

UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.,
Petitioner

v.

B. E. TECHNOLOGY LLC
Patent Owner

Case No. IPR2014-00053
Patent No. 6,628,314

**PETITIONER'S OPPOSITION TO PATENT OWNER'S
CONTINGENT MOTION TO AMEND**

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I. INTRODUCTION

The patent owner has failed to carry its burden of showing that its proposed substitute claims in its Contingent Motion to Amend are patentable. Those proposed claims are obvious in light of the prior art of record in this IPR, combined with the Apte and Barrett references discussed in more detail below.

The proposed substitute claims also fail to recite patent-eligible subject matter and are indefinite. And the patent owner's motion should also be rejected because it fails to apply the correct legal standard, does not address the proper factors, and pays only lip service to the closest prior art of record.

II. BACKGROUND

On October 9, 2013, Facebook filed two petitions for *inter partes* review of claims 11–13, 15, 18, and 20 of the '314 patent (IPR2014-00052 and IPR2014-00053). The Board instituted *inter partes* review in IPR2014-00052 on all petitioned claims as obvious over U.S. Patent No. 5,809,242 (Ex. 1103) (“Shaw”) in view of Melissa Dun et al., *Privacy and Profiling on the Web* (June 1, 1997) (Ex. 1105) (“W3C”). In IPR2014-00053, the Board instituted *inter partes* review on all petitioned claims as obvious over U.S. Patent No. 5,933,811 (Ex. 1003) (“Angles”) in view of Shaw (Ex. 1004).

III. THE PATENT OWNER FAILED TO CARRY ITS BURDEN TO DEMONSTRATE PATENTABILITY OF ITS PROPOSED SUBSTITUTE CLAIMS

In a motion to amend, the patent owner must address the patentability of its proposed substitute claims. (IPR2013-00191, paper 70 at 55.) The Board has made clear that with respect to obviousness, “the patent owner should present and discuss facts which are pertinent to the first three underlying factual inquiries of *Graham*, 383 U.S. at 17–18: (1) the scope and content of the prior art, (2) differences between the claimed subject matter and the prior art, and (3) the level of ordinary skill in the art, *with special focus on the new claim features added by the proposed substitute claims.*” *Id.* at 55–56. “Some discussion and analysis should be made about the specific technical disclosure of the closest prior art as to each particular feature, and the level of ordinary skill in the art, in terms of ordinary creativity and the basic skill set of a person of ordinary skill in the art, regarding the feature.” *Id.* at 56. But the patent owner failed to address *Graham’s* factual inquiries and, as shown below, its proposed substitute claims are not patentably distinguishable over the prior art.

A. The patent owner failed to distinguish over the closest prior art

Proposed substitute claim 23 adds two limitations to claim 11: (1) a

limitation requiring that computer usage information is collected from “user’s interactions with . . . at least one other program,” and (2) a limitation that advertising is selected using “real-time and other computer usage information.” The patent owner asserts that no prior art reference discloses these limitations, but it is mistaken.

It was widely known prior to the earliest priority date of the ’314 patent that targeted advertising was more effective when it was based on multiple sources of information about a user and timely presented. (Second Sherwood Decl., Ex. 1037, ¶¶ 12, 20, 24.) The prior art not only recognized this fact, but expressly relied upon in describing the same two features recited in patent owner’s proposed substitution. (*Id.*) As a result, the patent owner’s substitute claims are unpatentable and obvious.

As discussed in detail below and supported by the Second Declaration of Robert J. Sherwood, U.S. Patent No. 7,225,142 to Apte and U.S. Patent No. 6,490,584 to Barrett each render the proposed substitute claims obvious when viewed in light of Shaw and W3C or Angles and Shaw. (*Id.* ¶¶ 5-7.) BE’s amended claim 23 adds nothing but minor implementation details that persons of ordinary skill in the art would have viewed as known options for inclusion in a targeted

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