

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALTRICS, LLC,
Petitioner,

v.

OPINIONLAB, INC.,
Patent Owner.

Case IPR2014-00420
Patent 7,370,285 B1

Before RAMA G. ELLURU, JEREMY M. PLENZLER,
GEORGIANNA W. BRADEN, and CARL M. DeFRANCO,
Administrative Patent Judges.

BRADEN, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
35 U.S.C. § 318 and 37 C.F.R. § 42.73

I. INTRODUCTION

A. Background

Qualtrics, LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) to institute an *inter partes* review of claims 1, 4, 5, 7, 9, 12, 13, and 15 of U.S. Patent No. 7,370,285 B1 (Ex. 1001, “the ’285 patent”) pursuant to 35 U.S.C. § 311. OpinionLab, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”). We instituted an *inter partes* review of claims 1, 4, 5, 7, 9, 12, 13, and 15 on certain grounds of unpatentability alleged in the Petition. Paper 7 (“Dec. to Inst.”). After institution of trial, the Patent Owner filed a Patent Owner Response (Paper 17, “PO Resp.”), to which Petitioner filed a Reply (Paper 29, “Reply”). An oral argument was held on April 22, 2015.¹

We have jurisdiction under 35 U.S.C. § 6(c). In this Final Written Decision, issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73, we determine Petitioner has shown by a preponderance of the evidence that all of the challenged claims of the ’285 patent are unpatentable.

B. Related Proceedings

Petitioner informs us that the ’285 patent is involved in two co-pending federal district court cases captioned: *OpinionLab, Inc. v. Qualtrics Labs, Inc.*, No. 1:13-cv-01574 (N.D. Ill.) and *OpinionLab, Inc. v. iPerceptions Inc.*, No. 1:12-cv-05662 (N.D. Ill.). Pet. 2. In addition, Petitioner filed several petitions requesting *inter partes* review of related patents. *Id.* These cases are: IPR 2014-00314 requesting review of U.S. Patent No. 6,421,724; IPR2014-00356 requesting review of U.S. Patent No.

¹ A transcript (“Tr.”) of the oral hearing is included in the record. Paper 40.

6,606,581; IPR2014-00406 requesting review of U.S. Patent No. 7,085,820; and IPR2014-00366 requesting review of U.S. Patent No. 8,041,805.

Petitioner also filed IPR 2014-00421 requesting review of certain claims of U.S. Patent No. 8,024,668, which is a continuation of the '285 patent. *Id.* We consolidated the oral hearings for IPR2014-00314, IPR2014-00356, IPR2014-00406, IPR 2014-00420 and IPR 2014-00421. *See* Paper 34.

C. The '285 Patent

The '285 patent relates to a method for receiving page-specific user feedback concerning a web page of a website. Ex. 1001, Abstract. The method includes using a comment icon viewable on the web page to solicit from a user one or more page-specific, open-ended comments concerning the web page. *Id.* The '285 patent specification discloses several embodiments that, for example, provide a user reaction measurement tool that is incorporated into a particular web page of a website. *Id.* at 6:14–18, 14:56–58. An example of a user reaction measurement tool is icon 50, shown in Figure 2 reproduced below.

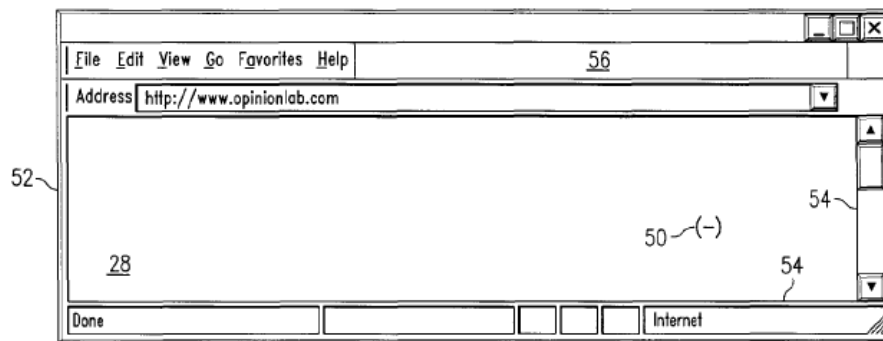


Figure 2 illustrates an embodiment of a user reaction measurement tool as icon 50.

Icon 50 has associated software components, so that when a user clicks on the icon, a multi-level subjective rating scale becomes visible and

allows users to provide reactions to the web page. *Id.* at 15:30–36. Figure 3, reproduced below, shows a multi-level subjective rating scale.

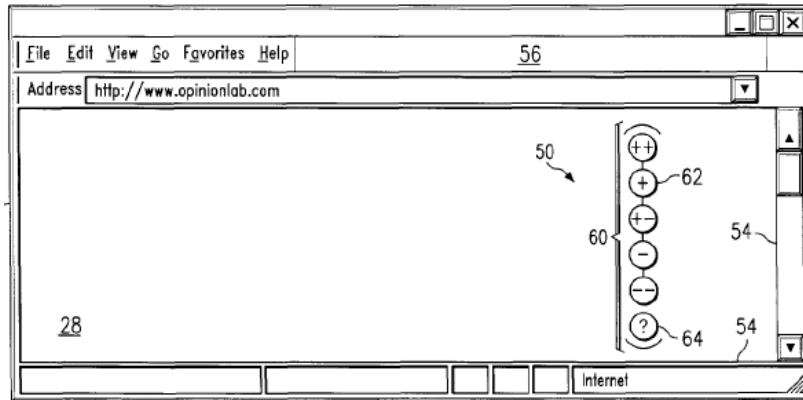


Figure 3 illustrates a multi-level subjective rating scale as icon 60.

Certain embodiments present a user with a pop-up window when the user clicks icon 50. Ex. 1001, 18:47–55. The pop-up window includes a field for the user to type in comments about a particular web page, as shown in Figure 6 reproduced below. *Id.* at 19:17–22.

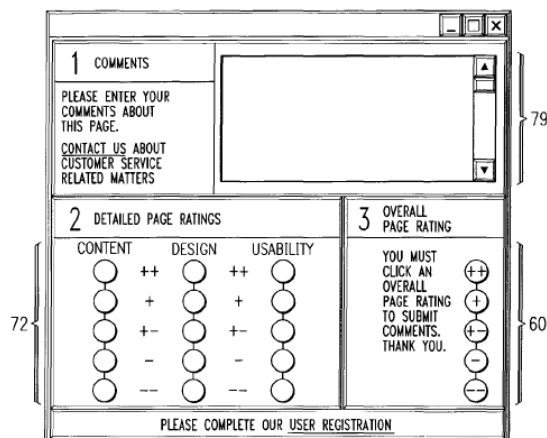


Figure 6 illustrates a pop-up window with field 79 for type-written comment(s).

