

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.
Petitioner

v.

AT HOME BONDHOLDERS' LIQUIDATING TRUST,
Patent Owner

Case CBM2016-00036
U.S. Pat. No. 6,286,045

REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE

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U.S. Patent and Trademark Office
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Following *Enfish, LLC v. Microsoft Corp.*, No. 2015-1244 (Fed. Cir. May 12, 2016), and *TLI Communications LLC v. AV Automotive LLC*, No. 2015-1372 (Fed. Cir. May 17, 2016), claims 1-12, 14-31, 33-44, 47-53, 55-59, 61-67, 69-73, 75, 77, and 78 of U.S. Pat. 6,286,045 remain unpatentable under 35 U.S.C. § 101.

I. Unlike *Enfish*, the '045 patent claims are not directed to a specific improvement to the way computers operate, and remain patent-ineligible.

The '045 patent claims are not, as PO argues, directed to an improvement to the way computers operate. Regardless of whether they are analyzed in their entirety or considered as an ordered combination, the challenged claims merely describe generalized steps, not an inventive technological solution.¹ Whereas in *Enfish* the claims were patent-eligible because a self-referential table was a specific asserted improvement over conventional databases and the operation of a computer, *Enfish* at *11-12, nothing in the challenged claims improves the functioning of the claimed servers, computer networks, or terminals, or changes the process of delivering content over the Internet. That is, the challenged claims do not: (i) recite any new hardware or software algorithm, (ii) aim to alter the claimed computing technology they rely on, or (iii) override routine computer functions like "conventional database structures." *Enfish* at *6, *8. In fact, the '045 patent acknowledges that most of its claimed invention used generic processes and known prior art. *See* Pet.,

¹ Throughout its POPR, PO stated that Google did not address the claims in their entirety, or as an ordered combination. *E.g.*, POPR, 31, 34-35, 40-41. This is not correct. *See, e.g.*, Pet., 54 ("Not only are the individual steps 112 and 114 conventionally performed in the art, but the combination was also well known"), 59, 26.

9-14 (comparing FIG. 3 to FIG. 4). And the allegedly novel combination of blocking and redirecting network traffic did not introduce any new or improved protocols that overrode existing functionality. Rather, the combination employed existing, conventional HTTP and HTML commands, and the claims do not recite any special techniques for implementing unblockability (which, in any event, is described in the specification as being implemented by way of existing, conventional techniques). *See* Pet., 27-29.

Further, the '045 patent claims are not written at the same level of detail as those in *Enfish*. The *Enfish* claims recite a specific system of managing information in a memory table, describing the self-referential table down to the formatting of the rows and columns of the table. In contrast, the '045 patent claims generically recite a signal having "information intended to prevent said first request signal from being blocked" followed by a "second request signal"—they provide no detail as to how to implement these signals, much less limitations guaranteeing the steps will work as "intended." *See, e.g.*, claim 1. Thus, the challenged claims are distinguishable from those in *Enfish*.

II. Similar to *TLI*, the '045 patent's abstract idea is tethered to the claim language, and any recited physical components merely provide a generic environment in which to carry out the abstract idea.

The challenged claims are more akin to the claims in *TLI* than those at issue in *Enfish*. Specifically, the challenged claims are directed to the abstract idea of storing, managing, and delivering information, similar to *TLI*'s abstract idea of "classifying an image and storing the image based on its classification." *TLI* at *7.

The Petition walks through the analysis "tethering" this abstract idea to explicit language in the claims. *See*, Pet., 51-52. As with the *TLI* claims, the challenged claims rely upon tangible components such as a server or a terminal, but the '045 patent's specification makes clear that these components only provide a generic environment where the components are merely a "conduit for the abstract idea." *TLI* at *9.

Moreover, PO's efforts to recast the 045 patent claims following *Enfish* (and ignoring *TLI* altogether) belie the purpose originally described by the patent. According to PO, the claims are "directed to solving the problem of blocked banner requests in a caching network, while retaining the benefits of caching." POPR, 33. PO therefore asserts that no analysis of the '045 patent or its claims support the proffered abstract idea of "storing, managing, and delivering information." POPR, 34. To the contrary, the Background of the Invention explicitly states that "[t]his invention relates to the system for the storage, management, and delivery of information on a computer network." GOOG 1001, 1:9-13. This abstract idea is also reflected in all five of the objects of the invention listed in the Summary of the Invention. *Id.*, 3:31-50. These sections provide a snapshot—concurrent with the time of filing—of the original purpose of the invention. Conversely, these sections do not support PO's efforts, nearly 20 years later, to recast the invention and analogize with *Enfish*. And both *Enfish* and *TLI* confirm that the specification's characterization of the invention can provide insight into the purpose of the claims. *Enfish* at *15; *TLI* at *8.

Here, similar to *TLI*, the challenged claims are "directed to the use of con-

ventional or generic technology in a nascent but well-known environment, without any claim that the invention reflects an inventive solution to any problem presented by combining the two." *TLI* at *8. The specification does not say, nor does PO argue, that the '045 patent claims any new servers, terminals, computers, devices, or new physical combination of these components. *See id.*, *8-9. The specification does not even provide any technical details for these components, but instead predominantly describes the system and methods in purely functional terms. *Id.*; *See Pet.*, 51-52. The functions of the claimed components also do not include any meaningful limitations—merely performing generic, well-known routines. *Id.*, 56-65. Like the claims in *TLI*, each of the additional claim limitations, both alone and in combination, were previously known in the art (even PO's asserted unblockable signal + cacheable signal combination was known, as evidenced by, among other documents, Kirsch. *See Pet.*, 27-28). This is like *TLI*, where the court found the feature of "attaching classification data ... to images for the purpose of storing" as a well-established "basic concept" sufficient to fall under *Alice* step 1. *TLI* at *11.

For these reasons, and as discussed in the Petition, the challenged claims are not directed to patent-eligible subject matter. If anything, (1) the contrast between the '045 patent claims and the specificity of the *Enfish* claims, and (2) the similarity between the level of detail in the '045 patent claims and the *TLI* claims, further support Petitioner's assertion that the challenged claims are patent-ineligible.

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