

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIVEINTENT, INC.,
Petitioner

v.

INTENT IQ, LLC AND ALMONDNET, INC.,
Patent Owner

Case IPR2025-01317
U.S. patent No. 8,677,398

**PETITIONER'S OPPOSITION TO
PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL**

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EXHIBITS

- EX1001 U.S. Patent No. 8,677,398 to Shkedi (“the ’398 Patent”)
- EX1002 Excerpts from the Prosecution History of the ’398 Patent (“the Prosecution History”)
- EX1003 Declaration and Curriculum Vitae of Dr. Michael Mitzenmacher
- EX1004 U.S. Pub. No. 2002/0123928 to Charles A. Eldering *et al.* (“Eldering”)
- EX1005 U.S. Pub. No. 2006/0265507 to Jaz Banga *et al.* (“Banga”)
- EX1006 U.S. Pub. No. 2007/0244750 to Grannan *et al.* (“Grannan”)
- EX1007 Internet Engineering Task Force (IETF) Request for Comment (RFC) 2460, *Internet Protocol, Version 6 (IPv6) Specification* (Dec. 1998)
- EX1008 IETF RFC 3177, *IAB/IESG Recommendations on IPv6 Address Allocations to Sites* (Sep. 2001)
- EX1009 IETF RFC 3513, *Internet Protocol Version 6 (IPv6) Addressing Architecture* (Apr. 2003)
- EX1010 IETF RFC 3587, *IPv6 Global Unicast Address Format* (Aug. 2003)
- EX1011 Internet Draft v08 of IETF RFC 2462, *IPv6 Stateless Address Autoconfiguration*, draft-ietf-ipv6-rfc2462bis-08.txt (May 12, 2005)
- EX1012 U.S. Pub. No. 2008/0133327 to Shah Ullah
- EX1013 U.S. Pub. No. 2007/0038568 to Todd Greene *et al.*
- EX1014 U.S. Pub. No. 2008/0201733 to Kent Ertugrul *et al.*
- EX1015 U.S. Patent No. 6,298,348 to Charles A. Eldering
- EX1016 U.S. Patent No. 6,457,010 to Charles A. Eldering and M. Lamine Sylla

- EX1017 Wayback Capture of P. Hoffman and S. Harris, “The Tao of IETF: A Novice's Guide to the Internet Engineering Task Force,” available at <https://web.archive.org/web/20070214120950/http://www.ietf.org:80/tao.html> (captured on Feb. 14, 2007)
- EX1018 Wayback Capture of RFC Editor available at <https://web.archive.org/web/20070217105548/http://www.rfc-editor.org:80/rfc.html> (captured on Feb. 17, 2007)
- EX1019 IETF RFC 6177, *IPv6 Address Assignment to End Sites* (Mar. 2011)
- EX1020 August 25, 2025 Stipulation
- EX1021 “Notice of Intent to Issue Ex Parte Reexamination Certificate” dated June 27, 2024, U.S. *Ex Parte* Reexamination No. 90/015,284
- EX1022 “Office Action in Ex Parte Reexamination” dated March 14, 2024, U.S. *Ex Parte* Reexamination No. 90/015,284
- EX1023 *Viant Technology LLC v. Intent IQ, LLC*, IPR2024-00421, Final Written Decision (Paper 41) (PTAB Oct. 14, 2025)
- EX1024 *Meta Platforms, Inc. v. AlmondNet, Inc.*, IPR2022-00773, Decision Institution of Inter Partes Review (Paper 6) (PTAB Oct. 21, 2022)
- EX1025 Complaint dated July 18, 2024, *AlmondNet, Inc. et al v. LiveIntent, Inc.*, Case No. 1-24-cv-00831 (DDE)
- EX1026 U.S. Patent No. 10,984,445
- EX1027 U.S. Patent No. 8,959,146
- EX1028 U.S. Patent No. 8,494,904
- EX1029 Docket Entries for *AlmondNet, Inc. et al v. LiveIntent, Inc.*, Case No. 1-24-cv-00831 (DDE)

