

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WALT DISNEY PARKS AND RESORTS U.S., INC.,
Petitioner,

v.

AGILE JOURNEYS LLC,
Patent Owner.

IPR2024-00029
Patent 7,212,983 B2

Before MICHAEL L. WOODS, AMEE A. SHAH, and
JASON W. MELVIN, *Administrative Patent Judges*.

SHAH, *Administrative Patent Judge*.

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

I. INTRODUCTION

Walt Disney Parks and Resorts U.S., Inc. (“Petitioner”) filed a Petition per 35 U.S.C. §§ 311–319 for *inter partes* review of claims 1, 3–5, 7, 8, 10–14, and 16–25 (“the Challenged Claims”) of U.S. Patent No. 7,212,983 B2 (Ex. 1001, “the ’983 patent”). Paper 2 (“Pet.”). Agile Journeys LLC (“Patent Owner”) is identified as the owner of the ’983 patent. Paper 4. Patent Owner filed a preliminary response to the Petition. Paper 6 (“Prelim. Resp.”).

We have authority under 35 U.S.C. § 314. Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless the information presented in the Petition and any response thereto shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Moreover, a decision to institute under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018); *see also* 37 C.F.R. § 42.108(a) (2023) (“When instituting . . . review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.”). The Board determines whether to institute a trial on behalf of the Director. 37 C.F.R. § 42.4(a).

Considering the Petition, the Preliminary Response, and the evidence of record, for the reasons set forth below, we determine that, at this stage based on the evidence presented, Petitioner has demonstrated that there is a reasonable likelihood that at least one of the Challenged Claims is unpatentable. Accordingly, we institute an *inter partes* review of all challenged claims and on all grounds asserted in the Petition. *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018) (stating that

a decision to institute is “a simple yes-or-no institution choice respecting a petition, embracing all challenges included in the petition”).

Our factual findings and conclusions at this stage of the proceeding are based on the evidentiary record developed thus far. This is not a final decision as to patentability of claims for which *inter partes* review is instituted. Any final decision will be based on the record, as fully developed during trial.

II. BACKGROUND

A. RELATED MATTERS

Petitioner states that the '983 patent is the subject of the following civil action: *Agile Journeys LLC v. The Walt Disney Company and Walt Disney Parks and Resorts U.S., Inc.*, Case No. 6:22-cv-02272 (M.D. Fla.), filed December 2, 2022. Pet. 4. Patent Owner Petitioner makes the same statement. Paper 4, 2.

B. REAL PARTIES-IN-INTEREST

Petitioner identifies “Walt Disney Parks and Resorts U.S., Inc., the Walt Disney Company, TWDC Enterprises 18 Corp., and Disney Corp Srvcs Co, LLC.” as the real parties in interest. Pet. 4. Patent Owner identifies “Agile Journeys LLC” as “the real party in interest,” and asserts that “Agile is the owner and assignee of all right, title and interest in and to U.S. Pat. No. 7,212,983.” Paper 4, 2.

C. OVERVIEW OF THE '983 PATENT

The '983 patent is titled “METHOD AND APPARATUS FOR PROVIDING VISITORS WITH A PERSONALIZED ITINERARY AND MANAGED ACCESS TO ATTRACTIONS,” and issued on May 1, 2007,

from U.S. Patent Application No. 09/858,376. Ex. 1001, codes (21), (45), (54).

The '983 patent “relates generally to a system for creating a personalized itinerary, and in particular, a system to create a personalized itinerary for visitors to a facility, such as a zoo, theme park, historic area, or shopping district.” Ex. 1001, 1:8–11. More specifically, “the invention relates to a system for creating a personalized itinerary for visitors to a facility that provides managed access to attractions at the facility.” *Id.* at 1:12–14.

As background, the '983 patent describes that “[a] tourist wants to see and do the most interesting things available, with a minimum of inconvenience.” Ex. 1001, 1:32–33. A facility having numerous attractions, such as “[i]ndividual rides, restaurants, exhibits, stores, shows, etc.[,] . . . commonly provides collateral materials such as maps and show schedules.” *Id.* at 1:42–47. The amount of information in these collateral materials “frequently amounts to information overload,” particularly for visitors visiting the facility for the first time, are “outside the primary marketing region of the facility,” are unfamiliar with the facility’s attractions, and/or have a language difference or barrier. *Id.* at 1:52–58.

The '983 patent describes prior art systems and methods of guided and self-guided tours, queue management, and itinerary generation/route planning, and describes the disadvantages of each system. Ex. 1001, 1:59–5:10. The '983 patent summarizes six (6) “Needs Unsatisfied by Prior Art:” of a tool, method, or system that understands and considers the interests, tastes, needs, limitations, “spatial and temporal situation,” and familiarity of a party of visitors and facility to create an appropriate and personalized itinerary and a viable set of reservations and that redistribute,

moderate, and diffuse demand in a facility. Ex. 1001, 5:49–6:4. The ’983 patent thus relates to “a system and method for creating a personalized itinerary for visitors to a facility, such as a Zoo, theme park, historic area, or shopping district” and “a system and method that provides managed access to attractions at the facility.” *Id.* at 6:11–15. One object of the invention is to “make it possible for visitors unfamiliar with a facility to make meaningful use of a queue management system” that would “normally require the user to enter or select explicitly each attraction that they would like to visit” to use to the invention’s system “to create meaningful, satisfying itineraries.” *Id.* at 8:65–9:6.

The ’983 patent defines certain terms. “A party consists of one or more visitors operating as a coherent group for the purpose of the itinerary,” that when arriving at a facility, receives a “single portable computer 100.” Ex. 1001, 11:1–4. A “facility” is “an entity having a collection of attractions that is visited by parties seeking to experience those attractions,” such as a theme park, shopping district, park, zoo, or historic area. *Id.* at 10:59–63. An “attraction” includes “rides, shows, shops, restaurants, tours, trails, presentations, displays, viewpoints, picnic sites, and other specific features that are to be experienced by the facility’s visitors.” *Id.* at 10:34–37. An “itinerary” is “comprised of events.” *Id.* at 7:31; 14:5–6. An “event” is “a visit to an attraction at a scheduled time. This is not necessarily a reservation, though it can be. It is a time at which the party is recommended to visit an attraction.” *Id.* at 7:31–34; 14:4–5.

Figure 1, reproduced below, illustrates a portable computer 100 for gathering information about a party, in accordance with the ’983 invention. *Id.* at 9:65–67.

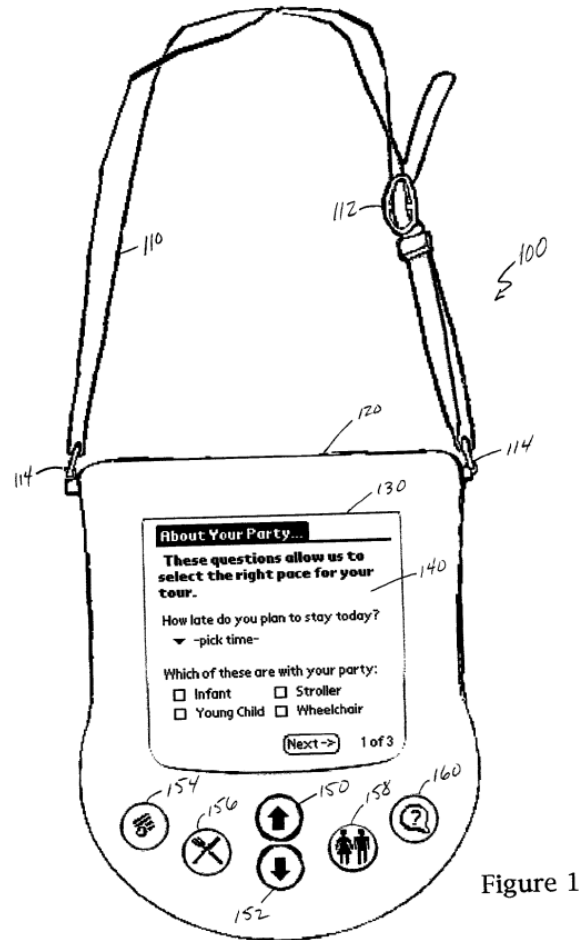
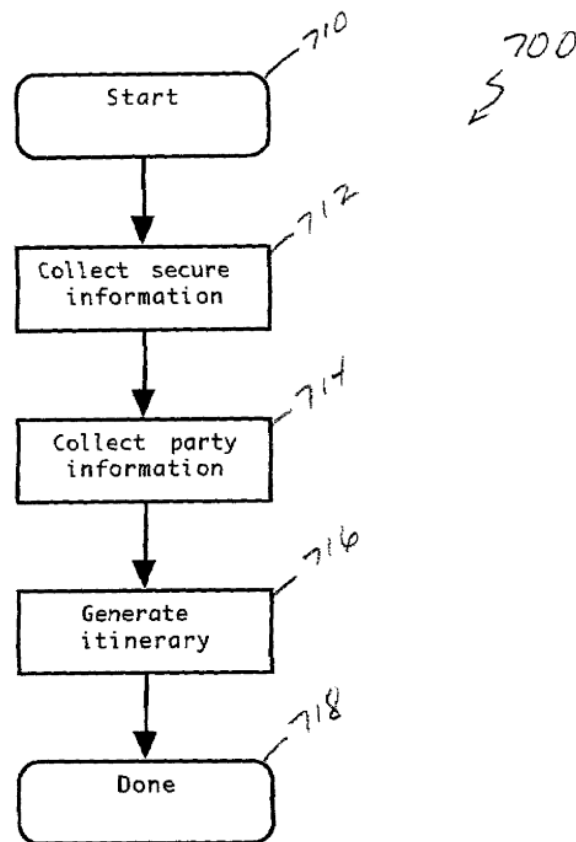


Figure 1

Figure 1 illustrates a portable computer 100 having a display screen 130 that is overlaid by a transparent, touch sensitive input surface for “asking questions of and providing information to the party” and “to present various forms for gathering or displaying information.” Ex. 1001, 11:8–11; 11:33–34. An itinerary button 154 calls up the party’s current itinerary. *Id.* at 11:15–32. A dining button 156 calls up a dialog concerning dining activities. *Id.* at 11:18–19. A restroom button 158 calls up information concerning restrooms. *Id.* at 11:19–21. “An information button 160 calls up other miscellaneous information such as facility operating hours, maps, database access, shopping information, etc.” *Id.* at 11:21–24.

Figure 7, reproduced below, is a flowchart of basic steps involved in making an itinerary. Ex. 1001, 10:14–15.



“At the start, step 710, the portable computer [100] contains current information about the facility and its attractions.” Ex. 1001, 12:42–43. In steps 712 and 714, “data are collected which comprise the party’s profile.” *Id.* at 12:47–48. The “secure information” may comprise the party’s admission class, the party’s size, prepaid meals, special tours or attractions purchased, and language preference, and is provided by the facility operator. *Id.* at 12:53–63. The “party information” is collected by the party through portable computer 100 via queries. *Id.* at 13:3–9; 13:16–58. This information may comprise the number of people in the party, whether there are any infants, children, disabled, or elderly members in the party, the

party's preferences (such as an interest or aversion to specific types of rides, or to particular themes), and access class. *Id.* at 6:23–52; 13:43–58.

Once the necessary secured information and answers to mandatory questions are received, the processor of portable computer 100 executes an algorithm to generate an itinerary in step 716. *Id.* at 13:10–13; 13:64–67.

Figure 14, reproduced below, “illustrates a flowchart describing in detail an exemplary method for generating an itinerary.” *Id.* at 10:30–31.

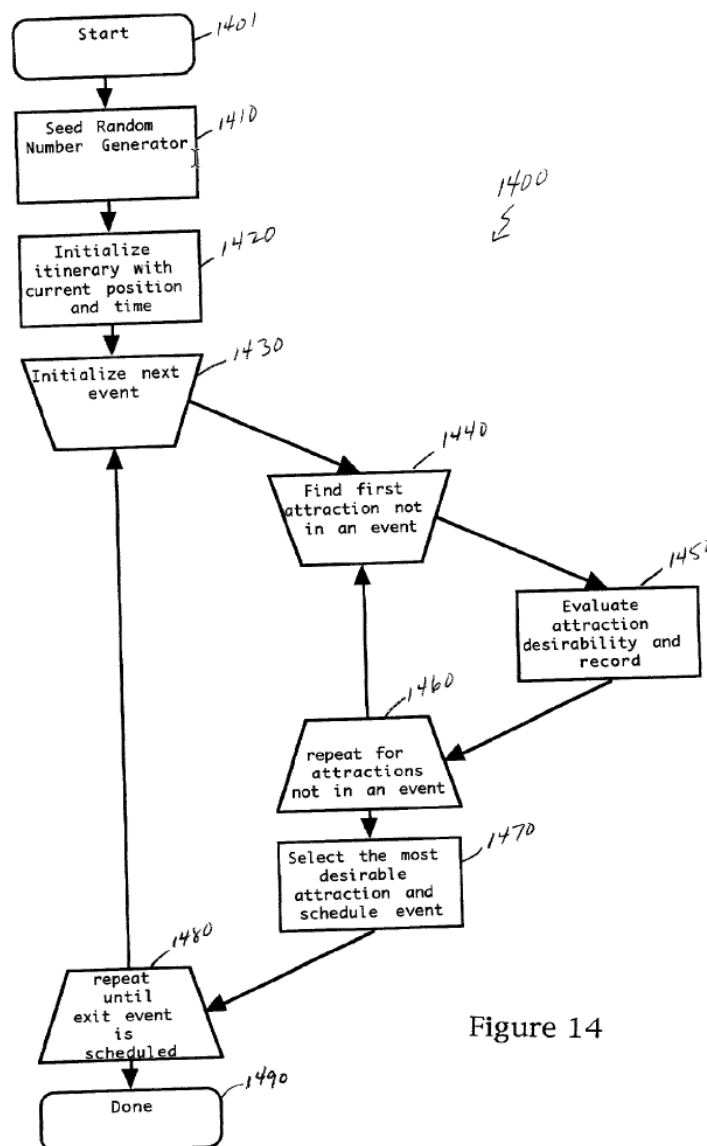


Figure 14

Figure 14's flowchart shows a method for generating an itinerary starting at step 1401 where "access is provided to the party profile gathered in [Figure 7's] steps 712 & 714, node database 800, link database 900, attraction database 1000, and profile interpretation database 1200."

