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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE, INC.,
Petitioner,

v.

MICHAEL MEIRESONNE,
Patent Owner.

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Case IPR2014-01188
Patent 8,156,096 B2

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Before JUSTIN T. ARBES, GLENN J. PERRY, and TINA E. HULSE, *Administrative Patent Judges.*

PERRY, *Administrative Patent Judge.*

# FINAL WRITTEN DECISION
*Inter Partes* Review
*35 U.S.C. § 318(a) and 37 C.F.R. § 42.73*

# I. INTRODUCTION

In this *inter partes* review trial, instituted pursuant to 35 U.S.C. § 314, Petitioner Google, Inc. ("Google") challenges the patentability of claims 16, 17, 19, and 20 ("the challenged claims") of U.S. Patent No. 8,156,096 B2 (Ex. 1001, "the '096 patent"), owned by Michael Meiresonne ("Meiresonne"). This Final Written Decision, issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73, addresses issues and arguments raised during trial. For the reasons discussed below, we determine that Google has met its burden to prove, by a preponderance of the evidence, that claims 16, 17, 19, and 20 of the '096 patent are unpatentable under 35 U.S.C. § 103(a) based on the combined teachings of Hill and Finseth.

## *A. Procedural History*

On July 18, 2014, Google filed a Petition (Paper 1, "Pet.") requesting *inter partes* review of claims 16, 17, 19, and 20 of the '096 patent. Meiresonne filed a Patent Owner's Preliminary Response. Paper 6. In a January 22, 2015 Decision on Institution of *Inter Partes* Review (Paper 9, "Dec."), we instituted trial on claims 16, 17, 19, and 20 of the '096 patent on the ground of obviousness based on Hill[1] and Finseth.[2]

After institution, Meiresonne filed a Response to the Petition (Paper 21, "Resp.") and Google replied (Paper 26, "Reply"). Meiresonne moved to exclude Exhibit 1019 (Paper 28, "Meiresonne Mot."); Google opposed (Paper 33, "Google Oppos."); and Meiresonne replied (Paper 34). Google moved to exclude Exhibits 2004, 2005, 2009, 2010, 2015, 2016, 2018, and

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[1] "World Wide Web Searching for Dummies, 2d Edition" by Brad Hill, IDG Books Worldwide" (1997) ("Hill") (Exhibit 1006).
[2] U.S. Patent 6,271,840 B1 – Finseth et al. ("Finseth") (Exhibit 1007).

2019, and portions of Exhibit 2013 (Paper 29, "Google Mot."); Meiresonne opposed (Paper 32, "Meiresonne Oppos."); and Google replied (Paper 35). We heard oral argument on October 7, 2014. Paper 37 ("Tr.").

### *B. Related Proceedings*

Meiresonne indicates that the '096 patent is asserted in *Industrial Quick Search, Inc. v. Google, Inc.*, Case No. 1:13-cv-00770-JTN, filed on July 17, 2013 in the Western District of Michigan. Paper 5, 1.

## II. THE '096 PATENT (Ex. 1001)

### *A. Described Invention*

The '096 patent, titled "Supplier Identification and Locator System and Method," issued on April 10, 2012, from U.S. Patent Application No. 13/241,554, filed September 23, 2011. Ex. 1001. It sought to address a need for a directory website "to include numerous links to a variety of goods and services suppliers related to a particular topic while providing easy and quick navigation to and from any number of supplier Web sites so that the user can find out more detailed information than that which is provided by the directory." *Id.* at 2:46–52. For example, a user who has carried out a search for "widgets" may locate and use a "key word displaying web page" as shown in Figure 2 of the '096 patent, reproduced below.

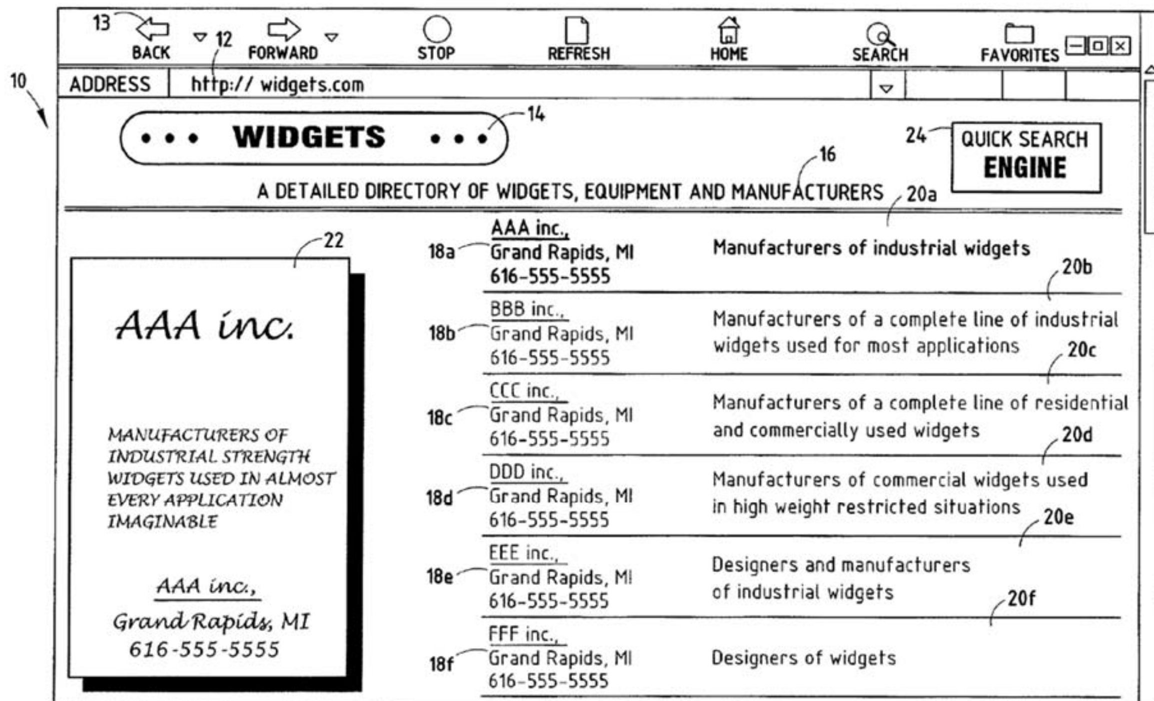



FIG. 2

Figure 2 shows an abbreviated directory page for widgets, a hypothetical good, according to an embodiment of the invention. Links (e.g., 18a, 18b, etc.) to search results (e.g., "AAA, Inc.") are listed vertically. "Descriptive portions" (e.g., 20a, 20b, etc.) corresponding to those links are displayed adjacent to corresponding links. A "rollover viewing area" (22) displays an image of a web page corresponding to a subject matter link when the user rolls over (i.e., mouses over) a link or rolls over an associated descriptive portion. The '096 patent Specification describes rollover viewing area 22 as follows:

> [W]hen a user's cursor is located over such a link, prior to activation of the link, the window 22, which can be any suitable size and may or may not have a border, displays more detailed information regarding the specific supplier of the goods or services of the directory, including the supplier's logo, without the user having to activate the link

> and wait for a new internet page to load into their internet browser.

*Id*. at 5:37–44. "[M]ore than one rollover window 22 may be utilized such that a rollover window is readily viewable whenever the user's cursor is placed over any of the links." *Id.* at 5:53–56.

### *B. Illustrative Claim*

Of the challenged claims, claims 16 and 19 are independent. Claim 17 depends from claim 16 and claim 20 depends from claim 19. Claim 19 is illustrative and is reproduced below.

> 19. A computer system including a server comprising:
>
> at least one web site stored on the server and accessible by a user via the Internet, wherein the web site comprises:
>
> a home page on the server accessible by the user using a computer via the Internet wherein the home page comprises an input receiving area and wherein a user inputs keyword search term information into the input receiving area;
>
> a key word results displaying web page that comprises:
>
> a listing of a plurality of related subject matter links to web sites that are also related to the key word search term information inputted into the input receiving area;
>
> a plurality of descriptive portions, wherein each descriptive portion is an associated descriptive portion that is adjacent to and associated by the user with an associated related subject matter link, which is one of the plurality of related subject matter links; and
>
> a rollover viewing area that individually displays information corresponding to more than one of the related subject matter links in the same rollover viewing area when the user's cursor is at least substantially over any of the links, at least substantially over a link's descriptive portion, or substantially adjacent the corresponding descriptive portion and wherein the rollover

> viewing area is located substantially adjacent to the plurality of related subject matter links.

Claim 16 is substantially the same as claim 19, but requires the listing of links to be "vertical" and does not include the limitation directed to a "home page."

## III. CLAIM CONSTRUCTION

We analyzed each claim term in light of its broadest reasonable interpretation, as understood by one of ordinary skill in the art and as consistent with the Specification of the '096 patent. 37 C.F.R. § 42.100(b); *See In re Cuozzo Speed Techs., LLC*, 778 F.3d 1271, 1281–82 (Fed. Cir. 2015). We construed the terms "keyword results displaying web page" and "in the same rollover viewing area" in the Decision on Institution. *See* Dec. 6–7.

During the course of the trial, neither party asked us to modify our constructions or construe any other claim terms. We see no reason to alter the constructions of these claim terms as set forth in the Decision on Institution, and we incorporate our previous analysis for purposes of this Decision. For the reasons set forth in the Decision on Institution, we interpret certain claim terms of the '096 patent as follows:

### *A. "keyword results displaying web page"*

The term "keyword results displaying web page" appears in all of the claims at issue. We construe the term "keyword results displaying web page" as a web page that displays search results—gathered information relating to one or more search term(s) (key words) input by a user to a search engine. This claim term does not in and of itself require links to web pages found in the search. Nor does it require that an input form for receiving the

key words appear on the keyword results displaying web page itself.

The challenged claims themselves impose additional requirements on the "keyword results displaying web page," including: 1) subject matter links to web sites, 2) descriptive portions, and 3) a rollover viewing area. *See* Claim 19.

### *B. "in the same rollover viewing area"*

The term "in the same rollover viewing area" appears in all of the claims at issue.

The claim language requires that for a "keyword results displaying web page" including the "rollover viewing area," images resulting from rollovers are presented in the *same* rollover viewing area. The '096 patent Specification does not specify that the rollover area must be rigidly fixed. In fact, it describes the possibility of multiple rollover windows. Ex. 1001, 5:53–56. The broadest reasonable construction allows for some movement of the rollover viewing area to be accommodated by the claim language.

## IV. MEIRESONNE MOTION TO EXCLUDE EVIDENCE

Meiresonne moves under Federal Rules of Evidence 402 and 403 to exclude a source code appendix to Finseth and all testimony and argument (Meiresonne Mot. 6–8) based on the source code because it is not prior art. Petitioner and Petitioner's expert, Benjamin B. Bederson, Ph.D., rely on Exhibit 1019, which are excerpts of the file history of Finseth including the source code, referred to in Finseth as "Exhibit 2." *See, e.g.*, Pet. 24, 28; Ex. 1011 ¶ 54; Ex. 1020 ¶ 18.

Meiresonne argues that: 1) the source code was not explicitly incorporated by reference into the Finseth application (Meiresonne Mot. 1); and 2) the source code was not submitted in proper source code appendix

form in accordance with USPTO rules then in effect, which required a microfiche appendix, as set forth in the Manual of Patent Examining Procedure (7th ed., July 1998). *Id.* (citing Ex. 2002).

Google opposes, arguing that the original Examiner recognized the source code as part of the Finseth patent, and the Finseth patent properly incorporated the source code appendix. Google Oppos. 1–5. According to Google, the Examiner did not object to the source code appendix as being improper or require that the source code be placed on a microfiche. *Id.* at 1.

Meiresonne argues that we should exclude portions of Dr. Bederson's Declaration (Ex. 1011) that rely upon the source code. Dr. Bederson's references to the source code are examples that we do not rely upon in reaching our decision. Nor do we rely upon Exhibit 1019 itself. Meiresonne's Motion to Exclude is therefore dismissed as moot.