I. INTRODUCTION

The Patent Trial and Appeal Board (Board) is uniquely suited to assess the patentability of the challenged claims of the '398 patent. The '398 patent is part of a family of three U.S. patent applications, each of which issued as a patent and claims overlapping subject matter with the others. The PTAB recently determined that all of the claims of one of the patents in the family (U.S. Patent No. 7,861,260) were unpatentable, demonstrating the obviousness of the claimed subject matter. Moreover, the prosecution history of the '398 patent tells a simple story for those familiar with patent prosecution. In examining the '398 patent, the Examiner failed to consider a reference cited in an Information Disclosure Statement that discloses the very feature identified by the Examiner as leading to allowance of the claims of the '398 patent. Had the Examiner simply considered this cited and considered reference, Eldering (EX1004), the Examiner would have determined that the '398 patent claims are unpatentable. This failure amounts to a pervasive material error that favors referral.

The Board's review of the '398 patent would also represent the most efficient allocation of judicial and administrative resources. In addition to the significant errors that occurred during examination of the '398 patent family, Patent Owner has asserted in a parallel district court litigation three other patents with divergent subject matter, creating a complicated technological backdrop ill-suited for

a district court. The Board’s technical expertise and familiarity with patent law and examination make it the optimal forum to address and simplify this complexity.

Furthermore, the parallel district court litigation is in its infancy, LiveIntent (Petitioner) has filed a broader-than-*Sotera* stipulation to prevent overlap of issues between this *Inter Partes* Review (IPR) and that litigation.

Under these circumstances, allocating Patent Office resources to review the ’398 patent would allow the Patent Office to correct its own material errors and avoid unnecessary burden on the district court, which has been drawn into the dispute between Petitioner and Patent Owner because these material errors led to the improper issuance of the ’398 patent. Referral to the Board is therefore appropriate.

II. The ’398 Patent Issued Only as a Result of the Examiner’s Material Error During Prosecution, Thus Justifying Referral of the Petition.

Material error during patent prosecution strongly favors granting review over discretionary denial. Correcting such errors is critical, often overriding a Patent Owner’s settled expectations or factors supporting a *Fintiv* denial. For settled expectations, see *Anthony, Inc. v. ControlTec, LLC* (“Anthony”), IPR2025-00559, Paper 12, at 2 (PTAB July 16, 2025) (strong settled expectations in patents that have been in force for approximately 18 and 17 years overcome by a material error showing, making it “an appropriate use of Office resources to review the potential

error.”); *Freightcar America, Inc. v. National Steel Car Ltd.* (“*Freightcar*”), IPR2025-01046, Paper 20, at 2-3 (PTAB Oct. 10, 2025) (petition referred to panel despite thirteen-year-old patent due to examiner’s failure to consider cited reference with respect to reasons for allowance); *Eunsung Global Corp. v. Hydrafacial LLC* (“*Eunsung*”), IPR2025-00445, Paper 14, at 2 (PTAB July 10, 2025) (petition referred despite an eight-year-old patent). For *Fintiv*, see *Microsoft Corporation v. Partec Cluster Competence Center GMBH*, IPR2025-00318, Paper 9, at 2 (PTAB June 12, 2025) (petition referred despite trial one month before Final Written Decision due to Examiner’s oversight of prior art); *Padagis v. Neurelis, Inc.*, IPR2025-00464-466, Paper 12, at 2-3 (PTAB July 16, 2025) (petition referred despite trial five months prior due to Examiner’s contradiction of prior Board priority date ruling). See also *Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025-00152, Paper 11, at 2 (PTAB June 12, 2025); *Microsoft Corp. v. XI Discovery, Inc.*, IPR2025-00253, Paper 13, at 2 (June 25, 2025).

As explained in Sections IV-VI, *infra*, Patent Owner over-estimates its settled expectations and *Fintiv* denial is plainly inappropriate. Even if this were not the case, however, referral to the merits panel would still be appropriate to allow the Board to correct a material error that occurred during prosecution of the ’398 patent.

A. Applicant Cited and the Examiner Considered Eldering

The Ground set forth in the Petition demonstrates the obviousness of the Challenged Claims based, in large part, on Eldering (EX1004). The Examiner failed to apply this reference in any rejections against the claims of the '398 patent, despite having considered Eldering during examination.

