

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FREEWHEEL MEDIA, INC.,
Petitioner,

v.

ALMONDNET, INC.,
Patent Owner.

IPR2024-00413
Patent 7,979,307 B2

Before LYNNE H. BROWNE, CHARLES J. BOUDREAU, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

BROWNE, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

FreeWheel Media, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting institution of an *inter partes* review of claims 1–7 and 9 of U.S. Patent No. 7,979,307 B2 (Ex. 1001, “the ’307 Patent”). AlmondNet, Inc. (“Patent Owner”) timely filed a Preliminary Response. Paper 9 (“Prelim. Resp.”). The ’307 Patent is also the subject of two other petitions for *inter partes* review (IPR2024-00414 and IPR2024-00415) challenging the same claims as challenged in the instant petition and filed by Petitioner on the same day. Pet. vii.

Patent Owner’s Preliminary Response does not address the merits of Petitioner’s challenges. Instead, Patent Owner contends that the Board should exercise its discretion to deny two of the three parallel petitions Petitioner has filed. *See* Prelim. Resp. 1, 4–8. Alternatively, Patent Owner contends the Board should deny institution because the Petition violates the particularity requirement of 35 U.S.C. § 312(a)(3) “by setting forth *twenty* express grounds of invalidity.” *Id.* at 1. Patent Owner contends further that the three parallel petitions “cumulatively set forth *forty-one* express grounds of invalidity relying on *seventeen* prior art references and at least *twenty-three* more ‘shadow’ references.” *Id.*

We have authority to determine whether to institute review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). An *inter partes* review may not be instituted unless it is determined that “the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a).

For the reasons discussed below, we determine, based on the record before us, that there is a reasonable likelihood Petitioner would prevail in showing at least one of the challenged claims is unpatentable. Furthermore, we deny Patent Owner's request that we exercise our discretion to deny institution in this proceeding based on the filing by Petitioner of two additional parallel petitions or due to the alleged lack of particularity in the instant Petition. We therefore institute *inter partes* review on all claims and all grounds. *See SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348 (2018).

B. Real Parties in Interest

Petitioner identifies the following real parties-in-interest: “(i) FreeWheel Media, Inc., (ii) Beeswax.io Corp., (iii) Comcast Corporation, (iv) Comcast Cable Communications, LLC, and (v) Comcast Cable Communications Management, LLC.” Pet. vii. Patent Owner identifies itself, “AlmondNet, Inc.,” as the only real party in interest. Paper 6, 1.

C. Related Matters

The parties identify the following as related district court matters: *AlmondNet, Inc. v. LinkedIn Corporation*, No. 1:23-cv-01373 (D. Del.); *AlmondNet, Inc. v. FreeWheel Media, Inc.*, No. 1:23-cv-00220 (D. Del.); and *AlmondNet, Inc. v. Viant Technology Inc.*, No. 1:23-cv-00174 (D. Del.) (“District Court Actions”). Pet. vii; Paper 6, 1. The parties also identify the following co-pending petitions challenging the '307 Patent: IPR2024-00414 and IPR2024-00415. *Id.* Petitioner also identifies *Yahoo! Inc. v. AlmondNet, Inc.*, CBM2017-00049 (PTAB) as challenging claims of the '307 patent.

Petitioner further identifies the following district court litigation as involving “the '307 patent or its related patents”: *AlmondNet, Inc., v.*

Samsung Electronics Co., 4-22-cv-07515 (N.D. Cal.); *AlmondNet, Inc. v. Meta Platforms, Inc.*, 4-23-cv-00438 (N.D. Cal.); *Roku, Inc. v. AlmondNet, Inc.*, 1-21-cv-01035 (D. Del.); *AlmondNet, Inc. v. Roku, Inc.*, 1-22-cv-01540 (D. Del.); *AlmondNet, Inc. v. Amazon.com, Inc.*, 6-22-cv-01204 (W.D. Tex.); *AlmondNet, Inc. v. Meta Platforms, Inc.*, 6-22-cv-01205 (W.D. Tex.); *AlmondNet, Inc. v. Microsoft Corp.*, 6-22-cv-01206 (W.D. Tex.); *AlmondNet, Inc. v. Meta Platforms, Inc.*, 4-22-cv-08911 (N.D. Cal.); *AlmondNet, Inc. v. Roku, Inc.*, 6-21-cv-00731 (W.D. Tex.); *AlmondNet, Inc. v. Facebook, Inc.*, 6-21-cv-00896 (W.D. Tex.); *AlmondNet, Inc. v. Microsoft Corp.*, 6-21-cv-00897 (W.D. Tex.); *AlmondNet, Inc. v. Amazon.com, Inc.*, 6-21-cv-00898 (W.D. Tex.); *AlmondNet, Inc. v. Samsung Electronics Co.*, 6-21-cv-00891 (W.D. Tex.); *AlmondNet, Inc. v. Roku, Inc.*, 6-21-cv-00876 (W.D. Tex.); *AlmondNet, Inc. v. Oath Holdings Inc.*, 1-19-cv-00247 (D. Del.); and *AlmondNet, Inc. v. Yahoo! Inc.*, 1-16-cv-01557 (E.D.N.Y.).

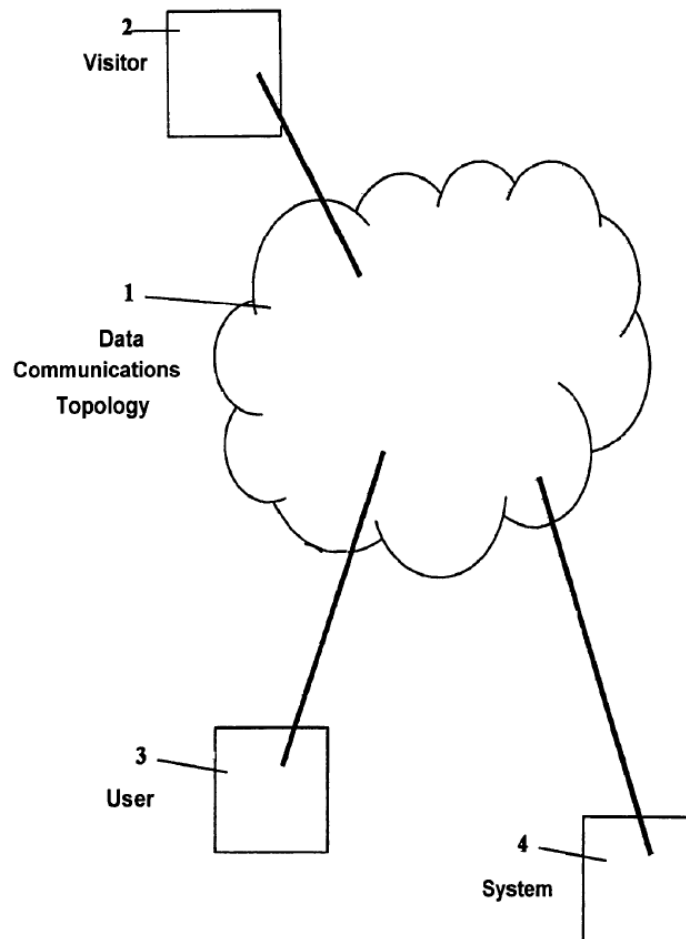
Petitioner further identifies the following terminated PTAB proceedings as involving patents related to the '307 Patent: *Yahoo! Inc. v. AlmondNet, Inc.*, CBM2017-00050; *Yahoo! Inc. v. AlmondNet, Inc.*, CBM2017-00051; *Yahoo! Inc. v. AlmondNet, Inc.*, CBM2017-00052; *Samsung Electronics Co. v. AlmondNet, Inc.*, IPR2022-01260; *Amazon.com, Inc. v. AlmondNet, Inc.*, IPR2022-01455; and *Meta Platforms, Inc. v. AlmondNet, Inc.*, IPR2022-01436.

