

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC., AMAZON WEB SERVICES, INC.,
and AMAZON.COM SERVICES LLC,
Petitioner,

v.

DATONICS, LLC,
Patent Owner.

Case IPR2025-00873
Patent 10,984,445

PATENT OWNER'S RESPONSE

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Patent Owner's Exhibit List for IPR2025-00873

Pursuant to 37 C.F.R. § 42.63(e), Patent Owner Datonics, LLC hereby submits its exhibit list associated with the above-captioned *inter partes* review of U.S. Patent No. 10,984,445.

Exhibit No.	Description
2001	Declaration of Erik de la Iglesia in support of Patent Owner's Response ("de la Iglesia Decl.")
2002	<i>Curriculum vitae</i> of Erik de la Iglesia
2003	February 5, 2026 deposition transcript of Henry Houh, Ph.D.
2004	June 12, 2024 Testimony from Kevin O'Connor in the trial of <i>AlmondNet, Inc. v. Amazon.com, Inc.</i> , 6:21-cv-898 (W.D. Tex.)
2005	Defendant's Exhibit 120 in <i>AlmondNet, Inc. v. Amazon.com, Inc.</i> , 6:21-cv-898 (W.D. Tex.) (the "Merriman" reference)
2006	Defendant's Exhibit 404 in <i>AlmondNet, Inc. v. Amazon.com, Inc.</i> , 6:21-cv-898 (W.D. Tex.) ("DoubleClick Products" archived webpage), <i>available at</i> https://web.archive.org/web/20000815063534/http://www.doubleclick.net:8080/company_info/about_doubleclick/products.htm
2007	Defendant's Exhibit 399 in <i>AlmondNet, Inc. v. Amazon.com, Inc.</i> , 6:21-cv-898 (W.D. Tex.) ("DoubleClick Network" archived webpage), <i>available at</i> https://web.archive.org/web/20000815223252/http://www.doubleclick.net:8080/publishers/network/
2008	Plaintiff's Exhibit PTX-098 in <i>AlmondNet, Inc. v. Amazon.com, Inc.</i> , 6:21-cv-898 (W.D. Tex.) (November 8, 1999 "Public Workshop on Online Profiling" transcript), <i>available at</i> https://www.ftc.gov/sites/default/files/documents/public_events/online-profiling-public-workshop/online.pdf

2009	Defendant's Exhibit 607 in <i>AlmondNet, Inc. v. Amazon.com, Inc.</i> , 6:21-cv-898 (W.D. Tex.) (DoubleClick website's "Affiliate Web Site FAQs" page)
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I. Introduction

Amazon's challenge to the sole independent claim of the '445 Patent is based on Gilmour as the primary reference.

Amazon acknowledges that Gilmour does not disclose (and the Board previously found that Gilmour does not disclose) a key aspect of the claims. *See* Pet. 47 (addressing "the Board's analysis in the '052 application"). There, the Board found that "[i]t is not apparent... how one of ordinary skill in the art would have known to cause [Gilmour's] policy to be 'based on a comparison of (A) profile information about a visitor..., with (B) a plurality of stored requests [for that profile information] from the plurality of media property entities,'" which comparison is used to provide the correct profile information to the requesting entities. Ex. 1009, 565; *see also* Pet. 42 ("Gilmour... does not disclose that the profile owner computer automatically selects a media property entity of a plurality of media property entities based on a comparison of the profile information with a plurality of stored requests from the plurality of media property entities.").

Amazon attempts to cure this deficiency of Gilmour by purporting to combine Gilmour with, *inter alia*, Frauenhofer. But Frauenhofer is not even prior art, because it is not in the same field of endeavor as the '445 Patent and is not reasonably pertinent to the problems faced by the inventor of the '445 Patent. Additionally, *even*

Frauenhofer does not involve “a comparison of (A) profile information about a visitor... with (B) a plurality of stored request from the plurality of media property entities”—the very aspect the Board found missing from Gilmour. *See* Ex. 1009. Instead, *Frauenhofer* discloses the *different* concept of comparing categories of *documents* with user profile information, and provides the correct documents to the correct users based on that comparison. Thus, even if *Frauenhofer* *were* prior art and *Frauenhofer*’s teachings were combined into Gilmour, the combination would still not remedy the deficiency of Gilmour recognized by the Board.

Amazon also relies on Gilmour in combination with Merriman, but that aspect of the combination is also deficient for several reasons. For instance, the Petition fails to explain why an ad server in Merriman (which a POSITA would have understood *receives payment* for receiving and use profile information) would coordinate with Gilmour’s system and *send payment* to that system for the same profile information it already has access to. The Petition also proposes that Gilmour’s system would make use of Merriman’s “spotlight tags,” but those tags do not have the capability of providing profile information in response to matching operations (the functionality they would need to have in the proposed combination), and the Petition does not explain how this modification to Merriman’s spotlight tags would have been obvious or even within the skill of a POSITA.

Accordingly, all challenged claims should be found not unpatentable.

