

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LINKEDIN CORPORATION,
Petitioner,

v.

DISTEFANO PATENT TRUST III, LLC,
Patent Owner.

IPR2019-00419
U.S. Patent No. 8,768,760

PATENT OWNER'S PRELIMINARY RESPONSE

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LIST OF EXHIBITS

To avoid unnecessary replication of exhibits, where already cited in the Petition, the present Patent Owner's Preliminary Response will refer to those Exhibits already identified in on pages viii-ix of the Petition. Additional exhibits are listed below.

No.	Description
2001	Definition of "site", https://www.dictionary.com/browse/site
2002	Definition of "reciprocal", https://www.merriam-webster.com/dictionary/reciprocal
2003	Definition of "reciprocal", https://www.dictionary.com/browse/reciprocal
2004	Definition of "reciprocal", https://en.oxforddictionaries.com/definition/reciprocal

BACKGROUND

U.S. Patent No. 8,768,760 ("760 Patent"), entitled "Reciprocal Linking Arrangement Between Web Pages," issued on July 1, 2014, to Thomas L. DiStefano III. Exhibit 1001. The '760 Patent ultimately claims priority through a series of continuation applications to U.S. Patent No. 7,996,259 ("259 Patent"), which was filed on June 7, 2000, as U.S. Patent Application No. 09/589,551 ("551 Application"). Exhibit 1003. On April 12, 2016, U.S. Patent No. 7,996,259 was subsequently reissued as RE45,971 ('971 Reissue Patent). Aside from the '971 Reissue Patent, 10 issued U.S. Patents and 2 pending U.S. Patent Applications claim priority from the '551 Application ("259 Family").

On December 14, 2017, DiStefano Patent Trust III, LLC ("Patent Owner") filed a patent infringement action (Case No. 1:17-cv-01798) against LinkedIn Corporation ("LinkedIn") asserting infringement of the '760 Patent. Exhibit 1013. On October 17, 2018, the United States District Court for the District of Delaware issued a judgment of invalidity of the '259 Patent for failure to claim patent-eligible subject matter under 35 U.S.C. § 101. That judgment is currently on appeal to the Court of Appeals for the Federal Circuit, Case No. 19-1210 (docketed November 16, 2018).

SUMMARY OF PATENT OWNER'S PRELIMINARY RESPONSE

Under 35 U.S.C. § 311(b), the Board can institute *inter partes* review "only on a ground that could be raised under section 102 or 103." LinkedIn proposes that claims 1-20 of the '760 Patent are obvious under 35 U.S.C. § 103 based upon its upstream parent application, the '259 Patent. LinkedIn's assertion that certain claimed limitations in the '760 Patent lack written descriptive support in the parent '259 Patent has no merit. Not only have the limitations at issue been examined for written descriptive support by the original Examiner, additional Examiners have also had the opportunity to review either the same or similar limitations. However, at no time did any of these Examiners indicate that the claim language lacks written descriptive support. Moreover, during prosecution of the '259 Patent, in an *ex parte* appeal, the Board rejected an interpretation of "reciprocal link site" that is nearly identical to the interpretation proposed by LinkedIn's expert, Loren G. Terveen ("Terveen"), and critical to Terveen's position that the claim language lacks written descriptive support. The prosecution history of the '259 Family notwithstanding, Patent Owner establishes here that all of the claim limitations find reasonable written descriptive support in the specification of the '760 Patent, the '259 Patent, and the intervening patents.

LinkedIn's assertion that the claims are obvious in view of LinkedIn's version of the '259 Patent ("*LV-'259 Patent*")¹ is also without merit. LinkedIn relies upon U.S. Patent No. 6,995,099 ("*Horstmann*")² – not to supply the allegedly missing limitations for its *LV-'259 Patent* – but as "information regarding the state of the art" and "in support of why a PHOSITA would be motivated to modify" LinkedIn's *LV-'259 Patent*. Paper No. 2, at 36, n.11. Horstmann, however, is closer to the challenged claims than LinkedIn's *LV-'259 Patent*. Not only did the Patent Office consider Horstmann during prosecution of the '760 Patent, the Patent Office explicitly cited Horstmann in a rejection under 35 U.S.C. § 103, during prosecution of the '971 Reissue Patent. Additionally, Terveen's analysis both improperly relies upon "common sense" to supply a missing limitation and ignores a critical teaching in Horstmann that teaches the opposite of what Terveen opines to be "common sense."

¹ In order to distinguish the '259 Patent from LinkedIn's characterization of the '259 Patent (i.e., a disclosure lacking the teachings that LinkedIn asserts do not find written descriptive support), Patent Owner will refer to LinkedIn's version as the "*LV-'259 Patent*".

² Horstmann was cited by LinkedIn as Exhibit 1008.

The Board cannot institute *inter partes* review on the proposed ground that all of the challenged claims are obvious under section 103 based upon the '259 Patent without first determining that LinkedIn can prevail in establishing that the '760 Patent cannot claim priority from the '259 Patent. However, LinkedIn cannot prevail on either, and for the Board to institute *inter partes* review, LinkedIn must be able to prevail on both. Consequently, the Board should deny the Petition.

CLAIM CONSTRUCTION AND CLAIM SUPPORT

Claim 1³ of the '760 Patent requires:

1. A method, within and by a computer hardware system that is configured to serve a first web page associated with a first user and a second web page associated with a second user, comprising:

receiving, from a first computer associated with the first user, a first indication to opt into a reciprocal linking arrangement;

receiving, from a second computer associated with the second user, a second indication to opt into the reciprocal linking arrangement;

establishing, within a database associated with the computer hardware system, the reciprocal linking arrangement based upon both the first and second users opting to participate in the reciprocal linking arrangement;

³ Independent claim 11 of the '760 Patent is substantially similar to independent claim 1, and does not raise any substantively additional claim construction or claim support issues.

including, within the second web page and based upon the reciprocal linking arrangement, a second functional identification element associated with the first [user];⁴ and

including, within the first web page and based upon the reciprocal linking arrangement, a first functional identification element associated with the second [user],⁵ wherein

the second functional identification element includes a link to the first web page, and

the first functional identification element includes a link to the second web page.

I. The Claim Limitations Find Support in the '760 and the '259 Patent's Written Description, Which are Substantively Identical

The written descriptions of the parent '259 Patent and the downstream '760 Patent are substantively identical.⁶ However, Patent

⁴ The phrase "with the first entity" was replaced by "with the first user" in a Certificate of Correction. Exhibit 1001 at 47.

⁵ The phrase "with the second entity" was replaced by "with the second user" in the Certificate of Correction. Exhibit 1001 at 47.

⁶ During prosecution of U.S. Patent Application No. 13/668,955, the Patent Office issued a Notice to File Corrected Application Papers, in which the Patent Office determined that replacement drawings were required. Consequently, applicant filed new drawings, which are also found in the '760 Patent. Aside from different fonts and having to split certain figures to fit on multiple pages, the drawings from the '259 Patent and the drawings from the '760 Patent are substantively identical.

Owner will cite to both the '259 Patent (Exhibit 1003) and the '760 Patent (Exhibit 1001) as providing written descriptive support for the limitations at issue.

