

Petition for *Inter Partes* Review of
U.S. Patent No. 7,065,555 B2

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN AIRLINES, INC.,
Petitioner

v.

ADVANCED TRANSACTIONS, LLC
Patent Owner

Inter Partes Review No. IPR2023-01366
U.S. Patent No. 7,065,555 B2
Issue Date: June 20, 2006

Title: SYSTEM AND METHOD RELATED TO GENERATING AND TRACKING
AN EMAIL CAMPAIGN

**PETITION FOR *INTER PARTES* REVIEW
OF U.S. PATENT NO. 7,065,555 B2**

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LIST OF EXHIBITS

Exhibit No.	Description of Document
1001	U.S. Patent No. 7,065,555 B2 to Michael G. Foulger et al. (filed April 25, 2001; issued June 20, 2006)
1002	U.S. Patent No. 8,533,038 B2 to Christopher P. Bergh et al. (filed February 5, 2001; issued September 10, 2013)
1003	U.S. Patent No. 7,865,394 B1 to Kevin Calloway et al. (filed November 7, 2000; issued January 4, 2011)
1004	U.S. Patent No. 6,859,909 B1 to Matthew R. Lerner et al. (filed March 7, 2000; issued February 22, 2005)
1005	U.S. Patent No. 7,302,430 B1 to Jagdish Mooljee Nagda et al. (filed August 31, 1999; issued November 27, 2007)
1006	Declaration of Dr. Eric Cole
1007	CV of Dr. Eric Cole
1008	U.S. Patent No. 7,065,555 B2 Prosecution File History
1009	Docket Navigator Report on Advanced Transactions, LLC Litigation History
1010	U.S. Provisional Application No. 60/135,521 to Nancy Benovich Gilby et al. (filed May 21, 1999)
1011	Tim Berners-Lee et al., <i>Request for Comments: 1738</i> (December 1994)

Petition for *Inter Partes* Review of
U.S. Patent No. 7,065,555 B2

Petitioner American Airlines, Inc. (American or Petitioner) respectfully requests *inter partes* review (IPR) of claims 1-17 (the Challenged Claims) of U.S. Patent No. 7,065,555 B2 (the '555 patent) (Ex.1001). According to PTO records, the '555 patent is assigned to Advanced Transactions, LLC (Advanced Transactions or Patent Owner). For the reasons set forth below, the Challenged Claims should be found unpatentable and canceled.

I. MANDATORY NOTICES UNDER 37 C.F.R. § 42.8

A. Real party in interest under § 42.8(b)(1)

American is the real party in interest to this petition. American is a wholly owned subsidiary of American Airlines Group, Inc., which is not a real party in interest to this petition.

B. Related matters under § 42.8(b)(2)

The '555 patent is the subject of *American Airlines, Inc. v. Advanced Transactions, LLC*, No. 4:23-cv-00576 (N.D. Tex., filed June 8, 2023). American is unaware of other active judicial or administrative matters related to the '555 patent.

C. Lead and backup counsel under § 42.8(b)(3)

American designates the following counsel:

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D. Service information

This petition is being served by Federal Express to the attorney of record for the '555 patent, MEUNIER CARLIN & CURFMAN LLC, 999 Peachtree Street NE, Suite 1300, Atlanta GA 30309. American consents to electronic service at AA-AdvTrans@mckoolsmith.com.

II. FEE PAYMENT

American requests review of 17 claims, with a \$41,500 payment. The Office is authorized to charge the fees specified by 37 C.F.R. §§ 42.103(a) and 42.15(a) to Deposit Account No. 50-5723.

III. GROUNDS FOR STANDING

American certifies that the '555 patent is available for IPR and that American is not barred or estopped from requesting an IPR challenging the '555 patent's claims on the grounds identified in this petition.

IV. BRIEF OVERVIEW OF THE '555 PATENT

The '555 patent relates to “[a] method and system for generating and tracking an email campaign.” Ex.1001 at Abstract. Such “email campaign[s]” are used for “sending email to a number of email targets for such purposes” as “marketing, information acquisition, and otherwise.” *See id.* (1:20-25). Their progress may also be “monitored and tracked” once underway. *See id.* (1:42). A

“custom URL” may also be sent to an email target. *Id.* (5:48-49). The custom URL may include a “hash” for “message authentication”—*i.e.*, as a way to “verif[y] the validity of the URL recipient” and allow “the recipient” to “view and edit the web page.” *See id.* (5:48-49, 6:39-42).

V. PRIORITY DATE

For purposes of this IPR, American contends the earliest effective filing date of the '555 patent is April 25, 2001. On that date, U.S. Application No. 09/841,186 was filed. That application later issued as the '555 patent. *Id.* at Cover. Thus this petition applies pre-AIA 35 U.S.C. §103 in showing unpatentability. As explained below, each of American's prior art references were filed before the earliest priority date and qualify as prior art. *See infra* IX.

VI. CLAIM CONSTRUCTION

American applies the *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005), claim construction standard. 83 Fed. Reg. 51,340, 51,340-44 (Oct. 11, 2018). American does not believe explicit construction is required to resolve this petition. Still, the district court case is in its early stages, having yet to commence claim construction. American reserves the right to revisit constructions proposed in district court and, in accordance with 37 C.F.R. § 42.100(b), request leave to submit the district court's claim construction order so the Board may consider it.

VII. PERSON OF ORDINARY SKILL IN THE ART (POSITA)

A POSITA as of April 2001 “would have been a person with a bachelor’s degree in computer science, computer engineering, or electrical engineering and at least three years of experience in networking operating systems and cybersecurity, or a person with a master’s degree in one of the foregoing and at least two years of experience in the aforementioned fields.” Ex.1006 ¶ 25.

VIII. PRECISE RELIEF REQUESTED AND GROUNDS RAISED

American requests cancellation of claims 1-17 based on the following obviousness grounds:

Ground	Claims	Basis for § 103 Challenge
1	1-6, 9-15	Obvious over Bergh (Ex.1002) in view of Nagda (Ex.1005)
2	1-6, 9-15	Obvious over Calloway (Ex.1003) in view of Nagda
3	7-8, 16-17	Obvious over Calloway in view of Lerner (Ex.1004)

American also submits the Declaration of Dr. Eric Cole (Ex.1006), a qualified expert in support of the obviousness grounds. *See* Ex.1006 ¶¶ 1-19. Grounds 1-2 are not cumulative because they use a different primary reference. Ground 3 is not cumulative because it addresses different claims from Grounds 1-2. Grounds 1-3 are also not cumulative with the art of record, including the art of record expressly considered by the examiner during prosecution of the ’555 patent,

because Grounds 1-3 address features found to be missing by the examiner in the considered references. Ex.1006 ¶ 33. Each of the asserted references is analogous art that is usable in an obviousness analysis. *Unwired Planet, LLC v. Google, Inc.*, 841 F.3d 995, 1000-01 (Fed. Cir. 2016). Each reference is from the same field of endeavor, *e.g.*, internet technology, and is also reasonably pertinent to the particular problem with which the inventors were involved, *e.g.*, email marketing. *See infra* IX; Ex.1006 §§ IV-V. As analogous art, a POSITA is presumed to have been aware of these references. *In re Nilssen*, 851 F.2d 1401, 1403 (Fed. Cir. 1988).

IX. BRIEF DESCRIPTION OF THE APPLIED PRIOR ART REFERENCES

A. Bergh (Ex.1002)

Bergh, titled “Offer Delivery System,” is U.S. Patent No. 8,533,038 B2. Bergh’s application was filed on February 5, 2001. As a continuation in part to U.S. Application No. 09/575,283 (the ’283 Application), Bergh claims priority to the ’283 Application’s May 22, 2000 filing date. Bergh also claims priority to U.S. Provisional Application Nos. 60/135,521 (filed on May 21, 1999) and 60/180,254 (filed on February 4, 2000). Ex.1002 at Cover. Thus, Bergh qualifies as pre-AIA prior art. *See* 35 U.S.C. § 102(e)(2).

Bergh discloses systems and methods to “select, deliver, and track offers” to customers—*i.e.*, through a “campaign.” Ex.1002 (3:9, 3:32). Bergh’s campaigns may deliver offers through “electronic channels, such as email.” *Id.* (3:45-46). Once underway, Bergh discloses “tracking” the “success of particular marketing campaigns,” and generating “various reports” in the process. *Id.* (5:18, 5:22, 5:28).

B. Calloway (Ex.1003)

Calloway, titled “Multimedia Messaging Method and System,” is U.S. Patent No. 7,865,394 B1. Calloway’s application was filed on November 7, 2000. It claims priority to U.S. Provisional Application No. 60/197,759, which was filed on April 17, 2000. Ex.1003 at Cover. Thus, Calloway qualifies as pre-AIA prior art. *See* § 102(e)(2).

Calloway discloses “[a] system and method for the distribution of individualized multimedia content over a network to a number of recipients.” Ex.1003 at Abstract. The “[m]ultimedia elements may be variously combined within an individualized message containing,” among other things, “text.” *Id.* Additionally, “the individualized content may be delivered through an email to the recipient as part of an email campaign.” *Id.* Once the campaign is underway, Calloway further discloses “allow[ing] instant, real-time access to . . . reports wherein clients can view the results of a campaign while it is underway.” *Id.* (28:13-15).

C. Lerner (Ex.1004)

Lerner, titled “System and Method for Annotating Web-Based Documents,” is U.S. Patent No. 6,859,909 B1. It was filed on March 7, 2000. Ex.1004 at Cover. Thus, Lerner qualifies as pre-AIA prior art. *See* § 102(e)(2).

Lerner generally “allows computer users to integrate any annotation, including ink, highlighter, text-based notes and audio, directly into a Web-based document (WBD) displayed by a Web browser.” Ex.1004 at Abstract. Key to Lerner’s invention is a “URL content hash,” which “contains an integer value that results from the execution of a standard hash function on the contents of the WBD.” *Id.* (5:10-15). Lerner further discloses that using such a hash enables users to send “a message” with a hashed “link to someone else,” enabling the sharing of annotated WBDs. *See id.* (14:67-15:7).

D. Nagda (Ex.1005)

Nagda, titled “Workflow Management System for Generating Output Material Based on Customer Input,” is U.S. Patent No. 7,302,430 B1. It was filed on August 31, 1999. Ex.1005 at Cover. Thus, Nagda qualifies as pre-AIA prior art. *See* § 102(e)(2).

Nagda generally discloses “a method, system, and program for an automated creation and delivery system for generating customer output information.” Ex.1005 at Abstract. The invention in Nagda uses an “output constructor,” which “receives

[a] template and us[es] information in a customer record” to “populate[] the template with marketing information tailored for the customer.” *Id.* (3:12-15). The generated marketing material “may be converted into a portable format” to “transmit to the customer via email.” *Id.* (3:21-25).

X. THE CHALLENGED CLAIMS ARE UNPATENTABLE

This petition applies **bold font** to terms related to ’555 patent claim terms.

A. Ground 1: Claims 1-6 and 9-15 are obvious over Bergh in view of Nagda.

Every limitation of claims 1-6 and 9-15 is disclosed or suggested by Bergh, Nagda, and a POSITA’s general knowledge. *See infra* X(A)(1)-(13); Ex.1006 ¶ 91. Thus a POSITA would have had a reasonable expectation of success in making the claimed invention using well-known, standard techniques. Ex.1006 ¶ 92. Bergh and Nagda likewise share the ’555 patent’s goals of providing a more “effective” and “efficient way to create and track a email campaign [*sic*].” Ex.1001 (1:33, 1:43-44); *see also* Ex.1002 (1:29-30) (discussing limitations in prior art “reducing the effectiveness of . . . communication[s] with [a] customer”); Ex.1005 (1:35-47) (discussing that customized campaigns required “substantial human intervention,” and uncustomized campaigns were “not as effective a marketing tool”). A POSITA would have thus been motivated to combine Bergh, Nagda, and its general

knowledge. Ex.1006 ¶¶ 93-94. Claims 1-6 and 9-15 are therefore obvious over Bergh in view of Nagda and a POSITA's general knowledge. *Id.* ¶ 95.