Ex. 1001, 25:17–24. In step 1410, "a seed unique to the portable computer 100, or unique to the party in the case of another embodiment, is acquired," such as one derived from portable computer 100's serial number, or a unique username. *Id.* at 25:24–30. "An itinerary database 1500, shown in FIG. 15, is prepared for use in step 1420." *Id.* at 25:45–47. "In step 1440, the attraction database 1000 is scanned for the next attraction that does not appear in the attraction name field 1523 of any event in itinerary 1500," and that attraction is evaluated in step 1450 by equations and analyses. *Id.* at 26:4–28:50. "In step 1460, the next attraction not contained in the itinerary 1500 is sought," and "[i]f one exists, the process loops back to step 1440. Steps 1440 and 1460 comprise the logic of a loop iteration over all the attractions in attraction database 1000." *Id.* at 28:51–55. The last temporary event to have been copied into the current event is now the selected event that will be recorded in step 1470, and the process is repeated until the event is "Exit," whereby the itinerary is complete and the process ends at step 1490. *Id.* at 28:58–29:19.

Figure 4, reproduced below, is "a schedule form, shown on the display screen, . . . showing the next attractions in the itinerary for a party."

Ex. 1001, 10:5–8.

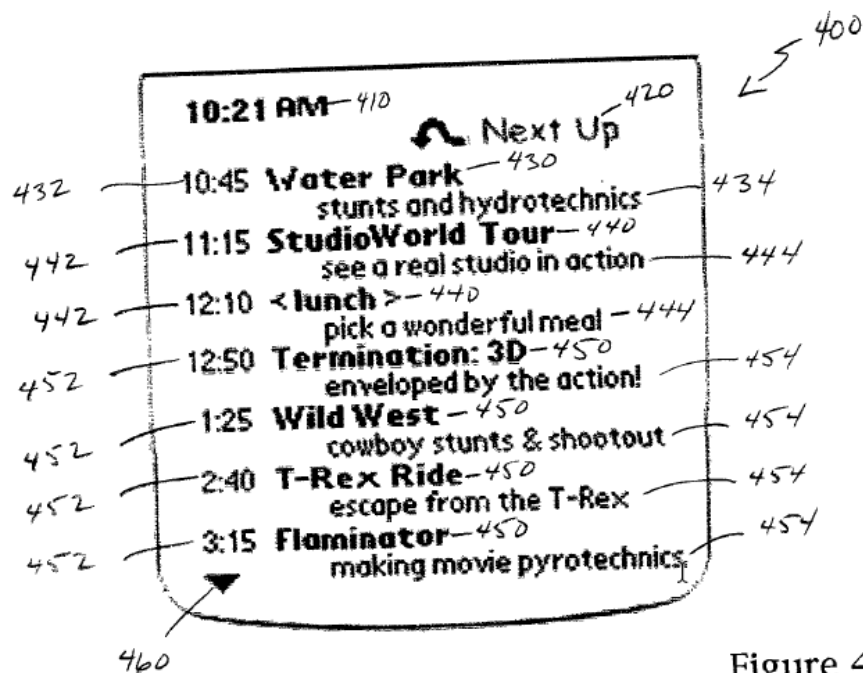


Figure 4

Figure 4 shows an itinerary generated from the results of the process depicted in Figures 7 and 14, above. Ex. 1001, 14:1–3. The itinerary displays the current time 410, the current event 420, and the current attraction name 430, shown with time 432 and a brief description 434. *Id.* at 14:10–18. In chronological order are displayed the successive attractions' names, time, and descriptions, 440, 450, 442, 452, 444, and 454. *Id.* at 14:19–31.

D. ILLUSTRATIVE CLAIM

Of the challenged claims, claims 1 and 3 are independent. No claim depends from claim 1. Claims 4, 5, 7, 8, 10–14, and 16–25 depend directly from independent claim 3.

Claim 1 is illustrative and is reproduced below with certain reformatting:¹

1. [pre] A system for providing an itinerary to a party, said itinerary comprising a second set of attractions selected from a first set of attractions, said system comprising:

[a] data regarding said first set of attractions;

[b] information about said party, at least a portion of said information distinguishing among said first set of attractions with respect to said data;

[c] a computer having access to said data and said information, said computer having software that selects said second set of attractions from said first set of attractions, said second set of attractions consisting of at least some of said first set of attractions for which said data substantially matches with said information;

[d] a presentation means in communication with said computer, said presentation means able to receive said itinerary from said computer and present said itinerary to said party,

[e] whereby said itinerary is customized for said party.

Ex. 1001, 31:50–67. Claim 3 recites similar steps. *Id.* at 32:31–51.

¹ We apply the same identifiers Petitioner uses to label the different portions of claim 1. Pet. App. A.

E. ASSERTED GROUNDS OF UNPATENTABILITY

Petitioner challenges the patentability of claims 1, 3–5, 7, 8, 10–14, and 16–25 on the following grounds (Pet. 5):

Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1	1, 3, 5, 7, 8, 10–14, 16, 17, 19, 20, 22–25	103(a) ²	Sim, ³ Doi ⁴
2	4, 18, 21	103(a)	Sim, Doi, Waytena ⁵
3	1, 3–5, 8, 10, 12–14, 16–21, 23–25	103(a)	Waytena
4	1, 3–5, 8, 10, 12–14, 16–21, 23–25	103(a)	Waytena, Herz ⁶
5	7	103(a)	Waytena (alone or as modified by Herz), Sim
6	11, 22	103(a)	Waytena (alone or as modified by Herz), Doi

In support of its unpatentability contentions, Petitioner also relies on the Declaration of Henry Houh, Ph.D. Ex. 1003. Patent Owner relies upon the Declaration of Gregory J. Gonsalves, Ph.D. Ex. 2001.

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. § 103, effective March 16, 2013. Because the application from which the ’983 patent issued was filed before this date, the pre-AIA version of § 103 applies.

³ Leonard Sim, International Publication WO97/18534, published May 22, 1997 (Ex. 1005, “Sim”).

⁴ Miwako Doi, U.S. Patent No. 6,938,066, issued Aug. 30, 2005 based on application 09/716,301, filed Nov. 21, 2000 (Ex. 1006, “Doi”).

⁵ William Waytena et al., U.S. Patent No. 5,978,770, issued Nov. 2, 1999 based on application 08/845,504, filed Apr. 24, 1997 (Ex. 1007, “Waytena”).

⁶ Frederick Herz et al., U.S. Patent No. 5,758,257, issued May 26, 1998 based on application 08/346,425, filed Nov. 29, 1994 (Ex. 1008, “Herz”).

III. ANALYSIS

A. DISCRETION TO DENY UNDER 35 U.S.C. § 325(D)

35 U.S.C. § 325(d) states, in relevant part: “In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.”

Although Patent Owner does not argue for discretionary denial under § 325(d) (*see* Prelim. Resp.), Patent Owner nonetheless contends the same and/or substantially the same art were previously presented to the Office (Prelim. Resp. 5, 6, 10–20). Specifically, Patent Owner argues Waytena was already considered by the Examiner during prosecution and that Sim and Doi add nothing new beyond what was already considered during the prosecution of the ’983 patent. Prelim. Resp. 10–20 (citing Exs. 1002, 2001).

Petitioner disagrees and argues that “[t]he grounds in this Petition are not the same or substantially the same as the art and arguments raised during prosecution, and to the extent that they are, the Examiner erred in a manner material to the patentability of the challenged claims.” Pet. 77–78.

Petitioner contends Sim, Doi, and Herz were not considered during prosecution and “although Waytena was considered by the Examiner as an anticipation ground, the Office erred in a manner material to patentability by failing to consider whether Waytena renders the claims obvious.” *Id.* at 78. Petitioner alleges the Examiner erred in “accept[ing] as true Applicants’ arguments that Waytena does not anticipate the claims because in Waytena parties can manually select which ‘matching’ attractions to include in their itinerary.” *Id.* (citing Ex. 1002, 9–10). Petitioner further argues that

“nothing in the prosecution indicates the Examiner considered whether the claims may nonetheless be obvious, in view of Waytena’s full disclosure of how its system works and the knowledge of a POSITA.”⁷ *Id.* Additionally, Petitioner argues Waytena in combination with Herz was not considered during prosecution and presents a new, noncumulative argument. *Id.* at 78–79.

It is not disputed that Sim, Doi, and Herz were not previously presented to the Office. And, the prosecution record indicates that Sim and Doi were not listed on an Information Disclosure Statement by Application nor in a List of References or in an Office Action by the Examiner. *See* Ex. 1002, 9–10, 20–25, 69–74, 196–197, 346–347. Petitioner’s asserted Grounds 1 and 2 rely substantially on Sim and Doi to teach the steps of the claimed system and method. Petitioner’s asserted Grounds 4, 5, and 6 substantially rely on Herz. Sim, Doi, and Herz are meaningful to the prior art combinations set forth in the Petition. Therefore, the asserted combinations regarding Sim and Doi, Sim, Doi, and Waytena, and Waytena and Herz were not previously presented to the Office.

It is also not disputed that Waytena was previously presented to the Office and considered by the Examiner. The prosecution history shows that throughout prosecution, the Examiner heavily considered and relied on Waytena for rejections under 35 U.S.C. §§ 102 and 103 in evaluating the application of the ’983 patent. *See, e.g.*, Ex. 1002, 9–10, 20–24, 69–73.

At this point and based on the present record, we do not discretionarily deny under 35 U.S.C. § 325(d) because Petitioner has

⁷ The terms “POSITA,” “PHOSITA” or “skilled artisan” refer to a person of ordinary skill in the art.

demonstrated that on at least one Ground not involving Waytena, there is a reasonable likelihood that at least one of the Challenged Claims is unpatentable. *PGS Geophysical*, 891 F.3d at 1360. However, based on the record before us, and because we reach the same conclusion as the Examiner regarding Waytena’s teachings, we find that Patent Owner has, on this record, sufficient support for its contentions that Waytena was previously presented to the Office and the Examiner’s evaluation on the merits regarding Waytena’s teachings was not in error.

B. LEGAL STANDARDS

In an *inter partes* review, the petitioner has the burden of showing there is a reasonable likelihood that Petitioner would prevail with respect to at least one of the claims challenged in the Petition. 35 U.S.C. § 314. That burden never shifts to the patentee. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The legal question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) when in evidence, objective evidence of obviousness or nonobviousness.⁸ *Graham v. John*

⁸ The record at this time does not include allegations or evidence of objective indicia of obviousness or nonobviousness.

Deere Co. of Kansas City, 383 U.S. 1, 17–18 (1966). One seeking to establish obviousness based on more than one reference also must articulate sufficient reasoning with rational underpinnings to combine teachings. *See KSR*, 550 U.S. at 418.

To show obviousness, it is not enough to merely show that the prior art includes separate references covering each separate limitation in a challenged claim. *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011). “This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *KSR*, 550 U.S. at 418–419.

On the other hand, an obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR*, 550 U.S. at 418; *accord In re Translogic Tech., Inc.*, 504 F.3d 1249, 1259 (Fed. Cir. 2007). However, a petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016). Instead, a petitioner must articulate a reason why a person of ordinary skill in the art would have combined or modified the prior art references. *In re NuVasive, Inc.*, 842 F.3d 1376, 1382 (Fed. Cir. 2016); *see also Metalcraft of Mayville, Inc. v. The Toro Co.*, 848 F.3d 1358, 1366 (Fed. Cir. 2017) (“In determining whether there would have been a motivation to combine prior art references to arrive at the claimed invention, it is insufficient to simply conclude the combination would have been obvious without identifying any reason why a person of skill in the art would have made the combination.”); *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064,

1073 (Fed. Cir. 2015) (“[O]bviousness concerns whether a skilled artisan not only *could have made* but *would have been motivated to make* the combinations or modifications of prior art to arrive at the claimed invention.”) (citing *InTouch Techs., Inc. v. VGO Commc’ns, Inc.*, 751 F.3d 1327, 1352 (Fed. Cir. 2014)).

We analyze the challenges presented in the Petition in accordance with the above-stated principles.

C. LEVEL OF ORDINARY SKILL IN THE ART

In determining the level of ordinary skill in the art, various factors may be considered, including the “type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.” *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (citation omitted).

Petitioner contends that a person of ordinary skill in the art at the time of the invention:

would have the equivalent of an undergraduate degree in computer science, engineering, operations research, or similar discipline, along with one year of experience in computer programming. (Houh Decl., ¶32.) The more education one has, the less experience needed to attain an ordinary level of skill. (*Id.*) Similarly, more experience in the field may serve as a substitute for formal education. (*Id.*)

Pet. 9 (footnote omitted).

Patent Owner does not contest or comment on Petitioner’s definition of the level of ordinary skill in the art or offer Patent Owner’s own definition of the level of ordinary skill. Prelim. Resp. 2.

For purposes of this Decision, we find that the current record supports that the '983 patent and the cited prior art references reflect the appropriate level of skill at the time of the claimed invention and that the level of appropriate skill reflected in these references and in the '983 patent is consistent with the level of skill proposed by Petitioner. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001). Accordingly, for purposes of this Decision, we adopt Petitioner's proposed definition for a person of ordinary skill in the art.