In one embodiment, the specification teaches that the pop-up window is generated from a remote server separate from the server hosting the website rather than generating the window locally. *Id.* at 10:16–25.

D. Illustrative Claim

As noted above, *inter partes* review was instituted for claims 1, 4, 5, 7, 9, 12, 13, and 15 of the '285 patent, of which claims 1 and 9 are independent. Claim 1 is illustrative of the challenged claims and is reproduced below:

1. A system for receiving page-specific user feedback concerning a particular web page of a website displayed at a computer system of a user that has accessed the particular web page, the system comprising:
 - a comment icon viewable on the particular web page and soliciting one or more page-specific open-ended comments concerning the particular web page from the user; and
 - software associated with the comment icon and operable to:
 - in response to the user selecting the comment icon, automatically communicate a request for a comment window to a remote computer system that is separate from a computer system hosting the website and also separate from the computer system of the user, the comment window allowing the user to provide the one or more page-specific open-ended comments concerning the particular web page;
 - receive, at the computer system of the user, the comment window from the remote computer system that is separate from the computer system hosting the website and also separate from the computer system of the user;
 - present the comment window to the user at the computer system of the user; and
 - receive the one or more or more page-specific open-ended comments concerning the particular web page from the user for reporting to a website owner, the one or more page-specific open-ended comments concerning the particular web page being provided using the comment window.

Id. at 31:17–47.

E. Prior Art References Alleged to Support Unpatentability Challenges

The instituted ground asserted the following prior art references:

Reference	Patent/Printed Publication	Date	Exhibit
McDonald	Michael J. McDonald et al., <i>Multimedia Feedback Systems for Engineering</i> , Sandia National Laboratories	April 25, 1999	1005
Pinsley	U.S. Patent No. 6,070,145	May 30, 2000	1007

F. Grounds of Unpatentability Instituted for Trial

The following table summarizes the challenge to patentability that was instituted for *inter partes* review:

Reference(s)	Basis	Claim(s) challenged
McDonald and Pinsley	§ 103(a)	1, 4, 5, 7, 9, 12, 13, and 15

II. DISCUSSION

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the Specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *see also In re Cuozzo Speed Techs., LLC*, No. 2014-1301, 2015 WL 4097949, at *7, *8 (Fed. Cir. July 8, 2015) (“Congress implicitly approved the broadest reasonable interpretation standard in enacting the AIA,” and “the standard was properly adopted by PTO regulation.”). Under that standard, and absent any special definitions, we give claim terms their ordinary and customary meaning, as would be understood by one of ordinary skill in the art at the time of the invention. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

Petitioner proposes construction of several claim terms of the '285 patent (Pet. 9–15), and Patent Owner does not contend that any terms should be given a special meaning (PO Resp. 6–7 n.3). We determine that no express constructions of claims are required for our analysis.

B. Principles of Law

To prevail in its challenges to the patentability of the claims, a petitioner must establish facts supporting its challenges by a preponderance of the evidence. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). A claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) objective evidence of nonobviousness, i.e., secondary considerations. See *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

We analyze the instituted grounds of unpatentability in accordance with the above-stated principles.

C. Level of Ordinary Skill in the Art

In determining whether an invention would have been obvious at the time it was made, we consider the level of ordinary skill in the pertinent art at the time of the invention. *Graham v. John Deere*, 383 U.S. at 17. “The importance of resolving the level of ordinary skill in the art lies in the

necessity of maintaining objectivity in the obviousness inquiry.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991).

Petitioner contends that a person of ordinary skill in the art at the time of the ’285 patent would have a “Bachelor’s degree in computer science (or equivalent technical field), experience in Web-based programming, an understanding of the basic principles governing the collection and reporting of customer feedback (*i.e.*, basic survey methodology), and five or more years of relevant work experience.” Pet. 16 (citing Ex. 1009 ¶¶ 48–51). Patent Owner’s declarant, Michael I. Shamos (“Dr. Shamos”) testifies that one of ordinary skill in the art at the time of the ’285 patent would have had an undergraduate degree in computer science, or equivalent work experience, and, in addition, at least two years of work experience, including familiarity with web-based programming and user interfaces. Ex. 2002 ¶ 32. Dr. Shamos disagrees with Petitioner’s characterization of the level of ordinary skill “because it appears to [him] to require too much work experience.” *Id.* ¶ 29. Dr. Shamos also does not believe that experience in survey methodology would be required. *Id.* According to Dr. Shamos, “the ’285 patent does not deal with or claim survey design, but is concerned with the collection and transmission of feedback information. In practice, the questions to be asked of a respondent might be designed by a survey specialist, but the questions themselves would then be presented over a user interface of the type disclosed and claimed in the ’285 Patent.” *Id.* Patent Owner concurs with Dr. Shamos’s opinion regarding the level of skill in the art at the time of the ’285 patent. PO Resp. 19 n.5 (citing Ex. 2002 ¶¶ 27–34).

Based on our review of the '285 patent and the types of problems and solutions described in the '285 patent and cited prior art, we conclude a person of ordinary skill in the art at the time of the '285 patent would have a Bachelor's degree in computer science (or equivalent technical field) and at least two years of work experience, including familiarity with web-based programming and user interfaces. Based on the stated qualifications of Petitioner's declarant, Mr. John Chisholm (Ex. 1009 ¶¶ 9–18) and his Curriculum Vitae (Ex. 1010), Petitioner's declarant meets the requirements of this definition. Additionally, based on the stated qualifications of Patent Owner's declarant, Dr. Shamos (Ex. 2002 ¶¶ 4–16) and his Curriculum Vitae (Ex. 2003), Patent Owner's declarant meets the requirements of this definition. We further note that the applied prior art reflects the appropriate level of skill at the time of the claimed invention. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001).

D. Alleged Obviousness of Claims 1, 4, 5, 7, 9, 12, 13, and 15 in view of McDonald and Pinsley

Petitioner alleges that claims 1, 4, 5, 7, 9, 12, 13, and 15 of the '285 patent are unpatentable under 35 U.S.C. § 103(a) over McDonald and Pinsley. Pet. 29–36. Patent Owner disputes Petitioner's position, arguing that a person of ordinary skill in the art would not have had reason to combine the references in the manner proposed by Petitioner and further that the combination of the references fails to teach or suggest all of the claim limitations. PO Resp. 1–4.

