

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HOME DEPOT U.S.A., INC.,
Petitioner,

v.

H2 INTELLECT LLC,
Patent Owner.

IPR2025-00480
U.S. Patent No. 8,433,296

PATENT OWNER'S PRELIMINARY RESPONSE

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Complaint, <i>H2 Intellect LLC v. The Home Depot, Inc., et al.</i> , No. 2:24-cv-00694 (E.D. Tex. Aug. 22, 2024), ECF No. 1.
2002	Amended Complaint, <i>H2 Intellect LLC v. The Home Depot, Inc., et al.</i> , No. 2:24-cv-00694 (E.D. Tex. Jan. 9, 2025), ECF No. 26.
2003	Amended Docket Control Order, <i>H2 Intellect LLC v. The Home Depot, Inc., et al.</i> , No. 2:24-cv-00694 (E.D. Tex. Dec. 10, 2024), ECF No. 23.
2004	Complaint, <i>H2 Intellect LLC v. The Home Depot, Inc., et al.</i> , No. 2:25-cv-00123 (E.D. Tex. Feb. 3, 2025), ECF No. 1.
2005	Docket Control Order, <i>H2 Intellect LLC v. The Home Depot, Inc., et al.</i> , No. 2:25-cv-00123 (E.D. Tex. June 2, 2025), ECF No. 46.
2006	Defendants' Opposed Motion to Consolidate, <i>H2 Intellect LLC v. The Home Depot, Inc., et al.</i> , No. 2:25-cv-00123 (E.D. Tex. June 18, 2025), ECF No. 53.
2007	Plaintiff's Response in Opposition to Defendant's Motion to Consolidate, <i>H2 Intellect LLC v. The Home Depot, Inc., et al.</i> , No. 2:25-cv-00123 (E.D. Tex. July 16, 2025), ECF No. 72.
2008	U.S. District Court – Judicial Caseload Profile for the Eastern District of Texas, Administrative Office of the U.S. Courts (March 31, 2025).
2009	Declaration of Rex Mann
2010	Defendant's Preliminary Invalidity Contentions, <i>H2 Intellect LLC v. The Home Depot, Inc., et al.</i> , No. 2:24-cv-00694 (E.D. Tex.)
2011	<i>Carolyn W. Hafeman v. Google LLC et al.</i> , Case No. 24-1600, Corrected Brief for Intervenor-Acting Director of the USPTO (Dec. 30, 2024)
2012	Declaration of Ryan Hardin

2013	Home Depot 2024 Annual Report
2014	List of Patents Assigned to “Home Depot”, USPTO Patent Public Search, https://ppubs.uspto.gov/pubwebapp/ (search “USPAT” Database using query text “home depot”.as.) (last visited July 17, 2025)
2015	Complaint, <i>Ryan Hardin et al. v. Samsung Elec. Co., Ltd. et al.</i> , No. 2:21-cv-00290 (E.D. Tex. July 30, 2021), ECF No. 1
2016	Complaint, <i>Ryan Hardin et al. v. Samsung Elec. Co., Ltd. et al.</i> , No. 2:22-cv-00344 (E.D. Tex. Sep. 2, 2022), ECF No. 1
2017	Claim Construction Order, <i>Ryan Hardin et al. v. Samsung Elec. Co., Ltd. et al.</i> , No. 2:21-cv-00290 (E.D. Tex. Aug. 25, 2022), ECF No. 86
2018	U.S. Patent No. 9,779,418
2019	U.S. Patent No. 10,049,387
2020	U.S. Patent No. 10,984,447
2021	Declaration of Andrew Hill
2022	Assignment History for U.S. Patent No. 8,433,296, USPTO, https://assignment.uspto.gov/patent/index.html#/patent/search/resultAbstract?id=8433296&type=patNum (last visited July 15, 2025)
2023	Joint Motion by Plaintiffs Ryan Hardin and Andrew Hill and Defendants LG Electronics, Inc. and LG Electronics Alabama, Inc., <i>Ryan Hardin et al. v. Samsung Elec. Co., Ltd. et al.</i> , No. 2:21-cv-00290 (E.D. Tex. May 31, 2022), ECF No. 46
2024	Plaintiff's Motion For a New Trial and Partial Judgment as a Matter of Law, <i>Carolyn W. Hafeman v. LG Electronics, Inc.</i> , No. 6:21-cv-00696 (W.D. Tex. July 20, 2023), ECF No. 262
2025	Stipulation of Dismissal, <i>H2 Intellect LLC v. Int'l Business Machines Corp.</i> , No. 2:24-cv-00367 (E.D. Tex. Feb. 3, 2025), ECF No. 42

2026	Joint Motion to Stay All Deadlines and Notice of Settlement, <i>Ryan Hardin et al. v. Samsung Elec. Co., Ltd. et al.</i> , No. 2:21-cv-00290 (E.D. Tex. Feb. 2, 2023), ECF No. 224
2027	Termination Due to Settlement Institution of Trial, <i>Samsung Elec. Co., Ltd., et al. v. Ryan Hardin, et al.</i> , IPR2022-01331, Paper 24 (PTAB July 26, 2023)
2028	Declaration of Scott Denning
2029	ZIP Code™ – the Basics
2030	ZIP Code™ Tabulation Areas (ZCTAs™) - Geography, U.S. Census Bureau (archived, June 2013), https://web.archive.org/web/20130617034846/http://www.census.gov/geo/reference/zctas.html
2031	ZIP Code Tabulation Areas (ZCTAs), U.S. Census Bureau (Aug. 10, 2023)
2032	ZIP Codes are Not Area Polygons, Manifold.net, (archived, April 2005), https://web.archive.org/web/20050407232304/http://www.manifold.net:80/cases/zip_codes/zip_codes.html
2033	ZIP Codes are not Boundaries, Service Objects (Apr. 21, 2021), https://www.serviceobjects.com/blog/zip-codes-are-not-boundaries/
2034	Understanding Geographies in NaNDA: Tract10, Tract20, ZCTA10, and ZCTA20, Univ. of Michigan NaNDA (Mar. 25, 2025), https://nanda.isr.umich.edu/2025/03/25/geographies/
2035	Census Geography and Map Frequently Asked Questions, U.S. Census Bureau
2036	ZIP Code® Tabulation Areas (ZCTAs™), U.S. Census Bureau (Jan. 11, 2000) (archived, Jan. 2000) https://web.archive.org/web/20000304081143/http://www.census.gov:80/geo/ZCTA/

2037	ZCTAs™: Zip Code Tabulation Areas for Census Data Products, U.S. Census Bureau, ZCTA/99 (June 1999)
2038	ZIP Code® Tabulation Areas (ZCTAs™) For Census 2000 Dress Rehearsal Data Products, U.S. Census Bureau (1999)
2039	Noelke et al., <i>COI 2.0 ZIP CODE DATA, Technical Details</i> , Brandeis, The Heller School for Social Policy and Management, January 8, 2022
2040	Frank Donnelly, <i>The Trouble with ZIP Codes: Solutions for Data Analysis and Mapping</i> , At These Coordinates (May 11, 2020)
2041	Matt Forrest, <i>Stop Using Zip Codes for Geospatial Analysis</i> , Carto (Aug. 8, 2019) (https://carto.com/blog/zip-codes-spatial-analysis)
2042	Excerpts from the Deposition of Ryan Hardin (Sept. 27, 2022)

I. INTRODUCTION

In 2009, inventors Ryan Hardin and Andrew Hill¹ developed an approach to overcoming challenges in digital advertising: how to deliver content to application programs on mobile devices when users enter geofences. Their solution—embodied in U.S. Patent No. 8,433,296 (“the ’296 Patent”)—has been thoroughly examined by the Patent Office, commercialized, licensed, and practiced for more than a decade. It has “settled expectations” in the marketplace from its twelve-plus years of being in force.

