

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC., AMAZON WEB SERVICES, INC. and
AMAZON.COM SERVICES LLC,
Petitioner,

v.

ALMONDNET, INC.,
Patent Owner.

IPR2025-00545
Patent 8,494,904 B2

Before JUSTIN T. ARBES, THOMAS L. GIANNETTI, and
DAVID COTTA, *Administrative Patent Judges*.

COTTA, *Administrative Patent Judge*.

DECISION

Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

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I. INTRODUCTION

On March 10, 2025, Amazon.com, Inc., Amazon Web Services, Inc., and Amazon.com Services LLC (collectively, “Petitioner”)¹ filed a Petition to institute *inter partes* review of claims 1, 3–11, 13–21, and 23–30 of U.S. Patent No. 8,494,904 B2 (Ex. 1001, “the ’904 patent”).² Paper 2 (“Pet.” or “Petition”). Almondnet, Inc. (“Patent Owner”)³ opted not to file a Preliminary Response.

Under 35 U.S.C. § 314(a), *inter partes* review may not be instituted unless the Petition “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Petitioner has established a reasonable likelihood of prevailing on its assertion that at least one of the challenged claims is unpatentable based on the grounds advanced here. Thus, for reasons explained below, we institute *inter partes* review of claims 1, 3–11, 13–21, and 23–30 of the ’904 patent.

A. Related Matters

The parties identify *AlmondNet, Inc and Datonics LLC v. Amazon.com, Inc., et al.*, No. 6:24-cv-00234 (W.D. Tex.) as a related matter. Pet. 75; Paper 3, 1.

Patent Owner additionally identifies *AlmondNet, Inc and Datonics LLC v. Lotame Solutions, Inc.*, 1:24-cv-00376 (D. Del.) and *AlmondNet, Inc*

¹ Petitioner identifies themselves as the real parties-in-interest. Pet. 74.

² Patent Owner disclaimed claims 2, 12, and 22 of the challenged patent. Ex. 1003, 1.

³ Patent Owner identifies itself as the real party-in-interest. Paper 3, 1.

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and Datonics LLC v. LiveIntent, Inc., 1:24-cv-00831 (D. Del.) as related matters. Paper 3, 1. In addition to these cases, Petitioner identifies the following cases as “related matters involving the ’904 patent and/or related patents”: *AlmondNet Inc. et al. v. Meta Platforms Inc.*, Case No. 4:22-cv-08911 (N.D. Cal.); *AlmondNet Inc. et al. v. Oath Holdings Inc. et al.*, Case No. 1:19-cv-00247 (D. Del.); *AlmondNet Inc. et al. v. Viant Technology LLC*, Case No. 1:23-cv-00174 (D. Del.); *AlmondNet Inc. et al. v. Beeswax.io Corp. et al.*, Case No. 1:23-cv-00220 (D. Del.); *AlmondNet, Inc. v. Oath Holdings Inc. and Yahoo Inc.*, Case No. 1:16-cv-00247 (D. Del.); *AlmondNet Inc. et al. v. LinkedIn Corp.*, Case No. 1:23-cv-01373 (D. Del.); *AlmondNet, Inc. v. Yahoo! Inc.*, Case No. 1:16-cv-01557 (E.D.N.Y.); *AlmondNet Inc. v. Roku Inc.*, Case No. 6:21-cv-00876 (W.D. Tex.); *AlmondNet Inc. et al. v. Facebook Inc.*, Case No. 6:21-cv-00896 (W.D. Tex.); *AlmondNet Inc. et al. v. Microsoft Corp et al.*, Case No. 6:21-cv-00897 (W.D. Tex.); *AlmondNet Inc. et al. v. Amazon Web Services Inc. et al.*, Case No. 6:21-cv-00898 (W.D. Tex.); *AlmondNet Inc. et al. v. Samsung Electronics America Inc. et al.*, Case No. 6:21-cv-00891(W.D. Tex.); *AlmondNet Inc. et al. v. Amazon Web Services Inc. et al.*, Case No. 6:22-cv-01204 (W.D. Tex.); *AlmondNet Inc. et al. v. Meta Platforms Inc.*, Case No. 6:22-cv-01205 (W.D. Tex.); *AlmondNet Inc. et al. v. Microsoft Corp. et al.*, Case No. 6:22-cv-01206 (W.D. Tex.); *AlmondNet Inc. & Intent IQ LLC v. Oracle Corp.*, Case No. 6:24-cv-00303 (W.D. Tex.); *AlmondNet Inc. v. Meta Platforms Inc.*, Case No. 24-1834 (Fed. Cir.). Pet. 75–81.

Petitioner identifies CMB2017-00051 as a Covered Business Method Patent Review involving the ’904 patent. Pet. 80. In that proceeding, the

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Board denied institution because the '904 patent did not qualify as a covered business method patent. Ex. 1003, 2–18. In addition, Petitioner identifies the following proceedings as related matters involving related patents: CBM2017-00049; CBM2017-00050; CBM2017-00052; IPR2022-01260; IPR2022-01455; IPR2022-01436; IPR2024-00413; IPR2024-00414; IPR2024-00415; IPR2024-00416; IPR2024-00417; IPR2024-00418; and IPR2025-00126. Pet. 80–81. We also note that the '904 patent is challenged in IPR2025-01160.

B. The '904 patent

The '904 patent discloses that the claimed invention relates to “a mercantile method directed to brokerage of attributes of information.” Ex. 1001, 1:31–33. According to the '904 patent, “[a]dvances in database technology have given rise to commerce in records, files and databases, per se. For example, paying for a database credit check for an individual or buying a mailing list have become common practice.” *Id.* at 1:37–40. The '904 patent further discloses that “[u]nfortunately, the current state of information commerce is focused on the sales of whole databases, whole records, or evaluations based on single or clusters of records.” *Id.* at 1:59–61. The '904 patent indicates this is a problem because “[i]n commercial applications where specific attributes of information strongly affect the value of evaluations, there is a need in the art for commerce in such attributes. For example, in targeted advertising, every attribute, which substantially affects the probability of that advertisement’s success, innately has a discrete economic value.” *Id.* at 1:61–1:67. The '904 patent addresses this problem by disclosing “a descriptive-profile mercantile method, for use at a juncture

in a data communications topology having associated therewith a maintained databank of partial profiles.” *Id.* at 3:32–35. According to the ’904 patent, the disclosed invention provides “a means for making viable the economic commerce in the information attributes” and “operates on a brokerage representation model.” *Id.* at 3:55–61.

Figure 1, reproduced below, “illustrates a schematic view of an Internet data communications topology” used by the ’904 patent. *Id.* at 4:60–61.

Fig. 1

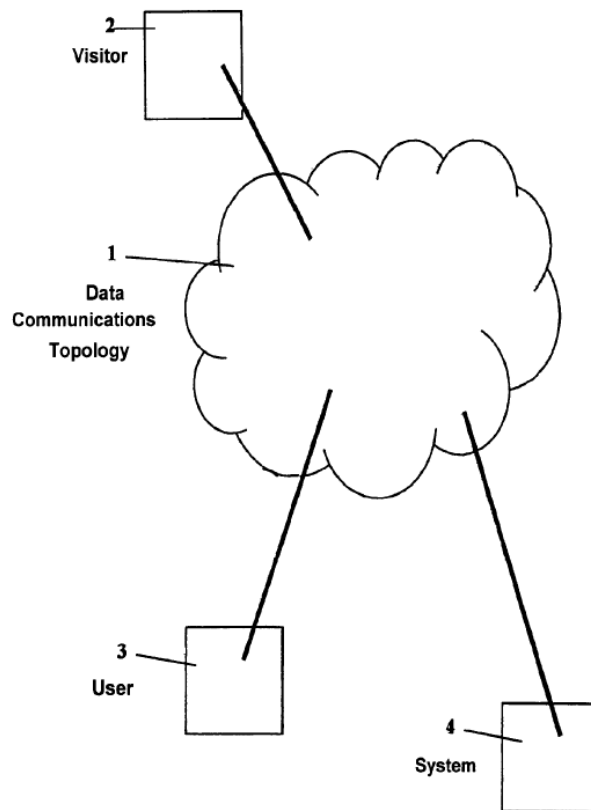


Figure 1 above shows data-communications topology 1 including a wide area network such as the Internet, interconnected to visitor 2, user 3, and

system 4. *Id.* at 5:7–11. Such a data-communication topology “having associated therewith a maintained databank of partial profiles” is used in the ’904 patent’s “descriptive-profile mercantile method” shown in Figure 2, which is reproduced below. *Id.* at 4:62–63, 5:12–16.