D. CLAIM CONSTRUCTION

In this *inter partes* review, we apply the same claim construction standard that would be used in a civil action under 35 U.S.C. § 282(b). 37 C.F.R. § 42.100(b). In applying this standard, we generally give claim terms their ordinary and customary meaning as would be understood by a person of ordinary skill in the art at the time of the invention and in the context of the entire patent disclosure. *See id.*; *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–14 (Fed. Cir. 2005) (en banc).

Petitioner contends the claimed “presentation means” is a means-plus-function term under § 112, ¶ 6, that “can perform the function of (a) ‘receiv[ing] said itinerary from said computer’ and (b) ‘present[ing] said itinerary to said party.’” Pet. 8–9. Petitioner further contends the corresponding structure for performing the recited functions is display screen 130. Pet. 9. Patent Owner presents no argument against this contention.

We agree that “presentation means” is a means-plus-function claim term. Because it is necessary to know what the structure and function are encompassed by the claim term in order to make a determination that the

prior art teaches the corresponding structure and function, and there is no disagreement, we adopt Petitioner's construction. Should either party believe that a different construction should apply in the instituted trial, it should explain the proposed construction, how the construction is supported by the record, and how the construction affects our unpatentability analysis.

Patent Owner contends that the limitation recited in each of independent claims 1 and 3 of "said computer having *software that selects* said second set of attractions from said first set of attractions" "excludes manual selection of attractions to include in an itinerary." Prelim. Resp. 20–21. Patent Owner asserts "the '983 patent clearly and unambiguously disclaimed or disavowed an interpretation of the claims encompassing manual selection of attractions to include in an itinerary." *Id.* at 22 (citing Ex. 2001 ¶ 92). Patent Owner also contends that the term "substantially matches" as recited in claims 1 and 3 does not include an "exact match." *Id.* at 26 (citing Ex. 2001 ¶ 185). Regarding dependent claims 20 and 22, Patent Owner contends that the term "directed demand" means "the number of visitors directed to an attraction by the itineraries produced by this invention." *Id.* at 21. We address each term below.

1. "software that selects"

Independent claims 1 and 3 recite, in relevant part, the "computer having software that selects said second set of attractions from said first set of attractions." Ex. 1001, 31:56–58; 32:39–41. Patent Owner contends that "claims 1 and 3 were narrowed to disclaim users' manual selection of attractions." Prelim. Resp. 22 (citing Ex. 2001 ¶ 92); *see also id.* at 16–20.

"For a statement during prosecution to qualify as a disavowal of claim scope, it must be 'so clear as to show reasonable clarity and deliberateness,'

and ‘so unmistakable as to be unambiguous evidence of disclaimer.’” *Genuine Enabling Tech. LLC v. Nintendo Co.*, 29 F.4th 1365, 1374 (Fed. Cir. 2022) (quoting *Omega Eng’g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1323, 1325 (Fed. Cir. 2003)). Prosecution disclaimer is not established “[i]f the challenged statements are ambiguous or amenable to multiple reasonable interpretations.” *Id.* The burden of “proving the existence of a clear and unmistakable disclaimer that would have been evident to one skilled in the art” is borne by the party seeking to invoke the prosecution history. *Id.* (quoting *Mass. Inst. of Tech. v. Shire Pharms., Inc.*, 839 F.3d 1111, 1119 (Fed. Cir. 2016)).

Here, Patent Owner provides a summary of the prosecution and post-issuance histories of the ’983 patent. Prelim. Resp. 16–20. The prosecution history indicates that the term “software to select” means that the software is selecting a set of attractions from the first set. Ex. 1002, 9 (amending the “operable to select” with “that selects”). However, claim 1 recites that the system “comprises,” in relevant part, a computer having software that selects a second set. “The well-established meaning of ‘comprising’ in a method claim indicates that the claim is open-ended and allows for additional steps.” *Solvay S.A. v. Honeywell Int’l Inc.*, 742 F.3d 998, 1005 (Fed. Cir. 2014) (quoting *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368 (Fed. Cir. 2003)). Thus, “software that selects” means that the software is selecting a set of attractions from the first set but does not exclude a contemporaneous or further manual confirmation or selection.

However, whether there exists a clear and unmistakable disclaimer that “software that selects” excludes a contemporaneous or further manual confirmation or selection requires further factual determinations to be addressed at trial.

2. “*substantially matches*”

Patent Owner argues that an “exact match” is not a “substantial match” because a “substantial match” “eases the requirement for a match.” Prelim. Resp. 26 (citing Ex. 2001 ¶ 185). Patent Owner argues that the ’983 patent “discloses that the computation to generate a customized itinerary may involve a utility function . . . [that] will be empirically determined; the greater the value returned by the function, the more desirable the event that was evaluated.” *Id.* (citing Ex 1001, 27:60–28:45). Thus, Patent Owner argues, even if there is not an exact match, a recommendation will be made. *See id.* (citing Ex. 2001 ¶ 185).

However, claims 1 and 3 do not recite how the match is determined. In other words, the claims do not recite the described utility function in determining whether there is a substantial match between data of the first set of attractions and the information. Ex. 1001, 31:60–62; 32:42–46.

“Although the claims must be read in light of the specification, it is important that we ‘avoid importing limitations from the specification into the claims.’” *Ericsson, Inc. v. D-Link Sys., Inc.*, 773 F.3d 1201, 1218 (Fed. Cir. 2014) (quoting *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc)).

Claims 1 and 3 do not recite that the data must *only* “substantially” match such that an exact match is excluded. There is no specific definition of what would be considered “substantial” nor is there an exclusion of an exact match that, by its nature, is also a “substantial” match.

3. “*directed demand*”

Dependent claim 20 recites, in relevant part, “accumulating in said storage a directed demand corresponding to the at least first attraction.”

Ex. 1001, 34:35–37. Similarly, dependent claim 23 recites, in relevant part, “redistributing a directed demand corresponding to said first attraction.” *Id.* at 34:50–51. Patent Owner contends that the term “directed demand” means “the number of visitors directed to an attraction by the itineraries produced by this invention.” Prelim. Resp. 21 (citing Ex. 1001, 8:6–8⁹).

The ’983 patent defines “directed demand” as “the number of visitors directed to an attraction by the itineraries produced by this invention. It includes the fact that an itinerary is generated for a party, and that a party may consist of multiple visitors.” Ex. 1001, 8:16–20.

Thus, we construe “directed demand” as defined in the ’983 patent as “the number of visitors directed to an attraction by the itineraries produced by this invention.”

E. OVERVIEW OF CITED ART AND EVIDENCE

1. *Overview of Sim – Exhibit 1005*

Sim relates to a queue management system for managing a queue of people such as at theme parks by allowing people to join a “virtual” queue, allowing people to be free to undertake other activities. Ex. 1005, code (57), 1:5–17, 2:1–4, 3:16–22. Sim discloses portable docking stations, each having a means to display a selection of queues the person or people wish to join, of the preferred sequence, and of preferred times of joining the queues *Id.* at 7:15–21, 8:11–27, 14:31–35, Fig. 1. This data are transmitted to the queue manager/controlling computer 3 via a communication means. *Id.* at 8:19–21.

Figure 2, which is reproduced below, is a schematic diagram of a system in operation in a theme park. Ex. 1005, 14:11–13.

⁹ We note that this citation is likely a typographical error.

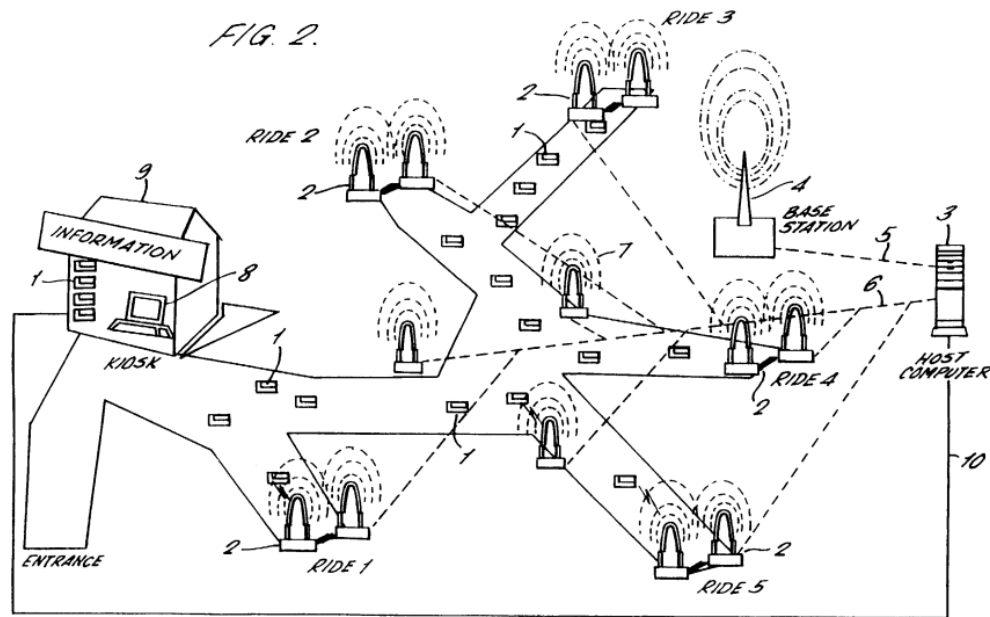


Figure 2 illustrates portable modules or prompters 1, gate units 2 positioned at various rides that detect portable modules/prompters 1, and host/controlling computer 3 that receives downloaded identification codes from gate units 2 and from module detectors 22 incorporated into locator units 7. Ex. 1005, 14:31–15:29. Computer 3 is linked to transmitter 4 by communication line 5 and linked to gate unit 2 by communication line 6. *Id.* at 15:1–7. Portable modules 1 can be inserted in a docking station 8 that is located within information kiosk 9. *Id.* at 15:18–22.

After receiving the preferred times and sequence of rides, computer 3 will determine the “optimum sequence and time of the rides.” Ex. 1005, 15:29–34. Once the module 1 is removed from the docking station 8, computer 3 transmits messages to each module 1 indicating the sequence and times of rides.

Sim describes that its “system would request other relevant information such as height or health status, which may be relevant in allowing access to certain rides and information such as the need for a

stroller or wheelchair,” and when a group of visitors share one portable module 1, the system would require information on each individual.

Ex. 1005, 22:32–23:3. Computer 3 can store in a database information on each user and member of a group. *Id.* at 23:8–9. This information can comprise, for example,

prompter serial number, relationship to other prompters or on tags, arrival time, preferred language, attract preferences, time preferences, calculated optimum route, the number in the group, attraction restriction information by individual user, other relevant information on the user, e.g. any relevant disability, baby being carried, stroller present etc., optional services activated (which might require additional user information), and credit available (where applications where individual ride tickets are used and the portable modules acts an electronic ticket).

Id. at 23:8–21.

Computer 3 can “operate to include a procedure which can ensure that a user registering late in the day would be given access to the same number of queues as a user registering earlier in the day,” so that a late registering user could join queues near the front. Ex. 1005, 23:22–27. “The structuring and managing of the queues are features which can be customised to suit[] a particular situation,” such that computer 3 “operates in accordance with the customised algorithm to manage the queues.” *Id.* at 23:27–31.

Sim further describes that “[t]he Queue Manager is the controlling software program in the host computer,” and “uses a simple but fast customizable flat database which from which records are selected and processed.” Ex. 1005, 34:15–18. The queue manager calculates “the actual time and sequence of attendance at queue entrances offered to the user” that is responsive to user preferences, overall system demand, and user priority to “result in effectively, a recommended route.” *Id.* at 34:22–28. “The queue

manager software accepts input from the various input terminals in the park,” from remote terminals, and from park management. *Id.* at 35:15–23. The queue manager also accepts guests’ ride preference requests and collects a guest’s location information. *Id.* at 35:22–25. “This information is used to calculate and update a guest’s itinerary,” and to send sequenced messages instructing guests to attend the rides. *Id.* at 35:25–30.

2. *Overview of Doi – Exhibit 1006*

Doi relates to a customer navigation system and method for a large-scale attraction facility such as a theme park. Ex. 1006, 1:14–67. Doi describes a customer navigation terminal having a display for customer navigation. Ex. 1006, 9:52–10:24.

Doi describes a system where customer navigation information is transmitted to the customer navigation terminal and displayed to the customer to perform navigation. Ex. 1006, 9:52–58. The customer navigation can vary based on the customer’s age and crowd condition. *Id.* at 9:48–52. For example, when attraction A is crowded, the navigation planner makes a plan to recommend other attractions to some of the customer queuing at that attraction, those customers being selected in consideration of their ages. *Id.* at 9:53–56. Figure 11, reproduced below, is illustrative.

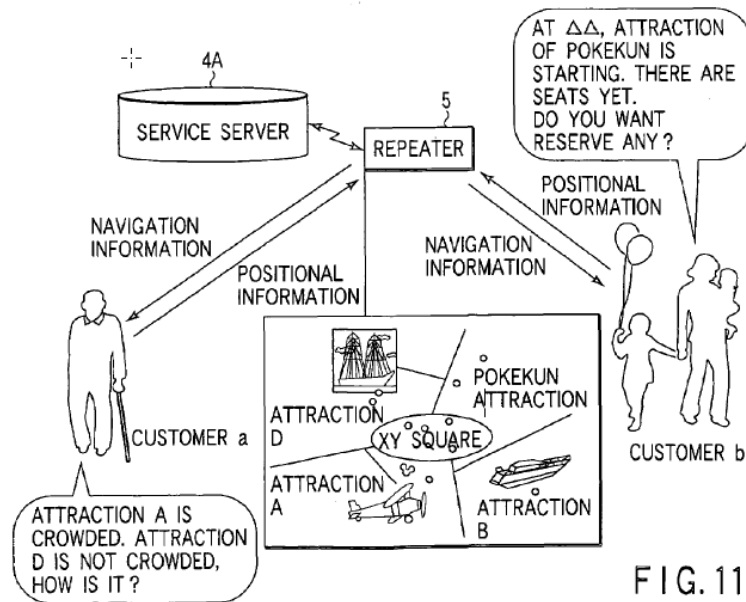


Figure 11 illustrates “examples of concrete actions.” Ex. 1006, 4:35–36. For example, these selected customers “a” and “b” may be provided information such as “Attraction A is crowded. Attraction D (enjoyable for aged person) is not crowded, how is it?[]” *Id.* at 9:56–10:3. After viewing a displayed map based in their location, the customer is then allowed to decide whether to move to the recommended Attraction D. *Id.* at 10:4–11. The system can also recommend, when there are seats available, events suitable for ages that match the customer’s age, and to recommend meal or food stops based on crowd condition. *Id.* at 10:12–19; 10:34–37.

