

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FREEWHEEL MEDIA, INC.,
Petitioner,

v.

ALMONDNET, INC.,
Patent Owner.

IPR2024-00417
Patent 8,775,249 B2

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

COTTA, Administrative Patent Judge.

DECISION

Denying 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. 1101, “the ’249 patent”). Paper 2 (“Pet.” or “Petition”). Almondnet, Inc. (“Patent Owner”)² filed a Preliminary Response. Paper 9 (“Prelim. Resp.”).

We have authority to determine whether to institute review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4. 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 the concurrent filing by Petitioner of petitions in IPR2024-00416 and IPR2024-00418.

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. vii; Paper 5, 1.

The parties identify IPR2024-00416 and IPR2024-00418 as parallel *inter partes* review proceedings in which Petitioner filed two other petitions challenging the ’249 patent. Pet. vii; Paper 5, 1. In concurrently issued decisions, we grant institution in IPR2024-00416 and deny institution in IPR2024-00418.

Petitioner identifies IPR2024-00413, IPR2024-00414, and IPR2024-00415 as *inter partes* review proceedings in which Petitioner filed 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. vii.

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

challenging related U.S. Patent No. 7,979,307 (“the ’307 patent”). Pet vii–viii.

Petitioner states that the ’249 patent is a continuation of U.S. Patent Appl. 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), which is a continuation of U.S. Appl. No. 12/186,918 (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 viii.

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. viii–x; 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. x–xii. 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

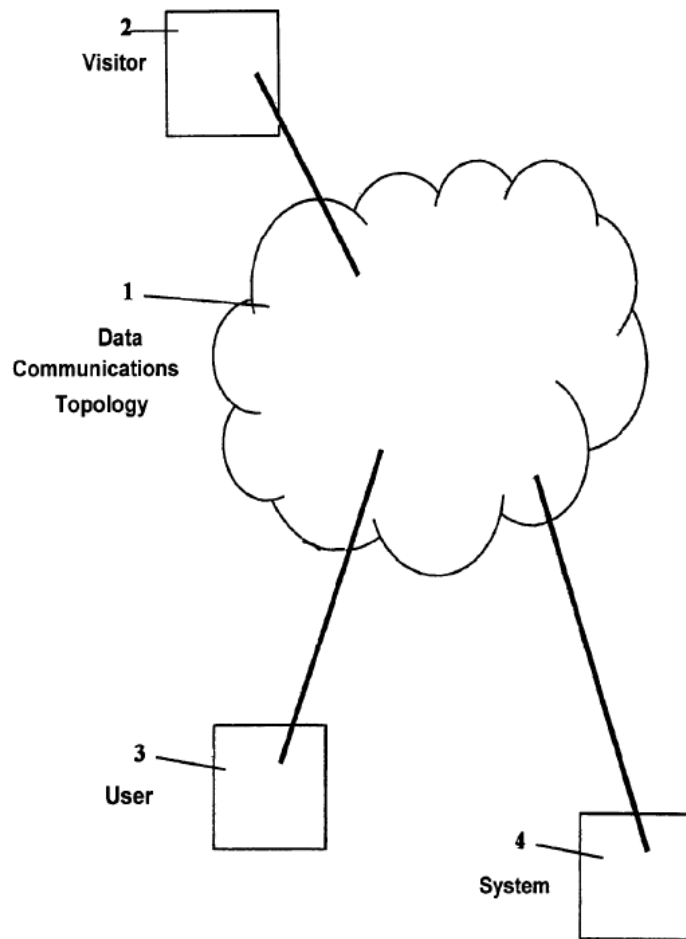


Figure 1 above shows data-communications topology 1 including a wide area network such as the Internet, interconnected to visitor 2, user 3, and system 4. *Id.* at 4:66–5:3. Such data-communication topology “having associated therewith a maintained databank of partial profiles” is used in the ’249 patent’s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