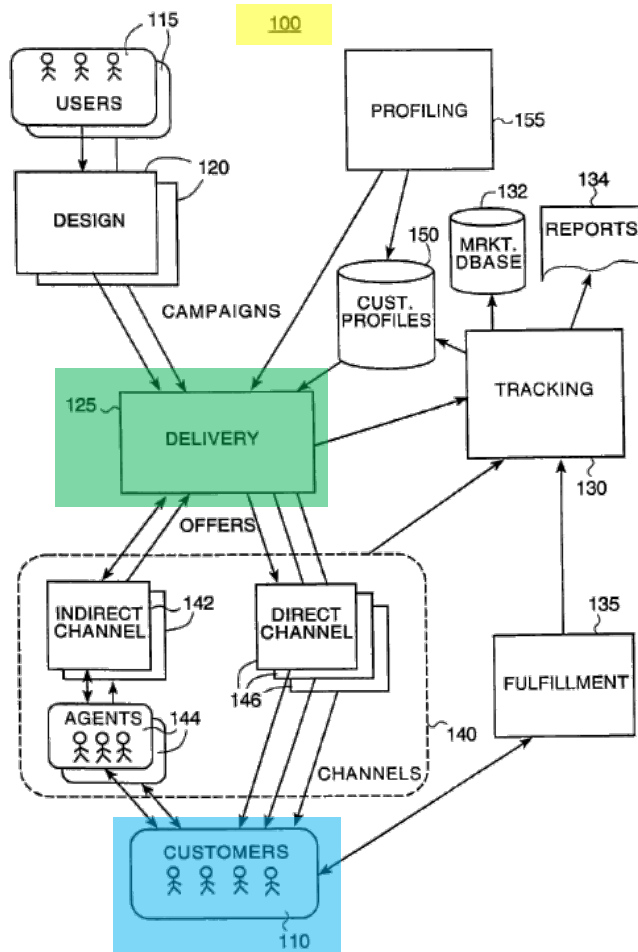
1. Claim 1

a) [1a] “A method for conducting an email campaign, comprising the steps of:”

Bergh discloses that “a ‘campaign’ refers to a collection of offers.” Ex.1002 (3:32-33). Figure 1 illustrates that those offers “are delivered by [the] offer management system 100 to customers 110” and “include commercial offers.” *Id.* (Sheet 1); *id.* (3:9-11, 3:16-17). Bergh’s offer management system may deliver offers to customers through “email.” *Id.* (3:37-46);

see also id. (4:29-31) (“[The] delivery component 125 can send an electronic mail message to one or more customers 110 that includes an offer.”). Thus, Bergh discloses or suggests claim 1a to the extent it is limiting. Ex.1006 ¶¶ 96-99.

FIG. 1

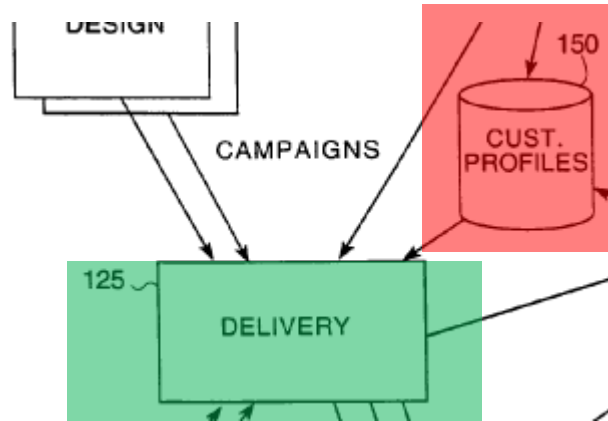


b) [1b] “(1) receiving an email target database;”

Bergh discloses that “users 115 specify campaigns, and the system creates sets of specific customer offers from the campaigns.” Ex.1002 (3:35-36). Those specific “customers” are the “individuals or entities that are desired **targets** for the offers.” *Id.* (3:17-18).

Bergh discloses a “**customer profile database**,” which includes “information specific to [each] customer[].” *Id.* (5:29-31). Figure 1’s arrow pointing from the **customer profile database 150** to the **delivery component 125** discloses **receiving**

the customer profile **database**. *See id.* (Sheet 1); *id.* (5:44-45) (explaining that the “**delivery component**” uses the “**customer profile database**”); Ex.1006 ¶¶ 100-101. A POSITA would



have also generally known that the content of a **database** could be **received** from an external source. *Id.* ¶ 102. Thus, Bergh and a POSITA’s general knowledge disclose or suggest claim 1b. *Id.* ¶¶ 100-103.

c) [1c] “(2) generating an email campaign template related to at least one email target in the received email target database, wherein step (2) comprises:”

To the extent claim 1c is limiting, Bergh, Nagda, and a POSITA’s general knowledge disclose or suggest it. Ex.1006 ¶¶ 104-107. Bergh discloses or suggests **receiving an email target database**, as discussed in claim 1b. It likewise discloses or suggests that the **received email target database** contains **at least one email target**. *See supra* X(A)(1)(b). Bergh also discloses or suggests claim 1c’s **generating an email campaign template**. *See infra* X(A)(1)(d)-(e).

d) [1d] “(a) generating a message template, and”

Bergh’s campaigns include “a **template** or rule” to “determine[]” the “one or more offers to specific customers.”

Ex.1002 (3:32-35); *Id.* (8:8-10) (noting that a “campaign can be thought of as a **template** for offers that are instantiated for particular customers”). Campaign **templates** include “content,” as Figure 3 illustrates at 318. *Id.* (Sheet 3).

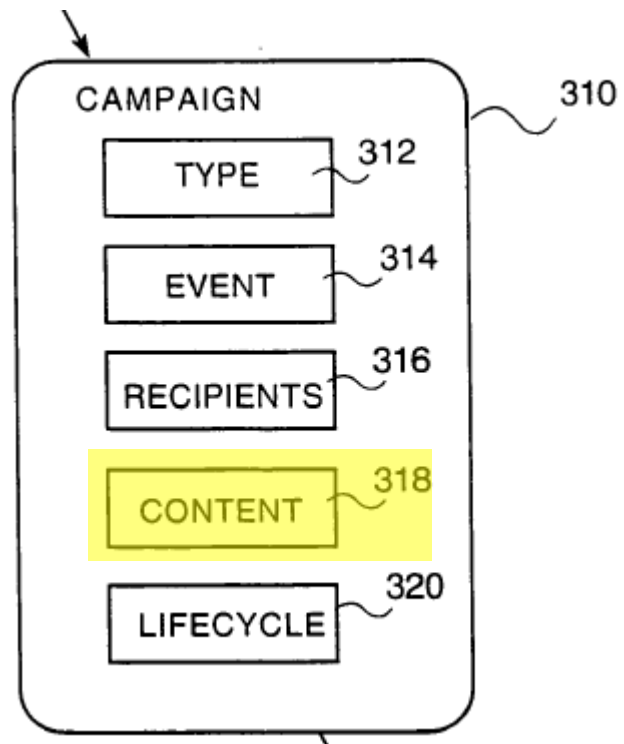


Figure 3’s content “specifies the content and layout of the information of an offer.” *Id.* (8:21-22). It includes

“text” and “HTML” that may be “filled in” with customer-specific data, like “the customer’s name,” to “personalize[]” it “before delivery.” *Id.* (8:23-26). Bergh’s “email **message**” includes such content. *Id.* (8:27-28). Thus, Bergh and a POSITA’s general knowledge disclose or suggest claim 1d. Ex.1006 ¶¶ 108-110.

e) [1e] “(b) generating a configuration file to contain data related to each of the at least one email target, wherein the data is insertable in the generated message template;”

Nagda discloses a “**template**, which when **generated** includes the tailored marketing information to send to the customer.” Ex.1005 (2:19-20). A POSITA would understand Nagda as disclosing or suggesting claim 1e’s **generated message template**. Ex.1006 ¶¶ 111-112.

Nagda also discloses a “customer record,” which **contains data related to each of the at least one email target**, such as the “Customer Name,” and “E-mail Address.” *See id.* Fig. 2a; *see also* Ex.1005 (4:17-18) (“FIGS 2a and 2b provide an example of a customer record database entry form[.]”); Ex.1006 ¶ 111. The customer record’s **data is insertable in the generated message template** by an “output constructor,” which “us[es] information in [the] customer record from the customer database” to “populate[] the **template** with marketing information tailored for the customer.” Ex.1005 (3:12-15).

Nagda similarly discloses “using the preferences and information in the customer record to query and select a file that includes content tailored to the

customer[’s] express preferences.” Ex.1005 (5:31-33). That content “file” may be used to “**generate** customize information [*sic*] in a container”—*i.e.*, the “sections into which files from the content database 8 are inserted” within “[a] template.” *Id.* (4:41-42, 5:39-40).

A POSITA would thus understand that Nagda’s customer record and content files disclose or suggest claim 1e’s **configuration file**. Ex.1006 ¶ 111. Nagda discloses or suggests that its content file may be “**generate[d]**,” as just discussed. *Id.* A POSITA would have also generally known that Nagda’s customer record could be **generated**. *See* Ex.1005 (11:45) (disclosing “**generating** a customer record in a first database table”); *see also id.* (11:33-34) (“Many modifications and variations are possible[.]”); Ex.1006 ¶ 111. Thus, Nagda and a POSITA’s general knowledge disclose or suggest claim 1e. Ex.1006 ¶¶ 111-113.

f) [1f] “(3) sending to each of the at least one email target a corresponding custom email, wherein the custom email is formed from the email campaign template; and”

Bergh discloses that a “personalized . . . **email** message may be **sent** directly to customers.” Ex.1002 (8:24-28). Bergh, Nagda, and a POSITA’s general knowledge also disclose or suggest **generating an email campaign template** to perform that personalization, as discussed. *See supra* X(A)(1)(c)-(e). Thus, Bergh, Nagda, and a POSITA’s general knowledge disclose or suggest claim 1f. Ex.1006 ¶¶ 114-115.

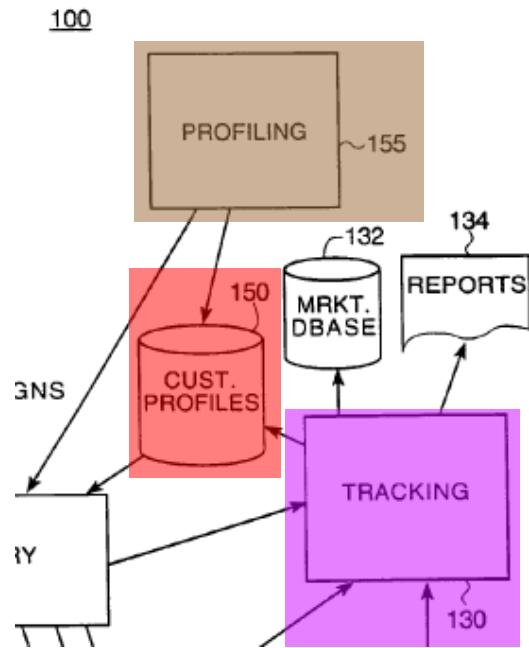
g) [1g] “(4) tracking the custom email sent to each of the at least one email target.”

Bergh discloses “**tracking** activities of the individuals to whom the offers were presented,” including “[s]tatistics related to [the] effectiveness of the offers” or “marketing campaigns involving multiple offers.” Ex.1002 (2:26-30, 12:34); Ex.1002 (14:39-42). For example, Bergh **tracks** “customers accessing particular web content,” and “particular activity related to offers, such as requests for information, performing commercial transactions, or otherwise explicitly responding to offers.” Ex.1002 (12:36-41). **Tracking** also includes “recording a customer’s access to a Web server,” “receiv[ing] a notification that the customer has read [an] email,” and “solicit[ing] an email response” from the customer. Ex.1002 (4:47-53). Thus, Bergh discloses or suggests claim 1g. Ex.1006 ¶¶ 116-117.

2. Claim 2: “The method of claim 1, wherein step (1) comprises the step of: (a) generating the email target database.”

Claim 2 is substantially similar to claim 1b. The claims differ only in how the email target database is provided: claim 1b requires **receiving** it, while claim 2 requires **generating** it. *Id.* ¶ 118.

