

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, LLC,
Petitioner,

v.

MCOM IP, LLC,
Patent Owner.

IPR2022-00055
Patent 8,862,508 B2

Before ERIC C. JESCHKE, FREDERICK C. LANEY, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

JESCHKE, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. BACKGROUND

Petitioner, Unified Patents, LLC, challenges claims 1, 3–7, 9–13, 15, 16, and 18–20 of U.S. Patent No. 8,862,508 B2 (Ex. 1001, “the ’508 patent”), assigned to Patent Owner, mCom IP, LLC. We have jurisdiction under 35 U.S.C. § 6, and we issue this Final Written Decision under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons below, we conclude that Petitioner has proven, by a preponderance of the evidence, the unpatentability of each of the challenged claims.

A. *Procedural History*

Petitioner filed a Petition to institute *inter partes* review of challenged claims 1, 3–7, 9–13, 15, 16, and 18–20. Paper 1 (“Pet.”). Patent Owner filed a Preliminary Response. Paper 7. Upon review of the arguments and supporting evidence, we instituted *inter partes* review of all claims and grounds asserted in the Petition. Paper 11 (“Decision on Institution” or “Dec. Inst.”). After institution, Patent Owner filed a Response (Paper 15, “PO Resp.”), and Petitioner filed a Reply (Paper 20, “Pet. Reply”). Patent Owner did not file a Sur-reply.

Petitioner relies on the declaration testimony of Mr. Ian Jestice, filed with the Petition. Ex. 1002 (“Jestic Decl.”). Patent Owner relies on the declaration testimony of Mr. Perry Landers, filed with the Response. Ex. 2002 (“Landers Decl.”). An oral argument in this proceeding was held on December 6, 2022, and a copy of the transcript was entered into the record. Paper 29 (“Tr.”).

B. *Related Proceedings*

The parties have identified several proceedings involving the ’508 patent. *See* Pet. 1–4; Paper 4 (Patent Owner’s Mandatory Notices) at 2–4;

Paper 25 (Patent Owner's Updated Mandatory Notice); *see also* Dec. Inst. 3–5 (providing the list of proceedings at the time of institution).

C. Real Parties in Interest

Petitioner identifies itself as the real party in interest. Pet. 1 (citing Ex. 1010). Patent Owner identifies itself as the real party in interest. Paper 4 at 2.

D. The '508 Patent

The '508 patent “is directed to a system and method for delivering a retail banking multi-channel solution that unifies interactive electronic banking touch points to provide personalized financial services to customers and a common point of control for financial institutions.” Ex. 1001, 1:18–23. Figure 1 is reproduced below:

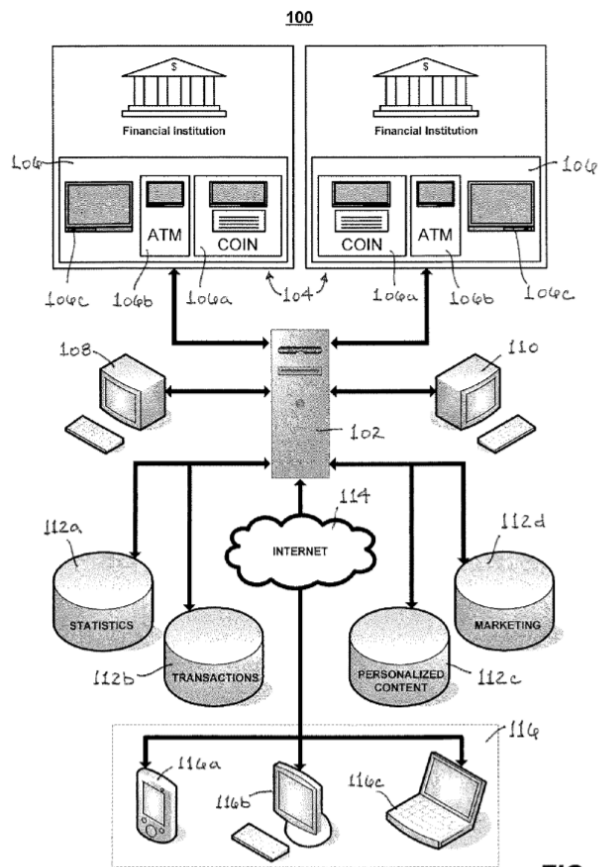


FIG. 1

Figure 1 depicts “a schematic diagram of a banking platform system networked with a modular multi-channel server.” Ex. 1001, 2:56–57.

Depicted system 100 includes “multi-channel server 102 networked to a plurality of branch locations 104 associated with a financial institution, wherein each branch location employs the use of various e-banking touch points 106.” *Id.* at 3:28–33.¹ As examples of e-banking touch points 106, the ’508 patent discloses “an automatic teller/transaction machine (ATM) touch point 106b, a self-service coin counter (SSCC) touch point 106a, a plasma signage display (PSD) touch point 106c, alternate e-banking system touch points (e.g., a kiosk) or any combination thereof.” *Id.* at 3:33–38.

“Multi-channel server 102 is additionally coupled to a marketing computer system 108 and an operations computer system 110 via the network.” Ex. 1001, 3:42–44. The ’508 patent also discloses exemplary databases 112a–d, with data related to customer statistics, customer transactions, personalized customer content, and marketing. *See id.* at 3:64–4:8. “Customers of the financial institution may interact with multi-channel server 102 via an Internet network 114 utilizing web-enabled customer devices 116,” such as personal digital assistant device 116a, personal computer 116b, or wireless laptop 116c. *Id.* at 4:9–15.

In operation, a user can authenticate their identity using e-banking touch point 106, and then server 102 retrieves and delivers data, including data associated with the user’s preferences, to e-banking touch point 106. *See* Ex. 1001, 4:52–5:7. Marketing personnel may use marketing computer system 108 to manage marketing campaigns, including scheduling delivery

¹ In this Decision, we omit emphasis on reference numerals in quotations from the ’508 patent and prior art references.

of certain marketing materials to customers via e-banking touch points 106.
See id. at 6:33–7:12.

E. The Challenged Claims

Petitioner challenges claims 1, 3–7, 9–13, 15, 16, and 18–20, of which claims 1, 7, and 13 are independent. Claims 3–6 depend from claim 1, claims 9–12 depend from claim 7, and claims 15, 16, and 18–20 depend from claim 13. Independent claim 1 is reproduced below, reformatted from the version provided in the '508 patent and with bracketed letters and numbers added to identify certain language:

1. [1pre] A method for constructing a unified electronic banking environment, said method comprising the steps of:

[1.A] providing at least one common multi-channel server coupled to more than one e-banking touch points and also coupled to at least one computer system configured with at least one control console, said more than one e-banking touch points and said at least one computer system being provided in locations remote from the other, [1.B] and further wherein said more than one plurality of e-banking touch points are comprised of at least two different types of e-banking touch point devices, each of which comprise one or more of an automatic teller/transaction machine (ATM), a self service coin counter (SSCC), a kiosk, a digital signage display, an online accessible banking website, a personal digital assistant (PDA), a personal computer (PC), a laptop, a wireless device, or a combination of two or more thereof, and wherein at least one of said e-banking touch points is in communication with one or more financial institutions through said multi-channel server;

[1.C] receiving an actionable input from at least one e-banking touch point;

[1.D] retrieving previously stored data associated with said actionable input, wherein said previously stored data is accessible to any one of said e-banking touch points, and said

previously stored data comprises data from one or more financial institutions and one or more user-defined preferences;

[1.E] delivering said retrieved data to said at least one e-banking touch point transmitting said actionable input;

[1.F1] storing transactional usage data associated with said at least one e-banking touch point transmitting said actionable input, [1.F2] wherein said stored transactional usage data is accessible by any one of said more than one e-banking touch points and said at least one computer system;

[1.G] monitoring via said server an active session in real-time for selection of targeted marketing content correlated to said user-defined preferences;

[1.H] subsequent to said monitoring, selecting in real-time said targeted marketing content correlated to said user-defined preferences; and

[1.I] transmitting in real-time said targeted marketing content during said active session to at least one of said e-banking touch points for acceptance, rejection, or no response by a user, wherein said response by said user is used during said active session to determine whether transmission of additional information related to said marketing content occurs during said active session.

Ex. 1001, 8:44–9:24.²

² We adopt and apply below Petitioner's designations for the elements of the challenged claims. *See* Pet. 15–54 (showing numerical designations for the language in the challenged claims).

