” *Id.* at 12:27–54. “A True Name is computed using a function, MD, which reduces a data block B of arbitrary length to a relatively small, fixed size identifier, the True Name of the data block, such that the True Name of the data block is virtually guaranteed to represent the data block B and only data block B.” *Id.* at 12:55–60. Farber further discloses a “mechanism for assimilating a data item” into a file system, in which “[t]he purpose of this mechanism is to add a given data item to the True File registry” and “[i]f the data item already exists in the True File registry[],” the duplicate will be discovered and eliminated. *Id.* at 14:41–47.

5. *Merriman*

Merriman is a U.S. Patent for “Network for Distribution of Re-Targeted Advertising” that issued on October 22, 2013. Ex. 1008, codes (45), (54). Merriman discloses:

To implement re-targeted advertising, a list of actions of each visitor at each advertiser's site is collected and reported back to the advertisement server. In one embodiment, the advertiser's web site reports activity in real time. In another embodiment, the advertiser's web site keeps a user log file of visitor activity and reports the user log file back to the advertisement server. Reporting of user log files may be by email or any other file transfer technique back to the advertisement server, where the user log files and other user data are merged.

Id. at 3:35–44.

E. Ground 1: Obviousness of Claims 11, 13–15, 19, and 20 Over Rosenberg, Zeff, and Sterne

Petitioner contends that claims 11, 13–15, 19 and 20 are unpatentable over the combined teachings of Rosenberg, Zeff, and Sterne. Pet. 16–63.

Patent Owner disputes Petitioner's contentions. Prelim. Resp. 6–39.

1. Independent Claim 11

a) Preamble - A tangible, non-transitory data storage medium comprising indicia of instructions for a processor to perform a method of collecting profiles of Internet-using entities, the method comprising:

Petitioner asserts that “Rosenberg discloses the claimed ‘method of collecting profiles of Internet using entities.’” Pet. 16.⁹ Petitioner asserts that “[t]he ‘Internet-using entities’ for claim 11 correspond in Rosenberg to users who access the Internet using web browsers on client computers.” *Id.* at 18. Petitioner asserts further that Rosenberg's “database server 25 collects two types of user profile information: (1) tracked user activity and (2) demographic information.” *Id.* (citing Ex. 1002 ¶¶ 80–83).

⁹ Emphasis and highlighting in quoted text from the Petition, Patent Owner's Response, Petitioner's Reply, and Patent Owner's Sur-reply are omitted in this Decision.

Patent Owner does not dispute Petitioner's assertions. *See generally* Prelim. Resp.

b) Limitation (a) - electronically receiving at a programmed computer system coupled to a global computer network, from at least one server controlled by one of a plurality of unaffiliated third parties, a partial profile of an entity that uses a user computer coupled to the global computer network and accessing a website, which partial profile is available to one of the third parties and contains at least one profile attribute related to the entity, and automatically with the computer system storing the received partial profile;

Petitioner provides a table (i.e., claim chart) outlining its assertions of how claim limitation (a) reads on Rosenberg. Pet. 21–22. We have reviewed this table, but do not reproduce it as Patent Owner does not dispute Petitioner's assertion that limitation (a) reads on Rosenberg. *See generally* Prelim. Resp.

c) Limitation (b) - wherein receiving the partial profile is achieved as a result of automatic electronic URL redirection from a portion of a page of the website accessed by the user computer;

(1) Petitioner's Assertions

Petitioner asserts that Rosenberg meets limitation (b). *See* Pet. 42–46. In particular, Petitioner asserts that “[t]he ‘automatic URL redirection’ in Rosenberg occurs when the web browser is redirected to Server_B 24B when it encounters the <FRAME SRC> attribute in the webpage provided by Server_A 24A . . . which directs the browser to obtain a webpage from Server_B 24B at the URL specified in the attribute.” *Id.* at 43 (citing Ex. 1002 ¶ 125). According to Petitioner, “[t]his qualifies as ‘automatic URL redirection’ because the <FRAME SRC> attribute causes the web

browser—which is currently accessing the webpage provided by Server_A 24A—to contact a server at a different location (Server_B 24B) to request a webpage from the specified URL.” *Id.* at 42–43 (citing Ex. 1003, 8:56–58, 5:36–38).

Petitioner asserts that “[t]he automatic URL redirection in Rosenberg . . . [is] ‘from a portion of a page of the website accessed by the user computer,’ with the ‘portion of a page of the website’ corresponding to a portion of a page of the website provided by Server_A 24A (‘the website’) accessed by the user computer.” Pet. 43. Petitioner asserts further that “receipt of the partial profile from Server_B 24B [is] ‘achieved as a result of’ the automatic URL redirection” because URL redirection from Server_A 24A causes the user’s browser to contact and access the webpage from Server_B 24B which in turn enables the user to request news, product information, and feature story pages from Server_B 24 B. *Id.* According to Petitioner, these actions generate the claimed partial profile. *Id.* (citing Ex. 1003, Fig. 3).

Alternatively, Petitioner asserts that “Rosenberg discloses the ‘achieved as a result of’ limitation in another way.” Pet. 45. Petitioner asserts that “the user activity received at database server 25 is stored based on the unique user identification value, for example, Cookie ID #123 in Figure 3.” *Id.* (citing Ex. 1003, 5:63–65). Petitioner asserts further that “[t]his unique identification value is critical to Rosenberg because it allows database server 25 to store and retrieve tracking information on a user-by-user basis.” *Id.* Petitioner asserts that “as shown in Figure 3, database server 25 can record tracking activity for the same user for Server_A 24A and Server_B 24B.” *Id.* (citing Ex. 1002 ¶ 122). According to Petitioner,

[t]he ability of Server_B 24B to send “partial profile” information to database server 25 was thus achieved “as a result of” the URL redirection, because it was that URL redirection that furnished Server_B 24B with the user identification value that database server 25 needed in order to receive the “partial profile” from Server_B 24B and store it in association with that user.

