

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 55246
	:	
Thomas DISTEFANO III	:	Confirmation Number: 9140
	:	
Application No.: 13/946,461	:	Group Art Unit: 3622
	:	
Filed: July 19, 2013	:	Examiner: K. Kolosowski-Gager
	:	
For: RECIPROCAL INSERTION OF IDENTIFICATION ELEMENTS FOR WEB PAGES		

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed February 11, 2019, wherein Appellant appeals from the Examiner's rejection of claims 22-26, 28-36, and 38-46.

I. REAL PARTY IN INTEREST

This application is assigned to DiStefano Patent Trust III, LLC by assignment recorded on April 18, 2016, at Reel 038308, Frame 0794.

II. RELATED APPEALS AND INTERFERENCES

An appeal is concurrently being filed in related U.S. Application No. 13/946,489. A Decision on Appeal and Decision on Request for Rehearing were respectively issued on June 15,

2009, and September 13, 2009, in parent U.S. Application No. 09/589,551. A Memorandum Opinion was issued by the United States District Court for the District of Delaware on September 28, 2018, with regard to related U.S. Patent No. 8,768,760. That decision is currently under appeal before the Federal Circuit (Appeal No. 19-1210). A Decision Denying Institution of *Inter Partes* Review was issued by the Patent Trial and Appeal Board on June 5, 2019, with regard to related U.S. Patent No. 8,768,760. Appellant is unaware of any other related appeals and interferences.

III. STATUS OF CLAIMS

Claims 22-26, 28-36, and 38-46 are pending and finally rejected in this Application. Claims 1-21, 27, and 37 have been cancelled. It is from the final rejection of claims 22-26, 28-36, and 38-46 that this Appeal is taken.

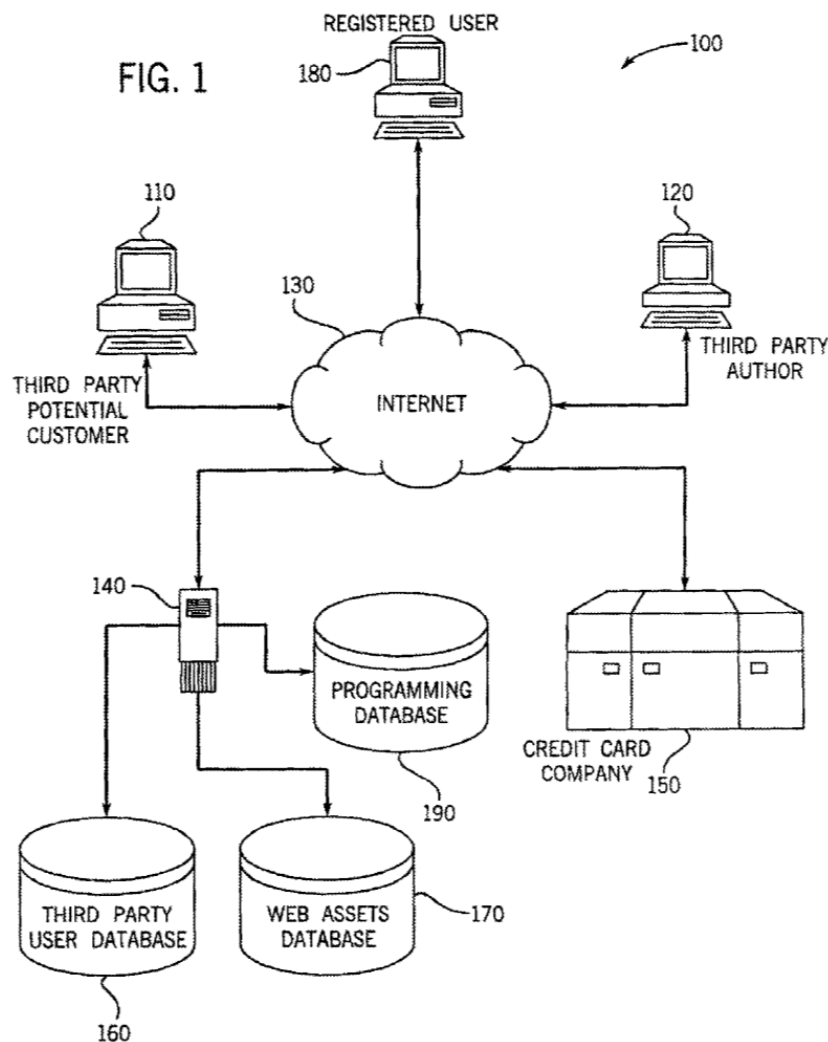
IV. STATUS OF AMENDMENTS

The claims have not been amended subsequent to the imposition of the Fourth and Final Office Action dated August 10, 2018 (hereinafter the Fourth Office Action).

V. SUMMARY OF CLAIMED SUBJECT MATTER

1 Claim 22

2 Referring to Figure 1 and also to independent claim 22, a method, within and by a
3 computer hardware system 180 that is configured to serve a first web page associated with a first
4 user and a second web page associated with a second user is disclosed (page 51, line 14 through
5 page 52, line 2 of Appellant's disclosure). A high-level drawing of the server system is
6 illustrated in Figure 1, which is reproduced below:



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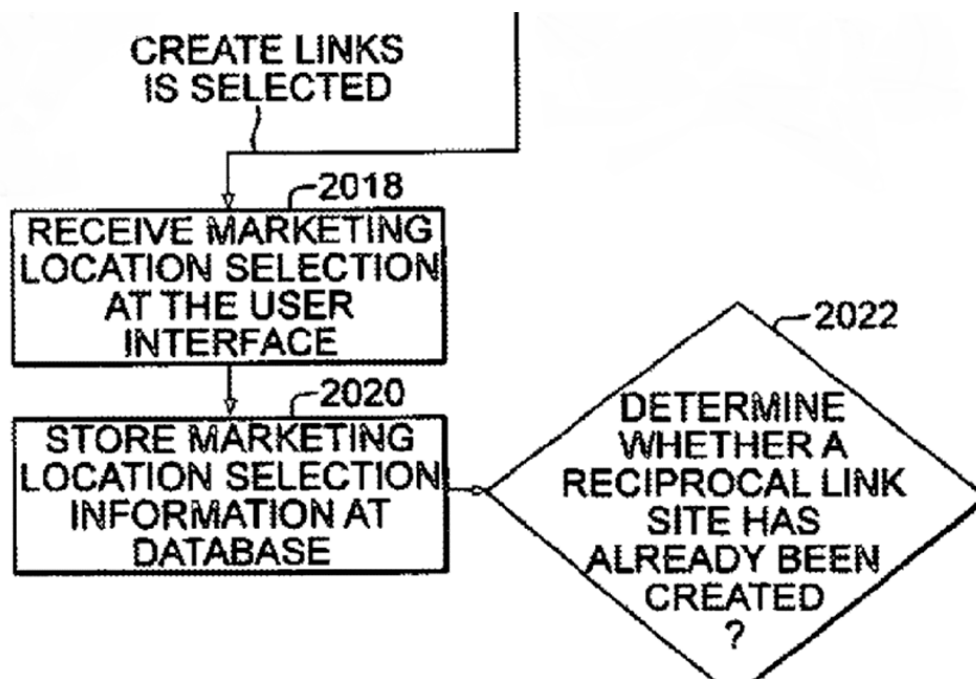
8

9

The present application discloses 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" (page 2, lines 7-10 of Appellant's disclosure). The present Application further discloses that the "system 100 includes a server computer 140 operably connected to the internet 130 using standard techniques well-known in the art" (page 12, lines 12-14 of Appellant's disclosure).

Claim 22 of the present application next requires "establishing a reciprocal arrangement between the first web page and the second web page based upon both the first and second users

1 opting to participate in the reciprocal arrangement." The present application discloses that
2 "[u]pon receiving the [website] selection information, the [website]¹ selection information is
3 stored at ... database 160 [and t]his stored information is later used to generate links at the
4 selected ... websites" (page 50, lines 12-19 of Appellant's disclosure). The website selection
5 information is an indication that a user has opted into a reciprocal arrangement. The storage of
6 this information is an example of establishing the reciprocal arrangement. (see Figure 20,
7 illustrated in part below, and pages 49, line 20 through page 52, line 20 of Appellant's
8 disclosure).



9
10 An example of a manner by which a user can opt into the reciprocal arrangement is
11 illustrated by the GUI illustrated in Figure 12 of Appellant's disclosure, a portion of which is
12 illustrated below:

¹ The terms "marketing locations" are "websites" are used interchangeably ("information is later used to generate links at the selected marketing locations (i.e., websites)").

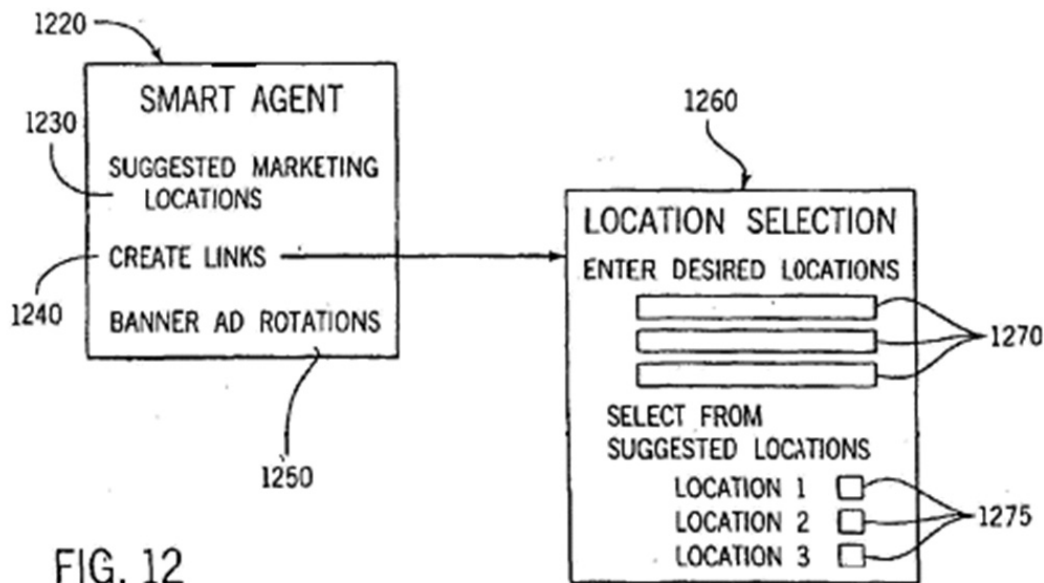


FIG. 12

1

2 Figure 12 illustrates how a registered user may access smart agent menu 1220, and select create
 3 links option 1240 to access "location selection menu 1260, in which the registered user can
 4 identify addresses for websites to which the registered user desires its website to be linked" (page
 5 31, lines 20-23). This can be accomplished by the registered user entering the website addresses
 6 into open fields 1270, or by the registered user checking selection boxes 1275 corresponding to
 7 website addresses that server 140 suggests may be beneficial for linking (page 31, line 23
 8 through page 32, line 10).

9 The first web page includes, based upon the reciprocal arrangement, a first link to the
 10 second web page and associated with the second user, and the second web page includes, based
 11 upon the reciprocal arrangement, a second link to the first web page and associated with the first
 12 user (page 51, line 14 through page 52, line 2 of Appellant's disclosure).

13 Claim 32

14 Referring to Figure 1 and also to independent claim 32, a webpage implementation server
 15 system 180 is configured to serve a first web page associated with a first user and a second web

1 page associated with a second user (page 51, line 14 through page 52, line 2 of Appellant's
2 disclosure). The server system 180 includes a database system 160/170/190 that stores
3 information associated with the first and second web pages (page 13, line 9 through page 14, line
4 6; and page 50, lines 12-24 of the Appellant's disclosure). A computer hardware system of the
5 server system 180 is configured to perform the following. First input received from the first user
6 into the database system 160/170/190, and second input received from the second user is stored
7 into the database system 160/170/190 (page 50, lines 12-19 of Appellant's disclosure).

8 Claim 32 of the present application next requires "establishing a reciprocal arrangement
9 between the first web page and the second web page based upon both the first and second users
10 opting to participate in the reciprocal arrangement." The present application discloses that
11 "[u]pon receiving the [website] selection information, the [website] selection information is
12 stored at ... database 160 [and t]his stored information is later used to generate links at the
13 selected ... websites" (page 50, lines 12-19 of Appellant's disclosure). The website selection
14 information is an indication that a user has opted into a reciprocal arrangement. The storage of
15 this information is an example of establishing the reciprocal arrangement. (see Figure 20 and
16 pages 49, line 20 through page 52, line 20 of Appellant's disclosure). An example of a manner
17 by which a user can opt into the reciprocal arrangement is illustrated by the GUI illustrated in
18 Figure 12 of Appellant's disclosure, which has already been reproduced and discussed, *supra*.

19 Claim 32 next requires the first web page is generated using the first input received from
20 the first user and the reciprocal arrangement, and the second web page is generated using the
21 second input received from the second user and the reciprocal arrangement (page 50, lines 12-19
22 of Appellant's disclosure). The second web page includes, based upon the reciprocal
23 arrangement, a second link to the first web page; and the first web page includes, based upon the

1 reciprocal arrangement, a first link to the second web page (page 50, lines 12-19; page 51, line
2 14 through page 52, line 2 of Appellant's disclosure).

3 Claim 44

4 Referring to Figure 1 and also to independent claim 44, a method within a computer
5 hardware system 180 that is configured to serve a first web page associated with a first user and a
6 second web page associated with a second user is disclosed (page 51, line 14 through page 52,
7 line 2 of Appellant's disclosure). The computer hardware system 180 is coupled to a database
8 system 160/170/190 that stores information associated with the first and second web pages (page
9 13, line 9 through page 14, line 6; and page 50, lines 12-24 of the Appellant's disclosure). First
10 input received from the first user into the database system 160/170/190, and second input
11 received from the second user is stored into the database system 160/170/190 (page 50, lines 12-
12 19 of Appellant's disclosure).

13 Claim 44 of the present application next requires "establishing a reciprocal arrangement
14 between the first web page and the second web page based upon both the first and second users
15 opting to participate in the reciprocal arrangement." The present application discloses that
16 "[u]pon receiving the [website] selection information, the [website] selection information is
17 stored at ... database 160 [and t]his stored information is later used to generate links at the
18 selected ... websites" (page 50, lines 12-19 of Appellant's disclosure). The website selection
19 information is an indication that a user has opted into a reciprocal arrangement. The storage of
20 this information is an example of establishing the reciprocal arrangement. (see Figure 20 and
21 pages 49, line 20 through page 52, line 20 of Appellant's disclosure). An example of a manner
22 by which a user can opt into the reciprocal arrangement is illustrated by the GUI illustrated in
23 Figure 12 of Appellant's disclosure, which has already been reproduced and discussed, *supra*.

1 Claim 32 next requires the first web page is generated using the first input received from
2 the first user and the reciprocal arrangement, and the second web page is generated using the
3 second input received from the second user and the reciprocal arrangement (page 50, lines 12-19
4 of Appellant's disclosure). The second web page includes, based upon the reciprocal
5 arrangement, a second link to the first web page; and the first web page includes, based upon the
6 reciprocal arrangement, a first link to the second web page (page 50, lines 12-19; page 51, line
7 14 through page 52, line 2 of Appellant's disclosure).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 22-26, 28-36, and 38-46 were rejected under 35 U.S.C. § 101; and
2. Claims 22-26, 28-36, and 38-46 were rejected under 35 U.S.C. § 102 for anticipation
based upon Bezos et al., U.S. Patent No. 6,029,141.

VII. ARGUMENT

PRINCIPLES OF LAW

Examiner's Burden

The Examiner has the initial burden to set forth the basis for any rejection so as to put Appellant on notice of the reasons why Appellant is not entitled to a patent on the claim scope that Appellant seeks – the so-called "*prima facie* case." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Additionally, the "[t]he examiner's action will be complete as to all matters," 37 C.F.R. § 1.104(b), and "[t]he pertinence of each reference, if not apparent, must be clearly explained." 37 C.F.R. § 1.104(c). Reference is also made to 37 C.F.R. § 1.2, which states "[t]he action of the Patent and Trademark Office will be based exclusively on the written record in the Office."

If the Examiner does not produce a *prima facie* case of unpatentability, then the rejection cannot be maintained, and Appellant is not obligated to respond. *See In re Oetiker, supra* ("If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent"). Only after a *prima facie* case of unpatentability does the burden shift to Appellant to rebut the *prima facie* case. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("[o]n appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

1 "[T]he Board cannot simply reach conclusions based on its own understanding or
2 experience - or on its assessment of what would be basic knowledge or common sense. Rather,
3 the Board must point to some concrete evidence in the record in support of these findings." *In re*
4 *Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). The failure of the Board
5 to provide an administrative record showing the evidence by which findings of fact are based
6 constitutes reversible error. *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002). With regard to the
7 burden placed on the Board in analyzing the rejections, the Federal Circuit held the following in
8 *Gechter v. Davidson*, 1167 F.3d 1454, 1460 (Fed. Cir. 1997):

9 In sum, we hold that the Board is required to set forth in its opinions specific
10 findings of fact and conclusions of law adequate to form a basis for our review. In
11 particular, we expect that the Board's anticipation analysis be conducted on a limitation
12 by limitation basis, with specific fact findings for each contested limitation and
13 satisfactory explanations for such findings. Claim construction must also be explicit, at
14 least as to any construction disputed by parties to the interference (or an applicant or
15 patentee in an ex parte proceeding).
16

17 In the Decision of *Ex parte Frye*, (Appeal No. 2009-006013) (Precedential), while
18 referring to a rejection under 35 U.S.C. § 103, the Honorable Board stated:

19 The panel then reviews the obviousness rejection for error based upon the issues
20 identified by appellant, and in light of the arguments and evidence produced thereon. *See*
21 *Oetiker*, 977 F.2d at 1445 ("In reviewing the examiner's decision on appeal, the Board
22 must necessarily weigh all of the evidence and argument.") (emphasis added); *see also* 37
23 C.F.R. § 41.37(c)(1)(vii) (appeal brief must include "the contentions of appellant with
24 respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this
25 section, and the basis therefor, with citations of the statutes, regulations, authorities, and
26 parts of the record relied on"). Specifically, the Board reviews the particular finding(s)
27 contested by an appellant anew in light of all the evidence and argument on that issue.
28

29 Therefore, a complete *de novo* review is to be performed on all issues that are raised by
30 Appellant without deference to the positions taken by the Examiner. Also, as stated within *In re*
31 *Nuvasive*, 842 F.3d 1376, 1383 (Fed. Cir. 2016), "it is not adequate to summarize and reject
32 arguments without explaining why the PTAB accepts the prevailing argument."

Anticipation

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single prior art reference. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993). Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art. *See, e.g., In re Spada*, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990). Under 35 U.S.C. § 102, not only must a prior art reference disclose all elements within a claim, the prior art reference must also disclose those elements "arranged as in the claim." *E.g., Net MoneyIn, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008).

"Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. ... The second step in the analyses requires a comparison of the properly construed claim to the prior art." *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted). During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification," *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000), and the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). Therefore, the Examiner must:

- (i) identify the individual elements of the claims and properly construe these individual elements, *In re Crish*, 393 F.3d 1253, 1256 (Fed. Cir. 2004), *Panduit Corp. v.*

1 *Dennison Mfg. Co.*, 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability
2 determination, analysis must begin with the question, "what is the invention claimed?"
3 since "[c]laim interpretation, ... will normally control the remainder of the decisional
4 process");

5 (ii) identify corresponding elements disclosed in the allegedly anticipating
6 reference. *Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730
7 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984);

8 (iii) and compare these allegedly corresponding elements to the individual
9 elements of the claims, *Id.*, while making factual findings that "each and every limitation
10 is found either express or inherently in [that] single prior art reference." *Crish* at 1256.
11

12

13 **THE REJECTION OF CLAIMS 22-26, 28-36, AND 38-46 UNDER 35 U.S.C. § 101**

14 For convenience of the Honorable Board in addressing the rejections, claims 25-26 and
15 28-31 stand or fall together with independent claim 22; claims 33 and 45 stand or fall together
16 with dependent claim 23; claims 34 and 46 stand or fall together with dependent claim 24; claims
17 35-44 stand or fall together with independent claim 32.

18

19 **A. Claims are Directed to an Improvement to Computer Technology**

20 Under 35 U.S.C. § 101, patentable subject matter includes "any new and use process,
21 machine ... or any new and useful improvement thereof." The Supreme Court recognized an
22 improvement to an existing technological process can be patent eligible. *Alice Corp. Pty. Ltd. v.*
23 *CLS Bank Int'l*, 134 S. Ct 2347, 2358 (2014) (discussing *Diamond v. Diehr*, 101 S.Ct. 1048
24 (1981)). Consequently, under both steps of the *Alice* analysis, the Federal Circuit has found a
25 claimed invention to be patent eligible based upon a finding that the invention is directed to a
26 specific improvement in existing computer technology. *See, e.g., BASCOM Glob. Internet*
27 *Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1348 (Fed. Cir. 2016) (noting that an
28 improvement to computer technology can render an invention patent-ineligible under step two of

1 the *Alice* analysis); *Ancora Tech., Inc. v. HTC America, Inc.*, ___ F.3d ___ (Fed. Cir. 2018) (slip
2 op., at 8) ("We have several times held claims to pass muster under *Alice* step one when
3 sufficiently focused on such improvement").

4
5 Regarding computer-implemented inventions, the Court also has confirmed that
6 "software-based innovations can make 'non-abstract improvements to computer technology' and
7 be deemed patent eligible subject matter." *Finjan, Inc. v. Blue Coat Sys., Inc.*, 879 F.3d 1299,
8 1304 (Fed. Cir. 2018). These improvements can include, for example, an improvement to the
9 usability of existing computer technology. See *Data Engine Tech LLC v. Google LLC*, ___ F.3d
10 ___ (Fed. Cir. 2018) (slip op., at 3) (noting that patent addressed a problem associated with "ease
11 of use of this [spreadsheet] technology").

