

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUOTIENT TECHNOLOGY, LLC,
Petitioner,

v.

INTELLIGENT CLEARING NETWORK INC.,
Patent Owner

Case IPR2024-01325
U.S. Patent No. 10,846,729

PATENT OWNER'S PRELIMINARY RESPONSE

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Exhibit No.	Description
2001	Joint Claim Construction Chart in <i>Inmar Brand Solutions, Inc. v. Quotient Technology Inc.</i> , Case No. 1:23-cv-00994 (D. Del.)

Pursuant to 37 C.F.R. § 42.107, Exclusive Licensee Inmar Brand Solutions, Inc. (“Inmar” or “Patent Owner”) files this preliminary response, setting forth reasons why the Petition for *inter partes* review (“IPR”) of claims 1-20 of U.S. Patent No. 10,846,729 (the “’729 Patent”), as requested by Quotient Technology, LLC (“Quotient” or “Petitioner”), should be denied.¹

I. INTRODUCTION

The ’729 Patent “relate[s] to a coupon processing system and method that allows for automatic processing of coupons and provides linkage between a coupon card and coupon information stored in a centralized database. The coupon processing may entail validation (and invalidation) and, when validated, redemption of the appropriate coupon(s) or other appropriate action.” ’729 Pat., 6:3-9. As disclosed in the ’729 Patent, first coupon or incentive information, including universal product code information of a product to be purchased at the retail business, may be received at a server from a retail business. After this first coupon or incentive information is received, the server may validate the first coupon or incentive related information by performing a comparison based at least in part on the received universal product code information. The server may transmit coupon or incentive codes triggered by validation, and may receive

¹ By submitting this Preliminary Response, no waiver of any argument is intended by Patent Owner. Patent Owner will have a right to file a complete response to the Petition, should the Board institute *inter partes* review. 37 C.F.R. § 42.120(a).

redeemed coupon related information that indicates successful coupon redemption. This redeemed coupon related information can include an application identifier, which defines the type of bar code symbology being used.

Petitioner asserts that the Aggrawal reference discloses the step of validating the first coupon or incentive related information at a server by performing a comparison based at least in part on the universal product code information of an item to be purchased, but this is wrong. Aggrawal discloses a *verification* step that includes expressly recited sub-steps, none of which include a comparison involving any universal product code information.

Further, Petitioner relies upon the secondary Deaton reference to disclose a claimed “application identifier” that is received at a coupon server from the retail server as part of “redeemed coupon related information indicating successful redemption of a coupon.” Deaton does not expressly disclose an “application identifier,” but Petitioner and its declarant, Dr. Mowry, attempt to read the claimed “application identifier” into a universal product code (UPC) disclosed in Deaton. But Ex. 1033, which Dr. Mowry relies upon for this assertion, expressly describes an “application identifier” as an identifier that is separate from a UPC, and not part of a UPC. This disclosure contradicts Dr. Mowry’s unsupported and unreliable opinion about whether an “application identifier” is part of a UPC. The record

evidence confirms that Dr. Mowry is wrong. Deaton's UPC fails to disclose the claimed "application identifier."

Finally, Petitioner's obviousness theories each fail. The Petition's obviousness challenges rely upon the testimony presented in Dr. Mowry's declaration to explain coupon processing practices. But Dr. Mowry is offered as "an expert in the field of computer science." Mowry, ¶17. Dr. Mowry does not claim to possess any experience in coupon processing business or technology, and yet he offers many opinions on coupon-processing subject matter, which are relied on upon by Petitioner to provide evidentiary support for understanding the asserted references and also to justify the proposed modifications in Petitioner's obviousness-based grounds. Thus, his opinions on the coupon industry, which are central to Petitioner's theories, are not based upon his experience or education, and these opinions should be given no weight.

Relatedly, Petitioner also builds its obviousness case on what "could" have been done in Aggrawal rather than what was allegedly obvious. *See, e.g.,* Pet., 30. This hindsight-based analysis of Aggrawal does not establish what a person of ordinary skill *would* have done, and fails to support Petitioner's obviousness theories.

For at least these reasons, Petitioner's challenges based on Aggrawal and Deaton fail. Further, these failures are fatal to the remaining challenges against the '729 patent's dependent claims.

II. THE '729 PATENT

The '729 patent describes a “system for validating, redeeming, and financially settling coupons.” '729 Pat., Abst. Figure 1 depicts an example of an “Intelligent Clearing Network” (ICN) system as disclosed:

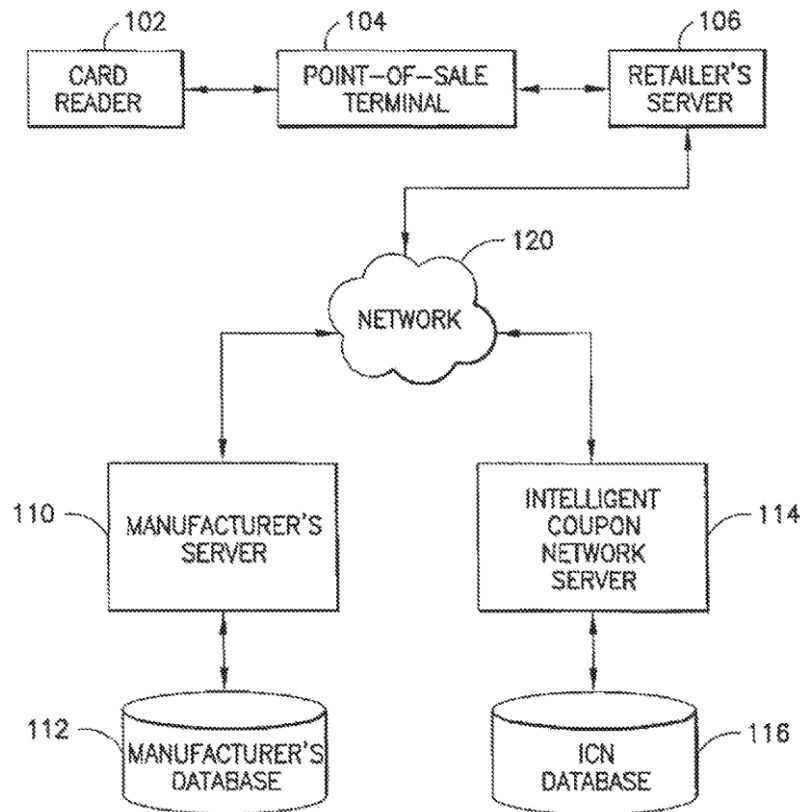
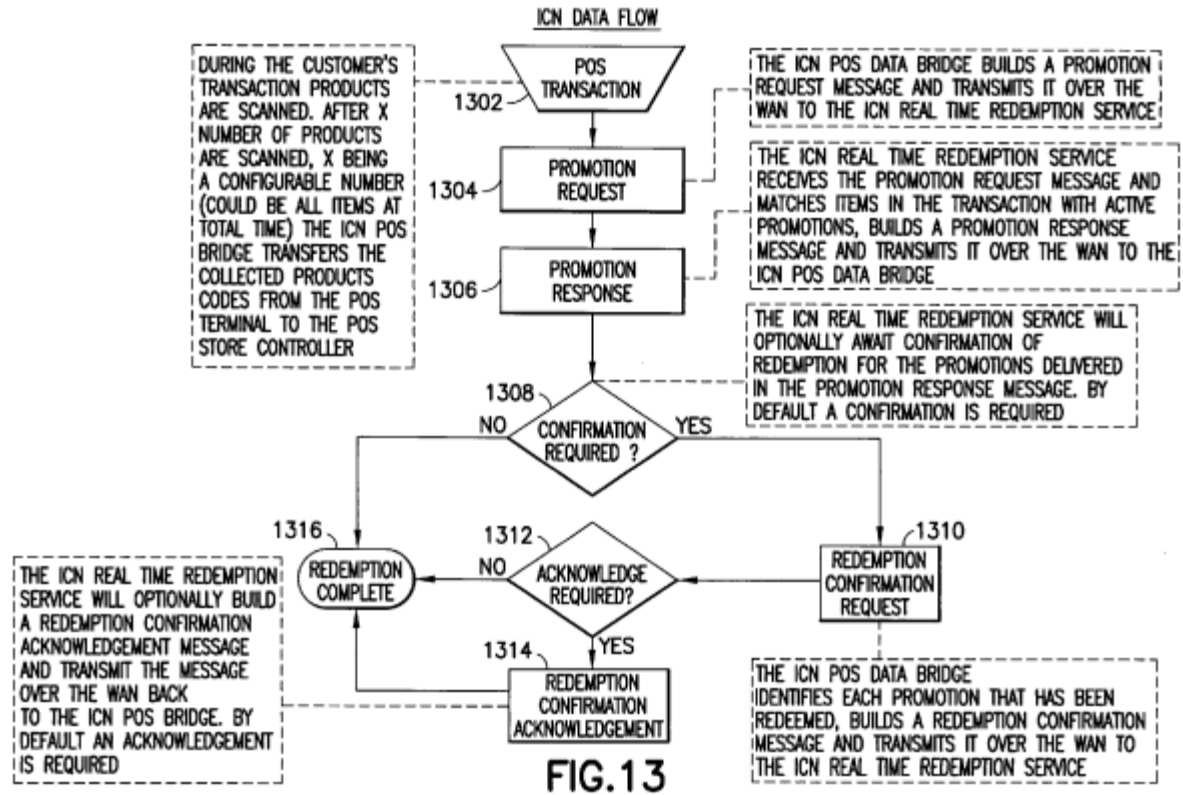


FIG.1

As described for the embodiment of FIG. 1, the ICN system can electronically validate and redeem coupons through “a centralized database, such as ICN database

116, which is coupled to the ICN server 114.”’729 Pat., 6:41-46. The disclosed ICN system embodiment includes a card reader 102, which can read a customer’s coupon card to obtain a unique account identifier, and then send that unique account identifier via the point-of-sale terminal 104 to the retail store server 106 and to the ICN server 114. ’729 Pat., 6:60-7:8. In this embodiment, the ICN server 114 can notify the manufacturer of a completed transaction by sending information to manufacturer’s server 110. ’729 Pat., 7:22-25.