F. Instituted Grounds of Unpatentability

We instituted *inter partes* review of the challenged claims based on the following grounds asserted by Petitioner:

Claim(s) Challenged	35 U.S.C. § ³	Reference(s)/Basis
1, 3, 5–7, 9, 11, 12	103(a)	Lawlor, ⁴ Bouve, ⁵ De Leo, ⁶ Looney ⁷
13, 15, 16, 19, 20	103(a)	Lawlor, Bouve, De Leo, Looney, Kawan ⁸
4, 10	103(a)	Lawlor, Bouve, De Leo, Looney, Arsenault ⁹
18	103(a)	Lawlor, Bouve, De Leo, Looney, Kawan, Arsenault

II. DISCUSSION

A. The Level of Ordinary Skill in the Art

The level of ordinary skill in the art is “a prism or lens” through which we view the prior art and the claimed invention. *Okajima v. Bourdeau*,

³ The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. § 103 that became effective on March 16, 2013. Pub. L. No. 112-29, §§ 3(c), 3(n)(1), 125 Stat. 284, 287, 293 (2011). Because there is no dispute that the challenged claims of the ’508 patent have an effective filing date before March 16, 2013, we apply the pre-AIA version of this statute. We would reach the same outcome, however, under the AIA version.

⁴ US 5,870,724, issued February 9, 1999 (Ex. 1004, “Lawlor”).

⁵ US 5,682,525, issued October 28, 1997 (Ex. 1006, “Bouve”).

⁶ US 2003/0141360 A1, published July 31, 2003 (Ex. 1005, “De Leo”).

⁷ US 7,925,549 B2, issued April 12, 2011 (Ex. 1007, “Looney”).

⁸ US 5,796,832, issued August 18, 1998 (Ex. 1008, “Kawan”).

⁹ US 7,877,290 B1, issued January 25, 2011 (Ex. 1009, “Arsenault”).

261 F.3d 1350, 1355 (Fed. Cir. 2001). The person of ordinary skill in the art is a hypothetical person presumed to have known the relevant art at the time of the invention. *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995). In determining the level of ordinary skill in the art, we may consider certain factors, including the “type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.” *Id.*

Petitioner contends, with accompanying declaration testimony, that a person having ordinary skill in the art at the time of the invention “would have had at least (i) a Bachelor of Science in Computer Science, Computer Engineering, Information Systems, or the equivalent, and (ii) approximately two years of experience with data/content selection and transmission-related fields.” Pet. 14–15 (citing Jestic Decl. ¶¶ 31–32).

In the Decision on Institution, we adopted Petitioner’s proposed level of ordinary skill in the art, stating that it “appears consistent with the record at th[at] stage of the proceeding, including the prior art.” Dec. Inst. 12. In the Response, Patent Owner also adopts Petitioner’s proposed level. *See* PO Resp. 11. We maintain the definition of the level of ordinary skill in the art adopted at institution.

B. Claim Construction

In *inter partes* reviews, the Board interprets claim language using the same claim construction standard that would be used in a civil action under 35 U.S.C. § 282(b), as described in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). *See* 37 C.F.R. § 42.100(b). Under that standard, we generally give claim terms their ordinary and customary meaning, as

would be understood by a person of ordinary skill in the art at the time of the invention, in light of the language of the claims, the specification, and the prosecution history. *See Phillips*, 415 F.3d at 1313–14. Although extrinsic evidence, when available, may also be useful when construing claim terms under this standard, extrinsic evidence should be considered in the context of the intrinsic evidence. *See id.* at 1317–19.

Petitioner states that, “[f]or purposes of this Petition, no specific claim construction (beyond plain and ordinary meaning) is necessary.” Pet. 15. Patent Owner responds that the terms of the challenged claims “are clear on their face.” PO Resp. 6 (citing Landers Decl. ¶¶ 21–22).

Based on the complete record, we do not discern a need to construe explicitly any claim terms because doing so would not change the result of the analysis below. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (stating that “we need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))). We do, however, address certain claim construction issues in the discussion of elements 1.A and 1.I below.

C. Asserted Obviousness of Claims 1, 3, 5–7, 9, 11, and 12 Based on Lawlor, Bouve, De Leo, and Looney

Petitioner asserts that claims 1, 3, 5–7, 9, 11, and 12 of the ’508 patent would have been obvious under 35 U.S.C. § 103(a) based on Lawlor, Bouve, De Leo, and Looney. Pet. 6, 15–60. Patent Owner provides arguments addressing this asserted ground. PO Resp. 12–26. We first summarize aspects of the prior art references.

interchange switch 66.” *Id.* at 17:61–64. In addition, central computer 52 “electronically communicates with additional remote data processing systems such as the Federal Reserve ACH 72 (e.g., via a Federal Reserve Bank data processing system 74), debit networks 76, wholesalers/remittance processors 78, direct payee computer systems 80, third party information providers 82 and advertisers 84.” *Id.* at 18:35–40. Lawlor discloses that central computer 52 is programmed “to perform various billpaying and other financial functions and to distribute billpaying and other services to remote terminals 54 on demand.” *Id.* at 19:8–12.

2. Bouve

Bouve discloses a system and method of retrieving and managing information stored in a remote database by an operator using a computer system. Ex. 1006, codes (54), (57), 5:39–52.

Figure 1 of Bouve is reproduced below:

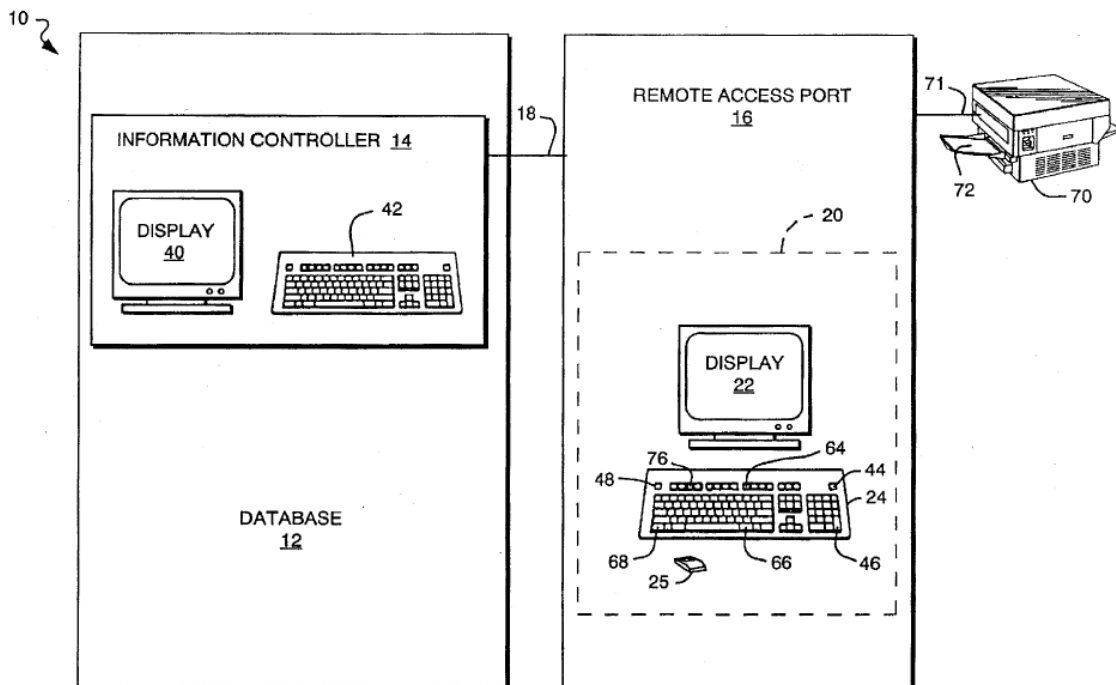


FIG. 1

Figure 1 depicts a system 10, which includes, among other aspects, database 12 with information controller 14, which includes display 40 and keyboard 42. *See* Ex. 1006, 4:53–59, 5:39–42. Controller 14 communicates with remote access port 16 via communications link 18. *See id.* at 4:56–59.

3. De Leo

De Leo discloses a “system and method for providing information and services to and from an automated teller machine.” Ex. 1005 ¶ 2.

