

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.,
Petitioner,

v.

REMBRANDT SOCIAL MEDIA, L.P.,
Patent Owner.

Case IPR2014-00415
Patent 6,415,316

Before PHILLIP J. KAUFFMAN, JENNIFER S. BISK, and
MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

CLEMENTS, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Facebook, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1, 4, 17, 18, 20, and 26 (“the challenged claims”) of U.S. Patent No. 6,415,316 (Ex. 1001, “the ’316 patent”). Paper 1 (“Pet.”). Rembrandt Social Media, L.P. (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides as follows:

THRESHOLD.—The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

Upon consideration of the Petition and Preliminary Response, we determine that the information presented by Petitioner establishes that there is a reasonable likelihood that Petitioner would prevail in showing unpatentability of the challenged claims of the ’316 patent. Accordingly, pursuant to 35 U.S.C. § 314, we institute an *inter partes* review of claims 1, 4, 17, 18, 20, and 26 of the ’316 patent.

A. Related Proceedings

Petitioner and Patent Owner indicate that the ’316 patent is involved in one co-pending district court case: *Rembrandt Social Media, L.P. v. Facebook, Inc.*, Case No. 13-CV-00158 TSE (E.D. Va.), filed February 4, 2013, and served on February 6, 2013. Pet. 1; Paper 5, 2. The case is

currently stayed pending an appeal to the U.S. Court of Appeals for the Federal Circuit. Pet. 1; Paper 5, 2.

B. The '316 Patent

The '316 patent relates generally to computer networks and, specifically, to a method and apparatus for implementing a diary of web pages on a computer network. Ex. 1001, 1:19-22. According to the '316 patent, there was a need for a way for users to keep track of locations that they have visited in a more visual and memorable way. *Id.* at 1:65-67.

To address this need, the '316 patent discloses a method and apparatus for implementing a web page diary. *Id.* at Title. The diary allows a diary owner to organize information, including links to websites and other content, like a book. *Id.* at 4:62-64. A diary has a book design that determines the graphics and layout of content within pages of a diary. *Id.* at 5:9-10. The book design includes page designs. *Id.* at 5:11. Page designs define the visual and audible appearance of the page, provides slots for content entries or objects, and determines the size and location of such slots within the page. *Id.* at 5:14-17. Diary owners can insert content objects into pages. *Id.* at 5:18. When a content object is inserted into a page, it is displayed in one of the slots provided by the page design of the page. *Id.* at 5:19-20. A content object can be any type of object, including text, bookmarks, images, programs, movies, etc. *Id.* at 5:20-22. The book design and book content are independent. *Id.* at 5:26-27. Diary software dynamically combines the diary's book design and book content to present a cohesive view of the "book." *Id.* at 5:32-34. The diary may enforce privacy rules on any part or level of the book—i.e., book, section, page, or individual content object. *Id.* at 5:55-57.

Figure 1(b) is reproduced below.

