

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GROUPON, INC.,
Petitioner,

v.

BLUE CALYPSO, LLC,
Patent Owner.

Case CBM2013-00035
Patent 7,664,516 B2

Before JONI Y. CHANG, MICHAEL W. KIM, and
BARBARA A. BENOIT, *Administrative Patent Judges*.

KIM, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 328(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

Groupon, Inc. (“Petitioner”) filed a Petition on June 25, 2013, requesting a covered business method patent review of U.S. Patent No. 7,664,516 B2 (“the ’516 patent”) pursuant to § 18(a) of the Leahy-Smith

America Invents Act (“AIA”).¹ Paper 2 (“Pet.”). Blue Calypso, LLC (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). Taking into account Patent Owner’s Preliminary Response, the Board determined that it was more likely than not that the challenged claims are unpatentable. Pursuant to 35 U.S.C. § 324, the Board instituted this trial on December 19, 2013, as to claims 1–27 and 29 of the ’516 patent on the following grounds of unpatentability.

Reference(s)	Basis	Claims Challenged
The Ratsimor paper ²	§ 102(b)	1–15, 20–23, and 29
Paul ³	§ 102(b)	2–15, 20–23, and 29
The Ratsimor paper and Paul	§ 103(a)	1–27 and 29
	§ 112 ¶ 1	1–19, 23–25 and 29

Paper 11 (“Dec.”).

Subsequent to institution, Patent Owner filed a Patent Owner Response (Paper 18; “PO Resp.”), and Petitioner filed a Reply (Paper 25; “Reply”). Patent Owner also filed a Motion to Exclude (Paper 32; “Mot.”), to which Petitioner filed an Opposition (Paper 37; “Pet. Opp.”), and Patent Owner filed a Reply (Paper 39; “PO Reply”).

An oral hearing was held on September 5, 2014.⁴

¹ Pub. L. No. 112-29, 125 Stat. 284, 329 (2011).

² Olga Ratsimor, et al., Technical Report TR-CS-03-27 “Intelligent Ad Hoc Marketing Within Hotspot Networks,” published Nov. 2003 (Ex. 1006) (“the Ratsimor paper”).

³ U.S. Patent Application Publication 2002/0169835 A1 (Ex. 1007) (“Paul”).

⁴ A transcript of the oral hearing is included in the record as Paper 44 (“Transcript”). This proceeding, as well as CBM2013-00033, CBM2013-00034, CBM2013-00044, and CBM2013-00046, involve the same parties

The Board has jurisdiction under 35 U.S.C. § 6(c). This decision is a final written decision under 35 U.S.C. § 328(a) and 37 C.F.R. § 42.73.

Petitioner has proven, by a preponderance of the evidence, that claims 1–25 and 29 of the '516 patent are *unpatentable*.

Petitioner has not proven, by a preponderance of the evidence, that claims 26 and 27 of the '516 patent are unpatentable.

Patent Owner's Motion to Exclude is *dismissed*.

A. *Related Matters*

In compliance with 37 C.F.R. § 42.302(a), Petitioner certifies that it has been sued for infringement of the '516 patent. Pet. 8. The identified related court cases are before the U.S. District Court for the Eastern District of Texas. Pet. 8; Paper 26, 2.

Petitioner also has requested review of the following patents related to the '516 patent—U.S. Patent 8,155,679 B2 (“the '679 patent”) (Case CBM2013-00033), U.S. Patent 8,457,670 B2 (“the '670 patent”) (Case CBM2013-00034), U.S. Patent 8,438,055 B2 (“the '055 patent”) (Case CBM2013-00046), and U.S. Patent 8,452,646 B2 (“the '646 patent”) (Case CBM2013-00044). Paper 26, 2. All four patents claim priority to the application that issued as the '516 patent, and Patent Owner has indicated that it is the real-party-in-interest in all four reviews.

B. *The '516 Patent*

The '516 patent discloses systems and methods for peer-to-peer advertising between mobile communication devices. Ex. 1001, Abstract.

and similar issues. The oral arguments for the five reviews were merged and conducted at the same time

The '516 patent discloses how advertisements may be transmitted before, or after, transmissions between peer-to-peer devices, such as cellular phones. Ex. 1001, 2:4–7.

Figure 1 of the '516 patent is set forth below:

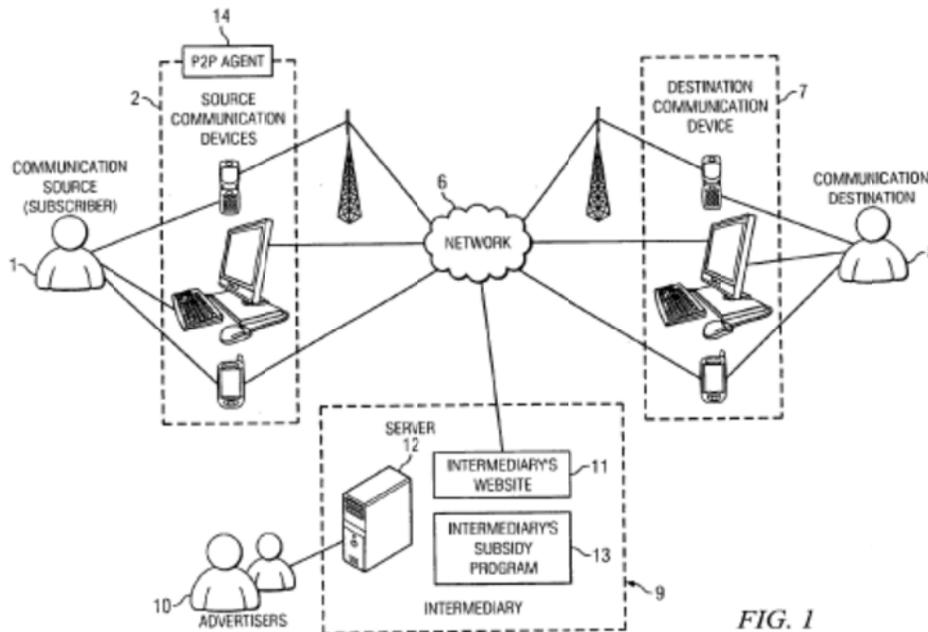


Figure 1 is a diagram for providing advertising between peer-to-peer communications devices.

As shown above in Figure 1, a communication source, such as subscriber 1, subscribes to communication subsidy program 13 of intermediary 9. Ex. 1001, 2:13–15. Communication subsidy program 13 of intermediary 9 may be funded in whole or in part by advertisers 10. Ex. 1001, 2:15–17. Specifically, advertisers 10 set up subsidy program 13, that enables advertisers 10 to select or endorse desirable subscribers in order to subsidize the communication fees, offer its own product discounts or other company's product discounts, generate and accumulate "rewards points" for the subscribers, and mitigate or defer other expenses of subscriber 1. Ex. 1001, 3:21–27. Once subscriber 1 is set up, intermediary 9

analyzes profile data of subscriber 1 and identifies advertisers 10 whose criteria for subsidy match subscriber 1. Ex. 1001, 4:19–22. Intermediary 9 then presents all acceptable advertisers 10 and subsidy programs available to the subscriber 1. Ex. 1001, 4:40–43. Subscriber 1 then may select one or more advertisers 10 and/or subsidy programs containing multiple advertisers or advertisements for endorsement. Ex. 1001, 4:43–46. The advertisements then are downloaded to subscriber 1. Ex. 1001, 4:51–53.

