

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZILLOW GROUP, INC. and ZILLOW, INC.,
Petitioner,

v.

INTERNATIONAL BUSINESS MACHINES CORP.,
Patent Owner.

IPR2020-01656
Patent 8,315,904 B2

Before KEN B. BARRETT, KEVIN W. CHERRY, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

PESLAK, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining No Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

Zillow Group, Inc. and Zillow, Inc. (collectively “Petitioner” or “Zillow”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1–5 and 7–10 of U.S. Patent 8,315,904 B2 (Ex. 1001, “the ’904 patent”). Petitioner filed a Declaration of Jonathan Hochman in support of the Petition. Ex. 1004. International Business Machines Corporation (“Patent Owner” or “IBM”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”). Taking into account the arguments presented in Patent Owner’s Preliminary Response, we determined there was a reasonable likelihood Petitioner would prevail in its contention that at least one of the challenged claims of the ’904 patent is unpatentable under 35 U.S.C. § 103(a). On March 15, 2021, we instituted this *inter partes* review as to the challenged claims and all grounds presented in the Petition. Paper 8. (“Dec.”).

During the course of trial, Patent Owner filed a response to the Petition. Paper 20 (“PO Resp.”). Patent Owner filed a Declaration of Michael I. Shamos, Ph.D., J.D. in support of the Patent Owner Response. Ex. 2004. Petitioner filed a Reply. Paper 22 (“Pet. Reply”). Patent Owner filed a Sur-reply. Paper 23 (“Sur-Reply”). An oral hearing was held on December 15, 2021 and the transcript is entered into the record. Paper 31 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of the challenged claims of the ’232 patent. For the reasons discussed below, we determine Petitioner does not establish by a preponderance of the evidence that any challenged claim of the ’904 patent is unpatentable.

A. Related Matters

The '904 patent is currently at issue in *International Business Machines Corp. v. Zillow Group*, Case No 2:20-cv-00851-TSZ (W.D. Wa.). Pet. 1, Paper 5, 1.

B. Real Parties in Interest

Petitioner and Patent Owner state that the named entities are the only real parties in interest. Pet. 1; Paper 5, 1.

C. The '904 Patent

The '904 patent describes a “method for producing a promotion list for a promotion management campaign, the method including assigning one or more promotion instances to the promotions list, and storing the promotion list.” Ex. 1001, 1:23–27. The “[a]ssigning . . . includes querying promotion instances to find one or more matching promotion instances having matching attributes to one or more of the promotion attributes, and at runtime, adding the matching promotion instances to the promotions list.” *Id.* at 1:44–49. The assigning also includes displaying, “limiting,” sorting, and filtering the “instances,” and assigning to the list a security policy. *Id.* at 1:49–63.

The '904 patent does not explicitly define the term “promotion instance,” but describes that “the terms ‘promotion(s)’ and ‘offer(s)’ are used interchangeably, but are limited to refer to specific marketing communications that are typically provided in a marketing campaign.” *Id.* at 2:51–54.

The system and method of the '904 patent describes several discrete processes including producing promotion templates and promotion instances, managing the design of a marketing campaign, assigning

promotion instances to groups of contact entities, executing the marketing campaigns, managing the contacts of a marketing campaign, logging the history of the promotions made to groups of contacts, producing contact lists for the promotions that aid in managing, optimizing the marketing campaign, and logging the responses from contact entities and controls. *Id.* at 3:55–65.

A user creates a “template,” which includes basic options attribute fields, standard attributes, and customized attributes. *Id.* at 3:66–4:8, 4:45–46. Because of the ability to use different “attributes,” multiple versions of a promotion instance can be produced. *Id.* at 5:27–31. However, a “promotion instance produced from a promotion template that does not include any parameterized attributes 86 can have at most one promotion version.” *Id.* at 5:27–44. The ’904 patent provides an example of an attribute in a promotion instance:

[I]f a “Fixed-rate home mortgage” promotion template is produced with a static attribute of “closing points,” Promotion instance A could be produced with two closing points and promotion instance B could be produced with zero closing points. All promotion versions A1, A2, A3 . . . produced from promotion instance A . . . would have two closing points. All promotion versions B1, B2, B3 . . . produced from promotion instance B would have zero closing points.

Id. at 5:52–62. “When the user assigns a promotion instance 120 to a group of contact entities, the user specifies different sets of values for the parameterized attributes in the promotion instance 120 to produce promotion versions 124, 126, 128.” *Id.* at 6:58–62.

The patent also describes a “promotion list,” which “is a collection of one or more promotion instances and can be used where ever individual promotion instances are used (e.g., for promotion assignment to target

groups). The promotion list includes promotion list attributes 350.” *Id.* at 16:17–22. A user can search through the promotion list, “based on any promotion attributes as well as ‘inherent attributes’ such as the creation or update date/time, owner, folder, promotion template, and security policy. Based upon browsing or the results of the search, the user selects one or more promotion instances to add to the static promotion list.” *Id.* at 16:42–47. Thus, the user searches “to find promotion instances with matching search criteria[.]” *Id.* at 16:56–58.

D. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–5 and 7–10 would have been unpatentable on the following ground (Pet. 3)¹:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–5, 7–10	102(a)	Reuning ²

E. The Challenged Claims

Claim 1, the only challenged independent claim, is reproduced below with paragraph annotations added by Petitioner:

1. A computer implemented method comprising:
 - [a] producing, by one or more computers, a promotion list for a promotion management campaign by:
 - [b] generating, by one or more computers, a promotion instance from a promotion template;

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 102. Because the ’904 patent was filed before the effective date of the relevant amendment, the pre-AIA version of § 102 applies.

² US 2002/0087573 A1, published July 4, 2002 (Ex. 1003, “Reuning”).

- [c] receiving, by one or more computers executing marketing campaign software, a search query that includes one or more attributes of a promotion instance;
- [d] searching one or more data repositories for promotion instances having attributes corresponding to the attributes specified in the search query;
- [e] returning a list including one or more promotion instances having the attributes corresponding to the attributes specified in the search query;
- [f] receiving, by the one or more computers, a selection of one or more promotion instances, from the returned list, to be included in the promotion list;
- [g] assigning the selected promotion instances to the promotions list; and
- [h] storing the promotion list in an electronic medium.

Ex. 1001, 24:48–67.

II. ANALYSIS

A. Overview

Petitioner bears the burden of establishing the unpatentability of the challenged claims by a preponderance of the evidence. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). This burden of persuasion never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

A claim is anticipated under 35 U.S.C. § 102 “only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). However, this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *See In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

B. Level of Ordinary Skill in the Art

Petitioner contends a skilled artisan “would have had a bachelor’s degree in computer science or a closely related field, along with two or more years of programming experience in application development, including familiarity with accessing databases and implementing user interfaces, as well as familiarity with marketing concepts and marketing workflows.”

Pet. 7–8 (citing Ex. 1004 ¶ 22).