Petitioner Home Depot now brings this belated challenge. Despite having every incentive, ample time, and near limitless resources to craft its challenge, the Petition never squarely addresses the claim limitations. At virtually every step, Petitioner either omits or simply assumes away required limitations. As such, the Petition falls far short of establishing the “reasonable likelihood” of invalidity that 35 U.S.C. § 314(a) demands.

¹ Mr. Hardin and Mr. Hill are the sole co-owners of H2 Intellect, the current assignee of the ’296 Patent.

For example, claim 1 requires “establishing a plurality of perimeters defining a plurality of geographic areas.” The Petition points only to ZIP codes—five-digit postal codes which unquestionably lack geographic boundaries—and offers no evidence or explanation of why ZIP codes meet this limitation. **Every** challenged claim contains this limitation or one that is materially the same. *See* independent claims 6 and 11 (requiring an “instruction to establish a plurality of perimeters defining a plurality of geographic areas”). By ignoring these express limitations, the Petition fails to map the prior art to the claims on a limitation-by-limitation basis, as Board precedent and 37 C.F.R. § 42.104 demand.

Petitioner's failure to show that the prior art meets the “plurality of perimeters defining a plurality of geographic areas” limitation alone dooms the Petition. But the Petition contains other fatal shortcomings as well. For its obviousness analysis, Petitioner stitches together disparate references supported only by cursory, hindsight-laden assertions. Such *ipse dixit* cannot satisfy *KSR* or the Federal Circuit's “articulated reasoning” requirement.

Each error independently dooms the asserted grounds. What emerges is not a close call; rather, a decade-old, thoroughly examined patent is being attacked with (i) prior art that fails to recite core claim limitations, (ii) rationales that rely on

speculation, and (iii) legal theories that collapse under minimal scrutiny. Because the Petition falls far short of carrying its initial burden, Patent Owner respectfully requests that the Board deny institution.

II. THE CHALLENGED PATENT

A. Background of Inventors

In 2002, the inventors started an IT services company called Pronet Solutions Corp. Once established, they investigated other emerging businesses that would leverage their technology expertise. This led the two entrepreneurs to explore digital billboards, which were relatively new in the mid-2000s. They believed that this field would allow them to grow a business for displaying advertisements on such billboards, which could be managed and controlled remotely. EX-2042.006-009, .012-014 (Deposition of Ryan Hardin).

But in 2007, Hardin looked at his mobile phone and realized that much of the public was or would soon be potentially carrying a digital billboard right in their pockets. *Id.* at .006-007. With modern smart phones having powerful processing capabilities on the immediate horizon, the inventors set out to fully realize this idea and soon developed a method and system that would enable customized delivery of content to mobile applications based on the geographic location of mobile devices

with respect to reserved geographic areas of interest. They filed their first patent application for their inventions on May 1, 2009. EX-1001, Cover Page. Over the course of a decade and several continuation applications, the two have been awarded multiple patents for these inventions, including U.S. Patent Nos. 8,433,296 (the challenged patent), 8,977,247, 9,286,625, 9,779,418, 10,049,387, 10,984,447, 11,948,171, and 12,056,736.

The inventors devoted significant time and resources into determining a way to market and promote their patented technology, which they had dubbed Chamber Planet. EX-2042.012-014. Due to family health challenges, however, the inventors needed to attend to other priorities and paused the continued development of Chamber Planet. *See, e.g.*, EX-2042.016-019. But thereafter, the two discovered that their inventions were being used without their authorization by major players in the mobile phone industry. The inventors brought suit for patent infringement and those cases resulted in confidential settlement agreements and license agreements. *See e.g.* EX-2023 (LG Electronics), EX-2026, EX-2027 (Samsung and Google).

The inventors later learned that other major companies were using their inventions, including Petitioner Home Depot. The inventors first brought suit against Home Depot for infringement of the '296 Patent in August 2024. EX-2001.

B. Overview of the '296 Patent

Messrs. Hardin and Hill filed the application resulting in the '296 Patent on May 1, 2009. EX-1001, Cover. The '296 Patent, titled “Exclusive Delivery of Content Within Geographic Areas,” issued on April 30, 2013, after a rigorous examination process before the United States Patent and Trademark Office (“USPTO”). *Id.*

At the time of the invention, the landscape of mobile content delivery was dominated by systems that broadcast content to users, often resulting in indiscriminate, overlapping, or irrelevant content being delivered. These conventional systems lacked the ability to target content not only by location but also by the specific type of application program in use, leading to inefficiencies and poor user experience. The inventors recognized that advertisers and content sponsors needed a more precise and exclusive mechanism to reach users—one that would allow them to reserve delivery rights for particular geographic areas and for

specific application program types, thereby avoiding the pitfalls of generic, location-based advertising. *See* EX-2042.010-011.

The solution devised by the inventors, and ultimately claimed in the '296 Patent, was a content delivery platform that enables sponsors to obtain interests in customizable geographic areas for the delivery of content to registered application programs associated with particular application types. The content delivery platform centralizes management processes associated with content delivery, and this is reflected in the claim language, which recites, for example, "registering a plurality of application programs," "receiving... a request to obtain an interest" from sponsors and "a request for content" from registered application programs, and "storing a record of the interest." EX-1001, cl. 1. The claims further enable customizable geofences and exclusivity with language like "a plurality of perimeters defining a plurality of geographic areas" and "reserving a specific one of the plurality of geographic areas for exclusive delivery of content." EX-1001, cl. 1, 5. This architecture provides a level of control and performance that was not available in the prior art, addressing technical challenges identified by the inventors and ultimately the industry.

In sum, the '296 Patent represents multiple improvements in the field of mobile content delivery, including providing a system and method that enables requesting applications with exclusive content delivery based on both geographic location with respect to geographic area and application type. These inventive features are tethered to the claim language, as explained in more detail herein.

C. Prosecution History of '296 Patent

The prosecution history of the '296 Patent demonstrates that these inventive features were thoroughly examined and evaluated by the USPTO. Application 12/434,094 was first filed on May 1, 2009. EX-1003 at 275. The USPTO issued a non-final Office Action on July 7, 2011. *Id.* at 174. The examiner rejected “computer readable medium” claims under 35 U.S.C. § 101 for lacking the language “non-transitory,” rejected claims 1-20 under 35 U.S.C. § 102 as anticipated by Gupta, and rejected certain claims under 35 U.S.C. § 103 over Gupta in view of Sato or Gupta in view of Guido. *Id.* at 173-182.