3. Overview of Waytena – Exhibit 1007

Waytena relates to assigning and managing patron reservations for attractions using wireless personal communication devices (PCDs). Ex. 1007, codes (54), (57).

Figure 1, reproduced below, illustrates Waytena’s system 100.

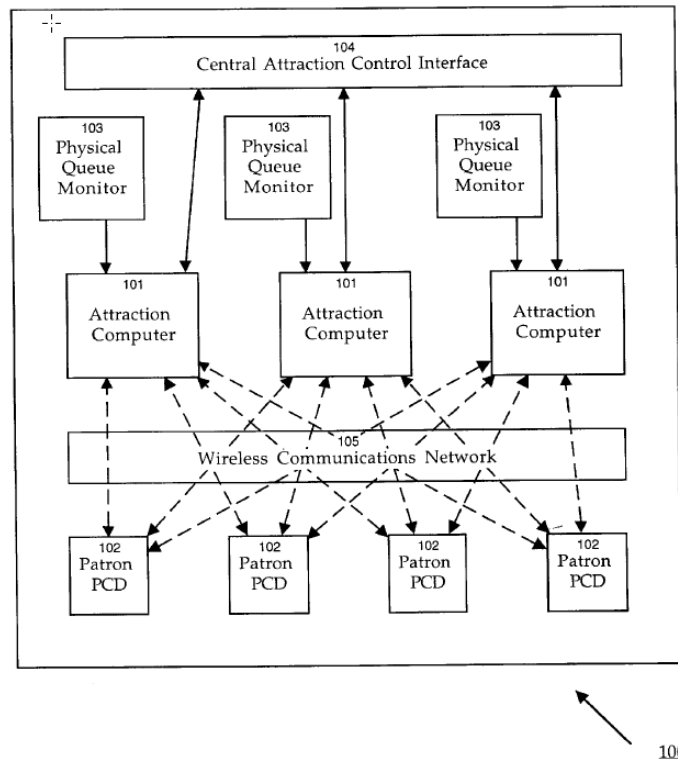


FIGURE 1

Figure 1 shows reservation system 100 having a Central Attraction Control Interface 104 communicating with Attraction Computers 101 that in turn communicate with Physical Queue Monitors 103 and wirelessly with Patrons 102. *See* Ex. 1007, 5:1–6:58.

Central Attraction Control Interface 104 is a conventional centralized computer system that allows access to all Attraction Computers 101 by staff and facilitates virtual and physical queue monitoring, reservation schedules, and other information regarding the attractions' states. *Ex.* 1007, 6:16–22. Interface 104 allows staff to manually change the attraction data. *Id.* at 6:22–30.

Each Attraction Computer maintains information regarding the associated attraction, such as information regarding its capacity, throughput description, height and weight requirements, geographic location, hours of operation, current state, and reservation status. *Id.* at 5:33–40. Each

Attraction Computer is also associated with Physical Queue Monitor 103 that monitors the current state of the corresponding attraction's physical queue. *Id.* at 5:41–45.

“Patron PCDs” 102 are each associated with a patron and are implemented “using conventional, small, hand-held portable computers” that include a rechargeable battery, microprocessor or CPU, display screen, auxiliary output device such as a speaker, input device such as a pen, RAM, storage, specific software, and wireless communication hardware. Ex. 1007, 5:59–6:10. “Upon activation, PCD 102 executes an initialization module 214 that prompts the patron via user interface 201 to input patron information describing his or her group, as is described below in connection with FIG. 5A,” reproduced below. *Id.* at 7:2–5.

WELCOME TO

PLEASE ENTER THE FOLLOWING INFORMATION
FOR EACH MEMBER OF YOUR GROUP.

NAME SEX

AGE YEARS

HEIGHT FEET INCHES

WEIGHT LBS.

HEALTH CONDITIONS: (CHECK ALL THAT APPLY)

☐ BACK CONDITION ☐ VERTIGO

☐ HEART CONDITION ☐ WHEELCHAIR

☐ PREGNANT ☐ HEARING DISABILITY

☐ NURSING ☐ OVERWEIGHT/LARGE

RIDE PREFERENCES: (CHECK ALL THAT APPLY)

☐ THRILL RIDES ☐ FRONT SEAT

☐ EDUCATIONAL ☐ REAR SEAT

☐ SHOWS ☐ AISLE SEAT

☐ KIDDIE RIDES

CANCEL

NEXT

DONE

FIG. 5A

Figure 5A illustrates a sample screen 519 for entry of information describing a patron and his or her group. Ex. 1007, 4:35–37. The

information collected typically includes the number of people in the group and for each member of the group, their name, sex, age, height, and weight 520, health conditions 521, and attraction and seating preferences 522. *Id.* at 13:53–60. Other information may be included such as “such as how far in advance of an upcoming reservation to alert the patron.” *Id.* at 13:60–65. This information is stored in patron information records in PCD’s patron information storage 202 and can also be stored in storage 213 in Attraction Computers 101 and/or in Central Attraction Control Interface 104. *Id.* at 7:5–11; 14:1–8. Each record includes fields of guest number, name, age, sex, height, weight, and flags (information describing preferences and characteristics). *Id.* at 7:11–28.

Figure 3, reproduced below, “is a flowchart showing a method of making a reservation.” Ex. 1007, 4:26–27.

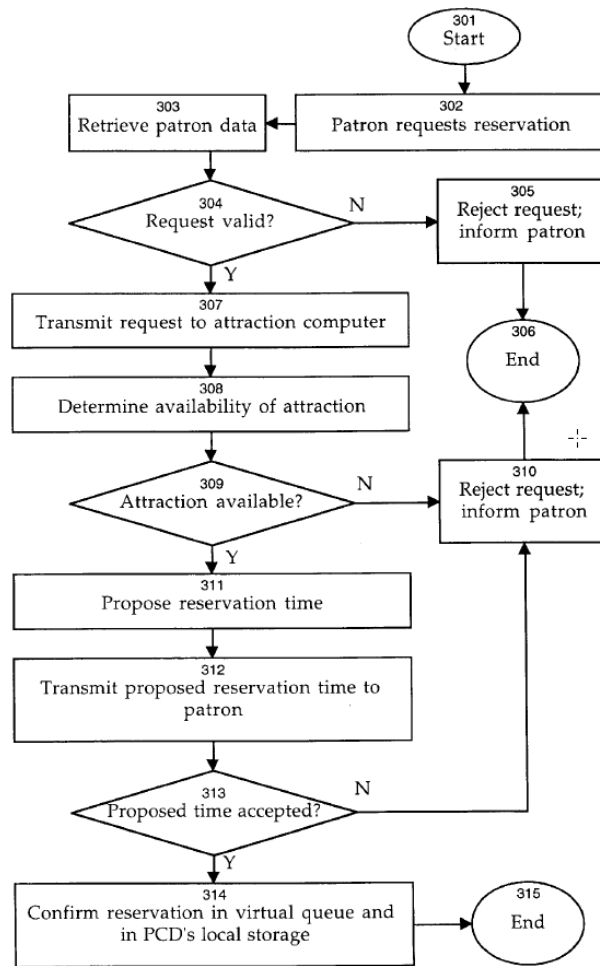


FIGURE 3

Figure 3 “shows a flowchart of the overall operation of system 100 in processing a reservation request from a patron.” Ex. 1007, 12:18–20. First, in step 302, the patron requests a reservation for a selected attraction using the interface of PCD 102. *Id.* at 12:25–29. In step 303, the stored patron information is received, and in step 304, the request is filtered or screened to determine validity. *Id.* at 12:30–34. If the request is invalid, then in step 305, the patron is informed of the rejection and the process ends in step 306. *Id.* at 12:35–36. If valid, then the request is transmitted to the requested attraction’s Attraction Computer 101 in step 307. *Id.* at 12:36–37.

In step 308, Attraction Computer 101 determines the availability of the requested attraction based on the stored attraction information, virtual queue information, and physical queue information. Ex. 1007, 12:38–45. In step 309, processor 209 determines whether the attraction is available. *Id.* at 12:45–51. If not available, then in step 310, the request is rejected and the patron is informed of the rejection in step 310, and the process ends at step 306. *Id.* at 12:46–49. If the attraction is determined to be available, then in step 311, a reservation time or position is proposed based on multiple factors, and is transmitted to PCD 102 in step 312. *Id.* at 12:50–65.

The patron is given a fixed amount of time to accept the proposal and is not permitted to make other reservations during this time. Ex. 1007, 13:2–7. Upon transmission of rejection of the proposal in step 313, the request is released and the patron is informed of the rejection in step 310, and the process ends at step 306. *Id.* at 13:6–23. Upon an acceptance of the proposal in step 313, the reservation is confirmed and stored in local storage 206 and virtual queue 220 of Attraction Computer 101, and the patron may optionally be informed of the confirmation in step 314. *Id.* at 13:6–9; 13:24–28.

Figure 5B, reproduced below, is a sample screen for requesting reservations, obtaining information, and viewing, modifying or canceling previously-made reservations. Ex. 1007, 4:38–41.

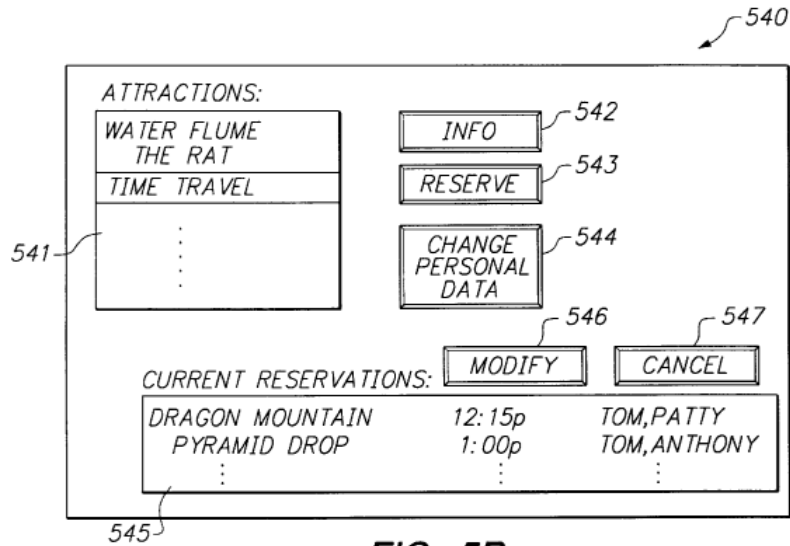


FIG. 5B

Figure 5B illustrates a list of available attractions 541 and a list of previously-made reservations 545. Ex. 1007, 14:13–35. Figure B includes a scrollable and/or pageable list 541 of available attractions, buttons 542 and 543 for obtaining information or generating reservation requests for selected attractions, a button 544 for changing patron information, a scrollable and/or pageable list 545 of previously-made reservations, and buttons 546 and 547 for modifying or canceling previously-made reservations.

Id. at 14:14–20. The patron can also “be presented with a list of attractions that match the particular preferences of the members of the patron’s group or that are in relative proximity to the patron’s current location.” *Id.* at 14:20–24.

Figure 5D, reproduced below, “is a sample screen for display while awaiting a response to a reservation request.” Ex. 1007, 4:44–46.

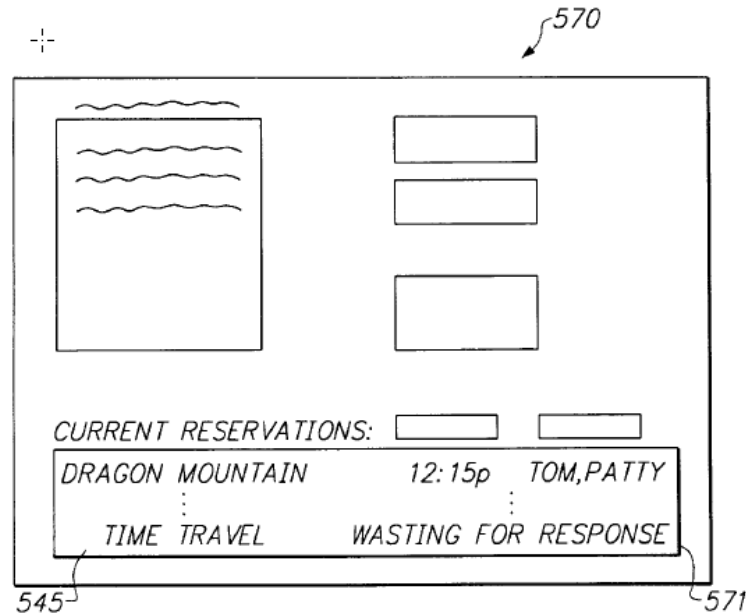


FIG. 5D

Figure 5D “is a sample screen 570 after a reservation request has been transmitted.” Ex. 1007, 16:51–52. “List 545 now includes item 571 showing the reservation request with an indication that PCD 102 is waiting for a response regarding the request.” *Id.* at 16:52–54.

Figure 5E, reproduced below, “is a sample screen including a dialog box for confirmation, rejection, or rescheduling of a proposed reservation time.” Ex. 1007, 4:48–50.