## V. GOOGLE MOTION TO EXCLUDE EVIDENCE

Google moves to exclude evidence as summarized in the table below. Google Mot.

| Exhibit | Basis | Response Page |
|---|---|---|
| Ex. 2004 | F.R.E. 106, 401–403, 801, 802, 901; Ex. 1024 at 4–7; Ex. 1025 at 5–7) | 21, 24–25 |
| Ex. 2005 | F.R.E. 106, 401–03, 801–02, 901 (Ex. 1024 at 4–7; Ex. 1025 at 5–7) pp. 21 | 21 |
| Ex. 2009 | F.R.E. 106, 401–03, 801–02, 901 (Ex. 1024 at 4–7; Ex. 1025 at 5–7) | 21 |

| Exhibit | Basis | Response Page |
|---|---|---|
| Ex. 2010 | F.R.E. 106, 401–03, 801–02, 901 (Ex. 1024 at 4–7; Ex. 1025 at 5–7) | 21 |
| Ex. 2013 | F.R.E. 401–03, 702–03 (Ex. 1025 at 1–2) | 18–23 |
| Ex. 2015 | F.R.E. 401–03, 801–02, 901 (Ex. 1025 at 2–5) | 22 |
| Ex. 2016 | F.R.E. 401–03, 801–02, 901 (Ex. 1025 at 2–5) | 22 |
| Ex. 2018 | F.R.E. 401–03, 901 (Ex. 1025 at 5–7) | 23 |
| Ex. 2019 | F.R.E. 401–03, 901 (Ex. 1025 at 2–5) | 23 |

Meiresonne relies upon Exhibits 2004, 2005, 2009, and 2010 to establish Google customer satisfaction with an "Instant Previews" feature used by Google. Resp. 21–22. Instant Previews provided a clickable magnifying glass icon by which a user could view a web page image without actually visiting the web page. *Id.* According to Meiresonne, this evidence is relevant as objective evidence of nonobviousness.

Google argues that customer satisfaction is not well-recognized as an objective indicator of nonobviousness. Reply 13.

Nevertheless, such evidence is relevant if tied to the challenged claims. We therefore do not exclude the evidence. Rather, we admit it and weigh it appropriately. Performing an obviousness analysis requires that we consider objective evidence related to obviousness and we do so. This is not a jury trial. There is no danger in this case of "confusing the issues, . . . undue delay, [and] wasting time," as provided for in F.R.E. 403.

Google argues that we should exclude Exhibits 2005 and 2009 as inadmissible hearsay under F.R.E. 801–802. Google Mot. 3. Exhibit 2005 is a print of a web page from "Mashable," authored by Ben Parr and including quotes from Google employee Ben Gomes, and titled "Google Now Lets You Preview Search Results Before You Click Them." Exhibit 2009 appears to be a print of a web page from the Forbes website including an article from "Forbes," authored by Quentin Hardy and including quotes from Mr. Gomes, and titled "Google Fasterer!" Google argues that both exhibits are written assertions made by declarants not testifying in this proceeding, and that Meiresonne relies on both exhibits for the truth of the matter asserted in the statements contained in those exhibits. *See* Google Mot. 2–3 (citing Resp. 21 ("Google boasted about these test results to the tech media.")).

Exhibits 2005 and 2009 are articles that include statements from Mr. Gomes, a Google employee. Thus, the Gomes statements are potentially hearsay within hearsay. *See* F.R.E. 805. Meiresonne correctly notes, however, that the Gomes statements are made by a Google employee offered *against* Google. Meiresonne Oppos. 4–5. Therefore, the Gomes statements are not hearsay under F.R.E. 801(d)(2). Nevertheless, even if the Gomes *statements* do not constitute hearsay, we agree with Google that the *articles* themselves are being offered by Meiresonne to prove the truth of the matter asserted in those exhibits. As such, they are hearsay, and Meiresonne has not pointed to any hearsay exception that would apply to the articles under the circumstances. We therefore exclude Exhibits 2005 and 2009.

Google argues that portions of the Declaration of Paul S. Jacobs, Ph.D. (Exhibit 2013) should be excluded under F.R.E. 401–403 and 702.

Google Mot. 2–12. In Exhibit 2013, Dr. Jacobs testifies to the alleged long-felt but unmet need of the claimed invention. Google requests that this Board strike paragraphs 40–49 of Exhibit 2013 as irrelevant and inadmissible under F.R.E. 401–403 and 702. *Id.*

Federal Rule of Evidence 702 precludes expert testimony when it is not "based on sufficient facts or data" or is not "the product of reliable principles and methods." F.R.E. 702(b)–(c). Expert opinion that is not "sufficiently tied to the facts of the case" is "not relevant and, ergo, non-helpful." *Daubert v. Merrell Dow Pharms., Inc.*, 509 U.S. 579, 591 (1993). F.R.E. 702 thus serves "a 'gatekeeping role,' the objective of which is to ensure that expert testimony admitted into evidence is both reliable and relevant." *Sundance, Inc. v. DeMonte Fabricating Ltd.*, 550 F.3d 1356, 1360 (Fed. Cir. 2008).

Dr. Jacobs was deposed by Google and that deposition is of record as Exhibit 1023. We do not exclude Dr. Jacobs's Declaration, but have taken into account all of the facts and circumstances, including the underlying basis for the testimony, and his cross-examination deposition (Ex. 1023), in weighing his testimony.

Google argues that confidential Exhibits 2015 and 2016 should be excluded as irrelevant under Federal Rules of Evidence 401–403. Meiresonne relies on these exhibits to support his argument that users of the Google search engine experienced "customer satisfaction" with Google's Instant Previews feature (Resp. 21–22).

Exhibits 2015 and 2016 are relevant even though "customer satisfaction" is not a well-recognized "secondary consideration." We

therefore do not exclude them. These exhibits are given appropriate weight in our consideration of the objective indicia of nonobviousness.

Google argues that Exhibits 2018 and 2019 should be excluded as irrelevant and inadmissible under F.R.E. 401–403. Google Mot. 12. Meiresonne relies on Exhibits 2018 to support his allegation of a nexus.[3] Resp. 23. According to Google, these exhibits should be excluded for the reasons explained above. We do not exclude the evidence and give it appropriate weight in our deliberations.