In response, the inventors clarified the claims, amending them to include additional limitations based on the “registered application program” aspect of the invention and to recite “non-transitory.” *Id.* at 157-169. The Examiner

maintained the § 103 rejection in a final Office Action dated January 24, 2012, again based upon Gupta, Sato, and Guido. *Id.* at 114-129.

The inventors thereafter requested and participated in an interview with the Examiner on February 28, 2012, to further explain the technical distinctions and the real-world advantages of the claimed system. *Id.* at 105. During this interview, “the examiner indicated that an amendment in which content from one sponsor was included and content from other sponsors was specifically excluded might overcome the cited references.” *Id.* The invention enables exclusivity of content delivery, so the inventors amended the claims to highlight this inventive feature. *Id.* at 97-108.

Following the amendments, the Examiner responded with a non-final Office Action on June 7, 2012, rejecting some amended claims under § 112 for insufficient antecedent basis for the term “selected sponsor,” and rejecting claims under § 103 over Gupta and Guido. The inventors amended the claims for a final time on September 6, 2012, to further clarify the inventive features of the application, including to specify a “plurality” of application programs, association with “application program type[s],” and customizable geofences

(“establishing a plurality of perimeters defining a plurality of geographic areas”). *Id.* at 32-44.

The Examiner ultimately recognized the significance of these technical distinctions. On December 28, 2012, the Examiner issued a Notice of Allowance, allowing claims 1–4, 7–11, 14–18, and 20. *Id.* at 11-13. The allowed claims reflect improvements over the prior art: a system that enables sponsors to reserve customizable geographic areas for exclusive content delivery to particular application program types, ensuring that intended content reaches intended users within intended areas and intended applications. The patent issued on April 30, 2013. *Id.* at 5.

The prosecution history of the '296 Patent thus tells a story of inventors who identified and solved a real technical problem, and who overcame rejections by demonstrating how their invention advanced the state of the art. The ultimate allowance of the claims confirms that the Patent Office recognized the novelty and non-obviousness of the inventors' solution, which provided a new and valuable approach to exclusive, location- and application-based content delivery.

III. ASSERTED PRIOR ART

The prior art relied on in the Petition for the asserted Grounds and discussed further herein is summarized below.

A. Elliott (EX-1004)

Elliott discloses systems and methods for “delivery of advertisements on mobile devices such as cellular telephones” where “advertisements are provided to a mobile device user in such a way as to allow the user to obtain further information from advertisers without revealing the user’s identity to the advertisers.” EX-1004, [0003], [0009]. The system includes an advertising intermediary that receives advertisements from advertisers, “maintains the advertisements in a database, and also maintains a database of mobile device users who are subscribers to its service.” *Id.* [0009]. The advertising intermediary includes a “advertisements selection engine” which “matches advertisements in the advertisement database... with subscriber information in the subscriber database.” *Id.* [0017]. Elliott discloses that “targeting information” can be supplied by advertisers which specify their “preference for which demographic should receive each advertisement.” *Id.* [0015]. Notably, Elliott does not mention “location” or “geographic areas.” *See generally id.*

B. Jacob (EX-1005)

Jacob describes a “method and apparatus that... relates to delivery of advertisements included with content in an electronic publication that have a geographic location significance to a user.” EX-1005, [0001]. An advertiser can provide advertisements and “advertisement attributes” to a service provider. *Id.*, [0026]. Jacob states “[o]ne of the “attributes that can be assigned to an advertisement is that of geographic location.” *Id.*, [0027]. The “preferred embodiment” of a moveable “communications unit’s reported position” is “stated in geographic coordinates” or “postal (ZIP) code areas.” *Id.*, [0022].

C. Musk (EX-1006)

Musk is directed to a “method and apparatus for performing an accelerated radius search” using a “locations database.” EX-1006, 1:5-7, 4:57-58. A “first search radius is generated based upon [a] category, and the first search radius is used to perform a first search.” *Id.*, 2:30-32. “If the first search returns an insufficient number of results, a second search radius is generated by using a heuristic to increase the first search radius, and the second search radius is used to perform a second search.” *Id.*, 2:32-36. This process repeats until a sufficient

number of results is found. *Id.* Notably, Musk does not mention content delivery or mobile devices. *See generally id.*

IV. SKILL LEVEL OF A POSITA

For purposes of this preliminary response only, Patent Owner applies the same skill level proposed by Petitioner. *See Pet.*, 3.

V. CLAIM CONSTRUCTION

The Petition is deficient for the reasons explained in subsequent sections regardless of whether the Board adopts any of Petitioner's proposed constructions. Claim construction therefore is not a prerequisite for determining that the Petition does not raise a reasonable likelihood of showing any claims are invalid. As such, and for purposes of this preliminary response only, Patent Owner adopts Petitioner's proposed constructions without prejudice to challenging them later in this or other proceedings, except for its construction of the term "recording a request identifier associated with the request" (cl. 2, 7, 12). Patent Owner reserves the right to propose constructions for any claim terms if the Board institutes trial.

A. "recording a request identifier associated with the request"

Petitioner's argument that the term "recording a request identifier associated with the request" is unclear or indefinite lacks merit. *Pet.*, 7, 38. The claim

language, supported by the specification and figures of the '296 Patent, provides clear and unambiguous support that the “request” refers to the “request for content to be used within the registered application program” as described in claim element 1.h. Both claim 2 and claim element 1.h consistently use the term “registered application program,” and claim element [1.d], which pertains to requests from sponsors to obtain an interest in a geofence, lacks such language. EX-1001, cl. 1-2; EX-2028 (Decl. of S. Denning), ¶¶ 32-35. Multiple portions of the specification which describe recording the request identifier also clearly associate this step with the request for content, including Figure 6 and 11:15-66. EX-1001; EX-2028, ¶¶ 36-38.

The same reasoning applies to similar terms in claims 7 and 12. *See* EX-1001, cl. 7, 12 (“record a request identifier associated with the request”). These terms likewise refer to requests *for content* from registered application programs in their respective preceding claims. EX-1001, cl. 6, 11.

VI. GROUND 1: THE PETITION HAS NOT SHOWN A REASONABLE LIKELIHOOD OF SUCCESS IN PREVAILING BECAUSE IT FAILS TO IDENTIFY HOW THE PRIOR ART TEACHES CLAIM LIMITATIONS

The Petition repeatedly fails to identify, with particularity, how the cited prior art teaches the claim limitations, instead relying on conclusory assertions. The law is clear that a petition must identify “with particularity, each claim challenged, the grounds on which the challenges to each claim are based, and the evidence that supports the grounds for challenge to each claim.” 35 U.S.C. § 312(a)(3); *see also Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (noting the importance of the “initial petition identify[ing] with particularity the evidence that supports the grounds for the challenge to each claim.”). The Petition fails on multiple counts.

