

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 ON REQUEST FOR REHEARING
37 C.F.R. § 42.71

I. INTRODUCTION

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.”).

Upon consideration of the Petition and Preliminary Response, the Board concluded, under 35 U.S.C. § 314(a), that Petitioner had not demonstrated a reasonable likelihood that it would prevail in showing the unpatentability of claims based on any of the asserted § 103 grounds; i.e.,

- claims 1, 2, 13, and 14 were obvious over Haggerty¹ in view of Demsey² and Khanna³ (Ground 1);
- claims 1–4, 6–10, 13, 14, and 19 were obvious as in Ground 1, in further view of Rakavy⁴ (Ground 2);
- claims 1, 2, 5, 13, and 18 were obvious as in Ground 1, in further view of *Ad Serving Technology*⁵ (Ground 3); and,
- claims 1, 2, 11–14, and 20 were obvious as in Ground 1, in further view of Molinet⁶ (Ground 4)

Thus, on February 26, 2024, the Board denied institution of an *inter partes* review with respect to claims 1–20. Paper 8 (“Dec.”; “Decision”).

On March 27, 2024, Petitioner filed a Request for Rehearing of the Decision. Paper 9 (“Req.”; “Request”). Petitioner seeks reversal of the Board’s denial of institution of an *inter partes* review on the grounds that the Board misapprehended Petitioner’s argument or overlooked the Petition’s

¹ U.S. Patent No. 8,532,283 B1, issued Sept. 10, 2013 (Ex. 1007).

² U.S. Patent Application Publication No. 2014/0379482 A1, published Dec. 25, 2014 (Ex. 1005).

³ U.S. Patent Application Publication No. 2013/0111328 A1, published May 2, 2013 (Ex. 1006).

⁴ U.S. Patent No. 5,913,040, issued June 15, 1999 (Ex. 1018).

⁵ Gregory Cristal, *Ad Serving Technology* (2014) (Ex. 1012).

⁶ U.S. Patent Application Publication No. 2016/0142858 A1, published May 19, 2016 (Ex. 1009).

explanation on the issue of motivation to combine (Req. 6–13) and reasonable expectation of success (*id.* at 13–20).

A request for rehearing must identify specifically all matters that the requesting party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d) (2022). When rehearing a decision on institution, the Board will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c) (2022).

For the reasons that follow, the Request for Rehearing is *denied*.

II. ANALYSIS

A. Reasons to Combine

Petitioner’s reasons to combine are presented in the Petition in a section entitled “C. Rationale (Motivation) Supporting Obviousness.” Pet. 28–32.

In that regard, the Board stated:

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*).

Dec. 18. The Board then focused on (1)–(3). *See id.* 18–21.

Petitioner challenges certain statements made in the Decision discussing (1)–(3), as follows.

(1) “*Advantageous*” (Dec. 18–21)

a. “***Increasing Reach of Haggerty’s Ads***” (Req. 6–7)

The Board stated that “*how* Demsey’s Internet ad techniques would increase the reach of Haggerty’s marketing efforts is not explained.” Dec. 19 (emphasis original). The Board similarly stated that “*how* using Khanna’s technique would increase the reach of Haggerty’s marketing efforts is not explained.” *Id.* at 20 (emphasis original).

Petitioner disagrees, explaining that

[t]he proposed combination of the Petition, however, uses the technology of Demsey and Khanna to allow Haggerty to place ads on Web pages. (Petition, pp. 24, 20-21, 20-28). By enabling the presentation of Haggerty’s ads on the Web, the combination increases the reach of Haggerty (Petition, pp. 30-31), because the ads can additionally be seen by people who read Web pages, not just by people who see Haggerty’s print ads or non-Web electronic material.

Req. 6–7.

As we understand Petitioner now to be explaining, the types of media carrying Haggerty’s ads would expand to include webpages if Internet ad techniques like that taught in Demsey and Khanna were included in Haggerty. The number of people who might see the ads would likely grow because Haggerty’s ads would be “additionally [] seen by people who read Web pages, not just by people who see Haggerty’s print ads or non-Web electronic material.” Req. 7. This in turn provides Haggerty with a larger platform for its marketing efforts, increasing their reach.