Other embodiments for validating and redeeming coupons are disclosed in the ’729 Patent, such as those described in association with Figures 13, 26, and 27 of the ’729 Patent. For example, FIG. 13 (reproduced below) illustrates an exemplary embodiment of a data flow that provides discounts based on the scanning of products during a customer’s transaction. ’729 Patent, 24:28-65.



In this exemplary process, in step 1302, when a point-of-sale transaction is complete and the total key has been pressed at checkout (or after X number of items have been scanned), the retail-side software may collect information about the items in the customer's transaction to build a promotion request message and transmit it over a network to an ICN real time promotion redemption service, in step 1304. '729 Pat., 24:28-40.

In response, in step 1306, the ICN real time promotion redemption service may receive the promotion request and may match items in the transaction with prospective promotions defined in the ICN database, may build a promotion response message, and transmit it over the network to the retail business. '729

Pat., 24:40-48. In step 1310, the point-of-sale software may then identify each promotion that has been redeemed, may build a redemption confirmation request message, and may transmit the redemption confirmation request message over the network to the redemption service. '729 Pat., 24:53-57.

Consistent with the '729 Patent's disclosure, independent claim 1 recites:

1. A method comprising:
receiving, at an ICN server from a retail server, first coupon or incentive information including universal product code information of an item to be purchased at a retail business, the first coupon or incentive related information having been input to a terminal in the retail business and transmitted from the terminal to the retail server, the ICN server being at a location that is remote from the retail business;
validating, at the ICN server, the first coupon or incentive related information by performing a comparison of the first coupon or incentive related information based at least in part on the universal product code information;
in response to validating the first coupon or incentive related information, transmitting from the ICN server to the retail server, coupon or incentive codes triggered by the validation of the first coupon or incentive related information;
receiving, at the ICN server from the retail server, redeemed coupon related information indicating successful redemption of a coupon, wherein the redeemed coupon related information comprises identification information from a

product purchased, customer identification information, ***an application identifier***, and retailer identification information;

in response to receiving the redeemed coupon related information, determining whether the redemption of the coupon was valid based on the redeemed coupon related information; and

storing, by the ICN server, the redeemed coupon related information in a redeemed coupon database, where the redeemed coupon database comprises a plurality of redeemed coupon related information received from a plurality of retailer servers.

'729 Pat., 52:34-67 (claim 1) (emphasis added).

Similarly, independent claim 10 recites:

10. An ICN server comprising a processor; and a memory including computer program code, the memory and the computer program code configured to, with the processor, cause the ICN server to perform at least the following:

to receive, at an ICN server, first coupon or incentive information including universal product code information of an item to be purchased at a retail business, the first coupon or incentive related information having been input to a terminal in the retail business, the ICN server being at a location that is remote from the retail business;

to validate, at the ICN server, the first coupon or incentive related information by performing a comparison of the

first coupon or incentive related information based at least in part on the universal product code information;

to transmit from the ICN server, in response to validation of the first coupon or incentive related information, coupon or incentive codes triggered by the validation of the first coupon or incentive related information, the coupon or incentive codes triggered being useable by the terminal to redeem the first coupon or incentive information;

to receive, at the ICN server from a retail server located in a retail business located at a first location, redeemed coupon related information indicating successful redemption of a coupon, wherein the redeemed coupon related information comprises identification information from a product purchased, customer identification information, an *application identifier*, and retailer identification information and where the ICN server is at a second location that is remote from the first location; in response to receiving the redeemed coupon related information, to determine whether the redemption of the coupon was valid based on the redeemed coupon related information; and

to store, by the ICN server, the redeemed coupon related information in a redeemed coupon database, where the redeemed coupon database comprises a plurality of redeemed coupon related information received from a plurality of retailer servers.

'729 Patent, 53:41-54:14 (claim 10) (emphasis added).

The third independent claim, claim 16, recites:

16. A computer readable medium tangibly encoded with a computer program executable by a processor to perform actions comprising:

receiving, at an ICN server, first coupon or incentive information including universal product code information of an item to be purchased at a retail business, the first coupon or incentive related information having been input to a terminal in the retail business, the ICN server being at a location that is remote from the retail business;

validating, at the ICN server, the first coupon or incentive related information by performing a comparison of the first coupon or incentive related information based at least in part on the universal product code information;

in response to validating the first coupon or incentive related information, transmitting from the ICN server, coupon or incentive codes triggered by the validation of the first coupon or incentive related information, the coupon or incentive codes triggered being useable by the terminal to redeem the first coupon or incentive information;

receiving, at the ICN server from a retail server in a retail business located at a first location, redeemed coupon related information indicating successful redemption of a coupon, wherein the redeemed coupon related information comprises identification information from a product purchased, customer identification information, an ***application***

identifier, and retailer identification information and where the ICN server is at a second location that is remote from the first location;

in response to receiving the redeemed coupon related information, determining whether the redemption of the coupon was valid based on the redeemed coupon related information; and

storing, by the ICN server, the redeemed coupon related information in a redeemed coupon database, where the redeemed coupon database comprises a plurality of redeemed coupon related information received from a plurality of retailer servers.

