

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WALGREEN CO., AHOLD USA, INC., DELHAIZE AMERICA, LLC,
AND PUBLIX SUPER MARKETS, INC.,

Petitioner,

v.

ADVANCED MARKETING SYSTEMS, LLC,

Patent Owner.

Cases CBM2016-00014 and CBM2016-00015

Patent 8,370,199 B2

Before THOMAS L. GIANNETTI, TREVOR M. JEFFERSON, and
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

WEATHERLY, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 328(a), 37 C.F.R. § 42.73

I. INTRODUCTION

A. BACKGROUND

Walgreen Co., Ahold USA, Inc., Delhaize America, LLC, and Publix
Super Markets, Inc. (collectively “Petitioner”) filed a petition (Paper 2,¹

¹ Unless otherwise noted, citations to Paper numbers reflect the Paper numbers in both CBM2016-00014 and -00015. When citations differ, we

“Pet.”) requesting a covered business method patent review (“CBM review”) of claims 15 and 28 of U.S. Patent No. 8,370,199 B2 (Ex. 1001,² “the ’199 patent”) pursuant to section 18 of the Leahy-Smith America Invents Act (“AIA”). Petitioner supported the Petition with the Declaration of Michael Lewis, Ph.D. (Ex. 1009). Advanced Marketing Systems, LLC (“Patent Owner”) timely filed a Preliminary Response. Paper 5 (“Prelim. Resp.”). On May 27, 2016, and June 1, 2016, based on the record before us at the time, we instituted a CBM review of claims 15 and 28 in CBM2016-00014 and -00015. Paper 6 (“Institution Decision” or “Dec.”). We instituted the review on the following challenges to claim 15 and 28:

Reference/Alleged Defect	Basis	Claim(s)
U.S. Patent No. 4,882,675 (Ex. 1007, “Nichtberger”)	§ 102(b)	15 and 28
International Patent Publication No. WO 96/30851 A1 (Ex. 1008, “Ovadia”)	§ 102(b)	15
Lack of written description support	§ 112, ¶ 1	28

After we instituted this review, Patent Owner filed a Patent Owner Response in opposition to the Petition (Paper 22, “PO Resp.”) that was supported by the Declaration of Steven R. Kursh, Ph.D. (Ex. 2015). Petitioner filed a Reply in support of the Petition (Paper 31, “Reply”).

will precede citations in CBM2016-00014 with “’014 CBM” and citations in CBM2016-00015 with “’015 CBM.”

² Unless otherwise noted, citations to Exhibit numbers reflect the Exhibit numbers in both CBM2016-00014 and -00015. When citations differ, we will precede citations in CBM2016-00014 with “’014 CBM” and citations in CBM2016-00015 with “’015 CBM.”

Patent Owner did not move to amend any claim of the '199 patent. Neither party requested oral argument, and none was held.

We have jurisdiction under 35 U.S.C. § 6(b). The evidentiary standard applicable to this proceeding is a preponderance of the evidence. *See* 35 U.S.C. § 326(e); 37 C.F.R. § 42.1(d). This Final Written Decision is issued pursuant to 35 U.S.C. § 328(a) and 37 C.F.R. § 42.73.

For the reasons expressed below, we conclude that Petitioner has demonstrated by a preponderance of evidence that claims 15 and 28 are unpatentable.

B. RELATED PROCEEDINGS

Patent Owner has asserted the '199 patent along with related U.S. Patent Nos. 8,219,445 B2 ("the '445 patent") and 8,538,805 B2 ("the '805 patent") against individual ones of the petitioners in the following district court proceedings: *Advanced Mktg. Sys., LLC v. Walgreen Co.*, No. 6:15-cv-00137 (E.D. Tex.); *Advanced Mktg. Sys., LLC v. Ahold USA, Inc.*, No. 1:15-cv-221 (E.D. Va.); *Advanced Mktg. Sys., LLC v. Delhaize America, Inc.*, No. 2:15-cv-00074 (E.D. Va.); and *Advanced Mktg. Sys., LLC v. Publix Super Markets, Inc.*, No. 3:15-cv-00247 (M.D. Fla.). Pet. 1–2; Paper 3, 1–2. Patent Owner has also asserted the '445 patent, '199 patent, and '805 patent against other parties in the following district court proceedings: *Advanced Mktg. Sys., LLC v. The Kroger Co.*, No. 3:14-cv-02065 (N.D. Tex.); *Advanced Mktg. Sys., LLC v. Hy-Vee, Inc.*, No. 3:15-cv-00103 (W.D. Wis.); *Advanced Mktg. Sys., LLC v. CVS Pharmacy, Inc.*, No. 6:15-cv-00134 (E.D. Tex.); *Advanced Mktg. Sys., LLC v. Brookshire Grocery Co.*, No. 6:15-cv-00138 (E.D. Tex.); and *Advanced Mktg. Sys., LLC v. Ingles Markets Inc.*, No. 1:15-cv-00007 (W.D. Va.). Pet. 2; Paper 3, 2. We instituted a CBM

review of the '805 patent in CBM2016-00013,³ and of the '445 patent in CBM2016-00012.⁴

C. THE '199 PATENT

The '199 patent issued from an application filed on June 5, 2012, and claims priority to a number of prior applications, the earliest of which was filed on February 19, 1998. Ex. 1001, 1:4–20. Two of the applications in the priority chain are described as continuations-in-part of prior applications. *See id.* Neither party addresses the priority date to which claims 15 and 28 are entitled. Nevertheless, Nichtberger is prior art to claims 15 and 28 under 35 U.S.C. § 102(b) even if those claims were entitled to the priority date of February 19, 1998. *See* Ex. 1007 (issuing November 21, 1989).

The '199 patent relates to “a data processing system and method for implementing a customer incentive promotional program for enhancing retail sales of select products, such as groceries and the like.” Ex. 1001, 1:25–28.

Claim 15 is directed to a “discount vehicle” and recites:

15[a]. A discount vehicle for use with a data processing system for tracking and processing a plurality of in-store discounts to potential purchasers of plural products during the checkout process, wherein said discounts are each associated with a specific one of said plural products, said discount vehicle comprising:

[b] two or more of said discounts including descriptive material to provide information at least identifying the products and their associated discounts, wherein

³ CBM2016-00013, Paper 6.

⁴ CBM2016-00012, Paper 7.

[c] said vehicle is associated with a select code that permits tracking of said vehicle and of individual purchasers' purchased products and the prices thereof during checkout,

said select code uniquely identifying all the discounts for all of the plural products associated with said vehicle, and

[d] said select code uniquely identifying said vehicle such that said select code can be selectively deactivated for only particular discounts, of the plurality of discounts, associated with the purchased products by redemption of the code associated with the vehicle such that the code remains active for future use with yet unused ones of the plurality of discounts associated with said plural products.

Id. at 11:65–12:20 (line breaks and subdivisions [a]–[d] used by Petitioner added for clarity).

The Specification describes one example of the claimed “discount vehicle” as a “multi-discount vehicle” (“MDV”) in the form of freestanding insert 300 which is distributed in a newspaper. *Id.* at 7:30–37. Freestanding insert 300 is illustrated in Figures 3A and 3B, which are reproduced below.

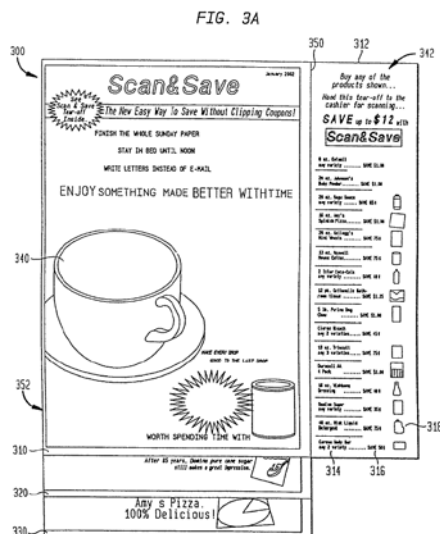


Figure 3A is a front view of an MDV as freestanding insert 300.

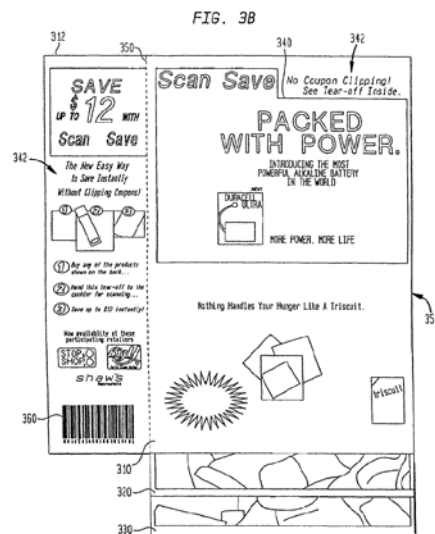


Figure 3B is a rear view of the freestanding insert 300.

The Specification describes freestanding insert 300 as follows:

[O]ne embodiment of the MDV is provided in the form of a freestanding insert (FSI) 300. The FSI may generally take the form of a folded sheets 310, 320, 330 unattached to each other (FIGS. 3a-c). Each sheet presents graphically displayed information, is folded or creased 352, and may include at least one advertisement or commercial 340 of a discounted product. FSI is preferably placed in a newspaper for dissemination to potential customers.

A redemption vehicle 312 is shown attached to one of the sheets, but may be attached to any of the sheets, in any position, may be printed on any portion, or may simply be loose and separate altogether. The redemption vehicle may include a barcode 360 or other readable medium, a description 314 of the discounted or sale-priced items, a picture or other representation 318 of the items, and/or the price or discount 316 of the items.

Id. at 7:30–44. The Specification describes other physical forms of the “discount vehicle” as flat card 400, *id.* at 7:60, and folded card 500, *id.* at 8:16. Flat card 400 and folded card 500 also include “redemption vehicles” having barcodes 460, 560 and descriptions 414, 514. *Id.* at 7:59–8:36. But for changes in reference numerals, all embodiments of the “discount vehicle” are described identically. *See id.* at 7:30–8:36.

