

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE INC.,  
MATCH.COM LLC, and PEOPLE MEDIA, INC.  
Petitioner

v.

B.E. TECHNOLOGY, LLC  
Patent Owner

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Case IPR2014-00038<sup>1</sup>  
Patent 6,628,314 B1

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**PETITIONER GOOGLE INC.'S OPPOSITION TO PATENT OWNER'S  
MOTION TO AMEND  
(*INTER PARTES* REVIEW OF U.S. PATENT NO. 6,628,314 B1)**

Before SALLY C. MEDLEY, KALYAN K. DESHPANDE, and LYNNE E.  
PETTIGREW, *Administrative Patent Judges*.

Mail Stop **Patent Board**  
Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

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<sup>1</sup> Case IPR2014-00699 has been joined with this proceeding.

**TABLE OF CONTENTS**

	<b>Page</b>
TABLE OF AUTHORITIES .....	ii
I. Introduction.....	1
II. BE Tech’s Proposed Substitute Claims are not Supported and Unpatentable under 35 U.S.C. § 112.....	1
A. BE Tech Does Not Set Forth Adequate Support in its Motion.....	1
B. BE Tech’s Proposed Amendment Lacks Written Description Support .....	3
C. BE Tech’s Proposed Amendment Raises Additional Patentability Issues .....	5
III. BE Tech’s Proposed Claims are Not Patentable Over the Prior Art.....	7
A. Teachings of Logan.....	7
B. Additional Teachings of the Prior Art.....	8
1. Ferguson.....	9
2. Lazarus .....	11
3. Fleming .....	12
IV. Conclusion .....	15

**TABLE OF AUTHORITIES**

	<b>Page(s)</b>
<b>CASES</b>	
<i>Idle Free Systems, Inc. v. Bergstrom, Inc.</i> , IPR2012-00026, Paper 26 (June 11, 2013).....	1
<i>Interactive Gift Express, Inc. v. Compuserve Inc.</i> , 256 F.3d 1323 (Fed. Cir.2001) .....	2
<i>Nichia Corp. v. Emcore Corp.</i> , IPR2012-00005, Paper 7 (June 3, 2013).....	1, 3
<i>Toyota Motor Corp. v. American Vehicular Sciences LLC</i> , IPR2013-00419, Paper 32 (March 7, 2014).....	2, 3
<b>STATUTES, RULES AND REGULATIONS</b>	
35 U.S.C. § 102.....	9, 11, 12
35 U.S.C. § 103.....	9
35 U.S.C. § 112.....	6
37 C.F.R. § 42.20.....	1
M.P.E.P. § 2172.01 .....	6
M.P.E.P. § 2143 .....	14

## **I. Introduction**

Patent Owner BE Tech, as the moving party, bears the burden to establish that it is entitled to the relief request in its Motion to Amend. 37 C.F.R. § 42.20(c). BE Tech's motion should be denied because it fails to adequately provide support in the original disclosure and explain "why a person of ordinary skill in the art would have recognized that the inventor possessed the claimed subject matter as a whole" for the proposed substitute claim. *Nichia Corp. v. Emcore Corp.*, IPR2012-00005, Paper 7 at 4 (June 3, 2013).

Further, BE Tech's motion should be denied because it fails to "come forward with technical facts and reasoning about those [added] feature(s), including construction of new claim terms, sufficient to persuade the Board that the proposed substitute claim is patentable over the prior art of record, and over the prior art not of record but known to the patent owner." *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00026, Paper 26 at 7 (June 11, 2013).

Finally, BE Tech's proposed claims should be denied because they not enabled and indefinite.

## **II. BE Tech's Proposed Substitute Claims are not Supported and Unpatentable under 35 U.S.C. § 112**

### **A. *BE Tech Does Not Set Forth Adequate Support in its Motion***

In its motion, BE Tech asserts that the following underlined elements of claim 23 were added:

wherein the computer usage information comprises information about the user's interactions with said computer software displaying advertising content and at least one other program,...

*selecting advertising content for transfer to the computer in accordance with real-time and other computer usage information and demographic information associated with said unique identifier.*

Motion to Amend at 6 (underline in original). BE Tech fails to mention an additional change in the claim – the modified “selecting advertising content...” step and the original “transferring said advertising content...” step have been moved to the end of the claim. It thus appears that BE Tech is attempting to introduce a requirement that the steps be performed in a specific order. *See Interactive Gift Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323, 1342-43 (Fed. Cir.2001).

BE Tech does not provide adequate support for its proposed claim changes including the new order of the recited steps. Rather, its sole support for the amendments consists of 16 string cites to various parts of the '705 application (which led to the '314 Patent). Contrary to the Board's requirements, BE Tech thus does not provide “written description support for **the entire combination claimed**,” (*Toyota Motor Corp. v. American Vehicular Sciences LLC*, IPR2013-00419, Paper 32 at 5(March 7, 2014)) (emphasis added). Nor does it explain why a

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