Fig. 2

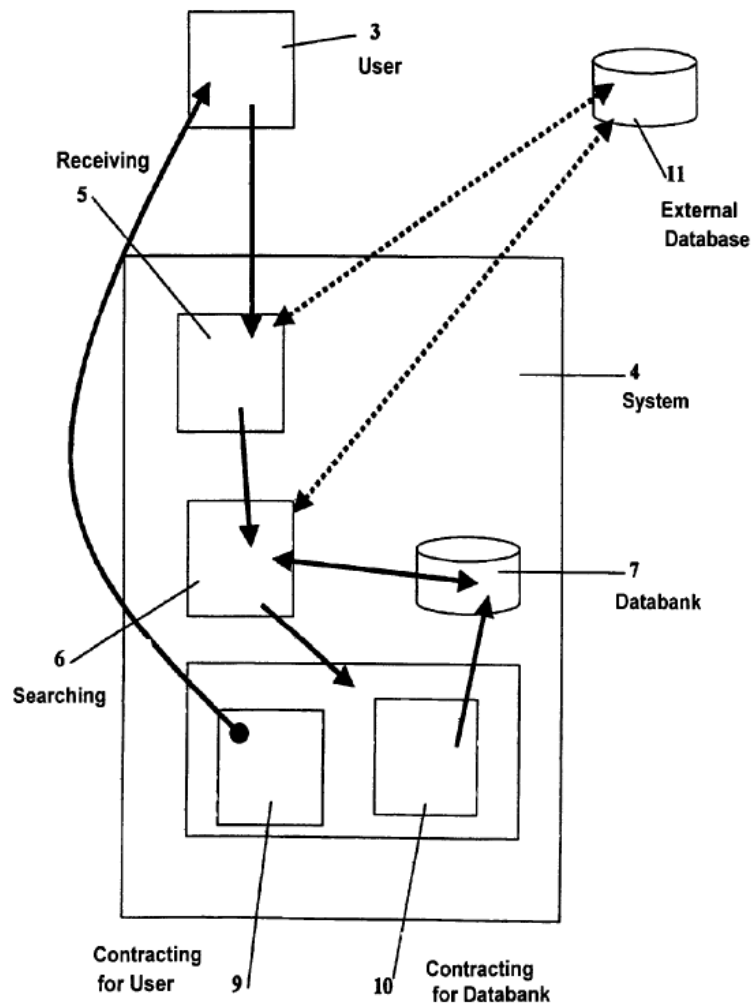


Figure 2 above shows a mercantile method including step 5 of receiving from user 3 “a transaction having therein a first partial profile,” and step 6 of using the first partial profile to search in databank 7 that has a plurality of

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second partial profiles. *Id.* at 5:17–24. Then, the method proceeds to either step 9 or step 10. In step 10, user 3 and databank 7 contract for databank 7 “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.” Alternatively, in step 9, the user and databank 7 contract for user 3 “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 upon portion of the second profile.” *Id.* at 5:25–34.

The ’904 patent’s “descriptive-profile mercantile method” allows the website to collect data of the visitor (including the visitor’s cookie) when visitor 2 arrives at website of user 3. The website can combine the newly collected data with prior-acquired information to “enable the website to engage in potentially more successful product offering and/or targeted advertising to the visitor.” *Id.* at 8:56–58.

The ’904 patent discloses that visitor credentials, including, e.g., a cookie, can be used to enable the web “site to retrieve the visitor profile.” *Id.* at 3:65–67. Further, the ’904 patent discloses:

The web-site forwards particulars from the visitor’s credentials (a partial profile), as well as (optionally) a redirect to a portion of the visitor’s page to a server located in cyberspace (at a juncture in a data communications topology). By redirecting a portion of the visitor’s page to the server, the visitor’s browser reports to the server a cookie the server put on the visitor’s computer in the past, if any.

Id. at 4:4–11.

C. Challenged Claims

The '904 patent includes 27 claims,⁴ all of which are challenged in the Petition. Claim 1 is representative and reads as follows:

1. an automated 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, an electronically URL-redirected partial profile of an entity that uses a user computer coupled to the global computer network to access a website, which partial profile is available to one of the third parties and contains at least one profile attribute related to the entity, which partial profile is received along with an identification of the one of the third parties that contributed the partial profile, and automatically with the computer system storing the received partial profile;

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

(c) 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; and

(d) 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, 16:59–17:16.

⁴ Claims 2, 12, and 22 have been disclaimed. Ex. 1003, 1.

D. Asserted Ground of Unpatentability

Petitioner asserts the following grounds of unpatentability in this Petition (Pet. 8–9):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 3–6, 10, 11, 13–16, 20, 21, 23–26, 30	103(a) ⁵	Merriman061, ⁶ Jaye ⁷
1, 3–6, 9–11, 13–16, 19–21, 23–26, 29, 30	103(a)	Rosenberg, ⁸ Merriman154 ⁹
7, 8, 17, 18, 27, 28	103(a)	Merriman061, Jaye, Coleman ¹⁰
7, 8, 17, 18, 27, 28	103(a)	Rosenberg, Merriman154, Coleman

Petitioner relies on the Declaration of Dr. Henry Houh, among other evidence. Ex. 1002 (“Houh Declaration”).

⁵ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. § 103, and became effective on March 16, 2013. Because the ’904 patent claims priority to a string of continuation and divisional applications filed before that date, we apply the pre-AIA version of § 103. *See* Ex. 1001, codes (30), (60); Pet. 9 n.3.

⁶ Merriman et al., U.S. Patent No. 5,948,061, issued Sept. 7, 1999 (Ex. 1004, “Merriman061”).

⁷ Jaye, U.S. Patent No. 6,415,322 B1, filed Feb. 26, 1999, issued July 2, 2002 (Ex. 1005, “Jaye”).

⁸ Rosenberg et al., U.S. Patent No. 6,073,241, filed Aug. 29, 1996, issued June 6, 2000 (Ex. 1006, “Rosenberg”).

⁹ Merriman et al., U.S. Patent No. 8,566,154 B2, issued Oct. 22, 2013, continuation of application filed July 27, 1999 (Ex. 1007, “Merriman154”).

¹⁰ Coleman, U.S. Patent Appl. Publ. No. 2002/0026351 A1, filed June 30, 1999, published Feb. 28, 2002 (Ex. 1019, “Coleman”).

II. ANALYSIS

D. Principles of Law

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)).

A claim is unpatentable under 35 U.S.C. § 103(a) 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 at the time the invention was made to a person having ordinary skill in the art to which that 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 ordinary skill in the art; and (4) objective indicia of nonobviousness when presented.¹¹ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

E. Level of Skill in the Art

In determining the level of skill in the art, we consider the problems encountered in the art, the art’s solutions to those problems, the rapidity with which innovations are made, the sophistication of the technology, and the

¹¹ The current record in this proceeding does not include any argument or evidence directed to objective indicia of nonobviousness.