II. Background of the '445 Patent

The challenged claims of the '445 Patent (claims 1-14) are directed to systems and methods for, e.g., causing delivery of electronic advertisements based on profile information received through particular means. The invention, at a high level, allows media properties to “better monetize their low-value ad space by selling ads based on the [received] profiles,” which allows for them to “mak[e] a payment for the profiles to the profile owners who provided the profiles.” Ex. 1001, 6:63–7:4.

Claim 1 is the sole independent claim, and recites:

1. A method of causing delivery of electronic advertisements based on provided profiles comprising:
 - (a) with a computer system automatically storing, in a central database associated with the computer system, profile information associated with a visitor, as a result of electronic receipt from a profile owner computer of indicia of the profile information, which profile information associated with the visitor matches a profile or kind of profiles requested by an entity controlling the computer system, wherein a tag associated with a visitor device serves as a link to the profile information associated with the visitor;
 - (b) wherein the profile owner computer is programmed: (i) to automatically select a media property entity of a plurality of media property entities based on a comparison of (A) profile information about a visitor who electronically

accessed electronic apparatus of a profile supplier with (B) a plurality of stored requests from the plurality of media property entities, one of which media property entities is the entity controlling the computer system, each stored request being for requested profiles or kinds of profiles, which plurality of stored requests includes the profile or kind of profiles requested by the entity controlling the computer system, and (ii) when the media property entity is the entity controlling the computer system, to automatically arrange for electronic storage of a requested profile linked to the tag that is associated with the visitor device, the tag being readable by equipment that is part of the computer system of part (a); and

(c) later, when the visitor device is available to receive an advertisement, with the computer system, (i) using the tag of part (a) that is associated with the visitor device to access the profile information stored in the central database, and (ii) using the profile information linked to the tag of part (a) to automatically cause delivery of an electronic advertisement to the visitor device, wherein the electronic advertisement is dependent on the profile information associated with the visitor.

'445 Patent (Ex. 1001) at claim 1.

III. Level of Ordinary Skill in the Art

The Petition alleges that a person of ordinary skill in the art, as of the priority date of the '445 patent, “would have experience in online advertising and computer science.” Pet. 19. The Petition’s description of the qualifications is generally vague, however, as the Petition does not specify *how much* experience or how much education (or equivalent) would be required. Patent Owner believes that a more precise definition of the level of skill in the art is that a POSITA would have had a bachelor’s degree in computer science or similar degree (such as electrical or computer engineering) and approximately two years of experience in computer science with at least some experience in online network communication (which could include online advertising more specifically), as well as HTTP protocol analysis and online identity tracking including the use of cookies. More education could substitute for less work experience, or vice versa. Ex. 2001, ¶27.

IV. Claim Construction

The Federal Circuit has held that “only those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.” *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999). This principle applies equally to IPR proceedings. *See, e.g., Apple Inc. v. Uniloc Luxembourg S.A.*, IPR2018-00420, Paper 7 at 8 (PTAB, Aug. 6, 2018). For purposes of this response, Patent Owner does not propose constructions for any claim terms.

V. Overview of Certain Alleged Prior Art

A. Gilmour (Ex. 1012)

Gilmour generally relates to “facilitating user-authorized disclosure of profile information to a requesting entity.” Ex. 1012, Abstract. An architectural overview of Gilmour’s system is reproduced below (with the Petition’s annotations).

