Trials@uspto.gov
571-272-7822

Paper 47
Entered: December 17 , 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GROUPON, INC.,
Petitioner,

v.

BLUE CALYPSO, LLC,
Patent Owner.

Case CBM2013-00044
Patent 8,452,646 B2

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

BENOIT, *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 requesting a covered business method patent review of claims 1-13 of U.S. Patent No. 8,452,646 B2 (Ex. 1001; "the '646 patent") pursuant to section 18(a) of the Leahy-Smith America Invents Act ("AIA").[1,2] Paper 1 ("Pet."). Patent Owner, Blue Calypso, LLC, filed a Preliminary Response. Paper 8 ("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. Paper 9 ("Inst. Dec."). The Board instituted trial as to claims 1-13.

Subsequent to institution, Patent Owner filed a Patent Owner Response (Paper 17; "PO Resp."), and Petitioner filed a Reply (Paper 26; "Reply"). Patent Owner also filed a Motion to Amend (Paper 18; "Mot. to Amend") requesting cancellation of claims 1-3 and 10-13. Patent Owner further filed a Motion to Exclude certain evidence (Paper 34; "Mot. to Exclude"), to which Petitioner filed an Opposition (Paper 39; "Pet. Opp."), and, in turn, Patent Owner filed a Reply (Paper 41; "PO Reply"). Pursuant to 35 U.S.C. § 324(a), the Board instituted this trial on January 17, 2014, as

[1] Pub. L. No. 112-29, 125 Stat. 284, 329 (2011).
[2] Paragraph (b) of 35 U.S.C. § 102 was replaced with newly designated § 102(a)(1) when § 3(b)(1) of the AIA took effect on September 16, 2012. Because the application that issued as the '646 patent was filed before that date, we will refer to the pre-AIA version of § 102.

to claims 1-13 of the ’646 patent. An oral hearing was held on September 5, 2014.[3]

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. For the reasons that follow, we determine that Petitioner has not demonstrated by a preponderance of the evidence that claims 4-9 of the ’646 patent are unpatentable; we grant Patent Owner’s Motion to Amend requesting cancellation of claims 1-3 and 10-13; and we dismiss as moot Patent Owner’s Motion to Exclude.

A. Instituted Grounds

The Board instituted this trial as to claims 1-13 of the ’646 patent on the following grounds of unpatentability.

[3] This proceeding, as well as CBM2013-00033, CBM2013-00034, CBM2013-00035, and CBM2013-00046, involve the same parties and similar issues. The oral arguments for all five reviews were merged and conducted at the same time. A transcript of the oral hearing is included in the record as Paper 46 (“Transcript”).

Reference(s)	Basis	Claims
Ratsimor[4]	§ 102(b)	1 and 2
Paul[5]	§ 102(b)	1 and 2
Ratismor and Paul	§ 103(a)	1-5, 10, and 11
Ratsimor, Paul, and Kitaura[6]	§ 103(a)	6-8
Ratsimor, Paul, and Atazky[7]	§ 103(a)	9
Ratsimor, Paul, Hall,[8] and MacEachren[9]	§ 103(a)	12 and 13

Inst. Dec. 41.

B. Related Matters

In compliance with 37 C.F.R. § 42.302(a), Petitioner certifies that it has been sued for infringement of the '646 patent. Pet. 9. The identified related court cases are before the United States District Court for the Eastern District of Texas. Pet. 9; Paper 5, 2.

Petitioner also requested review of the following patents related to the '646 patent—U.S. Patent No. 8,155,679 B2 ("the '679 patent") (Case CBM2013-00033), U.S. Patent No. 8,457,670 B2 ("the '670 patent")

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[4] Ratsimor, Olga, et al., Technical Report TR-CS-03-27 "Intelligent Ad Hoc Marketing Within Hotspot Networks," published November 2003 (Ex. 1006) ("Ratsimor" or "the Ratsimor paper").
[5] U.S. Patent Application Publication No. 2002/0169835 A1 (Ex. 1007) ("Paul").
[4] U.S. Patent Application Publication 2002/0091569 A1 (Ex. 1009) ("Kitaura").
[7] U.S. Patent Application Publication 2007/0121843 A1 (Ex. 1010) ("Atazky").
[8] U.S. Patent Application Publication 2008/0256233 A1 (Ex. 1011) ("Hall").
[9] MacEachren, Alan M., et al., *Geographic Visualization: Designing Manipulable Maps for Exploring Temporally Varying Georeferenced Statistics*, 1998 PROC. IEEE INFO. VISUALIZATION SYMP. 1 (Ex. 1012) ("MacEachren").