Fig. 2

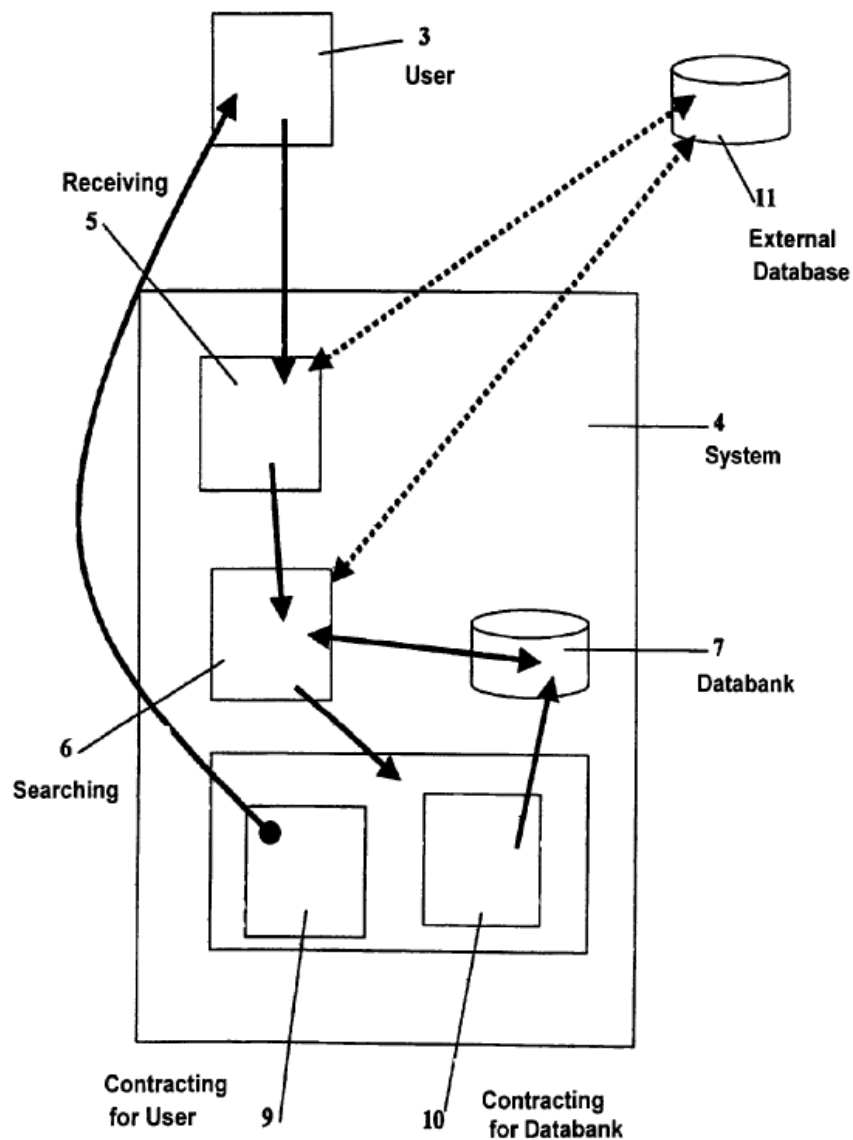


Figure 2 above shows a mercantile method including step 5 of receiving from user 3 “a transaction having therein a first partial profile,” and then step 6 of using the first partial profile to search in databank 7 that has a plurality of second partial profiles. *Id.* at 5:4–15. Then, between user 3 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 23 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. 1101, 16:46–17:4.

³ Claims 2, 12, and 22 have been disclaimed. Pet. 1.

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, 9–11, 13–16, 19–21, 23–25	103(a) ⁴	Rosenberg ⁵
1, 3–6, 9–11, 13–16, 19–21, 23–25	103(a)	Rosenberg, Zeff, ⁶ Sterne ⁷
1, 3–6, 9–11, 13–16, 19–21, 23–25	103(a)	Rosenberg, Kurtzman ⁸
1, 3–6, 9–11, 13–16, 19–21, 23–25	103(a)	Rosenberg, Zeff, Sterne, Kurtzman
1, 3–6, 9–11, 13–16, 19–21, 23–25	103(a)	Rosenberg, Merriman ⁹
1, 3–6, 9–11, 13–16, 19–21, 23–25	103(a)	Rosenberg, Zeff, Sterne, Merriman
6, 16	103(a)	Rosenberg, Farber 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 Rosenberg et al., U.S. Patent No. 6,073,241, issued June 6, 2000 (Ex. 1155, “Rosenberg”).

⁶ Zeff, R., et al., *Advertising on the Internet*, John Wiley & Sons, Inc., pp. 1–27, 89–109, 1997 (Ex. 1156, “Zeff”).

⁷ Sterne, Jim, *What Makes People Click: Advertising on the Web*, Que Corporation, pp. 1–41, 145–256, 375–386, 1997 (Ex. 1157, “Sterne”).

⁸ Kurtzman, II et al., U.S. Patent No. 6,144,944, issued Nov. 7, 2000 (Ex. 1158, “Kurtzman”).

⁹ Merriman et al., U.S. Patent No. 8,566,154 B2, issued Oct. 22, 2013 (Ex. 1159, “Merriman”).

¹⁰ Farber et al., U.S. Patent No. 5,978,791, issued Nov. 2, 1999 (Ex. 1163, “Farber”).