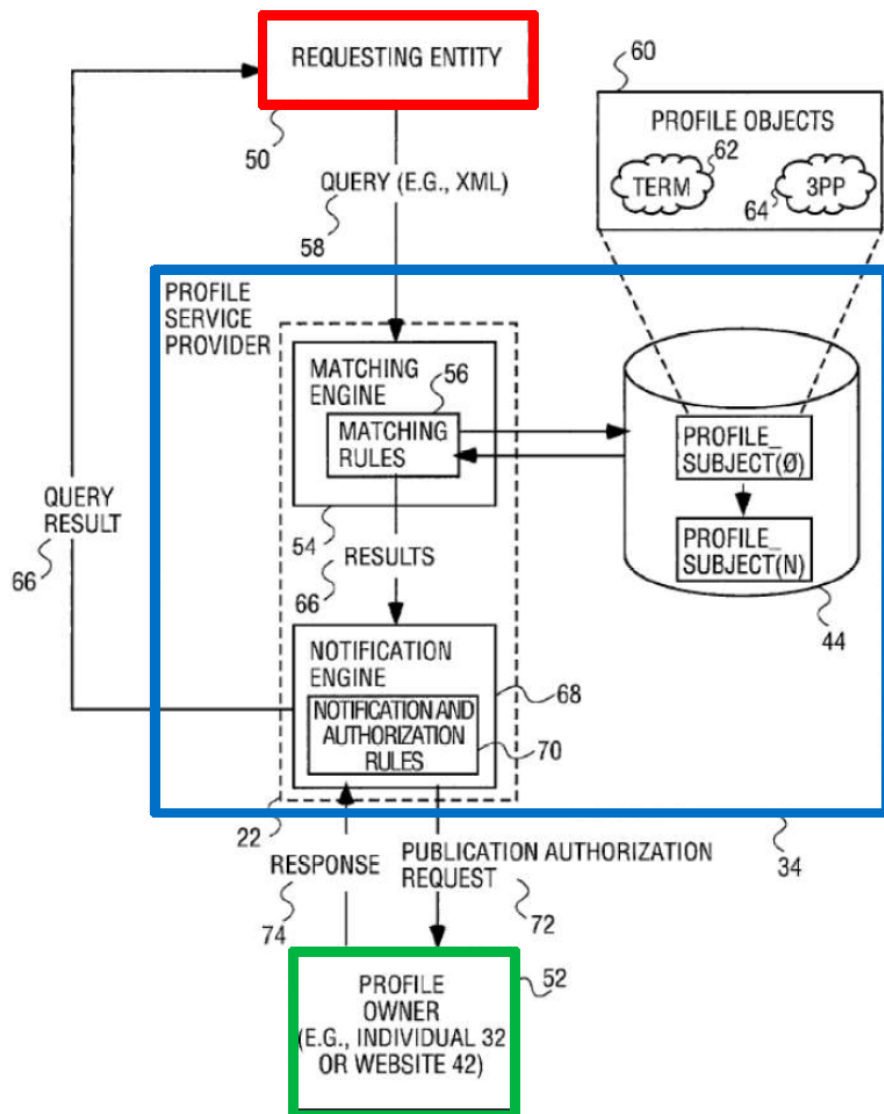


FIG. 3

Pet. 15 (annotated version of Ex. 1012, FIG. 3). Gilmour's teachings are heavily focused on profile owners / users being able to authorize disclosure of their information in response to requests from requesting entities, as shown throughout Gilmour. This is made particularly clear in the abstract, which focuses on "user-authorized disclosure" and "notification and authorization rules" which "may specify appropriate responses on a profile by profile basis" such that profile subjects are able to "exercise a certain degree of control over the publication of information from an external profile." Ex. 102, Abstract; Ex. 2001, ¶36.

An example of the operation of Gilmour's system is presented at FIGS. 12 and associated text. As shown below, the requesting entity pays for the profile information received, as Gilmour does not disclose any incentive for the profile service provider to operate other than to profit from the various payments made.