(Case CBM2013-00034), U.S. Patent No. 7,664,516 B2 ("the '516 patent") (Case CBM2013-00035), and U.S. Patent No. 8,438,055 B2 ("the '055 patent") (Case CBM2013-00046). The '646 patent claims the benefit of the filing dates of applications that issued as the '516 patent, the '679 patent, and the '055 patent. The specification of the '646 patent includes additional disclosures not part of the '516 patent or the '679 patent. *See*, *e.g.*, Ex. 1001, col. 2, l. 61 – col. 3, l. 48 ("Definitions"), col. 4, l. 25 – col. 7, l. 67, Figs. 1-2.

C. The '646 Patent

The '646 patent relates to a system and method for distribution of advertisements and electronic offers between communication devices. Ex. 1001, Abstract. Figure 1 of the '646 patent is set forth below:

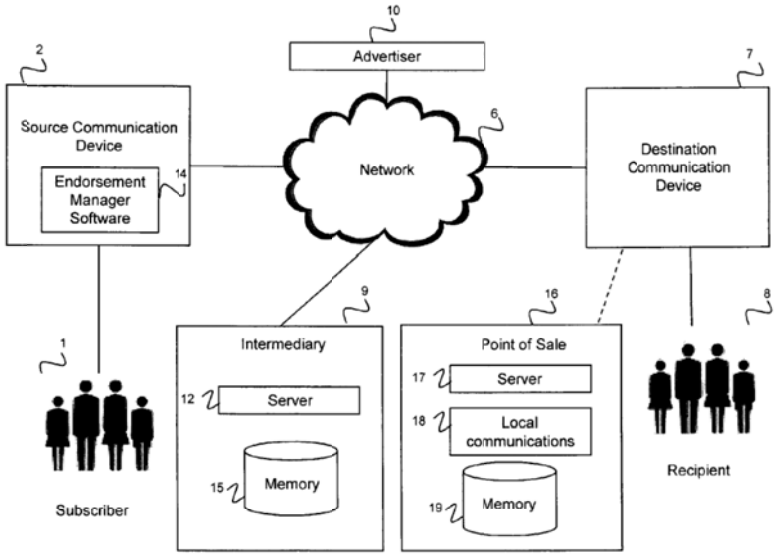

Figure 1

Figure 1 is a diagram for providing advertising between communication devices.

As shown in Figure 1, subscriber 1 possesses source communication device 2 (such as a computer or cell phone) and subscribes to an advertisement incentive program managed by intermediary 9. *Id*. at col. 3, ll. 41-43, col. 4, ll. 25-29. An intermediary may include one or more computer servers implementing an advertising endorsement system. *Id*. at col. 3, ll. 34-36. Advertisements are distributed from advertiser 10 to destination communication device 7 (such as a computer or cell phone), which is in possession of recipient 8. *Id*. at col. 3, ll. 15-17, col. 4, ll. 29-31. Intermediary 9 compares demographic and interest criteria of advertiser 10 to demographic and interest criteria of subscriber 1 and, based on the interest criteria, sends endorsement opportunities from various advertisers to subscriber 1. *Id*. at col. 5, ll. 15-20.

If subscriber 1 elects to endorse an advertisement, advertiser, or advertising campaign, an endorsement tag is transmitted from source communication device 2 of subscriber 1 to destination communication device 7 of recipient 8. *Id*. at col. 5, ll. 21-31. The endorsement tag includes a URL link that, when activated by destination communication device 7, causes an advertisement associated with the endorsement tag to be downloaded to destination communication device 7 from intermediary 9. *Id*. at col. 5, ll. 31-38.

D. Illustrative Claims

Claims 1-4 are illustrative of the claimed subject matter and read as follows:

> 1. In a system comprising a network, a source communication device, a first destination communication

device and an intermediary connected to the network, a method for providing an electronic offer to a first recipient associated with the first destination communication device and for incentivizing a subscriber associated with the source communication device comprising:

receiving, at the intermediary, a first profile including a set of identification requirements related to at least one advertiser of a group of advertisers;

receiving, at the intermediary, a second profile including a set of identification data related to the subscriber;

deriving, by the intermediary, a match condition between the first profile and the second profile;

determining, by the intermediary, if the subscriber is a first qualified subscriber based on the match condition;

transmitting, from the intermediary to the source communication device, a first endorsement tag related to the at least one advertiser of the group of advertisers and linked with advertising content;

transmitting a first content communication between the first source communication device and the first destination communication device;

transmitting the first endorsement tag to the first destination communication device; and,

receiving a first signal, at the intermediary from the first destination communication device, through execution of the first endorsement tag, to transmit the electronic offer.

2. The method of claim 1 further comprising the steps of:

transmitting an incentive program from the intermediary to the source communication device for participation of the first qualified subscriber; and,

incentivizing the first qualified subscriber at the source communication device according to the incentive program.

