

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION and GOOGLE INC.
Petitioner

v.

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

Case IPR2014-00039¹
Patent 6,628,314

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

DESHPANDE, *Administrative Patent Judge*.

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

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¹ Case IPR2014-00738 has been joined with this proceeding.

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TABLE OF AUTHORITIES

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Federal Statutes

35 U.S.C. § 102(a)	9
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35 U.S.C. § 103(a)	8, 9
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Regulations

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Other Authorities

Deutsch et al. <i>How to Use Anonymous FTP</i>	9
Dunn et al. <i>Privacy and Profiling on the Web</i>	8

LIST OF EXHIBITS

2005	U.S. Utility Patent Application Serial No. 09/699,705
2006	U.S. Patent No. 5,768,508 (Eikeland)
2007	U.S. Patent No. 5,848,396 (Gerace)
2008	U.S. Patent No. 5,796,952 (Davis et al.)
2009	U.S. Patent No. 5,823,879 (Goldberg et al.)
2010	U.S. Patent No. 6,714,975 (Aggarwal et al.)
2011	U.S. Patent No. 6,285,987 (Roth et al.)
2012	U.S. Patent No. 6,892,226 (Tso et al.)
2013	U.S. Patent No. 7,225,142 (Apte et al.)
2014	Declaration of Neal Goldstein

I. SUMMARY OF MOTION TO AMEND.

This contingent motion to amend is submitted in compliance with 37 C.F.R. § 42.121. The Patent Owner requests that substitute claims 23-34 be entered in the event that original claim 11 is found to be not patentable.

The proposed substitute claims include a single independent claim and eleven dependent claims (i.e. the exact number of original claims). The proposed substitute claim set presents one substitute claim for each original claim, satisfying the general presumption that “only one substitute claim would be needed to replace each challenged claim.” 37 C.F.R. § 42.121(a)(3).

Proposed substitute claim 23 corresponds to original independent claim 11 with the limitation that advertising content be selected for transfer to the computer in accordance with real-time and other computer usage information and demographic information associated with said unique identifier, and that the computer usage information comprise information about the user’s interactions with said computer software displaying advertising content and at least one other program.

Proposed substitute claims 24-34 correspond to original dependent claims 12-22. Substitute claims 24-34 do not include any amendments to original claims 12-22, other than being renumbered to depend from proposed substitute claim 23.

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