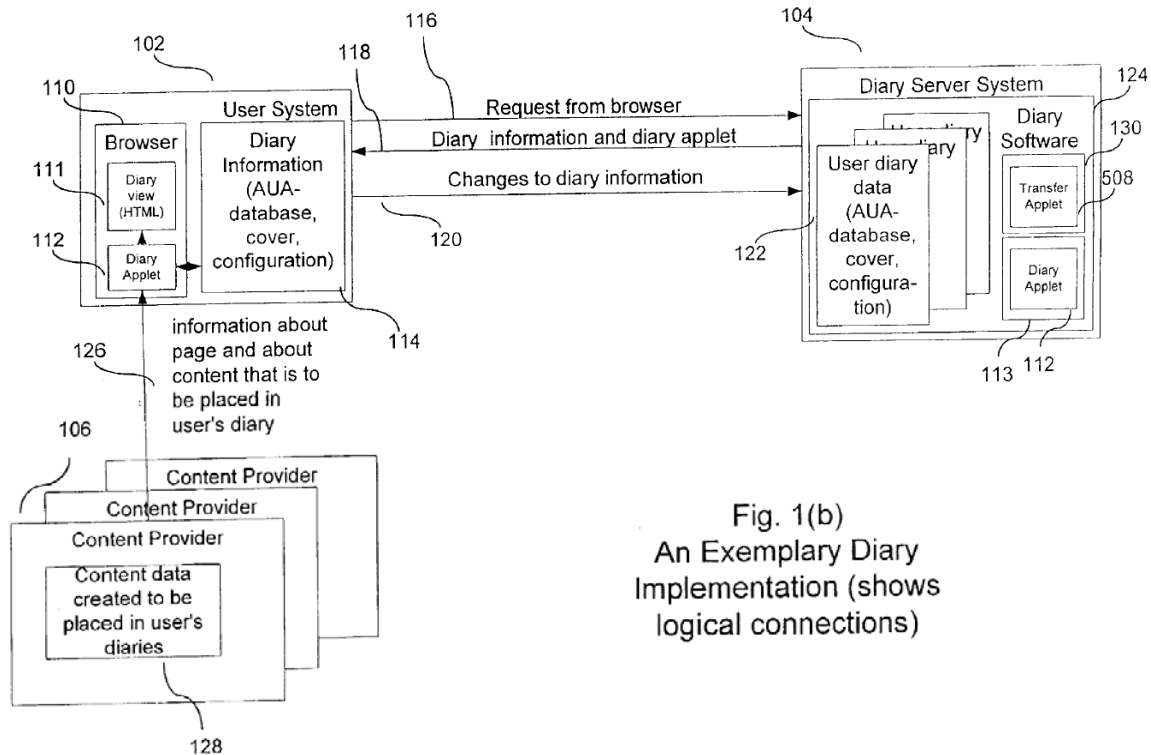


Fig. 1(b)
An Exemplary Diary
Implementation (shows
logical connections)

Figure 1(b) is a block diagram of a computer network in accordance with an embodiment of the invention of the '316 patent that illustrates how a diary is viewed or edited. Ex. 1001, 6:30-32. The system comprises user system 102, diary server 104, and one or more content providers 106. *Id.* at 6:32-34. User system 102 can be the system of the owner of the diary or of a person who wishes to view the diary. *Id.* at 6:34-36. User system 102 includes browser 110, which is shown executing diary applet 112 downloaded from diary server 104, and diary information 114, which contains information about the diary of this diary owner. *Id.* at 6:36-40. Diary applet 112 generates HTML 111 for the web pages of the user's diary, which are preferably displayed by browser 110. *Id.* at 6:40-43.

Diary server 104 includes diary information 122 (including diary information for a plurality of users' diaries), diary software 124, an original

copy of diary applet 112, and the HTML needed to display an initial web page. Ex. 1001, 6:44-48.

A user begins viewing or editing a diary by viewing web page 113 available from diary server 104. *Id.* at 6:56-59. Web page 113 allows the user to indicate that he wishes to view or edit a specified diary. *Id.* at 6:59-60. This indication begins execution of diary applet 112, which sends a request 116 to diary server 104 for the contents of the specified diary. *Id.* at 6:60-62. When diary software 124 receives request 116 from browser 110, it sends information 118, including diary information, appropriate for the specified diary to the user system. *Id.* at 6:63-67. Diary applet 112 reads diary information 114 received from diary server 104 and generates HTML 111 for one or more diary pages in accordance with diary information 114. *Id.* at 7:1-3. Diary applet 112 instructs browser 110 to display the diary page(s) in the browser window. *Id.* at 7:3-5.

C. Illustrative Claim

Of the challenged claims, claims 1 and 17 are independent. Claim 1 is reproduced below:

1. A method of organizing information for display, comprising:

 sending from a diary server to a user system, a diary program capable of being executed by a browser in the user system;

 sending diary information from the diary server to the user system, the information comprising content data including an associated time, a page design to specify the presentation of the content data, and configuration information for controlling behavior of a cohesive diary page, the configuration information including privacy level information;

assembling the cohesive diary page by dynamically combining the content data and the page design in accordance with the configuration information for the cohesive diary page to be displayed by the diary program running in the browser;

receiving by the diary server at least one request for at least one change concerning the diary information, from the diary program in the user system; and

sending, by the diary server to the user system, new diary information for changing the cohesive diary page.