## VI. CHALLENGE RELYING ON HILL AND FINSETH

### *A. Hill*

Hill is a book titled "World Wide Web Searching for Dummies." Ex. 1006. It discusses various search engines that were known and used in 1997. Petitioner focuses on Hill Figure 6.2, reproduced below.

[3] Meiresonne does not appear to cite Exhibit 2019 in the Response.

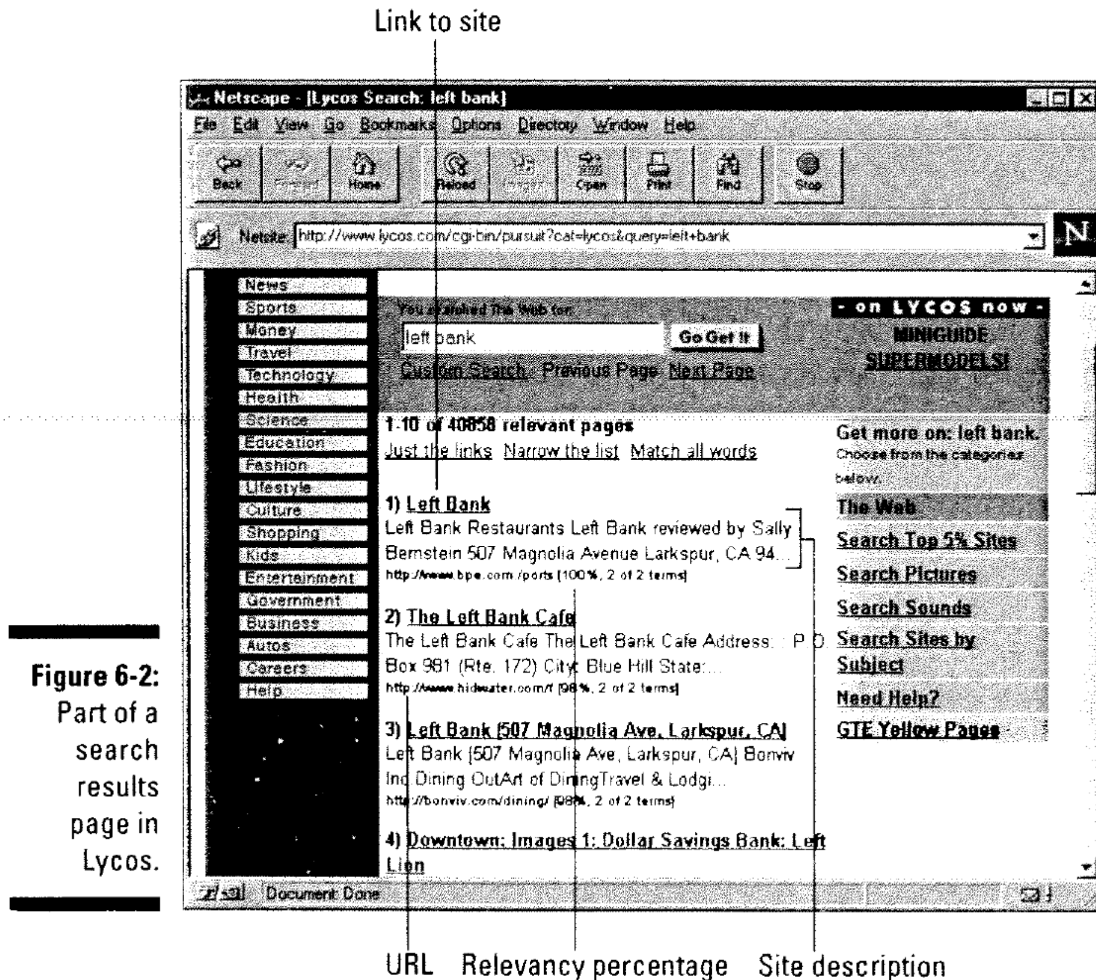



**Figure 6-2:** Part of a search results page in Lycos.

*Id.* at 101. Figure 6.2 illustrates a web page having a key word entry form for initiating a search. Search results for entered key words (e.g., "Left Bank") are displayed as a vertical listing of descriptions of websites including hyperlinks to those websites. Ex. 1006, Fig. 6.2; Pet. 18.

*B. Finseth*

Finseth describes a graphical search engine visual index. Ex. 1007, Title. Finseth Figure 5 is reproduced below.

