

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHOPIFY, INC., PRICELINE.COM LLC, and BOOKING.COM B.V.,
Petitioner,

v.

DDR HOLDINGS, LLC,
Patent Owner.

IPR2018-01009¹
Patent 9,043,228 B1

Before CARL M. DEFRANCO, PATRICK M. BOUCHER, and
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

FINAMORE, *Administrative Patent Judge*.

JUDGMENT

Final Written Decision

Determining No Challenged Claims Unpatentable
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

¹ *Priceline.com v. DDR Holdings, LLC*, IPR2019-00436 (PTAB filed Dec. 14, 2019) has been joined to this proceeding. Paper 24. In view of this joinder, the Board has adjusted the time period for issuing a final determination. Paper 32; *see also* 35 U.S.C. § 316(a)(11); 37 C.F.R. § 42.100(c).

I. INTRODUCTION

Shopify, Inc. filed a Corrected Petition (Paper 8, “Pet.”) requesting *inter partes* review of claims 1, 3–5, 7–9, 11–13, 15, and 16 of U.S. Patent No. 9,043,228 B1 (“the ’228 patent”). Pet. 1. On November 15, 2018, we instituted trial. Paper 10 (“Inst. Dec.”).

After institution, DDR Holdings, LLC (“Patent Owner”) filed a Response. Paper 19 (“PO Resp.”). Shopify, Inc. filed a Reply to Patent Owner’s Response. Paper 21 (“Reply”). Patent Owner filed a Sur-reply. Paper 23 (“Sur-reply”).

On June 10, 2019, we granted a Motion for Joinder by Priceline.com LLC and Booking.com B.V. in IPR2019-00436. Paper 24. As a result, Shopify, Inc., Priceline.com LLC, and Booking.com B.V. (collectively “Petitioner”) are challenging the claims of the ’228 patent in this proceeding.

An oral hearing was held on July 25, 2019. A transcript of the hearing has been entered into the record. Paper 31 (“Tr.”).

We issue this Final Written Decision pursuant to 35 U.S.C. § 318(a). For the reasons that follow, we conclude Petitioner has not demonstrated that claims 1, 3–5, 7–9, 11–13, 15, and 16 of the ’228 patent are unpatentable by a preponderance of the evidence.

II. BACKGROUND

A. *Real Parties in Interest*

Petitioner identifies Shopify, Inc., Priceline Group Inc., Priceline.com LLC, Priceline Partner Network, Booking.com B.V., Booking.com Holding B.V., Priceline.com Bookings Acquisition Co., Ltd., Priceline.com International Ltd., Priceline.com Holdco U.K. Ltd., and Priceline.com

Europe Holdco, Inc. as real parties in interest. Pet. 1; *Priceline.com LLC v. DDR Holdings, LLC*, IPR2019-00436, Paper 3 at 1 (PTAB Dec. 14, 2018) (Petition in joined proceeding). Patent Owner identifies only itself as a real party in interest. Paper 5, 1.

B. Related Matters

The parties identify the following five proceedings from the U.S. District Court for the District of Delaware: (1) *DDR Holdings, LLC v. Priceline.com LLC*, No. 1:17-cv-498-ER (D. Del. filed May 2, 2017); (2) *DDR Holdings, LLC v. Booking.com B.V.*, No. 1:17-cv-499-ER (D. Del. filed May 2, 2017); (3) *DDR Holdings, LLC v. TicketNetwork, Inc.*, No. 1:17-cv-500-ER (D. Del. dismissed May 9, 2018); (4) *DDR Holdings, LLC v. Shopify, Inc.*, No. 1:17-cv-501-ER (D. Del. filed May 2, 2017); and (5) *DDR Holdings, LLC v. Travel Holdings, Inc.*, No. 1:17-cv-502-ER (D. Del. dismissed May 9, 2018). Pet. 1–2; Paper 5, 1–2. Patent Owner indicates that these five proceedings have been consolidated under No. 1:17-cv-498-ER. Paper 5, 1–2.

The parties also identify *DDR Holdings, LLC v. Hotels.com, L.P.*, 954 F.Supp.2d 509 (E.D. Tex. 2013), as well as the corresponding appeal, *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014). Pet. 2–3; Paper 5, 2–3. Patent Owner further identifies *DDR Holdings, LLC v. World Travel Holdings, Inc.*, No. 2:13-cv-00646-JRG (E.D. Tex. filed Aug. 20, 2013) and *DDR Holdings, LLC v. Digital River, Inc.*, No. 2:13-cv-00647-JRG (E.D. Tex. filed Aug. 20, 2013). Paper 5, 3–4.

The parties further identify the following reexamination proceedings: *Ex parte DDR Holdings, LLC*, No. 2009-013987 (BPAI 2010) and *Ex parte*

IPR2018-01009
Patent 9,043,228 B1

DDR Holdings, LLC, No. 2009-013988 (BPAI 2010). Pet. 3–4; Paper 17, 5–6. Patent Owner also identifies: U.S. Patent Application Serial No. 15/582,105 (issued as U.S. Patent No. 10,304,121 B1); U.S. Patent No. 6,629,135 B1; U.S. Patent No. 6,993,572 B2; U.S. Patent No. 7,818,399 B1; U.S. Patent No. 8,515,825 B1; and U.S. Patent No. 9,639,876 B1. Paper 5, 4; Paper 20, 1.

Furthermore, the parties identify related proceedings before the Board. Namely, the parties identify *Priceline Group Inc. v. DDR Holdings, LLC*, IPR2018-00482 (PTAB filed Jan. 16, 2018). Pet. 4; Paper 5, 4. Patent Owner also identifies the following eleven Board proceedings: (1) *Shopify, Inc. v. DDR Holdings, LLC*, IPR2018-01008 (PTAB filed May 3, 2018); (2) *Shopify, Inc. v. DDR Holdings, LLC*, IPR2018-01010 (PTAB filed May 4, 2018); (3) *Shopify, Inc. v. DDR Holdings, LLC*, IPR2018-01011 (PTAB filed May 2, 2018); (4) *Shopify, Inc. v. DDR Holdings, LLC*, IPR2018-01012 (PTAB filed May 2, 2018); (5) *Shopify, Inc. v. DDR Holdings, LLC*, IPR2018-01014 (PTAB filed May 2, 2018); (6) *Priceline.com v. DDR Holdings, LLC*, IPR2019-00435 (PTAB filed Dec. 14, 2019); (7) *Priceline.com v. DDR Holdings, LLC*, IPR2019-00436 (PTAB filed Dec. 14, 2019); (8) *Priceline.com v. DDR Holdings, LLC*, IPR2019-00437 (PTAB filed Dec. 14, 2019); (9) *Priceline.com v. DDR Holdings, LLC*, IPR2019-00438 (PTAB filed Dec. 14, 2019); (10) *Priceline.com v. DDR Holdings, LLC*, IPR2019-00439 (PTAB filed Dec. 14, 2019); and (11) *Priceline.com v. DDR Holdings, LLC*, IPR2019-00440 (PTAB filed Dec. 14, 2019). Paper 5, 1, 4–5; Paper 17, 5.

C. The '228 Patent (Ex. 1001)

The '228 patent relates to an affiliate commerce system for co-marketing on the Internet. Ex. 1001, 2:59–61. As described in the '228 patent, an affiliate program is a commercial arrangement between an owner of an Internet commerce website, like Amazon.com, and a third-party website owner. *Id.* at 2:19–26. More specifically, the owner of the Internet commerce website lets the third-party website owner promote a subset of its goods, e.g., ten books selected by the website owner from Amazon.com's millions of books, on the third party's website. *Id.*

These affiliate programs generate revenue for the third-party website owners, i.e., affiliates, but there is a greater benefit to the owners of the Internet commerce websites. *Id.* at 2:27–33. According to the '228 patent:

Not only do these sites benefit from the marketing resources of the affiliate operators, they are also able to lure the visitor traffic away from the affiliate. Once a visitor clicks on an affiliate ad and enters an online store, that visitor has left the affiliate's site and is gone. . . . No alternatives have been able to address a fundamental drawback of the affiliate programs—the loss of the visitor to the vendor.

Id. at 2:33–42.

The disclosed invention provides the same benefits as traditional affiliate programs, but without the restrictive limitation of losing visitors. *Id.* at 2:61–3:2. In particular, the invention enables a website host to control the customer experience before, during, and after a purchase transaction. *Id.* at 2:63–65. As set forth in the '228 patent:

According to the present invention the look and feel of each participating Host is captured and stored. Hosts may include links to selected products or product categories within pages residing on the Hosts' website. Upon actuation of such a link by a visitor of the Host website, a page is presented to the visitor

incorporating a replica of the Host's look and feel directed to the sale of the selected products or product categories.

Id. at 3:11–18.

Furthermore, an outsource provider may be used to capture the look and feel of a host's website and generate pages that replicate the host's look and feel. *Id.* at 3:19–26. Namely, the '228 patent explains:

The look and feel of a host is captured and stored by receiving an identification of an example page of a target host. The identified page is retrieved. The look and feel elements of the page are identified, and these elements are stored for future use in generating outsourced transparent pages, pages served by a server other than the host but with the host's look and feel. Such pages give the viewer of the page the impression that she is viewing pages served by the host.

Id.

The '228 patent further explains that there are three main parties in the outsourced e-commerce relationship, excluding the end consumer: merchants, hosts, and the e-commerce outsource provider. *Id.* at 22:57–60. However, there may be only two parties where one party plays the dual role of host and merchant. *Id.* at 22:60–61.

In a typical transaction process, a customer visits a host's website and becomes interested in a product offered. *Id.* at 24:6–10. The customer selects the item she wishes to purchase by clicking a product image or similar link, taking her to dynamically generated web pages which retain the look and feel of the referring host and are served by the e-commerce outsource provider. *Id.* at 24:11–16. After browsing through and selecting certain offered products, the customer initiates the checkout procedure, never leaving the host's website. *Id.* at 24:17–26. A secure checkout interface appears, which is similarly consistent in look and feel with the

host's referring website, and the customer provides billing and shipping information. *Id.* at 24:27–32. Once the payment is authorized, the customer is returned to another section of the host's website, possibly the page in which the offer was placed. *Id.* at 24:33–36. The outsource provider passes the order to the merchant, and the merchant receives and logs the order before assembling and shipping the order to the customer. *Id.* at 24:37–43. The outsource provider also periodically remits payment to the merchant for filled orders and remits payment to hosts for commissions earned. *Id.* at 24:44–47.

D. Challenged Claims

Petitioner challenges claims 1, 3–5, 7–9, 11, 13, 15, and 16 of the '228 patent. Pet. 5.² Claims 1 and 9 are independent. Ex. 1001, 27:22–60, 28:37–29:8. Independent claim 1, reproduced below, is illustrative.