We have reviewed the Petition, the Patent Owner Response, and Petitioner's Reply, as well as the relevant evidence discussed in those papers. For reasons that follow, we determine that Petitioner has shown by a

preponderance of the evidence that claims 1, 4, 5, 7, 9, 12, 13, and 15 of the '285 patent are unpatentable as obvious over McDonald and Pinsley.

1. Overview of McDonald

McDonald discloses systems that allow users to provide typewritten comments about web pages, electronic documents, and videos. Ex. 1005, 5–6. McDonald specifically teaches software for implementing a web page commenting system that includes use of HTML and JavaScript. *Id.* at 1. McDonald states that the web page feedback system “allows people to make context-sensitive comments about specific web content” and “[t]he first system ties comments to specific web pages.” *Id.* According to the disclosure in McDonald, the web page commenting feedback system “first appears to reviewers as a ‘feedback’ link on each important web page of a report . . . This link has a similar function as typical ‘mailto’ links.” *Id.* at 4.

McDonald further discloses that when the “feedback link” is opened on a web page, the system automatically fills a comment form with basic information on the “Make Comment Page.” *Id.* Such information includes the URL of the page the user was viewing when he or she clicked the feedback link, the date, and the user’s name and email address. *Id.* The reviewer then writes and submits his or her comments to a web server. *Id.* Figure 2 of McDonald, reproduced below, illustrates the basic process of submitting and viewing comments associated with an electronic document.

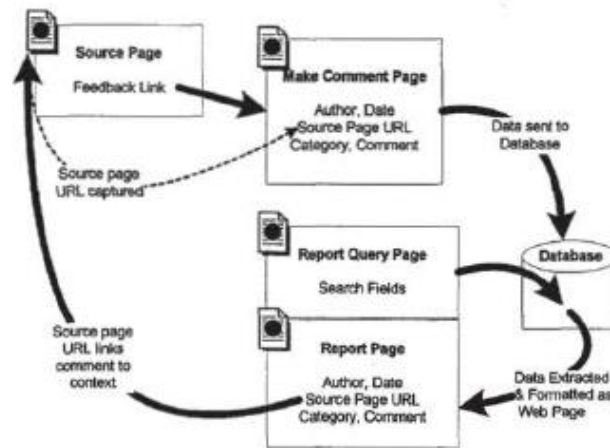


Figure 2 illustrates the basic process of the commenting system of McDonald.

McDonald also discloses an embodiment of a feedback system that allows a user to comment on digital movies (i.e., a “digital movie commenting system”). Ex. 1005, 5–6. In that system, a “user clicks on a provide/review comments about movie link and is then brought to a movie commenting page” (i.e., “feedback link”). *Id.* at 6. McDonald teaches that the digital movies are stored on a web server. *Id.* A web page (HTML) loads a Java commenting applet. The Java commenting applet loads and plays the movie, provides user controls, and interacts with the remote database. *Id.* A Java server program (on the remote database) interacts with the commenting applet and retrieves and stores comment data on a network server. *Id.* at 6, Fig. 4. Figure 4 of McDonald, reproduced below, illustrates the architecture of the digital movie commenting system and identifies the interactions of the different elements of the system.

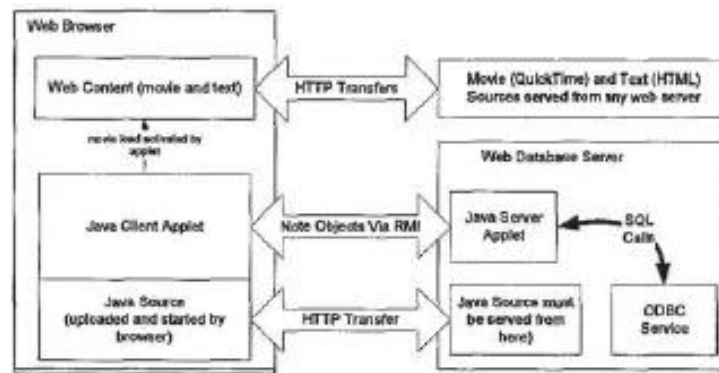


Figure 4 illustrates the basic elements of the digital movie commenting system of McDonald.

2. Overview of Pinsley

Pinsley describes methods for surveying the users of an advertiser website. Ex. 1007, Abstract. Pinsley teaches embedding into certain web page(s) of the website a GIF (graphic image format) icon that links to a recruit program located at a surveyor's site. *Id.* at 2:45–47; 3:9–16. Figure 1 of Pinsley, reproduced below, illustrates the different computer systems used by Pinsley's disclosed methods.

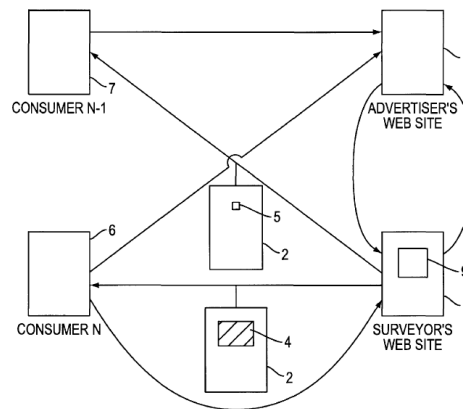


Figure 1 illustrates the basic elements of Pinsley's survey system.

Pinsley teaches that survey program (element 9) is located on a computer network (Surveyor's Web Site 3), remote from the Advertiser's

Web Site (element 1) and the user's computer system (elements 6 and 7).
Id. at 5:10–12.

The surveyor site monitors how many times the Advertiser's Web Site is accessed by users. Ex. 1007, 2:47–54. A recruit program on the surveyor site selects users of the website to be presented with a banner on the advertiser's website. *Id.* The banner entices the user to participate in a survey about the advertiser's website. *Id.* When a user clicks on the banner, the program launches and presents the user with a survey, as shown in Figure 4 reproduced below. *Id.* at 2:51–56, Fig. 4.

Netscape - [Your Opinion Counts]

File Edit View Go Bookmarks Options Directory Window Help

Location: <http://mis.npd.com/web/NthTest/recruit.html>

Your opinions will help us build a better site!

Please take a few moments to answer the following questions. In return for your input we'll enter your name into a drawing for a chance to win a Pentium PC.