A. "a computer hardware system that is configured to serve a first web page associated with a first user and a second web page associated with a second user"

As set forth in the preamble, the claimed operations are performed in "a computer hardware system that is configured to serve a first web page associated with a first user and a second web page associated with a second user." Exhibit 1001 at 45, 28:4-7. A high-level drawing of the server system is illustrated in Figure 1, which is reproduced below:

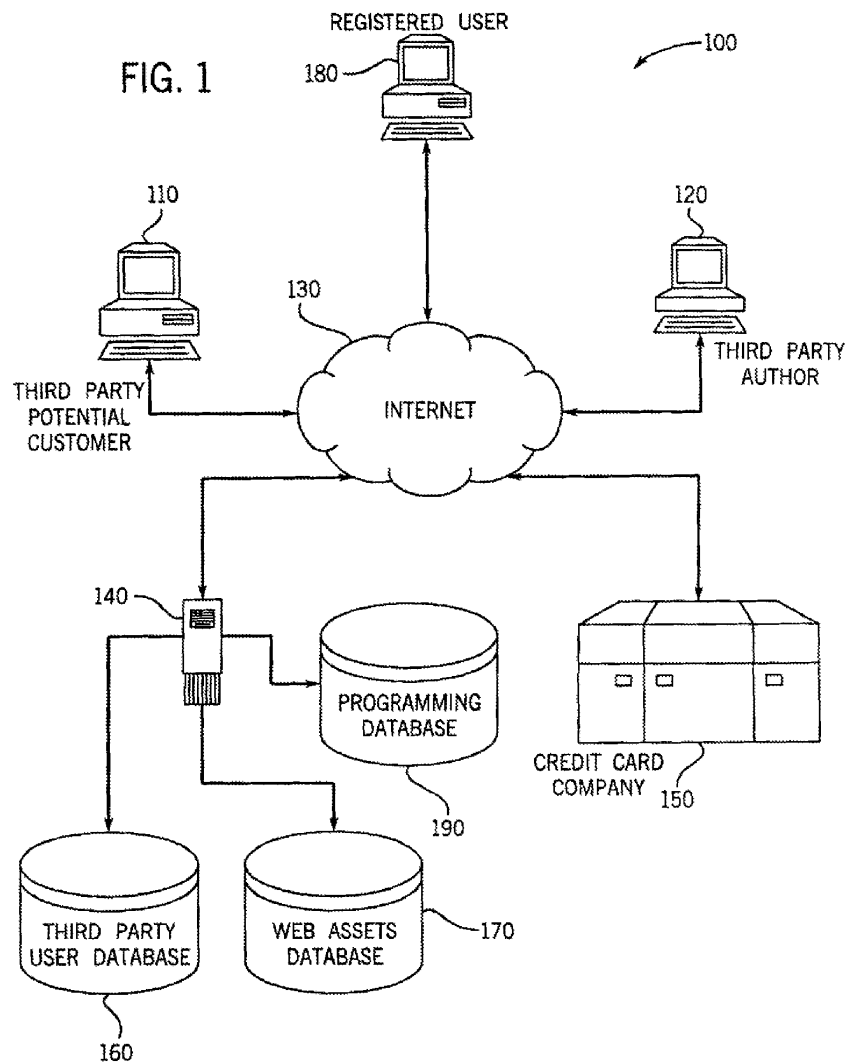


Exhibit 1001 at 3, Figure 1; Exhibit 1003 at 2, Figure 1.

The '760 and '259 Patents disclose that "[a] server computer is a computer which stores web page information, retrieves that information in response to a browser's request, and sends the information, via the internet, to the client computer." Exhibit 1001 at 32, 1:53-59; Exhibit 1003 at 25, 1:42-48. The '760 and '259 Patents further disclose that the "system 100 includes a server computer 140

operably connected to the internet 130 using standard techniques well-known in the art." Exhibit 1001 at 34, 5:53-60, Exhibit 1003 at 27, 5:37-44.

B. "receiving, from a first computer associated with the first user, a first indication to opt into a reciprocal linking arrangement" and "receiving, from a second computer associated with the second user, a second indication to opt into the reciprocal linking arrangement"

Claim 1 of the '760 Patent also requires "receiving, from a first computer associated with the first user, a first indication to opt into a reciprocal linking arrangement" and "receiving, from a second computer associated with the second user, a second indication to opt into the reciprocal linking arrangement." Exhibit 1001 at 45, 28:8-13. LinkedIn's claim construction refers to the reciprocal linking arrangement as being "bi-directional." Paper No. 2, at 13. However, the term "bi-directional" is not found in the claims nor the specification, and LinkedIn has neither explained what "bi-directional" means in the context of the claims nor explained why this term is necessary to construe the meaning of the claim language. The use of "bi-directional" is not necessary to construe the plain and ordinary meaning of the claim language.

LinkedIn then asserts that "[t]he claim term 'the' dictates the existence of a single, common, 'reciprocal linking arrangement'" (emphasis omitted). Paper No. 2, at 14. The phrase "single, common" is not found in the claim language, and neither word in this phrase is necessary to construe the plain and ordinary meaning of the

claim language. This point aside, LinkedIn is correct in asserting that both the claimed "first indication" and the "second indication" refer to the same "reciprocal linking arrangement."

The limitations at issue are mirror image operations that describe how first and second users, via first and second computers, both opt into a reciprocal linking arrangement. Referring to the '760 and '259 Patents, a user may be presented with an opportunity to create a link:

If the ... selection received at step 2004 is to create links, the system 100 then receives [website]⁷ selections at the user interface at step 2018.

Exhibit 1001 at 43, 24:46-48; Exhibit 1003 at 36, 24:25-27. This is illustrated in Figure 20A, which is reproduced, in part, below.

⁷ This portion of the '760 and '259 Patents uses the terms "marketing locations" and "websites" interchangeably. Exhibit 1001, 24:53-55; Exhibit 1003 at 36, 24:32-34 ("information is later used to generate links at the selected marketing locations (i.e., websites)").

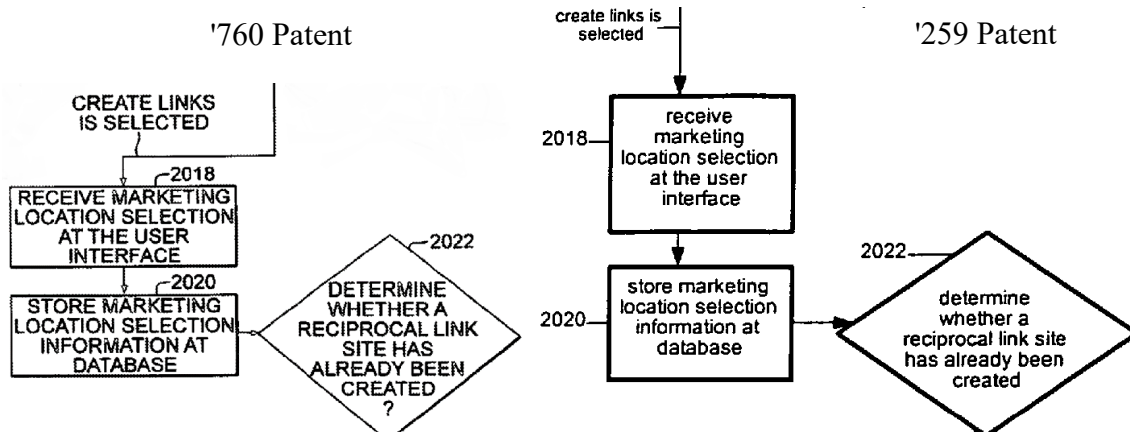


Exhibit 1001 at 25; Exhibit 1003 at 21.

As also disclosed, "the registered user can identify addresses for websites to which the registered user desires its website to be linked." Exhibit 1001 at 39, 15:24-36; Exhibit 1003 at 32, 15:4-16. Moreover, the '760 the '259 Patents disclose "the websites can be selected from among the websites that have been created by other registered users using the system 100." Exhibit 1001 at 39, 15:28-30; Exhibit 1003 at 32, 15:8-10. Thus, a registered user identifies websites from other websites created by other registered users of the system, and the other registered users can also identify websites to which these other registered users would like to be linked. Exhibit 1001 at 39, 16:4-10; Exhibit 1003 at 32, 15:51-57. The identification of a particular website, by a registered user, is an example of an indication to opt into a reciprocal linking arrangement. *Id.*

An example of a reciprocal linking arrangement involves the scenario in which registered user A indicates a desire to link to the website⁸ of registered user B, and registered user B indicates a desire to link to the website of registered user A. As will be described in more detail, *infra*, The reciprocal linking arrangement indicates that reciprocal links are to be created such that the website of user A links to the website of user B and the website of user B links to the website of user A.

C. "establishing, within a database associated with the computer hardware system, the reciprocal linking arrangement based upon both the first and second users opting to participate in the reciprocal linking arrangement"

Claim 1 of the '760 Patent next requires "establishing, within a database associated with the computer hardware system, the reciprocal linking arrangement based upon both the first and second users opting to participate in the reciprocal linking arrangement." Exhibit 1001 at 45, 28:14-17. LinkedIn's claim construction argument infers that this is a "Reciprocal Linking Arrangement Database." Paper No. 2, at 14. However, the claim language does not require a specific type of database. Rather, the claim language requires a database that is configured to having

⁸ A website includes one or more webpages and Patent Owner refers to these terms interchangeably within the Preliminary Response.

stored therein information that establishes the reciprocal linking arrangement. Exhibit 1001 at 45, 28:14-17.

