

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC., AMAZON.COM, INC., AMAZON WEB
SERVICES, INC., and AMAZON.COM SERVICES LLC,¹

Petitioner,

v.

ALMONDNET, INC.,
Patent Owner.

IPR2022-01064
Patent 9,830,615 B2

Before KRISTEN L. DROESCH, THOMAS L. GIANNETTI, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

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

¹ Amazon.com, Inc., Amazon Web Services, Inc., and Amazon.com Services LLC, Inc. filed a motion for joinder and a petition in IPR2023-00384, which were granted. Accordingly, Amazon.com, Inc., Amazon Web Services, Inc., and Amazon.com Services LLC have been joined as a petitioner in this proceeding.

I. INTRODUCTION

We have authority to hear this *inter partes* review under 35 U.S.C. § 6, and this Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons that follow, Petitioner has established by a preponderance of the evidence that claims 9–12 (“challenged claims”) of U.S. Patent No. 9,830,615 B2 (Ex. 1001, “’615 Patent”) are unpatentable.

A. Procedural History

Meta Platforms, Inc. filed a Petition requesting *inter partes* review of claims 9–12 of U.S. Patent No. 9,830,615 B2 (Ex. 1001, “the ’615 Patent”). Paper 2 (“Pet.”). AlmondNet, Inc. (“Patent Owner”) filed a preliminary response. Paper 6. Pursuant to 35 U.S.C. § 314, we instituted trial on November 30, 2022. Paper 7 (“Dec.”). Subsequently, Amazon.com, Inc., Amazon Web Services, Inc., and Amazon.com Services LLC, Inc. filed a petition for *inter partes* review and a motion for joinder in IPR2023-00384, which were granted. Paper 20. Hereinafter we refer to Meta Platforms, Inc., Amazon.com, Inc., Amazon Web Services, Inc., and Amazon.com Services LLC, Inc. collectively as “Petitioner.”

After institution of trial, Patent Owner filed a Response (Paper 14, “PO Resp.”), to which Petitioner filed a Reply (Paper 22, “Pet. Reply”), to which Patent Owner filed a Sur-reply (Paper 25, “PO Sur-reply”).

Petitioner relies on a Declaration of Christopher M. Schmandt (Ex. 1002) to support its Petition. Patent Owner relies on a Declaration of Robert Sherwood (Ex. 2002) to support its Response. Petitioner relies on a second Declaration of Christopher M. Schmandt (Ex. 1018) to support its Reply.

Mr. Schmandt and Mr. Sherwood were cross-examined during trial, and transcripts of Mr. Schmandt's depositions (Exs. 2005, 2006) and Sherwood's deposition (Ex. 1019) are included in the record.

Oral argument was held on September 6, 2023. A transcript of the oral argument is included in the record. Paper 32.

B. Related Matters

The parties indicate the '615 Patent is or was the subject of the following proceedings:

Microsoft Corp. v. AlmondNet, Inc., IPR2022-01324 (PTAB)
(institution denied)

AlmondNet, Inc. v. Oath Holdings Inc., 1–18-cv-00943 (D. Del.);

Roku, Inc. v. AlmondNet, Inc., 1:21-cv-01035 (D. Del.);

AlmondNet, Inc. v. Roku, Inc., 6:21-cv-00731 (W.D.Tex.);

AlmondNet, Inc. v. Meta Platforms, Inc., 6:21-cv-00896 (W.D.Tex.);

AlmondNet, Inc. v. Microsoft Corp., 6:21-cv-00897 (W.D.Tex.);

AlmondNet, Inc. v. Amazon.com, Inc., 6:21-cv-00898 (W.D.Tex.);

AlmondNet, Inc. v. Meta Platforms, Inc., 4:22-cv-08911 (N.D.Cal.).

Pet. 7; Paper 4, 1; Paper 9, 1.

A. The '615 Patent (Ex. 1001)

The '615 Patent relates to profile-based behavioral targeting “advertisement placement based on expected profit from the placement.” Ex. 1001, 1:28–32. Behavioral targeting companies (“BT companies”) “specialize in targeting ads based on observed behavior of sites’ visitors,” by placing “a cookie (or cookies) on the computers of visitors.” *Id.* at 2:6–9. A BT company collects profile information about site visitors, such as behavioral information, demographic information, or user-provided

information, and “target[s] ads to those visitors wherever found based on the collected profile information.” *Id.* at 2:38–43. Alternately,

[a]n ad network ad server (or any other server of the ad network) or a site’s ad server (or any other server of the site) can place their own cookies on the computers of visitors that are redirected to them by the BT companies, for the purpose of later recognizing those visitors within their own ad space.

Id. at 5:26–31. By this process, a second media property is able to recognize a first media property visitor, but the ’615 Patent explains that this process is inefficient at least because: (1) media properties’ ad space prices vary; (2) profiles of media properties’ visitors are worth different amounts to advertisers depending on the profiles; and (3) the same person might have several profile attributes in his or her profile. *See id.* at 5:56–6:13.

Figure 3 of the ’615 Patent is reproduced below.

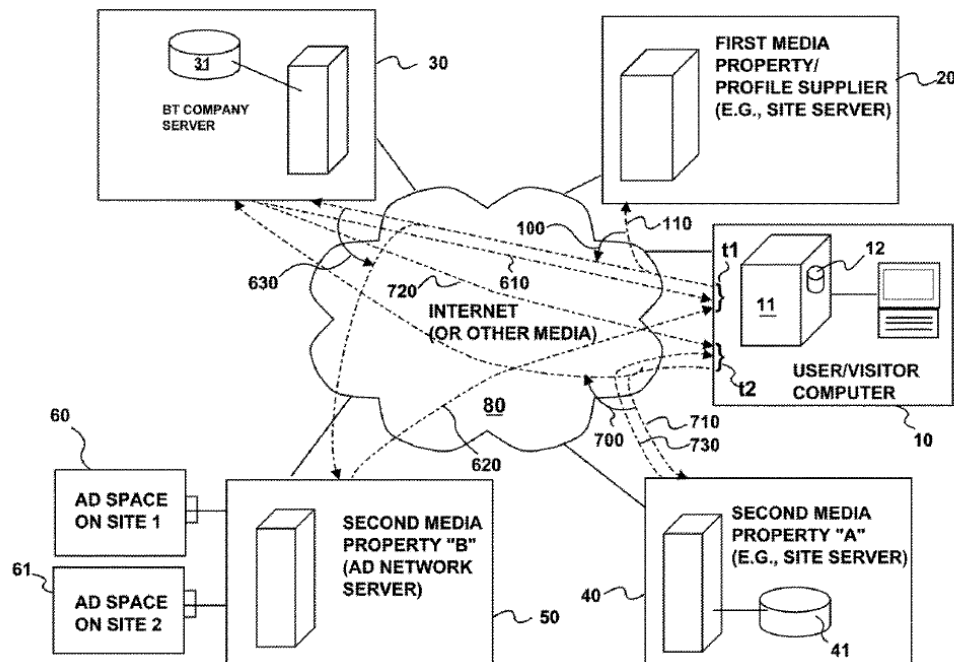


Figure 3 depicts entities and associated equipment used with an exemplary profit-based selection method. *See* Ex. 1001, 6:58–60. With respect to Figure 3, to address the above-noted inefficiencies and ensure that profile

information is not transferred to the second media property, the '615 Patent describes the BT company as “simply ask[ing] the second media property . . . to tag the visitor as a BT company visitor or arrang[ing] for a tag to be placed (620) that is readable by the second media property 40 and that marks the visitor as a BT company visitor.” *Id.* at 9:47–54. “BT company 30 selects . . . media properties (e.g., 40) for the delivery of an advertisement based on a profile collected on a first media property 20.” *Id.* at 8:48–50; *see id.* Fig. 2, step 500. In one embodiment, “BT company 30 makes the selection based on a calculated expected profit and then arranges for the visitor 10 to be tagged (610 or 620) with a tag readable by the selected media property 40.” *Id.* at 8:50–54.

When a selected media property 40 recognizes a tagged visitor 10 (tagged previously, at time t1) later (at time t2) visiting (710) its ad space, the media property 40 will arrange for the BT company 30 to serve an ad (720) to the visitor 10 (which will appear with the media content (730) requested by the visitor), by redirecting (700) a visitor to the BT company 30.

Id. at 9:16–22. The '615 Patent explains that when “BT company 30 buys ad space from the proprietor of the second media property 40 and delivers therein an ad based on the collected profile, the BT company 30 has no economic incentive to transfer the profile information itself. . . to the second media property.” *Id.* at 9:54–59. Thus,

[t]he second media company’s proprietor is being paid for the ad space and therefore just needs to know that the visitor 10 has been profiled by the BT company 30, which will pay the second media property’s proprietor for an opportunity to deliver an ad to this visitor 10 within the ad space of the second media property 40.

Id. at 9:59–65.

B. Illustrative Claim

Claim 9 is the sole independent challenged claim, and claims 10–12 depend therefrom. *See* Ex. 1001, 14:7–57. Claim 9 is illustrative and reproduced below.

A computer system controlled by a behavioral targeting company (BT company), which computer system (BT computer system) is comprised of one or more computers and is structured and programmed to perform a method of directing electronic advertisements, the method comprising:

automatically with the BT computer system:

- (a) at a first time, arranging for a third party computer system controlling advertising space on a plurality of third party media properties to electronically tag a first computer of a first visitor visiting a first website, without transferring to the third party computer system any profile information related to the first visitor, which tag is readable by computers operating under a domain of the third party computer system and identifies the visitor computer as associated with the BT company;
- (b) recording, in a profile of the first visitor maintained by the BT computer system, profile information collected during the first computer's visit to the first website;
- (c) electronically transferring to the computer system a price cap that the BT company is willing to pay for allowing delivery of an advertisement within media property advertising space controlled by the third party computer system controlling advertising space on the plurality of third party media properties; and
- (d) at a second time, later than the first time, upon receiving a redirection of the first computer while the first computer is visiting one of the plurality of third party media properties, causing a selected advertisement to be served to the first computer, which advertisement is based on the profile information collected during the first computer's visit to the first website, which profile information is in the profile of the first visitor maintained

by the BT computer system, in exchange for a price less than the price cap.

Ex. 1001, 14:7–40.