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educational level of active workers in the field. *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986).

Petitioner contends that a person of ordinary skill in the art “would have experience in online advertising and computer science.” Pet. 18.

Petitioner contends that a person of ordinary skill in the art’s education could include:

a bachelor’s degree in business or economics, with an emphasis on the use of technology in marketing or advertising, or have similar knowledge gained through actual work experience.

Such a person could also hold a bachelor’s degree in computer science or equivalent industry experience, and work with a team that includes software engineers.

Id. at 18–19. Petitioner also notes that “[a] person could also have qualified with more formal education and less technical experience, or vice versa.”

Id. at 19. Patent Owner does not offer a definition of the person of ordinary skill in the art.

Petitioner’s definition appears to be consistent with the field of the invention reflected in the prior art of record and the disclosure of the ’904 patent. Accordingly, for purposes of this Decision, we adopt Petitioner’s proposed definition of the person of ordinary skill in the art.

F. Claim Construction

We interpret a claim “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C.

282(b).” 37 C.F.R. § 42.100(b) (2024). Under this standard, we construe the claim “in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” *Id.*

Petitioner contends that it applies the plain and ordinary meaning for all claim terms. Pet. 19. Petitioner asserts that this approach is consistent with the district court’s claim construction in *AlmondNet, Inc. et al. v. Amazon.com, Inc., et al.*, 6:21-cv-00898 (W.D. Tex.) (“AlmondNet I”). That case involved U.S. Patent No. 8,244,582 B2 (“the ’582 patent”), the parent of the ’904 patent. In AlmondNet I, the district court applied the plain-and-ordinary meaning to terms in the ’582 patent, including “unaffiliated third parties”/“unaffiliated third party,” “partial profile,” “available,” “automatically with the computer system”/ “automatically,” “URL redirection,” and “indicia of instructions.” Pet. 19–20 (citing Ex. 1012, 18–42). Petitioner also notes that the panel in IPR2022-01436 applied the “ordinary and customary meaning” to claim terms in the ’582 patent. *Id.* (citing Ex. 1014). Finally, Petitioner argues that applying the plain and ordinary meaning to the terms of the ’904 patent is consistent with the claim constructions Patent Owner advanced in AlmondNet I for the terms “unaffiliated third parties”/“unaffiliated third party” and “URL redirection.” *Id.* (citing Ex. 1012, 22–24, 36–37). At this stage, Patent Owner does propose any claim constructions.

At this stage and for this Decision, we determine that no terms require express construction. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

G. Overview of Asserted Prior Art

1. Merriman061

Merriman is a United States patent for a method of delivery, targeting, and measuring advertising over networks that issued September 7, 1999.

Ex. 1004, codes (45), (54). Petitioner contends that Merriman is prior art under pre-AIA 35 U.S.C. § 102(a). Pet. 9. Merriman concerns compiling statistics on individual users and networks and tracking the use of advertisements to permit targeting of the advertisements to individual users. Ex. 1004, code (57). “In response to requests from affiliated sites, an advertising server transmits to people accessing the page of a site an appropriate one of the advertisement[s] based upon profiling of users and networks.” *Id.*

Figure 1 of Merriman is reproduced below.

FIG. 1

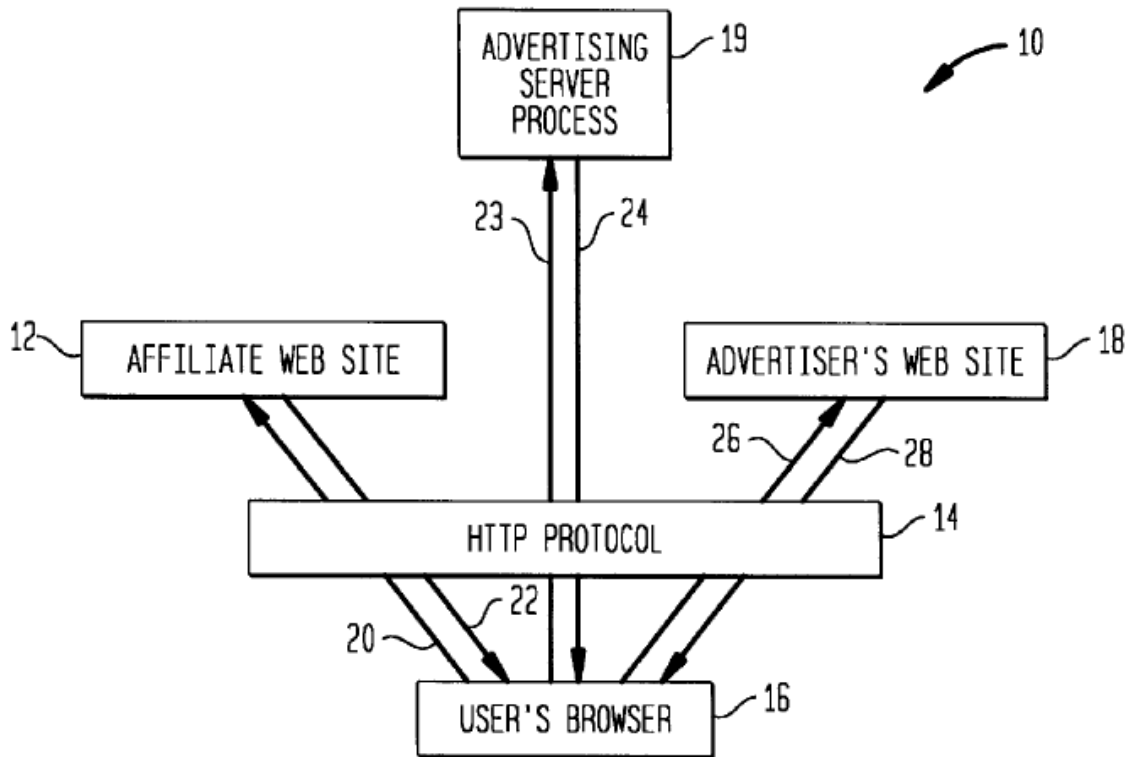


Figure 1 illustrates the “basic architecture” of a network 10 that comprises “at least one affiliate web site 12, an advertisement (ad) server web site 19 and one or more individual advertiser’s web sites 18.” *Id.* at 2:59–62.

According to Merriman, “[w]hen a user using a browser accesses or ‘visits’ a web site of an affiliate, an advertisement provided by the advertisement server 19 will be superimposed on the display of the affiliate’s web page displayed by the user’s browser.” *Id.* at 2:65–3:1.

Merriman describes the operations shown in Figure 1 as follows: “a user operates a web browser, such as Netscape or Microsoft Internet Explorer, on a computer or PDA or other Internet capable device 16 to generate through the hypertext transfer protocol (HTTP) 14 a request 20 to

any one of preferably a plurality of affiliate web sites 12.” *Id.* at 3:24–28.

Next, “[t]he affiliate web site sends one or more messages back 22 using the same protocol.” *Id.* at 3:28–30. “Those messages 22 preferably contain all of the information available at the particular web site 12 for the requested page to be displayed by the user’s browser 16 except for one or more advertising objects such as banner advertisements.” *Id.* at 3:30–34.