LinkedIn also argues that "the claimed database includes, that is, stores, the previously identified 'reciprocal linking arrangement.'" Paper No. 2, at 15. This claim construction is not correct as the claims do not necessarily require that the "reciprocal linking arrangement" itself be stored. Rather, the claim only requires that information (i.e., in the form of a data structure) that establishes the reciprocal linking arrangement be stored within the database. Exhibit 1001 at 45, 28:14-17. Thus, while the reciprocal linking arrangement, as manifested in a data structure, could be stored within the database, an alternative data structure(s) could also be stored within the database so long as this alternative data structure(s) establishes the reciprocal linking arrangement. *Id.*

The specification of the '760 and '259 Patents explain that, "[u]pon receiving the [website] selection information, the [website] selection information is stored at ... database 160 [and t]his stored information is later used to generate links at the selected websites." Exhibit 1001 at 43, 24:50-55; Exhibit 1003 at 36, 24:29-34. As discussed *supra*, the website selection information is an indication that a user has opted into a reciprocal linking arrangement. The storage of this information is an example of establishing the reciprocal linking arrangement within a database.

D. "including, within the second web page and based upon the reciprocal linking arrangement, a second functional identification element associated with the first [user]" and "including, within the first web page and based upon the reciprocal linking arrangement, a first functional identification element associated with the second [user]."

Upon the reciprocal linking arrangement being established, Claim 1 of the '760 Patent requires the inclusion of the reciprocal links into the first and second web pages:

including, within the second web page and based upon the reciprocal linking arrangement, a second functional identification element associated with the first [user]; and

including, within the first web page and based upon the reciprocal linking arrangement, a first functional identification element associated with the second [user].

Exhibit 1001 at 45, 28:18-24. In construing the language, Linked-In again refers to "Bi-Directional" without explaining what this term means in the context of the claims or explaining why this term is necessary to construe the meaning of the claim language. Paper No. 2, at 15. The use of "bi-directional" is not necessary to construe the plain and ordinary meaning of the claim language.

LinkedIn further asserts that "[t]his language explicitly requires that the first web page includes a link to the second web page, and further that the second web page includes a link to the first web page." Paper No. 2, at 15. While this statement accurately characterizes a portion of the claim language, LinkedIn's characterization omits that the links are included within the web pages *based upon the reciprocal*

linking arrangement. Exhibit 1001 at 45, 28:18-24. As used herein by Patent Owner, the concept of two web pages, each linking to the other, can be described as "reciprocal links."

For example, the specification of the '760 and '259 Patents disclose that "the system determines whether a reciprocal link site has already been created in the registered user's website, for displaying links to other websites ... [, and i]f a link site has not yet been created, the system creates a link site on the registered user's website" (emphasis added). Exhibit 1001 at 43, 24:53-62; Exhibit 1003 at 36, 24:32-41. By referring to a *reciprocal link* site, the specification of the '760 and '259 Patents provide support for the concept of two webpages, each linking to the other. Further, the specification discloses that "[o]nce the registered user has selected its desired [websites], the system 100 has sufficient information to create links to the registered user's website at other websites." Exhibit 1001 at 39, 15:41-45; Exhibit 1003 at 32, 15:46-50. Thus, the specification of the '760 and '259 Patents disclose a link, at a reciprocal link site, to another web page, and creating a link back, to the registered user's website, at this other web page.

E. "the second functional identification element includes a link to the first web page" and "the first functional identification element includes a link to the second web page"

Claim 1 of the '760 Patent concludes by clarifying that the first and second functional identification elements each include links (i.e., "the second functional

identification element includes a link to the first web page" and "the first functional identification element includes a link to the second web page"). Exhibit 1001 at 45, 28:26-29. Consistent with this language, the term "functional identification element" includes both hyperlinks and banner ads. Exhibit 1001 at 32, 2:40-54; Exhibit 1001 at 35, 7:59-67; Exhibit 1003 at 25, 2:27-41; Exhibit 1003 at 28, 7:41-49. A banner ad is a specialized form of a hyperlink that also includes a graphic. Exhibit 1001 at 37, 11:7-26; Exhibit 1003 at 29-30, 10:56-11:7.

II. Prosecution History of the '259 Family

A. Limitations of the '760 Patent were Considered by Multiple Examiners During Prosecution of Other Patents/Applications in the '259 Family

LinkedIn has alleged that three different sets of limitations in the challenged claim 1 of the '760 Patent lack written descriptive support. However, limitations comparable to each of these three different sets of limitations have been presented in prior applications and *none* of the prior Examiners has found that these limitations lack written descriptive support. The original Examiner⁹ and five other Examiners were involved in the prosecution of applications in the '259 Family. With the

⁹ The original Examiner, Daniel Lastra, was at least initially involved during the examination of all the patents/applications in the '259 Family.

exception of two Examiners with one set of limitations, all of the Examiners examined claim limitations comparable to those limitations in the '760 Patent that LinkedIn has alleged lacks written descriptive support.

The following is a chart of the '259 Family. This chart maps the patent/application with the limitations at issue and also provides an indication as to which claims contain the limitations at issue.

Patent/ Application	reciprocal links	user opts into reciprocal arrangement	storing information involving reciprocal arrangement in database
7,996,259	claims 4, 5, 7	N/A	1
RE45971 ¹⁰	claims 4, 5, 7, 8, 14	claims 21, 23, 25, 27, 29	1, 3
8,335,713	claims 1, 8	N/A	N/A
8,412,570	claims 1, 11, 19	N/A	N/A
8,417,567	claims 1, 7, 14	N/A	N/A
8,423,399	claims 1, 10, 17	N/A	N/A
8,442,860	claims 1, 9, 15	N/A	N/A
8,589,222	claims 1, 7, 13	N/A	N/A
8,650,076	claims 1, 9, 15	N/A	N/A
8,768,760	claims 1, 11	claims 1, 11	claims 1, 11
8,781,890	claims 1, 7, 13	N/A	N/A
8,966,398	claims 1, 9, 17	claims 7, 15, 22	N/A
13/946,461 ¹¹	claims 22, 32	claims 22, 32	N/A
13/946,489 ¹²	claims 22, 29, 35	claims 22, 29, 35	N/A

¹⁰ Examiners Michelle Tarae, Woo Choi, and Deandra Hughes were also involved in the examination of the '971 Reissue Patent.

¹¹ Examiner Katherine Kolosowski-Gager was also involved in the examination of U.S. Patent Application No. 13/946,461.

¹² Examiner Patricia Munson was also involved in the examination of U.S. Patent

B. Subsequent Examiners did not Necessary Give Full Faith and Credit to the Prior Examinations Performed by Their Predecessor

The Examiners who followed the original Examiner performed their own analysis and did not necessarily give full faith and credit to the prior examination performed by the original Examiner. Instead, each of the succeeding Examiners both withdrew prior rejection(s) and instituted new rejection(s). Notably, however, none of these succeeding Examiners instituted a rejection of the claims for lack of written descriptive support.

C. RE45,971 Application

The '971 Reissue Application was filed on August 9, 2013, and was initially examined by the original Examiner. On February 24, 2015, the original Examiner issued a Non-Final Office Action in which claims 1-29 were rejected under 35 U.S.C. § 101. No other rejections were issued at that time.

As evident by a new Non-Final Office Action issued on March 19, 2015, the prior Non-Final Office Action was withdrawn and the application was reassigned from Art Unit 3622 to Art Unit 3992. The application was also assigned a lead

Application No. 13/946,489.

Examiner as well as two other Examiners with whom the lead Examiner conferred.¹³

While the new Non-Final Office Action withdrew the rejection under 35 U.S.C. § 101, the new Non-Final Office Action made the following objections/rejections: (i) an objection to the claims under 37 C.F.R. § 1.173(d), (ii) an informality objection to claims 5 and 6, (iii) a rejection under 35 U.S.C. § 251 for a defective declaration, (iv) a rejection under 35 U.S.C. § 251 for improper recapture, (v) a rejection of several claim terms for indefiniteness under the second paragraph of 35 U.S.C. § 112, and (vi) rejections of the claims under 35 U.S.C. §§ 102, 103 based upon Horstmann. Ultimately, applicant was able to overcome all of these objections/rejections.

