UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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MICROSOFT CORPORATION AND GOOGLE INC.
Petitioner,

v.

B.E. TECHNOLOGY, LLC,
Patent Owner
_____

Case IPR2014-00039
Patent No. 6,628,314 B1
_____

**PETITIONER MICROSOFT'S OPPOSITION TO PATENT OWNER'S
MOTION TO AMEND CLAIMS**

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I.   Introduction

Patent Owner bears the burden of proving its proposed substitute claims are patentable. *Nichia Corporation v. Emcore Corporation*, Case IPR2012-00005, Paper 27 at 2 (June 3, 2013); *Int'l Flavors & Fragrances Inc. v. The United States of America*, IPR2013-00124, Paper 12 at 7 (May 20, 2014). Patent Owner must establish three things. *CBS Interactive v. Heferich Patent Licensing,* IPR2013-00033, Paper 122 at 51-58 (March 3, 2014). ***First***, Patent Owner must "identify ***how the proposed substitute claims are to be construed***, especially when the proposed substitute claims introduce new claim terms." *Id.* at 51-52. ***Second***, Patent Owner "must ***identify*** clearly ***the written description support*** for each proposed substitute claim." *Id*. at 53 (citing § 42.121(b)). ***Third***, "the patent owner bears the burden of proof in ***demonstrating patentability of the proposed substitute claims over the prior art in general***" and a "mere conclusory statement that one or more added claim features are not described in the cited prior art, or would not have been suggested or rendered obvious by the prior art, ***is facially inadequate***." *Id.* at 55. Patent Owner's motion fails on each criteria.

II.   Patent Owner Fails To Provide Any Claim Constructions

Patent Owner's amendment to claim 11 (new claim 23) adds significant amounts of new claim language. First, Patent Owner adds language defining the minimal elements of "computer usage information": "*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."

Patent Owner then modifies the step of "*selecting advertising content for transfer*

to the computer" to specify this must be done *"in accordance with real-time and*

other computer usage information and demographic information associated with

said unique identifier." Third, Patent Owner reorders the sequence of steps in the

claim. Motion at 2-3, 6. Finally, Patent Owner changes the dependence of original

claim 22 (new claim 34) from original ***dependent*** claim 22 to new ***independent***

claim 23 (original claim 11). This last change improperly enlarges the scope of

claim 22 by omitting limitations present in the original claim by its dependence on

original ***dependent*** claim 22. 35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii).

Remarkably, Patent Owner presents ***no constructions for any its new claim***

language. *See* Motion at 6-13. Patent Owner's refusal to do so conceals the

meaning of its amended claims. For example, Patent Owner's new phrase "*real-*

time and other computer usage information" is not defined anywhere in the

specification, and is used in the claims in a manner inconsistent with its use in the

specification. *See* § III.B, *infra*. The term has no single, accepted meaning in the

art, rendering the boundaries and meaning of the claims indefinite and confusing

by inclusion of this term. *See* § IV, *infra*. The recitation of a second category of

"computer usage information" in the amended claim (i.e., "*other*" computer usage

information) simply adds to this confusion. For example, nothing in the '314 patent suggests there are two classes of "computer usage information" or which type of information falls within one or both of the categories. Ex. 1028 at ¶¶ 94-95. This confusion is further compounded by the amorphous and inherently variable definition of "computer usage information" in the specification. *See* § IV, *infra*.

Patent Owner makes no effort to reconcile the internal conflicts and ambiguity of its amended claims, which render them incapable of analysis for patentability. Patent Owner's failure to even propose a claim construction severely prejudices the Board, the Petitioner and the public, and prevents a fair evaluation of the merits of its claim amendment. *Toyota Motor Corp. v. American Vehicular Sciences LLC*, IPR2013-00419, Paper 32 at 5 (March 7, 2014). Patent Owner thus plainly not met its burden, and its Motion to Amend should be denied.

III. The Proposed Substitute Claims Are Not Supported by the Written Description of the '314 Patent

A. Patent Owner Fails to Meet Its Burden of Proof on Written Description Support for its New Claims

Patent Owner had the burden of establishing written description support for the amended claims in the original disclosure of the patent. 37 C.F.R. § 42.20(c). Patent Owner again ignores its burden, and makes no attempt to show how the original disclosure supports the amended claims.

Whether there is written description support for a claimed invention requires

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