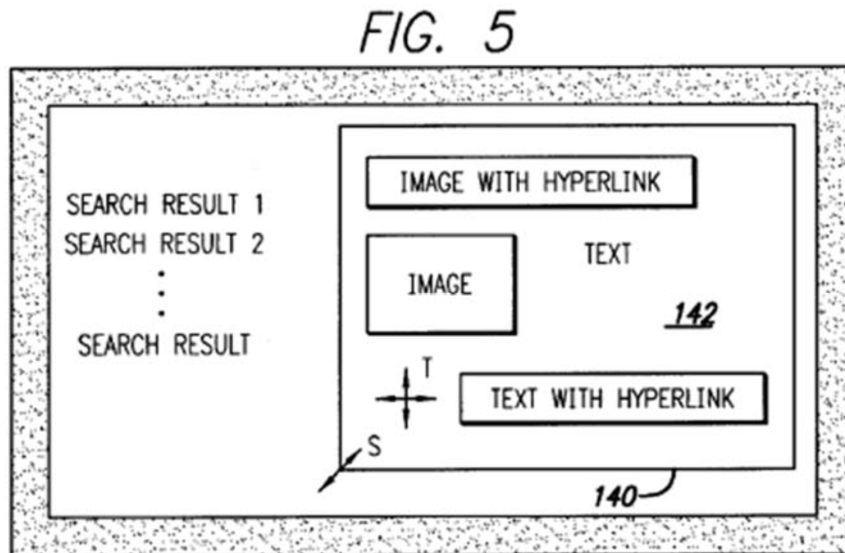
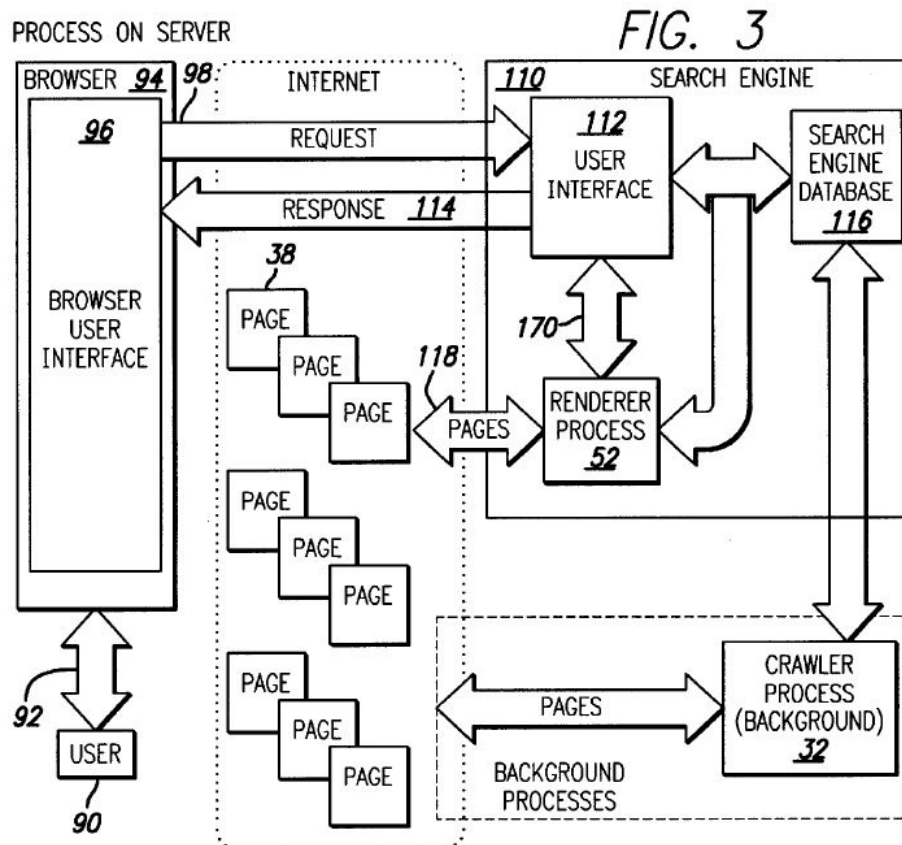



Figure 5 illustrates a screen output resulting from the described visual index method. Ex. 1007, 3:41–43. On this screen, a user can review results of an Internet search or other URL[4] listing. *Id.* at 8:49–51. A "dedicated graphical screen area" 140, which *may* be resized or moved in real time using a mouse, allows a user to preview search results. Pet. 18 (citing Ex. 1007, 8:31–38). When a cursor is positioned over a hyperlink (left side), an associated rendered web page 142 is displayed in area 140. Pet. 18–19 (citing Ex. 1007, 12:32–36); *see* Ex. 1011 ¶¶ 52–53. This rendered web page includes an image of the page and hyperlinks. Ex. 1007, 8:46–55.

Finseth describes how to generate a preview window (e.g., Figure 3

[4] Uniform Resource Locator ("URL").

and its description). However, as explained below, we find no suggestion in Finseth that descriptive text should be replaced. Google points to Finseth Figure 3, reproduced below.




Finseth Figure 3 is a schematic diagram demonstrating Finseth's visual index method. User 90 requests and receives information 92 from browser 94 having interface 96. That request is passed to search engine 110. Search engine 110 includes user interface 112 that provides formatted output to browser user interface 96 when response or reply 114 is delivered from search engine 110 back to browser user interface 96. "The search engine response may be determined predominately or in significant part by the visual index method page rendering process 52 that is associated with both the search engine user interface 112 and search engine database 116." *Id.* at

7:21–25.

> [T]he search engine interface 112 may parse the request and pass it to the search engine database 116. The search engine database may either or both rely upon its list of URLs with summary information and/or make request of the web crawler 32 that a search be performed. The web crawler 32 retrieves the data associated with the URLs from either the web crawler search or from the search engine database 116.

*Id.* at 7:33–41. Web crawler 32 passes the associated media and URL information to visual index method page renderer process 52. Rendered pages are output to user interface 112. Image maps may also be included with the rendered images. Interface 112 "transmits formatted and rendered pages 38 in its response 114 to the browser user interface 96 and ultimately to the user 90." *Id.* at 7:51–53.

*C. Level of Ordinary Skill in the Art*

"Section 103(a) forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 405 (2007) (quoting 35 U.S.C. § 103(a)). Dr. Bederson testifies that he believes a person of ordinary skill in the art would have had "at least a bachelor's degree in computer science or related field, and approximately one year of experience in web site design." Ex. 1011 ¶ 27. Dr. Jacobs agrees. Ex. 2013 ¶¶ 17–18. Based on the record presented, including our review of the '096 patent and the types of problems and solutions described in the '096 patent and cited prior art, we determine that a person of ordinary skill in the art would have had an undergraduate degree in computer science or a

related field (or equivalent work experience) and at least one year of experience with web site design, and apply this level of ordinary skill in the art for purposes of this Decision.

### *D. Combining Hill and Finseth*

There is no dispute that each limitation of the challenged claims is found in one or the other of Hill and Finseth. *See* Pet. 20–29. For example, with respect to claim 19, Hill describes the listing of descriptive links and descriptive portions. *Id.* at 20–23. Finseth describes the claimed rollover viewing area. *Id.* at 23–25. However, the parties disagree as to whether the teachings of Hill and Finseth would have been combined by one of ordinary skill in the art to meet the limitations of the challenged claims. During trial, the parties focused on motivation to combine, whether Finseth teaches away from combining, and whether or not there is objective evidence of nonobviousness.

Google argues that there was ample motivation to combine Hill and Finseth. Pet. 19–20 (citing Ex. 1011 ¶¶ 59–61); Reply 2–4. Google notes that the two references themselves provide evidence that they pertain to the same field of endeavor and would have been known to one of ordinary skill in this field of endeavor. Pet. 19–20. Hill discloses known elements of conventional Internet search engines. *Id.* When a user inputs a key word, a search results page returns a listing of results and hyperlinks to follow to find additional results. *Id.* at 20–23. Finseth discloses how to improve search results for a conventional search engine. *Id.* at 23–25. Both the Hill reference and the Finseth reference discuss precisely the same conventional search engines (e.g., AltaVista, Lycos, Infoseek, Excite, and Yahoo). *Id.* at 20–25. Thus, according to Google, one of ordinary skill would have been

motivated to use the Finseth preview window in combination with the Hill search results to obtain the predictable result of a display enabling the user to better review those results more quickly. *Id.* at 19–20.