D. U.S. Patent Application No. 13/946,461

U.S. Patent Application No. 13/946,461 ('461 Application) was filed on July 19, 2013, and is still pending. The '461 Application was initially examined by the original Examiner. On February 2, 2017, the original Examiner issued a Final Office

¹³ It is Patent Owner's understanding that with the advent of the IPR system at the Patent Office, the number of *ex parte* reexaminations dropped significantly. Consequently, the examiners who were previously handling *ex parte* reexaminations were also assigned to handle reissue examinations. This process also entailed using a team of three examiners, a named examiner as well as two other examiners who also reviewed the application.

Action in which claims 22-26, 28-36, and 38-41 were rejected under 35 U.S.C. § 101. The same claims were also rejected under 35 U.S.C. § 102 based upon Bezos. No other rejections were issued at that time.

After the filing of an Appeal Brief, a new (fifth) Examiner reopened prosecution in a new Non-Final Office Action issued on December 21, 2017, in which the rejection under 35 U.S.C. § 101 was maintained. However, the Examiner withdrew the rejection under 35 U.S.C. § 102 based upon Bezos and presented a new rejection of the claims under 35 U.S.C. § 102 based upon Horstmann. The Examiner also rejected claims 23-24 and 33-34 under the second paragraph of 35 U.S.C. § 112.

E. U.S. Patent Application No. 13/946,489

U.S. Patent Application No. 13/946,489 ('489 Application) was filed on July 19, 2013, and is still pending. The '489 Application was initially examined by the original Examiner. On February 2, 2017, the original Examiner issued a Final Office Action in which claims 22-23, 25-30, 32-36, and 38-40 were rejected under 35 U.S.C. § 101. The same claims were also rejected under 35 U.S.C. § 102 based upon Bezos. No other rejections were issued at that time.

After the filing of an Appeal Brief, a new (sixth) Examiner reopened prosecution in a new Non-Final Office Action issued on March 7, 2018, which the rejection under 35 U.S.C. § 101 was maintained. However, the Examiner withdrew

the rejection under 35 U.S.C. § 102 based upon Bezos and presented a new rejection of the claims under 35 U.S.C. § 102 based upon Underwood.

ARGUMENT

I. LinkedIn Cannot Prevail on Either Arguments that (i) the Claims Lack Written Descriptive Support, Or, that (ii) the '760 Patent Cannot Claim Priority Back to the '259 Patent

LinkedIn's argument that nearly all of the claim language found in the independent claims of the '760 Patent lacks written descriptive support, Paper No. 2, at 20-29, fails because LinkedIn ignores specific language in the '259 Patent that supports the claims language of the '760 Patent. Hence, LinkedIn's position that the claims of the '760 Patent are not entitled to an effective filing date of August 9, 2011, or earlier must fail. Paper No. 2, at 16-20.

A. LinkedIn Only Argues that Claims Lack Written Description Support

Under pre-AIA 35 U.S.C. § 120:

[a]n application for patent for an invention disclosed in the manner provided by the first paragraph section 112 ... shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing of the first application"

35 U.S.C. § 120. Consequently, a claim of priority requires that both the written description and enablement requirements of the first paragraph of 35 U.S.C. § 112 be met. The written description requirement is separate and distinct from the enablement requirement. *Ariad Pharm., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1341 (Fed. Cir. 2010) (*en banc*). In its Petition, LinkedIn did not argue that the claims are not enabled by the specification, and hence, Patent Owner will only address LinkedIn's arguments about lack of written descriptive support for the claims of the '760 Patent.

B. All Patent Applications in the Chain of Priority Comply with Written Description Requirement

To gain the benefit of the filing date of an earlier-filed application under 35 U.S.C. § 120, each application in the chain leading back to the earlier application must comply with the written-description requirement of 35 U.S.C. § 112, first paragraph. *Zenon Envtl., Inc. v. U.S. Filter Corp.*, 506 F.3d 1370, 1378 (Fed. Cir. 2007); *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1571 (Fed. Cir. 1997). As recognized by LinkedIn, the '760 Patent claims priority to a series of *continuation* applications that ultimately lead to the '551 Application filed on June 7, 2000. Paper No. 2, at 3-4. Notably, the specifications of the applications within this chain of

priority all include the *same* Detailed Description.¹⁴ Since the '259 Patent provides written descriptive support for the '760 Patent Claims, as established *infra*, all of the intervening applications within the chain of priority also necessarily comply with the written description requirement of 35 U.S.C. § 112, first paragraph.¹⁵

C. The Written Description Issues Raised by LinkedIn Have Already Been Considered During Prosecution

LinkedIn asserts that "[n]o Examiner *expressly* addressed whether the Challenged Claims have written description support in U.S. Patent Application No. 09/589,551 or U.S. Patent Application No. 13/206,483" (emphasis added). Paper No. 2, at 3. While this statement is technically accurate, as required by statute, several Examiners have considered the same issues now raised by LinkedIn. *See* M.P.E.P. § 2163(II)(A). Moreover, one of the findings made by LinkedIn's expert,

¹⁴ Aside from the claims and corrected drawings, the only substantive differences are that the '399 Patent, '398 Patent, and '760 Patent have abstracts and titles that more closely comport to the claim language. Patent Owner, however, has not relied upon the abstracts or titles to establish that the claims of the '760 Patent have written descriptive support.

¹⁵ LinkedIn has not separately asserted that the other applications in the chain of priority fail to satisfy the written description requirement.

a lynchpin to LinkedIn's arguments, is at odds with the position of the Board during prosecution of the '259 Patent.

The Manual of Patent Examining Procedure § 2163(II)(A)(3)(b), entitled "New Claims, Amended Claims, or Claims Asserting Entitlement to the Benefit of an Earlier Priority Date or Filing Date under 35 U.S.C. §§ 119, 120, 365, or 386," requires the Examiner to analyze whether claims in a subsequent, related application are entitled to the priority filing date of the parent application:

If the originally filed disclosure does not provide support for each claim limitation ... a new or amended claim must be rejected under 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph, as lacking adequate written description, or in the case of a priority or benefit claim under 35 U.S.C. 119, 120, 365, or 386, the priority or benefit claim must be denied.

M.P.E.P. § 2163(II)(A)(3)(b). Further, M.P.E.P. § 2103 requires that "[u]nder the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application." Therefore, all of the new claims added during prosecution were examined by the Examiners for compliance with the written description requirement of the first paragraph of 35 U.S.C. § 112. As discussed *supra* regarding the Prosecution History of the '259 Family, multiple Examiners in a multitude of applications have considered whether limitations comparable to the three different

sets of features identified by LinkedIn find adequate written descriptive support in the common specification. Notably, **none** of the Examiners who examined the applications in the '259 Family raised the issue as to whether adequate written descriptive support exists for this claim language.

In sharp contrast to the above facts, LinkedIn asks the Board to find that all six Examiners involved in the '259 Family not only failed to examine the claims for written descriptive support pursuant to the first paragraph of 35 U.S.C. § 112, but also that these Examiners failed to identify not just one – but three different sets of claim limitations – that lack written descriptive support. Paper No. 2, at 20-29. This is a far-fetched position that does not consider the reality of how patent applications are examined for compliance with every statutory requirement for patentability.

D. Legal Principles Regarding the Written Description Requirement

It is well settled that "the disclosure as originally filed does not ... have to provide *in haec verba* support for the claimed subject matter at issue," nor must it describe "every conceivable and possible future embodiment of [the] invention." *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1365 (Fed. Cir. 2003) (internal quotation marks omitted). The test for written descriptive support is "whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date." *Ariad Pharm*, 598 F.3d at 1351 (*en banc*). "[T]he test requires an objective

inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art. Based on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed." *Id.* Regarding the differences between the written description and enablement requirements, the Federal Circuit has stated "written description is about whether the skilled reader of the patent disclosure can recognize that what was claimed corresponds to what was described; it is not about whether the patentee has proven to the skilled reader that the invention works, or how to make it work, which is an enablement issue." *Alcon Research Ltd. v. Barr Labs., Inc.*, 745 F.3d 1180, 1191 (Fed. Cir. 2014). As will be described below, an objective inquiry into the four corners of the '259 Patent yields a conclusion the specification of '259 Patent reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter.

While LinkedIn's argument is that the specification of the '259 Patent does not provide written descriptive support, for ease of reference, Patent Owner will cite to both the '760 Patent and the '259 Patent. As discussed *supra* in footnote 6, the Detailed Descriptions in the '259 Family are substantively identical.