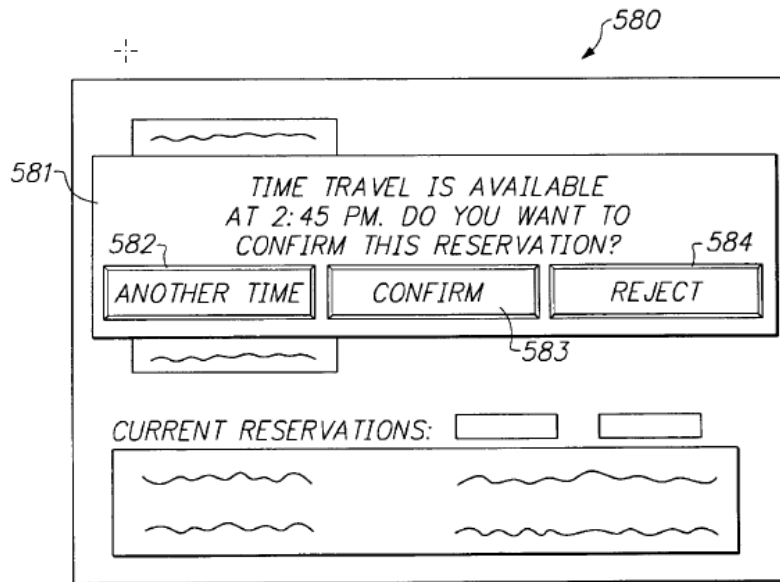


FIG. 5E

Figure 5E shows “a sample screen 580 containing a message 581 informing the patron of the availability of the selected attractions at a particular time.” Ex. 1007, 17:29–32. If the patron selects the “ANOTHER TIME” button 582, the patron is prompted to “enter a new requested time,” a message is sent to computer 101 of the rejection, and a new reservation request is generated with the specified time. *Id.* at 17:33–39. If the patron selects the “CONFIRM” button, a confirmation message is sent, and the reservation is stored in the PCD. *Id.* at 17:50–55. If the “REJECT” button is selected, a rejection message is sent, and the PCD returns to an idle state. *Id.* at 17:56–62. If no buttons are selected, then a “TIMEOUT” message is sent and the PCD returns to an idle state. *Id.* at 17:62–65.

4. Overview of Herz – Exhibit 1008

Herz relates to system and method for “scheduling the receipt of desired movies and other forms of data from a network which simultaneously distributes many sources of such data to many customers, as in a cable television system” (Ex. 1008, code (57)) and for “controlling

broadcast of and/or customer access to data such as video programs in accordance with objective profile data indicative of the customer's preferences for that data" (*id.* at 1:8–11). "The video programming and other data most desired by the customer" are made available to the customer "by developing an 'agreement matrix' characterizing the attractiveness of each available source of video programming or data to each customer." *Id.* at 4:18–22.

The agreement matrix is used to determine, for each customer, customized "virtual channels" of data. Ex. 1008, 4:23–25. The virtual channels "include the video programming or other data which is predicted to be most desirable to the customer based on the customer's preferences." *Id.* at 4:25–28; *see also id.* at 47:36–52. This would "minimize[]" "channel surfing" and is "accomplished by calculating an agreement matrix which matches the characteristics desired by customers with corresponding characteristics of the video programs." *Id.* at 47:36–45. In one alternative, programs that are liked by the same people are clustered together, and in another alternative, customers with similar interests are clustered together. *Id.* at 47:45–52.

F. GROUND 1 — ALLEGED OBVIOUSNESS OVER SIM IN VIEW OF
DOI — CLAIMS 1, 3, 5, 7, 8, 10–14, 16, 17, 19, 20, AND 22–25

Petitioner challenges claims 1, 3, 5, 7, 8, 10–14, 16, 17, 19, 20, and 22–25 as unpatentable under 35 U.S.C. § 103 over Sim or over Sim in view of Doi. Pet. 10–41. Specifically, regarding independent claim 1, Petitioner argues Sim discloses 1[pre], 1[a], 1[b], 1[d], and 1[e] and Sim renders obvious 1[c]. Pet. 10–41. Petitioner also argues that, alternatively, Sim in combination with Doi renders obvious limitations 1[b] and 1[c]. *Id.* at 17–22.

Patent Owner contends “[n]either Sim nor Doi discloses or renders obvious ‘software that selects,’” and that the data regarding the first set of attractions does not “substantially match[] with said information” about the party, as recited in limitation 1[c]. Prelim. Resp. 21–29.

After considering the parties’ arguments and evidence, we determine that at this stage, Petitioner has demonstrated a reasonable likelihood of establishing obviousness of at least independent claim 1 over Sim and Doi to support institution of Ground 1. We turn now to detailed discussions of the challenged claims.

1. Independent Claim 1

- a) Limitation [pre] — “A system for providing an itinerary to a party, said itinerary comprising a second set of attractions selected from a first set of attractions”

Petitioner contends the Sim’s “queue management system” comprises a controlling computer and portable modules used by parties meets the claim’s system. Pet. 1–2 (citing Ex. 1005, 2:5–20, 3:16–27, 15:23–16:5, Figs. 1, 2). Petitioner also asserts that in Sim, users, or parties, provide information regarding height, health, and preferred times and sequence of rides, the information then being used by the “‘Queue Manager’ software” to ‘determine the optimum queue sequence’ and ‘recommended route’ based on the party’s information,” i.e., the claimed “itinerary.” *Id.* at 11–12 (citing Ex. 1005, 7:15–26, 8:11–9:9, 15:18–16:3, 18:29–19:25, 22:4–24:22, 34:15–35:30, Figs. 2, 6).

Further, Petitioner contends that “Sim’s system includes information on rides throughout the park (‘first set of attractions’).” Pet. 13. Petitioner contends that the user’s “choosing among these park attractions” meets the recited “second set of attractions selecting from a first set of attractions.” *Id.*

Petitioner argues that Sim discloses that “after a party provides ‘relevant information,’ including preferred ‘rides,’ Sim provides an itinerary with an ‘optimum sequence and time’ of selected ride(s) in the park (‘second set of attractions’).” *Id.* at 14 (citing Ex. 1005, 15:23–16:5, 17:22–27, 22:4–24:22, Fig. 3).

Patent Owner does not present specific argument against the preamble. *See* Prelim. Resp. 5–6, 21–29.

After considering the parties’ arguments and evidence as presented, and without determining whether the preamble is limiting, we determine that at this stage Petitioner has demonstrated a reasonable likelihood of establishing that Sim teaches the preamble.

b) Limitation 1[a] — “data regarding said first set of attractions”

Petitioner contends, as discussed above, that Sim’s system’s data on rides meet this limitation. Pet. 15 (citing Ex. 1003 ¶¶ 60–62). Specifically, Petitioner asserts that Sim’s data comprise rides’ restrictions on age, size, health, whether the rides are open, closed, or busy, information on the rides’ queues, whether the rides require additional fees or tickets, rides’ names and images, and gate units associated with the rides. *Id.* at 15–16 (citing Ex. 1005, 8:22–9:9, 12:35–13:28, 19:4–5, 19:24–25, 19:28–20:22, 23:29–24:22, 35:21–36:5, 38:11–15, 38:27–32, 39:1–8, Table 2, Figs. 3, 5, 6; Ex. 1003 ¶ 61).

Patent Owner does not present specific argument against this limitation. *See* Prelim. Resp. 5–6, 21–29.

After considering the parties’ arguments and evidence as presented, we determine that at this stage Petitioner has demonstrated a reasonable likelihood of establishing that Sim teaches limitation 1[a].

c) Limitation 1[b] — “information about said party, at least a portion of said information distinguishing among said first set of attractions with respect to said data”

Petitioner contends that this limitation is met with Sim’s information on parties as entered by them regarding “height or health status,” “the need for a stroller or wheelchair,” and “ride and time preferences,” and as stored in Sim’s controlling computer 3 regarding “prompter serial number, relationship to other prompters or on tags, arrival time, preferred language, attract preferences, time preferences, calculated optimum route, the number in the group, attraction restriction,” “location data,” “user-preferred language,” “different classes of guest depending on fee paid,” and “range[s] of privileges.” Pet. 16 (citing Ex. 1005, 3:23–27, 4:1–17, 11:5–32, 12:35–30, 18:7–10, 22:29–23:3, 23:8–21, 30:10–17, 32:29–32, 34:22–32, 35:21–30, 37:3–4, 37:25–38:7, 38:25–26) (alteration in original). Petitioner argues that at least a portion of this information is distinguished from the first set at least by the data of age and height as entered by the party that “distinguishes among those rides that parties are allowed to access (e.g., based on ride age or height restrictions) and those they are not allowed to access.” *Id.* at 17. In a footnote, Petitioner appears to contend that limitation 1[b] “is obvious over Sim in view of Doi” and refers to the arguments presented for limitation 1[c]. *Id.* at 17, n. 6 (citing Ex. 1003 ¶ 66).

Patent Owner does not present specific argument against this limitation. *See* Prelim. Resp. 5–6, 21–29.

After considering the parties’ arguments and evidence as presented, we determine that at this stage Petitioner has demonstrated a reasonable likelihood of establishing that Sim teaches limitation 1[b]. However,

because of the lack of explanation as to how the combination of Sim and Doi renders this limitation obvious, at this stage, the Petitioner has not demonstrated a reasonable likelihood of establishing that the combination of Sim and Doi teaches limitation 1[b].

d) Limitation 1[c] — “a computer having access to said data and said information, said computer having software that selects said second set of attractions from said first set of attractions, said second set of attractions consisting of at least some of said first set of attractions for which said data substantially matches with said information”

Petitioner contends that Sim’s “‘controlling computer’ with ‘Queue Manager’ software” and with “access to attraction ‘data’ and party ‘information’” meets the claimed computer having access to the data of limitation 1[a] and information of limitation 1[b]. Pet. 17 (citing Ex. 1005, 14:31–15:7, Fig. 1). Petitioner argues that Sim’s computer acquires and uses party information, compares that to attraction data, and generates a recommended/custom itinerary consisting of a sequence of rides and route information. *Id.* at 18 (citing Ex. 1005, 23:32–24:22, 34:22–32, 35:21–30, 38:27–32; Ex. 1003 ¶¶ 68–69).

Petitioner alternatively argues that “[t]o the extent Sim does not disclose that its computer ‘selects’ particular rides when creating an itinerary, Sim in view of Doi¹ renders this obvious.” Pet. 19 (citing Ex. 1003 ¶¶ 70–76). Petitioner asserts that “Doi is directed to a theme park ‘customer navigation system’ and has the same goal of directing parties to attractions in a way that maximizes utilization.” *Id.* (citing Ex. 1006, code (57), 9:9–10:44, 10:52–62). Further, Petitioner argues that “Doi’s system uses similar components to Sim,” including a customer-carried

navigation terminal 1C and service server 4A transmitting information to the customer terminal. *Id.* (citing Ex. 1006, 4:56–63, 8:60–9:20, Figs. 1, 10).

Petitioner asserts that Doi’s customer terminal includes information regarding the customer such as nickname, height, age, and position, and that the terminal “can provide a navigation plan based on position and ‘crowd condition[s],’ among other things.” *Id.* (citing Ex. 1006, 4:64–5:29, 9:21–58) (alteration in original). And, Petitioner contends that Doi’s system collects and uses “‘use data’ reflecting ‘use frequencies of attractions by customer ages’ and attraction ‘waiting times’ . . . to ‘select’ attractions for the customer based on their information matching attraction data.” *Id.* at 19–20 (citing Ex. 1006, 6:43–64, 9:52–10:44). These selected attractions are the other attractions recommended to queueing customers, the attractions being selected based on consideration of the customers’ ages. *Id.* at 20 (citing Ex. 1006, 9:63–66). According to Petitioner, Doi’s teaching of an exact match meets the recited “substantial[] match[].” *Id.*, n. 8.

Petitioner contends “[i]t would have been obvious to apply Doi’s teachings and have Sim’s system ‘select’ attractions, with at least some of those attractions having data that ‘substantially matches with [party] information,’” because both references are in the same field, disclose similar systems, and collect and use the same types of party information when determining ride access. Pet. 21 (citing Ex. 1003 ¶ 73). Petitioner asserts that “Doi simply adds that the system can further use this information to select attractions for a party where party information and attraction data match,” and that this “would have been the use of a known technique to improve a similar device.” *Id.* Petitioner reasons that a person or ordinary skill in the art “would have thus been motivated to apply Doi to Sim, such that Sim’s system could select attractions and times that match party

information when determining a ‘guest’s itinerary,’” because doing so would “maximiz[e] attraction utilization, control[] crowding, offer[] parties sufficient rides for a complete day, and reduc[e] the need to later re-allocate sequences.” *Id.* at 21–22 (citing Ex. 1003 ¶ 75).

Patent Owner contends “[n]either Sim nor Doi discloses or renders obvious ‘software that selects.’” Prelim. Resp. 21 (citing Ex. 2001 ¶ 173). Patent Owner contends that “claims 1 and 3 were narrowed to disclaim users’ manual selection of attractions.” *Id.* at 22 (citing Ex. 2001 ¶ 92); *see also id.* at 16–20.

As we discussed above in Section III.E, “software that selects” means that the software is selecting a set of attractions from the first step, but does not necessarily exclude contemporaneous or further manual confirmation or selection by the user. Based on this interpretation, we find that Patent Owner has, on this record, sufficient support for its contention that Sim teaches that the second set is selected by the user, not software.

However, Petitioner also alleges that Doi teaches the navigation planner (i.e., software) making a plan to recommend other attractions (i.e., a second set) based on a match between a customer’s age (i.e., user information) and attractions in software, and selecting a recommendation of another attraction (i.e., a second set) based on a match of the age and attraction. *See* Pet. 19–20 (citations omitted).