Figure 8 of De Leo is reproduced below:

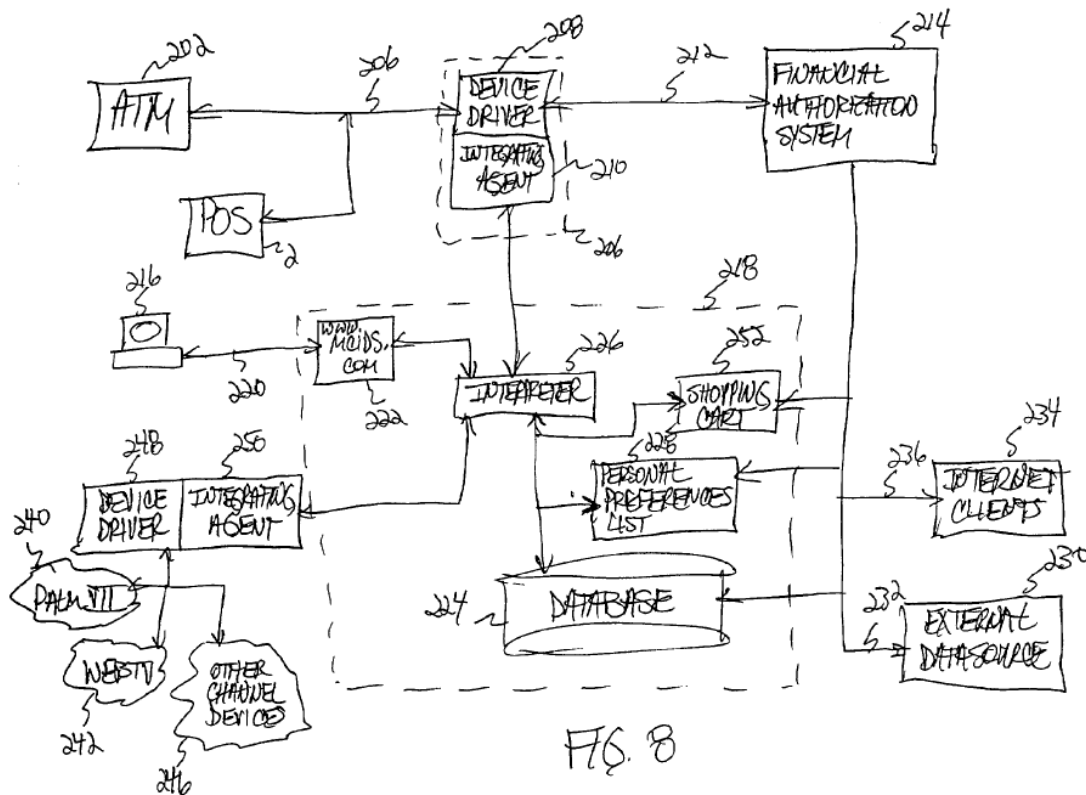


Figure 8 depicts “a multi-channel interactive distribution system for the interconnection of automated teller machines and the Internet.” Ex. 1005 ¶ 17. The system in Figure 8 includes, among other aspects, server 218, which includes database 224 and personal preferences list 228, as well as ATM 202. *See id.* ¶ 80. De Leo discloses that targeted advertisements,

based on user preferences, can be sent to customers when interacting with ATMs. *See id.* ¶¶ 82, 90–91, 111.

4. Looney

Looney “relates generally to data collection and message presentation systems” and, in particular, “relates to architecture for presenting a personalized advertising message.” Ex. 1007, 1:15–18.

Figure 2 of Looney is reproduced below:

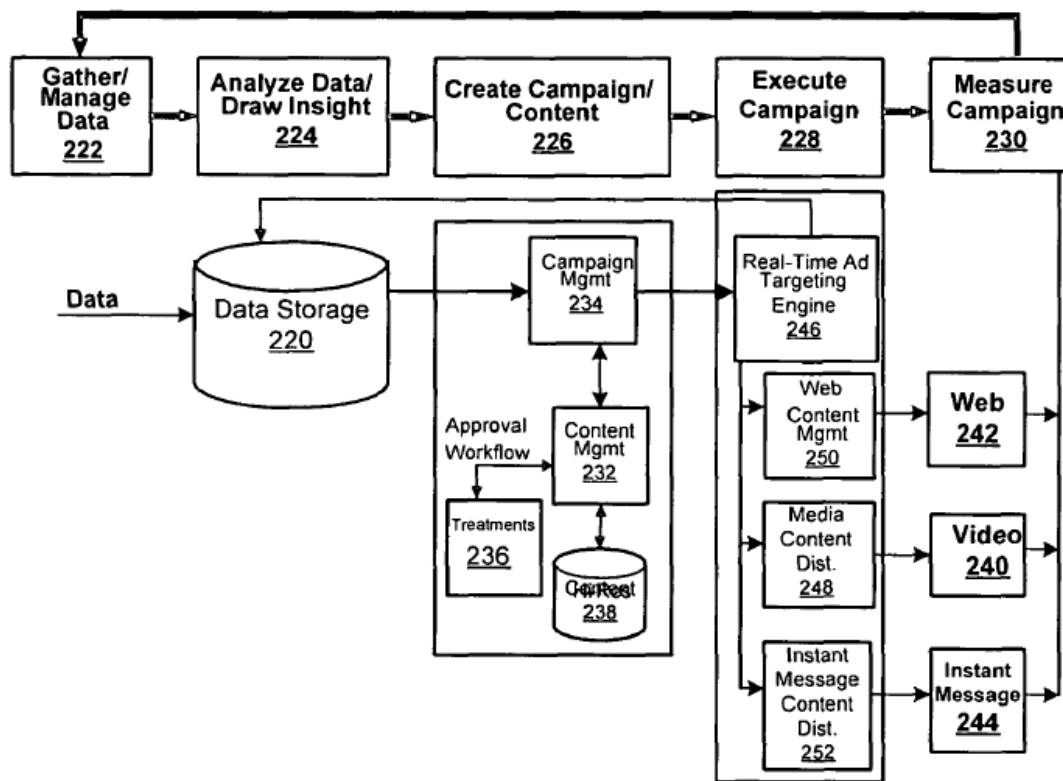


Figure 2

Figure 2 depicts an “example for a personalized marketing architecture.” Ex. 1007, 2:43–44. The exemplary architecture depicted includes, among other aspects, “data gathering and management 222, analysis of the data 224, campaign/content creation 226, campaign execution

228, and campaign measurement 230.” *Id.* at 5:9–13. The architecture also may include real-time advertisement targeting engine 246, which, according to Looney, “identifies and selects a personalized advertising message to be targeted to an individual that will have customer-specific information and content.” *Id.* at 8:59–64.

5. *Independent Claim 1*

For independent claim 1, Petitioner contends that the proposed combination of Lawlor, Bouve, De Leo, and Looney discloses each limitation. Pet. 15–54. To support its arguments, Petitioner identifies certain passages in the cited references and explains the significance of each passage with respect to the corresponding claim limitation. *Id.* Petitioner also articulates reasons to combine the relied-upon aspects of Lawlor, Bouve, De Leo, and Looney and explains why there would have been a reasonable expectation of success. *Id.* In the below analysis, we first address the contested limitations 1.A and 1.I.

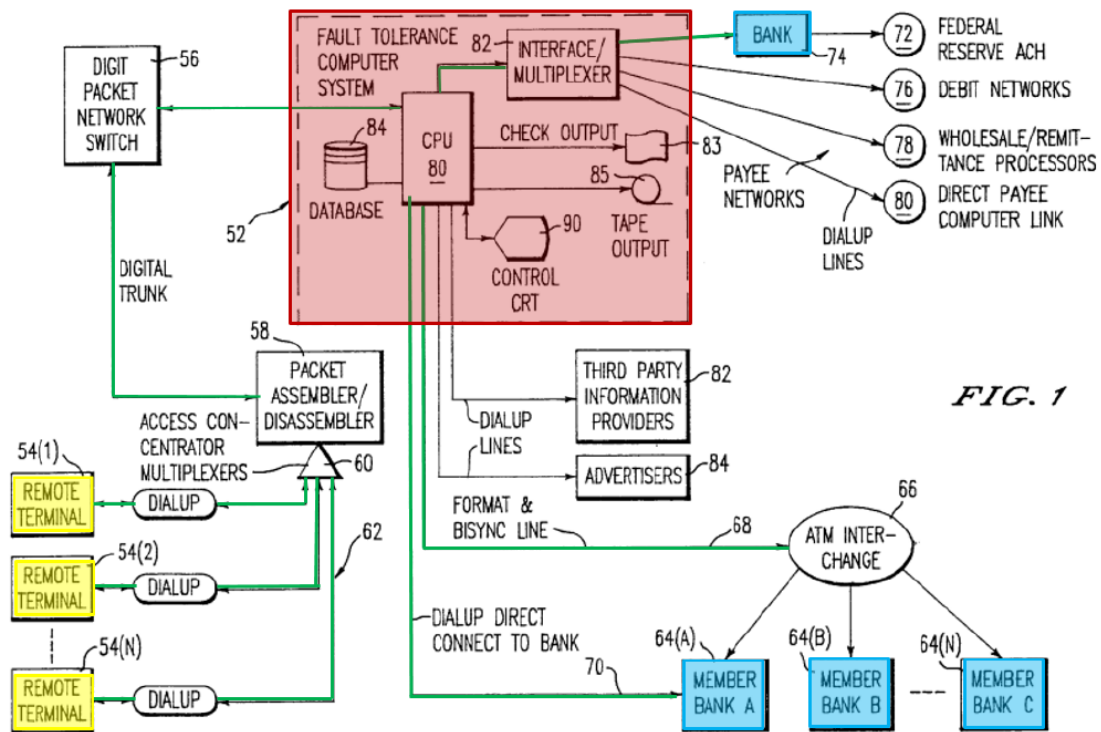
a. Element 1.A

Element 1.A recites

providing at least one common multi-channel server coupled to more than one e-banking touch points and also coupled to at least one computer system configured with at least one control console, said more than one e-banking touch points and said at least one computer system being provided in locations remote from the other.