E. Reciprocally Linked Web Pages

(i) LinkedIn's Arguments

LinkedIn's assertions related to "bi-directional linked web pages" and "reciprocal link sites and/or reciprocal banner ad sites," Paper No. 2, at 28-29, ignore the original claim limitations, add unnecessary words to the claims, repeat positions already rejected by the Board, and are contrary to the specification. To support its mistaken position, LinkedIn relies on the Declaration of Loren Terveen:

The 2011 Application uses the word "*reciprocal*" in conjunction with the word "site," but it does so to indicate a location on one website where another website will be marketed. As used in the Application, this is a mere description of a *general willingness* to participate in linking services with an unknown and undefined set of other (currently existing as well as yet-to-be-designed) sites, but does not disclose the existence of, or establishing, a two-way linking relationship between two such sites.

Exhibit 1009, ¶ 52 (emphasis in original). As set forth in sections (ii), (iii), (iv), and (v), *infra*, LinkedIn's arguments fail.

(ii) Original Claim Language of "Reciprocal Site," Properly Construed, Provides Written Descriptive Support for Reciprocal Links

LinkedIn's arguments ignore the original claims of the '551 patent application. And, original claims constitute their own description. *See, e.g.*, M.P.E.P. § 2163, citing *In re Koller*, 613 F.2d 819 (CCPA 1980). Claim 4 of the '551 patent

application recites, in part, the limitations of "determining whether a *reciprocal site for the display of at least one marketing element* of a third party website exists in the first website." Exhibit 1004, page 702 (emphasis added). Originally-filed claim 5 further clarifies that "the *element for marketing the first website is a link* to the first website." Exhibit 1004, page 702 (emphasis added). LinkedIn also admits that the specification refers to a "reciprocal link site." Paper No. 2, at 22.

Thus, the language of "reciprocal site" in original claim 4 supplies its own written description, and this written description reflects a proper claim construction of the term "reciprocal site" as construed consistently with the specification, which also discloses a "reciprocal link site." In contrast to the construction provided by the original claims when read in context with the specification, Terveen's proposed claim construction requires "the word '*reciprocal*' [be used] in conjunction with the word 'site,' but it does so to indicate a location on one website where another website will be marketed" (emphasis in original). Exhibit 1009, ¶ 52. However, Terveen's definition is already encompassed by the term "site," which means a location. Exhibit 2001. Hence, Terveen's proposed construction of "reciprocal site" renders the term "reciprocal" superfluous, which is improper. The Federal Circuit disfavors any claim interpretation which would render a claim term superfluous. *Stumbo v. Eastman Outdoors, Inc.*, 508 F.3d 1358, 1362 (Fed. Cir. 2007).

(iii) LinkedIn's Claim Construction Ignores Ordinary and Customary Meaning of "Reciprocal"

Claims are to be given their ordinary and customary meaning in the absence of an express intent to impart a novel meaning to the claim terms. *Ferguson Beauregard v. Mega Systems*, 350 F.3d 1327, 1339 (Fed. Cir. 2003). The ordinary and customary meaning of a term can be determined from sources include dictionaries, the written description, and the prosecution history. *Id.* In this instance, the definitions of "reciprocal" include:

- "shared, felt, or shown by both sides," "serving to reciprocate : consisting of or functioning as a return in kind," "mutually corresponding." Exhibit 2002.
- "given or felt by each toward the other, mutual." Exhibit 2003.
- "(of an agreement or obligation) bearing on or binding each of two parties equally." Exhibit 2004.

Given these definitions, LinkedIn's position that "nothing in the 2011 Application discloses actually requiring links back to the specific webpage hosting the reciprocal link site and/or reciprocal banner ad" has no reasonable basis. Paper No. 2, at 28. The term "reciprocal" itself indicates a need for a link back, as evidenced by these definitions, which include the phrases "shown by both sides," "return in kind," "given ... by each toward the other," and "binding each of two parties equally."

Terveen's position that the term "reciprocal" is used "to indicate a location on one website where another website will be marketed" is not consistent with the above-reproduced definitions for "reciprocal." Consequently, Terveen's position has taken the term "reciprocal" and improperly rendered this term superfluous. *See, e.g., Stumbo*, 508 F.3d at 1362.

(iv) LinkedIn's Position Mirrors the Position Rejected by Board During Prosecution of the '551 Application

LinkedIn also asserts that the word "*reciprocal*" in conjunction with the word 'site,'" merely indicates a "location on one website where other websites will be marketed." Ex. 1009, ¶ 52. According to LinkedIn, "reciprocal" does not disclose the existence of, or establishing, a two-way linking relationship between two such sites. Paper No. 2 at 22. LinkedIn's proposed construction mirrors the Examiner's Answer on appeal to the Board during prosecution of the '551 Application:

The Examiner answers that the term "reciprocal site", according to Appellant's specification page 16, lines 10-25 and page 51, lines 15-25, simply means providing a space in a website such that third parties can place their ads in said place in said website."

Exhibit 1004 at 234. A comparison of LinkedIn's position (i.e., "a location on one website where other websites will be marketed") and the Examiner's previously-stated position (i.e., "a space in a website such that third parties can place their ads in said place") during prosecution of the '259 Patent shows that they are substantially

the same with regard to the claimed "reciprocal site" found in claim 4, as originally-presented in the '551 Application. However, in the Decision on Appeal dated June 15, 2009, Appeal No. 2009-00339, the Board disagreed:

4 *Claims 4-6*

5 Claim 4 depends from claim 1 and requires a reciprocal site. The Appellant
6 argues the Examiner failed to show such reciprocity in the site described in the
7 references (Reply Br. 9). We agree with the Appellant. The Examiner appears to
8 have ignored this limitation in the analysis by construing the term "reciprocal" to
9 mean simply mean a third party (Ans. 19). The Examiner refers to a definition of
10 reciprocal in the Specification at 16:20-25, but we are unable to discern any
11 definition at that section, which only refers to other, rather than reciprocal, sites.
12 Claims 5 and 6 depend from claim 4 and the same argument applies to those claims
13 as well.

Exhibit 1004 at 191 (page 15 of Decision on Appeal).

Put simply, the Board disagreed with the same position now set forth by Terveen and LinkedIn. Like the position of the Examiner, LinkedIn asserts that the "reciprocal" portion of "reciprocal site" means "simply ... a third party" (e.g., "it does so to indicate a location on one website where another website will be marketed"). However, as previously construed by the Board, the term "reciprocal site" requires "reciprocity." Since claim 4 was one of the originally-filed claims and provides written description support for itself, the proper claim construction of claim 4 informs the written descriptive support provided in the specification of the '551 Application for the term "reciprocal site."

(v) LinkedIn's Position is Inconsistent with the Specification of the '760 Patent

As discussed *supra* in the Claim Construction and Claim Support, aside from the specific mention of "reciprocal link site" in the Specification of the '760 and '259 Patents, there are other teachings that show that adequate written descriptive support existed for the limitations at issue. For example, a discussion of the "create links" option 1240 refers "websites to which the registered user desires its website to be linked" (i.e., a link from the registered user to other websites) and "create links to the registered user's website at other websites" (i.e., a reciprocal link back from the other websites to the registered user's website). Exhibit 1001 at 32, 15:24-45; Exhibit 1003 at 39, 15:4-25. These passages described the existence of two websites that link to each other (i.e., the website of the registered user include a link to other website(s), and the other website(s) include a link to the website of the registered user). Consequently, adequate written descriptive support exists for the claimed limitations that involve reciprocally-linked web pages.

F. Two Users Opting into a Reciprocal Linking Arrangement

LinkedIn mistakenly asserts that the claim phrases "*indication to opt into*" and '*reciprocal linking arrangement*' do not appear in the 2011 Application, nor any of the other Priority Applications." Paper No. 2, at 21 (emphasis in original). However, as noted above, the original disclosure does not have to provide in *haec*

verba support for the claim limitations. *See, e.g., Cordis Corp.*, 339 F.3d at 1365. Rather, the priority applications must indicate to a person skilled in the art that the inventor was "in possession" of the invention as later claimed. *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306 (Fed. Cir. 2008).

According to LinkedIn:

The 2011 Application uses the word “*reciprocal*” in conjunction with the word “site,” but it does so in a way merely to indicate a location on one website where other websites will be marketed. Ex. 1009, ¶ 52. It does not disclose the existence of, or establishing, a two-way linking relationship between two such sites.

