

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

*In re* U.S. Patent No. 8,121,904

Filed: October 11, 2009

**IPR2013-00176**

Issued: February 21, 2012

Attorney Docket No.: 105263.00021

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Assignee: Clear With Computers, LLC

Title: ELECTRONIC PROPOSAL PREPARATION SYSTEM

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**SECOND PETITION FOR *INTER PARTES* REVIEW**  
**OF U.S. PATENT NO. 8,121,904**

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## INTRODUCTION

Petitioner Hyundai Motor America, Inc. (“Hyundai”) respectfully requests *inter partes* review of claims 1-21 of Clear With Computers LLC’s (“CWC”) U.S. Patent No. 8,121,904 (the “’904 Patent”). *See* 35 U.S.C. §§ 311-319 and 37 C.F.R. § 42.100 *et seq.* In a prior petition (IPR2013-00104), Hyundai addressed claims 22-40, whereas this petition addresses claims 1-21. The references, claim charts, and declaration evidence presented with this petition demonstrate that each of claims 1-21 is unpatentable.

The ’904 Patent is generally directed to a computer system for creating customized “proposals” for the sale of a product, with the proposal combining stored images and text segments. ’904 Patent, Abstract. The images include pictures of the product as well as environments in which the product may be used. *Id.* The text segments include textual descriptions of the product, descriptions of the environments in which the product can be used, and performance specifications. *Id.* Based on a user’s inputting information indicating his or her interests (e.g., by making menu selections), the system creates a “customized” output by “filling in” “templates” (page layouts) with appropriate images and text segments to present to the user. ’904 Patent, col. 5, ll. 3-31.

The ’904 Patent declares such “customized” output was a marked innovation in 1992 over existing preprinted marketing brochures, which were “generic” and

had to be “all things to every customer.” ’904 Patent, col. 1, l. 30-col. 2, l. 30. But in reality, there was nothing innovative about it. Interactive systems capable of collecting input indicating a customer’s interests and then conveying customized product information were widely known long before the alleged invention underlying the ’904 Patent.

This is demonstrated by several references not previously considered by the Patent Office. For example, Nohmi, et al., *Multimedia Presentation Systems – Prototyping for Electronic Catalogs*, Proceedings of the 38th National Convention of the Information Processing Society of Japan (1989 First Half) 668-69 (1989) (“Nohmi”) (Ex. 1001), describes a computerized sales presentation system which, based on a user’s inputting information indicating her interests, conveyed customized product information—specifically, information about cars. Nohmi, § 3, Fig. 2. Like many other systems available at the time, the Nohmi system provided an interactive interface to access information of particular interest in the form of “pages” constructed from selectively retrieved and composited images and text. Several such systems (including Nohmi and others discussed below) were the result of integrated research efforts at Hitachi, Ltd. of Japan. At least Nohmi in combination with other references described below renders obvious every one of claims 1-21 of the ’904 Patent.

## FACTUAL BACKGROUND

A proper appreciation of why claims 1-21 are all unpatentable requires an understanding of (a) the state of the art in the relevant field during the 1980s and early 1990s; (b) the '904 Patent's specification; (c) its prosecution history; and (d) prior related litigation between Hyundai and CWC, including constructions of certain claim terms by the U.S. District Court.

### A. The State of the Art

As explained in the accompanying second declaration of Professor Edward A. Fox, Ph.D.—who is Professor of Computer Science at the Virginia Polytechnic Institute and State University and who offers his opinion regarding the content and state of the prior art<sup>1</sup>—computer software has been used to systematically organize and present customized information since long before the predecessors to the '904 Patent were filed. Ex. 1012 (“Fox 2nd Decl.”). The early 1980s saw the birth of “hypertext” and “hypermedia” systems that, based on a user's input of interests, retrieved and presented customized images and text. These systems—which were forerunners of the World Wide Web—featured integrated databases to facilitate

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<sup>1</sup> In addition to research at Virginia Tech, where he has taught since 1983, Dr. Fox has co-authored or edited over 100 publications in the areas of information storage and retrieval, hypertext, hypermedia, multimedia, CD-ROM and optical disc technology, and electronic publishing.

efficient computerized search and retrieval. During the mid-1980s, companies began to develop electronic marketing programs using these technologies to provide potential customers with product information tailored to their specific interests (revealed by answers to menu-based selections or questions), many of which were then integrated with custom design and ordering systems. By 1992, when the first predecessor to the '904 Patent was filed, the marketplace was awash in computerized systems for presenting, configuring, and also directly selling products, including automobiles (e.g., in Nohmi), toys (e.g., in Matsuzaki), kitchen cabinets (e.g., in Detailer), building furnishings (e.g., in U.S. Patent No. 5,053,956 to Donald), and travel packages (e.g., in U.S. Patent No. 5,309,355 to Lockwood).

All these systems employed the same underlying technologies as the alleged inventions claimed in the '904 Patent and thus were capable of solving the problem that it allegedly solved—the inability of preprinted “generic” marketing brochures to adapt to the desires of particular customers. Specifically, the prior art systems provided interactive interfaces to collect input from users; means to store those inputs; databases of product information that could be updated; and object-oriented code responsive to user input that filled in page layouts with retrieved images and text, thus constructing proposals using visual composites of those materials. As Dr. Fox explains, persons of ordinary skill in 1992 appreciated the potential applications and benefits of these technologies, as demonstrated by the many

predecessor systems developed by others utilizing the same well-known underlying technical developments in the computing and software fields. Fox 2nd Decl., ¶¶ 26-45.

**B. The '904 Patent**

The '904 Patent issued from U.S. Patent Application Ser. No. 12/577,194, which was filed October 11, 2009, as a continuation of U.S. Patent Application Ser. No. 09/566,029, shortly before that application issued as U.S. Patent No. 7,606,739 (the "'739 Patent"). The '904 Patent (Ex. 1008) is generally directed to a computerized system for creating customized, printed "proposals" for the sale of a product. The system creates the proposals using information provided in response to user queries and generated using electronic templates that are "filled in" with stored images and text. *E.g.*, '904 Patent, Abstract. Figure 1B of the '904 Patent (reproduced below) conceptually illustrates a template for a page in such a proposal that is "filled in" and displayed. '904 Patent, col. 4-31. The preferred embodiment of the '904 Patent is depicted in Figure 2 (reproduced below).



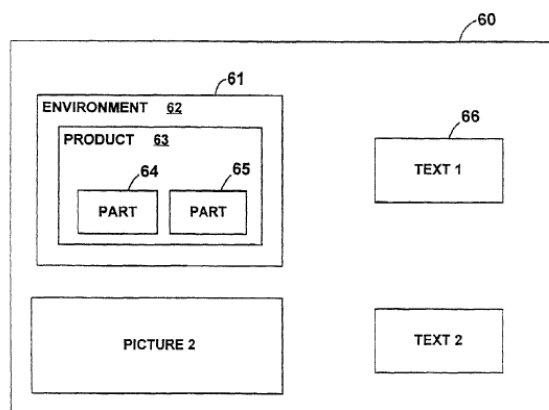


FIG. 1B

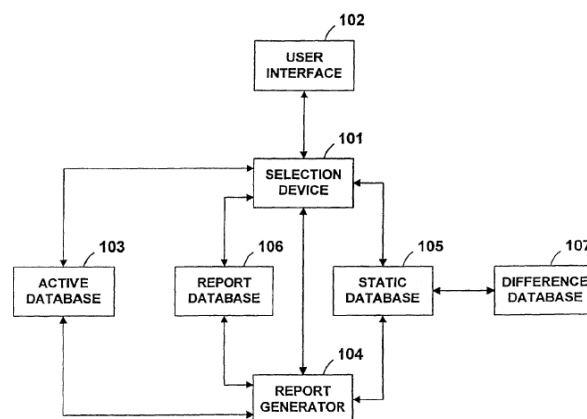


FIG. 2

With respect to the elements contained in challenged claims 1-21, Figure 2 illustrates a “user interface” 102 “by which the user may interactively input predetermined answers to predetermined queries,” using, for example, menus to access a particular desired page, *see id.*, col. 8-ll. 42-60. Figure 2 also illustrates: a “selection device” 101 that (according to the challenged claims) presents a customized proposal to the user based on the user’s product interests. *See, e.g., id.*, col. 17, l. 13-col. 18, l. 45. The “selection device” performs this function by employing an “active database” 103 that electronically stores user input, *e.g., id.*, col. 6, ll. 1-2; a “static database” 105 that electronically stores product and other information (pictures and text), *id.*, col. 7, l. 60-col. 8, l. 12; a “report database” 106 that stores page layouts used to format and produce the various pages of a proposal, *id.*, col. 8, ll. 33-38; and a “report generator” 104 that comprises the “means for processing and generating the customized printed proposal.” *Id.*, col. 10, ll. 9-17. A “difference database” 107 is provided to store updates (e.g., “net

changes”) to the static database 106. *Id.*, col. 8, ll. 15-20.

### **C. The ’904 Patent’s Prosecution History**

The ’904 Patent issued February 21, 2012, with 40 claims, of which claims 1, 21, 22, 31, 39, and 40 are independent. As originally filed, however, the application that matured into the ’904 Patent included only 16 claims, of which Claims 1 and 16 (now Claim 21) were independent. Substantive prosecution commenced April 14, 2010, with a first non-final Office Action containing three rejections: 1) a non-statutory obviousness-type double patenting rejection of then-pending Claims 1 and 16 over Claim 20 of the ’739 Patent, which had by then issued; 2) a rejection of Claims 1-4, 6-8, 12, and 13 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,309,355 to Lockwood (“Lockwood”); and 3) a rejection of claims 5, 9-11 and 14-15 under 35 U.S.C. § 103(a) as being obvious over Lockwood. The Office Action indicated Claim 16 was otherwise allowable if the double patenting rejection were resolved.

On June 24, 2010, CWC filed an amendment responsive to the non-final Office Action. In so doing, CWC amended Claim 1 to include the limitations of then Claims 12 and 13 that required a “difference database” to “store[] update information configured for transmittal to the static database,” and specifically argued that Lockwood did not disclose, teach, or suggest such a feature. This purportedly innovative feature allowed updates to be distributed to the content

stored in the static database. CWC also filed a Terminal Disclaimer in an attempt to resolve the double patenting rejection.