The Applicant cited Eldering in an Information Disclosure Statement (IDS) filed with the application that led to the '398 patent on June 23, 2011. EX1002, 435. The Examiner indicated consideration of Eldering on January 3, 2013 by initialing the IDS. EX1002, 317.

<u> </u>	13	20020123928	09/05/2002	Eldering et al.
<u> </u>	14	20020124249	09/05/2002	Shintani
<u> </u>	15	20020124253	09/05/2002	Iyer et al.
<u> </u>	16	20020129368	09/12/2002	Schlack et al.
<u> </u>	17	20020194058	12/19/2002	Eldering
<u> </u>	18	20030066078	04/03/2003	Bjorgan et al.
<u> </u>	19	20030149975	08/07/2003	Eldering et al.
<u> </u>	20	20030187949	10/02/2003	Bhatt et al.
<u> </u>	21	20040073915	04/15/2004	Dureau
<u> </u>	22	20040078809	04/22/2004	Drazin
<u> </u>	23	20040117827	06/17/2004	Karaoguz et al.
<u> </u>	24	20040163101	08/19/2004	Swix et al.
<u> </u>	25	20040172650	09/02/2004	Hawkins et al.
<u> </u>	26	20060253323	11/09/2006	Phan et al.
<u> </u>	27	20060271953	11/30/2006	Jacoby et al.
<u> </u>	28	20070100690	05/03/2007	Hopkins
<u> </u>	29	20080016540	01/17/2008	Savoer et al.
<u> </u>	30	20080040742	02/14/2008	Howcroft et al.

Examiner: /Nnenna Ekpo/ Date Considered: 01/03/2013

EXAMINER: Initial if reference considered whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /N.E./

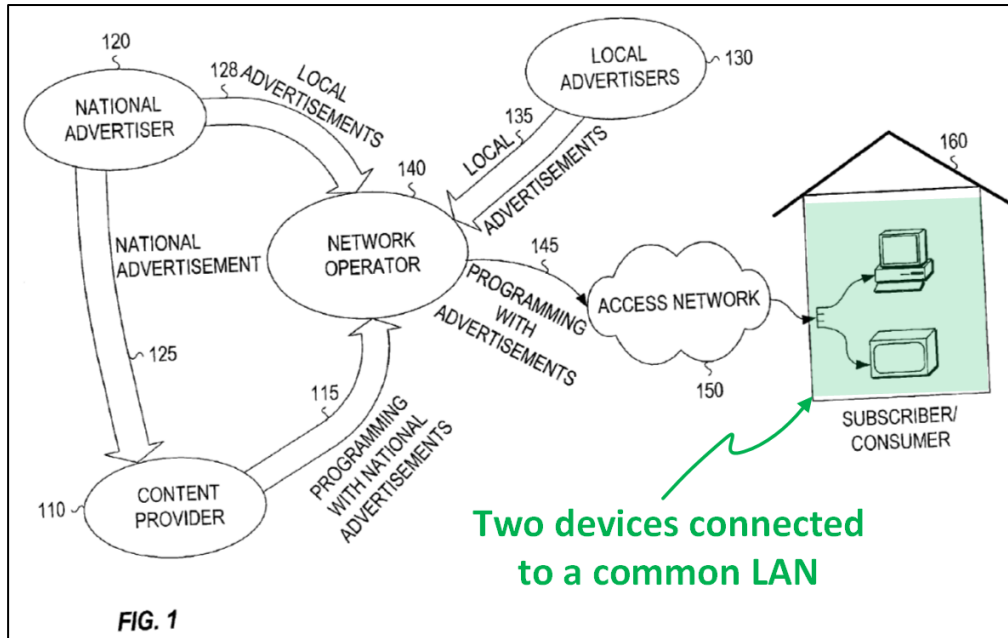
Nonetheless, the Examiner went on to issue a Notice of Allowance several

months later, on August 20, 2013. EX1002, 141-151. In allowing the claims of the '398 patent, the Examiner indicated that the reason for allowance is because the prior art:

do not disclose nor suggest requiring that a computer recognizes an association between two devices, with the association being derived from the computer observing that two devices are connected to a common LAN and with the computer system, based on the electronic indicia of the association between the first and second device identifiers, automatically sending an electronic transmission that causes another programmed hardware computer system to take an action, based on first electronic profile data associated with the first device identifier, with respect to the second device, which is indicated at the time of the action by the second device identifier.