Ex. 1001, 8:46–52.

Petitioner argues that Lawlor discloses, or renders obvious, element 1.A, alone or in combination with Bouve. *See* Pet. 16–24. In the discussion of element 1.A, Petitioner provides the following annotated version of Figure 1 of Lawlor:



Pet. 18. Figure 1 of Lawlor is “a block diagram . . . of a financial services distribution system.” Ex. 1004, 16:58–59. In the annotated version of Figure 1 here, Petitioner added (1) red highlighting to central computer 52, (2) yellow highlighting to Remote Terminals 54, (3) blue highlighting to Members Banks 64 and Bank 74, and (4) green highlighting to connections. Pet. 18.

Petitioner identifies central computer 52 (in red highlight above) as the recited “multi-channel server” and states that central computer 52 is connected (i.e., “coupled”) to the “more than one e-banking touch points” (remote terminals 54, highlighted in yellow). Pet. 17–18 (citing Ex. 1004, Fig. 1, 17:29–33, 19:7–12; Jestice Decl. ¶ 86). Petitioner states that central computer 52 is also coupled to “at least one computer system configured with at least one control console,” which “resides with the member banks 64 and bank 74 (blue) and/or with the operator of the Lawlor’s central computer

52” (red). Pet. 17 (citing Ex. 1004, Fig. 1, 18:11–54; Jestice Decl. ¶¶ 86–87). Petitioner discusses why one of ordinary skill in the art “would have understood from Lawlor’s disclosure that Lawlor’s central computer 52 [(in red above)] is *coupled to at least one computer system configured with at least one control console.*” Pet. 19 (citing Jestice Decl. ¶¶ 86–87); *see* Pet. 19–20 (citing Jestice Decl. ¶¶ 53, 86–87) (entire discussion). Petitioner also discusses why the “e-banking touch points” and “at least one computer system” are in “locations remote from the other,” as recited in element 1.A. *See* Pet. 20–21 (citing Ex. 1004, 1:15–17; Jestice Decl. ¶ 91).

In the alternative, Petitioner states, “[t]o the extent Lawlor does not render obvious *at least one computer system configured with at least one control console*, Bouve does.” Pet. 21 (citing Jestice Decl. ¶ 92). According to Petitioner, “Bouve discloses that operators need to ‘add and modify the information within [a] database’” (Pet. 21 (citing Ex. 1006, 5:39–52; Jestice Decl. ¶ 93)), which “can be done using a ‘controller’ (a *computer system*) that ‘preferably includes a display 40 and a keyboard 4[2]’ (a *control console*) and ‘through control of a system operator typing commands at the keyboard 42’” (*id.* (citing Jestice Decl. ¶ 93)). Petitioner also discusses why one of ordinary skill in the art would have been motivated to combine Lawlor and Bouve and would have had a reasonable expectation of success as to element 1.A. *See* Pet. 21–24.

In this proceeding, Petitioner presents three alternative options as to the “control console” limitation (which recites “at least one computer system configured with at least one control console” coupled to the “multi-channel server”): (1) that one of ordinary skill in the art would have reasonably inferred from Lawlor the presence of “at least one computer system

configured with at least one control console” coupled to the “multi-channel server” (i.e., central computer 52) and residing with the operator of central computer 52 (*see* Pet. 17); (2) that one of ordinary skill in the art would have reasonably inferred from Lawlor the presence of “at least one computer system configured with at least one control console” coupled to the “multi-channel server” (i.e., central computer 52) and residing with member banks 64 and bank 74 (in blue highlighting above) (*see* Pet. 17)¹⁰; and (3) that Bouve expressly discloses “at least one computer system configured with at least one control console” that would be coupled to the “multi-channel server” (i.e., central computer 52) for reasons provided by Petitioner (*see* Pet. 21–23). *See also* Tr. 18:25–19:10 (listing these three options with respect to the “control console” limitation).

Patent Owner presents several arguments as to why none of the option(s) relied on by Petitioner satisfy element 1.A. *See* PO Resp. 14–21. We address each of Patent Owner’s arguments below with reference to the option(s) of Petitioner’s to which each argument applies. First, Patent Owner argues that one of ordinary skill in the art “would have recognized that because users of Lawlor’s remote terminals [(i.e., elements 54)] can set transactions to be processed in the future, central computer 52 *can have* a control console to access and process these payments,” and thus, according to Patent Owner, “it is not necessary that banks and/or the operators of Lawlor’s central computer would need a computer system with a control

¹⁰ In the Reply, Petitioner confirms that the first two options are implicit disclosure theories (i.e., addressing how one of ordinary skill in the art would have understood Lawlor), as opposed to inherency theories. *See* Pet. Reply 4 (citing *In re Preda*, 401 F.2d 825, 826 (CCPA 1968)).

console to access and process these payments.” PO Resp. 17–18 (citing Landers Decl. ¶ 62).

This argument does not identify a deficiency in Petitioner’s position, especially as to options 2 and 3 above. *See* Jestice Decl. ¶ 92 (discussing why the “computer system” and “control console” identified in Bouve would have been located at, for example, member banks 64/bank 74 in Lawlor), *cited at* Pet. 21. As an initial matter, given the open-ended nature of claim 1—using “comprising” in the preamble and reciting “*at least one* computer system configured with *at least one* control console” (emphasis added)—claim 1 does not preclude the presence of *more than one* “control console.” *See Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 1319 (Fed. Cir. 2009) (“The claim uses the term ‘comprising,’ which is well understood in patent law to mean ‘including but not limited to.’”); Pet. Reply 8 (discussing how “Petitioner’s position that member banks would have included *computer systems* with *control consoles* does not preclude the central computer 52 from employing its own *control console*”). And, as argued by Petitioner, Patent Owner has not argued “that the central computer 52 would employ controls *instead of* at the member banks.” Pet. Reply 8–9.

Further, in the Petition and in the Reply, Petitioner explains, and supports with the testimony of Mr. Jestice, why one of ordinary skill in the art would have understood member banks 64 and bank 74 in Lawlor to have had “at least one computer system configured with at least one control console,” regardless of whether central computer 52 in Lawlor *also* had a “control console.” For example, Petitioner discusses disclosures in Lawlor as to (1) processing payments and (2) collecting user information via mailing or telephone, both of which would implicitly require the presence of “at least

one computer system configured with at least one control console” in order to input the received user information and also discusses why one of ordinary skill in the art would have understood those two disclosures as indicating that the “computer system” and “control console” would have been present at relied-upon member banks 64 and bank 74. *See* Pet. 19 (“Lawlor states that users of the remote terminals may designate payments to take place at a later time, which the internal bank systems will necessarily have to process.” (citing Ex. 1004, 42:47–43:9; Jestice Decl. ¶¶ 86–87)), 20 (“Therefore, [one of ordinary skill in the art] would have understood that to enter the customer information into database 84 and provide customer service—such as correcting improperly entered future payments—the bank and/or third party managing central computer 52 must be *coupled to at least one computer system configured with at least one control console* in order to interact and edit database 84 as required.” (citing Jestice Decl. ¶¶ 86–87)).