12
13 At the time of the invention, preparation of a webpage was not usually done in house.
14 Rather, it required working with both a website developer and a website service provider.
15 Appellant's disclosure describes the state of the art at the time of the invention as follows:

16 The most commonly used avenue for an individual to get his web page on
17 the internet is to employ one of numerous companies to provide, for a fee, web
18 page/website development services. After contacting such a website development
19 company, the individual would meet with one of the company's web page
20 designers to explain the individual's concept for his web page. The designer
21 would then create the associated HTML document. After approval by the
22 individual, the designer may provide the service of posting the web page to a
23 server. The server typically is not associated with the website development
24 company. Thus, the individual must separately contract with an ISP associated
25 with the server to host the web page.

1 Page 2, line 23 through page 24, line 7 of Appellant's disclosure. This computer-implemented
2 process was expensive, time consuming, and inefficient. Page 2, lines 7-12 of Appellant's
3 disclosure.

4
5 The use of reciprocal links in webpages to create hyperlinks between separate
6 individual's webpages was known at the time of Appellant's invention. Reciprocal links are
7 discussed, for example, in U.S. Patent 6,629,135 to Ross et al., assigned to DDR Holdings
8 (hereinafter, Ross),² which was cited as prior art during prosecution of U.S. Patent No.
9 7,996,259, upon which the present application claims priority. Referring to column 1, lines 30-
10 36, Ross states that "website programmers increased visitor traffic by placing 'links' within their
11 websites to other websites, usually related in content or function, in exchange for a reciprocal
12 link ... [and] link sharing developed into a standard practice."

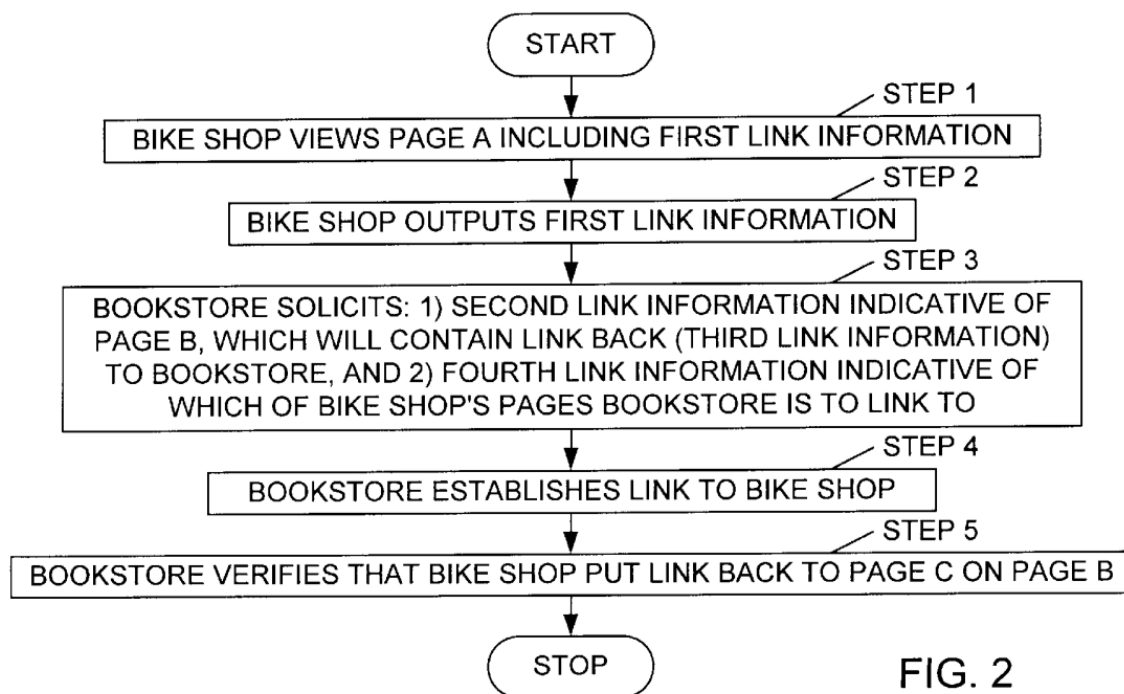
13
14 At the time of the Appellant's invention, prior art systems that facilitated the creation of
15 reciprocal links were also known, as described in U.S. Patent 5,995,099 to Horstmann
16 (hereinafter, "Horstmann"), which is current being cited as prior art.³ Regarding the creation of
17 reciprocal links in webpages, Horstmann recognized that "the tasks of communicating between
18 the bike-shop and bookstore and manually adding links are time consuming." Horstmann, 1:43-
19 55. Additionally, "it is possible that either the bookstore and/or the bike-shop will neglect to
20 establish the agreed upon links," and thus, there was a need to verify/enforce the creation of

² U.S. Patent 6,993,572 is the patent at issue in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), which is a Continuation Application of U.S. Patent 6,629,135 to Ross, available at <https://patents.google.com/patent/US6629135>.

³ Appellant successfully distinguished over Horstmann during the prosecution of U.S. Patent No. RE45,971, which is a reissue of aforementioned U.S. Patent No. 7,996,259.

these links. Horstmann, 1:41-53; Horstmann, 4:13-24. Horstmann also explains that certain links may be "undesirable" and provides the user with techniques for removing these links. Horstmann, 6:4-6.

The process by which Horstmann describes facilitating the creation of reciprocal links is illustrated in Figure 2 and reproduced below:



Horstmann's disclosure refers to two parties, a bookstore (and associated webpage) and the owner of a bike-shop (and associated webpage). In short, Horstmann discloses: bike-shop owner visits the bookstore webpage (Step 1); the bike-shop owner indicates a desire to add a link to the bookstore webpage (Step 2); a system in concert with the bookstore webpage collects information needed to add the link (Step 3); a link to the bike-shop webpage from the bookstore webpage is added to the bookstore webpage (Step 4), and the system implements a verification process to ensure that the bike-shop webpage eventually contains a link back to the bookstore

- 1 webpage (Step 5). Horstmann, 2:55-3-42. The present claims improve upon this process for
- 2 facilitating the generation of reciprocal links between webpages.

A(1) Improvement to Web Page and Reciprocal Link Creation

As part of streamlining the process of webpage creation, Appellant combined the conventional functionality of a website development company (who created the website) and an internet service provider (ISP) whose server hosted the website. In combining these functions, Appellant recognized that the resultant system could be configured to provide an improved methodology by which reciprocal links between webpages are generated.

The claim limitations associated with this improved combined functionality are:

- "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 recited in claims 22 and 44. Claim 32 recites similar limitations.
- "including, within the second web page and based upon the reciprocal arrangement, a second link to the first web page associated with the first entity," as recited in claim 22. Claims 32 and 44 recite similar limitations.
- "including, within the first web page and based upon the reciprocal arrangement, a first link to the second web page and associated with the second entity," as recited in claim 22. Claims 32 and 44 recite similar limitations.

The prior art conventional process described in Appellant's specification involved as many as three different entities per user (i.e., the user, the website development services, and the ISP).⁴ Appellant's combining of the different functionalities eliminates as many as 3 out of the 6 different entities, thus increasing the efficiency of the process.

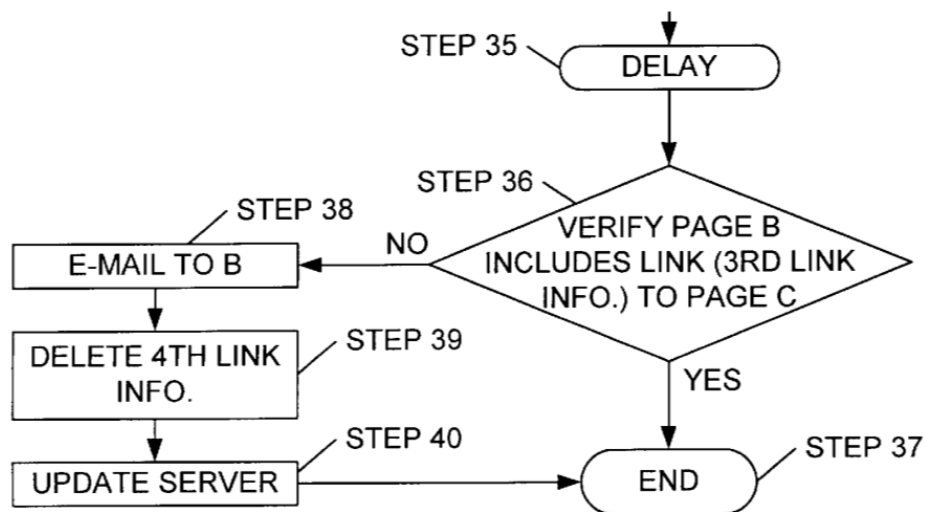
Appellant's invention, however, does more than just improve upon conventional systems by taking old processes performed by different entities and performing these combined processes in a single system. In addition, the claims describe a different manner by which reciprocal links between webpage are generated, which results in additional benefits, as discussed in more detail *infra*. For example, the claimed process ends in the generation of reciprocal links between

⁴ By extension, the creation of reciprocal links could require the coordination of as many as six different entities (i.e., two each of the three different entities).

pages. However, the prior art Horstmann system ends at the verification process (Step 5 in Figure 2), while trusting that the other user (e.g., the bike-shop owner) follows through in the creation of a link back to the bookstore webpage.

A(2) Claimed Invention Eliminates Need for Reciprocal Link Enforcement

Horstmann describes the need for a process that verifies the existence of a reciprocal link that was agreed upon. Horstmann, 4:12-23. The verification process of Step 5 in Figure 2 of Horstmann is illustrated in greater detail in steps 36-40 of Figure 3, which is reproduced in part below:



After the link has been added to the bookstore webpage in step 34 (not shown), Horstmann describes waiting for a period of time (step 35) before implementing a verification process in step 36. Horstmann, 4:7-13. This verification process includes checking the webpage of the bike-shop to see if a link back to the bookstore webpage has been included. Horstmann, 4:13-16. If not, in step 38, an email is sent that reminds the bike-shop owner to include the link back to the bookstore. Horstmann, 4:17-21. In steps 39/40, the process also entails deleting the

original link that was added to the bookstore webpage should a link back not be provided in the bike-shop webpage. Horstmann, 4:21-23.

By contrast, Appellant's claimed invention negates the need for reciprocal link enforcement by allowing a single operator/system to both create and serve the reciprocal links. While the system of Horstmann automatically generates the link in the bookstore webpage to the bike-shop webpage in step 34, Horstmann, 4:7-11, Horstmann does not contemplate the same system generating a link from the bike-shop webpage back to the bookstore webpage. However, the claimed invention requires "including, within the second web page and based upon the reciprocal arrangement, a second link to the first web page and associated with the first entity" and "including, within the first web page and based upon the reciprocal arrangement, a first link to the second web page and associated with the second entity" Generating both links based upon the claimed reciprocal arrangement, eliminates the need to verify the existence of the other link. Thus, the claims provide for an improvement over the state of the art, as represented by Horstmann.

A(3) Improvement Addressing Undesired Reciprocal Links

At the time of the invention, web designers faced the problem of "undesirable links." While Horstmann disclosed a mechanism by which these links can be deleted, Horstmann, 6:4-11, Appellant improved on that solution by claiming a process that prevents undesired links before they are included in the user's website. For example, a competitor of the bookstore described in Horstmann could add a link to the competitor's website without any intention of providing a link back to the bookstore knowing that the added link will exist for a period of time

1 before being deleted. Similarly, the competitor could add a link to a third party website having a
2 negative reputation anticipating that potential customers may be offended by the mere presence
3 of this link. While Horstmann describes that these links can subsequently be deleted, the damage
4 is already done by either losing customers to a competitor or loss of reputation.

5
6 While Horstmann provides a mechanism that allows one party (i.e., the bike-shop) to
7 choose the website that contains the link to the bike-shop's website, the same does not hold true
8 for the bookstore. Horstmann, 2:55-62. Rather, the bookstore owner merely opts into an
9 arrangement that allows *any entity* to include links on the bookstore's web page *without any input*
10 by the bookstore owner. Horstmann, 2:37-41. Thus, although Horstmann partially addresses the
11 problem of undesirable links, Horstmann's process could be improved upon.

12
13 The claimed invention addresses the problem of undesired reciprocal links using the
14 claimed "both the first and second users opting to participate in the reciprocal arrangement."
15 Thus, each user has control over the links contained within the respective user's web pages,
16 which prevents their own website from including an unwanted link to an undesirable website.
17 Thus, the claimed invention is an improvement over Horstmann by claiming a process that
18 prevents undesired links before they are included in the user's website.

19
20 Referring to page 14 of the Fourth Office Action, the Examiner admits that "the claims
21 are a technical solution." However, contrary to the Examiner's assertion on page 15, the problem
22 is not one with an "ancient lineage." The World Wide Web was only first proposed in 1989 by
23 Tim Berners-Lee. "History of the Web," *available at*

1 <https://webfoundation.org/about/vision/history-of-the-web/>. In 1990, Berners-Lee created "the
2 three fundamental technologies that remain the foundation of today's web: ... HTML, URI ...
3 (also commonly called a URL), [and] HTTP." *Id.* In 1991, the World Wide Web was first made
4 available to the public. "Internet History," *available at*
5 <https://www.internethalloffame.org/internet-history/timeline>. In 1993, CERN put the World
6 Wide Web software (including both a browser and a web server) in the public domain. "The
7 birth of the Web," available at <https://home.cern/science/computing/birth-web>. The present
8 application claims priority to an application filed on June 7, 2000. Consequently, the problem
9 being addressed was not of an "ancient lineage."

11
12 **B Based upon 2019 Guidelines, Claims are Not Directed to an Abstract Idea**

13 The Examiner's rejection was made on August 10, 2018 which preceded the 2019
14 Revised Patent Subject Matter Eligibility Guidance (hereinafter the 2019 Guidelines). As such,
15 the Examiner's rejection did not follow the guidelines described therein.

16
17 On pages 9-11 of the 2019 Guidelines, the Patent Office has stated that when a claim
18 does not recite matter than falls within one of these groupings of subject matter (i.e.,
19 "Mathematical concepts," "Certain methods of organizing human activity," and "Mental
20 processes"), then the claims "should not be treated as reciting abstract ideas."

21
22 **B(1) Claims Not Directed to Any of the Excluded Categories**

23 Mathematical concepts

1 The phrase *Mathematical concepts* includes "mathematical relationships, mathematical
2 formulas or equations, mathematical calculations." 2019 Guidelines, Page 9. Appellant's
3 claimed invention, however, does not recite any mathematical relationships, mathematical
4 formulas or equations, or mathematical calculations. Moreover, the Examiner's analysis in the
5 Fourth Office Action does not imply that the claims invention is directed to a mathematical
6 concept.

7
8 Certain methods of organizing human activity

9 The phrase *Certain methods of organizing human activity* includes a laundry list of
10 concepts including, but not limited to "fundamental economic principles or practices ...;
11 commercial or legal interactions ...; [and] managing personal behavior or relationships or
12 interactions between people." 2019 Guidelines, Page 10. Appellant's claimed invention,
13 however, involves operations that are necessarily performed on a computer and is not directed to
14 organizing human activity. To the extent that anything is being organized by the claimed
15 invention, it is the creation of web pages – not human activity. Specifically, the claimed
16 invention is directed to an improved and new set of operations that are used to generate
17 reciprocal links in web pages – operations that are necessarily performed with and by a
18 computer.

19
20 Mental processes

21 The phrase *Mental processes* is described as "concepts performed in the human mind."
22 2019 Guidelines, Page 11. None of the three separate operations recited in claim 22 are
23 performed in the human mind. The claimed "establishing a reciprocal arrangement" involves the

1 creation of one or more computer data structures that represent the reciprocal arrangement,
2 which is not a process performed in the human mind. The reciprocal arrangement is then used to
3 include the first and second links, respectively, in the second and first web pages. The inclusion
4 of links in first and second web pages are computer operations that cannot be performed in the
5 human mind. Consequently, the claimed invention is not directed to a mental process. Thus,
6 based upon the 2019 Guidelines, the claims "should not be treated as reciting abstract ideas."
7

8 **B(2) Examiner's Characterization of Claimed Invention Does Not Fall**
9 **Within One of the Excluded Categories**

10 On page 4 of the appealed Fourth Office Action, the Examiner asserted that the claimed
11 invention is "directed in part to reciprocal arrangements between web pages." Based upon this
12 characterization, the claimed invention is not directed to one of the excluded groupings of
13 subject matter. The Examiner's characterization does not refer to either mathematical concepts
14 or human activity. Thus, neither of the first two groupings of subject matter listed above is
15 implicated by the claimed invention. Additionally, the Examiner has made no allegations that
16 the claimed invention can be performed in the human mind and/or is otherwise a mental process.
17 Consequently, based upon the Examiner's characterization of the claimed invention, the claims
18 do not fall within of the excluded groupings of subject matter identified within the 2019
19 Guidelines.
20

21 **C The Examiner has Not Properly Characterized Claimed Invention**

22 Under step one of the *Alice* inquiry, "the focus of the claimed advance over the prior art"
23 is evaluated to determine if the claimed invention, as a whole, is directed to excluded subject

1 matter. *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1338 (Fed. Cir.
2 2017), quoting *Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir.
3 2016); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016). The Examiner
4 identifies the claimed invention as being directed to reciprocal arrangements between web pages.
5 However, merely creating reciprocal links on web pages is *not* the claimed advance over the
6 prior art as this technology preexisted the priority date of the present application.

7
8 **C(1) Claimed Invention Directed to an Improved Process for Generating**
9 **Web Pages Having Reciprocal Links**

10 Advances over conventional technical processes are captured via the claimed invention
11 by a claimed series of specific computer-implemented operations that are performed *in*
12 *conjunction with* a single particular type of computer hardware system that is both configured to
13 edit and serve web pages, as discussed in more detail above. Not only is the claimed invention
14 more efficient over prior art processes that achieve the same result of generating web pages with
15 reciprocal links, as discussed *supra*, the claimed invention captures additional benefits not
16 provided by these prior processes.

17
18 **C(2) Examiner Has Overgeneralized Claimed Invention**

19 The Federal Circuit has recognized that an overgeneralization of a claimed invention, as
20 occurred here, can be dangerous because "if carried to its extreme, [it would make] all inventions
21 unpatentable." *In re TLI Commc'ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016)
22 (quoting *Diamond v. Diehr*, 450 U.S. 175, 189 n.12 (1981)). Referring to *Alice*, "describing the
23 claims at such a high level of abstraction and untethered from the language of the claims all but

1 ensures that the exceptions to § 101 swallow the rule." *Enfish, LLC v. Microsoft Corp.*, 822 F.3d
2 1327, 1337 (Fed. Cir. 2016) (internal citations omitted). Therefore, the Step one analysis must
3 "articulate what the claims are directed to with enough specificity to ensure the step one inquiry
4 is meaningful." *Thales Visionix Inc. v. United States*, 850 F.3d 1343, 1347 (Fed. Cir. 2017).

5
6 In this instance, the Examiner's assertion that the claimed invention is directed to
7 "agreements between web pages to promote one another" is an overgeneralization of the claimed
8 invention. As already discussed *supra*, the prior art already describes the technological feature
9 of reciprocal links. By encompassing the prior art with the Examiner's characterization of the
10 claimed invention, the Examiner's characterization does not recognize the technical inventive
11 features of the claimed invention. A proper analysis under 35 U.S.C. § 101 requires that the
12 claimed invention "must be considered as a whole." *Diamond v. Diehr*, 450 U. S. 175, 188
13 (1981); *see Parker v. Flook*, 437 U. S. 584, 594 (1978) ("Our approach ... is ... not at all
14 inconsistent with the view that a patent claim must be considered as a whole"). This approach,
15 however, has not been followed by the Examiner.

16
17 **C(3) Claims Not Directed to Result of "reciprocal arrangements between**
18 **web pages"**

19 The Federal Circuit has described, as "one helpful way of double-checking the
20 application of the Supreme Court's framework to particular claims," an approach that considers
21 "an important common-sense distinction ... between desired results (functions) and particular
22 ways of achieving (performing) them." *Electric Power Group, LLC v. Alstom, SA*, 830 F.3d
23 1350 (Fed. Cir. 2016) (a claim that is "so result-focused, so functional, as to effectively cover

1 any solution to an identified problem" is likely to be patent ineligible). A claim that is merely
2 directed to a result "would 'inhibit[] innovation by prohibiting other inventors from developing
3 their own solutions to the problem without first licensing the abstract idea.'" *Id.* (citing district
4 court). On the other hand, "patenting a particular solution 'would incentivize further innovation
5 in the form of alternative methods for achieving the same result.'" *Id.*

6
7 The end result of claim 22 is a pair of web pages that include reciprocal links. However,
8 Appellant does not merely claim this desired result because this result is part of the prior art.
9 Rather, Appellant claims a different and specific set of operations that achieves the improved
10 result of providing a pair of web pages that do not have the specific drawbacks found in the prior
11 art: (1) reducing the number of required participating entities; (2) eliminating the need for
12 reciprocal link enforcement; and (3) improving the ability to police undesirable links.

13
14 **(D) Facts of Present Application are Comparable to DDR Holdings**

15 In *DDR Holdings*, this court recognized that the use of links between web pages
16 "introduces a problem that does not arise in the 'brick and mortar' context." *DDR Holdings, LLC,*
17 *v. Hotels.com, L.P.*, 773 F.3d 1245, 1258 (Fed. Cir. 2014). While the present application
18 addresses different problems than the problem addressed in *DDR Holdings*, the problem of web
19 page and reciprocal link creation that is addressed by the claimed invention is also one that does
20 not occur in a brick and mortar context.

