

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIANT TECHNOLOGY LLC and LIVEINTENT, INC.,
Petitioner

v.

ALMONDNET, INC.,
Patent Owner

Case IPR2025-01163
U.S. Patent No. 8,959,146

**PETITIONER'S OPPOSITION TO
PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL**

TABLE OF CONTENTS

I.	Introduction.....	1
II.	The '146 Patent Issued Only As A Result Of The Examiner's Material Error During Prosecution, Thus Justifying Referral Of The Petition.	3
III.	Board Review Would Streamline Complex Issues in the Co-Pending District Court Litigation.....	9
IV.	Patent Owner Overestimates Its Settled Expectations Regarding the '146 Patent.	10
V.	Neither The Petition's Expert Testimony nor Its Reliance on Obviousness Grounds Favors Discretionary Denial.	11
VI.	The Fintiv Factors Do Not Favor Discretionary Denial.	12
	A. Factors 1 and 5: No Pending Stay Has Been Requested, and the Same Parties Are in the Co-Pending Litigation.....	12
	B. ... Factors 2-3: The Court's Trial Date Would Occur Well After the Final Written Issue Is Issued, and Limited Resources Would Have Been Expended by Institution.	12
	C. Factor 4: There Is No Overlap Between the Issues in the Petition and the District Court Proceeding.....	13
	D. Factor 6: Other Circumstances Weigh in Favor of Referral.....	14
VII.	Conclusion	15

EXHIBITS

VLI-1001	U.S. Patent No. 8,959,146 to Shkedi (“the ’146 Patent”)
VLI-1002	Excerpts from the Prosecution History of the ’146 Patent (“the Prosecution History”)
VLI-1003	Declaration and Curriculum Vitae of Dr. Michael Mitzenmacher
VLI-1004	RESERVED
VLI-1005	U.S. Pat. App. Pub. No. 2007/0260514 to Burdick et al. (“Burdick”)
VLI-1006	U.S. Pat. App. Pub. No. 2007/0244750 to Grannan et al. (“Grannan”)
VLI-1007 -1008	RESERVED
VLI-1009	Excerpts from the Prosecution History of U.S. Patent No. 8,671,139 (“the ’139 Prosecution History”)
VLI-1010	First Amended Complaint for Patent Infringement in 23-cv-174-MN
VLI-1011	First Amended Complaint for Patent Infringement in 24-cv-831-MN
VLI-1012	RESERVED
VLI-1013	Interim Process for PTAB Workload Management
VLI-1014 - 1019	RESERVED
VLI-1020	U.S. Patent No. 8,600,784 to Ivey et al. (“Ivey”)
VLI-1021	U.S. Pat. App. Pub. No. 2005/0086087 to Razza et al. (“Razza”)
VLI-1022	U.S. Pat. App. Pub. No. 2007/0233530 to Blaszkka et al. (“Blaszkka”)

VLI-1023	Milgrom, P., 1989. Auctions and bidding: A primer. Journal of economic perspectives, 3(3), pp.3-22 (“Milgrom”)
VLI-1024	U.S. Pat. App. Pub. No. 2002/0029186 to Roth et al. (“Roth”)
VLI-1025	U.S. Pat. App. Pub. No. 2005/0165643 to Wilson et al. (“Wilson”)
VLI-1026	Hormozi, A.M., 2005. Cookies and privacy. Information Security Journal, 13(6). (“Hormozi”)
VLI-1027	U.S. Pat. App. Pub. No. 2002/0166117 (“Abrams”)
VLI-1028	Rappa, M.A., 2004. The utility business model and the future of computing services. IBM systems journal, 43(1), pp.32-42. (“Rappa”)
VLI-1029	Herness, et. al., 2004. WebSphere Application Server: A foundation for on demand computing. IBM Systems Journal, 43(2), pp.213-237. (“Herness”)
VLI-1030	August 25, 2025 Stipulation
VLI-1031	Excerpts from the Prosecution History of U.S. Patent No. 11,836,759
VLI-1032	U.S. Patent No. 8,677,398 (’398 Patent)
VLI-1033	U.S. Patent No. 10,984,445 (’445 Patent)
VLI-1034	U.S. Patent No. 8,494,904 (’904 Patent)
VLI-1035	Scheduling Order, <i>AlmondNet, Inc. v. LiveIntent, Inc.</i> , 1:24-cv-00831, D. Del., filed August 25, 2025
VLI-1036	Stay Order, <i>AlmondNet, Inc. et al v. Viant Technology Inc. et al.</i> , 1:23-cv-00174-MN, D. Del., filed February, 26, 2025