A. Petitioner Fails to Show How the Prior Art Discloses “Registering a Plurality of Application Programs” (Claim [1.a]).

Claim limitation [1.a] of the '296 Patent requires “registering a plurality of application programs for use with a content delivery platform, wherein the plurality of registered application programs are each associated with at least one application program type.” EX-1001, cl. 1. The Petition's attempt to satisfy this

limitation through Elliott is deficient, as it relies on inference and overbroad mapping rather than the particularized evidence the law requires.²

The Petition asserts that Elliott discloses “registering a plurality of application programs for use with a content delivery platform (collectively, application distributor 102 and advertising intermediary 104), wherein the plurality of registered application programs are each associated with at least one application program type (e.g., video game).” Pet., 15–16, citing EX-1004, [0013], [0018]–[0019], [0027]; EX-1002, ¶106. The Petition further claims that “Elliott discloses or renders obvious registering a plurality of application programs (mobile applications from application provider 112) for use with the content delivery platform (application distributor 102, application intermediary 104).” Pet., 17; EX-1004, [0013], [0018]; EX-1002, ¶108.

² The Petition also fails to show disclosure of materially identical limitations in independent claims 6 and 11. Pet., 50, 59. This argument therefore applies to all challenged claims.

Petitioner proposes that “registering” is “akin to ‘enrolling,’ i.e., recording identifying information for the application that facilitates providing content to and/or tracking the usage of the application.” Pet., 7. But neither Elliott nor Jacob disclose any “registering,” much less “enrolling,” of application programs. The cited portions of Elliott merely state that “Application distributor 102 distributes mobile applications provided by application providers 112 to mobile subscribers 110” (EX-1004, [0018]), and that “Application distributor 102...distributes both applications and advertisements over a network 108 to a mobile device 110” (EX-1004, [0013]). “Distributing” is not registering or enrolling.³ Nowhere does Elliott describe any process of “recording identifying information for the application that facilitates providing content to and/or tracking the usage of the application,” as Petitioner construes the limitation. Pet., 6; EX-1002, ¶85.

The Petition attempts to bridge this gap by arguing that “the application provider receives revenue from sponsors (‘advertising revenue’) based on

³ As a simple example, an employee at a sporting event may distribute water to the attendees without registering or otherwise recording who received the water.

advertising provided to mobile applications via a content delivery platform, which indicates that the mobile application was registered or enrolled with that content delivery platform to enable the provision of revenue to the application provider.” Pet., 17; EX-1004, [0018]. But Elliott states only that: “application distributor 102 provides a portion of its advertising revenue to an application provider 112 in exchange for the application provider 112 allowing application distributor 102 to distribute its product.” EX-1004, [0018]. This is, at best, a business arrangement between the application provider and application distributor, not a disclosure of a registration or enrollment process as required by the claim. There is nothing in Elliott that discloses that the application programs that are distributed are registered “for use with the content delivery platform” as the claim requires, and the Petition, by alleging as such, resorts to improper speculation. *See Alza Corp. v. Mylan Laboratories, Inc.*, 464 F. 3d 1286, 1290 (Fed. Cir. 2006) (emphasizing that “[L]egal determinations of obviousness, as with such determinations generally, should be based on evidence rather than on mere speculation or conjecture.”). A more plausible reading of Elliott is that the application distributor agrees to simply pay the application provider a percentage of its advertising revenue based on how many applications it distributes. In that case, there is no reason that the application

must be “registered” or enrolled with the content delivery platform for the distributor to know how many applications were distributed.

The Petition's mapping of the “associated with at least one application program type” term is equally unsupported and speculative. The Petition points to Elliott's statement that “many types of mobile applications exist, including games, shopping applications, social networking applications, mapping applications, etc.” (EX-1004, [0018]), and that “an advertiser may be interested in sponsoring a video game played using the mobile device” (EX1004, [0018]). But these are merely generic references to categories of applications, not a disclosure that each registered application is “associated with at least one application program type” as the claim requires.

The Petition therefore fails to show, with particularity and supporting evidence, that the prior art discloses “registering a plurality of application programs for use with a content delivery platform, wherein the plurality of registered application programs are each associated with at least one application program type.” The Petition's reliance on inference and overbroad mapping is insufficient under the law. The Board should find that Petitioner has failed to show that this limitation is found in the prior art and deny institution for this reason.

**B. Petitioner Fails to Show How the Prior Art Discloses
“Establishing a Plurality of Perimeters Defining a Plurality of
Geographic Areas” (Claim [1.b])**

The Petition asserts that the combination of Elliott and Jacob discloses the limitation of “establishing a plurality of perimeters defining a plurality of geographic areas” as required by claim [1.b] of the '296 Patent.⁴ The Petition asserts: “[t]hough Elliott does not explicitly describe establishing a plurality of perimeters defining a plurality of geographic areas, Jacob discloses this functionality.” Pet., 21. The Petition then relies on Jacob’s use of ZIP codes as allegedly constituting “pre-established perimeters that define geographic areas,” and contends that a person of ordinary skill would have understood the system to be “pre-programmed to accept ZIP codes and associate those ZIP codes with their corresponding perimeters that define geographic areas in which an advertiser desires to advertise.” Pet., 37–39; EX-1005, Fig. 3, [0027]-[0028]; EX-1016, 4. Petitioner’s mapping of ZIP codes to this limitation is fundamentally flawed for at

⁴ Claims 6 and 11 have materially identical limitations, and the Petition uses the same flawed mappings against these claims. Pet., 50, 59. Thus, this argument applies equally to all challenged claims.

least four reasons, as described below. Each of these alone establishes that the Petition fails to show a reasonable likelihood of establishing invalidity.

- i. ZIP Codes are not a “plurality of perimeters defining a plurality of geographic areas” because ZIP codes do not have boundaries.

First, the Petition's mapping of ZIP codes to this limitation is erroneous because ZIP Codes have no perimeters, let alone perimeters that define a geographic area. ZIP codes, as established by the United States Postal Service (USPS) in 1963, were created solely as a tool for efficient mail delivery, not as geographic boundaries or polygons. *See* EX-2029 (ZIP Code – the Basics). There is no doubt about this: “ZIP codes, unlike census tracts, ***do not have precisely defined geographic boundaries***. They are collections of addresses defined by the U.S. Postal Service (USPS) for efficient mail delivery.” EX-2039 at 5 (*COI 2.0 ZIP CODE DATA, Technical Details*) (emphasis added). The structure of ZIP codes is tied to mail routing and delivery logistics, not to the delineation of geographic areas. Consequently, ZIP codes cannot satisfy a “plurality of perimeters” that “defin[e] a plurality of geographic areas” as all challenged claims require.

Government agencies explain that ZIP codes do not have perimeters with fixed, contiguous, or even polygonal boundaries needed to “define [a] geographic area[]”. As the U.S. Census Bureau makes clear, “USPS ZIP Codes are not areal features but a collection of mail delivery routes.” EX-2030 (ZIP Code Tabulation Areas (ZCTAs) - Geography). The Census Bureau further explains that “*the fact that ZIP Codes aren’t required to be polygons* makes them difficult to map. They are networks of streets served by mail carriers or just individual post offices and are a tool for mail delivery.” EX-2035 (Census Geography and Map Frequently Asked Questions) (emphasis added). The geographic boundaries of ZIP codes are not only undefined, but they also frequently overlap or may even be assigned to single buildings, PO Boxes, or moving entities such as Navy ships. *See* EX-2033 (ZIP Codes are not Boundaries).