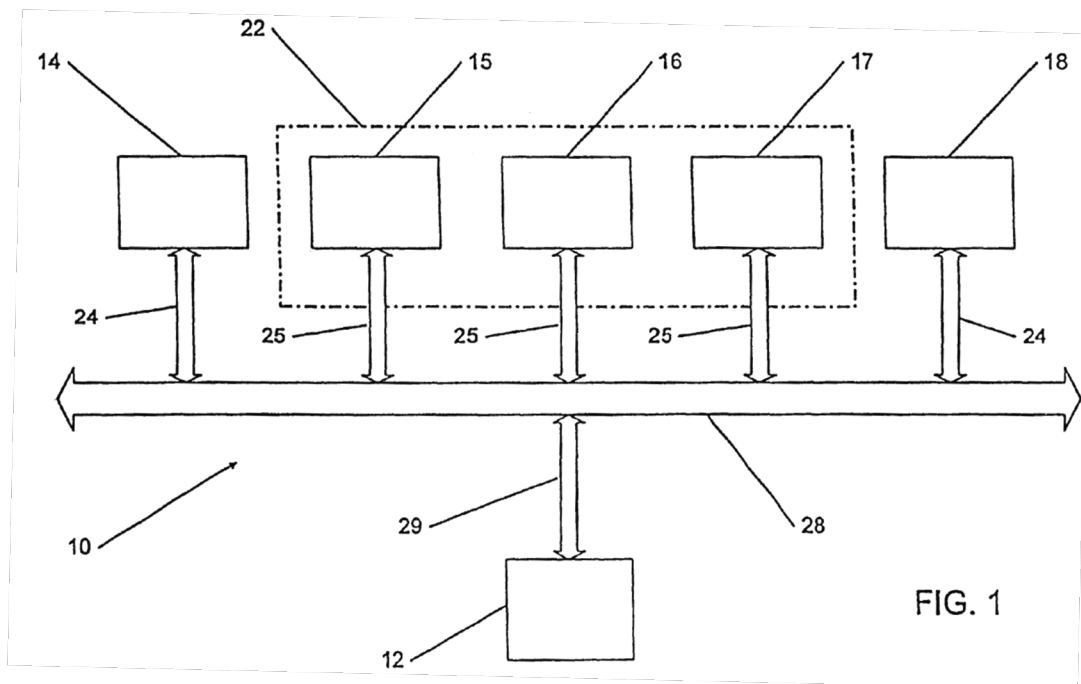
Merriman discloses that “[advertising] objects preferably do not reside on the affiliate’s web server” and “[i]nstead, the affiliate’s web server sends back a link including an IP address for a node running an advertiser server process 19 as well as information about the page on which the advertisement will be displayed.” *Id.* at 3:35–38. As an example, Merriman teaches that the link “may be a hypertext markup language (HTML) tag, referring to, for example, an inline image such as a banner,” and “[t]he user’s browser 16 then transmits a message 23 using the received IP address to access such an object indicated by the HTML tag from the advertisement server 19.” *Id.* at 3:39–44. “Upon receiving the request in the message 23, the advertising server process 19 determines which advertisement or other object to provide to user’s browser and transmits the messages 24 containing the object such as a banner advertisement to the user’s browser 16 using the HTTP protocol.” *Id.* at 3:52–57. Merriman describes that “[p]referably contained within the HTTP message is a unique identifier for the advertiser’s web page appropriate for the advertisement,” and “[t]hat advertisement object is then displayed on the image created by the web user’s browser as a composite of the received affiliate’s web page plus the object transmitted back by the advertising web server.” *Id.* at 3:57–63.

2. Jaye

Jaye is a United States patent for dual/blind identification that issued July 2, 2002. Ex. 1005, codes (45), (54). Petitioner contends that Jaye is prior art under pre-AIA 35 U.S.C. § 102(e). Pet. 12. Jaye concerns a global interest profile of a user. Ex. 1005, code (57).

Jaye describes “[a] distributed user identification process,” that allows “individual local servers or domains to control their own user identification scheme and to collaborate with other local servers or domains at the discretion of an enterprise server.” *Id.* at 2:2–6. “The enterprise server correlates the local user identification scheme with a global user identifier and may disclose to interested outside parties, such as advertisers, only the global user identifier without revealing the identity of a user who interacts with a local server.” *Id.* at 2:6–11.

Figure 1 of Jaye is reproduced below.



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Figure 1 illustrates a part 10 of the Internet computer network that includes a client 12 and a group of servers 14–18. *Id.* 4:5–6. Jaye describes that “client 12 may be any one of a variety of conventional, commercially available, hardware and software combinations configured to access Internet servers by any one of a variety of suitable means.” *Id.* at 4:7–10. Jaye discloses that “servers 14–18 and the client 12 communicate with each other via communication links 24, 25 and 29 which are all connected to a communication channel 28.” *Id.* at 4:20–23.

3. Rosenberg

Rosenberg is a United States patent for an apparatus and method for tracking world wide web browser requests across distinct domains using a persistent client-side state that issued June 6, 2000. Ex. 1006, codes (45), (54). Petitioner contends that Rosenberg is prior art under pre-AIA 35 U.S.C. § 102(e). Pet. 14.

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.” Ex. 1006, 3:24–27. 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 3:29–33. “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