Pet. 45–46 (citing Ex. 1003, Fig. 3, 5:63–65).

(2) *Patent Owner’s Response*

Regarding Petitioner’s first theory, Patent Owner contends that “Petitioner’s expert admits that ‘the user in Rosenberg could have directly navigated to and accessed Server_B 24B via its web browser without accessing the frame-based webpage provided by Server_A 24A (for example by entering the URL for Server_B 24B into the web browser address bar),” such that “the user would be able to ‘request news, product information and feature story pages from Server_B 24B’ without any redirection from Server_A 24A.” PO Resp. 36 (citing Pet. 44). Thus, according to Patent Owner, “the user can submit requests that result in profile information being transmitted to database server 25 without the alleged redirection” and “the Petition’s first theory, under which Rosenberg’s frame allegedly ‘enabled the user to request news, product information and feature story pages’ from Server B is unsupported.” *Id.* (citing Ex. 2001 ¶¶ 84–85).

Regarding Petitioner’s alternative theory, Patent Owner contends that the Petition “cannot support the core premise underlying its second argument: that a ‘user identification value’ received from Server_A is ‘needed’ for database server 25 to ‘receive the “partial profile” from Server_B 24B and store it in association with that user.’” PO Resp. 37.¹⁰

¹⁰ It is not clear what Patent Owner’s *Id.* citation refers to, but it appears to be a citation to pages 45–46 of the Petition.

Patent Owner contends further that “Rosenberg explicitly contradicts the Petition on this point” in that

Rosenberg teaches that, in the case where a user visits the website hosted by Server_B 24B after the user visits Server_A 24A, but the unique identification information from Server_A 24A did “not reach” server 24B (e.g., “if the instruction to pass the unique identification information is defeated by programming instructions associated with the client computer 22, or . . . by some network interruption”), server 24B will assign its own unique identifier “j” to the user, which differs from the unique identifier “i” previously assigned by server 24A.

Id. (citing Ex. 1003, 6:10–28). According to Patent Owner, “Rosenberg teaches that this ‘processing results in a database entry for the “j” identification value,’ such that database server 25 can receive profile information from server 24B using the ‘j’ identification value, even though server 24A previously assigned that user an identification value of ‘i.’” *Id.* at 37–38 (citing Ex. 1003, 6:23–32). Subsequently, according to Patent Owner,

database 25 will “merge the previously separate ‘i’ and ‘j’ entries,” such that the database is able to associate profile information regarding the user’s visit to the webpage hosted by server 24B with a common unique identifier, even though the alleged redirection from 24A did not provide the unique identifier “i” to server 24B. Thus, if server 24A previously assigned ID “123” to the user, and server 24B later assigned ID “456” to the user,[] database server 25 will associate profile information obtained from both servers 24A and 24B with both cookie IDs “123” and “456.”

Id. at 38 (citing Ex. 1003, 6:32–58, Figs. 4–5).

Patent Owner contends further that

Rosenberg does not need Server_A’s unique identifier to be transferred to Server_B in order for a partial profile describing a user’s content requests from Server_B to be received and stored

in association with the user. Thus, the Petition’s premise that “URL redirection . . . furnished Server_B 24B with the user identification value that database server needed in order to receive the ‘partial profile’ from Server_B 24B and store it in association with that user” (*see* Pet. at 45–46) is false, and the Petition’s theory based on that premise cannot succeed.

PO Resp. 38–39 (citing Ex. 2001 ¶¶ 86–89).

(3) *Petitioner’s Reply*

Petitioner replies that Patent Owner’s argument (regarding its first theory) that “it would have been possible for the user to bypass the frame-based webpage provided by Server_A 24A by directly navigating to the webpage provided by Server_B 24B” is irrelevant, because “Federal Circuit law is clear that ‘a prior art [reference] that sometimes, but not always, embodies a claimed method nonetheless teaches that aspect of the invention.’” Pet. Reply 16 (citing PO Resp. 35–36; Ex. 2001 ¶ 85; *Hewlett-Packard Co. v. Mustek Sys., Inc.*, 340 F.3d 1314, 1326 (Fed. Cir. 2003)) (alteration in original). Petitioner replies further that “[i]n the particular embodiment in Rosenberg relied upon in the Petition, in which the webpage from Server_B 24B was automatically accessed via the frame-based web page provided by Server_A 24A (Rosenberg, 8:56–65), the receipt of the partial profile from Server_B 24B would have occurred ‘as a result’ of automatic URL redirection, as explained in the Petition.” *Id.* at 16–17 (citing Pet. 44–45.) According to Petitioner, “[n]othing in the claim excludes a system in which a receipt of the partial profile, at other times, may not be achieved as a result of automatic URL redirection.” *Id.* at 17 (citing Ex. 1019 ¶ 41).