If ZIP codes defined geographic areas, as Petitioner contends, it would have been unnecessary for the Census Bureau to develop ZIP Code Tabulation Areas (ZCTAs). Because ZIP codes do not define any geographic areas, the Census Bureau created ZIP Code Tabulation Areas (ZCTAs) as “generalized areal representations of United States Postal Service (USPS) ZIP Code service areas.” EX-2030; EX-2031 (ZIP Code Tabulation Areas (ZCTAs)). The Census Bureau

“created the ZCTAs specifically to address the inadequacies of ZIP Codes for census data tabulation.” EX-2033 (ZIP Codes are not Boundaries).⁵ ZCTAs are constructed by aggregating census blocks based on the most frequently occurring ZIP code, but even these are only approximations and do not correspond to any USPS ZIP code boundaries, which do not exist as geographic features. The Census Bureau further cautions that there is “*no correlation between U.S. Postal Service ZIP Codes and U.S. Census Bureau geography*.” This is because individual U.S. Postal Service ZIP codes can cross state, place, county, census tract, block group

⁵ Petitioner contends that ZIP codes alone satisfy the claimed “plurality of perimeters defining a plurality of geographic areas.” Pet., 22 (“A ZIP code is a well-known to be a pre-established perimeter that defines a geographic area. Therefore, Jacob’s ZIP codes constitute a plurality of perimeters that define a plurality of geographic areas.”). To be clear, the Petition never mentions, let alone contends or cites any evidence to support an argument, that ZIP code tabulation areas (ZCTAs) satisfy this limitation. *See* Pet. *generally*. Regardless, Jacob does not disclose ZCTAs. *See* EX-1005.

and census block boundaries (just to name a few).” EX-2035 (Census Geography and Map Frequently Asked Questions) (emphasis added). Put simply, another government agency—the U.S. Census Bureau—had to create areal representations (via approximate boundary perimeters) to approximate geographic areas using ZIP codes (ZCTAs), which squarely contradicts the Petition’s argument that a ZIP code is well-known to be a pre-established perimeter that defines a geographic area. *See* EX-2037 (ZIP Code Tabulation Areas for Census Data Products) (brochure issued by the U.S. Census Bureau describing ZCTAs); EX-2038 (ZCTAs for Census 2000 Dress Rehearsal Data Products) (technical document describing original methodology for creating ZCTAs).

The Petition therefore is grounded in the misconception that ZIP codes have geographic perimeters. While this misconception may be a common one, it is beyond debate that it is incorrect. “Perhaps the most common misconception in GIS is that Zip codes in the United States are polygonal regions or areas. ... Zip codes are linear features associated with specific roads or with specific addresses such as apartment buildings or military bases that are *best regarded as a point*. Most often, they do not clump together in groups that may be covered by rational polygons.” EX-2032 (Zip Codes are Not Area Polygons) (emphasis added); *see*

also EX-2033 (“It is a ***common misconception*** that 5-digit US Zip Codes are topographic boundaries that can somehow be accurately represented on a map. ***They are not.***”) (emphasis added); EX-2040 (“ZIP Codes are actually ***not areas with defined boundaries***, and there are ***no official USPS ZIP Code maps.***”) (emphasis added); EX-2041 (“Despite the geographic derivation of most ZIP Codes, the codes themselves ***do not represent geographic regions***; in general, they correspond to address groups or delivery routes.”) (emphasis added).

Given this, the Petition’s assertion that “a ZIP code is well-known to be a pre-established perimeter that defines a geographic area” (Pet., 37–39) is not only unsupported by the record but is directly contradicted by numerous unbiased, authoritative sources. The very existence of ZCTAs, and the Census Bureau’s repeated disclaimers about the lack of correspondence between ZIP codes and geographic boundaries, provide objective evidence that ZIP codes cannot satisfy the claim limitation “establishing a plurality of perimeters defining a plurality of geographic areas.”

The Petition cites no competent evidence that a “ZIP code is well-known to be a pre-established perimeter that defines a geographic area.” Pet., 22. Instead, Petitioner merely makes the statement, then concludes that “Jacob’s ZIP codes

constitute a plurality of perimeters that define a plurality of geographic areas.” *Id.* Petitioner’s expert declaration fails to close this gap in evidence because the expert merely repeats *verbatim* the Petition. *See* EX-1002, ¶115. This is a textbook example of *ipse dixit* entitled to no weight. *See TQ Delta, LLC v. Cisco Sys.*, 942 F.3d 1352, 1362 (Fed. Cir. 2019) (rejecting *ipse dixit* expert testimony “untethered to any supporting evidence, much less any contemporaneous evidence”).

Further, Petitioner’s citation to EX-1016 (“Papers of H. Bentley Hahn: The Man Who Invented the 5-Digit ZIP Code”) is unavailing. First, EX-1016 is ***not*** prior art, as it is dated July 1, 2021, and is a repost of a “blog” from May 15, 2015. *Id.* Both dates are years after the May 1, 2009, filing date of the application leading to the ’296 Patent. *See* Pet., 1 (not contesting the priority date). Second, EX-1016 does not support Petitioner’s ZIP code argument. On the contrary, it shows that a five-digit ZIP code does not represent a perimeter of a geographic area but instead identifies the final distribution destination for a piece of mail:



EX-1016.9. As the above image shows, ZIP codes corresponded to “one of 637 sectional centers” and either a post office or building. EX-1016 explains that, for example, the ZIP code 98712 represented a geographical division, sub-division, and sectional center office (9 – California; 8 – Northern California; 7 – Sacramento), with the last two digits (12) corresponding to either a smaller post office in the sectional center or an office building receiving large volumes of mail. *Id.* (stating that “[p]ostal technicians throughout the country are now designating by number the sectional centers, post offices, zones and individual buildings which

will comprise the national ZIP Code”).⁶ Accordingly, Petitioner has failed to show that the combination of Elliott and Jacob discloses this limitation.

ii. Jacob teaches away from geographic perimeters in favor of ZIP codes to reduce complexity.

Jacob is in fact explicit in its choice to use, *not geographic perimeters, but ZIP codes* as a proxy for location, because of Jacob's stated goal of reducing complexity. Jacob teaches: “In order to reduce the complexity of the communications unit, conversion of the communications unit's reported position... to postal (ZIP) code areas is performed.” EX1005, [0022]. Jacob then performs ZIP code matching: “a match, at compare function 411, of the advertisement location

⁶ That the first three digits are used to identify, e.g., a city (such as Sacramento, California) does not help Petitioner. First, the perimeters of Sacramento were pre-existing and not “established” by the ZIP code. Second, the entire ZIP code identifies, e.g., a post office or building, not a geographic area. As the evidence cited herein proves, “ZIP codes ... do not have precisely defined geographic boundaries. They are collections of addresses defined by the U.S. Postal Service (USPS) for efficient mail delivery.” EX-2039.5.

attribute (one or a plurality of geographically related postal codes such as ZIP codes in a preferred embodiment).” EX1005, [0029]. Jacob’s intentional simplification is an example of teaching away: it chooses an inferior, less precise method to avoid complexity, and in doing so, Jacob further distances itself from the claimed invention.

iii. Petitioner’s mapping reads out the establishment of perimeters.