21
22 As discussed above, the claimed invention improves upon the process of generating
23 associated web pages, which specifically involves serving of a web page having a link to another

1 web page – an invention that is necessarily rooted in computer technology. *See DDR Holdings*
2 at 1249 ("Representative claim 13 of the '572 recites ... a computer processor ... programmed,
3 upon receiving an indication that the link has been activated ... to serve a composite web page
4 ... with content based on the commerce object associated wit[h] the link."). When there is an
5 improvement, the case law asks whether the improvement is directed towards a technological
6 process or is it directed to the abstract idea. *See, e.g., Enfish*, 822 F.3d at 1335-35 (holding that
7 improvements to technology or computer functionality do not always need to undergo the full
8 eligibility analysis). Here, the claimed invention does not simply improve upon an abstract idea.
9 Rather, the claimed invention provides a novel improvement to a conventional computer process
10 – the process of generating a pair of web pages that include reciprocal links. Therefore, the
11 claims of the present application are patent eligible.

12

13 **E Examiner Has Not Shown How Claimed Invention Preempts Alleged Abstract**
14 **Idea of "reciprocal arrangements between web pages"**

15 In *Alice*, the Supreme Court explained that "the concern that drives [the Section 101]
16 exclusionary principle [is] one of preemption." 134 S.Ct. at 2354 (2013) (citing *Bilski v.*
17 *Kappos*, 130 S. Ct. 3218 (2010)). Since then, the Federal Circuit has confirmed the importance
18 of considering the preemptive impact of a claim while stating that "[p]reemption is ... part and
19 parcel with the § 101 inquiry." *Return Mail, Inc. v. United States Postal Serv.*, 868 F.3d 1350,
20 1370 (Fed. Cir. 2017).

21

22 The concern over preemption "arises when the claims are not directed to a specific
23 invention and instead improperly monopolize 'the basic tools of scientific and technological

1 work." *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016).
2 Thus, lack of preemption is a factor to be considered during a patent eligibility analysis. *See Id.*
3 at 1315-16 (Fed. Cir. 2016); *BASCOM*, 827 F.3d at 1352 ("[T]he claims of the ... patent do not
4 preempt the use of the abstract idea of filtering content on the Internet or on generic computer
5 components performing conventional activities.").

6
7 The absence of *complete* preemption does not necessarily demonstrate patent eligibility,
8 *See FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, __ (Fed. Cir. 2017). For example,
9 lack of complete preemption can be shown by the addition of an insignificant admission.
10 However, lack of *broad* preemption is shown by a "specific, discrete implementation," which is
11 sufficient to establish that an abstract idea has not been preempted. *See BASCOM Global*
12 *Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1351 (Fed. Cir. 2016) ("[n]or do the
13 claims preempt all ways of filtering content on the Internet; rather, they recite a specific, discrete
14 implementation of the abstract idea of filtering content").

15
16 Additionally, the Federal Circuit has recognized that a claim that merely limits the
17 abstract idea to conventional components (e.g., a generic computer or the internet) may still be
18 patent ineligible. *See BASCOM*, 827 F.3d at 1352. Hence, the Federal Circuit has held, for
19 example, that the "specific structure of the claimed rules would prevent broad preemption of all
20 rules-based means of automating lip synchronization." *McRo*, 837 F.3d at 1315; *see also*
21 *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288 (Fed. Cir. 2016) ("[claimed]
22 arrangement is not so broadly described to cause preemption concerns ... it is narrowly
23 circumscribed to the particular system outlined").

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Claim 22 does not even remotely come close to broadly preempting the alleged abstract idea of *reciprocal links between web pages*. Reciprocal links between web pages already existed prior to the claimed invention. Moreover, Horstmann discloses a mechanism by which to create reciprocal links between web pages, and claim 22 does not broadly preempt that mechanism. Consequently, claim 22 does not broadly preempt the Examiner's alleged abstract idea.

Alice Step Two

The Court need only reach *Alice* Step Two if it determines that Claim 1 is directed to an abstract idea. *McRo*, 837 F.3d at 1312. *Alice* Step Two has been described as "the search for an 'inventive concept,' or some element or combination of elements sufficient to ensure that the claim in practice amounts to 'significantly more' than a patent on an ineligible concept." *DDR Holdings*, 773 F.3d at 1255 (citing *Alice Corp.*, 134 S.Ct. at 2355). The inventive concept includes those "additional features," beyond the abstract idea, that assure "that the [claim] is more than a drafting effort designed to monopolize the [abstract idea]." *Mayo Collaborative Servs. v Prometheus Labs., Inc.*, 132 S.Ct. 1298, 1297 (2012). Therefore, this step involves "consider[ing] the elements of each claim both individually and 'as an ordered combination' to determine whether the additional elements 'transform the nature of the claim' into a patent eligible application." *Alice*, 134 S.Ct. at 2355 (quoting *Mayo*, 132 S.Ct. at 1289). Step Two of the *Alice* test is satisfied when the additional elements "involve more than performance of 'well-understood, routine, [and] conventional activities previously known to the industry.'" *Content Extraction*, 776 F.3d at 1347-48 (quoting *Alice*, 134 S.Ct. at 2359).

1
2 In *Berkheimer*, this court held that "whether a claim element or combination of elements
3 is well-understood, routine and conventional to a skilled artisan in the relevant field is a question
4 of fact." 881 F.3d at 1368. Referring to the Examiner's analysis on page 3 of the appealed
5 Fourth Office Action, the Examiner only mentions individual elements (e.g., "computer
6 hardware system," "first and second web page," "web implementation server system,"
7 "database"). However, nearly all inventions are combination of known elements. *DDR*
8 *Holdings*, 773 F.3d at 1258 n.5. Thus, the Examiner noting that the claims recite conventional
9 components does not establish that the ordered combination of elements cannot be substantially
10 more than the alleged abstract idea. *See e.g., BASCOM*, 827 F.3d at 1349-50 ("an inventive
11 concept can be found in the nonconventional and non-generic arrangement of known,
12 conventional pieces.") The Examiner presents no evidence that the claimed combination of
13 elements were not routine, conventional, and well-understood. Rather, in the first full paragraph
14 on page 4 of the Fourth Office Action, the Examiner presents the conclusory assertion that
15 "[t]here is no indication that the combination of elements improves the functioning of a computer
16 or improves any other technology."

17
18
19 *buySafe, Inc. v. Google, Inc.*

20 The Examiner's reliance upon *buySafe, Inc. v. Google, Inc.*, 765 F.3d 1350 (Fed. Cir.
21 2014), is misplaced. As stated by the Federal Circuit:

22 The claims in this case do not push or even test the boundaries of the Supreme Court
23 precedents under section 101. The claims are squarely about creating a contractual
24 relationship—a "transaction performance guaranty"—that is beyond question of ancient

1 lineage. See Willis D. Morgan, *The History and Economics of Suretyship*, 12 Cornell
2 L.Q. 153 (1927). *Id.* at 1354-55.

3
4 The Federal Circuit also characterized this as a "long-familiar commercial transaction[]." *Id.* at
5 1355. As reproduced above, the Federal Circuit also presented evidence of the "ancient lineage"
6 of the alleged "contractual relationship." Claim 1 of U.S. Patent No. 7,644,019 (hereinafter the
7 '019 Patent), recites the following limitations:

8 A method, comprising:
9 receiving, by at least one computer application program running on a computer
10 of a safe transaction service provider, a request from a first party for obtaining a
11 transaction performance guaranty service with respect to an online commercial
12 transaction following closing of the online commercial transaction;
13 processing, by at least one computer application program running on the safe
14 transaction service provider computer, the request by underwriting the first party in order
15 to provide the transaction performance guaranty service to the first party, wherein
16 the computer of the safe transaction service provider offers, via a computer
17 network, the transaction performance guaranty service that binds a transaction
18 performance guaranty to the online commercial transaction involving the first party to
19 guarantee the performance of the first party following closing of the online commercial
20 transaction. (emphasis added)

21
22 As recognized by the Federal Circuit, "[t]he computer functionality is generic — indeed, quite
23 limited: a computer receives a request for a guarantee and transmits an offer of guarantee in
24 return." *Id.* at 1355.

25
26 The Examiner's analysis regarding *buySafe* is to assert "the 'establishment of a reciprocal
27 agreement between a first web page and a second web page...' is comparable to a contractual
28 agreement as in BuySAFE" (page 4 of the Third Office Action) and "claim language simply
29 transfers the issue of guaranteeing performance for a contract into a computing environment – a
30 long standing problem in the pre internet area" (page 12 of the Third Office Action). These
31 assertions both misrepresent the salient facts of *buySafe* and fail to reasonably tie the facts of the
32 present application to the facts of *buySafe*.

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As discussed above, the Federal Circuit presented evidence of the "ancient lineage" of a "transaction performance guaranty." However, no such evidence has been presented by the Examiner regarding the present claims. Moreover, even *assuming arguendo* that the claimed invention was directed to generating reciprocal links without anything more, this is an operation necessarily rooted in technology and not *some fundamental economic practice long prevalent in our system of commerce*.

underwriting a transaction performance guaranty service

The claim at issue in *buySafe* merely recited "receiving ... a request from a first party for obtaining a transaction performance guaranty service" and "processing ... the request by underwriting the first party." In short, the only operations being claimed are receiving a request, over a computer, for a transaction performance guaranty (again, a business method of ancient lineage) and underwriting the first party with a transaction performance guaranty.

Reference is made to column 4, lines 7-24 of the '019 Patent, which contains a description as to what constitute a "transaction performance guaranty":

The transaction performance guaranty may be provided in a variety of different forms. FIG. 2 illustrates different exemplary forms in which a transaction performance guaranty 210 may be provided, according to an embodiment of the inventions. It may be offered in the form of a surety bond 220, a specialized bank guaranty 230, . . . , a specialized insurance policy 240, or in a form of a safe transaction guaranty 250. The safe transaction service provider 130 may provide various forms of a performance guaranty. It may also provide other forms of guaranty based on its agreement with other institutions. The safe transaction service provider 130 may provide its own guaranty in the form of, for instance, the surety bond 220 and the safe transaction guaranty 250. The safe transaction service provider 130 may also provide a performance guaranty in forms supported by other institutions such as the specialized bank guaranty 230 supported by a

1 bank or the specialized insurance policy 240 (or surety bond) supported by an insurance
2 company. (emphasis added)
3

4 A surety bond 220,⁵ specialized bank guaranty 230⁶ or specialized insurance policy 240
5 are essentially different ways of describing a contractual arrangement in which one party (i.e.,
6 the surety, or bank, or insurer) will pay another party based upon the occurrence of some
7 insured-against event. The claims of the '019 Patent recite "processing ... the request by
8 underwriting the first party in order to provide the transaction performance guaranty service to
9 the first party." To "underwrite" is to "[s]ign and accept liability under (an insurance policy),
10 thus guaranteeing payment in case loss or damage occurs."⁷ In essence, it describes the acts of a
11 company (e.g., an insurance company) in underwriting an insurance contract whereby the "first
12 party" is paid by the underwriting company upon the failure of an online transaction (i.e., the
13 occurrence of the insured-against event). Therefore, the claim at issue in *buySafe* can be
14 simplified as such:

- 15 1) receive a request from a first party for performance insurance (i.e., a transaction
16 performance guaranty) for an online transaction, and
17 2) underwrite the performance insurance.
18

19 Accordingly, the claims of *buySafe* involve little more than performing "long-familiar
20 commercial transaction[]" *over the internet and regarding an internet transaction.*
21

22 In comparison, the claims of the present application are directed to a set of operations that
23 describe the creation and serving of web pages including reciprocal links. By way of example,
24 there is a huge difference between creating a contractual relationship (i.e., by underwriting an

⁵ See https://en.wikipedia.org/wiki/Surety_bond.

⁶ See <https://www.investopedia.com/terms/b/bankguarantee.asp> ("A performance bond serves as collateral for the buyer's costs incurred if services or goods are not provided as agreed in the contract.").

⁷ See <https://en.oxforddictionaries.com/definition/underwrite>.

1 insurance policy) tied to the performance of "building a new school" versus the actual operations
2 involved in "building a new school." The same scope of difference also exists between the facts
3 of the present application and the salient facts of *buySafe*. The claimed invention does not
4 purport to underwrite an insurance contract to be paid out upon the failure of reciprocal
5 hyperlinks to be generated. Rather the claimed invention involves set of operations involved in
6 performing technology-based operations that directly result in the creation of reciprocal
7 hyperlinks.

8
9 The Examiner's assertion that "the 'establishment of a reciprocal agreement between a
10 first web page and a second web page...' is comparable to a contractual agreement as in
11 BuySAFE" misrepresents how the Federal Circuit's used the concept of "contractual
12 relationship" in the decision. The Federal Circuit cited *Bilski* as referring to "an abstract idea in
13 certain arrangements involving contractual relations, which are intangible entities." *Id.* 1353.
14 The Federal Circuit also referred to a specific contractual relationship and found that this was
15 "beyond question of ancient lineage." *Id.* at 1355. As already argued above, the Examiner has
16 not presented any evidence of the "ancient lineage" of the alleged "contractual relationship."
17 Also, the language of the Court is "certain arrangements involving contractual relations," which
18 implies that there is a difference in arrangements such that some involve contractual relations
19 and others do not. In this instance, the claims of the present application do not purport to create
20 a contractual relationship.

21
22 The Examiner's other assertion that the "claim language simply transfers the issue of
23 guaranteeing performance for a contract into a computing environment – a long standing

1 problem in the pre internet area" also fails to reflect that the claim of *buySafe* does not purport to
2 "guaranty" the performance of anything. Instead, *buySafe* creates the contractual "guaranty"
3 (i.e., an insurance policy) that will be paid out if the online transaction is not performed. As
4 discussed above, the claims of the present application are directed to specific operations that
5 describe the creation and serving of web pages including reciprocal links, which does not involve
6 creating anything comparable to the performance guaranty service of *buySafe*. Accordingly, the
7 Examiner has not reasonably tied the facts of present application to *buySafe*.

8

9

10 *Return Mail, Inc. v. U.S. Postal Service*

11 The Examiner's reliance upon *Return Mail, Inc. v. U.S. Postal Service*, 868 F.3d 1350
12 (Fed. Cir. 2017), is also misplaced. The Federal Circuit agreed with the Board that the claims
13 "are directed to the abstract idea of 'relaying mailing address data.'" *Id.* at 1368. The Federal
14 Circuit further noted the following:

15 Encoding and decoding mail recipient information — including whether the sender wants
16 a corrected address — are processes that can, and have been, performed in the human
17 mind. The claims here simply recite that existing business practice with the benefit of
18 generic computing technology. That is insufficient to make the claims any less abstract
19 under step 1. *Id.* (emphasis added).

20

21 Accordingly, the key facts present in this case is that the claims were directed to an a *pre-existing*
22 *business practice* that can and has been *performed in the human mind*.⁸

23

⁸ In fact, U.S. Patent No. 6,826,548, which was the patent at issue in *Return Mail*, recognized that the invention was directed to an improvement to a manual process (e.g., "an improved method of processing returned mail is now provided that addresses the shortcomings of historical manual updating methods').

1 As discussed above, the claimed invention is directed to the creation and serving of web
2 pages, which is inherently a technical operation that requires a specialized computer system that
3 can both create and serve web pages. The claimed invention also includes a mechanism by
4 which reciprocal links (i.e., hyperlinks) are created in web pages. Notably, this is neither some
5 practice known from the pre-Internet world nor something that can be accomplished in the
6 human mind. Rather, this is a technical operation that is necessarily performed by a specialized
7 computer system.

8
9 The Examiner's sole analysis regarding *Return Mail* was to assert "relaying address data
10 (i.e. website information), which was found to be abstract idea by a controlling court in *Return*
11 *Mail*" and "including links between the pages (i.e. web addresses) is comparable to relaying
12 address data as in *Return Mail*." First, links between pages (i.e., hyperlinks) are not comparable
13 to the address data of *Return Mail*. Claim 42, which the Federal Circuit used as a representative
14 claim, recites "receiving from a sender a plurality of mail items, each including i) a written
15 addressee, and ii) *encoded data indicating whether the sender wants a corrected address to be*
16 *provided for the addressee.*" *Id.* at 1367 (italics in original). Accordingly, what the Federal
17 Circuit deemed to be the "address data" is the physical mailing address of an addressee (i.e., the
18 physical address to which physical mail item is sent). A link is not a physical mailing address of
19 an addressee, and consequently, the Examiner's finding of "similar[ity]" is not grounded on the
20 facts.

21

1 For the reasons discussed above, the Examiner has not reasonably tied the facts of present
2 application to *Return Mail*. Accordingly, the Examiner has improperly gone beyond those
3 concepts that are similar to what the Courts identified as the abstract idea within *Return Mail*.

4
5 On page 15 of the Fourth Office Action, the Examiner responded by asserting the
6 following:

7 Examiner cited tot [sic] this case for purposes of relaying address data that the addresses
8 in question are not identical is not required. Web links *inherently* are tied to an address,
9 which in the pending claims, is relayed between the two users in order to create the
10 updated page.

11
12 By the Examiner's logic all inventions that involves web pages or links are rendered abstract
13 based upon *Return Mail* because all web pages or links involves addresses. Clearly, this is not
14 accurate since the invention within *DDR Holdings* also involved links. A difference between the
15 addresses of *Return Mail* and the links of the present application and *DDR Holdings*, is that
16 addresses are not inherently tied to technology while links are inherently tied to technology. The
17 Examiner, on page 14, asserts that "the operation is not itself necessarily rooted in technology,"
18 but the Examiner presents no explanation to support this assertion.

19
20

21 Claim 23

22 The Examiner's only analysis regarding dependent claims 23-24, 33-34, and 45-46 is to
23 assert the following on page 4 of the appealed Fourth Office Action:

24 Dependent claim(s) 23, 24, 33, 34, 45, 46 /are not directed to any
25 additional abstract ideas, however, they do recite non-abstract elements including
26 the database(s) previously discussed in the independent claims. However, the
27 databases are only functioning to store and retrieve information, and as such they

1 are not directed to significantly more.

2

3 The Examiner's analysis ignores both USPTO Guidelines and Federal Circuit case law.

4 Reference is made to M.P.E.P. § 2106.05(II), which states the following with regard to

5 dependent claims:

6 Examiners should examine each claim for eligibility separately, based on the particular
7 elements recited therein. Claims should not be judged to automatically stand or fall with
8 similar claims in an application. For instance, one claim may be ineligible because it is
9 directed to a judicial exception without amounting to significantly more, but another
10 claim dependent on the first may be eligible because it recites additional elements that do
11 amount to significantly more. (emphasis added)

12

13 The case law is clear that each claim stands or falls alone, and dependent claims can add
14 additional elements that recite substantially more than the alleged abstract idea. While the
15 Examiner's analysis incompletely identifies certain additional elements (e.g., the claimed
16 database), the Examiner's analysis does not adequately explain why these additional elements
17 recited in the dependent claims do not add significantly more to the alleged exception.

18

19 The Examiner asserts "the databases are only functioning to store and retrieve
20 information, and as such they are not directed to significantly more." There are at least two
21 problems with this abbreviated analysis. First, as already discussed above, the Examiner only
22 looks at the database limitations and not the other limitations being recited in the claims.
23 Second, merely alleging that certain elements perform conventional functions (i.e., "function[] to
24 storage and retrieve information") is not dispositive as the Federal Circuit has found "an
25 inventive concept can be found in the nonconventional and non-generic arrangement of known,
26 conventional pieces." *See BASCOM*, 827 F.3d at 1350. *Alice* Step Two involves "consider[ing]
27 the elements of each claim both individually and 'as an ordered combination' to determine

1 whether the additional elements 'transform the nature of the claim' into a patent eligible
2 application." *Alice*, 134 S.Ct. at 2355 (quoting *Mayo*, 132 S.Ct. at 1289). However, the
3 Examiner only looks at a single limitation, in isolation, and not all of the claimed limitations as
4 part of an ordered combination, as required.

5
6 Consequently, the Examiner's rejection of dependent claims does not meet the
7 requirements described within the M.P.E.P. and, therefore, the Examiner has not set forth a
8 *prima facie* case of patent ineligible subject matter with regard to the dependent claim 23.

10
11 Claim 24

12 Appellant incorporates herein the arguments previously advanced with regard to claim 23
13 since the Examiner relied upon the same analysis as to both dependent claims 23 and 24.
14 Dependent claim 24 recites a set of operations involving the dynamic generating and serving of a
15 the first web page in response to a request from a third user. These elements go to how the first
16 web page is generated and served to a requesting third user. These elements are substantially
17 more than the Examiner's alleged abstract idea of "reciprocal agreements between web pages."

19
20 Claim 32

21 Independent claims 32 and 44, while similar to independent claim 22, recite additional
22 limitations that are substantially more than the alleged abstract idea of "reciprocal agreements
23 between web pages." The Examiner's analysis (see pages 3 and 4 of the Fourth Office Action)

neither specifically identifies these additional limitations nor explains why these limitations are not substantially more than the alleged abstract idea.

THE REJECTION OF CLAIMS 22-26, 28-36, AND 38-46 UNDER 35 U.S.C. § 102 FOR ANTICIPATION BASED UPON HORSTMANN

For convenience of the Honorable Board in addressing the rejections, claims 23-26, 28-36, and 38-46 stand or fall together with independent claim 22.

Summary of Arguments

Claim 22 recites "establishing a reciprocal arrangement between the first web page and the second web page based upon both the first and second users opting to participate in the reciprocal arrangement." Additionally, claim 22 recites a second link to the first web page and a first link to the second web page (i.e., reciprocal links) are respectively included in the second and first web pages based upon the reciprocal arrangement. Therefore, the links are not added until after the reciprocal arrangement has been established. Moreover, the reciprocal arrangement between the first and second web pages is based upon both users opting to participate in the reciprocal arrangement. However, with reference to column 3, lines 20-26, Horstmann teaches:

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. (emphasis added)

1 Referring to the underlined portion of the above-reproduced passage, Horstmann describes that a
2 link is automatically created without one user (i.e., the bookstore owner) intervening within the
3 process. Accordingly, the bookstore owner has not opted into this particular reciprocal
4 arrangement at the time that the links were included in the first and second web pages.
5 Moreover, once the link has been added (without intervention), at no time does Horstmann
6 require the bookstore owner to perform any action to keep the link. Accordingly, at no time does
7 Horstmann inherently (i.e., necessarily) or explicitly teach that both of the users opt to participate
8 in the reciprocal arrangement since one of the users (e.g., the bookstore owner) never need do
9 anything to keep the link.