In the cited testimony, Mr. Jestice explains why the system of Lawlor would be “inoperable” without “at least one computer system configured with at least one control console” at member banks 64 and bank 74. *See* Jestice Decl. ¶ 87 (“[One of ordinary skill in the art] would have understood that with at least one computer system configured with at least one control console, as without one neither banks nor the operator of Lawlor’s system would have any access to the Lawlor’s system and, thus, it would be inoperable. After all, if the transaction cannot be processed and the advertisement cannot be loaded into Lawlor’s system, the system will not be able to operate as described.”). We find this assertion supported by the record. For example, we are persuaded by Petitioner’s position that it would be illogical for a bank to not have a computer and control console *at the*

location of the bank itself to input necessary data for its operations. *See* Pet. Reply 6 (“It is nonsensical that banking institutions would not be able to have access to its own customer data to perform its basic functions, and would instead be required to share a *control console* at a common server.”).

Further, as noted by Petitioner (*see* Pet. Reply 6), the testimony of Mr. Landers cited by Patent Owner here merely repeats Patent Owner’s argument and does not squarely address Petitioner’s assertion (or Mr. Jestice’s accompanying testimony) as to the understanding of one of ordinary skill in the art regarding the implied presence of “at least one computer system configured with at least one control console” at member banks 64 and bank 74. *Compare* PO Resp. 18, *with* Landers Decl. ¶ 62.

As to Patent Owner’s argument that the recited “[c]ommon multi-channel server, e-banking touch point and computer system configured with at least one control console” must be “separate and distinct” (PO Resp. 14–16), as argued by Petitioner, at least in options 2 and 3 above—with the “at least one computer system configured with at least one control console” at member banks 64 and bank 74—the identified “server,” “e-banking touch points,” and “at least one computer system configured with at least one control console” *are* distinct components in the prior art, in that they are each individually and specifically identified. *See* Pet. Reply 3–4 (responding to Patent Owner’s “separate and distinct” argument by highlighting the “computer system” “residing with the member banks 64 and bank 74 indicated in blue” in the annotated version of Figure 1 of Lawlor).

Second, Patent Owner argues that “there is no substance in Petitioner’s assertion that in order to interact and edit database 84, central computer 52 must be coupled to at least one computer system configured

with at least one control console” in that, because “database 84 is in the central computer 52, the central computer 52 can employ a control console of itself to interact and edit database 84.” PO Resp. 18–19.

For the same reasons discussed above as to the first argument for element 1.A, this argument does not identify a deficiency in Petitioner’s position at least as to option 2. As discussed above, Petitioner has adequately explained, with supporting testimony of Mr. Jestice, why one of ordinary skill in the art would have understood member banks 64 and bank 74 in Lawlor to have had “at least one computer system configured with at least one control console,” regardless of whether central computer 52 in Lawlor *also* had a “control console.”

Third, turning to the alternative reliance on Bouve as to the “at least one computer system configured with at least one control console,” Patent Owner argues that “[t]he counterpart of [the relied-upon] ‘controller’ of Bouve in the ’508 Patent is common multi-channel server since the common multi-channel server controls the access and flow of information into and out of the database 112.” PO Resp. 20–21 (citing Ex.1001, 3:64–4:3, Fig. 1). According to Patent Owner, because “Bouve teaches that the common multi-channel server has one control console at most, Bouve does not disclose the limitation ‘common multi-channel server coupled to at least one computer system configured with at least one control console’ as required by claim 1.” *Id.* at 21 (citing Landers Decl. ¶ 71).

This argument does not identify a deficiency in Petitioner’s alternative reliance on Bouve as to “at least one computer system configured with at least one control console.” As argued by Petitioner, Patent Owner does not *actually address* Petitioner’s alternative position as to Bouve. *See Pet.*

Reply 9–10). Specifically, Patent Owner does not challenge Petitioner’s position that controller 14 in Bouve would have been understood as a “computer system” and that display 40/ keyboard 42 in Bouve would have been understood as a “control console” (as testified to by Mr. Jestice (*see* Pet. 21 (citing Jestice Decl. ¶ 93))); instead, Patent Owner challenges a position *not taken* by Petitioner—i.e., that controller 14 in Bouve satisfies the recited “common multi-channel server” recited *elsewhere* in element 1.A. *See* PO Resp. 20–21.

We determine that the position actually taken by Petitioner—that Bouve discloses “at least one computer system configured with at least one control console” with its disclosures as to controller 14 and display 40/keyboard 42 (*see* Pet. 21 (citing Ex. 1006, 5:39–42; Jestice Decl. ¶ 93))—is adequately supported by the record and uncontested by Patent Owner.

For the reasons above, we find the “control console” limitation of element 1.A satisfied by either the implicit disclosures of Lawlor in that one of ordinary skill in the art would have understood “at least one computer system configured with at least one control console” to be present at the location of member banks 64 and bank 74 (i.e., option 2 above) *or* by the express disclosure of “at least one computer system configured with at least one control console” in Bouve (i.e., option 3 above) located at the member banks 64/bank 74 in Lawlor. *See* Jestice Decl. ¶ 92 (discussing why the “computer system” and “control console” identified in Bouve would have been located at, for example, member banks 64/bank 74 in Lawlor), *cited at* Pet. 21.

As to the remaining aspects of element 1.A, we find Petitioner’s positions adequately supported by the record, including the testimony of Mr.

Jestice. *See* Pet. 16–24 (citing Jestice Decl. ¶¶ 84–103). For the reasons above, we find, based on the complete record, that Petitioner has demonstrated by a preponderance of the evidence that Lawlor discloses the subject matter of element 1.A and, in the alternative, that Lawlor in view of Bouve discloses the subject matter of element 1.A.¹¹

b. Element 1.I

Element 1.I recites

transmitting in real-time said targeted marketing content during said active session to at least one of said e-banking touch points for acceptance, rejection, or no response by a user, wherein said response by said user is used during said active session to determine whether transmission of additional information related to said marketing content occurs during said active session.

Ex. 1001, 9:18–24.

Petitioner argues that Lawlor in view of De Leo discloses, or renders obvious, element 1.I. *See* Pet. 49–54. Specifically, Petitioner states, “Lawlor describes that ‘if the inputted number is valid, central computer 52 transmits advertising or messaging text to remote terminal 54—this advertising text preferably being targeted to a specific user or user group (block 380),’” and thus, “Lawlor transmits a targeted advertisement (*said targeted marketing content*) during an active session, after a user enters their valid PIN (i.e., *in real-time*) to the user’s remote terminal (*at least one of said e-banking touch points*).” Pet. 50 (quoting Ex. 1004, 39:25–28) (citing Jestice Decl. ¶ 196). Petitioner also states that (1) “Lawlor adds that after a user views the advertisement, ‘[c]entral computer 52 then preferably sends

¹¹ Patent Owner argues that De Leo and Looney do not disclose element 1.A (PO Resp. 21), but Petitioner did not rely on those references as to element 1.A (Pet. 16–24).

an additional display screen to remote terminal 54 asking the user whether he wants additional information” (quoting Ex. 1004, 39:25–47) and (2) “[i]f the user selects for more information, Lawlor will allow the advertiser to send the user additional information” (quoting Ex. 1004, 39:55–62), in support of the assertion that Lawlor thus “provides the advertisement *for acceptance, rejection, or no response by a user as part of determining whether transmission of additional information related to said marketing content occurs during said active session.*” Pet. 50 (citing Jestic Decl. ¶ 197).

According to Petitioner, “[t]o the extent Lawlor does not expressly disclose *wherein said response by said user is used during said active session to determine whether transmission of additional information related to said marketing content occurs during said active session*, De Leo does.” Pet. 50–51 (citing Jestic Decl. ¶ 198). In support, Petitioner identifies certain examples in De Leo of “transmission of additional information related to said marketing content,” including coupons, tickets, and smartcards. Pet. 51 (emphasis omitted) (citing Jestic Decl. ¶¶ 199–201). Petitioner also discusses why one of ordinary skill in the art would have been motivated to apply the teachings of De Leo to Lawlor and would have had a reasonable expectation of success as to element 1.I. *See* Pet. 51–54.

Patent Owner presents two arguments as to why “Lawlor in view of De Leo[] does not teach” element 1.I. PO Resp. 22; *see also id.* at 22–24 (entire argument). First, Patent Owner argues that element 1.I requires “that ‘marketing content’ is viewed by a user, the user can determine his response to the ‘marketing content’ (acceptance, rejection, or no response), but the user can not directly determine ‘whether transmission of additional

information related to said marketing content occurs,” and argues that, in the context of claim 1, “[t]he transaction system rather than the user determines ‘whether transmission of additional information related to said marketing content occurs’ based on monitoring the response on the ‘marketing content’ of the user.” *Id.* at 22–23 (citing Landers Decl. ¶ 77). According to Patent Owner, Petitioner’s argument fails because, in Lawlor, “the user rather than the transaction system determines ‘whether transmission of additional information related to said marketing content occurs,’ which is distinct from” element 1.I. *Id.* at 23 (citing Landers Decl. ¶ 79).