In addition, the challenged claims require the *establishment* of “perimeters” that define “geographic areas,” not merely the use of pre-existing postal codes or labels. Petitioner fails to show that this limitation is met by the Elliott-Jacob combination. The claim language and specification make clear that the invention contemplates the creation and management of geographic boundaries for the purpose of reserving and delivering content to applications within those areas. *See, e.g.,* EX-1001, 3:11–22, 4:11–22. The Petition does not identify any disclosure in Elliott or Jacob of a system that *establishes* such perimeters, as opposed to simply referencing or storing ZIP codes.

iv. Using ZIP codes as perimeters is inconsistent with other claim limitations.

Next, the Petition's reliance on Jacob's use of ZIP codes as "perimeters" is inconsistent with the language of the claim. The '296 Patent contemplates the establishment and management of geographic areas for the purpose of sponsor reservation and content delivery, not the assignment of content to pre-existing postal regions. The Petition does not point to any mechanism in Jacob (or Elliott) capable of defining, modifying, or managing geographic perimeters in the manner allowed by the claims. Instead, Jacob merely allows advertisers to specify a ZIP code as a sole attribute for targeting, which does not disclose or render obvious "establishing a plurality of perimeters defining a plurality of geographic areas."

Moreover, the Petition fails to address the distinction between simply targeting content to a region and proactively establishing and reserving geographic perimeters as the claims require. The cited prior art does not disclose any system for creating, reserving, or tracking exclusive or semi-exclusive sponsor interests in defined geographic areas, nor does it provide for the management of overlapping or dynamic perimeters as contemplated by the patent. EX-1001, 3:11–22, 9:5–11.

Petitioner also asserts, with reference to Jacob, that the “outline of City B is a perimeter that defines the geographic area of City B; similar reasoning applies for Suburb A and Village C.” Pet., 22 (citing Jacob, Fig. 3). But Figure 3 of Jacob is a schematic representation of three municipalities (“suburb A, city B, and village C”). EX-1005 [0028]. There is no disclosure in Jacob that the pre-existing perimeters of A, B, and C are established to define the geographic area as the '296 Patent claims require.

Further, Jacob discloses that it uses “ZIP codes that designate the postal zones in suburb A” to deliver advertisements. *Id.* As explained herein, ZIP codes do not define geographic areas, and as such Jacob does not disclose or render obvious this claim limitation. Petitioner's assertions fail to overcome the fatal flaw that Jacob discusses ZIP codes, not geographic perimeters.

In sum, the Petition does not identify, in either Elliott or Jacob, any disclosure of “establishing a plurality of perimeters defining a plurality of geographic areas” as required by claim [1.b]. The mere use of ZIP codes as targeting attributes does not satisfy the claim limitation, and the Petition's attempt to equate ZIP codes with perimeters defining geographic areas is unsupported by the intrinsic evidence and contrary to the ordinary meaning of the claim terms.

Accordingly, Petitioner has failed to meet its burden to show that this limitation is disclosed or rendered obvious by the cited prior art.

C. Petitioner Fails to Show How the Prior Art Discloses “Receiving, from a Sponsor, a Request to Obtain an Interest in a Selected One of the Plurality of Geographic Areas” (Claim [1.d])

The Petition's analysis of claim limitation [1.d] (“receiving, from a sponsor, a request to obtain an interest in a selected one of the plurality of geographic areas”) is likewise deficient. Pet., 28-29. The Petition fails to identify, with the required particularity, any disclosure in Elliott or Jacob that teaches or renders obvious the claimed step of “receiving, from a sponsor, a request to obtain an interest” in a geographic area.

The Petition's purported mapping of this limitation is a single conclusory sentence:

When a new sponsor (Sponsor #3, green) in the Elliott-Jacob combination interfaces with advertising intermediary 104 for the delivery of advertisements to mobile subscriber 110 after the step of reserving delivery of content from a plurality of previous sponsors (e.g., Sponsor #1, red and Sponsor #2, blue) has been performed, the advertising intermediary 104 receives a new request for a reservation

from the new sponsor, Sponsor #3: [Figure omitted] EX1004, FIG. 1 (annotated). Thus, the Elliott-Jacob combination discloses this limitation.

Pet., 28–29. This passage from the Petition relies on one annotated figure in Elliott for support but does not cite to any specific disclosure in Elliott or Jacob of a sponsor that submits a “request to obtain an interest” in a geographic area. The cited figure (EX-1004, FIG. 1) is a high-level system diagram that does not depict, describe, or imply any such request. In fact, Elliott’s Fig. 1, upon which the Petition relies, does not even contain “sponsor” boxes—instead, Petitioner was reduced to imposing such boxes onto the reproduction of Elliott Fig. 1 at page 29 of the Petition. To be sure, there is no disclosure in the specifications of either Elliott or Jacob of a sponsor or advertiser requesting interest in a geographic area.⁷

⁷ The only disclosures of any “requests” in Elliott and Jacob are from users requesting content or to download an app, or from the application or application distributor requesting an advertisement. *See* EX-1004 [0009] (user requesting to download an app); [0018], [0027] (application or application distributor requesting

The absence of any identified disclosure in the prior art of “receiving, from a sponsor, a request to obtain an interest in a selected one of the plurality of geographic areas” is fatal to the Petition’s obviousness grounds. Again, Petitioner’s expert does not help Petitioner as he merely repeats the Petition’s conclusory narrative, without pointing to any specific teaching in Elliott or Jacob. *See* EX-1002, ¶123. The Board has held that such conclusory assertions, unsupported by particularized citations to the prior art, are insufficient to meet the Petitioner’s burden. *TQ Delta.*, 942 F.3d at 1359 (“‘Rejections on obviousness grounds,’ in particular, ‘cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’”) (citing *KSR Int’l. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007)); *see also Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 12 (on Director Review) at 5 (PTAB February 10, 2023) (precedential) (“[T]he Board was

an advertisement); EX-1005 [0029], [0035], [0037], [0039] (user requesting content). These requests are not the same as, and do not render obvious, the claimed sponsor requesting an interest in a geographic area.

correct in giving little weight to Petitioner's Expert because the expert declaration merely offered conclusory assertions without underlying factual support and repeated, verbatim, Petitioner's conclusory arguments.... The declaration does not provide any technical detail, explanation, or statements supporting why the Expert determines that the feature in question was required or would have been obvious based on the prior art disclosure.”)

The Petition thus fails to show, with the required particularity, how the prior art discloses or renders obvious the step of “receiving, from a sponsor, a request to obtain an interest in a selected one of the plurality of geographic areas,” as required by claim [1.d]. The Petition's analysis is conclusory, unsupported by specific citations, and inconsistent with both the claim language and the disclosures of Elliott and Jacob. This limitation appears in all challenged claims and provides an independent basis for the Board to find that Petitioner has not shown a reasonable likelihood of proving any claim invalid.