EX1002, 148-149.

As described in the Petition, Eldering is central in the obviousness of these features. As shown in FIG. 1 (below), Eldering illustrates two devices connected to a common LAN within a household. EX1004, FIG. 1.



Eldering goes on to explain that its system is configured to develop a profile for the whole household that tracks “viewing characteristics” over a “compilation of viewing sessions.” EX1004, [0101]-[0105]. Each of these viewing sessions “will be identified by some unique identification, which may include but it not limited to...Internet Protocol (IP) address,” which the Petition explains is used to correlate the sessions across the household’s devices. EX1004, [0091]; Pet., 31-34. Eldering’s system then uses the data collected in the household profile to serve advertisements (*i.e.*, take an action) to the devices associated with the household. See Pet., 38-43.

Failing to recognize the teachings of Eldering as directly applicable to the claim limitations identified as leading to allowance of the ’398 patent’s claims constitutes material error.

B. The Prior Challenges to the '398 Patent Do Not Address the Material Error, and Instead Reveal Further Material Error

Patent Owner highlights an *ex parte* reexamination that “considered the patentability of claims 1–2 over three separate grounds of unpatentability, and confirmed the validity of the claims.” Paper 7 (“DD”), 6. However, in its “Statement of Reasons for Patentability and/or Confirmation,” the Examiner in the reexamination highlighted one of the same features identified during original prosecution as leading to allowance, which Eldering teaches. *See* EX1021, 4-5.

The reexamination did not consider the patentability of the claims of the '398 patent based on Eldering. *See generally* EX1022. And the reexamination only found patentability with respect to the “applied references,” not all of the prior art cited in the original examination or the information disclosure statements submitted in the reexamination. *See* EX1021, 6-7. Thus, the reexamination did not address the material error committed during original prosecution of the '398 Patent.

Moreover, the conclusions of the Examiner in the reexamination have since been demonstrated to be of highly questionable merit. Specifically, on October 14, 2025 (over a year after the “Notice of Intent to Issue Ex Parte Reexamination Certificate” was filed by the Examiner in the reexamination of the '398 Patent), the Board issued a final written decision determining that all claims of U.S. Patent No.

7,861,260 are unpatentable based on the same Baig reference applied in the reexamination of the '398 patent. *Compare* EX1023, 8 *with* EX1022, 5. The '260 patent is the parent of the '398 patent. EX1001, p. 1. Moreover, the claims of the parent '260 patent were similar enough to the claims of the '398 patent that the Examiner of the '398 patent issued an obviousness-type double patenting rejection with respect to the '260 patent. EX1002, 189. And instead of traversing the rejection, Patent Owner filed a terminal disclaimer with respect to the '260 patent. EX1002, 172. Accordingly, the Board's decision to hold the claims of the '260 patent unpatentable based on Baig not only undermines the credibility of the prior reexamination of the '398 patent based on the same Baig reference, it reveals further material error in the Office's prior consideration of the '398 Patent.¹

¹ The '398 Patent was also the subject of several prior IPR petitions. *See* Pet., 69-70. However, Patent Owner conspicuously does not cite to these prior challenges in arguing for discretionary denial. *See generally* DD. This silence stands to reason, because the Board instituted IPR2022-00773 against the '398 patent based on the same Baig reference at issue in the '398 reexamination and '290 patent IPR. EX1024, 5. However, IPR2022-00773 was terminated due to settlement prior to the Board adjudicating the patentability of the '398 patent claims. The remaining

C. The Material Error During Prosecution of the '398 Patent Warrants Referral

These significant errors—failing to consider a key prior art reference of which the Examiner was aware and failing to properly consider prior art in a reexamination—strongly weigh against discretionary denial and independently justify referring the Petition to the merits panel. Indeed, the Director has referred petitions to the merits panel under similar and even less compelling circumstances.