D. References Relied Upon

Petitioner relies upon the following references:

Salas	US 6,233,600	May 15, 2001 (filed July 15, 1997)	Ex. 1005
ED TITTEL & STEPHEN N. JAMES, MORE HTML FOR DUMMIES, xv-xxv, 57-84, 153-180, 341-364 (2d ed. 1997) (“Tittel (1997)”)			Ex. 1006
Parker	US 5,729,734	Mar. 17, 1998	Ex. 1011
Angles	US 5,933,811	Aug. 3, 1999	Ex. 1012

E. The Asserted Grounds of Unpatentability

Petitioner argues that the challenged claims are unpatentable based upon the following grounds:

Reference(s)	Basis	Claims challenged
Salas, Tittel (1997), and Parker	§ 103	1, 4, 17, 18, and 26
Salas, Tittel (1997), Parker, and Angles	§ 103	20

II. ANALYSIS

A. 37 C.F.R. §§ 42.105, 106

Patent Owner argues that Facebook failed to qualify for a filing date of February 6, 2014, under 37 C.F.R. § 42.106 because it failed to effect timely service of the Petition in accordance with 37 C.F.R. § 42.105.

Prelim. Resp. 1-6. Specifically, Patent Owner argues that by depositing the

Petition with FedEx after the “cut-off time” on Thursday, February 6, 2014, and by failing to choose Saturday delivery, Petitioner failed to serve the Petition “by means at least as fast and reliable as EXPRESS MAIL[®],” as required by Rule 42.105(b). *Id.* at 3-5. Patent Owner argues that the Petition should, therefore, not be accorded a filing date pursuant to Rule 42.106(a), that Petitioner cannot file a corrected Petition because it would be time-barred under 35 U.S.C. § 315(b), and, therefore, that this Petition should be dismissed. *Id.* at 5-6.

We agree that mailing via FedEx after the cut-off time on Thursday without electing Saturday delivery failed to comply with 37 C.F.R. § 42.105(b). The error appears harmless, however, because Patent Owner received the Petition on the next business day (Monday) instead of on Saturday (Prelim. Resp. 2-3), and timely responded. In this instance, we, therefore, decline to change the filing date accorded in the notice of February 11, 2014 (Paper 3). Petitioner, however, must follow the Rules on service, such as Rule 42.6(e), going forward. 37 C.F.R. § 42.5(b)

B. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). Also, claim terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

For purposes of this decision, we construe the following claim terms and do not construe expressly any of the other claim terms at this time.

1. “*cohesive diary page*” (claims 1 and 17)

Petitioner proposes that “cohesive diary page” be construed as “a page sent by a server to a user system in which the content data and the page design are fully integrated for display.” Pet. 21-22. This construction is similar to the construction agreed upon by the parties and adopted by the court in the co-pending district court case: “A *diary page* in which the content data and the page design are fully integrated for display.” Ex. 1003, 1-2. Petitioner modifies the district court’s construction by inserting the district court’s construction of “diary page”—“A page containing content sent by a server to a user system” in place of the term “diary page.” As support for its proposed construction, Petitioner cites the Specification. Pet. 21-22 (citing Ex. 1001, 5:32-34, 5:19, 5:48-49, and 6:9-11). Patent Owner does not dispute Petitioner’s proposed construction.

We agree with Petitioner that “cohesive diary page” should be understood as a diary page in which the content data and the page design are fully integrated for display. We are not persuaded, however, that such a page must be “sent by a server to a user system,” as required by Petitioner’s proposed construction. Claim 1 does not require that a cohesive diary page is part of the diary information sent from the diary server to the user system. Rather, claim 1 requires only that the cohesive diary page be “assembled” from the diary information sent—i.e., from the content data, the page design, and the configuration information. As Petitioner points out, the ’316 patent discloses that “[t]he diary software dynamically combines the diary’s book design and book content to present a cohesive view of the ‘book.’” Pet. 21

(citing Ex. 1001, 5:32-34) (emphasis added). The '316 patent describes the diary software as residing only on the user system, not on the server. In the disclosed embodiments, then, the “cohesive diary page” is assembled at the user system; it is not assembled at the server and then “sent by a server to a user system,” as Petitioner’s proposed construction requires. Because Petitioner’s proposed construction excludes embodiments in which a “cohesive diary page” is assembled at the user system, it is unreasonably narrow. Accordingly, for purposes of this Decision, we construe “cohesive diary page” to mean “a page in which the content data and the page design are fully integrated for display.”

