UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC. Petitioner

v.

B.E. TECHNOLOGY, LLC Patent Owner

Case No.: IPR2014-00743 Patent 6,628,314

PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 6,628,314 UNDER 35 U.S.C §§ 311-319 AND 37 C.F.R. §§ 42.1-.80, 42.100-.123

Mail Stop **Patent Board** Patent Trial and Appeal Board U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-145

DOCKET

A L A R M Find authenticated court documents without watermarks at <u>docketalarm.com</u>.

TABLE OF CONTENTS

| I. | MAN | NDATORY NOTICES UNDER 37 C.F.R. § 42.8(a)(1) | 1 |
|------|------------------------------------------------------------------|----------------------------------------------------------------------------------------------------------------------------|----|
| | A. | Real Party-In-interest under 37 C.F.R. § 42.8(b)(1) | 1 |
| | B. | Related Matters under 37 C.F.R. § 42.8(b)(2) | 2 |
| | | Current Litigation | 2 |
| | | Administrative Proceedings | 2 |
| | C. | Lead and Back-Up Counsel under 37 C.F.R. § 42.8(b)(3) | 3 |
| | D. | Service Information | 4 |
| | E. | Power of Attorney | 4 |
| II. | _ | UIREMENTS FOR INTER PARTES REVIEW UNDER 37 R. §§ 42.104 AND 42.108 | 4 |
| | A. | Identification of Challenge under 37 C.F.R. § 42.104(b) and Statement of Precise Relief Requested | 5 |
| | В. | Threshold Requirement for Inter Partes Review 37 C.F.R. § 42.108(c) | 5 |
| III. | SUMMARY OF THE '314 PATENT | | 6 |
| | A. | Brief Description | 6 |
| | B. | Summary of the Prosecution History of the '314 Patent | 7 |
| IV. | CLA | IM CONSTRUCTION UNDER 37 C.F.R. § 42.104(b)(3) | 8 |
| | A. | Legal Overview | 9 |
| | B. | Clarification of "associating" | 9 |
| | C. | Clarification of "periodically" | 10 |
| V. | PERSON HAVING ORDINARY SKILL IN THE ART & STATE OF THE ART | | 11 |
| VI. | CLAIMS 11-13, 15, 18, AND 20 OF THE '314 PATENT ARE UNPATENTABLE | | 12 |
| | A. | Ground 1 – Claims 11-13, 15, 18, and 20 Are Obvious Under 35 U.S.C. § 103(a) Over Shaw in View of the W3C Submission | 13 |
| VII. | CONCLUSION | | 37 |

List of Exhibits¹

- Exhibit 1101: U.S. Patent No. 6,628,314 to Hoyle ("the '314 patent")
- Exhibit 1102: Excerpted File History of the '314 Patent
- Exhibit 1103: U.S. Patent No. 5,809,242 to Shaw et al., filed on April 19, 1996 and issued on September 15, 1998 ("Shaw")
- Exhibit 1104: Sheree R. Curry, Pointcast and its Wannabes (1996)
- Exhibit 1105: Melissa Dunn et al., Privacy and Profiling on the Web (1997) ("W3C Submission")
- Exhibit 1106: U.S. Patent No. 6,587,127 to Leeke et al., filed on November 24, 1998 and issued on July 1, 2003 ("Leeke")
- Exhibit 1107: U.S. Patent No. 5,721,827 to Logan et al., filed on October 2, 1996 and issued on February 24, 1998 ("Logan")
- Exhibit 1108: U.S. Patent No. 5,948,061 to Merriman et al., filed on October 29, 1996 and issued on September 7, 1999 ("Merriman")
- Exhibit 1109: U.S. Patent No. 5,918,014 to Robinson, filed on December 26, 1996 and issued on June 29, 2999 ("Robinson")
- Exhibit 1110: U.S. Patent No. 5,848,396 to Gerace, filed on April 26, 1996 and issued on December 8, 1998 ("Gerace")
- Exhibit 1111: Declaration of Robert J. Sherwood In Support Of This Petition ("Sherwood Decl.")
- Exhibit 1112: U.S. Patent No. 7,225,142 to Apte et al., filed on August 1, 1996 and issued on May 29, 2007

¹ All of the following exhibits are found in Case No. Case No. IPR2013-00052, the proceeding Petitioner seeks to join. While not all exhibits are referenced in the Petition below, Petitioner has included all exhibits and kept their original numbering for the purposes of consistency and accurate internal cross-citations.