Petitioner also indicates that it has filed three petitions for *inter partes* review against U.S. Patent No. 8,775,249, which is related to the '307 Patent, namely IPR2024-00416, IPR2024-00417, and IPR2024-00418. Pet. vii–viii.

D. The '307 Patent

The '307 Patent for a “Method and Stored Program for Accumulating Descriptive Profile Data Along with Source Information for Use in Targeting Third-Party Advertisements,” “relates to a mercantile method” and “[m]ore specifically, the present invention relates to a mercantile method directed to brokerage of attributes of information.” Ex. 1001, code (54), 1:23–27.

Figure 1, reproduced below, is “a schematic view of an Internet data communications topology.” Ex. 1001, 4:44–45.



As shown in Figure 1, the data-communications topology includes “a wide area network (e.g. the Internet) (1) having interconnected thereto a visitor

(2), a user (3), and a system (4) embodying the method of the present invention.” *Id.* at 4:58–62.

Figure 2, reproduced below, is “a schematic view of a system using the descriptive-profile mercantile method.” Ex. 1001, 4:46–47.

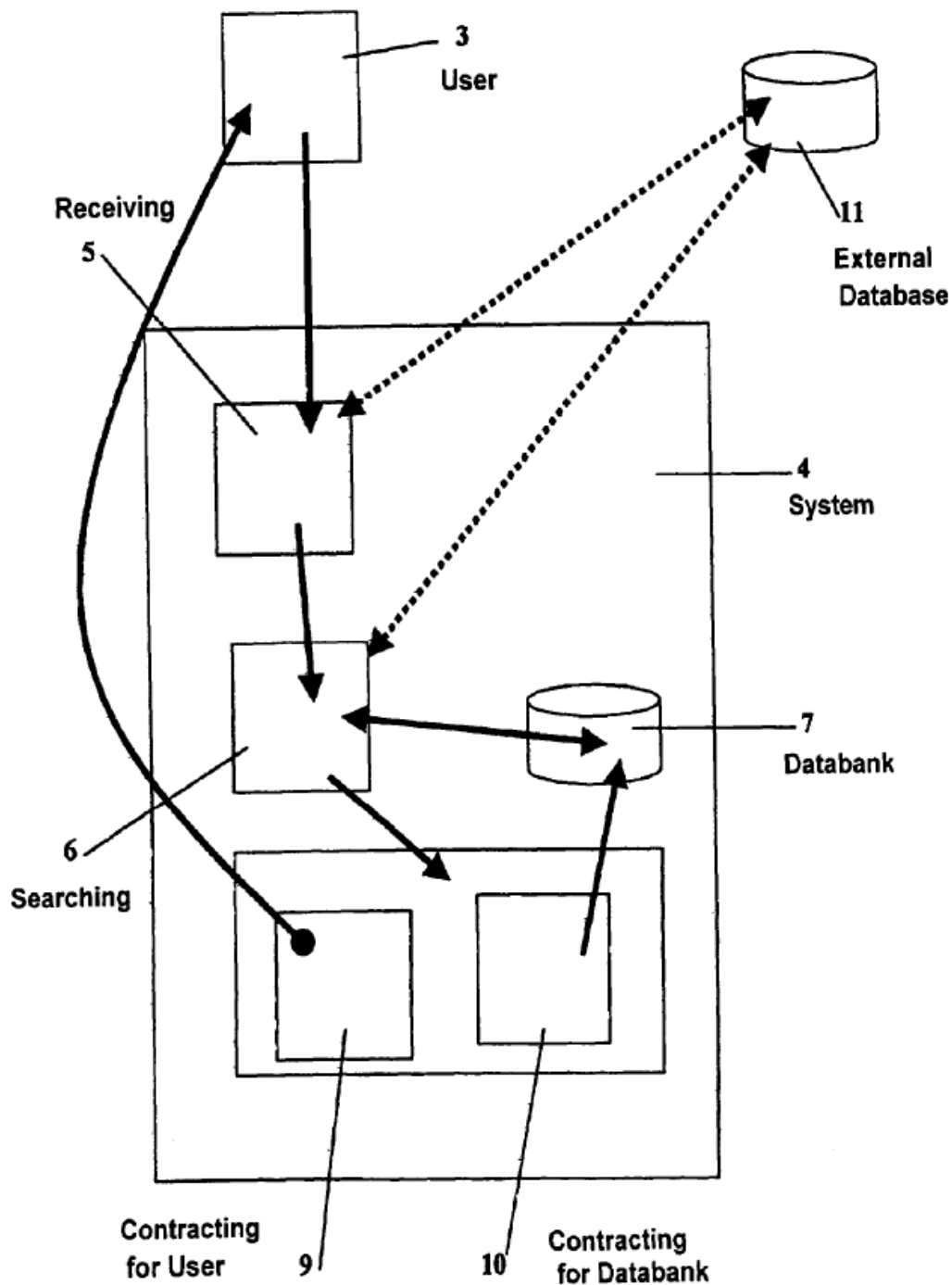


Figure 2 depicts “a descriptive-profile mercantile method” “for use at a juncture in a data-communications topology having associated therewith a maintained databank of partial profiles.” *Id.* at 4:63–66. The method shown in Figure 2 includes the steps of:

- (a) from a user (3), receiving (5) a transaction having therein a first partial profile;
- (b) using the first partial profile, searching (6) a databank (7) having a plurality of second partial profiles, wherein is included in said databank at least one null profile so that said searching will always yield at least one proximate second partial profile to the first partial profile;
- (c) between the user and the databank, contracting:
 - i. (10) for the databank to own or represent a right to a first mutually agreed portion of the first partial profile, and Substantially thereafter said databank incorporating the agreed portion of the first profile into at least one second partial profile; or
 - ii. (9) for the user to own or represent a right to a second mutually agreed portion of at least one said proximate second partial profile, and substantially thereafter the databank transmitting to the user the second mutually agreed portion of the second profile.

Ex. 1001, 5:1–18. The ’307 patent also discloses “an additional embodiment” wherein “receiving a transaction includes consulting an external database (11).” *Id.* at 5:49–51.

E. Challenged Claims

Petitioner challenges claims 1–7 and 9. Pet. 1. Petitioner indicates that “[c]laims 8 and 10 have been disclaimed.” *Id.* Claim 1, reproduced below, is illustrative of the claims at issue in this proceeding. Ex. 1001, 16:36–60.