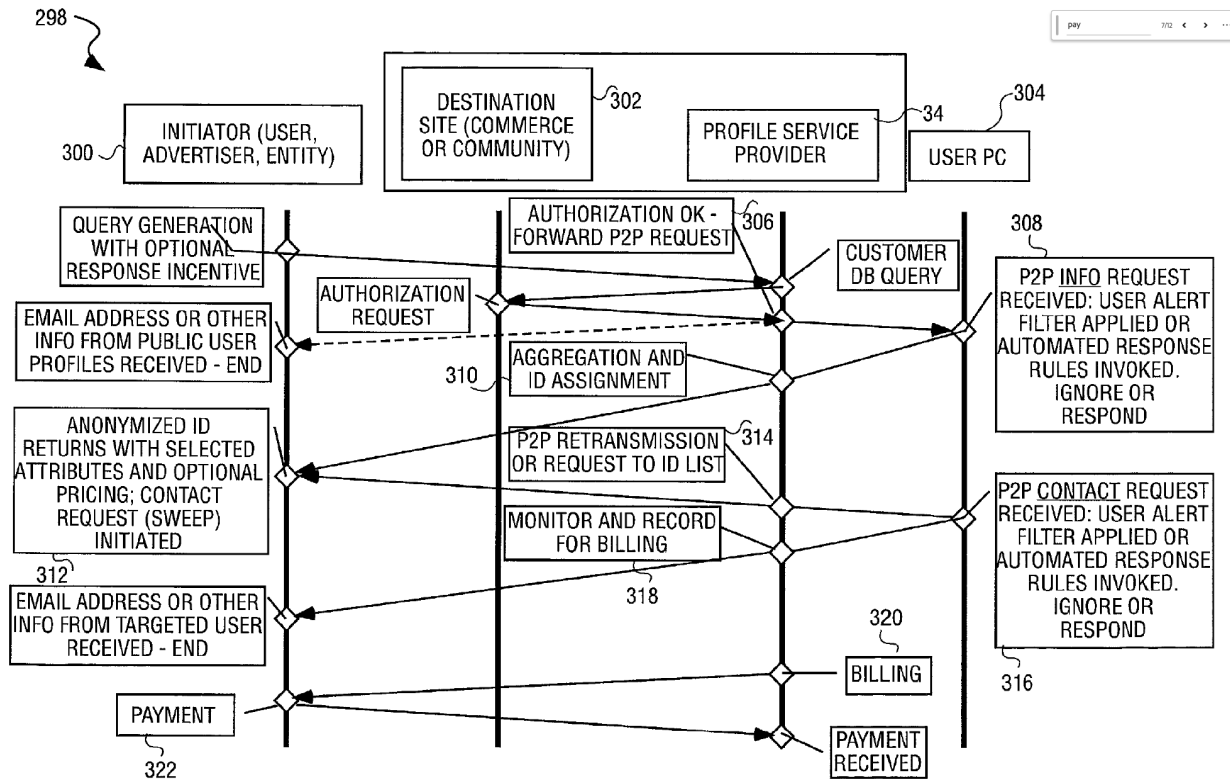


FIG. 12

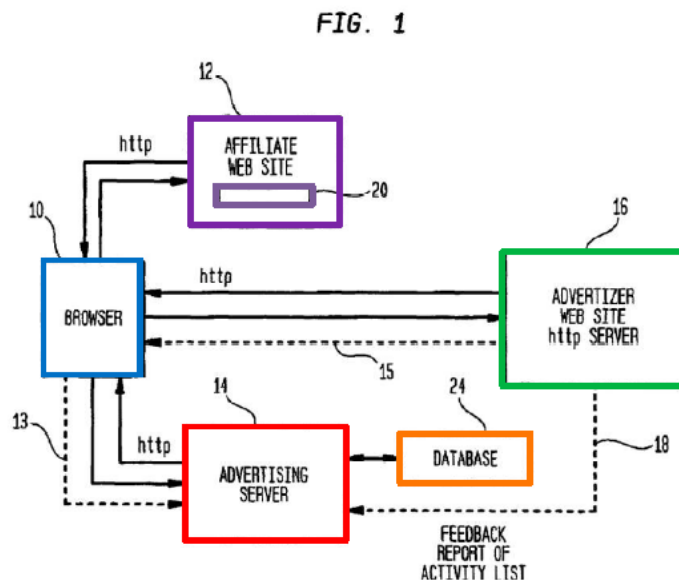
Ex. 1012, FIG. 12; Ex. 2001, ¶37.

B. Merriman (Ex. 1013)

Merriman describes Boomerang, a publicly available prior art system that was developed and made available by DoubleClick, Inc. Pet. 16 (“This type of advertising is also known as ‘Boomerang...’”); Ex. 1002 at ¶54 (“Merriman describes DoubleClick’s ‘Boomerang’ product”); *see also* Ex. 2004 (Amazon Trial Transcript) at 832:21–833:1 (Kevin O’Connor, the Founder and CEO of DoubleClick, testifying that Merriman “is the Boomerang patent”); *id.* at 833:19–22 (counsel for Amazon summarizing Mr. O’Connor’s testimony that “this patent is for the Boomerang feature”); Ex. 2001, ¶38.

Merriman (and Boomerang) is directed to “‘re-targeting,’ a type of targeted advertising in which ‘a new follow-up (retargeted) advertisement from a specific advertiser who targeted that viewer previously, is selected for that viewer based on the viewer’s own past behavior at that specific advertiser’s web site.’” Ex. 1013, 3:30–34; Pet. 16; Ex. 2001, ¶39; *see also* Ex. 2006 at 2 (“Boomerang ‘brings your customers back,’ by allowing you to re-target people who have previously visited your site. Your message can be delivered to these customers and interested prospects after they leave your site and when they appear on Web sites in the DoubleClick Network.”); Ex. 2001, ¶39.

The Petition provides an annotation, reproduced below, annotating “the entities [Merriman] uses in Figure 1”:



Pet. 17 (annotation of Ex. 1013, FIG. 1).

As shown in the figure above and the associated text of Merriman, the advertiser (“advertizer” in Figure 1) of Merriman transmits activity list information to Merriman’s advertising server for use in retargeting ads to a user who previously visited the advertiser’s web site, when that user is later found on a different (“affiliate”) web site. *See* Pet. 17; Ex. 1013, 4:37-43; 4:51–5:2, 5:38–40. As explained by Patent Owner’s expert Erik de la Iglesia, a POSITA would have understood “affiliate web site” to be a reference, for example, to a web site in the “DoubleClick Network,” which allows sites to “benefit” from “advertisers purchasing your inventory.” Ex. 2001, ¶39–40 (quoting Ex. 2007; *see also* Ex. 2006 at 1 (“With over 750 sites in the [DoubleClick] Network (including Alta Vista, Dilbert, and Travelweb), we provide advertisers with a wide selection of ad-vehicles and provide our affiliate sites with revenue and the reassurance that they are in good company.”)).

Merriman teaches several different ways (which Merriman calls “alternative mechanisms”) for the advertiser website to implement the “feedback path 18.” Ex. 1013 at 4:44–5:8. This discussion focuses primarily on the “spotlight tags” embodiment of Merriman (Ex. 1013 at 4:51–5:3), because that is what the Petition relies on in its combination of Merriman with Gilmour and Frauenhofer. Merriman teaches that “[e]ach of the advertiser web pages include a corresponding spotlight tag.” Ex. 1013, 5:33–51. A POSITA would have recognized that the advertiser does

not receive money from Merriman’s ad server for the use of its profile data, but instead *pays* Merriman’s ad server so that Merriman’s ad server will use the profile data to direct the advertiser’s ads using the profile data. Ex. 2001, ¶¶41-42.

