

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STODGE, INC. D/B/A POSTSCRIPT,
Petitioner,

v.

ATTENTIVE MOBILE INC.,
Patent Owner.

IPR2023-01338
Patent 11,416,887

Before HUBERT C. LORIN, LYNNE H. BROWNE, and
SCOTT A. DANIELS, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background

Stodge, Inc. d/b/a Postscript (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–20 of U.S. Patent No. 11,416,887 (Ex. 1001, “the ’887 patent”). Attentive Mobile Inc. (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”).

We have authority under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the Petition and the Preliminary Response shows that “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (2018).

Upon consideration of the arguments and evidence presented by Petitioner, we deny Petitioner’s request to institute an *inter partes* review as to the challenged claims of the ’887 patent on the grounds of unpatentability presented.

B. Related Proceedings

Petitioner indicates, and Patent Owner agrees, that the ’887 patent was asserted in: *Attentive Mobile Inc. v. 317 Labs, Inc. d/b/a Emotive*, No. 1-22-cv-01163 (D. Del 2022) and *Attentive Mobile Inc. v. Stodge Inc. d/b/a Postscript*, No. 1-23-cv-00087 (D. Del. 2023) (“District Court Actions”). Pet. 8; Paper 5, 1.

C. Real Parties in Interest

Petitioner identifies “Stodge, Inc. d/b/a Postscript” as the real party in interest. Pet. 8. Patent Owner identifies “Attentive Mobile Inc.” as the real party in interest. Paper 5, 1.

D. The '887 patent (Ex. 1001)

1. Disclosure

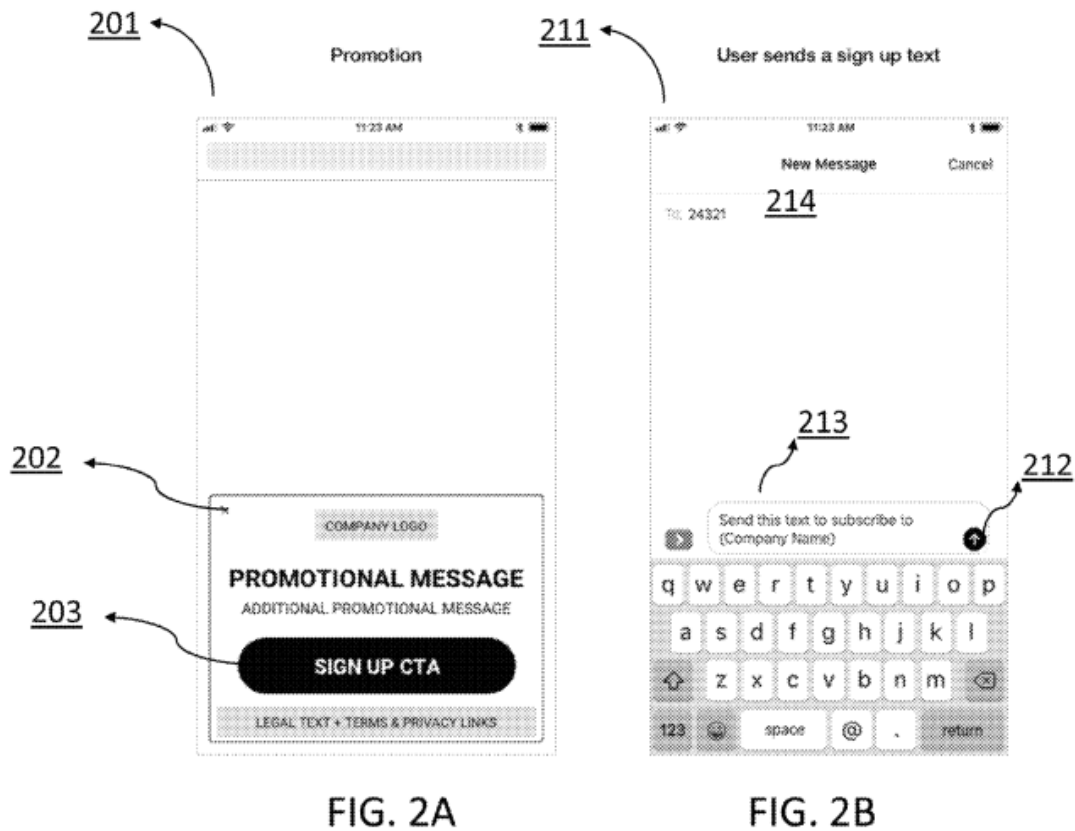
The '887 patent, titled “Methods and Apparatus for Mobile Device Messaging-Based Communications Using Custom-Generated Deeplinks and Based on the Hyper Text Transfer Protocol (HTTP),” relates to vendor applications and websites opened on mobile devices. Ex. 1001, code (54), 1:36–38.

The '887 patent explains that “[k]nown methods allow a user to open a vendor’s application or a vendor’s website on a mobile device to select a product or service,” and then “provide payment information via the vendor’s application or website to complete a transaction with the vendor.” Ex. 1001, 1:36–40.

According to the '887 patent, “[w]ith these known methods . . . the user often pauses its previous activities . . . on the mobile device and is redirected to the vendor’s application or website to purchase the products and services via many user input.” Ex. 1001, 1:40–47. “Accordingly, a need exists for methods and apparatus for dynamic application deeplinking to transition from one user interface to another user interface at a mobile device for continued and improved user experience and engagement when interacting with the mobile device.” *Id.* at 1:48–52.

To that end, the '887 patent discloses providing an input at a webpage at a first user interface being executed at a mobile device, and “deeplink[ing] to the second user interface” and “caus[ing] the second user interface to be rendered at the mobile device with the purchase information pre-populated in an input field of a text message for the user to initiate a purchase via the

text message.” Ex. 1001, 1:56–2:25. This is depicted in Figures 2A and 2B of the ’887 patent, reproduced below.



Figs. 2A and 2B of the ’887 patent (Ex. 1001) showing “screenshots of user interfaces at a user mobile device in a click-to-text subscription process.” Ex. 1001, 2:35–37.

