

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
Patent 8,433,296 B2

Before JAMESON LEE, SCOTT C. MOORE, and LISA A. MURRAY,
Administrative Patent Judges.

MURRAY, *Administrative Patent Judge.*

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. *Background and Summary*

Home Depot U.S.A., Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–15 of U.S. Patent No. 8,433,296 B2. Paper 1 (“Pet.”); Ex. 1001 (“the ’296 Patent”). H2 Intellect LLC (“Patent Owner”) filed a Preliminary Response.¹ Paper 8 (“Prelim. Resp.”). Petitioner filed a Reply to Patent Owner’s Preliminary Response (Paper 13), and Patent Owner filed a Sur-Reply (Paper 14).

We may institute an *inter partes* review when “the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). If we institute an *inter partes* review, the trial must encompass all claims and grounds identified in the Petition. 37 C.F.R. § 42.108(a) (2025) (“When instituting *inter partes* review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.”).

Upon consideration of the evidence and arguments in the Petition (including its supporting testimonial evidence) as well as the evidence and arguments in the Preliminary Response, the Preliminary Reply, and the Preliminary Sur-Reply, we determine that the information presented does

¹ Patent Owner also filed a Request for Discretionary Denial (Paper 6) and a Reply Discretionary Denial Brief (Paper 9). Petitioner filed an Opposition to Patent Owner’s Request for Discretionary Denial (Paper 7) and a Sur-Reply in Opposition to Patent Owner’s Request for Discretionary Denial (Paper 10). The Acting Director issued an Order denying Patent Owner’s Request for Discretionary Denial. Paper 11.

not show a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims of the '296 Patent. We thus determine not to institute an *inter partes* review of any of the challenged claims on any of the grounds alleged in the Petition.

B. Real Parties in Interest

Petitioner identifies Home Depot U.S.A., Inc., Home Depot Product Authority, LLC, and The Home Depot, Inc. as real parties in interest.

Pet. 68. Patent Owner identifies H2 Intellect LLC as a real party in interest. Paper 12, 2.

C. Related Matters

The parties identify *H2 Intellect LLC v. The Home Depot, Inc., Home Depot U.S.A, Inc., and Home Depot Product Authority, LLC*, Civil Action No. 2:24-CV-00694-JRG-RSP (EDTX) as involving the '296 Patent. Pet. 68; Paper 12, 2 (Patent Owner's Updated Mandatory Notices). Patent Owner notes that Petitioner filed a Petition in PGR2025-00047 against another patent (U.S. Patent No. 12,056,736) held by Patent Owner, and indicates that that proceeding has been terminated. Paper 12, 2.

D. The '296 Patent

The '296 Patent, titled "Exclusive Delivery of Content Within Geographic Areas," issued on April 30, 2013, from an application filed on Nov. 4, 2010. Patent Owner claims, and Petitioner does not dispute, an effective priority date of March 11, 2008. *See* Pet. 1. The purpose of the '296 invention is to provide content to a mobile device based on location. Specifically, a registered application running on a mobile device with a target location contained within a geographic area assigned to a particular sponsor will receive content related to that sponsor. Ex. 1001, Abstr.

E. Challenged Claims

Petitioner challenges claims 1–15 of the '296 Patent. Claims 1, 6, and 11 are independent claims. Claim 1, reproduced below with Petitioner's bracketed identifiers and formatting added (*see* Pet. xi–xv), is representative.

[1.pre] A method comprising:

[1.a] *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;

[1.b] *establishing a plurality of perimeters* defining a plurality of geographic areas;

[1.c] reserving delivery of content from a plurality of sponsors to the plurality of registered application programs on the basis of both a geographic area and an application program type associated with each of the plurality of registered application programs;

[1.d] *receiving, from a sponsor, a request to obtain an interest* in a selected one of the plurality of geographic areas;

[1.e] *providing the sponsor a response to the request*;

[1.f] storing a record of the interest in the selected one of the plurality of geographic areas;

[1.g] receiving, from the sponsor, content to be delivered to registered application programs having target locations contained within the selected one of the plurality of geographic areas;

[1.h] receiving, from a registered application program, a request for content to be used within the registered application program;

[1.i] in response to receiving the request: selecting content from at least one sponsor to be delivered to the registered application program, subject to the reserving; and

[1.j] [in response to receiving the request: . . .] providing the content from the at least one sponsor to the registered application program.