1. A method of serving informational pages offering commercial opportunities, the method comprising, with a computer system serving displayable information of an outsource provider:

upon receiving over the Internet an electronic request generated by an Internet-accessible computing device of a visitor in response to selection of a uniform resource locator (URL) within a source

² Petitioner also states that “Petitioner[] request[s] *inter partes* review of claims 1, 3, 5, 7–9, 11–13, 15, and 16 [of the '228 patent]” (Pet. 1), which does not include claim 4. Petitioner, however, addresses claim 4 in each asserted ground. *Id.* at 29–32, 47–48, 68–69. We, therefore, understand Petitioner's request for *inter partes* review includes claim 4, which is consistent with Patent Owner's understanding of the challenged claims. *See, e.g.*, PO Resp. 26, 44 (addressing Petitioner's challenge to claim 4).

web page that has been served to the visitor computing device when visiting a host website controlled by a third party to the owner of the computer system, wherein the URL correlates the source web page with at least one commerce object associated with a buying opportunity of a merchant that is a third party to the owner of the computer system,

automatically serving to the visitor computing device a dynamically generated composite page containing instructions directing the visitor computing device to display:

- (i) information associated with the commerce object associated with the URL that has been activated, which commerce object includes at least one product available for sale through the computer system after activating the URL, and
- (ii) a plurality of visually perceptible elements visually corresponding to the source web page,

wherein the visually perceptible elements comprise any of the following applicable features: logos, colors, page layout, navigation systems, frames, and visually perceptible mouse-over effects,

wherein the plurality of visually perceptible elements define an overall appearance of the composite page that, excluding the information associated with the commerce object, visually corresponds to the source web page, and

wherein the instructions direct the visitor computing device to download data defining the visually perceptible elements from an information storage that is accessible to the visitor computing device through the Internet.

Id. at 27:22–60.

E. References and Evidence

Petitioner relies on the following references in asserting that claims 1, 3–5, 7–9, 11, 13, 15, and 16 of the '228 patent are unpatentable (Pet. 5):

Reference	Exhibit No.
Moore et al., US 6,330,575 B1, issued Dec. 11, 2001 (“Moore”)	1010
First Virtual Seller Programs web page (June 1997), First Virtual InfoHaus Guide web page (June 1997), and First Virtual InfoHaus HelpMeister (June 1997) (collectively “the InfoHaus Documents”)	1014, 1015, and 1016, respectively
Peter Loshin, <i>Selling Online with . . . First Virtual Holdings Inc.</i> (1996) (“Loshin”)	1013

Additionally, the parties rely on testimonial evidence. Namely, Petitioner submits a Declaration of Michael Shamos, Ph.D. Ex. 1002. Patent Owner deposed and cross-examined Dr. Shamos, and submits a transcript of this deposition. Ex. 2027. Patent Owner relies on a Declaration of Arthur M. Keller, Ph.D. Ex. 2025. There is no cross-examination testimony of Dr. Keller in the record.

F. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability (Pet. 5):

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1, 3–5, 7–9, 11–13, 15, 16	102(b) ³	Loshin
1, 3–5, 7–9, 11–13, 15, 16	103(a)	Loshin, the InfoHaus Documents

³ Petitioner asserts Loshin is prior art under 35 U.S.C. § 102(b). Pet. 6.

1, 3–5, 7–9, 11–13, 15, 16	103(a)	Loshin, Moore
----------------------------	--------	---------------

III. ANALYSIS

A. Level of Ordinary Skill in the Art

Petitioner asserts a person of ordinary skill in the art “would need to have an undergraduate degree in computer science or a related field, or equivalent experience, and, in addition, at least one year of experience with Web user-interface design, electronic catalogs and online payment processing.” Pet. 8 (citing Ex. 1002 ¶ 57). Patent Owner does not provide its own explanation of the level of ordinary skill in the art, nor does Patent Owner oppose Petitioner’s proffered level of ordinary skill in the art. Patent Owner’s declarant, Dr. Keller, testifies that he has “no material substantive dispute” with Dr. Shamos’s formulation defining the level of ordinary skill, which is identical to Petitioner’s proposal. Ex. 2025 ¶ 18. Upon consideration of the record, including Loshin, the InfoHaus Documents, and Moore, we agree with and adopt Petitioner’s proposed explanation of the level of ordinary skill in the art.

B. Claim Construction

We interpret the claims of an unexpired patent using the broadest reasonable interpretation in light of the specification. 37 C.F.R. § 42.100(b) (2017); *see also* *Cuozzo Speed Techs. LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation

standard).⁴ Under this standard, a claim term generally is given its ordinary and customary meaning, as would have been understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Furthermore, “only those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.” *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

1. “*merchant*,” “*host*,” “*commerce object*,” and “*outsource provider*”

Petitioner proposes constructions for the following claim terms: “merchants,” “host,” and “commerce object.” Pet. 9–10. Patent Owner proposes constructions for “merchant,” “commerce object,” “outsource provider,” and “host.” PO Resp. 6–7. None of these terms, however, requires an express construction to determine whether Petitioner has shown the challenged claims to be unpatentable.

2. “*an overall appearance of the composite page that . . . visually corresponds to the source web page*”

In the Decision on Institution, we instructed the parties to propose constructions for this claim limitation. Inst. Dec. 34–35 (“[W]e expect the parties to take positions with respect to the construction of the phrase ‘define an overall appearance.’”). In response to our instruction, Patent Owner argues “explicit claim construction is not required, because the claim

⁴ The Petition in this proceeding was filed on May 3, 2018, prior to the effective date of the rule change that replaces the broadest reasonable interpretation standard with the federal court claim interpretation standard. See Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51340 (Oct. 11, 2018) (codified at 37 C.F.R. § 42.100(b) (2019)) (amending 37 C.F.R. § 42.100(b) effective Nov. 13, 2018).

language itself provides guideposts,” such as the exclusion of the commerce object information and the URL. PO Resp. 8 (footnote omitted). Patent Owner also argues that the dependent claims, claims from related patents, the Specification and file history of the ’228 patent, and determinations made during the district court litigation as to which websites do and do not have a corresponding overall visual appearance provide guidance as to how to achieve the recited visual correspondence. *Id.* at 8–12 (citations omitted).

Patent Owner further argues this limitation embodies what the Federal Circuit, in *DDR Holdings, LLC v. Hotels.com L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), determined to be missing from the claims of U.S. Patent No. 6,993,572 B2 (“the ’572 patent), to which the ’228 patent claims priority. *Id.* at 4; Sur-reply 2–6; Tr. 37:12–38:25. More specifically, Patent Owner maintains:

In the same decision, the Federal Circuit invalidated certain claims of the grandparent ’572 patent as anticipated by Digital River systems, because the ’572 patent’s claims did not contain “a requirement that the generated composite web page have an ‘overall match’ in appearance with the host website.” 773 F.3d at 1254. Patent Owner obtained this patent to cure that omission, and this patent has such an “overall match” claim limitation.

PO Resp. 4; *see also* Tr. 38:24–25 (“There is no difference between corresponding overall appearance and overall match.”). According to Patent Owner, the Federal Circuit acknowledged that the jury reviewed substantial evidence that Digital River’s systems do not replicate the host website’s look and feel in terms of overall appearance, and found that such correspondence is not required by the claims of the ’572 patent. Sur-reply 3–4.

Petitioner disagrees that this limitation requires an “overall match,” and instead asserts that it relates to “look and feel.” Reply 5–7; *see also*

Tr. 20:17–20 (“We don’t believe that construction of overall appearance is necessary. The Federal Circuit construed look and feel to mean overall appearance. That was the plain language of it.”). Petitioner additionally contends “overall appearance” should be construed as “appearance taken as a whole.” Reply 7.

We agree with Petitioner that this limitation means look and feel. The written description of the ’228 patent does not use the terms “overall appearance” or “visually corresponds.” The Specification does use the word “corresponding” in regard to “look and feel,” namely:

The processor performs the tasks of capturing a look and feel description associated with a host website, storing the captured look and feel description in the data store, providing the host website with a link that link correlates the host website with a commerce object for inclusion within a page on the host website and which, when activated, causes the processor to serve an e-commerce supported page via the communication link with *a look and feel corresponding to the captured look and feel description of the host website* associated with the provided link and with content based on the commerce object associated with the provided link.

Ex. 1001, 4:52–63 (emphasis added). Thus, in the context of the disclosure, “an overall appearance of the composite page that . . . visually corresponds to the source web page” means the composite web page has the look and feel of the source web page.

Furthermore, we disagree with Patent Owner that the Federal Circuit determined the language of this claim limitation cures the shortcoming of the claims of the ’572 patent by requiring an overall match between the web pages. In *DDR Holdings*, the Federal Circuit considered the parties’ stipulated construction for the term “look and feel” in the claims of the ’572 patent. The parties stipulated the construction of “look and feel” means

“[a] set of elements related to visual appearance and user interface *conveying an overall appearance* identifying a website; such elements include logos, colors, page layout, navigation systems, frames, ‘mouse-over’ effects, or other[] elements consistent through some or all of the website.” *DDR Holdings*, 773 F.3d at 1250–51 (emphasis added). In overturning the jury’s finding that Digital River’s systems do not anticipate the claims of the ’572 patent, the court determined the district court improperly introduced an “overall match” requirement into the claims. *Id.* at 1254. Specifically, the court held

[t]here is nothing, however, in *the parties’ stipulated construction of “look and feel,”* the claim language, or the specification that requires the generated composite web page to match the host website or to incorporate a specific number, proportion, or selection of the identified “look and feel” elements on a host website.

Id. (emphasis added).

This limitation of the ’228 patent is similar to the stipulated construction of “look and feel.” See PO Resp. 8 n.3 (explaining the claim language is derived from the stipulated construction of “look and feel” (citation omitted)). In particular, both refer to “overall appearance.” Given the court explicitly opined that the stipulated construction of “look and feel” does not require an overall match, this corresponding limitation of the ’228 patent does not make up for the lack of an overall match, but instead similarly does not require an overall match.

C. Anticipation by Loshin

Petitioner challenges claims 1, 3–5, 7–9, 11–13, 15, and 16 of the ’228 patent under 35 U.S.C. § 102(b) as anticipated by Loshin. Pet. 11–37;

Reply 2–21. In contrast, Patent Owner argues Loshin does not disclose every limitation of the claims. PO Resp. 12–30; Sur-reply 8–18. We begin our analysis with a brief summary of Loshin, and then address the parties’ contentions.

1. Loshin (Ex. 1013)

Loshin describes First Virtual’s InfoHaus service, which is a hosting service that enables sellers to sell their information products without having to own their own Internet servers. Ex. 1013, 103, 105, 214. More specifically, “InfoHaus is a Web server that customers can browse through, and that merchants can load with their store information and information products over the Internet.” *Id.* at 216.

Figure 7-1, reproduced below, shows a typical offering on InfoHaus.