Patent Owner argues that by requiring a confirmation, Doi teaches the user manually selecting the attraction. Prelim. Resp. 24. However, on this record and based on the construction of “software that selects,” as discussed above in Section III.D.1, as not excluding a contemporaneous or further manual confirmation or selection, we find Petitioner has sufficiently supported its contention that Doi’s recommendation of another attraction is

selected by software. Pet. 19–20 (citing Ex. 1006, 6:43–67, 9:63–10:33). The addition of a further step in Doi of confirming the recommendation before adding it to the itinerary does not disqualify the teaching.

Patent Owner further contends that neither Sim nor Doi “discloses or renders obvious ‘said data substantially matches with said information.’” Prelim. Resp. 25 (citing Ex. 2001 ¶ 173). Specifically, Patent Owner argues that Doi’s exact match is not a substantial match because “a substantial match . . . eases the requirement for a match.” *Id.* at 26 (citing Ex. 2001 ¶ 185); *see also id.* at 27–28. Patent Owner asserts argues that in both Sim and Doi, the customer must choose which event to join or decide which attraction to move to, whereas the ’983 patent “discloses software that selects attraction for the users.” *Id.* at 28. This selection, as argued by Patent Owner, is what “the software determines [is] ‘the best possible (or best available) match to a party’s profile,’” and may not exactly match the users’ preferences. *Id.* According to Patent Owner, this is emphasized by the “whereby” clause in limitation 1[e], i.e., “whereby the itinerary is customized for said party,” and not “by” the party. *Id.*

As discussed above in Section III.D.2, claim 1 does not recite that the data must *only* “substantially” match such that an exact match is excluded nor does it recite “the computation to generate a customized itinerary may involve a utility function.” Prelim. Resp. 26. (citing Ex. 1001, 27:60–28:45). Petitioner shows sufficiently for institution that Doi’s *exact match* satisfies the recited substantial match. Further, as discussed above, Doi does teach software recommending an attraction based on a customer’s age, which could be considered to be generating a customization *for* the party. On this record, we find Petitioner has sufficiently supported its contention that Doi teaches a substantial match.

Thus, after considering the parties' arguments and evidence as presented, we determine that at this stage, Petitioner has demonstrated a reasonable likelihood of establishing that the combination of Sim and Doi teaches limitation 1[c].

e) Limitation [d] — “a presentation means in communication with said computer, said presentation means able to receive said itinerary from said computer and present said itinerary to said party”

Petitioner contends that Sim's portable customer unit's display 30 that is “able to display the ride sequence and times” meets the claimed presentation means. Pet. 22 (citing Ex. 1005, 3:32–35, 9:10–10:3, 15:34–16:9, Figs. 3–5, 9). Petitioner further contends that Sim's queue manager 5 transmits the determined optimum sequence to the portable unit such that the portable unit is able to receive the itinerary from the computer. *Id.* at 22–23 (citing Ex. 1005, 3:28–31, 9:4–10:3, 18:16–20).

Patent Owner does not present specific argument against this limitation. *See* Prelim. Resp. 5–6, 21–29.

After considering the parties' arguments and evidence as presented, we determine that at this stage Petitioner has demonstrated a reasonable likelihood of establishing that Sim teaches limitation 1[d].

f) Limitation [e] — “whereby said itinerary is customized for said party”

Petitioner contends that “[t]o the extent limiting, Sim discloses” that its itinerary is customized for parties in using parties' provided information to calculate and update a guest's itinerary and providing a recommended route. Pet. 23 (citing Ex. 1005, 8:5–9, 11:16–55, 34:22–32, 35:21–30, Fig. 6; Ex. 1003 ¶ 78; *supra* 1[pre], 1[b], 1[c]). “Moreover, Sim's system, as modified by Doi, results in itineraries ‘customized’ for a party, as

attractions and times are selected based on those attractions matching the party's information.” *Id.*

Patent Owner contends that, as discussed above, “[c]ustomized for” indicates that the software makes the selection of the itinerary for the party, whereas ‘customized by’ requires that the selection is done by the party.” Prelim. Resp. 28.

As discussed above, Petitioner has demonstrated a reasonable likelihood of establishing that Doi teaches software selecting attractions and that the combination of Sim and Doi teaches providing an itinerary. Thus, after considering the parties’ arguments and evidence as presented, we determine that at this stage and to the extent the “whereby” clause is limiting, Petitioner has demonstrated a reasonable likelihood of establishing that Sim teaches element 1[e].

g) Summary of Claim 1

After considering the parties’ arguments and evidence, we determine that at this stage, Petitioner has demonstrated a reasonable likelihood of establishing obviousness of independent claim 1 over Sim and Doi to support institution.

We deem the issue raised by Patent Owner regarding prosecution disclaimer is better suited for resolution on a fuller record during the trial phase, given our institution determination that Petitioner has demonstrated a reasonable likelihood of showing independent claim 1 would have been obvious over Sim and Doi.

2. *Independent Claim 3*

Petitioner asserts that the preamble, limitations, and whereby clause of independent claim 3 are nearly identical to those of independent claim 1.

Pet. 24. Therefore, Petitioner's contention that claim 3 is obvious over Sim in view of Doi relies on the arguments and reasons presented for claim 1. *Id.*

Patent Owner, thus, also relies on the arguments presented regarding claim 1 for claim 3. Prelim. Resp. 29.

Having considered the parties' arguments and evidence and given Petitioner's demonstration of a reasonable likelihood of demonstrating obviousness of independent claims 1, we find that with the evidence presented at this stage of the proceeding, Petitioner has demonstrated a reasonable likelihood of prevailing on its assertion that claim 3 would have been obvious over Sim and Doi to support institution.

3. *Dependent claims 5, 7, 8, 10–14, 16, 17, 19, 20, and 22–25*

Petitioner contends that claims 5, 7, 8, 10–14, 16, 17, 19, 20, and 22–25, each of which depends from claim 3, would have also been obvious over Sim and Doi. Pet. 24–41. Given Petitioner's demonstration of a reasonable likelihood of demonstrating obviousness of independent claims 1 and 3, we institute *inter partes* review with respect to all claims challenged in Ground 1. *See SAS*, 138 S. Ct. at 1359–60; 37 C.F.R. § 42.108(a).

4. *Conclusion of Ground 1*

Having considered the parties' arguments and evidence, we find, based on the evidence presented at this stage of the proceeding, Petitioner has demonstrated a reasonable likelihood of prevailing on its assertion that claims 1, 3, 5, 7, 8, 10–14, 16, 17, 19, 20, and 22–25 would have been obvious over Sim and Doi to support institution under Ground 1.

G. GROUND 2 — ALLEGED OBVIOUSNESS OVER SIM AS MODIFIED
BY DOI IN VIEW OF WAYTENA — CLAIMS 4, 18, AND 21

Petitioner challenges dependent claims 4, 18, and 21 as unpatentable under 35 U.S.C. § 103 over Sim in view of Doi and further in view of Waytena. Pet. 41–48. We turn to detailed discussions of the disputes raised by the parties’ arguments at this stage.

1. *Dependent claim 4 – “The method of claim 3 wherein said information comprises a preference of said party; wherein said data distinguishes a portion of said first set of attractions as being more desirable with respect to said preference, and wherein in step d) at least one attraction from said portion of said first set of attractions is selected for said second set of attractions.”*

Petitioner contends that “Sim in view of Doi teaches a system that selects an itinerary of attractions and attraction times for a party, based on attraction data matching party information,” as discussed above, and “Waytena simply adds that additional party information, such as preferred ride types, can also be used to determine which rides to suggest to a party.” Pet. 41 (citing Ex. 1007, 7:9–31, 13:44–14:35, Fig. 5A). Petitioner asserts that a person of ordinary skill in the art “would have been motivated to include Waytena’s party preferences in Sim,” to “allow Sim to maximize ride/show utilization and raise spending on park attractions by selecting rides that parties would enjoy but may not know about.” *Id.* at 43 (citing Ex. 1003 ¶¶ 121–122; Ex. 1005, 23:32–24:23; Ex. 1007, 14:20–24). Petitioner also asserts that “a POSITA would recognize that by having information on preferred ride types, as taught by Waytena, Sim could select alternative rides as part of its re-allocation process, increasing ride utilization and customer satisfaction.” *Id.* at 43–44 (citing Ex. 1003 ¶¶ 121–122).

Petitioner further argues that “adding ride preference information would enhance the selection of rides in the Sim system as taught by Doi.” Pet. 44. Petitioner explains that Doi teaches selection of recommended rides based on parties’ ages matching attractions’ recommended ages, and “Waytena teaches this can also be based on matching ride type preferences with ride data.” *Id.* Thus, Petitioner concludes that:

Adding party preferences to Sim would have thus been the inclusion of a known technique in a similar system—Sim (as modified by Doi) already selects a second set of attractions based on matching user age to ride age recommendations, and adding Waytena would allow the system to perform the same selection of rides when ride type preferences match ride data.

Id.

Patent Owner argues that claim 4 “is valid at least because they are based on valid independent claim 3.” Prelim. Resp. 40. Patent Owner also argues that Sim’s party “‘preferences’ refer to *attractions selected by the party*,” and not by software. *Id.* at 41. Patent Owner also argues, as with claims 1 and 3, that the combination of Sim and Doi teaches selection by the user and not the software and Waytena’s additional information does not cure that alleged deficiency. Prelim. Resp. 41–42.

At this stage, the parties’ disputes regarding claim 4 are substantively the same as the parties’ disputes regarding independent claims 1 and 3. Pet. 41–48; Prelim. Resp. 41–42. Accordingly, our discussion of those disputes in Section III.G above also applies to the parties’ disputes regarding dependent claim 4.

2. *Dependent claim 18 – “The method of claim 3 further comprising the step of: g) providing a reservation computer in communication with said computer, said reservation computer providing an indication whether said a first attraction is available; wherein in step d) said software excludes said first attraction from said second set of attractions when said reservation computer indicates said first attraction is unavailable.”*

Petitioner contends that Sim as modified by Doi in view of Waytena teaches this claim in that Waytena’s reservation system is in communication with its attraction computers that include and maintain attraction information of the attraction’s current status, e.g., “OPERATING, CLOSED, SCHEDULED MAINTENANCE, PAUSED.” Pet. 44–45 (citing Ex. 1007, 5:1–12, 11:18–61). Petitioner argues that the attraction computer, upon determining that the attraction for which a reservation is requested is unavailable, responds as such and does not include it in the party’s itinerary. *Id.* at 45 (citing Ex. 1007, 5:59–6:15, 7:2–8:67, 11:18–61, 12:13–63, 16:56–17:32, 19:20–60, 21:6–24, Figs. 1–4, 6–7; Ex. 1003 ¶ 126).

Petitioner asserts it would have been obvious to modify the Sim/Doi system to include Waytena’s teachings of “having attraction reservation computers with information on whether attractions are available/unavailable,” because Sim determines if an attraction is available, unavailable ones are excluded, and itineraries are re-allocated as needed, and “Waytena discloses that such information on ride availability can be obtained via an ‘attraction computer’ ‘associated with each attraction.’” Pet. 45 (citing Ex. 1005, 23:32–24:32, 39:1–8; Ex. 1007, 11:18–61, 12:38–49, 16:56–17:32, 19:20–60, 21:6–24, Figs. 2, 6; Ex. 1003 ¶ 127). Petitioner reasons that “modify[ing] Sim’s existing gate units to include Waytena’s reservation computers” would allow for each attraction to

“provide its availability and alert when it becomes unavailable and itineraries need to be re-allocated.” *Id.* at 46 (citing Ex. 1003 ¶¶ 128–129).

Patent Owner attempts to distinguish Waytena and argues that in Waytena, “a user wastes time and is disappointed by attempting at least one reservation request before being informed that the attraction is not available,” such that “a user must attempt to reserve first and then receive the unavailable notification.” Prelim. Resp. 42 (citing Ex. 2001 ¶ 240; Ex. 1001, Fig. 7). In contrast, Patent Owner argues, “the ’983 Patent discloses that the software will determine attraction availability *before* the reservation is made.” *Id.* (citing Ex. 2001 ¶ 240). However, Patent Owner’s argument appears to be against Waytena individually whereas Petitioner relies on the combination of Sim, Doi, and Waytena for teaching this claim.

Thus, after considering the parties’ arguments and evidence as presented, we determine that at this stage, Petitioner has demonstrated a reasonable likelihood of establishing that the combination of Sim, Doi, and Waytena teaches claim 18.

3. *Dependent claim 21 – “The method of claim 3 further comprising the steps of: g) providing a reservation computer in communication with said software; and, h) making a reservation with said reservation computer for said party for a first attraction of said second set of attractions; whereby said reservation for said party is accessible to users of said reservation computer.”*

Petitioner contends that Sim as modified by Doi in view of Waytena teaches this claim in that, as discussed with regards to claim 18, Waytena teaches a reservation system. Pet. 46. Petitioner asserts that the reservation system is in communication with the patron’s PCDs “that allow parties to transmit reservation requests to attraction computers,” the reservation being

received by a request processor in the computer. *Id.* (citing Ex. 1007, 5:59–6:15, 7:2–8:67, 12:13–63, Figs. 1–4, 6–7). Referring to Waytena’s Figure 5E, Petitioner argues that when the request processor determines the attraction is unavailable per the request, it rejects the request and may send a proposed time or position that the attraction is available for the party to confirm. *Id.* at 46–47 (citing Ex. 1007, 11:18–61, 12:38–13:28, 16:56–17:32, 20:15–21:34, 19:20–60). Petitioner asserts that upon the confirmation of the proposed time or position, Waytena’s attraction computer makes the reservation for the party for that time or position. *Id.* at 47 (citing Ex. 1007, 12:50–13:28, 16:56–18:29, 20:15–21:34).