Turning to its alternative (i.e., second theory), Petitioner replies that Patent Owner’s “argument again violates the legal principle described above

that invalidity is not avoided by merely arguing that Rosenberg only ‘sometimes’ performs the steps of claim 11.” Pet. Reply 18 (citing *Hewlett-Packard Co.*, 340 F.3d at 1326). According to Petitioner, “[t]he embodiment relied upon by Patent Owner is little more than a failsafe mechanism to address an unusual situation in which, due to an error condition or malfunction, Server_B 24B was prevented from receiving the unique identification value (‘i’) from Server_A 24A.” *Id.* at (citing Ex. 1019 ¶ 44). Petitioner replies further that

Patent Owner’s reliance on this alternative embodiment establishes—at most—that there could be times when the system is not functioning properly such that the partial profile in Rosenberg is not received as a result of the claimed automatic URL redirection. But in the primary embodiment in Rosenberg relied upon in the Petition—in which the system functions properly and Server_B 24B receives the unique identification value (‘i’) from Server_A 24A—the partial profile would have been received “as a result of” the claimed automatic URL redirection.

Id. (citing Pet. 45–46; Ex. 1019 ¶ 45).

(4) *Patent Owner’s Sur-reply*

Regarding the Petition’s first theory, Patent Owner responds that “Petitioner does not explain or identify how the redirection enables the transmission of a partial profile.” PO Sur-reply 23 (citing PO Resp. 35–36). Patent Owner argues in Rosenberg “the user can submit requests that result in profile information being transmitted to database server 25 without the alleged redirection.” *Id.* at 24 (citing PO Resp. 36). Patent Owner argues further that “the Petition’s ‘enable’ theory of redirection does not make transmission of a partial profile possible, nor is it a necessary prerequisite for the transmission of a partial profile” because “[a] partial profile can be transmitted using any number of methods.” *Id.*

Regarding the Petition's second theory, Patent Owner responds that "[t]he Petition's second theory fares no better. Here, the Petition alleges that Rosenberg's 'user identification value' is 'needed in order to receive the 'partial profile'" because "the Petition does not establish that the user identification value is needed for Rosenberg's system to receive a partial profile." PO Sur-reply 24 (citing PO Resp. 37–39).

(5) *Discussion of Limitation (b)*

We agree with Petitioner and find that Rosenberg meets limitation (b) under either theory advanced in the Petition and credit the testimony of Dr. Schmandt that Rosenberg discloses automatic URL redirection as required by this limitation. Ex. 1002 ¶ 117. During oral argument, Petitioner noted that "[t]he specific embodiment in Rosenberg [that] is being relied on which uses frame tags" discloses URL redirection and argued that "[t]he fact that you could bypass [URL redirection] with an edge case air scenario where maybe you can type a URL directly . . . doesn't prevent [Rosenberg] from meeting the claim limitation." Tr., 16:25–17:4. Even if we assume for both theories that Patent Owner is correct that Rosenberg discloses instances where the partial profile is received without URL redirection, that does not negate the fact that Rosenberg discloses instances wherein the partial profile is received as a result of automatic URL redirection. Ex. 1003, 5:36–38, 8:56–68. We agree with Petitioner that Rosenberg's disclosure of such instances is sufficient to meet the requirements of limitation (b) because "prior art that sometimes, but not always, embodies a claimed method nonetheless teaches that aspect of the invention." *Hewlett-Packard Co.*, 340 F.3d at 1326.

d) Limitation (c) - automatically with the computer system electronically adding the received partial profile

to a maintained profile believed to be related to the same entity:

Petitioner asserts that Rosenberg meets this limitation. Pet. 46–47. Specifically, Petitioner asserts that “Rosenberg discloses ‘a maintained profile’ in the form of a profile at database server 25 about the user (the ‘entity’), which includes information about the user’s previous visits to servers 24, as well as demographic and other information about the user” and that “Rosenberg discloses ‘electronically adding the received partial profile to a maintained profile,’ because the user tracking information received from Server_B 24B (‘received partial profile’) is added to the maintained profile for the user stored at database server 25.” *Id.* at 46 (citing Ex. 1003, 3:30–37, 7:1–40, Fig. 7).

Patent Owner does not dispute Petitioner’s assertions regarding limitation (c). *See generally* Prelim. Resp.

e) Limitation (d) - automatically with the computer system generating and storing an electronic record of which of the plurality of unaffiliated third parties contributed to the maintained profile particular profile attributes;

Petitioner asserts that Rosenberg meets limitation (d). Pet. 48. Specifically, Petitioner asserts that when Rosenberg’s “database server 25 receives user tracking information from an individual server 24, it records which server provided the information.” *Id.* Petitioner asserts further that “Rosenberg confirms that database server 25 could also store ‘additional entries for a large number of servers.’” *Id.* Petitioner reasons that it “would have been obvious that database server 25 stores ‘an electronic record of which of the plurality of unaffiliated third parties contributed to the maintained profile particular profile attributes.’” *Id.* (citing Ex. 1002 ¶ 128).

Patent Owner does not dispute Petitioner's assertions and reasoning regarding limitation (d). *See generally* Prelim. Resp.

f) Limitation (e) - wherein the maintained profile, including the added partial profile, comprises data used in targeting third party advertisements to the user computer over the global computer network.