Patent Owner contends a skilled artisan “would have had a degree in computer science, information systems, or a similar discipline, or equivalent work experience.” PO Resp. 2. In addition to the educational attainment, Patent Owner contends a skilled artisan would have had “one to two years of work experience implementing networked systems with user interfaces, including familiarity with databases and computerized marketing.” *Id.* (citing Ex. 2004 ¶ 46). Patent Owner acknowledges that Petitioner offers “a slightly different level of ordinary skill in the art” but that “it is not materially different.” *Id.* at 2–3.

For the purposes of this Decision, we adopt Petitioner’s proposed level of ordinary skill in the art because it appears consistent with the problems addressed in the ’904 patent and the prior art of record. Our Decision, however, would not be impacted if we adopted Patent Owner’s proposed level of skill in the art.

C. Claim Construction

Petitioner contends that it “analyzed the claims using their plain and ordinary meaning.” Pet. 8. As a result, Petitioner contends we “need not explicitly construe the terms here.” *Id.*

Patent Owner starts by referring to our preliminary construction of the claim term “promotion instance” which is “a case or occurrence, or example of a specific marketing communication provided in a marketing campaign.” PO Resp. 3 (citing Dec. 10). Patent Owner argues that because our preliminary construction requires a promotion instance to be “a specific marketing communication provided in a marketing campaign” our construction precludes including “the list of contacts that may receive this advertisement.” *Id.* Patent Owner also argues that our Decision on Institution notes that “‘promotion instances’ comprise attributes that are ‘directed to the contents of the promotion instances not the identity of recipients.’” *Id.* (citing Dec. 18). Patent Owner further contends that our preliminary construction “makes clear that a ‘promotion instance’ is the advertisement itself and not the list of contacts that may receive this advertisement.” *Id.*

Petitioner, in turn, responds that the Specification of the ’904 patent “defines ‘promotions’ as ‘specific marketing communications that are **typically** provided in a marketing campaign.’” Pet. Reply 3. According to Petitioner, because “typically” does not mean always, we should not “limit promotion instances to always be part of a marketing campaign.” *Id.* Petitioner also argues that “marketing campaign” only appears in the preamble of claim 1 and the preamble is not limiting. *Id.*

Our decision in this case does not turn on whether or not a promotion instance is limited to one used in a marketing campaign or whether a list of contacts constitutes a promotion instance or whether the preamble is limiting. The parties also do not dispute that the cited prior art discloses promotion instances. Thus, we need not reach these issues. Consequently,

we need not formally construe this term. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (noting that “we need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’”) (citing *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

Patent Owner next contends that “promotion list” should be construed as “a collection of one or more promotion instances” but the term “does not apply to a collection of contact information.” PO Resp. 3–4 (citing Ex. 2004 ¶¶ 50–51). Petitioner, in turn, contends Patent Owner “fails to explain why the word ‘collection’ should replace ‘list’ or how ‘a collection’ clarifies the plain and ordinary meaning of ‘list.’” Pet. Reply 1–2. Petitioner further contends, based on deposition testimony by Dr. Shamos, that Patent Owner “imposes intent—‘an express act of making a list’—into ‘promotion list.’” *Id.* at 2 (citing Ex. 1020, 70:10–71:3). Patent Owner denies “there is an element of intent in the claims of the ’904 Patent.” Sur-Reply 9.

We apply the plain and ordinary meaning of “promotion list” as “a list of one or more promotion instances.” We note that our Decision would be the same even if we adopted Patent Owner’s construction, *i.e.*, “a collection of one or more promotion instances.”

Patent Owner next contends that “[a]t least steps 1[c] through 1[h] of claim 1 of the ’904 Patent must be performed in order.” PO Resp. 4. In support of this contention, Patent Owner argues because these steps refer to terms recited in previous steps, the doctrine of antecedent basis requires the steps to be performed in order. *Id.* Patent Owner further argues that logic and grammar also require these steps to be performed in order. *Id.* at 5–6.

Petitioner, in turn, replies that the steps need not be performed in order. Pet. Reply 4–7. Petitioner contends, based on the deposition testimony of Mr. Hochman, that the steps “do ‘not strictly require[e] some temporal ordering’ because processes in ‘[d]istributed concurrent computing like . . . caching, pre-fetching, [and] indexing’ make it ‘possible to do these steps in . . . different orders or concurrently.’” *Id.* at 4 (citing Ex. 2003, 55:2–10, 56:2–16, 68:21–25); *see also id.* at 5–7 (arguing that “[a]s a matter of computer logic, Mr. Hochman finds ‘the order [of steps in claim 1] is flexible.’”).

The question is whether “the sequential nature of the claim steps is apparent from the plain meaning of the claim language” and whether anything “in the written description [of the specification] suggests otherwise.” *Mantech Environmental Corp. v. Hudson Environmental Services, Inc.*, 152 F.3d 1368, 1376 (Fed. Cir. 1998). In this case, we determine that the sequential nature of the steps is apparent from the plain meaning of the claim language and apply the plain and ordinary meaning of the steps in claim 1 considering the recited antecedent basis for steps 1[c] to 1[h]. For example, the search query in step 1[d] is the search query received in step 1[c]. Ex. 1001, 24:53–58. Petitioner does not cite to any part of the Specification of the ’904 patent that would, at least, suggest we should deviate from the plain and ordinary meaning of the claim language. We address this issue, including the deposition testimony of Mr. Hochman cited by Petitioner, in the context of evaluating whether Petitioner establishes anticipation of claim 1.

D. Anticipation by Reuning

Petitioner contends that Reuning anticipates claims 1–5 and 7–10. Pet. 15–36. Patent Owner contends that Reuning does not anticipate claim 1 because it does not disclose steps 1[c] through 1[h]. PO Resp. 23–47.

1. Overview of Reuning (Ex. 1003)

Reuning relates to providing “advertisers a method of assembling advertisements and supplying or creating a list of targets for those advertisements from a remote location.” Ex. 1003 ¶ 12. Reuning’s “system will identify that candidate’s professional profile when a relevant product or employment position becomes available, and then notify the candidate.” *Id.* ¶ 11. Reuning describes that “resumes, because they contain detailed professional profiles, could be useful in compiling a direct marketing data base to use in direct-mail campaigns for technical or professional products.” *Id.* ¶ 5.

Figure 1, reproduced below, illustrates Reuning’s method steps.