'729 Patent, 54:47-55:19 (claim 16) (emphasis added). As indicated above, each independent claim recites the features of “performing a comparison of the first coupon or incentive related information based at least in part on the universal product code information” and also redeemed coupon related information including an “application identifier.” The Petition fails to establish that these features are disclosed or suggested by the asserted art, and therefore the Petition must fail as to each challenge and independent claim.

III. THE BOARD NEED NOT REACH ANY CLAIM CONSTRUCTION ISSUES TO DENY THE PETITION

The Petitioner identifies no terms as requiring constructions. Pet. 4 (“Petitioner submits that no construction of any claims term is necessary for the Board to resolve”). In contrast, in the District Court, Petitioner has advanced

numerous limiting constructions that are inconsistent with Petitioner's invalidity theories. As noted in Section IV.B below, Petitioner relies upon Aggrawal to generally disclose the claimed "validating" step in the challenged claims.

However, in District Court, Petitioner contends that "validating" requires determining "whether the purchase requirements of the [coupon/incentive/etc.] have been met." *See* Ex. 2001, Joint Claim Construction Chart, at 3-5. Nowhere in the Petition does Petitioner satisfy its narrow definition of "validating."

Petitioner does not attempt to show that any claim is allegedly unpatentable under Petitioner's proposed claim constructions.

Without waiving its right to submit constructions in a Patent Owner Response, and consistent with the position Patent Owner has taken in the District Court, Patent Owner submits that the Board need not engage in any pre-institution claim construction because the Petition fails to establish invalidity of any challenged claim under the plain and ordinary meaning of each term. For the substantive reasons presented in Section IV below, Petitioner's grounds include fundamental flaws and fail to establish the disclosure of every claimed element in each independent claim. These findings do not require the Board to conduct any construction of the above-identified terms.

IV. PETITIONER’S CHALLENGES FAIL ON THE MERITS

Petitioner asserts four grounds in its Petition, but only one of those grounds, Ground 1, applies to the independent claims (claims 1, 10, and 16). Ground 1 contends the independent claims, and certain dependent claims², are obvious over Aggrawal³ in view of Deaton⁴. For completeness, Grounds 2-4 are not used to shore up the deficiencies the challenges against the independent claims in Ground 1 and, instead, are asserted against certain dependent claims as follows: Ground 2 contends that dependent claims 2-4, 12, 13, 17, and 18 are obvious in view of Deaton and Aggrawal and further in view of Granger⁵; Ground 3 contends that dependent claims 7, 8, and 11 are obvious in view of Deaton and Aggrawal and further in view of Fajkowski⁶; and Ground 4 contends that dependent claims 9, 15, and 20 are obvious in view of Deaton and Aggrawal and further in view of Jones⁷.

Petitioner’s challenges uniformly fail. Initially, Petitioner’s proposed standard of ordinary skill in the art focuses purely on technical qualifications and experience and fails to support Petitioner’s challenges. Petitioner repeatedly relies on factual assertions about how the coupon-processing industry and technology

² Dependent claims 5, 6, 14, and 19.

³ Ex. 1004, U.S. Patent No. 7,013,286 (“Aggrawal”).

⁴ Ex. 1005, U.S. Patent No. 6,993,498 (“Deaton”).

⁵ Ex. 1006, EP 0757820 (“Granger”).

⁶ Ex. 1007, U.S. Patent No. 6,932,270 (“Fajkowski”).

⁷ Ex. 1008, U.S. Patent No. 5,832,458 (“Jones”).

operate without explaining how the hypothetical person of ordinary skill would possess this knowledge. Similarly, Petitioner's expert, Dr. Mowry, provides no basis upon which he understands the coupon-processing industry and technology. Nothing about Petitioner's proposed POSITA standard or Dr. Mowry's experience supports his espoused opinions on such topics as coupon-processing practices, the functionality of point-of-sale terminals in retail stores, or the networking considerations in retail-to-coupon server messaging. Given his lack of qualifications in the fields that Petitioner needs to try to make its obviousness case, Dr. Mowry's opinions on coupon processing art should be disregarded as unreliable.