We disagree as the language of element 1.I does not support Patent Owner’s narrow construction. Element 1.I does not preclude a user from “directly determin[ing] ‘whether transmission of additional information related to said marketing content occurs during said active session.’” PO Resp. 22–23. Instead, as reproduced above, the “wherein” clause in element 1.I recites that the “*response by said user is used during said active session to determine* whether transmission of additional information related to said marketing content occurs during said active session.” Ex. 1001, 9:18–24. In other words, as stated by Petitioner, “[t]he plain language of the claim requires that the user responds, and that response is used to determine whether transmission additional information occurs. There is simply no requirement that a ‘transaction system’ (which is not even a claimed component) perform anything.” Pet. Reply 12–13. We determine that the operation disclosed in Lawlor in view of De Leo, and relied on by Petitioner (Pet. 50–51)—even assuming it involves a “direct[.]” determination by a

user, as contended by Patent Owner (PO Resp. 22–23)—falls within the scope of the broader language in the “wherein” clause in element 1.I.

Patent Owner also argues that “[t]he written description of Lawlor shows a user needs to respond to ‘whether he wants additional information’ *on an additional display screen*, not to respond on the ‘advertising or messaging text’ with acceptance, rejection, or no response.” PO Resp. 23 (emphasis added). We do not agree with this argument. Element 1.I does not require any particular form of response and neither (1) precludes the use of “an additional display screen” to perform the recited process, nor (2) requires a response “on the ‘advertising or messaging text.’” *See* Pet. Reply 15–16 (“The claims recite transmitting the marketing content ‘for acceptance, rejection, or no response by a user,’ and do [not] require any particular form of response. Patent Owner does not explain – nor could it – why it is relevant whether Lawlor’s user responds on the advertisement itself, or on ‘an additional display screen [sent] to remote terminal 54 asking the user whether he wants additional information,’ as taught by Lawlor.” (citing Ex. 1004, 39:25–47)).

Second, Patent Owner argues that “De Leo does not disclose rejection, or no response to the marketing content by the user,” and therefore, “the response used to ‘determine whether transmission of additional information related to said marketing content occurs’ includes only ‘acceptance,’ [and] does not include ‘rejection, or no response.’” PO Resp. 23–24 (citing Landers Decl. ¶ 80).

This argument does not identify a deficiency in Petitioner’s positions. Petitioner relies on Lawlor—not De Leo—as to the portion of element 1.I reciting “transmitting in real-time said targeted marketing content during

said active session to at least one of said e-banking touch points for acceptance, rejection, or no response by a user.” *See* Pet. 50 (citing Jestice Decl. ¶¶ 196–197); *see also* *Bradium Techs. LLC v. Iancu*, 923 F.3d 1032, 1050 (Fed. Cir. 2019) (“A finding of obviousness, however, cannot be overcome ‘by attacking references individually where the rejection is based upon the teachings of a combination of references.’” (quoting *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986))). For the reasons stated in the Petition, and clarified in the Reply, we determine that Lawlor discloses “transmitting in real-time said targeted marketing content during said active session to at least one of said e-banking touch points for acceptance, rejection, or no response by a user.” *See* Pet. 50 (citing Jestice Decl. ¶¶ 196–197); Pet. Reply 18–19 (discussing Ex. 1004, 39:45–57, Fig. 10)).

Petitioner only relies on De Leo, in the alternative, as to the “wherein said response . . .” clause at the end of element 1.I. *See* Pet. 50–51 (“To the extent Lawlor does not expressly disclose *wherein said response by said user is used during said active session to determine whether transmission of additional information related to said marketing content occurs during said active session*, De Leo does.” (citing Jestice Decl. ¶ 198)). And we address the arguments as to *that* reliance in the discussion of Patent Owner’s first argument for element 1.I (above).

For the reasons above, we find, based on the complete record, that Petitioner has demonstrated by a preponderance of the evidence that Lawlor discloses the subject matter of element 1.I and, in the alternative, that Lawlor in view of De Leo discloses the subject matter of element 1.I.

c. The Remaining Limitations in Independent Claim 1

To address the remaining limitations in independent claim 1, Petitioner discusses why the proposed combination of Lawlor, Bouve, De Leo, and Looney discloses each limitation and discusses why one of ordinary skill in the art at the time of the invention would have had reason to combine the relied-upon aspects of Lawlor, Bouve, De Leo, and Looney as proposed. *See* Pet. 15–16, 24–49; Jestice Decl. ¶¶ 79–83, 104–194. The record evidence, as presented, supports Petitioner’s position as to the additional limitations in independent claim 1. Patent Owner does not present arguments addressing these limitations.

We find, based on the complete record, that Petitioner has demonstrated by a preponderance of the evidence that the proposed combination of Lawlor, Bouve, De Leo, and Looney discloses the remaining limitations in claim 1.¹² We also determine that Petitioner has adequately explained why one of ordinary skill in the art would have had reason to combine the relied-upon aspects of Lawlor, Bouve, De Leo, and Looney as proposed and that there would have been a reasonable expectation of success.

d. Alleged Incomplete Obviousness Analysis

Patent Owner argues that “Petitioner fails to undertake a Graham analysis, because Petitioner’s combination of Lawlor, Bouve, De Leo, and Looney lacks evidence of crucial limitations of claim 1.” PO Resp. 24. Patent Owner continues that, “[a]lthough Petitioner assert[s that one of

¹² Patent Owner includes a section in the Response ostensibly addressing element 1.F2, however, the arguments in that section rely on the argument, discussed above, addressing element 1.A. *See* PO Resp. 22.

ordinary skill in the art] ‘would have been motivated to integrate Lawlor, Bouve, De Leo, and Looney [to] achieve several predictable benefits (Pet., 21–24; 47–49), since Petitioner fails to undertake a Graham analysis, the motivation of combination is problematic.’ *Id.*

This argument does not identify a deficiency in Petitioner’s position. For the reasons above, we determine that Petitioner has adequately shown that the prior art relied upon satisfies elements 1.A and 1.I, as well as the remaining elements of claim 1. Moreover, for several elements in claim 1, Petitioner has provided reasons to modify the prior art as proposed and explained why one of ordinary skill in the art would have had a reasonable expectation of success as to each element. *See* Pet. 21–24 (discussing motivation to combine and reasonable expectation of success as to element 1.A), 27–30 (same as to element 1.B), 38–39 (same as to element 1.F.2), 43–45 (same as to element 1.G), 47–49 (same as to element 1.H), 51–54 (same as to element 1.I). The panel adopts as its own findings and conclusions Petitioner’s analysis of motivation and reasonable expectation of success. Simply concluding that the motivation to combine is “problematic” does not adequately explain the basis for any alleged deficiency. *See* PO Resp. 24.¹³

e. Conclusion as to Claim 1

For the reasons above, we determine, based on the complete record, that Petitioner has demonstrated by a preponderance of the evidence that claim 1 would have been obvious based on Lawlor, Bouve, De Leo, and Looney.

¹³ We provided a similar discussion in the Decision on Institution in response to a similar argument in the Preliminary Response. *See* Dec. Inst. 37–38. Patent Owner did not develop this argument in response.

6. Independent Claim 7

For independent claim 7, Petitioner relies on the discussion of independent claim 1 to contend that the proposed combination of Lawlor, Bouve, De Leo, and Looney discloses each limitation of claim 7, that there would have been reasons to combine the relied-upon aspects of Lawlor, Bouve, De Leo, and Looney, and that there would have been a reasonable expectation of success. Pet. 57–60; Jestice Decl. ¶¶ 229–248.

For claim 7, Patent Owner relies on the arguments addressing element 1.I (i.e., the “transmitting in real-time” limitation), which is the same as element 7.I. *See* PO Resp. 25. Patent Owner does not present any argument addressing claim 7 that does not also address claim 1. *Id.*

For the same reasons discussed above as to element 1.I, we find, based on the complete record, that Petitioner has demonstrated by a preponderance of the evidence that the proposed combination of Lawlor, Bouve, De Leo, and Looney discloses the subject matter of element 7.I. We also determine, based on the complete record, that the proposed combination of Lawlor, Bouve, De Leo, and Looney discloses the subject matter of the remaining limitations in claim 7, that there would have been reasons to combine the relied-upon aspects of Lawlor, Bouve, De Leo, and Looney, and that there would have been a reasonable expectation of success.

Based on the complete record, we determine that Petitioner has demonstrated by a preponderance of the evidence that claim 7 would have been obvious based on Lawlor, Bouve, De Leo, and Looney.