Patent Owner contends that “Waytena does not mention a ‘reservation computer,’ which is an element of ’983 Patent claim 21.” Prelim. Resp. 43 (citing Ex. 2001 ¶ 243). Petitioner further argues that “these elements and functions of Waytena alleged to motivate a PHOSITA to make the combination,” i.e., a computer and ensuring crowd conditional and operating status are taken into account, “are already present in Sim (in view of Doi) without any contribution from Waytena.” Prelim. Resp. 43 (citing Ex. 2001 ¶¶ 245–247).

We find that Petitioner has, on this record, sufficient support for its contention that Waytena teaches a “reservation computer.” Waytena discloses “a reservation system 100” that comprises a “plurality of attraction computers 101,” each associated with a particular attraction. Ex. 1007, 5:12–15. Regarding Patent Owner’s position that Petitioner’s reasoning is insufficient, we find potential merit in Patent Owner’s evidence and arguments, but do not find them sufficient, at this stage, to negate Petitioner’s reasonable likelihood of prevailing.

Thus, after considering the parties' arguments and evidence as presented, we determine that at this stage, Petitioner has demonstrated a reasonable likelihood of establishing that the combination of Sim, Doi, and Waytena teaches claim 21.

4. *Conclusion of Ground 2*

Having considered the parties' arguments and evidence, we find, based on the evidence presented at this stage of the proceeding, Petitioner has demonstrated a reasonable likelihood of prevailing on its assertion that dependent claims 14, 18, and 21 would have been obvious over Sim, Doi, and Waytena to support institution under Ground 2.

H. GROUND 3 — ALLEGED OBVIOUSNESS OVER WAYTENA —
CLAIMS 1, 3–5, 8, 10, 12–14, 16–21, AND 23–25

Petitioner challenges claims 1, 3–5, 8, 10, 12–14, 16–21, and 23–25 as unpatentable under 35 U.S.C. § 103 over Waytena. Pet. 48–69. Specifically, regarding independent claim 1, Petitioner argues Waytena discloses 1[pre], 1[a], 1[b], 1[d], and 1[e] and renders obvious 1[c]. Pet. 48–59. The preamble, limitations, and whereby clause of independent claim 3 are nearly identical to those of independent claim 1, and Petitioner asserts claim 3 is obvious over Waytena for the same reasons provided for claim 1. Pet. 59.

Patent Owner contends “Waytena was already considered and rejected by the Examiner during prosecution.” Prelim. Resp. 44. Patent Owner further argues that “Petitioner’s proposed reconfiguration of Waytena’s mechanisms to match their hypothetical user interface would not have been obvious to a PHOSITA at the time of the invention as claimed in the ’983 Patent.” *Id.* at 48.

After considering the parties' arguments and evidence, and because Waytena was previously provided and we discern no error on the part of the Examiner, Petitioner has not demonstrated a reasonable likelihood of prevailing on its assertion that claims 1, 3–5, 8, 10, 12–14, 16–21, and 23–25 would have been obvious over Waytena to support institution under Ground 3. We turn now to detailed discussions of the challenged claims, with claim 1 as representative.

1. Independent Claims 1 and 3

- a) Limitation [pre] — “A system for providing an itinerary to a party, said itinerary comprising a second set of attractions selected from a first set of attractions”

Petitioner contends that, to the extent limiting, Waytena discloses the preamble in having a system that provides an itinerary to a group of patrons, i.e., a party, through PCDs. Pet. 48–49 (citing Ex. 1007, 2:58–65, 6:59–7:8, Fig. 2). The PCDs, asserts Petitioner, collect information from the party regarding age, sex, height, weight, preferences, and flags for characteristics and stores the information in a record. *Id.* at 49 (citing Ex. 1007, 7:9–31, 13:44–14:35, Figs. 2, 2A, 5A). Petitioner asserts the PCDs also store attraction data including, age, height and weight restrictions, location, operating hours, and flags for characteristics. *Id.* (citing Ex. 1007, 7:52–8:31, Figs. 2, 2B). Waytena's itinerary, Petitioner contends, is created from Waytena's system matching a party's information with the attraction information and displaying the resulting attractions along with scheduled times to visit those attractions. *Id.* at 50 (citing Ex. 1007, 14:13–24, 15:3–16:15, 7:2–8:67, 11:18–61, 12:13–13:28, Figs. 1–4, 5B).

We further note that the Examiner made no specific finding regarding the preamble. Ex. 1002, 9–10, 21–25.

Patent Owner does not present specific argument against the preamble. *See* Prelim. Resp. 44–57.

After considering the parties’ arguments and evidence as presented, and without determining whether the preamble is limiting, we determine that at this stage Petitioner has demonstrated a reasonable likelihood of establishing that Waytena teaches the preamble.

b) Limitation 1[a] — “data regarding said first set of attractions”

Petitioner contends, as discussed above, that Waytena’s system’s data on attractions stored in the PCDs and in the attraction computers meet this limitation. Pet. 51–52 (citing Ex. 1007, 7:60–8:31, 11:18–12:13, Figs. 2B, 2E).

The Examiner made similar findings. Ex. 1002, 9, 21.

Patent Owner does not present specific argument against this limitation. *See* Prelim. Resp. 44–57.

Thus, after considering the parties’ arguments and evidence as presented, we determine that at this stage, Petitioner has demonstrated a reasonable likelihood of establishing that Waytena discloses limitation 1[a].

c) Limitation 1[b] — “information about said party, at least a portion of said information distinguishing among said first set of attractions with respect to said data”

Petitioner contends that this limitation is met with Waytena’s information on patrons as entered by them regarding age, weight, height, health, and attraction and ride preferences. Pet. 52 (citing Ex. 1005, 7:9–31, 13:44–14:35, Figs. 2, 2A, 5A). Petitioner argues that at least a portion of this information “distinguishes attractions certain parties are allowed to

attend (e.g., where the parties meet age, height, and weight restrictions) from those they are not allowed to attend.” *Id.* at 54 (citing Ex. 1003 ¶ 141).

The Examiner made similar findings. Ex. 1002, 9, 21.

Patent Owner does not present specific argument against this limitation. *See* Prelim. Resp. 5–6, 21–29.

Thus, after considering the parties’ arguments and evidence as presented, we determine that at this stage, Petitioner has demonstrated a reasonable likelihood of establishing that Waytena discloses limitation 1[b].

d) Limitation 1[c] — “a computer having access to said data and said information, said computer having software that selects said second set of attractions from said first set of attractions, said second set of attractions consisting of at least some of said first set of attractions for which said data substantially matches with said information”

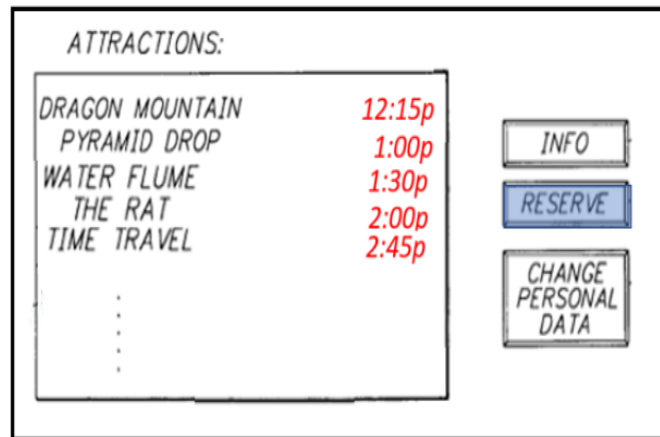
Petitioner contends that Waytena’s PCD is a computer with stored attraction and patron records and software modules, and meets the claimed computer having access to the data of limitation 1[a] and information of limitation 1[b]. Pet. 17 (citing Ex. 1007, 5:59–6:15, 6:59–8:31, 13:44–14:2, Figs. 1A, 2, 2A, 2B). Petitioner argues that Waytena’s “modules can cause the user interface to present ‘a list of attractions that match the particular preferences of the members of the patron’s group,” and that this means “the software can select a list of recommended attractions to display, by determining which attractions ‘match’ the party’s preferences computer.” *Id.* at 54–55 (citing Ex. 1007, 14:33–35, Fig. 5B; Ex. 1003 ¶ 145).

Alternatively, Petitioner argues that because Waytena discloses the PCD selecting and presenting attractions matching party preferences in a selectable list selectable to schedule reservations, “at the very least, it would

have been obvious over Waytena to simply present this list with proposed reservation times . . . for each recommended attraction.” *Id.* at 55.

Petitioner then provides a modified and annotated display of Waytena’s Figure 5B having attraction times, reproduced below.

Selected Matching Attractions and Times



The above picture depicts, in red, Petitioner’s annotations and proposed modification to Waytena’s display.

Petitioner argues that a person skilled in the art would recognize that Waytena “can” do this and would understand that the PCD “could simply use” the party’s selected “‘next available time’ as a default and create a complete itinerary itself.” Pet. 56–57 (citing Ex. 1003 ¶¶ 147–151).

Petitioner asserts, “[t]hus, these existing processes in Waytena *could* be used to present a list of matching attractions and proposed times to visit, without the party having to click on each one.” *Id.* at 57 (emphasis added).

Patent Owner first contends that “Waytena was already considered and rejected by the Examiner during prosecution.” Prelim. Resp 44; *see also id.* at 16–19. We find that Patent Owner has, on this record, sufficient support for its contention that Waytena was previously considered by Examiner and rejected. In the Notice of Allowance mailed on January 19,

2007, the Examiner specifically entered authorized amendments replacing the term of software “operable to select” with software “that selects.”

Ex. 1002, 9. The Examiner further found that Waytena does not disclose its computer having software that selects the second set of attractions from the first set. *Id.* We are not convinced the Examiner failed to consider whether Waytena renders the claims obvious, because the Examiner did consider Waytena in combination with other art in determining some claims obvious. *See* Ex. 1002, 23–24.

Patent Owner also contends “Petitioner’s proposed reconfiguration of Waytena’s mechanisms to match their hypothetical user interface would not have been obvious to a PHOSITA at the time of the invention as claimed in the ’983 Patent.” Prelim. Resp. 48. Patent Owner argues that such a person “would not perceive this as achieving Waytena’s intended purpose” to “address the ‘inability of patrons to communicate their intention to attend particular attractions, and in effect, request a reservation for an attraction’ by ‘allow[ing] patrons to . . . make reservations for certain ones of these [attractions].’” *Id.* at 46, 48 (alterations in original) (citing Ex. 2001 ¶¶ 105–108 and quoting Ex. 1007, 1:48–50, 2:31–35). Further, Patent Owner contends, the proposed configuration would not “produce the same results as asserted by the Petitioner.” Prelim. Resp. 48; *see also id.* at 49–55. For example, Petitioner’s annotated and modified version of Waytena’s Figure 5B omits buttons and lists and is motivated by hindsight. *Id.* at 53, 55.

Waytena discloses that while the PCD is in an idle state, the user interface can present to the patron a scrollable list of available attractions, buttons for information, reservations, and changes, and also “a list of attractions that match the particular preferences of the members of the

patron's group or that are in relative proximity to the patron's current location." Ex. 1007, 14:13–24. The user can select an attraction for which to make a reservation. *Id.* at 14:33–44, Fig. 5B.

We find that Patent Owner has, on this record, sufficient support for its contention that Petitioner's proposed modification of Waytena and reasoning for the modification is based on hindsight. Waytena teaches recommending an attraction, and Petitioner asserts that amounts to an automatic selection but does not explain how it meets the claimed "software that selects" a second set of attractions from the first set based on a substantial match with the information to create an itinerary. Further, Petitioner provides how Waytena *can* be modified and that one *could* do so, but does not provide adequate reasoning why one *would* modify Waytena as proposed. *See, e.g., Belden Inc.*, 805 F.3d at 1073. Specifically, Petitioner asserts that Waytena's "PCD could simply use 'next available time' as a default and create a complete itinerary itself." Pet. 56–57. That is insufficient without further justification.

Thus, after considering the parties' arguments and evidence as presented, we determine that at this stage, Petitioner has not demonstrated a reasonable likelihood of establishing that Waytena teaches limitation 1[c].

e) Limitation [d] — "a presentation means in communication with said computer, said presentation means able to receive said itinerary from said computer and present said itinerary to said party"

Petitioner contends that Waytena's user interface on the PCDs presents its itinerary to the party and meets the claimed presentation means. Pet. 57–58 (citing Ex. 1007, 14:30–20, Fig. 5B).

The Examiner made similar findings. Ex. 1002, 9, 21.

Patent Owner does not present specific argument against this limitation. *See* Prelim. Resp. 5–6, 21–29.

After considering the parties’ arguments and evidence as presented, we determine that at this stage Petitioner has demonstrated a reasonable likelihood of establishing that Waytena teaches limitation 1[d].

f) Limitation [e] — “whereby said itinerary is customized for said party”

Petitioner contends that “[t]o the extent limiting, Waytena discloses that is “PCDs can create a custom itinerary for a park visit based on a party’s personal information.” Pet. 58 (citing Ex. 1007, 14:13–24, 5:59–6:15, 7:2–8:67, 11:18–61, 12:13–13:28, 15:3–6, Figs. 1–4, 5B).

The Examiner made similar findings. Ex. 1002, 9, 21. Patent Owner does not present specific argument against this limitation. *See* Prelim. Resp. 5–6, 21–29.

After considering the parties’ arguments and evidence as presented, and without determining whether the preamble is limiting, we determine that at this stage Petitioner has demonstrated a reasonable likelihood of establishing that Waytena teaches element 1[e].

g) Summary of Claims 1 and 3

After considering the parties’ arguments and evidence, we determine that at this stage, Petitioner has not demonstrated a reasonable likelihood of establishing obviousness of Waytena of independent claims 1 and 3.

Nevertheless, because we institute a trial on other grounds, we institute a trial on this ground as well. *See* 37 C.F.R. § 42.108(a) (“When instituting inter partes review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.”). *See also SAS*, 138 S. Ct. 1359–60.