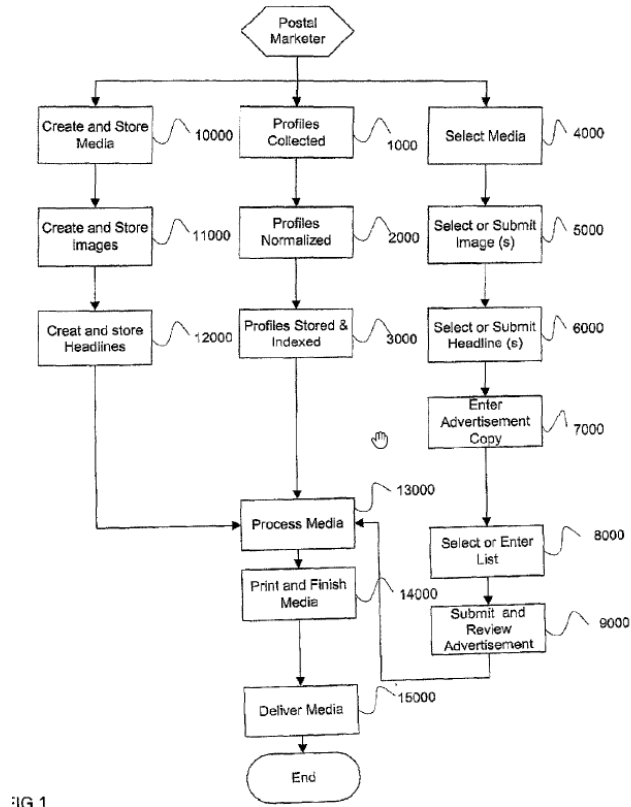


Figure 1 of Reuning “shows the major procedural steps of” Reuning’s invention. *Id.* ¶ 13.

Reuning describes that its system comprises “two general parts: (1) compiling a data base of candidate contact information, and (2) using this data as the variable inputs in a mail merge to create a customized advertisement delivered to the specific candidate.” *Id.* ¶ 98. First, “professional profiles are collected and stored in a database.” *Id.* ¶ 100. The profiles are then “normalized” by “converting and modifying data into a uniform format in preparation for importation into a database.” *Id.* ¶ 126.

To use the populated database of profiles, “an advertiser of the system selects a media type element,” as well as images, headlines, letter head, left border type, ads, and output media type. *Id.* ¶¶ 143–154. Figure 34C,

reproduced below, is an example of a computer user interface that permits the user to provide the information just described. *Id.* ¶ 53.

Figure 34C “is an invention application software and computer interface that provides for the operator to submit a new advertisement according to” Reuning’s invention. *Id.*

After the selections and input are provided, the system will “merge the digital objects selected and submitted by the advertiser and the variable data from the contact list using the method and systems of our invention and print them via a digital printer specifically attributed to merging and printing digital objects.” *Id.* ¶ 174.

2. Claim 1

Preamble: A computer implemented method comprising:

Petitioner contends “Reuning discloses a computer-implemented method.” Pet. 15. Petitioner further contends Reuning’s Figure 14 is a schematic illustrating how various computer ‘work stations,’ a server, and

“WinNt’ computers are necessary components for carrying out the invention.” *Id.* at 15–16 (citing Ex. 1003, Fig. 14). Petitioner further contends that Figures 13, 16, and 18 through 34N depict a computer apparatus and various software for carrying out the steps of claim 1. *Id.* at 16–17.

Patent Owner does not squarely address Petitioner’s contentions or whether the preamble is limiting. *See* PO Resp. 23–47. We need not decide whether the preamble is limiting because Petitioner demonstrates that Reuning discloses the subject matter of the preamble.

*1[a]*³: *producing, by one or more computers, a promotion list for a promotion management campaign by:*

Petitioner contends that Reuning discloses this limitation because it uses a computer to compile a data base of candidate contact information and uses that data as the variable inputs “in a mail merge to create a customized advertisement delivered to a specific candidate.” Pet. 17 (citing Ex. 1003 ¶¶ 98–141). Petitioner further contends that Reuning discloses “how ‘advertisement[s]’ may be ‘create[d]’ and ‘assemble[d]’ using a computer.” *Id.* (citing Ex. 1003 ¶¶ 151–176) (alteration in original). Petitioner further contends Reuning’s Figure 34F “depicts an ‘Advertisement Submission Interface’ where the computer ‘system display[s] a list of advertisements in a table element 372 . . . and the operator . . . select[s] an[] advertisement by clicking on its row.’” *Id.* (citing Ex. 1003 ¶ 157, Fig. 34F) (first, third, and fourth alterations in original). Petitioner further contends that a skilled artisan would have understood “this capability to mean that there are one or

³ We use the limitation identifiers such as “1[a]” used by the parties for ease of reference.

more advertisements available on the system to be selected for an advertisement campaign.” *Id.* (citing Ex. 1004 ¶ 81). Petitioner further contends that Reuning discloses “how a promoter or advertiser may ‘isolate[] a list of desirable contacts to receive an advertisement.’” *Id.* at 18 (citing Ex. 1003 ¶¶ 171–176) (alteration in original).

Patent Owner does not dispute Petitioner’s contention that Reuning discloses this limitation. *See* PO Resp. 23–47.

Based on our review of the evidence cited by Petitioner, we find that Reuning discloses this limitation.

l[b]: generating, by one or more computers, a promotion instance from a promotion template;

Petitioner contends “Reuning discloses generating promotion instances from . . . advertisement data.” Pet. 18–19 (citing Ex. 1004 ¶ 84). Petitioner directs us to Figure 34 C of Reuning. *Id.* at 19. According to Petitioner, Reuning discloses that this figure illustrates “an invention application software and computer interface that provides for the operator to submit a new advertisement.” *Id.* (citing Ex. 1003 ¶ 53). Petitioner contends that, in Reuning, a user selects a media type in Figure 34C and “[t]he system is able to provide image selections based on the media type that is selected, as well as other attributes such as images, letter heads and headlines.” *Id.* at 19–20 (citing Ex. 1003 ¶¶ 143–149). Petitioner further contends that Figure 7 of Reuning discloses “[t]he process of creating a promotion instance from a template of advertisement fields.” *Id.* at 20 (citing Ex. 1003, Fig. 7). Petitioner further contends a skilled artisan would have understood “that the creation of a new advertisement using various stored data (such as images, headlines, letterhead, and borders) from a database is the same as the generation of a promotion instance from a

promotion template according to the '904 patent.” *Id.* at 21 (citing Ex. 1004 ¶ 87).

Patent Owner does not dispute Petitioner’s contention that Reuning discloses this limitation. *See* PO Resp. 23–47.

Based on our review of the evidence cited by Petitioner, we find that Reuning discloses this limitation.

I[c]: receiving, by one or more computers executing marketing campaign software, a search query that includes one or more attributes of a promotion instance;

Petitioner contends that “Reuning discloses two embodiments illustrating how its system receives search queries” in accordance with this limitation. Pet. 25 (citing Ex. 1004 ¶ 93).

Petitioner first contends that Figure 34M of Reuning “discloses the user submission of search criteria to the ‘Postal Marketer’ marketing campaign software which may include an attribute of certain advertisement data.” Pet. 25 (citing Ex. 1003 ¶ 65; Ex. 1004 ¶ 94). According to Petitioner, “Figure 34M depicts that a user of the software may submit search queries such as a date or a specific advertiser in order to find matching advertisements.” *Id.* at 26 (citing Ex. 1004 ¶ 95).

Petitioner also contends that “in Figure 34F, a user is prompted to submit a ‘User Reference Code’ to the software program” and that a skilled artisan would have understood “the following interface screen to allow a user to search for promotion instances by submitting a search query using a ‘user reference code’—which is the same as entering an attribute as search criteria.” Pet. 26 (citing Ex. 1003 ¶ 157; Ex. 1004 ¶¶ 97–98).