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
6, 16	103(a)	Rosenberg, Zeff, Sterne, Farber
6, 16	103(a)	Rosenberg, Kurtzman, Farber
6, 16	103(a)	Rosenberg, Zeff, Sterne, Kurtzman, Farber
6, 16	103(a)	Rosenberg, Merriman, Farber
6, 16	103(a)	Rosenberg, Zeff, Sterne, Merriman, Farber
7, 8, 17, 18	103(a)	Rosenberg, Coleman ¹¹
7, 8, 17, 18	103(a)	Rosenberg, Zeff, Sterne, Coleman
7, 8, 17, 18	103(a)	Rosenberg, Kurtzman, Coleman
7, 8, 17, 18	103(a)	Rosenberg, Zeff, Sterne, Kurtzman, Coleman
7, 8, 17, 18	103(a)	Rosenberg, Merriman, Coleman
7, 8, 17, 18	103(a)	Rosenberg, Zeff, Sterne, Merriman, Coleman

Petitioner relies on the declaration of Dr. Sanjay Ranka, among other evidence. Ex. 1102.

II. DISCRETIONARY DENIAL

As discussed *supra* § I.A, this is the second of three petitions filed concurrently by Petitioner challenging claims 1, 3–11, 13–21, and 23–25 of the '249 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) ("CTPG").¹² In the Notice, Petitioner ranks this petition second and the petition in IPR2024-00416 first. Notice 1. In our separate

¹¹ Coleman, U.S. Patent Appl. Publ. No. 2002/0026351 A1, published Feb. 28, 2002 (Ex. 1139, "Coleman").

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

decision in IPR2024-00416, entered concurrently with this decision, we institute *inter partes* review of claims 1, 3–11, 13–21, and 23–25 of the ’249 patent on all grounds stated in that petition. IPR2024-00416, Paper 10.

Patent Owner argues that the we should exercise our discretion to deny institution in this proceeding because “Petitioner has not and cannot justify the three simultaneously filed parallel petitions directed towards the ’249 patent and challenging the same claims.” Prelim Resp. 5. For the following reasons, we agree with Patent Owner with respect to two of the proceedings, and we exercise our discretion to deny institution of IPR2024-00417 and IPR2024-00418.

In the Notice, Petitioner identifies what it asserts are three “material differences” between the petitions. Notice 1–5. Petitioner then asserts that “[i]n view of the material differences . . . , the Board should consider all three petitions.” *Id.* at 5. In addition, Petitioner asserts that “institut[ion] for Petition 2 [the present Petition] should not be too burdensome given that the Board has considered similar arguments against similar claims in instituted IPR2022-01436 involving a related patent.” *Id.*

In our analysis, we consider each of the three “material differences” identified by Petitioner in turn. We also consider Petitioner’s argument that we reviewed similar arguments against similar claims in IPR2022-01436. For the reasons discussed below, we determine Petitioner does not sufficiently support the need for institution of multiple proceedings. Accordingly, we exercise our discretion to deny institution of this proceeding and in IPR2024-00418.

The first material difference identified by Petitioner relates to the use of the prior art relied upon in the petitions in prior related proceedings. Notice, 1. Petitioner points out that one of the primary references in IPR2024-00416 was also used in IPR2022-01260, “an IPR filed against U.S. Patent No. 8,244,582 (“the ’582 patent”) which is the grandparent of the ’249 patent.” *Id.* Petitioner then asserts that the petition here relies on a “combination of references [that] was asserted against the ’582 patent in . . . IPR2022-01436, in which institution was granted.”¹³ *Id.* at 2. Finally, Petitioner describes its third petition, IPR2024-00418, as “combining brand new references” that “have never been considered by the Patent Office in any related IPR.” *Id.*

Petitioner does not explain, however, how the differences in whether the prior art was utilized in related proceedings supports instituting three petitions other than the fact that three petitions rely on different prior art that has been used in prior petitions to different effect. As Patent Owner points out, however, “[n]early all parallel petitions involve different proposed prior art” (Prelim. Resp. 7) and, in this case, the differences in whether that prior art was the subject of prior proceedings are not sufficient to justify filing two additional petitions.

The second material difference identified by Petitioner is that the prior art references relied upon have different priority dates and Patent Owner could attempt to antedate the references. Notice 2–3. Patent Owner,

¹³ Subsequent to the filing of this petition, the Board issued a Final Written Decision in that case finding all challenged claims unpatentable. IPR2022-01436, Paper 30.

however, responds to these arguments by “expressly stipulat[ing] that it will not ‘attempt to antedate or disqualify’ the prior art relied upon by Petitioner.” Prelim. Resp. 7. We, therefore, do not find Petitioner’s argument persuasive. *See* CTPG, 59–61, (recognizing that while a dispute about priority date may justify more than one petition, Patent Owner’s stipulation that it will not dispute whether references qualify as prior art may help explain why the Board should not exercise its discretion to institute.)