This might would have adequately explained how Demsey’s and Khanna’s Internet ad techniques would increase the reach of Haggerty’s marketing efforts but it was not provided in the Petition. The Petition simply said that “[i]t 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) because, *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). The Petition provided no further explanation or reasoning for combining Demsey, Khanna and Haggerty. *See In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (requiring “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). We could not have overlooked this new explanation provided in the Request as it was not before us. *See* 37 C.F.R. § 42.104(b)(4)–(5) (2012) (requiring a petitioner to identify “[h]ow the construed claim is unpatentable,” “specify where each element of the claim is found in the prior art patents or printed publications relied upon,” and identify “[t]he exhibit number of the supporting evidence relied upon to support the challenge and the relevance of the evidence to the challenge raised, including identifying specific portions of the evidence that support the challenge”).

b. “Improved Targeting of Ads” (Req. 7–9)

The Board stated that “Petitioner does not adequately explain how Demsey’s web-based ad-serving technology, when incorporated into Haggerty, would . . . 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.” Dec. 19; *see also* Req. 7.

Petitioner disagrees, referring the Board to certain pages of the Petition (i.e., Pet. 15–17, 20–26) and paragraphs from Dr. Houh’s declaration (i.e., Ex. 1002 ¶¶ 45–64, 70–71). Req. 7–8.

We have reviewed said pages and paragraphs but cannot find in them any discussion connecting the incorporation of Demsey’s web-based ad-serving technology in Haggerty to improving Haggerty’s ability to target advertisements to particular users.

On page 20, the Petition states that “[t]his 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). On the next page, it states that “in the combination, Haggerty teaches the known ‘two-tap’ business method, Demsey provides the standard ad-network functionality, and Khanna provides the standard deeplinking functionality.” *Id.* at 21 (citing Ex. 1002 ¶¶ 70–71). On page 24, at the end of the “Overview of Haggerty (two-tap method)” section (Pet. 21–24), it states that “[w]hile Haggerty assumes advertisements with clickable links (Ex. 1007, 2:28–31), it does not describe the technology used to serve those ads. This technology, however, was standard in the relevant timeframe, as described in Demsey.” Pet. 24 (citing Ex. 1002 ¶ 76). There is no mention in any of these pages of employing Demsey’s technique to help Haggerty better target advertisements to particular users.

Petitioner also reproduces a passage from pages 16–17 of the Petition and refers to other passages that “explain[] that this functioning of ad networks [i.e., to target individual users with ads by using ad tags] was standard technology for web-based advertising in the relevant timeframe (2017).” Req. 8 (reproducing Pet. 16–17 (citing Ex. 1002, ¶63), referring to Pet. 15–17, 21, 24, Ex. 1002 ¶¶ 45–48, 59–64, 65, 66, 71, 76). That explains

the technology available at the time of the invention but it does not explain how that would help *Haggerty* better target advertisements to particular users.

Petitioner further contends that “both the Petition and Dr. Houh expressly stated that this explanation [i.e., to target individual users with ads by using ad tags] was relevant to the later explanations in the Grounds of unpatentability, including the motivation to combine.” Req. 8 (referring to Pet. 10, footnote 1; 28, footnote 2; Ex. 1002 ¶ 82).

Setting aside the propriety of incorporating arguments into the Petition via footnotes⁷, we do not see how the footnotes explain how incorporating Demsey’s web-based ad-serving technology into Haggerty would help Haggerty better target advertisements to particular users. Footnote 1 on page 10 of the Petition simply states that “[t]his introduction reflects the understanding of a person having ordinary skill in the art (‘PHOSITA’), and is therefore relevant to each of the grounds below.” And footnote 2 on page 28 of the Petition simply states that “[t]he Overview (§B) and Introduction (§I) are relevant to this section.” That a section in the Petition is “relevant” to another section is not an adequate explanation.⁸

⁷ *Cf. SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1320 (Fed. Cir. 2006) (“[A]rguments raised in footnotes are not preserved.”).

⁸ It tends to put the burden on the Board to figure out how incorporating Demsey’s web-based ad-serving technology into Haggerty would help Haggerty better target advertisements to particular users. *Cf. Ernst Haas Studio, Inc. v. Palm Press, Inc.*, 164 F.3d 110, 112 (2d Cir. 1999) (“Appellant’s Brief is at best an invitation to the court to scour the record, research any legal theory that comes to mind, and serve generally as an advocate for appellant. We decline the invitation.”).