After some back-and-forth to resolve the double patenting rejection with the filing of additional Terminal Disclaimers, including a Final Rejection mailed September 17, 2010, a second Non-Final Rejection was mailed December 27, 2010. It contained three rejections: 1) a 35 U.S.C. § 101 rejection of Claims 1-11, 14, and 15 as not being directed to statutory subject matter and lacking utility; 2) a 35 U.S.C. § 112 rejection of Claims 1-11, 14, and 15 as lacking utility; and 3) 35 U.S.C. § 102(e)/103(a) rejections of claims 1-11, 14, and 15 over Lockwood. Claim 16 was indicated as being allowable. CWC filed a responsive amendment on March 3, 2011, adding further detail to Claim 1 “per the Examiner’s suggestions” from various telephonic interviews conducted in February 2011, and additionally adding new dependent claims 17-23 (which became issued claims 14-20). A first Notice of Allowance of issued claims 1-21 was mailed April 4, 2011. Although CWC engaged in further prosecution of the application, including filing two Requests for Continued Examination and submitting approximately 400 prior art references by Information Disclosure Statement, neither CWC nor the Examiner substantively discussed claims 1-21 again. Ultimately, on February 21, 2011, the ’904 Patent issued and CWC immediately sued Hyundai for infringement of it.

**I. THIS PETITION SATISFIES EVERY REQUIREMENT FOR *INTER PARTES* REVIEW AS TO EACH CLAIM.**

The remainder of this Petition is organized as follows: This Section explains why the Petition satisfies each of the formal requirements of 37 C.F.R. § 42.104 for *inter partes* review of claims 1-21 of the '904 Patent; and Section II provides analysis and claim charts showing that each of the challenged claims is unpatentable.

**A. Mandatory Notices and Fees**

Hyundai provides the following mandatory disclosures per 37 C.F.R. § 42.8:

(b)(1): Hyundai certifies that it is the real party-in-interest.

(b)(2): As noted above, the '904 Patent is presently the subject of patent infringement litigation captioned *Clear With Computers LLC v. Hyundai Motor America, Inc.*, Case No. 6:12 CV 77-LED (E.D. Tex). In addition, *Clear With Computers LLC v. Hyundai Motor America, Inc.*, Case No. 6:09 CV 479-LED (E.D. Tex), currently Appeal No. 2012-1291 (Fed. Cir.), is a judicial proceeding that could be affected by a decision in this *inter partes* review. Claims 22-40 are being separately challenged by Hyundai as being unpatentable in *Inter Partes* Review No. IPR2013-00104.

(b)(3): Hyundai provides the following designation of counsel, who are also designated in the power of attorney accompanying this Petition:

Lead Counsel	Back-Up Counsel
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(b)(4): Postal and hand-delivery addresses are provided for lead and back-up counsel above.

Regarding fees, per 37 C.F.R. § 42.103(a), the Office is authorized to charge \$27,800.00 to Deposit Account No. 50-1814 for the fee set forth in 37 C.F.R. § 42.15(a), and any additional fees that might be due in connection with this Petition.

## **B. Standing**

Pursuant to 37 C.F.R. § 42.104(a), Hyundai certifies that the '904 Patent is available for *inter partes* review and that Hyundai is not barred or estopped from requesting *inter partes* review challenging claims 1-21 on the grounds identified herein. Claims 1-21 have not been subject to a prior estoppel-based proceeding under the America Invents Act. The complaint referenced above in Section I(A) was not served<sup>2</sup> on Hyundai “more than one year” ago.

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<sup>2</sup> On March 5, 2012, Hyundai waived service of the complaint at CWC’s request.

Thus, according to Fed. R. Civ. P. 4(d)(4), CWC’s complaint was “served” on that date.

### C. Specific Art and Grounds on Which the Challenge Is Based

Claims 1-21 of the '904 Patent are unpatentable in view of the following references, each of which is prior art under 35 U.S.C. § 102(a), (b), and/or (e):

(1) Nohmi, et al., *Multimedia Presentation Systems – Prototyping for Electronic Catalogs*, Proceedings of the 38th Nat'l Convention of the Info. Processing Soc'y of Japan (1989 First Half) 668-69 (1989) (“Nohmi”). Ex. 1001. Nohmi describes a computerized sales presentation system that could be used to help sell products—specifically, cars—and is prior art under § 102(b) by virtue of its 1989 publication date. As discussed above, the Nohmi system provided an interactive interface to access information of particular interest in the form of “pages” constructed from selectively retrieved and composited images and text. This is illustrated in Nohmi, Fig. 2:

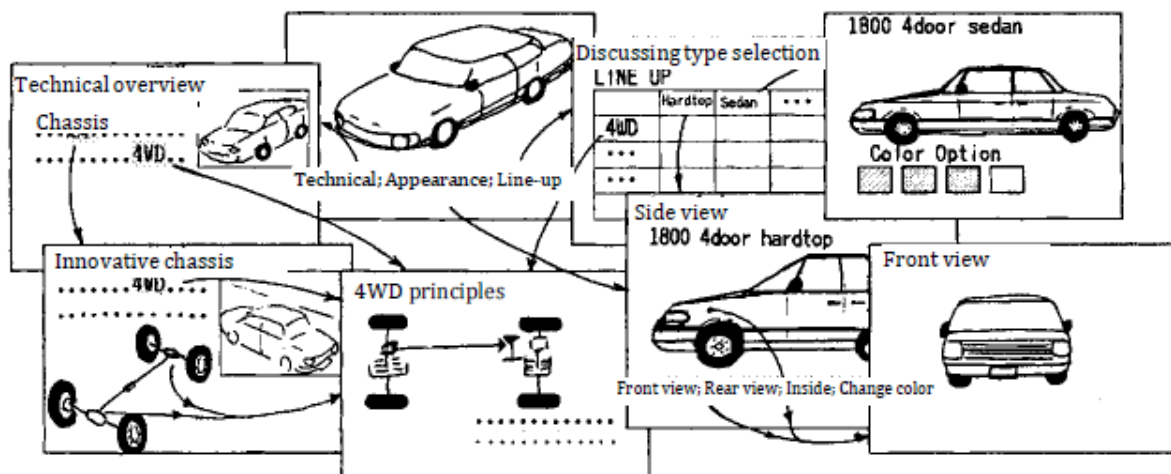


Figure 2: Outline of functions and image representation of a search

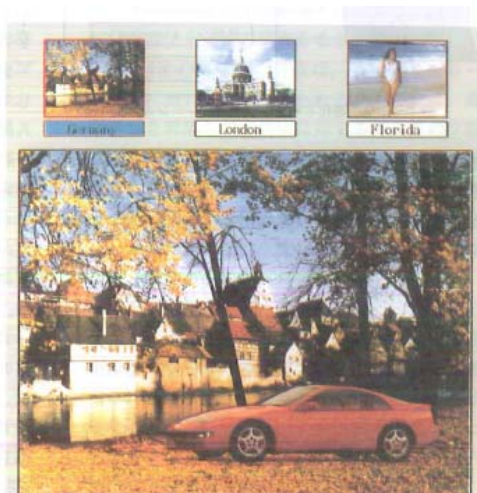
(2) U.S. Patent No. 5,528,490 to Hill (“Hill”). Ex. 1002. Hill describes an

electronic catalog system for displaying product information to customers with a remote component (i.e., a “difference database” as described and claimed by the ’904 Patent) that permits updating of locally stored information. Hill issued June 18, 1996 but was filed April 10, 1992. It is thus prior art under § 102(e).

Hill’s system was designed so that certain product information not likely to frequently change, including graphics and textual data (what the specification calls “constant data”) would be stored on the customer’s computer so that information did not have to be downloaded from a central server each time the user requested information about a product. *See* Fox 2nd Decl., ¶¶ 49-51; Hill, col. 1, l. 47-col. 2, l. 2, Fig. 1C. Revisions to the “constant data” were pushed to the remote machine if necessary by checking a “revision status” of the “constant data”. Hill, col. 2, ll. 9-15. Thus, Hill’s system ensured that when a customer accessed the electronic catalog and requested product information, all information presented to the user was up to date.

(3) Miyaoka, et al., *Image Processing in Presentations Systems*, The Journal of the Institute of Elecs., Info. and Comm’n Engineers, vol. 74, no. 4, 392-97 (April 25, 1991) (“Miyaoka”). Ex. 1003. Among other things, Miyaoka provides further description of image-compositing features in computerized sales presentation systems—and is prior art under § 102(b) by virtue of its 1991 publication date. Miyaoka specifically describes enabling user selection of an

environment in which a product is to be operated and then compositing a picture of that environment with an image of the product being considered. *See* Miyaoka, Photo 1 (below).



Miyaoka, Photo 1.

(4) The Complete Car Cost Guide, 1989 Edition (the “Complete Car Cost Guide”). Ex. 1004. The Complete Car Cost Guide, 1989 Edition is an example of an information resource containing textual information that system designers would have incorporated into sales presentation software. The Complete Car Cost Guide was published in March 1989 and is thus prior art under § 102(b).

The information detailed in the Complete Car Cost Guide includes price specifications for the vehicle, product technical detail specifications such as engine size and displacement, transmission type, and option detail, as well as life cycle specifications such as the projected year-over-year ownership costs for depreciation, financing, insurance, fuel, maintenance, and repairs. This



information was already kept in a database form, *see* Complete Car Cost Guide, p. 3,<sup>3</sup> and could have been easily integrated with computerized sales presentation systems. *See* Fox 2nd Decl., ¶ 55.

(5) U.S. Patent No. 4,876,592 to Von Kohorn. Ex. 1005. Von Kohorn describes a computerized system adapted to interact with viewers of a “home shopping” television broadcast to provide printouts regarding products users have expressed interest in purchasing. Von Kohorn issued October 24, 1989, and is thus prior art under § 102(b).

The relevant aspect of the Von Kohorn system is the printout of information regarding the product in which the user has expressed interest. That printout is also described to include “salesperson information,” e.g., a telephone number enabling contact with a salesperson for purchase of merchandise. *See* Von Kohorn col. 49, ll. 15-19.

(6) JP H3-74769 to Kobayashi, et al. (“Kobayashi”). Ex. 1006. Among other things, Kobayashi provides further description of templating and rendering features in computerized sales presentation systems. Kobayashi was published by the Japan Patent Office on March 29, 1991, and is thus prior art under § 102(b).

Kobayashi has a very similar organizational subsystem to the Nohmi

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<sup>3</sup> Cited page numbers in exhibits refer to the page within the PDF of the Exhibit, not the numbered pages in the exhibit.

reference and is the result of the same research efforts as Nohmi. Kobayashi also adds further detail to the Nohmi disclosure, focusing on how to address efficiency problems by expressing the information to be displayed using a template structure (a “page”) that can be processed in real time to recall images and text from a centralized location.

(7) Roux, *Updating CD-ROM Databases*, Chapter 14 in Lambert, S. and Ropiquet, S. (eds.), *CD ROM: Optical Publishing* (1987) (“Roux”). Ex. 1007. Roux describes various techniques for updating the information in databases stored on non-rewritable CD ROMs, including distributing collections of content changes (i.e., “difference databases” as described and claimed by the ’904 Patent) via tangible media and packet-switched networks. Roux was published in 1987 and is thus prior art under § 102(b).

Roux specifically teaches providing database content changes via tangible media such as floppy disks or over a network connection together with an index so those database content changes can be integrated with an existing database. *See* Roux, pp. 6, 9, 13-14. Once this new index is in use queries can be made to the combined database. *Id.*; *see* Fox 2nd Decl., ¶¶ 59-60.