2. *Conclusion of Ground 3*

Because we institute a trial on other grounds, we institute a trial on this ground as well for claims 1, 3–5, 8, 10, 12–14, and 16–21. *See* 37 C.F.R. § 42.108(a); *SAS*, 138 S. Ct. 1359–60.

I. GROUND 4 — ALLEGED OBVIOUSNESS OVER WAYTENA IN VIEW OF HERZ — CLAIMS 1, 3–5, 8, 10, 12–14, 16–21, AND 23–25

1. *Discussion*

Petitioner challenges claims 1, 3–5, 8, 10, 12–14, 16–21, and 23–25 as unpatentable under 35 U.S.C. § 103 over Waytena in view of Herz. Pet. 69–73. Petitioner, discussing independent claims 1 and 3 as representative of the group of claims in this Ground, contends that “[t]o the extent Waytena is determined not to disclose or render obvious certain elements of claims 1 and 3 . . . , such would have been obvious over Waytena in view of Herz.” *Id.* at 69–70.

Specifically, Petitioner argues that, with regard to limitations 1[c] and 1[e] and the corresponding limitations in claim 3, the combination of Waytena and Herz “renders obvious Waytena’s PCD presenting an itinerary, or schedule, of computer-selected attractions, without the party having to select which attractions to include.” Pet. 70. Petitioner asserts that Waytena and Herz both relate to “assist[ing] parties in identifying and scheduling desirable attractions (e.g., theme park rides in Waytena and movies or shows in Herz).” *Id.*

Petitioner alleges that Herz teaches “minimiz[ing] the need for parties to manually search for and select content, with the computer automatically selecting and scheduling matching content using an ‘agreement matrix.’” Pet. 70–71 (citing Ex. 1008, 1:38–47, 4:18–5:22, 19:5–65, 22:7–23:18). According to Petitioner, “Herz’s computer selects programs for time slots

that match a party’s profile” and “generates a custom schedule of programs for parties, without the party having to select which recommended programs to include in the schedule.” *Id.* at 71 (citing Ex. 1008, 2:65–3:16, 4:18–5:52, 6:53–7:55, 9:61–13:54, 19:5–65, 22:7–23:18, 24:53–25:30, Figs. 1–3; Ex. 1003 ¶¶ 178–181).

Petitioner asserts that it would have been obvious to apply Herz’s teachings to Waytena to have Waytena’s computer automatically select and schedule content. Pet. 71–72 (citing Ex. 1003 ¶¶ 182–184). And, Petitioner contends that a person of ordinary skill in the art would have done so to “no longer hav[e] to manually select each attraction they want to attend during their visit,” to “simply accept an entire list of attractions **and** proposed timed (e.g., a customized itinerary) without having to schedule reservations for each individual attraction.” *Id.* at 72 (citing Ex. 1003 ¶ 182).

Patent Owner contends that Herz, like Waytena, “teaches *selection by the user.*” Prelim. Resp. 66 (citing Ex. 2001 ¶ 163). Further, Patent Owner argues that Waytena and Herz are not analogous art. *Id.*

There are two separate tests for whether a reference is analogous art to the *claimed invention*: (1) the reference is from the same field of endeavor as the claimed invention (even if it addresses a different problem); **or** (2) the reference is reasonably pertinent to the problem faced by the inventor (even if it is not in the same field of endeavor as the claimed invention). *See, e.g., Netflix, Inc. v. DivX, LLC*, 80 F.4th 1352, 1358 (Fed. Cir. 2023); *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004).

Patent Owner provides that Waytena is in the field of endeavor of “scheduling patron reservations in facilities offering numerous attractions” whereas Herz is in the different field of “controlling broadcast of and/or customer access to data such as video programs.” Prelim. Resp. 66–67

(quoting Ex. 1007, 1:8–9; Ex. 1008, 1:2–3 and citing Ex. 2001 ¶¶ 146, 150, 151)

Patent Owner acknowledges that Waytena is analogous art to the '983 patent because both “belong to a common field of invention, each aiming to guide guests to desirable attractions.” Prelim. Resp. 67 (citing Ex. 2001 ¶ 149). However, Patent Owner argues, Herz is not analogous art because “scheduling broadcast of video programs and other data” is a different field than that of the '983 patent, Herz’s programs do not have a location, its customers do not travel between programs, and its optimization’s purpose is to draw the largest audience with an unlimited viewing capacity. *Id.* (citing Ex. 1008, 23:21–50, 34:11; Ex. 2001 ¶ 150).

Patent Owner also argues, that “given the substantial dissimilarities in the fundamental nature of the resources and how they are managed in Waytena and Herz, a PHOSITA would not recognize or anticipate any meaningful contribution that Herz’s domain—scheduling a television broadcast—could make to generating an itinerary.” *Id.* at 67–68 (citing Ex. 2001 ¶ 151). Thus, Patent Owner contends, there would be no motivation for the proposed combination. *Id.* at 68; *see also id.* at 69.

We find that Petitioner has, on this record, sufficient support for its contention that the combination of Waytena and Herz teaches claims 1, 3–5, 8, 10, 12–14, 16–21, and 23–25. We find potential merit in Patent Owner’s evidence and arguments that Herz is not analogous art because it is not in the same field of endeavor as the '983 patent nor is it reasonably pertinent to the problem faced by the inventor. However, we do not find them sufficient, at this stage, to negate Petitioner’s reasonable likelihood of prevailing. Moreover, Petitioner has not yet addressed Patent Owner’s argument, and this factual dispute is best resolved through the instituted trial.

2. *Summary of Ground 4*

After considering the parties’ arguments and evidence, we determine that at this stage, Petitioner has demonstrated a reasonable likelihood of establishing obviousness of claims 1, 3–5, 8, 10, 12–14, 16–21, and 23–25 in view of Waytena and Herz. Further, because we institute a trial on other grounds, we institute a trial on this ground as well. *See* 37 C.F.R. § 42.108(a); *SAS*, 138 S. Ct. 1359–60.

However, we deem the issue raised by Patent Owner regarding non-analogous art suited for resolution on a fuller record during *inter partes* review, given our determination that Petitioner has demonstrated a reasonable likelihood of showing the claims 1 and 3 would have been obvious over Waytena and Herz.

J. GROUND 5 — ALLEGED OBVIOUSNESS OVER WAYTENA (ALONE OR AS MODIFIED BY HERZ) IN VIEW OF SIM — CLAIM 7

1. *Discussion*

Petitioner contends Waytena (alone or as modified by Herz) in view of Sim renders dependent claim 7 obvious. Pet. 73–74. Petitioner alleges that Sim teaches the party information including privileges and the parties with these privileges receiving priority over others in including certain attractions in their itinerary. Pet. 73; *see also id.* at 25–26.

Patent Owner argues that “[c]laim 7 would not have been obvious over Waytena (as modified by Herz) due to the reasons already expressed during the original prosecution of the ’983 Patent.” Prelim. Resp. 70 (citing Ex. 2001 ¶ 170; Ex. 1002, 48:22–49:3). Patent Owner further argues that dependent claim 7 is not invalid based on its dependence from independent claim 3. *Id.* Patent Owner does not present separate argument against the Petitioner’s proposed modification of Waytena with Sim.

We find that Petitioner has, on this record, sufficient support for its contention that the combination of Waytena, Herz, and Sim teaches dependent claim 7.

2. *Summary of Ground 5*

Thus, after considering the parties' arguments and evidence, we determine that at this stage, Petitioner has demonstrated a reasonable likelihood of establishing obviousness of dependent claim 7 over Waytena, Herz, and Sim to support institution.

K. GROUND 6 — ALLEGED OBVIOUSNESS OVER WAYTENA (ALONE OR AS MODIFIED BY HERZ) IN VIEW OF DOI — CLAIMS 11 AND 22

1. *Dependent claim 11 – “The method of claim 3, wherein said information comprises a third set of attractions previously selected for said party, said third set consisting of an already visited portion and a remaining portion, wherein said party forgoes said remaining portion due to an interruption, wherein in step d) said software selects said second set of attractions as a replacement for said remaining portion, and wherein said second set of attractions substantially excludes said already visited portion, whereby said interruption is overcome.”*

Petitioner contends Waytena (alone or as modified by Herz) in view of Doi renders dependent claim 11 obvious. Pet. 74–76. Specifically, Petitioner asserts that Doi “discloses that where rides have long wait times, it will select replacement rides for parties so as ‘to take a measure for the waiting time to be shorter,’” and refers to the discussion in Ground 2 for claim 11. Pet. 74–75. In Ground 2, Petitioner argues that “Doi contemplates ‘interruptions,’ including where rides have ‘abnormally long wait times’ due to being overcrowded.” *Id.* at 28 (citing Ex. 1006, 8:20–45, 9:36–10:11). Petitioner asserts that “[i]n Waytena, a party receives an itinerary (‘third set of attractions’), and as the party proceeds through the day, some attractions

will have been visited and some will remain.” *Id.* at 75 (citing Ex. 1003 ¶ 191). And, Petitioner asserts that Waytena teaches that patrons may change or cancel reservations to overcome interruptions of “attraction malfunctions.” *Id.* (citing Ex. 1007, 11:1–17, 19:20–60).

Petitioner argues that a person of ordinary skill in the art “would have been motivated to include replacement attractions, as taught by Doi, when updating Waytena’s itinerary, so as to make up for attractions a party had to miss because of the interruption, while excluding those already visited.” Pet. 75–76 (citing Ex. 1003 ¶ 192).

Patent Owner contends that claim 11 would not have been obvious over Waytena, Herz, and Doi “due to the reasons already expressed during the original prosecution of the ’983 Patent,” i.e., “[s]ince the invention of [Waytena] does not select attractions, there is no mechanism proposed by Waytena to select replacement attractions that substantially avoid attractions already visited.” Prelim. Resp. 70–71 (citing Ex. 2001 ¶ 171; Ex. 1002, 51:4–15). Patent Owner does not provide specific argument against the combination proposed by Petitioner.

We find that Petitioner has, on this record, sufficient support for its contention that the combination of Waytena, Herz, and Doi teaches dependent claim 11.

2. *Dependent claim 22 – “The method of claim 3 wherein in step d) said software applies a perturbation to a desirability of a first attraction of said first set of attractions, said perturbation producing a different result for said second set, thereby redistributing a directed demand corresponding to said first attraction to mitigate at least one selected from the group consisting of underutilization of said first attraction, excessive demand for said first attraction.”*

Petitioner contends Waytena (alone or as modified by Herz) in view of Doi renders dependent claim 22 obvious. Pet. 76–77. Specifically, Petitioner asserts that Doi “discloses the additional elements of claim 22,” in teaching mitigation of attraction underutilization and excessive demand by guidance to a non-crowded attraction, and Petitioner refers to the discussion in Ground 2 for claim 22. *Id.* In Ground 2, Petitioner argues that “[r]egarding the software applying a ‘perturbation to a desirability’ of an attraction, the ’983 [patent] teaches the perturbation function can change the ‘desirability of an attraction,’ so that not all users are directed to the same attraction,” and “Sim in view of Doi renders this obvious.” *Id.* at 37 (citing Ex. 1001, 24:15–50; Ex. 1003 ¶ 106). Petitioner argues that Doi teaches address the selecting attractions based on age “will not always cause a customer to move as planned,” and “Doi can address this by making an attraction more desirable to certain parties.” *Id.* (citing Ex. 1006, 10:48–11:35; Ex. 1003 ¶ 106).

Patent Owner argues that Doi relies on users to select attractions so “there is no software to apply a perturbation to a desirability of a first attraction of the first set of attractions.” Prelim. Resp. 38, 71 (citing Ex. 2001 ¶ 222).

At this stage, the parties’ disputes regarding claim 22 are substantively the same as the parties’ disputes regarding independent

claims 1 and 3 regarding what is selected by software. Pet. 49–58; Prelim. Resp. 25–27, 31–42. Accordingly, our discussion of those disputes in Section III.G above also applies to the parties’ disputes regarding dependent claim 22.

We find that Petitioner has, on this record, sufficient support for its contention that the combination of Waytena, Herz, and Doi teaches dependent claim 22.

3. *Summary of Ground 6*

Thus, after considering the parties’ arguments and evidence, we determine that at this stage, Petitioner has demonstrated a reasonable likelihood of establishing obviousness of dependent claims 11 and 22 over Waytena, Herz, and Doi to support institution.

IV. CONCLUSION

For the foregoing reasons, we determine that Petitioner demonstrates a reasonable likelihood of prevailing with respect to at least one of the claims challenged in the Petition. Accordingly, *inter partes* review of the ’983 patent shall proceed in this case on all of the grounds raised in the Petition. *See SAS*, 138 S. Ct. at 1359–60; *PGS Geophysical*, 891 F.3d at 1360.

Our determination in this Decision is not a final determination on either the patentability of any Challenged Claims or the construction of any claim term. The factual findings set forth in this Decision are preliminary and provided for the sole purpose of deciding whether to institute a review. Our final decision will be based on the record as fully developed during trial, including all arguments and evidence in the Patent Owner’s Response, Petitioner’s Prelim. Resp., or submitted otherwise during trial, as permitted by our rules. *See Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed.

Cir. 2016) (noting that “there is a significant difference between a petitioner’s burden to establish a ‘reasonable likelihood of success’ at institution, and actually proving invalidity by a preponderance of the evidence at trial”) (quoting 35 U.S.C. § 314(a) and comparing *id.* with § 316(e)).

V. ORDER

Upon consideration of the record before us, it is:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1, 3–5, 7–8, 10–14, and 16–25 of U.S. Patent No. 7,212,983 B2 is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of U.S. Patent No. 7,212,983 B2 shall commence on the entry date of this Order, and notice is hereby given of the institution of a trial.

IPR2024-00029
Patent 7,212,983 B2

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