

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FREEWHEEL MEDIA, INC.,
Petitioner,

v.

ALMONDNET, INC.,
Patent Owner.

IPR2024-00416
Patent 8,775,249 B2

Before NABEEL U. KHAN, SCOTT B. HOWARD, and
DAVID COTTA, *Administrative Patent Judges*.

COTTA, Administrative Patent Judge.

DECISION

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

I. INTRODUCTION

On March 1, 2024, FreeWheel Media, Inc. (“Petitioner”)¹ filed a Petition to institute *inter partes* review of claims 1, 3–11, 13–21, and 23–25 of U.S. Patent No. 8,775,249 B2 (Ex. 1001, “the ’249 patent”). Paper 2 (“Pet.” or “Petition”). Almondnet, Inc. (“Patent Owner”)² filed a Preliminary Response. Paper 9 (“Prelim. Resp.”).

Under 35 U.S.C. § 314(a), *inter partes* review may not be instituted unless the Petition “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.” Petitioner has established a reasonable likelihood of prevailing on its assertion that at least one of the challenged claims is unpatentable based on the grounds advanced here. We decline to deny the Petition on a discretionary basis as requested by Patent Owner. Thus, for reasons explained below, we institute *inter partes* review of claims 1, 3–11, 13–21, and 23–25 of the ’249 patent.

A. Related Matters

The parties identify *AlmondNet, Inc v. Freewheel Media, Inc.*, No. 1:23-cv-00220-MN (D. Del.) as a related matter. Pet. viii; Paper 5, 1.

The parties identify IPR2024-00417 and IPR2024-00418 as a parallel *inter partes* review proceedings in which Petitioner filed two other petitions

¹ Petitioner identifies itself as well as Beeswax.io Corp., Comcast Corporation, Comcast Cable Communications, LLC, and Comcast Cable Communication Management, LLC as the real parties-in-interest. Pet. viii.

² Patent Owner identifies itself as the real party-in-interest. Paper 5, 1.

challenging the '249 patent. Pet. viii; Paper 5, 1. In concurrently issued decisions, we deny institution in IPR2024-00417 and IPR2024-00418.

Petitioner identifies IPR2024-00413, IPR2024-00414, and IPR2024-00415 as *inter partes* review proceedings in which Petitioner filed petitions challenging related U.S. Patent No. 7,979,307 (“the ’307 patent”). Pet viii–ix.

Petitioner states that the ’249 patent is a continuation of U.S. Patent Application No. 13/585,779 (now U.S. Patent No. 8,494,904), which is a continuation of U.S. Appl. No. 13/115,949 (now U.S. Patent No. 8,244,582) (“the ’582 patent”), which is a continuation of U.S. Appl. No. 12/186,918 (now the ’307 patent), which is a division of U.S. Appl. No. 11/099,861 (now U.S. Patent No. 7,428,493), which is a continuation of U.S. Appl. No. 09/593,993 (now U.S. Patent No. 6,925,440), which claims priority to Israel Appl. No. 133,489. *Id.* at ix.

The parties also indicate that the ’249 patent and its related patents are the subject of the following district court cases:

AlmondNet, Inc. v. LinkedIn Corporation, 1:23-cv-01373 (D. Del.) (pending);

AlmondNet, Inc. v. Viant Technology Inc., 1-23-cv-00174 (D. Del.) (pending);

AlmondNet, Inc., v. Samsung Electronics Co., Ltd., 4-22-cv-07515 (N.D. Cal.) (“7515 N.D. Cal. case”) (pending but stayed);

AlmondNet, Inc. v. Meta Platforms, Inc., 4-23-cv-00438 (N.D. Cal.) (reassigned to the 7515 N.D. Cal. Case);

Roku, Inc. v. AlmondNet, Inc., 1-21-cv-01035 (D. Del.) (“1035 D. Del. case”) (pending);

AlmondNet, Inc. v. Roku, Inc., 1-22-cv-01540 (D. Del.) (“1540 D. Del. case”) (consolidated with the 1035 D. Del. Case);

AlmondNet, Inc. v. Amazon.com, Inc., 6-22-cv-01204 (W.D. Tex.) (terminated);

AlmondNet, Inc. v. Meta Platforms, Inc. f/k/a Facebook, Inc., 6-22-cv-01205 (W.D. Tex.) (transferred to the 8911 N.D. Cal. Case);

AlmondNet, Inc. v. Microsoft Corp., 6-22-cv-01206 (W.D. Tex.) (consolidated into the 897 W.D. Tex. Case);

AlmondNet, Inc. v. Meta Platforms, Inc. f/k/a Facebook, Inc., 4-22-cv-08911 (N.D. Cal.) (“8911 N.D. Cal. case”) (reassigned to the 7515 N.D. Cal. Case);

AlmondNet, Inc. v. Roku, Inc., 6-21-cv-00731 (W.D. Tex.) (pending but stayed);

AlmondNet, Inc. v. Facebook, Inc., 6-21-cv-00896 (W.D. Tex.) (transferred to the 8911 N.D. Cal. Case);

AlmondNet, Inc. v. Microsoft Corp., 6-21-cv-00897 (W.D. Tex.) (“897 W.D. Tex. case”) (pending);

AlmondNet, Inc. v. Amazon.com, Inc., 6-21-cv-00898 (W.D. Tex.) (“898 W.D. Tex. case”) (pending);

AlmondNet, Inc. v. Samsung Electronics Co., Ltd., 6-21-cv-00891 (W.D. Tex.) (transferred to the 7515 N.D. Cal. Case);

AlmondNet, Inc. v. Roku, Inc., 6-21-cv-00876 (W.D. Tex.)
(transferred to the 1540 D. Del. case and then consolidated with the 1035 D. Del. Case);

AlmondNet, Inc. v. Oath Holdings Inc., 1-19-cv-00247 (D. Del.)
 (“*Oath Holdings* case”) (terminated); and

AlmondNet, Inc. v. Yahoo! Inc., 1-16-cv-01557 (E. D. N.Y.)
(transferred to the *Oath Holdings* case).

Pet. ix–xi; Paper 5, 1.

Patent Owner indicates that the ’249 patent is also the subject of the following district court case: *AlmondNet, Inc., v. Lotame Solutions, Inc.*, 1:24-cv-00376 (D. Del.). Paper 5, 1.

Petitioner also indicates that the ’249 patent and its related patents are the subject of the following post-grant proceedings:

CBM2017-00049 (the ’307 patent);

CBM2017-00050 (the ’249 patent);

CBM2017-00051 (the ’904 patent);

CBM2017-00052 (the ’582 patent);

IPR2022-01260 (the ’582 patent);

IPR2022-01455 (the ’582 patent); and

IPR2022-01436 (the ’582 patent).

Pet. xi–xiii. Petitioner indicates that the Board in the IPR2022-01436 proceeding “has issued a final written decision finding all challenged claims of the ’582 patent, which are substantially similar to claims of the ’307 and ’249 patents, unpatentable.” Paper 8, 1.