The first user interface (201) depicted in Fig. 2A “displays a promotional message 202 . . . at the user mobile device and provides a ‘sign-up’ link 203, when selected, clicked or tapped by the user, initiating a second user interface 211 at the user mobile device.” Ex. 1001, 7:34–39. The second user interface (211) depicted in Fig. 2B, “[i]n response to user selections, clicks or taps at the ‘sign up’ link 203 . . . opens with a message pre-populated with a subscription request 213.” *Id.* at 7:48–52.

2. Claims 1–20

Petitioner challenges claims 1–20. Pet. 8, 18.

Claim 1, reproduced below, is the sole independent claim from which claims 2–20 depend. Petitioner’s designations are added to assist in identifying the claim limitations.¹

1. [1a] At least one non-transitory processor-readable medium storing code configured to be executed by a processor of a click-to-text server, the code including instructions configured to cause the click-to-text server to:

[1b] send, to a client server, an integration tag configured to be served with a webpage hosted by the client server, [1c] the integration tag configured to cause a mobile device loading the webpage via a first application to send user data to at least one of the client server or the click-to-text server;

[1d] define and send a uniform resource identifier (URI) to the mobile device in response to the mobile device executing the integration tag, the URI deeplinking to a messaging application different from the first application and [1e] configured to cause the mobile device to (1) automatically transition from the first application to the messaging application in response to the mobile device detecting a user interaction with a promotional message associated with the webpage, the messaging application being different from the first application, and [1f] (2) automatically populate a custom message in the messaging application that includes an address associated with the click-to-text server and a message body that includes an identifier associated with at least one of the webpage or the user data [1g] such that, upon detecting a single user interaction with a send button of the messaging application, the mobile device sends the custom message to the click-to-text server;

¹ Petitioner’s designations are set forth in brackets. Pet. 17–18.

[1h] receive the custom message at the click-to-text server;
and

[1i] enroll the mobile device in a promotion associated with the promotional message based on receiving the custom message and without receiving any additional information from the mobile device.

Ex. 1001, 21:40–22:5.

E. Asserted References

Petitioner relies on the following references:

Name	Reference	Exhibit No.
Haggerty	U.S. Patent No. 8,532,283, issued Sep. 10, 2013	1007
Demsey	U.S. Patent Application Publication No. 2014/0379482A1, published Dec. 25, 2014	1005
Khanna	U.S. Patent Application Publication No. 2013/0111328A1, published May 2, 2013	1006
Rakavy	U.S. Patent No. 5,913,040, issued June 15, 1999	1018
<i>Ad Serving Technology</i>	Gregory Cristal, <i>Ad Serving Technology</i> (2014)	1012
Molinet	U.S. Patent Application Publication No. 2016/0142858A1, published May 19, 2016	1009

F. Evidence

Petitioner also relies on the Declaration of Dr. Henry Houh (Ex. 1002, “Houh Decl.”) as support for the various contentions.

Patent Owner relies on the Declaration of Dr. Sam Malek (Ex. 2001, “Malek Decl.”) as support for the various contentions.

G. Asserted Grounds

Petitioner contends that claims 1–20 of the ’887 patent are unpatentable under the following grounds:

Ground	Claims Challenged	35 U.S.C. §	Reference(s)/Basis
I	1, 2, 13, 14	§ 103 ²	Haggerty, Demsey, and Khanna
II	1–4, 6–10, 13, 14, 19	§ 103	Haggerty, Demsey, Khanna, and Rakavy
III	1, 2, 5, 13–18	§ 103	Haggerty, Demsey, Khanna, <i>Ad Serving Technology</i>
IV	1, 2, 11–14, 20	§ 103	Haggerty, Demsey, Khanna, Molinet

Pet. 9.

II. ANALYSIS

A. Principles of Law for Patentability

A patent 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 said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art;

² The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. §§ 102 and 103. Because the challenged claims of the ’887 patent have an effective filing date after the effective date of the applicable AIA amendments, we refer to the AIA versions of 35 U.S.C. § 103 throughout this Decision.

(2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) when in evidence, objective evidence of nonobviousness.³ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

“An obviousness determination requires finding that a person of ordinary skill in the art would have been motivated to combine or modify the teachings in the prior art and would have had a reasonable expectation of success in doing so.” *Regents of Univ. of Cal. v. Broad Inst., Inc.*, 903 F.3d 1286, 1291 (Fed. Cir. 2018).

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Technology, Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). This burden of persuasion never shifts to Patent Owner. See *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (discussing the burden of proof in *inter partes* review).

B. Level of Ordinary Skill in the Art

Petitioner contends that the “**level of ordinary skill** encompassed a person having a Bachelor’s Degree in computer science and three years of experience in Web-based programming methods, where a higher level of education may substitute for experience and vice-versa.” Pet. 32 (citing Ex. 1002 ¶¶ 68, 89–93).

³ Patent Owner presents objective evidence of nonobviousness at this stage of the proceeding. Prelim. Resp. 59–71.

Patent Owner states that a person of ordinary skill in the art “would have had a bachelor’s degree in an accredited program of computer science, computer engineering, electrical engineering, or a similar discipline, and have 2-3 years of practical work or research experience in mobile and web application programming.” Prelim. Resp. 15.

The parties propose similar definitions of a person of ordinary skill in the art. Petitioner’s definition appears reasonable, and we adopt that definition for our analysis in this decision. Accordingly, for the purposes of this Decision, we adopt Petitioner’s proposal regarding the level of one of ordinary skill in the art. We determine that the level reflected in the prior art is consistent with Petitioner’s definition.

C. Claim Construction

Petitioner does not submit constructions for any claim terms. *See* Pet. 19 (“Petitioner submits that the Board need not construe any claim terms to consider the prior art and arguments presented herein.”)

“Patent Owner and its expert apply the plain and ordinary meaning of all claim terms.” Prelim. Resp. 14. Patent Owner notes that “[i]n the district court litigation, Petitioner has proposed constructions for six claim terms” but that Petitioner has not “raise[d] these issues in its petition.” *Id.* (citing Ex. 2012, 3-13).

No term has been indicated as being in controversy. *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999). To the extent the meaning of any term requires discussion, we provide it in our analysis of the patentability challenges.

D. Overview of the Prior Art References

We limit this overview to the references applied in Ground I, on which our denial of institution on the merits of this case is based.

