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Paper 10
Entered: September 5, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FREEWHEEL MEDIA, INC.,
Petitioner,

v.

ALMONDNET, INC.,
Patent Owner.

IPR2024-00414
Patent 7,979,307 B2

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

BROWNE, *Administrative Patent Judge*.

DECISION
Denying 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"). The '307 Patent is also the subject of two other petitions for *inter partes* review (IPR2024-00413 and IPR2024-00415) challenging the same claims as challenged in the instant petition and filed by Petitioner on the same day. Pet. vii.

AlmondNet, Inc. ("Patent Owner") timely filed a Preliminary Response. Paper 9 ("Prelim. Resp."). 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 *eighteen* 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). For the reasons provided below, we are persuaded, based on the record before us, to exercise our discretion to deny institution in this proceeding based on Petitioner's parallel petition in IPR2024-00413.

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: IPR2024-00413 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.).

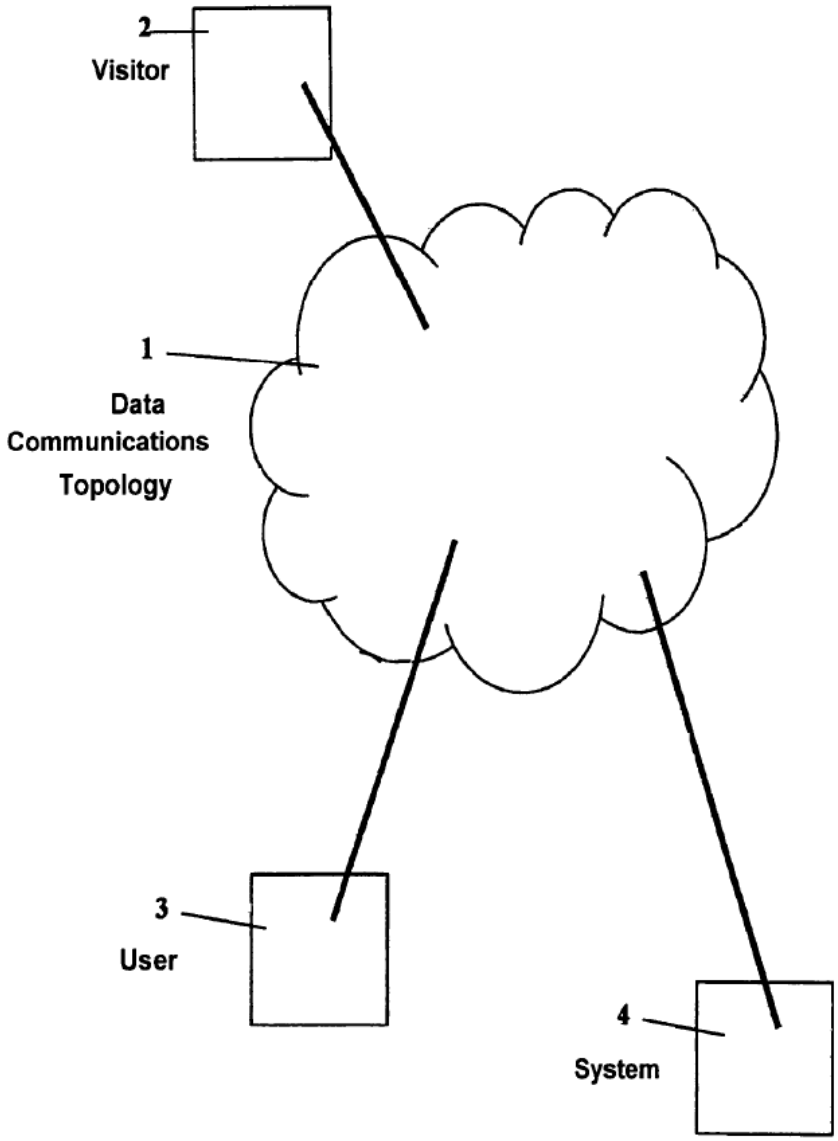
Petitioner further identifies the following terminated PTAB proceedings as involving patents related to the '307 Patent: *Yahoo! Inc. v. AlmondNet, Inc.*, CBM2017-00050; *Yahoo! Inc. v. AlmondNet, Inc.*, CBM2017-00051; *Yahoo! Inc. v. AlmondNet, Inc.*, CBM2017-00052; *Samsung Electronics Co. v. AlmondNet, 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.