3. The method of claim 2 further comprising the step of: verifying, by the intermediary, a validity state of the electronic offer.

4. The method of claim 3 wherein the step of verifying, by the intermediary, a validity state of the electronic offer comprises the further steps of:

receiving, at the intermediary, a set of offer attributes;

receiving, at the intermediary, a verification request from the first destination communication device;

comparing, by the intermediary, at least one offer attribute of the set of offer attributes to the verification request to arrive at a set of results;

generating, by the intermediary, a verification signal based on the set of results; and,

transmitting the verification signal from the intermediary to the first destination communication device.

Ex. 1001, col. 15, l. 48 – col. 16, l. 33.

II. ANALYSIS

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 generally are given 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). 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 "incentive program," "incentive," and "incentivizing" in accordance with these principles.

Sole independent claim 1 is directed to a system "for incentivizing a subscriber," and claim 2, which depends from claim 1, recites "incentivizing the first qualified subscriber at the source communication device according to the incentive program." Claims 3 depends directly from claim 2, and claim 4, in turn, depends directly from claim 3.

As recognized by both Petitioner and Patent Owner, the '646 patent sets forth express definitions of the terms "incentive" and "incentive program" under the heading "DEFINITIONS." *See* Ex. 1001, col. 3, ll. 28-31; Pet. 10-11; Prelim. Resp. 19, 24; *see generally* PO Resp. 10-11; Reply 1-2. Based on the express definitions, the Board, in the Decision to Institute, construed "incentive" as "a reward provided to a subscriber based on an endorsement" (Ex. 1001, col. 3, ll. 28-29) and "incentive program" as "a set of rules governing an incentive distribution" (*Id*. at col. 3, ll. 30-31). Inst. Dec. 8-9. Further, based on the express definition of "incentive" and

the ordinary meaning of "incentivize,"[10] the Board construed "incentivize" as "to offer a reward provided to a subscriber based on an endorsement." *Id.*

Neither party challenges these constructions. *See generally* PO Resp. 10-11; Reply 1-2. Having considered whether the constructions set forth in the Decision to Institute should be changed in light of evidence introduction during trial, we are not persuaded any modification is necessary. Therefore, we maintain the construction of "incentive" as "a reward provided to a subscriber based on an endorsement"; "incentive program" as "a set of rules governing an incentive distribution"; and "incentivize" as "to offer a reward provided to a subscriber based on an endorsement."

Further, we find "incentivizing" and "incentive program," when read in light of the specification, each suggests a financial product or service. The '646 patent repeatedly discloses "incentive," "incentive program," and "incentivizing" in a financial context. For example, the '646 patent discloses cash incentives are provided on debit cards or cash distributions. Ex. 1001, col. 2, ll. 25-26, col. 6, ll. 51-53. In another example, incentives are disclosed as "payments," "payouts," "cash," and "cash-like." *Id*. at col. 2, l. 48, col. 6, ll. 41-61, col. 7, ll. 51-54. The '646 patent further indicates an "incentive program may pay cash incentives, incentivize communication fees, offer product discounts, generate 'reward points,' or provide product or service credit." *Id*. at col. 6, ll. 48-51. These examples

[10] AMERICAN HERITAGE DICTIONARY 912 (3d ed. 1992) (defining "incentivize" as "[t]o offer incentives or an incentive to; motivate").

of incentive programs are financial—cash incentives and communication fees are monetary; product discounts, product credit, and service credit reduce the monetary cost of a financial transaction; and reward points are a form of currency. Accordingly, we determine "incentive," "incentive program," and "incentivize" are financial in nature.

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 who 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.

1. Financial Product or Service

Petitioner contends that the '646 patent is a covered business method patent because claim 2 recites "incentivizing the first qualified subscriber at the source communication device according to the incentive program" and, accordingly, is directed to activities that are financial in nature. Pet. 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). As set forth above, we determine "incentivizing" and "incentive program," which are recited in claim 2, are financial in nature.

Accordingly, the subject matter of claim 2 performs data processing or other operations used in the practice, administration, or management of a financial product or service. *See* 37 C.F.R. § 42.304(a).

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, 48,764 (Aug. 14, 2012).

Petitioner indicates that the '646 patent is not directed to a technological invention because claim 2 recites known components and is directed toward a business problem, not a technical solution. Pet. 7-8. We

agree. For example, claim 2 requires transmitting to a source communication device. Thus, claim 2 recites the use of a communication device, which is a known technology, to perform a method, which does not render claim 2 a technological invention. *See* 77 Fed. Reg. at 48,764, item (b).

Accordingly, we determine that claim 2 is not directed toward a technological invention. We, therefore, conclude that the '646 patent is a covered business method patent.