1. An automated method of collecting profiles of Internet-using entities, the method comprising:

(a) electronically receiving at a programmed computer system coupled to a global computer network, from at least one server controlled by one of a plurality of unaffiliated third parties operating respective websites, a partial profile of an entity that uses a user computer coupled to the global computer network and accessing the website, which partial profile contains at least one profile attribute related to the entity, and automatically with the computer system storing the received partial profile;

(b) wherein receiving the partial profile is achieved by automatic electronic URL redirection from a portion of a page of the website accessed by the user computer;

(c) automatically with the computer system electronically adding the received partial profile to a maintained profile believed to be related to the same entity;

(d) automatically with the computer system generating and storing an electronic record of which of the plurality of unaffiliated third parties contributed to the maintained profile particular profile attributes;

(e) wherein the maintained profile, including the added partial profile, comprises data used in targeting third-party advertisements to the user computer over the global computer network.

F. Asserted Grounds of Unpatentability

Petitioner asserts that claims 1–7 and 9 are unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §¹	Reference(s)/Basis
1–3, 7, 9	103	Merriman, ² Jaye ³
1–3, 7, 9	103	Roth, ⁴ Jaye
1–3, 7, 9	103	Merriman, Minor ⁵
1–3, 7, 9	103	Roth, Minor
4–6	103	Merriman, Jaye, Coleman ⁶
4–6	103	Merriman, Minor, Coleman
4–6	103	Roth, Jaye, Coleman
4–6	103	Roth, Minor, Coleman
2	103	Merriman, Jaye, Herz ⁷
2	103	Merriman, Minor, Herz
2	103	Roth, Jaye, Herz
2	103	Roth, Minor, Herz
3, 6	103	Merriman, Jaye, Gardner ⁸
3, 6	103	Merriman, Minor, Gardner
3, 6	103	Merriman, Jaye, Herz, Gardner
3, 6	103	Merriman, Minor, Herz, Gardner
3, 6	103	Roth, Jaye, Gardner
3, 6	103	Roth, Minor, Gardner
3, 6	103	Roth, Jaye, Herz, Gardner
3, 6	103	Roth, Minor, Herz, Gardner

¹ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. § 103, effective March 16, 2013. Because the ’307 patent issued from an application filed before that date, we refer to the pre-AIA version of § 103.

² Merriman et al., U.S. Patent No. 5,948,061, issued Sept. 7, 1999 (Ex. 1035) (“Merriman”).

³ Jaye, U.S. Patent No. 6,415,322 B1, issued July 2, 2002 (Ex. 1037).

⁴ Roth et al., U.S. Patent No. 6,285,987 B1, issued Sept. 4, 2001 (Ex. 1036) (“Roth”).

⁵ Minor et al., U.S. Patent No. 5,740,252, issued Apr. 14, 1998 (Ex. 1038) (“Minor”).

⁶ Coleman, U.S. Pat. Appl. Pub. 2002/0026351 A1, published Feb. 28, 2002 (Ex. 1039).

⁷ Herz et al., U.S. Pat. Appl. Pub. 2013/0097664 A1, published Apr. 18, 2013 (Ex. 1040) (“Herz”).

⁸ Gardner, U.S. Patent No. 6,141,694, issued Oct. 31, 2000 (Ex. 1043).

II. ANALYSIS

A. *Parallel Petitions*

As noted in the Background, Section I.A, of this Decision, Petitioner filed three Petitions for *inter partes* review of the '307 Patent. IPR2024-00413, IPR2024-00414, IPR2024-00415. Concurrent with the filing of these petitions, Petitioner filed a Petition Ranking and Explanation of Material Differences Between Petitions, ranking its three petitions directed to the '307 patent in accordance with the guidance with respect to parallel petitions in the Board's November 2019 Consolidated Trial Practice Guide. Paper 3; *see* Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), at 59–60 (available at *Available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>). In that Paper, Petitioner ranked the instant Petition first. Paper 3, 1.

Patent Owner contends that “the Board should exercise its discretion and deny institution in this proceeding (IPR2024-00413) because Petitioner has not shown that this is one of the ‘rare’ instances where multiple petitions are needed.” Prelim. Resp. 9.

For reasons discussed in our concurrent Decisions Denying Institution in IPR2024-00414 and IPR2024-00415, we agree with Patent Owner that plural petitions are not warranted. Given our Decisions to Deny Institution in IPR2024-00414 and IPR2024-00415, Patent Owner's argument is unavailing with regard to the instant Petition.

B. *Compliance with 35 U.S.C. § 312(a)(3)*

As noted in the Background, Section I.A, of this Decision, Patent Owner contends that “the Petition violates the requirement of 35 U.S.C. § 312(a)(3) that each petition identifies the grounds on which the challenge to each claim is based ‘with particularity’ by setting forth *twenty* express

grounds of invalidity.” Prelim. Resp. 1. Patent Owner contends that “Petitioner resorts to burying Patent Owner and the Board with scattershot invalidity theories supported by conclusory arguments.” *Id.*

We decline to exercise our discretion to deny this Petition for lack of particularity. Patent Owner’s reliance on *Adaptics* is misplaced. *Adaptics* is distinguishable from this case. In *Adaptics*, the petitioner’s use of “and/or” in its challenges yielded “hundreds of possible combinations.” *Adaptics*, Paper 20 at 19. In addition, the petitioner in *Adaptics* asserted a “catch-all” ground asserting obviousness as an alternative if its extensive anticipation grounds failed. *Id.* at 14. In finding that the petition lacked sufficient particularity, the Board cited this “catch-all” ground as “the worst offender.” *Id.* at 18.

While we agree that the instant Petition could have been more concise, we disagree that it is so “voluminous and excessive” as to warrant denial for lack of sufficient particularity. *See Adaptics*, Paper 20 at 18.

C. Principles of Law for Patentability

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

evidence of nonobviousness.⁹ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

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

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

D. Level of Ordinary Skill in the Art

In determining the level of skill in the art, we consider the type of problems encountered in the art, the prior art solutions to those problems, the rapidity with which innovations are made, the sophistication of the technology, and the educational level of active workers in the field. *Custom Accessories, Inc. v. Jeffrey-Allan Indus. Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986); *Orthopedic Equip. Co. v. United States*, 702 F.2d 1005, 1011 (Fed. Cir. 1983).

⁹ Patent Owner does not present objective evidence of nonobviousness at this stage of the proceeding. *See generally* Prelim. Resp.

Petitioner contends that “[a] person of ordinary skill in the art (‘POSITA’) at the time of the alleged invention would have had a bachelor’s degree in computer engineering, computer science, or a similar discipline, and two years of experience with data communications over the Internet (including Internet advertising) and database management.” Pet. 7 (citing Ex. 1002 ¶¶ 186–191).

Patent Owner does not address the level of skill in the art in its Preliminary Response. Petitioner’s definition appears reasonable, and we determine that the level reflected in the prior art is consistent with Petitioner’s definition. Accordingly, for the purposes of this Decision, we adopt Petitioner’s proposal regarding the level of one of ordinary skill in the art.