1. In the last 30 days, how many times have you visited this site?

☐ Less than 5 times ☐ Between 5 and 10 times ☐ More than 10 times

2. On a scale of 1 to 5 (1=poor, 5=excellent) How would you rate the following attributes of this site?

Current quality ☐ 1 ☐ 2 ☐ 3 ☐ 4 ☐ 5

Access speed ☐ 1 ☐ 2 ☐ 3 ☐ 4 ☐ 5

Visual appeal ☐ 1 ☐ 2 ☐ 3 ☐ 4 ☐ 5

Ease of use ☐ 1 ☐ 2 ☐ 3 ☐ 4 ☐ 5

3. Please enter your e-mail address so we may contact you if you win the grand prize.

Thank you for your valuable opinions

Document Done

FIG. 4

Figure 4 illustrates a survey presented to users of an Advertiser's Web Site as disclosed in Pinsley's survey system.

After the survey is completed, the information is collected, processed and analyzed by the surveyor, and then the information is delivered to the advertiser or otherwise used. *Id.* at 3:5–8.

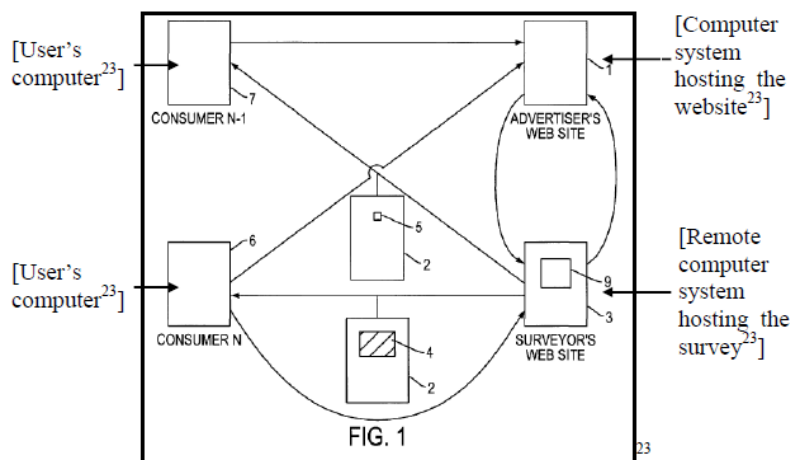
3. Analysis

a. McDonald and Pinsley Teach or Suggest All the Recited Limitations of Independent Claims 1 and 9

Petitioner contends the combination of McDonald and Pinsley, as summarized above, renders claims 1 and 9 of the '285 patent obvious. Pet. 29. Independent claims 1 and 9 each require communicating a request for a “comment window” to and receiving a “comment window” from “a remote computer system that is separate from a computer system hosting the website and also separate from the computer system of the user.” Ex. 1001, 31:17–47. Thus, all the claims require three separate computer systems: (1) a remote computer system to which a request for a “comment window” is communicated and from which a “comment window” is received by the user computer; (2) a computer system that hosts the website for which a user provides comments; and (3) a user computer system.

According to Petitioner, McDonald discloses every limitation of the challenged claims. Pet. 17–29. Petitioner supports its assertions with a first Declaration of Mr. John Chisholm (“Mr. Chisholm”), who testifies that McDonald teaches a system that includes three distinct and separate computer systems with a web-based user feedback system (and corresponding database) that can be hosted on a remote server, different from both the computer system hosting the web content and the computer system of the user. Ex. 1009 ¶¶ 118–19. Additionally, Petitioner contends Pinsley explicitly discloses and claims several limitations of the challenged claims, so that Pinsley considered in view of McDonald would have led one of skill in the art to consider claims 1 and 9 obvious. Pet. 30; Ex. 1009 ¶ 122.

Petitioner specifically asserts that Pinsley discloses hosting a Web-based survey (“comment window”) on a remote computer system that is different from both the computer system hosting the website and the computer system of the user as required by independent claims 1 and 9 of the ’285 patent. Pet. 30–36 (citing Ex. 1007, 1:6–10, 1:62–65, 2:11–14). Petitioner supports its assertions with testimony from Mr. Chisholm, who states that “Pinsley discloses (among other things) ‘a system for administering a survey for Internet Web site visitors . . . by embedding in the Web site a reference to an executable graphic image that initiates a program at a surveyor’s computer site.’” Ex. 1009 ¶ 123. Mr. Chisholm notes that Pinsley states “[r]esponding to the graphic stimulus causes the actual survey to be fetched from the surveyor’s site.” *Id.* (citing Ex. 1007, 2:3–14). Relying, in part, on Figure 1 of Pinsley, Mr. Chisholm then testifies that Pinsley discloses three distinct and separate computer systems: (1) the computer hosting the “Advertiser’s Web Site”; (2) the computer hosting the “Surveyor’s Web Site”; and (3) the computers of the “consumers” (*i.e.*, website users). *Id.* ¶ 124. Mr. Chisholm’s annotated Figure 1 of Pinsley is reproduced below:



Mr. Chisholm's annotated Figure 1, shown above, indicates that Surveyor's Web Site 3 is separate from both Advertiser's Web Site 1 and the computers of consumer N and consumer N-1. *Id.* ¶ 124 n.23 (citing Ex. 1007, 2:42–59, Fig. 1).

Petitioner then contends that Pinsley discloses receiving a Web-based survey (“comment window”) at the computer system of the user, and that the comment window is hosted on a remote computer system (Surveyor's Web Site 3) that is different from the computer system hosting the advertiser's website. Pet. 35–36 (citing Ex. 1007, 2:51–56, Fig. 4). Petitioner, thus, asserts that “Pinsley discloses ‘receiv[ing], at the computer system of the user, the comment window from the remote computer system that is separate from the computer system hosting the website and also separate from the computer system of the user [and] present[ing] the comment window to the user at the computer system of the user[.]’” *Id.* at 36 (citing Ex. 1009 ¶¶ 132–33).

Petitioner also contends that Pinsley discloses “embedding into [the] HTML Web page a reference to the surveyor's program.” Pet. 33 (citing Ex. 1007, 3:13–14). Petitioner explains that given this disclosure in Pinsley, it would have been obvious to a person of skill in the art to implement the HTML link to a “comment window” disclosed in McDonald using a remote computer system to host the “comment window.” *Id.* at 34. According to Petitioner, this implementation of a link to a “comment window” comprises “software associated with the comment icon and operable to: in response to the user selecting the comment icon, automatically communicate a request for a comment window to a remote computer system that is separate from a computer system hosting the website and also separate from the computer

system of the user[.]” *Id.* Petitioner concludes that when the link is clicked by the user, it is operable to automatically communicate an HTTP request for the “comment window” to the remote computer system. *Id.*