Ex. 1001, 13:43–14:5 (*emphases* added to disputed limitations).

F. Asserted Grounds

Petitioner asserts the following grounds of unpatentability for the challenged claims:

Ground	Claims Challenged	35 U.S.C. § ²	Reference(s)/Basis
1	1–3, 5–8, 10–13, 15	103(a)	Elliott, ³ Jacob ⁴
2	4, 9, 14	103(a)	Elliott, Jacob, Musk ⁵

Pet. 1. Petitioner also relies on a Declaration of David H. Williams in support of the Petition. Ex. 1002. Patent Owner relies on a Declaration of Scott Denning in support of the Preliminary Response. Ex. 2028.

II. ANALYSIS

A. Level of Ordinary Skill in the Art

Determining whether an invention would have been obvious under 35 U.S.C. § 103 requires resolving the level of ordinary skill in the pertinent

² The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. § 103 that became effective on March 16, 2013. Because the application from which the ’296 Patent claims priority was filed before this date, the pre-AIA version of § 103 applies. *See* Ex. 1001, codes (22), (65).

³ U.S. Patent Appl. Pub. No. 2006/0149630 A1, filed Nov. 16, 2005, published July 6, 2006 (Ex. 1004).

⁴ U.S. Patent Appl. Pub. No. 2002/0161633 A1, filed Apr. 27, 2001, published Oct. 31, 2002 (Ex. 1005).

⁵ U.S. Patent No. 6,108,650, issued Aug. 22, 2000 (Ex. 1007).

art at the time the invention was made. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). The level of skill in the art is “a prism or lens” through which we view the prior art and the claimed invention. *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001). The person of ordinary skill in the art is a hypothetical person who knows the relevant art. *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995). Factors in determining the level of ordinary skill in the art include the types of problems encountered in the art, the sophistication of the technology, and educational level of active workers in the field. *Id.* One or more factors may predominate. *Id.*

Petitioner contends that a person of ordinary skill in the art in March 11, 2008 (a “POSITA”) would have had:

a Bachelors’ degree in electrical or computer science or a comparable field of study, plus at least three years of professional experience in advertisement delivery systems or other relevant industry experience. Additional graduate education could substitute for professional experience, and significant experience in the field could substitute for formal education.

Pet. 3; Ex. 1002 ¶ 79. Patent Owner does not offer a competing formulation, stating that “[f]or purposes of this preliminary response only, Patent Owner applies the same skill level proposed by Petitioner.” Prelim. Resp. 12.

We find Petitioner’s formulation to be consistent with the evidence of record at this stage of the proceeding, including the asserted prior art and the ’296 Patent, and, accordingly, we adopt and apply that definition for purposes of this Decision.

B. Claim Construction

We interpret claims in the same manner used “in a civil action under 35 U.S.C. § 282(b), including construing the claim in accordance with the

ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b). When applying that standard, we interpret the claim language as it would have been understood by one of ordinary skill in the art in light of the specification. *Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, 1279–80 (Fed. Cir. 2017). Thus, we give claim terms their ordinary and customary meaning as understood by an ordinarily skilled artisan. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc).

Petitioner proposes constructions for a number of claim terms, including: “reserving”; “subject to the reserving”; “a request to obtain an interest”; “the plurality of registered application programs are each associated with at least one application program type”; “registering”; “providing the sponsor a response to the request”; and “recording a request identifier associated with the request.” Pet. 4–8. Patent Owner states that it “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).”⁶ Prelim. Resp. 12.