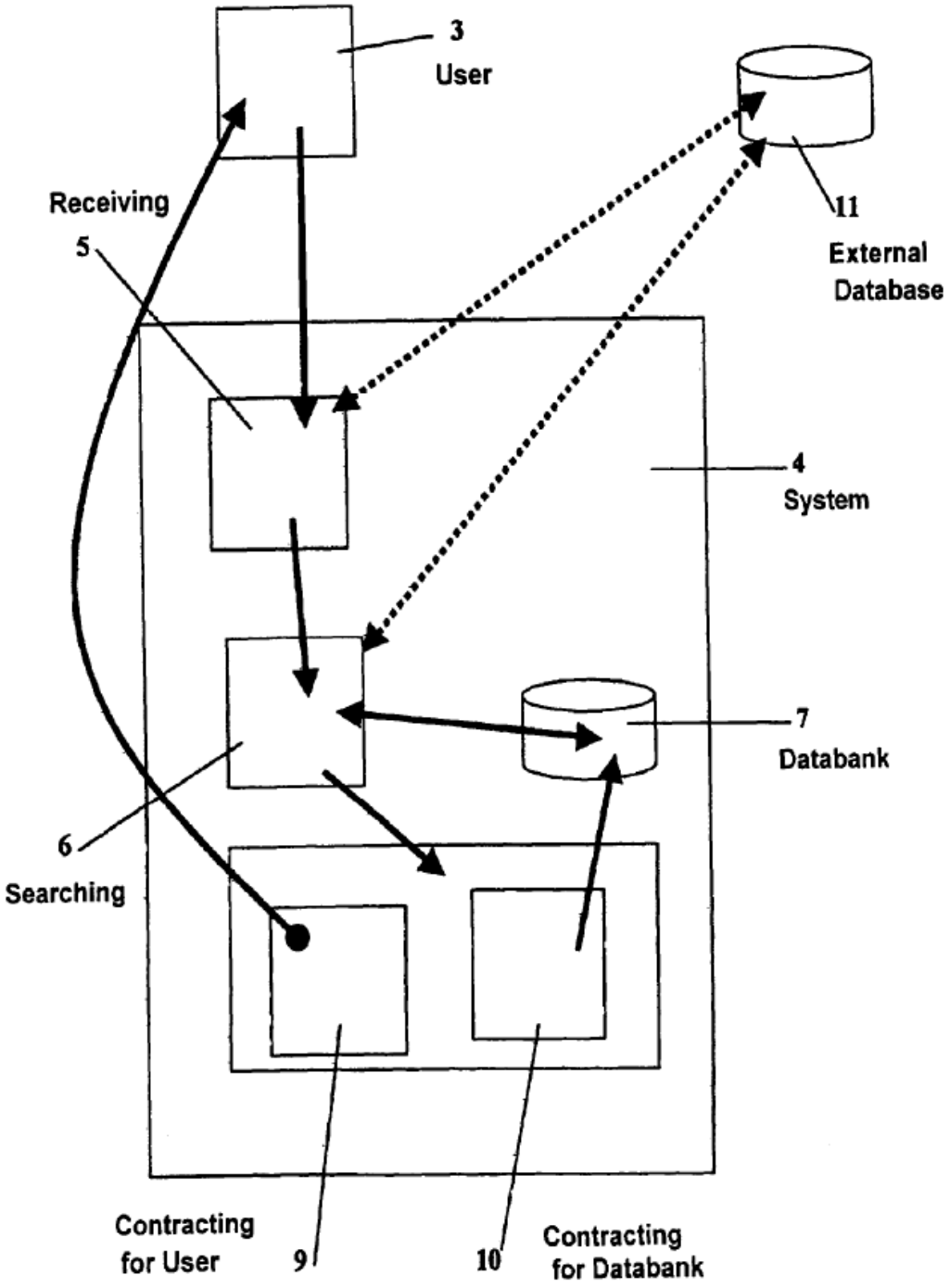


Figure 2 depicts "a descriptive-profile mercantile method" "for use at a juncture in a data-communications topology having associated therewith a maintained databank of partial profiles." *Id.* at 4:63–66. The method shown in Figure 2 includes the steps of:

> (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, 6–7, 9	103	Rosenberg[2]
1–3, 6–7, 9	103	Rosenberg, Zeff,[3] Sterne[4]

[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] Rosenberg et al., U.S. Patent No. 6,073,241, issued June 6, 2000 (Ex. 1155) ("Rosenberg").

[3] Zeff, R., et al., *Advertising on the Internet*, John Wiley & Sons, Inc., pp. 1–27, 89–109, 1997 (Ex. 1156) ("Zeff").

[4] Sterne, Jim, *What Makes People Click: Advertising on the Web*, Que Corporation, pp. 1–41, 145–256, 375–386, 1997 (Ex. 1157) ("Sterne").

Claim(s) Challenged	35 U.S.C. §[1]	Reference(s)/Basis
1–3, 6–7, 9	103	Rosenberg, Kurtzman[5]
1–3, 6–7, 9	103	Rosenberg, Zeff, Sterne, Kurtzman
1–3, 6–7, 9	103	Rosenberg, Merriman[6]
1–3, 6–7, 9	103	Rosenberg, Zeff, Sterne, Merriman
3	103	Rosenberg, Farber[7]
3	103	Rosenberg, Zeff, Sterne, Farber
3	103	Rosenberg, Kurtzman, Farber
3	103	Rosenberg, Zeff, Sterne, Kurtzman, Farber
3	103	Rosenberg, Merriman, Farber
3	103	Rosenberg, Zeff, Sterne, Merriman, Farber
4, 5	103	Rosenberg, Coleman[8]
4, 5	103	Rosenberg, Zeff, Sterne, Coleman
4, 5	103	Rosenberg, Kurtzman, Coleman
4, 5	103	Rosenberg, Zeff, Sterne, Kurtzman, Coleman
4, 5	103	Rosenberg, Merriman, Coleman
4, 5	103	Rosenberg, Zeff, Sterne, Merriman, Coleman