2. *“configuration information” (claims 1 and 17)*

Petitioner proposes that “configuration information” be construed as “information that determines what information will be displayed to a user who is viewing a cohesive diary page.” Pet. 22-24. This construction is the same construction adopted by the court in the co-pending district court case. Ex. 1003, 4. As support for its proposed construction, Petitioner cites the Specification. Pet. 22-24 (citing Ex. 1001, 5:63-67, 9:2-4, 10:51-54, 17:22-24). Patent Owner does not dispute Petitioner’s proposed construction. On this record, and for purposes of this Decision, because this construction appears consistent with the broadest reasonable interpretation, we adopt Petitioner’s proposed construction.

3. *“privacy level information” (claims 1 and 17)*

Petitioner proposes that “privacy level information” be construed as “configuration information that describes or specifies at least one user permitted to view particular content on a cohesive diary page.” Pet. 22-24. In the co-pending district court case, the parties agreed to construe “privacy

level information” differently: “configuration information that describes or specifies which user(s) or categories of users are permitted to view particular content data on a cohesive diary page.” Ex. 1003, 2. As support for its proposed construction, Petitioner cites the Specification. Pet. 23 (citing 2:40-44).

Patent Owner argues that Petitioner’s proposed construction is unreasonably broad to the extent that it encompasses specifying individual users. Prelim. Resp. 9-14. Patent Owner argues that “privacy level information” should be limited to information that specifies “a universe of permitted viewers.” Prelim. Resp. 13 (citing Ex. 1001, Fig. 4d, 10:36-41 for examples of privacy levels).

To the extent that it precludes “privacy level information” from specifying an individual user, Patent Owner’s proposed construction is overly narrow. Although the examples described in column 10 of the ’316 patent specify categories of users, nothing in the Specification precludes privacy level information from specifying an individual user. Moreover, Petitioner’s proposed construction is sufficiently broad to include specifying categories of users. Under Petitioner’s proposed construction, the “privacy level information” must specify “*at least one* user” but it may specify more users (i.e., a “universe” or “category” of users).

On this record, and for purposes of this Decision, we construe “privacy level information” to mean “configuration information that describes or specifies at least one user or category of users permitted to view particular content on a cohesive diary page.”

*C. Claims 1, 4, 17, 18, and 26 –
Obviousness over Salas, Tittel (1997), and Parker*

Petitioner argues that claims 1, 4, 17, 18, and 26 are unpatentable under 35 U.S.C. § 103(a) as obvious over Salas, Tittel (1997), and Parker. Pet. 24-56. In support of this ground of unpatentability, Petitioner relies upon the Declaration of Edward R. Tittel. *Id.* (citing Ex. 1002).

Salas (Exhibit 1005)

Salas describes a system and method for providing a collaborative work environment that includes servers and client workstations. Ex. 1005, Abstract. Client workstations receive data objects from one or more servers and combine the received data objects with stored templates to render HTML pages representing at least a portion of a common project. *Id.* Users may view, edit, and create common documents for the projects and upload them to the server using a drag-and-drop interface. *Id.*

Figure 4 of Salas is reproduced below.

