

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HIGHLEVEL, INC.,

Petitioner

v.

ETISON LLC D/B/A CLICKFUNNELS,

Patent Owner

IPR2025-00235

Patent No. 11,361,047

**PATENT OWNER'S PRELIMINARY RESPONSE
UNDER 37 C.F.R. § 42.107**

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Prosecution History Excerpts of U.S. Patent Application No. 15/880,226 (“’357 file history”)
2002	Prosecution History Excerpts of U.S. Patent Application No. 17/247,041 (“’047 file history”)
2003	U.S. Patent Pub. No. 2017/0147364 (“Shaposhnikov”)
2004	U.S. Patent Pub. No. 2008/0263135 (“Olliphant”)
2005	U.S. Patent Pub. No. 2012/0151329 (“Cordasco”)
2006	U.S. Patent No. 8,799,829 (“Grosz”)

I. INTRODUCTION

The Board should exercise its discretion and deny institution of *inter partes* review because the Petition only presents substantially the same art and arguments previously considered by the Examiner during prosecution of U.S. Patent No. 11,361,047 (“the ’047 Patent”). 35 U.S.C. § 325(d).

For each Ground, the Petition relies on references describing traditional websites including series of webpages linked together. The Examiner determined that such traditional websites do not render the challenged claims obvious. In particular, the Petition relies on a reference describing website generation and creation as its primary reference, just like the Examiner did during prosecution. The secondary references in the Petition are relied on for allegedly disclosing a series of webpages allowing user interaction, such as a website that includes webpages for shopping, i.e., add-to-cart, continue shopping, and checkout. The Examiner applied and considered secondary references describing the same thing. Thus, the Examiner considered substantially the same prior art during prosecution, and found that the prior art did not teach or render obvious the claimed invention. Yet Petitioner HighLevel LLC (“Petitioner”) asserts substantially the same art and applies it for the same purposes without explaining what is different from the references considered

by the Examiner. And any differences between the asserted art in the Petition and that considered during prosecution are not material to the challenged claims.

Moreover, Petitioner does not allege or provide evidence of what (if any) error was committed by the Examiner during prosecution. The claim element(s) cited by the Examiner for allowance of the claims are not present in the asserted art in the Petition.

The Petition relies on the same primary reference (Coursol) for all of the Grounds. But the relied-upon description in Coursol (EX1005) mirrors Shaposhnikov (EX2003) which was applied and overcome during prosecution. Both describe a website creation system using templates to allow a user to create and edit a website including a series of webpages. A traditional website including webpages that may be linked as relied on in Coursol, is substantially the same as the description in Shaposhnikov which the Examiner applied and determined did not disclose or render obvious the challenged claims.

The secondary references relied on in the Petition (Karidi (EX1006) and Sayed (EX1009)) fare no better. Petitioner relies on these references as allegedly describing a series of webpages allowing a user to interact with a website, for example by viewing, selecting, and purchasing a product. Again, these references add nothing beyond those references already considered by the Examiner. For

example, the Examiner considered Grosz (EX2006) during prosecution, which likewise describes a series of webpages allowing a user to view, select, and purchase a product. And further, Olliphant (EX2004), which was applied and overcome during prosecution, also describes substantially the same thing—a series of webpages presented to a user in a sequence, for example during a sign-up process. The Petition relies on asserted art for the same purpose that the Examiner relied on substantially the same description during examination.

There is no material difference between the portions of the asserted art relied on in the Petition and the art considered during examination of the '047 Patent and its parent, U.S. Patent No. 10,846,357 (“the '357 Patent”). Substantially the same references were overcome during prosecution, and the Examiner allowed the claims. The Examiner determined that traditional websites having a series of webpages, presented in sequence, do not disclose or render obvious at least the “wherein the series of directional webpages of each website type of the plurality of websites types comprises a unique plurality of sequential webpages configured to be provided sequentially one after another” as recited in the challenged claims. Yet Petitioner now asks the Board to revisit substantially the same art, and substantially the same arguments. There is no reason to revisit the Examiner’s determination.

Lastly, the Petition does not present sufficient rationale for any of its combinations of references. The Petition proposes to combine the same elements from each reference with each other, essentially combining the same element with itself—without explanation. “The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit.” MPEP § 2143 (citing *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 415–21 (2007)).

Accordingly, Patent Owner Etison LLC d/b/a ClickFunnels (“ClickFunnels” or “Patent Owner”) respectfully requests that the Board exercise its discretion and deny institution of *inter partes* review.

II. OVERVIEW OF THE ’047 PATENT

A. Background

The ’047 Patent “relates generally to a website creation system having at least one series of directional webpages and related methods.” EX1001, 1:16-18. The website creation system and methods recited in the ’047 Patent enable a user to create, within a single system, a website that includes “at least one series of directional webpages” ordered and designed to entice particular user interaction. EX1001, 3:28-31.

The specification discloses that “a series of directional webpages” may comprise a “series (e.g., a sequence or funnel) of webpages that are ordered and

designed to entice (e.g., elicit, encourage, prompt, evoke, cause, etc.) at least one particular user interaction with the website.” EX1001, 3:1-25, 4:46-62, 6:8-14, 7:17-44. A “series of directional webpages” includes “a plurality of sequential webpages provided sequentially one after another” across either a single, or multiple different, web browsing sessions. EX1001, 3:1-25, 7:17-55. The specification also provides numerous examples of “directional webpages,” along with accompanying details for each example. EX1001, 8:10-12:42, 12:57-15:58.

As the '047 Patent describes, the disclosed system and methods provide convenience for the user because everything is on one system and does not require “multiple developers and systems.” EX1001, 3:26-36. For example, the disclosed invention provides convenience to users that were largely left on their own to search for the types of products that were of interest to them. The specification also describes that the disclosed system and methods improve the processing and resources needed for website creation, as well as the functionality of the created websites. EX1001, 3:34-41 (“the website creation system reduces required processing power, memory, and communication resources needed to facilitate creating websites[, and] results in less data transfer and data bandwidth usage for a computer/communication system. ... Additionally, in view of the foregoing, the website creation system may result in more user friendly, consistent, attractive, and

persuasive websites). And the disclosed invention provides, over conventional systems, “a more appropriate system for mobile devices.” EX1001, 3:41-44.

The specification thus explains that the claimed features not only enhance the process of website creation, but those features also produce technical improvements for computers on which the claimed system and method are each used—making them more dynamic and efficient. EX1001, 3:34-44.

B. The Claimed Subject Matter

The '047 Patent contains twenty claims. Independent Claims 1 (a method), 14 (a system), and 18 (computer-readable medium, instructions, processor) are directed to particular ways of creating customized websites from templates that include of a series of directional webpages, provided sequentially one after another in the completed website.

In the claimed system, method, and medium, a user may select a “website type” from a “plurality of website types” wherein each website type “comprises a series of directional webpages,” each of which “comprises a unique plurality of sequential webpages,” and then, based upon the user’s selection, automatically “generating and launching a website.” EX1001, Claims 1, 14, 18. Based on the user’s selections, the user is allowed to edit the website. *Id.*, Claims 2, 20. To assist a user’s website creation, the system provides a “website editor graphical user

interface.” *Id.*, Claims 2-4. Through the website editor GUI, a user may select a “website type” from a “plurality of website types.” *Id.*, Claims 1, 14, 18, 2-4, 20. The system generates and launches a website based on a user’s selections, creating a “customized website.” *Id.*, Claims 1, 2, 20.

A user may also, via the website editor GUI, utilize an “automation tab” to create “triggers,” where at least one event results from one or more triggers. EX1001, Claim 16. These “triggers” and the resulting “event” (or “response action”) employ sets of specific, ordered rules that enable automation of tasks involving the creation of websites and the websites themselves. *Id.*, 4:63-5:9, 20:40-43, 21:67-27:10.

III. PROSECUTION HISTORY

A. Application No. 15/880,226 – The ’357 File History

U.S. Patent No. 11,361,047 (“the ’047 Patent”) was filed as a continuation of U.S. Patent Application No. 15/880,226, which issued as U.S. Patent No. 10,846,357 (“the ’357 Patent”) and was filed on January 25, 2018. EX1001, 1. Both applications were examined by the same Examiner. During prosecution, the ’357 Patent’s application was subject to non-final and final office actions, as well as a Request for Continued Examination, before receiving a Notice of Allowance. Over twenty references were made of record and expressly considered by the Examiner—who expressly stated that the references were considered: “ALL REFERENCES

CONSIDERED EXCEPT WHERE LINED THROUGH. /R.J.C/.” *See, e.g.,* EX2001, 251-54, 473-75. The references considered include U.S. Patent Pub. No. 2017/0147364 (Shaposhnikov, EX2003), U.S. Patent Pub. No. 2008/0263135 (Olliphant, EX2004), and U.S. Patent Pub. No. 2012/0151329 (Cordasco, EX2005) which were applied in rejections, as well as references the Examiner considered, but did not apply in a rejection (*e.g.,* U.S. Patent No. 8,799,829 (Grosz, EX2006)).

In a Non-Final Office Action, the Examiner rejected the original claims under 35 U.S.C. § 102 based on Shaposhnikov, and under § 103 based on (1) Shaposhnikov-Cordasco, and (2) Shaposhnikov-Olliphant. EX2001, 449-469. The anticipation rejection was made against all three independent claims (1, 12, 16) and dependent Claims 2, 17 (reciting “within each webpage tab of the website editor graphical interface a control window for adding media objects”).

In applying Shaposhnikov to the independent claims, the Examiner explained that Figs. 4 and 9, and ¶92 of Shaposhnikov, disclose a user dashboard that is displayed to allow a user to create, edit, and manage a channel—which the Examiner compared to the ’357 Patent’s claimed “website.” EX2001, 451 (citing EX2003). A user of Shaposhnikov’s system selects to begin “a channel creation process (i.e. website creation),” and the system displays “an interface for selection of channel name, channel image, channel category, channel template, and channel color

scheme.” EX2001, 451 (citing EX2003, ¶¶94, ¶98; Figs. 4, 10). The Non-Final Office Action states that, in Shaposhnikov, a user may also select a “channel category (i.e. type)” to provide website templates to the user, which the user can also select along with appearance settings like the color scheme. EX2001, 451-52. The rejection highlights that Shaposhnikov provides a “user editing interface for further edits to the channel, including tabs and content (i.e. menu items)” with which a user can make “edits to the channel and menu items (i.e. directional webpages).” EX2001, 452 (citing EX2003, ¶¶107-09; Figs. 4, 11-12). Shaposhnikov’s user may then publish the “the channel (i.e. website).” EX2001, 452.