Of the identified references, Nohmi, the Complete Car Cost Guide, Von Kohorn, Roux, and Kobayashi were not of record during the prosecution of the ’904 Patent. Moreover, none of the references identified in this petition were

substantively discussed or relied upon in any rejection of claims. Yet the references provide powerful grounds for rejecting claims 1-21.

Specifically, as demonstrated in Section II, Hyundai asserts the following combinations relevant to the subject claims:

A: Claims 1-8, 10, 12, and 14-17 are obvious under § 103 over Nohmi in view of Hill;

B: Claims 9 and 18 are obvious under § 103 over Nohmi in view of Hill in further view of Miyaoka;

C: Claims 11 and 19 are obvious under § 103 over Nohmi in view of Hill in further view of the Complete Car Cost Guide;

D: Claims 13 and 20 are obvious under § 103 over Nohmi in view of Hill in further view of Von Kohorn;

E: Claim 21 is Obvious under § 103 over Nohmi in view of Hill, Miyaoka, Von Kohorn, and the Complete Car Cost Guide;

F. Claims 1-8, 10, 12, and 14-17 are also obvious under § 103 over Nohmi in view of Hill in further view of Miyaoka;

G. Claims 1-8, 10, 12, and 14-17 are also obvious under § 103 over Nohmi in view of Hill in further view of Kobayashi; and

H. Claims 1-8, 10, 12, 14, and 16-17 are also obvious under § 103 over Nohmi in view of Roux.

#### **D. Summary of Challenged Claims 1-21**

Two of challenged claims 1-21 are independent: claims 1 and 21. Both are directed to “computer system[s] for facilitating sales of a product to a user” and both recite the same seven structural components:

- 1) a “**user interface**” which “quer[ies] the user regarding product interests”;
- 2) a “**selection device**” “operatively connected to the user interface”  
“configured to present a customized proposal to the user based on the user’s product interests”;
- 3) an “**active database**” “operatively connected to the selection device”  
“configured to store the user’s product interests”;
- 4) a “**report database**” “operatively connected to the selection device”  
“configured to store a plurality of page layouts”;
- 5) a “**static database**” “operatively connected to the selection device”  
“configured to store product information”;
- 6) a “**difference database**” “operatively connected to the static database”  
that “stores update information configured for transmittal to the static database”; and
- 7) a “**report generator**” “operatively connected to the active database, the report database, the selection device, and the static database” “configured to link page layout identifiers with particular data that appear in the

customized proposal, wherein the customized proposal includes at least one item based upon the user's product interests, and wherein the at least one item includes at least one of: a product picture, an environment picture, and a text portion."

All of the dependent claims (2-19) depend from claim 1. Each purports to add further features to one of the seven structural components described above.<sup>4</sup> Specifically, dependent claims 2, 3, and 15 address features of the "user interface" and its "quer[ies]," such as that the "query of the user interface comprises ... [certain] query portions." Dependent claims 4, 5, 14 and 16 address the "proposal" presented by the "selection device" and what it contains. Dependent claims 6, 7, and 17 address features of the "active database" and particularly what information is stored therein, such as "information received from the user in response to at least one ... query portion[]." Dependent claims 8, 9, and 18 address features of the "report database" and the "page layouts" stored therein, such as that "at least one of the page layouts is configured to display a product picture of a product selected by the user, an environment picture of an environment selected by the user, and a

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<sup>4</sup> Several dependent claims, particularly claims 2, 4, 6, 8, and 14, do not further limit claim 1 in any way, and thus fail to comply with 35 U.S.C. § 112, ¶ 4.

Hyundai reserves its right to assert this ground for unpatentability in an appropriate forum.

text portion, wherein the text portion is associated with at least one of the product and the environment.” Dependent claims 10, 11, and 19 address features of the “static database” and what it stores, such as “a plurality of product pictures, a plurality of environment pictures, and a plurality of text portions, wherein each text portion is associated with at least one of a product and a [sic] environment.” Dependent claims 12, 13, and 20 address features of the “report generator,” specifically how a “report” is generated and what is inserted therein.

As can be seen in the claim chart in Section II(A) below, challenged claim 21 is merely an amalgam of various elements described in claims 1-20, with minor differences in formulation. *See* Fox 2nd Decl. ¶¶ 65-68. Specifically, claim 21 contains each of the same seven basic elements described above that are found in claim 1. *Id.* Claim 21 then adds additional detail to those elements found in dependent claims 2-19. For example, claim 21 requires:

“a selection device operatively connected to the user interface, wherein the selection device is configured to create a proposal for the user by using information regarding interests of the user obtained via the user interface, wherein the proposal includes at least one product picture, at least one environment picture, and at least one text portion based upon information regarding interests of the user obtained via the user interface;

This formulation merely combines the limitations found in claims 4 and 5:

4. The computer system of claim 1, wherein the selection device is

configured to create a proposal for the user by using information regarding interests of the user obtained via the user interface.

5. The computer system of claim 4, wherein the proposal includes at least one product picture, at least one environment picture, and at least one text portion based upon information regarding interests of the user obtained via the user interface.

Accordingly, the elements of claim 21 are addressed below by reference to corresponding elements of claims 1-20. *See id.*, ¶ 68.

### **E. How Challenged Claims 1-21 Should Be Construed**

Pursuant to 37 C.F.R. § 42.104(b)(3), because the '904 Patent has expired,<sup>5</sup> the claim terms in claims 1-21 should be construed pursuant to the principles in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (claim terms should be “generally given their ordinary and customary meaning” as would be understood by a person of ordinary skill in the art in question at the time of the invention). *See* MPEP § 2258(I)(G). In prior disputes between CWC and Hyundai over the '904 Patent's parent, the '739 Patent, and another related patent, U.S. Patent No. 5,615,342 (the “'342 Patent”), several terms found in the same or substantially the same form as in claims 1-21 of the '904 Patent were fully briefed by Hyundai and CWC and given the following constructions by Chief Judge Davis

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<sup>5</sup> By virtue of its claiming priority to the May 5, 1992 filing date of Application Ser. No. 07/878,602, the '904 Patent expired May 5, 2012.

of the U.S. District Court for the Eastern District of Texas; *see* Exs. 1009, 1010:

<b>Claim Term (in the '904 Patent)</b>	<b>Claim Construction</b>
“proposal”  (Claims 1, 4-5, 16, 21)	“information intended for conveyance to a customer.” Ex. 1009 at 7-8, Ex. 1010 at 17.
“static database”  (Claims 1, 10-12, 19-21)	“a database that is not alterable during generation of a composite visual output.”  Ex. 1009 at 12.
“active database”  (Claims 1, 6-7, 12, 17, 20-21)	“a database that is alterable based on user input.” Ex. 1009 at 12-13.
“database”  (Claims 1, 6-8, 10-12, 17-21)	“a collection of logically related data stored together in one or more computerized files.”  Ex. 1009 at 11-12.
“selection device”  (Claims 1, 4, 16, 21)	“computer code data structure.” Ex. 1009 at 14-18.

The remainder of the terms used in the claims of both predecessor patents, many of which are the same (or substantially the same) terms used in claims 1-21 of the '904 Patent, were determined by the District Court to need “no construction,” that is, that they should be given their “plain meaning.” *See* Ex. 1009 at 19-20, Ex. 1010 at 32-33.

For the term “query,” however, the District Court’s interpretation is also



informative. For instance, the District Court held that a “question” (similar to “query” as used in claims 1-3, 15, 17, and 21) could include “menus or menu-like interfaces as questions.” *See* Ex. 1010 at 19-20.

The claim constructions adopted by the District Court for the '904 Patent's predecessors and the District Court's underlying rationales for those constructions should be adopted in this *inter partes* review, as they represent reasoned analyses of the “ordinary and customary meaning” of those terms as they would be understood by a person of ordinary skill in the art at the time of the invention. *See Omega Engineering, Inc v. Raytek Corp.*, 334 F. 3d 1314, 1334 (Fed. Cir. 2003) (“[W]e presume, unless otherwise compelled, that the same claim term in the same patent or related patents carries the same construed meaning.”); *see also* Fox 2nd Decl., ¶¶ 17. Moreover, as neither Hyundai nor CWC has ever challenged any of these constructions or interpretations, it appears that CWC agrees with these established constructions and understandings.

Three additional terms used in claims 1-21 but not in any of the prior related patents are amenable to construction to establish their “ordinary and customary meaning” as would have been understood by a person of ordinary skill in the art at the time of the invention. Those claim terms, and Hyundai's constructions of those terms, are:

Claim Term (in the '904 Patent)	Construction
“update information” (Claims 1, 21)	“changes to database content”
“transmit the report” (Claims 13, 21)	“send the report for printing”
“life cycle specifications” (Claims 11, 19, 21)	“specifications relating to projected ownership costs for the product”

Hyundai believes its proposed constructions are correct, for the following reasons:

**“update information”:** The ordinary and customary meaning of this term, which is used in claims 1 and 21 in the “**difference database**” limitation, is “changes to database content.” *See* Fox 2nd Decl. ¶ 20. As col. 8, ll. 15-32 of the '904 Patent's specification explains, the “difference database 107, stored on magnetic media, may be used to store information that reflects net changes to the contents of the static database 105.” As explained by Dr. Fox, in reading the claim, one of ordinary skill would understand that database content was at issue, and that update information must by necessity describe changes to that content, and this is what the usage of the claim term implies. *See* Fox 2nd Decl. ¶ 20; *see also* '904 Patent, col. 8, ll. 7-9, Figs. 2 and 10.

**“transmit the report”**: The ordinary and customary meaning of this term, which is used in claims 13, 20, and 21 in the **“report generator”** limitation, is “send the report for printing.” *See* Fox 2nd Decl. ¶¶ 21-23; *see also* ’904 Patent, col. 14, ll. 44-47. As explained by Dr. Fox, the word “transmit” is not found in the specification, while “send” occurs repeatedly, and every time the report generator is mentioned in the specification along with sending, it is mentioned in connection with printing. Fox 2nd Decl. ¶ 22. Moreover, because the report generator in the specification and claims only exists for the purpose of printing a report, the only possible proper meaning of “transmit the report” is to send it for printing. *Id.*

**“life cycle specifications”**: The ordinary and customary meaning of this term, which is used in claims 11, 19, and 21 in the **“static database”** limitation, is “specifications relating to projected ownership costs for the product.” *See* Fox 2nd Decl. ¶¶ 24-25; ’904 Patent, col. 8, ll. 15-20. As explained by Dr. Fox, this is exactly what one with ordinary skill would understand this claim term to mean in view of its usage in the claim and in the specification: projected costs over time associated with ownership of the product, such as maintenance, taxes, financing costs, and the like. *See* Fox 2nd Decl. ¶ 25.

The remaining terms in claims 1-21 should be given their “plain meaning.” *See* Fox 2nd Decl. ¶ 18.