Paper No. 2, at 22 (emphasis in original). Yet, this is the same unsuccessful argument about "reciprocal" (i.e., "It does not disclose the existence of, or establishing, a two-way linking relationship between two such sites") that the Board already refuted. Exhibit 1004 at 191. Because the specification supports "reciprocal linking," the specification also supports a "reciprocal linking arrangement," which is the arrangement upon which the inclusion of the reciprocal links in the webpages is based.

LinkedIn also asserts that the claim language "indication to opt into" requires the "necessity that two entities expressly agree to opt into a particular arrangement with each other" Paper No. 2 at 22-23. After reproducing a portion of the '760 Patent, LinkedIn concludes:

The passage falls short of disclosing the claimed subject matter. It does not describe how a first user is supposed to “*opt into*” a reciprocal linking arrangement with a particular second user. Instead, it merely recites that users may “*opt[] to participate*” in the linking and/or banner ad display functions. That does not describe a “*reciprocal linking arrangement*,” nor does it describe how a user “*opts into*” a particular arrangement with another user, nor does it describe how the system “*receive[s] an indication*” from a first or, more importantly, a second user “*to opt into*” that particular arrangement. Ex. 1009, ¶¶ 53-54. (emphasis added)

Paper No. 2, at 24 (emphasis in original).

LinkedIn's criticism of the specification as "not describ[ing] how a first user is supposed to 'opt into' a reciprocal linking arrangement" (emphasis omitted, underlined added), asks the wrong question. The written description requirement is separate from the enablement requirement, and enablement goes to "how" the invention works. *See Ariad Pharmaceuticals*, 598 F.3d at 1341.

This point aside, the specification provides sufficient written descriptive support for the limitations at issue, as discussed *supra* in the Claim Construction and Claim Support. The passage cited by LinkedIn is reproduced below:

By *completing these steps relating to the create links option 1240* and/or the banner ad rotations option 1250, *the registered user causes its website to participate in linking* and/or banner ad display *functions with other websites that also were created using the system*

100 by registered users who opted to participate in these linking and/or banner ad display functions. Once the design of the new website by the registered user is completed and the new website is posted/activated, *the system 100 causes the selected websites of other registered users* (i.e., the websites selected during the design of the new website) *to display a link and/or banner ad concerning the new website.* In the preferred embodiment, each website that is developed by a *registered user who opts to participate in the linking functions can display unlimited links to other registered users' websites.* If the number of links to be displayed exceeds the available display space on the display screen, links can be rotated on and off the screen. Each website that is developed by a registered user who opts to participate in the banner ad display functions can rotate an unlimited number of banner ads for other registered users' websites. The banner ads can be shown sequentially over a period of time at the registered user's website.

Exhibit 1001 at 39, 16:4-25; Exhibit 1003 at 32, 15:51-16:5 (emphasis added).

As previously argued, the links option 1240 involves reciprocal linking. Notably, this passage discloses a "registered user who opts to participate in the linking functions" and "the registered user causes its website to participate in linking ... functions with other websites that also were created using the system 100 by registered users who opted to participate in these linking ... functions." Exhibit 1001 at 39, 16:5-10,16-17; Exhibit 1003 at 32, 15:52-57,63-64. Therefore, both the registered user and previously-registered users have opted into the linking functions,

which includes reciprocal links. *Id.* Moreover, the opting in process includes, for example, "identify[ing] addresses for websites to which the registered user desires its website to be linked." Exhibit 1001 at 39, 15:26-28; Exhibit 1001 at 32, 15:6-8.

By way of example, if User A selects the website of User B to link to, and User B selects the website of User A to link to, then both users have opted into the same reciprocal linking arrangement. Therefore, adequate written descriptive support exists for the claimed "receiving, from a first computer associated with the first user, a first indication to opt into a reciprocal linking arrangement" and "receiving, from a second computer associated with the second user, a second indication to opt into the reciprocal linking arrangement."

G. Establishing Reciprocal Linking Arrangement Within a Database

As discussed *supra* regarding Claim Construction and Claim Support and contrary to LinkedIn's assertion, the challenged claims do not require a "reciprocal linking arrangement database." Instead, the challenged claims recite "establishing, within a database associated with the computer hardware system, the reciprocal linking arrangement." The limitations at issue find support in the specification here:

If the STAY STICKY.TM. selection received at step 2004 is to create links, the system 100 then receives marketing location selections at the user interface at step 2018. The marketing location selection information can be provided by the registered user at location selection menu 1260. *Upon receiving the marketing location selection*

information, the marketing location selection information is stored at third party user database 160 at step 2020. This stored information is later used to generate links at the selected marketing locations (i.e., websites) when the registered user's website is activated. The system 100 then proceeds to step 2022, at which the system determines whether a reciprocal link site has already been created in the registered user's website, for displaying links to other websites. If a link site has not yet been created, the system creates a link site on the registered user's website, at step 2024 before returning to step 1650. Otherwise, the system 100 immediately returns to step 1650.

Exhibit 1001 at 43, 24:46-62; Exhibit 1003 at 36, 24:25-41 (emphasis added).

The specification uses the term "marketing locations" and "websites" interchangeably. Exhibit 1001 at 43, 24:54-55; Exhibit 1003 at 36, 24:33-34. With this in mind, '760 Patent discloses "[u]pon receiving the [website] selection information, the *[website] selection information is stored at ... database 160 ...* [and t]his stored information is later used to generate links at the selected websites." Exhibit 1001 at 43, 24:50-55; Exhibit 1003 at 36, 24:29-34 (emphasis added).

As previously discussed, "the registered user can identify addresses for websites to which the registered user desires its website to be linked" and "[o]nce the registered user has selected its desired marketing locations on location selection menu 1260, the system 100 has sufficient information to create links to the registered user's website at other websites." Exhibit 1001 at 39, 15:24-45; Exhibit 1003 at 32,

15:4-25. The identification of address for websites (e.g., website selection information) that the registered user desires its website to be linked is an example of a user opting into a reciprocal linking arrangement, and this website selection information is then stored in the database, as discussed *supra*.

Consequently, the above passages provide written descriptive support for a user opting into a reciprocal linking arrangement, the reciprocal linking arrangement being established within a database, and then generating the reciprocal links based upon the reciprocal linking arrangement.

II. The Challenged Claims are Not Obvious in View of LinkedIn's Version of the '259 Patent

A. The '259 Patent is Not Prior Art

Because all of the challenged claim language finds written descriptive support in the common specification of the '259 Family, the '760 Patent properly claims priority at least to the June 7, 2000, filing date of the '551 Application, and consequently, the '259 Patent is not prior art under Section 102. *See* 35 U.S.C. § 120.

B. Horstmann is Closer Prior Art Than LinkedIn's Misrepresentation of the '259 Patent

Pursuant to 35 U.S.C. § 325(d), LinkedIn asserts that "neither 'the same or substantially the same prior art or arguments previously were presented to the Office' during the prosecution of the '760 Patent." Paper No. 2, at 3. While this may

technically true, because LinkedIn's version of the '259 Patent, the "*LV-'259 Patent*," is allegedly lacking support for several claim limitations, Paper No. 2 at 10-11, it is *not* the closest prior art considered by the Patent Office when examining the claims of either the '760 Patent or the claims in the '259 Family. Instead, U.S. Patent No. 6,995,099 to Horstmann appears to be the closest prior art reference. Even though LinkedIn undoubtedly knew about Horstmann, LinkedIn does not rely on Horstmann as prior art, electing instead to rely on its *LV-'259 Patent* alone. Paper No. 2, at 36, footnote 11 ("Petitioner cites Horstmann as information regarding the state of the art and in support of why a PHOSITA would be motivated to modify DiStefano ('259)").

Horstmann contemplates both reciprocal links and discloses an automated system for automatically creating one link that is intended to be part of reciprocal links. Exhibit 1008 at 10, 1:55-62, 4:7-11. Moreover, Horstmann discloses a user that opts into an arrangement in which reciprocal links are the desired result. Exhibit 1008 at 11, 3:14-26. These teachings provide a considerably closer starting point to the challenged claims than LinkedIn's *LV-'259 Patent*. Moreover, Horstmann has a filing date of June 10, 1996, which pre-dates the earliest possible claim of priority that could be made for the '760 Patent. Thus, there would be no need to consider whether the '760 Patent properly claims priority back to the '259 Patent. Therefore, on multiple fronts, Horstmann looks like the better reference.