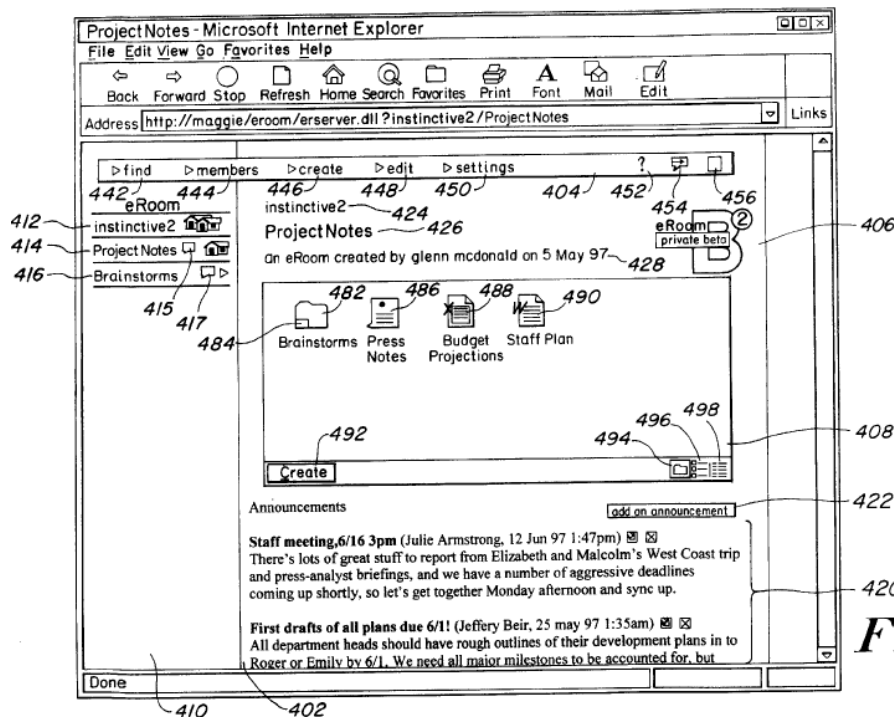


FIG. 4

Figure 4 depicts an embodiment of eRoom page 60 that a user might encounter while using a browser program. Ex. 1005, 5:21-23. The eRoom page has five major elements: page element 402, navigation bar 404, graphical identifier 406, item box 408, and shortcut list 410. *Id.* at 5:24-27.

Page element 402 may include subelements. *Id.* at 5:28. In the embodiment depicted, discussion 420 is embedded within page element 402 and facility 422 allows a viewer to contribute to discussion 420. *Id.* at 5:28-31. Embedded discussion 420 and contribution facility 422 may be implemented as ActiveX controls, a JAVA applet, or other means. *Id.* at 5:31-34.

Graphical identifier 406 is used to pictorially identify the viewed page—e.g., a corporate logo or other organizational identifier. *Id.* at 5:54-56. Graphical identifier 406 may be static or dynamic (such as a javascript or ActiveX control). Ex. 1005, 5:56-58.

Item box 408 collects and displays items associated with the project represented by page 402. *Id.* at 5:60-61. In the embodiment shown in Figure 4, item box 408 contains folder of items 482, notes file 486, spreadsheet file 488, and word processing file 490, each of these being links to other eRoom pages or files. *Id.* at 5:61-65. Item box 408 may also include version organizers, discussion, links, vote/poll pages, a facility for creating new items 492, and icons that control how items are displayed in item box 408. *Id.* at 5:65-6:4. In Figure 4, three icons are provided: “icon display” icon 494 (currently selected) which causes items to be displayed as large icons with identifying text underneath; “list display” icon 496 which causes items to be displayed as small icons with identifying text to one side of the icon; and “report display” icon which causes items to be displayed as

a list. *Id.* at 6:4-10. The displayed list may be alphabetized, ordered by size of item, ordered by creation date, ordered by modification data, or ordered by some other data field associated with each item. *Id.* at 6:10-13.

When a user requests the URL for an eRoom, the server returns an HTML file, called a “wrapper” file, that contains an object ID that is used by the client workstation to look up the object in the local database stored on the client workstation. *Id.* at 6:40-52. The local database includes information about the object, including which eRoom template to use and information regarding any “children” the object may have—e.g., items contained in item box 408. *Id.* at 6:52-56.

Generation, display, and management of an eRoom are controlled by a “page builder” application residing on the client workstation. *Id.* at 6:57-59. In some embodiments, the page builder application may be an ActiveX control or a COM object. *Id.* at 6:61-63.

Tittel (1997) (Exhibit 1006)

Tittel (1997) describes the use of style sheets and ActiveX components. Ex. 1006, 58, 176, 341. Tittel (1997) describes how ActiveX components are automatically downloaded from a server if the object is not already on a user’s machine. *Id.* at 341. Tittel (1997) also describes how style sheets define a set of layout parameters for a document to ensure that similar elements in the document appear uniformly. *Id.* at 176.

Parker (Exhibit 1011)

Parker describes a file service administration method in a computer network having an administrator account and a user account. Ex. 1011, Abstract. The computer network includes at least one sharepoint that is selectively accessible through the user account. *Id.* Parker uses the term

“sharepoint” to mean an item—e.g., file, folder, volume, hard disk—that is capable of being shared by network users. *Id.* at 2:24-26. The sharepoint is displayed in accordance with the user’s privileges by being represented in a first state when the access privilege for the user is enabled and being represented in a second state when the access privilege for the user is not enabled. *Id.*, Abstract.