Patent Owner contests Petitioner’s position, arguing neither McDonald nor Pinsley teaches or suggests that a “comment window” is requested and received from a “remote computer system separate from a computer system hosting the website and also separate from the computer system of the user.” PO Resp. 30–37. Patent Owner first contends that “McDonald merely discloses **communication** with a remote database, such as to submit comment information,” because the video commenting tool in McDonald is “merely a client-side Java applet” that is not requested and received from the “Web Database Server.” PO Resp. 30, 33–34. Rather, according to Patent Owner, the database server and web server shown in Figure 4 of McDonald both appear to reside on the same computer system and McDonald only discloses that the database is remote from the *user’s* computer system (which runs the video commenting applet), but not from the *web* server (*i.e.*, the computer system hosting the particular web page). *Id.* at 34 (citing Ex. 1005, 6 (“The commenting applet . . . interacts with the remote database”)); Ex. 2002 ¶¶ 56–57. Patent Owner, thus, concludes that McDonald does not disclose three separate systems with a “comment window” being requested and received from a “remote computer system.” *Id.*

Patent Owner relies on the Declaration of Dr. Shamos to support its position regarding McDonald. *See* Ex. 2002 ¶¶ 56–57. Dr. Shamos states in his declaration that Figure 4 of “McDonald shows a web browser at the left running on a client and web server on the right,” therefore, “Figure 4 at most

discloses two computer systems.” *Id.* (citing Ex. 1005, Fig 4). Dr. Shamos, however, testified to the contrary during his deposition, stating that McDonald discloses three different systems, including a Web Database Server that allows reviewers to comment on a movie with the comments being requested, received, and stored on a system that is separate from that storing the movie. *See* Ex. 1022, 221:17–222:15, 227:5–230:20. Specifically, Dr. Shamos testified as follows regarding Figure 4 of McDonald:

Q Right.

And so there could be three separate systems; one for the client web browser, one for the movie being served by a web browser and another for the server entitled “Web Database”; is that right?

MR. CREMEN: Same objections.

THE WITNESS: I think in -- it is contemplated that there would be three separate systems. The reason is that this system structure that’s disclosed here would allow you to comment on any movie whatsoever, even if it hadn’t been made at Sandia; for example, if it were available on a remote website.

You still might want to capture comments at Sandia about it and you wouldn’t have the luxury of going and fooling around with the website from which the movie was being served. And so it’s contemplated, because there’s -- with separate boxes, that there would be three different systems.

There are other technical reasons that it should be three different systems because normally the database server is simply serving the results of SQL queries and you don’t want to burden it with streaming video, which is a huge transmission burden.

Id. at 221:17–222:15.

We credit the testimony of both Dr. Shamos (Ex. 1022, 221:17-222:15, 227:5-230:20) and Mr. Chisholm (Ex. 1009 ¶ 118). Based on the evidence, we agree with Petitioner that McDonald at least suggests three separate computer systems with a web-based user feedback system (and corresponding database) that can be hosted on a remote server, different from both the computer system hosting the web content and the computer system of the user. *See* Pet. 19–21 (citing Ex. 1005, 5, Fig. 2; Ex. 1009 ¶¶ 117–19).

Patent Owner further contends that Pinsley does not teach or suggest a request for a “comment window” that is both requested and received from a “remote computer system separate from a computer system hosting the website and also separate from the computer system of the user” and that is displayed to a user. PO Resp. 34–35. According to Patent Owner, Pinsley is largely silent on where or how the website survey page (as opposed to its survey program) is stored and Pinsley suggests that the survey web page is stored on the same computer system as the advertiser’s page, not a “remote computer system” as claimed in the ’285 Patent. *Id.* at 35. Patent Owner explains that the URLs of the advertiser page and survey page in Figures 3 and 4, respectively, along with the exemplary HTML code in column 3, indicate that the pages are part of the same website, because the page including the invitation and the website survey page itself all refer to the same domain—NPD’s site (mis.npd.com). *Id.* at 36 (citing Ex. 1007, Figs. 2–4). Therefore, Patent Owner argues that the advertiser page and survey page are part of the same website and are delivered from the advertiser’s system, while the Surveyor’s Web Site is a remote computer system. *Id.* at 15–16. Patent Owner contends that if the survey page itself were located at

the Surveyor's Web Site then the surveyor would not have to collect survey results after the completion of a survey. *Id.* at 16 (citing Ex. 1007, 3:5–8). Patent Owner, thus, concludes that Pinsley does not disclose that the website survey page is requested and received from a “remote computer system.” *Id.* at 36–37.

Patent Owner again relies on the Declaration of Dr. Shamos to support its position, yet Dr. Shamos again testifies counter to Patent Owner. Ex. 2002 ¶¶ 74–80; Ex. 1022, 242:6–243:23, 248:2–250:3. Specifically, Dr. Shamos testifies that the Advertiser's Web Site in Figure 1 of Pinsley never delivers any web pages (or anything else) to a user. Ex. 2002 ¶ 74. Rather, according to Dr. Shamos, a user's request is passed on to the Surveyor's Web Site (*id.* ¶ 75) and a survey page is delivered by the Surveyor's Web Site (*id.* ¶ 78). Although Dr. Shamos testifies that the Advertiser's Web Site is the remote computer (Ex. 1022, 242:6–243:23, 248:2–250:3), rather than the Surveyor's Web Site as argued by Patent Owner, we do not find that Dr. Shamos's testimony is inconsistent with Patent Owner's position because both argue that the advertiser's webpage and the survey page are co-located rather than the survey page being remotely located from the advertiser's webpage.

Despite the consistency we discern between the different theories proffered by Patent Owner and Dr. Shamos, we are not persuaded by either theory. Rather, we agree with Petitioner that Pinsley teaches that the survey program (element 9) is located on a computer network (Surveyor's Web Site 3) remote from the Advertiser's Web Site (element 1) and the user's computer systems (elements 6 and 7). *See* Pet. 31–32 (citing Ex. 1007, 5:10–12). Pinsley also teaches giving users an opportunity to access the

survey by presenting a graphic icon to the user, and responding to the graphic icon causes the actual survey (i.e., the claimed “comment window”) to be fetched from the surveyor’s site (i.e., the claimed “remote computer system”). *Id.* at 2:11–14. Despite Figure 4 of Pinsley showing two arrows directed from the survey’s site to the user’s computer and no arrows from the advertiser’s site to the user’s computer, we are not persuaded that the Advertiser’s Web Site goes through the survey’s site to the user as suggested by Dr. Shamos. *See* Ex. 1022, 249:14–250:3. Such a conclusion is contradicted by Pinsley’s disclosure that (i) “The advertiser’s Web (1) may have an HTML document (2), which may be the home page, with a few additional lines of codes. . . . The added code should be in the form of a reference to an executable graphic image program (9) located at the surveyor’s site (3)” (Ex. 1007, 2:42–46), and (ii) “a user (6) reference the [survey] program by visiting the advertiser’s (1) web site” (*id.* at 5:11–12). Thus, we find that Pinsley teaches hosting a Web-based survey (“comment window”) on a remote computer system that is different from both the computer system hosting the website and the computer system of a user.