C. Frauenhofer (Ex. 1014)

As the Petition states, “Frauenhofer discloses ‘a system for gathering, categorizing, and delivering *electronic content* to users in response to user requests.’” Pet. 18 (quoting Ex. 1014, 2:8–10). The Petition correctly notes that Frauenhofer’s “system server gathers content, such as web pages, from multiple sources,” and “stores the categorized content in a database.” Pet. 18 (citing Ex. 1014, 2:46–54, 4:44–48); Ex. 2001, ¶44.

Frauenhofer is quite different from Gilmour (as well as the ’445 Patent) because rather than *providing* profile information to entities that request the information, Frauenhofer *receives* user profiles from the entities (users) who request that information, and uses that received information to send matching content to the requesting users. *See* Ex. 1014, 4:44–52; Ex. 1002 ¶93 (“The system matches the users’ interests (found in the users’ profiles) to the channels assigned to the content and sends content in those matching channels to the users.”); Ex. 1002, ¶93 n.6 (quoting Ex. 1014 at 5:40–43 to support the assertion that “Frau[e]nhofer refers to a set of these [user] queries as ‘user profiles’”) Ex. 2001, ¶45.

VI. The Petition fails to establish the obviousness of its proposed combinations involving Gilmour, Merriman, and Frauenhofer.

All grounds of the Petition involve a combination of (at least) Gilmour, Merriman, and Frauenhofer, and the Petition relies solely on these references in alleging the obviousness of claim 1. As explained below, the Petition’s reliance on this proposed combination fails for numerous reasons. Ex. 2001, ¶¶59–64.

A. The Petition’s combination fails due to its reliance on Frauenhofer.

The Petition’s reliance on Frauenhofer fails for at least two reasons. First, Frauenhofer is not prior art. Second, even if Frauenhofer were prior art, the Petition fails to show the obviousness of its proposed combination of Gilmour with Frauenhofer (which the Petition relies upon in order to cure the deficiency that the Board previously recognized is present in Gilmour—*see* Pet. 47–48 & Ex. 1009, 565).

1. Frauenhofer is not prior art.

There are two “separate tests” for whether a reference qualifies as prior art: “(1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.” *Netflix, Inc. v. DivX, LLC*, 80 F.4th 1352, 1358

(Fed. Cir. 2023). In other words, if either test is satisfied, a reference qualifies as prior art. Here, however, neither test is satisfied.

First, Frauenhofer is not in the same field of endeavor as the '445 Patent. The field of endeavor of the invention (even at a very high level) is profile-based behavioral targeted advertising. *See* Ex. 1001, 1:19–22 (noting that the invention “generally relates to profile-based behavioral targeting advertisement placement services”). Frauenhofer is certainly not from this same field of endeavor even when that field is phrased in such a broad manner. Frauenhofer does not mention advertising or advertisements, and is not in the field of providing profile-based behavioral targeted advertising. Ex. 2001, ¶60.

Second, Frauenhofer is not reasonably pertinent to the problem faced by the inventor. Here, the problem faced by the inventor was how to efficiently “provide collected profiles to media properties” so that they can “better monetize their low-value ad space.” *See* Ex. 1001, 6:63–7:4. Frauenhofer is not reasonably pertinent to this problem of providing profile information to media properties, as Frauenhofer does not even arguably disclose any techniques for doing so. Instead, contrary to *providing* profile information, Frauenhofer *receives* user profiles relates and provides related content (i.e., documents such as Internet web pages or articles) to the users having the profile information. Ex. 2001, ¶61.

Frauenhofer's matching system simply does not provide profile information to any entity, and it works in exactly the opposite way by *receiving* profile information from requesting entities and providing other information in response to that profile information. And matching a user's request (i.e., a "user profile" in the context of Frauenhofer) to categories of documents is also not a technique that is reasonably pertinent to providing profile information to any requesting entity (whether a media property or any other entity). While Frauenhofer *is* reasonably pertinent to delivering content to users in response to user profiles (in effect, a form of content-targeting), it is *not* reasonably pertinent to ensuring that media properties have efficient access to profile, which is the problem the '445 Patent seeks to solve. Ex. 2001, ¶61.

In sum, because Frauenhofer is neither in the same field of endeavor as the '445 Patent nor reasonably pertinent to the problem faced by the inventor, it is not prior art.

**2. The Petition fails to show the obviousness of its
proposed combination with Frauenhofer.**

Furthermore, even regardless of Frauenhofer's lack of prior art status, the Petition fails to show it would have been obvious to modify Gilmour in the manner Dr. the Petition suggests based on Frauenhofer. Dr. Houh alleges that a "POSITA in possession of Gilmour's 'method and system to publish results of a search

descriptive profiles’ would have looked to Frau[e]nhofer’s technique, which performs ongoing or periodic matching using stored queries ([Ex. 1014], 3:12–19), to provide profile information from the profile service provider to the requesting entities of Gilmour.” Pet. 46. But “Frauenhofer’s technique” is a ***document-matching*** technique, which evaluates user profile information and provides relevant document content in response, such that a POSITA in possession of Gilmour’s system which matches and publishes ***profile information*** would not have looked to Frauenhofer’s technique (and the Petition’s combination does not actually involve Frauenhofer’s technique in any event). *See* Ex. 2001, ¶¶62–63.