Figure 7 of Parker is reproduced below.

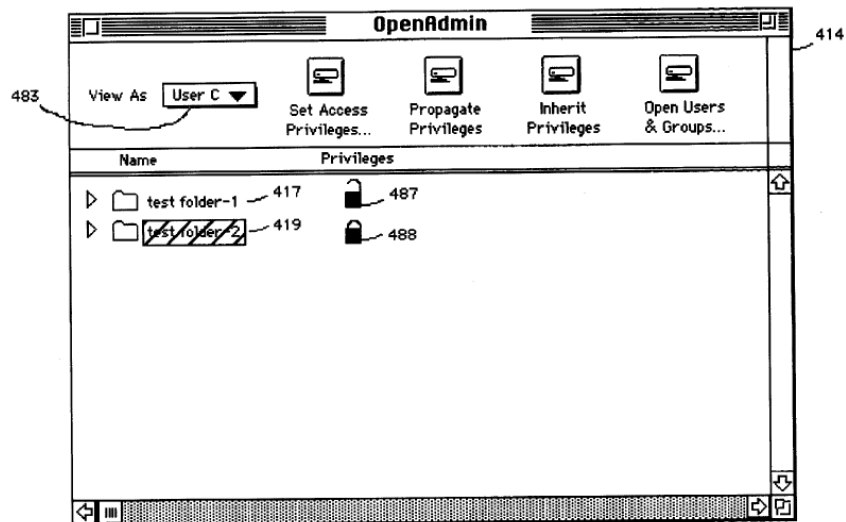


FIG. 7

Figure 7 shows a graphical user interface window in which two sharepoints are displayed in accordance with a user’s access privileges. *Id.* at 5:29-32; 11:20-22. As depicted in Figure 7, “test folder-1” (417) is shown as accessible to the user by open lock icon 487 and because it is not ghosted, grayed out, or hidden. *Id.* at 11:40-44. In contrast, “test folder-2” (419) is in a ghosted state indicating that the user does not have access rights to “test folder-2.” *Id.* at 11:44-46. In other embodiments, “test folder-2” (419) may be grayed out, shaded, or hidden altogether. *Id.* at 11:46-47.

Analysis

In light of the arguments and evidence, Petitioner has established a reasonable likelihood that claims 1, 4, 17, 18, and 26 are unpatentable as obvious over Salas, Tittel (1997), and Parker.

Independent claim 1 recites, “sending diary information from the diary server to the user system, the information comprising content data including an associated time, a page design to specify the presentation of the content data, and configuration information for controlling behavior of a cohesive diary page, the configuration information including privacy level information.”

For “content data including an associated time,” Petitioner relies upon entries under “Announcements,” and the representations of items in item box 408. Pet. 32-33. The entries are time-stamped, and the representations of items include a creation date and a modification date; both, therefore, “includ[e] an associated time,” as recited. *Id.* at 33-35. On this record, we are persuaded that Petitioner’s citations support Petitioner’s contentions.

For “page design,” Petitioner relies upon the “wrapper” file sent by the eRoom server to the user system. Pet. 35-36. The “wrapper” file “specif[ies] the presentation of the content data,” by specifying an eRoom template to be used to assemble the page. *Id.* at 35-37. Petitioner also argues that it would have been obvious to modify the “wrapper” file of Salas to include a URL identifying an eRoom template stored on the eRoom server. *Id.* at 37-39 (citing Ex. 1002 (Tittel Decl.) ¶¶ 20-23, 73-75). We are persuaded, on the current record, that Petitioner’s citations support Petitioner’s contentions.

For “configuration information including privacy level information,” Petitioner relies upon Salas’s teaching of entries in a database schema including three separate groups (*see, e.g.*, Ex. 1006, 14:30-54) and upon file metadata. Pet. 40-41. Petitioner further relies upon Salas’s teaching that file metadata includes “access information such as which users may open, view and edit the file” and is sent to client workstation 12 when synchronizing “local database metadata.” *Id.* On this record, we are persuaded that Petitioner’s citations support Petitioner’s contentions.