Patent Owner also contends that neither McDonald nor Pinsley teaches or suggests soliciting “page-specific” open-ended comments concerning a particular web page, as required by independent claims 1 and 9. PO Resp. 37–40. According to Patent Owner, McDonald fails to teach that limitation, because McDonald is directed to peer-review of multimedia files, *not particular web pages of a website*. *Id.* at 38–39. Patent Owner argues that the web pages holding the content are incidental to the commenting process and, although individual source web page URLs are tracked, the tracking is done simply to identify the particular report provided

at that URL, not to facilitate comments about that web page. *Id.* Patent Owner then notes that Petitioner does not assert that Pinsley discloses that limitation, and therefore, Petitioner fails to meet its burden to show obviousness of the independent claims. *Id.* at 39. Petitioner, however, asserts that McDonald does teach that limitation. Specifically, Petitioner asserts that McDonald discloses that “[e]ach system allows people to make context-sensitive comments about specific web content. . . .The first system ties comments to *specific web pages*[.]” Pet. 18 (citing Ex. 1005, 1) (emphasis added). McDonald further states that this “Web Page Commenting” system “interoperates with regular web pages to allow reviewers to comment on web page content.” *Id.* (citing Ex. 1005, 5). Given the disclosure in McDonald, we agree with Petitioner and find that McDonald teaches open-ended comments concerning a particular web page as recited in the challenged claims.

Patent Owner further contends that neither McDonald nor Pinsley teaches a “comment window” that is received by the computer system of the user, following the user “access[ing] the particular web page: and “selecting the comment icon” viewable on the particular web page. PO Resp. 40–42. According to Patent Owner, the McDonald system forces the user to **navigate away** from the web page with the “feedback link,” such that the “Make Comment Page” is never simultaneously viewable with the underlying web page on which the user indicated a desire to provide comments. *Id.* at 41 (citing Ex. 1005, 5, Figs. 1-3; Ex. 2002 ¶¶ 59-61; Ex. 2004, 86:8–87:2). Patent Owner, thus, concludes that the “Make Comment Page” cannot be considered a “comment window” as recited in the challenged claims. Petitioner, however, argues that the “make a comment

web form” corresponds to the claimed “comment window.” Pet. 19–21 (citing Ex. 1009 ¶¶ 120, 131). Petitioner supports its position with a second declaration from Mr. Chisholm. *See* Ex. 1021 ¶ 23. We agree with Petitioner, because there is nothing in the claims that requires the “comment window” to be simultaneously viewable with the underlying web page on which the user indicated a desire to provide comments; the claims simply require that the comment window allows a user to provide one or more page-specific open-ended comments concerning a particular web page. The “make a comment web form” disclosed in McDonald fulfills the stated requirement of the challenged independent claims.

Patent Owner lastly contends that neither McDonald nor Pinsley teaches or suggests “reporting [feedback comments] to a website owner,” as required by independent claims 1 and 9. PO Resp. 42–43. According to Patent Owner, the comments collected in McDonald are intended for and reviewed by peers of the commenters, and not by the owner of the underlying website that maintains the particular website. *Id.* at 43 (citing Ex. 1005, 1). Petitioner asserts, however, that McDonald teaches reporting user comments to a website owner through a Web-based “Report Page.” Pet. 24 (citing Ex. 1005, 5, Fig. 2). Petitioner points out that McDonald specifically states website owners can submit search terms through a web form on the Report Query Page to generate custom reports of reviewer comments (Report Pages). *Id.* These reports display the comments and provide hyperlinks to the Source Page to which the comment refers. Ex. 1005, 5. Based on the disclosure in McDonald cited by Petitioner, we find that McDonald teaches reporting feedback comments to a website owner.

Accordingly, we hold that Petitioner has shown by a preponderance of the evidence that claims 1 and 9 are unpatentable under 35 U.S.C. § 103(a) for obviousness in view of McDonald and Pinsley.

b. McDonald and Pinsley Teach or Suggest the Recited Limitations of Dependent Claims 4, 5, 7, 12, 13, and 15

Petitioner contends dependent claims 4, 5, 7, 12, 13, and 15 are unpatentable under 35 U.S.C. § 103(a) as having been obvious over McDonald and Pinsley. Pet. 25-29, 59-60; Ex. 1009 ¶¶ 139-50. Patent Owner contests Petitioner's position, arguing neither McDonald nor Pinsley teaches or suggests a "comment window," let alone a "comment window that is customizable by the website owner" as recited by the challenged dependent claims. PO Resp. 44-46. McDonald, however, discloses a "Make a Comment" form that is accessed through a "feedback link" on a particular web page (the "source page"), while the form itself is on a different web page (the "Make Comment Page") hosted by a remote server. Ex. 1005, 5, Fig. 2. According to Petitioner, the website owner need not modify the particular web page in order to customize the comment window. Pet. 25, 28; Ex. 1009 ¶ 140. As explained by Petitioner, as long as the URL of the "Make Comment Page" remains the same, the (unmodified) link on the particular web page will still function to call the (modified) comment window. Pet. 25, 28; Ex. 1009 ¶ 140. We agree with Petitioner and find that the "Make a Comment Page" disclosed in McDonald fulfills the stated requirement of the challenged dependent claims for a customizable comment window.

Patent Owner does not provide separate contentions regarding additional limitations recited in the dependent claims. After careful

consideration of the language recited in claims 4, 5, 7, 12, 13, and 15, we find that one of ordinary skill in the art would have considered these dependent claims obvious over McDonald and Pinsley. Accordingly, we determine that Petitioner has shown by a preponderance of the evidence that claims 4, 5, 7, 12, 13, and 15 are unpatentable under 35 U.S.C. § 103(a) because they would have been obvious in view of McDonald and Pinsley.

c. Reasons for Combining the Elements Taught in McDonald and Pinsley

Petitioner contends that a person of ordinary skill in the art would have had reason to combine the teachings of McDonald with those of Pinsley for at least the following reasons: (1) the references address the same problem: the solicitation of feedback from users of a web page; (2) the references address this problem in the same manner: presenting users with a comment icon (referred to in Pinsley as a “graphic image”), which they can click to open a comment window; and (3) the references rely on the same basic Web technology, including, in particular, an HTML link to a Web-based survey (comment window). Pet. 29 (citing Ex. 1009 ¶¶ 91-106.)