C. Asserted Patentability Challenges and Asserted Prior Art

Petitioner asserts that claims 9–12 are unpatentable based on the following grounds (Pet. 9):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
9–12	103(a) ²	Meyer ³ , Zeff ⁴ , Edlund ⁵ , Fisher ⁶
9–12	103(a)	Meyer, Zeff, Edlund, Fisher, Tittel ⁷

II. ANALYSIS

A. Claim Construction

In an *inter partes* review proceeding, the Board applies the same claim construction standard as applied in federal courts in a civil action under 35 U.S.C. § 282(b), which is generally referred to as the *Phillips* standard. *See* 37 C.F.R. § 42.100(b); *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). Under the *Phillips* standard, “words of a claim ‘are generally given their ordinary and customary meaning.’” *Phillips*, 415

² The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. § 103 effective March 16, 2013. Because the ’615 Patent claims the benefit of a series of continuation applications, some of which have filing dates prior to March 16, 2013 (Ex. 1001, code (63)), we refer to the pre-AIA version of § 103.

³ US 6,915,271 B1, issued July 5, 2005 (Ex. 1003).

⁴ Robbin Zeff and Brad Aronson, *Advertising on the Internet*, 2nd Edition, Wiley Computer Publishing, 1999 (Ex. 1004).

⁵ US 7,251,628 B1, issued July 31, 2007 (Ex. 1005).

⁶ US 5,835,896, issued Nov. 10, 1998 (Ex. 1006).

⁷ Ed Tittel and Natanya Pitts, *HTML 4 for Dummies*, 2nd edition, IDG Books Worldwide, 1999 (Ex. 1007).

F.3d at 1312. “In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17).

Extrinsic evidence may be useful, but it is unlikely to result in a reliable interpretation of patent claim scope unless considered in the context of the intrinsic evidence. *Phillips*, 415 F.3d at 1317.

The Petition does not provide claim constructions for any term or phrase as “Petitioner does not believe an express construction is necessary at this time.” Pet. 11. Patent Owner provides proposed constructions for “automatically with the BT computer system,” “profile information,” and “arranging for a third party computer system . . . to electronically tag a first computer . . . , without transferring to the third party computer system any profile information related to the first visitor.” See PO Resp. 7–16; PO Sur-reply 1–7. Petitioner disagrees with Patent Owner’s proposed constructions or the application of thereof. See Pet. Reply 2–6. We address each of the proposed claim constructions below.

1. “automatically with the BT computer system”

Patent Owner asserts that “automatically with the BT computer system,” recited in claim 9 “requires that the **BT computer system** performs each step of the recited method.” PO Resp. 14–15 (citing Ex. 2002 ¶¶ 52–56). According to Patent Owner, “[t]he BT computer system need not perform each of the steps *alone* . . . , but the BT computer system must perform them. For example, if a step is performed solely by the ‘third party computer system’ of the claims, that would not meet the claim language.”

Id. at 15 (citing Dec. 27–28). Patent Owner contends “the ‘automatically with the BT computer system’ language does not exclude other computers from assisting the BT computer system in performing the claimed method steps. *Id.*

Patent Owner further argues that the specific acts of the method are performed “automatically with the BT computer system.” *See* PO Resp. 15. Specifically, Patent Owner asserts that regarding claim limitation 9(a), the act that is performed “automatically with the BT computer system” is “arranging for a third party computer system . . . to electronically tag a first computer of a first visitor.” *Id.* According to Patent Owner, “if the BT computer system acts automatically to make the arrangements for another computer system to do tagging, that is sufficient. The BT computer system need not perform the tagging by itself—instead, the tagging is recited as being performed by the third party computer system.” *Id.*

Petitioner disagrees with Patent Owner’s construction, and asserts that it should be rejected because Patent Owner attempts to redraft the claim by replacing “with” to “by.” *See* Pet. Reply 5. According to Petitioner, “[t]he words ‘by’ and ‘with’ have different meanings, both in the English language generally and in the context of computer-based systems.” *Id.* (citing Ex. 1018 ¶ 18). Petitioner further asserts that “[t]he phrase ‘with’ in the context of claim 9 merely requires that the claim steps be performed alongside the BT computer system, for example, with the BT computer system providing assistance or otherwise participating, without having to directly perform the step itself.” *Id.* (bold emphasis omitted). According to Petitioner, “[h]ad Patent Owner intended to require that the recited steps in claim 9 be performed ‘by’ the BT computer system, it would have drafted the claim accordingly. It did just that for *other* claimed features; for

example claim 9(d) recites profile information “maintained by the BT computer system.” *Id.* at 6 (citing Ex. 1001, 14:35–40) (bold emphasis omitted). Petitioner asserts that the use of “with the BT computer system” “was a deliberate drafting choice.” *Id.* Petitioner also contends that Patent Owner does not provide justification for deviating from this deliberate drafting choice. *Id.*

We do not agree with Patent Owner’s construction for “automatically with the BT computer system.” Under *Phillips*, the starting point for the analysis is the language of the claims themselves. *See Phillips*, 415 F.3d at 1314. Claim 9 recites “automatically with the BT computer system” and does not otherwise recite or require the acts recited in the claims that follow, such as “arranging for a third party computer system . . . to electronically tag a first computer of a first visitor visiting a website . . .” to be performed in whole or part by the BT computer system. Accordingly, based on the record evidence, we decline to adopt Patent Owner’s proposed construction for “automatically with the BT computer system.”

As demonstrated in the analysis below, we need not further explicitly construe “automatically with the BT computer system” to resolve the controversy before us. *See, e.g., Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“[W]e 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))).

2. “profile information”

Patent Owner contends that “‘profile information’ should be construed to include at least ‘the observed behavior of a visitor to a media property and

demographic information about a visitor to a media property.” PO Resp. 7–8 (citing Ex. 2002 ¶¶ 43–44). According to Patent Owner, the proposed construction “derives directly from the specification of the ’615 Patent, which teaches that a ‘visitor’s profile’ can include ‘the observed behavior of the visitor on the media property, demographic information collected on the media property, profile information provided by the visitor to the media property, etc.’” *Id.* at 8 (quoting Ex. 1001, 3:37–44; parenthetically quoting Ex. 1001, 2:33–43). Patent Owner asserts that “[o]bserved behavior can include ‘taking any . . . kind of action’ on a media property, including ‘reading a specific content, searching, clicking an ad or content, making a phone call, asking for product information, [or] acquiring a product.’” *Id.* (quoting Ex. 1001, 4:16–21; citing Ex. 1001, 6:65–7:6) (second two alterations in original). According to Patent Owner, “the Petition appears to agree that . . . ‘profile information’ includes demographic information, observed behavior, or user-provided information.” *Id.* (quoting Pet. 30).

“Petitioner does not disagree with the literal words of Patent Owner’s construction, but with how it has interpreted and applied that construction.” Pet. Reply 2; *see also* PO Sur-reply 2. According to Petitioner, “Patent Owner has applied its construction in an overly broad manner wholly inconsistent with how the term is used in the patent.” Pet. Reply 2.

Although Patent Owner relies on the ’615 Patent Specification to provide support for its construction, we do not agree that the proposed construction for “profile information” “derives directly from the specification of the ’615 Patent.” Patent Owner’s proposed construction has a broader in scope than the ’615 Patent Specification disclosures cited by Patent Owner as support. Without explanation, Patent Owner’s proposed

construction uses the terms “the observed behavior of *a visitor to a media property*” and “demographic information *about a visitor to a media property*” (PO Resp. 7–8) (emphasis added), while the cited ’615 Patent Specification discloses that the “visitor’s profile “could be the observed behavior *of the visitor on the media property, demographic information collected on the media property.*” Ex. 1001, 3:37–44 (emphasis added); *see also, e.g.*, Ex. 1001, 4:16–21, 4:64–67. In other words, without explanation, Patent Owner’s proposed construction for “profile information” encompasses the observed behavior, in general, of a media property visitor and the demographic information, in general, about a media property visitor, and is therefore broader than the cited ’615 Patent Specification, which more narrowly discloses the visitor’s observed behavior *on the media property* and the visitor’s demographic information *collected on the media property*. Patent Owner does not direct us to disclosure in the ’615 Patent Specification to support the full scope of Patent Owner’s proposed construction for “profile information.”

In sum, based on the record evidence, we decline to adopt Patent Owner’s proposed construction for “profile information,” because the broad scope of the proposed construction is not supported by Patent Owner’s citations to the ’615 Patent Specification disclosure. Consistent with the cited ’615 Patent Specification disclosures, we instead construe “profile information” as “the observed behavior of the visitor *on the media property*, demographic information *collected on the media property*, or both.”⁸

⁸ Patent Owner, in a footnote, acknowledges that “profile information” is satisfied by information that constitutes overserved behavior, demographic information, or both. *See* PO Sur-reply 2 n.1 (citing Ex. 1019, 8:9–9:16;

3. “*arranging for a third party computer system . . . to electronically tag a first computer . . . , without transferring to the third party computer system any profile information*”

Patent Owner contends that, based on “arranging for a third party computer system . . . to electronically tag a first computer of a first visitor visiting a first website, without transferring to the third party computer system any profile information,” “[i]t is clear from the claim language itself that the arrangement for the third party computer system to tag the first computer must not result in transfer of visitor profile information to the third party computer system.” PO Resp. 9 (citing Ex. 2002 ¶¶ 45–46); *see also id.* at 10 (similar argument, citing Ex. 2002 ¶ 47). In a footnote, Patent Owner provides the following Billiards analogy: “a pool player does not ‘hit the cue ball without sinking the 8 ball’ if the player hit the cue ball, which then hits the 8 ball and the 8 ball then falls into the corner pocket. The reason . . . is that the 8 ball sank as a *direct result of* the cue ball being hit. *Id.* at 9–10 n.2 (citing Ex. 2002 ¶ 46) (bold emphasis omitted).

Patent Owner further contends that the ’615 Patent Specification supports this interpretation. *See* PO Resp. 10–11 (quoting Ex. 1001, 3:49–51, 4:13–15, 9:47–51, 9:54–65; citing Ex. 1001, 3:45–49, 3:51–53, 4:9–13, 9:51–54; Ex. 2002 ¶ 48). In support of its construction, Patent Owner also points to statements made by Applicant during prosecution of parent Patent No. 9,580,089 (“’089 Patent”), and during prosecution of the ’615 Patent. *See id.* at 11–13 (quoting Ex. 1013, 286, 287; Ex. 2004, 138, 139). According to Patent Owner, “the BT computer system *keeps* the profile data *confidential and undisclosed* from an ad network or other system

Ex. 1018); *see also* Pet. Reply 2 n.2 (Petitioner’s related argument citing Ex. 1019, 8:9–9:16).

facilitating delivery of the ad.” *Id.* at 13. Patent Owner also points to statements made by Petitioner in IPR2022-01481 challenging the parent ’089 Patent, and asserts that “Petitioner has in effect that the arrangement for tagging in claim limitation 9(a) of the ’615 must not *result in* the transfer of profile information to the third party computer system, else the interpretation would be inconsistent with the meaning Petitioner assigned to the parent ’089 Patent’s similar ‘redirecting . . . without transferring’ language.” *Id.* at 13–14 (quoting *Meta Platforms, Inc. v. AlmondNet, Inc.*, IPR2022-01481, Paper 2 at 24, 26–27 (PTAB Sept. 2, 2022); citing Ex. 1013, 281–282).