C. Illustrative Claim

Petitioner challenges claims 1–27 and 29 of the '516 patent. Claims 1, 2, and 20 are independent claims. Claim 2 is illustrative of the claims at issue and reads as follows:

2. A method for providing access to an advertisement from an advertiser to a source communication device possessed by a subscriber and distributing the access to the advertisement from the source communication device to a destination communication device possessed by a recipient, wherein the destination communication device is compatible with the source communication device, and the recipient having a relationship to the subscriber, the method comprising the steps of:

comparing a desired demographic profile to a subscriber demographic profile to derive a match;

establishing a bi-lateral endorsement between the subscriber and the advertiser;

providing a subsidy program to the subscriber based on the match;

sending a token related to the advertisement to the source communication device;

activating an endorsement manager in the source communication device;

initiating a communication session between the source communication device and the destination communication device;

transmitting a message, including the token, from the source communication device to the destination communication device contemporaneously with the communication session; and

recognizing a subsidy, according to the subsidy program, for the subscriber after a termination of the communication session.

II. ANALYSIS

We turn now to Petitioner's asserted grounds of unpatentability and Patent Owner's arguments in its Response and supporting evidence to determine the patentability of the challenged claims.

A. *Claim Construction*

As a step in our analysis for determining the patentability of the challenged claims, we determine the meaning of the claims. In a covered business method patent review, "[a] claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears." 37 C.F.R. § 42.300(b). Under the broadest reasonable construction standard, claim terms are given generally their "ordinary and customary meaning," as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) (quoting *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc)). Any special definition for a claim term must be set forth in the specification with "reasonable clarity, deliberateness, and precision." *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). We must be careful not to read a

particular embodiment appearing in the written description into the claim if the claim language is broader than the embodiment. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993). We construe the terms below in accordance with these principles.

1. “*subsidy*”

Each of independent claims 1, 2, and 20 recites the term “subsidy.” For example, independent claim 2 recites “recognizing a subsidy, according to the subsidy program, for the subscriber after a termination of the communication session.”

The ’516 patent does not set forth a special definition for “subsidy.” Accordingly, we look to the ordinary meaning of the term “subsidy”—financial assistance given by one to another.⁵ The ’516 patent’s use of “subsidy” is consistent with its ordinary meaning. Specifically, the ’516 patent describes an advertiser setting up a subsidy program to subsidize communication fees, offer product discounts, generate and accumulate “reward points” for subscribers, or mitigate or defer other expenses of the subscriber. Ex. 1001, 3:21–27 (referring to Fig. 2). These examples are financial in nature. Product discounts reduce the monetary cost of a financial transaction, reward points are a form of currency, and mitigating or deferring expenses reduces the monetary cost of a financial transaction or postpones the monetary cost of a financial transaction, respectively. Also, the ’516 patent describes, as part of a subscriber setup process, an intermediary presenting, to a subscriber for selection, “subsidy programs

⁵ AMERICAN HERITAGE DICTIONARY 896 (3d ed. 1992) (defining “subsidy” as “1. Monetary assistance granted by a government to a person or group in support of an enterprise regarded as being in the public interest. 2. Financial assistance given by one person or government to another.”).

available, including the criteria for continued subsidy and levels of subsidy.”
Ex. 1001, 4:41–43 (referring to Fig. 3).

For these reasons, in the Decision to Institute, the Board construed “subsidy” as “financial assistance given by one to another.” Dec. 7–9. Neither party challenges this construction. Having considered whether the construction set forth in the Decision to Institute should be changed in light of evidence introduced during trial, we are not persuaded any modification is necessary. Therefore, we maintain the construction of “subsidy” as “financial assistance given by one to another.”

2. *“bi-lateral endorsement”*

Both of independent claims 2 and 20 each recite “bi-lateral endorsement.” For example, independent claim 2 recites “establishing a bi-lateral endorsement between the subscriber and the advertiser.” The parties disagree on the construction of “bi-lateral endorsement.” Pet. 10–11; PO Resp. 9–12.

The ’516 patent does not set forth a special definition for “bi-lateral endorsement.” In proffering constructions, neither party provides sufficient evidence of the ordinary meaning of “bi-lateral” or “endorsement.” “Bi-lateral endorsement” is not recited in the original written disclosure. The term was added by amendment during prosecution of U.S. Application No. 11/318,144 (“the ’144 application”), which issued as the ’516 patent. The amendment was accompanied by the following assertion concerning “bi-lateral endorsement”: “[b]i-lateral endorsement requires approval of both the subscriber and the advertiser to the identity of the other.” Ex. 1003, 27.

This comports with the ordinary meaning of the terms “bi-,”⁶ “lateral,”⁷ and “endorsement,”⁸ which collectively mean “both sides giving approval.” The use of “bi-lateral endorsement” in independent claims 2 and 20 indicate that an endorsement occurs between two parties, a subscriber and an advertiser, which is consistent with its ordinary meaning of “both sides giving approval.”

The language in the original written disclosure corresponding to the aforementioned claim limitations also indicates an endorsement occurring between a subscriber and an advertiser. For instance, while the ’516 patent does not recite expressly “bi-lateral endorsement,” it does disclose endorsement by an advertiser of a subscriber, endorsement by a subscriber of one or more advertisers, and an endorsement of an advertiser by a subscriber facilitated through an intermediary. Ex. 1001, 3:21–27, 3:44–47, 4:43–46. Indeed, the ’516 patent discloses a subscriber being endorsed through a categorical grouping, whereby different advertisers endorse entire categories of subscribers for each communication event based on a target subsidy or target destination. Ex. 1001, 3:44–47.

Initially, Patent Owner contended that “bi-lateral endorsement” should be limited to “mutual selection arrangement in which the advertiser and the subscriber each affirmatively selects or otherwise indicates approval of the other’s identity.” Prelim. Resp. 38–39 (quoting Ex. 1003, 27). In the

⁶ AMERICAN HERITAGE DICTIONARY 181 (3d ed. 1992) (defining “bi-” as “1. a. Two . . . b. Both . . . c. Both sides, parts, or directions”).

⁷ AMERICAN HERITAGE DICTIONARY 1017 (3d ed. 1992) (defining “lateral” as “1. Of, relating to, or situated at or on the side”).

⁸ AMERICAN HERITAGE DICTIONARY 608 (3d ed. 1992) (defining “endorse” as “4. To give approval of or support to, especially by public statement”); *id.* (defining “endorsement” as “1. The act of endorsing”).

Decision to Institute, the Board disagreed that certain terms, such as “mutual selection arrangement” and “affirmatively selects,” are limiting, because Patent Owner had not shown where these terms are set forth in the ’516 patent in a manner sufficient to supersede the ordinary meaning of the term “bi-lateral endorsement” as used in the ’516 patent. Dec. 12. Based on its use in the ’516 patent, however, the Board agreed with the Patent Owner that “bi-lateral endorsement” requires each party to approve the other’s identity. Dec. 12. For these reasons, in the Decision to Institute, the Board construed “bi-lateral endorsement” as “approval of two parties to the identity of the other,” consistent with the term’s ordinary meaning in light of the Specification. Dec. 13–15. Petitioner does not challenge this construction. Reply 1.

After Institution, Patent Owner contends that “bi-lateral endorsement” means “a selection of one or more potential subscribers by the advertiser, and a selection of the same advertiser by the subscriber,” or, more simply, “selections by two parties of each other.” PO Resp. 9. Patent Owner also contends that bi-lateral endorsement “requires *affirmative acts of selection* by each party of the other.” PO Resp. 10. In proffering its construction, Patent Owner appears to be asserting that its construction is narrower than that of the Board, as the Board’s construction could plausibly be met by two parties approving of each of other without explicit affirmative acts of selection by each party of the other. For support, Patent Owner relies on various passages in the ’516 patent describing the selection of subscribers and advertisers. PO Resp. 10–11 (citing Ex. 1001, 3:21–33; 4:43–46; Fig. 3, step 46).