II. DISCRETIONARY DENIAL

Patent Owner contends that institution of trial should be denied because "Petitioner has not and cannot justify the three simultaneously filed parallel petitions directed towards the '307 patent and challenging the same eight claims—claims 1–7 and 9." Prelim. Resp. 4. For the reasons that

[5] Kurtzman, II et al., U.S. Patent No. 6,144,944, issued Nov. 7, 2000 (Ex. 1158) ("Kurtzman").
[6] Merriman et al., U.S. Patent No. 8,566,154 B2, issued Oct. 22, 2013 (Ex. 1159) ("Merriman").
[7] Farber et al., U.S. Patent No. 5,978,791, issued Nov. 2, 1999 (Ex. 1163) ("Farber").
[8] Coleman, U.S. Pat. Appl. Pub. 2002/0026351 A1, published Feb. 28, 2002 (Ex. 1139).

follow, we agree and therefore exercise our discretion under 35 U.S.C. § 314 to deny institution.[9]

As discussed *supra*, this is the second of three petitions filed concurrently by Petitioner challenging claims 1–7 and 9 of the '307 patent. Consistent with the Board's practice for handling parallel petitions, Petitioner filed a Petition Ranking (Paper 3, "Notice"). *See* Patent Trial and Appeal Board Consolidated Trial Practice Guide 59–60 (November 2019) ("Practice Guide").[10] In the Notice, of the three petitions challenging the '307 patent, Petitioner ranks this Petition second and the petition in IPR2024-00413 first. Notice 1. In our separate decision in IPR2024-00413, entered concurrently with this decision, we institute *inter partes* review of claims 1–7 and 9 of the '307 patent on all grounds stated in the Petition. IPR2024-00413, Paper 10.