Bergh’s Figure 1 illustrates a customer profiles database 150 that is generated from Bergh’s profiling 155 and/or tracking components 130. Ex.1002 (Sheet 1); see also *id.* (5:29-30) (“Tracking component 130 also provides data to a customer profile database.”); *id.* (5:43-44) (“Profiling component 155 provides data to customer profile database 150 in batch mode.”). A POSITA would understand those disclosures as disclosing or suggesting **generating the email target database**. Ex.1006 ¶ 119.



Moreover, Nagda discloses “customer records in the first **database** [that] are **generated** by a human operator” and “[an] automated creation and delivery system to **generate** customer records in a **database**.” Ex.1005 (2:6-17). In some embodiments of Nagda, the customer records include **email targets**. See *id.* (4:40-43) (disclosing that the customer record includes “information for the delivery

method, e.g., e-mail address”). A POSITA would also understand those disclosures from Nagda as disclosing or suggesting **generating the email target database**. Ex.1006 ¶ 120.

Therefore, Bergh, Nagda, and a POSITA’s general knowledge disclose or suggest claim 2. *Id.* ¶¶ 118-121.

3. Claim 3

a) [3a] “The method of claim 2, wherein step (a) comprises the steps of: (i) collecting at least one raw document;”

Bergh discloses “assembl[ing] information about particular customers.” Ex.1002 (5:37-38). That assembled information includes “customer-provided information,” which further includes “survey forms filled out by customers when registering a product.” *Id.* (5:41-43). Survey forms would be understood by a POSITA as raw documents. Ex.1006 ¶ 122. Thus, Bergh and a POSITA’s general knowledge disclose or suggest claim 3a. *Id.* ¶¶ 122-123.

b) [3b] “(ii) parsing said collected at least one document;”

As discussed, Bergh discloses or suggests claim 3a’s **collecting at least one raw document**. *See supra* X(A)(3)(a). A POSITA would have known that **raw documents** must be **parsed** to use their information. Ex.1006 ¶ 124. Thus, Bergh and a POSITA’s general knowledge disclose or suggest claim 3b. *Id.*

c) [3c] “(iii) categorizing said parsed at least one document into at least one category;”

Claim 3c provides a specific method for **generating the email target database** of claim 2 by using **raw documents**. *Id.* ¶ 125. Bergh teaches assigning a “class[]” to “customers” within a “customer profile database.” Ex.1002 (5:29-31). Those “class[es] (e.g., a market segment)” can then be used to choose targets for offers. *Id.* (7:1-3); *see also id.* (11:54-56) (“[P]rioritization rules may relate to the class of user 115 that originated the offer, for example, preferring offers from a corporate marketing department to those of a local distributor.”). Given claim 3c’s context, a POSITA would thus understand that classifying customers within a customer profile database requires **categorizing the parsed at least one document** containing each customer’s information. Ex.1006 ¶ 125. Thus, Bergh and a POSITA’s general knowledge disclose or suggest claim 3c. *Id.* ¶¶ 125-126.

d) [3d] “(iv) inserting said at least one document into a database; and”

Bergh discloses “provid[ing] data to [a] customer profile database.” Ex.1002 (5:44). A POSITA would understand that providing data to a **database** discloses **inserting said at least one document into** it. Ex.1006 ¶ 127.

A POSITA would have also have generally known that **inserting a document into a database** is a required to later retrieve it. *Id.* Thus, a POSITA would have also been motivated to modify that reference to include claim 3d to

enable later access to **parsed documents** through Berg's customer profile database. *Id.*

Thus, Bergh and a POSITA's general knowledge disclose or suggest claim 3d. *Id.* ¶¶ 127-128.

e) [3e] “(v) removing documents from the database corresponding to duplicate email addresses.”

Bergh discloses that an object of its invention is “preventing a customer from receiving **duplicate** . . . offers.” Ex.1002 (6:51-52). Bergh further discloses that “[t]he specific customers to whom the offer is sent by delivery component 125 can be based on a database query of customer profile database 150.” *Id.* (8:10-12). Because the specific customers to whom the offer is sent are based on a database query of the customer profile database, a POSITA would have understood that **duplicate email addresses** for that customer would need to be **removed** from the customer profile database to prevent **duplicate** offers. Ex.1006 ¶ 129. Thus, Bergh and a POSITA's general knowledge disclose or suggest claim 3e. *Id.* ¶¶ 129-130.

4. **Claim 4: “The method of claim 1, wherein step (1) comprises the step of: (a) requesting an email target database according to a structured query language statement.”**

Claim 4 differs from claim 1 in how the **email target database** is provided: claim 1 requires **receiving** it, while claim 4 requires **requesting** it **according to a structured query language**. Ex.1006 ¶ 131. Bergh discloses “a **database** server 230, such as a **SQL** server,” that stored “pending offers” and “customer profiles.” Ex.1002 (6:38-40). A POSITA would understand **SQL** as the initialism for **structured query language**, meaning that Bergh’s **SQL** server will process **requests according to a structured query language statement**. Ex.1006 ¶ 132. Because Bergh’s **SQL** server includes multiple types of information—*e.g.*, currently pending offers and customer profiles—a **structured query language statement** must be used to **request** the customer profile **database** specifically from amongst all the information stored on the **SQL** server generally. *Id.* Thus, Bergh and a POSITA’s knowledge disclose or suggest claim 4. *Id.* ¶¶ 131-133.

5. **Claim 5: “The method of claim 1, wherein step (1) comprises the step of: (a) receiving an email target database from a database vendor.”**

Claim 5 differs from claim 1 in how the **email target database** is provided: claim 1 merely requires **receiving** it, while claim 5 requires **receiving** it **from a database vendor**. *Id.* ¶ 134. Bergh discloses using “indirect channels” to deliver

campaigns, including those that integrate third-party “sales-force automation (SFA) systems and lead management systems.” Ex.1002 (4:14-16). Bergh also claims priority to Provisional Application No. 60/135,521. *Id.* at Related U.S. Application Data. It discloses that “a lead management system . . . accepts leads 162 from one or more lead sources 160,” and that “[l]ead sources 160 can include . . . purchased mailing lists.” Ex.1010 (14-20). A POSITA would understand that both third-party SFA and lead management systems generally include—and that purchased mailing lists specifically include—**an email target database from a database vendor**. Ex.1006 ¶ 135. Thus, Bergh and a POSITA’s general knowledge disclose or suggest claim 5. *Id.* ¶¶ 134-136.

6. Claim 6

a) [6a] “The method of claim 1, wherein step (b) comprises the steps of: (i) generating a custom uniform resource locator address for each of the at least one email target; and”

Bergh discloses “sending an email message that includes a link to content stored in a web offer database specifically for that customer.” Ex.1002 (10:63-66). A POSITA would understand that including a web link—*i.e.*, a uniform resource locator or URL—specifically for a customer requires **generating** it. Ex.1006 ¶ 137. Thus, Bergh and a POSITA’s general knowledge disclose or suggest claim 6a. *Id.* ¶¶ 137-138.

b) [6b] “inserting the generated custom uniform resource locator address for each of the at least one email target into the configuration file.”

Bergh and Nagda disclose or suggest claim 1e’s **generating a configuration file to contain data related to each of the at least one email target, wherein the data is insertable in the generated message template.** *See supra* X(A)(1)(e). Bergh discloses “HTML links”—*i.e.*, the **custom uniform resource locator addresses**—to be placed “in the email message.” Ex.1002 (8:28-29). Nagda discloses or suggests **configuration files** that contain content customized based on customer information. *See supra* X(A)(1)(e). A POSITA would thus understand that Bergh’s **custom uniform resource locator addresses** should be **inserted** into Nagda’s **configuration files**. Ex.1006 ¶ 139. Thus, Bergh, Nagda, and a POSITA’s general knowledge disclose or suggest claim 6b. *Id.* ¶¶ 139-140.

7. Claim 9: “The method of claim 1, wherein step (3) comprises the step of: (a) forming the custom email for each of the at least one email target from the generated text message template and the generated configuration file.”

All that distinguishes claim 9 from claim 1 is that claim 9 requires **forming the custom email directly from the generated text message template and the generated configuration file**, while claim 1 requires that its **custom email is formed from an email campaign template**, which claim 1 requires **generating from a message template and a configuration file**. Ex.1006 ¶ 141. That claim 9

requires a **text message template** while claim 1 requires a **message template** does not further limit claim 9 because the '555 patent treats both terms synonymously. *See, e.g., id.*; Ex.1001 (6:62-66) (explaining that “custom email message 410” is, in part, “formed from” a “text message file”); *id.* (8:61-63) (same, but referring to a “text message template”); *id.* (9:21-22) (explaining that “the message template is text message file 320”).

Bergh discloses that “[a] number of engines take campaigns in campaign store 620 and form offers for specific customers.” Ex.1002 (9:33-35). Fully formed campaigns use an **email campaign template**. *See supra* X(A)(1)(c)-(e). Those fully formed campaigns are formed by Bergh’s “direct engine.” *See* Ex.1002 (9:40-42). Campaigns handled by Bergh’s “trigger engine” and “lifecycle engine” form offers only upon a customer completing some action or series of actions—*e.g.*, “registration” or “repeat purchase.” *Id.* (9:49-52, 9:60-63). Because both the trigger and lifecycle engines form offers at the moment of a customer performing some action, a POSITA would understand that forming an intermediate **email campaign template** is unnecessary because only a single offer will be sent. Ex.1006 ¶ 142. A POSITA would therefore understand that offers formed by Bergh’s trigger and lifecycle engines are formed directly from a **message template** and **configuration file**. *Id.*

Even if Bergh did not disclose or suggest claim 9, a POSITA would have understood that Nagda discloses or suggests creating a **custom email** directly from a **message template** and **configuration file** without first forming an intermediary **email campaign template**. *Id.* ¶ 143. Nagda discloses or suggests combining a **message template** and data structure containing customer data (or **configuration file**) in an “output constructor” which, “[a]fter generating **direct** marketing material comprised of the populated template . . . may then direct the marketing material . . . to the customer via email.” Ex.1005 (3:12-25). No intermediate **email campaign template** is required. Ex.1006 ¶ 143.

Thus, Bergh, Nagda, and a POSITA’s general knowledge disclose or suggest claim 9. *Id.* ¶¶ 141-144.

8. Claim 10

a) [10a] “The method of claim 1, wherein step (4) comprises the steps of: (a) receiving at least one response from the at least one email target; and”

Claim 10 further narrows claim 1g’s **tracking the custom email sent to each of the at least one email target**. While claim 1g claims **tracking**, claim 10a requires **receiving at least one response from the at least one email target**. Ex.1006 ¶ 145.

Bergh discloses customer “feedback” that is “in response to an offer.” Ex.1002 (4:43-45). Such feedback includes “**receiv[ing]** a notification that the

customer has read [an] email” and “solicit[ing] an email **response**” from the customer. *Id.* (4:47-53). A POSITA would understand that Bergh’s feedback generally, and Bergh’s embodiments, include **responses** that are **received** from **at least one email target**. Ex.1006 ¶ 146.

A POSITA would have also generally known that **tracking** an email campaign includes **receiving at least one response from the at least one email target**. *Id.* ¶ 147. Because Bergh disclose such **tracking**, *see supra* X(A)(1)(g), a POSITA would have been motivated to use standard techniques to modify each reference to arrive at claim 10a, Ex.1006 ¶ 147.

Thus, Bergh and a POSITA’s general knowledge disclose or suggest claim 10a. *Id.* ¶¶ 145-148.

b) [10b] “creating a campaign tracking list from said received at least one response.”

Bergh discloses “reports.” Ex.1002 (5:24-25). Such reports characterize “the effectiveness of various types of offers.” *Id.* (5:25-26). A POSITA would understand that because Bergh’s reports characterize the effectiveness of various types of offers Bergh discloses **a campaign tracking list**. Ex.1006 ¶ 149; *see also* Ex.1001 (9:4-10) (explaining that a “campaign tracking list includes determining various parameters,” for example, like “a number of respondents that requested

deletion”). For the same reason, a POSITA would also understand that Bergh’s reports are **created from said received at least one response**. *Id.* ¶ 149.