For the foregoing reasons, we are unpersuaded that, in finding that the Petition did not adequately explain how Demsey would improve the targeting of Haggerty's ads, the Board misapprehended Petitioner's argument or overlooked the Petition's explanation.

(2) "*Business Appeal*" (Dec. 20–21)

a. "***Streamlined Acquisition of Contact Information and Proof of Possession***" (Req. 9–12)

The Board stated that "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.'" Dec. 20–21 (quoting Pet. 30); Req. 9. The Petition had contended, without elaboration, that "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." Pet. 30 (citing Ex. 1007, 1:19–26, 1:53–62, 17:4–18, 18:46–59; Ex. 1002 ¶¶ 85, 24–26).

Petitioner disagrees, now arguing, *inter alia*, that

the Petition did explain how the advantage would be achieved. The Petition explained that advertisers in the relevant timeframe (such as those using Demsey's ad network) desired to send text-based communications to potential customers. (Petition, p. 10)(Ex. 1002, ¶¶24-26). However, in the relevant timeframe

(2017), industry and legal restrictions could require an advertiser to obtain both the consent of the recipient of such messages, and proof of possession of the mobile device to which the messages were being sent. (Petition, p. 10)(Ex. 1002, ¶¶24-26). One way to prove consent and possession of the mobile device was to receive a text message from the user that opted-in to communications. (Petition, p. 10)(Ex. 1002, ¶¶24-26). For example, the Petition and Dr. Houh detailed the best practices provided in the 2012 Mobile Marketing Association document “U.S. Consumer Best Practices for Messaging”, which was submitted as Ex. 1028, cited on pages 10-11 of the Petition and in ¶25 of Dr. Houh’s declaration. This document explained that advertisers could receive a text message from a user device in order to prove both consent for further communications directed at the mobile device, and possession of the device by the consenting user. (Ex. 1002, ¶25)(Ex. 1028, p. 004, 008, 016). Both the Petition and Dr. Houh expressly stated that this explanation was relevant to the later explanations in the Grounds of unpatentability, including the motivation to combine. (Petition, p. 10, footnote 1; p. 28, footnote 2, Petition, p. 30 (*citing* Ex. 1002, ¶¶24-26))(Ex. 1002, ¶82).

Req. 9–10.

For reasons similar to those discussed in the previous section, we are unpersuaded that the Petition adequately explained how incorporating Demsey’s and Khanna’s techniques into Haggerty’s method would have resulted in a streamlined acquisition of contact information and proof of possession.

The pages of the Petition that Petitioner refers to (i.e., Pet. 10–11) discuss the technical background of the ’887 patent. We see no discussion there about Demsey’s and Khanna’s techniques or incorporating them into Haggerty’s method, let alone to yield in a streamlined acquisition of contact information and proof of possession. The footnotes Petitioner refers to (i.e., Pet. 10, footnote 1; 28, footnote 2), to indicate that the technical background

of the '887 patent is “relevant” to another section in the Petition, are also not helpful.

Petitioner further explains that

Haggerty provides a two-step method for responding to an advertisement that *pre-populates a text message* for a user to send back to the call center. (Petition, pp. 21-24)(Ex. 1002, ¶¶72-76). The Petition further explained that “Haggerty further states that its method provides **a convenient way for a user to respond to an advertisement** (Ex. 1007, 1:53-62) **with lowered risk of mistyping information in the SMS** (Ex. 1007, 9:48-55). (Ex. 1002, ¶74).” (Petition, pp. 23-24)(bolding added).

Req. 11. According to Petitioner, “[t]his is a *streamlined* method (because the user does not have to type the text message) for encouraging a user to send a text message to opt-in to further marketing messages. (Petition, p. 30)(*citing* Ex. 1002, ¶¶84, 24-26). The user sending a text message to the advertiser was considered one best practice for obtaining consent and proof of possession, as discussed in Dr. Houh’s declaration at ¶¶24-26, which is specifically cited as relevant to this discussion on page 30 of the Petition.” Req. 11.