LinkedIn, however, cannot cite Horstmann and make the statement, pursuant to 35 U.S.C. § 325(d), that "neither 'the same or substantially the same prior art or arguments previously were presented to the Office during the prosecution of the '760 Patent." Specifically, Horstmann was cited by applicant during prosecution of the '760 Patent. Exhibit 1002 at 23. Additionally, while Horstmann was not explicitly cited in any rejection during prosecution of the '760 Patent, Horstmann was explicitly cited in a rejection under 35 U.S.C. § 103, during the prosecution of the '971 Reissue Patent, which includes many of the same limitations found in the challenged claims, as discussed *supra* regarding the Prosecution History of the '259 Family. Notably, during prosecution of the '971 Reissue Patent, the claims at issue were distinguished over Horstmann.¹⁶ That the Patent Office, *in a reissue proceeding*, found the claims at issue to be patentable over Horstmann, *a closer reference*, is evidence that there is no reasonable likelihood of success for LinkedIn's proposed rejection based on the *LV-'259 Patent*.

¹⁶ Notwithstanding the closeness of Horstmann to the claimed invention, as will be discussed in more detail below, Horstmann does not render the claimed invention obvious.

C. "Common Sense" Cannot Be Used to Supply a Missing Limitation

In the Petition, LinkedIn identifies the alleged deficiencies of its *LV-'259 Patent* as follows:

For example, no reciprocal linking arrangement is disclosed in the specification of the 2011 Application in which two web pages of two different web sites link to each other. The 2011 Application also fails to disclose two different users “opting into” the same “reciprocal linking arrangement,” as well as storing reciprocal linking arrangement-related information in a database.

Paper No. 2, at 32. To make up for those alleged deficiencies, LinkedIn's expert Terveen opines:

A PHOSITA would have understood that it would have been *common sense* for the system to receive an indication of the first user's agreement (opt in) to participate in a reciprocal linking arrangement with the second website.

Exhibit 1009 at 33, ¶ 66 (emphasis added).

The emphasized portion is a fundamental flaw in Terveen's and LinkedIn's obviousness arguments for multiple reasons. First, the Federal Circuit has clarified that only in situations in which "the limitation in question [is] unusually simple and the technology particularly straightforward" can common sense be used to supply a limitation missing from the prior art. *See Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d

1355, 1362 (Fed Cir. 2016). Otherwise, obviousness is not intended to be used to supply a missing limitation. *Id.* at 1361 ("common sense is typically invoked to provide a known *motivation to combine*, not to supply a missing claim limitation") (emphasis in original). However, Terveen explicitly relies upon "common sense" to supply the allegedly missing limitation, which is improper.

Terveen improperly asserts that "[m]odifying DiStefano ('259) to require and track explicit opting into a reciprocal linking arrangement between multiple users would have been a simple implementation of routine and ordinary website functionality." Exhibit 1009 at 34, ¶ 67. However, this is not the same as alleging that the limitations at issue are "unusually simple" and that the technology is "particularly straightforward." Saying the something is "simple," for example, is not the same as saying that something is *unusually* simple. By using the phrase "unusually simple," the Federal Circuit placed a high bar upon the use of "common sense" in supplying a missing limitation that Terveen's opinion has not overcome. *See DSS Technology Management, Inc. v. Apple Inc.*, 885 F.3d 1367, 1375 (Fed. Cir. 2018) ("As in *Arendi*, the limitation at issue here is not 'unusually simple,' and the technology is not 'particularly straightforward'").

The Trial Practice Guide Update of August 2018¹⁷, further elaborates the requirements for asserting that a missing limitation would have been obvious:

Similarly, in an obviousness analysis, conclusory assertions from a third party about general knowledge in the art cannot, without supporting evidence of record, supply a limitation that is not evidently and indisputably within the common knowledge of those skilled in the art. *K/S Himpp v. Hear-Wear Techs., LLC*, 751 F.3d 1362, 1365 (Fed. Cir. 2014). Furthermore, because an inter partes review may only be requested “on the basis of prior art consisting of patents or printed publications,” 35 U.S.C. § 311(b), *expert testimony cannot take the place of disclosure from patents or printed publications*. In other words, expert testimony may explain “patents and printed publications,” but is not a substitute for disclosure in a prior art reference itself. (emphasis added)

Trial Practice Guide of August 2018 at 5. Contrary to the explicit guidance of the Trial Practice Guide, Terveen is not "explain[ing]" LinkedIn's *LV-'259 Patent*. Rather, LinkedIn is improperly using Terveen's testimony to supply nearly all of the limitations recited in challenged claim 1 of the '760 Patent since LinkedIn has

¹⁷ See https://www.uspto.gov/sites/default/files/documents/2018_Revised_Trial_Practice_Guide.pdf.

already argued that nearly all of the limitations recited in challenged claim 1 are missing from its version, the *LV-'259 Patent*.

D. LinkedIn's Expert's Position that the Missing Limitation is "Common Sense," "Natural," and "Highly Prudent" is Contradicted by the Teachings of Horstmann

To support his assertion that it would have be "common sense" to make the modification, Terveen further opines:

Specifically, a PHOSITA would understand that modifications to a user's web page would not be made without that user's permission, and it would be *natural for a user to assent to changes* that resulted in broader marketing exposure through reciprocal links ... It would be *highly prudent for the first user to be sure that this other site was appropriate to be linked* to, e.g., that it was reputable and relevant to the first user's business or purpose. Therefore, explicit "opting in" by the first user would have been a reasonable and obvious design choice.

Exhibit 1009 at 34-34, ¶ 66 (emphasis added).

Terveen's assertion that it would be "natural for a user to assent to changes" and "highly prudent for the first user to be sure that this other site was appropriate to be linked" is *directly contradicted* by Horstmann. A portion of Figure 3 of Horstmann is reproduced below:

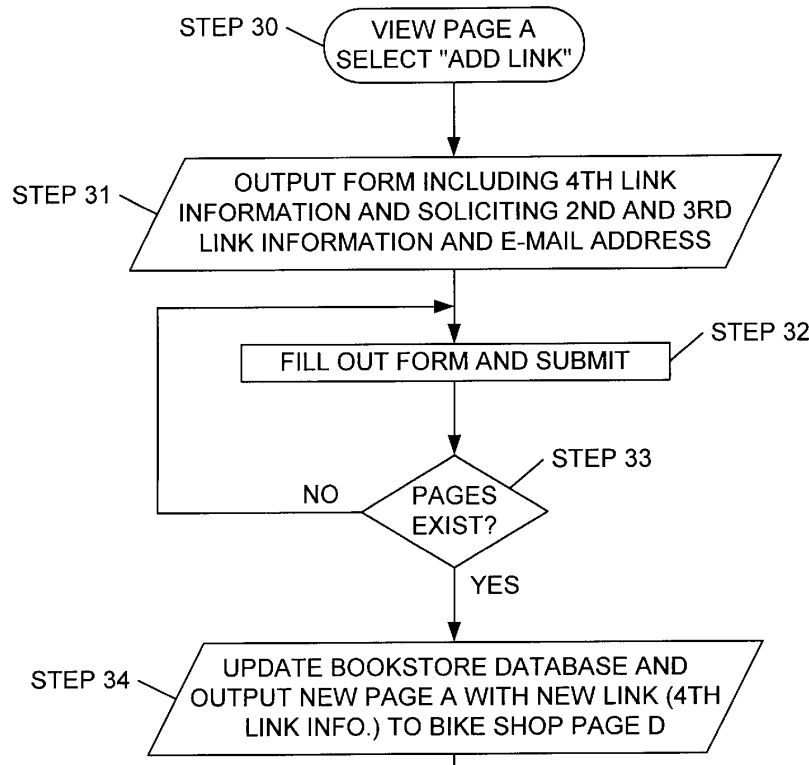


Exhibit 1008 at 3. As described in Horstmann:

Once the bike-shop owner specifies second and third link information corresponding to existing pages, the method moves to step 34, in which the server containing page A is updated so that page A includes a link to page D, as specified by the fourth link information entered in form 4.

Exhibit 1008 at 11, 4:7-11. If it was "natural for a user to assent to changes" and "highly prudent for the first user to be sure that this other site was appropriate to be linked," then Horstmann would have taught an additional step between step 33 and step 34 of Horstmann.