A POSITA would have also generally understood **creating a campaign tracking list from said received at least one response**. *Id.* ¶ 150. Such techniques were well known in the art. *Id.* Thus even if Bergh did not disclose or suggest claim 10b, a POSITA would have been motivated to modify them to include claim 10b at least because Bergh discloses or suggests claim 10a, **receiving at least one response from the at least one email target**. *Id.*

Thus, Bergh and a POSITA’s general knowledge disclose or suggest claim 10b. *Id.* ¶¶ 149-151.

9. Claim 11

a) [11a] “The method of claim 10, wherein step (b) comprises the steps of: (i) determining a number of successful visits from the at least one email target;”

Claim 11a further limits claim 10b’s **creating a campaign tracking list from said received at least one response**. Rather than requiring claim 10b’s **campaign tracking list** generally, claim 11a requires **determining a number of successful visits from the at least one email target** specifically. *Id.* ¶ 152.

Bergh discloses “reports” that are used to “characteriz[e] the effectiveness of various types of offers.” Ex.1002 (5:25-26). That includes characterization based on “[i]mplicit feedback,” like “a customer’s access to a Web server after an offer

has been presented.” *Id.* (4:47-50). A POSITA would understand that reporting a customer’s post-offer access to a web server discloses **determining a number of successful visits from the at least one email target**. Ex.1006 ¶ 153; *see also* Ex.1001 (7:48-49) (“[A] successful hit may be declared when an email recipient selects their customized URL[.]”).

Thus, Bergh and a POSITA’s general knowledge disclose or suggest claim 11a. Ex.1006 ¶¶ 152-154.

b) [11b] “(ii) determining a number of the custom email sent to the at least one email target that were undeliverable; and”

Claim 11b further limits claim 10b’s **creating a campaign tracking list from said received at least one response**. Rather than requiring claim 10b’s **campaign tracking list** generally, claim 11b requires **determining a number of the custom email sent to the at least one email target that were undeliverable** specifically. *Id.* ¶ 155.

Bergh discloses “reports” that are used to “characteriz[e] the effectiveness of various types of offers.” Ex.1002 (5:25-26). That includes “track[ing] the instances of offers sent to particular customers.” *Id.* (8:14-15). A POSITA would understand that tracking the instances of offers sent to particular customers discloses **determining a number of the custom email sent to the at least one email target that were undeliverable**. Ex.1006 ¶ 156; *see also* Ex.1002 (1:35-40) (disclosing

that an object of the invention is to improve the actual delivery of offers to customers—*i.e.*, by minimizing the number of “unsubscribe[s]” and automatically “discard[ed] future offers”). Thus, Bergh and a POSITA’s general knowledge disclose or suggest claim 11b. Ex.1006 ¶¶ 155-157.

c) (iii) [11c] “determining a number of the at least one email target that requested deletion.”

Claim 11c further limits claim 10b’s **creating a campaign tracking list from said received at least one response**. Rather than requiring claim 10b’s **campaign tracking list** generally, claim 11c requires **determining a number of the at least one email target that requested deletion** specifically. *Id.* ¶ 158.

Bergh discloses “reports” that are used to “characteriz[e] the effectiveness of various types of offers.” Ex.1002 (5:25-26). That includes “track[ing] the instances of offers sent to particular customers,” *id.* (8:14-15), and “solicit[ing] an email response” to an offer, *id.* (4:52). Bergh explains that “provid[ing] a mechanism to ‘unsubscribe’ from all future offers” was well-known to POSITAs already. *Id.* (1:34-35). Thus a POSITA would understand that tracking the instances of offers sent to particular customers and soliciting their email response both disclose **determining a number of the at least one email target that requested deletion**. Ex.1006 ¶ 159; *see also* Ex.1002 (1:35-40) (disclosing that an object of the invention is to improve the actual delivery of offers to customers—*i.e.*, by

minimizing the number of “unsubscribe[s]” and automatically “discard[ed] future offers”). Thus, Bergh and a POSITA’s general knowledge disclose or suggest claim 11c. Ex.1006 ¶¶ 158-160.

10. Claim 12

Claim 12 is substantially similar to claim 1 with claim 10 added. Thus, claim 12 is disclosed or suggested for the same reasons that claims 1 and 10 are disclosed or suggested. Even so, claim 12 is also disclosed or suggested for the reasons below. *Id.* ¶¶ 161-162.

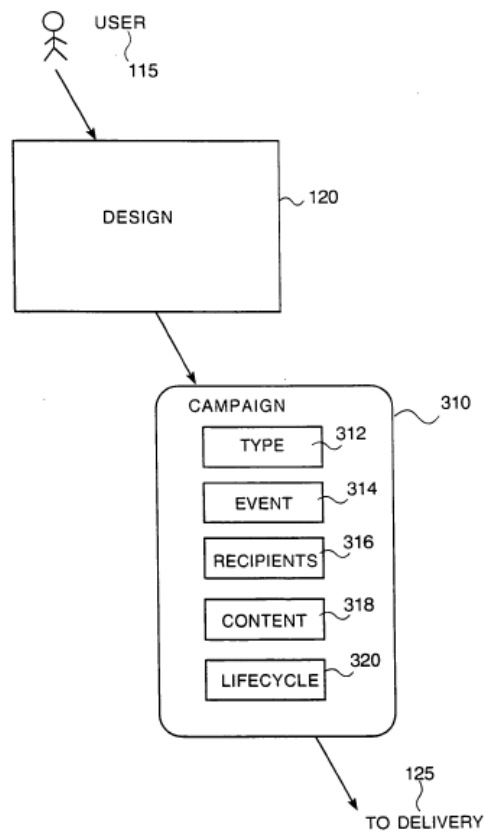
a) [12a] “A system for generating and tracking an email campaign, comprising:”

Claim 12 is substantially similar to claim 1. Claim 12 mainly differs in reciting **a system**, rather than claim 1’s **method**. *Id.* ¶ 161 (comparing claims 1 and 12 side by side). Bergh discloses or suggests **an email campaign**. *Id.* ¶ 163; *see supra* X(A)(1)(a). Bergh, Nagda, and a POSITA’s general knowledge also disclose or suggest **generating** or **tracking an email campaign**. Ex.1006 ¶ 163; *see infra* X(A)(10)(b)-(f). Thus, to the extent that claim 12a (claim 12’s preamble) is limiting, Bergh, Nagda, and a POSITA’s general knowledge disclose or suggest it. Ex.1006 ¶¶ 163-164.

b) [12b] “an email campaign generator that generates an email campaign template from an email target database, wherein said email target database comprises a plurality of email targets;”

Bergh discloses a “design component” for “specify[ing] campaigns.” Ex.1002 (6:57-58). For example, Figure 3 discloses the design component outputting a campaign:

FIG. 3



Id. (Sheet 3). Figure 3’s campaign 310 includes recipients 316. *Id.* Bergh discloses that recipients “characterize[] [the] particular customer or a class (e.g., a market segment) of customers 110 to whom the campaign is targeted.” *Id.* (7:1-3). The

specific customers “can be based on a **database** query of customer profile **database** 150,” *id.* (8:11-12). A POSITA would therefore understand that Bergh’s design component discloses **an email campaign generator that generates an email campaign template from an email target database, wherein said email target database comprises a plurality of email targets.** Ex.1006 ¶¶ 165-166. Thus, Bergh and a POSITA’s general knowledge disclose or suggest claim 12b. *Id.* ¶¶ 165-167.

c) [12c] “**an email campaign engine that generates a custom email corresponding to each of said plurality of email targets, wherein said custom email is formed from said email campaign template, wherein said email campaign engine sends said custom email to each of said plurality of email targets; and**”

Bergh discloses a “[d]elivery component.” Ex.1002 (4:23). It is passed “data structures holding data that specify characteristics of the offers to be sent according to [specified] campaigns” from the design component. *Id.* (6:57-60). Part of that data is “content” that is customer-specific data, like “the customer’s name,” which must be “filled in” to “personalize[]” the campaign’s offers. *Id.* (8:24-26). The delivery component uses those data structure to “form offers” before they are delivered to customers. *Id.* (9:28); *see also id.* (8:26) (explaining that personalization takes place “before delivery”). A POSITA would thus understand that Bergh’s delivery component discloses **an email campaign engine that**

generates a custom email corresponding to each of said plurality of email targets, wherein said custom email is formed from said email campaign template. Ex.1006 ¶ 168.

Bergh also discloses that its delivery component sends “offers to appropriate customers” through various channels, like through an “electronic mail message.” Ex.1002 (4:25-30). A POSITA would therefore understand that Bergh’s delivery component also discloses **an email campaign engine, wherein said email campaign engine sends said custom email to each of said plurality of email targets.** Ex.1006 ¶ 169. Thus Bergh and a POSITA’s general knowledge disclose or suggest claim 12c. *Id.* ¶¶ 168-170.

d) [12d] “a campaign tracker that receives a response corresponding to said sent custom email, and wherein said campaign tracker creates a campaign tracking list that includes said received response;”

Bergh discloses an “offer management system” that “deliver[s]” and “track[s] offers.” Ex.1002 (3:8-9). It includes a “delivery” and “**tracking**” component. *Id.* Fig.1 (Sheet 1). The “delivery component” receives “feedback” from customers, including “a notification that the customer has read the email” and “email **response[s].**” *Id.* (4:44-53). A POSITA would therefore understand that Bergh’s offer management system, at least through its delivery component,

discloses **a campaign tracker that receives a response corresponding to said sent custom email.** Ex.1006 ¶ 171.

Bergh also discloses that its delivery component sends information on the feedback it receives to “[a] **tracking** component.” Ex.1002 (5:18-19). Bergh’s **tracking** component uses the information it **receives** to produce “reports.” *Id.* (5:24-25). Those reports can “characterize[] the effectiveness of various types of offers.” *Id.* (5:25-26); *see also id.* (2:27-28) (“Statistics related to an effectiveness of the offers [*sic*] can be reported.”). A POSITA would thus understand that Bergh’s offer management system, at least through its tracking component, discloses **a campaign tracker, wherein said campaign tracker creates a campaign tracking list that includes said received response.** Ex.1006 ¶ 172. Thus, Bergh and a POSITA’s general knowledge disclose or suggest claim 12d. *Id.* ¶¶ 171-173.

e) [12e] “wherein said email campaign template comprises a text message, and”

Bergh’s design component discloses or suggests generating an **email campaign template.** *See supra* X(A)(10)(b). And Bergh likewise discloses or suggests **said email campaign template comprises a text message** for the same reasons it discloses or suggests claim 1d, **generating a message template.** *See supra* X(A)(1)(d); *see also* Ex.1002 (8:21-23) (“Content 318 specifies the content

and layout of the information of an offer . . . [and] can be text”). Thus, Bergh and a POSITA’s general knowledge disclose or suggest claim 12e. Ex.1006 ¶¶ 174-175.

f) [12f] “a configuration file that includes data from said email target database corresponding to each of said plurality of email targets.”

Bergh’s design component discloses or suggests generating an **email campaign template**. *See supra* X(A)(10)(b). Bergh and Nagda likewise disclose or suggest that the **email campaign template** is comprised of a **configuration file that includes data from said email target database corresponding to each of said plurality of email targets** for the same reasons they disclose or suggest claim 1e, **generating a configuration file to contain data related to each of the at least one email target, wherein the data is insertable in the generated message template**. *See supra* X(A)(1)(e); *see also* Ex.1002 (8:25-26) (explaining that “portions” of emails “need to be filled in (such as the customer’s name) before delivery”); *id.* (6:58-60) (explaining that “data structures holding data that specify characteristics of the offers to be sent according to [the] campaign” are “passed to [the] delivery component”). Thus, Bergh, Nagda, and a POSITA’s general knowledge disclose or suggest claim 12f. Ex.1006 ¶¶ 176-178.

11. Claim 13: “The system of claim 12, wherein said email campaign engine makes a copy of said text message to generate said custom email.”