Petitioner further contends that Figure 34L discloses this limitation. Pet. 27. Petitioner contends that Reuning “discloses the user input of a

search query into a computer executing the ‘Postal Marketer’ marketing campaign software where the search query includes one or more attributes of a promotion instance, such as words or phrases or states.” *Id.* (citing Ex. 1004 ¶ 99). According to Petitioner, Figure 34L illustrates an “interface that provides for the operator to search an invention contact database for the purpose of creating a contact list for merger with a submitted advertisement.” *Id.* (citing Ex. 1003 ¶ 64). Petitioner further contends that Reuning’s system “receives ‘keyword criteria’ that are input in these ‘fields’ so that the criteria may be used ‘for targeting a list of prospective contacts.’” *Id.* at 28 (citing Ex. 1003 ¶ 506). Petitioner further contends a skilled artisan would have understood “that a search query may include one or more attributes of a promotion instance, including those that correspond to the fields available in Figure 34L.” *Id.* at 28–29 (citing Ex. 1004 ¶ 100).

Patent Owner first contends Petitioner’s theory that Figure 34M discloses this limitation is flawed because the Petition “cites to the same figures for multiple steps in an incompatible fashion.” PO Resp. 24. Patent Owner contends Figure 34M is part of Step 13000 shown in Reuning’s Figure 1. *Id.* at 23 (citing Ex. 1003 ¶ 541, Fig. 1). Patent Owner further contends Petitioner relies on Figure 34M to satisfy step 1[g] but “is unclear as to what it is pointing to as the promotion list in 1[g], only going so far as to say ‘the professional data list shown at the bottom of Figure 34M also depict[s] that users can select promotion instances to be assigned to a promotion list.’” *Id.* at 24 (citing Pet. 33). Patent Owner also contends that Petitioner relies on Figures 34L and 34F for step 1[f], not Figure 34M. *Id.* at 23–24. Patent Owner further contends because “Figure 34M occurs after

Figure 34L and Figure 34F in Reuning’s disclosed process sequence, Figure 34M cannot provide the initial search.” *Id* at 25.

Petitioner, in turn, contends Patent Owner “improperly reads temporal requirements into 1[c]. By its terms, *any* search query—not just an ‘initial’ one—is sufficient.” Pet. Reply 7–8 (citing Ex. 1001, 24:53–55). Petitioner further contends “Figure 34M ‘discloses the user submission of search criteria . . . which may include an attribute of certain advertisement data,’ such as ‘ads submitted on a certain date,’ ‘ads from a specific advertiser,’ or ‘ads by customer.’” *Id.* (citing Ex. 1003 ¶¶ 65, 513; Ex. 1004 ¶¶ 94–95). Petitioner further contends “[n]othing precludes a [skilled artisan] from understanding Figure 34M to provide an advertisement in table 399 which may be ‘double click[ed] . . . to [be] process[ed]’—*i.e.*, selected for modifying.” *Id.* at 8 (citing Ex. 1001, Fig. 34M).

Patent Owner responds Petitioner’s contention that Figure 34M is used to select an advertisement for modifying is incorrect. Sur-Reply 13. According to Patent Owner, “Reuning makes clear that Figure 34M is for selecting an advertisement to ‘process’ for eventual printing in Step 13100, whereas Figure 34F in conjunction with Figure 34G is for modifying an advertisement.” *Id.* (citing Ex. 1003 ¶¶ 65, 157).

For the following reasons, we find that Petitioner establishes that Reuning’s Figure 34M discloses this limitation.

The pertinent inquiry is whether Reuning’s Figure 34M discloses “receiving . . . a search query that includes one or more attributes of a promotion instance.” Patent Owner’s contentions that Petitioner’s reliance on Figure 34M to satisfy step 1[c] is inconsistent with its contentions for succeeding claim steps, while potentially relevant to whether Petitioner

establishes disclosure of the succeeding claim steps, does not resolve the inquiry for step 1[c].

Petitioner directs us to paragraphs 65 and 513 of Reuning and paragraphs 94 and 95 of Mr. Hochman's Declaration. Pet. 25; Pet. Reply 7. Paragraph 65 of Reuning is a brief description of Figure 34M and provides no details of search queries. Paragraph 513 doesn't even mention Figure 34M. Mr. Hochman testifies that "Figure 34M depicts that a user of the software may submit search queries such as a date or a specific advertiser in order to find matching advertisements." Ex. 1004 ¶ 95. Based on our review of Figure 34M, we find Mr. Hochman's testimony credible on this point as there are various entries for search criteria in the form shown in Figure 34M corresponding to Mr. Hochman's testimony. For these reasons, we find Reuning's Figure 34M discloses step 1[c].

In connection with Petitioner's contention that Figure 34F discloses this claim limitation, Patent Owner disputes Petitioner's contention that Reuning's "user reference code" corresponds to "attributes of a promotion instance." PO Resp. 26. Patent Owner contends Mr. Hochman testifies "without explanation that entering a user reference code 'is the same thing as entering an attribute as search criteria.'" *Id.* (citing Ex. 1004 ¶ 98). Patent Owner further contends "this 'reference code' is not defined in Reuning and the Petition and Hochman Declaration provide no clear explanation of what it is." *Id.*

Petitioner, in turn, contends a skilled artisan "viewing interface 34F would understand that a user may search for advertisements by submitting a search query that includes one or more attributes." Pet. Reply 8 (citing Ex. 1003 ¶ 157; Ex. 1004 ¶ 98). Petitioner further contends Patent Owner's

“attempt to limit a ‘search query’ to exclude the ‘User Reference Code’ . . . fails because [Patent Owner] has waived the claim construction argument by neglecting to construe ‘attributes.’” *Id.* Petitioner also contends Patent Owner “fails to adduce evidence that either Reuning or the ’904 patent precludes these codes from being promotion instance attributes included in a search query.” *Id.* (citing PO Resp. 27).

Patent Owner replies Petitioner “improperly attempts to shift the burden of persuasion to” Patent Owner. Sur-Reply 17. Patent Owner contends it “put forth clear reasoning explaining that there are many codes mentioned in Reuning, but there is insufficient disclosure regarding them to find Step 1[c] anticipated.” *Id.* (citing PO Resp. 26–27; Ex. 2004 ¶¶ 63–65). Patent Owner further contends that in the Reply, Petitioner “effectively advances an obviousness argument of what ‘a [skilled artisan] viewing interface 34F would understand’ regarding what ‘a user *may* search for.’” *Id.* (citing Pet. Reply 8). According to Patent Owner, Petitioner only relies on paragraph 157 of Reuning which “states, in relevant part, only that ‘the system displays a list of advertisements’ in response to a code and password, markedly different than disclosing ‘receiving . . . a search query,’ as required in Step 1[c].” *Id.*

For the following reasons, we find Petitioner has not established that Figure 34F discloses this limitation.