In the Reply, Petitioner asserts that Patent Owner does not seek to construe this claim language but to rewrite it by inserting the phrase “must not result in,” which does not appear in the claim. *See* Pet. Reply 2–3 (quoting PO Resp. 9). According to Petitioner, “Patent Owner’s view would essentially prohibit any transfer of profile information to the third party computer system – including transfers that occur entirely after the step of ‘arranging’ has been fully performed.” *Id.* at 3 (bold emphasis omitted). Petitioner asserts that this argument must be rejected because the plain language of claim limitation 9(a) only requires that the arranging step itself be performed without transferring profile information to the third party computer system.” *Id.* Petitioner contends that claim 9 does not preclude the transfer of profile information at other times. *See id.* Petitioner further points out that claim 9 recites the transitional phrase “comprising,” and contends that Patent Owner’s arguments cannot be reconciled with the use of “comprising.” *See id.* (quoting Ex. 1001, 14:10–11; *CIAS, Inc. v. Alliance Gaming Corp.*, 504 F.3d 1356, 1360–61 (Fed. Cir. 2007)). Petitioner further contends that Patent Owner does not identify anything in the intrinsic record that prohibits transferring profile information at other times, such as after

tagging. *See* Pet. Reply 4 (quoting Ex. 1001, 12:66–13:4; citing Ex. 1001, 6:62–63, 9:47–65).

Petitioner also asserts that the quoted statements from the prosecution history of the parent '089 Patent and the '615 Patent were made to overcome patent eligibility rejections under § 101 and were not directed to any particular claim language. *See* Pet. Reply 4 (citing PO Resp. 11–12). According to Petitioner, “[n]one of these statements rises to the level of a disclaimer or disavowal and Patent Owner does not contend otherwise.” *Id.* at 4–5.

In the Sur-reply, Patent Owner asserts that Petitioner does not dispute Patent Owner’s assertions regarding the plain meaning of the claim language, does not address the billiards analogy, or otherwise address what it means to perform a first step without performing another step. PO Sur-reply 3. Patent Owner also directs attention to Petitioner’s witness Mr. Schmandt’s deposition testimony regarding his compensation for his work, and asserts that his testimony provides another helpful analogy confirming the plain meaning of performing a first step without performing another step. *Id.* at 3–5 (quoting Ex. 2006, 8:2–10, 8:16–21). Patent Owner further contends that Mr. Schmandt “does not dispute that the ‘plain language of claim 9(a),’ given its plain meaning, precludes profile information from being transferred to the third party computer system as a result of the arrangement for tagging being performed.” *Id.* at 5 (quoting Ex. 1018 ¶ 7; citing Ex. 1018 ¶¶ 7–14).

We do not agree with Patent Owner’s proposed construction for “arranging for a third party computer system . . . to electronically tag a first computer of a first visitor visiting a first website, without transferring to the third party computer system any profile information,” such that it “must not

result in transfer of visitor profile information to the third party computer system.” Under *Phillips*, the starting point for the analysis is the language of the claims themselves. *See Phillips*, 415 F.3d at 1314. The language of claim 9 does not include limitations precluding the later occurring transfer of any profile information as a result of tagging the first computer of a first visitor visiting a first website. *See Ex. 1001*, 14:7–40. We also agree with Petitioner’s arguments that the language of claim 9, by use of the transitional phrase “comprising,” does not preclude the occurrence of “transferring to the third party computer system any profile information” after the step of “arranging for a third party computer system . . . to electronically tag a first computer of a first visitor visiting a first website, which occurs “at a first time.” *See id.*

We also do not agree with Patent Owner’s arguments that the ’615 Patent Specification supports its construction. Although Patent Owner directs attention to the ’615 Patent Specification disclosures that the BT computer company stores a visitor’s collected profile information and does not transfer it to the second media property, but asks the second media property to tag the visitor or arrange for a tag to be placed (*see PO Resp. 10; Ex. 1001*, 9:47–54), and further discloses that the BT company has no economic incentive to transfer profile information to the second media property (*see PO Resp. 11; Ex. 1001*, 9:54–65), these disclosures do not provide sufficient support for Patent Owner’s requirement that “arranging for a third party computer system . . . to electronically tag a first computer of a first visitor visiting a first website” must not result in transfer of visitor profile information to the third party computer system. *See PO Resp. 10–11.*

Finally, we do not agree with Patent Owner that certain statements made during the prosecution of the ’615 Patent and the parent ’089 Patent

support its construction because, as pointed out by Petitioner, these cited prosecution statements address patent eligibility under 35 U.S.C. § 101. *See* Ex. 2004, 138–139; Ex. 1013, 286–287. Thus, Patent Owner’s relied-upon prosecution history statements are not pertinent to the construction of claim limitation 9(a) because the statements address subject matter eligibility under § 101.

We also do not find helpful to claim construction Patent Owner’s witness Mr. Sherwood’s testimony providing a billiards analogy and Patent Owner’s attorney argument providing an analogy based on Mr. Schmandt’s deposition testimony related to his compensation for his testimony. Both analogies are premised on a requirement that performing another step (e.g., “sinking the 8 ball,” “receiving compensation”) cannot occur as a direct result or cannot occur after performing a first step (e.g., “hitting the cue ball,” “offering expert opinions in a legal proceeding”). *See* PO Resp. 9–10 n.2; PO Sur-reply 3–5. Thus, by analogy, Patent Owner advocates that “transferring to the third party computer system any profile information,” cannot occur as a direct result or cannot occur after “arranging for a third party computer system . . . to electronically tag a first computer of a first visitor visiting a first website.” When considered in the context of the intrinsic evidence, e.g., the claim language itself, which does impose a negative limitation on a resulting transfer of profile information, we do not find Mr. Sherwood’s testimony or Patent Owner’s attorney argument providing an analogy based on Mr. Schmandt’s deposition testimony to provide a reliable interpretation of the scope of claim limitation 9(a). In addition, Patent Owner’s attorney argument providing an analogy based on Mr. Schmandt’s deposition testimony regarding his compensation for testimony is entitled to little weight. Argument of counsel cannot take the

place of objective evidence. *See Gemtron Corp. v. Saint-Gobain Corp.*, 572 F.3d 1371, 1380 (Fed. Cir. 2009) (unsworn attorney argument is not evidence).

We further do not find Patent Owner’s arguments regarding statements made by Petitioner in IPR2022-01481 helpful to claim construction in this proceeding. Petitioner’s statements in IPR2022-01481 address the application of prior art to claims of the parent ’089 Patent, not claims of the ’615 Patent challenged here. When considered in the context of the intrinsic evidence, e.g., the claim language itself and the ’615 Patent Specification, we do not find Petitioner’s statements addressing the application of prior art to claims of the parent ’089 Patent to provide a reliable interpretation of the scope of limitation 9(a).

In sum, based on the record evidence, we decline to adopt Patent Owner’s proposed construction for “arranging for a third party computer system . . . to electronically tag a first computer of a first visitor visiting a first website, without transferring to the third party computer system any profile information.” As demonstrated in the analysis below, we need not explicitly construe “automatically with the BT computer system” to resolve the controversy before us. *See, e.g., Nidec*, 868 F.3d at 1017.

B. The Level of Ordinary Skill in the Art

Petitioner asserts:

[a] person of ordinary skill in the art would have possessed a bachelor’s degree in electrical engineering or computer science, and two years of work experience in the field of network-based computer systems, such as systems for sending and receiving information over local networks and wide area networks (such as the Internet or World Wide Web). A person could also have qualified with more formal education and less technical experience, or vice versa.

Pet. 10 (citing Ex. 1002 ¶¶ 10–14). Patent Owner does not comment on Petitioner’s definition, and does not offer an alternate definition. *See* PO Resp. We adopt Petitioner’s definition of a person of ordinary skill in the art because it is consistent with the level of skill reflected by the ’615 Patent Specification and the asserted prior art.

C. Principles of Law

A claim is unpatentable under 35 U.S.C. § 103 if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) if in evidence, so-called secondary considerations. *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 17–18 (1966).⁹

D. Challenge to Claims 9–12 over Meyer, Zeff, Edlund, and Fisher

1. Overview of Meyer (Ex. 1003)

Meyer discloses a system for “electronically distributing, dynamically displaying to a consumer, [and] redeeming and clearing promotional incentives,” based on, among other things, “consumer factors (e.g., demographics, stated consumer interests, and past purchasing behavior).” Ex. 1003, 6:34–43.

⁹ Neither Petitioner nor Patent Owner present evidence related to secondary considerations.

Figure 1 of Meyer is reproduced below.

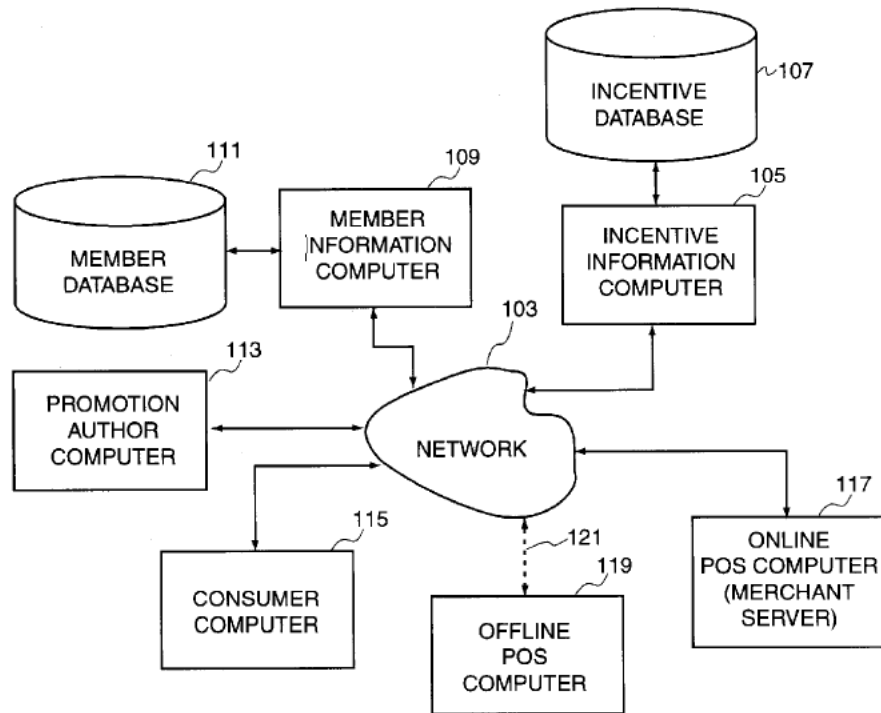


Figure 1 is a block diagram showing hardware components of an exemplary system. Ex. 1003, 14:3–4. As depicted in Figure 1, consumer computer 115, incentive information computer 105, which holds incentive information “in the form of a database (incentive database 107),” member information computer 109, which holds consumer information “in the form of one or more databases (the member database 111),” and is typically run by the account provider, and promotion author computer 113 “for managing promotions and incentives, for example for defining and editing incentives, such managing typically carried out remotely by the promotion author,” are each connected to network 103, which may be the Internet. *Id.* at 18:18–20, 18:35–38, 18:55–59, 18:66–19:3. In Meyer, a consumer is the entity at whom the promotion, including the incentives, is aimed, that often is a member that has joined the incentive service by registering. *Id.* at 16:21–28. When a consumer goes to a Web page that contains an icon, process

ICON_DSPLY is started by a JAVA servlet run as part of the service provider process, and because the display of the icon includes a URL on the page on the Web where the icon is displayed, the URL points to the service provider Web site and is used to retrieve the image displayed by the incentive icon. *Id.* at 28:4–19.