After reviewing the parties’ arguments and evidence, we determine that no express constructions of the terms identified by Petitioner are needed

⁶ For the term “recording a request identifier associated with the request,” Petitioner asserts that it is unclear which “request” is at issue, Pet. 7–8, while Patent Owner argues that “the ‘request’ refers to the ‘request for content to be used within the registered application program’ as described in claim element 1.h.” Prelim. Resp. 13. For the reasons discussed below, we determine that it is not necessary for us to construe this term for purposes of this Decision.

for us to render our Decision on Institution. *See, e.g., Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“[W]e need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy.’”) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

C. Obviousness under 35 U.S.C. § 103

An invention is not patentable under the pre-AIA statute “if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103 (pre-AIA). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and, (4) where in evidence, so-called secondary considerations, including commercial success, long-felt but unsolved needs, and failure of others.⁷ *Graham*, 383 U.S. at 17–18.

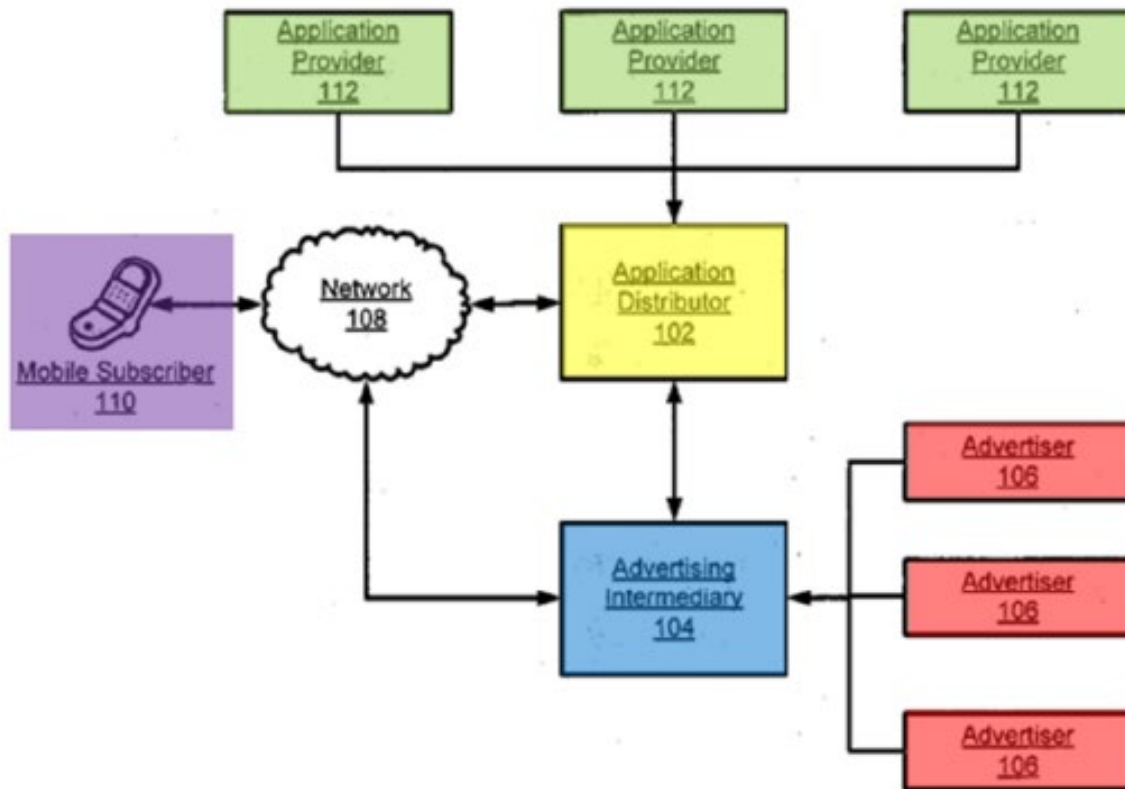
When evaluating a combination of teachings, we must also “determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

⁷ At this stage of the proceeding, neither party has directed us to evidence of such secondary considerations.