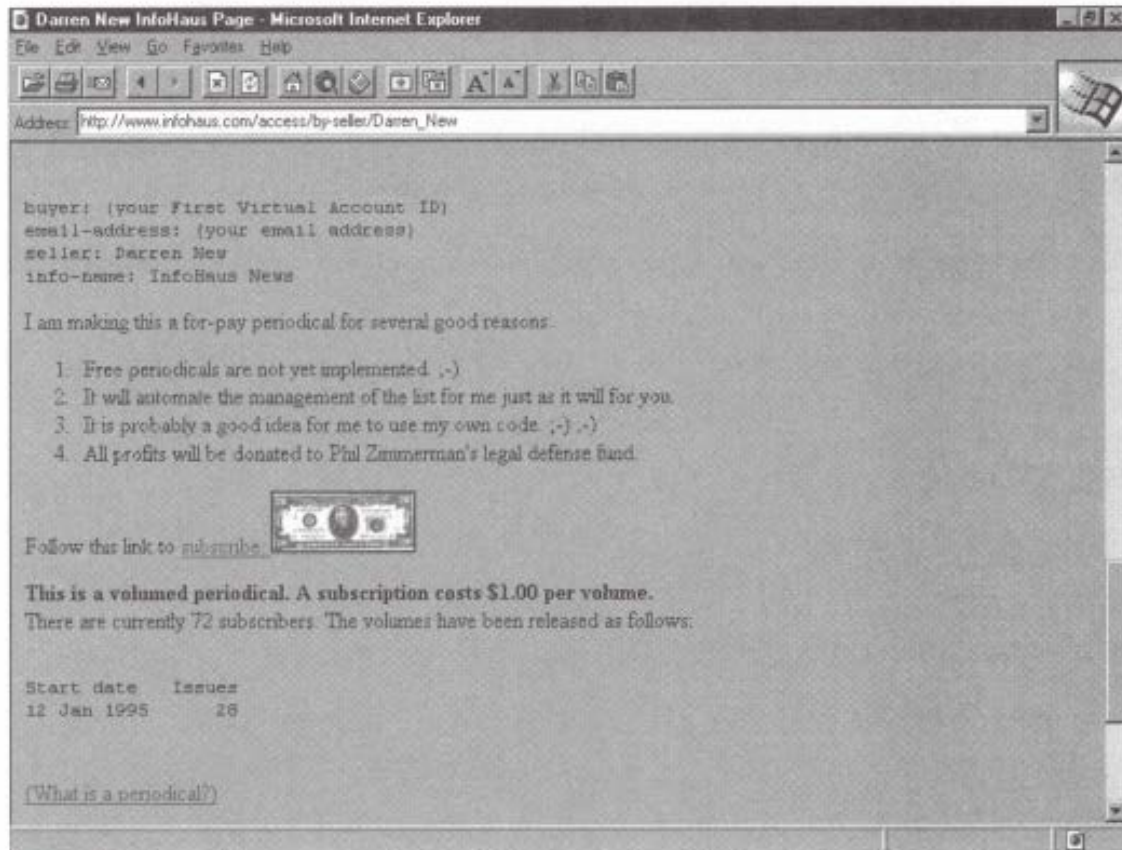


FIGURE 7-1 *This offering on the InfoHaus is for the InfoHaus News e-mail list. Reprinted with permission from First Virtual Holdings Incorporated, 1996.*

Figure 7-1 shows the InfoHaus News e-mailing list. Ex. 1024.⁵ According to Loshin:

Nothing can happen until a merchant sets up an Internet storefront for consumers to browse and buy from. This page includes a description of the product as well as the product's price. There is also a link from the offering screen to a transaction page with forms for the consumer to fill in with required information.

⁵ As Exhibit 1024, Petitioner submits higher quality scans of the figures of Loshin included in the Petition.

Ex. 1013, 195. Once a consumer decides to purchase a product, the consumer needs to follow the link associated with the image of the \$20 bill shown on the InfoHaus web page depicted in Figure 7-1. *Id.* Following the link results in an order page shown in Figure 7-2, reproduced below.

The screenshot shows a Microsoft Internet Explorer window titled "Subscription form - Microsoft Internet Explorer". The address bar displays "http://www.infohaus.com/access/subscription/Darren_New/InfoHaus_News". The main content area has the heading "Subscription to Darren_New/InfoHaus_News" and instructs the user to use the form to provide information for a subscription. It states: "This is a volumed periodical. A subscription costs \$1.00 per volume. There are currently 72 subscribers. The volumes have been released as follows:" followed by a table:

Start date	Issues
12 Jan 1995	28

Below the table, it says: "To buy a subscription, you must fill in the following fields." The form includes two input fields: "First Virtual Account ID to be billed" with the value "try-itzy bitsy spider" and "Email address to receive issues" with the value "pete@koshin.com". A note below the email field says "(Not necessarily your own. Makes for fun gifts!)". At the bottom of the form is a "Select" dropdown menu set to "BUY" and a "to purchase!" button. A footer note says: "If your browser does not support forms, please compose an electronic mail message as follows:" followed by a "To:" field with the address "subscribers@infohaus.com".

FIGURE *Paying for a product using First Virtual's payment system.*
7-2 *Reprinted with permission from First Virtual Holdings Incorporated, 1996.*

Figure 7-2 shows an order page. Ex. 1024. On the order page, a consumer enters a First Virtual Account ID (VirtualPIN) and an e-mail address for delivery of the subscription and then clicks on the "BUY" button. Ex. 1013, 195. The merchant then can submit the transaction to First Virtual for completion. *Id.*

2. Discussion

a. Independent claim 1

In asserting that Loshin anticipates independent claim 1, Petitioner identifies specific portions of Loshin that allegedly disclose each limitation of the claim. Pet. 14–28. Beginning with the preamble, independent claim 1 recites “[a] method of serving informational pages offering commercial opportunities, the method comprising, with a computer system serving displayable information of an outsource provider.” Ex. 1001, 27:22–25. Petitioner contends Loshin discloses an outsource provider, First Virtual, serving web pages offering commercial opportunities via its InfoHaus service, which allows sellers to sell their information products without having to own their own Internet servers. Pet. 14–15 (citing Ex. 1013, 103, 126–27, 207; Ex. 1002 ¶ 83).

Independent claim 1 recites the step of

upon receiving over the Internet an electronic request generated by an Internet-accessible computing device of a visitor in response to selection of a uniform resource locator (URL) within a source web page that has been served to the visitor computing device when visiting a host website controlled by a third party to the owner of the computer system.

Ex. 1001, 27:26–32. Petitioner argues Loshin discloses a sample purchase conducted via InfoHaus, whereby a buyer activates a link on a host web page, namely the Darren New InfoHaus Page shown in Figure 7-1. Pet. 15 (citing Ex. 1013, 194–96, Fig. 7-1; Ex. 1002 ¶ 85). Petitioner also asserts Loshin teaches that the host, Darren New, is a third party to the outsource provider, First Virtual. *Id.* at 16 (citing Ex. 1013, 103, 126–27; Ex. 1002 ¶ 86). Independent claim 1 further recites “wherein the URL correlates the source web page with at least one commerce object associated with a buying

opportunity of a merchant that is a third party to the owner of the computer system.” Ex. 1001, 27:32–35. According to Petitioner, Loshin discloses the URL, http://www.infohaus.com/access/subscription/Darren_New/Infohaus_News, which correlates the source web page, http://www.infohaus.com/access/subscription/Darren_New, with a commerce object, subscription to Darren_New/InfoHaus_News. Pet. 16–17 (citing Ex. 1013, 195–96, Figs. 7-1, 7-2; Ex. 1002 ¶ 88). Petitioner again asserts that Loshin teaches Darren New, the host and merchant, is a third party to the outsource provider, First Virtual. *Id.* at 17 (citing Ex. 1013, 103, 126–27; Ex. 1002 ¶ 88).

Independent claim 1 also recites the step of

automatically serving to the visitor computing device a dynamically generated composite page containing instructions directing the visitor computing device to display:

- (i) information associated with the commerce object associated with the URL that has been activated, which commerce object includes at least one product available for sale through the computer system after activating the URL.

Ex. 1001, 27:36–44. According to Petitioner, Loshin discloses that once the link on the host’s web page is activated, the order page shown in Figure 7-2 is automatically loaded. Pet. 17–18 (citing Ex. 1013, 195–96, Figs. 7-1, 7-2; Ex. 1002 ¶¶ 89, 91). Petitioner argues the page contains instructions directing a buyer’s computer to display information relating to the commerce object, namely the price, start date, and number of issues. *Id.* at 17–19 (citing Ex. 1013, 195–96, 227–32, Fig. 7-2; Ex. 1002 ¶¶ 89, 91).

In addition to information associated with the commerce object associated with the activated URL, independent claim 1 further recites that the instructions directed to the visitor computing device to display

- (ii) a plurality of visually perceptible elements visually corresponding to the source web page,
wherein the visually perceptible elements comprise any of the following applicable features: logos, colors, page layout, navigation systems, frames, and visually perceptible mouse-over effects,
wherein the plurality of visually perceptible elements define an overall appearance of the composite page that, excluding the information associated with the commerce object, visually corresponds to the source web page.

Ex. 1001, 27:45–55. Petitioner argues that Loshin discloses these limitations because the Darren New web pages shown in Figures 7-1, 7-2, and 7-3 have a similar appearance. Pet. 19, 21–27 (citing Ex. 1013, 194–96, Figs. 7-1, 7-2, 7-3; Ex. 1002 ¶¶ 92, 95–96, 99). Petitioner also asserts Loshin teaches these limitations because it discloses personalizing web pages for individual sellers to provide visual correspondence (*id.* at 19–20, 23, 27 (citing Ex. 1013, 196–98, 238–39, 252–53, Figs. 7-5, 9-2, 9-3; Ex. 1002 ¶¶ 93, 97, 100)), as well as using default pages which would visually correspond to each other (*id.* at 20, 23, 27 (citing Ex. 1013, 218–27, 228–39, Figs. 8–9; Ex. 1002 ¶¶ 94, 98, 101)).

Lastly, independent claim 1 recites “wherein the instructions direct the visitor computing device to download data defining the visually perceptible elements from an information storage that is accessible to the visitor computing device through the Internet.” Ex. 1001, 27:56–60. Petitioner argues that Loshin teaches serving web pages that include retrieved data that visually corresponds to the source web page. Pet. 28 (citing Ex. 1013,

249–51; Ex. 1002 ¶ 102). More specifically, Petitioner asserts Loshin’s web pages contain HTML, which describes the visual appearance of the pages and provides for the display of trademarks and images related to the company controlling the web page. *Id.* (citing Ex. 1013, 198, 238–39, 252–53; Ex. 1002 ¶ 102).

Patent Owner argues Loshin does not anticipate independent claim 1 because it does not disclose a source web page served while visiting a host website controlled by a third party to the owner of the computer system. PO Resp. 12–16; Sur-reply 14–16. Patent Owner also argues Loshin does not teach a visual correspondence of overall appearance between the composite web page and the source web page. PO Resp. 16–24; Sur-reply 8–13.

- i. *“a source web page that has been served to the visitor computing device when visiting a host website controlled by a third party to the owner of the computer system”*

Patent Owner asserts Petitioner has not demonstrated the Darren New storefront web page shown in Figure 7-1 is served when visiting a host website controlled by a third party to the outsource provider, i.e., owner of the computer system, as this claim limitation requires because the web page shown in Figure 7-1 and the web page shown in Figure 7-2 are located on the same server, namely First Virtual’s server for the infohaus.com domain. PO Resp. 13 (citing Ex. 2025 ¶ 53). Patent Owner further asserts “[n]o embodiment in Loshin teaches the two sites being on different servers.” *Id.* at 16 (citing Ex. 2025 ¶ 54; Ex. 2027, 208:5–10).

In reply, Petitioner contends the limitation at issue does not require two different servers. Tr. 69:18–20 (“[T]here is nothing in the claim language of the asserted patents that requires separate servers to be the first website and the second website.”). We agree with Petitioner to the extent

independent claim 1 does not explicitly recite a server for the source web page that is different from a server for the composite page. The claim simply requires a source web page that has been served when visiting a host website controlled by a third party to the owner of the computer system that generates the composite page. Nonetheless, a teaching of web pages served from different servers suggests a web page that has been served while a visiting a website of a third party to the party associated with the other page, whereas a teaching of web pages served from the same server suggests a web page that is served when visiting the website of the same party associated with the other web page.