(1) Petitioner's Assertions

Petitioner asserts that Rosenberg, Zeff, and Stern disclose or suggest limitation (e). Pet. 49–53. In particular, Petitioner asserts that “Rosenberg discloses and renders obvious that ‘the maintained profile’ of the user—including the newly-added user tracking information (‘the added partial profile’)—can be used to target advertisements to the user computer.” *Id.* at 49. Petitioner asserts further that “Rosenberg can also target based on demographic information in the maintained profile” and thus, discloses a “partial profile, [that] ‘comprises data used in targeting third-party advertisements to the user computer over the global computer network.’” *Id.* at 50–51. Petitioner admits that “Rosenberg does not expressly state that its ‘customized responses’ contain ‘target[ed] third-party advertisements,’” but asserts that “this would have been obvious based on Rosenberg,” because “Rosenberg explains that one of the purposes of his invention is to ‘allow editors and advertisers to tailor their content to users.’” *Id.* at 51 (citing Ex. 1003, 3:6–8) (alteration in original).

Petitioner also asserts that “[t]his would also have been obvious based on Rosenberg in further view of Zeff and Stern.” Pet. 51–52. Petitioner asserts that “Zeff and Sterne are analogous references describing the Firefly Passport system which provides a profile sharing service similar to database server 25 in Rosenberg” and that “Zeff and Sterne explain that Firefly

Passports can be shared with websites and used for targeting third-party advertisements.” *Id.* at 52 (citing Ex. 1002 ¶¶ 109–111, 113; Ex. 1004, 57–58; Ex. 1005, 171–172). Petitioner reasons that “[i]t therefore would have been obvious to implement Rosenberg for ‘targeting third-party advertisements,’ such as advertisements for products or services provided by third parties.” *Id.* (citing Ex. 1002 ¶ 132). Petitioner provides further reasoning in support of the proposed combination on pages 52–53 of the Petition.

(2) *Patent Owner’s Response*

(a) *Two Server Arguments*

Patent Owner responds that “the Petition does not explain how a POSITA would have implemented any sensible (and thus motivated) combination of Rosenberg and the Firefly Passport system.” PO Resp. 8 (citing Ex. 2001 ¶¶ 42–70). Specifically, Patent Owner contends that

Firefly is designed to interoperate with any number of websites (and a POSITA would understand Rosenberg to teach that its system would desirably be implemented to allow an arbitrary number of websites), but Petitioner relies on a way of implementing Rosenberg that allows for only two different websites, even though Petitioner’s expert admitted that such an implementation would be “foolish.”

Id. (citing Ex. 2003, 13:9–12). Patent Owner contends that “Petitioner’s expert could not identify any portion of his declaration where he ‘specif[ied] how Server A could synchronize unique identifiers between more than one [other] server.’” *Id.* at 15 (citing Ex. 2003, 22:18–26:18) (alterations in original). Patent Owner then asserts that Dr. Schmandt testified that “[i]t makes no difference whether Server A is referencing one other server or 18 other servers” and that “the frame layout would be exactly the same for Server A’s web page if there were a hundred different servers within

Rosenberg’s network or [two] different servers within Rosenberg’s network.”¹¹ *Id.* (alteration in original); Ex. 2003, 25:9–21.

According to Patent Owner, by way of this testimony, Dr. Schmandt made admissions that together demonstrate the Petition’s deficiency. Specifically, Patent Owner contends that Dr. Schmandt admitted “that persons ‘who design the user experience’ would have been the sort of POSITA to decide how to implement an ID-synchronization technique that would impact a website’s visuals,” that “in the context of using frames for ID synchronization, ‘a good user experience’ ‘would depend entirely on how those frames were laid out,’” and that “having only two frames to synchronize identifiers between only two sites is ‘foolish.’” *Id.* at 18–19 (citing Ex. 2003, 13:13–14, 18–19). Patent Owner contends further that these “admissions reveal a hole in the Petition’s reasoning: The combination is not scalable to a ‘broad range’ of websites.” *Id.* at 19.

*(b) Alleged Additional Reasons Why
Petitioner’s Reasoning Lacks Rational
Underpinning*

Patent Owner responds that “the Petition’s ‘visible frame’ approach significantly increases visual clutter, compared to simply displaying only Server A’s webpage in the user’s browser, because two webpages will be shown in the space that would have previously been allocated to only a single webpage.” PO Resp. 20. According to Patent Owner, Petitioner’s proposal is “a dramatic departure from what a POSITA would have known to be best practices in web design, which include simplicity in presentation.” *Id.* (citing Ex. 2001 ¶¶ 61–62). As an example, Patent Owner asserts that “a

¹¹ We note that the latter quotation is not Dr. Schmandt’s testimony, it is counsel’s question. Ex. 2003, 25:13–17.

POSITA would have known that if a site ‘choose[s] to pop open a new screen without the visitor’s consent, [that site] might use up system resources that user doesn’t have available,’ which could cause the ‘browser [to] disappear in the blink of an eye’ or even ‘freeze the whole system and force [the user] to restart.’” *Id.* at 22 (citing Ex. 1005, 128–129; Ex. 2001 ¶ 65) (alterations in original). Patent Owner responds further that “even if loading two pages simultaneously might not entirely crash the user’s computer or browser, such an approach would certainly increase loading times because the user’s browser would be downloading content for Server B’s page at the same time as the browser is attempting to load Server A’s page.” *Id.* (citing Ex. 2001 ¶ 66).

Turning to the “third-party” requirement of limitation (e), Patent Owner contends that a person of ordinary skill in the art would “understand that the Petition’s proposal fares even worse when the servers involved are unaffiliated as the Petition proposes.” PO Resp. 23 (citing Ex. 2001 ¶ 67). Patent Owner contends further that “unrelated sites would have actively avoided cross-promoting each other, because POSITAs would have taken active measures to avoid losing online visitors to another site.” *Id.* (citing Ex. 1005, 126). Thus, according to Patent Owner, “[t]here is simply no reason to presume, as Petitioner’s expert does, that Rosenberg’s network would have benefits that would outweigh the serious drawbacks of Petitioner’s proposed combination.” *Id.* at 26. Patent Owner also discusses a hypothetical in support of its contentions. *Id.* at 24–26.