E. Claim Construction

We apply the claim construction standard articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), and its progeny. Only terms that are in controversy need to be construed, and then only to the extent necessary to resolve the controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Matal*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (in the context of an *inter partes* review, applying *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

Petitioner states that it “applies AlmondNet’s construction of ‘unaffiliated third part[y/ies]’ as ‘part[y/ies] not having common ownership with the party or parties that control said programmed computer system.’” Pet. 8. Petitioner indicates that “[a]ll other terms have been given their plain and ordinary meaning” although Petitioner also notes that “[i]n related proceedings, certain constructions were proposed and/or adopted.” *Id.* (citing Exs. 1010–1019; Ex. 1002 ¶¶ 192–208). Petitioner asserts that “the

art teaches the claim limitations under any reasonable construction, including any prior construction by the Board or a court.” *Id.* Patent Owner does not address claim construction in its Preliminary Response.

As no claim terms are in controversy, we determine that claim construction is not necessary for purposes of this decision.

*F. Overview of the Prior Art References Discussed Below*¹⁰

1. Merriman (Ex. 1035)

Merriman is a United States patent for a method of delivery, targeting, and measuring advertising over networks that issued September 7, 1999. Ex. 1035, codes (12), (45). In particular, Merriman concerns compiling statistics on individual users and networks and tracking the use of advertisements to permit targeting of the advertisements to individual users. *Id.* at code (57). In response to requests from affiliated sites, an advertising server transmits to people accessing the page of a site an appropriate one of the advertisements based upon profiling of users and networks. *Id.*

Figure 1 of Merriman is reproduced below.

¹⁰ We do not provide summaries of the prior art relied on for Grounds that we do not discuss in this Decision.

FIG. 1

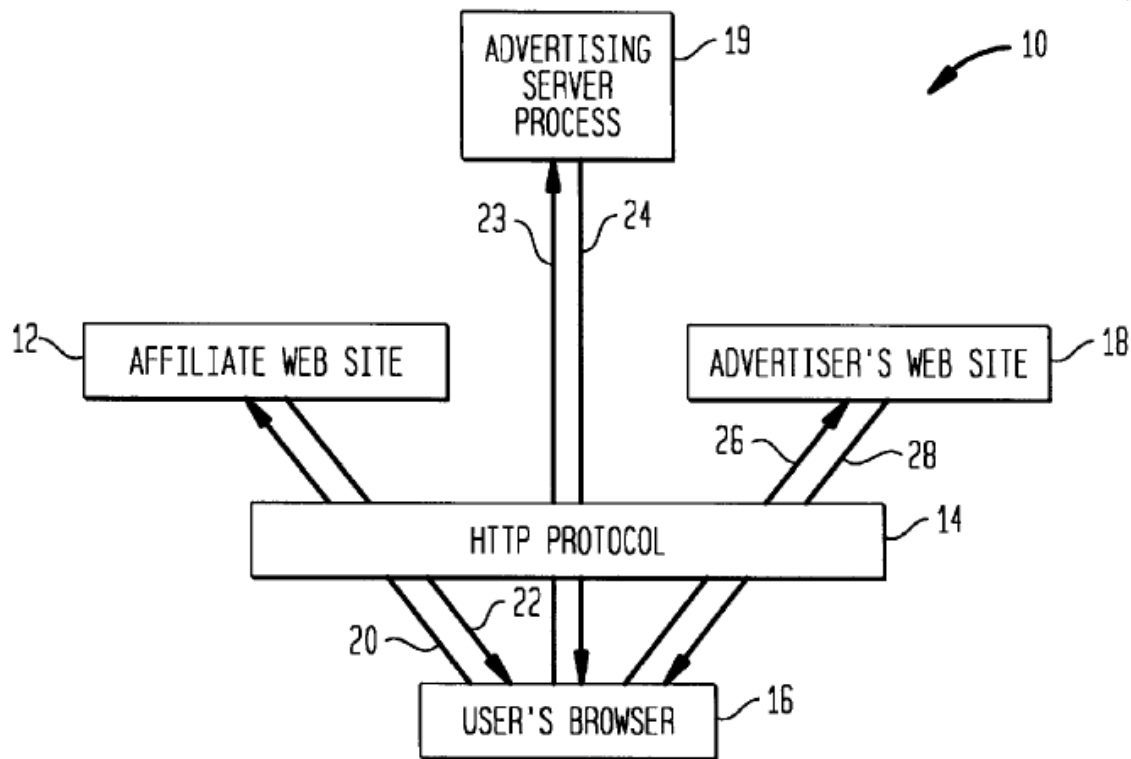


Figure 1 illustrates the basic architecture of a network 10 that comprises at least one affiliate web site 12, an advertisement (ad) server web site 19, and one or more individual advertisers web sites 18. Ex. 1035, 2:59–62.

According to Merriman, “[w]hen a user using a browser accesses or ‘visits’ a web site of an affiliate, an advertisement provided by the advertisement server 19 will be superimposed on the display of the affiliate’s web page displayed by the user’s browser.” *Id.* at 2:62–3:1. Merriman describes the operations shown in Figure 1 as follows: “a user operates a web browser, such as Netscape or Microsoft Internet Explorer, on a computer or PDA or other Internet capable device 16 to generate through the hypertext transfer protocol (HTTP) 14 a request 20 to any one of preferably a plurality of affiliate web sites 12.” *Id.* at 3:24–28. Next, “[t]he affiliate web site sends one or more messages back 22 using the same protocol.” *Id.* at 3:28–29.

“Those messages 22 preferably contain all of the information available at the particular web site 12 for the requested page to be displayed by the user’s browser 16 except for one or more advertising objects such as banner advertisements.” *Id.* at 3:30–34. Merriman discloses that “[advertising] objects preferably do not reside on the affiliate’s web server” and “[i]nstead, the affiliate’s web server sends back a link including an IP address for a node running an advertiser server process 19 as well as information about the page on which the advertisement will be displayed.” *Id.* at 3:34–38. As an example, Merriman teaches that the link “may be a hypertext markup language (HTML) tag, referring to, for example, an inline image such as a banner,” and “[t]he user’s browser 16 then transmits a message 23 using the received IP address to access such an object indicated by the HTML tag from the advertisement server 19.” *Id.* at 3:38–44. “Upon receiving the request in the message 23, the advertising server process 19 determines which advertisement or other object to provide to user’s browser and transmits the messages 24 containing the object such as a banner advertisement to the user’s browser 16 using the HTTP protocol.” *Id.* at 3:52–57. Merriman describes that “[p]referably contained within the HTTP message is a unique identifier for the advertiser’s web page appropriate for the advertisement,” and “[t]hat advertisement object is then displayed on the image created by the web user’s browser as a composite of the received affiliate’s web page plus the object transmitted back by the advertising web SCWC.” *Id.* at 3:57–63.

2. *Jaye (Ex. 1037)*

Jaye is a United States patent for dual/blind identification that issued July 2, 2002. Ex. 1037, codes (12), (45). In particular, Jaye concerns a global interest profile of a user. *Id.* at code (57).

Jaye describes “[a] distributed user identification process,” that allows “individual local servers or domains to control their own user identification scheme and to collaborate with other local servers or domains at the discretion of an enterprise server.” Ex. 1038, 2:2–6. “The enterprise server correlates the local user identification scheme with a global user identifier and may disclose to interested outside parties, such as advertisers, only the global user identifier without revealing the identity of a user who interacts with a local server.” *Id.* at 2:6–10.