Loshin's Figures 7-1 and 7-2 are part of Chapter 7, which describes the buying process with First Virtual's InfoHaus. Ex. 1013, 193. Figure 7-1 depicts a typical offering on the InfoHaus, namely a web page including a description of a seller's product including the product's price. *Id.* at 194–95. More specifically, Figure 7-1 shows a storefront web page for a seller, Darren New. *Id.* To purchase a product from the InfoHaus storefront web page, Loshin discloses: “[T]he consumer needs to follow the link associated with the image of the \$20 bill shown on the InfoHaus Web page The resulting order page is shown in Figure 7-2.” *Id.* at 195. Although the web page shown in Figure 7-1 is a storefront page for Darren New, who is a third party to First Virtual, the web address for the web page shows the domain as infohaus.com, which is the same domain as the order page shown in Figure 7-2, suggesting that both web pages are served by First Virtual and, in particular, that the web page shown in Figure 7-1 is served while visiting First Virtual's website. Ex. 1024. Moreover, Dr. Shamos acknowledges the Darren New storefront web page shown in Figure 7-1 is not served by

Darren New's server. Ex. 2027, 207:12–16 (“Q. So the page depicted at 7-1 is not one that is running on Darren New's own server; right? A. No, it's not running on Darren New's own server.”). Similarly, Petitioner acknowledges Loshin discloses a configuration where the outsource provider, First Virtual, hosts the source web page. Reply 3 (citing Ex. 1013, 214). For these reasons, Petitioner's reliance on Figures 7-1 and 7-2 does not establish persuasively that Loshin discloses a source page served while visiting a host website controlled by a third party to the owner of the computer system as this limitation requires.

Petitioner further contends Loshin discloses other configurations where the source web page is hosted by an entity other than the outsource provider. Reply 3–4 (citing Ex. 1013, 249; Ex. 2027, 205:19–209:5, 221:5–17). In particular, Petitioner asserts: “Patent Owner seeks to limit Loshin to Figs. 7-1 and 7-2. However, Loshin discloses using two different servers for serving different webpages such as those depicted in Figures 7-1 and 7-2. . . . Thus, Loshin teaches using two separate servers to implement the webpages identified in Figs. 7-1 and 7-2.” *Id.* at 4–5 (citing Ex. 1013, 194, 196, 248, 249).

Petitioner ostensibly relies on the web pages shown in Figure 7-1 and 7-2 in conjunction with Loshin's arrangement using different servers to serve different web pages. Anticipation, however, requires more than simply identifying each element of claim within the four corners of a reference. “Because the hallmark of anticipation is prior invention, the prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’” *Net*

MoneyIN, Inc. v. Verisign, Inc., 545 F.3d 1359, 1369 (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck & Co.*, 772 F.2d 1542, 1548 (Fed. Cir. 1983)); see also *Ecolochem, Inc. v. S. Cal. Edison Co.*, 227 F.3d 1361, 1369 (Fed. Cir. 2000) (reversing a finding of anticipation by a reference having a figure teaching one aspect of the claim and a separate passage discussing another because the reference does not contain a discussion linking the figure to the separate passage and therefore does not show the invention arranged as in the claim).

In contrast to Chapters 7 and 8, which describe using the InfoHaus web server to host a seller's storefront, Chapter 9 is directed to selling with a seller's own web server. Ex. 1013, 193, 213–14, 243. As explained in Chapter 9:

Determining when to move up to your own server from the InfoHaus depends entirely on your own situation. At one end of the spectrum is the individual with minimal computer experience, minimal computer equipment, and no employees, friends, relatives, or co-workers with Internet expertise. . . .

At the other end of the spectrum, you may already have access to an existing Internet server — for example, “rental” space on an Internet presence provider's system, or space available through some other type of affiliation. . . .

Id. at 244. Chapter 9 further discloses:

You may not want to go to all the trouble of building your Web site from scratch, but you may also want more options and control over your content than the InfoHaus can offer. . . .

Another alternative is to continue to use the InfoHaus to handle your transactions, but to use some other Web site to publish your products. . . .

Id. at 248–49.

Chapter 9 does disclose a selling arrangement using different servers to serve different web pages. Yet, the discussion of this arrangement does not reference the web pages shown in Figures 7-1 and 7-2, nor does the description of the figures reference this selling arrangement. Although Dr. Shamos testifies Loshin's teaching of this arrangement could be applied to its disclosure of the web pages shown in Figures 7-1 and 7-2, Dr. Shamos acknowledges Loshin does not disclose a link between the arrangement and the web pages of Figures 7-1 and 7-2. According to Dr. Shamos:

Q. The reference does not expressly disclose that 7-1 and 7-2 are on different servers; correct?

....

A. No, it doesn't. But they obviously could be. That's not true that the reference doesn't disclose it. It doesn't disclose it in the discussion of 7-1 and 7-2. It does disclose it on Page 244.

....

Q. It doesn't show that 7-1 and 7-2 are running on different servers; correct?

A. There's -- on Page 244, there's no reference to figure 7-1 and 7-2. But if you take the teaching of 244 and apply it to 7-1 and 7-2, you understand that they can be served by different servers.

Ex. 2027, 208:5–25.

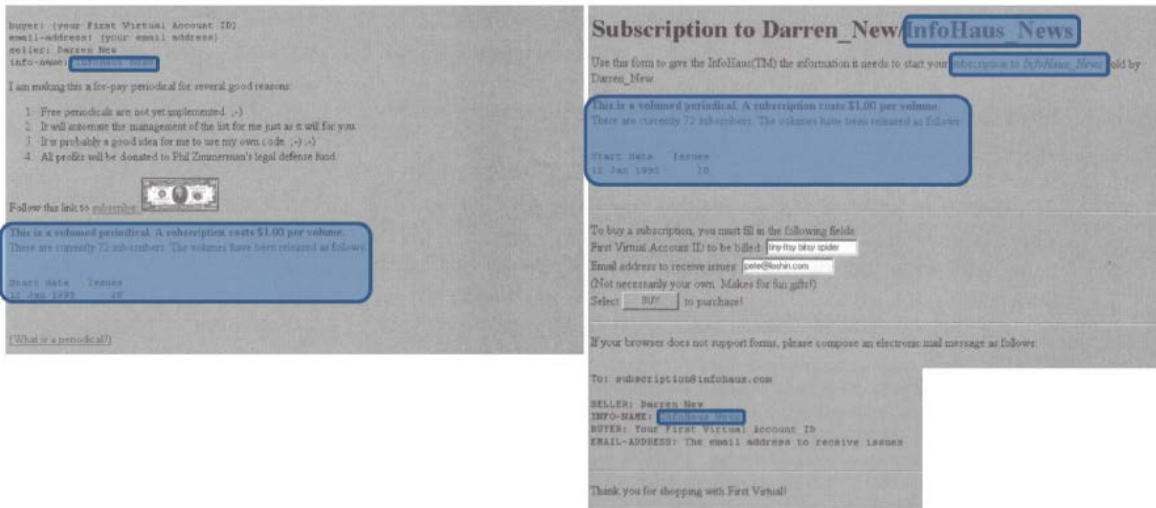
Absent a link between the web pages shown in Figures 7-1 and 7-2, which are both located at First Virtual's infohaus.com domain, and the discussion of a selling arrangement using different servers to serve different web pages, Petitioner has not shown these teachings disclose the recited source web page as arranged in the claim. Petitioner, therefore, has not demonstrated persuasively that Loshin discloses "a source web page that has been served to the visitor computing device when visiting a host website

controlled by a third party to the owner of the computer system” as recited in this limitation.

- ii. *“an overall appearance of the composite page that, excluding the information associated with the commerce object, visually corresponds to the source web page”*

As Patent Owner correctly asserts, Petitioner does not cite to any explicit teaching in Loshin regarding web pages having corresponding appearances. PO Resp. 16; *see also* Ex. 2027, 215:16–20 (Dr. Shamos testifying “I don’t think I’ve pointed to a place in Loshin where he says it would be a good idea for you to make your pages look the same. I don’t think that -- I don’t recall that being in Loshin.”). Rather, Petitioner relies on similarities between the web pages shown in Loshin’s Figures 7-1 and 7-2, namely the seller’s name, font, and background color. Pet. 24–27; Reply 11–18. Petitioner further relies on Loshin’s teaching of modifying the web pages to add images, such as trademarks from the seller, and Loshin’s disclosure of setting up a storefront with default pages. Pet. 27; Reply 11.

Patent Owner argues Petitioner has not shown the required visual correspondence because the elements on which Petitioner relies are commerce object information, which, according to independent claim 1, are excluded from the visual correspondence relating to overall appearance. PO Resp. 17, 19–21; Sur-reply 9–11. To support this argument, Patent Owner annotated Loshin’s Figures 7-1, 7-2, and 7-3 to identify the commerce object information, and we reproduce Patent Owner’s annotated versions of these figures below.



Patent Owner annotated Loshin's Figures 7-1, 7-2, and 7-3 to show commerce object information in blue. Sur-reply 10. According to Patent Owner, the information shown in blue cannot be relied upon to establish the recited visual correspondence. *Id.*

Patent Owner, however, acknowledges the presentation of commerce object information is not excluded from the recited visual correspondence. Tr. 45:4–11 (“JUDGE BOUCHER: . . . Wouldn't for example if someone were using a very identifiable and stylistic font to express all of the commerce object information, wouldn't that contribute to a sense of overall visual appearance? MR. HOFFMAN: Yes, I absolutely agree.”). To the extent Petitioner is relying on commerce object information, Petitioner is relying on its presentation, not its content. We, therefore, disagree with Patent Owner that the elements on which Petitioner relies are commerce object information that is excluded from visual correspondence relating to overall appearance.

Patent Owner also argues identifying Darren New as the seller on the web pages shown in Loshin's Figures 7-1 and 7-2 does not contribute to a visual correspondence relating to overall appearance. PO Resp. 22;

Sur-reply 13 (citing PO Resp. 10–12). According to Patent Owner, the Specification and file history of the '228 patent explain that a name is insufficient to establish visual correspondence relating to overall appearance. PO Resp. 10. Patent Owner further asserts the seller's name is presented differently on the web pages. *Id.* at 22–23. For example, the third line of the web page in Figure 7-1 displays the name in Courier font, whereas the web page in Figure 7-2 displays the name in a larger, Roman font. *Id.*

Patent Owner's argument has merit. The Specification does not specifically identify a seller's name as a look and feel element. Ex. 1001, 13:51–54 (“‘Look and feel elements’ include logos, colors, page layout, navigation systems, frames, ‘mouse-over’ effects, or other elements that are consistent through some or all of a Host’s website.”). That notwithstanding, we agree with Patent Owner that the seller's name is presented differently on both web pages, which undercuts any visual correspondence relating to overall appearance between the web pages.

We also agree with Patent Owner that Petitioner has not demonstrated the fonts on the web pages shown in Figures 7-1 and 7-2 contribute to visual correspondence between the web pages. PO Resp. 22; Sur-reply 12. Petitioner annotated Figures 7-1 and 7-2 to identify fonts that are allegedly similar in style and color, and we reproduce Petitioner's annotated figures below.