The remaining dependent claims were rejected by the Examiner as being unpatentable over combinations Shaposhnikov-Cordasco and Shaposhnikov-Olliphant. EX2001, 337-349. The obviousness rejection based on Cordasco was applied to dependent Claims 3-5 and 18 (reciting split testing), 11 (reciting directional webpages causing guest purchases), and 15 (page view statistics tab). EX2001, 456-59.

Dependent Claims 6-10, 13-14, and 19-20 were rejected over the combination of Shaposhnikov-Olliphant. Rejected Claim 6 recited

“wherein the series of directional webpages of the selected website type of the plurality of websites types comprises a plurality of sequential webpages configured to be provided sequentially one after another during a single web browsing session.”

EX2001, 462, 668. The Examiner stated that Olliphant discloses “sequential pages (i.e. one after another) [which] are displayed during a sign-up process,” citing ¶56-67; Figs. 4, 8A-S. EX2001, 462-63 (citing EX2004). These portions of Olliphant describe and illustrate a process “for setting up link categories and user preferences” where a user selects an email invitation/offer and is “directed to an initial set-up webpage” to enter information that the system uses to then direct the user to a website with links corresponding to the invitation/offer. EX2004, ¶56-67.

Addressing the combination, the Examiner stated that it would have been obvious for a POSITA to incorporate “the sequential webpages of Olliphant [in Shaposhnikov’s website builder] to allow the system to create a plurality of pages in succession to be displayed during a certain event.” EX2001, 462-63 (citing EX2004, ¶56-67; Figs. 4, 8A-S). According to the Examiner, a POSITA “would have been motivated to modify and include the sequential webpages to allow the user to generate a set of pages to be presented to a user during an event to lead the user to a certain purpose, creating an efficient and user friendly interface.” EX2001, 463.

After the Non-Final Office Action, the Applicant submitted remarks, requesting reconsideration without submitting amendments to the claims. EX2001, 439.

The Examiner then issued a Final Office Action, maintaining the rejections from the Non-Final action. EX2001, 328-51, 449-69. The Examiner again rejected the independent claims, and dependent claims 2, 17, as anticipated by Shaposhnikov—and the remaining dependent claims based on the obviousness combinations described above. *Id.*

In response to the Final Office Action, the Applicant amended the claims to recite

“the series of directional webpages of each website type of the plurality of website types comprises a unique plurality of sequential webpages configured to be provided sequentially one after another”

adding language from Claims 6 and 7 and that the sequential webpages are unique in the independent claims. EX2001, 302-08. The amendments also specified that it is an “end user[’s] interaction with a website” that is caused. EX2001, 302-08. The Examiner and Applicant then discussed the amendments in a phone interview, and the Examiner stated that the “additional language would overcome the current rejection and art but further search and consideration would be required.” EX2001, 283-84.

The Applicant filed a Request for Continued Examination after the interview with the Examiner. EX2001, 259-66. Based on the inclusion of the subject matter from Claims 6 and 7, and the additional language, a Notice of Allowance issued.

EX2001, 216-25. The “Reasons for Allowance,” state that the prior art of record (including “specifically Shaposhnikov”) did not teach or render obvious the amended claims. EX2001, 216-25. And further, the Examiner stated that it would not have been “within the level” of a POSITA¹ at the time of invention to “modify or integrate” the prior art to incorporate the features recited in the amended claims. EX2001, 223-24.

B. Application No. 17/247,041 – The ’047 File History

As discussed above, U.S. Patent Application No. 17/247,041, which issued as U.S. Patent No. 11,361,047, is a continuation of the application that led to the ’357 Patent and was filed on November 24, 2020. During prosecution, a Non-Final Office Action rejected the claims based on double-patenting. EX2002, 100-06. The Non-Final Office Action also indicated that the claims were allowable over the prior art of record, “including specifically Shaposhnikov,” which did not teach or render obvious the invention claimed, either alone or in combination with other references. EX2002, 100-06. The Examiner stated that neither Shaposhnikov nor the rest of the prior art of record taught:

¹ For institution purposes, Patent Owner does not dispute Petitioner’s proposed definition of a person of ordinary skill in the art (“POSITA”), but reserves the right to challenge such definition should the IPR be instituted.

“wherein each website type of the plurality of website types comprises a series of directional webpages configured to cause an end user interaction with a website, and wherein the series of directional webpages of each website type of the plurality of website types comprises a unique plurality of sequential webpages configured to be provided sequentially one after another”

EX2002, 103-05. And further, that it would not

“have been within the level of one of ordinary skill in the art at the time of the invention to modify or integrate the electronic device of the prior art to incorporate the features of wherein each website type of the plurality of website types comprises a series of directional webpages configured to cause an end user interaction with a website, and wherein the series of directional webpages of each website type of the plurality of website types comprises a unique plurality of sequential webpages configured to be provided sequentially one after another, in combination with the other elements recited.” *Id.*

And like prosecution of the '357 Patent, the prosecution history of the '047 Patent's application expressly states that the references made of record were considered. EX2002, 111-115. The Applicant filed a terminal disclaimer to overcome the double-patenting rejection, and the Examiner issued a Notice of Allowance. EX2002, 83, 87-88. The Examiner re-stated in the “Allowance” that the prior art of record did not disclose or render obvious the claimed invention, including the above-quoted claim language. EX2002, 44-48, 24-28.

IV. INSTITUTION OF THE PETITION SHOULD BE DENIED UNDER SECTION 325(d)

The Board should exercise its discretion to deny institution of *inter partes* review of the Challenged Claims of the '047 Patent under 35 U.S.C. § 325(d). The asserted art relied on by Petitioner is substantially the same as the art previously considered and distinguished during prosecution of the '047 Patent. The arguments presented by Petitioner add nothing new from what was already known and considered by the Examiner during prosecution.

The Board considers several factors when evaluating whether to exercise its discretion under Section 325(d), including (a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art; (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments. *Becton, Dickinson and Co. v. B. Braun Melsungen AG*, IPR2017-01586,

Paper 8, at 17–18 (Dec. 15, 2017) (precedential). “A reference is cumulative when it teaches no more than what a reasonable examiner would consider to be taught by the prior art already before the PTO.” *Regeneron Pharm., Inc. v. Merus N.V.*, 864 F.3d 1343, 1350 (Fed. Cir. 2017).

A. The Petition Presents Substantially the Same Prior Art or Arguments That Previously Were Presented to the Office

To determine whether to exercise its discretion and deny institution under Section 325(d) when “the same or substantially the same prior art or arguments previously were presented to the Office,” the Board has set forth a two-part framework that evaluates:

(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of [the] first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6, at 8 (Feb. 13, 2020) (precedential). “If a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute *inter partes* review.” *Id.*, 8-9.

The Examiner during prosecution of the '047 Patent considered prior art and combinations that are substantially the same as the asserted art in the Petition, and also considered substantially the same arguments as set forth in the Petition. Yet Petitioner neither alleges, nor provides evidence of, any Examiner error in considering prior art during prosecution.

1. *Becton, Dickinson* Factors (a) and (b) Support Denial Because the Petition Presents Art That is Substantially the Same As, and Cumulative of, the Prior Art Considered During Prosecution

This Section discusses *Becton, Dickinson* factors (a) and (b) together, for simplicity, due to the extent of overlapping facts. Both of these *Becton, Dickinson* factors weigh in favor of exercising the Board's discretion against institution because the asserted art in the Petition is substantially the same as that which was previously considered by the Office. Petitioner's asserted art is also cumulative of the prior art that the Examiner considered, and applied in some instances, during prosecution.

i) *Coursol* is Substantially the Same as, and Cumulative of, *Shaposhnikov*—Applied During Prosecution

Each of the Petition's four Grounds rely on U.S. Patent No. 9,147,004 to *Coursol* (EX1005) as the primary reference. Petition, 4. But *Coursol* is substantially the same as U.S. Patent Application Publication No. 2017/0147634 to *Shaposhnikov*

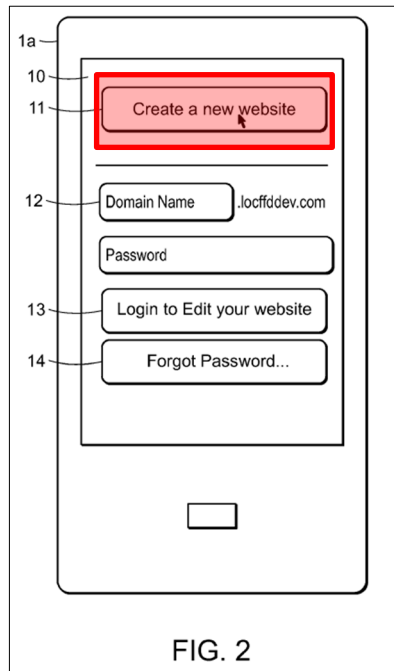
(EX2003), which was considered, applied, and overcome during prosecution. EX2002, 103-05; EX2001, 451-68, 330-49. The Petition relies on Coursol as describing a system for designing a website that allows a user to select website categories and templates to assist with building the website. Petition, 18-56 (Ground 1). But this does not present new disclosure for consideration, Shaposhnikov describes the same thing. Petitioner does not present any material difference between Coursol and Shaposhnikov.

Similar to Petitioner's relied-upon Coursol disclosure, the Examiner applied Shaposhnikov during prosecution as disclosing a website design and creation system. EX2002, 103-05; EX2001, 328-351, 449-69. Coursol "relates generally to **building websites**, and more particularly to systems, processes, and applications for **creation of websites from both traditional computing devices and mobile devices**." EX1005, 1:8-11 (emphasis added). Similarly, Shaposhnikov "relates generally to **website and mobile application** (hereinafter 'mobile app' or simply 'app') **creation systems and methods**." EX2003, ¶2 (emphasis added).

