

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GROUPON, INC.,  
Petitioner,

v.

BLUE CALYPSO, LLC,  
Patent Owner.

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Case CBM2013-00046  
Patent 8,438,055 B2

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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 August 16, 2013, requesting a covered business method patent review of U.S. Patent No. 8,438,055 B2 (“the ’055 patent”) pursuant to § 18(a) of the Leahy-Smith

America Invents Act (“AIA”).<sup>1</sup> Paper 1 (“Pet.”). Blue Calypso, LLC (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). Taking into account Patent Owner’s Preliminary Response and on the record at the time, 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 January 17, 2014, as to claims 1, 4–11, and 14 of the ’055 patent on the following grounds of unpatentability.

<b>Reference(s)</b>	<b>Basis</b>	<b>Claims Challenged</b>
The Ratsimor paper <sup>2</sup>	§ 102(b)	1, 4–7, and 14
Paul <sup>3</sup>	§ 102(b)	1, 4–6, 10, and 14
The Ratsimor paper and Paul	§ 103(a)	1, 4–7, 10, and 14
The Ratsimor paper, Paul, and Atazky <sup>4</sup>	§ 103(a)	8 and 11
The Ratsimor paper, McLean <sup>5</sup> , and Atazky	§ 103(a)	1, 4–9, 11, and 14

Paper 9 (“Dec.”).

Subsequent to institution, Patent Owner filed a Patent Owner Response (Paper 18; “PO Resp.”), and Petitioner filed a Reply (Paper 24;

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

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

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

<sup>4</sup> U.S. Patent Application Publication 2007/0121843 A1 (Ex. 1010) (“Atazky”).

<sup>5</sup> U.S. Patent Application Publication 2007/0207780 A1 (Ex. 1009) (“McLean”).

“Reply”). Patent Owner also filed a Motion to Exclude (Paper 33; “Mot.”), to which Petitioner filed an Opposition (Paper 38; “Pet. Opp.”), and Patent Owner filed a Reply (Paper 40; “PO Reply”).

An oral hearing was held on September 5, 2014.<sup>6</sup>

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, 4–6, 10, and 14 of the ’055 patent are *unpatentable*.

Petitioner has not proven, by a preponderance of the evidence, that claims 7–9 and 11 of the ’055 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 ’055 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 ’055 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 7,664,516 B2 (“the ’516 patent”) (Case CBM2013-00035), and U.S. Patent 8,452,646 B2 (“the ’646 patent”) (Case CBM2013-00044). The ’055 patent, ’679 patent, ’670 patent, and

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<sup>6</sup> A transcript of the oral hearing is included in the record as Paper 46 (“Transcript”). This proceeding, as well as CBM2013-00033, CBM2013-00034, CBM2013-00035, and CBM2013-00044, involve the same parties and similar issues. The oral arguments for the five reviews were merged and conducted at the same time.

'646 patent all 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 '055 Patent*

The '055 patent discloses systems and methods for distribution of advertisements between communication devices. Ex. 1001, Abstract.

Figure 1 of the '055 patent is set forth below:

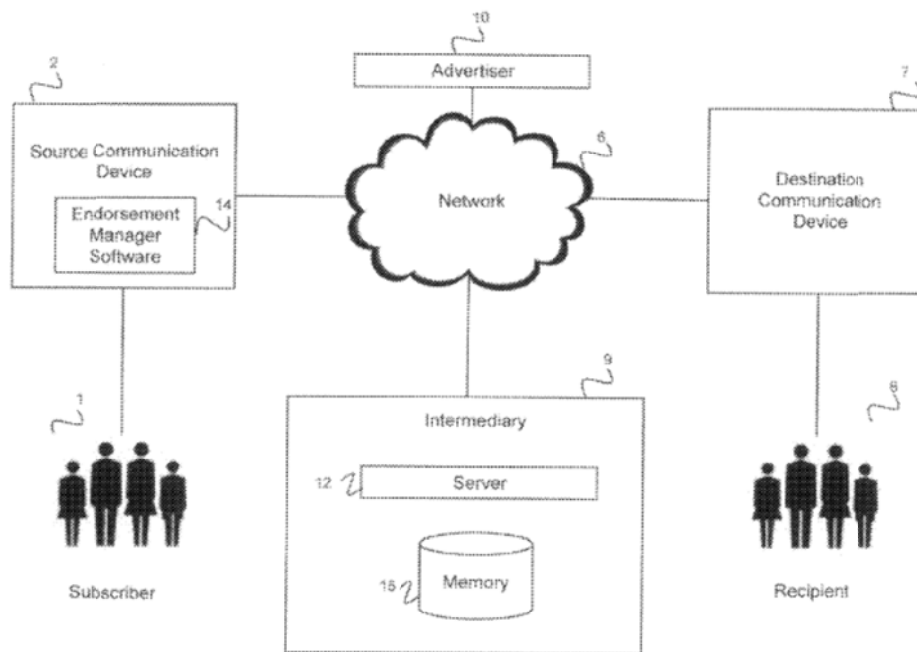


Figure 1

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

As shown above in Figure 1, the '055 patent discloses transmission of an endorsement tag between a source communication device and a destination communication device over a network. Ex. 1001, 1:56–58. The endorsement tag includes a serialized URL link that, when activated, causes an advertisement to be sent from a third-party intermediary to the destination

communication device. Ex. 1001, 1:58–62. According to the '055 patent, the intermediary functions, among other things, to identify which advertisement to send by virtue of decoding a serialized URL link and associating that link with a stored advertisement. Ex. 1001, 1:62–65.

The '055 patent discloses a “bi-directional” process between a subscriber and an advertiser. Ex. 1001, 1:66–67. The bi-directional process allows subscribers to choose or “endorse” certain advertisers with which they wish to associate. Ex. 1001, 1:67–2:3. The bi-directional process also allows advertisers to choose which subscribers to use by virtue of a review of related demographic information of each subscriber and pre-qualification of acceptable candidates. Ex. 1001, 2:3–6. Pre-qualification of one subscriber allows the advertiser to target advertisements to a related group of potential customers because a qualified subscriber’s contacts presumably share some or all of the same demographic features. Ex. 1001, 2:9–13.

The '055 patent discloses enabling advertisers to reach targeted audiences by contact with mobile communications devices. Ex. 1001, 2:21–22. Specifically, qualified subscribers are encouraged to send communications to their contacts, and the contacts who receive the communication are encouraged to accept the communication and related advertisements, because the communication is identified as being initiated by a known contact. Ex. 1001, 2:23–25. Subscribers and recipients are provided incentives to participate, such as cash incentives provided on debit cards or cash distributions. Ex. 1001, 2:27–29.

*C. Illustrative Claim*

Petitioner challenges claims 1, 4–11, and 14 of the '055 patent. Claim 1, the only independent claim, is illustrative of the claims at issue and reads 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 advertising content to a first recipient associated with the first destination communication device and for incentivizing a subscriber associated with the source communication device comprising:

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

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

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

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

conditioning, at the intermediary, a set of endorsement opportunities on the match condition;

transmitting a[n] incentive program to the first qualified subscriber, at the source communication device, for each endorsement opportunity of the set of endorsement opportunities;

communicating the set of endorsement opportunities to the qualified subscriber at the source communication device;

receiving, at the intermediary, a selection of at least one endorsement opportunity from the set of endorsement opportunities from the qualified subscriber;

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

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

transmitting the first endorsement tag from the source communication device to the destination communication device;

receiving, at the intermediary, a signal from the destination communication device, through execution of the first endorsement tag, to transmit the advertising content;

transmitting the advertising content to the destination communication device; and,

incentivizing the first qualified subscriber according to the incentive program.

## 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 whether to institute a review, we determine the meaning of the claims for purposes of this decision. 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 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 below in accordance with these principles.

*“incentive” and “incentive program”*

Independent claim 1 recites “incentivizing the first qualified subscriber according to the incentive program.” Petitioner contends that the express definitions of terms set forth in the “Definitions” section of the ’055 patent are the proper constructions of those terms. Pet. 10. We agree. Accordingly, we accept those definitions as proper constructions of “incentive” and “incentive program.”