Bergh, Nagda, and a POSITA’s general knowledge disclose or suggest **the system of claim 12**. *See supra* X(A)(10). Bergh’s delivery component “receives campaigns from design components” and then “forms offers” from them. Ex.1002 (9:26-28). Those campaigns include **said text messages**. *See supra* X(A)(10)(e). A POSITA would understand that forming offers from **said text message** could be accomplished by **making a copy of said text message**. Ex.1006 ¶ 179. A **custom email** could therefore be **generated** without having to mutate the campaign’s data. *Id.* A POSITA would be motivated to make that modification to Bergh because data immutability has many benefits, including promoting data/code reusability and reducing the incidence of errors. *Id.* Thus, Bergh, Nagda, and a POSITA’s general knowledge disclose or suggest claim 13. Ex.1006 ¶¶ 179-180.

12. Claim 14: “The system of claim 13, wherein said email campaign engine replaces at least one custom tag in said text message copy with a corresponding portion of said configuration file data.”

Bergh, Nagda, and a POSITA’s general knowledge disclose or suggest **the system of claim 13**. *See supra* X(A)(11). Bergh also discloses filling in (replacing) custom tags with a corresponding portion of said configuration file data. *See supra* X(A)(1)(d)-(e); *see also* Ex.1002 (5:44-47) (disclosing that the

customer-specific “portions” of emails must “be filled in (such as [with] the customer’s name) before delivery”). Thus, Bergh, Nagda, and a POSITA’s general knowledge disclose or suggest claim 14. Ex.1006 ¶¶ 181-182.

13. Claim 15: “The system of claim 12, wherein said email campaign generator comprises a custom uniform resource locator generator that creates a custom uniform resource locator address for each of said plurality of email targets, wherein said configuration file includes said custom uniform resource locator address in said data.”

Bergh, Nagda, and a POSITA’s general knowledge disclose **the system of claim 12**. *See supra* X(A)(10). Bergh also discloses that its design component “specif[ies]” the campaign’s “content.” *See* Ex.1002 (3:58, Sheet 3). “Content” is what “personalize[s]” the campaign’s offer, including offers that “include[] a link to content stored in the web offer database specifically for that customer.” *See* Ex.1002 (8:21-25, 10:63-66). A POSITA would therefore have understood that Bergh’s design component discloses **creating a custom uniform resource locator address for each of said plurality of email targets, wherein said configuration file includes said custom uniform resource locator address in said data**. Ex.1006 ¶ 183. Thus, Bergh, Nagda, and a POSITA’s general knowledge disclose or suggest claim 15. *Id.* ¶¶ 183-184.

B. Ground 2: Claims 1-6 and 9-15 are obvious over Calloway in view of Nagda.

Every limitation of claims 1-6 and 9-15 is disclosed or suggested by Calloway, Nagda, and a POSITA's general knowledge. *See infra* X(B)(1)-(13); Ex.1006 ¶ 185. Thus a POSITA would have had a reasonable expectation of success in making the claimed invention using well-known, standard techniques. *Id.* ¶ 186. Calloway and Nagda likewise share the '555 patent's goals of providing a more "effective" and "efficient way to create and track a email campaign [*sic*]." Ex.1001 (1:33, 1:43-44); *see also* Ex.1003 (1:8-11) (discussing prior art email marketing as "losing effectiveness as a medium for attracting and retaining the attention of a customer"); Ex.1005 (1:35-47) (discussing that customized campaigns required "substantial human intervention," and uncustomized campaigns were "not as effective a marketing tool"). A POSITA would have thus been motivated to combine Calloway, Nagda, and its general knowledge. Ex.1006 ¶ 188. Claims 1-6 and 9-15 are therefore obvious over Calloway in view of Nagda and a POSITA's general knowledge. *Id.* ¶ 189.

1. Claim 1

a) Claim [1a]

Calloway discloses, for example, "the deployment of individualized multimedia content as messages within an advertising **campaign** that targets and delivers an individualized **email** message to each recipient." Ex.1003 (2:58-62).

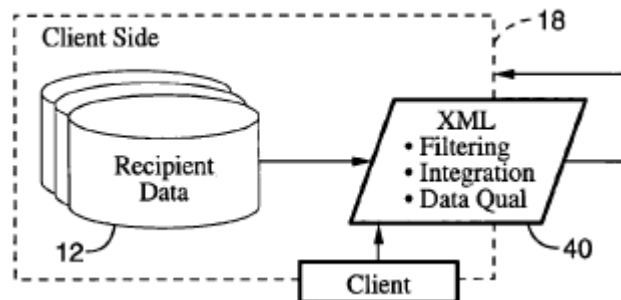
Calloway treats “advertising campaign” and “campaign” synonymously. *Id.* (3:3-4). Both reference “the action of sending individualized messages,” whether to “a single person, or any sized list of individuals.” *Id.* (3:5-8). Thus, Calloway discloses or suggests claim 1a to the extent it is limiting. Ex.1006 ¶¶ 190-192.

b) Claim [1b]

Calloway discloses or suggests claim 1b. It discloses that “an advertising campaign . . . **targets** and delivers an individualized email message to each recipient.” Ex.1003 (2:60-62). Further, “[t]he list of recipients to which the messages are to be directed is contained within a recipient **database** that may be supplied by the client, or a third party,” with “[t]he recipient **database** provid[ing] delivery information about the client, such as **email** address, along with various information about the recipient which may be utilized in the process of individualizing a message to that specific recipient.” Ex.1003 (3:65-4:4). A POSITA would understand that a database supplied by the client or a third party is necessarily **received**. Ex.1006 ¶ 193.

Multiple Figures also disclose **receiving** the recipient **database**.

Figure 4, for example, illustrates an



arrow from recipient data 12 to process 40, indicating **receiving** the recipient database. Ex.1003 (Sheet 4). Figures 1-3 all have similar arrows going from

recipient database 12, indicating the same. *See id.* (Sheets 1-3); Ex.1006 ¶ 194. Thus, Calloway and a POSITA's general knowledge disclose or suggest claim 1b. *Id.* ¶¶ 193-195.

c) Claim [1c]

To the extent claim 1c is limiting, Calloway, Nagda, and a POSITA's general knowledge disclose or suggest it. *Id.* ¶¶ 196-199. Calloway discloses or suggests **receiving an email target database**, as discussed in claim 1b. It likewise discloses or suggests that the **received email target database** contains **at least one email target**. *See supra* X(B)(1)(b). Calloway, Nagda, and a POSITA's general knowledge likewise disclose or suggest claim 1c's **generating an email campaign template**. *See infra* X(B)(1)(d)-(e).

d) Claim [1d]

Calloway discloses that its "preferred method of deploying the individualized messages utilizes a standard email **template** containing a rich media **message** and a Macromedia flash file which is unique for that particular recipient." Ex.1003 (3:48-51); *see also id.* (14:11-13) ("Recipients receive **message** with individualized audio and graphics. Parameters vary based on specific **template**."); *id.* (22:30-33) ("The multimedia engine, using an existing code library is capable of combining the email recipient information, as provided by a client, with existing email **message templates**."). These disclosures would be understood by a POSITA

as disclosing or suggesting **generating a message template**. Ex.1006 ¶ 200. Thus, Calloway and a POSITA's general knowledge disclose or suggest claim 1d. *Id.* ¶¶ 200-201.

e) Claim [1e]

Nagda discloses or suggests limitation 1e, as discussed above. *See supra* X(A)(1)(e); Ex.1006 ¶ 202.

f) Claim [1f]

Calloway discloses “deploying the individualized messages utiliz[ing] a standard **email template** containing a rich media message and a Macromedia flash file which is unique for that particular recipient.” Ex.1003 (3:48-51); *see also id.* (4:31-33) (“One typical form of messaging campaign involves the sending of emails to a list of recipients.”); *see also* Ex.1006 ¶ 204 (“A POSITA would understand from that disclosure, as well as the aforementioned deploying individualized messages, that Calloway and Nagda disclose or suggest **sending to each of the at least one email target a corresponding custom email.**”). Calloway and Nagda also disclose or suggest **generating an email campaign template** to perform that individualization, as discussed. *See supra* X(B)(1)(c)-(e). Thus, Calloway, Nagda, and a POSITA's general knowledge disclose or suggest claim 1f. Ex.1006 ¶¶ 203-205.

g) Claim [1g]

Calloway discloses “campaign **tracking.**” Ex.1003 (15:41). That includes **tracking the custom emails** with precision, including metrics such as:

[the] date and time of stream playback, number of recipients opening the message, number that access the playback site (if not automatically activated), number of recipients sending the message to another party, time between message dispatch and recipient opening the message, interaction time of recipient (average, range), participation rate, click history within the message, click-throughs to site[.]

Ex.1003 (28:20-26); Ex.1006 ¶ 206 (“A POSITA would understand those disclosures as disclosing or suggesting **tracking the custom email sent to each of the at least one email target.**”). Thus, Calloway and a POSITA’s general knowledge disclose or suggest claim 1g. Ex.1006 ¶¶ 206-207.

2. Claim 2

Claim 2 is substantially similar to claim 1b, merely requiring the **email target database be generated.** *Id.* ¶ 208.

Calloway likewise discloses that client-provided “recipient databases . . . may contain errors, and data issues should be resolved prior to using the data within the campaign.” Ex.1003 (31:10-13). Thus, “[t]he preferred embodiment of the invention comprises routines that are capable of operating on the recipient database to minimize the errors and to resolve data issues.” *Id.* (31:13-16); *see also id.* (39:4-6) (claiming “a clean up routine for selective clean

up of a recipient database by removing errors and unwanted redundancies”). A POSITA would understand Calloway teaching to **generate** a final recipient database (without errors) from an existing one (with errors). Ex.1006 ¶ 209.

Similarly, Calloway’s recipient database includes individualized “information about the recipient.” Ex.1003 (5:1-3). A POSITA would have generally understood that using such a database presupposes that the database was **generated**. Ex.1006 ¶ 210. A POSITA would have been motivated to modify Calloway to include the **generate** step at least because it is required for the invention to operate. *Id.*

Moreover, Nagda discloses “customer records in the first **database** [that] are **generated** by a human operator” and “[an] automated creation and delivery system to **generate** customer records in a **database**.” Ex.1005 (2:6-17). In some embodiments of Nagda, the customer records include **email targets**. *See id.* (4:40-43) (disclosing that the customer record includes “information for the delivery method, e.g., e-mail address”); Ex.1006 ¶ 211.

Therefore, Calloway, Nagda, and a POSITA’s general knowledge disclose or suggest claim 2. Ex.1006 ¶¶ 208-212.

3. Claim 3

a) Claim [3a]

Calloway similarly discloses a “five step process to ensure the quality of recipient information and email addresses,” starting with “1. Import raw customer list into a table.” Ex.1003 (31:23-26). A POSITA would understand that Calloway’s “raw customer list” is a “raw document.” Ex.1006 ¶ 213. Thus, Calloway and a POSITA’s general knowledge disclose or suggest claim 3a. *Id.* ¶¶ 213-214.

b) Claim [3b]

As discussed, Calloway discloses or suggests claim 3a’s **collecting at least one raw document**. *See supra* X(B)(3)(a). A POSITA would have known that **raw documents** must be **parsed** to use their information—*e.g.*, to “[i]mport raw customer list into a table.” Ex.1006 ¶ 215. Thus, Calloway and a POSITA’s general knowledge disclose or suggest claim 3b. *Id.*

c) Claim [3c]

Claim 3c provides a specific method for **generating the email target database** of claim 2 by using **raw documents**. *Id.* ¶ 216.

Calloway discloses a “content management subsystem that is responsible for performing the processes relating to access, organizing, and distributing data.” Ex.1003 (15:44-46). One of its “primary capabilit[ies],” Calloway discloses, “is

that of uploading groups of files using a simple Graphical User Interface (GUI).” *Id.* (16:39-41); *see also id.* (16:57-61) (disclosing that “a client-user may access an upload screen . . . to upload data . . . from the client database to the system for use in developing their campaign”). And “[o]nce uploaded to the server, the files are **categorized** in the SQL database and relevant information about the file is logged.” *Id.* (16:43-45). Given claim 3c’s context and Calloway’s disclosures, a POSITA would thus understand that **categorizing** files within Calloway’s SQL database discloses **categorizing the parsed at least one document**. Ex.1006 ¶ 216.