Figure 1 of Jaye is reproduced below.

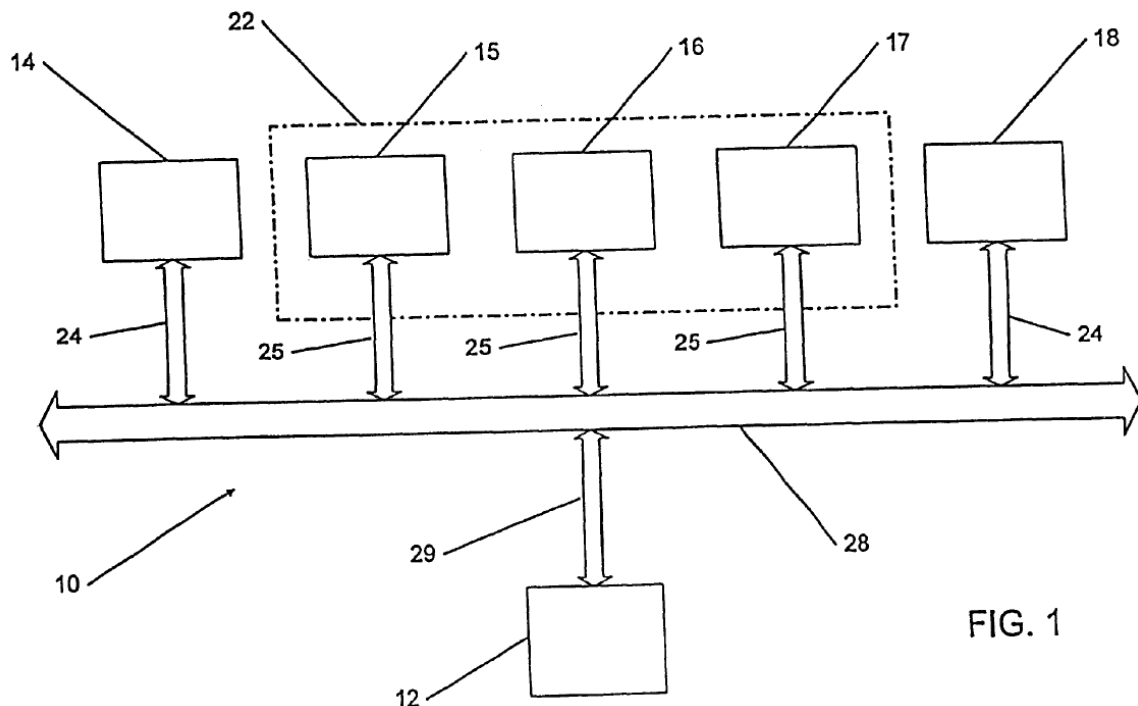


Figure 1 illustrates a part 10 of the Internet computer network that includes a client 12 and a group of servers 14–18. Ex. 1038, 4:5–6. Jaye describes that “client 12 may be any one of a variety of conventional, commercially available, hardware and software combinations configured to access Internet servers by any one of a variety of suitable means.” *Id.* at 4:7–10. Jaye discloses that “servers 14–18 and the client 12 communicate with each other

via communication links 24, 25 and 29 which are all connected to a communication channel 28.” *Id.* at 4:20–23.

3. *Roth (Ex. 1036)*

Roth is a United States patent for internet advertising system that issued September 4, 2001. Ex. 1036, codes (12), (45). Roth concerns “[a] system for providing advertisements from a central server to viewers who access web sites.” *Id.* at code (57). The central server stores both advertisements which are to be displayed and an information data base that “includes information about viewers, information about the characteristics of particular web sites and other information relevant to which advertisements should be displayed for particular viewers.” *Id.*

Figure 1 of Roth is reproduced below.

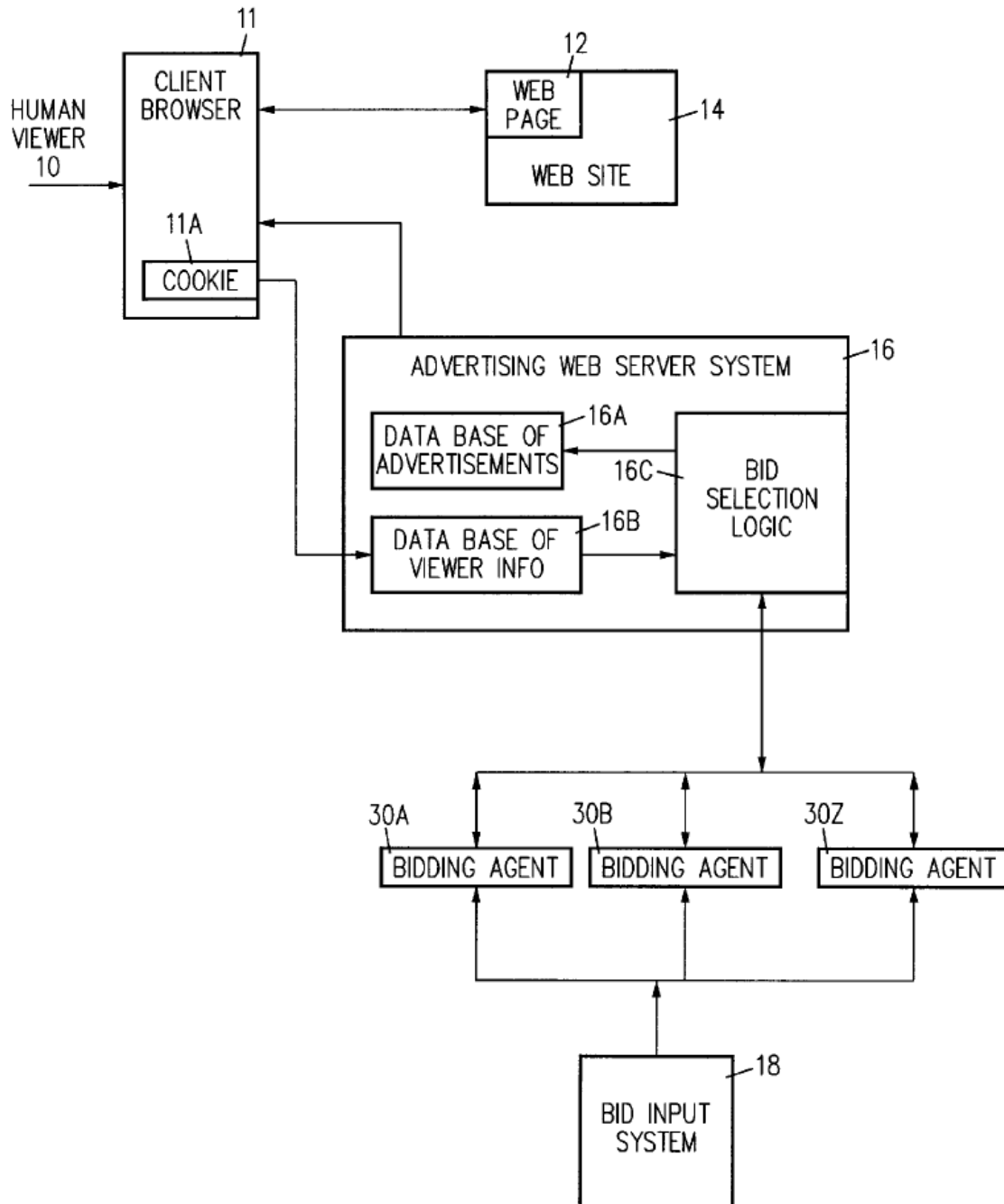


Figure 1 illustrates a human viewer 10 that utilizes a client browser 11 to access a web page 12 on a web site 14. Ex. 1036, 3:33–34. Web page 12 is transmitted to browser 11 and includes an HTML reference to a file (i.e., an advertisement) located on an advertising web server system 16. *Id.* at 3:34–38. Each time client browser 11 displays web page 12, the human viewer 10