10
11 Claim 22

12 The methodology described by Horstmann is quite different from the claimed invention.
13 While it purports to be "[a] method [that] establishes links between pages on the Internet" (see
14 Abstract), it does so in a manner different than that claimed. As described within the Abstract of
15 Horstmann:

16 To ensure reciprocity, the method also includes prompting the owner of the
17 second site for a link back to a page of the first site and later checking the second
18 site for the link back.

19
20 Referring to page 6 of the appealed Fourth Office Action, the Examiner cites column 2, line 55
21 through column 3, lines 15-41. For ease of reference, column 3, lines 27-42 of Horstmann is
22 reproduced below:

23 After a period of time (typically a few days), verification software, typically
24 located on the links server, verifies (step 5) that the bike-shop owner reciprocated by
25 providing a link back 5 to page C as requested on form 4. Because the bike-shop owner
26 indicated on form 4 that the back link would be provided on page B, the verification
27 software searches page B for link back 5 (the third link information) to page C. If link
28 back 5 does not exist, then the verification software removes link 6 (fourth link

1 information) from the bookstore's page A to the bike shop's page D. Alternatively, the
2 software may issue a reminder to the bike shop (via e-mail, for example) to add link back
3 5 to the bookstore. Once link back 5 (third link information) is verified to exist on the
4 bike shop's page B, the method terminates. In this way, the inventive method provides for
5 the creation of reciprocal page links. (emphasis added)
6

7 As discussed above, verification software is used to search page B for a link back 5 to page C. If
8 the link back 5 does not exist, the verification software issues a "reminder to the bike shop ... to
9 add link back 5 to the bookstore." A similar methodology is also disclosed in column 4, lines
10 15-24 of Horstmann with reference to Figure 3.
11

12 The claimed invention, as recited in claim 22, includes "establishing a reciprocal
13 arrangement between the first web page and the second web page based upon both the first and
14 second users opting to participate in the reciprocal arrangement." The claims subsequently recite
15 that the reciprocal links are included in the respective first and second web pages *based upon the*
16 *reciprocal arrangement*. However, this is not what is disclosed by Horstmann.
17

18 Reference is made to Figures 2 and 3 and column 2, line 55 through column 3, line 26,
19 the process described by Horstmann is essentially as follows:

- 20 1) the bike shop owner clicks on "add link" link on the bookstore's page (Step 1 in
21 Figure 2; Step 30 in Figure 3);
- 22 2) the bike shop owner is presented with a form that solicits link information from
23 the bike shop owner (Step 3 in Figure 2; Step 31 in Figure 3);
- 24 3) using the information from the bike shop owner, a link from bookstore's page to a
25 page associated with the bike shop owner is automatically created without input from the
26 bike shop owner (Step 4 in Figure 2; Step 34 in Figure 3); and
- 27 4) the verification process already described above is performed (Step 5 in Figure 2;
28 Steps 36-40 in Figure 3).
29

30 The creation of the link from the bookstore's page to the bike shop's page is not based upon a
31 reciprocal arrangement since the page of the bike shop owner is not required to do include

1 anything (i.e., "page A is modified and redisplayed without any intervention from the bookstore
2 owner"). This is why Horstmann requires the use of a verification process to determine whether
3 the bike shop page includes a link back to the bookstore's page.

4
5 Additionally, the user associated with the bookstore's page does not opt to participate in
6 the reciprocal arrangement, as claimed. Rather, the user associated with the bookstore's page
7 opts into a scheme (i.e., Horstmann's system) that allows anybody to place a link on the
8 bookstore's page so long as the form associated with the "add link" link has been completed. As
9 claimed, the reciprocal arrangement is between the first web page and the second web page.
10 However, when the user associated with the bookstore opts into Horstmann's system, the identity
11 of the other web page is unknown. Accordingly, the user associated with the bookstore's page
12 cannot opt into "a reciprocal arrangement between the first web page and the second web page,"
13 since the identity of other web page is unknown at the time of the opting in.

14
15 Referring to page 7 of the appealed Fourth Office Action, the Examiner asserted
16 "bookstore website now shows the link to the bike store website, based on the bike shop's
17 request and the agreement between the two." However, this statement is not accurate. As
18 discussed above, the bookstore's website shows the link based upon the bike shop's request.
19 However, the bookstore's owner has not opted to participate in this particular reciprocal
20 arrangement. Instead, the link is automatically generated *with no intervention from the owner of*
21 *the bookstore*. Moreover, the bike shop owner has not necessarily opted into the reciprocal
22 arrangement since a link from the bike store page to the bookstore page does not necessarily
23 exist. For this reason, Horstmann discloses the need for a verification process.

Examiner's Response – Fourth Office Action

Many of the above-reproduced arguments (incorporated herein) were previously presented on pages 30-33 of the Third Response. The Examiner's response these arguments is found on pages 16 and 17 of the Fourth Office Action. Initially, in the first full paragraph on page 16 of the Fourth Office Action, the Examiner asserted the following:

Applicant next turns to the prior art rejections, beginning on page 30. On pages 31-32, Applicant argues that the manner in which the arrangement is made is distinct from the prior art cited. However, claim 22 specifically only requires: "establishing a reciprocal arrangement between the first web page and the second web page based upon both the first and second users opting to participate in the reciprocal arrangement." Per the cited portions of Horstmann [sic], "A method establishes reciprocal page links between pages on the Internet. According to the method, individual sites (collections of pages) include dedicated links pages that contain lists of links, primarily to other sites." Col 3 further discloses that the bike shop owner and the bookstore owner agreed to the reciprocal arrangement, and that the system automatically checks for the reciprocity. Further, if the system does not find the required reciprocal link, the system removes the reciprocal link of the compliant party - i.e. if the bookstore does not post the required reciprocal link, the like on the bike shop page is removed. (emphasis in original)

This portion of the Examiner's response does not address the issue argued by Appellant. Notably, Appellant is not contesting that the ultimate result of Horstmann is that reciprocal links are created between two websites. Rather, Appellant has argued that (i) the claimed invention achieves this ultimate result in a different manner than disclosed by Horstmann, and (ii) this different manner results in an improvement⁹ over the teachings of Horstmann.

Referring to the second full paragraph on page 16 of the Fourth Office Action, the Examiner asserted the following:

Applicant is attempting to argue limitations or aspects of the invention that are simply not present in the claims. All that is required is an agreement between the two

⁹ As argued above with regard to the rejection of the claims under 35 U.S.C. § 101.

1 parties - clearly present in Horstmann. That the reference uses software to execute some
2 of the verification does not mean there is no "reciprocal agreement" between the two.
3

4 The Examiner argues that "Applicant is attempting to argue limitations or aspects of the
5 invention that are simply not present in the claims" while asserting "[a]ll that is required is an
6 agreement between the two parties." Here, the Examiner errs by failing to consider the actual
7 claim language. The claims do not merely recite "an agreement between the two parties." This
8 statement is an overgeneralization of the claimed invention. Notably, the claims recite
9 "establishing a reciprocal arrangement between the first web page and the second web page
10 based upon both the first and second users opting to participate in the reciprocal arrangement."
11 As noted above, Horstmann explicitly teaches "page A is modified and redisplayed *without any*
12 *intervention from the bookstore owner.*" There cannot be an "agreement between the two
13 parties" when one of the parties does not opt to participate in the reciprocal arrangement.
14

15 Referring to the last full paragraph on page 16 of the Fourth Office Action, the Examiner
16 further asserts the following:

17 Applicant argues that Horstmann allows any link to be initially created, however,
18 this is untrue; the owner of the website may modify the list of links at any time.
19 (emphasis added).
20

21 To be clear, the argument referenced by the Examiner is reproduced below:

22 Aside from the differences discussed above, the claimed invention represents an
23 improvement over Horstmann's system. As discussed above, using the information from
24 the bike shop owner, a link from bookstore's page to the bike shop's page is *automatically*
25 *created without input* from the bookstore's owner. Accordingly, the bookstore's page
26 could be automatically linked to any page on the internet. There is a large number of
27 pages on the internet that the owner of the bookstore's page may not want to be
28 associated with. However, the Horstmann system allows any link to be initially created
29 on the bookstore's page. (emphasis in original)
30

1 The Examiner's response does not refute Appellant's arguments. Specifically, the Examiner
2 argues that "the owner of the website may modify the list of links at any time." However, this
3 does not change that the Horstmann system allows any link to be initially created on the
4 bookstore's website since this link is automatically created without input from the bookstore's
5 owner.¹⁰ The Examiner's assertion that the bookstore owner may subsequently edit the list does
6 not change the fact that the link can be initially created and present on the bookstore's website
7 without input (or knowledge) of the bookstore's owner.¹¹ Additionally, if the bookstore owner
8 adds a link, then that link is added not "based upon the reciprocal arrangement," as claimed but
9 based upon the bookstore owner's own desire.

10
11 The Examiner's final response to Appellant's arguments is found in the paragraph
12 spanning pages 16 and 17 of the Fourth Office Action and is reproduced below:

13 Applicant again argues the reciprocal arrangement, however, as discussed above
14 this is not persuasive as there is clearly an agreement between the bookstore owner and
15 the bike shop owner in Horstmann. Applicant's claims simply require an agreement of
16 any sort. That Horstmann goes above and beyond the creation of the agreement to include
17 verification of performance is irrelevant.

18
19 The Examiner overgeneralizes both the claims and the teachings of Horstmann.

¹⁰ As stated in column 3, lines 20-26, "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." (emphasis added)

¹¹ One can imagine a situation in which a party could intentionally damage the reputation of the bookstore using the system of Horstmann via negative association. Specifically, such a party could add links to various websites associated with disreputable groups (e.g., hate groups and terrorist organizations). Potential customers of the bookstore could see this association between the bookstore and these disreputable groups negatively and avoid using the bookstore. While the bookstore owner would be subsequently able to delete the link (see column 5, lines 39-40 of Horstmann), the damage to the reputation of the bookstore has already been done.

1

2 The Examiner's assertion that "there is clearly an agreement between the bookstore owner
3 and the bike shop owner" does not accurately reflect either the claimed invention or the teachings
4 of Horstmann. As argued above, the user associated with the bookstore's page opts into a
5 scheme (i.e., Horstmann's system) that allows anybody to place a link on the bookstore's page so
6 long as the form associated with the "add link" link has been completed. The bookstore owner
7 cannot opt into an agreement between bookstore web page with the bike shop store page because
8 the bookstore owner does not necessarily know of the bike shop page or the bike shop owner.

9

10 Conclusion

11 Based upon the foregoing, Appellant respectfully submits that the Examiner's rejections
12 under 35 U.S.C. §§ 101, 102 are not viable. Appellant, therefore, respectfully solicits the Honorable
13 Board to reverse the Examiner's rejections under 35 U.S.C. §§ 101, 102.

Application No.: 13/946,461

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 503611, and please credit any excess fees to such deposit account.

Date: July 5, 2019

Respectfully submitted,

/Scott D. Paul/

Scott D. Paul

Registration No. 42,984

CUSTOMER NUMBER 55246

VIII. CLAIMS APPENDIX

22. 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:

establishing a reciprocal arrangement between the first web page and the second web page based upon both the first and second users opting to participate in the reciprocal arrangement;

including, within the second web page and based upon the reciprocal arrangement, a second link to the first web page and associated with the first entity; and

including, within the first web page and based upon the reciprocal arrangement, a first link to the second web page and associated with the second entity.

23. The method of claim 22, wherein
the first web page is stored in a database; and
the second web page is stored in the database.

24. The method of claim 22, further comprising
receiving, from a third user, a request for the first web page;
dynamically generating, using a database, the first web page; and
serving, to the third user, the dynamically-generated first web page.

25. The method of claim 22, wherein

the first web page includes one or more web pages.

26. The method of claim 22, further comprising
including, within the first web page, a web asset provided by a third party separate from
the computer hardware system.

28. The method of claim 26, wherein
the web asset is a functional application.

29. The method of claim 22, further comprising
providing, to the first user, at least one recommended web page, associated with the
computer hardware system, into which the second link is to be included.

30. The method of claim 22, wherein
the second link is associated with a graphic image within the second web page.

31. The method of claim 30, further comprising
receiving, from the first user, the image.

32. A webpage implementation server 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:
a database system storing information associated with the first and second web pages;
a computer hardware system configured to perform:

storing first input received from the first user into the database system;
storing second input received from the second user into the database system;
establishing a reciprocal arrangement between the first web page and the second web page based upon both the first and second users opting to participate in the reciprocal arrangement;
generating, using the first input received from the first user and the reciprocal arrangement, the first web page; and
generating, using the second input received from the second and the reciprocal arrangement, the second web page, wherein
the second web page includes, based upon the reciprocal arrangement, a second link to the first web page; and
the first web page includes, based upon the reciprocal arrangement, a first link to the second web page.

33. The server system of claim 32, wherein
the first web page is stored in the database system; and
the second web page is stored in the database system.

34. The server system of claim 32, wherein the computer hardware system is further configured to perform
receiving, from a third user, a request for the first web page; and
serving, to the third user, the first web page, wherein
the first web page is dynamically generated based upon the request.

35. The server system of claim 32, wherein
the first web page includes one or more web pages.

36. The server system of claim 32, wherein the computer hardware system is further
configured to perform
including, within the first web page, a web asset provided by a third party separate from
the computer hardware system.

38. The server system of claim 36, wherein
the web asset is a functional application.

39. The server system of claim 32, wherein the computer hardware system is further
configured to perform:
providing, to the first user, at least one recommended web page, associated with the
computer hardware system, into which the second link is to be included.

40. The server system of claim 32, wherein
the second link is associated with a graphic image within the second web page.

41. The server system of claim 40, wherein the computer hardware system is further
configured to perform
receiving, from the first user, the image.

42. The method of claim 22, wherein

the first and second users are both registered users with the computer hardware system.

43. The server system of claim 32, wherein

the first and second users are both registered users with the computer hardware system.

44. 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:

storing first input received from the first user into a database system coupled to the computer hardware system;

storing second input received from the second user into the database system;

establishing a reciprocal arrangement between the first web page and the second web page based upon both the first and second users opting to participate in the reciprocal arrangement;

generating, using the first input received from the first user and based upon the reciprocal arrangement, the first web page; and

generating, using the second input received from the second user and based upon the reciprocal arrangement, the second web page, wherein

the second web page includes, based upon the reciprocal arrangement, a second link to the first web page; and

the first web page includes, based upon the reciprocal arrangement, a first link to the second web page.

45. The method of claim 44, wherein
the first web page is stored in the database system; and
the second web page is stored in the database system.

46. The method of claim 44, further comprising:
receiving, from a third user, a request for the first web page; and
serving, to the third user, the first web page, wherein
the first web page is dynamically generated based upon the request.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellant in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

A Decision on Appeal and Decision on Request for Rehearing were respectively issued on Jun 15, 2009, and September 13, 2009, in parent U.S. Application No. 09/589,551, and are attached hereto. A Memorandum Opinion was issued by the United States District Court for the District of Delaware on September 28, 2018, with regard to related U.S. Patent No. 8,768,760, and is attached hereto. That decision is currently under appeal before the Federal Circuit (Appeal No. 19-1210). A Decision Denying Institution of *Inter Partes* Review was issued by the Patent Trial and Appeal Board on June 5, 2019, with regard to related U.S. Patent No. 8,768,760, and is attached hereto. Since Appellant is unaware of any other related appeals and interferences, no other decision rendered by a court or the Board is attached hereto.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,551	06/07/2000	Thomas L. DiStefano III	1115-007U	8542
29973 7590 06/15/2009 CAREY, RODRIGUEZ, GREENBERG & PAUL LLP ATTN: STEVEN M. GREENBERG, ESQ. 950 PENINSULA CORPORATE CIRCLE SUITE 3020 BOCA RATON, FL 33487			EXAMINER LA STRA, DANIEL	
			ART UNIT 3688	PAPER NUMBER
			MAIL DATE 06/15/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1 UNITED STATES PATENT AND TRADEMARK OFFICE

2
3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7
8 *Ex parte* THOMAS L. DISTEFANO, III
9

10
11 Appeal 2009-000339
12 Application 09/589,551
13 Technology Center 3600
14

15
16 Decided: ¹ June 15, 2009
17

18
19 Before HUBERT C. LORIN, ANTON W. FETTING, and
20 JOSEPH A. FISCHETTI, *Administrative Patent Judges*.
21 FETTING, *Administrative Patent Judge*.

22 DECISION ON APPEAL

23 STATEMENT OF THE CASE

¹ The two month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

1 Thomas L. Distefano, III (Appellant) seeks review under 35 U.S.C. § 134 of a
2 non-final rejection of claims 1-21, the only claims pending in the application on
3 appeal.

4 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

5
6 We AFFIRM-IN-PART.

7 The Appellant invented a way of assisting a website designer in establishing an
8 arrangement between a first website being designed by the website designer and a
9 second website to market the first website at the second website upon the
10 activation of the first website on the internet (Spec. 6:2-5).

11 An understanding of the invention can be derived from a reading of exemplary
12 claim 1, which is reproduced below [bracketed matter and some paragraphing
13 added].

14 1. A method of assisting a website designer in establishing an
15 arrangement between a first website being designed by the
16 website designer and a second website in order to market the
17 first website at the second website upon the activation of the
18 first website on the internet, the method comprising:

19 [1] during design of the first website, receiving
20 information at a user interface indicating a type of an
21 element for marketing
22 that is to be displayed at the second website, and
23 information specifying the second website at which the
24 element is to be displayed;

25 [2] saving the information at a first database that is coupled to
26 the user interface;

1 [3] obtaining the element for marketing of the type indicated;
2 and
3 [4] causing the display of the element for marketing at the
4 second website
5 when the first website is activated with respect to the
6 internet,
7 wherein the element for marketing includes at least one
8 of
9 a banner ad concerning the first website and
10 a link to the first website.

11 This appeal arises from the Examiner's Non-Final Rejection, mailed June 18,
12 2007. The Appellant filed an Appeal Brief in support of the appeal on November
13 19, 2007. An Examiner's Answer to the Appeal Brief was mailed on February 4,
14 2008. A Reply Brief was filed on April 4, 2008.

15 PRIOR ART

16 The Examiner relies upon the following prior art:

17	Wexler	US 5,960,409	Sep. 28, 1999
18	Hess	US 6,058,417	May 2, 2000
19	Moore	US 6,330,575 B1	Dec. 11, 2001
20	Mason	US 6,401,075 B1	Jun. 4, 2002

21 REJECTIONS

22 Claims 13, 16-18, and 20 stand rejected under 35 U.S.C. § 103(a) as
23 unpatentable over Moore.

24 Claims 1, 4-12, 19, and 21 stand rejected under 35 U.S.C. § 103(a) as
25 unpatentable over Mason and Moore.

Claims 2 and 3 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Wexler.

Claims 14 and 15 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Hess.

ISSUES

The issue of whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 1, 4-12, 19, and 21 under 35 U.S.C. § 103(a) as unpatentable over Mason and Moore turns on to whether the art describes, or shows that it was predictable, that (1) during design of the first website, information is received that is to be displayed at the second website and that specifies the second website at which the element is to be displayed, and (2) when the first website is activated with respect to the internet, the display of the element is caused, wherein the element includes a banner ad or a link to the first website. In addition, the issues as to claims 4-6 and 8-10 turn on whether the art describes the limitations added by those dependent claims.

The issues of whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 13, 16-18, and 20 under 35 U.S.C. § 103(a) as unpatentable over Moore, in rejecting claims 2 and 3 under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Wexler, and in rejecting claims 14 and 15 under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Hess turn on the resolution of the issues in the rejection of claim 1.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to Appellant's Disclosure

01. 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 (Spec. 33:9-13).

Moore

02. Moore is directed to providing a scalable distributed Internet commerce system (Moore 1:11-13).

03. Moore describes a method for designing a Web page, to be hosted on a Web page server, and for publishing the Web page at a destination of the customer's choosing. There is also a method for designing a Web page for use in a distributed electronic commerce system having a Web page server and a second server where the Web page server hosts the Web page. The method creates a link to the second server; designs the Web page such that the link can be embedded into the Web page; and embeds the link into the Web page (Moore 3:23-43).

04. Moore describes how the customer goes to a Store Server and begins shopping. When the customer finds a product to buy, he selects that product and the Store Server then jumps to the Store Builder Server by using a Uniform Resource Locator ("URL"). The URL, called a price URL, contains all of the relevant information on the product, and all the information necessary to build a "Buy Page." (Moore 6:12-20.)

05. Moore Fig. 7 shows several regions with information displayed, such that each would be a display region.

1 06. Moore describes the practice of using audio in HTML documents
2 (Moore 1:38-42).

3 *Mason*

4 07. Mason is directed to placing advertisements and/or other
5 communications on multiple websites (Mason 1:5-8).

6 08. Mason describes obtaining Internet-type advertisements, modifying
7 those advertisements to fit the designated advertising spaces allotted by
8 different and unrelated online newspaper websites, automatically placing
9 those advertisements, monitoring the success of the placed ads and
10 modifying the ads and their placements to meet dynamic goals of an
11 advertising campaign (Mason 2:5-12).

12 09. Mason facilitates the billing of an advertiser. For example, a national
13 advertiser can purchase advertising space on an online newspaper
14 website by the number of hits the ad receives or by the number of click-
15 throughs (Mason 5:4-8).

16 10. In Mason, the advertiser can upload one or more original ads into a
17 server which checks the configuration of the ad, and compares that
18 configuration to specifications of online newspaper website URLs where
19 the derivative advertisement links are going to be placed. Typically, the
20 original advertisement must be modified, forming derivative
21 advertisement links which are then displayed for final approval. If the
22 reconfigured ad is approved, it is stored for placement (Mason 5:47-58).

Facts Related To The Level Of Skill In The Art

11. Neither the Examiner nor the Appellant has addressed the level of ordinary skill in the pertinent arts of systems analysis and programming, web design, and web advertising design. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

12. Those of ordinary skill in the art knew at the time of filing that posting an HTML document to a web site such that it was accessible from links to that web site activated that document within the site.