1. Overview of the Prior Art

a) Elliott (Ex. 1004)

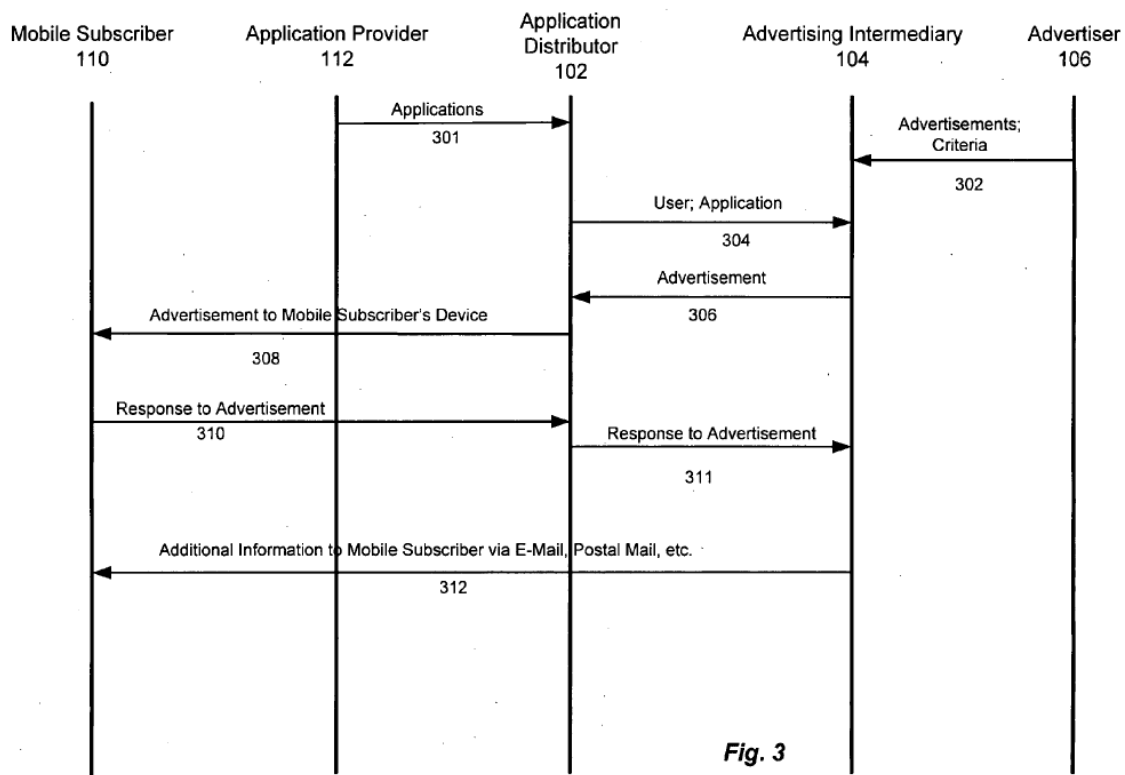
Elliott relates to systems and methods for delivering advertisements to mobile devices. Ex. 1004 ¶¶ 3, 9. Figure 1 of Elliott, as annotated by Petitioner, is reproduced below.



Pet. 9. Elliott Figure 1 is a block diagram depicting the overall architecture of Elliott's advertising delivery system. Ex. 1004 ¶ 10. Figure 1 includes a plurality of advertisers 106, shown in red, each of which provides advertisements to advertising intermediary 104, shown in blue. *See id.* ¶ 13. Advertising intermediary 104 in turn provides the advertisements to an application distributor 102, shown in yellow. *Id.* Application distributor 102 also receives mobile applications from a plurality of application providers 112, shown in green. *Id.* Application distributor 102 in turn distributes both

applications and advertisements over a network 108, shown in white, to a mobile device 110, shown in purple. *Id.*

The purpose of this system is to provide advertisements to mobile device users in a manner allowing the users to obtain further information about the advertisement without revealing the users' identity to the advertisers. Ex. 1004 ¶ 9. Advertising intermediary 104 maintains advertisements in a database and also maintains a second database of mobile device users who subscribe to its service. *Id.* ¶ 9, Fig. 2. To demonstrate Elliott's system and method for distributing those advertisements to the mobile device users, Elliott Figure 3 is reproduced below.



Elliott Figure 3 is an interaction diagram illustrating the flow of information among the various entities in the Elliott system. Ex. 1004 ¶ 12. Arrows indicate the flow of information from one entity to another. The timing of

each information transfer is shown by the location of the arrow in the diagram; transfers occur in order from top to bottom of the diagram.