As noted above in Section V.C, Frauenhofer’s matching technique does not operate to match profile information against requests from requesting entities. Instead, Frauenhofer’s system *receives* profile information in requests from users, and provides documents in response. Ex. 2003, 27:7–28:11 (“Q. Are you aware of any instances where Frauenhofer discloses providing these user profiles to any entities who request the user profiles? A.... I’m not relying on Frauenhofer for providing user profiles.... Frauenhofer is returning documents to the user and providing document information. I’m not relying on the—Frauenhofer providing user profiles.”).

Contrary to the Petition’s assertion, modification of Gilmour in the manner the Petition suggests would not involve “Frauenhofer’s technique” (which involves

matching document content against user profiles) at all. *See* Pet. 46 (the Petition alleging that “a POSITA... would have looked to Frau[e]nhofer’s technique... to provide profile information from the profile service provider to the requesting entities of Gilmour”). Instead, it would involve a fundamentally *different* technique—matching user profile information against stored requests for profile information and automatically selecting which requesting entity should *receive* the profile information—which technique is found nowhere in the art the Petition relies upon. Ex. 2001, ¶63.

Similarly, the Petition fails to show that its proposal constitutes “a combination of prior art elements according to known methods to yield predictable results and use of a known technique to improve a similar system in the same way.” Pet. 46. As an initial matter, it is not a combination of prior art elements, because Frauenhofer does not disclose the technique (matching profile information to requests from requesting entities) that the Petition proposes implementing within Frauenhofer. It also does not use “known methods” or “known techniques”—the Petition presents no evidence that the actual mechanism it proposes modifying Gilmour with was “known.” Ex. 2001, ¶64

Indeed, the proposed combination fundamentally changes the principle of operation of Frauenhofer’s matching technique, which was designed to *receive* user profiles and provide content in response, not to *match* profile information to requests

and provide that profile information in response to those requests. Implementing a technique where profile information is provided *in response* to a request (as opposed to being received *as part of a* user request) would render Frauenhofer's matching inoperable for its intended purpose of matching and providing document content in response to profile information. *See Plas-Pak Indus., Inc. v. Sulzer Mixpac AG*, 600 F. App'x 755, 759 (Fed. Cir. 2015) (“[A] change in a reference's principle of operation is unlikely to motivate a person of ordinary skill in the art to pursue a combination with that reference.”) (internal quotation omitted); Ex. 2001, ¶64.

B. The Petition fails to establish the obviousness of Merriman's ad server participating as a requesting entity in Gilmour's system.

The Petition proposes that in its combination, “Merriman's ad server” would “act[] as a requesting entity” and issue requests to Gilmour's profile service provider. *See* Pet. 42; *see also* Ex. 1002, ¶148 (“Gilmour combined with Merriman thus discloses that the claimed profile owner computer (Gilmour's profile service provider) performs a comparison of profile information about a visitor who electronically accessed an electronic apparatus of a profile supplier (Gilmour's website) with a request from a media property entity (Merriman's ad server acting as a requesting entity).”). However, the Petition fails to show that a POSITA would have found it obvious for Merriman's advertising server (which relates to

DoubleClick's Boomerang product and retargeting) as having any need to issue requests to a profile service provider. Ex. 2001, ¶¶46–50.

First, a POSITA would understand that requesting profile information from Gilmour's profile service provider would involve payment for the profile information. Ex. 2001, ¶47; *see also* Pet. 54–57 (the Petition's theory for claims 8 and 9 explicitly relying on Gilmour's teachings regarding payment).¹ A POSITA would have understood that profile suppliers (i.e., advertiser websites in the context of Merriman) actually paid **DoubleClick** for Boomerang to use their profile information to target advertisements. And Merriman itself is consistent with this understanding, as it (unlike Gilmour) does not disclose any payment for the profile information. Accordingly, a POSITA would understand that because the advertiser in Merriman is paying for advertisements, there would be no payment from Merriman's advertising server to the advertiser for the user of its profile information. In light of the fact that Boomerang was able to receive money to take and use this profile information, a POSITA would not have found a reason for Merriman's advertising server (i.e., the Boomerang ad server) to be the requesting entity in Gilmour's system.

¹ To the extent that the Board finds a combination involving Merriman's ad server would not be obvious if payment were involved, claims 8 and 9 are not unpatentable for that additional reason.

The Petition fails to address this issue. For example, the Petition provides no explanation of why Merriman’s advertising server would choose to coordinate with Gilmour’s profile service provider computer system when it already receives profile information from the advertiser (i.e., the profile information actually used to target the retargeted ads) for free (and indeed Merriman’s ad server receives payment for doing so). *See In re Schweickert*, 676 F. App’x 988, 995 (Fed. Cir. 2017) (finding a combination not obvious when it “would do little more than add unwanted cost and complexity to the system”). Amazon also provides no expert testimony on this point; in fact, Dr. Houh could not respond affirmatively when asked if he considered whether he “evaluate[d] whether Merriman’s advertising server pays Merriman’s advertiser for the profile information provided by the advertiser” when he was forming his opinions. Ex. 2003 at 21:10–22:2. In other words, Amazon’s expert formed his opinions without considering whether his proposed combination would require Merriman’s ad server to pay for information that it was previously receiving for free (and in fact, receiving money to receive and utilize).