Relying on a statement made during examination of the '144 application, Patent Owner contends that “bi-lateral endorsement is a ‘selection process’ involving acts of selection or endorsement.” PO Resp.

11. Patent Owner specifically relies on the following statements:

The subscriber’s *selection* process of claim 2 is different. Initially, [a] subscriber must *be selected* by a match condition based on his profile. The subscriber is then provided a corresponding subsidy plan based on the match condition. The subscriber is not limited to the highest bidding advertiser but rather *has a choice* of which advertiser(s) *to endorse*.

PO Resp. 10–12 (quoting Ex. 1003, 28) (emphasis added and citations omitted).

Applicant’s statements distinguished the limitations “comparing a desired demographic profile to a subscriber demographic profile to derive a match” and “providing a subsidy program to the subscriber based on the match” of claim 2 from prior art references describing “comparing an advertisement characterization to each consumer profile.” Ex. 1003, 27–28. Because the Applicant’s statements were not directed to the limitation “establishing a bi-lateral endorsement between the subscriber and the advertiser,” the statements have limited probative value concerning the construction of “bi-lateral endorsement.” We are not persuaded that Applicant’s statements are sufficient to supersede the ordinary meaning of the term “bi-lateral endorsement” as “both sides giving approval,” as used in the '516 patent.

We turn to Patent Owner’s contention that the process of establishing bi-lateral endorsement “requires *affirmative acts of selection* by each party of the other.” PO Resp. 10. For the reasons previously indicated, we recognize the '516 patent discloses various examples of selecting an

advertiser or subscriber. Some claims of the '516 patent, however, expressly require selection of an advertiser. Specifically, independent claim 1 recites “receiving a first selection of the at least one advertiser of the group of advertisers from the qualified subscriber,” and dependent claim 21 recites “select a subset of advertisers from the set of advertisers and at least one subsidy program of the set of subsidy programs.” Independent claims 2 and 20, which recite establishing or determining bi-lateral endorsement between an advertiser and a subscriber, do not recite limitations regarding selecting an advertiser or subscriber. We do not import a limitation requiring an affirmative selection by each party of the other into the claims, especially where, under the doctrine of claim differentiation, the “bi-lateral endorsement” recited in independent claim 20 is presumed to be broader than the “selecting” recited in dependent claim 21. Thus, we conclude that the process of establishing bi-lateral endorsement does not require affirmative acts of selection by each party of the other.

Also, Patent Owner, after Institution, proffers a construction of “bi lateral endorsement” that does not include “identity of the other.” PO Resp. 9. Previously, in its Preliminary Response, Patent Owner had contended, relying on a statement made during examination of the '144 application, that a bi-lateral endorsement should be limited to “a mutual selection arrangement in which the advertiser and the subscriber each *affirmatively selects or otherwise indicates approval of the other's identity.*” Prelim. Resp. 37–39 (quoting Ex. 1003, 27) (emphasis added). We already have addressed this issue above, and thus our analysis need not be repeated here.

Accordingly, in view of the evidence and arguments submitted during this proceeding, we maintain the construction of “bi-lateral endorsement” as “approval of two parties to the identity of the other.”

3. *Whether the Preambles Are Limiting*

After Institution, Patent Owner contends that the preambles of certain challenged claims are limiting. PO Resp. 15–17. specifically Patent Owner contends that the preambles provide antecedent basis for limitations in the body of claims 1, 2, 8, and 20. PO Resp. 16–17. As such, Patent Owner contends that “the preambles provide explicit structure to the relationship of certain components of the invention that give life, meaning and vitality to the claimed invention.” PO Resp. 16.

We agree. In general, a preamble is construed as a limitation “if it recites essential structure or steps, or if it is ‘necessary to give life, meaning, and vitality’ to the claim.” *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002) (quoting *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999)). When the limitations in the body of the claim “rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention.” *Eaton Corp. v. Rockwell Int’l Corp.*, 323 F.3d 1332, 1339 (Fed. Cir. 2003) (citations omitted).

For example, the preamble of independent claim 2 recites “an advertiser,” “a source communication device possessed by a subscriber” and “a destination communication device possessed by a recipient.” The body of independent claim 2 recites “the advertiser,” “the source communication device,” “the subscriber,” and “the destination communication device,” all

of which rely on and derive antecedent basis from the preamble of independent claim 2.

Similarly, the preamble of independent claim 20 recites “a first communication device,” “a second communication device,” and “a communication session.” The body of independent claim 20 recites “the first communication device,” “the second communication device,” and “the communication session.” The same is true for “subscriber” and “advertising content” in independent claim 1, and “advertising content” and “intermediary” in dependent claim 8.

Accordingly, we conclude that the preambles of independent claims 1, 2, 8, and 20 are entitled to patentable weight.

B. Standing

Section 18 of the AIA provides for the creation of a transitional program for reviewing covered business method patents. Section 18 limits reviews to persons or their privies that have been sued or charged with infringement of a “covered business method patent,” which does not include patents for “technological inventions.” AIA §§ 18(a)(1)(B), 18(d)(1); *see* 37 C.F.R. § 42.302. The parties disagree as to whether Petitioner has standing to file a petition for a covered business method patent review of the ’516 patent.

1. Financial Product or Service

Petitioner contends that the ’516 patent is a covered business method patent, because the claimed subject matter is directed to providing a subsidy, which is financial in nature. Pet. 5–7. Our inquiry is controlled by whether the patent “claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or

management of a financial product or service.” 37 C.F.R. § 42.301(a) (definition of a covered business method patent). To that end, independent claim 2 recites “providing a subsidy program to the subscriber.” As set forth above, we construe “subsidy” as “financial assistance given by one to another.” Accordingly, we agree with Petitioner that the subject matter of independent claim 2 is financial in nature.

2. *Exclusion for Technological Inventions*

The definition of “covered business method patent” in section 18 of the AIA expressly excludes patents for “technological inventions.” AIA § 18(d)(1). To determine whether a patent is for a technological invention, we consider “whether the claimed subject matter as a whole recites a technological feature that is novel and unobvious over the prior art; and solves a technical problem using a technical solution.” 37 C.F.R. § 42.301(b). The following claim drafting techniques, for example, typically do not render a patent a “technological invention”:

(a) Mere recitation of known technologies, such as computer hardware, communication or computer networks, software, memory, computer-readable storage medium, scanners, display devices or databases, or specialized machines, such as an ATM or point of sale device.

(b) Reciting the use of known prior art technology to accomplish a process or method, even if that process or method is novel and non-obvious.

(c) Combining prior art structures to achieve the normal, expected, or predictable result of that combination.

Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,763-64 (Aug. 14, 2012).

Petitioner contends that the ’516 patent is not directed to a technological invention, because independent claim 2 recites known

components and is directed toward a business problem, not a technical solution. Pet. 7. We agree. Accordingly, we determine that independent claim 2 is not directed toward a technological invention.