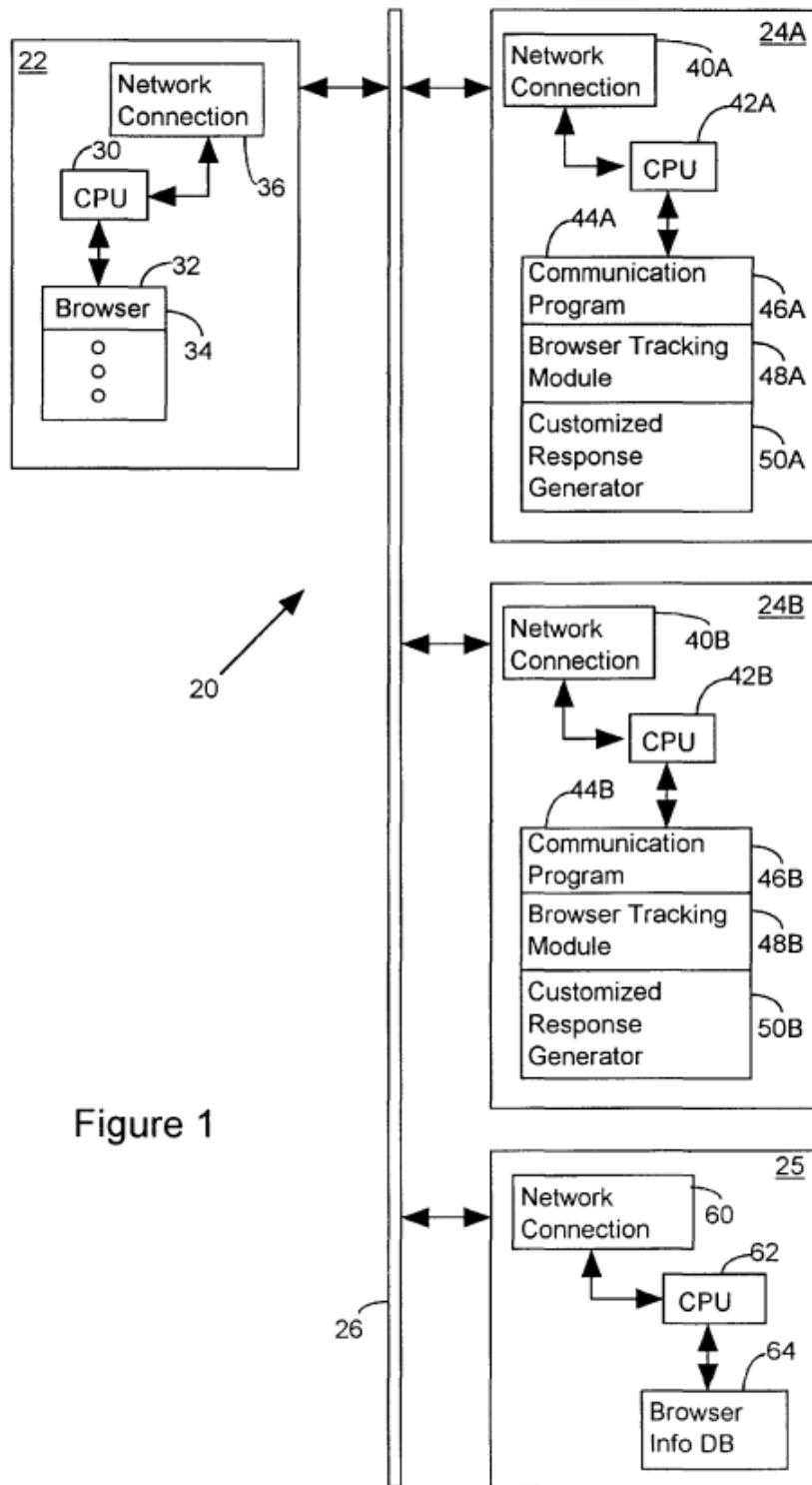


Figure 1

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. *Id.* at 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 4:52–56. Rosenberg’s Figure 2 is reproduced below:

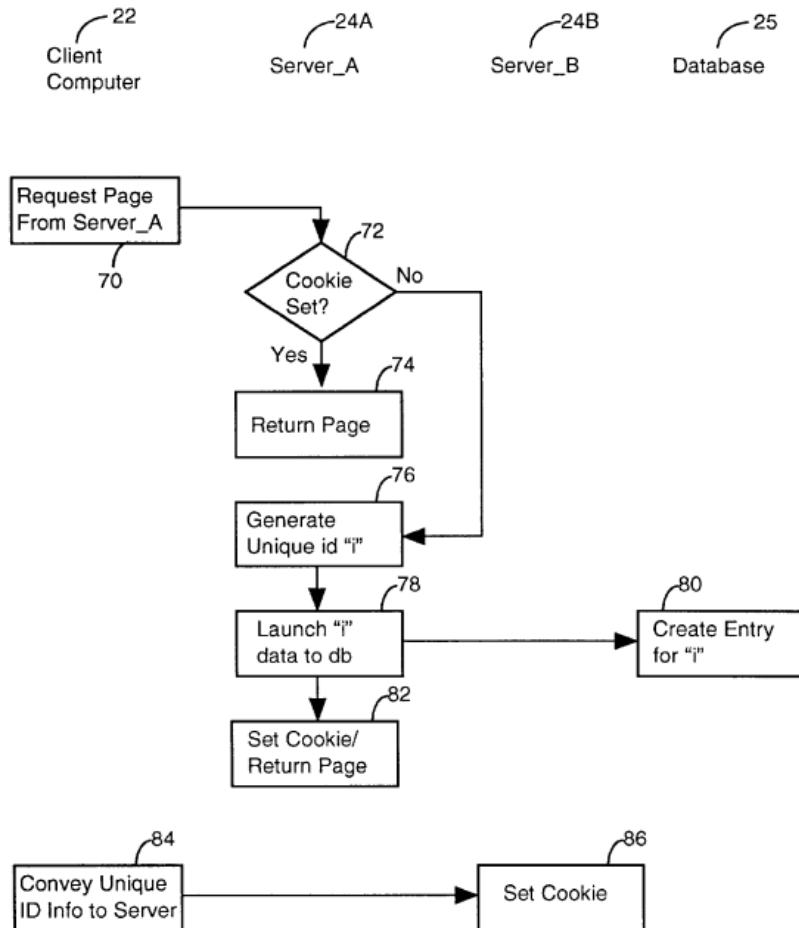


Figure 2 shows operations performed relative to client computer 22, server computer 24A (Server_A), server computer 24B (Server_B), and database server computer 25 (Database 25). *Id.* at 4:65–5:1. In first step 70, client computer 22’s browser requests a page of information from a first server so that “[S]erver 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, “[S]erver 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 a “page of the requested information” is returned 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 shows “a data structure that may be used to store information regarding the interaction between” a browser and Server 24. *Id.* at 5:55–56. “[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).” *Id.* at 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

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are several ways in which an HTML reference to another site can be embedded in a page.” *Id.* at 8:31–35. 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=“1,2”>
< 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.

4. Merriman154

Merriman154 is a United States patent for “Network for Distribution of Re-Targeted Advertising” that issued on October 22, 2013. Ex. 1007, codes (45), (54). Petitioner contends that Merriman154 is prior art under 35 U.S.C. § 102(e). Pet. 16.

Merriman “relates to methods of delivery of advertisements and measuring responses to those delivered advertisements, and in particular relates to the targeting of advertisements delivered over networks such as the internet.” Ex. 1007, 1:19–24. Merriman’s system, shown in Figure 1, is reproduced below:

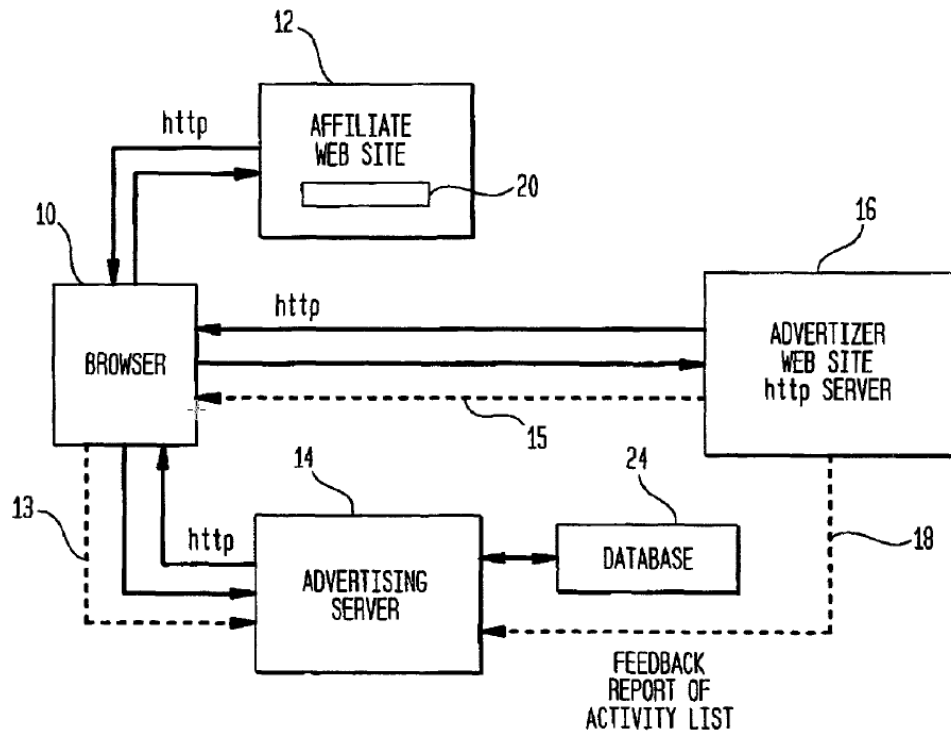


Figure 1 shows a system including browser 10, at least one affiliate web site 12 which has advertising space 20, advertising server 14 which has algorithms for selection of advertisement, database 24 which has activity history of users on various web sites, and one or more advertiser web sites 16. *Id.* at 4:26–38. Advertising server 14 communicates with database 24, and browser 10 communicates with each of affiliate web site 12, advertiser web site 16, and advertising server 14. *Id.* at Fig. 1. Feedback path 18 permits advertiser web site 16 “to communicate the activities of visitors at the advertiser’s web site 16, back to the advertising server 14.” *Id.* at 4:41–43.