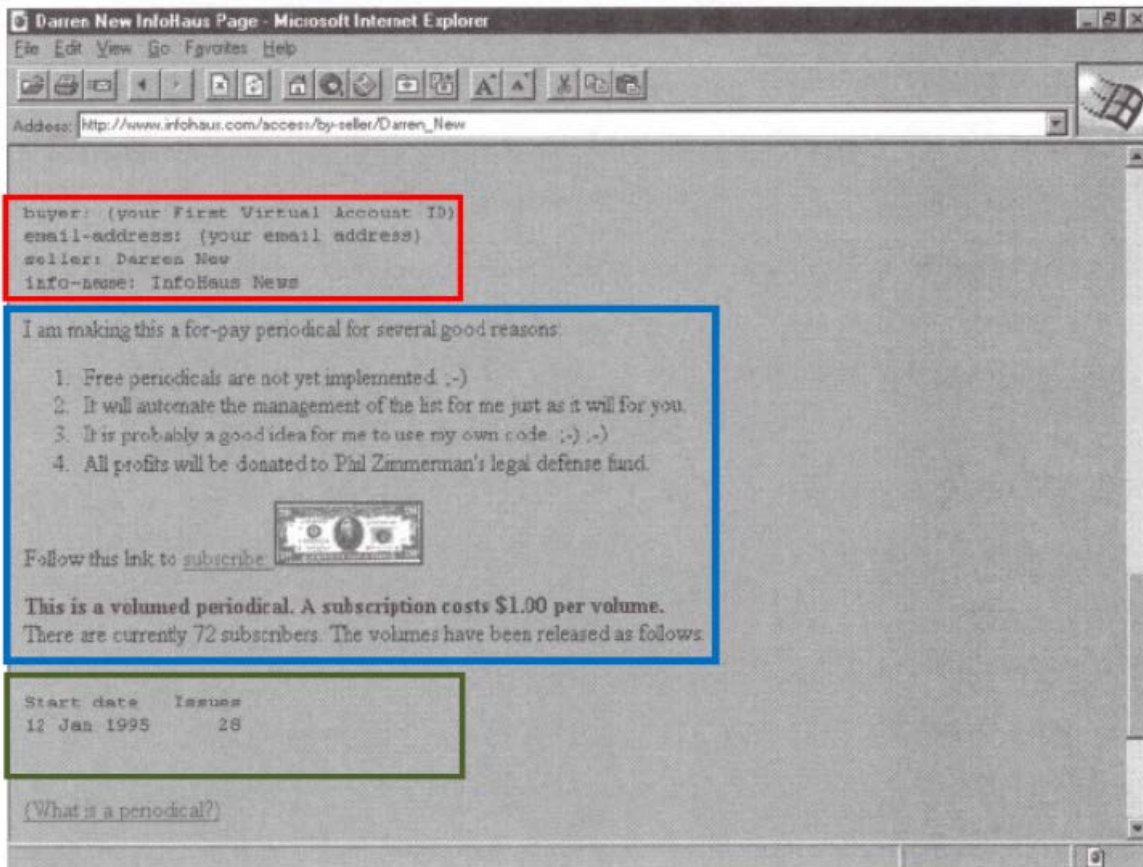


FIGURE 7-1 This offering on the InfoHaus is for the InfoHaus News e-mail list. Reprinted with permission from First Virtual Holdings Incorporated, 1996.

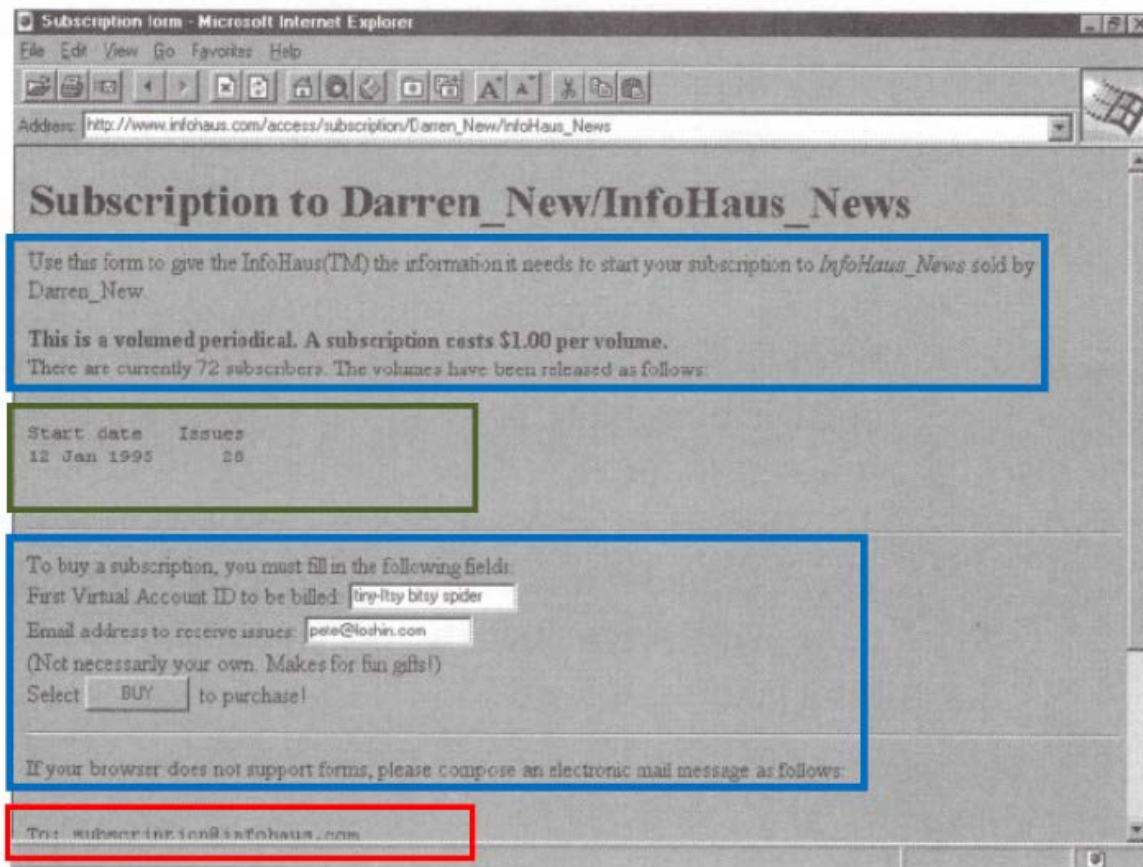


FIGURE 7-2 *Paying for a product using First Virtual's payment system. Reprinted with permission from First Virtual Holdings Incorporated, 1996.*

Petitioner annotated Loshin's Figures 7-1 and 7-2 to show e-mail purchase instructions in red boxes, body text in blue boxes, and commerce object information in green boxes. Reply 12, 14–15. According to Petitioner, the texts in the red boxes are the same font type and color, and the texts in the blue boxes are the same font type and color. *Id.* at 13.

At the outset, it is unclear whether the text in one box is the same color as the text in the correspondingly colored box. Petitioner provides color scans of the Loshin textbook, but Figures 7-1 and 7-2 appear to be grayscale images. See Tr. 29:4–17 (Petitioner explaining that Loshin is a colored book). Furthermore, although texts in the corresponding boxes

appear to have the same font type, the texts of the same font type are arranged differently on the web pages, as shown by Petitioner's colored boxes. For example, in Figure 7-1, text of the font type in the blue box is located in the center of the web page, below text of the font type in the red box, and above text of the font type in the green box, whereas in Figure 7-2, the text of the font type in the blue box is in multiple locations on the web page, above text of the font type in the red box, and sandwiching text of the type in the green box. As a result, the web pages shown in Figures 7-1 and 7-2 simply appear to have different collections of font types. The different arrangements of text having fonts of the same type detract from any visual correspondence afforded by the font types being the same type.

For the same reason as the font color, Petitioner has not demonstrated persuasively that the web pages shown in Figures 7-1 and 7-2 have the same background color. Namely, it is unclear whether Figures 7-1 and 7-2 are color images, such that the depicted web pages have gray backgrounds with black text, or grayscale images.

With respect to Loshin's teaching of adding images, such as trademarks, to web pages, Patent Owner argues that the web pages shown in Figures 7-1 and 7-2 do not include similar images and that such a teaching amounts to speculation as to what could be done, not what Loshin expressly or inherently discloses. PO Resp. 21; Sur-reply 13 n.4. We agree with Patent Owner that Loshin's disclosure of adding images to web pages is speculative as to whether the web pages would include similar images.

Turning to Loshin's defaults, the cited portion discloses defaults for certain types of information, namely currency and language. Ex. 1013,

218–27. The cited portion of Loshin does not disclose default pages having similar appearances.

Additionally, Patent Owner contends there are many differences between the web pages shown in Figures 7-1 and 7-2. PO Resp. 23 (citing Ex. 2025 ¶ 52); Sur-reply 11. For instance, Dr. Keller testifies that the web page in Figure 7-1 includes a numbered list, fill-in fields, and a “buy button,” whereas the web page in Figure 7-2 includes none of these elements. Ex. 2025 ¶ 52. We agree.

In view of the foregoing, despite identifying some similarities between the web page shown in Loshin’s Figure 7-1 and the web page of Figure 7-2, Petitioner has not provided evidence that shows persuasively the web page shown in Figure 7-2 has the look and feel of the web page shown in Figure 7-1. Petitioner has not proven by a preponderance of the evidence that Loshin discloses the limitation of independent claim 1 reciting “an overall appearance of the composite page that, excluding the information associated with the commerce object, visually corresponds to the source web page.”

iii. Conclusion for independent claim 1

Petitioner has not shown persuasively that Loshin discloses “a source web page that has been served to the visitor computing device when visiting a host website controlled by a third party to the owner of the computer system,” as recited in independent claim 1. Petitioner also has not demonstrated persuasively the limitation of independent claim 1 reciting “an overall appearance of the composite page that, excluding the information associated with the commerce object, visually corresponds to the source web

page.” Consequently, Petitioner has not proven by a preponderance of the evidence that Loshin anticipates independent claim 1.

b. Claims 3–5, 7, and 8

Each of claims 3–5, 7, and 8 depends from independent claim 1. Ex. 1001, 27:65–28:19, 28:24–36. For the reasons discussed above with respect to independent claim 1, Petitioner has not proven by a preponderance of the evidence that Loshin anticipates claims 3–5, 7, and 8.

c. Independent claim 9 and claims 11–13, 15, and 16

Like independent claim 1, independent claim 9 recites “a source web page that has been served to the visitor computing device when visiting a host website controlled by a third party to the owner of the computer system” and “an overall appearance of the composite page that, excluding the information associated with the commerce object, visually corresponds to the source web page.” Ex. 1001, 28:44–47, 28:67–29:3. Each of claims 11–13, 15, and 16 depends from independent claim 9. *Id.* at 29:15–30:9, 30:14–25. For the same reasons as independent claim 1, Petitioner has not proven by a preponderance of the evidence that Loshin anticipates claims 9, 11–13, 15, and 16.