Figures 7 and 8 of Meyer are reproduced below.

```
// Get_Member_ID executes in consumer computer as part of process
// DSPLY
BEGIN
get member ID from cookie;
IF (member ID valid) {
    access ACCTPRVD to get member info from MMBR-DB;
} ELSE {
    Sign_On;
    get member ID from cookie;
    IF (member ID valid) {
        access ACCTPRVD to get member info from MMBR-DB;
    } ELSE {
        display error message to consumer;
    }
}
END;
```

Fig. 7

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```
// Sign_On
BEGIN
pop-up sign-up screen on consumer computer;
get required account info from consumer; including account name and password;
IF (consumer is not a member) {
    in new pop-up request necessary account info from member;
    create new account for consumer;
}
access ACCTPRVD to get member ID from MMBR-DB;
write member ID to cookie;
END;
```

Fig. 8

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Figure 7 shows pseudocode for the Get Member ID procedure and Figure 8 shows pseudocode for the Sign_On procedure. Ex. 1003, 14:20–23. In Figures 7 and 8, a non-member customer becomes a member and is assigned a member ID using the ACCTPRVD [account provider] process and the member information is stored in MMBR-DB, the member ID is sent from

MMBR-DB, and a cookie is written in consumer computer 115. *Id.* at 33:30–34. The cookie is used in a consumer’s computer to identify the member to the service provider process SRVPRVD. *Id.* at 56:15–18.

2. Overview of Zeff (Ex. 1004)

Zeff is a book titled “Advertising on the Internet,” which includes sections addressing Ad Networks. Ex. 1004, 65, 130–133. Zeff discloses “an ad network brings together a group of sites with advertising inventory to sell in order to offer greater access and ease to publishers and advertisers.” *Id.* at 130. Zeff discloses that “[b]uying ads separately on the ever-growing number of sites can be a daunting task; you have to make your way through separate sales forces, individual rate sheets, and a myriad of audience demographics.” *Id.* at 131. According to Zeff, “[w]hen you work with a network, you are in contact with just one experienced sales force made up of people who know the online advertising business.” *Id.* at 131–132. Zeff discloses that DoubleClick “is an example of an advertising network,” and that “[a] media buyer can make one purchase with DoubleClick and have an ad placed on dozens of sites.” *Id.* at 65. Zeff also includes a section addressing cookies. *See id.* at 50–51. Zeff further includes a section addressing auctions for selling excess advertising inventory. *See id.* at 81–84.

3. Overview of Edlund (Ex. 1005)

Edlund is directed to Internet search engines and relates to emerging on-line markets of web-based auction sites. *See* Ex. 1005, 1:23–25. Edlund discloses a system that allows purchasers to manage their auction sites automatically. *See id.* at 2:35–37. The system will “automatically contact the defined auctions sites and perform a query (poll) in specific time

intervals to determine whether the selected item is currently available for purchase. With this information one preferred embodiment will then automatically select the auction with the lowest current bid and place a bid there.” *Id.* at 2:61–67.

4. Overview of Fisher (Ex. 1006)

Fisher is directed to conducting an interactive auction over an electronic network. *See* Ex. 1006, 1:8–9. Fisher discloses proxy bidding, which allows an auction manager 26 to automatically bid on the bidder’s behalf up to a limited amount established by the bidder when his or her initial bid is placed. *See id.* at 9:19–22. The auction manager will increase the bid as necessary up to the limit amount, which allows the customer to get the lowest possible price without exceeding a limit preferably established when the bid is entered. *See id.* at 9:23–26. Fisher also disclosed a “Dutch Auction” format where the auction system awards the merchandise to all of the top bidders for the available merchandise at the price bid by the lowest successful bidder. *See id.* at 10:29–33. “This format may be preferred by customers for being the most fair when a plurality of a specific item is being auctioned.” *Id.* at 10:33–35.

5. Analysis of Independent Claim 9

a. Preamble

Petitioner contends that, “[a]ssuming the preamble imposes a limitation, Meyer discloses a system and method for ‘directing electronic advertisements,’” based on Meyer’s disclosure of displaying incentives that provide an item of advertising. Pet. 13 (quoting Ex. 1003, 7:20–23; citing Ex. 1002 ¶¶ 43–44, 73–74; Ex. 1003, 6:34–43, 7:19–20, 7:39–43) (emphasis omitted). Petitioner asserts that Meyer also teaches a computer system that

is controlled by a behavioral targeting company (BT company) and is comprised of one or more computer systems, based on Meyer's teaching of member information computer 109 run by an account provider, such as a credit card issuer. *See id.* at 14–15 (reproducing Ex. 1003, Fig. 1 (with annotations); quoting Ex. 1003, 18:35–41, 31:24–25, Fig. 27; citing Ex. 1002 ¶ 80; Ex. 1003, 26:19–22, 30:23–32, 33:10–14, 33:35–39, Figs. 22, 23).

Patent Owner does not address Petitioner's showing addressing the preamble. *See* Prelim. Resp. 7–28. Nonetheless, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

We need not resolve whether the preamble is limiting because, based on the entire record, we find that Petitioner shows the preamble recitation is satisfied by the teaching of Meyer.

b. (a) [automatically with the BT computer system:]¹⁰ at a first time, arranging for a third party computer system controlling advertising space on a plurality of third party media properties to electronically tag a first computer of a first visitor visiting a first website, without transferring to the third party computer system any profile information related to the first visitor, which tag is readable by computers operating under a domain of the third party computer system and identifies the visitor computer as associated with the BT company;

Petitioner asserts that Meyer's disclosure of incentive information computer 105 is a service provider computer that qualifies as a third party computer system, "because it would have been owned and operated by an entity different from the account provider who owns and operates the 'BT

¹⁰ This limitation appears after the preamble, and applies to each of limitations 9(a)–9(d), and Petitioner addresses this limitation with each of limitations 9(a)–9(d). *See* Pet. 16 n.2.

computer system.” Pet. 18 (citing Ex. 1002 ¶ 84); *see* Pet. 16–18 (reproducing Ex. 1003, Fig. 1 (with annotations); quoting Ex. 1003, 16:36–37, 18:18–22, 19:8–10, 31:22–23; citing Ex. 1002 ¶ 80; Ex. 1003, 16:36–41, 18:42–45)) (emphasis omitted). Petitioner explicitly relies on embodiments in Meyer in which the account provider (i.e., member information computer 109) and service provider (i.e., incentive information computer 105) are different entities and separate computers. *See* Pet. 18.

As an additional position, Petitioner asserts that Zeff “provides further support and motivation for the account provider and service provider being different entities having separate computers” based on Zeff’s teaching of an “ad network” that operates as “an intermediary between (a) an advertiser that wanted to place advertisements on third party websites, and (b) the third party websites that could display those advertisements.” Pet. 18–19 (citing Ex. 1002 ¶¶ 85–94; Ex. 1004, 65, 130–131); *see also* Pet. 19–20 (providing specific examples of ad networks). Petitioner contends that it would have been obvious to one of ordinary skill in the art to have Meyer’s account provider (i.e., member information computer 109) and service provider (i.e., incentive information computer 105) be different entities having separate computers. *See* Pet. 20. According to Petitioner,

separating the ad network from an advertiser that seeks to use the ad network would have beneficially allowed both entities to focus on the particular services in which they specialize, consistent with the ad network business model that had organically developed and that had become well-known and successful well before the ’615 patent.

Pet. 20–21 (citing Ex. 1002 ¶¶ 91, 93). Petitioner also asserts that separating the service provider from the account provider would have enabled Meyer’s account provider “to focus on its membership business without the

intricacies of advertising on third party websites” and “would have allowed the service provider to provide a more focused, more broadly applicable, and more profitable service.” Pet. 21 (citing Ex. 1002 ¶ 92), *see also* Pet. 21–22 (quoting Ex. 1004, 131–132; citing Ex. 1002 ¶ 91).

Petitioner further contends that Meyer discloses that the third party computer system controls “advertising space on a plurality of third party media properties” based on Meyer’s disclosure of “a system for distributing advertisements (incentives) accessed through incentive ‘existence messages’ (such as icons) displayed on web pages on the Internet.” Pet. 22 (citing Ex. 1003, 8:6–11, 27:65–28:9); *see* Pet. 22–23 (quoting Ex. 1003, 27:66–28:4; citing Ex. 1002 ¶ 95; Ex. 1003, 24:34–38, 49:67–50:4). According to Petitioner, “Meyer . . . discloses that the service provider computer (‘third party computer system’) ‘control[s] advertising space on a plurality of third party media properties’ because it controls display of incentive icons on third party web sites.” Pet. 23 (quoting Ex. 1003, 28:4–19) (emphasis omitted, alteration in original); *see also* Pet. 23–24 (citing Ex. 1002 ¶ 96; Ex. 1003, 15:47, 19:56–58, 28:8–9, 28:14–16, 29:53–30:21, 30:61–31:16, 55:19–20, 55:26–31).

Petitioner asserts that Meyer discloses or suggests that the BT computer system (i.e., account provider computer) at a first time (i.e., when the consumer creates a new account), arranges for a third party computer system (i.e., the service provide computer) to electronically tag a first computer of a first visitor visiting a first website (i.e., store a cookie on the consumer computer visiting the third party website in which the incentive icon was displayed). *See* Pet. 24–27; *see also* Pet. 35–37 (addressing Meyer’s disclosure of a server-side approach of transmitting a “Set-Cookie” HTTP response header to the browser causing the cookie to be written

(quoting Ex. 1003, 56:44–45; Ex. 1004, 50, citing Ex. 1002 ¶¶ 116–124; Ex. 1003, 56:15–22, 29:12–26; Ex. 1010, 24–25)). Petitioner explicitly relies on Meyer’s disclosed embodiment in which the incentives have display requirements. *See* Pet. 24–25 (quoting Ex. 1003, 32:7–11; citing Ex. 1002 ¶ 99; Ex. 1003, 23:54–58). Petitioner asserts that when an incentive icon is activated and has display requirements, the system invokes a “Get_Member_ID” procedure, which obtains the member ID of the consumer who activated the icon. *See* Pet. 25 (citing Ex. 1003, 32:47–55, Fig. 7). Petitioner explains that, if the “Get_Member_ID” procedure of Figure 7 determines that the consumer is not yet a member, a “Sign-On” procedure of Figure 8 is called to enroll a new member, which prompts the user to enter personal and demographic information. *See* Pet. 25–26 (reproducing Ex. 1003, Figs. 22–23; citing Ex. 1003, 14:59–64, 32:61–62, 33:5–6). Petitioner further explains that once the consumer enters the information, an account is set up for the member and the account provider process (i.e., a set of computer programs operating on the member information computer) is accessed to assign a member ID (i.e., a unique identifier for the member used to identify the member’s information) and store the member information in the account provider member database. *See* Pet. 26 (quoting Ex. 1003, 20:14–16, 33:30–34, Fig. 8; citing Ex. 1002 ¶¶ 101–102, 162, 165; Ex. 1003, 21:18–20). The member ID also is sent from the database, and a cookie (i.e., used to identify and target incentives to the member) is written to the consumer’s computer. *See* Pet. 26–27 (quoting Ex. 1003, 33:30–34, Fig. 8; citing Ex. 1002 ¶¶ 101–102, 162, 165; Ex. 1003, 59:33–39, 60:58–63).