Calloway further discloses that “situations can arise in which the client database and the multimedia messaging system are incompatible and not capable of being directly interfaced with one another.” Ex.1003 (21:15-17). In those situations, Calloway teaches using an “intermediary application” that is “unique for each client” to “provide[] an interface”—*i.e.*, allowing for “data integration, on-the-fly *data capture*,” and other functionality. *Id.* (21:21-24) (emphasis added). A POSITA would understand from these disclosures that Calloway discloses or suggests **categorizing said parsed at least one document into at least one category**. Ex.1006 ¶ 216.

Thus, Calloway and a POSITA’s general knowledge disclose or suggest claim 3c. *Id.* ¶¶ 216-217.

d) Claim [3d]

Calloway discloses that “files” are “uploaded to the server,” and then “categorized in the SQL database.” Ex.1003 (16:43-45). And as discussed in claim 3c, Calloway’s unique interface applications enable “data integration.” *See id.* (21:10-24). A POSITA would understand from these disclosures that Calloway discloses or suggests **inserting said at least one document into a database**. Ex.1006 ¶ 218.

A POSITA would have also generally known that **inserting a document into a database** is required to later retrieve it. *Id.* Thus, a POSITA would have also been motivated to modify that reference to include claim 3d to enable later access of **parsed documents** through Calloway’s recipient database. *Id.*

Thus, Calloway and a POSITA’s general knowledge disclose or suggest claim 3d. *Id.* ¶¶ 218-219.

e) Claim [3e]

Calloway similarly discloses using “routines that are capable of operating on the recipient database to minimize . . . errors and to resolve data issues.” Ex.1003 (31:14-16). Calloway further discloses in Table 2 an example of a raw customer list. *Id.* (37:39-58). The highlighted lines indicate **duplicate email addresses** within the raw customer list. *Id.*; *see also id.* (31:58-59) (“Are records 1, 2, and 3 all duplicates?”). Calloway’s routine also determines “[s]hould the **duplicate[s]** be eliminated?” *Id.* (31:58). Thus, Calloway discloses or suggests claim 3e. Ex.1006 ¶¶ 220-221.

4. Claim 4

Claim 4 differs from claim 1 in how the **email target database** is provided: claim 1 requires **receiving** it, while claim 4 requires **requesting it according to a structured query language**. *Id.* ¶ 222.

TABLE 2				
Example of Data Quality Processing				
Part A				
	Name	Address	City	ST
1	John Smith	124 Oak St. #15	Los Angeles	CA
2	Smith John	124 Oak Ave.	Hollywood	
3	Lisa Smith	124 Oak #15		CA
4	Yakima Canute	124 Oak #10	Los Angeles	CA
5	John Smith	124 Oak St.	Hollywood	WI
Part B				
	email #1	email #2	Acct #	Phone
1	john@yahoo.com	John@dino.com	6001	3103491111
2	john@yahoo.com		6001	8185551717
3	john@yahoo.com	lisa@yahoo.com	6006	3105551234
4		yakima@my.com	8001	
5	johnsm@yahoo.com		7501	7155552223

Calloway discloses that “[t]he core of the email campaigns” are “**databases.**” Ex.1003 (20:56-57). “The preferred database access method” for Calloway “is **structured query language (SQL).**” *Id.* (20:57-58). Calloway further discloses that its “system is required to interface with the recipient **databases** of various clients.” *Id.* (31:10-11). Because Calloway requires interfacing with a client’s recipient **database** as the core of its email campaigns, and because the preferred database access method is using **structured query language**, a POSITA would understand that Calloway discloses or suggests **requesting an email target database according to a structured query language statement.** Ex.1006 ¶ 223.

Thus, Calloway and a POSITA’s general knowledge disclose or suggest claim 4. *Id.* ¶¶ 222-224.

5. Claim 5

Claim 5 differs from claim 1 in how the **email target database** is provided: claim 1 merely requires **receiving** it, while claim 5 requires **receiving it from a database vendor.** *Id.* ¶ 225.

Calloway discloses that “[t]he customer specific information used to drive the customization may be extracted from client **databases**, or alternately from third party **databases.**” Ex.1003 (2:56-58); *see also id.* (4:65-67 (“The list of recipients to which the messages are to be directed is contained within a recipient **database**

that may be supplied by a client, or a third party.”). A POSITA would understand that a recipient **database** supplied by a third party includes **an email target database from a database vendor**. Ex.1006 ¶ 226. Thus, Calloway and a POSITA’s general knowledge disclose or suggest claim 5. *Id.* ¶¶ 225-227.

6. Claim 6

a) Claim [6a]

Calloway discloses that “a link to a unique URL is embedded in a template” used for an email campaign. *See* Ex.1003 (24:2-5); *see also id.* (23:13-15) (“The client is provided with the ability to create the unique URL links associated with recipient.”). A POSITA would understand that embedding a unique URL in the template of an email used for an email campaign discloses **generating a custom uniform resource locator address**. Ex.1006 ¶¶ 228. Thus, Calloway and a POSITA’s general knowledge disclose or suggest claim 6a. *Id.* ¶¶ 228-229.

b) Claim [6b]

Calloway and Nagda disclose or suggest claim 1e’s **generating a configuration file to contain data related to each of the at least one email target, wherein the data is insertable in the generated message template**. *See supra* X(B)(1)(e). Calloway discloses “a link to a unique URL”—*i.e.*, the **custom uniform resource locator addresses**—to be “embedded in a template.” Ex.1003 (24:2-5); *see supra* X(B)(6)(a). Nagda discloses or suggests **configuration files**

that contain content customized based on customer information. *See supra* X(A)(1)(e). A POSITA would thus understand that Calloway's **custom uniform resource locator addresses** should be **inserted** into Nagda's **configuration files**. Ex.1006 ¶ 230. Thus, Calloway, Nagda, and a POSITA's general knowledge disclose or suggest claim 6b. *Id.* ¶¶ 230-231.

7. Claim 9

As discussed, claim 9 varies how the **custom email** is **formed**, requiring it to be formed directly **from the generated text message template and the generated configuration file**. *See supra* X(A)(7); Ex.1006 ¶ 232.

Calloway discloses "alternate templates" depending on the capabilities of a client's "email system," and whether it "support[s] embedding of multimedia content." Ex.1003 (24:1-3). When such support is lacking, Calloway discloses simply embedding "a link to a unique URL" directly "in the **template**." *Id.* (24:4-5). A POSITA would understand that emails formed by embedding a unique URL from a **configuration file**, *see supra* X(B)(1)(e), directly into a **message template**, *see supra* X(B)(1)(d), forms the email without use of an **email campaign template**, Ex.1006 ¶ 233.

Even if Calloway did not disclose or suggest claim 9, a POSITA would have understood that Nagda discloses or suggests creating a **custom email** directly from a **message template** and **configuration file** without first forming an intermediary

email campaign template. *Id.* ¶ 234. Nagda discloses or suggests combining a **message template** and data structure containing customer data (or **configuration file**) in an “output constructor” which, “[a]fter generating **direct** marketing material comprised of the populated template . . . may then direct the marketing material . . . to the customer via email.” Ex.1005 (3:12-25). No intermediate **email campaign template** is required. Ex.1006 ¶ 234.

Thus, Calloway, Nagda, and a POSITA’s general knowledge disclose or suggest claim 9. *Id.* ¶¶ 232-235.

8. Claim 10

a) Claim [10a]

As discussed, Claim 10a limits claim 1g’s **tracking** limitation. *See supra* X(A)(8)(a). Calloway discloses “campaign tracking” generally, Ex.1003 (15:41), and many embodiments of it specifically, for example, like the “number of recipients opening the message,” “interaction time of recipient (average, range),” and “click history within the message.” *Id.* (28:20-26). A POSITA would understand that Calloway’s campaign tracking, as well as its specific embodiments, all disclose or suggest **receiving at least one response from the at least one email target.** Ex.1006 ¶¶ 236-237.

Calloway likewise discloses an “unsubscribe” feature, requiring that “the unsubscribe **response** is logged upon receipt.” Ex.1003 (26:44-45). Calloway’s

“normal campaign reporting mechanisms preferably include reports of the number and percentage of [unsubscribe **responses**].” *See id.* (24:45-49). A POSITA would also understand Calloway’s unsubscribe feature as **receiving at least one response from the at least one email target**. Ex.1006 ¶ 237.

A POSITA would have also generally known that **tracking** an email campaign includes **receiving at least one response from the at least one email target**. *Id.* ¶ 238. Because Calloway discloses such **tracking**, *see supra* X(B)(1)(g), a POSITA would have been motivated to use standard techniques to modify each reference to arrive at claim 10a, Ex.1006 ¶ 238.

Thus, Calloway and a POSITA’s general knowledge disclose or suggest claim 10a. *Id.* ¶¶ 236-239.

b) Claim [10b]

Calloway discloses “creat[ing] a ‘non-participant’ table of parties that are not to be included in future campaigns” as “unsubscribe response[s] [are] logged.” Ex.1003 (26:44-47). Calloway likewise discloses “reports wherein clients can view the results of a **campaign** while it is underway.” *Id.* (28:13-15). Those reports are **created** from the **responses received** from Calloway’s “**campaign tracking**.” *See, e.g., id.* (15:37-41) (“Statistics and information collected when recipients access the link is utilized within the reporting subsystem 34 which provides campaign

information for client billing, sponsor analysis, and **campaign tracking.**”); *supra* X(B)(8)(a).

A POSITA would have also generally understood **creating a campaign tracking list from said received at least one response.** Ex.1006 ¶ 241. Such techniques were well known in the art. Thus even if Calloway did not disclose or suggest claim 10b, a POSITA would have been motivated to modify them to include claim 10b at least because Calloway discloses or suggests claim 10a, **receiving at least one response from the at least one email target.** *Id.* ¶ 241.

Thus, Calloway and a POSITA’s general knowledge disclose or suggest claim 10b. *Id.* ¶¶ 240-242.

9. Claim 11

a) Claim [11a]

As discussed, claim 11a further limits claim 10b’s **creating a campaign tracking list.** *See supra* X(A)(9)(a); Ex.1006 ¶ 243. Calloway discloses that its reports “provide information” regarding the “number [of recipients] that access the playback site (if not automatically activated)” and “click-throughs to site.” Ex.1003 (28:18-26). A POSITA would understand that reports providing information on a recipient’s post-email access to a playback site and click-through to site discloses **determining a number of successful visits from the at least one**

email target. Ex.1006 ¶ 244. Thus, Calloway and a POSITA's general knowledge disclose or suggest claim 11a. *Id.* ¶¶ 243-245.

b) Claim [11b]

As discussed, claim 11b further limits claim 10b's **creating a campaign tracking list**. *See supra* X(A)(9)(b); Ex.1006 ¶ 246. Calloway discloses that “[d]elivery and interactivity statistics are logged in a reporting subsystem 34 and the results may be made available.” Ex.1003 (12:32-33). A POSITA would understand that Calloway's delivery statistics disclose or suggest **determining a number of the custom email sent to the at least one email target that were undeliverable**. Ex.1006 ¶ 247. Thus, Calloway and a POSITA's general knowledge disclose or suggest claim 11b. *Id.* ¶¶ 246-248.

c) Claim [11c]

As discussed, claim 11c claim 10b's **creating a campaign tracking list**. *See supra* X(A)(9)(c); Ex.1006 ¶ 249. Calloway discloses an “unsubscribe” feature, requiring that “the unsubscribe response is logged upon receipt.” Ex.1003 (26:44-45). Calloway's “normal campaign reporting mechanisms preferably include reports of the number and percentage of [unsubscribe responses].” *See id.* (24:45-49). A POSITA would also understand Calloway's unsubscribe feature and normal campaign reporting mechanisms disclose **determining a number of the at least**

one email target that requested deletion. Ex.1006 ¶ 250. Thus, Calloway and a POSITA's general knowledge disclose or suggest claim 11c. *Id.* ¶¶ 249-251.