Petitioner relies on Reuning paragraph 157 and paragraph 98 of Mr. Hochman’s declaration to establish that Reuning’s “User Reference Code” correspond to the recited promotion attributes. *See* Pet. 26. Paragraph 157 of Reuning discloses “the operator of our invention enters an identification code and password, the system displays a list of advertisements.” Ex. 1003,

¶ 157. Petitioner does not argue that the “identification code” in paragraph 157 is another name for the “User Reference Code” in Figure 34F.

Assuming these two terms are synonymous, Petitioner does not direct us to any portion of Reuning where either “identification code” or “User Reference Code” is defined or described. Mr. Hochman’s testimony is no more enlightening than the Petition on this point. He testifies that a skilled artisan “would understand . . . a ‘user reference code’— . . . is the same as entering an attribute as search criteria.” Ex. 1004 ¶ 98. We give no weight to Mr. Hochman’s testimony as he offers no evidence from Reuning or elsewhere to support this testimony. *Id.*; 37 C.F.R. 42.65(a). Further, neither Petitioner nor Mr. Hochman point us to any portion in the ’904 patent that suggests Reuning’s User Reference Codes correspond to attributes of a promotion instance. Pet. 26; Ex. 1004 ¶ 98.

Consequently, we find Petitioner fails to establish that Figure 34F of Reuning discloses step 1[c].

With respect to Figure 34L, Patent Owner contends because it “correlates only to searching through a database of potential contacts, and not any promotion instances, it fails to disclose ‘a search query that includes one or more attributes of a promotion instance.’” PO Resp. 28 (citing Ex. 1003 ¶ 64). Patent Owner contends the “contacts have yet to be merged with an advertisement so there is no relation between the contacts being searched for and any advertisements, making this part of Reuning irrelevant to the ’904 patent.” *Id.* (citing Ex. 2003, 110:5–9). Patent Owner further contends that Petitioner’s reference to Reuning disclosing “a ‘search query may specify various ‘criteria’ using ‘keywords’ and ‘word expressions’ is describing the harvesting of professional data from web pages in Step 1000

to create a database of potential targets and has no relation to Figure 34L, let alone promotion instances.” *Id.* (citing Pet. 28; Ex. 1004 ¶ 100; Ex. 2004 ¶ 67).

Petitioner, in turn, contends “[j]ust because the 34L interface searches through contacts does not preclude the ‘word[s] or phrases’ being entered ‘into boxes 385’ or ‘States 388’ as a search query from including one or more attributes of a promotion instance.” Pet. Reply 8–9 (citing Ex. 1003 ¶¶ 108–110, 153, 506). Petitioner further contends a skilled artisan “would understand that a search query input into a box 385 in Figure 34L may be a promotion instance attribute, for example, an ad relating to tools for ‘gardening’ may be search criteria for a target recipient whose resume includes ‘gardening’ as an interest.” *Id.* at 9 (citing Ex. 1004 ¶ 100).

For the following reasons, we find Petitioner has not established that Figure 34L discloses this limitation.

Reuning discloses that Figure 34L “provides for the operator to search an invention contact database for the purpose of creating a contact list for merger with a submitted advertisement.” Ex. 1003 ¶ 64. Petitioner points to paragraphs 108–110, 153, and 506 of Reuning to support its contention that entries in the fields in Figure 34L “may specify various ‘criteria’ using ‘keywords and expressions.’” Pet. 28; *see also* Pet. Reply 8–9 (citing same paragraphs of Reuning). Paragraphs 108–110 describe general search query criteria, paragraph 153 describes Figure 34C not 34L, and paragraph 503 describes Figures 34C and Figure 34. Thus, none of the cited paragraphs disclose the use of “a search query that includes one or more attributes of a promotion instance” in connection with performing a search using the form shown in Figure 34L. Petitioner’s argument that Figure 34L “does not

preclude” using words or phrases in boxes 385 in Figure 34L does not help Petitioner. Petitioner has the burden to show Figure 34L discloses this claim limitation either expressly or inherently. Petitioner does not show that Figure 34L expressly discloses a search using promotion instances, does not argue that Figure 34L inherently discloses this limitation (Pet. 27–29), and does not direct us to evidence to support a finding that the recited search query is necessarily used in Figure 34L. *See In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Consequently, we find Petitioner fails to establish that Figure 34L of Reuning discloses step 1[c].

In the Reply, Petitioner contends “Figure 12 discloses the process of searching, modifying, and selecting an advertisement to be included on a promotion list.” Pet. Reply 8 (citing Ex. 1003 ¶¶ 160–167; Ex. 1004 ¶ 120).

Patent Owner responds “Zillow never cited Figure 12 in the Petition as disclosing Step 1[c]” and the contention is untimely and should be stricken. Sur-Reply 16 (citing Pet. 25–29). In addition, Patent Owner contends “[w]hile Figure 12 discloses the selection and the modifying of an advertisement, there is no disclosure of ‘searching’ as argued by [Petitioner].” *Id.* Patent Owner further contends that paragraph 120 of Mr. Hochman’s declaration cited by Petitioner is directed to step 1[h] not 1[c]. *Id.*

As a reminder, this claim step requires, *inter alia*, “receiving . . . a search query.” We turn to the evidence cited by Petitioner in support of its contention that Figure 12 discloses searching. The only reference to Figure 12 in paragraphs 160–167 of Reuning is the following sentence: “At Step 9060 FIG. 12, based on the decision to modify or accept the advertisement made in Step 9050 FIG. 12, the operator of the system clicks

on the Accept button element 348 FIG. 34G or the Modify button element 349 FIG. 34G.” Ex. 1003 ¶ 160. The cited paragraph of Mr. Hochman’s declaration provides “Figure 12 illustrates Step 9060, which a [skilled artisan] would understand to be the step of storing advertisements that have been reviewed, modified, and selected to be placed on a promotion list.” Ex. 1004 ¶ 120 (citing Ex. 1003 ¶¶ 160–167). None of the steps shown in Figure 12 disclose or suggest a search query is received. *See* Ex. 1003, Fig. 12. Consequently, regardless of whether Petitioner’s contention is timely, Petitioner fails to establish that Reuning’s Figure 12 discloses “receiving . . . a search query” as required by this claim limitation.

1[d]: searching one or more data repositories for promotion instances having attributes corresponding to the attributes specified in the search query;

Petitioner contends that Figure 34M discloses searching Reuning’s system for advertisements that “match[] the search criteria . . . submitted” and Figure 34F discloses searching “the submitted advertisements database using ‘an identification code’ or user reference code.” Pet. 29. (citing Ex. 1003 ¶¶ 157, 166; Ex. 1004 ¶ 102). Petitioner also contends Reuning discloses a series of steps in connection with searching for professional profiles in Figure 34L that a skilled artisan would understand “a search is run for promotion instances once the advertising user initiates a search, for example, by clicking the ‘submit’ button in Figure 34L.” *Id.* at 29–30 (citing Ex. 1003 ¶¶ 114, 156, Figs. 11 (steps 8090, 8100, 8110), 34L; Ex. 1004 ¶ 105).