Facts Related To Secondary Considerations

13. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369, (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed.

1 Cir. 2003) (claims must be interpreted “in view of the specification” without
2 importing limitations from the specification into the claims unnecessarily).

3 Although a patent applicant is entitled to be his or her own lexicographer of
4 patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*,
5 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such
6 definitions in the specification with sufficient clarity to provide a person of
7 ordinary skill in the art with clear and precise notice of the meaning that is to be
8 construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although
9 an inventor is free to define the specific terms used to describe the invention, this
10 must be done with reasonable clarity, deliberateness, and precision; where an
11 inventor chooses to give terms uncommon meanings, the inventor must set out any
12 uncommon definition in some manner within the patent disclosure so as to give
13 one of ordinary skill in the art notice of the change).

14 *Obviousness*

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16 A claimed invention is unpatentable if the differences between it and the
17 prior art are “such that the subject matter as a whole would have been obvious at
18 the time the invention was made to a person having ordinary skill in the art.”
19 35 U.S.C. § 103(a) (2000); *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406
20 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

21 In *Graham*, the Court held that that the obviousness analysis is bottomed on
22 several basic factual inquiries: “[(1)] the scope and content of the prior art are to be
23 determined; [(2)] differences between the prior art and the claims at issue are to be
24 ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” 383
25 U.S. at 17. *See also KSR*, 550 U.S. at 406. “The combination of familiar elements

1 according to known methods is likely to be obvious when it does no more than
2 yield predictable results.” *Id.* at 416.

3 “When a work is available in one field of endeavor, design incentives and
4 other market forces can prompt variations of it, either in the same field or a
5 different one. If a person of ordinary skill can implement a predictable variation,
6 § 103 likely bars its patentability.” *Id.* at 417.

7 “For the same reason, if a technique has been used to improve one device,
8 and a person of ordinary skill in the art would recognize that it would improve
9 similar devices in the same way, using the technique is obvious unless its actual
10 application is beyond his or her skill.” *Id.*

11 “Under the correct analysis, any need or problem known in the field of
12 endeavor at the time of invention and addressed by the patent can provide a reason
13 for combining the elements in the manner claimed.” *Id.* at 420.

14 *Obviousness and Nonfunctional Descriptive Material*
15

16 Nonfunctional descriptive material cannot render nonobvious an invention that
17 would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir.
18 2004). Cf. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive
19 material is not functionally related to the substrate, the descriptive material will not
20 distinguish the invention from the prior art in terms of patentability).

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ANALYSIS

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Claims 1-3, 7, and 11-21

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The Appellant argues claims 1, 7, 11, 12, 19, and 21 as a group². In addition, the Appellant applies the arguments in support of claim 1 as the arguments to the rejections of claims 13-18 and 20. Accordingly, we treat claims 1, 7, and 11-21 as a group and select claim 1 as representative of the group.
37 C.F.R. § 41.37(c)(1)(vii) (2007).

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The Examiner found that Mason describes the limitations of claim 1 except for “during the design of the first website causing the display of the element for marketing at the second website when the first website is activated with respect to the Internet.” The Examiner found that Moore described this limitation and that one of ordinary skill knew to combine this with Mason to avoid premature advertising expense before the advertising was launched (Ans. 3-4).

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The Appellant argues that (1) Mason fails to describe activity during a website design (App. Br. 7); (2) neither reference describes a problem to which the Examiner proposed a solution as the motivation to combine the references (App. Br. 8); and (3) neither reference describes causing the display of the element for marketing at the second website when the first website is activated with respect to the internet, as claimed (App. Br. 8). Additionally, the Appellant contends that (4) the Examiner failed to clearly identify how the art describes the claim limitations (App. Br. 5-6); (5) the Examiner mischaracterized limitations [1] and [4] (Appeal

² The Appellant included claim 6 in this group (App. Br. 5), but claim 6 depends from claim 4 which is not included in the group. We therefore consider this inclusion of claim 6 to be a typographic error and treat claim 6 with claims 4 and 5 *infra*.

1 Br. 6-7); and (6) one skilled in the art would not consider the words posted and
2 activated to be equivalent (App. Br. 9).

3 As to each of these arguments, the Examiner responded that (1) Moore was
4 applied to describe activity during a website design (Ans. 16); (2) Mason described
5 the practice of paying advertising fees based on ad click-throughs and one of
6 ordinary skill knew the disadvantage of placing such an ad before an advertising
7 campaign was ready (Ans. 16-17); and (3) that such display of ad elements for
8 marketing at websites other than the site where the ad was designed was
9 notoriously well known as evidenced by Moore's referral to Price URL's that users
10 publish when the second web site is activated (Ans. 17).

11 As to the three subordinate contentions, the Examiner responded to (4) by
12 laying out a more detailed analysis of the match between claim limitations and the
13 references (Ans. 14-15); to (5) by finding that the Examiner's paraphrasing of
14 limitations [1] and [4] were made in view of the support for those limitations in the
15 Specification at 33:10-15 (Ans. 15-16); and to (6) by finding the equivalence of the
16 words "posted" and "activated" based on Specification 33:10-15 (Ans. 18).

17 The Appellant responded to the Examiner's response to argument (2) by stating
18 that the Examiner's position appeared to be based on inherency and that inherency
19 cannot be based on probabilities (Reply Br. 3-4); and contention (5) that the
20 Specification does not support the Examiner's paraphrase, but instead requires that
21 once the design is completed and the website is posted/activated, then the link
22 and/or banner ad is displayed (Reply Br. 5).

23 We disagree with the Appellants. There is no contention regarding the
24 ubiquitous steps of saving and obtaining data in limitations [2] and [3]. The issues
25 in the remaining limitations [1] and [4] come down to whether the art describes, or

1 shows that it was predictable, that (1) during design of the first website,
2 information is received that is to be displayed at the second website and that
3 specifies the second website at which the element is to be displayed, and (2) when
4 the first website is activated with respect to the internet, the display of the element
5 is caused, wherein the element includes a banner ad or a link to the first website.

6 Limitation [1] requires that two items of information be received at a user
7 interface. The location of the user interface is unspecified. The intent of the two
8 items is that they indicate a marketing element type and specify a second site
9 location. However, the verb “indicating” does not require that the information
10 actually be displayed or used to identify the second site, only that the information
11 be functionally capable of doing so in some context. The Examiner relied on
12 Mason to describe this. Mason describes uploading ads into a server which checks
13 the configuration of the ad, and compares that configuration to specifications of
14 online newspaper website URLs where the derivative advertisement links are
15 going to be placed (FF 10). Thus, Mason’s information indicates an advertising
16 marketing element type and specifies a second site location. This information is
17 received at the user interface prior to final approval (FF 10) and is therefore during
18 the design of the website, or at least that particular advertising piece of the second
19 website. The design of any aspect of a web site is a component of the design of the
20 web site itself and thus fits the limitation of occurring during design of the web
21 site. We therefore find the Examiner’s position that Mason describes limitation [1]
22 supported by substantial evidence.

23 Limitation [4] requires causing the display of the element that includes either a
24 banner ad concerning the first website or a link to the first website for marketing at
25 the second website when the first website is activated with respect to the internet.

1 Limitation [4] does not specify the causation trigger but does require some
2 coincidence of timing between the display and website activation.

3 The verb “is activated” is the passive voice of activate, and thus limitation [4]
4 requires that the display occur when someone or something activates the web site.
5 The Examiner found that Moore described a system for designing websites where a
6 first website is activated with respect to the Internet when the first website is
7 posted to a hosting server (Answer 4; FF 03). The Examiner construed the verb
8 “activate” as equivalent to the verb “post” based on the use of the construct
9 “posted/activated” in the Specification (Ans. 4; FF 01). From this construction, the
10 Examiner found that Moore described causing the display of the element that
11 includes a banner ad concerning the first website at the *first* website when the first
12 website is activated with respect to the internet. The Appellant’s contention (6)
13 *supra* challenged this construction. Certainly activating is not equivalent to
14 posting in general. However, it is notoriously well known that posting an HTML
15 document on a web site, such that links activates that document within that site.
16 Thus, in the limited context of Internet systems, posting is synonymous with
17 activation (FF 12).

18 So the issue remaining is whether it was predictable to cause the display of the
19 element that includes a banner ad concerning the first website at the *second*
20 website when the first website is activated with respect to the internet. The
21 distinction is that now coordination is required to have display of an ad occur at a
22 second site when activation of the target of the ad occurs at a difference site. The
23 Examiner found it was predictable because without such coordination, the risk of
24 incurring advertising costs prior to the availability of the advertised target would
25 cause the advertising campaign to coordinate those events. The Appellant

1 responded with argument (2) *supra* that the references applied fail to show this
2 problem and that inherency cannot be based on probabilities.

3 Claim 1 does not specify how the coordination occurs, only that it occurs. The
4 Appellant does not make any arguments regarding the coordination mechanism.
5 So the sole issue is whether it was predictable at the time of filing.

6 The obviousness analysis cannot be confined by a formalistic
7 conception of the words teaching, suggestion, and motivation, or by
8 overemphasis on the importance of published articles and the explicit
9 content of issued patents. The diversity of inventive pursuits and of
10 modern technology counsels against limiting the analysis in this way.
11 In many fields it may be that there is little discussion of obvious
12 techniques or combinations, and it often may be the case that market
13 demand, rather than scientific literature, will drive design trends.

14 *KSR*, 550 U.S. at 419. “[T]he analysis need not seek out precise teachings
15 directed to the specific subject matter of the challenged claim, for a court can take
16 account of the inferences and creative steps that a person of ordinary skill in the art
17 would employ.” *Id.* 550 U.S. at 418. “[A] court must ask whether the
18 improvement is more than the predictable use of prior art elements according to
19 their established functions.” *id.* 550 U.S. at 417.

20 As the Examiner found, Mason describes the parameters of the problem in that
21 advertising may be billed based on click-throughs (FF 09). Common sense, let
22 alone knowledge of one of ordinary skill, informs one that with such an
23 arrangement, the mechanism that incurs those costs should not be deployed until
24 the advertisement would be effective, *viz.* at activation of the ad target. On the
25 other side, with any new promotional campaign, delay beyond the earliest
26 appropriate start time is counter to the purpose of such promotion. Thus, the time
27 that one of ordinary skill in the promotional arts would display such an ad would

1 be when the target of the ad is activated. As to the Appellant's argument regarding
2 inherency, this rejection is one of obviousness rather than novelty.

3 Accordingly we find the Appellant's arguments unpersuasive.

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.

14 *Claims 8-10*

15 Claims 8-10 depend from claim 1 and further require providing banner ads,
16 display regions, and sonic effects. The Appellant argues these are missing from
17 the applied references. The Examiner responds that Moore's price URL's are
18 equivalent to banner ads and that Moore show the use of display regions and audio
19 (Ans. 21-22). The Appellant responded that the Examiner failed to show that
20 Moore's price URL's are equivalent to banner ads and that the Examiner failed to
21 show all of the limitations of claims 9 and 10 (Reply Br. 9-10).

22 We disagree with the Appellant. A banner ad is simply a link in an HTML
23 document. The contents of the ad are non-functional descriptive material and are
24 accorded no patentable weight. *In re Ngai*, 367 F.3d at 1339. Moore shows such
25 links (FF 04). Moore also shows display regions and sonic effects (FF 05 & 06).

1 The general allegation that the Examiner has failed to show all of the limitations is
2 not a specific argument.

3 CONCLUSIONS OF LAW

4 The Appellant has not sustained its burden of showing that the Examiner erred
5 in rejecting claims 13, 16-18, and 20 under 35 U.S.C. § 103(a) as unpatentable
6 over Moore.

7 The Appellant has not sustained its burden of showing that the Examiner erred
8 in rejecting claims 1, 7-12, 19, and 21 under 35 U.S.C. § 103(a) as unpatentable
9 over Mason and Moore.

10 The Appellant has sustained its burden of showing that the Examiner erred in
11 rejecting claims 4-6 under 35 U.S.C. § 103(a) as unpatentable over Mason and
12 Moore.

13 The Appellant has not sustained its burden of showing that the Examiner erred
14 in rejecting claims 2 and 3 under 35 U.S.C. § 103(a) as unpatentable over Mason,
15 Moore, and Wexler.

16 The Appellant has not sustained its burden of showing that the Examiner erred
17 in rejecting claims 14 and 15 under 35 U.S.C. § 103(a) as unpatentable over
18 Mason, Moore, and Hess.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 13, 16-18, and 20 under 35 U.S.C. § 103(a) as unpatentable over Moore is sustained.
- The rejection of claims 1, 7-12, 19, and 21 under 35 U.S.C. § 103(a) as unpatentable over Mason and Moore is sustained.
- The rejection of claims 4-6 under 35 U.S.C. § 103(a) as unpatentable over Mason and Moore is not sustained.
- The rejection of claims 2 and 3 under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Wexler is sustained.
- The rejection of claims 14 and 15 under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Hess is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

JRG

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,551	06/07/2000	Thomas L. DiStefano III	1115-007U	8542
29973 7590 09/13/2009 CAREY, RODRIGUEZ, GREENBERG & PAUL LLP ATTN: STEVEN M. GREENBERG, ESQ. 950 PENINSULA CORPORATE CIRCLE SUITE 3020 BOCA RATON, FL 33487			EXAMINER LAстра, DANIEL	
			ART UNIT 3688	PAPER NUMBER
			MAIL DATE 09/13/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1 UNITED STATES PATENT AND TRADEMARK OFFICE

2
3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* THOMAS L. DISTEFANO, III
9

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11 Appeal 2009-000339
12 Application 09/589,551
13 Technology Center 3600
14

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16 Decided: September 13, 2009
17

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19 Before HUBERT C. LORIN, ANTON W. FETTING, and
20 JOSEPH A. FISCHETTI, *Administrative Patent Judges*.
21 FETTING, *Administrative Patent Judge*.

22
23 DECISION ON REQUEST FOR REHEARING
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STATEMENT OF THE CASE

The Appellants filed a REQUEST FOR REHEARING on August 17, 2009. The Examiner rejected claims 1-21 in a Non-Final Rejection, mailed June 18, 2007. We affirmed the rejections of claims 1-3 and 7-21 and reversed the rejections of claims 4-6 in our June 16, 2009 Decision. The Appellants seek reconsideration of the decision to affirm these rejections.

We DENY the REQUEST FOR REHEARING.

ISSUES

The issues pertinent to this request are whether the Appellants have sustained their burden of showing that we misapprehended the art or the claims and thus erred in sustaining the rejections of claims, or that we erred in any new grounds of rejection we entered. 37 C.F.R. 41.52(a)(1) and (3).

ANALYSIS

We found the following in our decision:

The Appellant had not sustained its burden of showing that the Examiner erred in rejecting claims 13, 16-18, and 20 under 35 U.S.C. § 103(a) as unpatentable over Moore.

The Appellant had not sustained its burden of showing that the Examiner erred in rejecting claims 1, 7-12, 19, and 21 under 35 U.S.C. § 103(a) as unpatentable over Mason and Moore.

The Appellant had sustained its burden of showing that the Examiner erred in rejecting claims 4-6 under 35 U.S.C. § 103(a) as unpatentable over Mason and Moore.

The Appellant had not sustained its burden of showing that the Examiner erred in rejecting claims 2 and 3 under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Wexler.

1 The Appellant had not sustained its burden of showing that the
2 Examiner erred in rejecting claims 14 and 15 under 35 U.S.C. §
3 103(a) as unpatentable over Mason, Moore, and Hess.

4 Decision 16.

5 *Independent Claim 1*

6 Independent claim 1 is directed to a method, whose first step occurs “during
7 design of a first website.” The Appellants argue that we misapprehended the
8 Examiner’s findings and changed the basic thrust of the rejection, essentially
9 making a new ground which the Appellants now ask to argue. The Appellants in
10 particular contend that the Examiner did not find that Mason described the “during
11 design of the first web site” of limitation [1] and expressly found that Mason did
12 not find it so. Thus the Appellants contend that our analysis presented a different
13 thrust from that of the Examiner and was therefore a new ground. Request 4:19 –
14 6:11.

15 We agree that the Examiner did not apply Mason for this claim limitation and
16 we will accept the Appellants’ characterization of our analysis as a new ground in
17 an abundance of caution to afford the Appellants the opportunity to argue our
18 findings as to the design limitation. We found that

19 Mason’s information indicates an advertising marketing element type
20 and specifies a second site location. This information is received at
21 the user interface prior to final approval (FF 10) and is therefore
22 during the design of the website, or at least that particular advertising
23 piece of the second website. The design of any aspect of a web site is
24 a component of the design of the web site itself and thus fits the
25 limitation of occurring during design of the web site.

26 Decision 12:15-21.

27 The Appellants contend that our claim construction is not reasonable and
28 eviscerates any definite meaning from the phrase "during the design of the first

1 web site." Request 6: 9-11. To the contrary, our finding simply equates the
2 process of design to the sum of its parts. The Appellants propose hypothetical
3 design situations that would extend the design time frame back to 300 BC, based
4 on the design of the triangle as a concept, in an advertisement incorporating
5 triangles. This argument is misplaced because it hypothesizes our finding as
6 implying a nonsensical and irrelevant design time frame prior to the beginning of a
7 web site design while the real implication is that design may be an ongoing process
8 that may and realistically often does extend indefinitely in the future, after the
9 beginning of the web site design process.

10 Let us be clear as to what our finding was – that the design of any aspect of a
11 web site, not of parts that might have been designed prior to the beginning of the
12 web site design, is an aspect of the web site design. Thus, none of such aspects as
13 we referred to can begin prior to the start of the concept of designing the web site.
14 But they can continue indefinitely afterward.

15 The Appellant contends that the phrase "during the design of the first website"
16 refers to the duration that starts when a designer makes a definitive step to design
17 the website and ends when the design of the website has been completed. Request
18 7:13-15. We find little to quarrel with in this proffer, but point out that completion
19 may never occur, since design may continue even after a web site is placed in
20 action. To the extent the Appellants may have meant completion of an initial
21 design, or of a particular design version, the claim does not recite that and in any
22 event, would simply substitute the ambiguity of when an design version completes
23 for the ambiguity of when the total design completes.

24 Thus, rather than our finding being unreasonable and eviscerating any definite
25 meaning from the phrase "during the design of the first web site," our finding

1 highlights the breadth of the scope of this temporal limitation. Simply pointing out
2 how broad a limitation is does not eviscerate the limitation. Rather that very
3 breadth might eviscerate the ability of that limitation to actually narrow the claim
4 scope. The choice of the terms used in the claims is that of the Appellants. We
5 simply analyzed the breadth of the terms and how they affected the scope of the
6 claims.

7 As to how our finding applied to the rejection, Mason's description of
8 changing an advertisement on a web site (Decision 6: FF 10) was evidence of a
9 change in the design of the web site containing that advertisement, and thus
10 occurred during the design of the web site. Thus, we find this argument
11 unpersuasive as to error on our part.

12

13 *Independent Claim 8*

14 Independent claim 8 requires selecting a banner ad. We found that a banner ad
15 is simply a link in an HTML document and that Moore described the link and that
16 the contents of the ad attached to a banner ad link are non-functional descriptive
17 material, citing to *In re Ngai*, 367 F.3d 1336,1339.(Fed.Cir. 2004). Decision 9:17-
18 18 and15:22-25.

19 The Appellants argue that our citation to *In re Ngai* constituted a new ground
20 which the Appellants now ask to argue. Request 8:7 – 9:5. We will accept the
21 Appellants' characterization of this as a new ground in an abundance of caution to
22 afford the Appellants the opportunity to argue our findings as to the non-functional
23 descriptive material nature of the contents of a banner ad.

24 The Appellants argue that the claimed banner ad is a type of data structure that
25 includes more than just "simply a link in an HTML document." *Id.* The Appellants

1 argue that banner ads also include a graphical image file and a means to connect
2 the link to a graphical image file, and the banner ad can also be animated, which
3 requires a mechanism to do so or even be interactive with a user input (e.g., a
4 mouse). The Appellants conclude that one skilled in the art would recognize the
5 claimed "banner ad" is a particular type of data structure that includes more than
6 just a link. *Id.*

7 To this argument, we find that the claim makes no reference to animation,
8 interactivity, or user input with a mouse with respect to a banner ad. As to being a
9 data structure, any non-functional descriptive material stored in a computer is a
10 data structure. The issue is whether the data structure has operational
11 functionality. The Appellants pick up on this by citing *In re Lowry*, 32 F. 3d 1579,
12 1583 (Fed. Cir. 1994). The Appellants contend that Lowry's data structures, which
13 according to Lowry greatly facilitate data management by data processing systems,
14 are processed by a machine and are not accessible other than through sophisticated
15 software systems.

16 The Appellants reach the wrong conclusion from this. Lowry's data structure
17 fundamentally altered the processing of the computer; their patentable weight arose
18 not because they were processed by the machine, but because they affected the
19 processing of the computer. Data structures that have no functional relationship
20 with the claimed subject matter are, by definition, non-functional descriptive
21 material. An advertisement, absent explicit incorporation of functional properties,
22 even on a computer display, is non-functional descriptive material.

23 The Appellants argue we failed to give full weight to the meaning of a banner
24 ad. Request 10:19-21. We equated a banner ad to a link attached to non-functional
25 descriptive material. To the extent the link is functional, both we and the

1 Examiner found that Moore's price URL's described the use of such links. The
2 only issue was whether attaching an advertisement, as contrasted with any other
3 descriptive matter such as in Moore, to that link should be afforded patentable
4 weight. We found such did not, citing *In re Ngai*, 367 F.3d at 1339. To the extent
5 the Appellants are arguing that we ignored the link component of a banner ad, our
6 finding as to Moore makes that argument unpersuasive. To the extent the
7 Appellants are arguing that a banner ad may have a functional component aside
8 from its link, the claim does not recite such a functional component, and such a
9 component is not inherent to banner ads per se. Thus, we find the arguments
10 unpersuasive as to error on our part.