We are not persuaded, on the present record, by Patent Owner’s argument that Salas, Tittel (1997), and Parker do not collectively teach “privacy level information” because the files themselves are not “content data,” and, therefore, the “file metadata” does not control what appears on the page. Prelim. Resp. 15-17, 26. As discussed above, we construe “privacy level information” to mean “configuration information that describes or specifies at least one user or category of users permitted to view particular content on a cohesive diary page,” and we construe “configuration information” to mean “information that determines what information will be displayed to a user who is viewing a cohesive diary page.” Salas teaches that file metadata includes “access information such as which users may open, *view*, and edit the file.” Ex. 1005, 13:54-55 (emphasis added). Thus, the file metadata “describes or specifies at least one user permitted to view particular content on a cohesive diary page.” Moreover, the file metadata “determines what information will be displayed to a user who is viewing a cohesive diary page” by determining the appearance of icons, small icons, or lists in item box 408. For example, Salas teaches that the visual appearance of items in item list box 408 is based upon file metadata such as filename,

creation date, modified date, and which application should be used to open and edit the file. *See, e.g.*, Ex. 1005, Fig. 4, 6:4-13. Moreover, Petitioner relies upon Parker for further teaching the modification of icons based on a user's access privileges, which Salas describes as being included in file metadata. Accordingly, we are not persuaded by Patent Owner's argument that Salas's file metadata in combination with the teachings of Parker does not control what appears on the page.

We also are not persuaded on the present record by Patent Owner's argument that Salas, Tittel (1997), and Parker do not teach sending "privacy level information" from the diary server to the user system. Prelim. Resp. 17-22, 26-27. As discussed above, we are persuaded by Petitioner's contention that file metadata is "privacy level information." Salas teaches synchronization of "local database metadata." Ex. 1005, 12:1-4. Page builder application requires file metadata in order to build eRoom page 402. *See, e.g., id.* at Fig. 4 (depicting filenames for 482, 486, 488, 490; depicting 486, 488, and 490 based on which application should be used to open and edit the file). Patent Owner argues that Salas does not explicitly teach that "local database metadata" includes access information, but Patent Owner cites nothing in Salas to suggest that file metadata does *not* include access information. Patent Owner argues that the access check depicted in Figure 6 and described in column 12 of Salas "takes place at the server, not at the user system" (Prelim. Resp. 20), but Figure 6 is described as "a flowchart of the steps taken *by a client workstation*" (Ex. 1005, 3:4-5), and the paragraph in question begins by describing "the first step taken by the background daemon." On this record, we are not persuaded by Patent Owner's argument that the access checks described are necessarily performed on eRoom server

14. Accordingly, on this record, we are not persuaded by Patent Owner’s argument that Salas, Tittel (1997), and Parker do not collectively teach sending “privacy level information” from the server to the user system.

Independent claim 1 also recites, “assembling the cohesive diary page by dynamically combining the content data and the page design in accordance with the configuration information for the cohesive diary page to be displayed by the diary program running in the browser.” Petitioner relies upon Salas’s disclosure of a page builder application that controls generation, display, and management of an eRoom. Pet. 41-42. Petitioner also relies upon Parker’s visual indication of a user’s access privileges to an object by means of an icon or by ghosting, graying, or hiding the object as teaching “assembling . . . *in accordance with the configuration information.*” *Id.* at 43-46 (emphasis added). Petitioner argues that a person of ordinary skill in the art would have found it obvious to combine Salas and Parker in order to allow a user to visually ascertain, before attempting to access, whether access is permitted. *Id.* at 47 (citing Ex. 1002 (Tittel Decl.) ¶ 89). We are persuaded, on the current record, that Petitioner’s citations support Petitioner’s contentions.

We are not persuaded on the present record by Patent Owner’s argument that Parker does not teach that its access control information can be used to control who can view the icons because “the icon remains fully viewable to the user.” Prelim. Resp. 21-22. To the contrary, Parker teaches that its access control information can be used to hide an icon from a user that does not have access rights to the sharepoint represented by the icon. Ex. 1011, Figs. 6, 7, 11:4-47. Patent Owner acknowledges that an icon can be blanked out (Prelim. Resp. 22), but argues that such an icon “is simply

not sent [to the user system]” and, therefore, the icon cannot be “content data” sent to a user system, and the access control information associated with the sharepoint cannot be “privacy level information” sent to a user system. Patent Owner, however, provides no support for its contention that Parker’s teaching to blank out an icon results in that icon not being sent. On this record, we are not persuaded that Parker’s access control information cannot be used to control who can view the icons.