7. Dependent Claims 3, 5, 6, 9, 11, and 12

For dependent claims 3, 5, and 6 (which depend from claim 1), and for dependent claims 9, 11, and 12 (which depend from claim 7), Petitioner

contends that the proposed combination of Lawlor, Bouve, De Leo, and Looney discloses each limitation, that there would have been reasons to combine the relied-upon aspects of Lawlor, Bouve, De Leo, and Looney, and that there would have been a reasonable expectation of success.

Pet. 54–56, 60; Jestice Decl. ¶¶ 211–228, 246–248. Patent Owner does not present any arguments specifically addressing claims 3, 5, 6, 9, 11, and 12, but rather relies on the same arguments addressing independent claims 1 and 7. *See* PO Resp. 25–26.

We determine, based on the complete record, that the proposed combination of Lawlor, Bouve, De Leo, and Looney discloses the subject matter of claims 3, 5, 6, 9, 11, and 12, that there would have been reasons to combine the relied-upon aspects of Lawlor, Bouve, De Leo, and Looney, and that there would have been a reasonable expectation of success. Based on the complete record, we determine that Petitioner has demonstrated by a preponderance of the evidence that claims 3, 5, 6, 9, 11, and 12 would have been obvious based on Lawlor, Bouve, De Leo, and Looney.

D. Asserted Obviousness of Claims 13, 15, 16, 19, and 20 Based on Lawlor, Bouve, De Leo, Looney, and Kawan

Petitioner asserts that claims 13, 15, 16, 19, and 20 of the '508 patent would have been obvious under 35 U.S.C. § 103(a) based on Lawlor, Bouve, De Leo, Looney, and Kawan. Pet. 6, 61–69. For claim 13, Patent Owner relies on the arguments addressing element 1.I/7.I (i.e., the “transmitting in real-time” limitation), which is similar to a portion of element 13.E. *See* PO Resp. 26–27. Patent Owner does not present any argument addressing claim 13 that does not also address claims 1 and 7 in the context of the prior discussed grounds. *Id.* We first summarize aspects of Kawan.

1. Kawan

In this asserted ground, Petitioner relies on Kawan, in addition to Lawlor (summarized above (*see* § II.C.1)), Bouve (summarized above (*see* § II.C.2)), De Leo (summarized above (*see* § II.C.3)), and Looney (summarized above (*see* § II.C.4)).

Kawan discloses “a financial system which utilizes wireless, portable terminals for providing financial information and performing financial transactions.” Ex. 1008, 1:5–9. Figure 1 of Kawan is reproduced below:

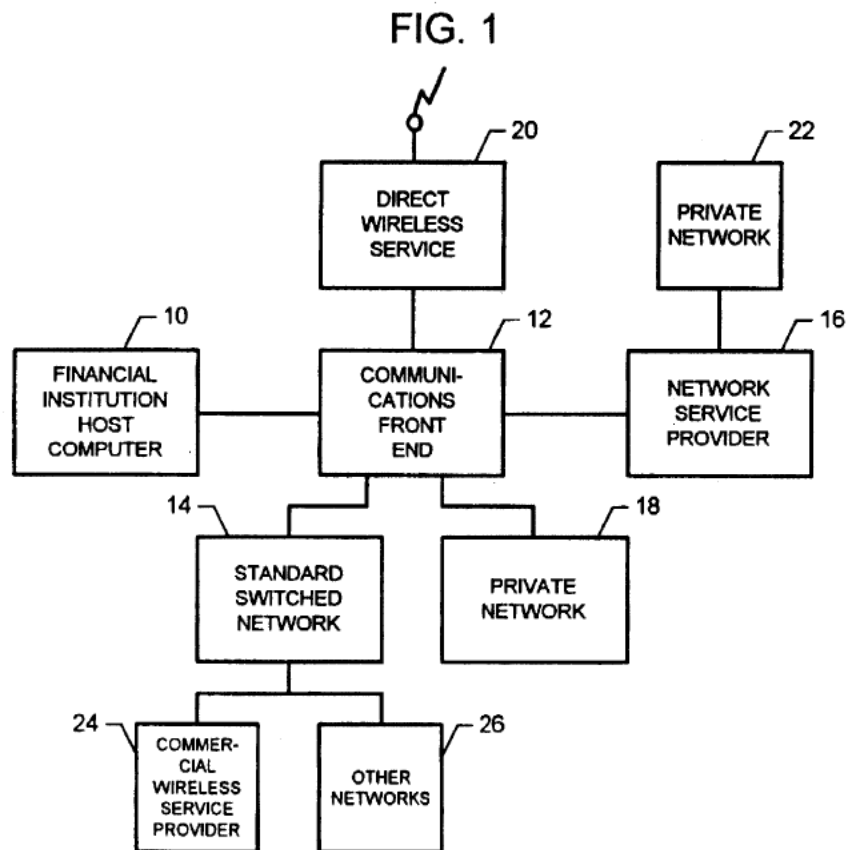


Figure 1 depicts “a block diagram of a financial information and transaction system.” Ex. 1008, 2:40–41. The system in Figure 1 shows, among other aspects, communications front end 12, which provides an interface to financial institution 10, standard switched network 14, network

service provider 16, private network 18, and direct wireless service 20. *See id.* at 3:9–55. Kawan discloses that “the financial institution, such as a consumer banking institution, utilizes an automated system, including a host computer, for maintaining records of customer accounts” and that the records “are used to keep track of funds in the customer accounts, to enter debits and credits made to such accounts, and for other purposes.” *Id.* at 3:3–8.

2. Independent Claim 13

For independent claim 13, Petitioner contends that the proposed combination of Lawlor, Bouve, De Leo, Looney, and Kawan discloses each limitation. Pet. 61–67; Jestice Decl. ¶¶ 251–277. In the context of this asserted ground, Kawan is generally relied on for the teaching of independent computer systems. Pet. 61–65. To support its arguments, Petitioner identifies certain passages in the cited references and explains the significance of each passage with respect to the corresponding claim limitation. Pet. 61–67; Jestice Decl. ¶¶ 251–277. Petitioner also articulates reasons to combine the relied-upon aspects of Lawlor, Bouve, De Leo, Looney, and Kawan and explains why there would have been a reasonable expectation of success. Pet. 61–67; Jestice Decl. ¶¶ 251–277.

For the same reasons discussed above as to element 1.I, we find, based on the complete record, that Petitioner has demonstrated by a preponderance of the evidence that the proposed combination of Lawlor, Bouve, De Leo, and Looney discloses the subject matter of the relevant portion of element 13.E. We also determine, based on the complete record, that the proposed combination of Lawlor, Bouve, De Leo, Looney, and Kawan discloses the subject matter of the remaining limitations in claim 13,

that there would have been reasons to combine the relied-upon aspects of Lawlor, Bouve, De Leo, Looney, and Kawan and that there would have been a reasonable expectation of success.

Based on the complete record, we determine that Petitioner has demonstrated by a preponderance of the evidence that claim 13 would have been obvious based on Lawlor, Bouve, De Leo, Looney, and Kawan.

3. Dependent Claims 15, 16, 19, and 20

For dependent claims 15, 16, 19, and 20 (which depend from claim 13), Petitioner contends that the proposed combination of Lawlor, Bouve, De Leo, Looney, and Kawan discloses each limitation, that there would have been reasons to combine the relied-upon aspects of Lawlor, Bouve, De Leo, Looney, and Kawan, and that there would have been a reasonable expectation of success. Pet. 67–68; Jestice Decl. ¶¶ 278–283. Patent Owner does not present any arguments specifically addressing claims 15, 16, 19, and 20, but rather relies on the same arguments addressing independent claim 13. *See* PO Resp. 27.

We determine, based on the complete record, that the proposed combination of Lawlor, Bouve, De Leo, Looney, and Kawan discloses the subject matter of claims 15, 16, 19, and 20, that there would have been reasons to combine the relied-upon aspects of Lawlor, Bouve, De Leo, Looney, and Kawan, and that there would have been a reasonable expectation of success. Based on the complete record, we determine that Petitioner has demonstrated by a preponderance of the evidence that claims 15, 16, 19, and 20 would have been obvious based on Lawlor, Bouve, De Leo, Looney, and Kawan.

E. Asserted Obviousness of Claims 4 and 10 Based on Lawlor, Bouve, De Leo, Looney, and Arsenault

Petitioner asserts that claims 4 and 10 of the '508 patent would have been obvious under 35 U.S.C. § 103(a) based on Lawlor, Bouve, De Leo, Looney, and Arsenault. Pet. 6, 69–71. Patent Owner does not present any arguments specifically addressing claims 4 and 10, but rather relies on the same arguments addressing independent claims 1 and 7, respectively. *See* PO Resp. 27–29. We first summarize aspects of Arsenault.