Claim 28 is directed to a “data processing system” and recites:

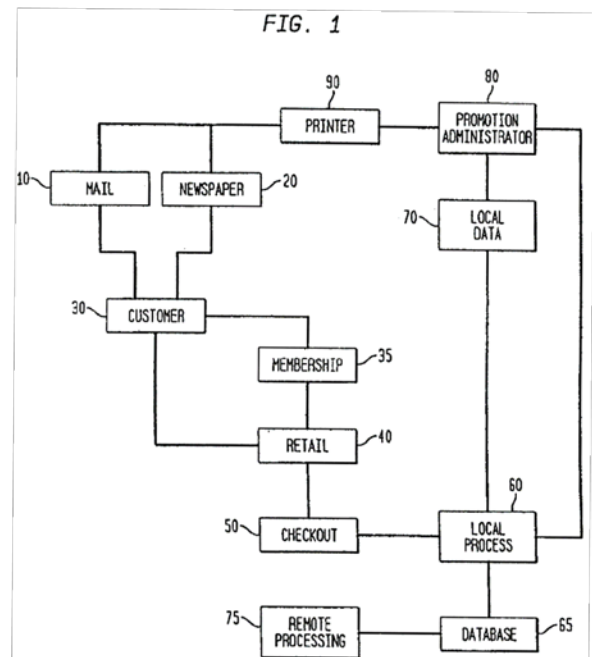
28. [a] A data processing system for tracking and processing a plurality of in-store discounts to potential purchasers of plural products during the checkout process wherein said discounts are each associated with a specific one of said plural products, said system comprising:

[b] a discount vehicle, characterized by two or more of said discounts, including descriptive material to provide information at least identifying the products and their associated discounts;

- [c] a customer account associated with a customer identification code, the customer account comprising two or more of said discounts of the discount vehicle selected by a customer to be associated with the customer account,
- [d] the customer account being associated with a select code that permits tracking of said customer account during checkout, said code uniquely identifying all the discounts for all of the plural products associated with the customer account;
- [e] a checkout processing terminal including computer based tracking of individual purchasers' purchased products and the prices thereof, wherein said processing terminal includes a device for receiving the customer identification code and the select code associated with the customer account during checkout; and
- [f] a data processor attached to said checkout terminal for receiving information regarding transactions associated with checkout, selected products and the discounts associated with the code associated with the customer account forming a part of the transactions, and processing said discounts in accord with said code;
- [g] wherein said data processor selectively deactivates the code for only particular discounts, of the plurality of discounts, associated with the purchased products by redemption of the code associated with the customer account such that the code remains active for future use with yet unused ones of the plurality of discounts associated with said plural products,
- [h] said data processor being further connected to memory for storing data associated with said transaction.

Id. at 13:1–14:15 (line breaks and subdivisions [a]–[g] used by Petitioner added for clarity).

The Specification describes the manner in which the discount vehicle is used within the claimed data processing system in connection with Figure 1, which is reproduced at right. Customer 30 receives an MDV via one of two paths, mail distribution 10 or newspaper 20. *Id.* at 6:17–21. Next, customer 30 visits retail store 40 with the MDV. *Id.* at 6:34–35. During checkout process 50, the MDV is scanned and checked for authenticity so



that the system can track which discounted items were purchased and adjust the total amount charged to that customer accordingly. *Id.* at 6:35–40.

In an example involving a super market, the customer may retain the MDV to use during the next trip to the super market. Ex. 1001, 10:7–8. During checkout, scanning equipment reads both the MDV and the products selected by the customer for purchase. *Id.* at 10:13–15. The scanning equipment is connected to a computer that compares the purchases with a file storing information regarding the products promoted on the MDV. Ex. 1001, 10:15–18. This comparison is facilitated by the unique identifier provided on the MDV, which associates the promotion to the stored file. *Id.* at 10:18–20.

As promoted items listed on the MDV are scanned during checkout, the system flags these items as purchased and applies the discount to the prices provided to the customer. *Id.* at 10:20–23. The computer may thereafter deactivate the promotion for that product to ensure that the MDV

is not used again to duplicate the discount for the purchased items. *Id.* at 10:23–26. The MDV, however, remains active for unexpired discount offers on items not purchased by the customer during this or previous shopping visits, which allows the customer to return to the store with the MDV and obtain the unused discounts. *Id.* at 10:26–32.

II. ANALYSIS

A. WHETHER THE '199 PATENT IS A COVERED BUSINESS METHOD PATENT

A “covered business method patent,” as defined in the AIA, is “a patent that claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.” AIA § 18(d)(1); *accord* 37 C.F.R. § 42.301(a). In determining whether a patent is eligible for CBM patent review, the focus is on the claims. *Secure Access, LLC v. PNC Bank Nat’l Ass’n*, 848 F.3d 1370, 1379 (Fed. Cir. 2017) (“It is the claims, in the traditional patent law sense, properly understood in light of the written description, that identifies a CBM patent.”). One claim directed to a covered business method is sufficient to render the patent eligible for CBM patent review. *See id.* at 1381 (“the statutory definition of a CBM patent requires that the patent have a claim that contains, however phrased, a financial activity element.”)

1. Financial Product or Service

Petitioner argues that the “discount vehicle” of claim 15 is financial in nature because it is used during a retail transaction as part of “a customer incentive promotional program for enhancing retail sales of select products,

such as groceries and the like.” Pet. 5 (quoting Ex. 1001, 1:24–28). Patent Owner does not contest Petitioner’s argument on this issue, and we find Petitioner’s argument to be persuasive. Claim 15, while not a method claim, is directed to a “corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service.” The Specification describes its invention as “a data processing system and method for implementing a customer incentive promotional program for enhancing retail sales of select products, such as groceries and the like.” Ex. 1001, 1:24–28. The Specification describes objectives of the invention and the manner in which the “discount vehicle” is an apparatus used to implement the “customer incentive promotional program for enhancing retail sales” as follows:

It is a further object of the present invention to provide a promotion system for enhancing retail based distribution of goods through the use of a multi-product discount vehicle, selectively distributed to potential customers, via direct mail or newspaper insert.

It is a further object of the present invention to provide a data processing system programmed to track redemptions of a specialized multi-product incentive vehicle, so as to insure proper discounting against select products and coordinated fulfillment of the incentive-based transaction.

The above and other objects of the present invention are realized in a novel data processing system operable with a specialized multi-product discount vehicle associated with a specified code. The multi-product discount vehicle has within its structure, a coordinated presentation of coupon-like indicia, coupled with graphics and text to draw customer attention to the salient features of the promoted products.

Id. at 4:6–23. These portions of the Specification indicate that the “discount vehicle” is an apparatus used in conjunction with the provision of discounts

applied to retail sales. Accordingly, we determine that claim 15, absent application of the exception for “technological inventions,” subjects the ’199 patent to CBM review.

2. Technological Invention Exception

Before institution of trial, but not after institution, Patent Owner argued that claims 15 and 28⁵ recite technological inventions that are exempt from CBM patent review. Prelim. Resp. 5–9; *see generally* PO Resp. (not addressing eligibility of ’199 patent for CBM review).

Patents subject to CBM patent review “do[] not include patents for technological inventions.” AIA § 18(d)(1); *accord* 37 C.F.R. § 42.301(a). The technological invention exception in the definition of a covered business method patent is not met by “[m]ere recitation of known technologies, such as computer hardware, . . . or specialized machines, such as an ATM or point of sale device,” or “[c]ombining prior art structures to achieve the normal, expected, or predictable result of that combination.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,763–64 (Aug. 14, 2012). To determine whether a patent is for a technological invention, we consider “whether the claimed subject matter as a whole”: (1) “recites a technological feature that is novel and unobvious over the prior art;” and (2) “solves a technical problem using a technical solution.” 37 C.F.R. § 42.301(b); *see* CBM Final Rules, at 48,736. Both the first and second

⁵ The presence of one claim in a patent that is directed to a financial product or service is sufficient to render a patent subject to CBM review. *See Secure Access*, 848 F.3d at 1381 (“the statutory definition of a CBM patent requires that the patent have a claim that contains, however phrased, a financial activity element.”). We address Patent Owner’s pre-institution arguments relating to claim 15.

prong must be met for the technological invention exception to apply. *Agilysys, Inc. v. Ameranth, Inc.*, Case CBM2014-00014, slip op. at 11 (PTAB Mar. 26, 2014) (Paper 19); see *Google Inc. v. Inventor Holdings, LLC*, Case CBM2014-00002, slip op. at 10 (PTAB Apr. 1, 2014) (Paper 16); 157 Cong. Rec. S1364 (daily ed. Mar. 8, 2011) (statement of Sen. Schumer).

Petitioner argues that because claim 15 encompasses a paper coupon as described in the Specification, claim 15 “is in no way technical.” Pet. 15. Before institution of trial, Patent Owner countered that claim 15, when “viewed as a whole,” recites novel and unobvious technological features that solve a technical problem using a technical solution. Prelim. Resp. 5–9. Nevertheless, Patent Owner fails to identify how the recited “discount vehicle” encompasses a single feature that is “technological” or how the “discount vehicle” provides any technical solution to a technical problem. *Id.* Patent Owner contends that the inventors of the ’199 patent “invented a solution rooted in computer technology to overcome a problem specifically arising in the realm of computer networks.” *Id.* at 7. However, Patent Owner cites no particular part of claim 15 or evidentiary support for its contention that the “discount vehicle” of claim 15 recites anything other than the vehicle itself. *Id.* at 5–9. After institution of trial, Patent Owner did not argue that the ’199 patent was not eligible for CBM review.

As explained in part II.B.1 below, we determine that claim 15 recites a “discount vehicle” bearing a “select code” that is intended to be read by scanning equipment and used by a “data processing system” to determine how to provide a discount to a potential purchaser of products “during the checkout process.” Nevertheless, claim 15 encompasses none of the devices used to scan and process the select code. Instead, claim 15 encompasses the

discount vehicle *itself* and the markings that make it compatible with the unclaimed “data processing system” and the unclaimed “machine” that is able to read the select code. Accordingly, Petitioner persuades us that the technological exception does not apply to the ’199 patent.

3. Summary

For the reasons expressed above, we find that at least claim 15 renders the ’199 patent subject to CBM review.