We also are persuaded, on this record, by Petitioner’s contentions with respect to independent claim 17 and dependent claims 4, 18, and 26. Pet. 50-56. Patent Owner offers no additional arguments on these claims.

Conclusion

We are persuaded that Petitioner has established a reasonable likelihood that it would prevail in showing that claims 1, 4, 17, 18, and 26 are unpatentable as obvious over Salas, Tittel (1997), and Parker.

D. Claim 20 – Obvious over Salas, Tittel (1997), Parker, and Angles

Petitioner argues that claim 20 is unpatentable under 35 U.S.C. § 103(a) as obvious over Salas, Tittel (1997), Parker, and Angles. Pet. 56-59. In support of this ground of unpatentability, Petitioner relies upon the Declaration of Mr. Tittel. *Id.* (citing Ex. 1002).

Angles (Ex. 1012)

Angles describes an online advertising service that can custom-tailor specific advertisements to particular consumers, and track consumer responses to the advertisements. Ex. 1012, 2:46-49. In one embodiment, advertisement computer 18 sends customized advertisement 30 to content provider computer 14. *Id.* at 21:35-37. Content provider computer 14 then incorporates the customized advertisement into electronic page 32 and

forwards electronic page 32 to consumer computer 12. *Id.* at 21:37-42. Consumer computer 12 then displays electronic page 32, including customized advertisement 30, to the consumer. *Id.* at 21:43-44. Because customized advertisement 30 is transferred from advertisement provider computer 18 to content provider computer 14 prior to sending electronic page 32 to the consumer, electronic page 32 appears to the consumer like all other electronic pages 32 on the Internet, except that it contains customized advertisement 30, which has been pre-selected for that consumer. *Id.* at 21:45-52.

Analysis

In light of the arguments and evidence, Petitioner has established a reasonable likelihood that claim 20 is unpatentable as obvious over Salas, Tittel (1997), Parker, and Angles.

Claim 20 recites, “wherein the cover includes advertisements not requested by a user.” Petitioner relies upon Angles’s teaching of an online advertising service that custom-tailors advertisements to particular customers. Pet. 57-59. On this record, we are persuaded that Petitioner’s citations support Petitioner’s contentions.

We also are persuaded by Petitioner’s contention that a person of ordinary skill in the art would have found it obvious to combine Salas, Tittel (1997), and Parker with Angles in order to obtain revenue, that a person of ordinary skill in the art would have recognized that an advertisement could be placed anywhere, including graphical element 406, and that adding Angles’ advertising to Salas’s eRoom would have had predictable results. *Id.* at 58-59 (citing Ex. 1002 (Tittel Decl.) ¶¶ 117, 119).

We are not persuaded on the present record by Patent Owner's argument that Petitioner's proffered rationale to combine the references is deficient because a person of ordinary skill in the art would not have known to place advertisements on a website geared for business users. Prelim. Resp. 23-25. On this record, Petitioner has justified sufficiently this combination by showing "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Conclusion

On this record, we are persuaded that Petitioner has established a reasonable likelihood that it would prevail in showing that claim 20 is unpatentable as obvious over Salas, Tittel (1997), Parker, and Angles.

III. CONCLUSION

For the foregoing reasons, we determine that the information presented in the Petition establishes that there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of claims 1, 4, 17, 18, 20, and 26 of the '316 patent.

The Board has not made a final determination on the patentability of any challenged claims.

IV. ORDER

Accordingly, it is

ORDERED that pursuant to 35 U.S.C. § 314, an *inter partes* review is hereby instituted on the following grounds:

1. Claims 1, 4, 17, 18, and 26 under 35 U.S.C. § 103 as obvious over Salas, Tittel, and Parker; and
2. Claim 20 under 35 U.S.C. § 103 as obvious over Salas, Tittel, Parker, and Angles;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(d) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial on the grounds of unpatentability authorized above; the trial commences on the entry date of this Decision.

Case IPR2014-00415

Patent 6,415,316

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