D. Obviousness based on Loshin and the InfoHaus Documents

Petitioner challenges claims 1, 3–5, 7–9, 11–13, 15, and 16 of the ’228 patent under 35 U.S.C. § 103(a) as unpatentable over Loshin and the InfoHaus Documents. Pet. 37–51; Reply 21–24. Petitioner asserts Loshin and the InfoHaus Documents disclose each limitation of these claims. Pet. 40–51; Reply 21–23. Petitioner also argues that it would have been obvious to a person of ordinary skill in the art to combine the teachings of

Loshin and the InfoHaus Documents because they describe a common system, InfoHaus. Pet. 39.

On the other hand, Patent Owner argues the combined teachings of Loshin and the InfoHaus Documents would not have resulted in every limitation of the claims because the InfoHaus Documents do not teach the limitations missing from Loshin. PO Resp. 48–49; Sur-reply 18–19. According to Patent Owner, “because the InfoHaus Documents refer to the same system as Loshin, the outcome should be the same.” PO Resp. 48.

We begin our analysis of this asserted ground of unpatentability with a brief summary of the InfoHaus Documents. We then turn to the parties’ contentions.

1. The InfoHaus Documents (Exs. 1014–1016)

The InfoHaus Documents are a collection of web pages from First Virtual’s website. Exs. 1014–1016. The InfoHaus Documents include a Seller Programs web page (Ex. 1014), an InfoHaus Guide web page (Ex. 1015), and the InfoHaus HelpMeister web page (Ex. 1016).

a. Seller Programs (Ex. 1014)

The Seller Programs web page teaches that First Virtual has designed two distinct seller programs, Pioneer Seller and Express Seller, to enable anyone to set up shop and become an entrepreneur on the Internet. Ex. 1014, 1. The Seller Programs web page also teaches that a seller can use the InfoHaus to set up a store. *Id.* (“See how easy it is to set up a store at The InfoHaus.”).

b. InfoHaus Guide (Ex. 1015)

According to the InfoHaus Guide, “[t]he InfoHaus is First Virtual’s on-line mall for informational products, where *anyone* can open an on-line

store!” Ex. 1015, 1. The InfoHaus Guide “clearly explains how to become a Merchant on First Virtual’s InfoHaus” and includes the following five chapters: 1: Introduction; 2: Communicating with The InfoHaus; 3: Opening Your Shop on The InfoHaus; 4: Adding and Removing Products; and 5: Adding HTML Formatting to Your Shop. *Id.* According to the InfoHaus Guide, once a user sets up a shop, the InfoHaus will automatically generate the user’s web page, create a storage area for the user’s products, and list the user’s store in the InfoHaus directories for buyers to see it. *Id.* at 11.

c. The InfoHaus HelpMeister (Ex. 1016)

The InfoHaus HelpMeister “covers advanced topics for expanding your shop’s design and capabilities.” Ex. 1016, 1. According to the InfoHaus HelpMeister, “[t]he InfoHaus automatically generates storefront pages,” but “[y]ou may override these with your HTML documents, creating a totally custom shop.” *Id.* at 5. The InfoHaus HelpMeister also teaches that “[y]ou can create sub-pages in your shop that organize your products by category.” *Id.* at 10.

2. Discussion

As set forth above, Petitioner has not shown persuasively that Loshin discloses “a source web page that has been served to the visitor computing device when visiting a host website controlled by a third party to the owner of the computer system,” as recited in independent claims 1 and 9.

Petitioner, however, asserts the InfoHaus Documents provide additional disclosure that teaches this limitation. Pet. 41. In particular, Petitioner contends that “[t]he InfoHaus Documents teach that InfoHaus generates Web pages (HTML) automatically for users” (*id.* (citing Ex. 1016, 5; Ex. 1002 ¶ 129)), and that “a [person of ordinary skill in the art] would have

understood that when a URL is activated, a GET request is generated and sent to the corresponding web server” (*id.* (citing Ex. 1015, 4, Ex. 1002 ¶ 129)). These contentions, however, do not explain how a source web page has been served when visiting a host website controlled by a third party to the owner of the computer system, as the claim limitation requires.

Moreover, the InfoHaus Documents expressly teach that the InfoHaus, i.e., the owner of the computer system, will automatically generate the web page for a user’s store, i.e., the source web page. Ex. 1015, 11.

In view of the foregoing, Petitioner has not shown persuasively that the combined teachings of Loshin and the InfoHaus documents would have resulted in “a source web page that has been served to the visitor computing device when visiting a host website controlled by a third party to the owner of the computer system,” as recited in independent claims 1 and 9.

Consequently, Petitioner has not proven by a preponderance of the evidence that the combined teachings of Loshin and the InfoHaus documents render obvious the subject matter of independent claims 1 and 9. Each of claims 3–5, 7, 8, 11–13, 15, and 16 depends from independent claim 1 or 9. Ex. 1001, 27:65–28:19, 28:24–36, 29:15–30:9, 30:14–25. For the same reasons as independent claims 1 and 9, Petitioner has not proven by a preponderance of the evidence that Loshin and the InfoHaus documents render obvious the subject matter of claims 3–5, 7, 8, 11–13, 15, and 16.

E. Obviousness based on Loshin and Moore

Petitioner challenges claims 1, 3–5, 7–9, 11–13, 15, and 16 of the ’228 patent under 35 U.S.C. § 103(a) as unpatentable over Loshin and Moore. Pet. 52–72; Reply 24–32. Patent Owner argues Petitioner has not

demonstrated sufficiently that the combined teachings of Loshin and Moore render obvious the claimed subject matter. PO Resp. 30–47; Sur-reply 19–25. We begin our analysis with a brief summary of Moore, and then address the parties’ contentions.

1. *Moore (Ex. 1010)*

Moore relates to providing a scalable distributed Internet commerce system. Ex. 1010, 1:12–13. Figure 4 of Moore is reproduced below.

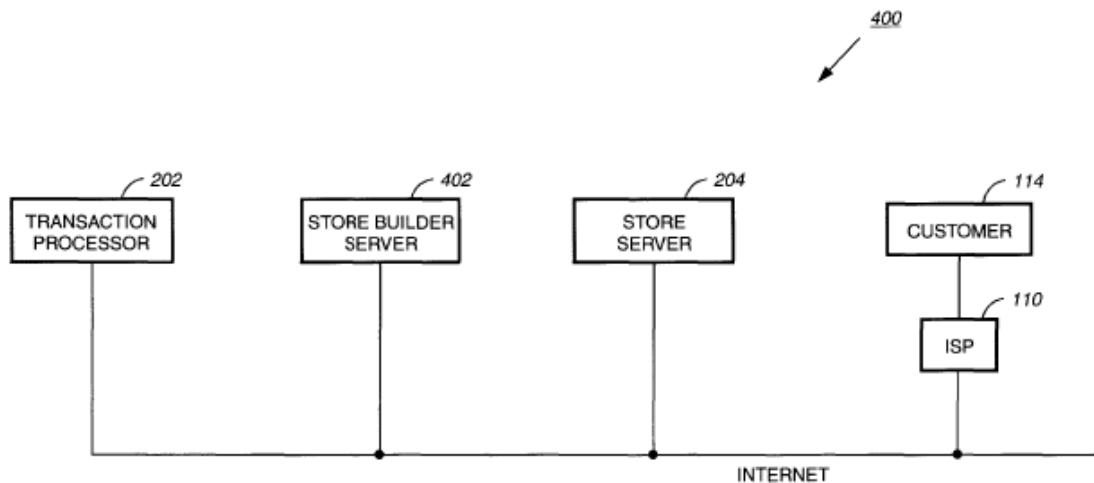


FIG. 4 PRIOR ART

Figure 4 is a functional block diagram of a distributed electronic commerce system for the World Wide Web (WWW). *Id.* at 3:57–58. Distributed electronic commerce system 400 includes customer 114, transaction server 202 having transaction processor 102, and store server 204 having Web storefront 106 and inventory and financial database 104. *Id.* at 4:48–51, Fig. 4. Distributed electronic commerce system 400 further includes store builder server 402 that builds and publishes storefront web pages. *Id.* at 5:55–63.

Figure 5, which includes Figures 5A and 5B, depicts the shopping process using distributed electronic commerce system 400, and is reproduced below.

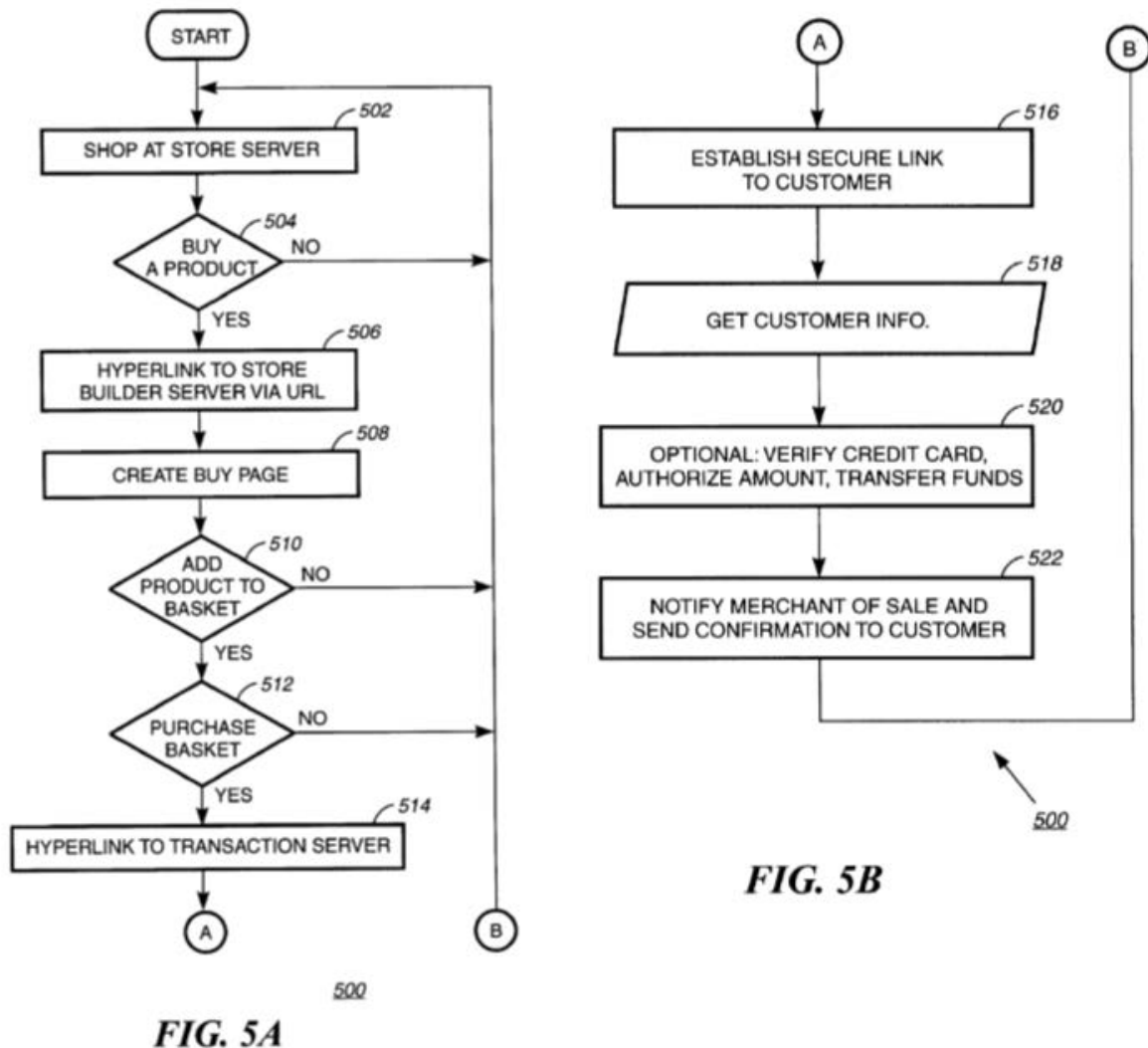


Figure 5 is a flow diagram of the functions that are performed in a typical shopping experience by a WWW customer using distributed electronic commerce system 400. *Id.* at 3:60–63. At step 502, a customer, using a browser, goes to the store server and browses the content of the Web storefront. *Id.* at 6:12–14, Fig. 5A. After the customer selects a product to buy in step 504, the store server jumps to the store builder server via a price