Petitioner contends that Meyer’s system carries out the tagging process automatically with the BT computer system (i.e., account provider

computer system) based on Meyer’s disclosure that the account provider (i.e., member information computer 109) arranges for the tagging by providing the member ID that is stored in the cookie without user involvement. *See* Pet. 27–28 (citing Ex. 1002 ¶¶ 103–104; Ex. 1003, 33:30–34; Ex. 1004, 51). Petitioner notes that “[a]lthough the consumer in Meyer performs actions such as entering information to enroll as a member, those actions precede and are separate from the act of electronically tagging. This is consistent with the ’615 patent embodiments.” Pet. 28 (citing Ex. 1001, 2:8–13). Petitioner further notes that “[a]lthough the enrollment process in Meyer uses pop-up windows (e.g. Figs. 21–22), the enrollment process – and the resulting storage of the cookie–nevertheless occurs while ‘visiting the first website.’” Pet. 29 (emphasis omitted), *see also id.* (quoting Ex. 1003, 31:4–8; citing Ex. 1002 ¶ 106; Ex. 1003, 8:43–48, 19:42–55, 30:61–31:2, 32:63–67, 45:22–26, 54:44–46).

Petitioner asserts that “the electronic tagging in Meyer occurs ‘without transferring to the third party computer system any profile information related to the first visitor,’” on the basis that “the only information potentially transferred to the service provider computer during the enrollment process is the member ID which, as noted, is placed in a cookie stored on the consumer computer.” Pet. 30 (citing Ex. 1002 ¶ 108; Ex. 1003, 33:30–34) (emphasis omitted). According to Petitioner, “the member ID is not ‘profile information’ relating to the first visitor because it is simply a unique identifier used by the account provider computer to identify the member and retrieve its information from the database.” Pet. 30–31 (citing Ex. 1003, 59:33–39, 60:58–63) (emphasis omitted), *see* Pet. Reply 7. Petitioner asserts “[t]he member ID in Meyer does not itself contain and cannot by itself be used to derive any profile information.”

Pet. 31 (citing Ex. 1002 ¶ 108), *see also* Pet. Reply 7, 8. According to Petitioner, Meyer’s “enrollment process only causes user-provided member information to be transferred and stored on the account provider computer (‘BT computer system’), not the service provider computer (‘third party computer system’).” Pet. 31 (quoting Ex. 1003, 33:30–33; citing Ex. 1002 ¶ 109; Ex. 1003, 19:42–55, 20:14–16) (emphasis omitted).

In Response, Patent Owner asserts that Meyer does not teach claim limitation 9(a) because “the transfer of the member ID itself constitutes transfer of profile information to the service provider computer” because “profile information” “includes ‘demographic information’ and ‘observed behavior.’” PO Resp. 26–27, 28 (citing Ex. 2002 ¶¶ 71–77; Pet. 7–8); *see id.* at 30 (similar argument, citing Ex. 2002 ¶ 76); PO Sur-reply 9 (citing Ex. 2002 ¶¶ 71–77). Patent Owner asserts that “the member ID falls within the category of demographic information because it indicates the user’s membership with the account provider.” PO Resp. 28 (citing Ex. 2002 ¶¶ 73–74); *see also id.* at 28–29 (addressing Meyer’s teachings related to a member ID being a demographic characteristic, quoting Ex. 1003, 33:30–33, 33:54–58; citing Ex. 1003, 29:19–21, 37:23–27, Fig. 8; Pet. 71; Ex. 2005, 61:13–62:5), 30 (similar argument)). Patent Owner also contends that Meyer’s member ID constitutes profile information because it indicates “the observed behavior of the visitor.” *Id.* at 29 (citing PO Resp. 7–8; Ex. 1001, 3:30–44). According to Patent Owner, “[t]he member ID indicates, at least, that the user completed a registration form to register as a member with the account provider, because the member ID is created only after certain ‘member information is entered’ so that the account can be created.” *Id.* at 29–30 (quoting Ex. 1003, 33:30–33); *see also id.* at 30 (citing Ex. 2002 ¶ 75); PO Sur-reply 9 (quoting Ex. 1003, 33:30–33, citing Ex. 2002 ¶ 75).

On the foregoing basis, Patent Owner contends that “the transfer of the member ID in Meyer’s Figure 8 constitutes transferring to the [service provider computer] . . . profile information related to the first visitor.” PO Resp. 30.

In Reply, Petitioner disagrees that Meyer’s member ID constitutes demographic profile information and observed behavior profile information. *See* Pet. Reply 7–12. Petitioner contends the ’615 Patent makes clear that information such as a member ID, which associates the visitor with the claimed BT computer system is not profile information. *See id.* at 8. Petitioner asserts that Meyer’s disclosure of a member ID serves as an index and unique identifiers that allows the account provider computer to retrieve profile information stored in the database. *See id.* (citing Pet. 32–33; Ex. 1002 ¶¶ 108, 111). Petitioner contends that outside of serving as an index and unique identifier for retrieving information stored in the database, Meyer’s member ID is a meaningless and useless string of information that conveys no information. *See id.* (citing Ex. 1018 ¶ 24). Petitioner further asserts that Patent Owner’s broad application of “profile information” to include Meyer’s member ID as demographic information indicating membership would render claim 9 inoperable because claim 9 also recites that the tag identifies the visitor computer as associated with the BT company. *See id.* at 12 (citing Ex. 1018 ¶¶ 31–32).

We do not agree with Patent Owner’s arguments because, as explained above in Section II.A.2, we do not adopt Patent Owner’s proposed construction for “profile information” as including the observed behavior, in general, of a visitor to a first website or the demographic information, in general, about a media property visitor. As explained above in Section II.A.2, consistent with the ’615 Patent Specification disclosure, we

construe “profile information” to include “the observed behavior of the visitor on the media property,” “demographic information collected on the media property,” or both. Patent Owner’s arguments that Meyer’s member ID discloses profile information do not adequately address or explain why Meyer’s member ID is observed behavior of the visitor on the media property or demographic information of the visitor collected on the media property.

Patent Owner further contends that Meyer does not teach or suggest this limitation of claim 9 because Meyer’s disclosure of an arrangement for tagging results in member information (i.e., profile information) being transmitted to the service provider. *See* PO Resp. 31 (citing Ex. 2002 ¶¶ 78–84, Pet. 37–38); PO Sur-reply 20. Petitioner asserts that Meyer teaches that tagging involves transfer of the member ID from the account provider to the consumer computer, which allows the service provider to get the member ID from the cookie and use it to access the account provider ACCTPRVD to get member information (i.e., profile information) from the member database MMBR-DB. *See* PO Resp. 32 (reproducing Ex. 1003, Fig. 7 (with Patent Owner’s annotations); citing Ex. 2002 ¶¶ 79, 80), 34 (citing Ex. 1003, Fig. 2: step 211, Fig. 5B, Fig. 7). According to Patent Owner, “this member information is transmitted *as a result of* Meyer’s arrangement for tagging, because the member information is retrieved from the member database using the member ID that is stored in the cookie (i.e., the “tag” that is created as a result of the arrangement for tagging).” *Id.* at 34–35 (citing Ex. 2002 ¶ 83) (bold emphasis omitted). Referencing its claim construction arguments, Patent Owner reiterates that “the claims must be interpreted such that, at minimum, the arrangement for tagging does not

result in the transfer of profile information to the ‘third party computer system’ of the claims.” *Id.* at 35 (citing PO Resp. 9–14).

We do not agree with Patent Owner’s arguments because, as explained above in Section II.A.3., we do not adopt Patent Owner’s proposed construction that improperly limits “arranging for a third party computer system . . . to electronically tag a first computer of a first visitor visiting a first website, without transferring to the third party system any profile information related to the first visitor,” such that it “must not result in transfer of visitor profile information to the third party computer system.” As explained above in Section II.A.3., the plain language of claim 9 does not preclude or prohibit the transfer of profile information at other times, such as after the step of “arranging for a third party computer system . . . to electronically tag a first computer of a first visitor visiting a first website” In sum, we do not that Meyer does not disclose or teach this limitation of claim 9 based Meyer’s disclosure of subsequently accessing the account provider to get the member info (i.e., profile information) from the member database,” using the member ID that was previously obtained by transferring the member ID to the service provider when storing the cookie on the consumer computer (i.e., the tagging process).

Petitioner also asserts that Meyer discloses the “tag is readable by computers operating under a domain of the third party computer system and identifies the visitor computer as associated with the BT company,” on the basis that “the tag in Meyer clearly ‘identifies the visitor computer as associated with the BT company,’ because “the cookie stored on the consumer computer (the ‘tag’) identifies the member ID of the consumer,” which was issued by the account provider computer. Pet. 32 (citing Ex. 1003, 33:30–34) (emphasis omitted); *see* Pet. 32–34 (reproducing

Ex. 1003, 56:27–33 (annotations added); citing Ex. 1002 ¶¶ 111–112, 114–115; Ex. 1003, 32:37–40, 56:23–25, 56:37–38, 56:44–50, 59:33–39). According to Petitioner, “Meyer further confirms that the cookie that stores the member ID is in fact ‘readable by computers operating under a domain of the third party computer system,’” on the basis that “the service provider computer (‘third party computer system’) later reads the cookie from the consumer computer to identify the member.” Pet. 34 (quoting Ex. 1003, 56:15–18; citing Ex. 1002 ¶ 113; Ex. 1003, 29:12–14) (emphasis omitted); *see id.* (citing Ex. 1002 ¶¶ 114–115; Ex. 1003, 18:45–54, 19:6–15, 28:19–26, 31:14–16, 36:40–44).

Based on the entire record, we find that Meyer and the combination of Meyer and Zeff teaches or suggests this limitation of claim 9. *See* Pet. 16–36.

