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Filed on behalf of GSI Commerce Solutions, Inc.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GSI COMMERCE SOLUTIONS, INC.
Petitioner

v.

LANDMARK TECHNOLOGIES LLC
Patent Owner of
U.S. Patent No. 7,010,508
Issued Mar. 7, 2006
Appl. No 08/418,772 filed Apr. 7, 1995

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I. INTRODUCTION

U.S. Patent No. 7,010,508 (“the ’508 Patent”; Ex. 1007) issued March 7, 2006 and is assigned to Landmark Technologies LLC (“Landmark”). Each of claims 1-17 of the ’508 Patent is unpatentable for two independent reasons. First, the specification of the ’508 Patent fails to disclose a structure for many of the means-plus-function elements in the claims. Second, every element of each of those claims was known in the prior art, including the use of so-called “forward-chaining” – the alleged inventive feature of the ’508 Patent.

Each of the ’508 Patent’s claims is unpatentable for failure to comply with 35 U.S.C. § 112 ¶ 2 and 6. A claim element governed by § 112 ¶ 6 is indefinite if the specification does not disclose its corresponding structure(s). *Aristocrat Techs. Austl. Pty Ltd. v. Int’l Game Tech.*, 521 F.3d 1328, 1338 (Fed. Cir. 2008).¹ To disclose structure for a § 112 ¶ 6 element consisting of a function performed on a programmed, general-purpose computer, the specification must teach the algorithm that performs that function. *Id.* Each claim of the ’508 Patent recites means to perform various functions on a programmed, general-purpose computer, for which

¹ The ’508 Patent is subject to pre-AIA patentability rules because all claims of the ’508 Patent were filed prior to March 16, 2013.

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the '508 Patent fails to teach any corresponding algorithm. Thus, claims 1-17 are indefinite and therefore unpatentable.

Each of the '508 Patent's claims is also unpatentable under 35 U.S.C. § 103. In its initial examination of the '508 Patent application, the Patent Office found that every element of the '508 Patent's claims was disclosed in the inventor's own prior art patent (i.e., U.S. Patent No. 4,359,631 ("Lockwood"); Ex. 1001) except the use of "forward-chaining." However, the use of backward- and forward-chaining was well known in the art at the time of the '508 Patent's invention. As the prior art references cited herein and the declaration of Dr. Sandra Newton (Ex. 1008) show, ordinarily skilled artisans working with expert systems at the time would have combined Lockwood with references showing backward- and forward-chaining regardless of the particular domains in which those references were used. Thus, the prior art references cited herein that teach the use of both backward- and forward-chaining combined with the teachings of Landmark's own admitted prior art patent (i.e., Lockwood) render all claims of the '951 Patent unpatentable.

II. GROUNDS FOR STANDING 37 C.F.R. § 42.304(a)

A. Petitioner GSI Commerce Solutions, Inc. Has Standing to File this Petition

Petitioner GSI Commerce Solutions, Inc., an eBay Enterprise Company, ("GSI") has been charged with infringement because Landmark has sued iRobot Corporation, GSI's customer, for infringement of the '508 Patent. Specifically,

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