UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

B.E. TECHNOLOGY, L.L.C.
Patent Owner

Case IPR2014-00038[1]
Patent 6,628,314 B1

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

DESHPANDE, *Administrative Patent Judge*.

PATENT OWNER'S REPLY TO PETITIONER'S OPPOSITION TO PATENT OWNER'S CONTINGENT MOTION TO AMEND (37 C.F.R. § 42.121)

[1] Case IPR2014-00699 has been joined with this proceeding.

I. THE PROPOSED SUBSTITUTE CLAIMS ARE SUPPORTED AND PATENTABLE UNDER 35 U.S.C. § 112.

A. No Order Of Steps Is Added.

Google wrongly suggests that the placement of unmodified original claim language in a different place means that Patent Owner "is attempting to introduce a requirement that the steps be performed in a specific order." (Paper 28 at 2).

B. The Proposed Substitute Claims Are Supported.

Google's attempt to restrict the disclosure of the '705 application has no merit. In multiple places, the application refers to the use of "other computer usage information," or to both "real-time computer usage information" and "other computer usage information" in a manner sufficient to advise one of ordinary skill in the art that the applicant was in possession of an invention including the use of "other computer usage information." For example, the Abstract of the '705 application, after stating that "demographic information on the user is . . . used for determining what banner advertising will be sent to the user," (Exhibit 2004 at 1) explains that "[t]he software application further targets the advertisements in response to normal user interaction, or use, of the computer. (*Id*.). "Computer usage information" is defined in the '705 application as "[d]ata concerning a person's use of the computer, including such things as what programs they run, what information resources they access, what time of day or days of the week they use the computer, and so forth." (*Id*. at 6). The disclosed "normal user interaction,

or use, of the computer" would be understood by one of ordinary skill as including "computer usage information" as it is defined.

Later in the abstract, there is mention of "a set of data that is used by the software application in determining when a particular banner is to be displayed." (*Id*. at 1). The data include "the specification of certain programs that the user may have so that, when the user runs the program (such as a spreadsheet program), an advertisement will be displayed that is relevant to the program (such as an advertisement for a stock brokerage)." (*Id*.). "This," it is said "provides two-tiered, real-time targeting of advertising – both demographically and reactively," but the "real-time reactive" targeting is not disclosed to the exclusion of other targeting employing "computer usage information."

The '705 application explained that "[p]eriodically, computer usage information is sent to ADM server 22 for use in profiling the end user and better targeting future advertising to the end user." (*Id*. at 14). As Google points out, (Paper 28 at 4), the computer usage information is "stored on the end user's computer 18 in user data storage 34," (*Id*.), but Google ignores the preceding sentence specifying that the computer usage information is also "sent to ADM server 22 for use in profiling the end user and better targeting future advertising to the end user." (Ex. 2004 at 14).

C. Google's Assertion Of "Additional Patentability Issues" Lacks Merit.

Google suggests that "real-time" is indefinite, claiming that "it could be information that is transmitted instantaneously with no delay or transmitted after some delay within a time constraint or at the next time information packets are sent." (Paper 28 at 6). Rather than address the intrinsic record, Google resorts to dictionary definitions in an attempt to cast doubt on the meaning of real-time. Throughout the '705 application, real-time is used in a manner referring to what is occurring while the user is engaged in a given activity. The alternatives discussed by Mr. Gray are not relevant to the meaning disclosed by the intrinsic record. "In general," the application states, "banners are displayed either in response to some user action (input) or, in the absence of user input, are displayed periodically at time intervals. The client software application monitors the user's inputs to the computer and, when possible, targets the banner advertising displayed so that it relates to the *[sic]* what the user is doing." (Ex. 2004 at 26). Later, it is explained that "[a]s will be appreciated by those skilled in the art, the reactive targeting provided by client software application 10 is handled in real time, *rather than simply as a part of building a set of advertisements for later display to the user.* This permits the display of advertising that is relevant to what the user is doing at any particular time." (*Id*. at 29 (emphasis added)). A person having ordinary skill would not ignore the disclosure of the '705 application in favor of dictionary

definitions that are neither necessary nor important to an understanding of the disclosure.

II. THE PROPOSED SUBSTITUTE CLAIMS ARE PATENTABLE OVER THE PRIOR ART.

Google turns to the Ferguson (Ex. 1022), Lazarus (Ex. 1023), and Fleming (Ex. 1024) patents in an attempt to cure the deficiencies in Logan. Ferguson also does not disclose that computer usage information includes information concerning the user's interactions with at least one other program, and Ferguson does not disclose selecting advertising content in accordance with real-time computer usage information. Lazarus fails entirely to make mention of monitoring a user's interactions with any program other than the engine providing an advertisement to the user. Fleming simply monitors a user's interactions with a particular resource (*e.g.* an advertisement) downloaded from a webpage. (Ex. 1024 at 4:36-51).

III. CONCLUSION.

For the foregoing reasons and those set forth in its Contingent Motion to Amend, Patent Owner B.E. Technology, L.L.C. respectfully requests that the Board grant its Contingent Motion to Amend in the event original Claim 11 is found not to be patentable

Date: October 10, 2014

Respectfully submitted,

By: */s/Jason S. Angell*
Jason S. Angell

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