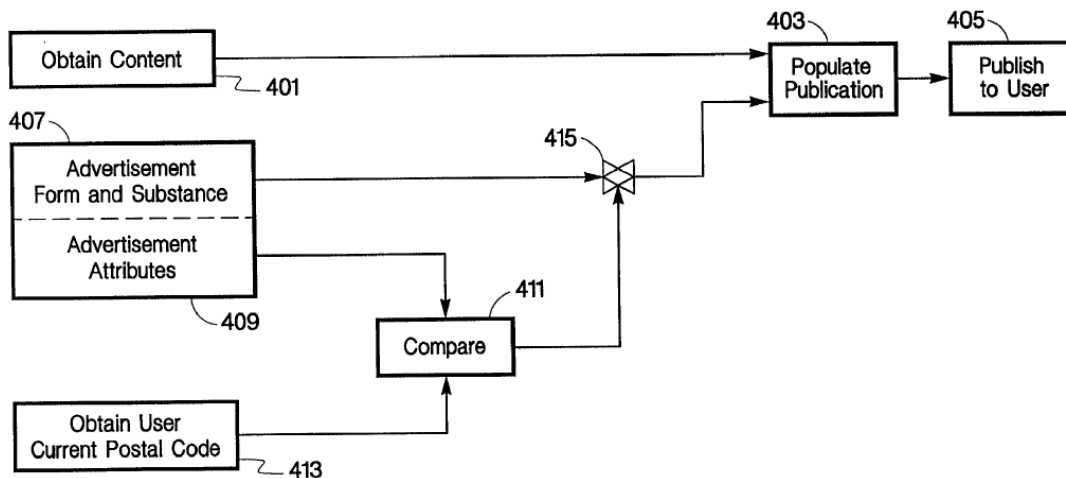
As shown in Figure 3, application providers provide mobile applications that have hooks for displaying advertisements to application distributor 102, while advertisers provide advertisements and targeting criteria to advertising intermediary 104. *Id.* ¶¶ 9, 27, Fig. 3. Application distributor 102 integrates advertisements obtained from advertising intermediary 104 into the applications and application content that it distributes to mobile subscribers 110. *Id.* ¶ 9, Fig. 3. If a subscriber indicates an interest in receiving additional information, e.g., by selecting a link provided as part of the advertisement, an indication of this interest is sent to advertising intermediary 104. *Id.* Advertising intermediary 104 then forwards additional information provided by the advertiser to the mobile subscriber 110, without the advertiser ever needing to obtain the subscriber's name or contact information. *Id.* ¶¶ 9, 28, Fig. 3.

b) Jacob (Ex. 1005)

While Elliott refers to advertising “targeting data,” Ex. 1004 ¶ 27, it does not expressly mention targeting advertisements based on location or geographic areas. *See* Prelim. Resp. 10. Petitioner relies on Jacob to teach that aspect of the claimed invention. Pet. 11–13.

Jacob discloses an advertising system based on a user's location, such that advertisements delivered to a device away from its home area are different from those delivered when the device is at home. Ex. 1005, Abstr., ¶ 4. Location is defined by postal (ZIP) code area. *Id.* ¶ 22 (“In order to reduce the complexity of the communications unit, conversion of the communications units reported position . . . to postal (ZIP) code areas [is]

performed . . . using conventional transformation algorithms by the service provider’s server.”). Figure 4 of Jacob is reproduced below.



