UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION AND GOOGLE INC.,
Petitioner

v.

B.E. TECHNOLOGY, LLC
Patent Owner

Case IPR2014-00039[1]
Patent 6,628,314

PATENT OWNER'S REPLY TO PETITIONER'S OPPOSITION TO PATENT OWNER'S CONTINGENT MOTION TO AMEND (37 C.F.R. § 42.23)

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

Patent Owner B.E. Technology, L.L.C. respectfully submits this reply to the opposition of Petitioner to its Contingent Motion to Amend.

I. MICROSOFT'S CLAIM CONSTRUCTION ARGUMENTS HAVE NO MERIT.

Under a heading noting the absence of claim constructions, Microsoft mentions "new claim language" but it is not clear which terms it claims to be in need of construction. Microsoft mentions an alleged reordering of "the sequence of steps in the claim," but there is no reordering of consequence. Merely placing limitations in a different order does not necessarily alter the meaning of the limitations or the claim. Microsoft then argues that the purported change in dependence has enlarged the scope of Claim 22 because it has resulted in the omission of "limitations present in the original claim by its dependence on original ***dependent*** claim 22 *[sic]*." Microsoft also appears to complain that "real-time and other computer usage information" was not made the subject of a specific claim construction. "Computer usage information" was defined in the '705 application. (Ex. 2005 at 6). "Other" requires no construction. Here, "other computer usage information" obviously means "computer usage information other than real-time computer usage information." Microsoft has misread the claims.

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. In the Abstract, there is a reference to what happens "when the user runs the program." Elsewhere,

the reference is to matters "relevant to what the user is doing at any particular time." (*Id*. at 16:9:14). A prior art patent that refers to advertisement queues that are prepared off-line is distinguished as not providing for "real time targeting of advertising based upon user actions." (*Id*. at 3:30-32).

II. DESCRIPTION SUPPORTS THE PROPOSED CLAIMS.

In *Ariad Pharm. v. Eli Lilly & Co.*, 598 F.3d 1336, 1334 (Fed. Cir. 2010), the Federal Circuit held that the "written description" requirement of 35 U.S.C. § 112 is satisfied when the application "reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date." Proposed substitute Claim 23 provides for advertising content to be selected in accordance with "real-time and other computer usage information and demographic information associated with" a unique identifier. "Real-time computer usage information" and "other computer usage information," *i.e.*, "computer usage information" other than "real-time computer usage information are both supported, and the use of both to select advertising are also supported.

In multiple places, the '705 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." (*See* Exhibit 2005 at 1, 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.

This disclosure of the use of computer usage information to target information is not limited to the use of "real-time computer usage information." The original claim language did not call for the computer usage information to be used to select advertising, but the computer usage information was to be associated with "the demographic information using the unique identifier." (*Id*. at 10, 41). The '705 application disclosed the use of computer usage information to select advertising, and the disclosure was not limited to the use of "real-time computer usage information."

There is a clear disclosure of the transmission of computer usage information "for use in . . . better targeting future," *i.e.*, not real-time, "advertising." The reference to the transmission and storage of computer usage information "for use in . . . better targeting future advertising" is a disclosure of the use of computer usage information other than "real-time computer usage information" to target advertising.

III. SUBSTITUTE CLAIMS ARE NOT INDEFINITE.

Microsoft's assertion that the defined term "computer usage information" is indefinite has no merit, and its attempt to link a purported problem with this term to a broader or different problem with the terms "real-time computer usage

information" or "other computer usage information" similarly has no basis.

IV. THE PROPOSED CLAIMS ARE PATENTABLE OVER PRIOR ART.

Microsoft's patentability arguments are also without merit. Guyot (Exhibit 1006) does not disclose all of the limitations of the original Claim 11 for the reason explained in Patent Owner's response to Microsoft's petition. (*See* Paper 30 at 9-25). Guyot further does not disclose using computer usage information that "comprises information about the user's interactions with said computer software displaying advertising content and at least one other program." Guyot makes no mention of the client application tracking what the user does after the initial launch of the Internet link.

Robinson (Exhibit 1007) does not teach all of the limitations of the original Claim 11 and does not teach or suggest all of the additional limitations of the proposed substitute claims. Microsoft ignores Robinson's disclosure that a "Smart Ad Box is an area on a Web page." (*See* Ex. 1007 at 4:8-13). The Smart Ad Box is a part of the web page, and rendered by a browser (*i.e.*, one program).

Greer (Ex. 1031) does not collect and use real-time computer usage information. Although Greer discusses becoming aware of the programs on a user's computer, Greer fails to mention tracking the user's interactions with any program outside of the browser. (Ex. 1031 at ¶ 0014).

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