Additionally, Petitioner explains that a person of ordinary skill in the art would have been led to combine the remote computer system hosting a Web-based survey (comment window) in Pinsley with the teachings of McDonald because: (1) McDonald also discloses the use of a remote computer system to host a “comment window”; (2) hosting Web-based surveys (*e.g.*, “comment windows”) on a remote server was routine industry practice by 1997-98 (and beyond); (3) remote hosting offered a number of business, technical and market research advantages, including, *e.g.*, avoiding security issues and other constraints associated with the server hosting the

website, and reducing traffic on the website server; and (4) implementing a “comment window” on a remote computer system was straightforward from a technical perspective, and could be accomplished simply by ensuring that the destination of the corresponding HTML link (appearing on the web page(s) for which feedback was being provided) was set to the address (URL) of the survey on the remote server. *Id.* at 29–30 (citing Ex. 1009 ¶¶ 107–11).

Patent Owner contests Petitioner’s position, arguing that one of ordinary skill in the art at the time of the invention of the challenged claims would not have been motivated to try to combine McDonald and Pinsley, for several reasons. PO Resp. 1, 17. First, Patent Owner contends that the proposed combination fails to account for the fact that the two references are directed to contrary endeavors. *Id.* at 1–2, 19–21. According to Patent Owner, McDonald’s peer review system would never look to Pinsley’s Nth visitor selection system. Patent Owner argues that a system such as Pinsley’s would defeat a key objective of scientific peer review, ***where one expects all reviewers to comment***, not merely every Nth visitor whether or not they have an opinion. *Id.* at 2, 21–22.

Second, Patent Owner contends that the Pinsley approach of soliciting comments about an advertiser’s overall website from a smaller number of visitors, as a ***complementary*** function of the advertiser’s website, lends itself to a “distributed thin-client system.” *Id.* at 2, 21–23. Patent Owner argues it would not have made sense to try to apply that approach with McDonald, whose entire purpose was instead to provide a “highly-integrated peer review system.” *Id.* at 2. Patent Owner explains:

In other words, distributing across a network the storage and handling of McDonald's tightly-coupled multimedia files and associated comments using a thin-client approach would have provided no benefit to McDonald and, in fact, would have degraded performance and increased cost. That was especially true in the early 2000s, when network bandwidth was at a premium and data transfer was typically much slower and more expensive than it is today.

Id.

Lastly, Patent Owner contends that Petitioner's arguments: (1) fail to provide a reason for why a person of ordinary skill in the art would combine McDonald and Pinsley together (*id.* at 17); (2) fail to demonstrate that there would have been reasonable expectation of success by combining the references (*id.*); (3) solely rest on hindsight analysis (*id.* at 18); and (4) are technologically incorrect and unreliable (*id.* at 23-26).

We are not persuaded by Patent Owner's arguments, as they narrowly focus on small differences between McDonald and Pinsley and fail to consider the collective teachings of McDonald and Pinsley from the perspective of one of ordinary skill in the art. *See KSR*, 550 U.S. at 420 (“[F]amiliar items may have obvious uses beyond their primary purpose, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.”); *EWP Corp. v. Reliance Universal Inc.*, 755 F.2d 898, 907 (Fed. Cir. 1985) (a prior art reference must be considered for everything it teaches by way of technology and is not limited to the particular invention it is describing and attempting to protect).

Moreover, the test for obviousness is not whether one could physically incorporate Pinsley's Nth visitor selection system (that solicits comments from users through a remote system) into McDonald, but whether

a person of ordinary skill in the art would have reason to incorporate the teachings of Pinsley to modify McDonald. In that regard, Patent Owner's expert testified that collecting feedback on a website basis was well known and that it was within the knowledge of one of skill in the art to program a comment collecting survey to be sent to a user. *See, e.g.*, Ex. 1022, 89:17–20, 88:7–20, 90:16–21, 95:16–96:2. Thus, Petitioner has proffered a reason for combining McDonald and Pinsley, which has a rational underpinning, in support of Petitioner's obviousness argument. *See KSR*, 550 U.S. at 418. Therefore, we conclude Petitioner has established by a preponderance of the evidence that one would have been led to combine the peer review commenting system (containing three separate and distinct systems) of McDonald with the commenting solicitation teachings of Pinsley (containing three separate and distinct systems) because such a combination appears to be merely a “predictable use of prior-art elements according to their established functions.” *See id.* at 417.

d. Secondary Considerations of Non-Obviousness

Factual inquiries for an obviousness determination include secondary considerations based on evaluation and crediting of objective evidence of nonobviousness. *See Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). Notwithstanding what the teachings of the prior art would have suggested to one with ordinary skill in the art at the time of the '285 patent's invention, the totality of the evidence submitted, including objective evidence of nonobviousness, may lead to a conclusion that the challenged claims would not have been obvious to one with ordinary skill in the art. *In re Piasecki*, 745 F.2d 1468, 1471-72 (Fed. Cir. 1984). Secondary considerations may include any of the following: long-felt but unsolved needs, failure of others,

unexpected results, commercial success, copying, licensing, and praise. See *Graham*, 383 U.S. at 17; *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007).

To be relevant, evidence of nonobviousness must be commensurate in scope with the claimed invention. *In re Kao*, 639 F.3d 1057, 1068 (Fed. Cir. 2011) (citing *In re Tiffin*, 448 F.2d 791, 792 (CCPA 1971)); *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998). In that regard, in order to be accorded substantial weight, there must be a nexus between the merits of the claimed invention and the evidence of secondary considerations. *In re GPAC Inc.*, 57 F.3d 1573, 1580 (Fed. Cir. 1995). “Nexus” is a legally and factually sufficient connection between the objective evidence and the claimed invention, such that the objective evidence should be considered in determining nonobviousness. *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988). The burden of showing that there is a nexus lies with the patent owner. *Id.*; see *Paulsen*, 30 F.3d at 1482. Here, Patent Owner argues that commercial success, industry praise, and copying demonstrate that the challenged claims would not have been obvious to a person of ordinary skill in the art. PO Resp. 46–57.

(1) Commercial Success

As evidence of commercial success, Patent Owner alleges its “page-specific feedback solution embodying the claimed invention² is utilized by “half of the Fortune 50 organizations.” *Id.* at 53 (citing Ex. 2015). Patent Owner further contends that “this feedback solution, as designated by

² Patent Owner identifies “the claimed invention” in its discussion of secondary considerations as independent claims 1 and 25. Pet. 33 n.9.

OpinionLab’s [+] feedback symbol, had already been ‘adopted by hundreds of brands and implemented on more than 6,500 websites worldwide.’” *Id.* (citing Ex. 2007; Ex. 2002 ¶ 106).

