

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.
Petitioner

v.

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

Case IPR2014-00743
Patent 6,628,314 B1

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

DESHPANDE, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Google, Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 11-13, 15, 18, and 20 of U.S. Patent No. 6,628,314 B1 (Ex. 1001, “the ’314 patent”). Paper 1 (“Pet.”). B.E. Technology, L.L.C. (“Patent Owner”) elected not to file a preliminary response. *See* Paper 8. We have jurisdiction under 35 U.S.C. § 314.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides as follows:

THRESHOLD -- The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

Upon consideration of the Petition, we determine that the information presented by Petitioner has established that there is a reasonable likelihood that Petitioner would prevail in showing the unpatentability of claims 11-13, 15, 18, and 20 of the ’314 patent. Accordingly, we institute an *inter partes* review of these claims.

A. *Related Proceedings*

Petitioner indicates that the ’314 patent is the subject of proceedings in *B.E. Technology, L.L.C. v. Google, Inc.*, No. 2:12-cv-02830 (W.D. Tenn.), filed on September 21, 2012, and numerous district court cases filed by Patent Owner against other defendants. Pet. 2.

Petitioner also seeks review of the ’314 patent in *inter partes* review case IPR2014-00738 and *inter partes* case IPR2014-00744. Additionally, the ’314 patent is the subject of the following *inter partes* reviews: *Google*,

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Inc. v. B.E. Technology, L.L.C., Case IPR2014-00038 (PTAB Apr. 9, 2014), *Microsoft Corporation v. B.E. Technology, L.L.C.*, Case IPR2014-00039 (PTAB Apr. 9, 2014), *Facebook, Inc. v. B.E. Technology, L.L.C.*, Case IPR2014-0052 (PTAB Apr. 9, 2014), *Facebook, Inc. v. B.E. Technology, L.L.C.*, Case IPR2014-00053 (PTAB Apr. 9, 2014), *Match.com LLC and People Media, Inc v. B.E. Technology, L.L.C.*, Case IPR2014-00698 (PTAB June 13, 2014), and *Match.com LLC and People Media, Inc v. B.E. Technology, L.L.C.*, Case IPR2014-00699 (PTAB June 13, 2014). Petitioner filed a motion for joinder with *Facebook, Inc. v. B.E. Technology, L.L.C.*, Case IPR2014-00052 (PTAB Apr. 9, 2014). See Paper 3.

B. Illustrative Claim

Petitioner challenges claims 11-13, 15, 18, and 20 of the '314 patent. Independent claim 11 is illustrative of the claims at issue and follows:

11. A method of providing demographically-targeted advertising to a computer user, comprising the steps of:
 - providing a server that is accessible via a computer network,
 - permitting a computer user to access said server via said computer network,
 - acquiring demographic information about the user, said demographic information including information specifically provided by the user in response to a request for said demographic information,
 - providing the user with download access to computer software that, when run on a computer, displays advertising content, records computer usage information concerning the user's utilization of the computer, and periodically requests additional advertising content,
 - transferring a copy of said software to the computer in response to a download request by the user,

providing a unique identifier to the computer, wherein said identifier uniquely identifies information sent over said computer network from the computer to said server,

associating said unique identifier with demographic information in a database,

selecting advertising content for transfer to the computer in accordance with the demographic information associated with said unique identifier;

transferring said advertising content from said server to the computer for display by said program,

periodically acquiring said unique identifier and said computer usage information recorded by said software from the computer via said computer network, and

associating said computer usage information with said demographic information using said unique identifier.

C. The Alleged Grounds of Unpatentability

The information presented in the Petition sets forth Petitioner's contentions of unpatentability of claims 11-13, 15, 18, and 20 of the '314 patent under 35 U.S.C. § 103, as follows (*see* Pet. 5, 13-37):

Reference(s)	Basis	Claims Challenged
Shaw ¹ and W3C ²	§ 103(a)	11-13, 15, 18, and 20

II. ANALYSIS

Petitioner argues that claims 11-13, 15, 18, and 20 are unpatentable under 35 U.S.C. § 103 as obvious over Shaw and W3C. Pet. 5, 13-37.

Petitioner submits arguments and evidence identical to those submitted in

¹ U.S. Patent No. 5,809,242 (Ex. 1103) ("Shaw").

² Melissa Dunn et al., *Privacy and Profiling on the Web* (Jun. 1, 1997), available at <http://www.w3.org/TR/NOTE-Web-privacy.html> (Ex. 1105) ("W3C").

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IPR2014-00052. Pet. 1. Petitioner proposes the same claim construction and argues the same rationale of unpatentability of claims 11-13, 15, 18, and 20 as presented in IPR2014-00052. Pet. 8-37; *Facebook, Inc. v. B.E. Technology, L.L.C.*, Case IPR2014-00052, Paper 1, 7-8, 10-32. Petitioner further relies on the same declaration by Robert J. Sherwood in support of their alleged ground of unpatentability. Pet. 5; Ex. 1111. Patent Owner did not file a preliminary response in IPR2014-00052, and does not file a preliminary response in this case. *See* Paper 8.

We determined that the Petitioner in IPR2014-00052 (“the -00052 Petitioner”) demonstrated a reasonable likelihood of prevailing in establishing the unpatentability of claims 11-13, 15, 18, and 20 of the ’314 patent. *Facebook, Inc. v. B.E. Technology, L.L.C.*, Case IPR2014-00052, slip op. at 8-15 (Paper 10). We granted that petition and instituted an *inter partes* review of claims 11-13, 15, 18, and 20 as unpatentable under 35 U.S.C. § 103 as obvious over Angles and Shaw. *Facebook, Inc. v. B.E. Technology, L.L.C.*, Case IPR2014-00052, slip op. at 16 (Paper 10).

Accordingly, we incorporate our previous analysis, including our claim interpretation analysis (*see Facebook, Inc. v. B.E. Technology, L.L.C.*, Case IPR2014-00052, slip op. at 6-8 (Paper 10)) and our unpatentability analysis regarding this asserted ground of unpatentability (*see Facebook, Inc. v. B.E. Technology, L.L.C.*, Case IPR2014-00052, slip op. at 8-15 (Paper 10)), from IPR2014-00052, and we determine that Petitioner has demonstrated a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of claims 11-13, 15, 18, and 20 of the ’314 patent in this petition for the same reasons discussed in *Facebook, Inc. v. B.E. Technology, L.L.C.*, Case IPR2014-00052 (PTAB Apr. 9, 2014).

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