B. The '249 patent

The '249 patent discloses that the claimed invention relates to “a mercantile method directed to brokerage of attributes of information.” Ex. 1001, 1:33–35. According to the '249 patent, “[a]dvances in database technology have given rise to commerce in records, files and databases, per se. For example, paying for a database credit check for an individual or buying a mailing list have become common practice.” *Id.* at 1:39–42. The '249 patent further discloses that “[u]nfortunately, the current state of information commerce is focused on the sales of whole databases, whole records, or evaluations based on single or clusters of records.” *Id.* at 1:61–63. The '249 patent indicates this is a problem because “[i]n commercial applications where specific attributes of information strongly affect the value of evaluations, there is a need in the art for commerce in such attributes. For example, in targeted advertising, every attribute, which substantially affects the probability of that advertisement’s success, innately has a discrete economic value.” *Id.* at 1:63–2:2. The '249 patent addresses this problem by utilizing “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 3:29–32. According to the '249 patent, the disclosed invention provides “a means for making viable the economic commerce in the information attributes” and “operates on a brokerage representation model.” *Id.* at 3:52–58.

Figure 1, reproduced below, “illustrates a schematic view of an Internet data communications topology” that is utilized by the '249 patent. *Id.* at 4:52–53.

Fig. 1

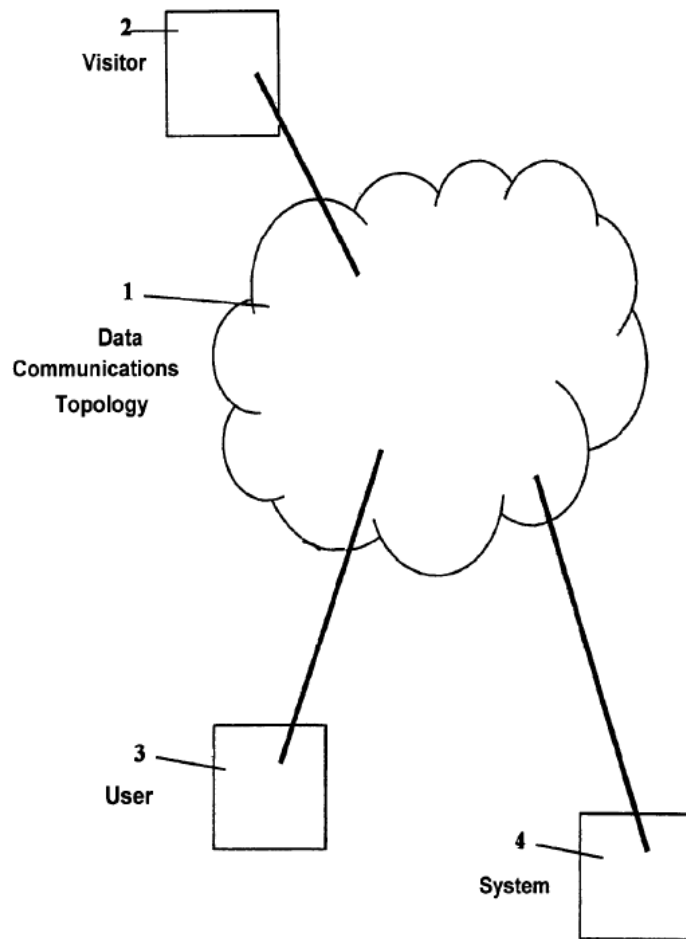


Figure 1 above shows data-communications topology 1 including a wide area network such as the Internet, interconnected to visitor 2, user 3, and system 4. *Id.* at 4:66–5:3. Such data-communication topology “having associated therewith a maintained databank of partial profiles” is used in the ’249 patent’s “descriptive-profile mercantile method” shown in Figure 2, which is reproduced below. *Id.* at 4:54–55, 5:4–7.

Fig. 2

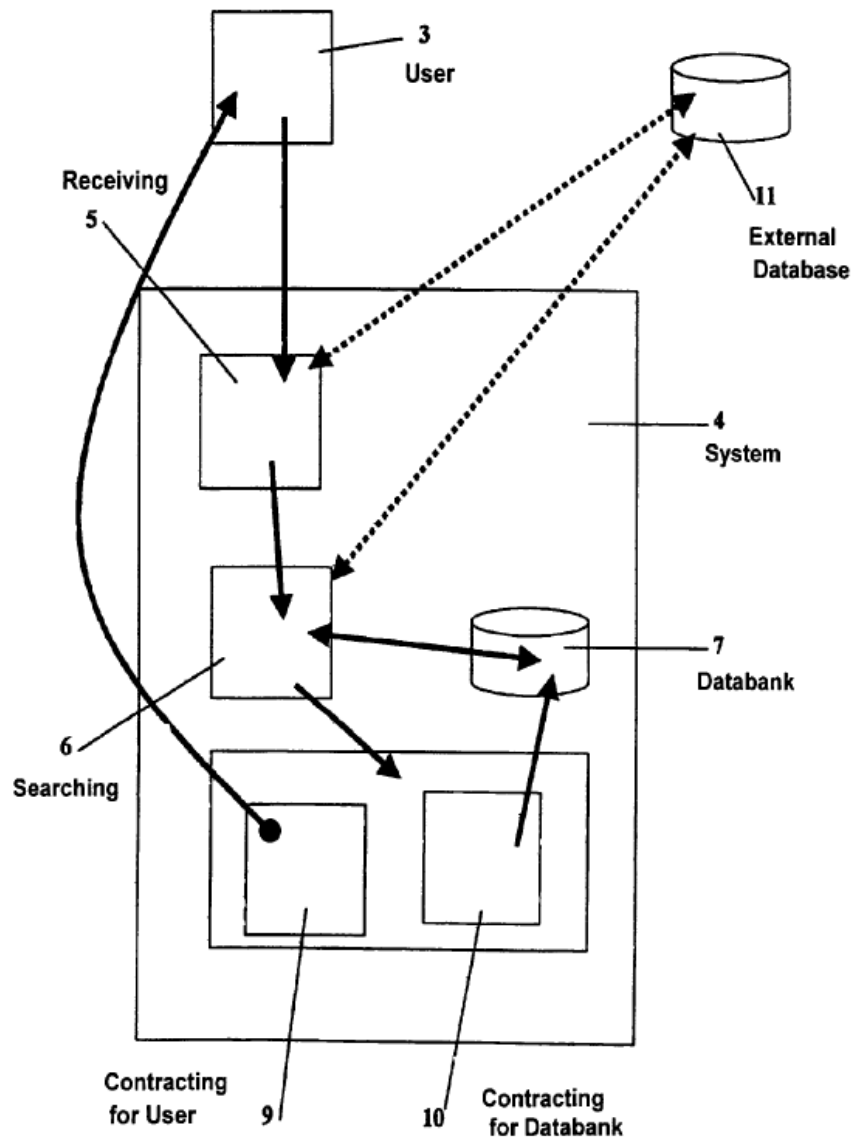


Figure 2 above shows a mercantile method including step 5 of receiving from user 3 “a transaction having therein a first partial profile,” and then step 6 of using the first partial profile to search in databank 7 that has a plurality of second partial profiles. *Id.* at 5:4–15. Then, between user 3 and

databank 7, the next step 10 is contracting for databank 7 “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 step 9 of contracting for user 3 “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 upon portion of the second profile.” *Id.* at 5:16–26. The ’249 patent’s “descriptive-profile mercantile method” allows, when visitor 2 arrives at website of user 3, the website to collect data of the visitor (including the visitor’s cookie) such that the website can combine the newly collected data with prior-acquired information to “enable the website to engage in potentially more successful product offering and/or targeted advertising to the visitor.” *Id.* at 8:29–47.