C. Patent Owner's Motion to Amend

Patent Owner's Motion to Amend (Paper 18) is before us for consideration. In the motion, Patent Owner requests cancellation of claims 1-3 and 10-13 of the '646 patent. The cancellation of these claims is not based on any contingency. There is no indication, for example, that claims 1-3 and 10-13 should be cancelled only if the claims are determined unpatentable. Rather, the Motion to Amend leaves no doubt that Patent Owner unequivocally requests cancellation of claims 1-3 and 10-13.

For these reasons, we grant Patent Owner's request to cancel claims 1-3 and 10-13 of the '646 patent. Because Patent Owner requested cancellation of claims 1-3 and 10-13, not based on any contingency, Patent Owner has waived any issues with respect to claims 1-3 and 10-13, and, therefore, we need not address the patentability of those claims.

Accordingly, we need consider only the following grounds of unpatentability: whether claims 4 and 5 would have been obvious over the Ratsimor paper and Paul; whether claims 6-8 would have been obvious over

the Ratsimor paper, Paul, and Kitaura; and whether claim 9 would have been obvious over the Ratsimor paper, Paul, Hall, and MacEachren.

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

Because each of the remaining grounds of unpatentability relies on the Ratsimor paper, the dispositive issue for determining whether Petitioner has shown claims 4-9 are unpatentable is whether the Ratsimor paper is prior art to those claims. 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 '646 patent. *See* Pet. 15; Ex. 1008 ¶¶ 2, 16; *see also* Ex. 1001, col. 1, ll. 8-15 (claiming priority to a provisional application filed December 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). *See* 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.

Pet. 15; Ex. 1008 ¶ 2. He 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.

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 claims of the '646 patent. PO Resp. 6-7, 17-25. 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. 19-20.

Having reviewed the parties' arguments and supporting evidence, we do not find sufficient evidence that the Ratsimor paper was accessible publicly and, therefore, we conclude the Ratsimor paper is not 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) (2011). "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 at i. The publications list also includes a uniform resource locator (http://www.csee.umbc.edu/~oratsi2/publications). *Id.* 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 viewable and downloadable 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. 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, her intent to publicize the Ratsimor paper, and her 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. *See, e.g.*, Ex. 1006 at 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. *See* Ex. 1006 at 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 (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 in *Cronyn* 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 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. 1042). 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 at 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.*, slip op. 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.*, slip op. 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 '646 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. *See* Reply 5.

2. Whether the Ratsimor Paper Was Publicly Accessible in November 2005

Petitioner first argues in its Reply that the Ratsimor paper was "publicly available on the Internet no later than November 2005" and so is prior art for claims 4-9 of the '646 patent "because each of the claims of the '646 patent have a priority date after" November 2005. Reply 5-6. For this assertion, Petitioner relies on the indication that Dr. Ratsimor's publication list was last updated as of November 2005. Reply 5. As explained previously, however, we do not need to reach the date of when the Ratsimor paper was available on the Department's webserver because 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. Therefore, the Ratsimor paper was not accessible publicly on the Department's webserver in a manner sufficient to qualify as a printed publication.

3. 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 '646 patent. Therefore, Petitioner may not rely upon the Ratsimor paper for its asserted grounds of patentability under 35 U.S.C. § 103(a). Accordingly, we conclude that Petitioner has not demonstrated that (i) claims 4 and 5 would have been obvious over the Ratsimor paper and Paul, (ii) claims 6-8 would have been obvious over the Ratsimor paper, Paul, and Kitaura, or (iii) claim 9 would have been obvious over the Ratsimor paper, Paul, Hall, and MacEachren.

E. 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. 8,636,608 B2 (Ex. 1035), 8,620,736 B2 (Ex. 1039), and 8,671,012 B2 (Ex. 1040), 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. 1032-1036, 1039, 1040) 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 not proven, by a preponderance of the evidence, that claims 4-9 of '646 patent are unpatentable under 35 U.S.C. § 103(a).

Patent Owner's Motion to Amend requesting cancellation of claims 1-3 and 10-13 is *granted*. Patent Owner's Motion to Exclude is *dismissed* as moot.

IV. ORDER

Accordingly, it is hereby:

ORDERED that Petitioner has not demonstrated by a preponderance of the evidence that claims 4-9 of U.S. Patent No. 8,452,646 B2 are unpatentable;

FURTHER ORDERED that Patent Owner's Motion to Amend requesting cancellation of claims 1-3 and 10-13 is granted;

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

FURTHER ORDERED that, because this is a final written decision, the 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.

PETITIONER:

Jeanne M. Gills
CBM_Groupon@foley.com

Troy D. Smith
tdsmith@foley.com

PATENT OWNER:

John C. Phillips
phillips@fr.com

Carl E. Bruce
bruce@fr.com

David B. Conrad
conrad@fr.com

Thomas H. Reger II
CBM2013-00044@fr.com