1. Haggerty (Ex. 1007)

Haggerty is directed to using advertising technology to drive contact from customers. Ex. 1007, 1:19–21. Haggerty discloses embedding a quick respond (“QR”) code or a link in an advertisement in electronic reading material. *Id.* at 10:8–11; 59–62. In one embodiment, when a user interacts with the embedded QR code, a “mobile phone [is caused] to formulate a SMS⁴ message to a destination address with the message text portion pre-populated.” *Id.* at 12:44–45; *see also* 13:14–16, 39–42. Once the user authorizes sending the message, the message is transmitted to a call center. *Id.* at 12:46–47. The call center determines the advertising campaign associated with the message. *Id.* 12:55–56. Once the call center identifies the campaign, the call center may respond with a response SMS message. *Id.* at 13:1–3.

2. Demsey (Ex. 1005)

Demsey relates to “systems and methods for identifying users as they use various devices to access the Internet (e.g., by browser-linking technologies), and to online advertising based on users’ identities for targeted and behavioral advertising.” Ex. 1005 ¶ 1. Demsey describes “receiving, over a network, a request for an advertisement to display at a first device of the user, the request including a unique identifier stored on the

⁴ “Short Message Service.”

user's first device; . . . and identifying, based on the demographic or browsing history information, an advertisement to display at the user's first device *Id.* at ¶ 9. In one embodiment, this is accomplished by the user's first device (1) "request[ing] a web page or ad from an ad or publisher server," and (2) "receiv[ing] HTTP and an ad tag from the ad or publisher server." *Id.* at ¶ 45. The user's first device "may execute the ad tag, such as by executing any type of client side script (e.g., JavaScript)" to look-up a unique ID stored on the device and issue an ad request to the ad server that includes the looked-up unique ID. *Id.*

3. *Khanna (Ex. 1006)*

Khanna discloses "technologies relating to launching applications from content items in webpages." Ex. 1006, code (57). Khanna describes a method whereby a content item is received that includes "a first data element that identifies an application and a second data element that identifies a product." *Id.* at ¶ 5. In response to receiving a user selection of the content item, the request is transmitted to a server, "wherein the request includes the first data element, and installing [if not installed] the application identified by the first data element on the user device." *Id.* This "may further include launching the application with the second data element as an input so that the first content displayed by the application relates to the product." *Id.* Khanna discloses embodiments whereby launching the application involves deploying a deep-link. *See, e.g., id.* at ¶ 15. "Deep-linking is making a hyperlink that points to a specific content (e.g., a webpage or image) on a destination website, instead of that website's main or home page." *Id.* at

¶ 30. “A link that directs a user to a webpage for a particular product on the merchant’s website, without viewing the main or home page, is an example of a deep-link.” *Id.*

E. Ground I

Petitioner challenges claims 1, 2, 13, and 14 as unpatentable over 35 U.S.C. § 103 over the combination of Haggerty, Demsey, and Khanna. Pet. 20–54.

Petitioner’s position is that Haggerty teaches all that is claimed but for the limitations to using an integration tag (*inter alia*, [1b], [1c]) and a deeplinking uniform resource identifier (“URI”) (*inter alia*, [1d], [1e]), for which Demsey and Khanna are relied upon, respectively. *See, e.g.*, the claim chart at Pet. 17–18. “This ground posits that it would have been obvious to implement Haggerty’s business method using well-known ad-serving technology, by adding the techniques of Demsey (an ad-network patent) and Khanna (a mobile app deeplinking patent).” Pet. 20 (citing Ex. 1002 ¶¶70-71).

a. Claim 1

Claim 1 is directed to a processor-readable medium having “code including instructions configured to cause” a “click-to-text server” ([1a]) to perform functions [1b]–[1i] as recited in the claim. *See* section I.D.2.

Haggerty

Petitioner provides an annotated version of Figure 1 of Haggerty, reproduced below, outlining with a red-dashed line that portion of Haggerty’s call center which Petitioner contends is a “click-to-text” server. Pet. 35 (citing, *inter alia*, Ex. 1007, Fig. 1, 3:44-63, 5:45-7:62; Ex. 1002 ¶ 98).

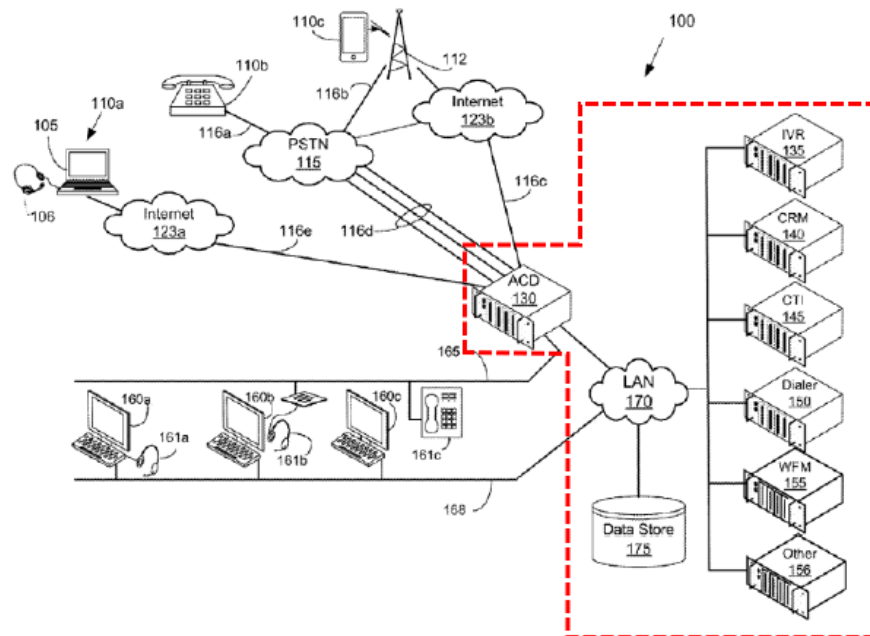


Figure 1 of Haggerty showing a call center 100 and, within the red-dashed line, an automatic call distributor 130, an interactive voice response server 135, a customer relationship management server 140, a computer-telephone integrated server 145, a dialer 150, a workforce management server 155, a processing device 156, local network 170, and data store 175. Ex. 1007, 3:45–46, 4:58–59, 6:29–30, 53–54; 5:63–64, 7:17, 22–23, 36–37, 27:36, 19:20–21, respectively.