11 For the above reasons we are not convinced of reversible error in our
12 decision. Accordingly, the Appellants' request for rehearing is denied.

13 DECISION

14 To summarize, our decision is as follows:

- 15 • We have considered the REQUEST FOR REHEARING
- 16 • We DENY the request that we reverse the Examiner as to claims 1-3 and 7-
17 21.
 - 18 ○ The rejection of claims 13, 16-18, and 20 under 35 U.S.C. § 103(a) as
19 unpatentable over Moore remains sustained.
 - 20 ○ The rejection of claims 1, 7-12, 19, and 21 under 35 U.S.C. § 103(a)
21 as unpatentable over Mason and Moore remains sustained.
 - 22 ○ The rejection of claims 4-6 under 35 U.S.C. § 103(a) as unpatentable
23 over Mason and Moore remains not sustained.

- 1 ○ The rejection of claims 2 and 3 under 35 U.S.C. § 103(a) as
- 2 unpatentable over Mason, Moore, and Wexler remains sustained.
- 3 ○ The rejection of claims 14 and 15 under 35 U.S.C. § 103(a) as
- 4 unpatentable over Mason, Moore, and Hess remains sustained.

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DENIED

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10 mev

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**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

DISTEFANO PATENT TRUST III, LLC,	:	
	:	
Plaintiff,	:	
	:	
v.	:	C.A. No. 17-1798-LPS-CJB
	:	
LINKEDIN CORPORATION,	:	
	:	
Defendant.	:	
	:	
	:	
	:	

MEMORANDUM OPINION

Timothy Devlin, DEVLIN LAW FIRM LLC, Wilmington, DE

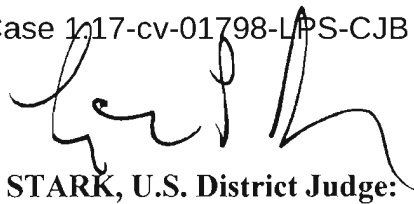
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September 28, 2018
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STARK, U.S. District Judge:

Plaintiff DiStefano Patent Trust III, LLC (“Plaintiff” or “DiStefano”) asserts that Defendant LinkedIn Corporation (“Defendant” or “LinkedIn”) infringes DiStefano’s U.S. Patent No. 8,768,760 (the “’760 patent”), entitled “Reciprocal Linking Arrangement between Web Pages.” (D.I. 11 at 2-3) LinkedIn has filed a motion to dismiss, pursuant to Federal Rule of Civil Procedure 12(b)(6), on the grounds that the ’760 patent fails to claim patent-eligible subject matter under 35 U.S.C. § 101. (D.I. 12) The parties submitted briefing (D.I. 13, 16, 18) and the Court heard oral argument on July 31, 2018 (*see* D.I. 25) (“Tr.”). For the reasons stated below, the Court will grant LinkedIn’s motion to dismiss.

I. BACKGROUND

There ’760 patent relates to “developing web pages through the use of a graphical user interface.” ’760 Pat. at 1:25-26. Specifically, the patent describes a method of creating a reciprocal arrangement between two websites in order to market the first website at the second website. *See id.* at 3:12-28.

DiStefano contends LinkedIn infringes claims 1, 4, 5, 8, and 10 of the ’760 patent. (D.I. 11 at 4)¹ Independent claim 1 recites:

¹In its motion to dismiss, LinkedIn asserts that “there is no meaningful difference between the asserted claims and unasserted claims for purposes of invalidity under Section 101” and, therefore, requests the Court hold all claims invalid. (*See* D.I. 13 at 3 n.1) DiStefano responds that the unasserted claims are not part of this action and further, the asserted claims are directed to a method, whereas the unasserted claims are directed to a computer hardware system. (D.I. 16 at 7 n.1) The Court agrees with DiStefano that the unasserted claims are not a part of this action and thus, the Court’s analysis is limited to the asserted claims. *See Alcon Research Ltd. v. Barr Labs., Inc.*, 745 F.3d 1180, 1193 (Fed. Cir. 2014) (“The scope of any judgment should conform to the issues that were actually litigated.”); *see also Uniloc USA, Inc. v. ADP, LLC*, 279 F. Supp. 3d 736, 741 (E.D. Tex. 2017) (declining to consider invalidity of unasserted claims).

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;

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

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

The remaining asserted claims all depend from claim 1. During oral argument, the parties agreed that claim 1 is representative. (*See* Tr. at 4 (“[C]laim 1 is representative.”), 50 (“[T]his case could rise or fall on claim 1 as to the asserted claims.”))²

²“The asserted dependent claims – 4, 5, 8, and 10 – add the following limitations: (4) a third party requesting the first web page and having the web page provided to it; (5) the ‘first web page’ including ‘one or more web pages’; (8) providing the first user a plurality of recommended web pages; and (10) the ‘second functional identification element’ including an ‘image.’” (D.I. 13 at 3)

II. LEGAL STANDARDS

A. Rule 12(b)(6) Motion to Dismiss

Evaluating a motion to dismiss under Federal Rule of Civil Procedure 12(b)(6) requires the Court to accept as true all material allegations of the complaint. *See Spruill v. Gillis*, 372 F.3d 218, 223 (3d Cir. 2004). “The issue is not whether a plaintiff will ultimately prevail but whether the claimant is entitled to offer evidence to support the claims.” *In re Burlington Coat Factory Sec. Litig.*, 114 F.3d 1410, 1420 (3d Cir. 1997) (internal quotation marks omitted). Thus, the Court may grant such a motion to dismiss only if, after “accepting all well-pleaded allegations in the complaint as true, and viewing them in the light most favorable to plaintiff, plaintiff is not entitled to relief.” *Maio v. Aetna, Inc.*, 221 F.3d 472, 481-82 (3d Cir. 2000) (internal quotation marks omitted).

A well-pleaded complaint must contain more than mere labels and conclusions. *See Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009); *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555 (2007). A plaintiff must plead facts sufficient to show that a claim has substantive plausibility. *See Johnson v. City of Shelby*, 135 S. Ct. 346, 347 (2014). A complaint may not be dismissed, however, for imperfect statements of the legal theory supporting the claim asserted. *See id.* at 346.

“To survive a motion to dismiss, a civil plaintiff must allege facts that ‘raise a right to relief above the speculative level on the assumption that the allegations in the complaint are true (even if doubtful in fact).’” *Victaulic Co. v. Tieman*, 499 F.3d 227, 234 (3d Cir. 2007) (quoting *Twombly*, 550 U.S. at 555). A claim is facially plausible “when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the

misconduct alleged.” *Iqbal*, 556 U.S. at 678. At bottom, “[t]he complaint must state enough facts to raise a reasonable expectation that discovery will reveal evidence of [each] necessary element” of a plaintiff’s claim. *Wilkerson v. New Media Tech. Charter Sch. Inc.*, 522 F.3d 315, 321 (3d Cir. 2008) (internal quotation marks omitted).

The Court is not obligated to accept as true “bald assertions,” *Morse v. Lower Merion Sch. Dist.*, 132 F.3d 902, 906 (3d Cir. 1997) (internal quotation marks omitted), “unsupported conclusions and unwarranted inferences,” *Schuylkill Energy Res., Inc. v. Pa. Power & Light Co.*, 113 F.3d 405, 417 (3d Cir. 1997), or allegations that are “self-evidently false,” *Nami v. Fauver*, 82 F.3d 63, 69 (3d Cir. 1996).

B. Patentable Subject Matter

Under 35 U.S.C. § 101, “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” There are three exceptions to § 101’s broad patent-eligibility principles: “laws of nature, physical phenomena, and abstract ideas.” *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980). “Whether a claim recites patent eligible subject matter is a question of law which may contain disputes over underlying facts.” *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1368 (Fed. Cir. 2018).

In *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289 (2012), the Supreme Court set out a two-step “framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014). First, courts must determine if the claims at issue are directed to a patent-ineligible concept (“step

one”). *See id.* If so, the next step is to look for an “‘inventive concept’ – i.e., an element or combination of elements that is sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself” (“step two”). *Id.* The two steps are “plainly related” and “involve overlapping scrutiny of the content of the claims.” *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016).

At step one, “the claims are considered in their entirety to ascertain whether their character **as a whole** is directed to excluded subject matter.” *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015) (emphasis added); *see also Affinity Labs of Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016) (“*Affinity Labs I*”) (stating first step “calls upon us to look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter”).

In conducting the step one analysis, courts should not “oversimplif[y]” key inventive concepts or “downplay” an invention’s benefits. *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1337-38 (Fed. Cir. 2016); *see also McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1313 (Fed. Cir. 2016) (“[C]ourts ‘must be careful to avoid oversimplifying the claims’ by looking at them generally and failing to account for the specific requirements of the claims.”) (quoting *In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016)).

At step two, courts must “look to both the claim as a whole and the individual claim elements to determine whether the claims contain an element or combination of elements that is sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the ineligible concept itself.” *McRo*, 837 F.3d at 1312 (internal brackets and quotation marks omitted). The “standard” step two inquiry includes consideration of whether claim elements

“simply recite ‘well-understood, routine, conventional activit[ies].’” *Bascom Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350 (Fed. Cir. 2016) (quoting *Alice*, 134 S. Ct. at 2359). “Simply appending conventional steps, specified at a high level of generality, [is] not **enough** to supply an inventive concept.” *Alice*, 134 S. Ct. at 2357 (internal quotation marks omitted; emphasis in original).

However, “[t]he inventive concept inquiry requires more than recognizing that each claim element, by itself, was known in the art.” *Bascom*, 827 F.3d at 1350. In *Bascom*, the Federal Circuit held that “the limitations of the claims, taken individually, recite generic computer, network and Internet components, none of which is inventive by itself,” but nonetheless determined that an **ordered combination** of these limitations was patent-eligible under step two. *Id.* at 1349.

The Federal Circuit recently elaborated on the step two standard, stating that “[t]he question of whether a claim element or combination of elements is well-understood, routine and conventional to a skilled artisan in the relevant field is a question of fact. Any fact, such as this one, that is pertinent to the invalidity conclusion must be proven by clear and convincing evidence.” *Berkheimer*, 881 F.3d at 1368; *see also Aatrix*, 882 F.3d at 1128 (“While the ultimate determination of eligibility under § 101 is a question of law, like many legal questions, there can be subsidiary fact questions which must be resolved en route to the ultimate legal determination.”); *Automated Tracking*, 2018 WL 935455, at *5 (“We have held that ‘whether a claim element or combination of elements is well-understood, routine and conventional to a skilled artisan in the relevant field is a question of fact.’”) (quoting *Berkheimer*, 881 F.3d at 1368).

“Whether a particular technology is well-understood, routine, and conventional goes beyond what was simply known in the prior art. The mere fact that something is disclosed in a piece of prior art, for example, does not mean it was well-understood, routine, and conventional.” *Berkheimer*, 881 F.3d at 1369; *see also Exergen*, 2018 WL 1193529, at *4 (“Something is not well-understood, routine, and conventional merely because it is disclosed in a prior art reference. There are many obscure references that nonetheless qualify as prior art.”). Still, “[w]hen there is no genuine issue of material fact regarding whether the claim element or claimed combination is well-understood, routine, [and] conventional to a skilled artisan in the relevant field, this issue can be decided on summary judgment as a matter of law.” *Id.*

As part of the step two “inventive concept” inquiry, the Federal Circuit has looked to the claims as well as the specification. *See Affinity Labs of Texas, LLC v. Amazon.com Inc.*, 838 F.3d 1266, 1271 (Fed. Cir. 2016) (“*Affinity Labs II*”) (“[N]either the claim nor the specification reveals any concrete way of employing a customized user interface.”). Still, it is not enough just to disclose the improvement in the specification; instead, the Court’s task becomes to “analyze the asserted claims and determine whether they *capture these improvements*.” *Berkheimer*, 881 F.3d at 1369 (emphasis added). In other words, “[t]o save a patent at step two, an inventive concept must be *evident in the claims*.” *RecogniCorp, LLC v. Nintendo Co., Ltd.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017) (emphasis added); *see also Alice*, 134 S. Ct. at 2357 (“[W]e must examine the *elements of the claim* to determine whether it contains an ‘inventive concept.’”) (emphasis added); *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1149 (Fed. Cir. 2016) (“The § 101 inquiry must focus on the language of the Asserted Claims themselves.”).

At both steps one and two, it is often useful for the Court to compare the claims at issue

with claims that have been considered in the now considerably large body of decisions applying § 101. *See Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016).

Finally, as a procedural matter, the Federal Circuit has observed frequently that § 101 disputes may be amenable to resolution on motions for judgment on the pleadings, motions to dismiss, or summary judgment. *See, e.g., Berkheimer*, 881 F.3d at 1368 (“Whether a claim recites patent eligible subject matter is a question of law which may contain disputes over underlying facts. Patent eligibility has in many cases been ***resolved on motions to dismiss or summary judgment. Nothing in this decision should be viewed as casting doubt on the propriety of those cases.*** When there is no genuine issue of material fact regarding whether the claim element or claimed combination is well-understood, routine, conventional to a skilled artisan in the relevant field, this issue can be decided on summary judgment as a matter of law.”) (emphasis added); *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1351-52 (Fed. Cir. 2014) (affirming grant of Rule 12(c) motion for judgment on pleadings for lack of patentable subject matter); *Intellectual Ventures I LLC v. Symantec Corp.*, 2018 WL 1324863, at *1 n.1 (Fed. Cir. Mar. 15, 2018) (affirming grant of summary judgment of patent ineligibility and stating *Berkheimer* “does not compel a different conclusion”).

III. DISCUSSION

LinkedIn contends that the claims of the ’760 patent are ineligible under § 101 because they are directed to the abstract idea of facilitating cross-marketing relationships and fail to add any inventive concept, even when considered as an ordered combination. (*See* D.I. 13 at 5; *see also* Tr. at 15-16) DiStefano responds that the patent recites non-abstract, particularized methods of web design and hosting that improve “an already computerized field of web page

development,” making web development “easier for everyone,” including those with and without technical knowledge. (Tr. at 26-28) DiStefano further contends that the ordered combination of the claim elements recites an inventive concept. (See D.I. 16 at 1, 7, 13-14) The Court addresses each argument in turn.

A. Step One

At step one of the *Alice/Mayo* test, the question is whether the asserted claims are directed to a patent-ineligible concept. “[A]ll inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Mayo*, 132 S. Ct. at 1293. Thus, “an invention is not rendered ineligible for patent simply because it involves” a patent-ineligible concept. *Alice*, 134 S. Ct. at 2354. “Indeed, to preclude the patenting of an invention simply because it touches on something natural would ‘eviscerate patent law.’” *Rapid Litig. Mgmt. Ltd. v. CellzDirect, Inc.*, 827 F.3d 1042, 1050 (Fed Cir. 2016) (quoting *Mayo*, 132 S. Ct. at 1293). “At step one, therefore, it is not enough to merely identify a patent-ineligible concept underlying the claim; we must determine whether that patent-ineligible concept is what the claim is ‘directed to.’” *Id.*

Here, the Court agrees with LinkedIn that the asserted claims of the ’760 patent are directed to the abstract idea of facilitating cross-marketing relationships. In broad terms, the method of claim 1 comprises two users on two computers opting into a reciprocal linking arrangement and then, through use of a computer database, establishing the reciprocal linking arrangements between the two users such that a link to the first page appears on the second and a link to the second page appears on the first. See ’760 pat. at cl. 1. As LinkedIn explains, this method “is not essentially different from reciprocal marketing relationships formed between two

brick and mortar stores selling complementary products.” (D.I. 13 at 6) Rather than improving any technical problem in the prior art, the patent “relate[s] to . . . marketing problems or dealing with the hassle of matchmaking.” (Tr. at 12; *see also* ’760 Pat. at 4:20-25 (“The present invention further relates to an internet-based system for assisting a website designer . . . in order to market the first website at the second website.”); Tr. at 18 (“[I]t may be difficult for novice web designers to arrange those relationships; but those aren’t technical problems, those are marketing problems.”); *id.* at 19 (“[A]voiding the hassle of having to interact with the web designer also is not a technical problem.”))

DiStefano contends that LinkedIn oversimplifies the invention because the claims teach “transport[ing] the user instantly to the linked website,” an invention not (at least yet) realistic in the real-world because the third-party agent would have to “port the physical storefronts . . . *into* its own establishment.” (D.I. 16 at 8-9) But simply because the invention has no direct physical corollary does not render the claims patent-eligible, as DiStefano acknowledges. (Tr. at 30-31)³

In *Alice*, the Supreme Court found claims directed to a method of “facilitat[ing] the exchange of financial obligations between two parties by using a computer system as a third-party intermediary” unpatentable. *Alice*, 134 S. Ct. at 2352; *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (finding patent claims directed to contractual relationship for “a fundamental economic practice long prevalent in our system of commerce”). The claims at issue here similarly recite a method of facilitating relationships between two parties through a computer system intermediary. This common marketing tactic does not become patent-eligible simply

³Moreover, there *is* a corollary to the ’760 patent in the physical world: seeing an advertisement at one storefront for a second storefront and then visiting the second storefront via any mode of transportation (albeit not instantly).

through computer implementation. *See Alice*, 134 S. Ct. at 2357 (“[M]erely requiring generic computer implementation fails to transform that abstract idea into a patent-eligible invention.”); *see also buySAFE*, 765 F.3d at 1355 (“The claims are squarely about creating a contractual relationship [and their] invocation of computers adds no inventive concept.”); *VideoShare, LLC v. Google, Inc.*, 2016 WL 4137524, at *6 (D. Del. Aug. 2, 2016), *aff’d*, 695 F. App’x 577 (Fed. Cir. 2017) (“[C]laims overcom[ing] the burden of manually posting a link associated with a video to a web page by automating this process [are directed to an abstract idea because they] are not directed to an improvement in computer functionality, and the physical components of the claim merely provide a generic environment for carrying out the abstract idea.”).

Accordingly, the Court finds the asserted patent claims abstract under *Alice* step one.⁴

B. Step Two

At step two, the Court looks at “the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355; *see also Mayo*, 566 U.S. at 73 (explaining that steps of claim must amount to more than “well-understood, routine, conventional activity”). “To save a patent at step two, an inventive concept must be *evident in*

⁴LinkedIn submitted a notice of subsequent authority on September 14, pursuant to D. Del. LR 7.2(b), directing the Court to a recent “Final Rejection of certain claims in United States Patent Application No. 13/946,461,” which claims priority to the same patent application and inventor as the ’760 patent and shares many similarities. (D.I. 26) This is relevant, LinkedIn argues, because claims in this recent application were rejected under 35 U.S.C. § 101. (*Id.*) In response, DiStefano argues that “[t]he cited examiner arguments can be overcome by subsequent arguments or amendments submitted by the applicant, and are not the type of authority properly submitted pursuant to Local Rule 7.1.2(b).” (D.I. 27 at 1-2) The subsequent authority has played no part in the Court’s conclusion that the asserted claims of the ’760 patent are ineligible under Section 101.

the claims.” *RecogniCorp*, 855 F.3d at 1327 (emphasis added); *Alice*, 134 S.Ct. at 2357 (“[W]e must examine the *elements of the claim* to determine whether it contains an ‘inventive concept.’”) (emphasis added).

Claim 1 is directed to the method of facilitating cross-linking relationships by establishing reciprocal arrangements. Not only does the specification acknowledge that using reciprocal links on web pages was “very common” in the prior art, *see* ’760 Pat. at 2:43-49; *see also id.* at 5:52-54 (“[T]he preferred system . . . includes a server computer . . . operably connected to the internet . . . using standard techniques well-known in the art.”), but, more importantly, the claims are silent as to any manner in which the improvement actually functions and instead, only claim the desired result. *See* ’760 Pat. at cl. 1 (claiming method steps of “receiving . . . a first [or second] indication to opt into a reciprocal linking arrangement,” “establishing, within a database . . . the reciprocal linking arrangement” based on the users opting in, and “including . . . a first [or second] functional identification element” within each web page). Nowhere do the claims (or specification) explain how opt-ins are received, how the database works or what type of database is actually used, or how links and identification elements are created or added to the web pages.

Similarly, while the specification recognizes that creating such links in the prior art was “not always easy” and could be difficult without contractual arrangements, *see id.* at 3:49-54, the claims do not explain how the claimed system makes the creation of links any easier. Instead, the claims broadly direct that users opt into using the system and then the system establishes the linking arrangement. These conventional steps of opting into a reciprocal linking arrangement, establishing the reciprocal linking arrangement in a computer database, and including links on the reciprocal web pages, considered alone or as an ordered combination, fail to render the claims

patent-eligible. *See buySAFE*, 765 F.3d at 1355 (finding claims directed to “familiar commercial arrangements by use of computers and networks” ineligible for patenting).

DiStefano contends a factual dispute exists regarding whether the ordered combination of steps is routine and conventional, but given its multiple concessions during oral argument – including that the method involves all conventional elements present in the prior art and that the claimed method is simply an automation of already-established steps – and its failure to identify any reason to find the ordered combination non-routine, the Court sees no reason to conclude that the method steps, considered alone or in combination, are anything but routine and conventional. (*See* Tr. at 40 (“The patent concedes that all of the individual components, at least those that are at issue here, are conventional components. There is no doubt about that. We don’t contest it.”); *id.* at 47 (“‘[C]reating reciprocal links on web pages’ was well known in the prior art.”); *id.* at 48 (“[P]rior art processes accomplish the same result.”))⁵

Finally, DiStefano contends factual allegations in the First Amended Complaint support the finding of an inventive concept. (*See* Tr. at 36-37; D.I. 16 at 10-11) The First Amended Complaint alleges that the claims of the ’760 patent “resolve technical problems related to a streamlined process for developing web pages and posting those web pages on the internet.” (D.I. 11 at 3) As addressed earlier, however, the asserted claims do not describe with any detail how to create web pages or create links on a web page, or provide any details surrounding the database associated with the computer hardware system. The remaining relevant allegations in the First Amended Complaint broadly assert that the claims “recite one or more inventive

⁵During oral argument, DiStefano conceded that no claim construction disputes preclude the Court’s ruling on LinkedIn’s motion. (*See* Tr. at 49-50) (“[T]he real heart of the issue here is not one of claim construction.”)

concepts” and “recite an invention that is not merely routine or conventional [and] does not preempt all ways of . . . establish[ing] reciprocal linking arrangements between web pages.” (*Id.*) Each of these allegations, however, merely recites a boilerplate legal conclusion without any supporting facts in the remaining sections of the complaint, in the specification, or in the claims.⁶

IV. CONCLUSION

For the reasons stated above, the Court will grant LinkedIn’s motion to dismiss. An order follows.