For example, in *Freightcar*, the Director referred the petition despite the patent having been in force for over thirteen years. *Freightcar*, 1. In referring the petition, the Director explained that “Petitioner persuasively demonstrates that the patent examiner overlooked certain teachings of [a reference cited in an IDS] that appear to disclose the allowable features of the claims.” *Freightcar*, 2-3. The exact same material error exists here. Further, in *Eunsung*, the challenged patent, which had been in force for 8 years, was referred to the merits panel because the Examiner overlooked certain teachings in a prior art reference that disclosed the allowable features of the challenged claims. *Eunsung*, 2. By overlooking the teach-

IPRs were all denied institution on procedural issues inapplicable here, not on the merits.

ings of Eldering, the Office committed a similar material error “and it is an appropriate use of Office resources to review the potential error.” *Freightcar*, 3.

III. BOARD REVIEW WOULD STREAMLINE COMPLEX ISSUES IN THE CO-PENDING DISTRICT COURT LITIGATION.

AlmondNet’s assertion of a “large number and vast scope of [] patents” directed toward “a diverse range of subject matter” in the parallel district court proceeding is the precise situation for which “the Board is better suited to review” issues of validity. *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9, at 2-3 (Jun. 13, 2025). The ’398 patent is one of four patents originally asserted in the district court litigation, and the other three patents are in unrelated families and cover subject matter distinct from the ’398 patent. EX1022, 1.

For example, the ’398 patent is related to causing an action to be performed on a second electronic device (e.g., displaying an advertisement) in response to recognizing that a second electronic device is connected to the same local area network as a first electronic device. EX1001, 24:49-54. However, the ’445 patent is related to delivering an advertisement to a visitor device as a result of comparing (1) a visitor profile linked to a visitor device by a tag and (2) stored requests from media property entities. EX1026, 15:3-14. The ’146 patent is related to displaying an advertisement to an electronic visitor on a second media property based on a profile attribute correlated with the advertisement being received after the elec-

tronic visitor visits a first media property. EX1027, 12:64-13:5. And the '904 patent is related to receiving a URL-redirection partial profile for use with delivering third-party advertisements. EX1028, 16:61-17:5.

Although all are related to electronic advertising, these patents focus on a broad array of complex and disparate subject matter within electronic advertising. Such diverse technology in the district court litigation favors institution, as institution here would help narrow the issues in the co-pending litigation, ultimately conserving resources of the parties, the judiciary, and the Board.

IV. PATENT OWNER OVERESTIMATES ITS SETTLED EXPECTATIONS REGARDING THE '398 PATENT.

Patent Owner's claim of settled expectations for the '398 patent is undermined by a history of developments affecting its scope and validity. *First*, the parent '260 patent, with similar claims, had all challenged claims found unpatentable. EX1023. *Second*, the '398 patent's flawed examination process, resulting in material error, outweighs settled expectations. *See Anthony*, IPR2025-00559, Paper 12, at 2; *supra* Section II. Thus, discretionary denial is unwarranted despite the patent's age.

V. NEITHER THE PETITION'S EXPERT TESTIMONY NOR ITS RELIANCE ON OBVIOUSNESS GROUNDS FAVORS DISCRETIONARY DENIAL.

Patent Owner argues that the Petition's extensive expert testimony favors discretionary denial, as district courts better assess witness credibility. DD, 6.

However, Patent Owner states that the expert merely “explain[s] the relevance of the prior art,” and Patent Owner does not even assert that the Petition relies on expert testimony to fill gaps in prior art for one simple reason: no such gaps exist. *Id.* Further, the declaration complies with the Consolidated Trial Practice Guide (TPG), establishing the level of skill in the art, explaining prior art teachings, and providing reasons to combine references without substituting for prior art disclosures. *iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00377, Paper 10, at 2 (PTAB June 6, 2025); TPG 34-36; VLI-1003, *generally*. Thus, the expert testimony does not support denial.