(3) *Petitioner's Reply*

(a) *Two Server Arguments*

Petitioner replies that Patent Owner's "argument is based entirely on a mischaracterization of how Rosenberg was used in the Petition." Pet. Reply 1. According to Petitioner, "Rosenberg is not limited to two cooperating servers, and as Patent Owner acknowledges, Rosenberg itself states that a 'typical embodiment' would have included additional cooperating servers." *Id.* (citing Ex. 1003, 4:16–19). Petitioner replies further that "Patent Owner's argument improperly attempts to twist the Petition's analysis, which focused on servers 24A and 24B because no other cooperating servers were required to disclose the claim limitations, into some kind of concession that the proposed combination could only have been implemented using those two servers." *Id.*

Petitioner asserts that "Patent Owner repeatedly acknowledges that Rosenberg is not limited to just Server_A 24A and Server_B 24B" and that "Rosenberg itself explains that a 'typical embodiment' would have involved more than two cooperating servers." Pet. Reply 2 (citing PO Resp. 10, 18, 27–28; Ex. 2001 ¶¶ 46, 58, 75; Ex. 1003, 4:16–19, 4:52–55). In addition, Petitioner asserts that "Patent Owner also correctly acknowledges that although the detailed description in Rosenberg focuses on servers 24A and 24B, this was provided; for simplicity of explanation, not to suggest a limit to the number of cooperating servers the system of Rosenberg could handle." *Id.* at 3 (citing PO Resp. 10; Ex. 1003, 5:31–33, 7:49–53).

Petitioner replies further that the Petition's (like Rosenberg's) focus on cooperating servers 24A and 24B was "for simplicity of explanation" and was not intended to suggest any limit to the number of cooperating

servers the proposed combination could handle” and “also a by-product of the fact that, to show invalidity of the challenged claims, additional servers were not required.” *Id.* at 3–4. Petitioner emphasizes this latter assertion, by arguing that “claim 11 only requires ‘a programmed computer system,’ which Petitioner mapped to database server 25 in Rosenberg, and ‘at least one server,’ which Petitioner mapped to Server_B 24B.” *Id.* at 4 (citing Pet. 21–24; Ex. 1002 ¶¶ 86–88). According to Petitioner, “[a]lthough the system of Rosenberg can include additional cooperating servers as fully explained above, those additional servers were not claimed and thus not needed to satisfy the limitations of claim 11.” *Id.*

*(b) Alleged Additional Reasons Why
Petitioner’s Reasoning Lacks Rational
Underpinning*

Petitioner replies that “[n]othing in Rosenberg or the proposed combination would have limited the frame tag embodiment to just Server_A 24A and Server_B 24B.” Pet. Reply 6. According to Petitioner, “[a]ny number of server pairs in Rosenberg’s network could have employed the exact same frame tag technique to allow a first cooperating server to convey the unique user identification to a second cooperating server, and display information from both servers in a dual-frame web page.” *Id.* (citing Ex. 1019 ¶ 18).

In addition, Petitioner replies that “[t]here is also no basis for Patent Owner’s apparent assumption that an ordinarily skilled artisan implementing Rosenberg would have included only the absolute minimum set of features needed to invalidate the challenged claims by only allowing for two cooperating servers.” *Id.* at 7. According to Petitioner “[a]n ordinarily skilled artisan implementing the proposed combination would thus have also

considered, among other things, Rosenberg’s express disclosure that ‘a typical embodiment of the invention would include a larger number of server computers, say server computers 24A through 24N.’” *Id.* (citing Ex. 1003, 4:16–19). Petitioner replies further that “even if there was a basis for Patent Owner’s assumption that the frame tag embodiment could be used with only two servers within the entire server network, Rosenberg discloses at least four alternative approaches for allowing a cooperating server to convey the unique identifier to other cooperating servers.” *Id.* at 7–8 (citing PO Resp. 11; Ex. 2001 ¶¶ 49–50).

Petitioner also replies that Patent Owner’s argument that an ordinarily skilled artisan would not have used Rosenberg’s frame tag does “nothing more than confirm the unremarkable fact that the frame tag embodiment, as with almost all user interface decisions, would have offered both benefits and trade-offs.” Pet. Reply 10 (citing Ex. 1019 ¶ 22). According to Petitioner, “Rosenberg itself explains that the particular method to select for synchronization across servers ‘depends on several factors, including the desired appearance of a page, the expected distribution of browsers (i.e., which features are implemented), whether requiring explicit user actions is desirable, etc.’” *Id.* (citing Ex. 1003, 8:36–40). Addressing Patent Owner’s clutter example, Petitioner asserts that “an ordinarily skilled artisan would have weighed any so-called increase in ‘visual clutter’ of the frame-based approach, as described by Patent Owner, against the benefits of displaying more information to the user within the browser window.” *Id.* (citing Ex. 1019 ¶¶ 23–24). According to Petitioner, “[f]rames were often regarded as a superior way to present information from a second web page when

compared, for example, to separate ‘pop-up’ windows that users may have found distracting or annoying.” *Id.* at 11 (citing Ex. 1019 ¶ 23).