C. Whether the Ratsimor Paper is a Printed Publication under 35 U.S.C. § 102(b)

Petitioner asserts that claims 1–15, 20–23, and 29 are unpatentable under 35 U.S.C. § 102(b) as anticipated by the Ratsimor paper, and claims 1–27 and 29 are unpatentable under 35 U.S.C. § 103(a) as obvious over the Ratsimor paper and Paul. Pet. 11–32, 55–57. In its Petition, Petitioner asserts the Ratsimor paper is prior art because it is a technical report published by the Department of Computer Science and Electrical Engineering (“the Department”) of the University of Maryland, Baltimore County in November 2003, more than one year prior to the earliest priority date claimed by the ’516 patent. Pet. 2, 11; Ex. 1008 ¶¶ 2, 14; *see also* Ex. 1001, 1:5–8 (claiming priority to provisional Application No. 60/639,267 filed Dec. 27, 2004).

To substantiate its position that the Ratsimor paper is a printed publication, Petitioner relies on a “publications” list of papers authored by Dr. Olga Ratsimor (pages i–ii) included in Exhibit 1006, along with the Ratsimor paper itself (pages 1–14), and a page that appears to be a cover page identifying the Ratsimor paper as “Technical Report TR-CS-03-27” (page iii). Ex. 1006.

Petitioner also relies on the testimony of its Declarant, Anupam Joshi, Ph.D. (one of the authors of the Ratsimor paper), that the Ratsimor paper was a technical report of the Department that was “published and publicly available around November 2003” and also was “publicly available for

viewing and downloading” from the Department’s website. Ex. 1008 ¶ 2. Petitioner also explains the “TR-CS-03-27” designation of the technical report on the cover page “means that this Report was the 27th report issued in 2003 by” the Department. Ex. 1008 ¶¶ 2, 14.

Patent Owner counters that Petitioner has failed to prove the Ratsimor paper is a printed publication under 35 U.S.C. § 102(b) and, therefore, Petitioner has not established that Ratsimor is prior art to the ’516 patent. PO Resp. 4–5, 23–32. Patent Owner contends the Ratsimor paper is an unindexed, internal departmental technical report that was not accessible to those of ordinary skill in the art more than one year prior to the date of the application for patent. PO Resp. 25–27.

Having reviewed the parties’ arguments and supporting evidence, we do not find sufficient evidence that the Ratsimor paper was publicly accessible and, therefore, we conclude that Petitioner has failed to show that the Ratsimor paper is a printed publication under 35 U.S.C. § 102(b). Section 102 states: “A person shall be entitled to a patent unless . . . (b) the invention was . . . described in a printed publication . . . more than one year prior to the date of the application for patent” 35 U.S.C. § 102(b). “The statutory phrase ‘printed publication’ has been interpreted to give effect to ongoing advances in the technologies of data storage, retrieval, and dissemination.” *In re Hall*, 781 F.2d 897, 898 (Fed. Cir. 1986). As such, a printed publication under 35 U.S.C. § 102(b) may be an electronic publication, such as the Ratsimor paper is purported to be. *See In re Wyer*, 655 F.2d 221, 226 (CCPA 1981) (holding that an electronic publication is considered to be a “printed publication” “upon a satisfactory showing that such document has been disseminated or otherwise made available to the

extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it and recognize and comprehend therefrom the essentials of the claimed invention without need of further research or experimentation”).

The determination of whether a particular reference qualifies as a prior art printed publication “involves a case-by-case inquiry into the facts and circumstances surrounding the reference’s disclosure to members of the public.” *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004). The key inquiry is whether the reference was made “sufficiently accessible to the public interested in the art” before the critical date. *In re Cronyn*, 890 F.2d 1158, 1160 (Fed. Cir. 1989). “A given reference is ‘publicly accessible’ upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it” *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006). Indexing is not “a necessary condition for a reference to be publicly accessible,” but is among many factors that may bear on public accessibility. *In re Lister*, 583 F.3d 1307, 1312 (Fed. Cir. 2009).

1. *Whether the Ratsimor Paper Was Publicly Accessible in November 2003*

Although Petitioner does provide some evidence to support its position, after considering all of the evidence regarding the facts and the circumstances surrounding the public accessibility of the Ratsimor paper, in view of the relevant case law, we determine that Petitioner has not met its burden of showing that the Ratsimor paper was publicly accessible in November 2003.

We begin our analysis with Petitioner's supporting evidence, and specifically with Dr. Joshi's testimony, which supports Petitioner's contention that the Ratsimor paper was a technical report of the Department posted on the Department's webserver and was accessible to the public for viewing and downloading in November 2003. As corroborating evidence, Petitioner presents additionally the publications list of Dr. Ratsimor, which includes the Ratsimor paper designated as a "Technical Report" and identifies a November 2003 date with it. Ex. 1006, i. The publications list also includes a uniform resource locator (<http://www.csee.umbc.edu/~oratsi2/publications>). Ex. 1006, i. Petitioner contends that Dr. Ratsimor's publications list "includes a link to download" the Ratsimor paper. Reply 4.

According to Petitioner, the inclusion of the Ratsimor paper in Dr. Ratsimor's publications list supports Petitioner's contention that Dr. Ratsimor viewed the Ratsimor paper as a publication and associated a November 2003 date with the paper. Because, as Dr. Joshi testifies, the paper was "publicly available for viewing and downloading" from the Department's website, Petitioner asserts that the inclusion of the Ratsimor paper in Dr. Ratsimor's list of publications on the Department's website evinces an intent to make the Ratsimor paper public and further is an attempt by Dr. Ratsimor to disseminate the reference. *Cf. In re Wyer*, 655 F.2d at 227 (Factors supporting public accessibility include an intent to publicize and disseminating activities). We agree that Dr. Ratsimor's subjective view of the Ratsimor paper, whose intent to publicize the Ratsimor paper and dissemination activities weigh in favor of finding the Ratsimor paper was publicly accessible. These findings, however, are not dispositive, and,

indeed, are insufficient to support a legal determination that the Ratsimor paper is a printed publication.

As an initial matter, we note that there are gaps in Petitioner's proffered evidence—foremost is Dr. Joshi's lack of indication that the Ratsimor paper was downloaded or otherwise disseminated, or how persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, could locate the Ratsimor paper on the Departmental website or otherwise locate an issued Technical Report in November 2003. Turning to the reference itself, the Ratsimor paper is a fourteen page paper, which does not provide a date or indicia of dissemination, such as the name of a journal. Ex. 1006, 1 (page 1 of the Ratsimor paper shows the title of the paper, author names and internet addresses, the Department's address, an abstract, keywords, and the first section of text). Nor does the cover page provide a date or indicia of dissemination of the Ratsimor paper, other than it being a technical report. Ex. 1006, iii (showing "Technical Report TR-CS-03-27," the title of the paper, author names and internet addresses, and the Department's address).

The aforementioned gaps in evidence are important, because even when we assume that the Ratsimor paper was available on the Department's website and was included in a list of publications identified by the author's name, the facts are similar to those involving the theses placed in university libraries in *In re Bayer*, 568 F.2d 1357, 1361–62 (CCPA 1978) and *In re Cronyn*, 890 F.2d 1158, 1161 (Fed. Cir. 1989). The Court held that an unshelved and uncatalogued graduate thesis placed in a university library and known only to three faculty members was not sufficient to support a finding that it was publicly accessible. *Bayer*, 568 F.2d at 1361–62. In

Bayer, as the Court explains, the student thesis was not a printed publication under 35 U.S.C. § 102(b), because the “thesis could have been located in the university library only by one having been informed of its existence by the faculty [members], . . . the probability of public knowledge of the contents of the [thesis] . . . was virtually nil.” *Bayer*, 568 F.2d at 1361 (internal citation omitted).