We are not persuaded by Patent Owner’s arguments.

Initially, we note that “[e]vidence of commercial success, or other secondary considerations, is only significant if there is a nexus between the claimed invention and the commercial success.” *Ormco Corp. v. Align Tech., Inc.*, 463 F.3d 1299, 1311–12 (Fed. Cir. 2006). In its summary of the legal standard for secondary considerations, Patent Owner states, generally, that “[a] nexus is presumed[] when a marketed product is coextensive with the asserted claims.” PO Resp. 47 (citing *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 723 F.3d 1363, 1372 (Fed. Cir. 2013)). Patent Owner, however, offers no persuasive explanation or evidence to support the allegation that its allegedly commercially successful product is *coextensive* with the claimed invention. In fact, Patent Owner’s reference to the patent markings on its product appears to evidence that the product is not coextensive with the claimed invention, as its product lists at least fourteen patents, in addition to the ’285 patent, that apply to its product. *See id.* at 47–48.

In its specific discussion of “nexus,” Patent Owner contends that “[a] nexus between the OpinionLab product and the challenged claims is easy to show,” but simply alleges that its product includes the limitations of claim 1 and references the patent markings discussed above. *Id.* at 47. To show how commercial success supports non-obviousness, however, Patent Owner must prove that the sales were a direct result of the unique characteristics of the invention, and not a result of economic and commercial factors unrelated

to the quality of the patented subject matter. Patent Owner has not so shown. *See In re Applied Materials, Inc.*, 692 F.3d 1289, 1299–1300 (Fed. Cir. 2012). Even if Patent Owner’s product includes the limitations of claim 1, there is no explanation as to how these limitations are related to the alleged commercial success other than simply alleging that the limitations are present in its product. *See* PO Resp. 47–52. Patent Owner provides examples of the database and reporting module features of its product and discusses use of various features by its customers, but does not attempt to tie any of these features to the alleged commercial success. Patent Owner’s specific discussion of “commercial success” does not cure this deficiency. *See id.* at 52–53 (alleging that “OpinionLab’s page-specific user feedback solution embodying the claimed invention is utilized by an extensive list of customers” and that “OpinionLab’s customer list has continued to grow” without tying this alleged commercial success to the unique characteristics of the claims).

Accordingly, we are not persuaded by Patent Owner’s allegations of commercial success.

(2) Industry Praise

Patent Owner contends, generally, that it “has received widespread industry recognition and praise for the claimed technology as demonstrated in the many articles written on OpinionLab’s page-specific user feedback solution.” *Id.* at 53 (citing Ex. 2002 ¶ 107). As with commercial success, however, evidence of industry praise is only relevant when it is directed to the merits of the invention claimed. *See Ormco*, 463 F.3d at 1311. Patent Owner identifies various documents discussing features of its product. *See* PO Resp. 54. For example, Patent Owner quotes a discussion from Exhibit

2009 touting “the iconic image of a rotating plus/minus sign,” a discussion from Exhibit 2020 stating “OpinionLab, the pioneer and leader in voice-of-customer (VOC) listening technologies,” and a discussion from Exhibit 2017 regarding “OpinionLab’s [+] feedback symbol.” *Id.* Notably, these materials quoted in the Patent Owner Response praise OpinionLab’s product in general. Patent Owner does not identify any praise due to specific features that are present in the claims. Patent Owner has not established a sufficient nexus with the claimed invention.

Accordingly, we are not persuaded by Patent Owner’s allegations of industry praise.

(3) Copying

Patent Owner contends that “there is strong evidence of copying by others of OpinionLab’s page-specific user feedback solution covered by the ’285 Patent claims.” *Id.* at 55. Patent Owner notes that “[t]his copying is generally shown for *at least* the reasons identified in Exhibit 1012 to the *Petition*, which includes OpinionLab’s Infringement Contentions. . . .”³ *Id.* Patent Owner notes that “[t]he Infringement Contentions of Exhibit 1012 illustrate in detail how each element of the challenged claims are present in Petitioner’s system.” *Id.* Patent Owner’s arguments regarding copying are not persuasive.

“[C]opying requires evidence of efforts to replicate a specific product.” *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1246 (Fed. Cir. 2010).

³ To the extent Patent Owner relies on arguments in Exhibit 1012 not discussed in the Patent Owner response, we decline to address those arguments. See 37 C.F.R. § 42.6(a)(3) (“Arguments must not be incorporated by reference from one document into another document.”).

Patent Owner does not provide any analysis or explanation of how other companies, such as Petitioner, allegedly copied its product that allegedly includes the features of the claimed invention. Rather, Patent Owner simply shows similarities between its products and those offered by Petitioner. See Pet. 55–56.

Accordingly, we are not persuaded by Patent Owner’s allegations of copying.

e. Conclusion

We have considered the entirety of the evidence, including the evidence of obviousness and the evidence submitted by Patent Owner to show commercial success. For the reasons set forth above, Petitioner has established, based on a preponderance of the evidence, that claims 1, 4, 5, 7, 9, 12, 13, and 15 would have been obvious over the combination of McDonald and Pinsley.

E. Petitioner’s Motion to Exclude

Petitioner filed a Motion to Exclude Evidence seeking to exclude portions of the Shamos Declaration (Ex. 2002) and portions of the deposition testimony of Dr. Shamos (Ex. 1022). Paper 33 (“Mot.”). Even without excluding this evidence, we have determined that Petitioner has established, based on a preponderance of the evidence, the unpatentability of claims 1, 4, 5, 7, 9, 12, 13, and 15 of the ’285 patent. Further, Petitioner’s arguments on these items go to the weight to be accorded to the evidence. See, e.g., Mot. 4 (Dr. Shamos allegedly failed to consider any of the prior art in the field of the challenged patent), 4 n.1 (Dr. Shamos’s characterization of a person of ordinary skill in the art), 7 (Dr. Shamos did not conduct independent research or analysis regarding secondary considerations).

Decisions regarding the appropriate weight to accord to evidence are within the purview of the Panel.

For these reasons, we *deny* Petitioner's motion.

III. CONCLUSION

We conclude Petitioner has shown by a preponderance of the evidence the unpatentability of claims 1, 4, 5, 7, 9, 12, 13, and 15 under 35 U.S.C. § 103(a) for obviousness over McDonald and Pinsley.

IV. ORDER

For the reasons given, it is

ORDERED that claims 1, 4, 5, 7, 9, 12, 13, and 15 of the '285 patent are held unpatentable;

FURTHER ORDERED that Petitioner's Motion to Exclude is *denied*; and

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

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