UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HIGHLEVEL, INC.,

Petitioner

v.

CLICKFUNNELS,

Patent Owner

Case IPR2025-00234

U.S. Patent No. 10,846,357

PRELIMINARY REPLY IN SUPPORT OF PETITIONER'S PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 10,846,357

TABLE OF CONTENTS

I. INTRODUCTION 1

II. EXERCISING §325(D) DISCRETION WOULD PREVENT HEARING THESE INVALIDITY ISSUES FOR THE FIRST TIME.....1

A. The New References Were Not Previously Considered. 1

B. The New References Are Not Cumulative of the Prosecution-Applied References. 2

C. The Examiner Erred. 4

III. CONCLUSION.....5

PETITIONER'S EXHIBIT LIST

Exhibit No.	DESCRIPTION
1001	U.S. Patent 10,846,357 ("'357 patent")
1002	Declaration of Dr. Kevin Almeroth
1003	Curriculum Vitae of Dr. Kevin Almeroth
1004	File History of U.S. Patent No. 10,846,357
1005	U.S. Patent No. 9,147,004 ("Coursol")
1006	U.S. Patent Application Publication No. 2007/0061412 ("Karidi")
1007	U.S. Patent Application Publication No. 2014/0282049 ("Lyon")
1008	U.S. Patent Application Publication No. 2011/0288924 ("Thomas")
1009	U.S. Patent No. 7,610,219 ("Sayed")
1010	U.S. Patent No. 6,026,433 ("D'Arlach")
1011	U.S. Patent No. 8,321,457 ("Tan")
1012	Screenshot of Kajabi from the Internet Archive, available at https://web.archive.org/web/20100510202538/http://www.kajabi.com:80/
1013	Screenshot of Kajabi from the Internet Archive, available at https://web.archive.org/web/20101018200138/http://get.kajabi.com/sales_pages/138
1014	U.S. Patent Application Publication No. 2019/0028531 ("Nagar")
1015	U.S. Application 62/536,403
1016	U.S. Application 62/536,403 Appendix A
1017	U.S. Application 62/536,403 Appendix C
1018	U.S. Patent Application Publication No. 2007/0299985 ("Craig")

Exhibit No.	DESCRIPTION
1019	U.S. Patent No. 6,029,141 ("Bezos")
1020	Claim Mapping Table
1021	Plaintiff's Infringement Contention Chart (Ex. B)
1022	Plaintiff's Infringement Contention Chart (Ex. D)
1023	U.S. Patent No. 5,715,314 ("Payne")
1024	Chris J. Pilgrim, *Website Navigation of Tools – A Decade of Design Trends 2002 to 2011*, 13 AUIC Proc. 26, 3 (2012)
1025	Jatinder Manhas, *Comparative Study of Website Sitemap Feature as Design Issue in Various Websites*, 4 Int'l J. Eng'g & Mfg. 22 (2014)
1026	Ron Kohavi et al., *Controlled Experiments on the Web: Survey and Practical Guide*, 18 Data Mining & Knowledge Discovery 140 (2009)
1027	*Google Optimize Product Overview*, Google, extension://efaidnbmnnnibpcajpcglclefindmkaj/https://services.google.com/fh/files/misc/optimize_product_overview.pdf
1028	Rotimi Iziduh & Jon Mesh, *This Is Not a Test: Google Optimize Now Free – For Everyone*, Google Blog (Mar. 30, 2017), https://blog.google/products/marketingplatform/analytics/this-is-not-a-test-google-optimize-now-free-for-everyone/
1029	U.S. Patent No. 9,141,976 ("Urban")
1030	U.S. Application 62/536,403 Concepts Appendix
1031	Screenshots of "Google Optimize Tutorial: How to Get Started Quickly," available at https://youtu.be/IzTLxFOETgc?si=44HBVYF7PUgzADaj
1032	U.S. Patent Application Publication No. 2013/0198679 to Nurse et al. ("Nurse")

Exhibit No.	DESCRIPTION
1033	Email from the Board authorizing Petitioner's Preliminary Reply (Mar. 21, 2025)

I. INTRODUCTION

ClickFunnels's ("PO") Preliminary Response ("POPR") does not argue the Petition's merits. Instead, it requests that the Board discretionarily deny institution under 35 U.S.C. §325(d).[1] PO's request should be denied because none of the references relied upon in the Petition were previously presented to the Office. Nor are the Petition's references ("the new references") substantially similar or cumulative of art previously considered during prosecution ("the prosecution-applied references"). In fact, the new references specifically provide disclosures that the applicant argued were missing from the prosecution-applied references, and that the Examiner identified as reasons for allowance.