Perhaps even closer to our current fact pattern is *Cronyn*, in which three student theses were determined by the Court not to be accessible to the public because “they had not been either cataloged or indexed” in relationship to the subject matter of the theses. *Cronyn*, 890 F.2d at 1161. Specifically, even if we were to determine that the current fact pattern supported a finding of indexing by author, the Federal Circuit held that indexing based on author’s name was not sufficient to make the theses publicly accessible, even when the title of the theses was listed along with the author’s name. *Id.*

The Ratsimor paper also is similar to the paper that was placed “on an open [File Transfer Protocol (FTP)] server and might have been available to anyone with FTP know-how and knowledge of [a particular] subdirectory,” containing information about a particular project in *SRI Int’l, Inc. v. Internet Security Sys., Inc.*, 511 F.3d 1186, 1194–97 (Fed. Cir. 2008). In *SRI*, the Court disagreed that an interested person of ordinary skill in the art would know, based on distribution of the existence of the FTP server to interested persons, that the “FTP server contained information on the [particular] project and therefore would navigate through the folders to find” the paper at issue. *SRI*, 511 F.3d at 1195. Although the paper on the FTP server was available to anyone who managed to find it, the “paper was not publicized or

placed in front of an interested public.” *SRI*, 511 F.3d at 1197. Thus, the Court concluded the paper on the FTP server was “analogous to placing posters at an unpublicized conference with no attendees” and, therefore, was not publicly accessible. *Id.*

In the instant case, like the paper placed on an FTP server that was accessible to knowledgeable persons, the Ratsimor paper was only “available for viewing and downloading” (Ex. 1008 ¶ 2) to members of the public who happened to know that the Ratsimor paper was there. Thus, comparing the totality of the current facts to the above cases, we determine that Petitioner has not met its burden of showing that the Ratsimor paper was publicly accessible.

In response, Petitioner contends that an interested and ordinarily skilled artisan aware of an October 2003 article by Dr. Ratsimor, which the parties do not dispute was publicly available, would expect additional written materials to be generated and available from the Department’s website. Reply 4 (citing Ex. 1039). According to the Petitioner, an interested and ordinarily skilled artisan, having such knowledge of the October 2003 article, then would be led to Dr. Ratsimor’s publications list (Ex. 1006, i), which identifies the Ratsimor paper and “includes a link to download Ratsimor.” Reply 4. Thus, according to Petitioner, an interested and ordinarily skilled artisan would be able to follow the October 2003 article as a roadmap to the Ratsimor paper, in the same way that an article in *Cornell University v. Hewlett-Packard Co.*, No. 01-cv-1974, 2008 U.S. Dist. LEXIS 39343, at *24–25 (N.D.N.Y. May 14, 2008) pointed the way to an unpublished thesis that was not indexed by subject or title. In that district court case, the article used as a roadmap was published in a seminal

publication in the field of electrical engineering and included an express reference to the unpublished thesis, which was deemed by the Court to be a printed publication under 35 U.S.C. § 102(b). *Id.*, at *11 (“After weighing all the circumstances of accessibility, this court views as vitally important the citation of [the unpublished thesis] in the . . . article [published in a seminal publication].”). The article served to guide those skilled in the art to the thesis because “the article cites [to] the . . . thesis in such a way as to make it accessible to any reader interested in [the] subject matter.” *Id.*, at *12.

Unlike the roadmap article in *Cornell*, however, the October 2003 article by Dr. Ratsimor does not include an explicit reference to the November 2003 Ratsimor paper asserted in this proceeding. Moreover, although the October 2003 article may have pointed an interested researcher to the Departmental webserver, the October 2003 article does not point an interested researcher expressly to the Ratsimor paper on the Departmental webserver. And as noted previously, insufficient evidence has been presented to establish the Department’s webserver contained an index or catalog, or any other tools for finding the Ratsimor paper based on the subject matter of the paper.

Thus, after considering the totality of the indicia of public accessibility, the evidence on this record places the Ratsimor paper on the non-accessible side of public accessibility. Therefore, we conclude the Ratsimor paper is not a printed publication under 35 U.S.C. § 102(b) that can be used to challenge the patentability of the claims in the ’516 patent.

Because we have determined that Petitioner has not shown that the Ratsimor paper was publicly accessible in November 2003, we need not

consider Petitioner's evidence purporting to corroborate the date of the Ratsimor paper. Reply 5.

2. *The Ratsimor Paper Is Not Prior Art*

For the foregoing reasons, we determine that Petitioner has not demonstrated, by a preponderance of the evidence, that the Ratsimor paper is a printed publication within the meaning of 35 U.S.C. § 102(b) and, therefore, the Ratsimor paper is not prior art to the claims of the '516 patent. Therefore, Petitioner may not rely upon the Ratsimor paper for its asserted grounds of patentability under 35 U.S.C. § 102(b) and § 103(a). Accordingly, we conclude that Petitioner has not demonstrated that claims 1–15, 20–23, and 29 are anticipated by the Ratsimor paper or that claims 1–27 and 29 would have been obvious over the combination of the Ratsimor paper and Paul.

D. *Asserted Ground of Anticipation by Paul*

Petitioner asserts that claims 2–15, 20–23, and 29 of the '516 patent are unpatentable under 35 U.S.C. § 102(b) as anticipated by Paul. Pet. 32–55; Reply 11–12.

1. *Principles of Law*

To establish anticipation, each and every element in a claim, arranged as recited in the claim, must be found in a single prior art reference. *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008); *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001). To anticipate, a prior art reference must disclose more than “multiple, distinct teachings that the artisan might somehow combine to achieve the claimed invention.” *Net MoneyIN*, 545 F.3d at 1371. Although the elements must be arranged or combined in the same way as in the claim,

“the reference need not satisfy an *ipsissimis verbis* test,” i.e., identity of terminology is not required. *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009); *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990). Moreover, the prior art reference is read from the perspective of one with ordinary skill in the art. *In re Graves*, 69 F.3d 1147, 1152 (Fed. Cir. 1995) (“A reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention.”); *In re Preda*, 401 F.2d 825, 826 (CCPA 1968) (“[I]t is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.”).

2. *Overview of Paul*

Paul discloses an Internet-based e-mail communications system that broadcasts communications to members, some of whom have cellular telephones. Ex. 1007, Abstract. The Internet-based e-mail communications system includes a campaign manager to provide a number of tool options to users. Ex. 1007 ¶¶ 34, 51, 100. For example, one of the tool options allows the users to develop and manage an e-mail direct marketing campaign that sends personalized e-mail messages to members whose member records match parameters identified for the campaign. Ex. 1007 ¶ 51. The personalized e-mail message includes an advertisement for a particular business, and a hyperlink to a web site of a business that, when activated, transfers the member to the web site. Ex. 1007 ¶ 95. Another tool option in the campaign manager provides a “refer a friend” advertising campaign that provides a coupon to a member who is successful in referring a friend to the web site of the business. Ex. 1007 ¶¶ 101–102. Specifically, the member

sends the e-mail message (with the embedded hyperlink and an associated referral communication data packet, which identifies the business sponsoring the advertising campaign) to one or more friends. Ex. 1007 ¶ 102. The “refer a friend” advertising campaign can increase member activity “by offering an economic incentive.” Ex. 1007 ¶ 102.

3. *Analysis*

Petitioner asserts that claims 2–15, 20–23, and 29 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Paul. Pet. 32–55; Reply 11–12. In support of this asserted ground of unpatentability, Petitioner provides detailed explanations as to how each claim limitation is met by Paul and relies on testimony by Dr. Joshi. Pet. 32–55 (citing Ex. 1008). Patent Owner disagrees with Petitioner’s assertions and relies on testimony by Vernon Thomas Rhyne, Ph.D. PO Resp. 61–67 (citing Ex. 2039).