In sum, Amazon fails to articulate any reason for Merriman’s advertising server has access to profile information (both in the context of Merriman’s disclosure and in the context of how Boomerang actually operated), because there is no identified reason for Merriman’s advertising server to coordinate with Gilmour’s profile service provider when Merriman’s ad server *already* has access to profile

information from advertisers who wish to advertise with that ad server by virtue of the very spotlight tags that the Petition relies on in its combination. Ex. 2001, ¶¶48–49. Nor is there any identified reason or Gilmour’s profile service provider to give away profile information for free. Ex. 2001, ¶49.

Nor is this a “combination of prior art elements according to known methods to yield predictable results” (Pet. 41), because the Petition’s combination would fundamentally change the way that Merriman’s advertising server operates by introducing an unnecessary middleman (Gilmour’s profile service provider) between Merriman’s ad server and the advertiser web site that would only serve to add inefficiency and payment requirements. Although the Petition asserts that Merriman’s ad server could “better target advertisements” (Pet. 41), it does not explain why Merriman’s ad server (which is focused on *re*-targeted advertising, not targeted advertising more generally) would benefit from the use of Gilmour’s profile service provider, because the disclosure of Merriman’s invention is about using information *from advertisers* to retarget visitors to those advertisers’ own advertisements. For instance, Merriman explicitly differentiates between the broader “Targeted Advertising” (which is discussed in the “Background of the Invention” section) from the narrower “Re-Targeted Advertising” (which is discussed in the “Summary of the Invention” Section”). Ex. 1013, 2:3–4:10. And each of Merriman’s descriptions of the invention relate solely to retargeted advertising. Ex. 2001, ¶50.

Because Merriman only serves retargeted advertisements from advertisers, and because Merriman's ad server already has access to the necessary profile information from advertisers, there is no coherent theory regarding how Merriman's ad server cooperating with Gilmour's profile service provider would allow the ad server "to better target advertisements" as the Petition alleges. *See* Pet. 41.

C. The Petition fails to show the obviousness of using spotlight tags in the manner it proposes to satisfy limitation [1.b(ii)].

Even if one *were* to attempt to combine Gilmour with Merriman such that Merriman's advertising server would be the requesting entity in the context of Gilmour, that would still not satisfy limitation [1.b(ii)], because the Petition fails to show how the obviousness of its alleged implementation with regard to that limitation. Ex. 2001, ¶¶51–58.

The Petition specifically alleges that in order to satisfy this limitation, "[i]n combination, Gilmour's profile service provider computer redirects a website visitor having a requested profile to the server of the requesting entity computer system using the technique taught in Merriman." Pet. 51. But the Petition ignores the fundamental incompatibility between Gilmour's technique (which involves transferring profile information *conditionally*, upon a profile match) and Merriman's spotlight tag technique (which transfers profile information *unconditionally* after a user visits a web page having a spotlight tag embedded in the page). None of the

Petition, Petitioner's expert, Merriman, Gilmour, or Fraunhofer explain how redirection using a spotlight tag could operate such that a user's browser would only be redirected to the relevant location if the user's profile met certain matching criteria, as the Petition's proposed combination would require.

As explained by Patent Owner's expert, a POSITA would not have found such a modification (redirection contingent on matching certain profile attributes) to be obvious as that was not a known use of a spotlight tag or redirection, because such a modification was not within the level of skill in the art. Ex. 2001, ¶52. The level of complexity is still further increased because the Petition's combination would need to operate consistently *multiple* ad servers like Merriman's ad server are requesting profile information. See Pet. 42, 48 (alleging there would be a "plurality of requesting entities" in this combination). Ex. 2001, ¶53. Merriman's spotlight tag is only disclosed as redirecting the user's browser to a single location (i.e., Merriman's ad server), and the Petition provides no explanation as to how a POSITA would supposedly have found it obvious to have spotlight tags (or any other redirection) work as applied to multiple requesting ad servers each with their own profile matching criteria. As explained by Patent Owner's expert, this is not a simple solution, and it is not apparent how a person of ordinary skill in the art would have been able to implement conditional redirection, particularly in a manner consistent with the teachings of Gilmour and Fraunhofer. Ex. 2001, ¶¶52-57.

Furthermore, the Petition’s unexplained combination is not merely “a combination of prior art elements according to known methods to yield predictable results.” *See* Pet. 52. Neither the Petition nor Dr. Houh even explain the operational details of the combination (i.e., **how** spotlight tags or other redirection would even possibly be used to conditionally transfer information), and application of spotlight tags in such a manner has not been shown to be either “known” nor “predictable.”² Ex. 2001, ¶58; *see In re Schweickert*, 676 F. App’x 988, 995 (Fed. Cir. 2017) (reversing obviousness finding in part because “[e]ven if the [feature from a secondary reference] were readily applicable to [the primary reference], the Board has not explained why or how a skilled artisan would further configure” the combination to operate as required).