⁶While DiStefano faults LinkedIn for failing to separately address preemption (*see* D.I. 16 at 11), Federal Circuit precedent explains that “where a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Alice* framework, as they are in this case, preemption concerns are fully addressed and made moot.” *Two-Way Media Ltd. v. Comcast Cable Commc’ns, LLC*, 879 F.3d 1329, 1339 (Fed. Cir. 2017).

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LINKEDIN CORPORATION,
Petitioner,

v.

DISTEFANO PATENT TRUST III, LLC,
Patent Owner.

Case IPR2019-00419
Patent 8,768,760 B1

Before GEORGE R. HOSKINS, SCOTT B. HOWARD, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

HOSKINS, *Administrative Patent Judge*.

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

I. INTRODUCTION

LinkedIn Corporation (“Petitioner”) has filed a Petition (Paper 2, “Pet.”) pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 1–20 of U.S. Patent No. 8,768,760 B1 (“the ’760 patent”). DiStefano Patent Trust III, LLC (“Patent Owner”) has filed a Preliminary Response (Paper 6, “Prelim. Resp.”).

Institution of review requires demonstration of a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim. 35 U.S.C. § 314(a). Applying that standard on behalf of the Director (37 C.F.R. § 42.4(a)), we do not institute the petitioned review. The Petition presents one ground of unpatentability, which relies on DiStefano ’259 (Ex. 1003, U.S. Patent No. 7,996,259 B1, iss. Aug. 9, 2011) as prior art. Pet. 2. The Petition acknowledges the ’760 patent asserts priority to the filing date of DiStefano ’259 via a series of continuation applications. *Id.* at 3–4. The Petition asserts DiStefano ’259 is nonetheless prior art to the ’760 patent, because one of the intervening continuation applications lacks written description support for the independent claims of the ’760 patent. *Id.* at 12, 16, 20, 30.

We determine the Petition fails to demonstrate that the intervening continuation application lacks written description support for the independent claims of the ’760 patent. Therefore, the Petition fails to establish DiStefano ’259 is prior art to the ’760 patent. We do not reach the other issues raised in the Petition and the Preliminary Response.

II. BACKGROUND

A. *Real Parties in Interest and Related Proceedings*

Petitioner identifies itself as the real party-in-interest. Pet. ix. Patent Owner identifies itself as the real party-in-interest. Paper 4, 2.

The parties identify one U.S. District Court litigation as related to this proceeding: *DiStefano Patent Trust III, LLC v. LinkedIn Corporation*, Civil Action No. 1:17-cv-01798 (D. Del.). Pet. ix; Paper 4, 2. In that case, the District Court granted Petitioner's motion to dismiss Patent Owner's Complaint, on the basis that claims 1, 4, 5, 8, and 10 of the '760 patent fail to claim patent-eligible subject matter under 35 U.S.C. § 101. Ex. 1014, pg. 2.¹ That decision is currently on appeal to the Federal Circuit. Pet. ix; Prelim. Resp. 1.

B. *The '760 Patent*

The '760 patent concerns methods for “creating and posting web pages to the internet,” including “a method for more easily developing web pages through the use of a graphical user interface.” Ex. 1001, 1:20–26. Figure 1 of the '760 patent is reproduced below:

¹ When citing “pg.” numbers of Petitioner's Exhibits, this Decision refers to the pagination added to the bottom of each page by Petitioner.

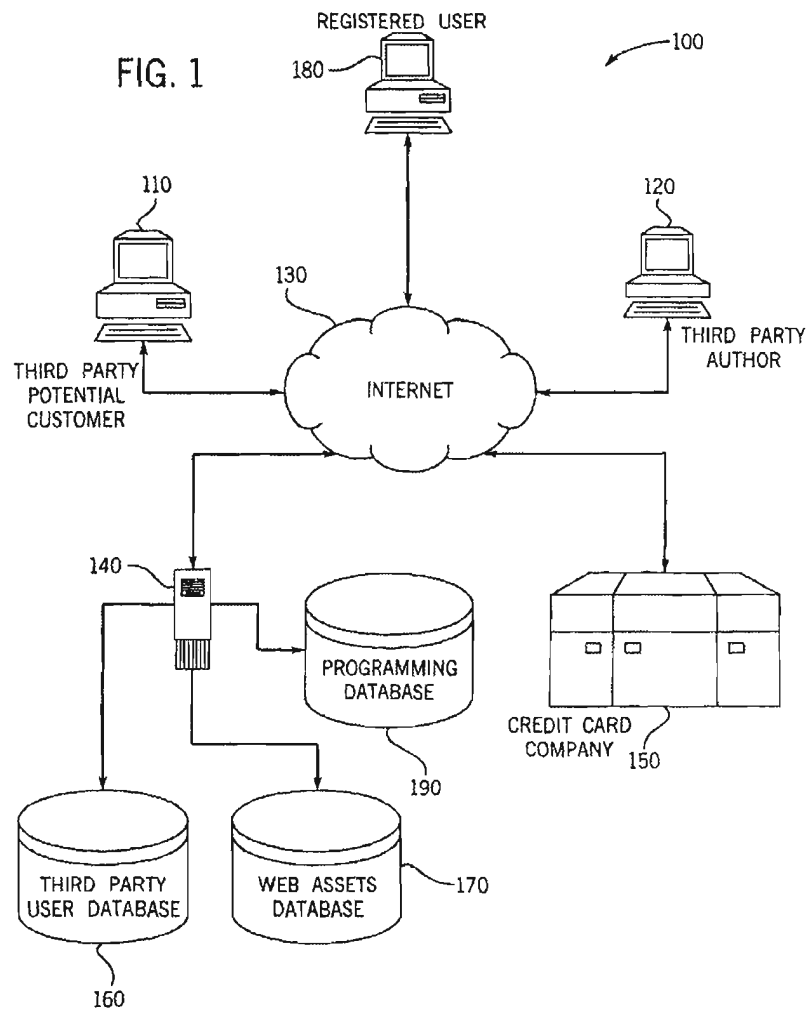


Figure 1 illustrates system 100 for developing a website. *Id.* at 4:43–44, 5:48–52. A user desiring to create a website accessible via the internet 130 uses computer 180 to register with and use server computer 140 for that purpose. *Id.* at 5:61–65, 6:58–64. In particular, server 140 presents a graphical user interface (“GUI”) on computer 180, such as the interface shown in Figure 2, “to allow a registered user to easily develop a website comprising one or more web pages.” *Id.* at 6:44–46, 6:64–67.

An excerpt from Figure 12 of the ’760 patent, reproduced below, illustrates one aspect of the GUI presented on the registered user’s computer 180:

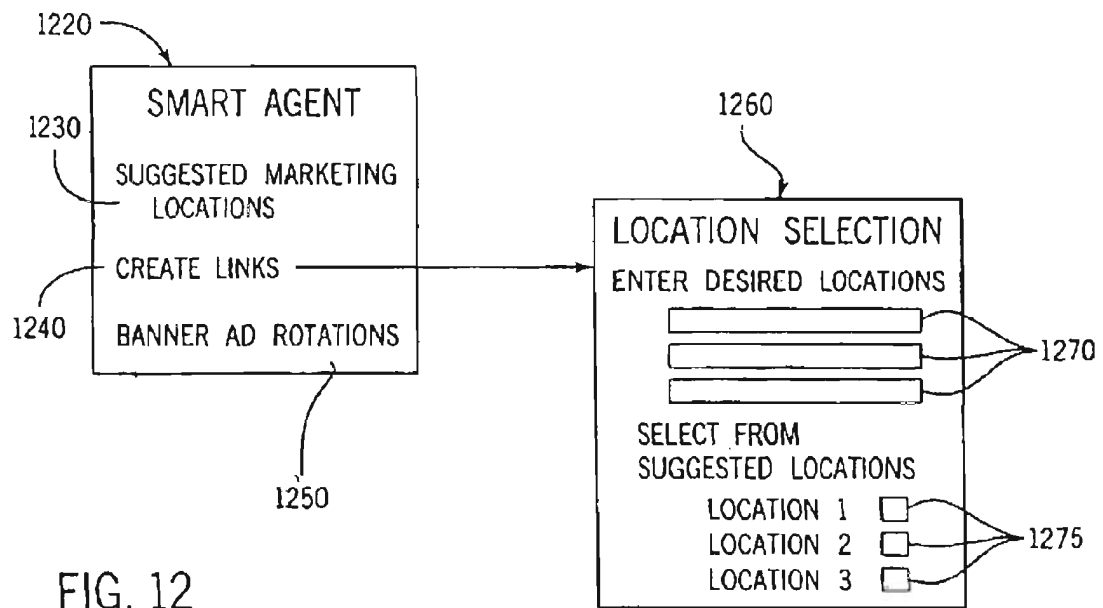


FIG. 12

Figure 12 illustrates how a registered user may access smart agent menu 1220, and select create links option 1240 to access “location selection menu 1260, in which the registered user can identify addresses for *websites to which the registered user desires its website to be linked.*” *Id.* at 14:61–65, 15:24–28 (emphasis added). This can be accomplished by the registered user entering the website addresses into open fields 1270, or by the registered user checking selection boxes 1275 corresponding to website addresses that server 140 suggests may be beneficial for linking. *Id.* at 15:28–41; *see also id.* at 14:66–15:23 (describing how server 140 generates selections 1275).

Server 140 creates links to the registered user’s website at the websites of other registered users identified by the registered user using location selection menu 1260. *Id.* at 15:41–45, 16:4–18. Thus, “the registered user causes its website to participate in linking . . . display functions with other websites that also were created using the system 100 by registered users who opted to participate in these linking . . . display

functions.” *Id.* at 16:5–10. Further, “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.” *Id.* at 16:15–18. In this way, system 100 “provide[s] special marketing benefits to registered users of the system 100 vis-à-vis one another.” *Id.* at 14:53–55.

C. *The Challenged Claims*

The ’760 patent contains twenty claims. Ex. 1001, 28:3–30:24. They include two independent claims 1 and 11. *Id.* Claim 1 recites, with lettering [A1]–[C4] being added for further reference in the discussion below:

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:
 - [A1] receiving, from a first computer associated with the first user, a first indication to opt into a reciprocal linking arrangement;
 - [A2] receiving, from a second computer associated with the second user, a second indication to opt into the reciprocal linking arrangement;
 - [B] 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;
 - [C1] including, within the second web page and based upon the reciprocal linking arrangement, a second functional identification element associated with the first user; and
 - [C2] including, within the first web page and based upon the reciprocal linking arrangement, a first functional identification element associated with the second user, wherein

[C3] the second functional identification element includes a link to the first web page, and

[C4] the first functional identification element includes a link to the second web page.

Id. at 28:4–29; *see also id.* at pg. 47 (Certificate of Correction). Claim 11 recites a server system comprising a database and a computer hardware system, in which the hardware system is configured to perform the same steps [A1]–[C4] recited in claim 1. *Id.* at 28:58–29:20, pg. 47.

We refer to limitations [A1]–[A2] as the “Opt In Limitations.” We refer to limitation [B] as “the Database Limitation.” We refer to limitations [C1]–[C4] as the “Reciprocal Linking Limitations.”

D. Asserted Ground of Unpatentability

Petitioner asserts claims 1–20 of the ’760 patent are unpatentable under 35 U.S.C. § 103 as having been obvious over DiStefano ’259. Pet. 2.

III. ANALYSIS

A. Claim Construction

We interpret the claims of the ’760 patent “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” *See* Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340, 51,358 (Oct. 11, 2018) (to be codified at 37 C.F.R. § 42.100(b)).

1. The Opt In Limitations

The Opt In Limitations of claims 1 and 11 recite receiving “a first indication to opt into a reciprocal linking arrangement” from a first user, and receiving “a second indication to opt into the reciprocal linking arrangement” from a second user. Ex. 1001, 28:8–13 (claim 1), 28:65–29:3 (claim 11).

Petitioner contends the Opt In Limitations require that the two users opt into a “single, common,” and “bi-directional,” reciprocal linking arrangement. Pet. 13–14. In support, Petitioner contends the term “*the* reciprocal linking arrangement” in the second indication limitation refers back to the reciprocal linking arrangement previously recited in the first indication limitation. *Id.* at 14.

Patent Owner responds that the term “bi-directional” is not found in the claims or in the ’760 patent specification, and Petitioner has not explained the significance of interpreting the claims to require a single, common, bi-directional linking arrangement. Prelim. Resp. 8–9, 13. Nonetheless, Patent Owner indicates Petitioner “is correct in asserting that both the claimed ‘first indication’ and the ‘second indication’ *refer to the same* ‘reciprocal linking arrangement.’” *Id.* at 9–10 (emphasis added) (citing Ex. 1001, 15:24–36, 16:4–10, 24:46–55 (Fig. 20A)).

We concur with the overlap between Petitioner’s and Patent Owner’s claim constructions, namely, that the Opt In Limitations require the first and second user to opt into the same reciprocal linking arrangement. We also agree with Patent Owner that Petitioner’s gloss on that claim construction as representing a single, common, and bi-directional arrangement, does not help to elucidate the meaning of the claim language, and is unsupported by

citations to the '760 patent specification. *See* Pet. 13–14; Ex. 1009 ¶ 45. Thus, we construe the Opt In Limitations to require that the first and second users opt into the same reciprocal linking arrangement. No further construction is necessary for purposes of the present Decision.

2. *The Database Limitation*

The Database Limitation of claims 1 and 11 recites “establishing, within a database associated with the computer hardware system, the reciprocal linking arrangement.” Ex. 1001, 28:14–17 (claim 1); *id.* at 28:58–64 & 29:4–7 (claim 11).

Petitioner describes this limitation as the “Reciprocal Linking Arrangement Database” limitation, and contends it “means that the claimed database includes, that is, stores, the previously identified ‘reciprocal linking arrangement.’” Pet. 14–15 (emphasis omitted). Petitioner concludes the Database Limitation “should be construed as requiring establishing the ‘reciprocal linking arrangement’ within the database.” *Id.* at 15.

Patent Owner responds that “the claim language does not require a specific type of database,” but instead “requires a database that is configured to having stored therein information that establishes the reciprocal linking arrangement.” Prelim. Resp. 11–12. In Patent Owner’s view, “the claims do not necessarily require that the ‘reciprocal linking arrangement’ itself be stored,” but rather “only require[] that information (i.e., in the form of a data structure) that establishes the reciprocal linking arrangement be stored within the database.” *Id.* at 12 (citing Ex. 1001, 24:50–55).

Based upon our review of the foregoing, it appears that the principal claim terms in dispute are “establishing” and “arrangement.” Specifically,

what does it mean to require *establishing* a reciprocal linking *arrangement* within a database? Petitioner contends the claims require storing the arrangement within the database. Patent Owner contends the claims are not limited to storing the arrangement *per se*, and instead are open to storing information that establishes the arrangement.

We agree with Patent Owner. We do not discern any support in the claim language for Petitioner’s assertion that establishing a linking arrangement within a database requires storing an identification of that arrangement, *per se*. Petitioner, further, does not cite to any disclosures in the ’760 patent specification which might support its proposed construction. *See* Pet. 14–15; Ex. 1009 ¶ 46. Patent Owner, by contrast, cites the ’760 patent specification’s disclosure that “*the marketing location selection information is stored at third party user database 160,*” and “[t]his stored information is later *used to generate links at the selected marketing locations (i.e., websites).*” Ex. 1001, 24:50–55 (emphases added). This disclosure supports Patent Owner’s assertion that establishing a reciprocal linking arrangement within a database occurs, as claimed, when information is stored within the database that is sufficient to generate links within first and second web pages to effectuate the reciprocal linking arrangement.

3. *The Reciprocal Linking Limitations*

The Reciprocal Linking Limitations of claims 1 and 11 recite “including, within the second web page and based upon the reciprocal linking arrangement, a second functional identification element associated with the first user,” “wherein the second functional identification element includes a link to the first web page.” Ex. 1001, 28:18–29 (claim 1), 29:8–

19 (claim 11), pg. 47. The Reciprocal Linking Limitations similarly recite that the first web page includes a first functional identification element comprising a link to the second web page, based upon the reciprocal linking arrangement. *Id.*

Petitioner contends the Reciprocal Linking Limitations “explicitly require[] two web pages, each associated with a separate user, wherein each of the two web pages includes a hyperlink to the other web page.” Pet. 15. Petitioner then reiterates 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.” *Id.*

Patent Owner responds that Petitioner’s proposed construction “accurately characterizes a portion of the claim language,” but it “omits that the links are included within the web pages *based upon the reciprocal linking arrangement.*” Prelim. Resp. 13–14 (emphases in original). Patent Owner contends “the concept of *two web pages, each linking to the other*, can be described as ‘reciprocal links.’” *Id.* at 14 (emphasis added) (citing Ex. 1001, 15:41–45, 24:53–62); *see also id.* at 28–29 (discussing dictionary definitions of the term “reciprocal”).

We concur with the overlap between Petitioner’s and Patent Owner’s claim constructions, namely, that the Reciprocal Linking Limitations require that the first and second web pages each include a link to the other of the first and second web pages. In this way, these respective links effectuate the “reciprocal linking arrangement” specified in the claims.

Petitioner additionally proposes that the two web pages are “each associated with a separate user.” Pet. 15. However, Petitioner does not rely on this proposed claim requirement as a basis to conclude that the parent

application(s) to the '760 patent lack written description support for the Reciprocal Linking Limitations. *Id.* at 28–29. Therefore, we need not reach this particular claim construction issue in the present Decision. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (per curiam) (claim terms need to be construed “only to the extent necessary to resolve the controversy” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

Thus, we construe the Reciprocal Linking Limitations to require that the first and second web pages each include a link to the other of the first and second web pages.

4. *Remaining Claim Terms*

No further explicit construction of any claim term is provided by the parties, and we determine no further explicit constructions are needed to resolve the issues presented by the arguments and evidence of record. *See Nidec*, 868 F.3d at 1017.

B. *Priority Date of the '760 Patent*

The parties dispute whether the '760 patent is entitled to priority to the filing date of DiStefano '259, via a chain of intervening continuation applications. Pet. 16–29; Prelim. Resp. 5–15, 20–37. In addressing this dispute, we first identify the chain of parent continuation applications at issue, then we provide an overview of the dispute, next we summarize the applicable law, then we consider the level of ordinary skill in the art, and finally we address the subject matter of the '760 patent claims at issue.

1. *Parent Continuation Applications to the '760 Patent*

The '760 patent issued from U.S. Patent Application No. 14/191,746, filed on February 27, 2014 (“the 2014 Application”). Ex. 1001, at [21]–[22]. The 2014 Application was a continuation of U.S. Patent Application No. 13/763,128, filed on February 8, 2013 (“the 2013 Application”). *Id.* at [63]. The 2013 Application was a continuation of U.S. Patent Application No. 13/669,027, filed on November 5, 2012 (“the 2012 Application”). *Id.* The 2012 Application was a continuation of U.S. Patent Application No. 13/206,483, filed on August 9, 2011 (“the 2011 Application”). *Id.* The 2011 Application was a continuation of U.S. Patent Application No. 09/589,551, filed on June 7, 2000 (“the 2000 Application”). *Id.* The 2000 Application issued as DiStefano '259. *Id.*; Ex. 1003, at [10], [21].

2. *Overview of the Priority Dispute*

The Petition is premised upon the assertion that the 2011 Application fails to provide written description support for the '760 patent claims. *See* Pet. 12, 16–17, 20–29, 30. If that assertion is accurate, then the continuity chain linking the '760 patent back to the filing date of the 2000 Application is broken at the 2012 Application, which was never co-pending the 2000 Application. *See id.* at 16, 20, 30. In that circumstance, the '760 patent is entitled to, at the earliest,² the 2012 Application's filing date

² Petitioner suggests the actual priority date is later: February 27, 2014, which is the actual filing date of the 2014 Application. *See* Pet. 16 & n.2, 17 n.4, 21 & n.6. However, that contention is not supported by citation to, or any meaningful discussion of, the disclosures of the parent applications intervening between the 2011 Application and the 2014 Application. *See id.* Thus, we focus our attention on the 2011 Application disclosure, and do not address the 2012 or 2013 Application disclosures.

of November 5, 2012 (Ex. 1001, at [63]), which is more than one year after the issuance of DiStefano '259 on August 9, 2011 (Ex. 1003, at [45]). *See* Pet. 16, 20, 30. Therefore, in that circumstance, DiStefano '259 is prior art to the '760 patent. *See id.*

Patent Owner misconstrues the Petition as relying on a lack of written description support in the 2000 Application, which issued as DiStefano '259, rather than the 2011 Application. *See, e.g.,* Prelim. Resp. 25 (“LinkedIn’s argument is that the specification of the '259 Patent does not provide written descriptive support”); *id.* at 22 n.15 (“LinkedIn has not separately asserted that the other applications in the chain of priority fail to satisfy the written description requirement.”). As a result, Patent Owner generally cites to the disclosures of the '760 patent and DiStefano '259 when opposing Petitioner’s written description arguments. *See, e.g., id.* at 5–6, 20, 25. For clarity and consistency, in this Decision, we re-cast the '760 patent and DiStefano '259 citations in the Preliminary Response to refer, instead, to the corresponding disclosures of the 2011 Application.

Petitioner contends the 2011 Application fails to provide written description support for each of the Opt In Limitations, the Database Limitation, and the Reciprocal Linking Limitations. *See* Pet. 20–29. Patent Owner disputes each contention. *See* Prelim. Resp. 5–15, 26–37.