B. CLAIM INTERPRETATION

“A claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears.” 37 C.F.R. § 42.200(b); *see also* *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2142 (2016) (affirming that USPTO has statutory authority to construe claims according to similarly written Rule 42.100(b)). When applying that standard, we interpret the claim language as it would be understood by one of ordinary skill in the art in light of the specification, and absent any special definition, we give claim terms their ordinary and customary meaning. *See In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010); *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) (“The ordinary and customary meaning is the meaning that the term would have to a person of ordinary skill in the art in question.” (internal quotation marks omitted)). Only terms which are in controversy need to be construed, and then only to the extent necessary to resolve the controversy. *See Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999). Based on the arguments and evidence adduced by the parties, we interpret various aspects of claims 15 and 28 as discussed below.

1. *Elements of the “discount vehicle”*

a) Claim 15

At a high level, claim 15 affirmatively recites a “discount vehicle” (e.g., multi-discount vehicles (“MDV”) 300, 400, 500) having only two physical elements. Namely, claim 15 recites “descriptive material” that provides information identifying products (e.g., descriptions 314, 414, 514 and pictures 318, 418, 518) and associated discounts (e.g., discounts 316, 416, 516) and a “select code” (e.g., barcodes 360, 460, 560). Among other things, the “select code” identifies “all the discounts” for all the products. Ex. 1001, 7:30–8:48. The claim also recites a functional capability of the discount vehicle as being “for use with a data processing system.” *Id.* at 11:65–66. Nevertheless, claim 15, by its plain terms, does not encompass the “data processing system.” *Id.*

b) Claim 28

Claim 28 recites a “discount vehicle” even more broadly than claim 15 in the sense that the discount vehicle of claim 28 need only include “descriptive material to provide information at least identifying the products and their associated discounts.” *Id.* at 13:6–9. The select code is recited as “being associated” with a “customer account” that “permits tracking of said customer account during checkout.” *Id.* at 13:13–16. The “select code,” therefore, need not appear on or be associated with the discount vehicle.

2. *Whether the “discount vehicle” encompasses a website or mobile application*

Before trial was instituted, the parties’ competing interpretations of “discount vehicle” in claim 15 focused on whether the term narrowly covers only paper versions of the vehicle, like those explicitly described in the

Specification, '014 CBM Pet. 20–26, '015 CBM Pet. 20–27, or more broadly also covers “a website, or a mobile application,” '014 CBM Prelim. Resp. 9–16, '015 CBM Prelim. Resp. 9–17. In our Institution Decision, we did not resolve this dispute because Petitioner had demonstrated that claim 15 was more likely than not anticipated by the paper discount vehicles described by each of Nichtberger, '014 CBM Dec. 11, and Ovadia, '015 CBM Dec. 11. Based on the record before us, we conclude that we still need not resolve this specific dispute because Petitioner has demonstrated, by a preponderance of evidence, that the paper-based discount vehicles described by each of Nichtberger and Ovadia anticipate claim 15.

3. *Claim 28: “the code” and “said code”*

Claim 28 introduces two different “codes” as follows: “a customer account associated with *a customer identification code* . . . the customer account being associated with *a select code*.” Ex. 1001, 13:10–14 (emphasis added). Claim 28 later refers to either “the code” or “said code” five times as follows:

said code uniquely identifying all the discounts

* * *

the code associated with the customer account forming a part of the transactions, and processing said discounts in accord with *said code*

* * *

redemption of *the code* associated with the customer account such that *the code* remains active for future use

Id. at 13:16–14:11 (emphases added). To address uncertainty regarding which “code” is the antecedent for “the code” and “said code,” we instructed both parties to address during the trial whether each instance of “the code”

or “said code” recited later in claim 28 refers to the “customer identification code” or the “select code” and the manner in which claim 28 meets the requirement under 35 U.S.C. § 112, ¶ 2 of “particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” Dec. 11–12, n.2.

Petitioner argues in its Reply that “[b]ecause both the customer identification code and the select code are associated with the customer account, it is impossible to determine which of the two codes are referenced by ‘the code associated with the customer account.’” Petitioner argues that the ambiguity renders claim 28 unpatentable as indefinite under 35 U.S.C. § 112, ¶ 2. ’015 CBM Reply 25. Petitioner proffers no evidence on the issue of whether an ordinarily skilled artisan would have considered the meaning of claim 28 to have been set forth with reasonable certainty. *See id.* at 25–26 (failing to support its argument for indefiniteness with any expert testimony). Patent Owner contends that Petitioner fails to present “evidence demonstrating that the claims, when read in context, are not understood by persons of ordinary skill in the art with reasonable certainty.” ’015 CBM PO Resp. 49. We also note that the District Court, in related litigation between Petitioner and Patent Owner, has rejected Petitioner’s argument that claim 28 is indefinite based on its recitations of “the code” and “said code,” and instead ruled that both phrases refer to the “select code” of claim 28. Ex. 2018, 30–36.

We agree with and adopt as our own the District Court’s analysis of “the code” and “said code” as recited in claim 28, whether we apply the standard for evaluating indefiniteness under *In re Packard*, 751 F.3d 1307 (Fed. Cir. 2014) or *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120,

(2014). Accordingly, we determine that Petitioner has failed to establish by a preponderance of evidence that claim 28 is indefinite due to its recitations of “the code” and “said code.” We also determine that “the code” and “said code” refer to the “select code” when considering whether Nichtberger anticipates claim 28.

4. *“select code can be selectively deactivated for only particular discounts”*

Claim 15 recites that the “select code can be selectively deactivated for only particular discounts, . . . by redemption of the code associated with the vehicle.” Ex. 1001, 12:14–17. Claim 28 similarly recites that “said data processor selectively deactivates the code for only particular discounts, . . . by redemption of the code associated with the customer account.” *Id.* at 14:7–11. Both claims also require that after selective deactivation, “the code remains active for future use with yet unused” discounts. *Id.* at 12:17–18 (claim 15), 14:11–12 (claim 28).

The Specification sheds light on the meaning of “selectively deactivated” when it describes the process of selectively deactivating the select code as follows:

At check-out, the super market employs conventional scanning equipment to read both the MDV and the products selected by the customer for purchase. The scanning equipment is connected to a computer that compares the purchases with a file storing information regarding the products promoted with the MDV. This comparison is facilitated by the unique identifier provided on the MDV, which comports the promotion to the stored file. As promoted items listed on the MDV are scanned during checkout, the system flags these items as purchased and applies the discount to the price provided to the customer. *The computer may thereafter deactivate the promotion for that product to insure that the MDV is not used again to duplicate the discount for the purchased items. The MDV, however, remains*

active to the extent promoted items were not purchased by the customer during this or previous shopping visits, and the time period set for the promotion has not expired (typically 45 to 90 days). This, of course, allows the customer to return to the store with the MDV and to take advantage of the remaining promotions on the MDV that have not been used.

Id. at 10:13–32 (emphasis added). This passage indicates that the barcode (i.e., “select code”) associated with the discount vehicle is not modified during the process of selectively deactivating the select code for only those products for which the customer has redeemed the code and received a discount. Instead, a computer modifies a “file storing information regarding the products promoted” on the discount vehicle to deactivate the code regarding the discount associated with a purchased item while leaving the code active for the discounts associated with the promoted items not yet purchased. Rather, claim 15 expressly covers only the discount vehicle itself, and neither claim 15 nor claim 28 requires any alteration to the select code when it is “selectively deactivated.” Accordingly, we determine that: (1) claim 15 does not encompass the computer (i.e., the recited “data processing system”) that modifies the file storing information regarding promoted products, and (2) neither claim 15 nor claim 28 requires that the select code associated with the discount vehicle be altered to reflect selective deactivation.

5. “*during the checkout process*”

At trial, Patent Owner argues that “all of the terms utilized in the preamble are limiting” with respect to claims 15 and 28. ’014 CBM PO Resp. 9; ’015 CBM PO Resp. 13. Specifically, Patent Owner argues that the term “during the checkout process” recited in the preamble limits the “structure and intended purpose” of the discount vehicle recited in the body

of the claim, such that the discount vehicle must be “selectively deactivated” during checkout.⁶ ’014 CBM PO Resp. 10; ’015 CBM PO Resp. 14.

Patent Owner’s argument that neither Nichtberger nor Ovadia anticipates claim 15 relies in part upon its contention that selective deactivation of discounts must occur during checkout and not later. *See* ’014 CBM PO Resp. 42–52 (regarding Nichtberger), ’015 CBM PO Resp. 35–37 (regarding Ovadia). Petitioner argues, in response, that Patent Owner’s interpretation of the limiting effect on the claim of reciting “during the checkout process” in the preamble is wrong for two reasons. First, Petitioner argues that reciting “during the checkout process” does not limit the scope of claims 15 or 28 at all. Reply 2–5. Second, Petitioner asserts that reciting “during the checkout process” does not limit when the “select code” can be “selectively deactivated.” *Id.* at 5–12. For the reasons expressed below, we agree with Petitioner on both arguments.

Petitioner persuasively argues that we should apply the general rule that a preamble which merely recites an intended purpose for an apparatus does not limit the apparatus. Reply 2–3. The preamble of claim 15 recites, in pertinent part, a “distributed discount vehicle for use with a data processing system for tracking and processing a plurality of in-store discounts to potential purchasers of plural products during the checkout process.” Ex. 1001, 11:65–12:1. Similarly, the preamble of claim 28 recites, in pertinent part, “[a] data processing system for tracking and processing a

⁶ Patent Owner fails to identify any persuasive evidence that other terms in the preamble have limiting effect. *See* ’014 CBM PO Resp. 7–11 and ’015 CBM PO Resp. 13–19 (specifically addressing only “during the checkout process” from among phrases recited in the preamble).

plurality of in-store discounts to potential purchasers of plural products during the checkout process.” *Id.* at 13:1–3. By its plain terms, the phrase “during the checkout process” in both claims modifies “for tracking and processing,” which in turn modifies the “data processing system.”

As explained in Part II.B.1 above, claim 15 is directed to a “discount vehicle” and not to the “data processing system” that is recited in the preamble of claim 15. By its plain terms, therefore, at best, “during the checkout process” describes an intended use of the unclaimed “data processing system,” namely, by stating when that system is intended to perform “tracking and processing . . . of in-store discounts.” For both claims, the limitation relates merely to a time at which the “data processing system” is able to track and process discounts, and not to the time at which the “select code” must be “selectively deactivated” for particular discounts.