The portion of Haggerty’s call center outlined by a red dotted line in Petitioner’s annotated version of Figure 1, reproduced above, cannot alone meet the claimed “click-to-text server” because Haggerty does not teach that portion of the call center being caused to perform all of the functions recited in the claim. To fill the missing disclosure, Petitioner relies on Demsey and Khanna.

Demsey

Demsey is relied on for teaching “code including instructions configured to cause” a “click-to-text server” to “send, to a client server, an

integration tag configured to be served with a webpage hosted by [a] client server” ([1b]), where “the integration tag [is] configured to cause a mobile device loading the webpage via a first application to send user data to at least one of the client server or the click-to-text server” ([1c]), according to Petitioner. Pet. 36–42.

Petitioner contends that Demsey teaches “ad tags,” which, according to Petitioner, are integration tags as the claim calls for. Pet. 36 (citing Ex. 1005 ¶ 5; Ex. 1002 ¶ 102). The “ad tags of Demsey are ‘**integration tags**’ because they are code . . . that performs the functions as an integration tag.” *Id.* at 37 (citing, *inter alia*, Ex. 1002 ¶¶ 103, 105; Ex. 1005 ¶ 45 (“The user's first device 502 may execute the ad tag, such as by executing any type of client side script (e.g., JavaScript) . . .”). Petitioner contends that Demsey’s “ad tags are **configured to be served with a webpage hosted by the client server.**” *Id.* (citing Ex. 1005 ¶¶ 5, 45, 47; Ex. 1002 ¶ 104).

Petitioner explains that

Demsey sends “ad tags” to a publisher for inclusion in webpages. (Ex. 1005, ¶0005)(Ex. 1002, ¶78). When a webpage is downloaded to a user device, the ad tag (which uses JavaScript, a common programming language for webpages) executes and requests that an advertisement be sent back to the user’s device for display. (Ex. 1005, ¶¶0045-0048, Fig. 5)(Ex. 1002, ¶78).

Id. at 25. In support thereof, Petitioner provides an annotated version of Demsey Figure 5, reproduced below, showing, via red-dashed boxes, a user device downloading a webpage containing an ad tag (at 2), the device issuing an ad request and sending a user ID (at 4A), and the server responding by sending an ad back to the user device for incorporation into the webpage on the device (at 5). *Id.* at 25–26 (citing Ex. 1005 ¶¶ 41, 45; Ex. 1002 ¶ 78).

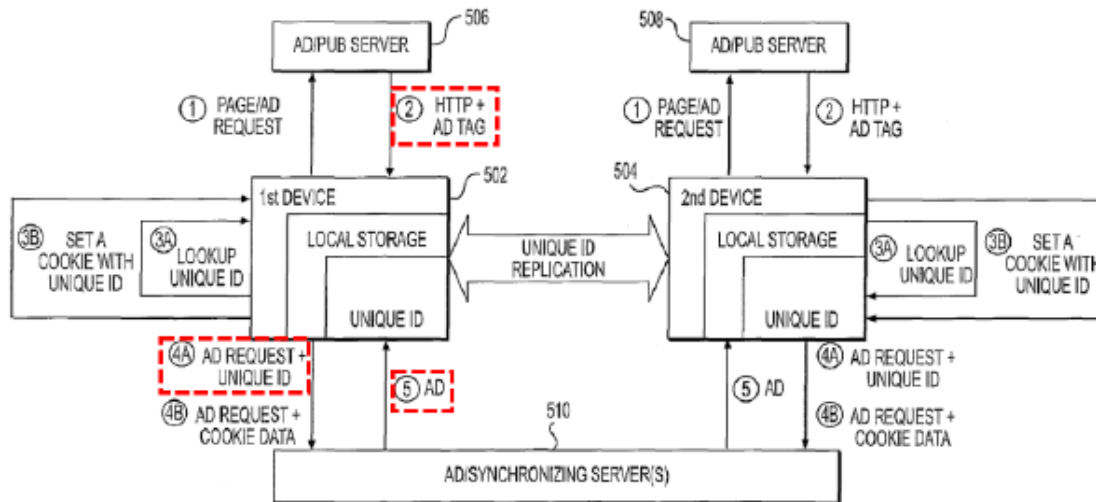


FIG. 5

Figure 5 of Demsey showing a “flow for performing Internet advertising techniques based on user advertising IDs synchronized across devices and browsers.” Ex. 1005 ¶ 19. Red-dashed boxes indicate a user device downloading a webpage containing an ad tag (at 2), the device issuing an ad request and sending a user ID (at 4A), and the server responding by sending an ad back to the user device for incorporation into the webpage on the device (at 5). *Id.* at ¶ 45.

Khanna

Khanna is relied on for teaching “code including instructions configured to cause” a “click-to-text server” to “define and send a uniform resource identifier (URI) to the mobile device in response to the mobile device executing the integration tag, the URI deeplinking to a messaging application different from the first application” ([1d]) and “configured to cause the mobile device to (1) automatically transition from the first application to [a second] application in response to the mobile device detecting a user interaction with a promotional message associated with the

webpage, the [second] application being different from the first application” ([1e]). Pet. 42–45.

Petitioner concedes that “Demsey does not teach mobile app deeplinking.” Pet. 42. Petitioner asserts that “Khanna teaches mobile app deeplinking from ads served from an ad server.” *Id.* To help explain Khanna’s deeplinking technique, Petitioner reproduces Figure 1 of Khanna, reproduced below.