Patent Owner contends, in connection with Figure 34M, that Petitioner “points only to the disclosure that ‘in response our invention reports a list of advertisement submissions in the table element 399 FIG.

34M.” PO Resp. 29 (citing Pet. 29; Ex. 1003 ¶ 166). According to Patent Owner, “reporting” is not “searching.” *Id.* Patent Owner further contends Mr. Hochman “acknowledges that simply populating results on a page is not enough to disclose that a search has been performed, as this could have been done through indexing or pre-fetching.” *Id.* (citing Ex. 2003, 51:14–17); *see also id.* at 30 (arguing that Mr. Hochman’s testimony “that a search does not necessarily have to be run for results to be populated” is resorted to “because there is no disclosure in the cited portions of Reuning for a search actually being carried out.”) *Id.* (citing Ex. 2003, 51:1–17)).

In connection with Figure 34F, Patent Owner repeats its contention that Reuning’s identification codes do not satisfy the search requirements of claim 1. PO Resp. 32; Sur-Reply 20.

In connection with Figure 34L, Patent Owner contends that Petitioner “implicitly concedes that Figure 34L does not disclose ‘searching . . . for promotion instances’” because it “argues that Figure 34L and the process of ‘searching for professional profiles’ discloses step 1[d].” PO Resp. 33 (citing Pet. 29). Patent Owner further contends “[c]ontact information of potential targets cannot be reconciled with any construction of the term ‘promotion instance.’” *Id.* Patent Owner further contends “Mr. Hochman admits that ‘promotion instances’ are the advertisements and contact information does not qualify as a promotion instance.” *Id.* (citing Ex. 2003, 131:13–18).

Petitioner, in turn, contends “[j]ust because a system has the capability of ‘preloading’ or ‘prefetching’ results from a search query, does not mean that ‘searching of the data repositories’ was not performed *at some point.*” Pet. Reply 10. Rather, according to Petitioner, “[a] system may elect to

prefetch search query results to ‘reduce the response time for the user,’ but that does not preclude the system from running a search—all it means is that a search need not be run *after* receipt of a search query in step 1[c].” *Id.* (citing Ex. 2003, 54:5–55:10); *see also id.* at 5 (arguing a skilled artisan “would understand that claim 1 allows, but does not require, the ‘receiving’ step to be performed before the ‘searching step.’” (citing Ex. 2003, 50:20–51:7, 51:8–17, 62:14–22, 65:23–66:10, 66:16–21).

In connection with Figure 34F, Petitioner points to paragraph 495 of Reuning. Pet. Reply 10. Petitioner contends this paragraph discloses “each advertisement is ‘assigned a unique ID in the corresponding tables REF Code field, and the advertiser’s reference code from element 168 FIG. 34 is stored in the Owner Code field of the newly created database record so that images, object, headlines etc. may be filtered based on ownership in other steps.” *Id.* (citing Ex. 2003, 103:24–105:8).

In connection with Figure 34L, Petitioner argues Figure 34L “was an alternative disclosure which teaches a ‘searching’ sequence sufficient for a “[skilled artisan] to infer that a similar ‘search’ operation could be run for a different type of data (*e.g.*, promotion instances) by submitting a search query.” Pet. Reply 11 (citing Pet. 29–30; Ex. 1004 ¶ 105).

Patent Owner replies the search being conducted in Figure 34L “is for contacts, and not the required ‘searching . . . for promotion instances.” Sur-Reply 19 (citing Ex. 1003 ¶ 64). In addition, Patent Owner contends Petitioner’s contention that a skilled artisan could “infer that a similar ‘search’ operation could be run for a different type of data” is “an obviousness-style argument.” *Id.* at 20. Patent Owner further contends “at

best, this would require adapting and combining different features from different processes in the Reuning reference.” *Id.*

For the following reasons, we find Petitioner establishes that Reuning’s Figure 34M discloses this limitation.

This claim limitation requires “searching . . . data repositories for promotion instances having attributes corresponding to the attributes specified in *the search query*.” The search query in step 1[d] is the search query received in step 1[c]. Ex. 1001, 24:53–58.

As discussed above, we are persuaded that Figure 34M discloses step 1[c] which includes receiving a search query. Patent Owner contends that Reuning’s description of Figure 34M cited by Petitioner uses the word “repor[ting]” not “searching” which it argues is insufficient to establish this limitation. PO Resp. 29. In support of its argument that reporting is not necessarily the result of a search is Patent Owner asserts Reuning *could* report without searching if its system engaged in “indexing or pre-fetching.” *Id.* The evidence cited by Patent Owner to support this premise is deposition testimony of Petitioner’s expert Mr. Hochman. *Id.* (citing Ex. 2003, 51:14–17). Mr. Hochman testified it was possible to return results without a search by “a process called indexing.” Ex. 2003 51:14–17. As discussed above in our claim construction analysis, Patent Owner specifically contends that steps 1[c] through 1[h] *must be* performed in order. PO Resp. 4. Mr. Hochman’s testimony was offered by Petitioner in support of its contrary argument that the steps of claim 1 need not be performed in order. *See* Pet. Reply 4 (“As Petitioners’ expert testified, most steps 1[c] through 1[h] do ‘not strictly require[e] some temporal ordering’ because processes in ‘[d]istributed concurrent computing like . . . caching, pre-fetching, [and]

indexing’ make it ‘possible to do these steps in . . . different orders or concurrently.’)(citing Ex. 2003, 55:2–10, 56:2–16, 68:21–25).

Reliance on Mr. Hochman’s testimony is problematic because it is bare opinion testimony offered by Mr. Hochman with no corroborating evidence. **Patent Owner** confirms that “Mr. Hochman . . . provide[s] examples, none of which are disclosed in Reuning or the ’904 patent . . . of how results may be populated without a search necessarily being run to support his reliance on Figure 34M.” PO Resp. 30 (citing Ex. 2003, 51:1–17). Essentially, Patent Owner uses testimony by Mr. Hochman that it argues is not entitled to weight to construct an argument that Petitioner fails to show Reuning’s Figure 34M inherently discloses a search. PO Resp. 29 (“The mere possibility or probability that a search for promotions is being carried out is not sufficient to establish anticipation.”). Patent Owner’s argument is of little import, however, because as we next explain, a preponderance of the evidence supports a finding that Figure 34M explicitly discloses a search.

The fact that that the words “search” or “searching” do not explicitly appear in paragraph 166 of Reuning is not dispositive. This paragraph states “the operator of the system selects an option from . . . interface FIG. 34M and in response our invention *reports a list of advertisement submissions* in the table element 399.” Ex. 1003 ¶ 166 (emphasis added). Figure 34M is reproduced below:

392

Postal Marketer
 Advertisement Submission Interface
 Process Advertisements

☐ List ads submitted on a certain date 393 394

☐ List ads from a specific advertiser 393 396

Scroll 396

☐ List all ads in date order 397

☐ List all ads by customer 398

Date	Job Name	RefCode	Status

Double Click on Ad to process

399

Figure 34M is a computer interface screen containing various options for listing advertisements with buttons labeled “Submit” near the top of the interface and table 399 on the bottom. *Id.* ¶ 65, Fig. 34M. From Figure 34M and the description in paragraph 165, a person of ordinary skill in the art would understand a user is requesting a search by selecting one of the options such as a date, a specific advertiser, listing in date order, and by customer name. Ex. 1004 ¶ 95 (“a user of the software may submit search queries such as a date or a specific advertiser”); Ex. 2003, 85:5–86:2. Dr. Shamos confirms that Figure 34M will provide a list of matching advertisements if a user submits a search based on date or a specific advertiser. Ex. 1020 94:4–9. Consequently, we find Petitioner establishes that Figure 34M of Reuning discloses this claim limitation.