II. EXERCISING §325(D) DISCRETION WOULD PREVENT HEARING THESE INVALIDITY ISSUES FOR THE FIRST TIME

A. The New References Were Not Previously Considered.

None of the five new references were previously before the Office in any way. Pet., 1, 7. A reference that "'was neither applied against the claims nor discussed by the Examiner' does not weigh in favor of exercising discretion under § 325(d)." *Cisco Sys., Inc. v. Netsocket, Inc.*, IPR2023-00607, Paper 11 at 21-22 (PTAB Sept. 26, 2023); *see also K/S HIMPP v. Bragi GmbH*, IPR2023-01205, Paper 8 at 20 (PTAB Mar. 19, 2024) ("Because neither of those references was before the office,

[1] The Board authorized this paper on March 21, 2025. Ex-1033.

Patent Owner has not satisfied the first prong of the *Advanced Bionics* test."). The vast weight of PTAB cases make clear that the Board will not discretionarily deny institution where, as here, a petition presents entirely new references. This should end the analysis.

B. The New References Are Not Cumulative of the Prosecution-Applied References.

PO's arguments also fail at the first prong of *Advanced Bionics*. New prior art references are not "substantially the same" as prosecution-applied references when there are materials differences between them. *See Wolfspeed, Inc. v. Trs. of Purdue Univ.*, IPR2022-00761, Paper 13 at 7-8 (Vidal Mar. 30, 2023). As may be expected, there are superficial similarities between all the references because they are directed to analogous technology, such as improving "traditional websites." POPR, 1-3, 28, 33-34. But this superficial analysis ignores disclosures in the new references that PO argued were missing from the prosecution-applied references. These material differences should end the inquiry. *See Nokia of Am. Corp. v. Soto*, IPR2023-00680, Paper 18 at 7-8 (Vidal Mar. 28, 2024); Paper 30 at 6 (Vidal Dec. 3, 2024) ("Each [new] reference includes disclosures that are not present in [a prosecution-applied reference], i.e., disclosures addressing the alleged deficiencies in [a prosecution-applied reference] that the applicants presented during patent prosecution.").

For example, new reference Coursol includes disclosures that PO argued were missing from prosecution-applied Shaposhnikov. During prosecution, PO argued

that Shaposhnikov did not teach a "series of directional webpages configured to cause a particular user interaction" or webpage tabs representing a series of directional webpages because Shaposhnikov's tabs are not webpage tabs of a "launched generic website." Ex-1004, 461-464. But, as noted in the Petition, Coursol initializes a "website containing default set of web pages" (Pet., 28-29, 34) that can be edited using webpage tabs. Pet., 42-44. These webpage tabs represent actual webpages of a launched website, which corresponds to what PO argued was missing from Shaposhnikov.

New references Karidi and Sayed also include disclosures that PO argued were missing from prosecution-applied Olliphant. PO argued that Olliphant did not teach that "the series of directional webpages … comprises a unique plurality of sequential webpages configured to be provided sequentially one after another." Ex-1004, 464. But, as noted in the Petition, Karidi teaches a typical interaction on a generated website (such as retail.com) of webpages being sequentially presented, to go from browsing products to viewing a product, adding to cart, continue shopping, and completing a purchase. Pet., 30-34, 35-36 (citing Ex-1006 ¶¶43, 45-47, Figs. 3C-3H). Sayed also expressly teaches webpages presented in a sequential order by having a "parent-child relationship" and linking to each other sequentially: "Page A links only to page B, and page B links only to page C." Pet., 68-69 (citing Ex-1009, 10:44-49, 10:50-56). Again, the new references specifically teach what PO argued

was missing in the prior art during prosecution.