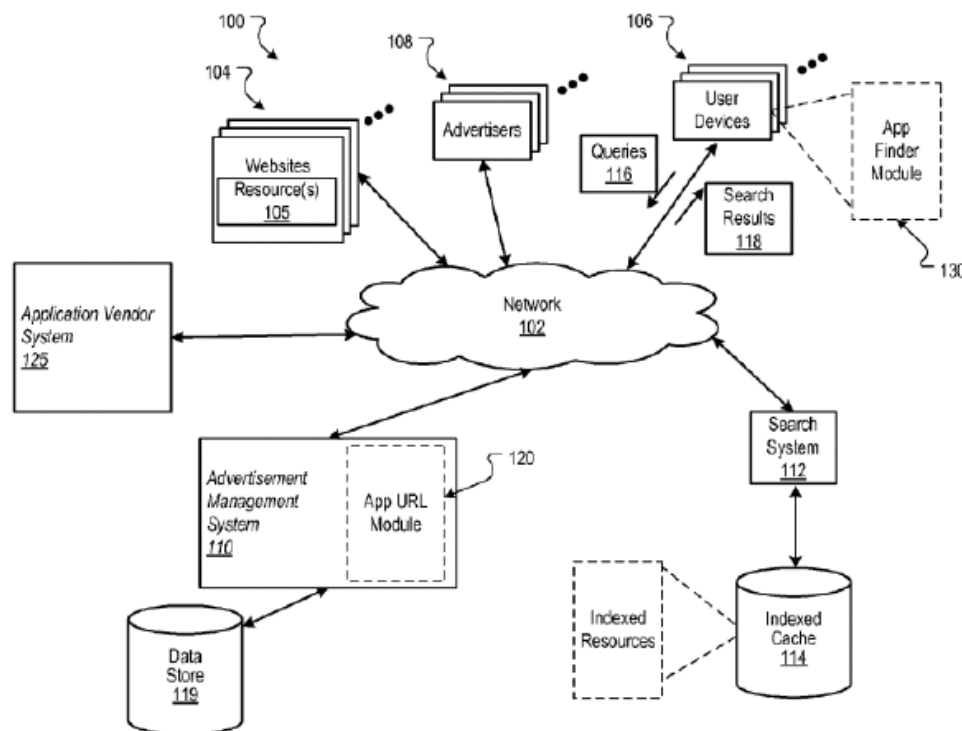


Fig. 1

Figure 1 of Khanna showing “an example online environment 100 in which user devices may use specialized applications to access online content (e.g., landing pages) associated with content items (e.g., advertisements).” Ex. 1006 ¶ 31.

Petitioner explains that Khanna provides for a central server (110) that “receives ad requests when users browse websites (just as in Demsey).” Pet.

42 (citing Ex. 1006 ¶¶ 35–39; Ex. 1002 ¶ 113). “In response to an ad request, Khanna teaches returning an advertisement (called a ‘content item’).” *Id.* (citing Ex. 1006 ¶¶ 31, 35–39; Ex. 1002 ¶ 113). According to Petitioner, the advertisement “can be augmented by **defining and sending a uniform resource identifier (URI) to the mobile device**, where the **URI deeplinks to an application different from the first application.**” *Id.* (citing Ex. 1006 ¶¶ 43–44, 25–30; Ex. 1002 ¶ 113). “Khanna’s URIs **deeplink to an application different from the first application**, because the first application is a browser . . . , while the second application is a specific application associated with the content item. . . .” *Id.* at 43 (citing Ex. 1006 ¶¶ 67, 5; Ex. 1002 ¶ 113). According to Petitioner, Khanna teaches using “**“deep-linking”**” technology to transition from the browser to another application. *Id.* (citing Ex. 1006 ¶¶ 15, 25–30, 44; Ex. 1002, ¶ 113). “[W]hen a user clicks on a portion of the content item (advertisement) that activates the URI (*i.e.* when the mobile device **detects a user interaction with a promotional message associated with the webpage**), the URI **causes** the mobile device to **automatically transition** from a first mobile application to a different mobile application.” Pet. 44–45.

Reasons to Combine

In order to demonstrate obviousness, a petitioner must demonstrate that a skilled artisan would have had a reason to combine the teachings of the prior art in the manner claimed in the patent. *KSR*, 550 U.S. at 406 (2007). “To facilitate review, this analysis should be made explicit. *See In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (‘[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there

must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’).” *Id.* at 418.

We find that the evidence on this record does not sufficiently support the reasons Petitioner presents as demonstrating that a person of ordinary skill in the art would have had a reason to combine Haggerty, Demsey, and Khanna in the manner claimed in claim 1.

Discussion

According to Petitioner, “it would have been obvious carry out Haggerty’s method (on Haggerty’s central server) by using Demsey’s techniques for Internet advertising, extended using Khanna’s techniques for mobile-app deeplinking.” Pet. 28. Several reasons Petitioner gives are, *inter alia*, (1) it was “advantageous to use Internet ad techniques like Demsey/Khanna in order to increase the reach of Haggerty’s marketing efforts” (Pet. 30–31); (2) “Haggerty’s method would have appealed to businesses that sell goods and services and that seek new potential customers” (Pet. 30); and (3) it involves “the application of known techniques (Demsey and Khanna), for their known functions, in order to improve Haggerty, with no unpredictable results” (Pet. 31–32; citing *KSR*).

(1) Advantageous

Petitioner argues that a “PHOSITA [person having ordinary skill in the art] would have found it advantageous to use Internet ad techniques like [Demsey] in order to increase the reach of Haggerty’s marketing efforts, [and] to better target advertisements to particular users (as expressly taught by Demsey), ...” Pet. 30–31 (citing, *inter alia*, Ex. 1005 ¶¶ 2, 21; Ex. 1002 ¶ 86).

Petitioner discusses, *inter alia*, Haggerty’s disclosure of “a two-step sequence for acquiring new leads, in which a potential customer first interacts with a hyperlink, and second, clicks ‘send’ on a pre-filled text message.” Pet. 30 (citing Ex. 1007, 10:1–5, 1:53–62, 14:41–49, 1:36–62, 2:1–5, 8:51–56, 10:59–11:21, 16:26–31, Figs. 3C, 4G; Ex. 1002 ¶ 86)). Then, Petitioner contends that a PHOSITA would have found it advantageous to use Internet ad techniques like that taught in Demsey in order to increase the reach of Haggerty’s marketing efforts. *Id.* at 30–31.