Google argues that the references themselves provide evidence of a motivation to combine. *Id.* Google points to passages of Finseth describing the problem to be solved, namely that known search engines returned results in the form of a list of hyperlinks with cursory if not cryptic initial text presentations on those web pages. *Id.* (citing Ex. 1007, 1:47–59). The known vertical listing of search results made it difficult for a user to quickly find a desired link. Finseth's solution was to present a thumbnail image or other representational graphic information accompanying the hyperlinks. Ex. 1007, 2:25–31.

Meiresonne argues that the Petition and supportive testimony of Dr. Bederson (Ex. 1011) do not provide a reason that one of ordinary skill would have made the claimed combination, referring to Dr. Bederson's explanation of motivation as "broad" and not specifically directed to why one would have kept the descriptive text when adding Finseth's web page graphical representation. Resp. 13. Meiresonne also points out that both Hill and Finseth identify problems with text descriptions that accompany links on a search results page, with Hill stating that descriptions can be "about as informative as a paragraph full of gibberish" and Finseth stating that descriptive text can be "cursory, if not cryptic." *Id.* at 8 (citing Ex. 1006, 2, Ex. 1007, 1:54–63). According to Meiresonne, a person of ordinary skill in the art would not have had reason to incorporate Finseth's rollover viewing area in Hill's arrangement because Finseth eliminates and replaces the descriptive portions, rather than merely adding them to the

search results page. *Id.* at 8–12. Meiresonne also challenges the testimony of Dr. Bederson. *Id.* at 13–16.

Meiresonne's arguments are not persuasive, however, because they do not consider Finseth's teachings as a whole. *See Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1166 (Fed. Cir. 2006) (explaining that in an obviousness analysis, "the prior art must be considered *as a whole* for what it teaches"). Although it is true that Finseth describes the descriptive text of the time as "cursory, if not cryptic," Finseth describes an express benefit to using a graphical preview of the contents of the linked web pages—namely, that *more information is available to the user*. *See* Pet. 19–20; Reply 9–11; Ex. 1011 ¶¶ 60–61; Ex. 1007, 1:54–63 ("Such review or perusal of some summary form of a web page, even if cursory, provides a significant amount of information as the form in which graphical information is presented often indicates to a significant degree its content."), 2:27–34 (the graphical preview "greatly enhances the ability to review search engine results"), 3:11–14 (the graphical preview "provide[s] quicker review of search engine results"), 8:30–32 ("more convenient perusal or review of the results of the Internet search or other URL listing"), 10:31–63 ("By providing the visual index method of the present invention, vast amounts of graphical data can be perused by a user much faster than by previously available methods or means."); *see also Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1125 (Fed. Cir. 2000) (evidence of a motivation to combine prior art references "may flow from the prior art references themselves"). Thus, Finseth would have suggested to a person of ordinary skill in the art that the graphical view is better than the descriptive text of the time, but does not suggest that the descriptive text should be abandoned

wholesale. In the end, both sources—the descriptive text and the graphical preview—provide information useful to the user; the only difference is that one is more useful than the other.

We are persuaded by Google's argument that in its proposed combination, the elements disclosed in Hill and Finseth would operate in known ways to achieve predictable results. *See* Pet. 19; Reply 4; Ex. 1011 ¶ 59. Additionally, based on the record presented, we do not see any reason why incorporating Finseth's preview feature into the arrangement of Hill would have achieved an unexpected result or would have been uniquely challenging or otherwise beyond the level of skill of an ordinarily skilled artisan. *See KSR*, 550 U.S. at 416, 421; *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161–62 (Fed. Cir. 2007). Google's arguments as to why a person of ordinary skill in the art would have had reason to combine the teachings of Hill and Finseth are supported by the disclosures of the references themselves, as well as the testimony of Dr. Bederson,[5] and are persuasive. *See KSR*, 550 U.S. at 417–18 (requiring "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" based on the combined teachings of the references) (quotation omitted)).

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[5] We are not persuaded by Meiresonne's arguments regarding Dr. Bederson's testimony. *See* Resp. 14–16. As Petitioner points out, Dr. Bederson testified regarding reasons to combine the references in his declaration. *See* Ex. 1011 ¶¶ 59–61. Meiresonne's questions during cross-examination, to which Dr. Bederson responded that he had no "opinion," were directed to specific aspects of Hill, not the general combination that Dr. Bederson describes in his declaration. *See* Ex. 2014, 37:24–38:21. Dr. Bederson also corrected his testimony later during cross-examination and explained why adding Finseth's preview functionality would have improved the "user experience." *Id.* at 38:24–39:15.

*E. Teaching Away*

Meiresonne argues that Finseth "[led] in a path different from the '096 patent claims, and disparaged the claimed 'descriptive portions.'" Resp. 12. Thus, according to Meiresonne, combining Hill and Finseth would have led to a search results display on which the Finseth image representation would have *replaced* Hill's descriptive portions, rather than supplemented them. *Id.* According to Meiresonne, at the time of the invention, Finseth's graphical approach, without descriptive portions, would have been the obvious solution to the problem of gibberish and cursory descriptions that both Hill and Finseth identified. *Id.* Further, combining Hill and Finseth to achieve the '096 patent claims would require the impermissible use of hindsight according to Meiresonne. Resp. 17. Google disagrees, arguing that Finseth nowhere describes that text should be replaced. Reply 8–9; Tr. 9:1–5.

Petitioner argued (Reply 26, 7–8; Tr. 9:6–10:13) that Figure 3 of Finseth shows that the Finseth invention is used in the context of a search engine running on a server. We note the search engine in the upper right-hand portion of Figure 3. The Finseth process returns search results through search engine database 116. Those results are passed to both the search engine and renderer process 52, which generates thumbnail images of web pages 38. User interface 112 determines how those thumbnail images are displayed by browser 96. Thus, Finseth appears to be agnostic as to how the information is presented.