I. Introduction

The Patent Trial and Appeal Board (Board) is uniquely suited to assess the patentability of the challenged claims of the '146 Patent. The '146 Patent is part of a sprawling family of *fourteen* U.S. patents that claim overlapping subject matter, and Patent Owner continues to expand the family.¹ The prosecution histories of these patents tell a simple story for those familiar with patent prosecution, such as the Board. In examining the '146 patent, the Examiner failed to consider references the Examiner himself surfaced during prosecution of the parent case (U.S. Patent No. 8,671,139). Had the Examiner simply considered a reference, Burdick (VLI-1005), *included in the Examiner's prior search*, the Examiner would have determined that the '146 Patent claims are unpatentable. This failure amounts to a pervasive material error, stretching across several patent family members and reflecting a pattern of examination flaws that the Patent Office is best equipped to understand. Such a material error favors referral.

The Board's review of the '146 Patent would also represent the most efficient allocation of judicial and administrative resources. In addition to the significant errors that occurred during examination of the '146 Patent family, Patent

¹ See, e.g., pending family member 18/384,836.

Owner has asserted in a parallel district court litigation three other patents with divergent subject matter, creating a complicated technological backdrop ill-suited for a district court. The Board's technical expertise and familiarity with patent law and examination make it the optimal forum to address and simplify this complexity.

Other considerations also favor referral. The '146 Patent family's enforceable life has been repeatedly disrupted by intervening events—including multiple terminal disclaimers, including as late as 2023,² and a 2023 Board finding related to unpatentability of similar claims of a related family member—thus negating the Patent Owner's assertion of settled expectations merely on the basis that the '146 Patent issued ten years ago. Furthermore, the parallel district court litigation is in its infancy, and Viant and LiveIntent (Petitioners) have filed a broader than *Sotera* stipulation to prevent overlap of issues between this *Inter Partes* Review (IPR) and that litigation.

Under these circumstances, allocating Patent Office resources to review the '146 Patent would allow the Patent Office to correct its own material errors and

² VLI-1031, 1, a terminal disclaimer listing U.S. Patents: 7747745, 8204783, 8200822, 8671139, 10475073, 10839423, 11301898, 11610226, 9208514, 9508089, 9830615, 10134054 and 8959146.

avoid unnecessary burden on the district court, which has been drawn into the dispute between Petitioners and Patent Owner because these material errors led to the improper issuance of the '146 Patent. Referral to the Board is therefore appropriate.

II. The '146 Patent Issued Only As A Result Of The Examiner's Material Error During Prosecution, Thus Justifying Referral Of The Petition.

Material error during patent prosecution strongly favors granting review over discretionary denial. Correcting such errors is critical, often overriding a Patent Owner's settled expectations or factors supporting a *Fintiv* denial. For settled expectations, see *Anthony, Inc. v. ControlTec, LLC* ("*Anthony*"), IPR2025-00559, Paper 12, at 2 (PTAB July 16, 2025) (strong settled expectations in patents that have been in force for approximately 18 and 17 years overcome by a material error showing, making it "an appropriate use of Office resources to review the potential error."); *Xencor, Inc. v. Merus N.V.*, IPR2025-00604, Paper 12, at 2-3 (PTAB July 17, 2025) (petition issued as a result of a "material error" was referred to panel despite strong expectations in a nine-year-old patent); *Eunsung Global Corp. v. Hydrafacial LLC* ("*Eunsung*"), IPR2025-00445, Paper 14, at 2 (PTAB July 10, 2025) (petition referred despite an eight-year-old patent). For *Fintiv*, see *Microsoft Corporation v. Partec Cluster Competence Center GMBH*, IPR2025-00318, Paper 9, at 2 (PTAB June 12, 2025) (petition referred despite trial one month before Final Written Decision due to Examiner's oversight of prior art); *Padagis v. Neurelis*,