In addition to Petitioner's flaw in presenting a witness who fails to have experience or training in coupon processing, Ground 1 fails to establish that any independent claim is unpatentable as challenged. The verification process in Petitioner's primary reference, Aggrawal, is relied upon to disclose "performing a comparison of the first coupon or incentive related information based at least in part on the universal product code information" as claimed, but Aggrawal does not perform this claimed step. There is no disclosure or suggestion in Aggrawal to perform "a comparison of the first coupon or incentive related information based at least in part on the universal product code information" as claimed. Similarly, Deaton fails to disclose those claimed features. Further, Deaton also fails to

disclose the claimed “application identifier” as recited in each independent claim, and Petitioner presents no alternative reference to remedy the shortcomings of these references.

Ground 1 is facially deficient in establishing the unpatentability of any challenged independent claim. As introduced above, Grounds 2-4 are not used to shore up the deficiencies of the challenges against the independent claims in Ground 1. Instead, Grounds 2-4 are asserted against certain dependent claims. Thus, Ground 1’s failure to establish unpatentability of any challenged claim is fatal to the Petition.

For the reasons discussed below, the Petition should be denied without institution.

A. Petitioner’s Proposed POSITA Standard and Dr. Mowry’s Qualifications Fail To Support the Petition’s Challenges, Which Rely on Specialized Insight Into the Art of Coupon Processing Technology or Practices

The Petition reaches incorrect conclusions regarding obviousness of the challenged claims in part because Petitioner’s factual allegations regarding the coupon processing art, upon which the Petition depends, are founded upon testimony from a person who has no experience in the coupon processing art.

Petitioner’s proposed standard for a “Person of Ordinary Skill in the Art” (hereinafter, “POSITA”) focuses purely on technical qualifications and experience. Petitioner defines the POSITA here as someone with knowledge of “distributed

applications that involve client machines communicating with remote server machines over a network to perform queries and update transactions on data stored in database management systems.” Pet., 13 (citing Mowry, ¶23). Petitioner asserts that a POSITA would have the following qualifications:

1. First, a POSITA “would have had an undergraduate degree in electrical engineering, computer science, computer engineering, or similar technical field.” Pet., 13.
2. Second, a POSITA would have had “one to two years of experience in the analysis, design, development, and implementation of distributed applications that involve client machines communicating with remote server machines over a network to perform queries and update transactions on data stored in database management systems.” Pet., 13.
3. Relatedly, Petitioner notes that “additional education” could substitute “for less experience and vice versa.” Pet., 13.

Notably for the purpose of this proceeding, nothing about this proposed standard informs how the alleged POSITA would have any understanding about coupon-processing business or technology. While a POSITA meeting this proposed standard could have the requisite education and experience to implement network technology solutions, a POSITA would not have the knowledge that the Petition itself claims is necessary to render the claims obvious, including whether

such implementations made sense within the field of coupon processing art or would be desired or feasible within the context of this art. But such knowledge is critical to and a central part of the obviousness grounds in the Petition.

The Petition repeatedly contends that a POSITA would require a deep and specific understanding of various aspects of the business and technology of validating, redeeming, and clearing coupons to reach the proposed obviousness determinations. For example, in its section addressing the proposed motivations for combining Aggrawal and Deaton, Petitioner argues that “a POSITA seeking to implement a coupon redemption and validation as taught by Aggrawal would have looked to available couponing systems to determine what ‘optional additional information’ could *advantageously be sent to the clearing house and how that information could be used.*” Pet., 18-19 (citing Mowry, ¶¶101-02) (emphasis added). Left unexplained is why a computer scientist or electrical engineer with experience in networking or database systems would have formulated any opinion about what information could have been sent to a clearing house “advantageously,” or how a clearing house would have used that information.

The Petition repeatedly touts Dr. Mowry as someone with insight into how a POSITA would understand coupon processing business practices and technologies in the coupon processing industry, when he has no such knowledge. On its face, the Petition’s asserted basis for modifying Paul expressly depends upon numerous

statements attributed to a POSITA having extensive knowledge coupon processing business practices and technologies, despite proffering no witness with this knowledge. These statements include, for example:

- “As combined, Aggrawal/Deaton would have provided a coupon redemption and validation system that would have allowed a central server to receive information about the point-of-sale *that would allow the central server to determine whether the point-of-sale properly redeemed a coupon.*” Pet., 19 (citing Mowry, ¶104).
- “A POSITA would have been motivated to implement this configuration in Aggrawal because *Aggrawal both describes how information can be sent from the point-of-sale to a central server and describes the benefit of including additional information.*” Pet., 19 (citing Mowry, ¶105).
- “A POSITA would have also understood that including Deaton’s functionality in Aggrawal *would have enhanced Aggrawal.*” Pet., 19 (citing Mowry, ¶107).
- “For example, sending more information *would have allowed the central server to generate more detail reports regarding coupon redemption activity.*” Pet., 20 (citing Mowry, Ex-1003, ¶108).