As Patent Owner acknowledges, the Specification describes a “computer” that deactivates discounts after the items are scanned and purchased, as follows:

As promoted items listed on the MDV are scanned during checkout, the system flags these items as purchased and applies a discount to the price provided to the customer. The computer *may thereafter deactivate* the promotion for that product to insure that the MDV is not used again to duplicate the discount for the purchased item. The MDV, however, remains active to the extent promoted items were not purchased by the customer during this or previous shopping visits, and the time period set for the promotion has not expired (typically 45 to 90 days).

’014 CBM PO Resp. 12–13 and ’015 CBM PO Resp. 16–17 (quoting Ex. 1001, 10:20–29) (emphasis added). This portion of the Specification describes two events occurring “[a]s promoted items listed on the MDV are scanned during checkout,” namely, flagging items as purchased and applying

a discount to the price. This passage also indicates that the data processing system with which the discount vehicle is used (i.e., the computer) may “thereafter deactivate” discounts. Thus, the Specification makes it clear that selective deactivation need not occur during checkout, as argued by Patent Owner, but may occur “thereafter.”

Patent Owner also cites three other portions of the Specification as describing “what occurs during checkout,” but those portions fail to demonstrate that deactivation must occur “during the checkout process.” See ’014 CBM PO Resp. 10 and ’015 CBM PO Resp. 14 (each citing Ex. 1001, 4:43–47, 4:56–58, 5:1–9). The first and third cited portions describe the checkout process as using a Point-Of-Sale (“POS”) processor that may include a barcode reader and as involving “data processing performed locally within the retail outlet and/or remotely via network connections.” Ex. 1001, 4:43–47, 5:1–9. The second cited portion explains that the discount vehicle may include “coded data located in separate locations [other than a “single code”] for reading during the check-out process.” *Id.* at 4:56–58.

We are not persuaded that these cited portions of the Specification support Patent Owner’s argument because none demonstrates that “during the checkout process” as recited in the preamble is intended to limit the structure of the discount vehicle itself. Accordingly, based on our review of the record before us, and for the foregoing reasons, we determine that the term “during the checkout process” recited in the preamble does not limit the “discount vehicle” of claim 15 in the way asserted by Patent Owner.

6. “*during checkout*”

Similar to its argument based on the preamble of claim 15, Patent Owner asserts that “during checkout” as recited in the body of claim 15 limits the time at which the select code must be selectively deactivated. *E.g.*, ’014 CBM PO Resp. 42; ’015 CBM PO Resp. 35. For the following reasons, we disagree.

Patent Owner’s argument is contradicted by the plain language of the claim and is, therefore, not persuasive. Claim 15 recites, in pertinent part: “a select code that *permits tracking* of said vehicle and of individual purchasers’ purchased products and the prices thereof *during checkout*.” Ex. 1001, 12:7–10 (emphasis added). Claim 28 similarly recites, in pertinent part, “a select code that *permits tracking* of said customer account *during checkout*.” *Id.* at 13:14–16 (emphases added). Here, the phrase “during checkout” describes an intended function of the “select code.” More specifically, “during checkout,” the code must permit “tracking” of the vehicle or the customer account” by the data processing system. For claim 15, the code must also permit “tracking . . . of individual purchasers’ purchased products and the prices thereof.”

Patent Owner does not persuasively demonstrate why the phrase “tracking . . . during checkout” also limits the point in time at which the “select code” must be “selectively deactivated.” This separate operation is described in other clauses of claims 15 and 28, providing a different functional capability of the select code. *See* Part II.B.4 above (analyzing the phrases in claims 15 and 28 that recite “selectively deactivated”). For all these reasons, we determine that “during checkout” as recited in the body of

claims 15 and 28 does not limit the “select code” such that it must be “selectively deactivated” during checkout.

C. THE PARTIES’ POST-INSTITUTION ARGUMENTS

In our Institution Decision, we concluded that the argument and evidence adduced by Petitioner demonstrated more likely than not that Nichtberger anticipates claims 15 and 28. ’014 CBM Dec. 22–25. We also concluded that Petitioner had established that Ovadia anticipates claim 15, ’015 CBM Dec. 22–25, and that claim 28 is unpatentable as being unsupported by written description as required under 35 U.S.C. § 112, ¶ 2, *id.* at 19–21. We must now determine whether, on the entire record before us, Petitioner has established by a preponderance of the evidence that claims 15 and 28 are unpatentable. 35 U.S.C. § 326(e). In this connection, we previously instructed Patent Owner that “any arguments for patentability not raised in the [Patent Owner Response] will be deemed waived.” Paper 7, 5–6. *See In re Nuvasive, Inc.*, 842 F.3d 1376, 1380 (Fed. Cir. 2016) (failure to address issue raised in preliminary response during trial held to be a waiver). Additionally, the Board’s Trial Practice Guide states that the Patent Owner Response “should identify all the involved claims that are believed to be patentable and state the basis for that belief.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012).

D. THE CHALLENGES TO THE CLAIMS

To prevail in its challenges to the patentability of claims 15 and 28, Petitioner must establish facts supporting its challenges by a preponderance of the evidence. 35 U.S.C. § 326(e); 37 C.F.R. § 42.1(d). In proceedings under the AIA, “the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *See 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”)). This burden never shifts to Patent Owner. See *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof in AIA proceedings).

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). With this standard in mind, we address each challenge below.

1. *Anticipation by Nichtberger*

Petitioner argues that Nichtberger anticipates claims 15 and 28. ’014 CBM Pet. 49–80. For the reasons expressed below, we determine that Petitioner has demonstrated by a preponderance of evidence that Nichtberger anticipates claims 15 and 28.

a) Overview of Nichtberger

Nichtberger describes a system in which “[c]ents-off merchandise coupons are distributed and redeemed immediately and electronically.” Ex. 1007, Abstract. The hub of Nichtberger’s system is a “local coupon distribution and redemption (CDR) unit 20.” See, e.g., *id.* at 5:1–4, Figs. 1, 5. CDR 20 is located in a store and presents information about available discounts to customers who may select one or more of the discounts as being of interest. E.g., *id.* at 5:4–16. After selection, CDR 20 prints a “selection

list” or “reminder,” which bears a description of the selected products/discounts and a number or barcode representing the customer’s account number or a receipt number that is associated in CDR 20 with the selections made by the customer. *E.g., id.* at 11:51–63, 13:65–14:4.

At checkout, the customer can present the selection list to the store personnel, who scan the barcode or use the receipt number to retrieve the customer’s selected discounts and compare that selection of discounts to the products presented for purchase. *E.g., id.* at 17:30–56. Any discounts redeemed during checkout are stored in a record in CDR 20. *E.g., id.* at 17:59–61. Any discounts that are redeemed would not be “re-offered” by the system for at least a predetermined time period. *Id.* at 29:32–46. Nichtberger’s system also deletes redeemed discounts from the customer’s selected discounts. *Id.* at 19:31–51, Fig. 9.

b) Petitioner’s Arguments

Petitioner describes in detail, with citations to specific portions of Nichtberger, how Nichtberger describes a selection list printed by CDR 20 that constitutes the discount vehicle of claim 15, which list can be used with a data processing system. ’014 CBM Pet. 49–65. Petitioner also similarly sets forth the manner in which Nichtberger describes the “data processing system” of claim 28. *Id.* at 65–80. Petitioner also relies upon testimony of Dr. Michael Lewis in which Dr. Lewis identifies specific portions of Nichtberger’s disclosure corresponding to every element of claim 15. *Id.* at 49–80 (citing Ex. 1009 ¶¶ 78–105). Petitioner’s contentions regarding the manner in which Nichtberger’s “coupon selection list” includes all elements of claims 15 and 28 are summarized in the table below.

Claim language	Nichtberger's Teachings
<p>15. A discount vehicle for use with a data processing system for tracking and processing a plurality of in-store discounts to potential purchasers of plural products during the checkout process, wherein said discounts are each associated with a specific one of said plural products, said discount vehicle comprising:</p>	<p>Nichtberger states that “the CDR 20 prints the coupon selection list for the benefit of the customer and dispenses the list to the customer.” ’014 CBM Pet. 54 (citing Ex. 1007, 23:3–5); <i>see also</i> Ex. 1007, 5:15–16, 11:35–41, 13:65–14:2. The paper coupon selection list (the “receipt”), “can be used to identify the user[.]” ’014 CBM Pet. 54 (citing Ex. 1007, 11:39–41); <i>see also</i> Ex. 1007, 11:60–63, 14:2–7, 17:38–52. The receipt number on the selection list may be printed in machine readable UPC code format. Ex. 1007, 28:37–40.</p>
<p>two or more of said discounts including descriptive material to provide information at least identifying the products and their associated discounts,</p>	<p>Nichtberger’s selection list includes “for each coupon selected, a product description, the coupon discount value, and the coupon expiration date.” ’014 CBM Pet. 56 (citing Ex. 1007, 23:3–5 (sic, 23:6–8)).</p>
<p>wherein said vehicle is associated with a select code that permits tracking of said vehicle and of individual purchasers’ purchased products and the prices thereof during checkout, said select code uniquely identifying all the discounts for all of the plural products associated with said vehicle, and</p>	<p>The code (i.e., receipt number or customer account number) on Nichtberger’s selection list constitutes the “select code.” ’014 CBM Pet. 58 (citing Ex. 1007, 28:30–35; Ex. 1009 ¶¶ 84–85). The code on Nichtberger’s selection list may be printed in a format that can “be read by a standard scanning system.” Ex. 1007, 28:30–43. The barcode is used by CDR 20 and central processor 16 to identify all the discounts described on the selection list. ’014 CBM Pet. 60 (citing Ex. 1007, 9:60–68, 17:59–61,</p>