Ex. 1005, Fig. 4. Figure 4 is a logic flow diagram of a publication assembly process that may be employed to deliver location-significant advertising. *Id.* code (54), ¶ 9. At step 401, content requested by the user is obtained. *Id.* ¶ 29. At 413, a current location is determined for the user’s device. *Id.* At 411, the location attribute of an advertisement 407 is compared to the user’s current location 413 to determine if there is a match. *Id.* Once a match is found, “[t]he publication is populated, at 403, with the content obtained, at 401, and the advertisement form and substance 407[,]” and the publication is then published to the user at 405. *Id.* ¶¶ 29–30.

c) Musk (Ex. 1007)

Musk is directed to a computerized search system for “finding geographic entities such as an address, street, area, point, business, or list of cities that are located near a given starting point.” Ex. 1007, 1:14–17. Specifically, it performs an “accelerated radius search” using a “locations database.” *Id.* at 1:5–7, 4:57–58. A search category is built having a density value corresponding to a geographic area. The density factor is a function of

a given geographic region such as state, city, or zip code. *Id.* at 2:26–30. If a first search radius returns an insufficient number of results, a larger search radius is generated and a new search is performed. *Id.* at 2:32–36. The process repeats until there is a sufficient number of search results. *Id.* Abstr.

2. *Ground 1: Obviousness of Claims 1–3, 5–8, 10–13, and 15 Under 35 U.S.C. § 103(a) Over Elliott and Jacob*

Petitioner asserts that claims 1–3, 5–8, 10–13, and 15 are unpatentable as obvious over the combination of Elliott and Jacob. Pet. 9–60. Patent Owner contests Petitioner’s mapping of the cited prior art to four limitations in independent claim 1 (and the commensurate limitations in independent claims 6 and 11): limitations [1.a], [1.b], [1.d], and [1.e]. Prelim. Resp. 14–39. Patent Owner also argues that one of ordinary skill in the art would not have been motivated to modify Elliott with the teachings of Jacob. *Id.* at 39–46. We agree with Patent Owner that the proposed combination does not teach or suggest elements [1.a] and [1.e], for the reasons discussed below. Because the absence of these two elements from the cited prior art is a sufficient basis for denying institution, we do not address Patent Owner’s remaining arguments.

a) *[1.e] “providing the sponsor a response to the request”*

Our decision not to institute an *inter partes* review is based primarily on our determination, based on the evidence presently before us, that the Elliott/Jacob combination does not teach or suggest limitation [1.e], “providing the sponsor a response to the request[.]” Petitioner contends that Elliott discloses this limitation, either alone or in combination with Jacob. Pet. 29–31. Patent Owner disagrees, contending that “[t]he Petition attempts

to map this limitation to communications which are not found in the prior art.” Prelim. Resp. 35. We are persuaded by Patent Owner’s arguments.

Petitioner first contends that Elliott alone discloses “advertiser 106 . . . receiving a response from advertising intermediary 104 after the reservation request from the sponsor, such as when 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; *see* Ex. 1004 ¶ 24 (“the response rate based on e-mails sent to mobile subscribers . . . can be used, for example, to adjust the amount charged to a particular advertiser 106.”). According to Petitioner, a message from the advertising intermediary that includes the response rate is a response to the sponsor’s request to obtain an interest that is described in limitation [1.d]. Pet. 30.

Petitioner also argues that the Elliott/Jacob combination renders limitation [1.e] obvious because “Jacob discloses the advertiser receiving a response to the request.” Pet. 30. Petitioner refers to paragraph 26 of Jacob, which describes that

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 . . . to particular subscribers’ stored preferences or . . . demographic data, which can also be provided to the prospective advertisers by the publisher.

Ex. 1005 ¶ 26.

Regarding Petitioner’s first argument, Patent Owner responds that 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.” Prelim. Resp. 35 (quoting Ex. 1004, ¶ 24). Patent Owner contends that there is no “message communicating the response rate” to an advertiser in Elliott. *Id.* at 36. This is shown in the information flow diagram in Elliott Figure 3, which shows *no* flow of information from advertising intermediary 104 to advertiser 106. *Id.*; *see* Ex. 1004, Fig. 3 (no arrow pointing to advertiser *from* advertising intermediary; arrow 302 flows from advertiser *to* advertising intermediary).

Patent Owner further argues that even if there were a “message communicating the response rate” in Elliott, that message “would not be a *response* to the ‘request to obtain an interest in a selected one of the plurality of geographic areas.’” Prelim. Resp. 37 (emphasis added). It would be a separate, later communication for the purpose of charging the advertiser. *Id.* Similarly, “Jacob’s assurance from the service provider that advertisements will be delivered . . . also is responsive to a different request—one relating to subscriptions or advertising analytics.” *Id.* at 38; *see* Ex. 1005 ¶ 26. Patent Owner concludes that the Petition fails to identify any specific communication from advertising intermediary to sponsor in response to the claimed request. Prelim. Resp. 39.