will see an advertisement which is provided by advertising web server system 16. *Id.* at 3:52–55. Advertising web server system 16 includes a database of advertisements 16A, a database of viewer information 16B, and a bid selection logic 16C. *Id.* at 3:57–59. The bid selection logic 16C receives bids from bidding agents 30A to 30Z, which in turn receive information concerning proposed bids from bid input system 18. *Id.* at 3:59–62.

4. *Minor (Ex. 1038)*

Minor is a United States patent for an “apparatus and method for passing private demographic information between hyperlink destinations” that issued April 14, 1998. Ex. 1038, codes (12), (45). Minor concerns “associating a computer operator with a set of demographic information.” *Id.* at code (57).

Figure 2 of Minor is reproduced below.

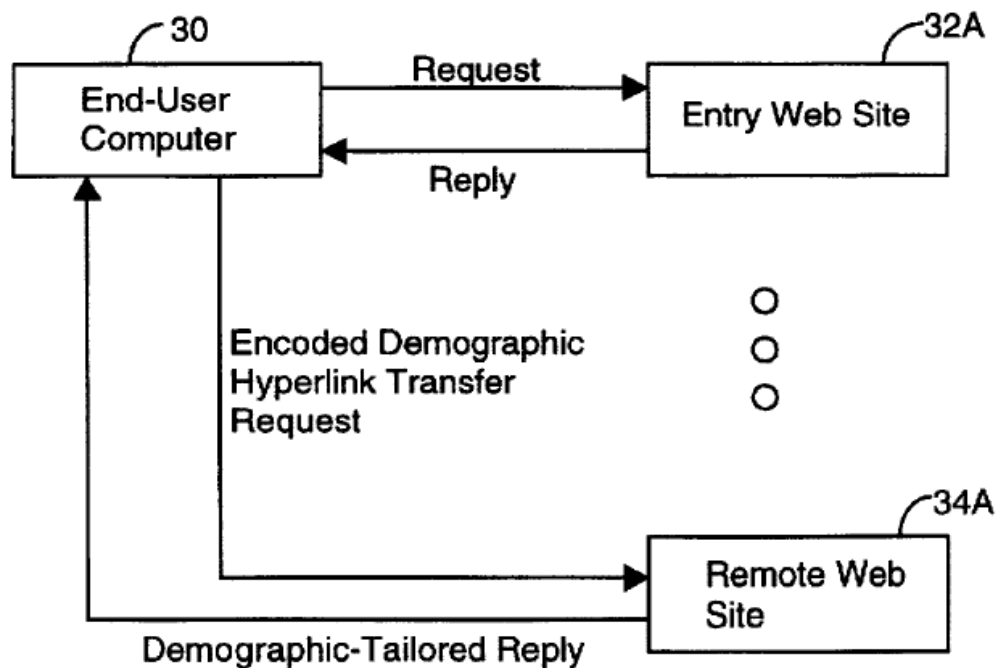


Figure 2 illustrates a system architecture that includes an end-user computer 30 that generates a request that reaches an entry web site 32A. Ex. 1038.

3:40–41. The request uses a Uniform Resource Locator (URL) address to specify a computer (entry web site 32A) and information (a file) at that computer. *Id.* at 3:41–44. Entry web site 32A obtains demographic information about the computer operator at the end-user computer 30 by providing “a set of inquiries or a graphical interface to obtain demographic information about the computer operator.” *Id.* at 3:45–49. Minor discloses that “[t]ypical demographic information includes name, age, zip code, income level, employment information, type of computer used, other purchasing preferences, etc.” *Id.* at 3:49–52.

G. Ground A: Alleged Obviousness of Claims 1–3, 7, and 9 in View of the Combined Teachings of Merriman and Jaye

Petitioner asserts that the combined teachings of Merriman and Jaye render claims 1–3, 7, and 9 unpatentable. Pet. 8. Patent Owner does not dispute Petitioner’s reasoning and assertions. *See generally* Prelim. Resp.

1. Petitioner’s Reasoning in Support of the Proposed Combination

Petitioner asserts that “Merriman describes a method and system for compiling information to profile website visitors and delivering targeted advertisements over the Internet.” Pet. 9 (citing Ex. 1035, code (57), 1:8–11, 2:6–45, 3:5–23, 4:24–32, 4:43–54, Figs. 1–3A). Specifically, Petitioner asserts that “Merriman’s website 12^[11] sends message 22 that provides a webpage including a portion with a URL for redirecting browser 16 to send message 23 to advertising server 19.” *Id.* at 9–10 (citing Ex. 1035, 3:24–52, Fig. 1; Ex. 1002 ¶ 218). Petitioner asserts that “message 23 includes a cookie stored on browser 16, but admits that Merriman “does not expressly

¹¹ We do not reproduce the coloring of the text or bold emphasis used in the Petition.

disclose passing profile information from website 12 to advertising server 19 through messages 22 and 23.” *Id.* at 10 (citing Ex. 1035, 3:41–52, 5:11–29).

Turning to Jaye, Petitioner asserts that “Jaye’s client 12 (like Merriman’s browser 16) gets a webpage from local server 15 (like Merriman’s website 12) and communicates over the Internet 10 with enterprise server 16 (like Merriman’s advertising server 19) that maintains a global user profile.” Pet. 10–11 (citing Ex. 1037, 4:5–6:19, 7:21–26, 8:40–43, 13:19–41, 14:22–25, Fig. 1; Ex. 1002 ¶ 219). Petitioner asserts further that “Jaye’s local server 15 forces a transfer to automatically redirect client 12 to enterprise server 16.” *Id.* at 11 (citing Ex. 1037, 6:32–67, 7:46–57, Figs. 2–3). In addition, Petitioner asserts that “Jaye specifically describes a technique of inserting, into an image tag of a webpage, a special URL that redirects client 12 to enterprise server 16” and that “Jaye further describes appending additional profile information, such as a local server ID and client information (e.g., a local user ID), to the special URL.” *Id.* at 11–12 (citing Ex. 1037, 6:36–46).

Based on these assertions, Petitioner reasons that

It would have been obvious to apply Jaye’s teachings of automatically forcing a transfer of profile information (e.g., by appending it to a URL) to an enterprise server that maintains a global user profile for use by an advertiser to Merriman’s system for delivering targeted advertisements based on user profiles because doing so usefully provides the profile information in real time.