The final material difference identified by Petitioner is that the petitions adopt different approaches to the claim limitations. Notice, 3–5. Petitioner explains that its first ranked petition relies on a combination of references to teach the claimed “URL redirection” while its second ranked reference “does not use a secondary reference at all for the URL redirection.” *Id.* at 3–4. Petitioner asserts that the first ranked petition is “strong against an overly narrow reading (argued by Patent Owner for similar claims in the [a] prior . . . IPR) that precludes intervening human action between the URL redirection and step of receiving the partial profile” but “requires two references.” *Id.* As for Petitioner’s third ranked petition, Petitioner argues that it could “become . . . 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.” *Id.* at 4.

We are not persuaded that the different approaches taken as between Petitioner’s first and second-ranked petitions supports institution of multiple

proceedings.¹⁴ We give some weight to the argument that the first-ranked petition addresses an argument Patent Owner raised in a prior IPR proceeding. Less persuasive is Petitioner’s argument that the second-ranked petition relies on two references rather than one for the URL redirection. In this regard we note that: 1) we found that Petitioner established a reasonable likelihood of success in proving obviousness (including for the URL limitation) based on a two reference combination, 2) notwithstanding its reliance on a single reference for one of its grounds, the second-ranked petition is, like the first ranked petition, grounded in obviousness, and 3) although the second ranked petition includes one ground that relies on a single reference, it also includes three additional grounds challenging the exact same claim set based on three different combinations of prior art, making it difficult to determine how meaningful the difference in the number of references relied upon is.

Moreover, Petitioner does not make any effort to explain why grounds relying on these two different approaches—i.e., single-reference URL redirection and two reference URL redirection—could not have been presented in a single petition. This omission detracts from Petitioner’s argument that multiple petitions are merited. This is particularly true given that: 1) Petitioner’s first ranked petition includes 16 grounds relying, in part, on various combinations of two primary references that Petitioner describes as “similar, though not identical” (Notice, 4) with two secondary references,

¹⁴ We address differences in approach as between Petitioner’s first and third ranked Petitions in connection with our decision on Petitioner’s third ranked petition, IPR2024-00418.

both of which Petitioner identifies as teaching “features related to URL redirection” (*id.* at 2). Petitioner’s second-ranked petition includes 18 grounds with as many as six different prior art combinations challenging the same claim sets. Pet. 6. It may well be that it was not possible to present single-reference and two-reference URL redirection grounds in a single petition. But, in this case, and under these circumstances, we will not simply assume that to be the case; it is not self-evident that the single-reference and two-reference URL redirection grounds could not have been presented in a single petition. Accordingly, the different approaches taken in the first and second ranked petitions do not support institution of multiple proceedings.

In addition to the three material differences identified by Petitioner, we also consider that the Board found claims very similar to those challenged here unpatentable over the same prior art relied upon in Petitioner’s second-ranked petition. The fact that the Board and the parties are already familiar with the prior art in the second-ranked petition weighs in favor of institution. So too does the fact that Petitioner prevailed on similar arguments in a related petition, although this success is somewhat counterbalanced by Petitioner’s decision to rank the petition including those similar arguments second. However, in this case, where we have already instituted review on 16 grounds and where Petitioner does not otherwise provide persuasive argument that multiple petitions were necessary, we are not persuaded that Petitioner’s prior success and familiarity with the prior art justifies institution of review on another 18 grounds.

We recognize that not instituting the second-ranked petition could potentially lead to disparate results for related patents. Nevertheless, the

record in each proceeding is different and, as the Supreme Court has explained, “the petitioner is master of its complaint.” *SAS Institute Inc. v. Iancu*, 138 S.Ct. 1348, 1355 (2018). Here, Petitioner chose to rank the 16 grounds presented in IPR2024-00416 ahead of the 18 grounds presented in this petition, and we will not second guess that decision. Nor will we use that decision as a basis to institute review of a second proceeding where Petitioner has not otherwise convinced us that there was a need for multiple petitions.

In sum, 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 reasons discussed above, we are not persuaded that the facts presented by Petitioner justify a second petition challenging the same claims of the ’249 patent as the petition in IPR2024-00416. 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* of claims 1, 3–11, 13–21, and 23–25 is not instituted on the grounds asserted in this Petition.

IPR2024-00417
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