Merriman discloses:

The feedback path 18 may be achieved by a number of alternative mechanisms. For bulk feedback of data accumulated in a user activity list, the advertiser periodically emails the

information directly, or transfers it in bulk form in a file transfer operation. Activity list updates are performed as often as necessary, and may even be reported at the conclusion of each individual visit.

In a second embodiment, feedback of individual activities of the user at an advertiser site 16 may be communicated in real time back to the advertising server 14 using by spotlight tags placed on specific pages in the advertiser's web site. A spotlight tag is a minimal graphic (e.g., a one pixel image) containing a redirect message back to the advertising server 14. Spotlight tags are placed on web pages by the advertiser and contain other imbedded information such as information identifying the specific advertiser web page (as for example, identifying a purchase confirmation page stating "thank you for your order" etc.)

When the user requests (i.e., visits) an advertiser page containing a spotlight tag, a reply message 15 redirects the user's browser 10 back to the advertising server 14 via request 13 to access the minimal one pixel graphic image. The requested image is not significant to the event. However, by this process, the advertiser web site 16 provides real time reporting of user activities while the user is in the advertising web site 16. The advertising server 14 assembles the activity list for each user.

Id. at 4:44–5:3.

Merriman's Figure 2 is reproduced below:

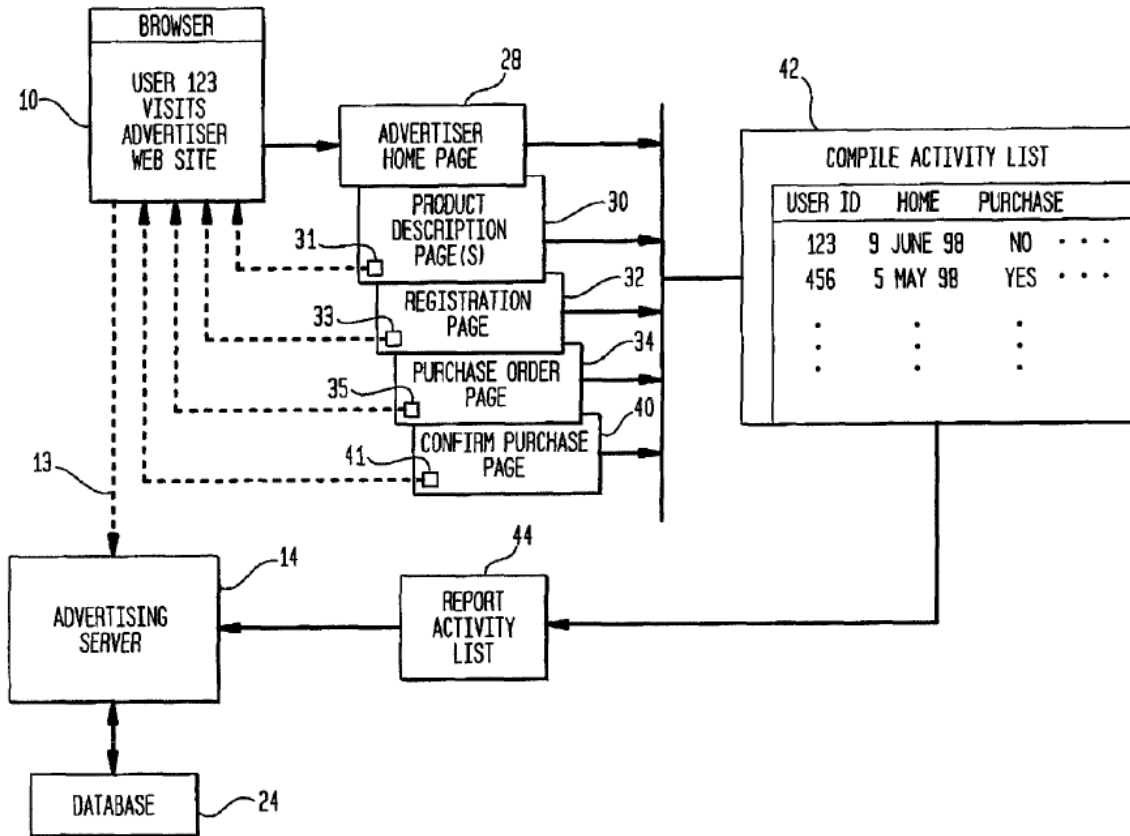


Figure 2 shows “two alternate embodiments of a data collection system for reporting user activities at an advertiser’s web site to an advertising server.” Ex. 1004, 4:17–19. An advertiser web site comprises home page 28 with linked pages such as product description pages 30, registration pages 32, purchase order pages 34, and confirmation pages 40, in which each of these pages includes a corresponding spotlight tag, i.e., spotlight tags 31, 33, 35, and 41. *Id.* at 5:33–42. Merriman discloses:

When the viewer accesses any page having at spotlight tag 31, 33, 35 and 41, a reply message back to the browser 10 redirects the browser to send a message 13 back to the advertising server 14. Receipt of the message 13 back at the advertising server 14 in effect, reports (in real time) to the

advertising server that the user has accessed the [] respective page while browsing at the advertiser's web site. Reported user activity is stored in the local database 24 for further processing.

Alternatively, the user activity list 42 is compiled at the advertiser[']s web site. The activity list is reported back 44 to the advertising server 14 by email or ftp (file transfer protocol).

Id. at 5:43–54.

5. Coleman (Ex. 1019)

Coleman is a U.S. Patent Application Publication published on February 28, 2002. Ex. 1019, code (43). Petitioner contends that Coleman is prior art under pre-AIA 35 U.S.C. § 102(e). Pet. 18. Coleman discloses “pooling and advertising methods and systems for linking purchasers with sellers of goods or services, as well as targeted commercial messaging.” Ex. 1019 ¶ 2. In Coleman's method, “[a]fter information has been gathered from a registered user . . . , the information may be verified for accuracy, updated, and profiled in comparison to other registered users.” *Id.* ¶ 73.

H. Obviousness over the Combination of Merriman061 and Jaye
Petitioner asserts that claims 1, 3–6, 10, 11, 13–16, 20, 21, 23–26, and 30 would have been obvious over the combination of Merriman061 and Jaye and sets forth an element-by-element comparison of the challenged claims to the asserted art. Pet. 20–42. At this point in the proceeding, Patent Owner does not dispute Petitioner's obviousness contentions.

1. Rationale for proposed combination

Petitioner asserts Merriman061 teaches that it is “highly desirable to target advertisements to the appropriate potential customer base” and discloses “techniques for gathering profile information about users and

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using it to target ads to the users.” Pet. 20–21 (citing Ex. 1004, 1:13–14, 1:52–53, 1:64–2:3, 2:6–30, 4:44–5:7, 5:50–59, 7:46–8:30, 8:39–46; Ex. 1002 ¶ 123). According to Petitioner, Jaye “recognizes the importance of collecting profile information for targeted advertising” and discloses “techniques for combining profile information from multiple local websites visited by users into more comprehensive global profiles that may be shared with ‘interested outside parties, such as advertisers.’” *Id.* at 21 (citing Ex. 1005, code (57), 1:18–38, 2:6–10, 2:6–8, 2:15–3:40, 5:5–19, 6:1–7:45, 8:40–10:41, 14:22–25; Ex. 1002 ¶ 123). Petitioner contends that a person of ordinary skill in the art would have been motivated to “incorporate Jaye’s techniques for collecting and combining profile information to enhance and improve Meriman061’s ad targeting by providing more information about the users to whom the ads are targeted.” *Id.* (citing Ex. 1002 ¶ 123).