The Petition cites to Fig. 2 of Coursol, which illustrates a GUI with a button (control 11) to "Create a new website," highlighted in red below. Petition, 9-12, 24-26. Coursol's specification describes that "[c]ontrol 11 is configured to launch a

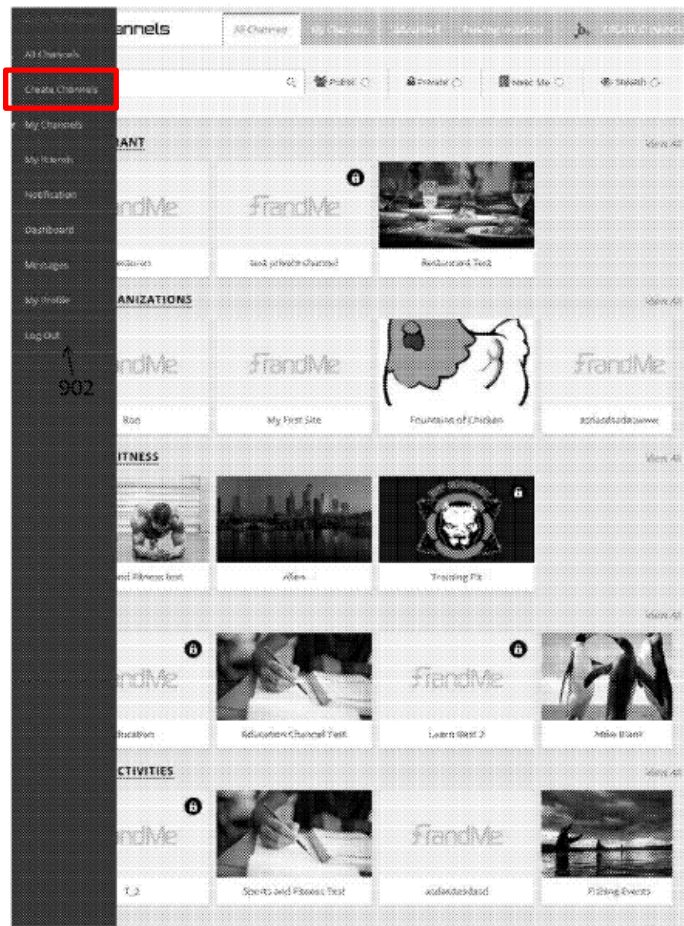
website design studio application for selecting and editing a website template.”

EX1005, 11:10-12.



Id., Fig. 2 (annotated).

Similarly, Shaposhnikov describes a GUI including a “create channels” button that allows a user to create a website, also highlighted in red in Fig. 9 below:



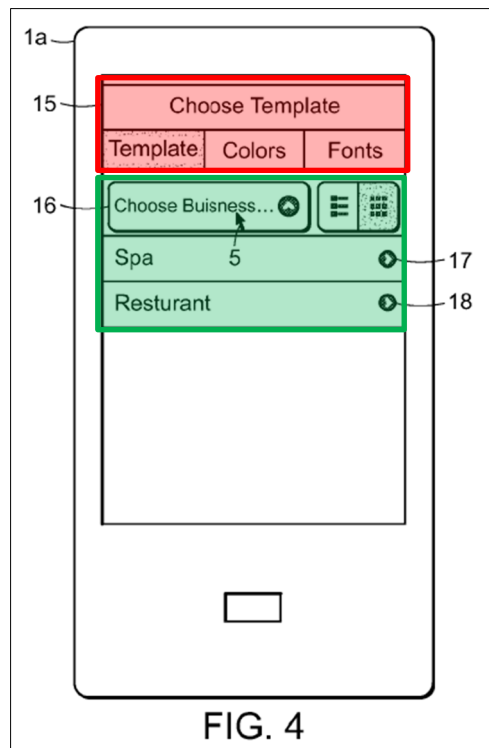
900
FIG. 9

EX2003, Fig. 9 (annotated).

As the Examiner stated during prosecution, Shaposhnikov's channels are, "i.e. websites." EX2002, 103-05; EX2001, 333; *see also supra* Sections III.A-B. Shaposhnikov describes that once a user selects to create a website, a "channel creation guide page 1000 may guide the channel-owner developer through a pre-determined linear process for simultaneously creating a website and corresponding mobile app. In other words, the channel creation guide page 1000 may, for example,

provide a pre-determined sequential process that the channel-owner developer is required to follow in order to simultaneously create the website and the corresponding mobile app.” EX2003, ¶92. Thus, Shaposhnikov discloses substantially the same thing as Coursol’s “Create a new website” relied on in the Petition.

Next, according to Petitioner, Coursol describes that once a user selects to create a website, the user can select a **category** and **template** for the website. Petition, 9-12, 36-39 (citing EX1005, 11:19-30) (emphasis added); *generally*, 33-40. These Coursol passages also recite that when “the user clicks on the website creation control 11, the design studio application 215 displays a graphical user interface screen 15, shown in FIG.3, including a control 16 allowing a user to select a template category.” EX1005, 11:20-23.



Id., Fig. 4 (annotated).

The Petition (at 36-38) also relies on Coursol’s description that the

“user may select a **category** control, for example control 17, to display a gallery of **template** design choices 18a, 18b, as illustrated in FIG. 5. The preview 22 is preferably an operational version of the website design of the selected template, containing a plurality of web pages and associated web page assets including sample text, and one or more images, a color scheme, a font Scheme, page layouts associated with the selected template. The preview 22 comprises a browser-renderable page which includes operational links to other browser-renderable pages of the previewed website template.”

EX1005, 11:28-43 (emphasis added).

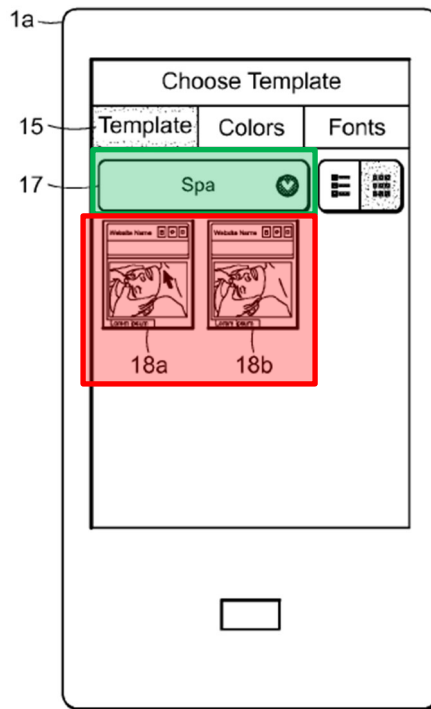


FIG. 5

Id., Fig. 5 (annotated).

Shaposhnikov describes the same thing. Shaposhnikov describes that once a user selects to create a website, the user may select a **category** and **template** as part of a process for creating the website. EX2003, ¶93 (“[T]he 5-step process may require the user to perform the following steps to create the channel: 1) select a channel name; 2) choose a **category** for the channel; 3) choose a **template** for the channel; 4) choose a color scheme for the channel; and 5) click a ‘create channel’ button.”) (emphasis added).

Shaposhnikov goes on to describe the selection of categories in more detail, paralleling the description of categories in Coursol. For example, Shaposhnikov describes that

“the channel creation guide page 1000 may display a list of channel categories from which the channel owner-developer may select. In the exemplary embodiment, the channel categories include restaurant, business organizations, health and fitness, education, sports and activities, and others. In other embodiments, there may be more or less categories, and/or different categories. A ‘category’ can be considered a specifically defined class or group that a subject matter of the website and mobile app to be created generally falls under. A user desiring to view websites/mobile apps with information about such subject matter may select the appropriate category and, responsive to such selection, the server 106 may cause websites/mobile apps falling under the category to be displayed to the user.”

EX2003, ¶94.

Shaposhnikov also provides details about its templates, again paralleling the templates described in Coursol. As Shaposhnikov describes,

“templates 700 may be considered pre-built GUI templates with a pre-determined layout, menus, pages, web/app elements, and the like. The pre-determined website-app templates 700 may each be associated with one or more html files specifying the elements of the website and the mobile app, such as, for example, style elements (overall layout, font, colors, default graphics, background, header images, etc.). The computer program files associated with each pre-determined website-app template 700 may also include other like languages, specifying elements, features, and functionality of the website and the mobile app, including, but not limited to, CSS code, JavaScript, PHP, XML, Java, Swift, etc. Software languages used to create websites and mobile apps are known and will therefore not be discussed in detail herein. In one embodiment, the pre-determined website-app templates 700 may

include one or more of the following elements/features: a home page, a blog page, a testimonials section, a contact us page, an events page, a products page, a services page, and the like. In additional embodiments, the pre-determined website-app templates 700 may include additional elements/features. The selected template 700 may be used to simultaneously create a website 704.”

EX2003, ¶96; *compare* EX1005, 11:28-43.

Fig. 10 of Shaposhnikov below is highlighted to show the **categories** (in green) and **templates** (in red):



1000
FIG. 10

EX2003, Fig. 10 (annotated). Thus, Shaposhnikov provides substantially the same disclosure as Coursol's disclosure of templates and categories which are relied on in the Petition.

Petitioner also asserts that in Coursol, "the user can make selections, edit content, and configure the website." Petition, 11. The Petition (*id.*) also relies on Coursol's description that when

"a template is selected and downloaded to the user device 210a, 210b, a state object 305 (such as a JS State Object) is initialized to represent the website containing the default set of web pages and default set of graphical and functional components and other default selections and sample content. A user is then guided through the website customization and **editing process by the design studio application 215** through a sequenced series of screens 320, 330, 340, 350, 360, 370, 380, 390." citing EX1005, 8:1-9 (emphasis added).

Shaposhnikov, just like Coursol, discloses a process and interface for a user to edit content and configure the website. As Shaposhnikov's specification describes,

"the channel owner-developer may select a selected template 700 from a plurality of pre-determined website-app templates 700 selectable by the channel-owner developer to create and open for **editing** an instance of **a website/app user application editing interface 1100**. Accordingly, the server 106 may receive the selection of the selected template 700 chosen by the channel owner-developer."

EX2003, ¶95 (emphasis added). So, Coursol and Shaposhnikov both provide corresponding descriptions of creating and editing a website via a template.