We have reviewed paragraphs 24–26 of Dr. Houh’s declaration. It is a discussion of the technical background of the '887 patent. We see no discussion there about Demsey’s and Khanna’s techniques or incorporating them into Haggerty’s method, let alone to yield in a streamlined acquisition of contact information and proof of possession. To the extent Petitioner is arguing that Haggerty’s two-step method for responding to an advertisement whereby a text message for a user is pre-populates before it is sent to the call center is *necessarily* a streamlined approach, it is not an argument that was before us.

For the foregoing reasons, we are unpersuaded that, in finding that the Petition did 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’” (Dec. 20–21 (quoting Pet. 30)), the Board misapprehended Petitioner’s argument or overlooked the Petition’s explanation.

(3) “*Known Techniques for Their Known Functions*” (Dec. 21)
a. “*Capabilities Added to Haggerty*” (Req. 12–13)

The Board stated that “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” and that “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.” Dec. 21.

Petitioner disagrees, explaining that the

Petition argued that Demsey and Khanna would provide the ability for Haggerty to perform web-based advertising using known ad-network and deeplinking capability. (e.g., Petition, pp. 20-21). Haggerty does not disclose this capability, as the Institution Decision expressly found. (Institution Decision, pp. 24-25). Petitioner respectfully submits that it is inconsistent to find that Haggerty *already* provides for Demsey’s web-based “technique to serve an advertisement” and Khanna’s web-based “deeplinking technique”, while simultaneously finding 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.” (Institution Decision, p. 24).

Req. 12–13.

Petitioner’s portrayal of the Board’s view (that “Haggerty *already* provides for Demsey’s web-based ‘technique to serve an advertisement’” (Req. 12–13)) is inaccurate. What the Board said was: “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.” Dec. 21. We determined that Haggerty provides for “a technique to serve an advertisement.” *Id.* But we did not find that Haggerty also provides for *Demsey*’s web-based technique. This is so because, as Petitioner recognizes, we found — consistent therewith — 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.” *Id.* at 24.

Similarly, we did not find that “Haggerty *already* provides for . . . Khanna’s web-based ‘deeplinking technique’” as Petitioner argues. Req. 12–13. We determined that Haggerty “provides a link in an advertisement contained in electronic reading material that, when interacted with, formulates a pre-populated SMS message.” Dec. 21. But we did not find that Haggerty provides for *Khanna*’s deeplinking technique. This is so because, as Petitioner recognizes, we found – consistent therewith – 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.” *Id.* at 24.

For the foregoing reasons, we are unpersuaded that, in finding that the Petition did “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” (Dec. 21) and that “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” (*id.*), the Board misapprehended Petitioner’s argument or overlooked the Petition’s explanation.

B. Reasonable Expectation of Success

Petitioner’s reasons in support of a reasonable expectation of success are presented in the Petition in a section entitled “**E. Reasonable Expectation of Success.**” Pet. 32.

The Board stated:

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.

Dec. 22–23. The Board then stated Patent Owner’s position (Dec. 23) followed by a “Discussion” (Dec. 23–29).

Petitioner challenges certain statements made in the “Discussion,” as follows.

1. “Reasonable Expectation of Success Implementing Demsey / Khanna with Haggerty” (Req. 13–18)

The Board stated that “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.” Dec. 24; Req. 13. We also stated that “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”, and that “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.” Dec. 24–26; Req. 13–14.

Petitioner disagrees, arguing, *inter alia*, that

On the general issue of whether Haggerty’s advertisements could have been presented on the Web with a reasonable expectation of success, Haggerty’s advertisements (e.g., Fig. 3B shown [below])



FIG. 3B

consist of the normal stuff of advertising—text and images—together with a QR code or clickable link that serves as a launching point for Haggerty’s business method. Petitioner does not believe that the Institution Decision found that text and images were difficult to display in web-based advertisement form in 2017, but even so, Dr. Houh explained how they could be. (Ex. 1002, ¶¶45-62)(Dr. Houh explaining how to construct and serve Web pages having text, images, mobile deeplinks, and ad tags). Dr. Houh’s testimony was directed to the relevant timeframe. (Ex. 1002, ¶67).

Req. 15.

The argument that text and images in Haggerty’s electronic media were not difficult to display in web-based advertisement form in 2017 is a new argument. Although Petitioner appeared to “argu[e] that Haggerty’s downloaded electronic reading material *could* be a webpage” (Dec. 25 (referring to Pet. 21, Ex. 1002 ¶ 72) (emphasis original)),

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.