Pet. 12 (citing Ex. 1002 ¶ 222; Ex. 1035, 3:24–4:54; Ex. 1037, 6:32–67, 7:46–57, 8:40–52). Petitioner explains that

In the Merriman-Jaye system, website 12 sends message 22 that provides a webpage including a portion having a special URL (with appended profile information per Jaye) that causes browser

16 to send message 23 (including the special URL with appended profile information) to advertising server 19, which in turn adds the profile information to a global user profile.

Id. (citing Ex. 1002 ¶ 222; Ex. 1035, 4:43–50; Ex. 1037, 8:10–55). Thus, according to Petitioner, “Merriman-Jaye teaches a method and system in which advertising server 19 receives profile information from website 12 by performing automatic electronic URL redirection from a portion of a webpage accessed by browser 16.” *Id.* at 13 (citing Ex. 1002 ¶ 223).

Petitioner articulates additional reasons in support of the proposed combination and explains why a person of ordinary skill in the art “would have expected success in Merriman-Jaye.” Pet. 12–16.

2. *Petitioner’s Assertions for Claim 1*

Petitioner addresses each limitation of claim 1. Pet. 17–28. Patent Owner does not dispute Petitioner’s assertions for each limitation, which we summarize below. *See generally* Prelim. Resp.

a) *1. An automated method of collecting profiles of Internet-using entities, the method comprising:*

Petitioner asserts that “Merriman teaches a method of delivering targeted advertisements that includes an automated method of collecting profiles of users of Internet browsers.” Pet. 17 (citing Ex. 1002 ¶ 234).

b) *(a) electronically receiving at a programmed computer system coupled to a global computer network, from at least one server controlled by one of a plurality of unaffiliated third parties operating respective websites, a partial profile of an entity that uses a user computer coupled to the global computer network and accessing the website, which partial profile contains at least one profile attribute related to the entity, and*

automatically with the computer system storing the received partial profile;

Petitioner asserts that “Merriman’s advertising server 19 (claimed ‘programmed computer system’) comprises one or more servers and uses database 54” and is “coupled to the Internet (claimed ‘global computer network’).” Pet. 18 (citing Ex. 1035, code (57), 3:6–18, 3:24–28, 4:12–24, 8:47–60, Fig. 2; Ex. 1002 ¶ 235). Petitioner asserts further that “Merriman’s website 12 is a web server controlled by one of a plurality of unaffiliated third parties (claimed ‘at least one server controlled by one of a plurality of unaffiliated third parties operating respective websites’)” and that its “website 12 is not owned or controlled by the same party that owns or controls advertising server 19.” *Id.* at 18–19 (citing Ex. 1035, 3:2–4, 3:16–18, 3:30–38, 4:12–19). Petitioner reasons that “[i]t would have at least been obvious, and straightforward, to implement Merriman such that website 12 is controlled by one of a plurality of third parties unaffiliated with advertising server 19 for the purpose of expanding the applicability of the system.” *Id.* at 19 (citing Ex. 1002 ¶ 236).

In addition, Petitioner asserts that Merriman “teaches electronically receiving, at advertising server 19, message 23 including a cookie identifying the user of the user computer operating browser 16,” but “does not expressly disclose message 23 including profile information from website 12.” Pet. 19 (citing Ex. 1002 ¶ 238; Ex. 1035, 3:28–57). To cure this deficiency in Merriman, Petitioner asserts that “Merriman-Jaye maintains Merriman’s system, but modifies Merriman’s operation to append profile information to a URL in messages 22 and 23.” *Id.* (citing Ex. 1002 ¶ 238). Specifically, Petitioner asserts that “[i]n Merriman-Jaye, both messages 22 and 23 include profile information about browser 16’s user

(claimed ‘partial profile’) appended to the URL by website 12.” *Id.* at 20 (citation omitted). Thus, according to Petitioner, “Merriman-Jaye teaches electronically receiving, at advertising server 19 from website 12, profile information of the user (claimed ‘electronically receiving at a programmed computer system . . . from at least one server . . . a partial profile of an entity’).” *Id.* (citing Ex. 1002 ¶ 238).

Regarding the proposed Merriman-Jaye combination, Petitioner asserts further that “Merriman-Jaye’s profile information (appended by website 12) would have contained at least one attribute related to the user of browser 16 (claimed ‘contains at least one profile attribute related to the entity’).” Pet. 20 (citing Ex. 1002 ¶¶ 239–240). In addition, Petitioner asserts that Merriman’s teaching “that advertising server 19 automatically stores received profile information in database 54 (claimed ‘automatically with the computer system storing the received partial profile’) . . . would have been preserved in the combination.” *Id.* at 20–21 (citing Ex. 1035, 4:43–54, Fig. 3A).

c) (b) wherein receiving the partial profile is achieved by automatic electronic URL redirection from a portion of a page of the website accessed by the user computer;

Petitioner asserts that “Merriman’s website 12 sends message 22, including a URL, that causes (without user action) browser 16 to send message 23 to advertising server 19 associated with the URL” which “is ‘automatic electronic URL redirection.’” Pet. 21 (citing Ex. 1002 ¶¶ 241–242; Ex. 1035, 3:38–43; Ex. 1019, 112–113). Petitioner asserts further that “[i]n Merriman-Jaye, the same messages 22 and 23 of Merriman are communicated, but with profile information appended to the URL.” *Id.* (citing Ex. 1002 ¶ 245). Thus, according to Petitioner, Merriman-Jaye

teaches that receiving the profile information . . . is achieved by automatic electronic URL redirection from a portion of a webpage of website 12 accessed by the user computer. *Id.* (citing Ex. 1002 ¶ 246).

d) (c) automatically with the computer system electronically adding the received partial profile to a maintained profile believed to be related to the same entity;

Petitioner asserts that “Merriman’s database structure stores a user profile (claimed ‘maintained profile’), including attributes such as a user identification (‘USER ID’) and information identifying pages on which advertisements were seen (‘PAGES ADS SEEN ON’).” Pet. 22–23 (citing Ex. 1035, 4:43–54, Fig. 3A; Ex. 1002 ¶ 247). Petitioner asserts further that “[t]hese features of Merriman would have been preserved in Merriman-Jaye” as “Merriman’s USER ID and PAGES ADS SEEN ON attributes are related to attributes that Jaye expressly discloses as being appended.” *Id.* at 23 (citing Ex. 1037, 5:5–6:46).

e) (d) automatically with the computer system generating and storing an electronic record of which of the plurality of unaffiliated third parties contributed to the maintained profile particular profile attributes;

Petitioner asserts that “Merriman’s advertising server 19 maintains database 54 having a structure with a field for recording information identifying pages on which advertisements were seen (‘PAGES ADS SEEN ON’) in a user profile (claimed ‘maintained profile’)” and that “[a]dvertising server 19 automatically generates and stores the information identifying a page an advertisement was seen on.” Pet. 25 (citing Ex. 1035, 4:5–8, 4:20–24, 4:32–37, 4:43–54, Fig. 3; Ex. 1002 ¶¶ 252–253). Petitioner asserts further that “[b]y generating the information identifying this page and recording it within database 54, Merriman generates and stores an electronic

record of the party controlling website 12 that contributed the profile information.” *Id.*

In addition, Petitioner asserts that “[b]ecause Jaye teaches recording the local server ID, it would have been obvious for Merriman-Jaye to record the local server ID” and thus, a person of ordinary skill in the art “would have recorded the local server ID to keep a record of which party provided the profile information for rewarding that party and incentivizing parties to provide profile information.” Pet. 26 (citing Ex. 1002 ¶ 256; Ex. 1037, 8:23–28).

f) (e) wherein the maintained profile, including the added partial profile, comprises data used in targeting third-party advertisements to the user computer over the global computer network.