The ’249 patent discloses that visitor credentials, including, e.g., a cookie, can be used to enable “the web site to retrieve the visitor profile.” *Id.* at 3:61–64. Further, the ’249 patent discloses:

The web-site forwards particulars from the visitor’s credentials (a partial profile), as well as (optionally) a redirect to a portion of the visitor’s page to a server located in cyberspace (at a juncture in a data communications topology). By redirecting a portion of the visitor’s page to the server, the visitor’s browser reports to the server a cookie the server put on the visitor’s computer in the past, if any.

Id. at 4:1–7; *see also id.* at 11:64–12:6.

C. Challenged Claims

The '249 patent includes 22 claims,³ all of which are challenged in the Petition. Claim 1 is representative and reads as follows:

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, a partial profile of an entity that uses a user computer coupled to the global computer network and accessing a website, which partial profile is available to one of the third parties and contains at least one profile attribute related to the entity;
 - (b) automatically with the computer system electronically storing the received partial profile by adding the received partial profile to an electronically stored profile, which stored profile is believed to be related to the same entity;
 - (c) wherein receiving the partial profile is achieved as a result of automatic electronic URL redirection from a portion of a page of the website accessed by the user computer; and
 - (d) automatically with the computer system generating an electronic record of which of the plurality of unaffiliated third parties contributed to the stored profile particular profile attributes;
 - (e) wherein the stored profile, including the added partial profile, comprises data used in targeting third-party advertisements to the user computer over the global computer network.

Ex. 1001, 16:46–17:4.

³ Claims 2, 12, and 22 have been disclaimed. Pet. 1 (citing Ex. 1001,16).

D. Asserted Ground of Unpatentability

Petitioner asserts the following grounds of unpatentability in this
Petition (Pet. 5–6):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 3–6, 10, 11, 13–16, 20, 21, 23–25	103(a) ⁴	Merriman, ⁵ Jaye ⁶
1, 3–6, 10, 11, 13–16, 20, 21, 23–25	103(a)	Roth, ⁷ Jaye
1, 3–6, 10, 11, 13–16, 20, 21, 23–25	103(a)	Merriman, Minor ⁸
1, 3–6, 10, 11, 13–16, 20, 21, 23–25	103(a)	Roth, Minor
7–9, 17–19	103(a)	Merriman, Jaye, Coleman ⁹
7–9, 17–19	103(a)	Merriman, Minor, Coleman
7–9, 17–19	103(a)	Roth, Jaye, Coleman
7–9, 17–19	103(a)	Roth, Minor, Coleman
5, 15, 25	103(a)	Merriman, Jaye, Herz ¹⁰

⁴ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. § 103, and became effective on March 16, 2013. Because the ’249 patent claims priority to a string of continuation and divisional applications filed before that date, we apply the pre-AIA version of § 103. *See* Ex. 1001, codes (60)(30).

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

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

⁷ Roth et al., U.S. Patent No. 6,285,987 B1, issued Sept. 4, 2001 (Ex. 1036, “Roth”).

⁸ Minor et al., U.S. Patent No. 5,740,252, issued Apr. 14, 1998 (Ex. 1038, “Minor”).

⁹ Coleman, U.S. Patent Appl. Publ. No. 2002/0026351 A1, published Feb. 28, 2002 (Ex. 1039, “Coleman”).

¹⁰ Herz et al., U.S. Patent Appl. Publ. No. 2013/0097664 A1, published Apr. 18, 2013 (Ex. 1040, “Herz”).

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
5, 15, 25	103(a)	Merriman, Minor, Herz
5, 15, 25	103(a)	Roth, Jaye, Herz
5, 15, 25	103(a)	Roth, Minor, Herz
6, 9, 16, 19	103(a)	Merriman, Jaye, Gardner ¹¹
6, 9, 16, 19	103(a)	Merriman, Minor, Gardner
6, 9, 16, 19	103(a)	Roth, Jaye, Gardner
6, 9, 16, 19	103(a)	Roth, Minor, Gardner

Petitioner relies on the declaration of Dr. Sanjay Ranka, among other evidence. Ex. 1002.

II. DISCRETIONARY DENIAL IN VIEW OF PARALLEL PETITIONS

Petitioner filed three petitions for *inter partes* review of claims 1, 3–11, 13–21, and 23–25 of the ’249 patent: this Petition, the petition filed in IPR2024-00417, and the petition filed in IPR2024-00418. *See Freewheel Media, Inc. v. Almondnet, Inc.*, IPR2024-00417, Paper 2 (PTAB, filed Mar. 1, 2024); *Freewheel Media, Inc. v. Almondnet, Inc.*, IPR2024-00418, Paper 2 (PTAB, filed Mar. 1, 2024). Patent Owner argues that “Petitioner has not shown that this is one of the ‘rare’ instances where multiple petitions are needed.” Prelim. Resp. 1. Petitioner requests that we consider this Petition before we consider the Petitions in IPR2024-00417, and IPR2024-00418. Paper 3, 1. Accordingly, we reserve consideration of whether multiple petitions are merited for our decisions in IPR2024-00417, and IPR2024-00418.

¹¹ Gardner, U.S. Patent No. 6,141,694, issued Oct. 31, 2000 (Ex. 1043, “Gardner”).

III. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 312(A)(3)

Patent Owner argues that “the Petition alone—and even moreso when viewed in the context of the multiple petitions filed on the same day—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 *sixteen* express grounds of invalidity.” Prelim. Resp. 1.

“At the outset, a party must file a petition to institute review, 35 U.S.C. § 311(a), that identifies the challenged claims and the grounds for challenge with particularity, [35 U.S.C.] § 312(a)(3).” *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1351 (2018); *see also* 37 C.F.R. § 42.104(b) (specifying necessary elements of a petition). An IPR can be instituted only if there is a reasonable likelihood that the petitioner would prevail with respect to at least one of the claims challenged in the petition. 35 U.S.C. § 314(a). Even when a petitioner demonstrates a reasonable likelihood as to at least one claim, however, institution of an IPR remains discretionary. *SAS*, 138 S. Ct. at 1351 (“§ 314(a) invests the Director with discretion on the question whether to institute review.”); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“First of all, the [U.S. Patent and Trademark Office] is permitted, but never compelled, to institute an IPR proceeding” (citing 35 U.S.C. § 314(a))). As explained in the Consolidated Trial Practice Guide (“CTPG”),¹² “[t]he Director’s discretion is informed by 35 U.S.C. §§ 316(b) and 326(b), which require the Director to ‘consider the

¹² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

effect of any such regulation [under this section] on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter.” CTPG, 56.