Inc., IPR2025-00464-466, Paper 12, at 2-3 (PTAB July 16, 2025) (petition referred despite trial five months prior due to Examiner’s contradiction of prior Board priority date ruling). See *also Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025-00152, Paper 11, at 2 (PTAB June 12, 2025); *Microsoft Corp. v. XI Discovery, Inc.*, IPR2025-00253, Paper 13, at 2 (June 25, 2025).

As explained in §§IV-VI below, Patent Owner has no settled expectations and *Fintiv* denial is plainly inappropriate. Even if this were not the case, however, referral to the merits panel would still be appropriate to allow the Board to correct a material error that occurred during prosecution of the ’146 patent and of its parent application, the ’139 patent.

Patent Owner acknowledges that U.S. Patent No. 8,671,139, the parent of the ’146 patent, has “similar independent claims.” DD, 5. To avoid material error, therefore, the Examiner’s prior art search for the ’139 patent should have been applied to the ’146 patent’s prosecution. This was not done.

During prosecution of the ’139 patent, the Examiner used the search string:

S12	18626	((advertis\$3 or market\$3 or advertisement\$1) near4 \$3line)	US-PGPUB; USPAT	ADJ	ON	2012/08/26 12:05
-----	-------	--	--------------------	-----	----	---------------------

VLI-1009, 140.

Replicating this search³ against the USPTO database⁴ produces results that include the Burdick reference, as shown below:

Highlight: market 2007 advertising online

Distributed Architecture For Online Advertising

DOCUMENT ID		DATE PUBLISHED			
US 20070260514 A1		2007-11-08			
INVENTOR INFORMATION					
NAME	CITY	STATE	ZIP CODE	COUNTRY	
Burdick; Brian	Bellevue	WA	N/A	US	
Meek; Christopher A.	Kirkland	WA	N/A	US	
Chickering; David M.	Bellevue	WA	N/A	US	
Dominowska; Ewa	Kirkland	WA	N/A	US	
Biggs; Jody D.	Redmond	WA	N/A	US	
ASSIGNEE INFORMATION					
NAME	CITY	STATE	ZIP CODE	COUNTRY	TYPE CODE
Microsoft Corporation	Redmond	WA	98052	US	02
APPLICATION NO		DATE FILED			
11/418905		2006-05-05			
US CLASS CURRENT:					
705/14.46,705/14.71,705/14.53					
CPC CURRENT					
TYPE	CPC			DATE	
CPCI	G 06 Q 30/02			2013-01-01	
CPCI	G 06 Q 30/0255			2013-01-01	
CPCI	G 06 Q 30/0247			2013-01-01	
CPCI	G 06 Q 30/0275			2013-01-01	

The Examiner's failure to consider the Burdick reference, despite it being identified by the Examiner's search during the '139 patent's prosecution, constitutes the Examiner's **first material error**, especially since Patent Owner concedes that the '139 and '146 patents share similar independent claims VLI-1009, 140;

³ To address the asserted Critical Date, Petitioner limited results to applications filed before 6/16/2006. Petitioner does not concede that this Critical Date is accurate.

⁴ <https://ppubs.uspto.gov/pubwebapp/>

VLI-1002, 110-116; DD, 5. Given the similarity between their independent claims, this error resulted in deficient prosecution of both the '139 and '146 patents, as the Examiner overlooked Burdick's critical teachings, which could have prompted rejections of the '139 patent's claims and, as detailed in the Petition, would have barred issuance of the '146 patent's Challenged Claims. The Examiner's clear error is further exacerbated by the fact that, in an Applicant Initiated Interview, the Examiner himself noted the similarity to the parent case ("the allowed claim "recites similar features from allowed parent case 13/491,454"), yet completely ignored Burdick when proposing the amendments that resulted in allowance. VLI-1002, 102 ("Examiner proposed amendments for applicant's consideration, by canceling claim 1 and re-writing claim 1 as new claim 37 [, and] agreement was reached regarding canceling claim 1, and including limitations and features within new independent claim 37").