- “A POSITA would have understood that *more data would be more valuable to manufacturers.*” Pet., 20 (citing Mowry, ¶108).
- “For example, a POSITA would have been *aware that many coupons go unredeemed and a manufacturer would find more information about coupons that are redeemed valuable in determining how to deploy future coupons.*” Pet., 20 (citing Mowry, ¶108).
- “A POSITA would have also known that using a central server to confirm that a coupon was properly redeemed at the point-of-sale *would help combat erroneous redemptions at the point-of-sale.*” Pet., 20 (citing Mowry, ¶109).
- “For example, a POSITA would have been aware that *coupon fraud was a concern, including where a point-of-sale improperly redeems a coupon.*” Pet., 20 (citing Mowry, ¶109).
- “[I]ncluding Deaton’s functionality in Aggrawal would have used *known methods (sending additional information and then using that information to verify proper redemption) to improve Aggrawal’s coupon redemption and validation system.*” Pet., 20 (citing Mowry, ¶110).

But Petitioner fails to establish how a person having only the education and training identified in its proposed POSITA definition would have understood these

intricacies of the coupon-processing business and technology, which are critical to the obviousness Grounds presented in the Petition.

More importantly, Petitioner's declarant, Dr. Mowry, does not have the required experience and knowledge the Petition contends a POSITA must have. Dr. Mowry identifies no education or qualifications to render his opinions on coupon processing. Dr. Mowry candidly states, "I have over 30 years of experience in the field of computer science, including distributed computing, networked computer systems, database management systems, and transaction processing. In light of the foregoing, *I consider myself to be an expert in the field of computer science.*" Mowry, ¶17 (emphasis added). What he fails to address is how this education and experience informs his opinions regarding the retail/coupon industry. Dr. Mowry states that he has "relied on [his] professional experience, knowledge, and skill in computer science, as well as [his] experience in distributed computing, networked computer systems, database management systems, and transaction processing in reaching the opinions expressed in [his] Declaration." Mowry, ¶20. Although the Petition establishes that knowledge regarding the coupon processing art is essential to each of the Grounds, Dr. Mowry's qualifications statement, and his Declaration in general, fail to state the basis for Dr. Mowry's understandings and opinions regarding how the coupon-processing industry and technology work.

Each instance that Dr. Mowry issues an “opinion” about the coupon-processing industry should be disregarded by the Board as unsupported and lacking foundation under 37 C.F.R. § 42.65(a). *See Avail Medsystems, Inc. v. Teladoc Health, Inc.*, IPR2022-00444, Paper 10 at 24-27 (PTAB July 21, 2022) (denying institution after giving “no weight” to testimony from the perspective of a skilled artisan where the expert’s qualifications fell short). Such opinions “amount[] to nothing more than advocacy from the witness stand.” *See Sundance, Inc. v. DeMonte Fabricating Ltd.*, 550 F.3d 1356, 1364-65 (Fed. Cir. 2008); *see also Kyocera Senco Indus. Tools Inc. v. ITC*, 22 F.4th 1369, 1375-79 (Fed. Cir. 2022) (finding abuse of discretion when ALJ relied on testimony from an expert with “advanced degrees in engineering and extensive experience in the design and manufacture of fastener driving tools” but who did not have experience in “power nailer design”). Because Dr. Mowry’s opinions are critical to the Petition’s challenges, the Petition should be denied institution on this basis alone.

B. Petitioner and Dr. Mowry Improperly Attempt to Reinvent Aggrawal’s Verification Process, and Fail to Resolve Aggrawal’s Missing Disclosures

Element [1b] of claim 1 recites, “validating, at the ICN server, the first coupon or incentive related information *by performing a comparison of the first coupon or incentive related information based at least in part on the universal product code information.*” (emphasis added). Thus, by this step, the step of

“validating” at the ICN server includes “performing a comparison of the first coupon or incentive related information based at least in part on the universal product code information.” Petitioner relies on Aggrawal to disclose this step, alleging that “Aggrawal discloses that the coupon mint, verification center, verification equipment, or clearing house ... can verify the coupon ... using the universal product code information of the product the customer wants to purchase.” Pet., 26. This is wrong. Aggrawal does not disclose this claimed step. As discussed below, Petition improperly reinvents Aggrawal’s verification process using expert testimony and possibilities—rather than obviousness—to fill in missing disclosures.

Petitioner cites to Aggrawal’s Abstract, which discloses that a “verification center verifies that the coupon is authentic and has not already been used before.” Aggrawal, Abst.; Pet., 27. Petitioner also cites a long list of pin citations in Aggrawal Pet., 27 (citing Aggrawal, Figs. 2, 3, and 5, 5:32-42, 8:26-52, 8:53-9:18, 9:53-57, 10:20-21, 10:62-12:2, 12:55-67, 13:1-10, 13:46-57, 13:64-14:5, 14:11-19). Petitioner does not explain these citations except to characterize 10:62-12:2 as “describing different types of coupons and when the criteria for determining whether the coupon is valid.” Pet., 27. Although Petitioner originally alleges that Aggrawal “discloses” element [1b] (Pet., 26), Petitioner does not point to any of these individual citations for this alleged disclosure.