In more detail, Shaposhnikov provides a sequence of screens shown in Figs. 8-29, demonstrating a process through which the user edits and customizes the website. EX2003. Using the screens shown in the drawings, “the channel owner-developer may select an add/edit menu button 1108. Responsive to such selection, the user application editing interface 1100 may display **a menu editing feature 1200 that allows the user to add, edit, and/or delete menus and sub-menus**, as illustrated in FIG. 12.” EX2003, ¶109 (emphasis added). Thus, Shaposhnikov also describes a sequence of screens for editing and customization, which is substantially the same disclosure as that relied on from Coursol in the Petition. *See, e.g.*, Petition, 19 (“a POSITA would have understood that Coursol was providing for traditional websites that included a sequence....”).

The Petition further cites Coursol’s website editing disclosure, stating that it allows the user to add pictures to the website. Petition, 11-12. In the cited portions, Coursol describes that “FIG. 61 shows the Gallery editing control page 121, which shows the current list of website gallery photos 122a, 122b, 122c that will appear on the web site Gallery page. The user can add a Gallery photo using the add gallery item control 123, which operates similarly to the addition of images elsewhere in the design studio application 215 and is illustrated in FIGS. 62-65.” EX1005, 14:57-63.

Likewise, Shaposhnikov describes that the user can add and delete pictures on the website, along with text. EX2003, ¶118 (“the user application editing interface 1100 may be configured to allow the channel owner-developer to upload and delete photographs associated with the website 704 and the mobile app 706 (the channel) and to also add, edit, or delete text associated with the same.”). And thus, Coursol’s relied on disclosure does not provide anything new, and instead mirrors the disclosure in Shaposhnikov.

For the last element of the independent claims, the Petition points to Coursol’s preview of the customized website, asserting that the generated website includes the user’s selections and edits. Petition, 11-12 (citing EX1005, 6:67-7:2), 39-40. Petitioner highlights Coursol’s description of previewing website changes (EX1005, 10:12-21, 11:31-35), and then that Coursol’s “user may request that the website is published.” Petition, 39-40.

Shaposhnikov also describes viewing changes made and publishing the customized website, including a user’s selections and edits, for public viewing. EX2003, ¶122 (“the channel owner-developer may selectively publish the channel when ready. ...[And] responsive to such publication feature being turned on, both the website 704 and the mobile app 706 may become simultaneously publicly available for viewing.”), ¶128-30.

In sum, each of the Petition's Grounds rely on Coursol for substantially the same disclosure from Shaposhnikov that the Examiner applied during prosecution. In other words, Coursol provides nothing new. Accordingly, the Coursol disclosure relied on in the Petition is substantially the same as, and cumulative to, Shaposhnikov.

ii) Karidi is Substantially the Same as, and Cumulative of, Olliphant—Applied During Prosecution

Each of the Petition's four Grounds relies on U.S. Patent Application Publication No. 2007/0061412 to Karidi as a secondary reference. Petition, 4.

During prosecution of the '047 Patent's parent patent, the Examiner determined that Shaposhnikov did not disclose or render obvious the parent's original dependent Claims 6-8, later-incorporated into the independent claims as discussed above, and which recited:

“the series of directional webpages of each website type of the plurality of website types comprises a unique plurality of sequential webpages configured to be provided sequentially one after another”

EX2001, 302-08; *see supra* Section III.A. Instead, the Examiner relied on Olliphant for this claim element. Likewise, in applying Shaposhnikov to the '047 Patent's claims, the Examiner also determined that Shaposhnikov did not disclose or render

obvious the claimed invention. *See supra* Section III.B. Similar to the above language from its parent patent, the '047 Patent's independent claims recite:

“wherein each website type of the plurality of website types comprises a series of directional webpages configured to cause an end user interaction with a website, and wherein **the series of directional webpages of each website type of the plurality of website types comprises a unique plurality of sequential webpages configured to be provided sequentially one after another**”

EX1001, Claims 1, 14, 18. *See supra* Sections III.A-B.

Olliphant is cited on the face of the '047 Patent and was considered during prosecution; it was also applied during prosecution of the parent application. EX1001, 2; EX2002, 112; *see supra* Section III.A. As discussed above in the Prosecution History section, language from original '357 Patent Claims 6 and 7 was moved into its independent claims and the combination of Shaposhnikov and Olliphant was overcome, leading to allowance. *See supra* Section III.A. The '047 Patent application's as-filed claims included this language. Thus, the Examiner did not apply Shaposhnikov to this similar claim language recited in the '047 Patent's independent claims and reiterated that none of the prior art of record (including Olliphant) taught this claim language. *See supra* Section III.B; EX2002, 104-105. But the alleged teachings of Karidi that Petitioner relies on are substantially the same as those in Olliphant, which were considered during prosecution.

For that same subject matter from the '357 Patent's original Claims 6-7—and similarly present in the '047 Patent's independent claims—the Petition relies on Karidi's disclosure of allowing “a guest of the created website to interact with the website, such as to view an item (Figure 3C) and add the item to cart, view the cart (Figure 3D), continue shopping (Figures 3E-G), checkout and view the receipt (Figure 3H).” Petition, 32-35. This disclosure is substantially the same as the disclosure in Olliphant of a user interacting with a website via a series of webpages that was overcome during examination.

The Examiner applied Olliphant to the '357 Patent's original Claims 6-7, stating that Olliphant discloses “sequential pages (i.e. one after another) [which] are displayed during a sign-up process,” citing ¶56-67; Figs. 4, 8A-S. EX2001, 462-63 (citing EX2004); *see supra* Section III.A. Similar to Karidi, Figs. 8A-8S of Olliphant cited by the Examiner show a series of webpages. EX2004; *see supra* Section III.A. In Olliphant, webpages are presented in sequence to the user during a sign-up process. EX2004, ¶56-67; *see also* 10 (“With each user-initiated action, the displayed website is advanced to the next webpage in the series of websites that the user views each day.”). Figs. 4A-D provide a detailed flow chart of the sequential flow of the process and webpages. EX2004. And Step 450 describes generating webpages with a form to solicit username or login information for social

bookmarking services, webpages with which a user interacts, *e.g.*, by providing contact and other information (Step 452). EX2004, ¶72.

In addition, the series of webpages in Olliphant allow for other interactions by the user. For example, the user can provide links or invite others (Figs. 8B; 8P; 8Q) and allow a user interaction with the series of webpages (Figs. 8N and 8O), such as sharing webpages with others. EX2004, ¶63.

Thus, Karidi is relied on here for substantially the same disclosure as Olliphant—which was overcome during prosecution of the parent patent—and is cumulative of Olliphant. The Petition does not explain why Karidi’s teaching of a traditional website having linked pages for a user to make a purchase provides anything more than the sequence of webpages in Olliphant. Petitioner is simply asking the Board to second-guess the Examiner’s previous decision on substantially the same issues.

iii) Karidi is Substantially the Same as, and Cumulative of, Grosz

Each of the Petition’s four Grounds relies on U.S. Patent Application Publication No. 2007/0061412 to Karidi as a secondary reference. Petition, 4. But Karidi also has substantially the same disclosure as U.S. Patent No. 8,799,829 to Grosz (EX2006), cited on the face of the ’047 Patent, and which was considered during prosecution. *Advanced Bionics*, IPR2019-01469, Paper 6, at 7-8 (“Previously

presented art includes art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent.”); *Vital Connect, Inc. v. Bardy Diagnostics, Inc.*, IPR2023-00381, Paper 7, at 14 (Jul. 11, 2023) (“The examiner also certified that he considered all references listed in the IDS ‘except where lined through,’ and Oster is not lined through.”); *Helena*, IPR2024-00801, Paper 10, at 8 (“Section 325(d) does not distinguish between primary and secondary references....”); EX2002, 111.

As noted above, the Petition relies on Karidi’s disclosure that “webpages are presented in an order to allow the user to go from **browsing products, to viewing a product** (EX1006 ¶43, Figure 3C), **adding to cart** (*id.* ¶45, Figure 3D), **continue shopping** (*id.* ¶¶46-47, Figures 3E-G), and **completing a purchase** (*id.* ¶47, Figure 3H).” Petition, 12-14 (emphasis added). But this is substantially the same as the description in Grosz that the Examiner considered during prosecution. *Helena*, IPR2024-00801, Paper 10, at 10 (“A reference submitted, but not substantively discussed during prosecution, nonetheless qualifies as prior art previously presented to the Office.”).

More specifically, Grosz also discloses a series of webpages linked together, where a user can view products/items and select them for purchase. EX2006, 18:61-

65. Grosz describes “link Pricing [that] takes a user to a pricing page detailing different prices for ordered products. The Link Gallery take a user to a gallery of public MIXBOOK™ products created by community members who have given permission to view their created products.” EX2006, 31:41-46. And, like Karidi, Grosz describes the series of webpages as including:

- **adding to cart:** “a link to a shopping cart for purchasing MIXBOOK™ products” (EX2006, 31:47-54; *see also* 35:44-52); and
- **continue shopping:** “the user can continue to the shopping cart or interacting with the rest of the website (embodiments) of the present invention” (*id.*, 18:13-15); and
- **completing a purchase:** “The user can further continue with payment options and order a printed photobook. A standard payment processing gateway maybe implemented in the present invention to order a printed copy of the photobook” (*id.*, 14:44-48).

Accordingly, Karidi is substantially the same as—and cumulative to—Grosz, which was considered during prosecution. There are no material differences between the description in Karidi relied on in the Petition and Grosz. Petitioner relies on substantially the same description as what is described in Grosz, and Karidi is cumulative of Grosz.

iv) Sayed is Substantially the Same as, and Cumulative of, Grosz and Olliphant

Ground 2 (and Grounds 3 and 4) of the Petition propose to combine Sayed with the Coursol-Karidi combination of Ground 1. Sayed adds nothing to what was considered during prosecution. The Petition asserts Sayed “teaches that one webpage leads to another such that a website having three pages allows the first page to link to the second page and the second page to link to the third page.” Petition at 59. The Petition asserts that Sayed allegedly discloses a “parent-child” relationship that allows webpages to be shown in sequence. *Id.*, 61. The parent-child relationship in Sayed relates to when properties of a “parent” element may be presumed to be included in the “child” element. For example, a color, etc. from a “parent” webpage may be inherited by the “child” webpage. EX1009, 10:35-49. This is not relevant to the challenged claims, and is not a material difference over the prior art considered during examination.