In addition, Petitioner asserts that “Patent Owner’s expert also acknowledged at his deposition that an ordinarily skilled artisan would have had experience with user interface design and would have had experience with how frames work” and “[a] skilled artisan would thus have been fully capable of weighing and balancing the relative benefits and trade-offs of the frame tag embodiment in Rosenberg.” Pet. Reply 11 (citing Ex. 1020, 11:13–12:10; Ex. 1019 ¶ 24). Petitioner asserts further that “Rosenberg itself provides an express motivation to use the frame tag embodiment over its other disclosed alternatives in that ‘the request will be made automatically, without the need for human action.’” *Id.* (citing Ex. 1003, 8:64–65).

In reply to Patent Owner’s stability arguments, Petitioner asserts that “[t]hese concerns are unsubstantiated” and that “[a]s of the assumed December 1999 priority date of the challenged claims, web browsers that supported HTML frames existed for years.” Pet. Reply 12 (citing Ex. 1019 ¶ 26). Petitioner replies that “Rosenberg—which itself was filed in August 1996—does not suggest that frames presented any stability concerns. The use of frames to load a second webpage, as described in Rosenberg, would have presented no significant technological obstacles by December 1999.” *Id.*

In reply to Patent Owner’s contentions about the time it would have taken to load content, Petitioner asserts that “web pages as of December 1999 were considerably simpler and consumed less storage and network bandwidth than they do today, with many pages consisting of nothing more

than HTML, text and some embedded images.” Pet. Reply 13 (citing Ex. 1019 ¶ 26). Petitioner also asserts that “[n]othing in Rosenberg requires that the frames display bandwidth-intensive web pages, as both sides’ experts agree.” *Id.* (citing Ex. 1019 ¶ 26; Ex. 1020, 30:20–25).

In reply to Patent Owner’s contention that “there would have been drawbacks of ‘cross-promotion of related sites,’ including by competitors,” Petitioner asserts that “Patent Owner’s argument merely confirms the unremarkable fact that—of course—there may have been situations when a company may not want to display content from another company’s website, such as when the two companies are direct competitors,” but “nothing in Rosenberg suggests that the parties that control Server_A 24A and Server_B 24B would have been (or needed to be) competitors or otherwise adverse to one another.” Pet. Reply 13–14 (citing PO Resp. 22–26; Ex. 2001 ¶¶ 67–70; *KSR*, 550 U.S. at 421). In addition, Petitioner discusses Patent Owner’s hypothetical and proposes a hypothetical of its own in response. *Id.* at 14.

(4) *Patent Owner’s Sur-reply*

(a) *Two Server Arguments*

Patent Owner replies that “Petitioner’s Reply makes clear that its obviousness theory only involves synchronizing unique identifiers between pairs of just two websites at a given time, and no more.” PO Sur-reply 4. Thus, according to Patent Owner, Petitioner’s “Reply’s theory presents a significant technical modification to Rosenberg: disregarding Rosenberg’s teaching that Server A would convey the user’s unique identifier to all participating servers, and instead modifying the system such that Server A would only convey the user’s unique identifier to a single other participating server.” *Id.* at 4–5. Patent Owner replies further that “Petitioner cannot

explain how its proposed implementation of Rosenberg (specifically, using visible frame tags to synchronize unique identifiers between just two servers) could have operated consistently with Rosenberg’s teachings that identifiers are synchronized between all servers of the ‘broad range’ of servers Petitioner’s theory entails.” *Id.* at 5.

Patent Owner replies further that “Petitioner’s proposed implementation of Rosenberg is also inconsistent with the admissions of Petitioner’s expert, who asserted that under the theory of the Petition, Rosenberg’s servers would be synchronizing the unique identifiers for all servers in the system, rather than only synchronizing the identifier between one other server as the Reply newly alleges.” PO Sur-reply 5–6 (citing Ex. 2003, 23:9–21).

In addition, Patent Owner replies that “Petitioner does not present any evidence that a POSITA would have been motivated to modify Rosenberg such that a server visited by a user would synchronize the user’s unique identifier with only one other server, rather than with all participating servers.” PO Resp. 6. According to Patent Owner, “[g]iven that Petitioner fails to motivate the proposed modification to Rosenberg’s system, Petitioner cannot show that that modification would have been obvious.” *Id.* at 8. Patent Owner then provides 5 more pages of arguments in support of its assertion that a person of ordinary skill in the art would not have been motivated to modify Rosenberg to only synchronize two servers. *Id.* at 8–13.

(b) *Alleged New Argument*

Patent Owner contends that

For the first time in Reply, Petitioner contends that “an ordinarily skilled artisan could have implemented the Rosenberg

system under the proposed combination such that Server_A 24A and Server_B 24B adopted the invalidating frame tag approach, as fully described in the Petition,” but “for other cooperating servers in the Rosenberg server network, those could have employed one or more of the four alternative techniques described in Rosenberg.”

PO Sur-reply 13 (citing Pet. Reply 9). Patent Owner contends further that “Petitioner’s argument explicitly alleges that a POSITA ‘could have implemented the Rosenberg system’ (*id.*), not an allegation that a POSITA would have been motivated to implement the Rosenberg system” and that “[a]s such, the Petition has not even alleged, much less shown, a motivation to implement Rosenberg’s system in the alleged manner.” *Id.* at 13–14 (citing *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015)).