We find Paul discloses each limitation of independent claim 2 as arranged in the claims. For example, independent claim 2 recites a method for providing an advertisement from an advertiser to a subscriber, and then distributing the advertisement from the subscriber to a recipient. Paul discloses an Internet-based e-mail communications system that sends personalized e-mail messages to members. Ex. 1007 ¶ 51. The personalized e-mail message includes an advertisement for a particular business, and a hyperlink to a web site of a business. Ex. 1007 ¶ 95. The member then sends the received e-mail message (with the embedded hyperlink and referral data) to one or more friends, as a part of a “refer a friend” advertising campaign. Ex. 1007 ¶ 102. Independent claim 2 further recites providing a subsidy program to the subscriber, and recognizing a subsidy, according to the subsidy program, for the subscriber after the

subscriber distributes the advertisement to the recipient. Paul discloses the “refer a friend” advertising campaign can increase member activity “by offering an economic incentive.” Ex. 1007 ¶ 102.

Petitioner sets forth a similar analysis for claims 3–15, 20–23, and 29. We have reviewed the evidence presented by Petitioner regarding Paul’s disclosure of the further limitations recited in dependent claims 3–15, independent claim 20, and dependent claims 21–23 and 29. We find that Paul discloses each limitation of claims 3–15, 20–23, and 29 as arranged in the claims.

i. Patent Owner’s Contentions Regarding Independent Claim 2

Patent Owner asserts that Petitioner cannot show anticipation of independent claim 2 by a preponderance of the evidence, because in order to meet “establishing a bi-lateral endorsement between the subscriber and the advertiser” and “providing a subsidy program to the subscriber based on the match,” as recited in independent claim 2, disparate methods of Paul’s e-mail communication system must be combined, and so, Paul does not disclose all elements as arranged in the claim. PO Resp. 59–65.

Specifically, Patent Owner asserts, with support from Dr. Rhyne’s testimony (Ex. 2039 ¶¶ 161–166), that Paul describes “two separate and distinct methods” of using the e-mail communication system—a direct e-mail campaign to send targeted advertisements based on demographics of members (as disclosed in paragraph 51 and surrounding paragraphs of Paul) and a “refer-a-friend” campaign involving incentive-based referrals (as disclosed in paragraphs 95–102). Patent Owner asserts that it is improper to combine a direct e-mail campaign with a “refer-a-friend” campaign because the campaigns are unrelated.

We disagree with Patent Owner's characterization of Paul's campaign manager computer program as having multiple separate and distinct methods, rather than a single comprehensive program that provides users with multiple tool options to design their marketing campaign. Paul discloses a campaign manager computer program of the e-mail communications system that "enables [a user] to develop and implement direct marketing email campaigns." Ex. 1007 ¶¶ 34, 51 (A user "is enabled to conduct direct marketing campaigns using a computer program generally identified as a 'campaign manager' herein."). "With the campaign manager program, the [user] defines the parameters of the campaign by conducting a search through the member records based upon criteria encompassed in the member records." Ex. 1007 ¶ 51. Dr. Rhyne, Patent Owner's Declarant, does not dispute that a direct e-mail campaign is developed using the campaign manager program of Paul's e-mail communications system. Ex. 1030, 175-77.

Paul also discloses that, under the tools option in the campaign manager, the user may select the "refer-a-friend" routine. Ex. 1007 ¶¶ 50, 100 (indicating the "refer-a-friend" campaign of the e-mail communications system may be selected "using the tools option in the campaign manager"). Thus, the campaign manager computer program is a single computer program that provides tools options for the user to develop the campaigns.

We acknowledge that Paul does not disclose expressly an example in which a direct e-mail campaign to send targeted advertisements based on demographics of members is used with a "refer-a-friend" campaign involving incentive-based referrals. We also acknowledge that Paul does not indicate expressly that any of the computer routines in the campaign

manager computer program can be used with any other one of the campaign manager computer routines, a fact also acknowledged by Dr. Joshi (Ex. 2045, 189:4–24). Paul, however, does disclose expressly that the preferred embodiment of the invention “may be produced in a single computer system having . . . elements or means combining the performance of any of the functions or steps disclosed.” Ex. 1007 ¶ 29.

Based on the above disclosures of Paul, we find that the direct e-mail campaign and a “refer-a-friend” campaign are not different methods, but are different tool options provided by the campaign manager computer program in the e-mail communications system disclosed by Paul. Accordingly, as different tool options of the campaign manager in the e-mail communications system, one of ordinary skill in the art would understand that the direct e-mail campaign tool option was to be used in conjunction with the “refer-a-friend” campaign tool option to send “refer-a-friend” e-mail message incentives to a subset of the members based on member demographic characteristics. To determine otherwise would require a finding that one of ordinary skill in the art, when reading Paul, would come to the conclusion that the only option would be to send a “refer-a-friend” e-mail to all members. We do not find that one of ordinary skill in the art would have understood Paul to be so restrictive. Rather, Paul’s disclosure of the campaign manager computer program having multiple tool options to develop marketing campaigns is analogous to a reference disclosing two functions of a word processing program—creating a document and saving a document. One skilled in the art would understand the word processing

program reference to disclose how to use those functions together to create and save a document.⁹ Cf. Transcript 67:9 – 68:11.

Dr. Joshi confirms this understanding and explains:

While Paul does disclose the possibility of sending the referral email to all members of the system [Ex. 1007 ¶ 102], Paul further explicitly states that the referral email can alternatively be created through use of the Campaign Manager.

Ex. 1029 ¶ 93. Dr. Joshi further cites Paul’s disclosure that “[s]ponsors . . . have the ability to create numerous types of e-mail campaigns, such as ‘refer a friend’ campaign, through the campaign manager program discussed later.” Ex. 1029 ¶ 93 (quoting Ex. 1007 ¶ 50).

Dr. Rhyne recognizes, as do we, that Paul does not disclose expressly “having a member forward a[n] advertising e-mail received from a sponsor during an e-mail-based advertising campaign to another member or someone who is not a member” through the “refer-a-friend” campaign. Ex.

⁹ At Oral Argument, the Board and Patent Owner’s counsel had the following exchange:

JUDGE KIM: So using your logic, then, in Microsoft Word, if I create a document and I save it later, but there are two different routines, I would not know to create a document and save it?

MR. CONRAD: Well, it depends on what you’re looking at as the reference. So what are you looking at to say it anticipates --

JUDGE KIM: Well, let's say it’s similar to this, you know, like on one part of the reference you have a save function and one part you have a create document function.

MR. CONRAD: Right. Well, it depends. Are you looking at anticipation or obvious? If it’s anticipation

JUDGE KIM: Anticipation.

MR. CONRAD: The references says [sic] you’ve got a routine to save the program. Then what’s the other routine you’re interested in?

JUDGE KIM: Creating a document.

Transcript 67:9-22.

2039 ¶¶ 161, 168. Dr. Rhyne, however, does not address persuasively Paul’s disclosure that both the direct e-mail campaign and a “refer-a-friend” campaign use the campaign manager computer program, or how one of ordinary skill in the art would understand how the direct e-mail campaign and a “refer-a-friend” campaign are related through the campaign manager. *See generally* Ex. 2039 ¶¶ 145–168 (discussing Paul’s disclosure of the direct e-mail campaign and the “refer-a-friend” campaign).