“Because the Board’s practice, in light of *SAS*, is to institute on all grounds asserted in a petition, the Board may consider whether a lack of particular[ity] as to one or more of the asserted grounds justifies denial of an entire petition.” *Adaptics Ltd. v. Perfect Co.*, IPR2018-01596, Paper 20 at 17 (PTAB March 6, 2019) (Informative). For example, in *Adaptics*, the Board found that the petition contained voluminous or excessive grounds and that “the Petition fail[ed] to specify what Petitioner regard[ed] as the difference(s) between [the references] and the challenged claims.” *Id.* at 18–20. More specifically, the Board found that “Petitioner’s ‘catch-all’ ground attempt[ed] to require Patent Owner to address whether each and every claim limitation [was] taught not only by each of [two primary references], but by each of these references in combination with one or more of the other references asserted in the proceeding.” *Id.* at 20–21. Accordingly, the Board concluded that “Petitioner’s ‘catch-all’ ground [was] not reasonably bounded in scope and unduly burdensome for both Patent Owner and the Board to address.” *Id.* at 21.

Additionally, as discussed above, our rules require that a petition includes fully developed arguments. *See* 37 C.F.R. § 42.22(a)(2) (the “petition . . . must include . . . [a] full statement of the reasons for the relief requested”); *DeSilva v. DiLeonardi*, 181 F.3d 865, 866–67 (7th Cir. 1999) (“A brief must make all arguments accessible to the judges, rather than ask

them to play archeologist with the record.”). By statute, a petition is required to identify “with particularity[] the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge.” 35 U.S.C. § 312(a)(3). The petition shall also include a “full statement” with “a detailed explanation of the significance of the evidence, including material facts.” 37 C.F.R. § 42.22(a)(2). In that regard, our rules require a petition to include both an adequate explanation of how the claims should be construed, as well as information sufficient to show how and why the properly construed claims are unpatentable over the asserted prior art. 37 C.F.R. § 42.104(b)(3), (b)(4). A petition should also “explain why a person of ordinary skill in the art would have combined elements from specific references in the way the claimed invention does.” *ActiveVideo Networks, Inc. v. Verizon Comm’ns, Inc.*, 694 F.3d 1312, 1328 (Fed. Cir. 2012). Thus, based on our rules, we only consider fully developed arguments set forth in the petition.

Patent Owner argues that “[a] petition that sets forth extensive alternative grounds fails to meet the particularity requirement, and it may also independently be denied institution as an exercise of the Board’s discretion based upon the assertion of ‘voluminous and excessive grounds’ and lack of procedural fairness to the patent owner.” Prelim. Resp. 10 (quoting *Adaptics*, Paper 20 at 24; *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016)). According to Patent Owner, the Petition contains both (1) sixteen separate grounds specifically identified in the Petition and (2) multiple shadow grounds based

on testimony that is several times longer than the Petition and relies on many additional references. *Id.* at 10–12.

We are not persuaded by Patent Owner’s arguments. Unlike in *Adaptics*, which involved potentially hundreds of distinct grounds challenging each claim due to the use of “and/or” in the catch-all ground (*see Adaptics*, Paper 20 at 19), the Petition relies on four grounds, comprised of combinations of two primary references with two secondary references, for each of the challenged claims (*see* Pet. 5–6).

Nor has Patent Owner shown any evidence of improper “shadow grounds.” Although Patent Owner points to the size of declaration testimony and the number of exhibits relied on by the declarants, Patent Owner has not pointed to any examples of alleged improper use of the testimony or exhibits. We decline to perform analysis that is missing from the Preliminary Response. *See United States v. Dunkel*, 927 F.2d 955, 956 (7th Cir. 1991) (“Judges are not like pigs, hunting for truffles buried in briefs.”); *DeSilva* 181 F.3d at 866–67 (7th Cir. 1999) (“A brief must make all arguments accessible to the judges, rather than ask them to play archaeologist with the record.”).

To be clear, we make no judgment on the propriety of the declarants’ testimony or the cited exhibits at this time. If appropriate, Patent Owner can challenge (1) the admissibility of the exhibits and testimony and (2) specific arguments as going beyond the grounds stated in the Petition during the trial. But simply including a significant amount of testimony and a number of supporting references is not, by itself, a reason to find that the particularly requirement is not met.

IV. PATENTABILITY ANALYSIS

A. Principles of Law

“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”)).

A claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the subject matter sought to be patented 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 that 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) objective indicia of nonobviousness when presented.¹³ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

B. Level of Skill in the Art

In determining the level of skill in the art, we consider the problems encountered in the art, the art’s solutions to those problems, the rapidity with which innovations are made, the sophistication of the technology, and the

¹³ The current record in this proceeding does not include any argument or evidence directed to objective indicia of nonobviousness.

educational level of active workers in the field. *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986).

Petitioner contends that a person of ordinary skill in the art “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 dispute Petitioner’s definition of the person of ordinary skill in the art. *See* Prelim. Resp.

Petitioner’s definition appears to be consistent with the field of the invention reflected in the prior art of record and the disclosure of the ’249 patent. Accordingly, for purposes of this Decision, we adopt Petitioner’s proposed definition of the person of ordinary skill in the art.

C. Claim Construction

We interpret a claim “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b).” 37 C.F.R. § 42.100(b) (2023). Under this standard, we construe the claim “in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” *Id.*

Petitioner asserts that it applies Patent Owner’s construction of the term “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 (citing Ex. 1011, 30–36, 69). Petitioner further asserts that “[a]ll other terms have been given their plain and ordinary meaning.” *Id.*

Patent Owner does not dispute Petitioner's proposed construction.
See Prelim. Resp.

We determine that no terms require express construction at this stage.
See Realtime Data, LLC v. Iancu, 912 F.3d 1368 (Fed. Cir. 2019) ("The Board is required to construe 'only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.'" (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

D. Overview of Asserted Prior Art Relevant to Disputed Issues

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). Petitioner contends that Merriman is prior art under pre-AIA 35 U.S.C. § 102(a) and (e). Pet. 4. Merriman concerns compiling statistics on individual users and networks and tracking the use of advertisements to permit targeting of the advertisements to individual users. Ex. 1035, 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 on the next page.