But *how* Demsey’s Internet ad techniques would increase the reach of Haggerty’s marketing efforts is not explained. Petitioner relies on Dr. Houh’s testimony but that testimony simply repeats a desired result as in the Petition without further elaboration. *Cf.* Pet. 30, Ex. 1002 ¶ 86. Petitioner does not adequately explain how Demsey’s web-based ad-serving technology, when incorporated into Haggerty, would increase the reach of Haggerty’s marketing efforts and/or help Haggerty better target advertisements to particular users such that one of ordinary skill would have been motivated to incorporate Demsey’s technique in Haggerty.

Petitioner argues that a “PHOSITA would have found obvious that the hyperlinks of Haggerty that open a text-messaging application to a particular (pre-populated) state are exactly the kind of function that Khanna’s deeplinks provide, and would have been aware of the standard URI protocols available to deeplink to SMS applications.” Pet. 30. Then Petitioner contends that a person of ordinary skill in the art would have found it “advantageous to use Internet ad techniques like [Khanna]” “in order to increase the reach of Haggerty’s marketing efforts, . . . and to account for conversions of deeplinks (as expressly taught by Khanna).” Pet.

30–31 (citing, *inter alia*, Ex. 1005 ¶¶ 2, 21; Ex. 1006 ¶¶ 43, 51, 66; Ex. 1002 ¶ 86).

But *how* using Khanna’s technique would increase the reach of Haggerty’s marketing efforts is not explained. Again, Petitioner relies on Dr. Houh’s testimony that simply repeats the desired result asserted in the Petition without further elaboration. *Cf.* Pet. 30–31, Ex. 1002 ¶ 86. Petitioner does not adequately explain how incorporating Khanna’s web-based deep-linking technology into Haggerty would increase the reach of Haggerty’s marketing efforts and/or help Haggerty account for conversions of deeplinks such that one of ordinary skill would have been motivated to incorporate Khanna’s technique in Haggerty.

(2) Business Appeal

Petitioner argues that “it was obvious to implement Haggerty’s method using the techniques of Demsey and Khanna” because:

Haggerty’s method would have appealed to businesses that sell goods and services and that seek new potential customers. (Ex. 1007, 1:19–26, 1:53–62)(Ex. 1002, ¶85). In particular, it would have been attractive to have a streamlined method for acquiring the contact information and for acquiring consent to receive marketing communications and proof of possession from people interested in the business’s offerings. (Ex. 1007, 1:19–26, 1:53–62, 17:4–18, 18:46–59)(Ex. 1002, ¶¶85, 24–26).

Pet. 29–30.

Here, too, Petitioner does not adequately explain *how* incorporating Demsey’s and Khanna’s techniques into Haggerty’s method would have resulted in “a streamlined method for acquiring the contact information and for acquiring consent to receive marketing communications and proof of possession from people interested in the business’s offerings” that would

have “appealed to businesses that sell goods and services and that seek new potential customers.” Pet. 29–30. Petitioner relies on Dr. Houh’s testimony but that testimony simply repeats the desired result asserted in the Petition without further elaboration. Cf. Pet. 29–30, Ex. 1002 ¶¶ 85, 24–26.

(3) Known Techniques for Their Known Functions

Petitioner argues that “[t]he combination further would have been obvious under [*KSR*], as the application of known techniques (Demsey and Khanna), for their known functions, in order to improve Haggerty, with no unpredictable results.” Pet. 31–32 (citing Ex. 1002 ¶ 88).

But Petitioner does not adequately explain what those improvements would be. Haggerty teaches providing advertisements in electronic reading material and a link within the advertisement that, once interacted with, formulates a pre-populated SMS message. Ex. 1007, 10:8–11, 59–62; 2:44–45; 13:14–16, 39–4. Petitioner does not adequately explain why one of ordinary skill in the art would have looked to Demsey for a technique to serve an advertisement that Haggerty already provides for. The improvement that one of ordinary skill in the art would obtain by incorporating Demsey’s ad-serving technique into Haggerty’s method is not adequately explained. Petitioner also does not adequately explain how adding Khanna’s deeplinking technique improves Haggerty’s method, which method already provides a link in an advertisement contained in electronic reading material that, when interacted with, formulates a pre-populated SMS message.

Reasonable Expectation of Success

Evidence of a reasonable expectation of success, just like evidence of a motivation to combine, “may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved.” *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1125 (Fed. Cir. 2000) (citing *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed. Cir. 1996)).

Ethicon LLC v. Intuitive Surgical, Inc., 2022 WL 1613188, at *4 (Fed. Cir. 2022).

We find that the evidence on this record does not sufficiently support Petitioner’s argument that a person of ordinary skill in the art would have had a reasonable expectation of success in combining Haggerty, Demsey, and Khanna and arrive at the claimed invention.

Petitioner’s Position

According to Petitioner:

A PHOSITA in the relevant timeframe would have had a reasonable expectation of success in using the prior art in the manner discussed in this petition. (Ex. 1002, ¶94). As Dr. Houh explains, the methods of the prior art are implemented in software, are compatible, and were predictable in the relevant timeframe (May 2017). (Ex. 1002, ¶94). A PHOSITA would have been able to make any necessary modifications to implement the Ground, and in particular would have been able to implement Khanna’s and Demsey’s software technique together with Haggerty’s teachings. (Ex. 1002, ¶94).

Pet. 32. Dr. Houh repeats Petitioner’s statements and adds the following:

When I use the term “central server”, I am referencing the somewhat more general concept of a central coordinating server, such as the AMS 110 in Khanna, the synchronizing server 150 in Demsey, and the call center server function in Haggerty, which

serve the purpose of coordinating activities with respect to users and other server functions, while recognizing that the functions of the central server of all three references could easily be combined into a server function under owned and maintained by a single entity, e.g. Haggerty's call-center server function.

Ex. 1002 ¶ 94; Pet. 32.

Patent Owner's Position

Patent Owner disagrees that one of ordinary skill in the art would have been led to incorporate the technologies of Demsey and Khanna into Haggerty, irrespective of a reason to combine Haggerty, Demsey, and Khanna. Patent Owner argues, *inter alia*, that

Demsey's technique specifically "leverag[ed] modern browsers" to offer "the ability to synchronize storage across browsers linked to a single user." . . . Where Haggerty's "efforts" were geared towards expanding the capabilities of non-web based embedded links or barcodes and not web-based content, a POSITA [person of ordinary skill in the art] would have no reason to implement Demsey's browser-reliant technique.