Dec. 25 (emphasis original).

Petitioner now explains that “text and images were [not] difficult to display in web-based advertisement form in 2017.” Req. 15. In other words, Petitioner is arguing that it would have been within the knowledge of one of ordinary skill in the art to display the advertisement that Haggerty presents in electronic reading material (Dec. 10 (citing Ex. 1007, 10:8–11; 59–62)), “such as ‘books, news print, and periodicals,’ provided by a ‘publisher’ in communication with the call center” (Dec. 24 (quoting Ex. 1007, 8:9–31)) on a webpage. Then given such a webpage, as the argument goes, one of ordinary skill in the art would have been led to incorporate the web-based technologies of Demsey and Khanna. This is not an argument that was previously before us. We understood Petitioner to be arguing that one of

ordinary skill in the art would have understood how to implement Haggerty's embedded link in a webpage. *See* discussion at Dec. 24.

The Petition presented no argument that one of ordinary skill in the art would have understood that Haggerty's electronic reading material could be presented as a webpage. Dr. Houh's testimony explaining how to create a webpage having text, images, mobile deeplinks, and ad tags does not further address how one of ordinary skill would have been led to do so for Haggerty's electronic reading material. Ex. 1002, ¶¶ 45–62, 67. There was no discussion in the Petition about implementing Haggerty's advertisement (with the embedded link) in a webpage. The explanation the Request now gives that doing so would not be "difficult" was not before us and as such is not an argument we could have overlooked or misapprehended.

2. "*Reasonable Expectation of Success Implementing Servers*" (Req. 18–20)

The Board stated that "[w]e [understood] 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." Dec. 28 (referring to discussion at Pet. 31 (citing, *inter alia*, Ex. 1002 ¶ 87)). We determined that Petitioner did not show a reasonable expectation of success, quoting *inter alia*, *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1365 (Fed. Cir. 2007) ("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"). Dec. 28–29.

Petitioner characterizes our quoting *Pfizer* as possibly finding a lack of motivation, even though the quote falls under the caption "reasonable

expectation of success” (Dec. 21). Req. 18. We disagree that we were confusing. We clearly explained that the difficulty we had with Petitioner’s argument was that “neither Petitioner nor Dr. Houh explain how one of ordinary skill in the art [(1)] 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* (2) “would reasonably expect to successfully arrive at the claimed invention.” Dec. 21. The section captioned under “reasonable expectation of success,” wherein we quote *Pfizer*, deals with the latter.⁹

Petitioner also characterizes our reasoning as “premised on *Pfizer*.” Req. 19. We disagree. We quoted *Pfizer* in response to Petitioner’s argument that “[i]t would have been obvious to combine the functionalities of these references [Haggerty’s call center functionality, Demsey’s Synchronization Server 150 and Khanna’s AMS 110] 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).” Dec. 27–28 (quoting Pet. 31). What we said was that “[t]he possible variety

⁹ We note that Petitioner’s discussion of “reasonable expectation of success” is brief and vaguely cites to the rest of the petition. *See e.g.*, Pet. 32 (“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.*”) (emphasis added). In this circumstance, the Board would not have been remiss to have addressed motivation and reasonable expectation of success under a single caption. *Cf. Eleкта Limited v. ZAP Surgical Systems, Inc.*, 81 F.4th 1368, 1377 (Fed. Cir. 2023) (“the Board made no error in addressing the issues of motivation to combine and reasonable expectation of success in the same blended manner that Eleкта chose to present those very issues.”).

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.*” Dec. 28 (emphasis added). *Pfizer* is applicable on that point. Cf. *Netflix, Inc. v. DivX, LLC*, 2023 WL 2298768, at *3 (Fed. Cir. 2023)

The parties in this case accept a familiar framework for proving obviousness. Under that framework, a challenger asserting obviousness based on a combination of prior-art references must demonstrate “ ‘that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.’ ” *Procter & Gamble Co. v. Teva Pharmaceuticals USA, Inc.*, 566 F.3d 989, 994 (Fed. Cir. 2009) (quoting *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1361 (Fed. Cir. 2007)). There is a “clear distinction in our case law between a patent challenger's burden to prove that a skilled artisan would have been motivated to combine prior art references and the additional requirement that the patent challenger also prove that the skilled artisan would have had a reasonable expectation of successfully achieving the claimed invention from the combination.” *Eli Lilly & Co. v. Teva Pharmaceuticals International GmbH*, 8 F.4th 1331, 1344 (Fed. Cir. 2021).