FIG. 1

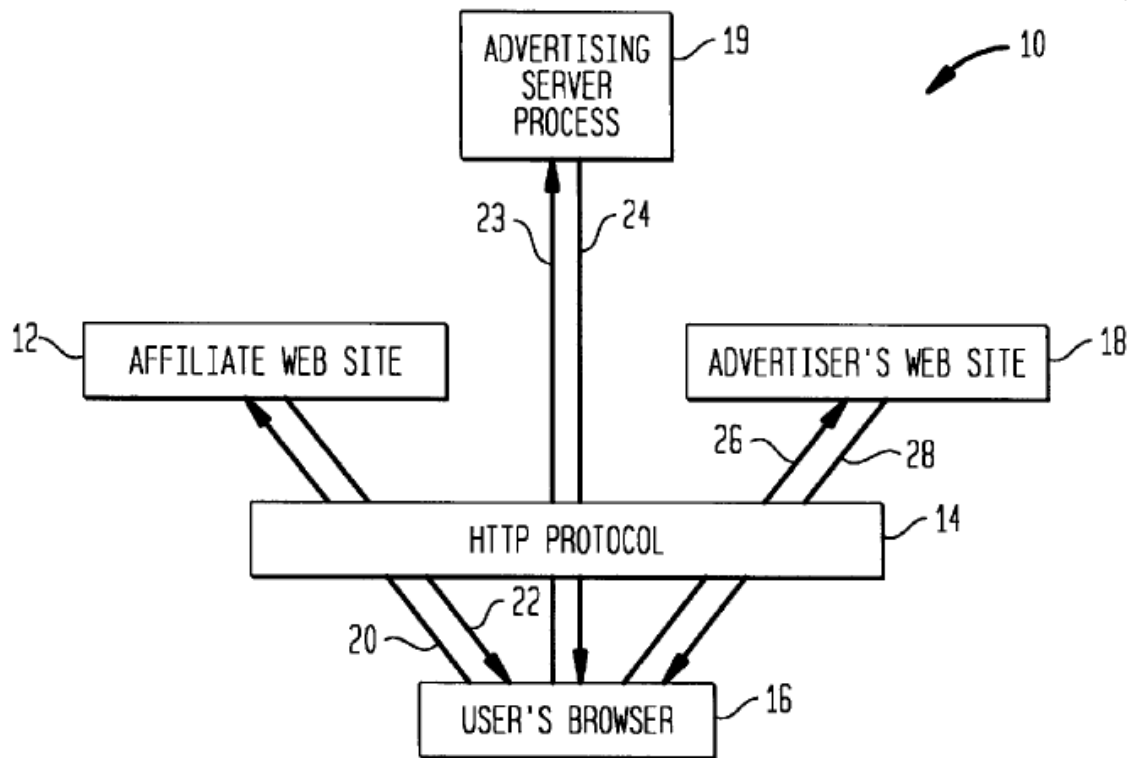


Figure 1 illustrates the basic architecture of a network 10 that comprises at least one affiliate web site 12, an advertisement (ad) server web site 19, and one or more individual advertisers web sites 18. Ex. 1035, 2:59–62.

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). Petitioner contends that Jaye is prior art under pre-AIA 35 U.S.C. § 102(e). Pet. 4. Jaye concerns a global interest profile of a user. Ex. 1037, 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.

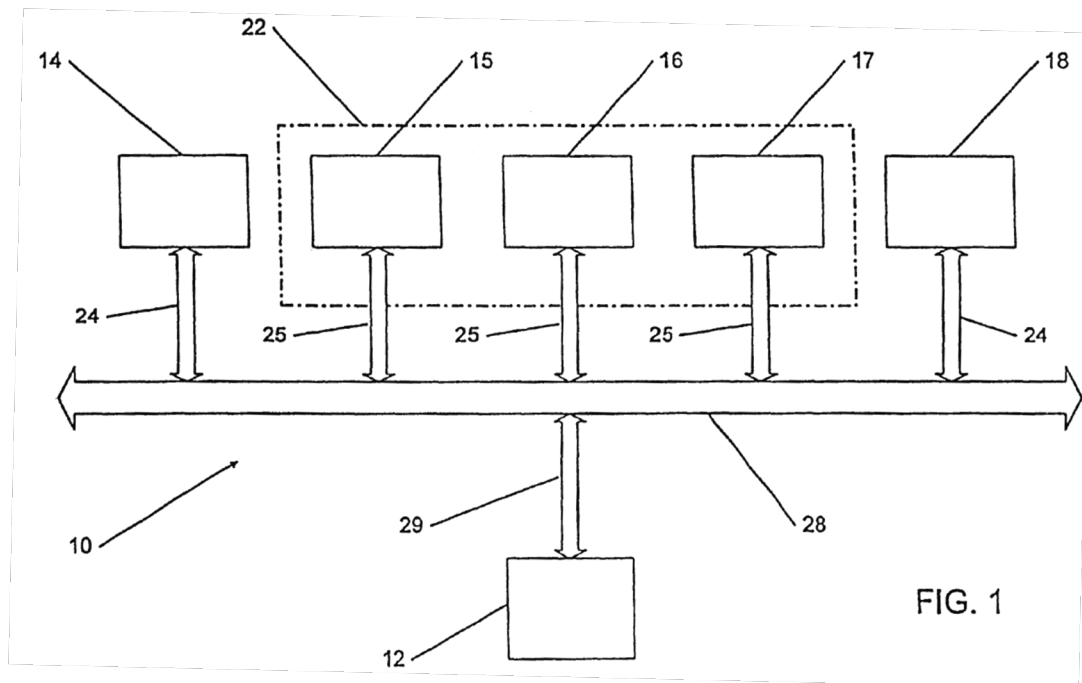


Figure 1 illustrates a part 10 of the Internet computer network that includes a client 12 and a group of servers 14–18. Ex. 1038, 4:5–6. Jaye describes that “client 12 may be any one of a variety of conventional, commercially available, hardware and software combinations configured to access Internet 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 an internet advertising system that issued September 4, 2001. Ex. 1036, codes (12), (45). Petitioner contends that Roth is prior art under pre-AIA 35 U.S.C. § 102(e). Pet. 5. Roth concerns “[a] system for providing advertisements from a central server to viewers who access web sites.” Ex. 1036, 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 on the next page.