In support of its decision to file three separate petitions challenging the same claims, Petitioner makes three arguments. Notice 1–5. First, Petitioner asserts that the Petition relies on three references (Rosenberg, Zeff, and Sterne) that were "asserted against the '582 patent in *Meta Platforms, Inc. v. AlmondNet, Inc.*, Case No. IPR2022-01436, in which institution was granted." *Id.* at 2. Petitioner argues that "[g]iven the similarities between the '582 and '307 claims, the Board should likewise institute IPR based on Petition 2." *Id.*

Next, Petitioner asserts that because "[t]he primary references used in the petitions all qualify as prior art under 35 U.S.C. §§ 102(a) or 102(e)," "Patent Owner . . . could attempt to antedate these references." Notice 2.

[9] We have discretion to deny this parallel petition under 35 U.S.C. § 314(a).
[10] *Available at* https://www.uspto.gov/TrialPracticeGuideConsolidated.

Finally, Petitioner asserts that "[t]he petitions use different prior art in different ways and provide multiple avenues to invalidate the claims, which is necessary in light of potential claim construction issues that may arise." *Id.* at 3. We do not find these arguments persuasive.

Our Practice Guide provides guidance on handling situations involving multiple petitions by a single petitioner challenging the same patent claims:

> Based on the Board's experience, *one petition should be sufficient* to challenge the claims of a patent in most situations. . . . . In addition, *multiple petitions by a petitioner are not necessary in the vast majority of cases*. To date, a substantial majority of patents have been challenged with a single petition.

Practice Guide 59 (emphasis added). The Practice Guide provides examples of "circumstances in which more than one petition may be necessary." *Id.* None of these examples are pertinent here. For example, a second petition might be justified "when the patent owner has asserted a large number of claims in litigation or when there is a dispute about priority date requiring arguments under multiple prior art references." Petitioner does not argue that the number of claims in the parallel litigation is "large." And while Petitioner does argue that the prior art relied upon on might be antedated, Patent Owner responds by stipulating "that it will not 'attempt to antedate or disqualify' the prior art relied upon by Petitioner." Prelim. Resp. 6–7.

Petitioner's remaining arguments are no more persuasive. Responding to Petitioner's argument that different prior art is involved in the three petitions, Patent Owner points out, "[n]early all parallel petitions involve different proposed prior art." Prelim. Resp. 6. We agree. Petitioner's desire to triple the available word count is an insufficient

justification for a second or third petition. As our Practice Guide cautions, "[t]wo or more petitions filed against the same patent at or about the same time . . . may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns." Practice Guide 59. This is especially concerning here, where the instituted trial in IPR2024-00413 will involve eight references and twenty grounds. Adding an additional eighteen grounds and five references from this Petition to the mix would create an "unnecessary burden."

Finally, we do not see merit in Petitioner's argument that a second petition is necessary because of the "possibility" Patent Owner might assert narrow claim constructions. Notice 3–5. Petitioner's argument is based on conjecture.

In sum, in the words of our Practice Guide, Petitioner fails to show "why the Board should exercise its discretion to institute additional petitions if it identifies one petition that satisfies petitioner's burden under 35 U.S.C. § 314(a)." Practice Guide 60.

III. CONCLUSION

For the foregoing reasons, we are not persuaded that the facts presented by Petitioner justify a second petition challenging the same claims of the '307 patent as the petition in IPR2024-00413. We therefore exercise our discretion under 35 U.S.C. § 314(a) to deny institution of *inter partes* review.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), the Petition is denied and *inter partes* review of claims 1– 7 and 9 of the '307 patent is not instituted on the grounds asserted in the instant Petition.

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