1. Arsenault

In this asserted ground, Petitioner relies on Arsenault, in addition to Lawlor (summarized above (*see* § II.C.1)), Bouve (summarized above (*see* § II.C.2)), De Leo (summarized above (*see* § II.C.3)), and Looney (summarized above (*see* § II.C.4)).

Arsenault relates “generally to digital video transmission systems and, more particularly, to a system and method of transmitting, receiving and displaying advertisements via a digital video transmission system.”

Ex. 1009, 1:13–16.

Figure 7 of Arsenault is reproduced below:

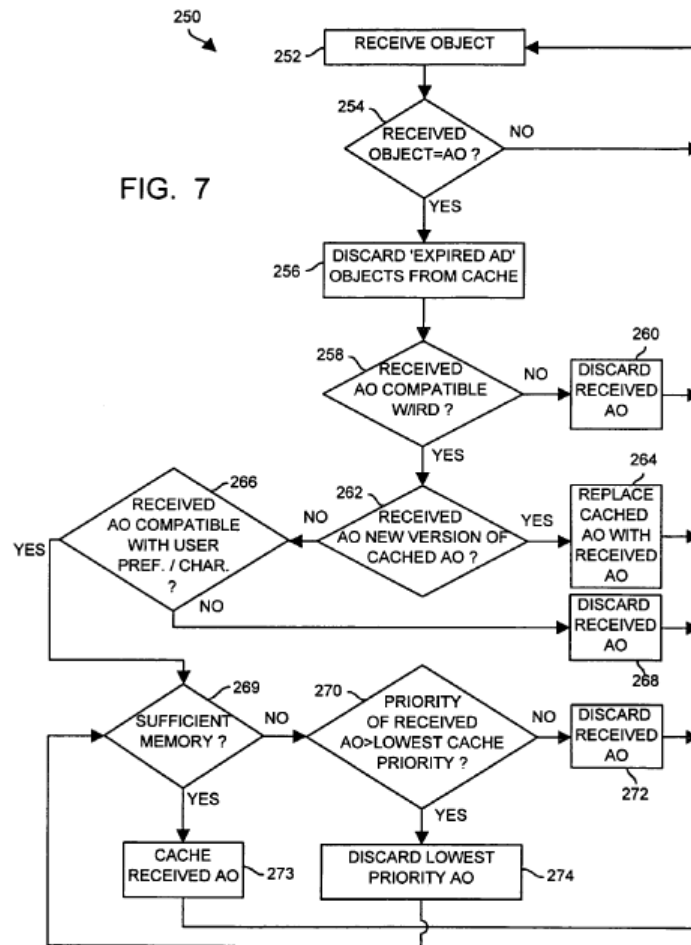


Figure 7 depicts “an exemplary flow diagram illustrating one method of processing advertising objects” within an exemplary integrated receiver decoder. Ex. 1009, 2:62–64. As to step 256, Arsenault discloses that the integrated receiver decoder

identifies expired AOs [(advertising objects)] by referring to the ULO [(update list object)]. The ULO contains only unexpired AOs. Thus, the IRD [(integrated receiver decoder)] 36 will only cache AOs that are currently contained in the ULO and will discard currently cached AOs that are not currently in the ULO (i.e., those that are expired).

Ex. 1009, 14:35–40.

2. Dependent Claims 4 and 10

For dependent claims 4 and 10 (which depend from claims 1 and 7, respectively), Petitioner contends that the proposed combination of Lawlor, Bouve, De Leo, Looney, and Arsenault discloses each limitation, that there would have been reasons to combine the relied-upon aspects of Lawlor, Bouve, De Leo, Looney, and Arsenault and that there would have been a reasonable expectation of success. Pet. 69–71; Jestice Decl. ¶¶ 287–295.

We determine, based on the complete record, that the proposed combination of Lawlor, Bouve, De Leo, Looney, and Arsenault discloses the subject matter of claims 4 and 10, that there would have been reasons to combine the relied-upon aspects of Lawlor, Bouve, De Leo, Looney, and Arsenault, and that there would have been a reasonable expectation of success. Based on the complete record, we determine that Petitioner has demonstrated by a preponderance of the evidence that claims 4 and 10 would have been obvious based on Lawlor, Bouve, De Leo, Looney, and Arsenault.

F. Asserted Obviousness of Claim 18 Based on Lawlor, Bouve, De Leo, Looney, Kawan, and Arsenault

Petitioner asserts that claim 18 of the '508 patent would have been obvious under 35 U.S.C. § 103(a) based on Lawlor, Bouve, De Leo, Looney, Kawan, and Arsenault. Pet. 6, 71. Patent Owner does not present any arguments specifically addressing claim 18, but rather relies on the same arguments addressing independent claim 13. See PO Resp. 30.

1. Asserted References

In this asserted ground, Petitioner relies on Lawlor (summarized above (*see* § II.C.1)), Bouve (summarized above (*see* § II.C.2)), De Leo (summarized above (*see* § II.C.3)), Looney (summarized above (*see*

§ II.C.4)), Kawan (summarized above (*see* § II.D.1)), and Arsenault (summarized above (*see* § II.E.1)).

2. Dependent Claim 18

For dependent claim 18 (which depends from claim 13), Petitioner contends that the proposed combination of Lawlor, Bouve, De Leo, Looney, Kawan, and Arsenault discloses each limitation, that there would have been reasons to combine the relied-upon aspects of Lawlor, Bouve, De Leo, Looney, Kawan, and Arsenault and that there would have been a reasonable expectation of success. Pet. 71; Jestic Decl. ¶ 296.

We determine, based on the complete record, that the proposed combination of Lawlor, Bouve, De Leo, Looney, Kawan, and Arsenault discloses the subject matter of claim 18, that there would have been reasons to combine the relied-upon aspects of Lawlor, Bouve, De Leo, Looney, Kawan, and Arsenault, and that there would have been a reasonable expectation of success. Based on the complete record, we determine that Petitioner has demonstrated by a preponderance of the evidence that claim 18 would have been obvious based on Lawlor, Bouve, De Leo, Looney, Kawan, and Arsenault.

III. CONCLUSION

Upon consideration of the briefing and the evidence of record, we determine that Petitioner has proven by a preponderance of the evidence that (1) claims 1, 3, 5–7, 9, 11, and 12 would have been obvious based on Lawlor, Bouve, De Leo, and Looney; (2) claims 13, 15, 16, 19, and 20 would have been obvious based on Lawlor, Bouve, De Leo, Looney, and Kawan; (3) claims 4 and 10 would have been obvious based on Lawlor,

Bouve, De Leo, Looney, and Arsenault; and (4) claim 18 would have been obvious based on Lawlor, Bouve, De Leo, Looney, Kawan, and Arsenault.¹⁴

In summary:

Claim(s)	35 U.S.C. §	Reference(s)/ Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1, 3, 5–7, 9, 11, 12	103(a)	Lawlor, Bouve, De Leo, Looney	1, 3, 5–7, 9, 11, 12	
13, 15, 16, 19, 20	103(a)	Lawlor, Bouve, De Leo, Looney, Kawan	13, 15, 16, 19, 20	
4, 10	103(a)	Lawlor, Bouve, De Leo, Looney, Arsenault	4, 10	
18	103(a)	Lawlor, Bouve, De Leo, Looney, Kawan, Arsenault	18	
Overall Outcome			1, 3–7, 9–13, 15, 16, 18–20	

¹⁴ Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner’s attention to the April 2019 Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding, 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. *See* 37 C.F.R. §§ 42.8(a)(3), (b)(2).

IV. ORDER

Accordingly, it is hereby:

ORDERED that Petitioner has proven by a preponderance of the evidence that claims 1, 3–7, 9–13, 15, 16, and 18–20 are unpatentable; and

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

IPR2022-00055
Patent 8,862,508 B2

FOR PETITIONER:

David M. Tennant
Jacob M. Rothenberg
ALLEN & OVERY LLP
david.tennant@allenoverly.com
jacob.rothenberg@allenoverly.com

David C. Seastrunk
Jordan Rossen
UNIFIED PATENTS, LLC
david@unifiedpatents.com
jordan@unifiedpatents.com

FOR PATENT OWNER:

Jacob B. Henry
William P. Ramey, III
RAMEY & SCHWALLER, LLP
jhenry@rameyfirm.com
wramey@rameyfirm.com
uspto@rameyfirm.com