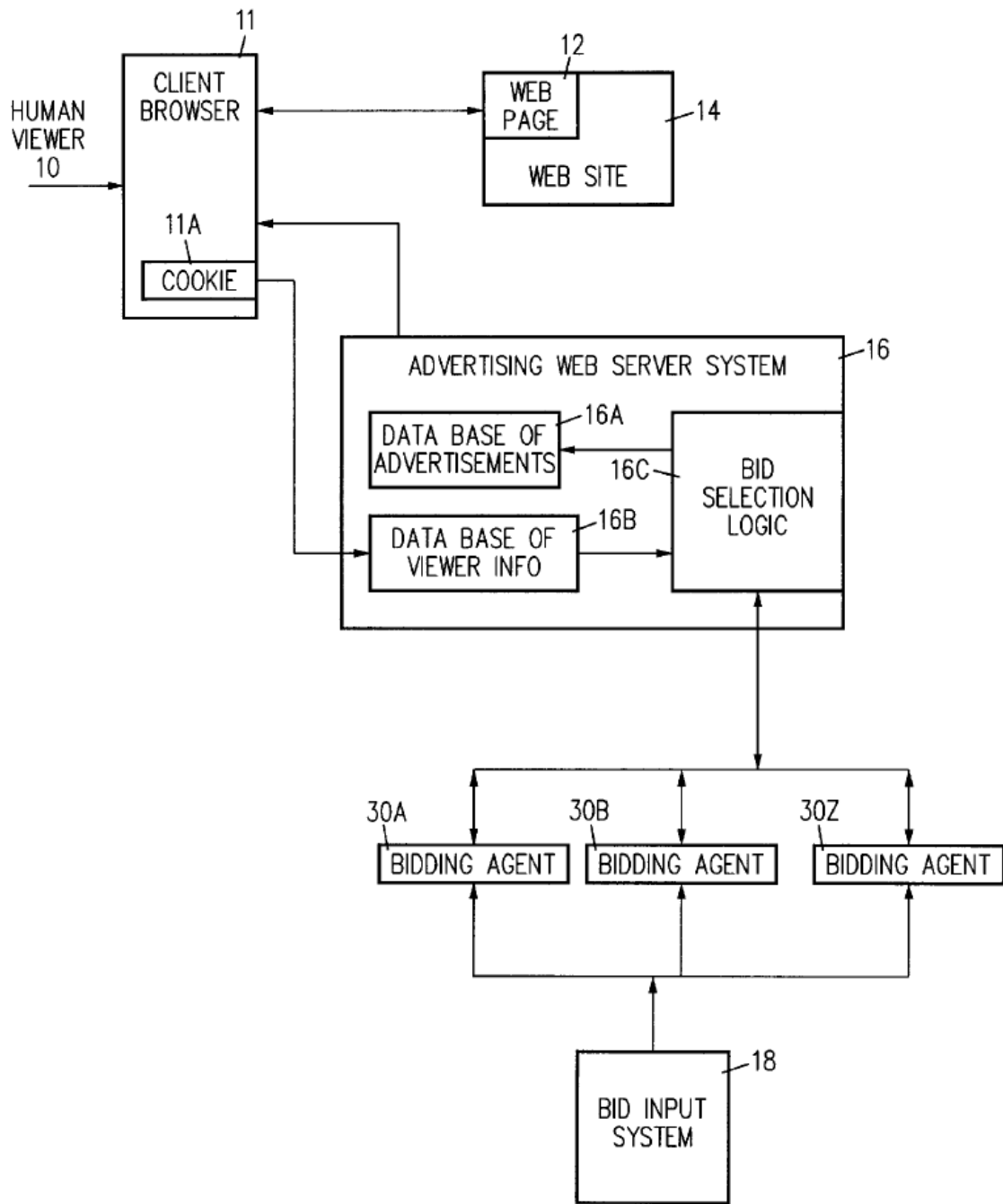


Figure 1 illustrates a human viewer 10 that utilizes a client browser 11 to access a web page 12 on a web site 14. Ex. 1036, 3:33–34. Web page 12 is transmitted to browser 11 and includes an HTML reference to a file (i.e., an

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). Petitioner contends that Minor is prior art under pre-AIA 35 U.S.C. § 102(b). Pet. 5. Minor concerns “associating a computer operator with a set of demographic information.” Ex. 1038, code (57).

Figure 2 of Minor is reproduced on the next page.

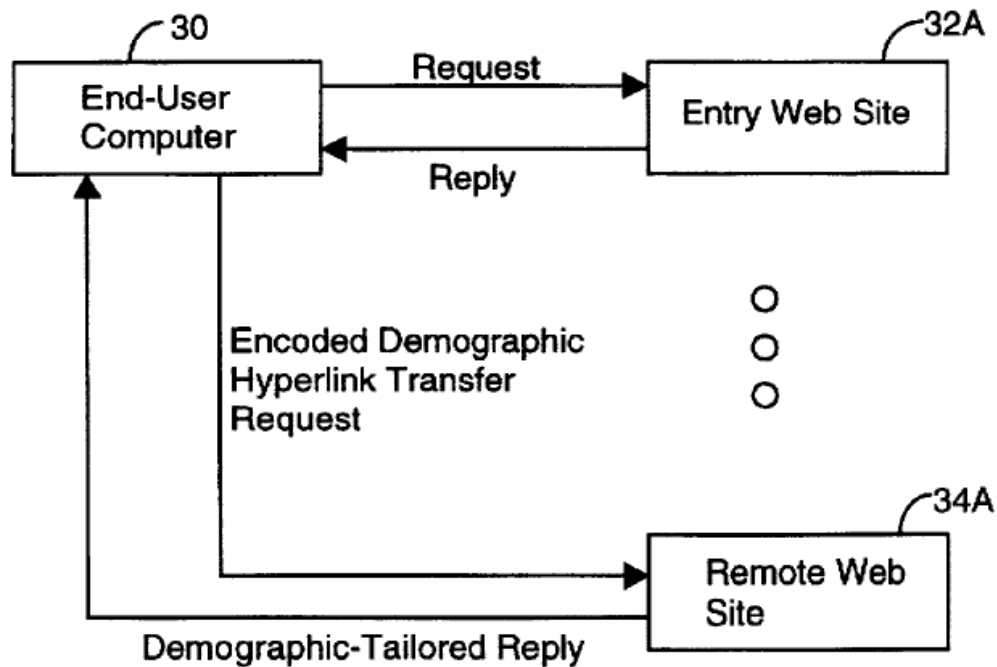


Figure 2 illustrates a system architecture that includes an end-user computer 30 that generates a request that reaches an entry web site 32A. Ex. 1038. 3:40–41. The request uses a Uniform Resource Locator (URL) address to specify a computer (entry web site 32A) and information (a file) at that computer. *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.

5. Coleman (Ex. 1039)

Coleman is a U.S. Patent Application Publication published on Feb. 28, 2002. Ex. 1039, code (43). Petitioner contends that Coleman is prior art

under pre-AIA 35 U.S.C. § 102(e). Pet. 5. Coleman discloses “pooling and advertising methods and systems for linking purchasers with sellers of goods or services, as well as targeted commercial messaging.” Ex. 1039 ¶ 2. In Coleman’s method, “[a]fter information has been gathered from a registered user . . . , the information may be verified for accuracy, updated, and profiled in comparison to other registered users.” *Id.* ¶ 73.

6. Herz (Ex. 1040)

Herz is a U.S. Patent Application Publication published on Apr. 18, 2013. Ex. 1040, code (43). Petitioner contends that Herz is prior art under pre-AIA 35 U.S.C. § 102(e). Pet. 5. Herz discloses a “Secure Data Interchange” (SDI) which is “a system to allow a privacy-protected market for data exchange between multiple self-interested parties.” Ex. 1040 ¶ 3. Herz’s SDI is “a central data warehouse that maintains data submitted by different users, and executes queries and programs on the data.” *Id.* ¶ 43.