3. *Pertinent Legal Standards for Establishing Priority*

Pursuant to 35 U.S.C. § 120, the '760 patent is entitled to assert priority to the filing date of the 2011 Application only if the 2011 Application discloses the invention claimed in the '760 patent in the

manner provided by 35 U.S.C. § 112(a).³ The test for sufficiency of a written description under 35 U.S.C. § 112(a) is whether the earlier application's disclosure "reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date." *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). The written description "test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art." *Id.*

4. *Level of Ordinary Skill in the Art*

Neither the Petition nor the Preliminary Response addresses the level of ordinary skill in the art pertaining to the '760 patent. However, Petitioner's declarant, Dr. Loren G. Terveen, does address this issue. *See* Ex. 1009 ¶¶ 33–35. We have applied Dr. Terveen's understanding of the level of ordinary skill in the art in reaching the present Decision.

5. *The Opt In Limitations*

The Opt In Limitations of claims 1 and 11 recite receiving "a first indication to opt into a reciprocal linking arrangement" from a first user, and

³ We cite to the post-AIA version of § 112, because the 2014 Application (which issued as the '760 patent) was filed on February 27, 2014, after the AIA amendments to § 112 took effect on September 16, 2012. *See* Leahy-Smith America Invents Act ("the AIA"), Pub. L. No. 112-29, § 4(e), 125 Stat. 284, 297 (2011) (amendments to § 112 "shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and *shall apply to any patent application that is filed on or after that effective date*") (emphasis added). However, our Decision is not affected by the changes to § 112 enacted via the AIA; we would reach the same result applying either the pre-AIA version or the post-AIA version.

receiving “a second indication to opt into the reciprocal linking arrangement” from a second user. Ex. 1001, 28:8–13, 28:65–29:3. We have construed these limitations to require that the first and second users opt into the same reciprocal linking arrangement. *See supra* Section III.A.1. Petitioner focuses on two phrases in the Opt In Limitations: “indication to opt into” and “reciprocal linking arrangement.” Pet. 21.

Regarding the “indication to opt into” phrase, Petitioner argues “the only disclosure of a user ‘opt[ing] into’ anything” in the 2011 Application “falls short of disclosing the claimed subject matter,” because “[i]t does not describe how a first user is supposed to ‘***opt into***’ a reciprocal linking arrangement with a particular second user.” *Id.* at 22–24 (emphases in original) (citing Ex. 1005, pg. 69 (lines 5–21)); Ex. 1009 ¶¶ 53–54. Petitioner asserts the 2011 Application, instead, “merely recites that users may ‘***opt[] to participate***’ in the linking . . . display functions.” Pet. 24 (emphasis in original). This is insufficient, in Petitioner’s view, because it does not “describe how a user ‘***opts into***’ a particular arrangement with another user,” or “how the system ‘***receive[s] an indication***’ from a first or, more importantly, a second user ‘***to opt into***’ that particular arrangement.” *Id.*

Regarding the “reciprocal linking arrangement” phrase, Petitioner argues: “Although the 2011 Application refers to a ‘***reciprocal link site***,’ the description thereof is in a significantly different context than the . . . ‘***reciprocal linking arrangement***’” recited in the ’760 patent claims. Pet. 22 (citing Ex. 1005, pg. 26 (Fig. 20), pg. 86 (lines 12–24)); Ex. 1009 ¶¶ 52, 54. Petitioner’s view is that the “reciprocal link site” of the 2011 Application “indicate[s] a location on one website where other websites will be

marketed,” whereas the reciprocal linking arrangement of the ’760 patent claims concerns “the existence of, or establishing, a two-way linking relationship between two such sites.” *Id.*

Patent Owner contends the 2011 Application demonstrates possession of the Opt In Limitations by describing how registered users may select create links options 1240 to access location selection menu 1260. Prelim. Resp. 9–10, 31, 33–35 (citing Ex. 1005, pg. 26 (Fig. 20, steps 2018–2022), pgs. 67 (line 20) – 68 (line 10), pg. 69 (lines 5–21), pg. 86 (lines 12–19)). Patent Owner asserts location selection menu 1260 allows a registered user to create links within the websites of other registered users, wherein such links lead to the registered user’s own website. *Id.* Further according to Patent Owner, “the other registered users can also identify websites to which these other registered users would like [their websites] to be linked.” *Id.* at 10, 31 (citing Ex. 1005, pg. 69 (lines 5–9)). Patent Owner’s view is that “[t]he identification of a particular website, by a registered user, is an example of an indication to opt into a reciprocal linking arrangement” with the other registered user of the other website, as claimed. *Id.* at 10–11, 31, 34–35.

We agree with Patent Owner that the 2011 Application demonstrates possession of receiving a first indication to opt into a reciprocal linking arrangement from a first user, and receiving a second indication to opt into the same reciprocal linking arrangement from a second user. An excerpt from Figure 12 of the 2011 Application, which is identical to Figure 12 of the ’760 patent, is reproduced below:

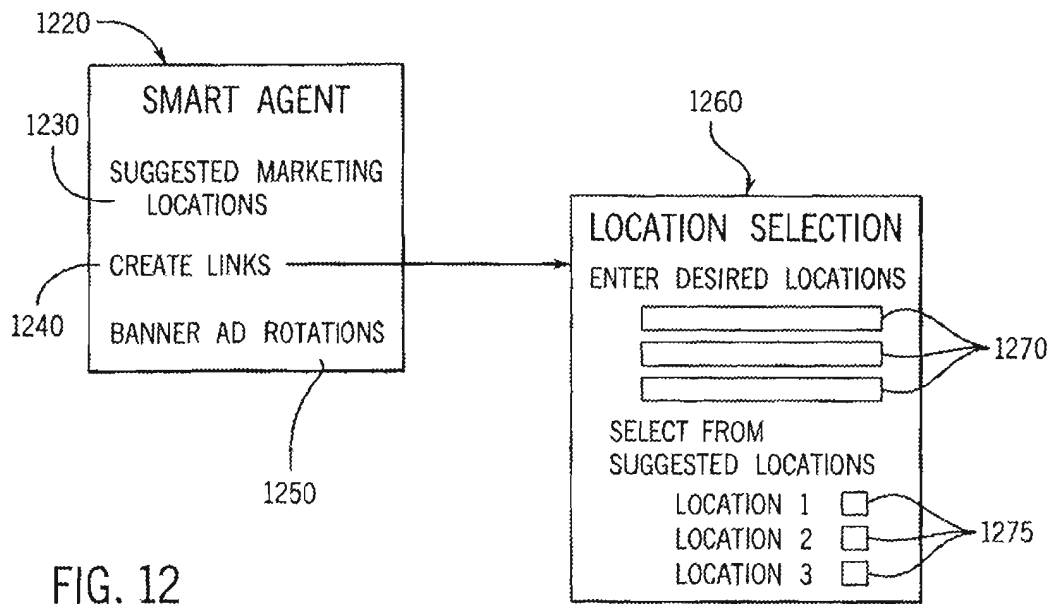


FIG. 12

Ex. 1005, pg. 18. Figure 12 illustrates how a registered user may access smart agent menu 1220, and select create links option 1240 to access location selection menu 1260. *Id.* at pg. 66 (lines 21–26), pg. 67 (lines 20–21). In the following discussion of the 2011 Application disclosure concerning this process, we will refer to a “new” user and to “preexisting” users.

The “new” user is the registered user who is selecting, for the first time, create links option 1240 to access location selection menu 1260, in order to “identify addresses for websites to which the [new] registered user desires its website to be linked.” *Id.* at pg. 67 (lines 20–23). The “preexisting” users are the registered users who have, previously to the new user, completed the process of location selection menu 1260. *See id.* at pg. 67 (lines 23–25) (“the websites can be selected from among the websites that have been created by *other registered users* using system 100” (emphasis added)). In this way, each “new” registered user becomes a “preexisting” registered user once the new registered user completes the

process of location selection menu 1260. Pursuant to that process, the new user selects the websites of preexisting users which the new user would like to contain links to the new user's website in order to market the new user's website, and system 100 creates those links. *Id.* at pgs. 67 (line 1) – 68 (line 10).

The 2011 Application expressly describes the process of location selection menu 1260 as the new user *causing* the new user's website to participate in linking functions with the websites of preexisting users who *opted to participate* in the linking functions. *Id.* at pg. 69 (lines 5–9) (“By completing the[] steps relating to the create links option 1240 . . . , the [new] registered user *causes its website to participate in linking . . . functions* with other websites that also were created using the system 100 by [preexisting] registered users who *opted to participate in these linking . . . functions.*” (emphases added)). Further according to the 2011 Application, “each website that is developed by a [new] registered user who *opts to participate in the linking functions* can display unlimited links to other registered users' websites.” *Id.* at pg. 69 (lines 14–16) (emphasis added). From these disclosures, a person of ordinary skill in the art would understand that the 2011 Application demonstrates possession of each new user opting into participation in the linking functions with preexisting users, and demonstrating that option by completing the process of location selection menu 1260, just like the preexisting users did prior to the new user.

Further, we determine that the optional linking functions provided by system 100 of the 2011 Application correspond to “a reciprocal linking arrangement” as recited in the '760 patent claims. The 2011 Application describes the linking functions as a feature that “provide[s] special

marketing benefits to *registered users* of the system 100 *vis-à-vis one another*.”⁴ *Id.* at pg. 66 (lines 14–26) (emphases added). In particular, as each new user opts into the linking functions of system 100, the new user’s website is modified to include “a *reciprocal* link site . . . for displaying links to other websites.” *Id.* at pg. 86 (lines 12–24) (emphasis added). From these disclosures, and the other disclosures discussed above, a person of ordinary skill in the art would understand that the linking functions of system 100 in the 2011 Application represent a *quid pro quo* between the various users who opt into the linking functions. Each new user is granted the authority to modify the websites of preexisting users to include a link to the new user’s website, so long as the new user is willing to have its own website contain links to the websites of other registered users opting into the linking function. In this way, the linking functions described in the 2011 Application correspond to a reciprocal linking arrangement.

Petitioner’s declarant, Dr. Terveen, reaches a contrary conclusion. Dr. Terveen testifies that the 2011 Application merely discloses “a *general willingness* to participate in linking services with an unknown and undefined

⁴ Another aspect of the special marketing benefits is implemented by choosing banner ad rotations option 1250 in smart agent menu 1220. Ex. 1005, pg. 66 (lines 14–26), pgs. 68 (line 11) – 69 (line 4). Petitioner and Patent Owner both discuss this feature in their arguments. However, we conclude this feature is not particularly pertinent to the ’760 patent claims, because there is no indication that the banner ads include *links*, which are specifically required by the ’760 patent claims. *See id.* at pgs. 39 (line 24) – 40 (line 10) (differentiating between “banner ads” and “links”), pg. 52 (lines 20–25) (describing banner ads), pg. 59 (lines 8–22) (describing design of banner ads). We appreciate that a banner ad may include a link to the advertised website, but that is not necessarily so, and the 2011 Application does not suggest that its banner ads in fact include a link. *See id.*

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.” Ex. 1009 ¶¶ 52, 54 (emphasis in original). This testimony is not persuasive. It equates the claimed “reciprocal linking arrangement” to “a two-way linking relationship between two” websites. *Id.* However, the Opt In Limitations merely require that the first and second users opt into the same reciprocal linking arrangement. *See supra* Section III.A.1. That occurs in the 2011 Application each time a new user completes the process of location selection menu 1260, and thereby opts into participating in the reciprocal linking functions of system 100 with other such users.

For the foregoing reasons, we determine the 2011 Application demonstrates possession of receiving a first indication to opt into a reciprocal linking arrangement from a first user, and receiving a second indication to opt into the same reciprocal linking arrangement from a second user.

6. *The Database Limitation*

The Database Limitation of claims 1 and 11 recites “establishing, within a database associated with the computer hardware system, the reciprocal linking arrangement.” Ex. 1001, 28:14–17, 28:58–64, 29:4–7. We have construed this limitation to require storing information within the database that is sufficient to generate links within first and second web pages to effectuate the reciprocal linking arrangement. *See supra* Section III.A.2.

Petitioner contends the 2011 Application “does not disclose the claimed database for storing information regarding a particular ‘reciprocal

linking arrangement’ . . . into which two separate [users] have each opted.” Pet. 25–26 (discussing Ex. 1005, pg. 42 (lines 5–9), pg. 43 (lines 12–16)); Ex. 1009 ¶¶ 55–56. According to Petitioner, the 2011 Application’s third party user database 160 does not “contain[] information about particular ‘reciprocal linking arrangements’ that have been ‘opted into’ by two different users.” *Id.* at 26–27 (citing Ex. 1005, pg. 49 (lines 9–20), pg. 17 (Fig. 11, “LOGIN” menu 1150)); Ex. 1009 ¶¶ 56–58.

Patent Owner contends the 2011 Application “explain[s] 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].” Prelim. Resp. 12, 35–36 (paraphrasing Ex. 1005, pg. 86 (lines 15–19)). Patent Owner asserts “[t]he storage of this information is an example of establishing the reciprocal linking arrangement within a database.” *Id.* at 12, 36–37 (citing Ex. 1005, pgs. 67 (line 20) – 68 (line 10)).

We agree with Patent Owner that the 2011 Application demonstrates possession of storing information within third party database 160 that is sufficient to generate links within first and second web pages to effectuate the reciprocal linking arrangement. According to the 2011 Application, third party user database 160 stores “the marketing location selection information” entered by each new user opting into the linking functions provided by system 100 using location selection menu 1260. Ex. 1005, pg. 86 (lines 12–17). This marketing location selection information includes the website addresses of preexisting users that the new user desires to include a link to the new user’s website. *Id.* at pg. 86 (lines 12–17), pg. 67 (lines 20–25). After the new user has completed the process of location

selection menu 1260, server 140 uses the marketing location selection information “to *generate links at the selected marketing locations (i.e., websites)*” of the preexisting users. *Id.* at pg. 86 (lines 17–19) (emphasis added). From these disclosures, a person of ordinary skill in the art would understand that the marketing location selection information is sufficient to generate a link within each of the preexisting user’s websites leading to the new user’s website.

As discussed above, the process of location selection menu 1260 is completed by each new user who opts into the linking functions provided by system 100 of the 2011 Application. In this way, over time, the marketing location selection information stored within third party user database 160 is used to generate links within first and second web pages to effectuate the reciprocal linking arrangement.

Petitioner contends the District Court opinion (Exhibit 1014), holding that claim 1 of the ’760 patent fails to claim patent-eligible subject matter under 35 U.S.C. § 101, supports a contrary view. *See* Pet. 27 (citing Ex. 1014, pg. 13); Ex. 1014, pgs. 2, 13. We disagree. Patent eligibility under § 101 and written description under § 112 are different issues, requiring different analyses. The District Court’s analysis establishes, at the most, that the specification and claims of the ’760 patent describe and define the claimed invention only at a high level of abstraction, amounting to no more than well-understood, routine, and convention activity, without containing an inventive concept. Ex. 1014, pgs. 13–14. Even if that is true, the ’760 patent specification (or the equivalent parent 2011 Application disclosure) may still demonstrate possession of the claimed invention, as abstract or as broad as the claimed invention may be.

For the foregoing reasons, we determine the 2011 Application demonstrates possession of establishing the reciprocal linking arrangement within a database, namely, third party user database 160.

7. *The Reciprocal Linking Limitations*

The Reciprocal Linking Limitations of claims 1 and 11 require first and second web pages that each include a link to the other of the first and second web pages. *See supra* Section III.A.3.

Petitioner contends the 2011 Application fails to disclose “two web pages . . . wherein each page provides a hyperlink to the other.” Pet. 28; Ex. 1009 ¶ 59. According to Petitioner, the 2011 Application instead discloses only “a system that creates a web site of links . . . that essentially serve as one-directional links,” via “reciprocal link *sites*.” Pet. 28 (emphasis in original) (citing Ex. 1005, pg. 86 (lines 12–24)); Ex. 1009 ¶ 59. In Petitioner’s view, “nothing in the 2011 Application discloses actually requiring *links back to* the specific webpage hosting the reciprocal link site.” *Id.* at 28–29 (emphasis added) (citing Ex. 1005, pgs. 87 (line 23) – 88 (line 2)); Ex. 1009 ¶¶ 59–60.

Patent Owner contends the 2011 Application “disclose[s] 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.’” Prelim. Resp. 14 (emphasis in original) (paraphrasing Ex. 1005, pg. 86 (lines 20–24)). In Patent Owner’s view, this description of “a *reciprocal link* site . . . provide[s] support for the concept of two webpages, each linking to the other.” *Id.* at 14, 28–29.

Patent Owner also cites the 2011 Application's disclosure 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." *Id.* at 14 (paraphrasing Ex. 1005, pg. 68 (lines 7–10)), 31 (citing Ex. 1005, pgs. 67 (line 20) – 68 (line 10)). Patent Owner further relies on original claims 4 and 6 of the 2011 Application. *Id.* at 26–27.⁵ Based on these disclosures, Patent Owner concludes the 2011 Application "disclose[s] 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." *Id.* at 14, 31.

We agree with Patent Owner that the 2011 Application demonstrates possession of first and second web pages that each include a link to the other of the first and second web pages. In this regard: (A) the first web page corresponds to the "reciprocal link site" portion of the website of the new user, and (B) the second web page corresponds to the "reciprocal link site" portion of the website of a preexisting user selected by the new user using location selection menu 1260. *See* Ex. 1005, pg. 86 (lines 12–24) (each time a new user opts into the linking functions provided by system 100, the system creates "a reciprocal link site . . . in the [new] registered user's website, for displaying links to other websites"). We discuss each aspect (A) and (B) in turn.

Beginning with (B), a person of ordinary skill in the art would understand the 2011 Application indicates that the respective reciprocal link

⁵ In part, Patent Owner states: "Originally-filed claim 5 further clarifies that 'the ***element for marketing the first website is a link*** to the first website.'" Prelim. Resp. 27 (underlined emphasis added, otherwise emphasis in original). However, the quoted limitation appears in claim 6, not in claim 5. *See* Ex. 1005, pg. 96.

sites of each preexisting user includes a link to the new user's website. The 2011 Application correspondingly discloses that the new user's completion of the process of location selection menu 1260 provides server 140 with "sufficient information to create links to the [new] registered user's website *at other websites.*" Ex. 1005, pgs. 67 (line 20) – 68 (line 10) (emphasis added). The 2011 Application further indicates those other websites include "the selected websites of other [preexisting] registered users (i.e., the websites selected during the design of the new website [by the new user using location selection menu 1260])." *Id.* at pg. 69 (lines 5–13).

Next considering (A), a person of ordinary skill in the art would understand the 2011 Application indicates that the reciprocal link site of the new user includes links to each of the preexisting users' websites selected by the new user with location selection menu 1260. Possession of that subject matter is demonstrated, first, in the 2011 Application's description of the process of location selection menu 1260 as the new user "identify[ing] addresses for websites to which the registered user desires its website to be linked." Ex. 1005, pg. 67 (lines 20–23). The 2011 Application describes that process as "*caus[ing] [the new user's] website to participate in linking . . . functions with other websites.*" *Id.* at pg. 69 (lines 5–9) (emphasis added); *see also id.* at pg. 69 (lines 13–16) ("*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" (emphasis added)). A person of ordinary skill in the art would understand such participation of the new user's website is effectuated by populating the reciprocal link site of the new user's website with links to the preexisting

users' websites selected by the new user via location selection menu 1260.
See id. at pg. 86 (lines 12–24).

Possession is further demonstrated by the 2011 Application's description of the reciprocal nature of the linking functions provided by system 100, as providing special marketing opportunities to each registered user vis-à-vis other registered users. That is, the 2011 Application describes the linking functions implemented by create links option 1240 (which invokes location selection menu 1260) as “provid[ing] the registered user with . . . *marketing opportunities* with respect to[] other registered users,” including “*special marketing benefits to registered users of the system 100 vis-à-vis one another.*” *Id.* at pg. 66 (lines 14–19), pg. 67 (lines 20–23). The 2011 Application further indicates that these special marketing benefits are implemented by creating, within the website of each user who opts into the marketing link functions, “a *reciprocal* link site . . . for displaying links to” the websites of other users who have also opted into the marketing link functions. *Id.* at pg. 86 (lines 12–24) (emphasis added). A person of ordinary skill in the art would understand that the foregoing reciprocal marketing opportunities, provided by system 100 to two registered users vis-à-vis one another, would involve the respective websites of *each* user linking to the website of the *other* user, based on one of the two users identifying the website of the other user via location selection menu 1260.

For the foregoing reasons, we determine the 2011 Application demonstrates possession of first and second web pages that each include a link to the other of the first and second web pages.

8. *Conclusion Concerning Priority Date of the '760 Patent*

For the reasons provided above, the Petition fails to demonstrate that the 2011 Application lacks written description support for the independent claims of the '760 patent. Therefore, the Petition fails to establish that the '760 patent is not entitled to priority to the filing date of DiStefano '259.

C. *Obviousness over DiStefano '259*

Petitioner asserts claims 1–20 of the '760 patent are unpatentable under 35 U.S.C. § 103 as having been obvious over DiStefano '259. Pet. 2, 30–54. Patent Owner provides several arguments in opposition. Prelim. Resp. 37–50. Patent Owner's first argument is that the Petition does not establish DiStefano '259 is prior art to the '760 patent, by virtue of the 2011 Application lacking written description support for the independent claims of the '760 patent. *Id.* at 37. For the reasons provided above, we agree with Patent Owner in that regard. Therefore, we need not address the other obviousness issues raised in the Petition and the Preliminary Response.

IV. CONCLUSION

We determine the Petition fails to demonstrate that the 2011 Application lacks written description support for the independent claims of the '760 patent. Therefore, the Petition fails to establish DiStefano '259 is prior art to the '760 patent, such that claims 1–20 of the '760 patent might be unpatentable as having been obvious over DiStefano '259. Therefore, the Petition is denied.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), the Petition is *denied*, and no *inter partes* review is instituted.

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