We find Patent Owner’s arguments convincing. Figure 3 of Elliott and the accompanying explanation appear to indicate that in Elliott the advertising intermediary does *not* respond to the advertiser’s communication sending “advertis[ing] and targeting data[.]” *See* Ex. 1004, Fig. 3, ¶¶ 27–28. Moreover, the passage in Jacob that Petitioner cites describes a sales-type communication from the advertising intermediary to the advertiser, which would be just as likely to occur *before* the advertiser requests to obtain an interest in a selected one of a plurality of geographic areas. The purpose of

that communication is to convince the advertiser that the intermediary's future services would be worthwhile. Ex. 1005 ¶ 26 (“the service provider can provide some assurance to *prospective* advertisers”) (emphasis added). It is not a response to a sponsor's request for a reservation. Accordingly, Petitioner's arguments do not show that the Elliott/Jacob combination discloses limitation [1.e].

b) [1.a] “registering a plurality of application programs”

Even if the Elliott/Jacob combination did disclose limitation [1.e], we would still decline to institute an *inter partes* review because we are persuaded that the combination does not teach or suggest limitation [1.a].

Petitioner asserts that Elliott discloses limitation [1.a], “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[.]” Pet. 15–20. Patent Owner contends that “neither Elliott nor Jacob disclose any ‘registering’ . . . of application programs” and that “[t]he Petition's mapping of the ‘associated with at least one application program type’ term is equally unsupported and speculative.”⁸ Prelim. Resp. 14–18. We agree with Patent Owner for the following reasons.

First, we conclude that Elliott does not disclose “registering a plurality of application programs.” Petitioner argues that “a POSITA would have understood ‘registering’ to mean something 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. For

⁸ Petitioner does not argue that Jacob discloses any portion of this limitation.

support, Petitioner cites to the following passage from the Specification of the '296 Patent: “registering the application program with content delivery platform 112 allows developer 108 to receive revenue from sponsor[s] . . . for content displayed on a mobile device located within, or in proximity to, a geographical area reserved by one or more of the sponsors.” *Id.* at 6; Ex. 1001, 3:1–10; *see* Ex. 1002 ¶ 85.

As discussed above, Patent Owner has agreed to adopt Petitioner’s proposed constructions for the purpose of these preliminary proceedings. Prelim. Resp. 12. In Patent Owner’s view, however, Petitioner’s argument fails even under Petitioner’s proposed construction because “neither Elliott nor Jacob disclose any ‘registering,’ much less ‘enrolling,’ of application programs.” Prelim. Resp. 16. Rather, Elliott teaches only that “[a]pplication distributor 102 . . . *distributes* both applications and advertisements over a network 108 to a mobile device 110[.]” Ex. 1004 ¶ 13 (emphasis added). We agree with Patent Owner that “[d]istributing’ is not registering or enrolling.” Prelim. Resp. 16. Elliott does not disclose “recording identifying information for the application” or “tracking the usage of the application” and therefore does not “register” application programs under Petitioner’s proposed construction.

Second, we are not persuaded by Petitioner’s argument that tracking application usage is implied in Elliott because “the application provider receives revenue from sponsors . . . based on advertising provided to mobile applications via a content delivery platform[.]” Pet. 17; *see* Ex. 1004 ¶ 18 (“In one embodiment, 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”). In Petitioner’s view, one of ordinary skill in the art would have

understood that Elliott’s mobile applications *must* be registered with the application provider in order to “enable the provision of revenue to the application provider.” Pet. 17; *see* Ex. 1002 ¶¶ 108–109 (“Elliott discloses that the application provider receives revenue from sponsors . . . which indicates that the mobile application was registered or enrolled . . . to enable the provision of revenue to the application provider.”). Patent Owner responds that registration is not necessary for revenue distribution. Prelim. Resp. 17 (“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.”). We agree. As long as an application distributor knows who an application provider is and how many times it has distributed one of that provider’s applications, it does not *necessarily* need to keep a registry of the applications supplied to calculate the advertising revenue due to the provider. Accordingly, the fact that Elliott discloses revenue sharing does not mean that it inherently discloses “registering a plurality of application programs.”