Claim language	Nichtberger's Teachings
	18:5–9, 24:49–25:13, 26:22–27:3; Ex. 1009 ¶¶ 84–85).
<p>said select code uniquely identifying said vehicle such that said select code can be selectively deactivated for only particular discounts, of the plurality of discounts, associated with the purchased products by redemption of the code associated with the vehicle such that the code remains active for future use with yet unused ones of the plurality of discounts associated with said plural products.</p>	<p>Information about the discounts shown on the customer's selection list is maintained in selection file 162. '014 CBM Pet. 63 (citing Ex. 1007, 5:10–15, 11:24–27, 11:35–37, 11:44–45, 22:31–35, 22:56–23:2, Figs. 17–19). File 162 contains a record for each coupon selected which includes a “redemption flag” Ex. 1007, 19:31–38. Nichtberger's system “flags” redeemed coupons in the appropriate records within selection file 162. '014 CBM Pet. 64 (citing Ex. 1007, 5:17–25, 9:60–68, 11:51–63, 12:4–7, 14:4–7, 15:67–16:11, 17:30–56, 24:20–41, 24:49–25:13, 25:59–26:15, 26:22–27:3, 28:30–40, Figs. 4, 25, 26, 27, 32, 33, 35). Records that correspond to coupons that have been flagged as redeemed are deactivated for future use by deleting the record from file 162. <i>Id.</i> (citing Ex. 1007, 19:31–38, 19:46–51, Fig. 9; Ex. 1009 ¶¶ 86–87).</p>
<p>28[a]. A data processing system for tracking and processing a plurality of in-store discounts to potential purchasers of plural products during the checkout process wherein said discounts are each associated with a specific one of said plural products, said system comprising:</p>	<p>Nichtberger discloses a data processing system including “a plurality of local stations 10.” '014 CBM Pet. 65 (citing Ex. 1007 at 4:42–44, Fig. 1). Each station 10 includes “a local coupon distribution and redemption (CDR) unit 20.” <i>Id.</i> (citing Ex. 1007, 5:1–4, Figs. 1, 5). Nichtberger's system tracks and processes discounts associated with</p>

Claim language	Nichtberger’s Teachings
	specific products during checkout in a retail store. <i>Id.</i> (citing Ex. 1007, Abstract, 1:6–11, 3:19–40, 5:1–36, 17:30–61, 22:65–23:2 (a customer’s record of selected coupons “contains the transaction number and, for each coupon selected, the product UPC code, the discount value of the coupon, and the expiration date of the coupon”); 30:43–63, 31:54–32:16, 33:10–34:17, Figs. 1, 4, 5, 19).
[b] a discount vehicle, characterized by two or more of said discounts, including descriptive material to provide information at least identifying the products and their associated discounts;	Nichtberger’s selection list includes “for each coupon selected, a product description, the coupon discount value, and the coupon expiration date.” ’014 CBM Pet. 66 (incorporating argument citing Ex. 1007, 23:3–5 (sic, 23:6–8)).
[c] a customer account associated with a customer identification code, the customer account comprising two or more of said discounts of the discount vehicle selected by a customer to be associated with the customer account,	Each of Nichtberger’s selection records in CDR unit 20 is associated with a “customer number,” which is printed on the special card in the form of a UPC barcode and is stored on the special card’s magnetic stripe. ’014 CBM Pet. 69 (citing Ex. 1007, 5:7–15, 5:46–6:23, 11:24–27, 11:44–45, 12:16–19, 17:30–45, 19:31–38, 21:37–43, 22:43–46, 22:56–23:2, 24:22–41, 25:59–26:21, Figs. 4, 15, 18, 19, 25, 32, 33). When the special card is inserted into CDR unit 20, the customer number is read from the special card’s magnetic stripe to validate the identity of the customer and trigger the presentation of coupons for selection by the customer. <i>Id.</i> at 70

Claim language	Nichtberger's Teachings
	(citing Ex. 1007, 5:4–9, 10:65–11:2, 12:16–32, 20:67–22:12). The coupon selections are entered in a selection record for that user. Ex. 1007, 11:35–36 (account choice record is created), 11:45–50.
<p>[d] the customer account being associated with a select code that permits tracking of said customer account during checkout, said code uniquely identifying all the discounts for all of the plural products associated with the customer account;</p>	<p>The code (i.e., receipt number or customer account number) on Nichtberger's selection list constitutes the "select code." '014 CBM Pet. 74–75 (citing Ex. 1007, 5:17–25, 11:51–63, 14:4–7, 17:30–56, 24:20–41, 25:59–26:15, 28:30–40, Figs. 4, 25, 26, 32, 33; Ex. 1009 ¶¶ 96–97). The code on Nichtberger's selection list may be printed in a format that can "be read by a standard scanning system." Ex. 1007, 28:30–43. The barcode is used by CDR 20 and central processor 16 to identify all the discounts described on the selection list and associated with a customer number. '014 CBM Pet. 78 (citing Ex. 1007, 9:60–68, 17:59–61, 18:5–9, 24:49–25:13, 26:22–27:3; Ex. 1009 ¶ 100).</p>
<p>[e] a checkout processing terminal including computer based tracking of individual purchasers' purchased products and the prices thereof, wherein said processing terminal includes a device for receiving the customer identification code and the select code associated with</p>	<p>Nichtberger explains that "[e]ach of the local stations 10 may be considered to consist of an automated UPC scanning checkout system 18" for recording products purchased by a customer and the prices thereof during checkout. '014 CBM Pet. 75 (citing Ex. 1007, 5:1–4). Checkout system 18 performs computer-based tracking of individual purchasers' purchased products and the prices thereof, given</p>

Claim language	Nichtberger's Teachings
the customer account during checkout; and	that it is a computer-based system that works with a barcode scanner at checkout and "automatically credits the customer for the coupons the customer has selected where there are corresponding purchases against which the coupons are to be applied." <i>Id.</i> at 76 (citing Ex. 1007, 5:17–25; Ex. 1009 ¶¶ 98–99).
[f] a data processor attached to said checkout terminal for receiving information regarding transactions associated with checkout, selected products and the discounts associated with the code associated with the customer account forming a part of the transactions, and processing said discounts in accord with said code;	Nichtberger's CDR unit 20 includes "a microprocessor 102" and is attached to a checkout system 18 via connections 112 and 104. '014 CBM Pet. 77 (citing Ex. 1007 at 4:42–53, 5:1–25, 11:64–12:15, 16:42–45, Figs. 1, 5; Ex. 1009 ¶ 100). Microprocessor 102 processes discounts in accord with the select code by receiving redemption data and full purchase data from checkout system 18, recoding the data, flagging customer selected coupons that have already been redeemed based on the data, and transmitting the data to CPU 16 for clearing and generating reports. <i>Id.</i> at 78 (citing Ex. 1007, 4:65–68, 5:26–31, 18:20–41, 25:7–9, 26:67–27:3; Ex. 1009 ¶¶ 100–01).
[g] wherein said data processor selectively deactivates the code for only particular discounts, of the plurality of discounts, associated with the purchased products by redemption of the code associated with the customer account such	Petitioner incorporates its argument relating to element "d" of claim 15 and further cites testimony of Dr. Lewis. <i>Id.</i> at 79 (citing Ex. 1009). A summary of that analysis follows. Information about the discounts shown on the customer's selection list is maintained in selection file 162. <i>Id.</i>

Claim language	Nichtberger’s Teachings
<p>that the code remains active for future use with yet unused ones of the plurality of discounts associated with said plural products,</p>	<p>at 63 (citing Ex. 1007, 5:10–15, 11:24–27, 11:35–37, 11:44–45, 22:31–35, 22:56–23:2, Figs. 17–19). File 162 contains a record for each coupon selected which includes a “redemption flag” Ex. 1007, 19:31–38. Nichtberger’s system “flags” redeemed coupons in the appropriate records within selection file 162. ’014 CBM Pet. 64 (citing Ex. 1007, 5:17–25, 9:60–68, 11:51–63, 12:4–7, 14:4–7, 15:67–16:11, 17:30–56, 24:20–41, 24:49–25:13, 25:59–26:15, 26:22–27:3, 28:30–40, Figs. 4, 25, 26, 27, 32, 33, 35). Records that correspond to coupons that have been flagged as redeemed are deactivated for future use by deleting the record from file 162. <i>Id.</i> (citing Ex. 1007, 19:31–38, 19:46–51, Fig. 9; Ex. 1009 ¶¶ 86–87).</p>
<p>[h] said data processor being further connected to memory for storing data associated with said transaction.</p>	<p>Microprocessor 102 is connected via disk controller 108 to “disk drive 98,” which “is used as the storage device for program and data files.” ’014 CBM Pet. 80 (citing Ex. 1007, 14:42–51, Fig. 5). “[T]ransaction data is . . . stored on the disk 98 for later transmission to the central processing unit 16.” Ex. 1007, 14:42–49.</p>

The panel agrees with and adopts Petitioner’s arguments reflected in the summary above. Specific arguments raised by Patent Owner are addressed below.

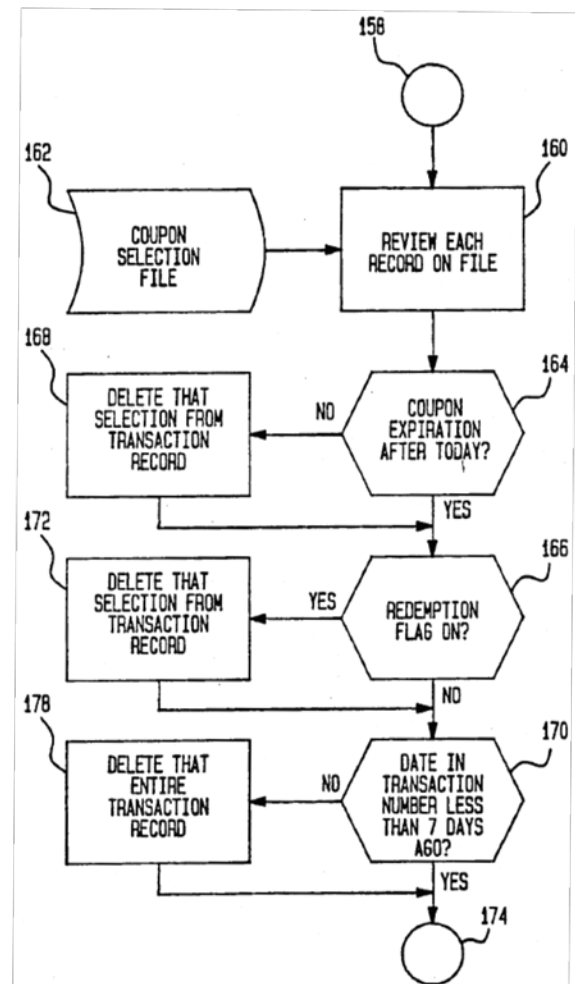
c) Analysis of Patent Owner's Arguments

Patent Owner primarily argues that Nichtberger fails to anticipate claims 15 and 28 for two reasons. First, Nichtberger allegedly fails to describe a discount vehicle in which its “select code can be selectively deactivated” for only those discounts that are redeemed. ’014 CBM PO Resp. 16–21, 40–48. Second, Nichtberger allegedly fails to describe “select code” on the claimed “discount vehicle.” *Id.* at 36–40. Neither argument is persuasive for the reasons set forth below.