**F. Why Claims 1-21 Are Unpatentable, and Supporting Evidence**

Pursuant to 37 C.F.R. § 42.104(b)(4) and (5), Section II includes claim charts identifying (1) where each element of claims 1-21 is found in the prior art; and (2) exhibit numbers of the evidence relied upon and explanation of the relevance of the evidence, including those portions of the evidence that support the challenges. Dr. Fox's declaration provides supporting evidence of obviousness.

**II. REPRESENTATIVE PROPOSED REJECTIONS EACH SHOW A REASONABLE LIKELIHOOD THAT EACH OF CLAIMS 1-21 IS UNPATENTABLE**

The only remaining requirement for granting the present petition as to each of the asserted grounds is a showing of a *reasonable likelihood* that the challenged claim is unpatentable. *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.108(c). The following proposed rejections show how the identified references render obvious the claimed subject matter of each of claims 1-21. Other rejections may be premised on alternative combinations of these same references.

**A. Independent Claim 1 and Dependent Claims 2-8, 10, 12, and 14-17 Are Obvious under § 103 over Nohmi in view of Hill**

Nohmi renders obvious claims 1-8, 10, 12, and 14-17 in view of Hill. *See* Fox 2nd Decl., ¶¶ 73-109. As noted above, Nohmi was published in 1989 and is therefore prior art under 35 U.S.C. § 102(b). *See* Ex. 1001. Nohmi was not considered during the prosecution of the '904 Patent and is not cumulative of any prior art considered by the Examiner. Hill, which teaches update functionality in

product catalog systems such as Nohmi, was filed in April 1992 and is therefore prior art under 35 U.S.C. § 102(e). *See* Ex. 1002.

With respect to claim 1, one of ordinary skill would have been motivated to combine Hill's ability to update product information with Nohmi's dynamic visual interface because the references are from the same field and targeted at the same problem: automating the presentation of customized sales materials for customers. Fox 2nd Decl., ¶ 73. The modification would add known and useful functionality that would have improved the effectiveness of Nohmi's electronic catalog particularly in view of the fact that the Nohmi system was designed to be distributed on a non-rewritable medium (CD-ROM). *See* Nohmi § 2; *see also* Fox 2nd Decl., ¶ 73. Indeed, Hill's update functionality directly addresses a possible shortcoming in Nohmi, i.e., that an updated data disk would need to be sent to a customer in order for that customer to have the most up-to-date product information. *See* Hill, col. 1, ll. 28-36.

Additionally, with particular reference to claim 15, which requires a query composed of multiple inputs, one of ordinary skill also would have been motivated to integrate Hill's ability to generate a query based on multiple inputs with Nohmi's interface that allows selecting particular product criteria (e.g., a product option) individually. *See* Hill, col. 16, ll. 11-22; Fox 2nd Decl., ¶ 107. This would allow users of the Nohmi system a more direct way to generate a

customized output corresponding to the exact product configuration they desire.

Further, there is no incompatibility between the references. Fox 2nd Decl., ¶ 107.

'904 Claim Language and Correspondence to Nohmi/Hill
<b>1. A computer system for facilitating sales of a product to a user, the computer system comprising:</b>
In its Introduction, Nohmi describes a “sales presentation system being put to practical use; it enables real presentations for products.” <i>See</i> Nohmi, Introduction. More specifically, Nohmi is “a multimedia presentation system that applies the concept of hypermedia for the purpose of sales presentations.” <i>Id.</i> Nohmi’s “multimedia presentation system” and the method by which it operates produces customized output to facilitate the sale of products, specifically, cars. <i>See</i> Nohmi, § 3.1 (“integrated onto a work station (HITAC-2050, 2050G),” a “car”); § 3.3 (“car catalog”); Figs. 2, 3 (showing images of cars).
<b>a user interface configured to query the user regarding product interests of the user;</b>
Nohmi teaches such a “ <u>user interface</u> ”: Nohmi’s KEY, MENU, and SELECTOR objects each pose a “query” that a customer interested in a car could select to indicate product interests such as a desired product feature (e.g., “hardtop,” or “sedan”) or use (e.g., “4WD principles”). For instance, when a customer is presented with a selectable keyword or image element (a KEY) for “Hardtop” or “4WD,” the system is posing a “query” regarding whether he or she wishes to learn more about the “Hardtop” feature or the use of “4WD principles.” <sup>6</sup> <i>See</i> Nohmi, Fig. 2, § 3.3 (“Figure 2 shows an image representation of a search using a car catalogue”; § 3.4(4) (“(KEY): A selectable keyword or constituent element... within a natural image”); § 3.4(5) (“Menu (MENU)”); § 3.4(6) (“Selector (SEL)”); § 4 (“searches could be run as if touching the object.”) Likewise, a customer’s selections from a MENU would provide responses to a “query” posed thereby.

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<sup>6</sup> This is exactly the type of query CWC’s expert witness, Dr. V. Thomas Rhyne, has previously said is “presented” by selecting an HTML link or menu item (itself an HTML link) on Hyundai’s website. *E.g.*, Ex. 1011, ¶¶ 67-71.

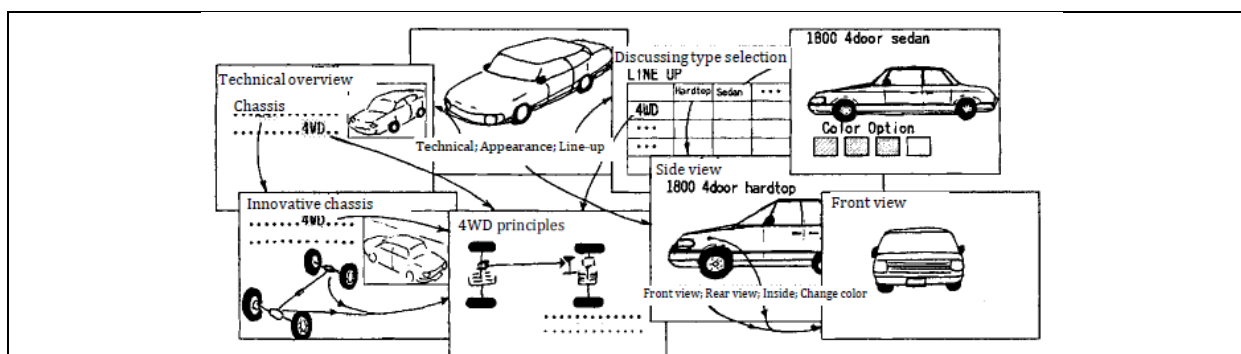


Figure 2: Outline of functions and image representation of a search or image

Nohmi, Figure 2.

**a selection device operatively connected to the user interface, and configured to present a customized proposal to the user based on the user's product interests;**

Nohmi teaches such a “**selection device**”: Nohmi's selection device is the underlying “computer code data structure” that presents a customized proposal to a user based on input from an operatively connected user interface by causing a selected “page” (a “list” of objects) to be displayed to that user. *See, e.g.*, Nohmi, § 3.4 (“In order to realize this type of structure, the system is represented by a list structure like what is illustrated in Figure 4.”), Fig. 2 (showing exemplary outputs of this computer code), Fig. 4 (illustrating how a page is generated from a page's list structure by sequentially processing and rendering all of the various elements of the page).

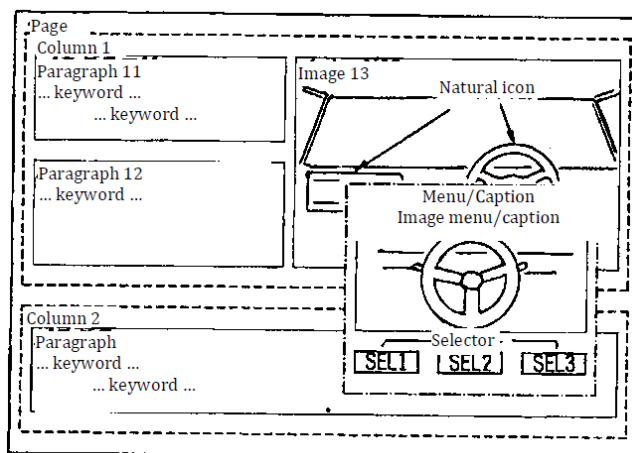
**an active database operatively connected to the selection device, and configured to store the user's product interests;**

Nohmi also teaches an “**active database**”: Nohmi's system keeps an active database (i.e., “a [collection of logically related data stored together in one or more computerized files] that is alterable based on user input”) where the user's product interests, e.g., a customer's selected color, is found so that it can be properly included in “pages” that refer to this information. *See* Nohmi, Fig. 2 (e.g., collecting the customer's car color option preference as conveyed via the selection device); § 3.1(3) (“Processing (Simulations for changing the color of the body)”; § 3.3 (“key attributes and a reference page are recorded for any element within each page”); § 3.4 (“[T]his function is used to start up the color-changing simulation”).

**a report database operatively connected to the selection device, and configured to store a plurality of page layouts;**

Nohmi teaches such a “**report database**”: Nohmi's system keeps a “database” (a “collection of logically related data stored together in one or more computerized files”) of page layouts “managed as independent objects” and

stored on “a file on the hard disk,” which must necessarily be operatively connected to the claimed selection device to enable “pages” to be rendered. Nohmi, § 3.4. This is exemplified by the sample “page” layout shown in FIG. 3 (reproduced below), which is triggered for display by Nohmi’s operatively connected selection device.



Nohmi, Figure 3.

**a static database operatively connected to the selection device, and configured to store product information;**

Nohmi teaches such a “**static database**”: Nohmi’s text and pictures can be stored on a “CD-ROM or similar packaged media,” i.e., a static, non-alterable database (“a collection of logically related data stored together in one or more computerized files that is not alterable during generation of a composite visual output”). See Nohmi, §§ 2, 3(2) (“Media retrieval functions – Hyper retrieval (text, natural images)”). As shown in Fig. 2, the system stores product information, e.g., text and natural images related to cars being sold, which is accessed when the operatively connected selection device commands “pages” to be loaded based on user input.

**a difference database operatively connected to the static database, wherein the difference database stores update information configured for transmittal to the static database; and**

Nohmi teaches distribution via a “dedicated media that uses a CD-ROM or similar packaging.” Nohmi § 2. Hill teaches a “**difference database**” that can be operatively connected to permit database content changes to be sent to computers relying on information conveyed on distributed media. Specifically, Hill describes a “data base log of changes” (revision “data base” on vendor computer 12) that is operatively connected via a modem connection to the static database (i.e., product information stored on the customer’s computer as “constant data,” see Hill, col. 18, ll. 28-46). See Hill, col. 8, ll. 18-52.