URL in step 506. *Id.* at 6:14–18, Fig. 5A. The price URL contains all the relevant information for the selected product and all of the information necessary to build a Buy Page. *Id.* at 6:18–20. At step 508, the store builder server receives the price URL and builds a Buy Page from the received HTML. *Id.* at 6:23–25, Fig. 5A. At step 510, with the Buy Page, the customer can either accept the buy operation by selecting the option that puts the product in the customer's shopping basket or cancel the buy. *Id.* at 6:25–27, Fig. 5A. If the customer accepts the buy operation, the store builder server presents the customer with the entire shopping basket so that the customer can edit the contents of the shopping basket, as shown at step 512. *Id.* at 6:29–35, Fig. 5A. If the customer decides to purchase an item in the shopping basket, the customer leaves the shopping basket page and at step 514, is hyperlinked to the transaction server, which processes payment for the purchase in steps 516–522. *Id.* at 6:44–7:21, Figs. 5A, 5B.

Although Figure 5 utilizes a store builder server, Moore discloses that the transaction server can perform the functions of the store builder server. *Id.* at 7:16–17. In such an embodiment, the price URL would hyperlink to the transaction server which builds the Buy Page and maintains the shopping basket. *Id.* at 7:17–21.

Moore also discloses an object-oriented and template-driven Development Tool for designing Web storefront 106. *Id.* at 5:30–32, 10:44–47. The Development Tool breaks the design process into four steps: (1) selecting a Web site category, i.e., industry such as automotive, dining, or education; (2) collecting information for the page header and footer; (3) choosing defaults for the background color or image and for the page style; and (4) filling in the content of each page. *Id.* at 10:47–11:50,

Figs. 6–13. Moore further discloses a Buy Page can be customized. *Id.* at 12:12–28, Figs. 15–16.

2. Discussion

a. Independent claim 1

In addition to Loshin, Petitioner argues Moore discloses every limitation of independent claim 1. Pet. 55–67. The preamble of independent claim 1 recites “[a] method of serving informational pages offering commercial opportunities, the method comprising, with a computer system serving displayable information of an outsource provider.” Ex. 1001, 27:22–25. Petitioner contends Moore discloses a distributed ecommerce system (Pet. 55 (citing Ex. 1010, Abs.; Ex. 1002 ¶ 159)) having a merchant maintaining a Web storefront and a transaction service provider handling the processing of purchases from the merchant’s storefront (*id.* (citing Ex. 1010, 4:43–56; Ex. 1002 ¶ 160)).

Independent claim 1 recites the step of

upon receiving over the Internet an electronic request generated by an Internet-accessible computing device of a visitor in response to selection of a uniform resource locator (URL) within a source web page that has been served to the visitor computing device when visiting a host website controlled by a third party to the owner of the computer system.

Ex. 1001, 27:26–32. Petitioner argues Moore discloses creating a link to a second server such that the link can be embedded into a web page of a merchant’s webstore. Pet. 56 (citing Ex. 1010, 3:31–39, 6:12–22; Ex. 1002 ¶ 162). Petitioner also argues Moore teaches that when a customer selects a product, the store server jumps to the store builder server by using a URL, as shown in step 506 of Figure 5A. *Id.* at 56–57 (citing Ex. 1010, 6:12–22, Fig. 5A; Ex. 1002 ¶ 162). Petitioner further asserts that Moore discloses an

embodiment where the transaction server performs the functions of the store builder server, and that, in this embodiment, the transaction server receives the URL. *Id.* at 57 (citing Ex. 1010, 8:10–26; Ex. 1002 ¶ 163).

Independent claim 1 further recites “wherein the URL correlates the source web page with at least one commerce object associated with a buying opportunity of a merchant that is a third party to the owner of the computer system.” Ex. 1001, 27:32–35. For this limitation, Petitioner again relies on Moore’s teaching that once a customer selects a product, the store server jumps to the store builder server by using a price URL, as shown in step 506 of Figure 5A. Pet. 58 (citing Ex. 1010, 6:12–22, Fig. 5A; Ex. 1002 ¶ 165). Petitioner also argues Moore discloses that when the price URL is sent, the location of the store server is known to allow the transaction server or the store builder server to hyperlink the customer back to the store server to continue shopping. *Id.* at 58–59 (citing Ex. 1010, 5:49–67, 8:10–26, 9:49–61; Ex. 1002 ¶ 165). According to Petitioner, a person of ordinary skill would have understood that Moore teaches that a server, i.e., the transaction server or the store builder server, of an outsource provider uses URLs to recognize source web pages, i.e., web pages of the web storefront. *Id.* at 59 (citing Ex. 1002 ¶ 165).

Independent claim 1 also recites the step of

automatically serving to the visitor computing device a
dynamically generated composite page containing
instructions directing the visitor computing device to
display:

- (i) information associated with the commerce object associated with the URL that has been activated, which commerce object includes at least one product available for sale through the computer system after activating the URL.

Ex. 1001, 27:36–44. Petitioner argues that Moore discloses two methods for automatically generating and transmitting, by a server, a second web page, i.e., the Buy Page, to a customer's web browser, namely either the store builder server or the transaction server receives the price URL and builds the Buy Page. Pet. 60–61 (citing Ex. 1010, 6:7–7:21, 12:1–24; Ex. 1002 ¶¶ 168, 171). Petitioner also contends the Buy Page includes information associated with a commerce object, i.e., the product, associated with the link, i.e., the price URL, that has been activated, as shown in Figure 16. *Id.* at 60–62 (citing Ex. 1010, 12:25–32, Fig. 16; Ex. 1002 ¶¶ 169, 172).

In addition to information associated with the commerce object associated with the activated URL, independent claim 1 further recites that the instructions directed to the visitor computing device to display

- (ii) a plurality of visually perceptible elements visually corresponding to the source web page, wherein the visually perceptible elements comprise any of the following applicable features: logos, colors, page layout, navigation systems, frames, and visually perceptible mouse-over effects, wherein the plurality of visually perceptible elements define an overall appearance of the composite page that, excluding the information associated with the commerce object, visually corresponds to the source web page; and wherein the instructions direct the visitor computing device to download data defining the visually perceptible elements from an information storage that is accessible to the visitor computing device through the Internet.

Ex. 1001, 27:45–60. Petitioner argues that Moore discloses these limitations because it teaches a design tool that allows merchants to design web pages for the web storefronts and Buy Pages. Pet. 63–66 (citing Ex. 1010, 7:48–60, 12:23–24, Fig. 15; Ex. 1002 ¶¶ 175, 177, 180, 183). According to Petitioner, Moore discloses that during the design process, header and footer

information is collected for use on every page. *Id.* (citing Ex. 1010, 10:43–11:67, Fig. 7; Ex. 1002 ¶¶ 175, 177, 180, 183).

Petitioner also argues it would have been obvious to a person of ordinary skill in the art to combine the teachings of Loshin and Moore. Pet. 54. According to Petitioner, Moore and Loshin disclose outsource providers providing the same functions: serving web pages facilitating sales transactions, customizing web pages that facilitate transactions to have the appearance of the referring pages, and processing sales transactions. *Id.* (citing Ex. 1002 ¶ 156). Petitioner asserts that “[i]n view of these conceptual teachings, a [person of ordinary skill in the art] would have found it advantageous to implement certain aspects of *Moore* as described by *Loshin*.” *Id.* (citing Ex. 1002 ¶ 157).

As set forth above, Petitioner has not shown persuasively that Loshin discloses “a source web page that has been served to the visitor computing device when visiting a host website controlled by a third party to the owner of the computer system” and “an overall appearance of the composite page that, excluding the information associated with the commerce object, visually corresponds to the source web page,” as recited in independent claim 1. We therefore consider whether the combined teachings of Loshin and Moore would have resulted in these limitations.

- i. “*a source web page that has been served to the visitor computing device when visiting a host website controlled by a third party to the owner of the computer system*”

Patent Owner does not refute Petitioner’s contention that Moore teaches this claim limitation. Indeed, Moore discloses a storefront page hosted by one server, and a Buy Page served by another server. More specifically, Moore teaches a distributed electronic commerce system using

a plurality of servers, including a transaction server, store server, and store builder server. Ex. 1010, 3:57–59, Fig. 4. The store server hosts a merchant’s storefront, which includes a price URL containing all the information necessary to build a Buy Page. *Id.* at 4:49–51, 6:12–20. When the price URL is selected, another server, namely the store builder server or the transaction server, receives the information from the price URL and builds the Buy Page via Java servlet. *Id.* at 6:23–25, 8:10–26.

Accordingly, Petitioner has demonstrated persuasively that Moore teaches this claim limitation, thereby curing the deficiency of Petitioner’s reliance on Loshin for disclosing this claim limitation. Petitioner has shown by a preponderance of the evidence that combined teachings of Loshin and Moore would have resulted in this limitation.

ii. *“an overall appearance of the composite page that, excluding the information associated with the commerce object, visually corresponds to the source web page”*

Patent Owner argues Moore does not teach this limitation because Moore does not teach applying common style elements to a storefront page, i.e., the source web page, and a Buy Page, i.e., the composite web page. PO Resp. 33–42; Sur-reply 20–24. According to Patent Owner, Moore’s Development Tool allows merchants to design their own web pages with headers, footers, logos, and page styles. PO Resp. 33. Patent Owner acknowledges Moore teaches the Development Tool can create a template that applies the merchant’s design to different pages, but argues this teaching regards only the merchant’s storefront pages, not the Buy Pages. *Id.* at 33–42 (citing Ex. 2025 ¶¶ 28–34, 36–39, 42, 45, 46); Sur-reply 19–24 (citations omitted).

In reply, Petitioner argues Moore teaches incorporating look and feel elements, namely headers, footers, logos, and page styles, across all web pages. Reply 24 (citing Ex. 1010, 11:5–7). Petitioner further asserts that Moore’s Development Tool uses Java class files to define common look and feel elements and that Java servlets generate both storefront and Buy Pages. *Id.* at 24–25 (citing Ex. 1010, 5:55–59, 6:23–25, 12:56–58, 14:1–4). Petitioner also argues Moore’s discussion of using the Development Tool to build web pages in the section entitled “b. Building a Page” (“section b”) applies to all web pages, including storefront web pages and Buy Pages. Tr. 13:15–21.