Petitioner asserts that Merriman discloses using data “in the user profiles to deliver targeted advertisements for third-party advertisers 18 (claimed ‘data used in targeting third-party advertisements’) to the user computer operating browser 16 over the Internet.” Pet. 27–28 (citing Ex. 1035, code (57), 1:8–11, 2:40–45, 4:50–54, 5:50–60, 5:64–67, 6:6–11, 6:56–59, 8:47–51; Ex. 1002 ¶ 258). Thus, according to Petitioner, “Merriman teaches that the user profile, including added profile information, comprises data used in targeting advertisements for advertisers 18 to the user computer operating browser 16 over the Internet.” *Id.* (citing Ex. 1002 ¶ 259). Petitioner asserts further that “[t]his feature is preserved in Merriman-Jaye” with “[t]he only difference is that, in Merriman-Jaye, the profile information comes from website 12 because it is appended to the URL by website 12.” *Id.* (citation omitted).

3. *Petitioner’s Assertions for Claim 2: The method of claim 1 further comprising automatically with the computer*

system electronically maintaining an electronic record of which unaffiliated third party contributed, to the maintained profile, the profile attributes used in targeting the advertisements.

Petitioner asserts that the Merriman-Jaye combination “teaches ‘automatically with the computer system electronically maintaining an electronic record of which unaffiliated third party contributed, to the maintained profile, the profile attributes used in targeting the advertisements’ added in claim 2” in that “[t]he information in the PAGES ADS SEEN ON field (already in Merriman) or in the ‘Party Providing Profile Info’ field . . . is an electronic record indicating that the party controlling website 12 contributed the profile information.” Pet. 28–29 (citing Ex. 1002 ¶¶ 261–266). Petitioner asserts further that “[a]ny information in this data structure is used for targeted advertising” such that “the information in Merriman-Jaye’s PAGES ADS SEEN ON field or ‘Party Providing Profile Info’ field is an electronic record of the party controlling website 12 that contributed, to the user profile, attributes of the profile information used in targeting the advertisements.” *Id.* at 29 (citing Ex. 1002 ¶ 266; Ex. 1035, code (57), 2:40–45, 4:50–54, 5:50–6:11, 6:56–63, 8:47–56).

4. Petitioner’s Assertions for Claim 3: The method of claim 2 further comprising automatically with the computer system electronically determining whether the received partial profile contains any profile attributes about the entity that were not previously contained in a maintained profile.

Petitioner asserts that “Merriman’s advertising server 19 stores received profile information in user profiles on a user-by-user basis and receives profile information for the same user from different websites 12.” Pet. 30 (citing Ex. 1002 ¶¶ 271–273; Ex. 1035, 2:8–36, 2:59–62, 8:63–9:4). According to Petitioner, in order “[t]o store attributes from different

websites in the same user profile, server 19 would have determined which attributes are not already in the profile.” *Id.* (citing Ex. 1002 ¶ 273).

Petitioner asserts further that “to store attributes from different websites 12 on a user-by-user basis, server 19 would have checked whether received attributes of a user were already stored in that user’s profile; otherwise, information would be overwritten or duplicated.” *Id.* at 31 (citing Ex. 1002 ¶ 274). Thus, Petitioner asserts that “Merriman-Jaye teaches server 19 automatically and electronically determining whether the received profile information contains any profile attributes about the user of browser 16 that were not previously contained in the user’s profile, thereby teaching claim 3.” *Id.* (citing Ex. 1002 ¶¶ 275–276).

5. *Petitioner’s Assertions for Claim 7: The method of claim 1 further comprising automatically with the computer system electronically reading a cookie previously stored on the entity’s computer, as a result of the URL redirection.*

Petitioner asserts that “Merriman’s redirect message 23 includes a cookie, stored by browser 16 on the user computer, that would have been read by advertising server 19.” Pet. 31–32 (citing Ex. 1035, 3:43–52, 5:11–29). Thus, according to Petitioner, “Merriman-Jaye further teaches advertising server 19 automatically and electronically reading a cookie previously stored on the user’s computer, as a result of the URL redirection, thereby teaching claim 7.” *Id.* at 32 (citing *Id.* ¶¶ 278–281).

6. *Petitioner’s Assertions for Claim 9¹²*

Petitioner asserts that “Claim 9 is a storage medium version of claim 1 and unpatentable for similar reasons.” Pet. 32 (citation omitted).

¹² We do not reproduce claim 9.

7. *Conclusion for Ground A*

Patent Owner does not dispute Petitioner’s assertions in Ground A or Petitioner’s reasoning in support of its proposed combination. *See generally* Prelim. Resp. We have reviewed Petitioner assertions and reasoning, as well as the evidence of record, in support of this challenge. On the current record, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing on Ground A.

H. Grounds B–D: Alleged Obviousness of Claims 1–3, 7, and 9 in View of the Combined Teachings of Roth and Jaye; Merriman and Minor; or Roth and Minor

Having determined that Petitioner has demonstrated a reasonable likelihood of prevailing for claims 1–3, 7, and 9 on the basis of Ground A, and given that Patent Owner does not dispute Petitioner’s assertions and reasoning for Grounds B–D, we do not reproduce Petitioner’s assertions and reasoning for these grounds.

I. Grounds E–T: Alleged Obviousness of Claims 2–6 Based on Various Combinations of Merriman, Jaye, Roth, Minor, Coleman, Herz, and Gardner

Petitioner asserts that claims 2–6 are unpatentable over sixteen various combinations of Merriman, Jaye, Roth, Minor, Coleman, Herz, or Gardner. Pet. 5–6. Although Petitioner sets forth its support for these challenges, we question whether Petitioner has adequately explained its position. Pet. 72–85. For example, Petitioner discusses Grounds E–H in only 6 pages of the Petition. Pet. 72–78. The discussion on these pages is confusing and hard to follow, as Petitioner does not clearly explain how Coleman’s teachings are applied in each proposed combination and instead refers collectively to “the Coleman combinations” in explaining its reasoning. Regardless, as we institute trial in this proceeding based on

Petitioner's showing of a reasonable likelihood of prevailing with respect to at least one claim on Ground A, in accordance with 37 C.F.R. § 42.108(a), we institute trial on all asserted grounds and reserve further discussion of these grounds until after full development of the trial record.

III. CONCLUSION

For the foregoing reasons, we have determined that there is a reasonable likelihood that Petitioner would prevail with respect to at least one of the claims challenged in the Petition. We therefore institute trial as to all challenged claims on all grounds stated in the Petition.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review is instituted as to claims 1–7 and 9 of the '307 patent on the 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, notice is hereby given of the institution of a trial; the trial will commence on the entry date of this decision.

IPR2024-00413
Patent 7,979,307 B2

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