On start-up of Hill's electronic catalog software (i.e., prior to and not during generation of visual output), the customer's computer compiles and sends a "constant data revision status" to the catalog provider's computer. Hill, col. 18, ll. 28-46. If the "constant data revision status" indicates updates are needed, an "update file" is compiled and sent to the customer's computer, where it is unpacked into the appropriate subdirectories. Hill, col. 18, ll. 47-67. That "update file" contains "update information"—database content changes to the files used to present proposals regarding products to customers. Hill, col. 19, ll. 5-10 (Table 1, below), 40-45.

Revision Level	File Changed
0	All software and constant data is the same in vendor's computer 12 and customer's computer 18
1	Data file #5
1	Data file #28
1	Program file #2
2	Data file #17
3	Program file #4
4	Data file #5 (second revision)
4	Data file #6

Hill, Table 1.

**a report generator operatively connected to the active database, the report database, the selection device, and the static database, and configured to link page layout identifiers with particular data that appear in the customized proposal,**

Nohmi teaches a "**report generator**." Specifically, when displaying a "page" for the user, Nohmi processes the "page" to be displayed, i.e., a page layout from the report database to be rendered based on the customer's selection of a KEY, SELECTOR, or MENU (as directed by Nohmi's operatively connected selection device) and fills that "page" with text and images to produce a customized proposal. *See* Nohmi, Fig. 3, § 3.4 ("[T]he page ... structure for implementing the various link structures shown above, as illustrated in Figure 3, has the following stratified configuration, where each stratum is managed as an object."); *see also* § 3.4 ("In order to realize this type of structure, [a "page"] is represented by a list structure like what is illustrated in Figure 4."). This list structure provides a series of page layout identifiers, that is, placeholders for data to be inserted in the page layout.

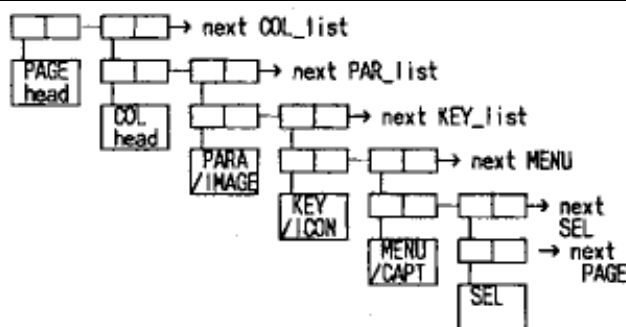


Figure 4: Representation of pages by a list structure

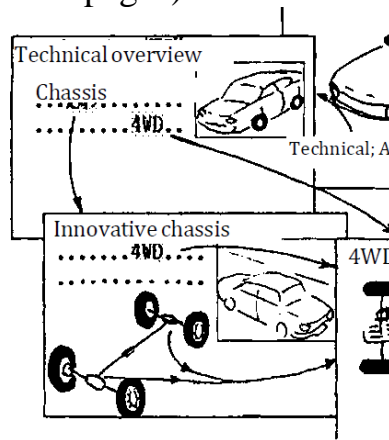
Specifically, the Nohmi system links stored “PARAs” (text) and “IMAGEs” (images) from the operatively connected static database for display based on what the page layout identifiers prescribe for a given “page” structure. Nohmi, Fig. 4. Other linkages that may be established include a “link to a program (a rule or function) and this function is used to start up the color-changing simulation,” which would alter a displayed IMAGE based on, e.g., information collected by the Nohmi system such as a user’s preferred car color (stored in Nohmi’s operatively connected active database). *See* Nohmi, § 3.4.

**wherein the customized proposal includes at least one item based upon the user’s product interests, and wherein the at least one item includes at least one of: a product picture, an environment picture, and a text portion**

The “**customized proposal**” generated by the Nohmi system includes at least one of: a product picture, an environment picture, and a text portion. Specifically, Nohmi describes in § 3.3 that “when [a] key is selected, the new page specified thereby is displayed.” This selection of a KEY—representing the user’s product interests—prompts selection of product and environment images and text to fill a “page” of the proposal. *See* Nohmi, § 3(2) (“Hyper retrieval”); § 3.4 (“Data structure for pages,” separate elements for Paragraph “PARA” and Image “IMAGE”).

Exemplary product images selected include the sedan and the hardtop depicted in Fig. 2. Exemplary environment images include the road image depicted on the “Innovative chassis” “page” in Fig. 2; *see also* Nohmi, § 2(3) (“image information ... compositing”); § 3.1(3) (“Image processing... Segmentation ... cutting out the body of a car”). Exemplary text segments “comprised of a description of product specifications and performances” are represented by the dotted lines on the “Innovative chassis” “page,” as in a “product catalog,” of which Nohmi’s system is a “digital conversion.” *See* Nohmi § 2; Fig. 2 (dotted lines on “pages” discussing “Technical overview” and “4WD principles,” table

of specifications on “LINE UP” “page”).



Nohmi, Figure 2 (excerpt).

**2. The computer system of claim 1, wherein the user interface is configured to query the user regarding interests of the user.**

Nohmi teaches this limitation. As established above with respect to the “user interface” limitation of claim 1, Nohmi teaches querying the user regarding her “product interests.” A recitation of “interests” alone, which has a broader connotation, necessarily includes such “product interests.” *See* Fox 2nd Decl., ¶ 97.

**3. The computer system of claim 2, wherein the query includes at least one of the following query portions: a first query portion regarding selecting the product, a second query portion regarding an intended use for the product, a third query portion regarding a request for technical information, and a fourth query portion regarding selecting a product option by the user.**

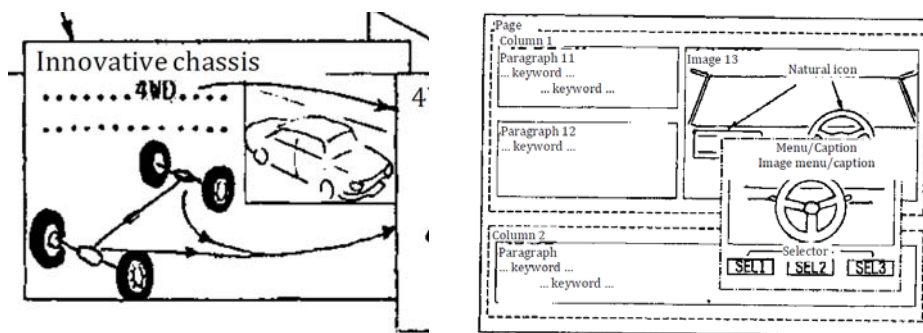
Nohmi teaches this limitation. As established above with respect to the “user interface” limitation of claim 1, Nohmi teaches querying the user regarding her product interests. More particularly, Nohmi teaches querying for at least one of selecting the product (a link to the “LINE UP” page), an intended use for the product (a link for “4WD”), a request for technical information (a link to the “Technical overview” page), or a product option (a link for displaying a “Hardtop” visual).

**4. The computer system of claim 1, wherein the selection device is configured to create a proposal for the user by using information regarding interests of the user obtained via the user interface.**

Nohmi teaches this limitation. As established above with respect to the “selection device” limitation of claim 1, Nohmi teaches creating a proposal for the user using her “product interests.” A recitation of “interests” alone, which has a broader connotation, necessarily includes such “product interests.” *See* Fox 2nd Decl., ¶ 99.

**5. The computer system of claim 4, wherein the proposal includes at least one product picture, at least one environment picture, and at least one text portion based upon information regarding interests of the user obtained via the user interface.**

Nohmi teaches this limitation. Specifically, the proposals generated by Nohmi can include at least one product picture, at least one environment picture, and at least one text portion based upon information regarding interests of the user obtained via the user interface. For instance, in response to the user expressing interest in the “Innovative chassis” of a product, the “Innovative chassis” page is displayed which includes a composite image of a car (product image) on a road (environment image), a separate image of the car chassis (product image), and a text portion describing “4WD.” See Nohmi, Figs. 2 and 3 (showing page layout), below.

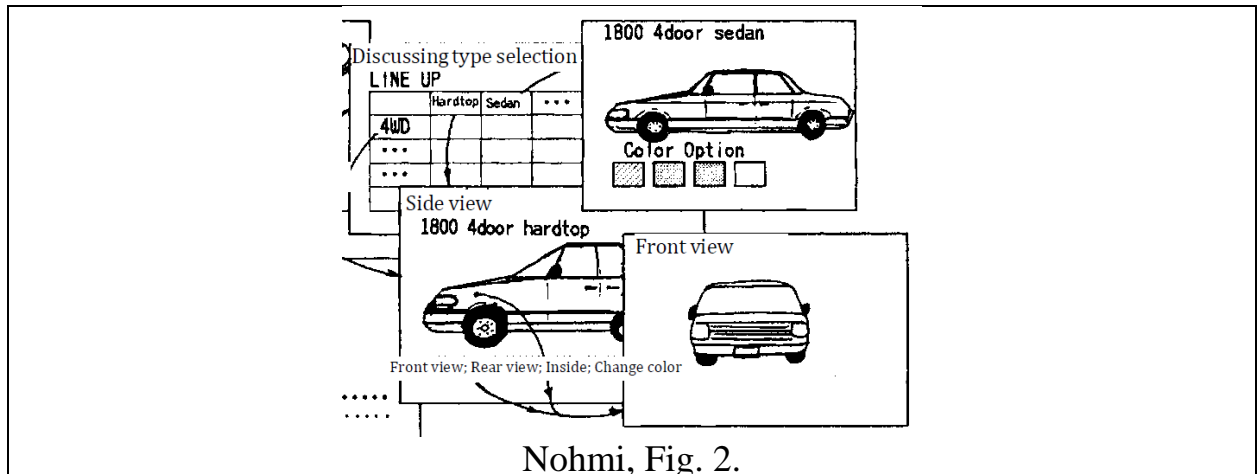


**6. The computer system of claim 1, wherein the active database is configured to store information regarding interests of the user obtained via the user interface.**

Nohmi teaches this limitation. As established above with respect to the “**active database**” limitation of claim 1, Nohmi teaches storing a user’s “product interests.” A recitation of “interests” alone, which has a broader connotation, necessarily includes such “product interests.” See Fox 2nd Decl., ¶ 101.

**7. The computer system of claim 6, wherein the information stored in the active database includes information received from the user in response to at least one of the following query portions: a first query portion regarding selecting the product, a second query portion regarding an intended use for the product, a third query portion regarding a request for technical information, and a fourth query regarding a selection of a product option by the user.**

Nohmi teaches this limitation. As established above with respect to the “**active database**” limitation of claim 1 and the multi-part query limitation of claim 3 above, Nohmi teaches collecting and storing a user’s car color preference, which is a “product option.” See Nohmi, Fig. 2 below (excerpted).



Nohmi, Fig. 2.

**8. The computer system of claim 1, wherein the report database stores a plurality of page layouts.**

This limitation does not appear to have any different scope than the “**report database**” limitation of claim 1. *See* Fox 2nd Decl., ¶ 103. In any event, Nohmi teaches this limitation as established above with respect to the “**report database**” limitation of claim 1. Specifically Nohmi keeps a “database” (a “collection of logically related data stored together in one or more computerized files”) of page layouts “managed as independent objects” and stored on “a file on the hard disk.” Nohmi, § 3.4.