10. Claim 12

For the same reasons claim 12 is disclosed or suggested by claim 1 in the context of ground 1, claim 12 is also disclosed or suggested by claim 1 in the context of ground 2 by Calloway, Nagda, and a POSITA's general knowledge. *See supra* X(A)(10); Ex.1006 ¶ 252. Claim 12 is also disclosed or suggested by Calloway, Nagda, and a POSITA's general knowledge for the reasons below.

a) Claim [12a]

Claim 12 is substantially similar to claim 1. Claim 12 mainly differs in reciting **a system**, rather than claim 1's **a method**. Ex.1006 ¶ 161 (comparing claims 1 and 12 side by side). Calloway discloses or suggests **an email campaign**. *Id.* ¶ 253; *see supra* X(B)(1)(a). Calloway, Nagda, and a POSITA's general knowledge also disclose or suggest **generating** or **tracking an email campaign**. Ex.1006 ¶ 253; *see infra* X(B)(10)(b)-(f). Thus, to the extent claim 12a (claim 12's preamble) is limiting, Calloway, Nagda, and a POSITA's general knowledge disclose or suggest it. Ex.1006 ¶¶ 253-254.

b) Claim [12b]

Calloway discloses a “multimedia engine,” which “is a collection of processes, applications and rules which, operating collectively, create the

individualized messages.” Ex.1003 (22:29-30). Calloway includes in its “capabilities/features” an “HTML email **template** builder.” *Id.* (9:34-36). The multimedia engine also “imports” the “data” from a recipient **database**. *Id.* (22:63-66). Calloway’s recipient **database** includes “[t]he list of recipients to which the messages are to be directed is contained within a recipient **database** that may be supplied by the client, or a third party” and “various information about the recipient which may be utilized in the process of individualizing a message to that specific recipient.” *Id.* (3:65-4:4). A POSITA would thus understand that Calloway’s multimedia engine discloses **an email campaign generator that generates an email campaign template from an email target database, wherein said email target database comprises a plurality of email targets**. Ex.1006 ¶ 255. Thus, Calloway and a POSITA’s general knowledge disclose or suggest claim 12b. *Id.* ¶¶ 255-256.

c) Claim [12c]

Calloway discloses a “multimedia engine,” which “is a collection of processes, applications and rules which, operating collectively, create the individualized messages.” Ex.1003 (22:29-30). It “combin[es] the email recipient information . . . with existing email **templates**.” *Id.* (22:31-33). A POSITA would thus understand that Calloway’s multimedia engine discloses **an email campaign engine that generates a custom email corresponding to each of said plurality**

of email targets, wherein said custom email is formed from said email campaign template. Ex.1006 ¶ 257.

Calloway also discloses that its multimedia engine “**emails** the message” once it has been formed. Ex.1003 (22:63-66). A POSITA would thus understand that Calloway’s multimedia engine also discloses **an email campaign engine, wherein said email campaign engine sends said custom email to each of said plurality of email targets.** Ex.1006 ¶ 258. Thus, Calloway and a POSITA’s general knowledge disclose or suggest claim 12c. *Id.* ¶¶ 257-259.

d) Claim [12d]

Calloway discloses a “reporting and **tracking** subsystem.” Ex.1003 (10:14). It “provides . . . varying degrees of reporting and **tracking** capability,” like “monitoring [an] ad campaign while it is in progress.” *Id.* (10:14-20). To monitor ad campaigns the reporting and **tracking** subsystem collects “[s]tatistics and information,” including “when recipients access [a] link,” *id.* (15:37-41), the “number of recipients opening the message” or “sending [it] to another party,” Ex.1003 (28:20-23), and “logg[ing]” any “unsubscribe **response[s]**,” *id.* (26:44-47). A POSITA would thus understand that Calloway’s reporting and tracking subsystem discloses **a campaign tracker that receives a response corresponding to said sent custom email.** Ex.1006 ¶ 260.

Calloway also discloses that its reporting and tracking subsystem can “create a ‘non-participant’ table that are not to be included in future campaigns,” Ex.1003 (26:46-48), and “reports wherein clients can view the results of a **campaign** while it is underway,” *id.* (28:13-15). A POSITA would thus understand Calloway’s reporting and tracking subsystem also discloses **a campaign tracker, wherein said campaign tracker creates a campaign tracking list that includes said received response.** Ex.1006 ¶ 261. Thus, Calloway and a POSITA’s general knowledge disclose or suggest claim 12d. *Id.* ¶¶ 260-262.

e) Claim [12e]

Calloway’s multimedia engine discloses or suggests generating an **email campaign template.** *See supra* X(B)(10)(b). And Calloway likewise discloses or suggests **said email campaign template comprises a text message** for the same reasons it discloses or suggests claim 1d, **generating a message template.** *See supra* X(B)(1)(d); *see also* Ex.1003 at Abstract (“Multimedia elements may be variously combined within an individualized message containing . . . text . . .”). Thus, a POSITA would understand that Calloway discloses or suggests claim 12e. Ex.1006 ¶¶ 263-264.

f) Claim [12f]

Calloway's multimedia engine discloses or suggests generating an **email campaign template**. *See supra* X(B)(10)(b). Calloway and Nagda likewise disclose or suggest that **email campaign template** is comprised of a **configuration file that includes data from said email target database corresponding to each of said plurality of email targets** for the same reasons they disclose or suggest claim 1e, **generating a configuration file to contain data related to each of the at least one email target, wherein the data is insertable in the generated message template**. *See supra* X(B)(1)(e); *see also* Ex.1003 (23:7-8) (“[A] multimedia engine provided protocol[] **inserts** the data into the required **template**”). Thus, Calloway, Nagda, and a POSITA's general knowledge disclose or suggest claim 12f. Ex.1006 ¶¶ 265-267.

11. Claim 13

Calloway, Nagda, and a POSITA's general knowledge disclose or suggest **the system of claim 12**. *See supra* X(B)(10). Calloway's "multimedia engine, using an existing code library is capable of combining the email recipient information, as provided by a client, with existing email message templates." Ex.1003 (22:30-33). Those message templates include claim 13's **text message**. *See supra* X(B)(1)(d), (10)(e). A POSITA would understand that forming **custom emails** from **said text message** would be accomplished by **making a copy of said**

text message. Ex.1006 ¶ 268. Thus a **custom email** could be **generated** without having to mutate Calloway’s underlying data—*i.e.*, the email recipient information or the email message templates themselves. *Id.* ¶ 268. A POSITA would be motivated to make that modification to Calloway because data immutability has many benefits, including promoting data/code reusability and reducing the incidents of errors. *Id.* Thus, Calloway, Nagda, and a POSITA’s general knowledge disclose or suggest claim 13. *Id.* ¶¶ 268-269.

12. Claim 14

Calloway, Nagda, and a POSITA’s general knowledge disclose or suggest **the system of claim 13.** *See supra* X(B)(11). Calloway also discloses inserting (replacing) **custom tags with a corresponding portion of said configuration file.** *See supra* X(B)(1)(d)-(e).; *see also* Ex.1003 (23:6-8) (teaching “access[ing] the requisite data” to it can be later “insert[ed] . . . into the required template”). Thus, Calloway, Nagda, and a POSITA’s general knowledge disclose or suggest claim 14. Ex.1006 ¶¶ 270-271.

13. Claim 15

Calloway, Nagda, and a POSITA’s general knowledge disclose **the system of claim 12.** *See supra* X(B)(10). Calloway also discloses that its multimedia engine “create[s] the individualized messages” in an email campaign. Ex.1003 (22:27-29). That includes “assembl[ing] a unique URL link to provide for click-

back.” *Id.* (22:37-38). Thus, a POSITA would have understood that Calloway’s multimedia component discloses **creating a custom uniform resource locator address for each of said plurality of email targets, wherein said configuration file includes said custom uniform resource locator address in said data.** Ex.1006 ¶ 272. Thus, Calloway, Nagda, and a POSITA’s general knowledge disclose or suggest claim 15. *Id.* ¶¶ 272-273.

C. Ground 3: Claims 7-8 and 16-17 are obvious over Calloway in view of Lerner.

Every limitation of claims 7-8 and 16-17 are disclosed or suggested by Calloway, Lerner, and a POSITA’s general knowledge. *See infra* X(C)(1)-(4); Ex.1006 ¶ 274. Thus a POSITA would have had a reasonable expectation of success in making the claimed invention using well-known, standard techniques. Ex.1006 ¶ 275. Calloway also discloses that “clients can view the results of a campaign while it is underway.” Ex.1003 (28:14-15). A POSITA would have known that Lerner’s disclosure of a “URL content hash,” Ex.1004 (5:12-14), would have enabled more-effective “‘custom’ report[s]” that “by [their] nature [are] driven by a specialized client need,” which Calloway discloses, Ex.1003 (28:60-61); Ex.1006 ¶ 276. Thus a POSITA would have been motivated to combine Lerner with Calloway. Ex.1006 ¶¶ 276-277. A POSITA would have likewise been motivated to combine Calloway with Lerner and general knowledge

of email campaigns and tracking to arrive at a more “effective” and “efficient way to create and track a email campaign [*sic*].” Ex.1001 (1:33, 1:43-44). Thus claims 7-8 and 16-17 are obvious over Calloway in view of Lerner and a POSITA’s knowledge. Ex.1006 ¶ 278.

1. Claim 7

a) [7a] “The method of claim 6, wherein step (i) comprises the steps of: (A) generating a hash from a campaign ID, a message template version ID, a user reference ID, and a private key, for each of the at least one email target; and”

Calloway discloses or suggests **the method of claim 6**. *See supra* X(B)(6). It also discloses that, “[p]referably,” a recipient’s “URL is made unique by the inclusion of a unique user ID.” Ex.1003 (24:6-7). A POSITA would understand this as disclosing or suggesting claim 7a’s **user reference ID**. Ex.1006 ¶ 279. Calloway claims a “content management routine” that “comprises version control.” Ex.1003 (42:20-21). A POSITA would understand this as disclosing or suggesting claim 7a’s **campaign ID** and **message template version ID**. Ex.1006 ¶ 279. Calloway also discloses that “[a]ll activities within [its] system are password protected.” Ex.1003 (17:66-67). A POSITA would understand this as disclosing or suggesting claim 7a’s **private key**. Ex.1006 ¶ 279; *see also* Ex.1001 (6:2-4) (“Private key 670 is a private key or password unique to the email campaign host, as would be understood by persons skilled in the relevant art(s) from the teachings

herein.”). Thus Calloway discloses or suggests all claim 7a’s elements, save for **generating a hash**. Ex.1006 ¶ 279.

Lerner discloses a “URL content **hash**” that “contains an integer value that results from the execution of standard **hash** function on the contents of the [Web-based document].” Ex.1004 (5:12-14); *see also id.* (14:64-66) (disclosing software that “**generates** [an] address by executing a standard **hash** function on the contents of the annotated [Web-based document]”). A POSITA would thus understand that Lerner discloses or suggests claim 7a’s **generating a hash**. Ex.1006 ¶ 280. A POSITA would have understood that Lerner’s standard hash function could be used to **generate a hash** from all four pieces of information Calloway discloses or suggests—a **campaign ID**, a **message template version ID**, a **user reference ID**, and a **private key**. *Id.* ¶ 281.

Generating a hash from multiple values was also generally known and commonly used by POSITAs. *Id.* “Hashing is the process of transforming any given key or a string of characters into another value.” Andrew Zola, *Definition: Hashing*, TECHTARGET (June 2021), techtarget.com/searchdatamanagement/definition/hashing. That value is “usually represented by a shorter, fixed-length value or key that represents and makes it easier to find or employ the original string.” *Id.* And the technique has been around since at least the 1950s. *See* Katlyn Gallo, *What is Hashing? A Guide with Examples*, BuiltIn,

builtin.com/cybersecurity/what-is-hashing (July 26, 2023) (“The idea of hashing was introduced in the early 1950s by an IBM researcher, Hans Peter Luhn. Although Luhn didn’t invent today’s algorithms, his work ultimately led to the first forms of hashing.”).