(1) Selective Deactivation

Petitioner argues that Nichtberger uses a “redemption flag” in file 162 to keep track of specific discounts that have been redeemed and prevent future use of redeemed discounts. ’014 CBM Pet. 62–65, 79. Petitioner relies on Nichtberger’s description of “flagging” of previously redeemed discounts in connection with item 166 in the flow diagram of Figure 9, which is reproduced at right. *Id.* at 64 (citing Ex. 1007, 19:31–38, 19:46–51, Fig. 9). The Specification partially explains the flow diagram of Figure 9 as follows:

At step 166, a test is performed to see whether the redemption flag is on. If not, a test is performed immediately at step 170 as described below. If so, the CDR 20



first deletes that selection from the selection transaction record, as indicated at 172, and the program then proceeds to step 170.

Ex. 1007, 19:46–51.

Patent Owner argues that Nichtberger fails to describe selective deactivation “because ‘flagging redemption’ is not ‘selective deactivation’.” ’014 CBM PO Resp. 43. Patent Owner contends, more specifically, that “flagging redemption as taught by Nichtberger merely equates to making a mark on a coupon to indicate that the particular customer is not eligible to select this coupon at the kiosk (CDR 20) in the future.” *Id.* at 46. In support of this contention, Patent Owner relies solely on Dr. Kursh’s testimony. *Id.* (citing Ex. 2015 ¶¶ 56–61).

We conclude that the cited testimony supports Petitioner’s argument rather than Patent Owner’s. Dr. Kursh testifies that “the Nichtberger version of deactivation . . . removes the customer redemption record from the database, preventing future purchases.” Ex. 2015 ¶ 61. Dr. Kursh also testifies that “the Nichtberger version of deactivation does not take place until after checkout is completed,” *id.*, and that “selective deactivation needs to occur before the customer’s transaction ends [i.e., during the checkout process],” *id.* ¶ 52. However, as explained in Parts II.B.4–6 above, we determine that claims 15 and 28 encompass deactivation that occurs during or after checkout. We conclude, therefore, that a preponderance of evidence supports Petitioner’s argument that Nichtberger describes a selection list in which “the select code can be selectively deactivated” as required in claim 15 and a “data processor” that “selectively deactivates the code” as required in claim 28.

(2) Select Code

Patent Owner argues that Nichtberger fails to describe “exactly one select code uniquely identifying all the discounts” for three reasons. For the reasons expressed below, none of these arguments is persuasive.

First, Patent Owner argues that the barcode on Nichtberger’s selection list identifies users rather than “discounts” as required in claim 15.

’014 CBM PO Resp. 37–38. Patent Owner’s argument is unpersuasive.

Nichtberger states that a “receipt number [on the selection list] allows the system to match up the customer’s selections with his purchases to effect a redemption at checkout.” Ex. 1007, 14:4–7. Nichtberger also indicates that the receipt number can be encoded in a UPC format that can be scanned by standard scanning system. *Id.* at 28:37–43. Petitioner points out that Patent Owner’s argument is contrary to the Specification, which “indirectly identifies the coupons by identifying ‘a file’ storing information regarding the discounts on the MDV.” ’014 CBM Reply 20 (citing Ex. 1001, 10:13–20.) We agree with Petitioner’s analysis. Therefore, for the reasons stated, we conclude that Petitioner has demonstrated by a preponderance of evidence that the barcode on Nichtberger’s selection list is used to identify the discounts selected by the customer.

Second, Patent Owner argues that Nichtberger describes multiple codes rather than “a select code,” as recited in the claims. PO Resp. 31–36. Patent Owner’s argument is unpersuasive because the use in claims 15 and 28 of the transitional term “comprising” renders the claims open-ended. Thus, the claim does not preclude the presence of other codes, such as Nichtberger’s magnetic stripe or the code on a customer’s special card. *Georgia-Pacific Corp. v. U.S. Gypsum Co.*, 195 F.3d 1322, 1327 (Fed. Cir.

1999), *modified on reh'g on other grounds, Georgia-Pacific Corp. v. U.S. Gypsum Co.*, 204 F.3d 1359 (Fed. Cir. 2000); *see also KCJ Corp. v. Kinetic Concepts, Inc.*, 223 F.3d 1351, 1356 (Fed. Cir. 2000) (“This court has repeatedly emphasized that an indefinite article ‘a’ or ‘an’ in patent parlance carries the meaning of ‘one or more’ in open-ended claims containing the transitional phrase ‘comprising.’”). We are persuaded, also, by Petitioner’s argument that the Specification describes using multiple codes. ’014 CBM Reply 21 (citing Ex. 1001, 4:56–63, 5:54–63, 6:52–65, 7:15–18). Thus, we find that consistent with the claim language and Specification the phrase “a select code” does not require one code and only one code.

Third, Patent Owner argues that the barcode on Nichtberger’s selection list is not used for redemption when the list is used along with the “special card” described by Nichtberger. ’014 CBM PO Resp. 39–40. We agree with Petitioner (’014 CBM Reply 22–23) that a customer who has one of Nichtberger’s special cards will still be provided with a selection list having a barcode to be scanned during checkout to access and obtain the discounts shown on the list. Ex. 1007, 14:4–7, 28:30–43.

For all the reasons explained above, we determine that Petitioner has demonstrated by a preponderance of evidence that Nichtberger describes “a select code” as recited in claims 15 and 28.

d) Summary

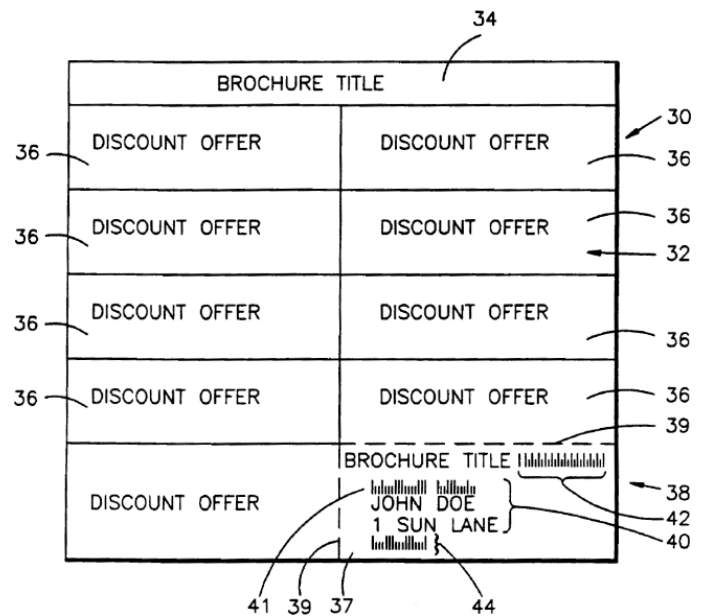
For the reasons stated above, we determine that Petitioner has proven by a preponderance of evidence that claims 15 and 28 are unpatentable as anticipated by Nichtberger.

2. Anticipation by Ovadia

a) Overview of Ovadia

Ovadia describes a system and method for redeeming discount offers that are distributed via a “vehicle.” Ex. 1008, 9:14–22.⁷ An example of the “vehicle” by which Ovadia’s system distributes discount offers is brochure 30 that is illustrated in Figure 2 and reproduced at right. The advertising vehicle “can be a single sheet or a

multi-sheet item, e.g. a brochure indicated generally as 30, having a front page 32 on which is printed the brochure title 34 along with various descriptions of discount offered items each separately displayed in associated areas 36,36.” *Id.* at 9:17–22. Ovadia’s indicia means 38 includes “bar code indicia 42 which identifies in machine readable code the brochure title.” *E.g., id.* at 9:22–30. Indicia 42 is preferably a barcode that “identifies the flyer so that the designated offers which are set forth on that flyer can be called up by computer 8 when the flyer is presented at the point of sale station.” *E.g., id.* at 10:15–30. Indicia means 38 could also include information that identifies the recipient of the vehicle, which could be included as part of barcode indicia 42, *e.g., id.* at 10:21–26, provided as “a



⁷ References to page numbers are to the original pagination of Ovadia at the top center of each page.

second barcode indicia 41 which is readable by the system 2 of the invention and which identifies the address of the user,” *e.g.*, *id.* at 9:22–34.

Ovadia indicates that individual discount offers on its brochure 30 can be held invalid after redemption while allowing unredeemed offers on brochure 30 to be used at a later time. *See, e.g.*, *id.* at 13:28–14:7. For example, Ovadia states that “the POS terminal can be programmed to electronically void the offer(s) after crediting a discount.” *Id.* at 14:1–2.

b) Petitioner’s Arguments

Petitioner cites in detail specific portions of Ovadia that allegedly teach all elements of claim 15. ’015 CBM Pet. 40–52. Petitioner also relies upon Dr. Lewis’s testimony to explain how a skilled artisan would conclude that Ovadia teaches every element of claim 15. *Id.* (citing Ex. 1009 ¶¶ 106–14). Petitioner’s contentions regarding the manner in which Ovadia describes all elements of claim 15 are summarized in the table below.