*(c) Alleged Additional Reasons Why
Petitioner’s Reasoning Lacks Rational
Underpinning*

Patent Owner replies that a “POSITA would not have been motivated to apply the frame tag approach to Petitioner’s combination of Rosenberg with Firefly, because that approach would be limited to synchronizing identifiers between only two participating servers, contrary to Rosenberg’s teachings.” PO Sur-Reply 17. According to Patent Owner, “[t]his alone is sufficient to show that a POSITA would not have implemented the frame tag approach in the manner suggested by Petitioner.” *Id.*

Patent Owner replies further that “Petitioner does not allege any advantages to its proposed frame tag approach over ‘embedded image tags and HTTP redirection.’” PO Sur-reply 17 (citing Pet. Reply 11–12). According to Patent Owner, “the Reply does not provide any evidence that a POSITA would have recognized display of content from the second site in this context as being a benefit that would have motivated the proposed

implementation.” *Id.* at 18. Patent Owner then discusses it’s hypothetical and Petitioner’s responsive hypothetical. *Id.* at 18–22.

(5) *Discussion*

(a) *Two Server Argument*

Patent Owner’s two server arguments are not responsive to the challenge to claim 11 (and in particular to limitation (e)) as set forth in the Petition. *See* Pet. 49–53. For example, in its discussion of limitation (e), the Petition explicitly states that “the example from Figure 6 . . . shows profile information for the user being made available to Server_B 24B, Rosenberg makes clear that the profile information could also have been used by Server_A 24A, or any other cooperating server 24 in which a cookie has been stored with the unique identifier.” *Id.* at 51 (citing Ex. 1003, 7:51–55; Ex. 1002 ¶¶ 129, 104) (emphasis added).

Further, the Petition’s discussion of limitation (e) refers to its discussion of limitation (a) which states that “Rosenberg explains that the user profile maintained by database server 25 is available to multiple servers including Server_A 24A and Server_B 24B.” *Id.* at 34 (citing Ex. 1003, 6:59–67, Fig. 6). Patent Owner’s arguments, including that “the Petition only explains how its combination would work as applied to *exactly two* participating servers,” ignore the statements in the Petition and instead set up a strawman argument which it then proceeds to knock down. PO Resp. 14; *see also* PO Sur-reply 4. Such arguments are inapposite.

Further, even if we were to consider the challenge to be limited to two servers, as Patent Owner contends, Patent Owner’s arguments are unpersuasive because claim 11 does not require more than two servers. Ex. 1001, 17:45–18:8).

Claim 11 requires a “programmed computer system” and “at least one server.” Ex. 1001, 17:49–51. The Petition identifies Rosenberg’s database server 25 as corresponding to the claimed “programmed computer system” and Rosenberg’s Server_B 24B as corresponding to the claimed “at least one server.” Pet. 21, 23–24. Patent Owner does not contest Petitioner’s assertions that Rosenberg discloses a “programmed computer system and “at least one server.” *See generally* PO Resp.; *see also* PO Sur-reply. Instead, Patent Owner contends that the Petition does not explain how Rosenberg’s method could be applied to more than two servers and that this failure undermines Petitioner’s reasoning in support of the proposed combination. *See* PO Resp. 14–20 (citing Ex. 2001 ¶¶ 46, 55–59).

Patent Owner’s argument that Petitioner’s reasoning in support of its challenge only applies to two servers is undermined by Dr. Sherwood’s testimony that “a POSITA would seek to create a system that could have been scaled to an arbitrary number of servers, because Rosenberg, Zeff, and Sterne all teach the desirability of such scaling.” Ex. 2001 ¶ 59. Patent Owner’s argument also ignores the fact that Rosenberg repeatedly discloses that its method can be applied to multiple servers. *See, e.g.*, Ex. 1003, 4:16–19. Moreover, Patent Owner’s argument assumes that one of ordinary skill in the art would not have known how to implement Rosenberg’s method with more than one server. Such arguments are unconvincing, because “[a] person of ordinary skill is also a person of ordinary creativity, not an automaton.” *KSR*, 550 U.S. at 421.

*(b) Alleged Additional Reasons Why
Petitioner's Reasoning Lacks Rational
Underpinning*

Regarding Patent Owner's contention that "the Petition's 'visible frame' approach significantly increases visual clutter," we agree with Petitioner that this argument does "nothing more than confirm the unremarkable fact that the frame tag embodiment, as with almost all user interface decisions, would have offered both benefits and trade-offs." PO Resp. 26; Pet. Reply 10. We credit Dr. Schmandt's testimony that "[a]n ordinarily skilled artisan would thus have been motivated, depending on the needs of the particular system, to employ the frame tag embodiment in Rosenberg to obtain benefits not offered by the other disclosed alternatives." Ex. 1019 ¶ 23. We further credit Dr. Schmandt's testimony that any "so-called increase in 'visual clutter' also results in an increase in the amount of usable information that can be displayed to the user within the browser window." *Id.* ¶ 24.

Regarding Patent Owner's stability concerns, we agree with Petitioner that "[t]hese concerns are unsubstantiated." PO Resp. 21–22; Pet. Reply 12. We credit Dr. Schmandt's testimony that "[b]y the assumed December 1999 priority date of the challenged claims, web browsers that could support HTML frames had existed for several years." Ex. 1019 ¶ 26 (citing Ex. 1006, 39).

Regarding Patent Owner's concerns about the amount of time it would have taken to load additional content, we agree with Petitioner that "[n]othing in Rosenberg requires that the frames display bandwidth-intensive web pages, as both sides' experts agree." PO Resp. 22; Pet. Reply 13 (citing Ex. 1019 ¶ 26; Ex. 1020, 30:20–25).