We are not persuaded that Finseth disparages the use of descriptive portions sufficiently for us to conclude that Finseth teaches away from the claimed invention. Rather, we read Finseth as providing an explanation of

how to provide visual representations of web pages that can be used to *enhance* search results presentations. We do not read Finseth as suggesting that these visual representations should replace all other types of search results, such as Hill's descriptive portions. Notably, although Finseth describes the descriptive text of the time as "cursory," and describes the graphical preview as being more useful to the user, we do not see why a person of ordinary skill in the art would have read the reference as discouraging the particular solution recited in the claims, i.e., using *both* (even though one may be more useful than the other). A reference does not teach away if it expresses merely a general preference for an alternative invention from amongst options available to the ordinarily skilled artisan, and the reference does not "criticize, discredit, or otherwise discourage the solution claimed." *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

*F. Claim 19*

Google presents a detailed reading of claim 19 on Hill and Finseth at pages 17–29 of the Petition. Hill discloses all of the limitations of claim 19 except for the rollover viewing area, which is taught by Finseth. Finseth provides a detailed explanation of how to provide a rollover preview for web pages found by well-known search engines described by Hill. Google's asserted reasons for why a person of ordinary skill in the art would have combined the teachings of Hill and Finseth are supported by the testimony of Dr. Bederson and are persuasive. *See* Pet. 19–20; Ex. 1011 ¶¶ 59–61. As explained above, the strongest evidence of the obviousness of claim 19 comes from the Hill and Finseth references themselves. Further, we are unpersuaded that Finseth teaches away from such combination for the reasons explained above. Accordingly, we are persuaded that Hill and

Finseth teach all of the limitations of claim 19, and that a person of ordinary skill in the art would have had reason to combine those teachings to achieve the system of claim 19.

### *G. Claim 16*

Claim 16 is substantially the same as claim 19, but requires a "vertical listing" of search results and does not include the limitation related to a "home page" comprising an "input receiving area" where the "user inputs keyword search information." Meiresonne's arguments apply to both claims, and our conclusions with regard to claim 19 apply as well to claim 16. We are persuaded that Hill and Finseth teach all of the limitations of claim 16, and that a person of ordinary skill in the art would have had reason to combine those teachings to achieve the system of claim 16.

### *H. Dependent Claims 17 and 20*

Dependent claims 17 and 20 add limitations to their respective independent claims that describe the position of the rollover window. Those limitations were not separately argued during trial. Petitioner's analysis with respect to the claims is supported by the testimony of Dr. Bederson and is persuasive. *See* Pet. 56–57 (explaining how Finseth teaches the additional limitations); Ex. 1011 ¶ 58.

### *I. Objective Evidence of Nonobviousness*

Factual inquiries for an obviousness determination include evaluating and crediting objective evidence of nonobviousness ("secondary considerations"). *See Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). Notwithstanding what the teachings of the prior art would have suggested to one of ordinary skill in the art at the time of the invention, the totality of the evidence submitted, including objective evidence of nonobviousness, may

lead to a conclusion that the challenged claims would not have been obvious to one of ordinary skill in the art. *In re Piasecki*, 745 F.2d 1468, 1471–72 (Fed. Cir. 1984). Secondary considerations may include any of the following: long-felt but unsolved needs, failure of others, unexpected results, commercial success, copying, licensing, and praise. *See Graham*, 383 U.S. at 17; *Leapfrog*, 485 F.3d at 1162.

To be relevant, evidence of nonobviousness must be commensurate in scope with the claimed invention. *In re Kao*, 639 F.3d 1057, 1068 (Fed. Cir. 2011) (citing *In re Tiffin*, 448 F.2d 791, 792 (CCPA 1971)); *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998). In that regard, in order to be accorded substantial weight, there must be a nexus between the merits of the claimed invention and the evidence of secondary considerations. *In re GPAC Inc.*, 57 F.3d 1573, 1580 (Fed. Cir. 1995). "Nexus" is a "legally and factually sufficient connection" between the objective evidence and the claimed invention, such that the objective evidence should be considered in determining nonobviousness. *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988). The burden of showing that there is a nexus lies with the patent owner. *Id.*; *see In re Paulsen*, 30 F.3d 1475, 1482 (Fed. Cir. 1994).

Meiresonne argues objective evidence of nonobviousness of the challenged claims and that there is a nexus between that evidence and the challenged claims. Resp. 17–26. In particular, Meiresonne argues that the invention defined by the '096 patent claims satisfied a long-felt but unmet need. *Id.* at 17–20. Further, Meiresonne argues that Google's customers who experienced its temporary use of Instant Previews indicated customer satisfaction with that feature. *Id.* at 23–25.

*1. Long-Felt Need*

Meiresonne contends that the challenged claims define an invention that satisfied a "long-felt need." Resp. 17–26. Meiresonne relies in part on the testimony of Dr. Jacobs. Ex. 2013.

In support of this argument, Meiresonne notes that both Hill and Finseth recognize a significant problem with descriptive portions of conventional search results and that neither solved the problem in the same manner as called for by the challenged claims. Resp. 18. For example, in 1997, Hill commented, "Sometimes [the descriptive text is] about as informative as a paragraph full of gibberish." *Id.* (citing Ex. 1006, 102). In 1998, Finseth noted, "One of the great drawbacks of current search engines is the output that they provide to the user." *Id.* (citing Ex. 1007, 1:54–55). "In particular, Finseth criticized the descriptive text as 'a cursory, if not cryptic, excerpt of initial text present on the web page.'" *Id.* (citing Ex. 1007, 1:56–57). Meiresonne argues that Hill and Finseth offered different solutions. *Id.* (citing Ex. 1006, 102). According to Dr. Jacobs, Finseth did away with descriptive portions altogether and replaced them with graphics thought to be more helpful. *Id.* at 18–19 (citing Ex. 2013 ¶ 38).