Furthermore, through their assertions concerning standing, Petitioner asserts that “incentive” and “incentive program” are financial in nature. We agree. Pet. 6–7. The ’055 patent repeatedly, and almost exclusively, discloses “incentive” and “incentive program” in a financial context. For example, the ’055 patent discloses that cash incentives are provided on debit cards or as cash distributions. Ex. 1001, 2:28–29. In another example, incentives are disclosed as “payments,” “payouts,” and “distributions.” Ex. 1001, 2:51, 6:34–45, 7:31–34, 8:3–6. In a further example, incentive programs are disclosed as having financial budgets and accounts that are debited until depletion. Ex. 1001, 6:41–45, 7:18–20, 8:50–56. Accordingly, we construe “incentive” and “incentive program” as being 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 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 ’055 patent.

*1. Financial Product or Service*

Petitioner contends that the ’055 patent is a covered business method patent, because the claimed subject matter is directed to providing incentives, which are financial in nature. Pet. 6–7. 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 1 recites “incentivizing the first qualified subscriber according to the incentive program.” As set forth above, we construe “incentive” and “incentive program” as being financial in nature. Accordingly, we agree with Petitioner that the subject matter of independent claim 1 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 '055 patent is not directed to a technological invention, because independent claim 1 recites known components and is directed toward a business problem, not a technical solution. Pet. 7–8. We agree. Accordingly, we determine that independent claim 1 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, 4–7, and 14 are unpatentable under 35 U.S.C. § 102(b) as anticipated by the Ratsimor paper; claims 1, 4–7, 10, and 14 are unpatentable under 35 U.S.C. § 103(a) as obvious over the Ratsimor paper and Paul; claims 8 and 11 are unpatentable under 35 U.S.C. § 103(a) as obvious over the Ratsimor paper, Paul, and Atazky; and claims 1, 4–9, 11, and 14 are unpatentable under 35 U.S.C. § 103(a) as obvious over the Ratsimor paper, McLean, and Atazky. Pet. 15–27, 40–74. 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 '055 patent. Pet. 2, 15; Ex. 1008 ¶¶ 2, 11; *see also* Ex. 1001, 1:8–10 (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). 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, 11.

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 '055 patent. PO Resp. 6–7, 14–23. 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. 17–18.

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 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) (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, 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, 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. 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 (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 3–4 (citing Ex. 1038). 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 '055 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. 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 1, 4-11, and 14 of the '055 patent because claims 1, 4-11, and 14 of the '055 patent have a priority date after November 2005. Reply 5. For this assertion, Petitioner relies on the indication that Dr. Ratsimor's publication list was last updated as of November 2005. 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 publicly accessible 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 '055 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, 4–7, and 14 are unpatentable under 35 U.S.C. § 102(b) as anticipated by the Ratsimor paper; claims 1, 4–7, 10, and 14 are unpatentable under 35 U.S.C. § 103(a) as obvious over the Ratsimor paper and Paul; claims 8 and 11 are unpatentable under 35 U.S.C. § 103(a) as obvious over the Ratsimor paper, Paul, and Atazky; or that claims 1, 4–9, 11, and 14 are unpatentable under 35 U.S.C. § 103(a) as obvious over the Ratsimor paper, McLean, and Atazky.

D. *Asserted Ground of Anticipation by Paul*

Petitioner asserts that claims 1, 4–6, 10, and 14 of the '055 patent are unpatentable under 35 U.S.C. § 102(b) as anticipated by Paul. Pet. 28–40; Reply 8–10.

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 1, 4–6, 10, and 14 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Paul. Pet. 28–40; Reply 8–10. 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. 28–40 (citing Ex. 1008). Patent Owner disagrees with Petitioner’s assertions and relies on testimony by Vernon Thomas Rhyne, Ph.D. PO Resp. 41–46 (citing Ex. 2039).

We find Paul discloses each limitation of independent claim 1 as arranged in the claims. For example, independent claim 1 recites a method for providing an advertisement from an advertiser to a first recipient associated with a first destination communication device, and also incentivizing the first 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 packets) to one or more friends, as a part of a “refer a friend” advertising campaign. Ex. 1007 ¶ 102. The “refer a friend” campaign provides a coupon to the member if the member is successful in generating or referring a friend to the sponsor. Ex. 1007 ¶ 101. Paul discloses the “refer a friend” advertising campaign can increase member activity “by offering an economic incentive.” Ex. 1007 ¶ 102. Such coupons and incentives are tracked using referral data packets, which not only identify which member is actively recruiting friends or new members, but also identifies the e-mail campaign for “refer a friend.” Ex. 1007 ¶ 102.