Regarding Patent Owner's contention that "the Petition's proposal fares even worse when the servers involved are unaffiliated as the Petition proposes," we agree with Petitioner that nothing in Rosenberg suggests that the third parties "that control Server_A 24A and Server_B 24B would have been (or needed to be) competitors or otherwise adverse to one another." PO. Resp. 27; Pet. Reply 14. We credit Dr. Schmandt's testimony regarding examples wherein the third party's content complements that of the server operator. Ex. 1019 ¶ 28.

For these reasons, Patent Owner "additional reasons" arguments are unconvincing.

(c) Alleged New argument

To the extent that Petitioner raises a new argument in support of its challenge as Patent Owner contends (PO Sur-reply 13), we do not rely on this argument in reaching our decision in this proceeding. Accordingly, we do not address this alleged new argument.

(6) Conclusion For Claim 11

For the foregoing reasons we find that each limitation of claim 11 is taught or suggested by Rosenberg, Zeff, and Stern and that a person of ordinary skill would have successfully combined the teachings of those references. For the reasons discussed above, and based on our review of the entire record of this proceeding, we determine that Petitioner has shown, by a preponderance of the evidence, that claim 11 is unpatentable over the combined teachings of Rosenberg, Zeff, and Sterne.

2. Dependent Claims 13–15, 19, and 20

Claims 13–15, 19, and 20 depend from claim 11. Petitioner asserts that claims 13–15, 19, and 20 are unpatentable over the combined teachings

of Rosenberg, Zeff, and Sterne. Pet. 53–63. Patent Owner does not separately address Petitioner’s assertions. *See generally* PO Resp. We have reviewed Petitioner’s evidence including the testimony in support of Petitioner’s assertions. Based on our review of the entire record before us, we determine that for the reasons given, Petitioner has shown, by a preponderance of the evidence, that claims 13–15, 19, and 20 are unpatentable over the combined teachings of Rosenberg, Zeff, and Sterne.

F. Obviousness of Claim 16 Over Rosenberg, Zeff, Sterne, and Farber

Claim 16 depends from claim 11. Petitioner asserts that claim 16 is unpatentable over the combined teachings of Rosenberg, Zeff, Sterne, and Farber. Pet. 63–68. Patent Owner does not separately address Petitioner’s assertions. *See generally* PO Resp. Based on our review of the entire record before us, we determine for the reasons given that Petitioner has shown, by a preponderance of the evidence that claim 16 is unpatentable over the combined teachings of Rosenberg, Zeff, Sterne, and Farber.

G. Obviousness of Claims 11, 13–15, 19, and 20 Over Rosenberg, Zeff, Sterne, and Merriman

As we have already determined that Petitioner has shown, by a preponderance of the evidence, that claims 11, 13–15, 19, and 20, are unpatentable over the combined teachings of Rosenberg, Zeff, and Sterne, we do not reach this ground. *See SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1359 (2018) (holding that a petitioner “is entitled to final written decision addressing all of the claims it has challenged”); *Boston Sci. Scimed, Inc. v. Cook Grp. Inc.*, 809 F. App’x 984, 990 (Fed. Cir. 2020) (nonprecedential) (stating that the “Board need not address issues that are not necessary to the resolution of the proceeding,” such as “alternative arguments with respect to

claims [the Board] found unpatentable on other grounds”); *SK Hynix Inc. v. Netlist, Inc.*, IPR2017-00692, Paper 25 at 40 (PTAB July 5, 2018) (determining all challenged claims to be unpatentable and not addressing additional grounds).

H. Obviousness of Claim 16 Over Rosenberg, Zeff, Sterne, Merriman, and Farber

As we have already determined that Petitioner has shown, by a preponderance of the evidence, that claim 16 is unpatentable over the combined teachings of Rosenberg, Zeff, Sterne, and Farber, we do not reach this ground.

III. CONCLUSION

For the reasons discussed above, we determine that Petitioner has demonstrated, by a preponderance of the evidence, that claims 11, 13–16, 19, and 20 are unpatentable on the basis set forth in the following table.¹²

¹² Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this Final Decision, we draw Patent Owner’s attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. See 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. See 37 C.F.R. §§ 42.8(a)(3), (b)(2).

Claim(s)	35 U.S.C. §	References	Claim(s) Shown Unpatentable	Claim(s) Not Shown Unpatentable
11, 13–15, 19, 20	103(a)	Rosenberg, Zeff, Sterne	11, 13–15, 19, 20	
16	103(a)	Rosenberg, Zeff, Sterne, Farber	16	
11, 13–15, 19, 20	103(a)	Rosenberg, Zeff, Sterne, Merriman ¹³		
16	103(a)	Rosenberg, Zeff, Sterne, Farber, Merriman ¹⁴		
Overall Outcome			11, 13–16, 19, 20	

IV. ORDER

In consideration of the foregoing, it is hereby
 ORDERED that, Petitioner has demonstrated by a preponderance of
 the evidence that claims 11, 13–16, 19, and 20 of U.S. Patent No.
 8,244,582 B2 are unpatentable; and

FURTHER ORDERED that because this is a Final Written Decision,
 any party to the proceeding seeking judicial review of this Decision must
 comply with the notice and service requirements of 37 C.F.R. § 90.2.

¹³ As explained above, we do not reach this ground.

¹⁴ As explained above, we do not reach this ground.

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