Additionally, when examining the '146 patent, the Examiner did not replicate the search from the parent application (the '139 patent), inexplicably omitting the search string identified above:

S12	18626	((advertis\$3 or market\$3 or advertisement\$1) near4 \$3line)	US-PGPUB; USPAT	ADJ	ON	2012/08/26 12:05
-----	-------	--	--------------------	-----	----	---------------------

VLI-1002, 110-115 (listing the search strings used instead). The Examiner's failure to replicate the prior art search from the '139 patent's prosecution when examining the '146 patent constitutes a **second material error**. VLI-1002, 140-115.

Despite the patents' nearly identical independent claims, as conceded by Patent Owner (DD, 5), the Examiner omitted the search string that identified the Burdick reference during the '139 patent's prosecution. The Petition demonstrates that Burdick is clearly material prior art to the '146 patent's Challenged Claims, yet the Examiner inexplicably failed to consider it. This oversight, stemming from the Examiner's neglect to apply the same search to the '146 patent, prevented proper evaluation of both patents' claims.

These significant errors—failing to consider a key prior art reference surfaced by the Examiner's own search and failing to perform that same search for a child application having very similar claims—strongly weighs against discretionary denial and independently justifies referring the Petition to the merits panel. Indeed, the Director has referred petitions to the merits panel under similar and even less compelling circumstances.

For example, in *Anthony*, the Board stated the following, "Although the challenged patents have been in force for approximately 18 and seventeen years, Petitioner appears to show a material error by the Office and it is an appropriate use of Office resources to review the potential error." *Anthony*, 2. In *Anthony*, the Director referred the patent to the merits panel due to the examiner's inadequate and incomplete prosecution, which resulted in a quick allowance of the subject pa-

tent suggestive of a deficient search. And the deficiency of that search was revealed by the examiner's failure to identify and consider the Carter reference, which was shown by the petitioner to disclose the allowable subject matter. Here, the Examiner's deficient search is even more evident than in *Anthony*, as the Examiner used a search string that actually identified the Burdick reference and yet clearly overlooked the teachings of that reference by failing to consider it with respect to both the '139 patent and the '146 patent. Further, in *Eunsung*, the challenged patent, which had been in force for 8 years, was referred to the merits panel because the Examiner overlooked certain teachings in a prior art reference that disclosed the allowable features of the challenged claims. *Eunsung*, 2. By overlooking the teachings of Burdick and its anticipation of the Challenged Claims, the Office committed a similar material error "and it is an appropriate use of Office resources to review the potential error." *Anthony*, 2.

Additionally, Patent Owner's argument that the PTAB adjudicated validity of the Challenged Claims in IPR2022-01480 fails since that Petition does not address the glaring material error described above. DD, 5; IPR2022-01480, Paper 2, *generally*. Instead, it relied on Roth, a reference cited on the face of the '146 patent. VLI-1001, p. 2.

III. Board Review Would Streamline Complex Issues in the Co-Pending District Court Litigation.

AlmondNet's assertion of a "large number and vast scope of [] patents" directed toward "a diverse range of subject matter" in the parallel district court proceeding is the precise situation for which "the Board is better suited to review" issues of validity. *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9, at 2-3 (Jun. 13, 2025). The '146 Patent is one of four patents asserted in the Vi-ant district court litigation, and the other three patents are in unrelated families and cover subject matter distinct from the '146 Patent. VLI-1011, 1.⁵