Prelim. Resp. 30 (citing Ex. 1005 ¶ 21; Ex. 2001 ¶¶ 68–70). Similarly

Khanna's method relies on web-based content items containing the data elements necessary to deeplink to an application landing page. (Section V(C) [of the Preliminary Response], *supra*; EX-2001 ¶ 72.) Yet Petitioner does not explain how a POSITA would apply Khanna's teachings to Haggerty's method, which does not involve a web-based content item, or how Khanna's teachings might be modified to be applicable to Haggerty.

Id. at 31 (citing

Discussion

We agree with Patent Owner's identified deficiencies in the combination of Haggerty and Demsey/Khanna; that is, Petitioner does not explain how one of ordinary skill in the art would incorporate the

Demsey/Khanna techniques in Haggerty and reasonably expect to successfully arrive at the claimed subject matter. We find that the evidence on this record weighs in favor of Patent Owner's argument.

Haggerty describes downloading "electronic reading material," such as "books, news print, and periodicals," provided by a "publisher" in communication with the call center. Ex. 1007, 8:9–31. The content may "contain[] an advertisement." *Id.* at 10:66. And the advertisement may include a link. *Id.* at 11:2. Haggerty does not explain the means by which an advertisement, with or without a link, may be included in electronic reading material. *See* Pet. 24 ("While Haggerty assumes advertisements with clickable links (Ex. 1007, 2:28–31), it does not describe the technology used to serve those ads."). But we agree with Patent Owner that "Haggerty does not disclose a webpage, a webpage-based advertisement, and/or any method that involves a user device loading a webpage in a browser." Prelim. Resp. 28 (citing Ex. 2001 ¶¶ 63–66).

Given the absence of any teaching of web-based technologies in Haggerty, one of ordinary skill in the art would have had to understand that web-based technologies, such as those taught in Demsey and Khanna, could be incorporated into Haggerty with a reasonable expectation that the claimed invention would be arrived at. But Petitioner does not explain how one of ordinary skill in the art would know how to incorporate web-based technologies like those taught in Demsey and Khanna into Haggerty and thereby reach the claimed subject matter.

Petitioner relies on Dr. Houh testimony who testified, in part, that "[a] PHOSITA would understand a 'link' to mean a clickable link in a Web page, implemented, for example, using an HTML anchor tag (<a>) or JavaScript to open a URI similar to the URIs described in RFC 5724 (Ex. 1019)." Ex.

1002 ¶ 72; Pet. 21. To the extent Petitioner is arguing that Haggerty’s downloaded electronic reading material *could* be a webpage, neither Petitioner nor Dr. Houh explain *how* one of ordinary skill in the art would understand Haggerty to teach a webpage when the web-based technology for creating a webpage is nowhere suggested. Haggerty alone provides insufficient guidance to lead one of ordinary skill in the art to employ a webpage for containing an advertisement with an embedded link. Rather, one of ordinary skill in the art would understand Haggerty to provide for electronic reading material containing a linked advertisement downloaded without the use of web-based technology. Ex. 1007, 10:8–11; 59–62.

Even if we were to assume for argument’s sake that Haggerty covers an advertisement with an embedded link contained in a webpage, claim 1 requires more. It requires the webpage to be served with an integration tag “configured to cause a mobile device loading the webpage via a first application [e.g., a browser] to send user data to at least one of the client server or the click-to-text server” ([1c]) and when executed to cause the “click-to-text server” to “define and send a uniform resource identifier (URI) to the mobile device . . . , the URI deeplinking to a messaging application different from the first application” ([1d]).

To address the integration tag, Petitioner relies on Demsey’s teaching of ad tags. Pet. 36–42.

To address the URI deeplink, Petitioner relies on Khanna’s teaching of deeplinking within a web-based advertising environment. Pet. 43.

Haggerty already includes advertisements with links in the downloaded electronic reading material that is displayed on a mobile device. Ex. 1007, 10:8–11; 59–62. Thus, to reach the claimed subject matter, one of ordinary skill in the art would have to modify Haggerty’s downloaded

electronic reading material such that the advertisement includes an integration tag as claimed. But Petitioner does not explain how one of ordinary skill in the art would incorporate Demsey's technology into Haggerty's method so that Haggerty would have the ability to serve an advertisement with an ad tag to a webpage that, when delivered to a mobile device and executed, an advertisement is sent back to the user's device for display.

Petitioner also does not explain how one of ordinary skill would modify Haggerty's method to incorporate Khanna's URI-deeplinking technology into Haggerty so that links in advertisements in the downloaded electronic reading material, when interacted with, transition the mobile device to a different messaging application.

Petitioner argues that "it would have been obvious to use the concept[] of . . . Khanna to implement the business method of Haggerty . . . wherein the deeplinking technology of Khanna is used to open a pre-populated text message in a text messaging application." Pet. 43–44 (citing Ex. 1007, 9:39–44, 9:56–10:6; Ex. 1008 ¶¶ 66–67; Ex. 1002 ¶114).

But Khanna does not teach using its deeplinking technology to open a text messaging application as the claim requires. (This is taught in Haggerty. Ex. 1007, 12:44–45.) Khanna exemplifies opening an application associated with a landing page. *See e.g.*, Ex. 1006 ¶ 27 ("When a user selects (e.g., clicks on) the content item, if the application is installed, the application may be launched with the associated product related data elements as inputs so that the content (e.g., a landing page) related to the product is displayed in the application."). *See also e.g., id.* at ¶ 44 ("In some implementations, the application URL module may generate a deep-linking application specific landing page URL based on unformatted data elements

associated with the content item received from an advertiser 108.”) We agree with Patent Owner that “Khanna does not teach or suggest opening a messaging application at all—rather, Khanna’s technique is limited to launching an application that may be directed to product landing pages.” Prelim. Resp. 32 (citing Ex. 1006 ¶ 30; Ex. 2001 ¶ 75).

Petitioner does not explain how one of ordinary skill in the art would modify Haggerty to incorporate Khanna’s deeplinking technology, which Haggerty appears not to need and which Khanna uses for a different purpose, and thereby reach the claimed subject matter with a reasonable expectation of success. We agree with Patent Owner that “Petitioner selects discrete disclosures from the three prior art references for each limitation, while failing to articulate the contemplated workings of the combination.” Prelim. Resp. 49. *Cf. SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 887 (Fed. Cir. 1988) (“Helena cannot pick and choose among the individual elements of assorted prior art references to recreate the claimed invention”).