Having reviewed the arguments and evidence included in the Petition, including the Houh Declaration, which are not substantively addressed by Patent Owner at this stage, we are persuaded that Petitioner sufficiently demonstrates, for purposes of this Decision, that it would have been obvious to combine Merriman061 and Jaye in the manner set forth in the Petition.

2. Petitioner’s contentions regarding claim 1

Petitioner addresses each limitation of claim 1. Pet. 21–35. Patent Owner does not dispute Petitioner’s assertions for each limitation. Below, we address each limitation of claim 1.

a) *Preamble*

The preamble of claim 1 recites “[a]n automated method of collecting profiles of Internet using entities.” Ex. 1001, 16:59–60.

Petitioner contends that “[t]o the extent the preamble is limiting, Merriman061 discloses it.” Pet. 21. More specifically, Petitioner asserts that Merriman061 discloses “an advertising network that implements a method for ‘targeting the delivery of advertisements over a network’” that “targets ads by collecting profiles of users who are Internet-using entities.” *Id.* at 21–22 (citing Ex. 1004, code (57), 1:8–11, 2:6–7, 2:65–3:1, 3:41–52, 4:44–51, 8:51–56, 14:2–3; Ex. 1002 ¶ 126–129). According to Petitioner, “Merriman061’s method is performed automatically when a user visits a website and is thus ‘automated.’” *Id.* at 22 (citing Ex. 1004, 3:41–52, 4:25–28, 5:13–28, 6:17–19, 7:45–8:30; Ex. 1002 ¶ 130).¹²

b) *Limitation 1a(i):¹³ the electronically receiving step*

Claim 1 further recites “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, an electronically URL-redirectioned partial profile of an entity that uses a user

¹² Because Petitioner has sufficiently shown that the prior art teaches the preamble, we need not determine at this time whether the preamble is limiting. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017). If Patent Owner contends that the preamble is limiting, it must do so in the claim construction section of the Patent Owner’s Response.

¹³ Petitioner divides the portion of claim 1 labeled “(a)” into four parts. For convenience, we do the same.

computer coupled to the global computer network to access a website, which partial profile . . . contains at least one profile attribute related to the entity.”¹⁴ Ex. 1001, 16:61–17:1 (“limitation 1(a)(i)” or “the electronically receiving step”). Petitioner contends that the combination of Merriman061 and Jaye suggests this limitation. Pet. 22.

Specifically, Petitioner contends that Merriman061’s “advertising server process” corresponds to the claimed “programmed computer system coupled to a global computer network” because it is an “‘advertisement (ad server web site)’ that comprises a programmed computer coupled to the Internet.” Pet. 23 (citing Ex. 1004, 2:60–61, 3:15–18, 4:15–24; 9:8–16; Ex. 1002 ¶ 137). Petitioner contends that Merriman061’s “affiliate web site” corresponds to the claimed “at least one server controlled by one of a plurality of unaffiliated third parties,” explaining that “[t]he server providing the website is controlled by a publisher that is one of a plurality of publishers.” *Id.* (citing Ex. 1002 ¶¶ 139; Ex. 1004, 3:28–35, 4:16–17; Ex. 1008, 26). And Petitioner contends that Merriman061’s “user’s browser” corresponds to the claimed “entity that uses a user computer coupled to the global computer network to access a website,” explaining that “Merriman061 describes ‘a user browsing on the Internet’ who ‘accesses an affiliate’s web site.’” *Id.* at 24 (citing Ex. 1002 ¶ 143; Ex. 1004, 3:6–7).

According to Petitioner, “Merriman061 discloses the ad server ‘electronically receiving . . . an electronically URL-redirected partial profile of an entity . . . , which partial profile . . . contains at least one profile

¹⁴ Petitioner designates the material omitted by the ellipsis limitation 1(a)(ii) and addresses it separately. Pet. 31.

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attribute related to the entity” as recited in claim 1. *Id.* at 24–25 (citing Ex. 1002 ¶¶ 144–151). Petitioner explains that when a user’s browser requests a web page from the affiliate web site, the web site transmits, *inter alia*, one or more messages including “one or more advertising objects” which “do not reside on the affiliate’s web server.” *Id.* at 25 (citing Ex. 1004, 3:5–15, 3:24–38; Ex. 1002 ¶ 145). “The messages include ‘a link including an IP address for a node running an advertiser server process.’” *Id.* (citing Ex. 1004, 3:38–41; Ex. 1002 ¶ 145). “The user’s browser . . . then transmits a message . . . using the received IP address to access such an object indicated by the HTML tag from the advertisement server.” *Id.* at 25–26 (citing Ex. 1004, 3:41–44; Ex. 1002 ¶ 48). According to Petitioner, the link included in the message “causes an electronic URL redirection” and the redirection “causes the ad server to receive a message including user profile information including ‘a cookie if the browser is cookie enabled. . .’ and ‘a substring key indicating the page in which the advertisement . . . is to be embedded.’” *Id.* at 26 (citing Ex. 1002 ¶¶ 146–148; Ex. 1004, 3:35–52; Ex. 1011, 9, 34–35).

Petitioner acknowledges that Merriman061 “does not explain precisely how the partial profile is received ‘from at least one server controlled by one of a plurality of unaffiliated third parties,’” but contends that this information would have been obvious based in the disclosure of Jaye. *Id.* at 27 (citing Ex. 1002 ¶ 50). Petitioner contends that Jaye “discloses that when a client requests a web page from a ‘local server,’ the local server redirects the client to an ‘enterprise’ (also called a ‘global’) server using a ‘special URL.’” *Id.* (citing Ex. 1005, 2:31–40, 6:32–46; Ex.

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1009, 268–69; Ex. 1002 ¶¶ 151–154). “The special URL contains information appended at the end conveying profile information from the local server to the enterprise server.” *Id.* at 28 (citing Ex. 1005, 6:32–43). According to Petitioner, it would have been obvious to use “Jaye’s special URL to append profile information (i.e., a partial profile) to the URL that redirects the user’s browser to the ad server in [Merriman061’s] messages” because it would “efficiently convey additional profile information to Merriman061’s ad server in real time, enable more precise targeting, and increase advertising revenue.” *Id.* at 28–29 (citing Ex. 1002 ¶¶ 50, 155–157; Ex. 1004, 1:52–53, 3:35–38; Ex. 1005, 1:18–25, 6:32–43; Ex. 1008, 16, 28, 43, 105). Petitioner explains that this combination is the combination of known methods to achieve predictable results and that a person of ordinary skill in the art would reasonably have expected success using a URL in this way because it was conventional. *Id.* at 30–31 (citing Ex. 1005, 4:7–20, 6:26–38, 7:49–57; Ex. 1002 ¶ 157; Ex. 1008, 41; Ex. 1009, 218–219).

c) Limitation 1a(ii): partial profile is available

Claim 1 further recites that the “electronically URL-redirected partial profile of an entity that uses a user computer” recited in limitation 1a(i) is “available to one of the third parties.” Ex. 1001, 16:61–17:1 (“limitation 1(a)(ii)” or “the partial profile availability limitation”). Petitioner contends that in the combination of Merriman061 and Jaye, “the partial profile is ‘available’ to the affiliate website because the website necessarily has access to the partial profile to append the profile information to the URL as taught in both Merriman061 and Jaye.” Pet. 31 (citing Ex. 1004, 3:44–52; Ex.

1005, 6:22–31, 6:43–46; Ex. 1002 ¶¶ 159-160). Petitioner also points out that Jaye teaches that its “substring key” and “local user ID” are available to the affiliate website. *Id.* (citing Ex. 1005, 5:31–67, 7:7–19).

d) Limitation 1a(iii): partial profile received with identification of third parties

Claim 1 further recites that the “electronically URL-redirectioned partial profile of an entity that uses a user computer” recited in limitation 1a(i) is “received along with an identification of the one of the third parties that contributed the partial profile.” Ex. 1001, 16:60–17:4 (“limitation 1a(iii)” or “the received with limitation”).