We recognize that, at first glance, this case appears to be similar to the facts in *Net MoneyIN, Inc.*, 545 F.3d at 1368–71. In that case, a prior art reference was held not to anticipate a claim reciting five links in an Internet payment system, because neither of the two separate protocols for processing Internet credit card transactions disclosed all five links. *Id.* The Court concluded that the prior art reference did not show the claimed invention arranged or combined in the same way as recited in the claim. *Id.* Two additional facts in the instant case distinguish *Net MoneyIN*: (i) Paul discloses an e-mail communications system in which a particular computer program—campaign manager—has tool options to create both a direct e-mail campaign based on demographics and a “refer-a-friend” campaign involving incentive-based referrals; and (ii) Dr. Joshi’s testimony that the disclosure would be understood by one of ordinary skill in the art to mean the campaigns can be used together through the campaign manager.

Thus, we find that a direct e-mail campaign and a “refer-a-friend” campaign are not multiple, distinct teachings of the prior art reference unrelated to each other by the teachings. Rather, we find the campaigns are tool options to be used together, “without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the

teachings of the cited reference,” to anticipate the challenged claims of the ’516 patent. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972); *see Net MoneyIN*, 545 F.3d at 1371.

Patent Owner asserts that Paul does not disclose a member “electing” to receive a particular e-mail campaign from an advertiser, let alone approving a particular advertiser as required by independent claim 2. We are not persuaded by Patent Owner’s assertion, because Paul discloses a member forwarding an e-mail received from a business. Ex. 1007 ¶¶ 101–102. By forwarding the e-mail, the member is expressing approval of that business.

Patent Owner asserts further that Paul does not disclose whether it is the same business sending (i) an e-mail message to a member in the e-mail match embodiment, and (ii) an e-mail message to a member for forwarding in the refer-a-friend embodiment. Patent Owner asserts that, unless it is the same business, there can be no bi-lateral endorsement, as required by independent claim 2. Patent Owner’s assertion is unavailing, because (i) we have explained above why one of ordinary skill would have understood the two tool options as being used together, and (ii) even without the direct e-mail campaign, in the refer-a-friend campaign, the business is approving the member by sending to the e-mail to the member, and the member is approving the business by forwarding the same e-mail to a friend.

Patent Owner asserts additionally that Paul does not disclose “providing a subsidy program to the subscriber based on the match,” as required in independent claim 2. According to Patent Owner, the two campaign methods cannot be read together, because Paul discloses explicitly that the “refer-a-friend” message is sent to each and every member, which is

contrary to the direct e-mail campaign in which e-mails are only sent to a subset of members.

We do not agree with Patent Owner's assertions because, as explained previously, one of ordinary skill would have understood the two tool options as being used together, such that the refer-a-friend e-mail would only be sent to a subset of members.

*ii. Patent Owner's Contentions Regarding
Independent Claim 20*

Patent Owner asserts that Paul does not disclose "the intermediary having a processor configured to . . . determine a bi-lateral endorsement by the qualified subscriber and the at least one advertiser," as recited in independent claim 20. PO Resp. 66–67. Patent Owner contends that Petitioner, in asserting Paul discloses this limitation, improperly combines the unrelated direct e-mail campaign and "refer-a-friend" campaign. Patent Owner also contends that Paul does not disclose a member "electing" to receive a particular e-mail campaign from an advertiser. Further, Patent Owner contends that that Paul does not disclose whether it is the same business sending (i) an e-mail message to a member in the direct e-mail campaign and (ii) an e-mail message to a member for forwarding in the "refer-a-friend" campaign. Patent Owner asserts that unless it is the same business, there can be no bi-lateral endorsement, as required by independent claim 20.

Patent Owner's contentions substantially are similar to Patent Owner's contentions regarding independent claim 2. For the reasons discussed with respect to independent claim 2, we do not agree with Patent Owner.

4. Conclusion

For the foregoing reasons, we find that Petitioner has proven, by a preponderance of the evidence, that claims 2–15, 20–23, and 29 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Paul.

E. Claims 1–19, 23–25, and 29 – Failing to Comply with Written Description Requirement

Petitioner contends that claims 1–19, 23–25, and 29 of the '516 patent are unpatentable under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. Pet. 73–80; Reply 13–15. Specifically, Petitioner contends the claim terms “endorsement tag” and “token.” do not have adequate written description support. Patent Owner disagrees with Petitioner’s assertions and relies on the Declaration of Dr. Rhyne. PO Resp. 17–22 (citing Ex. 2039).

1. Principles of Law

“[T]he purpose of the written description requirement is to ‘ensure that the scope of the right to exclude, as set forth in the claims, does not overreach the scope of the inventor's contribution to the field of art as described in the patent specification.’ ” *Ariad Pharms., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336,1353–54 (Fed. Cir 2010) (en banc) (quoting *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 920 (Fed.Cir.2004)). To satisfy the written description requirement, the focus is not just on whether the claims are supported by the specification, but whether one of ordinary skill in the art reasonably would conclude from the original disclosure that the inventor had possession of the claimed invention. *See, e.g., Ariad Pharms.*, 598 F.3d at 1351. The written description requirement is met if the specification shows that the inventor has invented what is claimed—that is,

the inventor had possession of it. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed.Cir.1991).

2. “endorsement tag”

Claims 1, 11, and 14 each recite “endorsement tag.” The ’144 application, which issued into the ’516 patent, does not recite expressly “endorsement tag.” Petitioner asserts that “endorsement tag” should be construed as an “executable link, such as a hyperlink,” and that “endorsement tag” must be related to an advertiser linked with advertising content, transmitted from a qualified subscriber to a recipient, and be capable of being executed to produce a signal, as required by independent claim 1. Petitioner asserts that the ’144 application does not disclose any such feature with all the aforementioned functionalities. Pet. 73–75. Patent Owner agrees with Petitioner’s proposed construction of “endorsement tag,” and asserts that, because the ’144 application provides adequate written description support for a hyperlink that includes all of the aforementioned functionalities of an endorsement tag, it must also provide adequate written description support for the claim limitation “endorsement tag.” PO Resp 19–22. Both parties’ contentions are misplaced. The question is not whether the ’144 application provides adequate written description support for a definition of or the features of “endorsement tag.” The question is whether given the ’144 application, one of ordinary skill would reasonably conclude that the inventor had possession of “endorsement tag,” because the list of features of an “endorsement tag” disclosed in the ’144 application would allow one of ordinary skill to recognize that the inventor had invented the claimed “endorsement tag.” Although the Specification does not need to use the term “endorsement tag” or otherwise describe exactly the subject

matter claimed, “the description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed”—that is, an “endorsement tag.” *Vas-Cath*, 935 F.2d at 1563 (quoting *In re Gosteli*, 872 F.2d 1008, 1012 (Fed.Cir.1989)).

There is no question that the ’144 application does not recite the precise words “endorsement tag.” Although “endorsement tag” is a claim limitation, it was added by amendment during prosecution and, thus, even the original claims submitted as a part of the ’144 application do not recite the precise words “endorsement tag.” Accordingly, the proper inquiry then is whether, after reading the ’144 application, any other disclosure would lead one of ordinary skill to reasonably conclude that the inventor had possession of “endorsement tag.”

Patent Owner asserts the ’144 application’s disclosure of “an executable link, such as a hyperlink,” associated with all of the relevant endorsement functionalities, is just such a disclosure. Accordingly, Patent Owner’s position appears to be that one of ordinary skill, when seeing the disclosure of “an executable link, such as a hyperlink,” associated with all of the relevant endorsement functionalities, would know that such a disclosure is the equivalent of a “endorsement tag,” even though the ’144 application does not recite the term “endorsement tag.” Perhaps even more fundamentally, Patent Owner’s position appears to be that one of ordinary skill, when seeing the disclosure of “an executable link, such as a hyperlink,” would know that such a disclosure is the equivalent of a “tag,” even though the ’144 application does not recite the term “tag.”