Claim language	Ovadia’s Teachings
15. A distributed discount vehicle for use with a data processing system for tracking and processing a plurality of in-store discounts to potential purchasers of plural products during the checkout process, wherein said discounts are each associated with a specific one of said plural products, said discount vehicle comprising:	Ovadia describes an “an advertising vehicle” distributed via mail, such as “a mailed circular brochure or flyer.” ’015 CBM Pet. 41 (citing Ex. 1008, Abstract, 5:17–37, 9:13–22, Fig. 2; Ex. 1009 ¶¶ 106–07).
two or more of said discounts including descriptive material to provide information at least identifying the products and their associated discounts,	Ovadia explains that the advertising vehicle may consist of one or more pages of discount offers 36, which include printed thereon descriptive material “presenting the

Claim language	Ovadia's Teachings
	<p>value of any discounts issued” and “a list of discount eligible items.” <i>Id.</i> at 44 (citing Ex. 1008, 5:29–37, 9:13–22, Fig. 2).</p>
<p>wherein said vehicle is associated with exactly one select code that permits machine reading and tracking of said vehicle and of individual purchasers' purchased products and the prices thereof during checkout, said select code uniquely identifying all the discounts for all of the plural products associated with said vehicle, and</p>	<p>Ovadia's brochure 30 describes the “select code” as its “bar code indicia 42 which identifies in machine readable code the brochure title which is readable by the system 2,” such as by a barcode scanner attached to a POS terminal, that uniquely identifies all the discounts for the products associated with the vehicle. <i>Id.</i> at 45 (citing Ex. 1008 at Abstract, 7:8–15, 9:22–34, 10:15–11:19, 12:15–20, 13:2–7, 15:34–16:2, 17:3–18:8, 20:25–22:7, Figs. 1, 2, 3A–C).</p> <p>Ovadia explains that if multiple vehicles are in circulation, “a different machine readable code [is used] for each different brochure which is currently in circulation.” <i>Id.</i> at 46 (citing Ex. 1008, 11:32–38). Machine-readable indicia 42 may also identify “the name and/or address of the person, household, business, or organization intended to receive the advertising.” <i>Id.</i> (citing Ex. 1008, 10:15–30, 15:34–37). A barcode scanner at a POS terminal can scan Ovadia's indicia 42 to retrieve electronically stored information regarding the discount offers identified on the vehicle. <i>Id.</i> at 46–47 (citing Ex. 1008, Abstract,</p>

Claim language	Ovadia’s Teachings
	<p>7:8–15, 10:15–30, 11:11–19, 11:25–28, 11:32–38, 12:15–20, 13:2–7, 17:3–18:8, Figs. 3A–C). Discount offers that match a purchased product can then be applied to the transaction. <i>Id.</i> at 47 (citing Ex. 1008, Abstract, 14:27–38, 17:3–18:8, Figs. 3A–C; Ex. 1009 ¶ 111). One purpose of Ovadia’s indicia 42 is allow its system “to record the identity of each recipient of that circular who redeems at least one item offered in the circular along with a listing of all items purchased during that transaction.” Ex. 1008, 11:11–19.</p>
<p>said select code uniquely identifying said vehicle such that said select code can be selectively deactivated for only particular discounts, of the plurality of discounts, associated with the purchased products by redemption of the code associated with the vehicle such that the code remains active for future use with yet unused ones of the plurality of discounts associated with said plural products.</p>	<p>Ovadia identifies various ways “to limit the number of times an incentive promotion offer can be redeemed.” ’015 CBM Pet. 50 (citing Ex. 1008 at 13:33–36). For example, “the POS terminal can be programmed to electronically void the offer(s) after crediting a discount.” Ex. 1008, 13:38–14:2.</p>

The panel agrees with and adopts Petitioner’s arguments reflected in the summary above. Specific arguments raised by Patent Owner are addressed below.

c) Analysis of Patent Owner's Arguments

Patent Owner primarily argues that Ovadia fails to anticipate claim 15 for two reasons. First, Ovadia allegedly fails to describe a discount vehicle in which its “select code can be selectively deactivated” for only those discounts that are redeemed. ’015 CBM PO Resp. 22–29, 34–48. Second, Ovadia allegedly fails to describe “exactly one select code” on the claimed “discount vehicle.” *Id.* at 31–34. Neither argument is persuasive for the reasons set forth below.

(1) Selective Deactivation

Patent Owner argues that Ovadia teaches three methods of limiting the number of times that a discount can be redeemed, but none of the three constitutes the “select code” being “selectively deactivated” as recited in claim 15. Patent Owner identifies those three methods as: (1) voiding an offer by expiration, *id.* at 35–37, (2) limiting an offer to a specific number of redemptions, *id.* at 37–41, and (3) voiding an offer after crediting a discount, *id.* at 41–47. Petitioner identifies only Ovadia’s third method as describing the manner in which a “select code can be selectively deactivated” as claimed. Pet. 49–52. Accordingly, we need not address Patent Owner’s arguments regarding Ovadia’s first and second identified methods of limiting the number of times that a discount may be redeemed.

Regarding the third method of limiting redemption, Patent Owner argues that Ovadia’s teaching that “the POS terminal can be programmed to electronically void the offer(s) after crediting a discount” is not a form of selective deactivation because “‘crediting a discount’ . . . is **not** the same as deactivation based on the redemption of a discount after purchasing” the discounted product. ’015 CBM PO Resp. 42 (citing Ex. 2015 ¶¶ 78, 80–83).

More specifically, Patent Owner argues that: “[o]ne of ordinary skill in the art would understand that ‘**crediting a discount**’ in Ovadia’s invention means identifying: 1) if a discount to an item is offered to a particular user or not, and 2) if the offer has expired or not.” *Id.* at 46. The only evidence that Patent Owner cites to support its argument is a general citation to Dr. Kursh’s declaration. *Id.* (citing Ex. 2015). Based on our review of Dr. Kursh’s testimony, Patent Owner’s argument is unsupported by Dr. Kursh’s declaration testimony and thus unpersuasive.

We determine, for the reasons that Petitioner argues in the Petition and its Reply, that Ovadia’s use of “crediting a discount” refers to part of the process of redeeming a discount by a customer. The portion of Ovadia upon which Petitioner relied in the Petition states:

In some instances it may be desirable to limit the number of times an incentive promotion offer can be redeemed. Various means can be utilized to accomplish this. The cashier at the POS terminal can mark, tear or otherwise destroy the redemption identification indicia section of the circular. Likewise, the POS terminal can be programmed to electronically void the offer(s) after crediting a discount. It is also possible to incorporate a magnetic stripe or similar recording device into the redemption identification indicia and program the POS terminal to record appropriate data onto the stripe that will limit or invalidate future discounts on purchases of designated items.

Ex. 1008, 13:33–14:7 (emphasis added) (cited at ’015 CBM Pet. 50). The entire passage indicates that the code on the flyer (i.e., indicia 42) is a type of “redemption identification indicia” on which the system may rely to limit the number of times that it may be redeemed (which would include one time). The reference to the cashier as the POS terminal indicates that these actions occur during checkout.

The mechanism that Petitioner identifies as “selective deactivation” is programming in the POS terminal that voids the discount on a product for which the customer has been credited that discount. ’015 CBM Pet. 50 (citing Ex. 1008, 13:38–14:2). After voiding the discount on a particular item, the system, when it later reads the “redemption identification indicia,” will not permit another discount on that item. *Id.* (citing Ex. 1009 ¶ 113).

Patent Owner also argues that Ovadia fails to describe a select code that is selectively deactivated “during the checkout process.” ’015 CBM PO Resp. 35 (citing Ex. 2015 ¶¶ 74–94). Dr. Kursh testifies that Ovadia’s voiding of an offer after crediting a discount does not occur “during checkout.” Ex. 2015 ¶ 84. Patent Owner’s argument is unpersuasive because we determine that, for the reasons stated in Parts II.B.4–6 above, claim 15 does not require that selective deactivation must occur during checkout.

(2) Select Code

Patent Owner argues that Ovadia’s indicia 42 on brochure 30 does not constitute “a select code” because brochure 30 “includes **multiple codes**,” and no single code in Ovadia meets all requirements of the “select code.” ’015 CBM PO Resp. 31–34. Patent Owner’s argument is unpersuasive because the use in claim 15 of the transitional term “comprising” renders the claim open-ended such that the claim does not preclude the presence of other codes such as Ovadia’s indicia 41. *Georgia-Pacific Corp. v. U.S. Gypsum Co.*, 195 F.3d 1322, 1327 (Fed. Cir. 1999), *modified on reh’g on other grounds*, *Georgia-Pacific Corp. v. U.S. Gypsum Co.*, 204 F.3d 1359 (Fed. Cir. 2000); *see also KCJ Corp. v. Kinetic Concepts, Inc.*, 223 F.3d 1351, 1356 (Fed. Cir. 2000) (“This court has repeatedly emphasized that an

indefinite article ‘a’ or ‘an’ in patent parlance carries the meaning of ‘one or more’ in open-ended claims containing the transitional phrase ‘comprising.’”). See further discussion *supra*.

Patent Owner also argues that Ovadia’s indicia 42 identifies a file stored elsewhere but “does not directly identify the discounts.” *Id.* at 33. Patent Owner’s argument is unpersuasive because the claim does not require that the “select code” must “directly identify the discounts” rather than identifying a file stored elsewhere that contains information about the discounts.

As discussed with respect to Nichtberger, *supra*, this argument is inconsistent with the description of the claimed invention. The Specification describes scanning the select code during checkout and using the code to access a “stored file” so that the “computer . . . compares the purchases with a file storing information regarding the products promoted with the MDV.” Ex. 1001, 10:13–20. Ovadia describes one purpose of indicia 42 as “to address a file in the POS machine containing the products or services offered under . . . that circular,” Ex. 1008, 11:14–16, so that “the designated offers which are set forth on that flyer can be called up by the computer 8 when the flyer is presented at the point of sale station,” *id.* at 10:26–29, and compared to items to be purchased at a discount, *id.* at 14:11–15, 14:32–37.

For all the reasons explained above, we determine that Petitioner has demonstrated by a preponderance of evidence that Ovadia describes “a select code” as recited in claim 15.

d) Summary

For the reasons stated above, we determine that Petitioner has proven by a preponderance of evidence that claim 15 is unpatentable as anticipated by Ovadia.