Because of our finding in connection with step 1[c] that Figures 34F and 34L do not disclose a search query as required by step 1[c], we find Petitioner does not establish that Figure 34F or Figure 34L disclose this limitation which requires “*searching . . . for promotion instances having attributes . . . specified in the search query.*” Pet. 29.

1[e]: returning a list including one or more promotion instances having the attributes corresponding to the attributes specified in the search query;

Petitioner contends Reuning discloses that “after submitting a search using the interface at Figure 34M, the operator of the system would receive a response in the form of a ‘report’ or ‘list of advertisement submissions in the table element 399 Fig 34M’ that match the submitted search criteria.” Pet. 31 (citing Ex. 1003 ¶ 166; Ex. 1004 ¶ 107).

For step 1[e], Patent Owner relies on its contentions for Figure 34M for step 1[d] discussed above. PO Resp. 34.

For the reasons discussed above for step 1[d], we find Petitioner establishes that Figure 34M of Reuning discloses this limitation.

1[f]: receiving, by the one or more computers, a selection of one or more promotion instances, from the returned list, to be included in the promotion list;

Petitioner contends Reuning discloses this limitation because after a user decides that a list of matches is acceptable, “[t]he system then launches an ‘Advertisement Submission Program View and Update Submitted Advertisements’ interface, as shown in Figure 34F, prompting ‘the operator of our invention [to] select[] an[] advertisement by clicking on its row[.]’” Pet. 32 (citing Ex. 1003 ¶¶ 157) (alterations in original). Petitioner further contends that a skilled artisan would have understood that “the selection of a promotion instance of professional data, and the selection of a promotion

instance of advertisement—to be consist in the system’s receiving a selection of one or more promotion instances from a returned matching list to be included in a promotion list.” *Id.* (citing Ex. 1004 ¶ 113).

Patent Owner contends “Figure 34M occurs after Figures 34L and 34F in Reuning’s disclosed process sequence.” PO Resp. 25. Patent Owner also notes that “Figure 34M is not cited for step 1[f] in [the] Petition.” PO Resp. 25; Sur-Reply 23. Patent Owner further contends “the selection of 1[f] must be made from the results of the query of 1[c].” *Id.*

Petitioner, in turn, contends Patent Owner “waived the claim construction argument requiring 1[f] to be performed after 1[c].” Pet. Reply 8. According to Petitioner, “[n]othing precludes a [skilled artisan] from understanding Figure 34M to provide an advertisement in table 399 which may be ‘double click[ed] . . . to be process[ed]’—*i.e.*, selected for modifying.” *Id.* (citing Ex. 1003, Fig. 34M). Petitioner further contends that the processes disclosed in Figures 34L and 34F “are necessarily combined, or, in Reuning’s words, placed in a ‘merger.’” *Id.* at 12 (citing Ex. 1003 ¶¶ 58, 64). Petitioner further contends a skilled artisan “would understand that the combination of these two processes of searching professional data and selecting advertisements discloses the ‘receiving . . . a selection . . . from the returned list’ in step 1[f].” *Id.* at 13 (citing Ex. 1004 ¶ 113); *see also* Tr. 27:5–28:21 (arguing that the Federal Circuit’s decision in *Chamberlain Group v. Techtronic Indus. Co.*, 935 F.3d 1341 (Fed. Cir. 2019) allows for combinability of embodiments for anticipation).

In the Sur-Reply, Patent Owner contends Petitioner is incorrect that “Figure 34L and Figure 34F are ‘necessarily combined, or, in Reuning’s words, placed in a ‘merger.’” Sur-Reply 21. According to Patent Owner,

neither Reuning's paragraph 58 or 64, cited by Petitioner, "describe Figure 34F being used for merger, but instead Ruening makes clear that Figure 34F is an interface for selecting an advertisement for subsequent modification in Figure 34G." *Id.* (citing Ex. 1003 ¶ 159).

For the following reasons, we find Petitioner fails to establish that Reuning discloses this claim limitation.

Patent Owner did not waive but specifically argues in the Patent Owner Response that steps 1[c] through 1[h] must be performed in order. PO Resp. 4. Patent Owner provides a step-by-step analysis showing that the language of claim 1 shows that "step 1f . . . refers back to step 1e," "step 1e . . . refers back to step 1d," and "step 1d . . . refers back to step 1c." *Id.* at 5–6 (emphasis omitted). Petitioner's basis for its contention that the steps do not have to be performed in order is Mr. Hochman's testimony concerning prefetching and indexing. Pet. Reply 4–7. As discussed above in connection with step 1[d], we find this testimony by Mr. Hochman to be entitled to no weight because it is entirely unsupported. We also note that Mr. Hochman's credibility in regard to his testimony that the steps of claim 1 are not required to be performed in order is further undercut by his testimony that he is not familiar with the "the term 'antecedent basis' in patent law." Ex. 2003, 52:22–24. For all of these reasons, we agree with Patent Owner that the plain language of claim 1, including the antecedent basis recited in steps 1[c] to 1[h] requires the steps to be performed in order.

Figure 1 of Reuning is reproduced below:

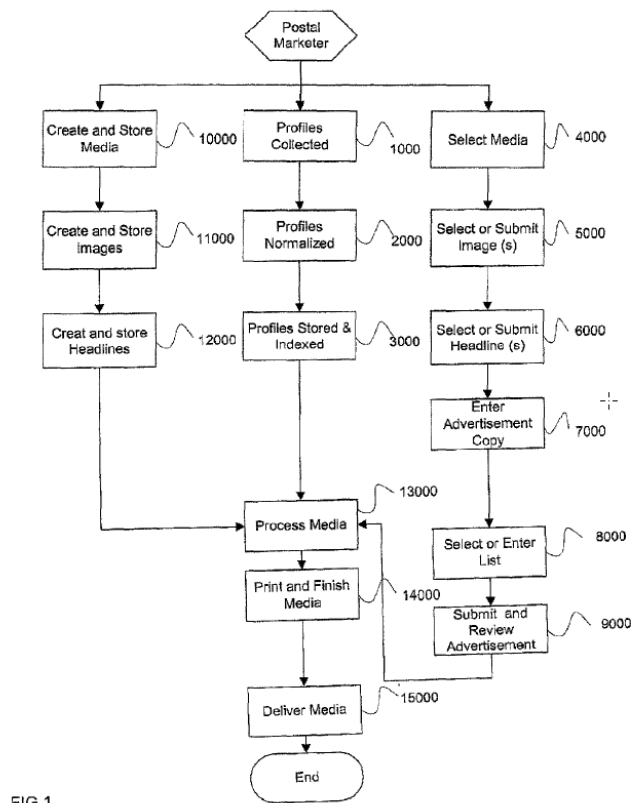


FIG 1

Ex. 1003, Fig. 1. Figure 1 of Reuning “shows the major procedural steps of” Reuning’s process. *Id.* ¶ 13. Figure 34L is used at step 8090 which is part of block 8000 in Figure 1. *Id.* ¶ 64, 156, Figs. 11, 34L. Figure 34F is used at Step 9000. *Id.* ¶¶ 0159, 520, Figs. 12, 34F. Figure 34M is used at Step 13000. *Id.* ¶ 541, Figs. 34M, 37.