VII. The Petition’s Ground 2 cannot be considered and is also unsupported.

A “petitioner ‘may request to cancel as unpatentable’ claims ‘only on the basis of prior art consisting of patents or printed publications.’” *Qualcomm Inc. v. Apple Inc.*, 134 F.4th 1355, 1364 (Fed. Cir. 2025) (quoting 35 U.S.C. § 311(b)). As the Federal Circuit has made clear, this “means that ‘the basis’ of an IPR ground asserting unpatentability can ‘only’ include ‘prior art consisting of patents or printed

² Although the Petition does not address **any** manner in which spotlight tags could be used to conditionally transfer information as its combination would require, to the extent Amazon is allowed to present a new theory in this regard in its reply brief, Patent Owner reserves the right to respond to those new theories.

publications,”” such that applicant admitted prior art or other material that does not constitute “patents or printed publications” cannot form the basis for an IPR ground.

Id.

Here, the Petition is explicit that the basis for its Ground 2 challenge is “Gilmour, Merriman, Frauenhofer, and knowledge of a POSITA.” Pet. 13 (noting that this is a separate ground from merely “Gilmour, Merriman, and Frauenhofer”). The Petition’s identification of the basis involving knowledge of a POSITA is reproduced below.

Ground	Claims	Statutory Basis	Prior Art
1	1, 8-11, 13	§103	Gilmour, Merriman, and Frauenhofer
2	12	§103	Gilmour, Merriman, Frauenhofer, and knowledge of a POSITA
3	2-7, 14	§103	Gilmour, Merriman, Frauenhofer, and Julia

Pet. 13. Notably, this is nearly identical to the table (reproduced below) that the Federal Circuit relied on in *Qualcomm* as improperly including applicant-admitted prior art:

Grounds	Claims	Basis
Ground 1	8-9, 12-13, 16-22	§103: Steinacker in view of Doyle and Park
Ground 2a	8-9, 12-13, 17-21	§103: Applicants Admitted Prior Art (AAPA) in view of Majcherczak
Ground 2b	16, 22	§103: AAPA in view of Majcherczak and Matthews

Qualcomm, 134 F.4th at 1359. Thus, the Petition expressly included prior art that does not constitute a patent or printed publication as the basis for its Ground 2, and thus the Petition’s Ground 2 cannot result in any unpatentability determination. *See Qualcomm*, 134 F.4th at 1364.

The Petition also provides no analysis regarding how the personally identifiable information in a cookie would be useful in the context of the Petition’s proposed combination. The Petition does not, for example, identify any deficiency in Gilmour, Merriman, or Fraunhofer related to recognizing a user or lacking a key to find information stored in a database. The Petition does not allege that using personally identifiable information is a simple substitution of known elements or any other *KSR* rationale, yet the Petition makes no effort to establish that the alleged motivation would apply to the combination the Petition actually relies upon.

Ultimately, the Petition’s argument is that personally identifiable information *could have* been used, not that a POSITA *would have been motivated* to use it in the proposed combination. *See* Pet. 63 (alleging that a POSITA would have “found

[it] obvious that a cookie *may* store essentially any information, including [personally identifiable information]”). Given that there were congressional hearings concerning the use of personally identifiable information in the online advertising context (including involving DoubleClick) where members of the United States government expressed concern over the use of personally identifiable information and where major advertisers such as DoubleClick downplayed their usage of personally identifiable information, a POSITA would have avoided utilizing personally identifiable information in the context of a combination involving Merriman’s ad server absent some actual motivation beyond simply that such information “could” have been used to track a user’s identity within a given system. *See* Ex. 2008, 134:22–135:7 (a DoubleClick representative testifying that privacy safeguards must be imposed before personally identifiable information is collected); *id.* 151:8–11 (testifying that DoubleClick “cannot associate the name and address *or personally identifiable information* with the profile that we have,” contrary to the Petition’s proposed combination); *id.* at 162:17–163:10 (testifying that “a DoubleClick cookie... [is] not associated with the personally identifiable information that was given to” members of the DoubleClick network).

VIII. Conclusion

For the reasons set forth above, Patent Owner respectfully requests that the Board find all challenged claims not unpatentable.

Date: February 13, 2026

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CERTIFICATION REGARDING WORD COUNT

Pursuant to 37 C.F.R. §42.24(d), Patent Owner hereby certifies, in accordance with and reliance on the word count provided by the word-processing system used to prepare this **PATENT OWNER'S RESPONSE**, that the amount of words in this paper is 5,182. Pursuant to 37 C.F.R. § 42.24, this word count is in compliance with the word limit set forth in 37 C.F.R. § 42.24(b)(2) excluding the portions exempted under 37 C.F.R. § 42.24(a)(1).

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

The undersigned hereby certifies that the above document was served on February 13, 2026, by filing this document through the Patent Trial and Appeal Case Tracking System as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioners:

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