3. *Written Description Support for Claim 28*

A patent claim must be supported by written description in the specification as required in 35 U.S.C. § 112, ¶ 1, to be patentable. For the Specification to provide sufficient written description support for a claimed invention, the “description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.” *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989). Claim 28 of the ’199 patent refers to a “customer account.” Specifically, the claim states:

a customer account associated with a customer identification code, the customer account comprising two or more of said discounts of the discount vehicle *selected by a customer to be associated with the customer account.*

Ex. 1001, 13:10–13 (emphasis added).

Petitioner contends that claim 28 is unpatentable because the Specification fails to provide written description support for the quoted element. ’015 CBM Pet. 30–33. In particular, Petitioner argues that in the ’199 patent, “[b]ecause customers receive the MDV only *after* discounts have been selected and the MDV printed, consumer input is never involved in the selection process, and at no time is a customer given the ability to select which discounts they desire to be on the MDV.” *Id.* at 31–32. Petitioner further contends that every described embodiment of the discount vehicle is a physical item that is distributed to users via mail or as an insert in a periodical like a newspaper or magazine. *Id.* at 31 (citing Ex. 1001,

S C A N & S A V E C H E C K C L I S T



available at
Rockford area

Offers good until 1/1/03

For your convenience, mark the items you want and those you've purchased in the boxes.

☐ Kraft Deluxe Macaroni & Cheese
55¢ Off any 2

☐ Grey Poupon Mustard
55¢ Off any 1

☐ Pillsbury Pie Crusts
50¢ Off any 1 - In the Dairy Case

☐ Baker's Chocolate Baking Squares
30¢ Off any 1

☐ Triscuit Crackers
40¢ Off any 1

☐ Jell-O Gelatin
55¢ Off any 2 Dry Packages

☐ Philadelphia Cream Cheese
30¢ Off any 1 - 8 oz.

☐ Mrs. Smith's Frozen Pumpkin Pie
75¢ Off any 1 - Any Variety

☐ Kraft Cheez Whiz
25¢ Off any 1

☐ Kraft Salad Dressing
30¢ Off any 1 - Any Variety

☐ Ban
75¢ Off any 1 product

☐ Reynolds Wrap Aluminum Foil
75¢ Off any 1 Roll - except 25 sq. ft.

☐ Mr. Clean
\$1.00 Off any 1 - 23 oz. or 40 oz.

☐ Fantastik All-Purpose Cleaner
\$1.00 Off any 1

☐ Electrasol Automatic Dishwasher Detergent
75¢ Off any 1 - Tabs, Gel, Powder or 2-in-1 Tabs

☐ Advil
75¢ Off any 1 - 20 ct. or larger

☐ Luvs Diapers
\$1.00 Off any 1 - Jumbo Size or larger

☐ Vaseline Intensive Care Lotion
75¢ Off any 1

☐ Colgate Toothpaste
\$1.00 Off any 1 - 4.6 oz. or larger

☐ Iams Dog Food
\$1.00 Off any 1 Bag - 4 lbs. or larger



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Our save off products, offers cannot be electronic, multiple offers for the same product (i.e. several in one shopping row). Cash value of any offer is .01¢ per 1¢ OFF. VOID IF COUPON, TRANSFERRED, INK-BLEND, OR SET. Can only be redeemed by Advanced Marketing Systems division of its agent. Cash value of transactions and 1¢ off. Terms, conditions and restrictions apply. Some offers off this offer plus 2.0¢ savings. COUPONS: One offer per valid item available. Any other is a non-valid item.

See directions on other side

Patent Owner further relies upon the following passages in the Specification as support for its argument that the Specification describes associating selected discounts with the customer account:

45

Id. at 7:18–21 (quoted at '015 CBM PO Resp. 9).

At check-out, the super market employs conventional scanning equipment to read both the MDV and the products selected by the customer for purchase. The scanning equipment is connected to a computer that compares the purchases with a file storing information regarding the products promoted with the MDV.

Id. at 10:13–18 (quoted at '015 CBM PO Resp. 9–10).

Petitioner responds that there is no disclosure in the patent of how marking a check box on the MDV in Figures 6A and 6B of the '199 patent would result in the addition of a discount to the consumer's account. '015 CBM Reply 13. We agree with Petitioner that Figures 6A and 6B do not disclose customer selection of discounts associated with a customer account. The checklist boxes shown at the bottom of the discount vehicle in Figure 6B are nothing more than a manual shopping list. The checklist instructs shoppers as follows: "For your convenience, mark the items you want and those you've purchased in the boxes." See Ex. 1001, Fig. 6B. The Specification describes the manner in which the checkboxes shown in Figure 6B are used by consumers as follows:

The lower portion of the back side of the MDV, shown in FIG. 6b, contains a list of each of the products for which a discount is provided by the MDV. Next to each of the product names are printed two boxes. The boxes provide locations for the consumer to mark, such as by placing an 'x' or 'check', to indicate that a particular product is desired and that the MDV has been redeemed for a particular product. For example, the box to the immediate left of each named product may be marked to indicate that the discount has been redeemed, and the box to the left of that box may be marked to indicate that the purchase of the product is desired. This provides a left-to-right chronological sequence to the boxes since identification of the desire to purchase normally precedes the actual purchase. This enables

the consumer to track the discounts of the MDV which have been used and those which remain available.

Id. at 9:20–35.

The Specification indicates, therefore, that the checkboxes are used merely for the consumer’s convenience “to track the discounts of the MDV which have been used and those which remain available.” At no point does the Specification refer to markings on the checkboxes being relayed or stored in any data file. Additionally, we find that the Specification indicates that the products appearing on the MDV for which a discount is provided are selected by promotion administrator 80, not the consumer. *Id.* at 6:48–51. We are persuaded, therefore, by Petitioner’s argument that Figure 6B and the related description in the Specification do not demonstrate possession of the invention of claim 28.

Petitioner also argues persuasively that Patent Owner’s reliance on redemption of discounts being recorded in a data file as discounts being “selected by a customer to be associated with the customer account” is inconsistent with the requirement in the claim that “the [select] code remains active for future use with yet unused ones of the plurality of discounts.”

’015 CBM Reply 13. More specifically, Petitioner explains

a collection of redeemed discounts, like that proposed by PO, cannot provide the necessary written description support for the “customer account” limitation because the collection would never include (i) unredeemed discounts for which an associated select code can be “selectively deactivate[d]” or (ii) unredeemed discounts for which an associated select code “remains active for future use,” as required by claim 28.

Id. at 14. Patent Owner’s reliance on data being written during checkout is unpersuasive because the data being written is driven by products purchased

with redeemed discounts without regard for markings made by the consumer on the checklist.

Patent Owner's other arguments are likewise not persuasive. For example, we are not persuaded by Patent Owner's argument that the customer profile described in the Specification of the '199 patent is a synonym for a customer account in the claims. '015 CBM PO Resp. 5. To the contrary, the use of different terms in the Specification indicates that they are not the same. *Chicago Bd. Options Exchange, Inc. v. International Securities Exchange*, 677 F.3d 1361, 1369 (Fed. Cir. 2012). Patent Owner does not point us to where in the specification the terms are used interchangeably. *Cf. Edwards Lifesciences LLC v. Cook, Inc.*, 582 F.3d 1322, 1329 (Fed. Cir. 2009)(“ In this case, the specification consistently uses the words ‘graft’ and ‘intraluminal graft’ interchangeably.”). But even if we were to agree that “customer account” and “customer profile,” were synonymous, Patent Owner fails to explain how the Specification describes associating the discounts “selected by the user” with a customer profile, as the claim requires.

We are not persuaded, either, by the testimony of Patent Owner's expert, Dr. Kursh, concerning a hypothetical “data base table” that would store data during checkout. Ex. 2015, ¶¶ 97, 99–101 (cited at '015 CBM PO Resp. 9–11). Patent Owner's reliance on this cited testimony fails to support any of the propositions for which it is cited regarding any conclusions that might be drawn by an ordinarily skilled artisan about the alleged selection by customers of discounts or association of selected discounts with the customer account. Nowhere in this analysis does Dr. Kursh explain how the Specification describes the “data base table” or how a customer selects

discounts to be associated with the customer account. *Id.* Additionally, Dr. Kursh admitted that his testimony regarding the table merely related to a hypothetical configuration of such a table “could well appear” in the ’199 patent. Ex. 1024, 158:15–160:19.⁸

We have considered Patent Owner’s other arguments and do not find them persuasive. Accordingly, we determine that Petitioner has demonstrated by a preponderance of the evidence that claim 28 is unpatentable for failing to be supported by sufficient written description under 35 U.S.C. § 112 ¶ 1.

III. CONCLUSION

For the reasons explained above, we determine that Petitioner has demonstrated by a preponderance of the evidence that: (1) claim 15 is unpatentable as anticipated by each of Nichtberger and Ovadia; (2) claim 28 is unpatentable as anticipated by Nichtberger; and (3) claim 28 is unpatentable for failing to be supported by sufficient written description under 35 U.S.C. § 112 ¶ 1.

IV. ORDER

For the reasons given, it is:

ORDERED, that claims 15 and 28 of U.S. Patent 8,370,199 B2 are *unpatentable* as anticipated under 35 U.S.C. § 102(b) by Nichtberger;

FURTHER ORDERED that claim 15 of U.S. Patent 8,370,199 B2 is *unpatentable* as anticipated under 35 U.S.C. § 102(b) by Ovadia;

⁸ We found Dr. Kursh’s testimony to be evasive and therefore give it minimal weight. For example, he frequently quibbled over the meaning of common words such as “performed,” Ex. 1024, 82:1; “pertained,” *id.* at 98:22–23; “changing,” *id.* at 103:7–8; “discuss,” *id.* at 248:19; “expressly,” *id.* at 267:24–268:1; and “separate,” *id.* at 277:10–11.

FURTHER ORDERED that claim 28 of U.S. Patent 8,370,199 B2 is *unpatentable* under 35 U.S.C. § 112, ¶ 1, because the claim is not supported by sufficient written description; and

FURTHER ORDERED because this is a final written decision, the parties to this proceeding seeking judicial review of our Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

CBM2016-00014 and CBM2016-00015
Patent 8,370,199 B2

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