Finally, we note that Petitioner’s argument that

it would have been obvious to carry out the server-based software techniques of Demsey and Khanna at Haggerty’s call center server. (Ex. 1002, ¶87). Haggerty teaches that its call center functionality can be expanded with other server-based functions. (Ex. 1007, 7:34–36)(Ex. 1002, ¶87). Each of Demsey and Khanna, moreover, provides functionality with a central server (like Haggerty’s call-center), such as Demsey’s Synchronization Server 150 and Khanna’s AMS 110 (Ex. 1005, ¶¶0021–0028, 0045–0048)(Ex. 1006, ¶¶0031, 0038–0039)(Ex. 1002, ¶87). Both Demsey and Khanna also express flexibility in the arrangement of the software, and user and server devices that make up their systems. (Ex. 1005, ¶¶0026–0032)(Ex. 1006, ¶¶0108, 0120–0122)(Ex. 1002, ¶87). It would have been obvious to combine the functionalities of these references into a single

“server” as that term is understood in the ’887 patent (Ex. 1001, 5:4–6:4) in order to obtain the benefits of each system as described above. (Ex. 1002, ¶87).

Pet. 31. Dr. Houh’s supporting testimony repeats Petitioner’s statements and adds that “[t]he use of server systems was a well-established discipline by 2017, and it was well-known to scale such systems according to demand, and to combine various software functionalities capable of implementing the functionality described in the Demsey, Khanna and Haggerty.” Ex. 1002 ¶ 87; Pet. 31.

We understand Petitioner to be arguing that Haggerty, Demsey, and Khanna, each teach a server providing certain functionalities and that they express flexibility in arranging software such that one of ordinary skill in the art would “combine the functionalities of these references into a single ‘server’” as claimed. Pet. 31.

The difficulty with this argument is that neither Petitioner nor Dr. Houh explain how one of ordinary skill in the art would have been led or motivated to select the particular combination of functionalities from the numerous possible functional combinations that would result from combining Haggerty, Demsey, and Khanna and reasonably expect to successfully arrive at the claimed invention. The possible variety of functional combinations are numerous and not all would meet the claim. The argument amounts to arguing that one of ordinary skill in the art could pick and choose functionalities from Haggerty, Demsey, and Khanna, and combine them into a single server that meets the claim. But “to have a reasonable expectation of success, one must be motivated to do more than merely to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result.” *Pfizer, Inc. v. Apotex, Inc.*, 480

F.3d 1348, 1365 (Fed. Cir. 2007) (quoting *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006)).

b. Conclusion as to claim 1

After reviewing the record, we find Petitioner has not adequately explained with sufficient evidence that “it would have been obvious to implement Haggerty’s business method using well-known ad-serving technology, by adding the techniques of Demsey (an ad-network patent) and Khanna (a mobile app deeplinking patent).” Pet. 20 (citing Ex. 1002 ¶¶ 70–71) with a reasonable expectation of success.

On this record, Petitioner has not demonstrated a reasonable likelihood of prevailing in demonstrating that claim 1 of the ’887 patent is rendered obvious over the combination of Haggerty, Demsey, and Khanna.

c. Claims 2, 13, and 14

Dependent claims 2, 13, and 14 depend from independent claim 1 and therefore require all the limitations of claim 1. Thus, the analysis presented above for claim 1 applies equally to claims 2, 13, and 14. For the reasons discussed with respect to claim 1, Petitioner has not provided a sufficient showing that all the limitations of claims 2, 13, and 14 of the ’887 patent are rendered obvious by the combination of Haggerty, Demsey, and Khanna.

F. Grounds II–IV

Petitioner challenges claims 1–4, 6–10, 13, 14, and 19 as unpatentable under 35 U.S.C. § 103 over the combination of Haggerty, Demsey, Khanna, and Rakavy. Pet. 54–62; Ground II.

Petitioner challenges claims 1, 2, 5, and 13–18 as unpatentable over 35 U.S.C. § 103 over the combination of Haggerty, Demsey, Khanna, and *Ad Serving Technology*. Pet. 62–67; Ground III.

Petitioner challenges claims 1, 2, 11–14, and 20 as unpatentable over 35 U.S.C. § 103 over the combination of Haggerty, Demsey, Khanna, and Molinet. Pet. 67–72; Ground IV.

Petitioner’s position as to the patentability of sole independent claim 1 under each of these grounds is the same as the one presented under Ground I. *See*, e.g., Pet. 55 (“Claims 1-2, and 13-14 are obvious as in Ground 1.”); Ground II.

For the reasons discussed with respect to claim 1, Petitioner has not provided a sufficient showing that all the limitations of claims 1–20 of the ’887 patent are rendered obvious by the combination of references applied under these grounds.

G. Discretion under 35 U.S.C. § 314(a)

Patent Owner requests that we exercise our discretion to deny institution under § 314(a) due, *inter alia*, to the District Court Actions. *See* Prelim. Resp. 3–9.

Petitioner disagrees. *See* Pet. 74–75. Petitioner has also provided, based on our prior authorization, a stipulation “that, if the petitions are instituted, it will not pursue in district court proceedings concerning these patents invalidity based on the same grounds set forth in the instituted petitions, nor any grounds that could have reasonably been raised in the instituted petitions.” Ex. 1032.

For the reasons stated above, we decline to institute *inter partes* review. Because we base our denial of institution on the merits of this case,

it is unnecessary for us to analyze whether we should also discretionarily deny institution under 35 U.S.C. § 314(a).

III. CONCLUSION

We determine that the Petitioner has not satisfied its burden from the onset to show with particularity why the patent it challenges is unpatentable. 35 U.S.C. § 312(a)(3).

Petitioner has not demonstrated a reasonable likelihood that it would prevail in showing the unpatentability of any of claims 1–20 of the ’887 patent under the asserted grounds.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review of claims 1–20 of the ’887 patent is denied.

IPR2023-01338
Patent 11,416,887

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