Finally, we conclude that Elliott does not disclose that “the plurality of registered application programs are each associated with at least one application program type.” Petitioner relies on Elliott’s statement that “[m]any types of mobile applications exist, including games, shopping applications, social networking applications, mapping applications, etc.” Pet. 18; Ex. 1004 ¶ 18. Petitioner also argues that a “POSITA would have understood it was well-known that different *application programs* would have been *associated with application program types*.” Pet. 18; Ex. 1002 ¶ 110; *see* Ex. 1011 ¶ 99. Patent Owner is correct that these broad statements are not a disclosure that *each* of the plurality of registered applications in

Elliott is “associated with at least one application program type,” as claim 1 requires. *See* Prelim. Resp. 18.

c) Summary

We may institute an *inter partes* review when “the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). We have determined that, at this stage of the proceeding and on the present record, the information presented in the Petition does not show that Petitioner is reasonably likely to prevail with respect to its challenge to claim 1 based on the combination of Elliott and Jacob. Specifically, the Petition does not demonstrate that the proposed Elliott/Jacob combination would teach or suggest either limitation [1.e] or limitation [1.a] of independent claim 1. For the same reasons, the Elliott/Jacob combination does not teach or suggest the commensurate limitations in independent claims 6 and 11. *Compare* Ex. 1001, 13:42–14:5, 14:31–15:5, 15:38–16:21.

Patent Owner does not present any additional arguments regarding dependent claims 2, 3, 5, 7, 8, 10, 12, 13, and 15, which are related to Petitioner’s Ground 1. However, claims 2, 3, and 5 depend from claim 1, either directly or indirectly, and therefore incorporate limitations [1.a] and [1.e]. Ex. 1001, 13:42–14:30. Similarly, claims 7, 8, and 10 depend from claim 6, while claims 12, 13, and 15 depend from claim 11, and therefore these dependent claims also incorporate limitations not taught by the combination of Elliott and Jacob. *Id.* at 15:6–16:51. Consequently, we conclude that Petitioner is not reasonably likely to prevail with respect to its challenge to any of claims 1–3, 5–8, 10–13, and 15 of the ’296 Patent.

3. *Ground 2: Obviousness of Claims 4, 9, and 14 Under 35 U.S.C. § 103(a) Over Elliott, Jacob, and Musk*

In Ground 2, Petitioner asserts that claims 4, 9, and 14 are obvious and unpatentable based on Elliott, Jacob, and Musk. Pet. 60–67. These claims depend from claims 1, 6, and 11, respectively, and incorporate each limitation of their respective independent claims. As discussed above, we have determined that the evidence before us does not establish a reasonable likelihood that Petitioner would prevail with respect to its Ground 1 challenge to claims 1, 6, or 11. Petitioner does not contend that Musk teaches or suggests limitations [1.a] or [1.e], or the commensurate limitations of claims 6 and 11. Thus, as applied by Petitioner, Musk does not cure the deficiencies discussed above with respect to independent claims 1, 6, and 11, or with respect to challenged claims depending therefrom. Consequently, we conclude that Petitioner is not reasonably likely to prevail with respect to its challenge to any of claims 4, 9, and 14 of the '296 Patent.

III. CONCLUSION

For the reasons discussed above, Petitioner has not shown a reasonable likelihood that it will succeed in demonstrating that claims 1–15 of the '296 Patent are unpatentable under 35 U.S.C. § 103(a). We thus determine not to institute an *inter partes* review of any of the challenged claims on any of the grounds alleged in the Petition. 35 U.S.C. § 314(a); 37 C.F.R. § 42.108(a).

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is denied as to all challenged claims of the '296 Patent.

IPR2025-00480
Patent 8,433,296 B2

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