Sayed adds nothing that has not already been considered, and is instead substantially the same as the prior art considered and relied on during prosecution. According to Petitioner, a POSITA understands that “in view of Sayed’s teachings, the user visiting an electronic commerce website may view a product and then click to add the object to the cart to be purchased and ultimately be presented a shopping cart page to check out and complete the purchase.” Petition at 59-60. Yet as

discussed above in Section IV.A.1.iii, Grosz discloses a series of linked webpages for a user to make a purchase. Just like Sayed, Grosz describes a sequence in which a user can view items and select items for purchase, add items to a cart, and link to another webpage to complete the purchase. *See supra* Section IV.A.1.iii. The webpages to complete the purchase of course can only be reached once an item is selected to purchase, *i.e.*, one page leads to another (“parent-child”).

In addition, Petitioner relies on portions of Sayed that are substantially the same as Olliphant. Olliphant has substantially the same description of sequential webpages as Sayed. As explained by the parent patent’s Examiner, Olliphant describes “sequential pages (i.e. one after another) are displayed during a sign-up process.” EX2001, 462-63 (citing EX2004); *see also supra* Section III.A. Olliphant’s sign-up process likewise presents a “parent-child” relationship, *e.g.*, as the webpages provided to the user depend on which invitation/offer was selected, and the content of the generated webpages—including generated links to other webpages—will depend on what information the user enters on the “initial set-up webpage.” *See supra* Section IV.A.1.ii; EX2004, ¶¶56-67. Olliphant was applied and overcome during prosecution of the parent patent, while including substantially the same alleged descriptions as Sayed. Thus, the Sayed disclosure that Petitioner

relies upon is substantially same as, and is cumulative of, the teachings of Grosz and/or Olliphant, which were considered during examination.

In sum, Petitioner articulates no difference whatsoever between Coursol and Shaposhnikov; between Karidi and Grosz or Olliphant; or between Sayed and Grosz or Olliphant, let alone a material difference that would encourage the Board to revisit the Examiner's work during prosecution. *See Becton*, IPR2017-01586, Paper 8, at 21-22 (finding that references were cumulative in nature when Petitioner failed to articulate any substantive differences between prior art alone or in combination). Thus, the asserted art in the Petition is substantially the same as, and cumulative of, the art that the Examiner considered (and applied) during prosecution.

2. *Becton, Dickinson* Factor (c) Supports Denial Because the Petition Reargues and Relies on the Asserted Art in the Same Manner as the Examiner During Prosecution

The third *Becton* factor weighs in favor of denying the Petition because the Petition relies on, and applies, the asserted art in the same manner as the art the Examiner applied during prosecution. *See Becton*, IPR2017-01586, Paper 8 at 17 (“Petitioner has failed to present any new evidence or arguments that are substantively different than those already presented by the Office during prosecution of the ’339 patent.”). As detailed below, the asserted art in the Petition, and the way it is applied, overlaps with prosecution. The Petition relies on Coursol

as describing traditional webpages that may be linked together in series allowing a user interaction. *See e.g.*, Petition at 19 (“Coursol was providing for traditional websites that included a sequence or order to some or all of its webpages in accordance with the function of the website.”). The Petition relies on Karidi and Sayed as describing webpages allowing a user to make a purchase. Petition, 28-35, 56-62. But the Examiner already considered substantially the same prior art and arguments—and determined in allowing the claims that such traditional websites do not teach claim elements 1[c]/14[c]/18[c] or 1[d]/14[d]/18[d].

i) Petitioner Applies Coursol in the Same Manner as the Examiner Applied Shaposhnikov During Prosecution

As discussed above in Section IV.A.1.i, the description of Coursol relied on by the Petition is substantially the same as Shaposhnikov—which was considered, applied in the same manner, and overcome during prosecution. Coursol describes a traditional website with linked webpages, just like Shaposhnikov. And as described above in Sections III.A-B, the Examiner expressly stated that such traditional websites as described in Shaposhnikov do not disclose or render obvious the claim elements:

- “each website type of the plurality of website types comprises a series of directional webpages configured to cause an end user interaction with a website” and

- “the series of directional webpages of each website type of the plurality of website types comprises a unique plurality of sequential webpages configured to be provided sequentially one after another.”

EX2002, 104-05; EX2001, 223-24.

For these claim elements, Petitioner relies—in the same manner—on substantially the same description of traditional websites from Coursol as was applied by the Examiner in Shaposhnikov. Coursol adds nothing material beyond what the Examiner already considered and applied from Shaposhnikov. Specifically, the Petition only has two cites to Coursol for the claim element “each website type of the plurality of website types comprises a series of directional webpages configured to cause an end user interaction with a website.” Petition, 27-28 (citing EX1005, 8:67-9:6, 14:57-64). This relied-upon disclosure from Coursol is substantially the same as that in Shaposhnikov which the Examiner determined did not teach these claim elements. *See supra* Section IV.A.1.i.

Petitioner avers that both of the above-listed claim elements are met when a user selects Coursol’s “spa” website type, where the user is presented with webpages for products, contact, and a gallery page. Petition, 27-28, 33-35 (*compare* EX2003, ¶96). However, this portion of Coursol actually relates to the process of editing the website, and recites that the website control editing home page 320 “includes

controls 321-328 for activating **editing of various components of the website, including a website header, a website footer, a website home page, and one or more additional website pages such as an About page, a Products page, a Services page, a Gallery page, a Contact page, etc.**” EX1005, 8:67-9:6 (emphasis added).

The Petition’s arguments and reliance on this disclosure in Coursol overlap with that of Shaposhnikov. *See supra* Sections III.A-B. The Petition relies on Coursol for the same purpose that the Examiner relied on Shaposhnikov. In applying Shaposhnikov, the Examiner evaluated and applied Figs. 4, 9, 10, 11 and 12—and the associated descriptions—to various claim elements. EX2002, 103-05; EX2001, 221-24. Aligning Shaposhnikov’s Figs. 4, 11, and 12 to the claims, the Examiner also cited the related description in Shaposhnikov for “providing user editing interface.” EX2002, 103-05; EX2001, 222-23. Thus, there is no doubt that this disclosure of Shaposhnikov was explicitly considered by the examiner. *Helena*, IPR2024-00801, Paper 10, at 13 (“We observe that the Examiner substantively discussed Camilleri by applying the reference as prior art in an Office Action....”).

These portions of Shaposhnikov cited by the Examiner disclose that selecting a template provides a webpage including webpage elements, just like Coursol does. EX2003, ¶¶94, 98. As Shaposhnikov describes, “the pre-determined website-app

templates 700 may include one or more of the following elements/features: a home page, a blog page, a testimonials section, a contact us page, an events page, a products page, a services page, and the like. In additional embodiments, the pre-determined website-app templates 700 may include additional elements/features.” EX2003, ¶96 (emphasis added). Shaposhnikov’s templates relied-upon by the Examiner are substantially the same as Coursol’s templates, and the Examiner applied them in the same manner.

Petitioner’s arguments with respect to Coursol’s functionality of adding of photos, and its application to the claims, are similarly cumulative to prosecution. The Petition states that Coursol’s “‘gallery’ page allows a user to add gallery photos to be viewed by visitors (*id.*, 14:57-64).” Petition, 27-28 (citing EX1005, 14:57-64); *compare* EX2003, ¶¶96-97. As with the “spa” website arguments described above, this cited portion of Coursol describes the process of editing a webpage. EX1005, 14:57-63 (“FIG. 61 shows the Gallery editing control page 121, which shows the current list of website gallery photos 122 a, 122 b, 122 c that will appear on the website Gallery page. The user can add a Gallery photo using the add gallery item control 123, which operates similarly to the addition of images elsewhere in the design studio application 215 and is illustrated in FIGS. 62-65.”). The Examiner

considered substantially the same description in Shaposhnikov during prosecution and determined that it did not teach this claim element.

Similar to Coursol, Shaposhnikov describes that webpages, including the photos on a webpage, may be edited. EX2003, ¶123 (“such edits results in these notifications to all channel member end-users may be any edits, such as ... uploading a new photograph, or any edits that may be made via the user application editing interface 1100.”). As Shaposhnikov details, a user’s addition of gallery photos may be viewed by visitors. EX2003, ¶97, 123 (describing Fig. 4, which was cited by the Examiner); EX2002, 103-05; EX2001, 332-37, 222-23 (Examiner citing Fig. 4). A user of Shaposhnikov’s system may “upload and delete photographs associated with the website 704 and the mobile app 706 (the channel) and to also add, edit, or delete text associated with the same.” EX2003, ¶118.

Thus, the Petition’s reliance on Coursol presents substantially the same art in the same manner for the same purpose as the Examiner relied on Shaposhnikov during prosecution.

The Petition also includes a footnote in Section X.A.2.f, referring to Coursol’s description of a traditional website and webpage, without any explanation or analysis of the relevance of a traditional website or webpage to any claim language of elements 1[c] and 1[d]. Petition, 27 n.6. According to Coursol’s description cited

by Petitioner, “[a] traditional **website is a set of one or more web pages served by a web server at a particular domain name.**” EX1005, 5:1-2; *see also* 4:5-9. The cited parts of Coursol also describe that a “website may consist of a plurality of related web page 500, 510, 520, 530, 540, each comprising a browser-renderable document.” EX1005, 5:26-32.

Yet the Examiner considered this same description of a traditional website from Shaposhnikov: “**A website typically includes a collection of web pages in HTML format**, with each page including content, such as graphics, images, text, icons, links, buttons, menus, and/or multi-media content, such as videos and audio. **Creating a website typically includes a collection of webpages....**” and allowed the claims. EX2003, ¶3. As Shaposhnikov describes, “[t]he proliferation of the Internet has resulted in an increased demand for the creation of websites. In fact, some would argue that businesses, in particular, require a website in order to be relevant and competitive as a business’s website is often a first point of contact for many potential customers.” *Id.* Thus, even this unexplained footnote citation to Coursol overlaps with what the Examiner already considered during prosecution in Shaposhnikov.