**10. The computer system of claim 1, wherein the static database stores a plurality of product pictures, a plurality of environment pictures, and a plurality of text portions, wherein each text portion is associated with at least one of a product and a environment.**

Nohmi teaches this limitation. As established above with respect to the “**static database**” limitation of claim 1, Nohmi separately stores for retrieval product pictures, environment pictures, and text portions associated with at least one of a product and a environment as exemplified in Fig. 2. *See also* Nohmi, § 3(2) (“Media Retrieval functions... Hyper retrieval (text, natural images)”).

**12. The computer system of claim 1, wherein the report generator is configured to: read a page layout from the report database, read a product picture, an environment picture, and a text portion selected by the selector from the static database based upon information from the active database, and generate a report by inserting the product picture, the environment picture, and the text portion into the page layout.**

Nohmi teaches this limitation. As established above with respect to the “**report generator**” limitation of claim 1, Nohmi’s “report generator” reads the structure of a page layout to be rendered based on the customer’s selection of a KEY, SELECTOR, or MENU, determines which stored “PARAs” (text) and

“IMAGES” (images) are to be included in the “page” display based on information in the “active database” (i.e., the user’s selected car color), retrieves those stored “PARAs” (text) and “IMAGES” (images), and generates the “page” for display by inserting the product picture, the environment picture, and the text portion into the page layout. *See* Nohmi, § 3(2) (“Media Retrieval functions... Hyper retrieval (text, natural images)”), Fig. 3 (showing page structure).

**14. The computer system of claim 1, wherein the at least one item based upon the user’s product interests includes a product picture, an environment picture, and a text portion.**

This limitation does not appear to have any different scope than the “customized proposal” limitation of claim 1. *See* Fox 2nd Decl., ¶ 106. In any event, Nohmi teaches this limitation as established above with respect to the “customized proposal” limitation of claim 1. Specifically, Nohmi teaches output based on user interests that includes at least one of a product picture, an environment picture, and a text portion. *See* Nohmi, § 3(2) (“Hyper retrieval”); § 3.3 (“when [a] key is selected, the new page specified thereby is displayed.”); § 3.4 (“Data structure for pages,” separate elements for Paragraph “PARA” and Image “IMAGE”).

**15. The computer system of claim 1, wherein the query of the user interface comprises the following query portions: a first query portion regarding selecting the product, a second query portion regarding an intended use for the product, a third query portion regarding a request for technical information, and a fourth query portion regarding selecting a product option by the user.**

As discussed above with respect to claim 3, Nohmi teaches each of the claimed query portions individually. Hill teaches generating a query from multiple selection criteria each corresponding to design characteristics of products contained in Hill’s electronic catalog system. Hill, col. 16, ll. 11-22.

**16. The computer system of claim 1, wherein the selection device is further configured to create a proposal for the user by using information regarding interests of the user obtained via the user interface, and wherein the proposal includes at least one product picture, at least one environment picture, and at least one text portion based upon information regarding interests of the user obtained via the user interface.**

This limitation does not appear to have any different scope than the “selection device” limitations of claims 4 and 5. *See* Fox 2nd Decl., ¶ 108. In any event, Nohmi teaches these limitations as established above with respect to the “selection device” limitation of claims 4 and 5. Specifically, as established above with respect to the “selection device” limitation of claim 1, Nohmi teaches creating a proposal for the user using her “product interests.” A recitation of

“interests” alone, which has a broader connotation, necessarily includes such “product interests.” *See id.* The proposals generated by Nohmi can include at least one product picture, at least one environment picture, and at least one text portion based upon information regarding interests of the user obtained via the user interface. For instance, in response to the user expressing interest in the “Innovative chassis” of a product, the “Innovative chassis” page is displayed which includes a composite image of a car (product image) on a road (environment image), a separate image of the car chassis (product image), and a text portion describing “4WD.” *See* Nohmi, Figs. 2 and 3 (showing page layout)

**17. The computer system of claim 1, wherein the active database is further configured to store information regarding interests of the user obtained via the user interface, and wherein the information stored in the active database includes information received from the user in response to at least one of the following query portions: a first query portion regarding selecting the product, a second query portion regarding an intended use for the product, a third query portion regarding a request for technical information, and a fourth query regarding a selection of a product option by the user.**

This limitation does not appear to have any different scope than the “active database” limitations of claims 6 and 7. *See* Fox 2nd Decl., ¶ 109. In any event, Nohmi teaches these limitations as established above with respect to the “active database” limitation of claims 6 and 7. Specifically, as established above with respect to the “active database” limitation of claim 1, Nohmi teaches storing a user’s “product interests.” A recitation of “interests” alone, which has a broader connotation, necessarily includes such “product interests.” *See id.* Nohmi also teaches collecting and storing a user’s car color preference, which is a “product option.” *See* Nohmi, Fig. 2.

**B. Dependent Claims 9 and 18 Are Obvious under § 103 over Nohmi in view of Hill in further view of Miyaoka**

The Nohmi and Hill combination also renders claims 9 and 18 obvious in further view of Miyaoka. *See* Fox 2nd Decl., ¶¶ 110-113. Claims 9 and 18 relate to specific aspects of the page layouts stored in the “report database” of claim 1.

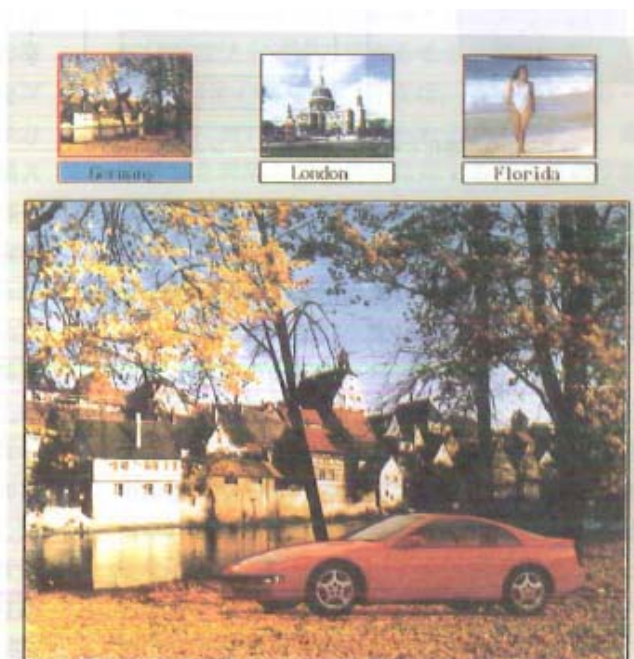
Miyaoka, which elaborates on additional capabilities of systems such as that described in Nohmi, is prior art under 35 U.S.C. § 102(b). *See* Ex. 1003. Indeed,

Miyaoka states directly that “there is an increased need for systems to effectively provide product information and support sales. For example, given the variation in product types, colors, patterns, optional components, etc., the trick is to provide support so that the consumer obtains the necessary product information in an appropriate and speedy manner and can easily make a selection that meshes with his own desires.” Miyaoka, § 2.1. In particular, Miyaoka teaches a separate user selection of both the product and environment in § 2.1, Photo 1, and the subsequent display of the selected product in the selected environment as a composite image. The addition of Miyaoka to the proposed Nohmi and Hill combination would have been obvious to—and within the knowledge of—one of ordinary skill, as Nohmi and Miyaoka are actually from the *same* endeavor (both are co-authors on the references). Fox 2nd Decl., ¶ 113. Further, there is no incompatibility between the references. *Id.*

<b>’904 Claim Language and Correspondence to Nohmi/Hill/Miyaoka</b>
<b>9. The computer system of claim 8, wherein at least one of the page layouts is configured to display a product picture of a product selected by the user, an environment picture of an environment selected by the user, and a text portion, wherein the text portion is associated with at least one of the product and the environment.</b>
As noted above with respect to claim 5, Nohmi alone teaches a page layout (e.g. “Innovative chassis”) which includes a product picture of a product selected by the user (the product being viewed), an environment picture, and a text portion associated with at least the product. Miyaoka further teaches separately selecting one of a plurality of environments (e.g., “Germany,” “London,” “Florida”) which is used to create a composite image, that is, “an image of a scene showing a product placed in the environment in which it is actually used with the product



colors or patterns being changed. This is the part where the advantages of digital image processing can be maximized.” See Miyaoka, § 2.1.



Miyaoka, Photo 1.

**18. The computer system of claim 1, wherein at least one of the page layouts of the report database is configured to display a product picture of a product selected by the user, an environment picture of an environment selected by the user, and a text portion, and wherein the text portion is associated with at least one of the product and the environment.**

As noted above with respect to claims 5 and 9, the proposed Nohmi, Hill and Miyaoka combination teaches this limitation. Although claim 9 depends from claim 8 and this claim depends directly from claim 1, claim 8 as discussed above does not appear to have any different scope from the “report database” limitation of claim 1. See Fox 2nd Decl., ¶ 114. Nohmi teaches a “report database” of page layouts, see Nohmi, § 3.4, and a page layout (e.g. “Innovative chassis”) which includes a product picture of a product selected by the user (the product being viewed), an environment picture, and a text portion associated with at least the product. Miyaoka further teaches separately selecting the environment, as described above with respect to claim 9.

**C. Dependent Claims 11 and 19 Are Obvious under § 103 over  
Nohmi in view of Hill in further view of the Complete Car Cost  
Guide**

The Nohmi and Hill combination also renders claims 11 and 19 obvious in further view of the Complete Car Cost Guide. *See* Fox 2nd Decl., ¶¶ 115-122. Claims 11 and 19 relate to specific additional information stored in the “static database” of claim 1.

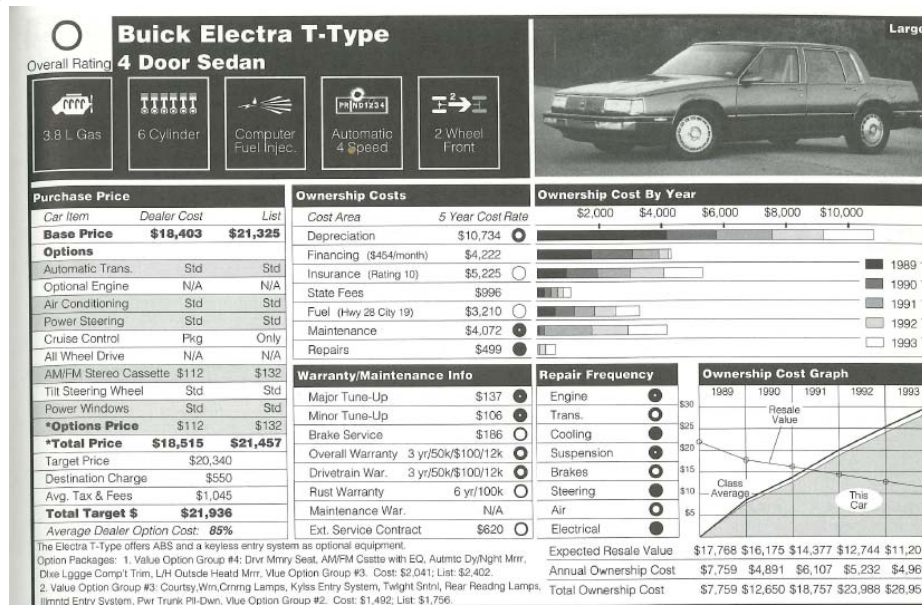
The Complete Car Cost Guide (Ex. 1004) is an example of a type of omnibus “product catalog” known in the prior art that the Nohmi system was designed to computerize to facilitate efficient retrieval of product information by interested customers. *See* Nohmi, §2, *see also* Fox 2nd Decl., ¶ 53. It is prior art under 35 U.S.C. § 102(b) and was not previously considered by the USPTO.