c. (b) [automatically with the BT computer system] . . . recording, in a profile of the first visitor maintained by the BT computer system, profile information collected during the first computer’s visit to the first website;

Petitioner asserts that Meyer teaches or suggests this limitation of claim 9. *See* Pet. 38–43. Petitioner contends that Meyer’s “account provider computer (‘BT intercomputer system’) includes member database 111 (MMBR-DB) for storing member information,” and that “database [111] records at least two types of profile information ‘collected during the first computer’s visit to the first website.’” Pet. 37 (citing Ex. 1003, 18:35–39, 21:18–20) (emphasis omitted). Petitioner contends that Meyer’s member database 111 includes an account database and that demographic information and information of clipping, redeeming, and viewing incentives is automatically recorded during a first visit. *See* Pet. 37–43 (reproducing Ex. 1003, Fig. 21; quoting Ex. 1003, 21:22–29, 34:48–65; citing Ex. 1002

¶¶ 106–107, 127–135; Ex. 1003, 8:43–48, 18:35–39, 21:29–32, 29:27–35, 29:53–58, 30:61–31:8, 33:35–39, 33:46–54, 34:48–35:3, 35:18–21, 36:27–31, 36:65–67, 40:44–51, 40:63–41:2, 45:22–26, 59:33–39).

Patent Owner does not substantively address or rebut Petitioner’s showing for this limitation of claim 9. *See* PO Resp. 18–52. In any event, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

Based on the entire record, we find that Meyer and the combination of Meyer and Zeff teaches or suggests this limitation of claim 9. *See* Pet. 37–43.

d. (c) [automatically with the BT computer system] . . . electronically transferring to the computer system a price cap that the BT company is willing to pay for allowing delivery of an advertisement within media property advertising space controlled by the third party computer system controlling advertising space on the plurality of third party media properties;

Petitioner asserts that the combination of Meyer, Zeff, and Edlund teaches or suggests this limitation of claim 9. *See* Pet. 43–50. More specifically, Petitioner contends that Zeff teaches “electronically transferring to [the auction system] a price cap that [an advertiser] is willing to pay for allowing delivery of an advertisement,” based on Zeff’s disclosure that the price cap “is provided through the bid electronically submitted by an advertiser over the Internet,” which, according to Petitioner, “qualifies as a ‘price cap’ because it represents the highest amount the advertiser indicated it was willing to pay, at the time of the bid, for the auctioned advertising placements.” Pet. 44–45 (citing Ex. 1002 ¶ 142) (emphasis omitted, alterations in original); *see also* Pet. 43–44 (reproducing Ex. 1004, Fig. 7.12; quoting Ex. 1004, 12, 81, citing Ex. 1002 ¶¶ 138–140; Ex. 1004, 83).

According to Petitioner, Zeff’s “CPM [cost per thousand]-based bid also qualifies as a price cap specifying what an advertiser ‘is willing to pay for allowing delivery of an advertisement,’ because it provides a price-per-display amount that is merely aggregated based on multiples of 1000.” Pet. 45 (citing Ex. 1002 ¶ 144) (emphasis omitted). Petitioner contends that the combination of Meyer and Zeff “would have been implemented in straightforward ways” and “resulted in the incentive system of Meyer in which the account provider (‘BT company’), who desires to purchase advertisement placements on third party websites, electronically transmits a bid to the service provider computer (‘third party computer system’) reflecting a price cap it is willing to pay.” Pet. 45–46 (citing Ex. 1002 ¶¶ 141, 145, 146; Ex. 1004, 33, 83–84) (emphasis omitted).

Petitioner asserts that it would have been obvious to one of ordinary skill in the art to modify Meyer to include electronically transferring a price cap that the BT company is willing to pay. *See* Pet. 45–47. Petitioner contends that Zeff discloses that auctions are a good place to buy and sell excess ad inventory, advertisers can usually get pretty good prices on well-recognized sites, and it is a way to generate revenue on inventory that would otherwise go unsold. *See* Pet. 46 (quoting Ex. 1004, 81; citing Ex. 1002 ¶ 149). Petitioner contends that using an auction and bidding system in Meyer could have resulted in a substantially lower price than the account provider might otherwise have paid. *See id.* (citing Ex. 1002 ¶ 148).

According to Petitioner,

[a]n ordinarily skilled artisan would have also appreciated that using an auction would have solved a problem for the service provider in deciding how much to charge for advertising. A known benefit of auctions is their ability to obtain the most

appropriate price based on direct purchaser feedback through competitive bidding.

Pet. 46–47 (citing Ex. 1002 ¶ 147).

In Response, Patent Owner argues that the Petition fails to provide a motivation or show a reasonable expectation of success in modifying the teachings of Meyer to incorporate automatic Dutch or proxy bidding. PO Resp. 42–52. More specifically, Patent Owner contends that “[t]he Petition’s proposal that Meyer’s service provider would have offered an auction for advertising space would make sense only if a large number of account providers were competing for common advertising space.” *See id.* at 44 (citing Ex. 2002 ¶ 97); PO Sur-reply 25. According to Patent Owner, “Meyer does not disclose or suggest that a large number of account providers would be competing for common advertising space.”

PO Resp. 44. In any event, Patent acknowledges that Meyer mentions that there may be multiple account providers associated with a service provider. *See id.* (citing Ex. 1003, 47:12–15). Nonetheless, Patent Owner criticizes Meyer’s disclosure for not saying how many account providers would be associated with a single service provider, not describing how account providers would divide up potential advertising space, not identifying the degree of relationship between the “service provider” and the multiple account providers, and not teaching how to implement Meyer’s system to operate in the context of a one-to-several mapping of service provider to account providers. *See id.* at 44–45 (citing Ex. 2002 ¶ 98); PO Sur-reply 25. According to Patent Owner, a person of ordinary skill in the art “reading Meyer would not view Meyer’s teachings as disclosing a service provider providing common advertising space for a large number of account providers.” PO Resp. 45 (quoting Ex. 2005, 65:3–14; citing Ex. 2002 ¶ 98).

We do not agree with Patent Owner's arguments because they are incorrectly premised on a requirement that, in order to provide a reason to modify the teachings of Meyer to include an auction and bidding system for electronically transferring a price cap, Meyer must disclose "a large number" of account providers competing for a common advertising space. Patent Owner does not direct us to persuasive authority to support its position that there must be deficiency in the prior art being modified in order to provide a reason for the modification. Rather, the Supreme Court instructs that it is often necessary "to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine." *KSR*, 550 U.S. at 41. Importantly, Patent Owner's arguments overlook that Zeff's teachings, highlighted by Petitioner, provide a reason for modifying the teachings of Meyer in view of Zeff's auction and bidding system for electronically transferring a price cap. *See* Pet. 45–47. For example, Zeff discloses that auctions are a good place to buy and sell excess ad inventory, advertisers can usually get pretty good prices on well-recognized sites, and it is a way to generate revenue on inventory that would otherwise go unsold. *See* Pet. 43, 46; Ex. 1004, 81.

Based on the entire record, including Petitioner's citations to Meyer, Zeff, Edlund, and Mr. Schmandt's testimony (Ex. 1002), we are persuaded Petitioner sets forth sufficient articulated reasoning with rational underpinning to support the conclusion that it would have been obvious to one of ordinary skill in the art to modify Meyer to include an auction and bidding system for electronically transferring a price cap that the BT company is willing to pay. *See* Pet. 45–47; *KSR*, 550 U.S. at 418.

Petitioner further recognizes that Zeff does not disclose that bids are electronically transmitted “automatically,” but asserts this would have been obvious based on the combination of Meyer, Zeff, and Edlund. *See* Pet. 47. According to Petitioner, Edlund discloses techniques for automating bids in Internet auctions, and in one embodiment a purchaser manages a number of Internet auctions by specifying desired items and the prices it is willing to pay. *See* Pet. 47–48 (quoting Ex. 1005, 2:35–37; citing Ex. 1005, code (57), 2:37–61). Petitioner asserts that Edlund discloses that the system “will then automatically contact the desired auctions sites and perform a query (poll) in specific time intervals to determine whether the selected item is currently available for purchase,” and “will then automatically select the auction with the lowest current bid and place a bid there.” Pet. 48 (quoting Ex. 1006, 2:61–67; citing Ex. 1002 ¶¶ 152–153; Ex. 1005, 4:58–5:6, 8:62–9:18) (emphasis omitted).

Petitioner asserts that it would have been obvious to one of ordinary skill in the art to modify the combination of Meyer and Zeff such that the account provider computer is enabled to automatically transmit a bid for internet advertising. *See* Pet. 48–50. More specifically, Petitioner contends that Edlund discloses that without automation techniques, purchasers have to do the entire bidding process manually, requiring careful monitoring of active auctions and quick reactions when others place higher bids. *See* Pet. 49 (quoting Ex. 1005, 2:27–30). Petitioner asserts that the techniques of Edlund would have alleviated the known problems of manually monitoring auctions and needless losing auctions by automatically submitting bids consistent with the purchaser’s intent. *See id.* (citing Ex. 1002 ¶ 157; Ex. 1005, 3:5–14). According to Petitioner, “[a]s a further benefit, Edlund’s techniques would have allowed an advertising purchaser to automatically

monitor and place bids across *multiple* auction sites” and “would have benefitted the proposed combination by ‘enhanc[ing] the probability of buying the desired item’ . . . because it would have expanded the potential universe of auction sites for Internet advertising beyond a single site.” Pet. 50 (citing Ex. 1002 ¶¶ 158, 189; Ex. 1005, 5:1–10, 6:46–49, 9:5–13) (second alteration in original).

In Response, Patent Owner contends that a person of ordinary skill in the art would not have found it obvious to modify Meyer’s architecture such that an account provider would submit bids automatically. *See* PO Resp. 46 (citing Ex. 2002 ¶¶ 101–106). According to Patent Owner, a person of ordinary skill in the art, “would not have been motivated to apply Edlund’s automated bidding techniques to the advertising context, because Edlund teaches only how to perform automated bidding when there is a commodity (i.e., a fungible) product such as a specific CDROM or music cassette.” *Id.* at 46–47 (citing Ex. 1005, 1:66–2:18, 4:58–5:6). Patent Owner asserts that a person of ordinary skill in the art “would recognize that these types of goods are notably different than advertising space, because advertising space is not the same from one media property to another.” *Id.* at 46 (citing Ex. 2002 ¶ 101). According to Patent Owner,