7. Gardner (Ex. 1043)

Gardner is a U.S. patent issued on Oct. 31, 2000. Ex. 1043, code (45). Petitioner contends that Gardner is prior art under pre-AIA 35 U.S.C. § 102(e). Pet. 5. Gardner discloses “the use of online resources to determine facts about a user and the verification of user data with reference to the user’s online activities.” Ex. 1043, 1:6–9. For maintenance of user data, Gardner discloses step 615 in which “a determination is made regarding whether or not to update the currently stored user data.” *Id.* at 7:37–39, 8:4–5.

E. Obviousness over the Combination of Merriman and Jaye

Petitioner asserts that claims 1, 3–6, 10, 11, 13–16, 20, 21, and 23–25 would have been obvious over the combination of Merriman and Jaye and sets forth an element-by-element comparison of the challenged claims to the asserted art. Pet. 8–33. At this point in the proceeding, Patent Owner does not substantively dispute Petitioner’s obviousness contentions. See Prelim. Resp.

1. Rationale for 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^[14] 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 ¶ 224). Petitioner asserts that “message 23 includes a cookie stored on browser 16,” but acknowledges that Merriman “does not expressly 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). Petitioner contends that it would have been obvious to pass profile information from website 12 to server 19 in view of Jaye. *Id.*

¹⁴ We do not reproduce the coloring of the text or bold emphasis used in the Petition.

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, 4:5–5:19, 7:21–26, 8:40–43, 13:19–41, 14:22–25, Fig. 1; Ex. 1002 ¶ 225). 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 contends:

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. Ex. 1002 ¶ 228; Ex. 1035, 3:24–4:54; Ex. 1037, 6:32–67, 7:46–57, 8:40–52). 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. Ex. 1002 ¶ 228; Ex. 1035, 4:43–50; Ex. 1037, 8:10–55. . . . Thus, 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. Ex. 1002 ¶ 229.

Pet. 12–13.

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.

Having reviewed the arguments and evidence included in the Petition, including the Ranka Declaration, which are not substantively addressed by Patent Owner at this stage (*see* Prelim. Resp.), we are persuaded that Petitioner sufficiently demonstrates, for purposes of this Decision, that it would have been obvious to combine Merriman and Jaye in the manner set forth in the Petition.

2. Petitioner’s contentions regarding claim 1

Petitioner addresses each limitation of claim 1. Pet. 17–27. Patent Owner does not dispute Petitioner’s assertions for each limitation. *See* Prelim. Resp. Below, we address each limitation of claim 1.

a) *Preamble*

The preamble of claim 1 recites “[a]n automated method of collecting profiles of Internet using entities.” Ex. 1001, 16:46–47.

Petitioner contends that “[t]o the extent the preamble is limiting, Merriman-Jaye teaches it.” Pet. 17. More specifically, Petitioner asserts that “Merriman discloses methods for delivering targeted advertisements over the Internet” that includes “gathering information about those receiving the advertisements” and “compil[ing] information about users using browser

16 to access websites . . . into user profiles.” *Id.* (citing Ex. 1035, 1:8–11, 2:1–3, 2:6–14, 2:37–45, 2:40–45, 2:65–3:28, 4:20–27, 4:43–54, 7:46–56, 8:51–56, FIG. 3A). Supported by the testimony of Dr. Ranka (Ex. 1002 ¶ 240), Petitioner contends that the method suggested by Merriman and Jaye is a method as recited in the preamble. *Id.*

Having reviewed the arguments and evidence included in the Petition, including the Ranka Declaration, which are not substantively addressed by Patent Owner at this stage (*see* Prelim. Resp.), we are persuaded that Petitioner sufficiently demonstrates, for purposes of this Decision, that it the method suggested by Merriman and Jaye is a method as recited in the preamble.¹⁵

b) Limitation 1A: the electronically receiving step

Claim 1 further recites “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, a partial profile of an entity that uses a user computer coupled to the global computer network and accessing a website, which partial profile is available to one of the third parties and contains at least one profile attribute related to the entity.” Ex. 1001, 16:48–55 (“limitation 1A” or “the electronically receiving

¹⁵ Because Petitioner has sufficiently shown that the prior art teaches the preamble, we need not determine at this time whether the preamble is limiting. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017). If Patent Owner contends that the preamble is limiting, it must do so in the claim construction section of the Patent Owner’s Response.

step”). Petitioner contends that the combination of Merriman and Jaye suggests limitation 1A. *See* Pet. 17–20.

Petitioner asserts that “Merriman’s advertising server 19 (claimed ‘programmed computer system’)” is a “computer platform programmed to perform its various processes” that is comprised of “one or more servers and use[r] database 54” and that “is coupled to the Internet (claimed ‘global computer network’).” Pet. 17 (citing Ex. 1035, code (57), 3:6–18, 3:24–28, 4:12–19, 8:47–60, 9:8–16; Ex. 1002 ¶ 241). Petitioner further asserts that Merriam’s website is “controlled by one of a plurality of unaffiliated third parties.” *Id.* at 18 (citing Ex. 1035, 2:59–3:4, 3:16–18, 3:30–38, 4:12–19; Ex. 1002 ¶ 242). Petitioner identifies the user of Merriman’s user computer operating browser 16 as the claimed “entity that uses a computer” and points out that browser 16 is coupled to the Internet and can access website 12. *Id.* (citing Ex. 1035, 2:65–2:1, 3:6–18, 3:24–28; Ex. 1002 ¶ 243). 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 acknowledges that Merriman “does not expressly disclose message 23 including profile information from website 12.” *Id.* at 18–19 (citing Ex. 1035, 3:28–57; Ex. 1002 ¶ 244).

To address this deficiency, Petitioner asserts that the combination of Merriman and Jaye, “maintains Merriman’s system, but modifies Merriman’s operation to append profile information to a URL in messages 22 and 23.” *Id.* at 19 (citing Ex. 1002 ¶ 244). According to Petitioner, in the combined method, “both messages 22 and 23 include profile information about browser 16’s user (claimed ‘partial profile’) appended to the URL by

website 12.” *Id.* Further, Petitioner asserts, in the method suggested by Merriman and Jaye, profile information would contain “at least one attribute related to the user of the browser” and would be “available to the party controlling website 12 because website 12 appends it.” *Id.* at 20 (citing Ex. 1002 ¶¶ 245–246). Petitioner, thus, asserts that the combination of Merriman and Jaye suggests limitation 1A. *Id.*

Having reviewed the arguments and evidence included in the Petition, including the Ranka Declaration, which are not substantively addressed by Patent Owner at this stage (*see* Prelim. Resp.), we are persuaded that Petitioner sufficiently demonstrates, for purposes of this Decision, that the combination of Merriman and Jaye suggests the claimed electronically receiving step.

c) Limitation 1B: electronically storing step

Claim 1 further recites “automatically with the computer system electronically storing the received partial profile by adding the received partial profile to an electronically stored profile, which stored profile is believed to be related to the same entity.” Ex. 1001, 16:56–59 (“limitation 1B” or “the electronically storing step”).