Patent Owner’s claims that the Petition’s relies on obviousness (§ 103) rather than anticipation (§ 102) is equally weak and unavailing. DD, 12-13. The statutory basis does not determine the challenge’s merits, which depend on the strength of facts and law. Patent Owner identifies no evidentiary or legal flaws in the Petition’s prior art or arguments. Thus, the use of obviousness does not favor discretionary denial.

VI. THE *FINTIV* FACTORS DO NOT FAVOR DISCRETIONARY DENIAL.

Every *Fintiv* factor is either neutral or weighs against discretionary denial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential).

A. Factors 1 and 5: No Stay Has Been Requested, and the Same Parties Are in the Co-Pending Litigation.

Factors 1 and 5 are neutral. No litigation stay has been requested in the LiveIntent trial. Further, the parties in the co-pending litigation and this IPR are the same.

B. Factors 2-3: The Court's Trial Date Would Occur Well After the Final Written Issue Is Issued, and Limited Resources Would Have Been Expended by Institution.

Factors 2 and 3 favor referral and, at worst, are neutral. The LiveIntent trial is scheduled for October 4, 2027. EX1029, 5. The Final Written Decision in this IPR is expected in late January, 2027—well before the scheduled trial date. Indeed, Patent Owner and Petitioner have not exchanged infringement or invalidity contentions, proposed terms for claim constructions, or scheduled depositions. Claim construction briefs are due September 25, 2026, fact discovery is not expected to be completed until August 28, 2026, and opening expert reports are not due until January 15, 2027. EX1029, 5.

C. Factor 4: There Is No Overlap Between the Issues in the Petition and the District Court Proceeding.

Factor 4 strongly favors institution. In Patent Owner's view, Petitioner's broader-than-*Sotera* stipulation is insufficiently broad because it permits Petitioner to raise an invalidity ground based on system prior art in combination with prior art that reasonably could have been raised in this IPR proceeding. DD, 9-11. But the breadth of Petitioner's stipulation is identical to the breadth of stipulations in other

proceedings where the Director determined the stipulations weighed against discretionary denial. *See Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9, at 2 (PTAB June 13, 2025); *Tesla*, IPR2025-00217, Paper 8, at 10-11 (PTAB May 27, 2025) (stipulation having same breadth as Petitioner's stipulation); *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00341, Paper 12, at 2 (PTAB June 13, 2025); *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00341, Paper 10, at 10-11 (PTAB May 27, 2025) (stipulation having same breadth as Petitioner's stipulation). Patent Owner's observation that the stipulation *could* be even broader does not alter the conclusion that Petitioner's stipulation weighs against discretionary denial.

Patent Owner claims Petitioner's broader-than-*Sotera* stipulation allows subsequent *ex parte* reexamination requests, potentially causing inefficiencies. DD, 11. However, this is irrelevant to inefficiencies with respect to co-pending district court litigation and speculative, as no such reexamination exists. Statutory and administrative mechanisms mitigate inefficiencies: estoppel under 35 U.S.C. § 315(e)(1) prevents Petitioner from raising IPR grounds in later reexaminations; the Director can manage concurrent proceedings under 35 U.S.C. § 314(d); and the patent Office can deny abusive reexamination requests under 35 U.S.C. § 325(d). *In re Vivint, Inc.*, 14 F.4th 1342, 1354 (Fed. Cir. 2021). Thus, an even broader stipulation is unnecessary.

D. Factor 6: Other Circumstances Weigh in Favor of Referral.

Factor 6 strongly favors referral. As discussed above, contrary to Patent Owner's assertion, the Petition's reliance on obviousness grounds has no bearing on the merits of unpatentability. DD, 12-13; *see supra* Section V. The Petition's merits are strong at least because it offers compelling evidence as to why the prior art teaches all features of the Challenged Claims of the '398 patent. *See supra* Section II. And the other factors raised in Patent Owner's briefing—including settled expectations and expert testimony—do not favor discretionary denial, as discussed above. *See supra* Section IV. In fact, other factors, such as material error and litigation complexity, favor referral. *See supra* Sections II-III.

VII. CONCLUSION

For these reasons, a holistic evaluation of the record strongly weighs against discretionary denial. Petitioner therefore respectfully requests that this case proceed to an institution determination on the merits.

Respectfully submitted,

Dated October 31, 2025

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