Instead, Petitioner’s theory on element [1b] is that “to offer a discount based on products being purchased, the verification center would *need* to verify that the product the coupon is intended for is being purchased.” Pet., 29 (emphasis added). However, Petitioner fails to support this inherency-based theory in the context of Aggrawal’s verification process. There is no evidence in the Petition to support the heightened burden of establishing inherency, which *necessarily must exist* to be satisfied. Then, rather than looking to any patent or printed publication for this missing disclosure, Petitioner alleges that a “POSITA would have understood that universal product code information is routinely captured at the point-of-sale, and would have understood that universal product code *could* be transmitted to the verification center, such that before providing a discount to the customer, the verification center would verify that the pertinent product(s) covered by the coupon.” Pet., 29 (citing Mowry, ¶133) (emphasis added). Similar to the deficiencies in Dr. Mowry’s testimony identified in Section IV.A above, neither Petitioner nor Dr. Mowry explains the basis for Dr. Mowry’s conclusion on this critical point. Dr. Mowry does not explain how he knows (or how a POSITA would know) that universal product code information is routinely captured at the point-of-sale.

Further, it is noteworthy that Petitioner never proposes that Aggrawal would have been modified to transmit the universal product code for the purpose of

performing a comparison as part of Aggrawal’s verification step. Rather, Petitioner states that a POSITA “would have understood that universal product code *could* be transmitted to the verification center.” Pet., 29. This is error under the law. Properly considered, “[t]he obviousness inquiry does not merely ask whether a skilled artisan could combine the references, but instead asks whether ‘they would have been motivated to do so.’” *InTouch Techs., Inc. v. VGO Commc’ns, Inc.*, 751 F.3d 1327, 1352 (Fed. Cir. 2014). “Fundamental differences between the references are central to this motivation to combine inquiry.” *Adidas AG v. Nike Inc.*, 963 F.3d 1355, 1359 (Fed. Cir. 2020).

Petitioner’s assertions fail to span the differences between Aggrawal and the challenged claim, and impermissibly deviate from the disclosure of Aggrawal. Petitioner’s reliance upon expert testimony and hypothetical processes to fill in what is plainly missing from any asserted patent or printed publication is improper, especially where this reliance fails to explain why a person of ordinary skill would have made the contemplated changes.

Failing to find element [1b] expressly disclosed in Aggrawal, Petition next looks to Aggrawal’s ambiguous teachings. According to Petitioner, Aggrawal discloses that “additional information related to the transaction” may be sent “to the verification center to aid in the verification process.” Pet., 29-30 (quoting Aggrawal, 8:33-37). Petitioner specifically points to the “transaction identifier,

invoice number, or a proof of purchase etc. to the verification center” as part of this “additional information.” Pet., 29-30 (quoting Aggrawal, 8:33-37). But Aggrawal specifically discloses how the verification center uses any “additional information,” and this use does not include or disclose any step of “performing a comparison of the first coupon or incentive related information based at least in part on the universal product code information.” Aggrawal, 8:53-9:18. Petitioner tacitly concedes this point by once again relying on possibilities rather than obviousness. Petitioner alleges that a “POSITA would have understood that universal product information is one of the pieces of additional information that *could* be sent to the verification center, and that the verification center *could* verify the coupon by making sure the relevant universal product code was being purchased.” Pet., 30 (emphasis added).⁸ Once again, Petitioner cites only to Dr. Mowry’s declaration to support these hypothetical assertions about what is possible. *Id.* And Dr. Mowry merely parrots the Petition without disclosing any reasoning or support for these assertions. *See* Mowry, ¶¶134-35. Dr. Mowry’s statements should be disregarded under 37 C.F.R. § 42.65(a), and Petitioner’s assertions relying on these statements should be rejected as violating 35 U.S.C. § 311(b).

⁸ These assertions directed to what “could” be done, rather than what must necessarily be done, do not rise to the level of an inherency-based argument.

Aggrawal's failure to disclose or suggest element [1b] is fatal to Petitioner's challenge. However, this is not the only error in the Petition.

C. Deaton Fails to Disclose or Suggest the Application Identifier Recited in Element [1d]

Element [1d] of claim 1 recites, “receiving, at the ICN server from the retail server, redeemed coupon related information indicating successful redemption of a coupon, wherein the redeemed coupon related information comprises identification information from a product purchased, customer identification information, an application identifier, and retailer identification information.” Thus, by this step, the ICN server receives, *inter alia*, “an application identifier” from the retail server as part of “redeemed coupon related information indicating successful redemption of a coupon.”

In an attempt to satisfy the claimed “application identifier,” Petitioner alleges that “Deaton provide [*sic*] several examples of information that can be transmitted from a point-of-sale to a clearing house, including ... UPC (*application identifier*).” Pet., 32 (emphasis in original). Petitioner asserts in a footnote that a “POSITA would have understood that an application identifier is a standard portion of the GS1 bar code that is used both in UPC codes for coupons and purchased products.” Pet., 32 n.5. The citation for Petitioner's assertion is not any patent or printed publication, but once again the Mowry declaration. *Id.*

(citing Mowry, ¶144). Dr. Mowry fails to disclose how his training and experience would lead him to this knowledge, however.