For example, the '398 Patent is related to causing an action to be performed on a second electronic device (e.g., displaying an advertisement) in response to recognizing that a second electronic device is connected to the same local area network as a first electronic device. VLI-1032, 24:49-54. The '146 Patent is related to displaying an advertisement to an electronic visitor on a second media property based on a profile attribute correlated with the advertisement being received after the electronic visitor visits a first media property. VLI-1001, 12:64-13:5. The '445 Patent is related to delivering an advertisement to a visitor device as a result

⁵ Five patents, including the '146 patent, were asserted against LiveIntent. VLI-1010, 1.

of comparing (1) a visitor profile linked to a visitor device by a tag and (2) stored requests from media property entities. VLI-1033, 15:3-14. The '904 Patent is related to receiving a URL-redirected partial profile for use with delivering third-party advertisements. VLI-1034, 16:61-17:5.

Although all related to electronic advertising, these patents focus on a broad array of complex and disparate subject matter within electronic advertising. Such diverse technology in the district court litigation favors institution, as institution here would help narrow the issues in the co-pending litigation, ultimately conserving resources of the parties, the judiciary, and the Board.

IV. Patent Owner Overestimates Its Settled Expectations Regarding the '146 Patent.

Patent Owner's claim of settled expectations for the '146 Patent is undermined by a history of developments affecting its scope and validity. *First*, family member 9,830,615, with similar claims, had all challenged claims found unpatentable. (*Meta Platforms, Inc., Amazon.Com, Inc., Amazon Web Services, Inc., and Amazon.Com Services LLC. v. AlmondNet, Inc.*, IPR2022-01064, Paper 33, at 51 (PTAB Nov. 28, 2023).) *Second*, the '146 Patent's flawed examination process, resulting in material error, outweighs settled expectations. *See Anthony*, IPR2025-00559, Paper 12, at 2; *supra* Section II. Thus, discretionary denial is unwarranted despite the patent's age.

V. Neither The Petition’s Expert Testimony nor Its Reliance on Obviousness Grounds Favors Discretionary Denial.

Patent Owner argues that the Petition’s extensive expert testimony favors discretionary denial, as district courts better assess witness credibility. DD, 4-5. However, Patent Owner states that the expert merely “explain[s] the relevance of the prior art,” and Patent Owner does not even assert that the Petition relies on expert testimony to fill gaps in prior art for one simple reason: no such gaps exist. DD, 4. Further, the declaration complies with the Consolidated Trial Practice Guide (TPG), establishing the level of skill in the art, explaining prior art teachings, and providing reasons to combine references without substituting for prior art disclosures. *iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00377, Paper 10, at 2 (PTAB June 6, 2025); TPG 34-36; VLI-1003, *generally*. Thus, the expert testimony does not support denial.

Patent Owner’s claims that the Petition’s relies on obviousness (§ 103) rather than anticipation (§ 102) is a weak challenge. DD, 12. The statutory basis does not determine the challenge’s merits, which depend on the strength of facts and law. Patent Owner identifies no evidentiary or legal flaws in the Petition’s prior art or arguments. Thus, the use of obviousness does not favor discretionary denial.

VI. The *Fintiv* Factors Do Not Favor Discretionary Denial.

Every *Fintiv* factor is either neutral or weighs against discretionary denial.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential).

A. Factors 1 and 5: No Pending Stay Has Been Requested, and the Same Parties Are in the Co-Pending Litigation.

Factors 1 and 5 are neutral. No litigation stay has been requested in the LiveIntent trial; the Viant trial has been stayed. VLI-1036, 1. Further, the parties in the co-pending litigations and this IPR are the same.

B. Factors 2-3: The Court's Trial Date Would Occur Well After the Final Written Issue Is Issued, and Limited Resources Would Have Been Expended by Institution.

Factors 2 and 3 favor referral and, at worst, are neutral. The LiveIntent trial is scheduled for October 4, 2027. VLI-1035, 12. The Final Written Decision is expected in December 2026—well before the scheduled trial date. Indeed, Patent Owner and Petitioner have not exchanged infringement or invalidity contentions, proposed terms for claim constructions, or scheduled depositions. Patent Owner's opening claim construction brief is due September 25, 2026, fact discovery is not expected to be completed until August 28, 2026, and opening expert reports are not due until January 15, 2027. VLI-1035, 3-5, 7. The Viant trial is stayed with no trial date scheduled. VLI-1036, 1.