D. Petitioner Fails to Show How the Prior Art Discloses “Providing the Sponsor a Response to the Request” (Claim [1.e])

As with limitation [1.d] above, the Petition similarly fails to identify, with the required particularity, any disclosure in Elliott or Jacob that teaches or suggests

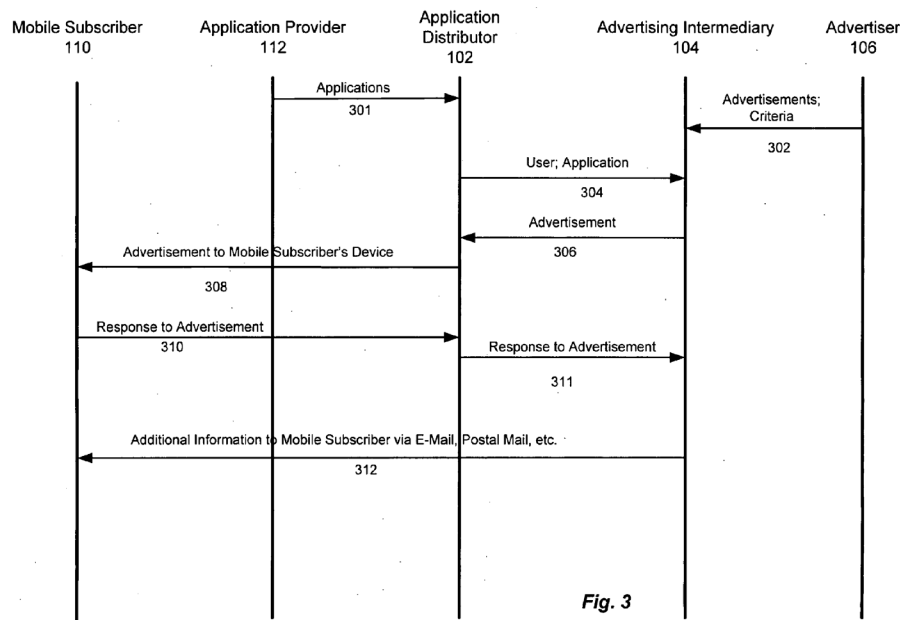
the step of “providing the sponsor a response to the request,” as required by claim [1.e]. The Petition’s analysis for limitation [1.e] is insufficient as it is limited to conclusory assertions and does not point to any specific passage in Elliott or Jacob where a sponsor receives a response to a request to obtain an interest in a geographic area. *TQ Delta*, 942 F.3d at 1359; *see also Xerox Corp.*, IPR2022-00624, Paper 12 at 5. Further compounding this problem, the Petition fails to identify a “response” provided to a request.

- i. The Petition maps this limitation to a “message communicating the response rate” which is not in Elliott.

The Petition attempts to map this limitation to communications which are not found in the prior art. The Petition asserts that this limitation is disclosed by Elliott because, in Elliott, the “advertising intermediary 104 communicates the response rate to a particular advertiser 106 for the purpose of charging the advertiser 106 based on the response rate.” Pet., 29-30 (citing EX-1004, [0024]). But the cited passage in Elliott ***never states*** that the response rate is communicated to anyone, much less a specific advertiser; it only discloses that the advertising intermediary can “track the response rate based on e-mails sent to mobile subscribers, which can be used, for example, to adjust the amount charged to a

particular advertiser.” EX-1004, [0024]. There is no “message communicating the response rate” to an advertiser in Elliott. Pet., 30; EX-1004.

As further evidence that an alleged “message communicating the response rate” is not disclosed in Elliott but instead created out of whole cloth by Petitioner, Figure 3 of Elliott shows *no* flow of information from advertising intermediary 104 to advertiser 106. EX-1004, Fig. 3. Figure 3 shows, at 302, “an advertiser 106 provides 302 advertisements and targeting data to advertising intermediary 104,” *id.*, [0027], but there is *no* arrow in the opposite direction:



EX-1004, Fig. 3. The Petition therefore fails to point out how this claim limitation is disclosed by the prior art.

- ii. Even if Elliott disclosed a “message communicating the response rate,” the Petition’s argument improperly mixes and matches different elements from Elliott.

Even if a POSITA would have understood Elliott to disclose a “message communicating the response rate,” such a message would not be a response to the original request to obtain an interest in a geographic area, but rather to subsequent or unrelated requests, such as billing or analytics.

The claim limitation “providing the sponsor a response to the request,” follows the “request to obtain an interest in a selected one of the plurality of geographic areas” from the preceding limitation [1.d]. The Petition even recognizes this, with its claim construction that “[t]he ‘response’ must occur after the request.” Pet., 7. But the “message communicating the response rate” which the Petition makes up in Elliott would not be a response to the “request to obtain an interest in a selected one of the plurality of geographic areas.” The Petition states that the “message communicating the response rate” would be “for the *purpose of charging the advertiser* 106 based on the response rate.” Pet., 30 (emphasis added). The Petition fails to make any connection between any “message communicating the response rate” to any “request to obtain an interest.” The cited paragraph describing “charg[ing]... a “particular advertiser” instead relates to

portions of Elliott describing a contractual relationship. EX-1004, [0019] (stating that “application distributor 102 may be a separate business entity from advertising entity 104, which itself contracts with advertisers 106.”)

iii. The Proposed Elliott-Jacob combination also fails to disclose this limitation.

The Elliott-Jacob combination also does not meet this claim limitation. The Petition maps limitation [1.e] to Jacob's assurance from the service provider that advertisements will be delivered, which also is responsive to a different request—one relating to subscriptions or advertising analytics. EX-1005, [0026] (“In an embodiment in which the service provider offers a subscription service...the service provider can provide some assurance to prospective advertisers that their advertisements will be delivered to preferred recipients by matching certain of an advertiser's advertisement attributes, stored by the service provider, to particular subscribers' stored preferences or by using subscriber demographic data, which can also be provided to the prospective advertisers by the publisher”).

The Petition does not identify any disclosure in Elliott or Jacob of a response that is provided to the sponsor in reply (directly or indirectly) to a *request to obtain an interest in a geographic area*, as required by the claim. The reliance

on post-delivery analytics or billing communications is insufficient and does not satisfy the claim language. The Petition's failure to identify a specific, sponsor-directed response to the claimed request demonstrates that the Elliott-Jacob obviousness Ground fails for this reason also.

VII. ALL GROUNDS: THE PETITION PRESENTS NO THEORY ON HOW TO COMBINE THE PRIOR ART NOR DOES IT ADDRESS THE INCONSISTENCIES IN THE PRIOR ART THAT HINDER THE PROPOSED COMBINATION.

The Petition's rationale that the proposed combination is a "simple addition of one known element (Jacob's geographic location advertisement) with other similar elements (e.g., Elliott's targeting information) to obtain predictable results" (Pet., 14; EX-1002, ¶102) is conclusory and unsupported by the cited evidence. The Petition provides no explanation as to *how* a POSITA would combine the teachings of Jacob into the advertising system and method of Elliott, nor does it address the fundamental incompatibility between the references. Without such an explanation, the Petition does not present any obviousness ground that satisfies the particularity requirement. *See* 35 U.S.C. § 312(a)(3); *Intelligent Bio-Sys.*, 821 F.3d at 1369 ("It is of the utmost importance that petitioners in the IPR proceedings

adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’”).