Section b teaches how the Development Tool builds web pages using a template including a merchant’s design elements. Ex. 1010, 10:43–11:67. More specifically, Moore teaches that the Development Tool creates a default header, footer, background color or image, and page style, and that the default conditions constitute a template. *Id.* at 11:4–36. The following section entitled “c. Interfacing with a Distributed Electronic Commerce System” (“section c”) teaches how a merchant builds the price URL, which includes the information for generating a Buy Page. *Id.* at 12:1–32. In section c, Moore further teaches that a Buy Page is separately customizable from the storefront pages. Namely, Moore teaches:

The price URL has attached an encrypted message that contains a text description of the item for sale, including a picture, its costs, quantity of measure, the merchant’s ID, *several fields used to customize the Buy Page that is created from the attached data*, and a special signature from the Store Builder Server. . . . FIG. 15 shows the dialog page for the price URL.

The Store Builder Server is able to decrypt the price URL data and convert it into an HTML page (a Buy Page). A typical Buy Page is shown in FIG. 16.

Id. at 12:12–27 (emphasis added). We reproduce Moore’s Figures 15 and 16 below.

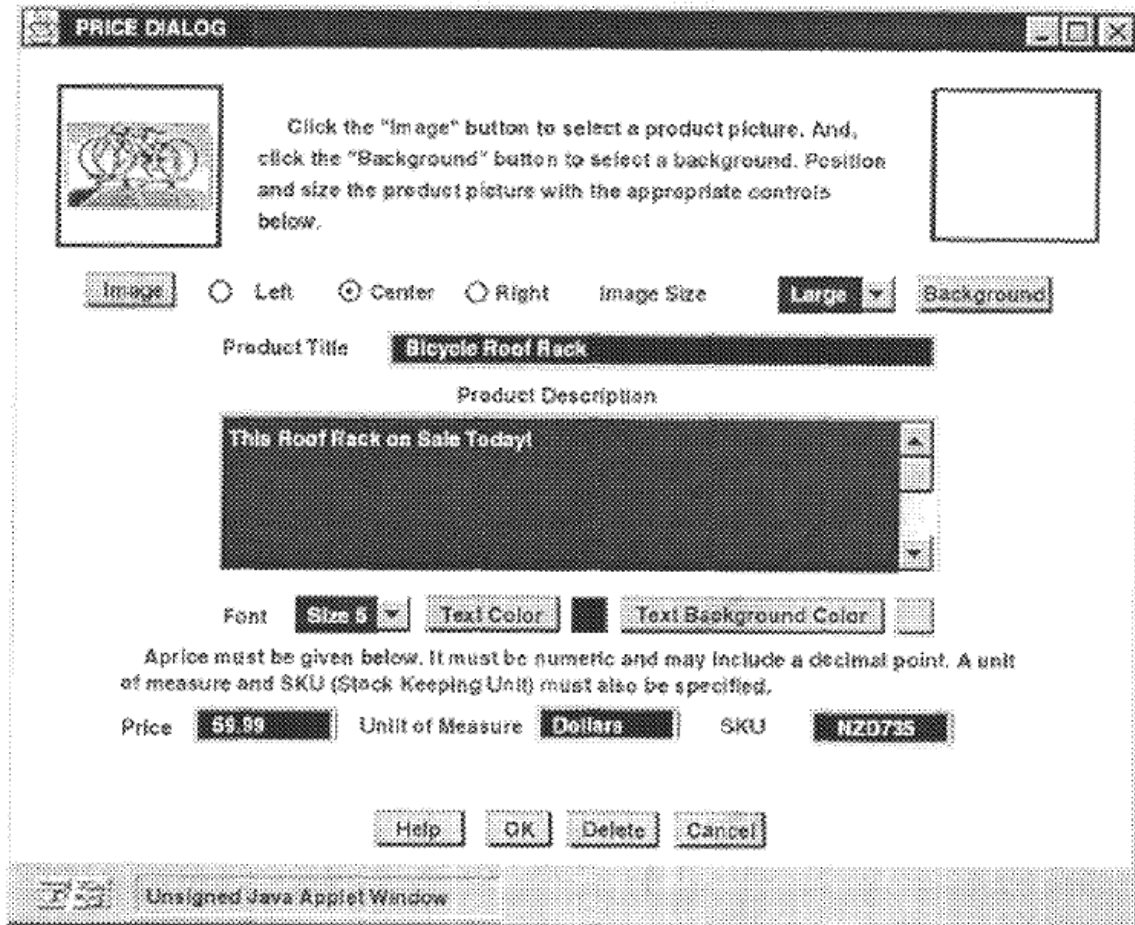


FIG. 15

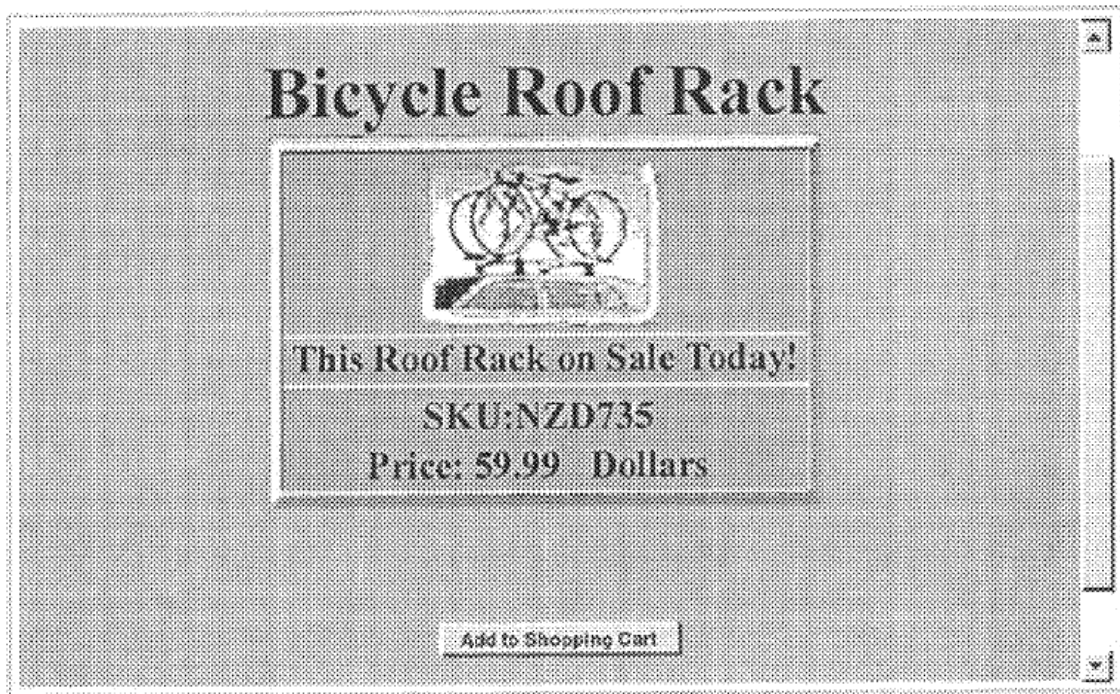


FIG. 16

Figure 15 shows a dialog box for a price URL, and Figure 16 illustrates a Buy Page generated from the price URL. *Id.* at 4:15–18, 12:23–27. The dialog box shown in Figure 15 enables a merchant to customize the Buy Page by adding an image and selecting background colors, font color, and font size for the Buy Page.

In teaching the generation of a web page template from a default header, footer, background, and page style, section b refers to pages, but is silent as to whether the pages are storefront pages or Buy Pages. *Id.* at 10:43–11:67. In describing the Buy Page, section c does not reference the template described in section b. Moreover, Figure 16 depicts only the middle portion of the Buy Page, as evident from the scroll bar visible at the right of the image, so it is unclear whether the Buy Page includes a header

and a footer, which are part of the template. Also part of the template is the page style, and the Buy Page shown in Figure 16 does not include one of the possible default page styles for the template shown in Figures 7 and 8.

Background color is similarly part of the template, but, as shown in Figure 15, one of the inputs in the dialog box for compiling the URL information for generating the Buy Page is background color. For these reasons, Petitioner has not shown persuasively that Moore teaches using a common template to generate both storefront pages and Buy pages.

Furthermore, the ability to customize a Buy Page apart from a storefront web page undermines any visual correspondence between the storefront web page and the Buy Page. As Petitioner acknowledges, Moore does not depict a storefront page to enable a visual comparison between the storefront page and the Buy Page shown in Figure 16. Tr. 7:1–5 (“There is no figure that shows you a storefront page and a buy page in their entirety. . . . [T]here is no example where you can compare and contrast the storefront page with the buy page.”).

In view of the foregoing, Petitioner has not demonstrated persuasively that Moore’s Buy page has the look and feel of the storefront page, and, thus, has not shown that Moore discloses “an overall appearance of the composite page that, excluding the information associated with the commerce object, visually corresponds to the source web page,” as recited in independent claim 1. Given Petitioner has not persuasively demonstrated that Loshin and Moore disclose this claim limitation, Petitioner has not proven by a preponderance of the evidence that combined teachings of Loshin and Moore would have resulted in this limitation.

iii. Conclusion for independent claim 1

Petitioner has not shown persuasively that the combined teachings of Loshin and Moore would have resulted in “an overall appearance of the composite page that excluding the information associated with the commerce object, visually corresponds to the source web page,” as recited in independent claim 1. Consequently, Petitioner has not proven by a preponderance of the evidence that Loshin and Moore render obvious the subject matter of independent claim 1.

b. Claims 3–5, 7, and 8

Each of claims 3–5, 7, and 8 depends from independent claim 1. Ex. 1001, 27:65–28:19, 28:24–36. For the reasons discussed above with respect to independent claim 1, Petitioner has not proven by a preponderance of the evidence that Loshin and Moore renders obvious the subject matter of claims 3–5, 7, and 8.

c. Independent claim 9 and claims 11–13, 15, and 16

Like independent claim 1, independent claim 9 recites “an overall appearance of the composite page that, excluding the information associated with the commerce object, visually corresponds to the source web page.” Ex. 1001, 28:67–29:3. Each of claims 11–13, 15, and 16 depends from independent claim 9. *Id.* at 29:15–30:9, 30:14–25. For the same reasons as independent claim 1, Petitioner has not proven by a preponderance of the evidence that Loshin and Moore renders obvious the subject matter of claims 9, 11–13, 15, and 16.

IV. CONCLUSION

Claims	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1, 3–5, 7–9, 11–13, 15, 16	102(b)	Loshin		1, 3–5, 7–9, 11–13, 15, 16
1, 3–5, 7–9, 11–13, 15, 16	103(a)	Loshin, the InfoHaus Documents		1, 3–5, 7–9, 11–13, 15, 16
1, 3–5, 7–9, 11–13, 15, 16	103(a)	Loshin, Moore		1, 3–5, 7–9, 11–13, 15, 16
Overall Outcome				1, 3–5, 7–9, 11–13, 15, 16

V. ORDER

In consideration of the foregoing, it is:

ORDERED that claims 1, 3–5, 7–9, 11–13, 15, and 16 of the
'228 patent have not been shown to be unpatentable, and

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

IPR2018-01009
Patent 9,043,228 B1

For PETITIONER:

Michael McNamara
mmcnamara@mintz.com
William Meunier
wameunier@mintz.com Peter Snell
pfsnell@mintz.com

For PATENT OWNER:

Louis Hoffman
donald@valuablepatents.com
Justin Lesko
justinlesko@patentit.com
Ian Crosby
icrosby@susmangodfrey.com