Petitioner asserts that “Merriman’s database structure stores a user profile (claimed ‘electronically stored profile’), including attributes such as a user identification (‘USER ID’) and information identifying pages on which advertisements were seen (‘PAGES ADS SEEN ON’).” Pet. 20 (citing Ex. 1035, 4:43–54, Fig. 3A; Ex. 1002 ¶ 247). According to Petitioner, “[a]dvertising server 19 (claimed ‘computer system’) automatically receives

the attributes and electronically stores them in database 54 on a user-by-user basis to form a user profile for each user.” *Id.* (citing Ex. 1035, 3:41-52, 3:64-4:8, 4:20-24, 4:43-50; Ex. 1002 ¶ 247). Petitioner contends that these features are “related to attributes that Jaye expressly discloses as being appended,” and would be preserved in the proposed Merriman-Jaye combination. *Id.* at 21 (citing Ex. 1037, 5:5–6:46; Ex. 1002 ¶ 248). Petitioner then provides examples of the information that would be stored in the proposed Merriman-Jaye combination. *Id.* at 21–22 (citing Ex. 1002 ¶¶ 248–251).

Having reviewed the arguments and evidence included in the Petition, including the Ranka Declaration, which are not substantively addressed by Patent Owner at this stage (*see* Prelim. Resp.), we are persuaded that Petitioner sufficiently demonstrates, for purposes of this Decision, that the combination of Merriman and Jaye suggests the claimed electronically storing step.

d) Limitation 1C: automatic redirection step

Claim 1 further recites “wherein receiving the partial profile is achieved as a result of automatic electronic URL redirection from a portion of a page of the website accessed by the user computer.” Ex. 1001, 16:60–63 (“limitation 1C” or “the automatic redirection step”).

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” and that “[t]his is ‘automatic electronic URL redirection.’” Pet. 22 (citing Ex. 1002 ¶¶ 252–253; Ex. 1035, 3:28–44; Ex. 1019, 112–113). Petitioner further

asserts that in the proposed combination of Merriman-Jaye, “the same messages 22 and 23 of Merriman are communicated, but with profile information appended to the URL.” *Id.* at 23 (citing Ex. 1002 ¶ 256). 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 ¶ 257).

Having reviewed the arguments and evidence included in the Petition, including the Ranka Declaration, which are not substantively addressed by Patent Owner at this stage (*see* Prelim. Resp.), we are persuaded that Petitioner sufficiently demonstrates, for purposes of this Decision, that the combination of Merriman and Jaye suggests the claimed automatic redirection step.

e) Limitation 1D: automatically generating step

Claim 1 further recites “automatically with the computer system generating an electronic record of which of the plurality of unaffiliated third parties contributed to the stored profile particular profile attributes.” Ex. 1001, 16:64–67 (“limitation 1D” or “the automatically generating step”).

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.” Pet. 24 (citing Ex. 1035, 4:5–8, 4:20–24, 4:32–37, 4:43–54, Fig. 3; Ex. 1002 ¶ 258). Petitioner further asserts that “[a]dvertising server 19 automatically generates the information identifying a page an advertisement was seen on” and that by generating such

information, “Merriman generates an electronic record of the party controlling website 12 that contributed the profile information.” *Id.* at 24 (citing Ex. 1002 ¶ 259). Thus, according to Petitioner, Merriman teaches the claimed automatically generating step. *Id.* Petitioner contends that this feature would be preserved in the combination of Merriman and Jaye. *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. 25 (citing Ex. 1002 ¶ 262; Ex. 1037, 8:23–28).

Having reviewed the arguments and evidence included in the Petition, including the Ranka Declaration, which are not substantively addressed by Patent Owner at this stage (*see* Prelim. Resp.), we are persuaded that Petitioner sufficiently demonstrates, for purposes of this Decision, that the combination of Merriman and Jaye suggests the claimed “automatically generating step.”

f) Limitation 1E: stored profile limitation

Claim 1 further recites “wherein the stored profile, including the added partial profile, comprises data used in targeting third-party advertisements to the user computer over the global computer network.” Ex. 1001, 17:1–4 (“limitation 1E” or “the stored profile limitation”).

Petitioner asserts that Merriman discloses using data “in the user profiles to deliver targeted advertisements for third-party advertisers 18 to

the user computer operating browser 16 over the Internet.” Pet. 26 (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 ¶ 264). 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.* at 26–27 (citing Ex. 1002 ¶ 265). Petitioner asserts further that this feature would be preserved in the combination of Merriman and Jaye, noting that “[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.*

Having reviewed the arguments and evidence included in the Petition, including the Ranka Declaration, which are not substantively addressed by Patent Owner at this stage (*see* Prelim. Resp.), we are persuaded that Petitioner sufficiently demonstrates, for purposes of this Decision, that the combination of Merriman and Jaye suggests the claimed stored profile limitation.

g) Conclusion for claim 1

Based on the current record, there is a reasonable likelihood that Petitioner will prevail in demonstrating that claim 1 is unpatentable as obvious over the combination of Merriman and Jaye.

3. Petitioner’s contentions regarding claims 3–6, 10, 11, 13–16, 20–21, and 23–25

Because Petitioner demonstrates a reasonable likelihood of success in proving that at least one claim of the ’249 patent is unpatentable, we institute on all grounds and all claims raised in the Petition. *See* 37 C.F.R.

§ 42.108(a). Therefore, at this stage of the proceeding, it is not necessary for us to provide an assessment of every claim in the ground challenged by Petitioner, especially, as in this case, when Patent Owner does not separately argue those claims. Those challenges, in our view, are best left for trial after full development of the record.

F. Remaining Grounds

Petitioner asserts that claims 1, 3–11, 13–21, and 23–25 would have been obvious over various combinations of Merriman, Minor, Jaye, Coleman, Hertz, and Gardner as well as over various combinations of Roth, Minor, Jaye, Coleman, Hertz, and Gardner. Because Petitioner demonstrates a reasonable likelihood of success in proving that at least one claim of the '249 patent is unpatentable, we institute on all grounds and all claims raised in the Petition. *See* 37 C.F.R. § 42.108(a). Therefore, at this stage of the proceeding, it is not necessary for us to provide an assessment of every challenge raised by Petitioner, especially, as in this case, when Patent Owner does not separately argue these grounds. Those challenges, in our view, are best left for trial after full development of the record.

V. CONCLUSION

On this preliminary record, Petitioner has established a reasonable likelihood of prevailing in showing that at least one of the challenged claims is unpatentable based on the grounds advanced in the Petition.

VI. NOTICES

The Board shall deem forfeited any issue not raised by Patent Owner in a timely response to the Petition or as permitted in another manner during

trial, even if the issue was raised in the Preliminary Response or discussed in this Decision.

Nothing in this Decision authorizes Petitioner, in a manner not otherwise permitted by the Board's rules or controlling precedent, to supplement the information supporting any ground advanced in the Petition.

VII. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *granted*, and we institute *inter partes* review of claims 1, 3–11, 13–21, and 23–25 based on the grounds asserted in this Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is given of the institution of trial, which will commence on the entry date of this Decision.

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