Further regarding claim element 1[d]/14[d]/18[d], the parent patent’s claims were amended during prosecution of the parent patent to add this element and

overcome Shaposhnikov, leading to allowance. *See supra* Section III.A. Specifically, the parent patent’s claims were amended to incorporate “wherein the **series of directional webpages of each website type** of the plurality of website types comprises a **unique plurality of sequential webpages** configured to be **provided sequentially one after another**” into the independent claims. EX2001, 302-08; *see supra* Section III.A; *see* EX1001, Claims 1, 14, 18. For this claim element in the ’047 Patent, Petitioner relies on substantially the same asserted art in substantially the same manner as during prosecution. The Examiner determined that merely linking webpages together and providing a traditional sequence of webpages does not meet this claim element. Thus, Petitioner relies on Coursol in substantially the same manner as Shaposhnikov was applied—and overcome—during examination. Coursol adds nothing new or materially different. *See, e.g., Advanced Bionics*, IPR2019-01469, Paper 6, 16 (emphasizing, in denying institution, that the “Examiner allowed the claims only after they had been amended to specifically require” claim elements configured in a specific way, and that “Petitioner relies on Charvin in the same manner as the Examiner relied on Zimmerling during prosecution.”).

As discussed above in Section IV.A.1.i, there are substantial similarities between Coursol and Shaposhnikov. Despite these substantial similarities,

Petitioner fails to point to any material difference between Coursol and Shaposhnikov, let alone rely on a material difference between these references. *See Becton*, IPR2017-01586, Paper 8, at 21 (finding no material differences when Petitioner did not rely on any particular differences between asserted art and art considered during prosecution).

And not only did the Examiner find that the prior art of record (including “specifically Shaposhnikov”) did not teach or render obvious the claims, but the Examiner also expressly stated that it would not have been “within the level” of a POSITA at the time of invention to “modify or integrate” the prior art to incorporate the features recited in the claims. EX2002, 103-05; 44-48, 24-28; EX2001, 216-25. Because Petitioner relies on Coursol in the same or substantially the same manner as Shaposhnikov was applied during prosecution, this *Becton* factor favors denying institution.

ii) Karidi

Each of the Grounds in the Petition propose to supplement Coursol with Karidi. However, the Petition never identifies or explains what part of the claim is missing from Coursol and that is provided by Karidi, or why a POSITA would combine Karidi with Coursol to provide that missing element. For example, the Petition avers that Coursol teaches element 1[c]/14[c]/18[c] (Petition, 27 (“Coursol’s

website type comprises a series of directional webpages configured to cause an end user interaction with a website.”)), yet proposes to combine Karidi with Coursol for this exact same element. Is Coursol missing a “website type;” “series of directional webpages;” or being “configured to cause an end user interaction with the website?” The Board is left to guess.

In the same manner for element 1[d]/14[d]/18[d], the Petition asserts that this claim element is met by Coursol. Petition at 34 (“The webpages of Coursol’s website are thus ‘a unique plurality of sequential webpages’ that are provided sequentially.”). Again, the Petition proposes to combine Coursol with Karidi without identifying any part of claim element 1[d]/14[d]/18[d] that is missing from Coursol. Is Karidi relied on to supplement Coursol to provide “directional webpages of each website type;” the “website types comprise a unique plurality of sequential website pages;” or “provided sequentially one after another?” The Petition does not explain. Accordingly, the Petition fails to present a *prima facie* case of obviousness as it does not ascertain the differences between the claimed invention and the prior art, as required by the *Graham* factors. *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

(a) Petitioner Applies Karidi in the Same Manner as the Examiner Applied Olliphant During Prosecution

As described above, the Examiner applied Olliphant in rejecting original Claims 6-7 of the parent patent during prosecution. *See supra* Section III.A. These claims recited the “series of directional webpages of the selected website type of the plurality of website types comprises a plurality of sequential webpages configured to be provided sequentially one after another” before that language was incorporated into the independent claims. EX2001, 331-37, 343-44. Each of the ’047 Patent’s claims include similar claim language. EX1001.

Olliphant was overcome during prosecution of the parent patent and the claims allowed. EX2001, 343-44. There are no material differences between the asserted art in the Petition and the prior art evaluated during prosecution because Olliphant describes substantially the same thing as the relied-upon portions of Karidi. Both references describe a traditional website of linked webpages in sequence, which the Examiner determined did not teach the claims. Petitioner relies on Karidi in the same manner that the Examiner relied on Olliphant during examination of the parent patent. And because this claim language is similarly recited in the ’047 Patent’s independent claims, and the Examiner also considered Olliphant (*see supra* Section III.B) overcome.

In applying Olliphant to the parent patent's claims, the Examiner cited Figs. 4, 8A-S and paragraphs [0056]-[0067] of Olliphant, citing Olliphant's description of "sequential pages (i.e. one after another) [that] are displayed during a sign-up process." EX2001, 343. This rejection was overcome by the Applicant with the amendments moving language from the parent patent's original Claims 6-7, into its independent claims, and adding that the plurality of sequential webpages are unique. EX2001, 302-08, 283-84. A traditional website with a series of linked webpages was thus determined not to teach this claim element. Petitioner's reliance on the same description in Karidi does not present any reason to revisit this issue.

As discussed above in Section IV.A.1.ii, Figs. 8A-8S of Olliphant (which the Examiner applied) were cited to show a traditional website with a series of webpages, just like Karidi. EX2001, 343-44. In Olliphant, webpages are presented to a user during a "sign-up" process. EX2004, ¶57, 72, 10; *see* Section IV.A.1.ii. Figs 4A-D of Olliphant provide a detailed flow chart of the sequential flow of the process and the sequence of webpages presented. *See, e.g.*, EX2004, ¶68 ("The next steps process those selections to ensure that the link categories are set up as the user intended, as illustrated in FIG. 4B."). And Step 450 describes generating webpages with a form to solicit username or login information for social bookmarking services, which are webpages with which a user interacts, *e.g.*, by providing contact and other

information (Step 452). EX2004, ¶72. One webpage can only be reached from another.

Petitioner applies Karidi in the same manner as was done during prosecution, as allegedly describing a sequence of webpages involving user interaction (cart-shopping-purchase) and therefore presents substantially the same arguments that were already considered—and overcome by amendment—during prosecution.

Olliphant’s series of webpages also allows for other interactions by the user. For example, the user can provide links or invite others (Figs. 8B; 8P; 8Q). EX2004. And Figs. 8N and 8O of Olliphant illustrate part of the series of webpages that allow a user interaction, for example by sharing websites with others. *Id.*, *see also* ¶63. Accordingly, Karidi adds nothing to what has already been considered by the Examiner—and overcome. Here again, substantially the same prior art is being presented in the same or substantially the same manner as was considered during prosecution. It has already been determined that such descriptions do not teach “wherein the **series of directional webpages of each website type** of the plurality of website types comprises a **unique plurality of sequential webpages** configured to be **provided sequentially one after another**” as recited in the claims.

(b) Karidi is Substantially the Same as Grosz

As discussed above in Section IV.A.1.iii, the description in Karidi that Petitioner relies on is substantially the same as that in Grosz, which was considered during prosecution. The Petition relies on Karidi as allegedly describing webpages where a user performs an interaction and, more specifically, makes a purchase. Petition, 12-14, 32. But what Petitioner points to in Karidi does not add anything material beyond what the Examiner already considered in Grosz. Grosz also describes a traditional sequence of webpages for a user to make a purchase. *See supra* Section IV.A.1.iii; EX2006, 31:51-54. The Examiner already determined that such description of traditional webpages for a user to make a purchase does not teach “the series of directional webpages of each website type of the plurality of website types comprises a unique plurality of sequential webpages configured to be provided sequentially one after another,” as recited in the claims.

Petitioner relies on Karidi as allegedly teaching webpages for a user “to view an item (Figure 3C) and add the item to cart, view the cart (Figure 3D), continue shopping (Figures 3E-G), checkout and view the receipt (Figure 3H)” for this claim element. Petition, 33, 51 (citing EX1006, ¶¶43, 45-47). And similarly, Grosz describes a series of webpages to view items, select items for purchase and add to a

cart, continue shopping or other activities on the website and then to complete the purchase. EX2006, Figs. 1Q-1T, Fig. 1L, Figs. 4-8.

In more detail below and as described above in Section IV.A.1.iii, Grosz describes substantially the same thing as Karidi. Fig. 4 of Grosz (below) illustrates a webpage 400. Grosz describes that

“[p]age 400 includes navigation options 402 including the locations Home, Create, Pricing, and Gallery. The link Pricing takes a user to a pricing page detailing different prices for ordered products. The Link Gallery take a user to a gallery of public MIXBOOK™ products created by community members who have given permission to view their created products.”

EX2006, 31:37-46.