Edlund provides no teachings on how to automate bidding when the bidder wishes to bid on non-commodity items such as advertising space on a variety of different ad networks or websites. And applying Edlund’s “lowest current bid” algorithm to a non-commodity product, specifically advertising space, would create predictably disastrous results for the bidder.”

PO Resp. 48 (citing Ex. 2002 ¶¶ 102–103); *see also id.* at 48–52 (Patent Owner’s additional arguments that applying Edlund’s “lowest current bid” algorithm would create disastrous results, Edlund and/or the prior art fail to

teach how an automated bidding system would value an advertising space and determine the price cap according to a formula, and Edlund's automated bidding is inapplicable to Dutch and proxy auctions and scenarios where bid cancellation is not possible).

In Reply, Petitioner asserts that Edlund is not limited to tangible or commodity products because Edlund discloses that "the entire broad context of sales and purchase order bidding within normal commerce is within the anticipated scope of the present invention" and includes non-tangible items such "automated purchases of stock over the Internet." *See* Pet. Reply 20 (quoting Ex. 1005, 4:7–9, 10:41–51; citing Ex. 1002 ¶ 153; Ex. 1018 ¶ 51).

We do not agree with Patent Owner's arguments that Edlund's automated bidding is limited to commodities or fungible items and is not applicable to an online advertising space. The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned, as they are a part of the literature and are relevant for all they contain. *In re Heck*, 699 F.2d 1331, 1333 (Fed. Cir. 1983). Moreover, as pointed out by Petitioner, Edlund contemplates the use of its system for sales and purchase orders in normal commerce including non-tangible items.

We also do not agree with Patent Owner's additional arguments. *See* PO Resp. 48–52; PO Sur-reply 25–29. For example, Patent Owner's argument that applying Edlund's "lowest current bid" algorithm to an advertising space would create predictably disastrous results for the bidder, such as purchasing ad space on an inappropriate website (*see* PO Resp. 48 (citing Ex. 2005, 71:11–20); Pet. Reply 21, 25–26) overlooks that the Petition highlights Edlund's teachings that a bidder provides a configuration

profile for each auction site specifying desired items and prices it is willing to pay. *See* Pet. 48 (citing Ex. 1005, 2:37–53, 2:54–61). Patent Owner’s argument that a person of ordinary skill in the art would not recognize Edlund’s automated bidding teachings as applicable to Dutch or proxy auctions which require the bidder to specify a particular dollar amount for the bid (*see* Pet. 51) overlooks this same aforementioned teaching of Edlund. As another example, Patent Owner’s argument that Edlund and the prior art to not teach how an automated system would automatically value or automatically calculate the value of a particular advertising space (*see* PO Resp. 49–51; PO Sur-reply 27–28) is not commensurate in scope with the claim language which merely recites “transferring . . . a price cap” and does not recite or require automatically determining a value or otherwise calculating the claimed “price cap.” *See* Ex. 1001, 14:25–30; Pet. Reply 21–22. As a final example, Patent Owner’s argument that a person of ordinary skill in the art would not have been motivated to apply Edlund’s automated bidding techniques in scenarios where bid cancellation was not possible because Meyer does not allow bid cancellation (*see* PO Resp. 51–52 (citing Ex. 1005, 9:24–47; Ex. 2002 ¶ 108); PO Sur-reply 25–26, 27–28) addresses teachings of Edlund not relied upon by Petitioner for combining the teachings of Meyer, Zeff, and Edlund. *See* Pet. 47–50. This argument also focuses on the teachings of Meyer alone and does not address the teachings of Meyer in view of Zeff’s teachings of an auction and bidding system for electronically transferring a price cap.

Based on the entire record, including Petitioner’s citations to Meyer, Zeff, Edlund, and Mr. Schmandt’s testimony (Ex. 1002), we are persuaded Petitioner sets forth sufficient articulated reasoning with rational underpinning to support the conclusion that it would have been obvious to

one of ordinary skill in the art to modify the combination of Meyer and Zeff such that the account provider computer is enabled to automatically transmit a bid for internet advertising. *See* Pet. 48–50; *KSR*, 550 U.S. at 418.

In sum, based on the entire record, we find that the combination of Meyer, Zeff, and Edlund teaches or suggests this limitation of claim 9. *See* Pet. 43–50.

e. (d) [automatically with the BT computer system] . . . at a second time, later than the first time, upon receiving a redirection of the first computer while the first computer is visiting one of the plurality of third party media properties, causing a selected advertisement to be served to the first computer, which advertisement is based on the profile information collected during the first computer's visit to the first website, which profile information is in the profile of the first visitor maintained by the BT computer system, in exchange for a price less than the price cap.

Petitioner contends that the combination of Meyer, Zeff, Edlund, and Fisher teaches or suggests this limitation of claim 9. *See* Pet. 51–65.

Petitioner contends that Meyer discloses that “the consumer can, after enrollment (‘at a second time, later than the first time’) view a third party website and receive targeted incentives based on its member ID.” Pet. 51 (emphasis omitted). More specifically, Petitioner contends that the selected advertisement can be served to the first computer based on profile information collected during the first computer’s visit to the first website, which is in the profile of the first visitor maintained by the BT computer system, based on demographic information and behavioral information of the consumer. *See* Pet. 51–55 (quoting Ex. 1003, 8:6–11, 37:56–38:2, 38:11–13; citing Ex. 1002 ¶¶ 127–128, 163–168; Ex. 1003, 6:34–43, 7:27–30, 10:4–10; 21:29–32, 23:58–64, 24:24–32, 25:9–10, 26:24–31, 27:66–28:4, 29:5–27, 29:54–58, 33:23–29, 36:65–67; Figs. 16, 23–24). Petitioner contends that Meyer also discloses the service of a selected

advertisement occurs upon receiving a redirection of the first computer while the first computer is visiting one of the plurality of third media properties based on the display of the incentive and an incentive icon occurring as a result of a URL embedded on the third party website that causes the web browser to redirect to the service provider computer. *See* Pet. 55; *see also* Pet. 55–57 (providing additional details; quoting Ex. 1003, 28:11–26; citing Ex. 1002 ¶¶ 170–172; Ex. 1003, 10:54–56, 11:7–13, 12:24–34, 31:8–16, 29:54–58, 36:8–10; Ex. 1012, 5). According to Petitioner, “Meyer also makes clear that serving an incentive to the consumer computer, based on behavioral information, can occur ‘automatically’” based on Meyer’s disclosures that targeted incentive information can be displayed in response to a request to view an incentive when the user manually clicks an incentive icon, and alternatively displayed automatically when the incentive icon is displayed. Pet. 55 (citing Ex. 1002 ¶ 169; Ex. 1003, 10:54–56, 11:7–13, 12:24–34, 29:53–58, 37:62–66) (emphasis omitted); *see* Pet. 53 (citing Ex. 1002 ¶ 166). Petitioner further asserts that Meyer discloses that “[i]t also occurs ‘with the BT computer system’ because the account provider computer (‘the BT computer system’) works with the service provider computer to cause incentives to be displayed.” Pet. 57 (emphasis omitted). Petitioner asserts that Meyer’s account provider computer performs the critical step of providing member information based on the member ID which is essential to selecting and displaying the incentive to the user and also relies on the service provider computer to perform certain aspects of the incentive display process including responding to the URL that caused display of the incentive icon or incentive. *See* Pet. 57–58 (citing Ex. 1002 ¶¶ 165, 173; Ex. 1003, 29:5–21, 32:37–46). Petitioner asserts that claim 9 only requires “automatically with

the BT computer system,” and not “automatically by the BT computer system.” *See* Pet. 58.

Petitioner asserts that the combination of Meyer, Zeff, and Edlund does not disclose that the advertising would have been delivered in exchange for a price less than the price cap. *See* Pet. 62. Petitioner contends that this feature would have been obvious in view of Fisher’s teachings of known techniques for enhancing electronic auctions including “proxy bidding” and “Dutch auctions” that allows a purchaser to win the auction and pay an amount less than its maximum bid amount. *See* Pet. 62–63 (quoting Ex. 1006, 10:29–33; citing Ex. 1002 ¶¶ 183–184; Ex. 1006, 12:63–13:24, 9:19–26).

Petitioner asserts that it would have been obvious to one of ordinary skill in the art to modify the combined teachings of Meyer, Zeff, and Edlund, in view of Fisher to deliver advertising in exchange for a price less than the price cap. *See* Pet. 63–65. Petitioner contends that a person of ordinary skill in the art would have been motivated to adapt Meyer’s service provider computer to provide proxy bidding as disclosed by Fisher to improve auction fairness because it can beneficially prevent a purchaser from significantly overpaying if it submits an abnormally high bid. *See* Pet. 64 (quoting Ex. 1006, 13:15–24; citing Ex. 1002 ¶ 187). Petitioner also asserts that a person of ordinary skill in the art would have been motivated to adapt Meyer’s service provider computer to employ a Dutch auction format because it is the most fair when a plurality of a specific item is being auctioned and guarantees that everyone who wins pays the same price. *See* Pet. 64–65 (citing Ex. 1002 ¶¶ 188–189; Ex. 1006, 10:33–35).

In Response, Patent Owner argues that the Petition fails to provide a motivation or show a reasonable expectation of success in modifying the

teachings of Meyer to incorporate automatic Dutch or proxy bidding. PO Resp. 42–52. More specifically, Patent Owner asserts that the Petition does not identify any articulated reasoning supporting a motivation to use automatic bidding in conjunction with proxy or Dutch bidding. *See id.* at 45. Patent Owner asserts that the Petitioner’s purported benefit of Dutch or proxy bidding accrue to the bidders (i.e., Meyer’s account providers). *See id.* at 45–46 (quoting Pet. 64). Patent Owner contends that in Meyer, the service provider would need to implement the Dutch or proxy bidding, and “[t]he Petition does not identify any benefit for the service provider, much less that any that would outweigh the obvious drawback to the service provider of foregoing additional revenue in scenarios where an account provider would have been willing to spend more money to purchase an advertisement.” PO Resp. 46 (citing Ex. 2002 ¶ 100). According to Patent Owner, “[i]n other words, it is not articulated reasoning to suppose that a service provider would undercut its own financial incentives by implementing a modification that benefits the opposing party in a zero-sum game.” *Id.*