Not only does Horstmann not describe a need for the user to assent to the changes, Horstmann extolls that *user intervention* is *not needed*. Specifically, Horstmann teaches:

Once the bike-shop owner fills out form 4, the bike-shop owner selects a "form complete" button 7, which initiates a transfer of the form data to the server supporting form 4 (hereafter the "links server"). The links server includes software that presents and processes forms, and could be the same server that maintains the bookstore's pages or some other server. Software on the links server (step 4) automatically modifies page A to include a link 6 (the fourth link information) from page A to page D as requested by the bike-shop owner. The new page A, including the link to page D, is then redisplayed to the bike-shop owner. Thus, *page A is modified and redisplayed without any intervention from the bookstore owner*.

Exhibit 1008 at 11, 3:14-26 (emphasis added).

Contrary to Terveen's position, it cannot be "common sense," "natural," and "highly prudent" to include these missing limitations when Horstmann teaches that the modification to the bookstore website is made "without any intervention" from the owner of the bookstore website. To assent to a change would be an intervention, which is something that Horstmann states is not required. Therefore, Terveen's assertions that the limitations at issue are "common sense," "natural," and "highly prudent" are directly contradicted by the teachings of Horstmann.

E. LinkedIn's Expert Misrepresents Horstmann's Figure 5 As Requiring Reciprocal Links

In further support of his position that it would have been obvious to include the missing limitations, Terveen also opines:

Horstmann explicitly discloses *a process where one entity (bike-shop) must approve reciprocally linking with the other website (bookstore)*. (*Id.* at 5:17-21 (“The bike-shop owner can then approve the page by, for example, selecting a ‘page approved’ button (step 56), in which case the software will update the server to include the new page (step 57). Alternately, in step 56 the bike-shop owner could elect not to approve the new links page, in which case the method would return to step 51 in which a form solicits links-page layout data.”).)

Exhibit 1009 at 34, ¶ 68. (emphasis added).

Terveen's reliance upon the teachings in Figure 5 of Horstmann is misplaced. Contrary to Terveen's analysis, rather than teaching "a process where one entity (bike-shop) must approve reciprocally linking with the other website (bookstore)," Figure 5 of Horstmann *does not involve the creation of reciprocal links* between websites.¹⁸

¹⁸ While other portions of Horstmann refer to an automated process of creating a link that is intended to be a reciprocal link followed by a verification process, Figure 5 is directed to *something different*. For Terveen to rely on Figure 5 for reciprocal links

Instead, Figure 5 "is a flow diagram illustrating a method used to create a links page similar to links page 400." Exhibit 1008 at 11, 4:43-44. Put differently, Figure 5 of Horstmann describes the creation of a links page 400 – not the creation of links. Exhibit 1008 at 10, 2:16-17. As stated by Horstmann:

Suppose that the bike-shop owner is impressed with the "add-link" feature of page A and would like to have bike-shop site 2 support such a feature. The bike-shop owner could begin the method of creating such a links page for bike-shop site 2 by pressing create-links-page button 450 at the bottom of links page 400. Link information associated with create-links-page button 450 accesses a form that is then displayed to the bike-shop owner. This *form solicits information pertinent to the creation of a links page specific to bike-shop site 2*. For example, the form could solicit link information corresponding to an HTML file (a page) that specifies an appropriate layout for a page associated with bike-shop site 2. This will *allow the new links page to provide the same look and feel as the other bike shop pages*.

Exhibit 1008 at 11, 4:47-60 (emphasis added).

According to Horstmann, the bike-shop owner, wanting to have a links page 400, proceeds through the process of Figure 5 to have such a links page 400 created for the bike-shop site 2. Exhibit 1008 at 11, 4:47-52. The bike-shop owner provides

is evidence of Terveen's failure to accurately comprehend what is being taught by Horstmann.

information that provides "the same look and feel as the other bike shop pages." Exhibit 1008 at 11, 4:56-60. Additionally, the bike-shop owner provides information regarding "one or more links to other pages." Exhibit 1008 at 11, 4:66-5:4. These links are checked (to determine if they link to an existing web page) in step 52 and the links page 400 is created in step 54 after the checks have been made. Exhibit 1008 at 12, 5:5-16. The bike-shop owner is then presented with an opportunity to review the links page 400 in step 55. Exhibit 1008 at 12, 5:16-24. Once approved, the links page 400 is stored in the links server. Exhibit 1008 at 12, 5:25-33.

While Terveen describes this process as involving "a process where one entity (bike-shop) must approve reciprocally linking with the other website (bookstore)," the creation of reciprocal links is not involved. The bookstore has nothing to do with this process and is not obligated to create a reciprocal link back to the bike-shop page. Instead, the process illustrated in Figure 5 of Horstmann *unilaterally* involves the bike-shop. The bike-shop owner provides all the information for the links page 400, and the links page 400 will be associated with the bike-shop page. By asserting that Figure 5 describes "a process where one entity (bike-shop) must approve reciprocally linking with the other website (bookstore)," Terveen has misrepresented the teachings of Horstmann. Exhibit 1009 at 34, ¶ 68.

F. LinkedIn's Expert Again Misrepresents Horstmann As Disclosing The Requirement to "Opt-In" by Two Parties

Terveen's characterization of Figure 5 of Horstmann is not the only instance in which Terveen has misrepresented Horstmann. For example, Terveen states:

Horstmann further teaches means for the two parties to opt in to the reciprocal linking arrangement and for that arrangement to be stored in a database.

Exhibit 1009 at 20, ¶ 20. However, as already discussed above, Horstmann explicitly teaches that "page A is modified and redisplayed *without any intervention* from the bookstore owner." Exhibit 1002 at 11, 3:24-26 (emphasis added). Thus, two parties (i.e., the bookstore owner and the bike-shop owner) do not opt into the reciprocal linking arrangement – contrary to that asserted by Terveen.

G. LinkedIn Cannot Prevail Against Any of the Challenged Claims

As admitted by LinkedIn, its *LV-'259 Patent* does not disclose "two different users 'opting into' the same 'reciprocal linking arrangement.'" Paper No. 2, at 32. While Terveen opines that such a limitation is "common sense," the Federal Circuit disfavors the use of "common sense" to supply a missing limitation in an obviousness rejection. Moreover, it is not "common sense," "natural," and "highly prudent" to include these missing limitations in its *LV-'259 Patent*, as alleged by Terveen, when Horstmann teaches that the modification to the bookstore website is made "without any intervention" from the owner of the bookstore website – i.e., one

of the users does not opt into a reciprocal linking arrangement. Thus, independent claim 1 of the '760 Patent is not obvious in view of LinkedIn's *LV-'259 Patent* at least¹⁹ for these reasons.

Independent claim 11 is substantially similar to independent claim 1 and is not obvious in view of *LV-'259 Patent* for the same reasons. Since independent claims 1 and 11 are not obvious in view of the *LV-'259 Patent*, dependent claims 2-10 and 12-20 are also not obvious in view of the same. *In re Fine*, 837 F .2d 1071, 1076 (Fed. Cir. 1988) ("Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.").

¹⁹ Patent Owner does not concede that these are the only reasons why claim 1 of the '760 Patent is not obvious in view of LinkedIn's *LV-'259 Patent*.

CONCLUSION

LinkedIn has failed to establish either (1) that the '760 Patent's priority claim to the '259 Patent fails, or (2) in the remote chance that such priority claim fails, that all the challenged claims are obvious under section 103 based on LinkedIn's warped interpretation of the '259 Patent. Therefore, institution by the Board of *inter partes* review is not appropriate, and the Board should deny the petition.

Date: March 14, 2019

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

Patent Owner's Preliminary Response complies with the type-volume limitations of 37 C.F.R. §§ 42.24(a)(1)(i), 42.24(b)(1). Specifically, this Preliminary Response contains 10,799 words, excluding the parts of the Preliminary Response exempted by 37 C.F.R. § 42.24(a).

The Preliminary Response was prepared in a proportionally space typeface using Microsoft Word 2013 in a 14 point Times New Roman Font.

Date: March 14, 2019

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CERTIFICATE OF SERVICE

The undersigned certifies that Patent Owner's Preliminary Response and Exhibits 2001-2004 were served on March 13, 2019, via e-mail pursuant to 37 C.F.R. § 42.6(e)(1), at the following email address listed on Page 1 of the Mandatory Notices in the Petition:

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