We are not persuaded because Patent Owner has not set forth sufficient evidence to persuasively outweigh Petitioner’s position. There is

no question that the '144 application discloses “an executable link, such as a hyperlink,” for example, at steps 58, 64, and 66 of Figure 4, and paragraphs 21, 28, and 30. Patent Owner fails to take the next step, however, and show that one of ordinary skill, when seeing the disclosure of “an executable link, such as a hyperlink,” would know that such a disclosure is the equivalent of a “tag.” As the '114 application does not make such a showing, Patent Owner needed to provide evidence to show persuasively such equivalency so as to outweigh Petitioner’s analysis and evidence. The only other evidence Patent Owner provides in support of its position, however, is certain paragraphs from the Declaration of Dr. Rhyne. We have reviewed those paragraphs, and they only serve to underscore Patent Owner’s assertion that the '144 application provides adequate written description support for “an executable link, such as a hyperlink” (Ex. 2039 ¶¶ 263–271), which is not enough to show possession of “tag.”

At oral argument, Patent Owner asserted that because an inventor is free to be their own lexicographer, we should decide in Patent Owner’s favor. Patent Owner’s assertions are misplaced, because although an inventor certainly is free to be their own lexicographer, such freedom is usually relevant in the context of definitions, i.e., if an inventor explicitly sets forth a definition in the Specification, such a definition controls. Accordingly, if the Specification had specifically set forth a definition that a “tag” meant “an executable link, such as a hyperlink,” the written description requirement would clearly have been met. That, however, is not the case.

Tangentially, Patent Owner may have been asserting that when one of ordinary skill in the art reads one term in the Specification, and knows that

another term not in the Specification is the equivalent of that term, the written description requirement is met. We agree, and yet that is the fundamental reason we are not persuaded by Patent Owner's position. Patent Owner has not shown persuasively, either through argument or evidence, that one of ordinary skill would read "an executable link, such as a hyperlink," and know that "tag" was an equivalent term.

Patent Owner asserts further that the burden is on Petitioner to show lack of written description, and because Petitioner has only provided attorney argument, and no evidence, they cannot meet that burden. We are not persuaded, however, because Petitioner provided the most persuasive evidence of all; that the '114 application does not recite "endorsement tag."

After considering Petitioner's and Patent Owner's positions, as well as their supporting evidence, we determine that, by a preponderance of the evidence, Petitioner has shown that the '114 application does not provide sufficient written description support under 35 U.S.C. § 112, first paragraph, for "endorsement tag," as recited in claims 1, 11, and 14. Claims 8–10, 12, and 23 depend ultimately from independent claim 1.

3. "token"

Claims 2, 3, 7, 13, 15–17, and 29 each recite "token." The '144 application, which issued into the '516 patent, does not recite expressly "token." Petitioner asserts that "token" should be construed as an "executable link, such as a hyperlink," and that "token" must be related to an advertiser linked with advertising content, transmitted from a qualified subscriber to a recipient, and be capable of being executed to produce a signal, as required by independent claim 2. Petitioner asserts that the '144 application does not disclose any such feature with all the aforementioned

functionalities. Pet. 78–80. Patent Owner agrees with Petitioner’s proposed construction of “token,” and asserts that because the ’144 application provides adequate written description support for a hyperlink that includes all of the aforementioned functionalities of an endorsement tag, it must also provide adequate written description support for the claim limitation “token.” PO Resp. 22. In other words, Patent Owner presents the same arguments as set forth above for “endorsement tag.” To that end, our analysis is the same as set forth above for “endorsement tag,” and thus need not be repeated here.

After considering Petitioner’s and Patent Owner’s positions, as well as their supporting evidence, we determine that, by a preponderance of the evidence, Petitioner has shown that the ’114 application does not provide sufficient written description support under 35 U.S.C. § 112, first paragraph, for “endorsement tag,” as recited in claims 2, 3, 7, 13, 15–17, and 29. Claims 4–7, 18, 19, 24, and 25 depend ultimately from independent claim 2.

4. *Conclusion*

After considering Petitioner’s and Patent Owner’s positions, as well as their supporting evidence, we determine that, by a preponderance of the evidence, Petitioner has shown that claims 1–19, 23–25, and 29 are unpatentable under 35 U.S.C. § 112, first paragraph, for failing to provide adequate written description support for the claim terms “endorsement tag” and “token.”

F. *Patent Owner’s Motion to Exclude*

Patent Owner seeks to exclude: (i) Dr. Ratsimor’s resume (Ex. 1032), her research summary (Ex. 1033), and a Departmental webpage for a research project (Ex. 1034), all of which cite the Ratsimor paper with a

November 2003 publication date; (ii) three patents—U.S. Patent Nos. 8,620,736 B2 (Ex. 1025), 8,671,012 B2 (Ex. 1026), and 8,626,608 B2 (Ex. 1035), which cite the Ratsimor paper with a November 2003 date; and (iii) results from a search engine (i.e., Google Scholar) (Ex. 1036), which list the Ratsimor paper with a November 2003 date.

We need not assess the merits of Patent Owner's Motion to Exclude. Petitioner uses the challenged exhibits to support its contention that the Ratsimor paper was published in November 2003. Reply 5. As discussed above, even without Petitioner's supporting evidence regarding the date of the Ratsimor paper, we have determined that the Ratsimor paper is not a printed publication under 35 U.S.C. § 102(b), because the Ratsimor paper was not publicly accessible as of November 2003. Notably, the evidence that Patent Owner seeks to exclude is dated between 2007 and 2014 (*see* Exs. 1025–1026, 1032–1036) and, as such, provides little probative value regarding how an interested and ordinarily skilled artisan would have been able to locate the Ratsimor paper in November 2003. Thus, the evidence that Patent Owner seeks to exclude does not tip the scales in favor of public accessibility of the Ratsimor paper.

Accordingly, Patent Owner's Motion to Exclude certain evidence is dismissed as moot.

III. CONCLUSION

Petitioner has proven, by a preponderance of the evidence, that claims 2–15, 20–23, and 29 of the '516 patent are unpatentable under 35 U.S.C. § 102(b) as anticipated by Paul.

Petitioner, however, has not proven, by a preponderance of the evidence, that claims 1–15, 20–23, and 29 of the '516 patent are unpatentable under 35 U.S.C. § 102(b) as anticipated by the Ratsimor paper.

Petitioner has not proven, by a preponderance of the evidence, that claims 1–27 and 29 of the '516 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over the Ratsimor paper and Paul.

Petitioner has proven, by a preponderance of the evidence, that claims 1–19, 23–25, and 29 of the '516 patent are unpatentable under 35 U.S.C. § 112, first paragraph, for failing to provide adequate written description support for the claim terms “endorsement tag” and “token.”

Patent Owner’s Motion to Exclude is *dismissed*.

IV. ORDER

It is

ORDERED that Petitioner has demonstrated by a preponderance of the evidence that claims 1–25 and 29 of U.S. Patent No. 7,664,516 B2 are unpatentable;

FURTHER ORDERED that Petitioner has not demonstrated by a preponderance of the evidence that claims 26 and 27 of U.S. Patent No. 7,664,516 B2 are unpatentable;

FURTHER ORDERED that Patent Owner’s Motion to Exclude is dismissed; and

FURTHER ORDERED that, because this is a final written decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

CBM2013-00035
Patent 7,664,516 B2

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