As can be seen from the arrows between the boxes 8000, 9000, and 13000 in Figure 1, Figure 34M is the last operation in this sequence. As discussed above in connection with step 1[c], Petitioner relies on Figure 34M to satisfy step 1[c]’s requirement of “receiving . . . a search query.” In order to satisfy step 1[f], Petitioner must point to a part of Reuning’s process that occurs subsequent to the process in Figure 34M. Petitioner’s reliance on Figures 34F and 34L fails to satisfy the requirements

of step 1[f] because the processes in both figures occur prior to the process in Figure 34M. *Id.* at Fig. 1. This is a fact that Petitioner does not dispute. Tr. 22:12–18. Even if we assume Petitioner is correct that Figures 34F and 34L are “necessarily combined” (Pet. Reply 12), that fact would still not solve Petitioner’s problem. Both Figure 34F and Figure 34L occur prior to the process in Figure 34M and Petitioner fails to explain how the combination of the processes in Figure 34F and Figure 34L would change the temporal sequence of steps in Reuning.

For all the foregoing reasons, Petitioner has not shown that Reuning discloses this limitation.

1[g]: assigning the selected promotion instances to the promotions list; and

Petitioner contends a skilled artisan would have understood that “Figure 36B . . . is a graphical interface showing the properties of a promotion instance that has been selected and assigned to a promotion list.” Pet. 33 (citing Ex. 1003, Fig. 36B; Ex. 1004 ¶ 117). Petitioner further contends that “the advertisement list shown at the bottom of Figure 34F, and the professional data list shown at the bottom of Figure 34M, also depict the users can select promotion instances to be assigned to a promotion list using Reuning’s system.” *Id.* (citing Ex. 1004 ¶ 117).

Patent Owner contends Mr. Hochman testified that none of Figures 34F, 34M, or 36B disclose the recited promotion list. PO Resp. 41 (citing Ex. 2003, 116:17–117:5, 120:4–9). Patent Owner further contends “the Petition provides no explanation of how Figure 36B would operate in order to ‘assign[] the selected promotion instances to the promotion list.’” *Id.* at 42. For Figures 34F and 34M, Patent Owner argues that Petitioner only provides conclusory explanations as to how these figures disclose step

1[g]. *Id.* at 42–44. Patent Owner further contends that because Petitioner does not rely on Figure 34M to satisfy the selection of promotion instances in step 1[f], “Figure 34M cannot then disclose the assignment of this selection to the promotions list.” *Id.* at 44 (citing Ex. 2004 ¶ 88).

We agree with Patent Owner that Petitioner fails to provide sufficient evidence or explanation of how any of Figures 34F, 34M, or 36B satisfy this limitation. The entirety of Mr. Hochman’s testimony with respect to step 1[g] is “A [skilled artisan] viewing the below figures [Figs. 36B, 34F, 34M] from Reuning would understand them to disclose ‘assigning the selected promotion instances to the promotion list’ by providing interfaces that show the properties, products, or services in the returned lists for display to the user.” Ex. 1004 ¶ 117. There is no explanation offered how Figure 36B relates to any of Figures 34F, 34L, or 34 M upon which Petitioner relies for steps 1[c] through 1[f]. *See* Pet. 33; Pet. Reply 13–14. Petitioner fails to direct us to any disclosure in Reuning where Figure 36B is described. *See* Pet. 33; Pet. Reply 13–14. Figure 36B appears to be merely a list of names and addresses not a list of promotion instances. The only description of Figure 36B we have been able to locate is that it “is a schematic that is how, in our invention, key features of the Data window appear in a computer interface screenshot of a graphic application such as Darwin Desktop and QuarkXpress used according to our invention.” Ex. 1003 ¶ 80. Petitioner’s citation to Mr. Hochman’s deposition testimony in the Petitioner Reply is no more enlightening as to how what is displayed in the table shown in Figure 36B relates to this claim limitation, the function of Figure 36B, or how it relates to any of the other figure in Reuning cited for prior steps 1[c] through

1[f]. For these reasons, we find Petitioner fails to establish that Figure 36B of Reuning discloses this limitation.

Because Petitioner has not shown that the processes shown in any of Figure 34F, Figure 34L, or Figure 34M satisfy the requirement of step 1[f] to “return[] a list including one or more promotion instances. . . corresponding to the . . . search query,” Petitioner has not established that Reuning discloses the requirement of “assigning *the selected promotion instances*” in step 1[g]. Ex. 1001, 24:48–67.

For all the foregoing reasons, Petitioner has not shown that Reuning discloses this limitation.

1[h]: storing the promotion list in an electronic medium.

Petitioner contends that Reuning discloses this limitation. Pet. 34 (citing Ex. 1004 ¶ 118). In particular, Petitioner contends that a skilled artisan would have understood that step 9060 shown in Reuning’s Figure 12 corresponds to “the step of storing advertisements that have been reviewed, modified, and selected to be placed on a promotion list.” *Id.* at 34–35 (citing Ex. 1003 ¶¶ 160–167, Fig. 12; Ex. 1004 ¶ 120).

Because Petitioner fails to establish the requirement of step 1[f] or 1[g] relating to assigning promotion stances to the promotion list, Petitioner fails to establish that Reuning discloses storing such the recited promotion list.

Claim 1 Conclusion

For all of the reasons discussed above, Petitioner fails to establish by a preponderance of the evidence that claim 1 is anticipated by Reuning.

3. *Claims 2–5 and 7–10*

Claims 2–5 and 7–10 depend directly or indirectly from claim 1. Ex. 1001, 25:1–22, 25:27–45. We reviewed Petitioner’s arguments and evidence in support of its contentions for these dependent claims and find that the additional evidence does not cure the deficiencies identified for claim 1. Consequently, Petitioner fails to establish that any of claims 2–5 and 7–10 are anticipated by Reuning.

III. CONCLUSION

Based on the record before us, we determine the following:

Claims	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Not shown Unpatentable
1–5, 7–10	102(a)	Reuning		1–5, 7–10
Overall Outcome				1–5, 7–10

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, based on the preponderance of the evidence, claims 1–5 and 7–10 of the ’904 patent have not been shown to be unpatentable; and

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

IPR2020-01656
Patent 8,315,904 B2

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