Instead, in paragraph 144 of his Declaration, Dr. Mowry relies on Lubow, Ex. 1032.⁹ Dr. Mowry first states that in his “opinion, a POSITA would have understood that an application identifier is a standard portion of the GS1 bar code that is used both in UPC codes for coupons and purchased products.” Mowry, ¶144. He cites to Lubow paragraphs [0003] and [0004] to support this opinion. However, these paragraphs of Lubow are not on-point. Lubow’s [0003] describes the numbers of a UPC *coupon code* for processing a coupon, and does not even address a UPC code for products. Lubow’s [0004] describes the UCC/EAN-128 Coupon Extended Code. Neither of these paragraphs discloses or even touches on a format of a GS1 bar code for purchased *products*. Further, while pages 60-65 of Ex. 1033 are cited by Dr. Mowry to “explain[] the application identifier in a bar code,” Dr. Mowry does not discuss those paragraphs in any detail, or explain how those paragraphs support his initial opinion in his paragraph 144. This is a critical oversight because ***Dr. Mowry’s own cited evidence contradicts his assertion.***

Ex. 1033, which he relies upon briefly (but does not explain), expressly discloses that the “application identifier” is not part a UPC, but rather “defines the type of bar code, or symbology, being used,” that is, it defines whether a bar code

⁹ Ex. 1032, U.S. Patent Publication No. 2004/0117250 (“Lubow”).

being transmitted is “UPC, Interleaved 2 of 5 (ITF), UCC-128” or another type of bar code. Ex. 1033, 64. Per Ex. 1033:

The data structure contained within bar code symbologies can include five identifier elements:

- an application identifier
- an indicator digit
- a company prefix
- an item number
- a check digit

The *application identifier* defines the type of bar code, or symbology, being used. Symbologies include UPC, Interleaved 2 of 5 (ITF), UCC-128, and many others. An application identifier is used with some but not all symbologies. For example, application identifiers aren’t used with EAN, ITF, or UPC symbologies. Application identifiers define the type of number that follows the identifier. The application identifier 00, for example, signifies a shipping container serial number; the identifier 402 indicates a bill of lading.

Ex. 1033, 64. Ex. 1033 also expressly states that “application identifiers aren’t used with EAN, ITF, or UPC symbologies,” and that “[a]pplication identifiers define the type of number that follows the identifier.” *Id.*

According to these disclosures, Dr. Mowry and Petitioner are wrong to contend that a “POSITA would have understood that an application identifier is a standard portion of the GS1 bar code that is used both in UPC codes for coupons and purchased products.” Pet., 32 n.5. Petitioner is similarly incorrect to treat “application identifier” as synonymous with product UPC. *See* Pet., 32. These statements are clearly inconsistent with Petitioner’s own evidence, and cannot support Petitioner’s conclusions for element [1d]. The only record evidence

supporting Petitioner's "application identifier" analysis in this element [1d] is Dr. Mowry's unsupported testimony, which is directly contradicted by Ex. 1033. Once again, Dr. Mowry's opinion in paragraph 144 should be disregarded under 37 C.F.R. § 42.65(a), and Petitioner's assertions relying on this paragraph should be rejected as violating 35 U.S.C. § 311(b).

Neither Deaton nor Aggrawal discloses or suggests the claimed "application identifier" of claim 1, 10, or 16. For this reason as well, the Petition fails to establish the invalidity of any challenged claim.

D. Petitioner's Challenges Uniformly Fail and Should be Denied Without Institution

For each of these reasons, the Petition fails with regard to Ground 1 and independent claims 1, 10, and 16. Ground 2 contends that dependent claims 2-4, 12, 13, 17, and 18 are obvious in view of Deaton and Aggrawal and further in view of Granger; Ground 3 contends that dependent claims 7, 8, and 11 are obvious in view of Deaton and Aggrawal and further in view of Fajkowski; and Ground 4 contends that dependent claims 9, 15, and 20 are obvious in view of Deaton and Aggrawal and further in view of Jones. Thus, Grounds 2-4 are dependent on the success of Ground 1's challenges to the independent claims. Because Ground 1 fails for the reasons presented above, that failure is also fatal to Grounds 2-4.

V. CONCLUSION

For the reasons presented above, the Petition should be denied, and no *inter partes* review should be instituted.

Dated: December 18, 2024

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CERTIFICATE OF WORD COUNT

The undersigned certifies that the foregoing PATENT OWNER'S PRELIMINARY RESPONSE complies with the type-volume limitation in 37 C.F.R. § 42.24(b)(1). According to the word-processing system's word count, the brief contains 5,863 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

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CERTIFICATE OF SERVICE

Petitioner has consented to e-mail service in this proceeding. Pursuant to 37 C.F.R. §42.6, the undersigned certifies that on this date, a copy of the foregoing document was served by email upon the following counsel at the below email addresses:

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