As the information detailed in the Complete Car Cost Guide was available in database form, *see* Complete Car Cost Guide, p. 3, one of ordinary skill would have been motivated to expand the information stored in the “static database” of Nohmi’s system to include that which is discussed in the Complete Car Cost Guide, adding further known and useful information that would have improved the effectiveness of proposals generated by Nohmi’s system. Fox 2nd Decl., ¶ 120. Further, there is no incompatibility between the references. *Id.*

## '904 Claim Language and Correspondence to Nohmi/Hill/Complete Car Cost Guide

**11. The computer system of claim 10, wherein the static database further stores a plurality of product technical detail specifications, a plurality of price specifications, and a plurality of life cycle specifications.**

As discussed above with respect to claim 10, Nohmi teaches a “static database” containing product pictures, environment pictures, and text portions associated with at least one of a product and an environment. Nohmi further teaches product technical detail specifications as would be displayed on a “LINE UP” page listing available models and described on a “Technical overview” page (both shown in Fig. 2 of Nohmi). The Complete Car Cost Guide also teaches product technical detail specifications in the form of lists of the technical features available for each car model, price specifications in the form of both original MSRP and current estimated selling prices for each car model, and life cycle specifications corresponding to projected ownership costs for the product, including depreciation, annual maintenance, and projected repair costs. *See* Complete Car Cost Guide, at 19, 20 (excerpted below, *see* Ownership Costs subtable).



Complete Car Cost Guide, p. 20.

**19. The computer system of claim 1, wherein the static database stores a plurality of product pictures, a plurality of environment pictures, and a plurality of text portions, wherein each text portion is associated with at least one of a product and a [sic] environment, and wherein the static database further stores a plurality of product technical detail specifications, a plurality of price specifications, and a plurality of life cycle specifications.**

As noted above with respect to claims 10 and 11, the proposed Nohmi, Hill and Complete Car Cost Guide combination teaches this limitation. Although claim 11 depends from claim 10 and this claim depends directly from claim 1, claim 19 appears to simply combine the limitations of claims 10 and 11. *See* Fox 2nd Decl., ¶ 122. In any event, the Nohmi, Hill and Complete Car Cost Guide combination teaches this limitation because Nohmi teaches a “static database” containing product pictures, environment pictures, and text portions associated with at least one of a product and a environment, and the Complete Car Cost Guide further teaches such a database could also include technical detail specifications, price specifications, and a life cycle specifications, as described above with respect to claim 11.

**D. Dependent Claims 13 and 20 Are Obvious under § 103 over Nohmi in view of Hill in further view of Von Kohorn**

The Nohmi and Hill combination also renders claims 13 and 20 obvious in further view of Von Kohorn. *See* Fox 2nd Decl., ¶¶ 124-131. Claims 13 and 20 relate to the inclusion of “salesperson information” in the output of the “report generator.” As discussed above, Von Kohorn (Ex. 1005) describes a computerized system adapted to interact with viewers of a “home shopping” television broadcast to provide customized printouts regarding products users have expressed interest in purchasing. It is prior art under 35 U.S.C. § 102(b) and was not previously considered by the USPTO. One of the particular items included in Von Kohorn’s customized printouts is a telephone number enabling contact with a salesperson for purchase of merchandise. *See* Von Kohorn, col. 49, ll. 15-19.

One of ordinary skill would have been motivated to combine the teachings of Von Kohorn with the above-described Nohmi and Hill combination because they are from the same field and targeted at the same problem: presenting

customized sales materials regarding products to customers. It would have been obvious to add functionality to the Nohmi “report generator” for including salesperson contact information within the customized proposal, thus increasing opportunities for a successful sale to be made to the customer. *See, e.g.,* Von Kohorn, col. 29, ll. 15-25; *see also* Fox 2nd Decl., ¶ 127. Further, there is no incompatibility between the references. *Id.*

<b>'904 Claim Language and Correspondence to Nohmi/Hill/Von Kohorn</b>
<p><b>13. The computer system of claim 12, wherein the report generator is further configured to: insert salesperson information into the report, and transmit the report.</b></p> <p>As discussed above with respect to claim 12, Nohmi teaches reading a page layout from the report database, reading a product picture, an environment picture, and a text portion selected by the selector from the static database based upon information from the active database, and generating a report by inserting the product picture, the environment picture, and the text portion into the page layout. <i>See</i> Nohmi, § 3(2) (“Media Retrieval functions... Hyper retrieval (text, natural images)”), Fig. 3 (showing page structure).</p> <p>Von Kohorn teaches generating customized printouts of product information with inserted “salesperson information,” e.g., a telephone number enabling contact with a salesperson for purchase of merchandise. <i>See</i> Von Kohorn, col. 49, ll. 15-19. As to “transmit[ing] the report,” which requires “send[ing] the report for printing,” Hill further teaches “build[ing] a data sheet print file at block 368 using the integrated constant data and variable data. Therefore the data sheet includes accurate data having the most recent update included on vendor’s computer 12. At this point, a customer can print a data sheet on printer 24 as illustrated at block 370.” Hill, col. 21, ll. 44-48.</p> <p>Even under a broader construction of the term “transmit the report,” Nohmi separately teaches, following construction of customized output (i.e., a “page”) that the output is transmitted to the workstation display. <i>See</i> Nohmi, Figs. 2 and 3, § 3.1 (stating the “multimedia presentation system ... [is] integrated onto a work station (HITAC-2050, 2050G).”).</p>

**20. The computer system of claim 1, wherein the report generator is further configured to: (i) read a page layout from the report database, (ii) read a product picture, an environment picture, and a text portion selected by the selector from the static database based upon information from the active database, (iii) generate a report by inserting the product picture, the environment picture, the text portion, and salesperson information into the page layout, and (iv) transmit the report.**

As noted above with respect to claims 12 and 13, the proposed Nohmi, Hill and Von Kohorn combination teaches this limitation. Although claim 13 depends from claim 12 and this claim depends directly from claim 1, claim 20 appears to simply combine the limitations of claims 12 and 13. *See* Fox 2nd Decl., ¶ 130. In any event, the Nohmi, Hill and Von Kohorn combination teaches this limitation because Nohmi teaches a “report generator” performing steps (i) and (ii) as described above with respect to claim 12, Von Kohorn teaches step (iii) as described above with respect to claim 13, and Hill or Nohmi teach step (iv) as described above with respect to claim 13.

**E. Independent Claim 21 Is Obvious under § 103 over Nohmi in view of Hill in further view of Miyaoka, the Complete Car Guide, and Von Kohorn**

As discussed above in Section I(D), independent claim 21 is an amalgam of various features recited in claims 1-20. *See also* Fox 2nd Decl., ¶¶ 65-68. All of these features are taught by the references discussed in subsections A-D above. One of ordinary skill would have been motivated to combine the teachings of Miyaoka, the Complete Car Guide, and Von Kohorn with the proposed Nohmi and Hill combination because they are all from the same field and targeted at the same problem: presenting sales materials regarding products to customers. It would have been obvious to add functionality from any of these references to the primary combination as an exercise of ordinary creativity. Fox 2nd Decl., ¶ 132; *see also KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742 (2007) (“[I]n many cases a

person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.”) Further, there is no incompatibility between the references. Fox 2nd Decl., ¶ 132.

<b>’904 Claim Language and Correspondence to Nohmi/Hill/Miyaoka/Complete Car Cost Guide/Von Kohorn</b>
<b>21. A computer system for facilitating sales of a product to a user, the computer system comprising:</b>
This is the same preamble contained in claim 1, which is taught by at least Nohmi as discussed above.
<b>a user interface configured to query the user regarding interests of the user, wherein the query comprises the following query portions: a first query portion regarding selecting the product, a second query portion regarding an intended use for the product, a third query portion regarding a request for technical information, and a fourth query portion regarding selecting a product option by the user;</b>
This is the same “ <u>user interface</u> ” limitation contained in claims 1, 2, and 15, which is taught by at least Nohmi and Hill as discussed above.
<b>a selection device operatively connected to the user interface, wherein the selection device is configured to create a proposal for the user by using information regarding interests of the user obtained via the user interface, wherein the proposal includes at least one product picture, at least one environment picture, and at least one text portion based upon information regarding interests of the user obtained via the user interface;</b>
This is the same “ <u>selection device</u> ” limitation contained in claims 1, 4, and 5, which is taught by at least Nohmi as discussed above.
<b>an active database operatively connected to the selection device, wherein the active database is configured to store information regarding interests of the user obtained via the user interface, and wherein the information stored in the active database includes information received from the user in response to at least one of the following query portions: a first query portion regarding selecting the product, a second query portion regarding an intended use for the product, a third query portion regarding a request for technical information, and a fourth query regarding a selection of a product option by the user;</b>
This is the same “ <u>active database</u> ” limitation contained in claims 1, 6, and 7, which is taught by at least Nohmi as discussed above.

**a difference database operatively connected to the static database, wherein the difference database stores update information configured for transmittal to the static database;**

This is the same “difference database” limitation contained in claim 1, which is taught by at least Hill as discussed above.

**a report database operatively connected to the selection device, wherein the report database stores a plurality of page layouts, wherein at least one of the page layouts is configured to display a product picture of a product selected by the user, an environment picture of an environment selected by the user, and a text portion, and wherein the text portion is associated with at least one of the product and the environment;**

This is the same “report database” limitation contained in claims 1, 8, and 9 which is taught by at least Nohmi and Miyaoka as discussed above.

**a static database operatively connected to the selection device, wherein the static database stores a plurality of product pictures, a plurality of environment pictures, and a plurality of text portions, wherein each text portion is associated with at least one of a product and a environment, and wherein the static database further stores a plurality of product technical detail specifications, a plurality of price specifications, and a plurality of life cycle specifications;**

This is the same “static database” limitation contained in claims 1, 10, and 11 which is taught by at least Nohmi and the Complete Car Cost Guide as discussed above.