This lack of explanation is unsurprising given the prior art’s incompatibilities. The Petition does not explain how the data structures, workflows, or system logic of Elliott and Jacob would be integrated, nor does it address potential conflicts or incompatibilities of combining them. The Petition fails to address multiple technical and operational differences between Elliott’s advertising system and Jacob’s location-based system, such as how reservations, exclusivity, and application program types would be managed in a combined system.

Rather than addressing incompatibilities with the prior art, the Petition provides a conclusory statement the references “could” be combined into a single system:

If PO argues the portions of Elliott or Jacob cited below relate to different incompatible embodiments (they do not), it would have been obvious to a POSITA to combine such embodiments into a single system for providing the ability to deliver advertisements at least because such embodiments are described in the same prior art

reference, are fully compatible with each other, and *could* be combined with minimal effort to achieve predictable results.

Pet., 14-15 (emphasis added). The Federal Circuit has held that “conclusory statements alone are insufficient and, instead, the finding must be supported by a reasoned explanation.” *In re Nuvasive, Inc.*, 842 F.3d 1376, 1383 (Fed. Cir. 2016). The Petition’s assertion of a “simple substitution” is not supported by the references and does not satisfy the requirement for a reasoned motivation to combine. *See KSR*, 550 U.S. at 418 (“A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning.”).

A. The Petition fails to explain how or why a POSITA would combine the prior art without hindsight and presents a convoluted implementation requiring three disparate references.

The Petition’s approach to combining Elliott, Jacob, and Musk is a textbook example of impermissible hindsight. Rather than providing a reasoned explanation for why a POSITA would have been motivated to combine these references, the Petition assembles elements from each reference merely to match the claim limitations, using the claims as a blueprint. The Petition first combines Elliott and Jacob to purportedly address location-based targeting, then adds Musk to supply

the “accelerated radius search” feature. Pet., 61-62. However, the Petition does not explain how these disparate systems would be integrated, how their functionalities would interact, or how a POSITA would have arrived at the claimed invention without knowledge of the claims themselves.

For example, Elliott and Jacob demonstrate being at odds, yet the Petition does not address this or explain how or why a POSITA would combine the two and still satisfy their intended purpose. A reading of Elliott reveals that it repeatedly emphasizes privacy-preserving aspects of its system: “there is a need in the art for a convenient way to allow potential customers to respond to advertisements provided on a mobile device while maintaining anonymity” and “[i]n accordance with the present invention, advertisements are provided to a mobile device user in such a way as to allow the user to obtain further information from advertisers without revealing the user’s identity to the advertisers”. EX1004, [0008], [0009]. Notably, Elliott does not discuss any form of geographic or location-based targeting, and it makes no mention of any benefits for demographic targeting. Elliott’s system is built around the delivery of advertisements to mobile subscribers based on (1) “the advertiser’s specified target demographic” and (2) “the subscriber’s indicated preferences for advertisements.” *Id.*, [0017]. Elliott hardly

discusses the former (mentioning “demographic” only three times), while it significantly focuses on the latter (devoting, for example, [0017], [0021], and [0023] to subscriber preferences). Elliott also emphasizes the value of subscriber-driven selection: “In one embodiment, advertisements are selected for a subscriber based in part on advertisements to which the subscriber has previously responded...” EX1004, [0017]. Thus, a POSITA reading Elliott would be motivated to preserve these privacy, anonymity, and subscriber-driven features of Elliott's system.

Jacob, by contrast, emphasizes advertisers knowing an individual's information and preferences to increase the impact of targeting:

Individualization of content tailored to the expressed preferences of a person has led to the individualization of advertising also tailored to the expressed preferences (and the inferred preferences) of the person. Catalog retailers have known of and exploited lists of persons whose Shopping habits have been collated into a profile favorably disposed to the products being offered by the catalog retailer. A person on the list will receive an unsolicited catalog. *Advertisers alert to the possibilities of the Internet use the same methods to target potential*

purchasers, but the collection and sorting of names and preferences can now be accomplished more quickly and accurately. It should be noted that much of this collection of preferences is not meant to be devious or with ill will....

EX1005, [0003] (emphasis added). Elliott and Jacob are therefore at odds, and the result of the combination renders the privacy-preserving aspects of Elliott's system inoperable, and likewise, the prior art unsatisfactory for its intended purpose.

Moreover, the Petition does not explain how the proposal to modify Elliott based on Jacob could maintain and preserve a user's anonymity. There is accordingly no suggestion or motivation to combine the prior art. *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984) (holding that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification). Thus, the only reason a POSITA would have proceeded in such a manner is by using the '296 Patent as a template for their own reconstruction, which is inappropriate. *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570 (Fed. Cir. 1996) ("To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the

invention as a template for its own reconstruction—an illogical and inappropriate process by which to determine patentability”).

The Petition's rationale is further undermined by the fact that Musk is directed to a search system for geographic entities, not to content delivery, advertising, or reservation systems. Pet., 61; EX-1007, 1:14–17. The Petition's reliance on the mere existence of similar elements in the prior art, without a specific, articulated reason for combining them in the manner required by the claims, is insufficient. As the Federal Circuit has held, “it is critical that the claimed invention ‘be viewed not with the blueprint drawn by the inventor.’” *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138 (Fed. Cir. 1985) (citation omitted). The Petition's hindsight-driven assembly of Elliott, Jacob, and Musk, without a reasoned motivation to combine and without addressing the technical challenges of integration, fails to meet the legal standard for obviousness. *See also Raytheon Techs. Corp. v. Gen. Elec. Co.*, 993 F.3d 1374, 1380 (Fed. Cir. 2021) (“To render a claim obvious, the prior art, taken as a whole, must enable a skilled artisan to make and use the claimed invention.”).

In sum, the alleged motivations to combine Elliott, Jacob, and Musk identified in the Petition are conclusory, unsupported by the cited evidence, and

rely on impermissible hindsight. The Petition fails to provide a sufficient reason why a POSITA would have been motivated to make the proposed combinations and does not explain how the prior art could be combined to arrive at the claimed invention. This deficiency is fatal to the Petition's obviousness grounds.

VIII. CONCLUSION

For the above reasons, the Board should decline to institute *inter partes* review.

Dated: August 19, 2025

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CERTIFICATE OF COMPLIANCE

The undersigned certifies that this response complies with the word-count limitations of 37 C.F.R. § 42.24(b)(1). This response contains 8,505 words as calculated by the word-count feature of Microsoft Word, the word-processing program used to create it.

The undersigned further certifies that this Petition complies with the typeface requirements of 37 C.F.R. § 42.6(a)(2)(ii) and typestyle requirements of 37 C.F.R. § 42.6(a)(2)(iii). This petition has been prepared in a proportionally spaced typeface using Microsoft Word in Times New Roman 14-point font.

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CERTIFICATE OF SERVICE

I hereby certify that on this 19th day of August, 2025, I caused to be served a true and correct copy of the foregoing "Patent Owner's Preliminary Response" and accompanying exhibits by electronic mail on the following:

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