- Exhibit 1113: U.S. Patent No. 6,141,010 to Hoyle, filed on July 17, 1998, and issued on October 31, 2000
- Exhibit 1114: Excerpted File History of U.S. Patent No. 6,141,010
- Exhibit 1115: Neil Barrett, Advertising on the Internet (Sept. 1997)
- Exhibit 1116: Jim Sterne, Advertising on the Web (Sean Dixon & Patrick Kanouse, Jan. 1997)
- Exhibit 1117: Simon St. Laurent, Cookies (Mar. 1998)
- Exhibit 1118: Don Peppers & Martha Rogers, The One to One Future (Dec. 1996)
- Exhibit 1119: Robbin Zeff & Brad Aronson, Advertising on the Internet (Tim Ryan et al., July 1997)
- Exhibit 1120: Ramez Elmasri & Shamkant B. Navathe, Fundamentals of Database Systems (Dan Joraanstad et al., 2nd ed. Aug. 1998)
- Exhibit 1121: Mark R. Brown et al., Using Netscape 3 (Kellie M. Brooks et al. eds., special ed., Dec. 1996)
- Exhibit 1122: Rosalind Resnick & Dave Taylor, The Internet Business Guide (Cindy Morrow et al., 2nd ed., Jan. 1995)
- Exhibit 1123: U.S. Patent No. 6,134,592 to Montulli, filed on August 27, 1997 and issued on October 17, 2000
- Exhibit 1124: M. Crawford, Transmission of IPv6 Packets over FDDI Networks (1998)
- Exhibit 1125: The American Heritage Dictionary of the English Language (Anne H. Soukhanov et al., 3rd ed. 1992)
- Exhibit 1126: Alan Freedman, The Computer Desktop Encyclopedia (2nd ed. 1999)
- Exhibit 1127: U.S. Patent No. 5,826,242 to Montulli, filed August 27, 1997 and issued on October 20, 1998
- Exhibit 1128: Non-Final Office Action, U.S. App. No. 13/107,231 (July 29, 2013)

- Exhibit 1129: Persistent Client State HTTP Cookies, Preliminary Specification, Netscape Communications Corp. (1996)
- Exhibit 1130: U.S. Patent No. 5,724,521 to Dedrick, filed November 3, 1994 and issued on March 3, 1998
- Exhibit 1131: U.S. Patent No. 5,796,952 to Davis et al., filed on March 21, 1997 and issued on August 18, 1998.
- Exhibit 1132: D. Kristol & L. Montulli, HTTP State Management Mechanism, Network Working Group, Request for Comments 2109 (Feb. 1997)
- Exhibit 1133: Network Working Group, Request for Comments: 1945 HTTP/1.0 (May 1996) available at http://www.w3.org/Protocols/rfc1945/rfc1945
- Exhibit 1134: U.S. Patent No. 5,933,811 to Angles et al., filed on August 20, 1996 and issued on August 3, 1999 ("Angles")
- Exhibit 1135: Microsoft Corp., A History of Windows, available at http://windows.microsoft.com/en-us/windows/history
- Exhibit 1136: Affidavit of Ralph Swick Regarding the Authenticity and Publication Date of "Privacy and Profiling on the Web" and the "Open Profiling Specification" Published on June 9, 1997
- Exhibit 1137: Pat Hensley et al., Proposal for an Open Profiling Standard, v1.0 (June 2, 1997), available at http://www.w3.org/TR/NOTE-OPS-FrameWork

DOCKE.

DOCKET A L A R M



Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.