**and a report generator operatively connected to the active database, the report database, the selection device, and the static database, wherein the report generator is configured to: (i) read a page layout from the report database, (ii) read a product picture, an environment picture, and a text portion selected by the selector from the static database based upon information from the active database, (iii) generate a report by inserting the product picture, the environment picture, the text portion, and salesperson information into the page layout, and (iv) transmit the report.**

This is the same “report generator” limitation contained in claims 1, 12, and 13 which is taught by at least Nohmi, Hill and Von Kohorn as discussed above.



**F. Independent Claim 1 and Dependent Claims 2-8, 10, 12, and 14-17  
Are also Obvious under § 103 over Nohmi in view of Hill in  
further view of Miyaoka**

As noted above, the Nohmi and Hill combination renders obvious independent claim 1 as well as dependent claims 2-8, 10, 12, and 14-17. These claims also would be obvious in view of a Nohmi, Hill, and Miyaoka combination should the PTAB make a finding of fact that Nohmi's collecting color preferences does not evince an "active database," as required by claims 1, 6, 7, and 17. Miyaoka specifically teaches selection and storing of environment information as well as a connection to system facilitating "usual business processes that take place for products customized by a consumer such as providing a quote, placing orders, etc." that would collect such customer input. *See* Miyaoka, § 2.1; *see also* Fox 2nd Decl., ¶¶ 133-137. As discussed above, the addition of Miyaoka to the proposed Nohmi and Hill combination would have been obvious to—and within the knowledge of—one of ordinary skill, as Nohmi and Miyaoka are actually from the *same* endeavor (both are co-authors on the references). Fox 2nd Decl., ¶¶ 113, 133.

<b>'904 Claim Language and Correspondence to Nohmi/Hill/Miyaoka<sup>7</sup></b>
<b>1. ... an active database operatively connected to the selection device, and configured to store the user's product interests; ...</b>
Miyaoka teaches an “ <b><u>active database</u></b> ”: First, Miyaoka teaches collecting user input (product customizations indicated by links selected and followed) and electronically storing that information so that it can be reflected in the presentation (e.g., a selected environment in which the product is to be used). <i>See</i> Miyaoka, § 2.1, Photo 1. Second, Miyaoka also teaches collecting user input and electronically storing product interests to facilitate “the usual business processes take place for a product customized by a consumer such as providing a quote, placing orders, etc.” <i>Id.</i> Both of these constructs are active databases, that is, logically related data stored together in one or more computerized files that is alterable based on user input.
<b>6. The computer system of claim 1, wherein the active database is configured to store information regarding interests of the user obtained via the user interface.</b>
Miyaoka teaches this limitation. As established above with respect to the “ <b><u>active database</u></b> ” limitation of claim 1, Miyaoka teaches storing a user's “product interests.” A recitation of “interests” alone, which has a broader connotation, includes such “product interests.” <i>See</i> Fox 2nd Decl., ¶ 134.
<b>7. The computer system of claim 6, wherein the information stored in the active database includes information received from the user in response to at least one of the following query portions: a first query portion regarding selecting the product, a second query portion regarding an intended use for the product, a third query portion regarding a request for technical information, and a fourth query regarding a selection of a product option by the user.</b>
Miyaoka teaches this limitation. As established above with respect to the “ <b><u>active database</u></b> ” limitation of claim 1, Miyaoka teaches collecting at least information relating to an intended use for the product, that is, the environment in which the product will be used. <i>See</i> Miyaoka, § 2.1, Photo 1 (selecting from among “Germany,” “London,” “Florida”).
<b>17. The computer system of claim 1, wherein the active database is further</b>

<sup>7</sup> The other elements of claims 1-8, 10, 12, and 14-17 taught by Nohmi and Hill are discussed above in Section II(A).

**configured to store information regarding interests of the user obtained via the user interface, and wherein the information stored in the active database includes information received from the user in response to at least one of the following query portions: a first query portion regarding selecting the product, a second query portion regarding an intended use for the product, a third query portion regarding a request for technical information, and a fourth query regarding a selection of a product option by the user.**

As discussed above with respect to claims 6 and 7, Miyaoka teaches this limitation as it appears to have the same scope as the limitations of claims 6 and 7 combined. *See* Fox 2nd Decl., ¶ 137.

**G. Independent Claim 1 and Dependent Claims 2-8, 10, 12, and 14-17 Are also Obvious under § 103 over Nohmi in view of Hill in further view of Kobayashi**

As noted above, the Nohmi and Hill combination renders obvious independent claim 1 as well as dependent claims 2-8, 10, 12, and 14-17. These claims also would be obvious in view of a Nohmi, Hill, and Kobayashi combination should the PTAB make adverse findings of fact regarding Nohmi's teaching of a "report database," that is, separate logical storage of a plurality of page layouts, as required by claims 1 and 8. Kobayashi (Ex. 1006) strengthens and supplements Nohmi's teachings as to at least this claim element. *See* Fox 2nd Decl., ¶¶ 138-140. Kobayashi specifically teaches a system where the "managing unit of the information display output is a page" and "data serving as the origin for carrying out the display and output of information, including ... text, graphics, and images, is configured to be a component file of each element in a file different from the file corresponding to the page." Kobayashi, Claims 1, 3; *see also* Fig. 5. That is, Kobayashi teaches an organized collection of files relating to its "pages"—

i.e., a database of page layouts—separate from its organized collection of files relating to the information appearing on those “pages.” Fox 2nd Decl., ¶¶ 138-140.

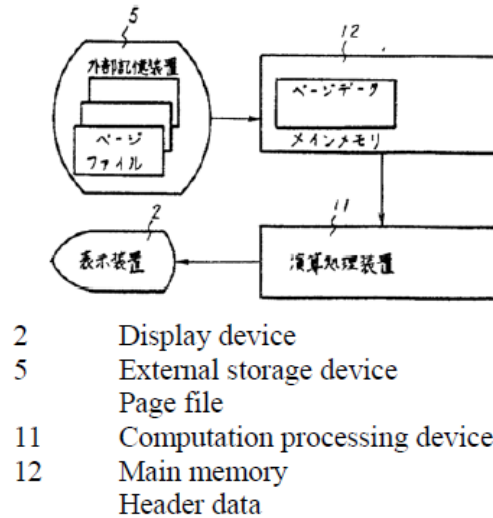
The addition of Kobayashi to the Nohmi and Hill combination would have been obvious to—and within the knowledge of—one of ordinary skill, as Nohmi and Kobayashi are actually from the same endeavor (Nohmi is a co-author on both). Fox 2nd Decl., ¶ 139. Further, there is no incompatibility between the references. *Id.*

<b>'904 Claim Language and Correspondence to Nohmi/Hill/Kobayashi<sup>8</sup></b>
<b>1. ... a report database operatively connected to the selection device, and configured to store a plurality of page layouts; ...</b>
Kobayashi teaches a “ <b>report database</b> ”. Kobayashi specifically teaches a system where the “managing unit of the information display output is a page” and “data serving as the origin for carrying out the display and output of information, including ... text, graphics, and images, is configured to be a component file of each element in a file different from the file corresponding to the page.” Kobayashi, Claims 1, 3; <i>see also</i> Fig. 3. Describing Fig. 3, Kobayashi explains that the “drawing illustrat[es] the flow of data in which the page data stored in the external storage device 5 is read out and displayed; firstly, the page data is read out from the external storage device 5 to a main memory 12 of the processing device.” Kobayashi, p. 5.

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<sup>8</sup> The other elements of claims 1-8, 10, 12, and 14-17 taught by Nohmi and Hill are discussed above in Section II(A).

FIG. 3



Kobayashi, Fig. 3.

**8. The computer system of claim 1, wherein the report database stores a plurality of page layouts.**

Kobayashi teaches this limitation as established above with respect to the “report database” limitation of claim 1. This limitation does not appear to have any different scope. *See* Fox 2nd Decl., ¶ 140.

**H. Independent Claim 1 and Dependent Claims 2-8, 10, 12, 14, and 16-17 Are also Obvious under § 103 over Nohmi in view of Roux**

As noted above, Nohmi renders obvious independent claim 1 as well as dependent claims 2-8, 10, 12, 14, and 16-17 with the addition of a “difference database” from Hill. Should the PTAB make adverse findings of fact regarding Hill’s teaching of a “difference database,” that is, a database storing changes to database content, one of ordinary skill would also have looked to Roux (Ex. 1007) for such teaching. Fox 2nd Decl., ¶ 141. Roux teaches several techniques for updating databases stored on static CD-ROM (such as that provided by Nohmi) and discusses specifically why such databases need updates, providing the

necessary motivation one of ordinary skill would need to combine Roux with, e.g., Nohmi to arrive at the claimed invention. Roux, p. 1-2, 12-14; *see also* Fox 2nd Decl., ¶ 141. More particular, Roux describes a technique in which new material (technically a separate “database” of content changes) and an updated index are provided to integrate the material in the original database with the new. Roux, p. 13-14. This is all that is required to meet the “difference database” limitation of claim 1, and there is no incompatibility between the references. *Id.*

<b>’904 Claim Language and Correspondence to Nohmi/Roux<sup>9</sup></b>
<b>1. ... a difference database operatively connected to the static database, wherein the difference database stores update information configured for transmittal to the static database; ...</b>
Nohmi teaches distribution via a “dedicated media that uses a CD-ROM or similar packaging.” Nohmi § 2. Roux teaches techniques for updating CD-ROM based databases, including providing a “ <b><u>difference database</u></b> ,” that is, a database that stores database content changes configured for transmittal to the static database. Roux, p. 1-2, 12-14.
Roux specifically teaches: “Perhaps the most effective update method is to provide updated material” (that is, a “difference database” – a separate collection of database content changes stored together in one or more computerized files) “and indexes for the entire database. The reprocessed index will contain all references to old and new information.” Roux, p. 13-14. Roux further describes how such updates are “configured for transmittal” to an existing static database on, e.g., tangible media such as floppy disks, <i>see</i> Roux, p. 6. Roux also teaches how such updates may be delivered over a packet-switched network. <i>See</i> Roux, p. 9.

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<sup>9</sup> The other elements of claims 1-8, 10, 12, 14, and 16-17 taught by Nohmi are discussed above in Section II(A).

## CONCLUSION

For the foregoing reasons, *inter partes* review of claims 1-21 of U.S. Patent No. 8,121,904 is respectfully requested—and amply warranted.

Respectfully submitted,

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**CERTIFICATE OF SERVICE ON PATENT OWNER**  
**UNDER 37 C.F.R. § 42.105(a)**

Pursuant to 37 C.F.R. §§ 42.8(e) and 42.105(b), the undersigned certifies that on the 4th day of March 2013 a complete and entire copy of this Second Petition for Inter Partes Review and all supporting exhibits were provided via Federal Express, postage prepaid, to the Patent Owner by serving the correspondence address of record for the '904 Patent:

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