Meiresonne notes that "Hill describes 11 search engine companies, including Yahoo!, Excite, Lycos, and InfoSeek, that existed in 1997 and competed for customers." Resp. 19 (citing Ex. 1006, 15–17). In addition to the 11 companies Hill identified, Meiresonne provides a history of Google, copied from its website, noting that Google "provided search services for consumers in the late 1990s." *Id.* (citing Ex. 2020, 1). According to Dr. Jacobs, these companies hired "some of the most talented software engineers in the field." Ex. 2013 ¶ 42. According to cross-examination of Google's

expert, Dr. Bederson, the web designers employed by these companies were at least persons of ordinary skill in the art. Ex. 2014, 39:24–40:4. Dr. Jacobs testifies that during the years 1997–2001, search companies were busy and innovative, yet did not deploy the invention described by the challenged claims. Ex. 2013 ¶¶ 40–44.

Google argues, and we agree, that this testimony does not establish a long-felt but unmet need. Reply 12–13. Meiresonne admits that each claim limitation (including the rollover viewing area) was known in the art, and identifies no technical impediment to creating the claimed systems. To support a conclusion of nonobviousness, an alleged long-felt need must have been a persistent one that was recognized by those of ordinary skill in the art, must not have been satisfied by another before the challenged patent, and must have been satisfied by the claimed invention. *See Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1332–33 (Fed. Cir. 2009); *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 768 (Fed. Cir. 1988). Meiresonne does not explain sufficiently why there was a long-felt need to solve a particular problem that others recognized prior to the ’096 patent but were unable to meet. Thus, Meiresonne’s evidence of long-felt need is not persuasive.

*2. Customer Satisfaction with Instant Previews*

Meiresonne argues that customer satisfaction experienced by Google’s customers as a result of Google’s use of its Instant Previews feature is evidence of the nonobviousness of the challenged claims. Resp. 21–22.

Meiresonne notes that Google’s first use of Instant Previews occurred more than a decade after Hill and Finseth. *Id.* According to Meiresonne,

customer satisfaction is indicated by a Google Official Blog Post (Ex. 2004, 2) and in a Webmaster Central Blog Post (Ex. 2010, 2). According to Meiresonne, Instant Previews contained all elements of claims 19 and 20 of the '096 patent, including both "descriptive portions" and "a rollover viewing area" that provided information about each link when a user hovered a cursor near a "subject matter link." Resp. 23 (citing Ex. 2013 ¶ 47). On its Official Blog, Google praised Instant Previews: "The previews provide new ways to evaluate search results, making you more likely to find what you're looking for on the pages you visit." Ex. 2004, 2. The post states that Google's testing showed that "people who use Instant Previews are about 5% more likely to be satisfied with the results they click." *Id.* Google's Official Blog described Instant Previews as the "next step in search results" and something that Google was "excited" about. Ex. 2010, 3. Google explained that "testing shows that the feature really does help with picking the right result." *Id.* at 2. Such laudatory comments about the patented invention – comments made by Google almost a decade after the invention – constitute objective evidence of nonobviousness according to Meiresonne.

Meiresonne argues that a nexus exists between the indicated customer satisfaction and the challenged claims in that before use of the Instant Previews feature, the challenged claims did not cover the Google search engine, but that Google's test of Instant Previews brought its search engine within the scope of the challenged claims. Resp. 23 (citing Ex. 2013 ¶ 47). According to Meiresonne, this before/after point of comparison demonstrates a value that Google brought to its customers as a result of the

invention defined by the challenged claims. *Id.*

Google argues that there can be no nexus when the evidence points to a result that derives from something other than what is both claimed and novel. Reply 14. The image produced by Google's Instant Previews is not novel in that Finseth demonstrates its use. *See* Pet. 23–24 (citing Ex. 1007).

Google further argues that the increased customer satisfaction may have resulted from its speed and ability to dynamically stitch together relevant parts of a webpage, and cites the blog entry relied upon by Meiresonne as support. *Id.* (citing Ex. 2004, 2 ("With Instant Previews, we match your query with an index of the entire web, identify the relevant parts of each webpage, stitch them together and serve the resulting preview completely customized to your search—usually in under *one-tenth* of a second. Once you click the magnifying glass, we load previews for the other results in the background so you can flip through them without waiting.")). We agree with Google's analysis on both points.

Google further argues that the praise Meiresonne refers to is Google's own self-praise rather than industry recognition. *Id.* at 15. We agree that Google's self-praise for Instant Previews falls short of demonstrating industry praise of the quality that would provide strong objective evidence of nonobviousness.

For these reasons, we are not persuaded that the objective evidence of nonobviousness overcomes what appears to be the strongest evidence of obviousness in this case, namely the teachings of Hill and Finseth along with

a motivation to combine based on the disclosure of Finseth.

## VII. CONCLUSION REGARDING PATENTABILITY

Taking into account the evidence properly admitted, including the objective evidence of nonobviousness provided by Meiresonne, we conclude that Google has demonstrated by a preponderance of the evidence that claims 16, 17, 19, and 20 of the ’096 patent are unpatentable under 35 U.S.C. § 103, as having been obvious over the combination of prior art references Hill and Finseth. The Hill and Finseth references themselves provide strong evidence that it would have been obvious to one of ordinary skill to apply the Finseth graphical index to Hill to meet the limitations of the challenged claims. Even considering the objective evidence provided by Meiresonne, the preponderance of the evidence establishes the unpatentability of the challenged claims.

## VIII. ORDER

Accordingly, it is

ORDERED that Meiresonne’s Motion to Exclude Evidence is DISMISSED;

FURTHER ORDERED that Google’s Motion to Exclude Evidence is GRANTED as to Exhibits 2005 and 2009. In all other respects, Google’s motion is DENIED;

FURTHER ORDERED that claims 16, 17, 19, and 20 of U.S. Patent No. 8,156,096 B2 are held unpatentable; 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.

Certain material has been sealed in this proceeding, but has not been relied upon in this Decision. *See* Paper 25 (granting motion to seal). The record will be maintained undisturbed pending the outcome of any appeal taken from this Decision. At the conclusion of any appeal proceeding, or if no appeal is taken, the materials will be made public. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,760–61 (Aug. 14, 2012). Further, either party may file a motion to expunge the sealed materials from the record pursuant to 37 C.F.R. § 42.56. Any such motion will be decided after the conclusion of any appeal proceeding or the expiration of the time period for appealing.

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