In Reply, Petitioner asserts that Patent Owner’s argument overlooks the benefits of increased bidder confidence, leading to greater auction participation and thus greater revenue over the long term for sellers of advertising. *See* Pet. Reply 19–20 (citing Pet. 64–65; Ex. 1002 ¶ 187; Ex. 1018 ¶¶ 51–52). Petitioner contends that “[t]his would also have provided a distinct competitive advantage for sellers, as the safeguards of a Dutch auction would have encouraged more bidders to participate.” *Id.* at 20 (citing Ex. 1018 ¶ 52).

We do not agree with Patent Owner’s arguments that there is insufficient reason to modify the combined teachings of Meyer, Zeff, and

Edlund to further include the use of proxy or Dutch bidding as taught by Fisher because it may result in drawbacks for service providers. As explained by Petitioner, the use of proxy or Dutch bidding provides benefits to both buyers and sellers. *See, e.g.*, Pet. 62–66; Pet. Reply 19; Ex. 1002 ¶ 187. Although the combination of Meyer, Zeff, Edlund, and Fisher may result the service provider foregoing additional revenue in scenarios where an account provider would have been willing to spend more money to purchase an advertisement, we do not agree this drawback undercuts Petitioner’s showing of the advantages of the combination. More specifically, Patent Owner’s arguments do not undercut Petitioner’s showing that the combination Meyer, Zeff, Edlund, and Fisher would improve auction fairness because it can beneficially prevent a purchaser from significantly overpaying if it submits an abnormally high bid, is the most fair when a plurality of a specific item is being auctioned and guarantees that everyone who wins pays the same price, and increases bidder confidence, auction participation, and revenue over the long term for sellers of advertising. *See* Pet. 64–65; Ex. 1002 ¶ 187. “[A] given course of action often has simultaneous advantages and disadvantages, and this does not necessarily obviate motivation to combine.” *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006). “The fact that the motivating benefit comes at the expense of another benefit, however, should not nullify its use as a basis to modify the disclosure of one reference with the teachings of another. Instead, the benefits, both lost and gained, should be weighed against one another.” *Id.* (quoting *Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 n.8 (Fed. Cir. 2000)).

Based on the entire record, including Petitioner’s citations to Meyer, Zeff, Edlund, Fisher, and Mr. Schmandt’s testimony (Ex. 1002), we are

persuaded Petitioner sets forth sufficient articulated reasoning with rational underpinning to support the conclusion that it would have been obvious to one of ordinary skill in the art to modify the combined teachings of Meyer, Zeff, and Edlund, in view of Fisher to deliver advertising in exchange for a price less than the price cap. *See* Pet. 63–65; *KSR*, 550 U.S. at 418.

In sum, based on the entire record, we find that the combination of Meyer, Zeff, Edlund, and Fisher teaches or suggests this limitation of claim 9. *See* Pet. 51–65.

f. Summary

Based on the entire record, Petitioner has established by a preponderance of the evidence that claim 9 is unpatentable under 35 U.S.C. § 103 over Meyer, Zeff, Edlund, and Fisher.

6. Analysis of Dependent Claim 12

Claim 12 depends from claim 9 and recites “[t]he system of claim 9 further comprising a storage containing visitor profile information and . . . the act in part (d) . . . comprises (i) selecting an advertisement based on the visitor profile information in the storage, and (ii) serving the selected advertisement to the first computer.” Ex. 1001, 14:51–57. Relying on its analysis addressing the limitation claim 9 (d), Petitioner asserts that Meyer teaches the limitations of claim 12. *See* Pet. 67–68 (citing Ex. 1002 ¶ 198).

Patent Owner argues that Meyer does not teach or suggest the limitations of claim 12 because Meyer’s account provider computer does not select advertisements or serve advertisements. Referencing its claim construction arguments, Patent Owner asserts that independent claim 9 specifies that the BT computer system must perform the step of causing a selected advertisement to be served, and therefore claim 12 requires that the

BT computer system must select an advertisement and serve the selected advertisement. *See* PO Resp. 52–53 (citing Ex. 2002 ¶ 109; PO Resp. 14–16). Patent Owner contends that Meyer discloses the service provider, not the account provider selects and serves the selected advertisement. *See id.* at 53–54 (quoting Ex. 1003, 19:56–58, 31:57–59; citing Ex. 1003, 32:2–5, Fig. 3; PO Resp. 31–35; Ex. 2002 ¶ 110).

As explained above in Section II.A.1 addressing “automatically with the BT computer system” we do not adopt Patent Owner’s proposed narrow construction that would require the acts recited in claim 9 to be performed in whole or part by the BT computer system. Accordingly, we do not agree with Patent Owner’s argument that Meyer does not disclose or teach this limitation because Meyer’s account provider does not select and serve advertisements.

Based on the entire record, we find that the combination of Meyer, Zeff, Edlund, and Fisher teaches or suggests the limitations of dependent claim 12. *See* Pet. 51–65, 67–68. Accordingly, based on the entire record, Petitioner has established by a preponderance of the evidence that claim 12 is unpatentable under 35 U.S.C. § 103 over Meyer, Zeff, Edlund, and Fisher.

7. Analysis of Dependent Claims 10 and 11

Claim 10 depends from claim 9 and further recites “[t]he advertisement is automatically served to the first computer along with content of the one of the media properties visited by the first computer.” Ex. 1001, 14:41–44. Petitioner asserts that in Meyer, when the incentive icon or incentive itself is automatically served to the consumer computer, it is presented along with the content of the third party website on which the incentive appeared. *See* Pet. 65 (quoting Ex. 1003, 25:11–16, 27:66–28:4;

citing Ex. 1003, 24:34–38, 27:66–28:25). According to Petitioner, “[i]t would have been obvious that these websites would have displayed their own content along with the displayed incentive icon and/or incentive.” Pet. 65–66 (citing Ex. 1002 ¶ 192).

Claim 11 also depends from claim 9 and further recites “automatically with the BT computer system, after part (d), recording data indicating that the BT company owes the price to a proprietor of the computer system controlling advertising space on the plurality of media properties.” Ex. 1001, 14:45–50. Petitioner asserts that Meyer’s account provider can automatically record that an incentive icon or incentive itself has been delivered to a user. *See* Pet. 66 (citing Ex. 1003, 29:27–35, 34:48–65). According to Petitioner, “[a]n ordinarily skilled artisan would have understood and found it obvious that this information was recorded ‘automatically,’ as explained for claim 9(b).” *Id.* (citing Ex. 1002 ¶¶ 135, 193); *see* Pet. 37–43 (addressing claim limitation 9(b)). Petitioner further asserts that the information represents “data indicating that the BT company owes the price to the proprietor of the computer system controlling advertising space on the plurality of media properties” because, in the combination of Meyer, Zeff, Edlund, and Fisher, the “price” was based on CPM and therefore based on display of the advertisement. *See* Pet. 66–67 (citing Ex. 1002 ¶¶ 194).

Patent Owner does not substantively address or rebut Petitioner’s showing addressing the limitations of claims 10 and 11. *See* PO Resp. 2. In any event, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

Based on the entire record, we determine Petitioner shows by a preponderance of the evidence that Meyer teaches or suggests the additional

limitations of dependent claims 10 and 11. *See* Pet. 65–67. Accordingly, based on the entire record, Petitioner has established by a preponderance of the evidence that claims 10 and 11 are unpatentable under 35 U.S.C. § 103 over Meyer, Zeff, Edlund, and Fisher.

E. Challenge to Claims 9–12 over Meyer, Zeff, Edlund, Fisher, and Tittel

Petitioner also challenges the patentability under 35 U.S.C. § 103 of claims 9–12 over Meyer, Zeff, Edlund, Fisher, and Tittel. We need not determine the merits of this challenge because, as explained above, Petitioner has shown by a preponderance of the evidence that claims 9–12, are unpatentable under 35 U.S.C. § 103 over Meyer, Zeff, Edlund, and Fisher. *See SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1359 (2018) (holding that a petitioner “is entitled to a final written decision addressing all of the claims it has challenged”); *Beloit Corp. v. Valmet Oy*, 742 F.2d 1421, 1423 (Fed. Cir. 1984) (finding an administrative agency is at liberty to reach a decision based on a single dispositive issue because doing so “can not only save the parties, the [agency], and [the reviewing] court unnecessary cost and effort,” but can “greatly ease the burden on [an agency] faced with a . . . proceeding involving numerous complex issues and required by statute to reach its conclusion within rigid time limits”); *Bos. Sci. Scimed, Inc. v. Cook Grp. Inc.*, 809 F. App’x 984, 990 (Fed. Cir. 2020) (non-precedential) (recognizing that the “Board need not address issues that are not necessary to the resolution of the proceeding” and, thus, agreeing that the Board has “discretion to decline to decide additional instituted grounds once the petitioner has prevailed on all its challenged claims”).

III. CONCLUSION

For the foregoing reasons, and after having analyzed the entire record and assigning appropriate weight to the cited supporting evidence, Petitioner has established by a preponderance of the evidence that claims 9–12 of the '615 Patent are unpatentable.¹¹

In summary:

Claims	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
9–12	103(a)	Meyer, Zeff, Edlund, Fisher,	9–12	
9–12	103(a)	Meyer, Zeff, Edlund, Fisher, Tittel ¹²		
Overall Outcome			9–12	

IV. ORDER

Accordingly, it is

ORDERED that, Petitioner has shown by a preponderance of the evidence that claims 9–12 of the '615 Patent are unpatentable;

¹¹ Should Patent Owner pursue amendment of the challenged claims in a reissue or reexamination proceeding, we direct 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. *See* 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner files a reissue application or a request for reexamination, Patent Owner is reminded 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).

¹² As explained above in Section II.E, because Petitioner shows all of the claims are unpatentable on the basis of Meyer, Zeff, Edlund, and Fisher, we need not reach this patentability challenge on the basis of Meyer, Zeff, Edlund, Fisher, and Tittel.

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

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