Petitioner sets forth a similar analysis for claims 4–6, 10, and 14. We have reviewed the evidence presented by Petitioner regarding Paul’s disclosure of the further limitations recited in dependent claims 4–6, 10, and 14. We find that Paul discloses each limitation of claims 4–6, 10, and 14 as arranged in the claims.

*i. Patent Owner’s Contentions*

Patent Owner asserts that Petitioner cannot show anticipation of independent claim 1 by a preponderance of the evidence, because, in order to meet the following limitations of independent claim 1, disparate methods of Paul’s e-mail communication system must be combined:

conditioning, at the intermediary, a set of endorsement opportunities on the match condition;

transmitting a[n] incentive program to the first qualified subscriber, at the source communication device, for each endorsement opportunity of the set of endorsement opportunities;

communicating the set of endorsement opportunities to the qualified subscriber at the source communication device;  
receiving, at the intermediary, a selection of at least one endorsement opportunity from the set of endorsement opportunities from the qualified subscriber.

Thus, according to Patent Owner, Paul does not disclose all elements as arranged in the claim. PO Resp. 42–46.

Specifically, Patent Owner asserts, with support from Dr. Rhyne’s testimony (Ex. 2039 ¶¶ 95–101), 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.<sup>7</sup> Cf. Transcript 67:9 – 68:11.

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<sup>7</sup> 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.

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 ¶ 71. 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 ¶ 71 (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. 2039 ¶¶ 95, 101. 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 ¶¶ 103–125 (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 that are unrelated to each other. Rather, we find the campaigns are tool options to be used together, “without any need for picking, choosing, and combination various disclosures not directly related to each other by the teachings of the cited reference,” to anticipate the challenged claims of the ’055 patent. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972); *see Net MoneyIN*, 545 F.3d 1371.

Patent Owner asserts that Paul does not disclose (1) a “qualified subscriber” that (2) sends the intermediary a selection of an endorsement opportunity as required by independent claim 1. We are not persuaded by Patent Owner’s assertions. Paul discloses an Internet-based e-mail communications system that sends personalized e-mail messages to certain members based on demographics. Ex. 1007 ¶ 51. These members correspond properly to the recited “qualified subscriber” determined based on a match condition. 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 embedded hyperlink corresponds to the recited endorsement opportunity. The member then sends the received e-

mail message (with the embedded hyperlink and referral data packets) to one or more friends, as a part of a “refer a friend” advertising campaign.

Ex. 1007 ¶ 102. The “refer a friend” campaign provides a coupon to the member if the member is successful in generating or referring a friend to the sponsor. Ex. 1007 ¶ 101. Such coupons and incentives are tracked using referral data packets, which not only identify which member is actively recruiting friends or new members, but also identifies the e-mail campaign for “refer a friend.” Ex. 1007 ¶ 102. The entity at the campaign that tracks the referral data packets sent with the endorsement opportunity corresponds to the recited intermediary.

#### 4. *Conclusion*

For the foregoing reasons, we find that Petitioner has proven, by a preponderance of the evidence, that claims 1, 4–6, 10, and 14 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Paul.

#### *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. 8,620,736 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 1, 4–6, 10, and 14 of the '055 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, 4–7, and 14 of the '055 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, 4–7, 10, and 14 of the '055 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over the Ratsimor paper and Paul.

Petitioner has not proven, by a preponderance of the evidence, that claims 8 and 11 of the '055 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over the Ratsimor paper, Paul, and Atazky.

Petitioner has not proven, by a preponderance of the evidence, that claims 1, 4–9, 11, and 14 of the '055 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over the Ratsimor paper, McLean, and Atazky.

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, 4–6, 10, and 14 of U.S. Patent No. 8,438,055 B2 are unpatentable;

FURTHER ORDERED that Petitioner has not demonstrated by a preponderance of the evidence that claims 7–9 and 11 of U.S. Patent No. 8,438,055 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.

CBM2013-00046  
Patent 8,438,055 B2

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