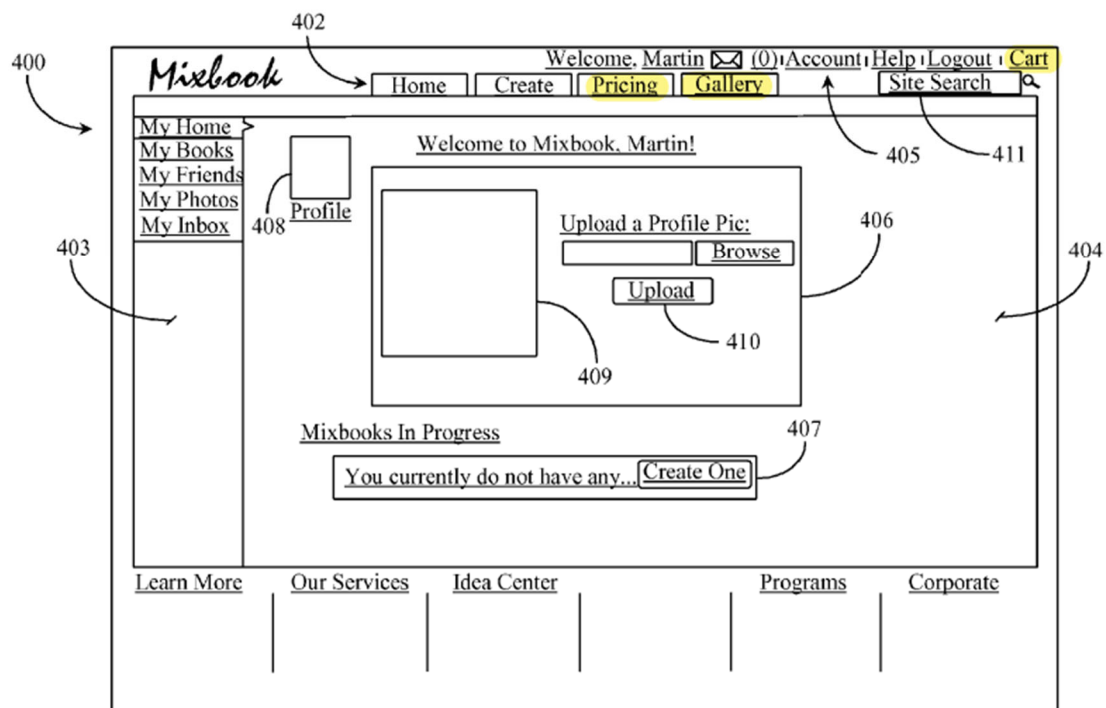
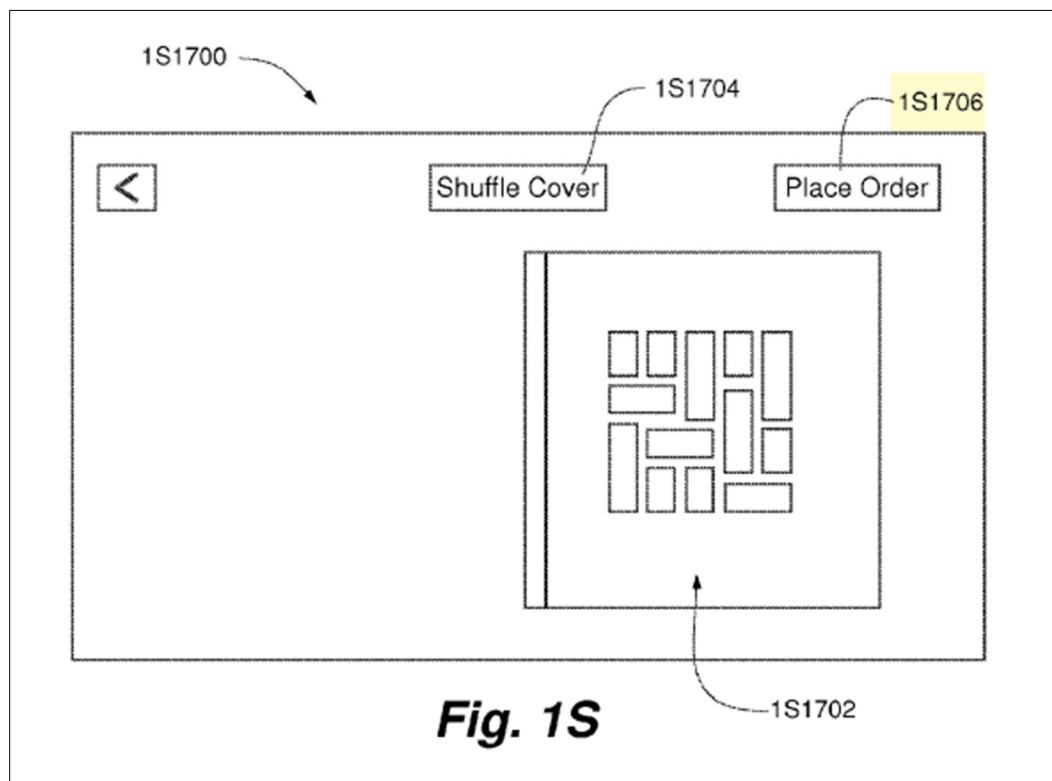


Fig. 4

EX2006, Fig. 4 (annotated).

Grosz's Page 400 also includes "a link to a shopping cart for purchasing MIXBOOK™ products. A user may purchase products created by that user or products created by others that the user is authorized to purchase." EX2006, 31:51-54. The specification describes that "the user can continue to the shopping cart or interacting with the rest of the website (embodiments) of the present invention." EX2006, 18:13-15. So, like Karidi, Grosz discloses providing the option for a user to add to cart or continue shopping, and also to complete a purchase.

In addition, Fig. 1S of Grosz illustrates an embodiment via which a user can place an order for a project (1S1706):



EX2006, Fig. 1S. The user in Grosz “can proceed to order the photobook by pressing a button place order 1S1706.” EX2006, 15:39-40. Then, selecting order button 1S1706 leads the user to the next webpage in sequence, shown in Fig. 1T of Grosz.

1T1800

1T1802

1T1804

1T1806

1T1808

1T1810

Fig. 1T

EX2006, Fig. 1T.

Fig. 1T illustrates an embodiment for ordering a product. Grosz describes that the

“user can specify a quantity of the order at the quantity area 1T804. A price information is also included with the quantity information. The user can enter a shipping address in the area 1T1806, and an email address in the area 1T1808. The user continues a

processing of payment for the order by pressing a button payment information 1T1810. The button payment information 1T1810 directs the user to a payment processing gateway to complete the order.”

EX2006, 15:45-52. Thus, pressing the payment information button leads to user to the next webpage in the sequence.

And like Karidi, Grosz also describes that the user may continue shopping after selecting a product for purchase. EX2006, 64:52-57 (“[W]hen a user is ready to purchase the project in print form the system might also recommend that the user purchase another product that can be displayed to the user through the GUI with the recommended photos in place on the product. The system might offer an up sell option of one or more than one product exhibiting the selected photos.”). Accordingly, Petitioner’s reliance on Karidi as describing webpages to view items, select items for purchase and add to a cart, overlaps with Grosz and is the same or substantially the same as disclosure considered by the Examiner. Though Karidi was not before the Examiner, its relied-upon teachings were in Grosz.

Notably, Petitioner does not explain how substantially the same disclosure in Karidi as that which was applied and overcome from Olliphant somehow teaches the claim elements. This supports that the asserted art in the Petition suffers from the same flaws as what was already considered by the Examiner during prosecution. *See, e.g., Advanced Bionics*, IPR2019-01469, Paper 6, 15-16 (explaining that

Petitioner was relying on a combination reference to provide substantially the same as what had already been examined during prosecution). The Examiner here expressly stated that “the series of directional webpages of each website type of the plurality of website types comprise[] a unique plurality of sequential webpages configured to be provided sequentially one after another,” was not taught by Olliphant and Grosz. EX2002, EX104-05, 27; EX2001, 283-84. Yet the Petition relies on substantially the same disclosure in Karidi that was overcome during prosecution.

The Board in *Roku, Inc. v. Universal Electronics Inc.* analyzed a Petitioner’s reliance on a non-record reference for disclosure of the “distinguishing” claim element. IPR2019-01619, Paper 11, at 16, 13 (Apr. 2, 2020). The Petitioner relied on the non-record reference for substantially the same disclosure that was described in the reference of record, and the Board denied institution. *Id.*, at 15-16. Like in *Roku*, Olliphant and Grosz here describe substantially the same series of webpages for user interaction as relied on in Karidi, and there is no reason to revisit the Examiner’s decision.

In sum, the Petition relies on Karidi for the same purpose that the Examiner relied on Olliphant, and considered Grosz, during examination. Therefore, this factor favors denying institution.

iii) Sayed is Substantially the Same as What the Examiner Considered During Prosecution in Grosz and Olliphant

Ground 2 (and Grounds 3 and 4) in the Petition proposes combining Sayed (EX1009) with the “Coursol-Karidi” combination of Ground 1. Petition, 56-65. But Sayed also describes the same traditional websites like Coursol and Karidi that the Examiner already determined do not teach elements 1[c]/14[c]/18[c] and 1[d]/14[d]/18[d] of the claims.

However, as an initial matter, the Petition never identifies or explains what part of the claim is missing from the Coursol-Karidi combination and that is provided by Sayed. Thus, just like attempting to combine Coursol and Karidi, Petitioner never identifies or explains what part of claim elements 1[c]/14[c]/18[c] or 1[d]/14[d]/18[d] is missing from the Coursol-Karidi combination—and that is provided by Sayed. *In re Sang Su Lee*, 277 F.3d 1338, 1345-46 (Fed. Cir. 2002) (“The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims,” and the rationale “must [be] set forth.”). Accordingly, the Petition fails to present a *prima facie* case of obviousness, as it does not ascertain the differences between the claimed invention and the prior art as required by the *Graham* factors. 383 U.S. at 2.

It is not surprising that the Petition fails this test as the description relied on in Sayed overlaps with the description relied on in Karidi. For element 1[c]/14[c]/18[c], the Petition states that “in view of Sayed’s teachings, the user visiting an electronic commerce website may view a product and then click to add the object to the cart to be purchased and ultimately be presented a shopping cart page to check out and complete the purchase.” Petition 59-60. This is the same as the description in Karidi relied on in the Petition. A webpage in Sayed having a “link[] to make a purchase” (Petition, 59 (citing EX1002, ¶242)) is no different than the description of a user making a purchase in Karidi, and of no material difference to the claim language.

For example, the Petition states that “Sayed teaches a series of directional webpages that are designed and intended to cause a guest of the created website to interact with the website, such as **to view a product (1002), add the item to the cart (1006) and access the shopping cart (1004).**” Petition, 60 (emphasis added). Similarly, in Ground 1, Petitioner alleges that Karidi also describes the same thing:

“to view an item (Figure 3C) and add the item to cart, view the cart (Figure 3D), continue shopping (Figures 3E-G), checkout and view the receipt (Figure 3H).”

Petition, 28-32 (emphasis added).

As another example, the Petition avers that “Coursol-Karidi’s series of directional webpages comprise a ‘unique plurality of sequential webpages.’” Petition, 61 (citing Almeroth Decl., EX1002, ¶224).

Petitioner then asserts that a POSITA would combine Sayed with Coursol-Karidi, even while admitting that Sayed discloses the exact same thing as is allegedly already in Coursol-Karidi: “Sayed’s series of directional webpages comprise a ‘unique plurality of sequential webpages.’” Petition, 62. What the petition fails to identify is the difference(s) between the claimed invention and the proposed Coursol-Karidi combination—and how Sayed supplements that combination to render the claimed invention obvious, running afoul of *Graham*. 383 U.S. at 2.

In any event, it is clear that Sayed adds nothing to the art considered and applied by the Examiner. Sayed is substantially the same as Olliphant and Grosz, applied and considered, respectively, during prosecution. The same or substantially the same descriptions of Sayed were in Olliphant and Grosz, and were considered and overcome by amending the claims during prosecution.