C. Factor 4: There Is No Overlap Between the Issues in the Petition and the District Court Proceeding.

Factor 4 strongly favors institution. In Patent Owner's view, Petitioner's broader-than-*Sotera* stipulation is insufficiently broad because it permits Petitioner to raise an invalidity ground based on system prior art in combination with prior art that reasonably could have been raised in this IPR proceeding. DD, 8-9. But the breadth of Petitioner's stipulation is identical to the breadth of stipulations in other proceedings where the Director determined the stipulations weighed against discretionary denial. *See Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9, at 2 (PTAB June 13, 2025); *Tesla*, IPR2025-00217, Paper 8, at 10-11 (PTAB May 27, 2025) (stipulation having same breadth as Petitioner's stipulation); *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00341, Paper 12, at 2 (PTAB June 13, 2025); *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00341, Paper 10, at 10-11 (PTAB May 27, 2025) (stipulation having same breadth as Petitioner's stipulation). Patent Owner's observation that the stipulation *could* be even broader does not alter the conclusion that Petitioner's stipulation weighs against discretionary denial.

Patent Owner claims Petitioner's broader-than-*Sotera* stipulation allows subsequent ex parte reexamination requests, potentially causing inefficiencies. DD, 10. However, this is irrelevant to inefficiencies with respect to co-pending district

court litigation and speculative, as no such reexamination exists. Statutory and administrative mechanisms mitigate inefficiencies: estoppel under 35 U.S.C. § 315(e)(1) prevents Petitioner from raising IPR grounds in later reexaminations; the Director can manage concurrent proceedings under 35 U.S.C. § 314(d); and the Patent Office can deny abusive reexamination requests under 35 U.S.C. § 325(d). *In re Vivint, Inc.*, 14 F.4th 1342, 1354 (Fed. Cir. 2021). Thus, Petitioner's stipulation is unnecessary.

D. Factor 6: Other Circumstances Weigh in Favor of Referral.

Factor 6 strongly favors referral. As discussed above, contrary to Patent Owner's assertion, the Petition's reliance on obviousness grounds has no bearing on the merits of unpatentability. DD, 12; *see supra* Section V. The Petition's merits are strong at least because it offers compelling evidence as to why the prior art teaches all features of the Challenged Claims of the '146 Patent. *See supra* Section II.B.3. And the other factors raised in Patent Owner's briefing—including settled expectations and expert testimony—do not favor discretionary denial, as discussed above. DD, 4-5; *see supra* Section V. In fact, other factors, such as material error and litigation complexity, favor referral. *See supra* Sections II-III.

VII. Conclusion

For these reasons, a holistic evaluation of the record strongly weighs against discretionary denial. Petitioner therefore respectfully requests that this case proceed to an institution determination on the merits.

Respectfully submitted,

Dated October 8, 2025

/Roberto J. Devoto/

W. Karl Renner, Reg. No. 41,265
Roberto J. Devoto, Reg. No. 55,108
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
T: 202-783-5070
F: 877-769-7945

Attorneys for Petitioners

CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4) and 42.205(b), the undersigned certifies that on October 8, 2025, a complete and entire copy of this Petitioner's Opposition to Patent Owner's Request for Discretionary Denial and Accompanying Exhibits were provided by email to the Patent Owner by serving the correspondence email address of record as follows:

Reza Mirzaie
James A. Milkey
Philip X. Wang
Benjamin T. Wang
RUSS, AUGUST & KABAT
12424 Wilshire Boulevard, 12th Floor
Los Angeles, CA 90025

Email: rmirzaie@raklaw.com
rak_almondnet@raklaw.com
jmilkey@raklaw.com
pwang@raklaw.com
bwang@raklaw.com

/Diana Bradley/
Diana Bradley
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
bradley@fr.com