We are guided by two legal principles.

First, *the Petition* must identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3). As the Federal Circuit stresses:

It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify with particularity the evidence that supports the grounds for the challenge to each claim. . . . [T]he expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition to institute.”

Wasica Finance GmbH v. Continental Automotive Systems, Inc., 853 F.3d 1272, 1286–87 (Fed. Cir. 2017) (quoting *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016), which quotes, in part, 35 U.S.C. § 312(a)(3)).

Second, the burden of proving a reasonable expectation of success *is on Petitioner*. *Eli Lilly & Co. v. Teva Pharms. Int’l GmbH*, 8 F.4th 1331, 1348–49 (Fed. Cir. 2021) (“[I]t was, at all times, [petitioner’s] burden to show that the claims would have been obvious, including that a skilled artisan would have had a reasonable expectation of success in achieving the claimed invention.”). *See also Intelligent-Bio-Sys.*, 853 F.3d at 1367–68 (It is the petitioner’s “burden to demonstrate both ‘that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.’”).

Petitioner argues that

the underlying technology is predictable (Ex. 1002, ¶¶94, 88), the testimony of Dr. Houh that there was a reasonable expectation of success, and in particular 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) is highly credible.

Req. 19.

Unlike the case in *Pfizer*, where the patent challenger argued obviousness based on a plan to “try each of numerous possible choices to see if a successful result was obtained” (*Pfizer*, 480 F.3d at 1365), here no such plan of experimentation is contemplated or necessary, because a PHOSITA would have reasonably expected success in implementing a large variety of different server arrangements. Specifically, none of the prior art references teaches any complex or surprising result that could

even hypothetically arise from the arrangement of software on servers, instead teaching that the servers can be implemented in a variety of ways, and implying—in a manner especially reasonable for the year 2017—that the variations between different arrangements are immaterial to the respective inventions. (Petition, pp. 31-32)(Ex. 1002, ¶¶87-88). The '887 patent similarly places no importance on the particular arrangement of software on servers (Petition, pp. 31, 36)(citing Ex. 1001, 5:4-6:4), instead relying on ordinary skill in the art to implement this aspect of the claims correctly. There is no basis in the record to conclude that a PHOSITA would not have expected success in implementing Demsey and Khanna's software functionality on a server at Haggerty's call center.

Req. 20.

Claim 1 of the '887 patent is particular in requiring a “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”, *inter alia*,

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 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 (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 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.

The Petition states, under the caption “Reasonable Expectation of Success,” that “[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. According to Petitioner, Dr. Houh explains that “the methods of the prior art are implemented in software, are compatible, and were predictable in the relevant timeframe (May 2017).” *Id.* (citing Ex. 1002 ¶ 94).

Arguing that a PHOSITA would have been able to make any necessary modifications, notwithstanding the predictability of software, is inadequate to satisfy Petitioner’s burden of proving a reasonable expectation of success. Simply because “the methods of the prior art are implemented in software, are compatible, and were predictable in the relevant timeframe (May 2017)” (Ex. 1002 ¶ 94) does not adequately explain how one of ordinary skill in the art would have had a reasonable expectation of success in achieve what claim 1 of the ’887 patent is particularly calling for. As we stated in the Decision, “[w]e 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.” Dec. 22. “We [understood] 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. *Id.* at 28 (quoting Pet. 31). We maintain that “[t]he 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.” *Id.* Petitioner did not adequately explain how a person of ordinary skill in the art would have selected the specific functionalities from all of the possible functionalities disclosed in Haggerty, Demsey, and Khanna to have a reasonable expectation of successfully arriving at a non-transitory processor-readable medium performing the particular functions claimed.

III. CONCLUSION

Petitioner’s Request for Rehearing is *denied*.

For PETITIONER:

Matthew Smith
Andrew Baluch
SMITH BALUCH LLP
smith@smithbaluch.com
baluch@smithbaluch.com

For PATENT OWNER:

Mikaela Stone
Brian Eutermoser
KING & SPALDING LLP
mikaela.stone@kslaw.com
beutermoser@kslaw.com