A least because Calloway requires that “clients can view the results of a campaign while it is underway,” Ex.1003 (28:14-15), a POSITA would have been motivated to combine Lerner with Calloway to arrive at claim 7a, Ex.1006 ¶ 282. A POSITA would have known that claim 7a’s **hash** would have supported more-granular, “‘custom’ report[s]” that “by [their] nature [are] driven by a specialized client need.” Ex.1003 (28:60-61); Ex.1006 ¶ 282. A POSITA would have had a reasonable expectation of success in making the combination because, as Lerner explains, a **hash** could be generated based on a web-page’s “contents” and “executing a standard hash function.” Ex.1004 (14:64-66); Ex.1006 ¶ 282.

Thus, Calloway, Lerner, and a POSITA’s general knowledge disclose or suggest claim 7a. Ex.1006 ¶¶ 279-283.

b) [7b] “(B) appending a first portion of the generated hash for each of the at least one email target to a host web address to form the custom uniform resource locator address for each of the at least one email target.”

As discussed, Calloway discloses or suggests including a **custom uniform resource locator address for each of the at least one email target**. *See supra* X(B)(6). That **custom resource locator address** would be understood by a POSITA as being unique to each **email**. Ex.1006 ¶ 284; *see also* Ex.1003 (4:37-38) (“[A] unique URL can be embedded within the email message”).

POSITAs commonly create unique or custom URLs through hashing. A unique string or a unique signature is created. Then it is **appended** as a **hash** to some known value to create the unique or custom URLs. Ex.1006 ¶ 285; *see also* Gallo, *supra* (noting that hashing has been known since the 1950s and “has many uses”). In other words, hashing is a very common and well known area in email and secure communications. A POSITA would be fully aware of a hash and how it works. Ex.1006 ¶ 285.

Thus, a POSITA would have generally known claim 7b. *Id.* ¶¶ 284-86.

2. Claim 8

a) [8a] “The method of claim 7, wherein the host web address is equal to: hostname/module?token”

Calloway and Lerner disclose or suggest **the method of claim 7**. *See supra* X(C)(1). Calloway, Lerner, and a POSITA’s general knowledge likewise disclose or suggest a **host web address that is equal to: hostname/module?token**. *See infra* X(C)(2)(b)-(d). Thus, Calloway, Lerner, and a POSITA’s general knowledge disclose or suggest claim 8a to the extent it is limiting at all. Ex.1006 ¶¶ 287-288.

b) [8b] “where hostname is replaced with an email campaign host Internet address,”

A POSITA would understand that claim 8b merely recites the URL standard for a **hostname**. *Id.* ¶ 289. A URL’s **hostname** property contains the URL’s domain name. *Id.* ¶ 289; *see also* Ex.1001 (6:23-24) (explaining that “‘**hostname**’ may be replaced by any addressable **Internet address**, such as ‘www.icplanet.com’”). Thus a POSITA would have generally understood claim 8b. Ex.1006 ¶ 289.

Even if a POSITA had not, though, Calloway discloses or suggests it. *Id.* ¶ 290. Calloway discloses “a unique URL can be embedded within the email message to open a browser for displaying the individualized multimedia message.” Ex.1003 (4:38-39). A POSITA would thus understand that Calloway’s multimedia message’s unique URL includes its **hostname**. Ex.1006 ¶ 290.

Thus, Calloway and a POSITA's general knowledge disclose or suggest claim 8b. *Id.* ¶¶ 289-291.

c) [8c] “module is replaced with an identifier for software located at the email campaign host directed to processing the custom uniform resource locator address for each email target after it is selected, and”

A POSITA would understand that claim 8c merely recites the URL standard, with **module** claiming a URL's “path.” Ex.1006 ¶ 292. By definition, following a link will cause a browser to access the **software located** at the distal end of the URL path. *Id.* ¶ 292. Thus a POSITA would have generally understood claim 8c. *Id.*

Even if a POSITA had not, though, Calloway discloses or suggests claim 8c. *Id.* ¶ 293. Calloway discloses that its “content manager . . . creates the database and directory structures required by the multimedia engine to efficiently retrieve and process the rich media files used in an email campaign.” Ex.1003 (16:9-12); *see also* Ex.1003 (40:53-55) (“A system as recited in claim 22, wherein the content repository comprises a structured database having a directory hierarchy.”); Ex.1003 (44:27-30) (“A method as recited in claim 60, further comprising providing a database and directory structure for retrieving and processing multimedia files to be used in an email campaign.”). A POSITA would understand that Calloway's directory structures disclose or suggest claim 8c. Ex.1006 ¶ 293.

Thus, Calloway and a POSITA's general knowledge disclose or suggest claim 8c. *Id.* ¶¶ 292-294.

d) [8d] “token is replaced with any alphanumeric identifier for unique information related to the customized uniform resource locator address for each of the at least one email target.”

A POSITA would understand that claim 8d merely recites the URL standard, with **token** reciting a limited form of URL parameter. *Id.* ¶ 295; *see also* Ex.1001 (9:49-50) (explaining that a “token” is merely a “replaceable parameter[]”). A POSITA would have understood that URL parameters, like a **token**, merely pass additional information to a server as part of requesting the resource at the distal end of a URL. Ex.1006 ¶ 295. And claim 7's generating a **token** is disclosed or suggested by Calloway and Lerner. *See supra* X(C)(1).

Further, the idea of the web and having a URL or domain to access the website was invented in the 1990's. *See* Zack Bloom, *The History of the URL* (March 5, 2020), blog.cloudflare.com/the-history-of-the-url (“In 1992 Tim Berners-Lee created . . . the URL.”). During this time period, additional enhancements were developed to allow information to be added or appended to a URL. *See id.* (“If you've used the web for any period of time, you are familiar with query parameters. They follow the path portion of the URL, and encode options like ?name=zack&state=mi.”). Parameters could be used with the POST command

to customize a URL. Parameters could also be used with a unique ID, customizing each URL to the user in an effort to add state into the stateless HTTP protocol. Ex.1006 ¶ 295.

Indeed, HTTP was created to be stateless. As originally developed it could only access static documents. But this quickly proved limiting. So a method to add state was created so each user could be tracked. This was done by adding an alphanumeric identifier for each user into the URL, thus creating a customized uniform resource locator. *Id.*; *see also* Ex.1011 ¶ 3.3 (“An HTTP URL takes the form: `http://<host>:<port>/<path>?<searchpart>` where . . . <searchpart> is a query string.”). Claim 8d merely recites this known method of creating customized URLs, which was standard practice in the 1990s. Ex.1006 ¶ 295. A POSITA thus would have generally known claim 8d. *Id.* ¶¶ 295-296.

3. Claim 16

a) [16a] “The system of claim 15, wherein said custom uniform resource locator generator generates a hash from a campaign ID, a message template version ID, a user reference ID, and a private key, for each of said plurality of email targets,”

Calloway discloses or suggests **the system of claim 15**. *See supra* X(B)(13). The remainder of claim 16a is substantially similar to claim 7a and thus disclosed or suggested for the same reasons. *See supra* X(C)(1)(a); Ex.1006 ¶¶ 297-298.

b) [16b] “and appends at least a portion of the generated hash to a host web address to form said custom uniform resource locator address for each of said plurality of email targets.”

Claim 16b is disclosed or suggested for the same reasons as substantially similar claim 7b. *See supra* X(C)(1)(b); Ex.1006 ¶¶ 299-300.

4. Claim 17

a) [17a] “The system of claim 16, wherein said host web address is equal to: hostname/module?token”

Claim 17a is disclosed or suggested for the same reasons as substantially similar claim 8a. *See supra* X(C)(2)(a); Ex.1006 ¶¶ 301-302.

b) [17b] “where hostname is replaced with an email campaign host Internet address,”

Claims 17b is disclosed or suggested for the same reasons as substantially similar claim 8b. *See supra* X(C)(2)(b); Ex.1006 ¶¶ 303-304.

c) [17c] “module is replaced with an identifier for software located at the email campaign host directed to processing said custom uniform resource locator address for an email target after it is selected, and”

Claim 17c is disclosed or suggested for the same reasons as substantially similar claim 8c. *See supra* X(C)(2)(c); Ex.1006 ¶¶ 305-306.

d) [17d] “token is replaced with any alphanumeric identifier for unique information related to said custom uniform resource locator address for said email target.”

Claim 17d is disclosed or suggested for the same reasons as substantially similar claim 8d. *See supra* X(C)(2)(d); Ex.1006 ¶¶ 307-308.

XI. NO BASIS FOR DISCRETIONARY DENIAL

American respectfully submits that no basis exists under § 314(a) for discretionary denial. All relevant factors favor institution or, at the very least, are neutral. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (designated precedential May 5, 2020).

Factor 1 is neutral because neither party has requested a stay. *See, e.g., Sand Revolution II, LLC v. Continental Intermodal Grp.-Trucking LLC*, IPR2019-01393, Paper 24 at 7 (P.T.A.B. June 16, 2020) (informative).

Factor 2 weighs against discretionary denial because no trial date is scheduled in American’s suit against Advanced Transactions.

Factor 3 favors institution because the parties have expended limited resources in the litigations and American acted expeditiously—*i.e.*, by filing this petition within three months of the Complaint, well before the commencement of the of the *Markman* process, in the early stages of fact discovery, and before expert discovery. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 16-17 (P.T.A.B. Dec. 1, 2020) (precedential).

Factor 4 favors institution because American challenges all claims of the '555 patent, although Advanced Transactions is expected to assert only a subset in the litigation. American also stipulates that, if the Petition is instituted, American will not pursue in the District Court Litigation any ground raised or that could have been reasonably raised in an IPR. *Sotera Wireless*, Paper 12 at 18.

Factor 5 favors institution because Advanced Transactions has filed 7 different litigations against 17 different defendants since February 2022 asserting infringement of the '555 patent. Ex.1009 (Docket Navigator Report). Advanced Transactions sent a notice letter to American identifying different allegedly infringed patents and American filed a declaratory judgment action to try to resolve the dispute. Given Advanced Transactions's pattern of sending notice letters, filing litigations, and reaching early settlements (with 17 defendants so far), its campaign is likely to continue. Institution will promote judicial efficiency and integrity by reducing the number of issues to be addressed in numerous parallel litigations.

Factor 6 favors institution because American has set forth a strong case of unpatentability. *Sand Revolution*, Paper 24 at 13.

Further, the Director's interim procedure states that institution will not be denied based on the *Fintiv* factors "where a petition presents compelling evidence of unpatentability." Memorandum, Interim Procedure for Discretionary Denials in

Petition for *Inter Partes* Review of
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AIA Post-Grant Proceedings with Parallel District Court Litigation at 2 (USPTO
June 21, 2022); *CommScope Techs. LLC. v. Dali Wireless, Inc.*, IPR2022-01242,
Paper 23 (February 27, 2023) (precedential). Here because the petition presents a
compelling case that all claims are unpatentable, institution should not be denied.

XII. CONCLUSION

American respectfully requests institution of IPR and cancellation of the
Challenged Claims based on the grounds set forth and described above.

Dated: August 30, 2023

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE WITH WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), I certify that this petition complies with the type-volume limits of 37 C.F.R. § 42.24(a)(1)(i) because it contains 13,713 words, according to the word-processing system used to prepare this petition, excluding parts of this petition that are exempted by 37 C.F.R. § 42.24(a) (including the table of contents, a table of authorities, mandatory notices, a certificate of service or this certificate word count, appendix of exhibits, and claim listings).

Dated: August 30, 2023

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Petition for *Inter Partes* Review of
U.S. Patent No. 7,065,555 B2

CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. Sections 42.6 and 42.106, that a complete copy of the attached **PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 7,065,555 B2**, including all exhibits (**Nos. 1001-1011**) and related documents, are being served by USPS Priority Mail Express on 30th day of August, 2023, the same day as the filing of the above-identified document in the United States Patent and Trademark Office/Patent Trial and Appeal Board, upon Patent Owner by serving the correspondence address of record with the USPTO as follows:

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A courtesy copy was also sent via electronic mail to the Patent Owner's litigation counsel listed below:

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