UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FREEWHEEL MEDIA, INC.,
Petitioner,

v.

ALMONDNET, INC.,
Patent Owner.

Patent No. 8,775,249
Filing Date: Jul. 23, 2013
Issue Date: Jul. 8, 2014
Title: METHOD, COMPUTER SYSTEM, AND STORED PROGRAM FOR ACCUMULATING DESCRIPTIVE PROFILE DATA ALONG WITH SOURCE INFORMATION FOR USE IN TARGETING THIRD-PARTY ADVERTISEMENTS

Inter Partes Review No.: IPR2024-00416

PETITIONER'S PETITION RANKING AND EXPLANATION OF MATERIAL DIFFERENCES BETWEEN PETITIONS

Pursuant to the November 2019 update to the America Invents Act (AIA) Trial Practice Guide published by the USPTO, Petitioner submits this notice of its ranking of its petitions for *inter partes* review of U.S. Patent No. 8,775,249 filed in IPR2024-00416, IPR2024-00417, and IPR2024-00418. *See* "CONSOLIDATED TRIAL PRACTICE GUIDE UPDATE (November 2019)" at 59-60. Petitioner also explains the material differences between the petitions.

Ordering of Petitions. Each of the three petitions filed uses different primary references for significantly different grounds. Although all the petitions have merit and are justified in light of the positions Patent Owner may take, Petitioner requests that the Board consider the petitions in the following order:

Rank	Petition	Primary Ground(s)
A	IPR2024-00416 (Petition 1)	Merriman-Jaye; Merriman-Minor; Roth-Jaye; Roth-Minor
B	IPR2024-00417 (Petition 2)	Rosenberg alone; Rosenberg-Zeff-Sterne
C	IPR2024-00418 (Petition 3)	Herz-Bezos; Hagel-Bezos

Below are some of the material differences between the petitions:

(1) ***Use of Prior Art from Prior Related Proceedings***: Petition 1 relies on a primary reference (Merriman), also used in *Samsung Electronics Co., Ltd. and Microsoft Corp. v. AlmondNet, Inc. and Intent IQ, LLC*, Case No. IPR2022-01260, an IPR filed against U.S. Patent No. 8,244,582 ("the '582 patent") which is the grandparent of the '249 patent. In that IPR, Merriman was used as a secondary reference in combination with a reference (Philyaw) not used in Petition 1. Petition

1 combines Merriman with each of Jaye and Minor to form combinations never before considered. Additionally, Petition 1 relies on Roth—a new reference never used in any related IPR—in combination with each of Jaye and Minor.

Petition 2 relies on a primary reference (Rosenberg) in combination with secondary references (Zeff and Sterne). This combination of references was asserted against the '582 patent in *Meta Platforms, Inc. v. AlmondNet, Inc.*, Case No. IPR2022-01436, in which institution was granted. Given the similarities between the '582 and '249 claims, the Board should likewise institute IPR based on Petition 2. Petition 2 also includes additional arguments (not in IPR2022-01436) relying on additional disclosures of Rosenberg and presenting additional grounds combining Rosenberg with Kurtzman.

Petition 3 combines brand new references: Herz, Hagel, and Bezos. These references have never been considered by the Patent Office in any related IPR.

(2) *Different Prior Art Dates of References*: The primary references used in the petitions all qualify as prior art under 35 U.S.C. §§ 102(a) or 102(e). Patent Owner, therefore, could attempt to antedate these references. Herz is prior art under 102(e) and predates the '249 patent's earliest possible priority date because of Herz's priority to a provisional application. Herz thus raises potential priority issues (e.g., under *Dynamic* Drinkware) inapplicable to the other references. For this reason, Petition 3, relying on Herz, is ranked lowest even though Herz teaches the same

business method as the ’249 patent. The primary reference in Petition 2 (Rosenberg) has an earlier priority date (by 2 and 5 months, respectively) than the references in Petition 1 (Merriman and Roth). Depending on Patent Owner’s attempts to antedate or disqualify these references, their respective priority dates could be material, justifying multiple petitions.

(3) ***Different Approaches to the Claim Limitations***: The 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. In particular, multiple petitions are warranted due to the lack of description of the claimed URL redirection in the ’249 patent and lack of specificity in Patent Owner’s pleadings, leaving the URL redirection limitations subject to different possible interpretations and gamesmanship.

Petition 1 asserts two primary references (Merriman and Roth) with similar, though not identical, teachings that are combined with secondary references (Jaye and Minor) that teach features related to URL redirection. These combinations are strong against an overly narrow reading (argued by Patent Owner for similar claims in the prior Meta IPR) that precludes intervening human action between the URL redirection and step of receiving the partial profile. In the grounds of Petition 1, there is clearly no intervening human action because the partial profile is included in the URL redirection (e.g., appended to the URL) from a user website to the system

collecting profile information.

Petition 2, on the other hand, takes a different approach in which URL redirection occurs from one user website to another, and profile information is subsequently sent from the other website to the system. Petition 2 does not use a secondary reference at all for the URL redirection (Kurtzman is used for direct and/or immediate transfer of the partial profile *after* Rosenberg's URL redirection in case such additional limitations are (incorrectly) read into the claims). Although Rosenberg alone has the URL redirection and step of receiving the partial profile, Rosenberg allows for (but does not require) intervening human action. Given the uncertainty as to the scope of the claims, at least both of Petitions 1 and 2 (with 1 being stronger against an overly narrow reading, but requiring two references, and 2 having a single reference teaching the proper construction) should be instituted.

Petition 3 starts with primary references (Herz and Hagel) that teach the '249 patent's claimed business model and relies on Bezos for the URL redirection limitation. Petition 3 would become particularly important if Patent Owner moves away from its prior arguments in IPR2022-01436 (arguing inventiveness based only on URL redirection), and instead argues that its business model is somehow inventive (e.g., tracking a source of profile attributes and incentivizing sharing of attributes). Because Herz and Hagel more closely match the business model of the '249 patent, they seamlessly teach, without relying on the additional references used

in Petitions 1 and 2, the dependent claims that attempt to claim this business model.

Furthermore, the petitions use different secondary references to teach features of dependent claims or for back-up arguments to the primary references. For instance, Petition 2 uses Zeff and Sterne as back-up arguments for the claimed "at least one server controlled by one of a plurality of unaffiliated third parties." Petition 1 does not add these back-up references.

In another example, with respect to dependent claims 7 and 8 which require a credibility rating, Petitions 1 and 2 use an additional reference (Coleman), whereas Petition 3 does not require an additional reference. Although Petitions 1 and 2 both use Coleman for some dependent claims, they use different references (e.g., Gardner and Farber) for other dependent claims (e.g., claim 6). Also, Petitions 1 and 3 both include arguments using Herz to teach claim 5, whereas Petition 2 does not rely on Herz at all. Depending upon Patent Owner's arguments, the different teachings of the references would be material.

Conclusion. In view of the material differences discussed above, the Board should consider all three petitions and not exercise its discretion to deny institution of any of the three IPRs. In particular, additionally instituting IPR for Petition 2 should not be too burdensome given that the Board has considered similar arguments against similar claims in instituted IPR2022-01436 involving a related patent.

Dated: March 1, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.105, I hereby certify that I caused a true and correct copy of the PETITIONER'S PETITION RANKING AND EXPLANATION OF MATERIAL DIFFERENCES BETWEEN PETITIONS to be served via FedEx Priority Overnight on March 1, 2024, on the following:

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