As discussed above in Section IV.A.1.iii, Grosz discloses a series of linked webpages for a user to make a purchase. *See, e.g.*, EX2006, 21:7-18. Like Sayed, Grosz describes webpages with links, where a user can view items and select items

for purchase, add to a cart, and complete the purchase. *See supra* Section IV.A.1.iii; *see also* EX2006, 21:47-57. For example, Grosz describes that

Once a photobook 1L1102 is customized and ready to order, a user can select a specification of the project to order. If the user is not happy with the customization of the photobook 1L1102, the user can go back to the editor or workspace by clicking 1L1104 to further edit/customize the pages of the photobook. ... Each specification may have a different price for order. When the user agrees to a price, the user can enter a shipping address as shown at 1L1108. The user can further continue with payment options and order a printed photobook. A standard payment processing gateway maybe implemented in the present invention to order a printed copy of the photobook.

EX2006, 14:33-48. Grosz describes a payment page that is only presented after a user is linked there from a project or photobook, which are themselves only presented after the user selects the corresponding products. EX2006, 15:41-52 (“The user continues a processing of payment for the order by pressing a button payment information 1T1810. The button payment information 1T1810 directs the user to a payment processing gateway to complete the order.”). It is clear that the payment webpage in Grosz can only be reached from the order webpage; the user cannot pay if there is no order. Thus, the same or substantially the same description of webpages that is relied on from Sayed is described in Grosz.

The Examiner also considered and applied Olliphant to the same claim language in the parent patent, and Olliphant includes the same or substantially the same description of webpages as Sayed. *See supra* Section IV.A.1.ii; *see also, e.g.,*

EX2004, ¶67. The Petition relies on Sayed for the same purpose that the Examiner relied on Olliphant during the parent patent's examination, allegedly describing sequential webpages that allow a user to perform an interaction. During prosecution of the parent patent, the Examiner applied Olliphant's Figs. 4, 8A-S, ¶¶56-67, stating that Olliphant describes sequential pages "(i.e. one after another)" that are displayed during a sign-up process. EX2001, 343. It is axiomatic that the welcome webpage is only presented following a log-in on the log-in webpage. The Examiner has already determined that traditional webpages linked together in series do not meet this claim element. There is no teaching of at least "wherein the **series of directional webpages of each website type** of the plurality of website types comprises a **unique plurality of sequential webpages** configured to be **provided sequentially one after another**" as recited in the claims. Petitioner's reliance on Sayed is the same or substantially the same as the descriptions in Grosz and/or Olliphant, considered by the Examiner. Substantially the same references were overcome during prosecution, and the Examiner allowed the claims.

Accordingly, the same or substantially the same art is presented in the Petition in the same or substantially the same manner as was considered during prosecution. The Petition simply seeks to revisit the Examiner's determination that a sequence of webpages, for example webpages presented during a sign-up process or making a

purchase, do not teach all of claim elements 1[c]/14[c]/18[c] and 1[d]/14[d]/18[d], with no explanation of any material difference.

3. *Becton, Dickinson* Factor (d) Supports Denial Because the Examiner Had the Same or Substantially the Same Prior Art Before Them During Prosecution

The fourth *Becton* factor weighs in favor of denying institution because the Examiner applied Shaposhnikov (substantially the same art as Coursol), Olliphant (substantially the same art as Karidi, Sayed); and considered Grosz (substantially the same art as Karidi, Sayed) during prosecution.

As discussed in the above Sections 1 and 2, references made of record are “considered” by the Examiner. *Advanced Bionics*, IPR2019-01469, Paper 6, at 7-8; *see also Becton*, IPR2017-01586, Paper 8 at 22-23 (across obviousness rejections, observing that asserted art was substantively considered during examination); *id.*, at 15 (comparing a non-record reference to a reference that was of record: “As such, both [non-record] and [applied references] disclose substantially the same magnet shape and configuration, thereby disclosing substantially the same information already considered by the Office.”). Here, not only were the references made of record substantially the same as the asserted art in the Petition, but the Examiner also made rejections against similar claim language in the parent patent based on substantially the same art. *See supra* Sections 1 and 2, III.A-B. In response to the

parent patent's rejections, the Applicant presented arguments and amended those claims to recite that "directional webpages of each website type of the plurality of website types comprises a unique plurality of sequential webpages configured to be provided sequentially one after another." *See supra* Section III.A. After the amendments, the Examiner allowed the parent patent's claims. *Id.* EX2001, 216-25. The '047 Patent's claims include similar claim language.

The Petition relies on Coursol for the same teachings as were applied from Shaposhnikov. *See supra* Section 2. And the Petition also relies on Karidi and Sayed for the same teachings as the Examiner applied and considered, respectively, in Olliphant and Grosz. The Examiner therefore considered (and applied) prior art in the same or substantially the same way that the Petition now proposes to apply Coursol, Karidi and Sayed.

Because the Examiner considered prior art that was squarely cumulative of Coursol, Karidi, and Sayed, and determined that the claims were patentable, this factor also weighs in favor of denying institution.

4. *Becton, Dickinson* Factor (e) Supports Denial Because the USPTO Made No Errors During Prosecution, Nor Has Petitioner Demonstrated Any

Petitioner has failed to demonstrate that the Examiner erred in evaluating substantially the same art during prosecution of the '047 Patent and its parent, the

'357 Patent. *Vital*, IPR2023-00381, Paper 7, at 19 (“we agree with Patent Owner that Petitioner has failed to demonstrate that the Office erred in its evaluation of the cited art as required by *Advanced Bionics*.”); *Advanced Bionics*, IPR2019-01469, Paper 6, at 8 (when the “‘same or substantially the same prior art or arguments previously were presented to the Office,’ then the Board’s decisions generally have required a showing that the Office erred in evaluating the art or arguments.”).

Petitioner does not allege—and fails to provide any evidence here—that the Examiner erred in any way in considering the prior art of record during prosecution of the '047 Patent. Thus, this factor weighs against institution. *RJ Reynolds Vapor Company et al v. Fontem Holdings 1 BV*, IPR2017-01642, Paper 10, at 15 (“Petitioner is thus asking the Board, essentially, to second-guess the Office’s previous decision on substantially the same issues, without providing any arguments distinguishing the Examiner’s prior consideration of [substantially the same references], or any compelling reason why we should re-evaluate substantially the same prior art or arguments as those presented during prosecution and considered by the Examiner.”); *Edge Endo, LLC v. Maillefer Instruments Holding S.A.R.L.*, IPR2018-01349, Paper 15 at 19 (Jan. 14, 2019).

5. *Becton, Dickinson* Factor (f) Weighs Against Institution Because the Petition Presents No New Evidence or Facts Warranting Reconsideration

The Petition does not present any new evidence or facts that warrant reconsideration of what has been considered by Office, and this *Becton* factor weighs in favor of exercising the Board’s discretion to deny institution. Petitioner’s proposed combination of Coursol with Karidi is not new evidence because the Examiner considered substantially the same art during prosecution. Indeed, Coursol and Shaposhnikov are relied-upon for substantially the same description; as are Karidi and Grosz, and Olliphant, and Sayed and Grosz, and Olliphant. *See supra* Sections 1-3. And Petitioner does not suggest that the Examiner may have erred in evaluating the prior art—so this factor weighs in favor of denying institution.

As discussed above, the Petition leaves the Board to guess on multiple features from the asserted art, what it is they bring to the combination, and how or why that fits together. *See, e.g.*, Petition, 19.

The expert declaration of Dr. Kevin Almeroth (EX1002), which accompanies the Petition does not provide any explanation that warrants reconsidering what was already determined during prosecution. Indeed, the declaration often repeats the Petition’s arguments word-for-word without any additional analysis. *See, e.g.*, Petition, 36 and Declaration, ¶173; Petition, 28 and Declaration, ¶159; Petition, 32-

33 and Declaration, ¶163-64. The Board has repeatedly found this kind of conclusory testimony deserves little to no weight. *See, e.g., Infobionic, Inc. v. Braemer Manufacturing, LLC*, IPR2015-01704, Paper 11, at 14-15 (Feb. 16, 2016) (citing to 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”)); *Edge Endo*, IPR2018-01349, Paper 15 at 23 (“We have reviewed [the] testimony [of petitioner’s expert] ... and determine that his testimony largely mirrors the arguments presented in the Petition. On balance, we do not find that the additional evidence or facts presented in the Petition warrant reconsideration of the prior art or arguments.”).

And as has been discussed above, the Examiner found that the prior art of record did not disclose or render obvious the claims, and stated that it would not have been “within the level” of a POSITA at the time of invention to “modify or integrate” the prior art to incorporate the features recited in the claims. EX2002, 103-05, 44-48, 24-28; EX2001, 216-25. Petitioner here does not present anything materially new, nor does it so in a different manner than has already been considered—and thus there is no evidence in the Petition that warrants Board reconsidering what the Examiner has expressly stated was outside the reach of a POSITA at the time.

6. Institution Should Be Denied Under *Advanced Bionics*

Because both prongs of the *Advanced Bionics* framework have been met as described in the above sections, and all *Becton, Dickinson* factors weigh in favor of denial, the Board should exercise its discretion under Section 325(d) here and deny institution. The Petition's art is substantially the same as the art that was considered, applied, and overcome during prosecution. Petitioner does not even attempt to distinguish its references from those before the Examiner. *RJ Reynolds Vapor Company et al v. Fontem Holdings I BV*, IPR2017-01642, Paper 10, at 15 ("Petitioner is thus asking the Board, essentially, to second-guess the Office's previous decision on substantially the same issues, without providing any arguments distinguishing the Examiner's prior consideration of [substantially the same references], or any compelling reason why we should re-evaluate substantially the same prior art or arguments as those presented during prosecution and considered by the Examiner."). No compelling reason exists to revisit the Examiner's prior determination. The Board should thus decline to do so and deny institution.

V. CONCLUSION

For the reasons stated above, Patent Owner submits that the Petition presents the same, or substantially the same, already-examined prior art and arguments.

Accordingly, Patent Owner requests that the Board deny of institution of *Inter Partes* Review.

DATED: March 11, 2025

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), I hereby certify that the foregoing Patent Owner Preliminary Response Under 37 C.F.R. § 42.107 contains 13,079 words as measured by the word processing software used to prepare the document, excluding the cover page, signature block, and portions exempted under 37 C.F.R. § 42.24(a).

DATED: March 11, 2025

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CERTIFICATE OF SERVICE

I certify that a copy of the Patent Owner Preliminary Response Under 37 C.F.R. § 42.107 was served on Petitioner by causing it to be sent by email to counsel for Petitioner at the following email addresses:

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