PO next asserts that Karidi's and Sayed's series of directional webpages are cumulative of Grosz. POPR, 28-33, 45-56. But Grosz was not even applied during prosecution; it was merely listed on an Information Disclosure Statement (IDS). POPR, 7-8, 28; Ex-1004, 509. The Board has consistently found that a reference listed on an IDS, without more, has not been meaningfully considered.[2] *See Advanced Energy Indus. Inc. v. Reno Techs. Inc.*, IPR2021-01397, Paper 7 at 6-9 (PTAB Feb. 16, 2022); *K/S HIMPP,* Paper 8 at 20. Moreover, PO relies on disparate teachings of Grosz to cobble together a vague suggestion that Grosz could possibly suggest a series of linked webpages for a user to make a purchase. POPR, 29-30. But, as explained in the Petition, Karidi explicitly discloses how its webpages are linked together. Pet., 30-34, 35-36 (citing Ex-1006 ¶¶43, 45-47, Figs. 3C-3H). Sayed also expressly teaches that webpages are presented in a sequential order. Pet., 68-69 (citing Ex-1009, 10:44-49, 10:50-56). Karidi and Sayed thus include material differences from Grosz, a reference that went undiscussed during prosecution, to teach elements 1[e]/12[e]/16[e] and 1[f]/12[f]/16[f].

C. The Examiner Erred.

After failing the first *Advanced Bionics* prong (which should end the analysis),

[2] Under the April 19, 2024 Notice of Proposed Rulemaking, §325(d) is not applied to references not "meaningfully considered," such as merely being listed on an IDS, without more. 89 Fed. Reg. 28693, 28700 (Apr. 19, 2024).

PO's arguments also fail the second. The Examiner erred in overlooking the existence of references that contradict the provided rationale for allowance. In allowing the claims, the Examiner identified "a series of directional webpages configured to cause an end user interaction with a website, wherein the series of directional webpages … comprises a unique plurality of sequential webpages … provided sequentially one after another," providing a "plurality of website templates for selection," and "receiving a selection of a website template" as reasons for allowance. Ex-1004, 481; Pet., 7. The new references teach exactly these features. Pet., 28-40, 66-69. It was thus material error for the Examiner to not have identified new references, such as Coursol, Karidi, Lyon, Thomas, and Sayed, which plainly teach these simple claim elements.

III. CONCLUSION

The Board should not exercise its discretion under § 325(d) to deny institution because the Petition presents brand-new references that were never previously considered by the Office. Moreover, the new references each contain disclosures that the PO specifically argued were missing from the prosecution-applied references, so they are not "cumulative" of those references. This IPR should be instituted, and these new invalidity issues should be addressed for the first time on the merits.

Date: March 28, 2025

Respectfully submitted,

/s/ William M. Fink
William M. Fink (Reg. No. 72,332)
Counsel for Petitioner

CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

I hereby certify that on March 28, 2025, I caused a true and correct copy of the foregoing PRELIMINARY REPLY IN SUPPORT OF PETITIONER'S PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 10,846,357 to be served electronically on counsel for Patent Owner at the following addresses:

Jeffri A. Kaminski
JAKaminski@Venable.com
VENABLE LLP
600 Massachusetts Ave., NW
Washington, DC 20001
Tel: (202) 344-4048
Fax: (202) 344-8300

Justin J. Oliver
JJOliver@Venable.com
VENABLE LLP
600 Massachusetts Ave., NW
Washington, DC 20001
Tel: 202-721-5423
Fax: 202-344-8300

Dated: March 28, 2025

Respectfully submitted,

/s/ William M. Fink

William M. Fink (Reg. No. 72,332)
O'Melveny & Myers LLP
1625 Eye Street, NW
Washington, DC 20006
Telephone: (202) 383-5300
Fax: (202) 383-5414
E-Mail: tfink@omm.com
Attorney for Petitioner