Petitioner asserts that in the combination suggested by Merriman061 and Jaye, “the partial profile is ‘received along with an identification of the one of the third parties that contributed the partial profile.’” Pet. 31. Petitioner points out that the “local_server_id in Jaye’s special URL identifies the affiliate website contributing the other profile information, including the user ID and the substring key.” *Id.* (citing Ex. 1005, 6:40–46, 7:49–51; Ex. 1002 ¶¶ 163–164). In addition, Petitioner contends that it would have been obvious to “receive the identification of the contributing server using the conventional HTTP ‘Referer’ [*sic*] field.” *Id.* at 31–32 (citing Ex. 1002 ¶ 165) (“sic” in original).

e) Limitation 1a(iv): automatically storing

Claim 1 further recites “automatically with the computer system storing the received profile particular profile.” Ex. 1001, 17:4–5 (“limitation 1a(iv)” or “the automatically storing limitation”). Petitioner asserts that the combination suggested by Merriman061 and Jaye discloses automatically

storing the received partial profile. Pet. 32 (citing Ex. 1002 ¶¶ 166–167). According to Petitioner, “Merriman061’s ad server maintains a ‘database structure’ that stores profile information for ‘each user identified by the system.’” *Id.* (citing Ex. 1004, Fig. 3A, 4:43–51, 5:10–63; Ex. 1002 ¶ 166). Petitioner contends that in the proposed combination, it would have been obvious for Merriman061’s ad server to receive profile information appended at the end of the redirect URL. *Id.* Petitioner explains that both Merriman061 and Jaye disclose storing profile information in a database, with Jaye “explicitly disclos[ing] storing the profile information appended to the URL in a database.” *Id.* (citing Ex. 1004, 4:43–51; Ex. 1005, 8:23–26; Ex. 1002 ¶ 167). According to Petitioner, automatically storing profiles in this manner “would allow the ad server to combine profile data received from the affiliate websites on a per-user basis to build more robust user profiles.” *Id.* at 32–33 (citing Ex. 1004, 8:51–56; Ex. 1005, 2:21–24, 3:3–9, 8:35–43). Petitioner asserts that a person of ordinary skill in the art would reasonably have expected this combination to be successful because it uses known methods to yield predictable results in a conventional way. *Id.* at 33 (citing Ex. 1005, 8:16–28; Ex. 1002 ¶ 167).

f) Limitation 1b: stored profile limitation

Claim 1 further recites “automatically with the computer system electronically adding the received partial profile to a maintained profile believed to be related to the same entity.” Ex. 1001, 17:6–8 (“limitation 1b” or “the automatically adding limitation”). Petitioner asserts that “Merriman061 in combination with Jaye discloses this limitation.” Pet. 33. According to Petitioner, “Merriman061’s database stores for ‘each user

identified by the system,’ ‘all of the information known about the user’” and, “[a]s it receives additional partial profiles for a user, Merriman061’s ad server adds the partial profile information to the maintained profile believed to be related to the same user.” *Id.* at 33–34 (citing Ex. 1004, 2:11–15, 2:26–30, 4:43–55, 5:10–20; Ex. 1005, 6:32–58; Ex. 1002 ¶¶ 170-171).

g) Limitation 1c: automatically generating

Claim 1 further recites “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.” Ex. 1001, 17:9–12 (“limitation 1c” or the “automatically generating limitation”). Petitioner contends that in the combination of Merriman061 and Jaye, when Merriman061’s ad server ads a partial received profile to the user’s database record, as discussed with respect to limitation 1b, “[t]he ad server adds the partial profile by automatically generating and storing an electronic database record to hold the profile information.” Pet. 34 (citing Ex. 1002 ¶ 172; Ex. 1009, 48–50). According to Petitioner, in the proposed combination, “the stored record includes the local server ID, which identifies both the website visited by the user and the website that redirected the user’s browser to the ad server,” thus identifying “which of the plurality of unaffiliated third parties contributed to the maintained profile particular profile attributes.” *Id.* (citing Ex. 1002 ¶ 173; Ex. 1005, 7:49–53, 8:25–26).

h) Limitation 1d: profile comprising

Claim 1 further recites “wherein the maintained profile, including the added partial profile, comprises data used in targeting third-party

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advertisements to the user computer over the global computer network.”

Ex. 1001, 17:13–16 (“limitation 1d” or the “profile comprising limitation”).

Petitioner contends that Merriman061 discloses this limitation. Pet. 35

(citing Ex. 1002 ¶ 174–175). More specifically, Petitioner asserts that

Merriman061 “discloses using the profile data in the database, which stores the maintained profile including the added partial profile, to target

advertisements to the user computer over the Internet” and teaches that the

ads are “third-party advertisements.” *Id.* (citing Ex. 1004, 2:18–36, 2:62–65, 3:52–62, 4:50–55, 5:50–6:59; Ex. 1002 ¶¶ 174–175).

i) Conclusion for claim 1

Having reviewed the arguments and evidence included in the Petition, including the Houh Declaration, which are not substantively addressed by Patent Owner at this stage, we are persuaded that Petitioner sufficiently demonstrates, for purposes of this Decision, that the combination of Merriman061 and Jaye teaches or suggests each of the limitations of claim 1. Accordingly, we determine that, based on the current record, there is a reasonable likelihood that Petitioner will prevail in demonstrating that claim 1 is unpatentable as obvious over the combination of Merriman061 and Jaye.

3. Petitioner’s contentions regarding claims 3–6, 10, 11, 13–16, 20, 21, 23–26, and 30

Because Petitioner demonstrates a reasonable likelihood of success in proving that at least one claim of the ’904 patent is unpatentable, we institute on all grounds and all claims raised in the Petition. *See* 37 C.F.R.

§ 42.108(a). Therefore, at this stage of the proceeding, it is not necessary for

us to provide an assessment of every claim in the ground challenged by Petitioner, especially, as in this case, when Patent Owner does not separately argue those claims. Those challenges, in our view, are best left for trial after full development of the record.

I. Remaining Grounds

Petitioner asserts that claims 1, 3–6, 9–11, 13–16, 19–21, 23–26, 29, and 30 would have been obvious over the combination of Rosenberg and Merriman154, claims 7, 8, 17, 18, 27, and 28 would have been obvious over the combination of Merriman061, Jaye, and Coleman, and claims 7, 8, 17, 18, 27, and 28 would have been obvious over the combination Rosenberg, Merriman154, and Coleman. Because Petitioner demonstrates a reasonable likelihood of success in proving that at least one claim of the '904 patent is unpatentable, we institute on all grounds and all claims raised in the Petition. *See* 37 C.F.R. § 42.108(a). Therefore, at this stage of the proceeding, it is not necessary for us to provide an assessment of every challenge raised by Petitioner, especially, as in this case, when Patent Owner does not separately argue these grounds. Those challenges, in our view, are best left for trial after full development of the record.

III. CONCLUSION

On this record, Petitioner has established a reasonable likelihood of prevailing in showing that at least one of the challenged claims is unpatentable based on the grounds advanced in the Petition.

IV. NOTICES

The Board shall deem forfeited any issue not raised by Patent Owner

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in a timely response to the Petition or as permitted in another manner during trial.

Nothing in this Decision authorizes Petitioner, in a manner not otherwise permitted by the Board's rules or controlling precedent, to supplement the information supporting any ground advanced in the Petition.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *granted*, and we institute *inter partes* review of claims 1, 3–11, 13–21, and 23–30 based on the grounds asserted in this Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is given of the institution of trial, which will commence on the entry date of this Decision.

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