

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner,

v.

AT HOME BONDHOLDERS' LIQUIDATING TRUST,
Patent Owner.

Case IPR2015-00660
Patent 6,286,045 B1

Before, KARL D. EASTHOM, JUSTIN T. ARBES, and
MIRIAM L. QUINN *Administrative Patent Judges*.

QUINN, *Administrative Patent Judge*.

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

Google, Inc. (“Petitioner”) filed a Petition to institute *inter partes* review of claims 49–53, 55–58, 64–67, and 69–71 of U.S. Patent No. 6,286,045 B1 (“the ’045 patent”) pursuant to 35 U.S.C. § 311–319. Paper 2 (“Pet.”). At Home Bondholders’ Liquidating Trust (“Patent Owner”) timely filed a Preliminary Response. Paper 10 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314.

For the reasons that follow, we institute an *inter partes* review as to claims 49–53, 55–58, 64–67, and 69–71 on certain grounds of unpatentability.

I. BACKGROUND

A. RELATED MATTERS

Petitioner identifies that the patent-at-issue is the subject matter of a district court case filed in the U.S. District Court for the District of Delaware (Case No. 1:14-cv-00216). Pet. 51.

B. ASSERTED GROUNDS

Petitioner contends that claims 49–53, 55–58, 64–67, and 69–71 (“the challenged claims”) are unpatentable under 35 U.S.C. § 103 based on the following specific grounds:

Reference[s]	Basis	Claims challenged
Angles, ¹ Merriman, ² and HTTP1.0 ³	§ 103	49, 51-53, 55-58, 64-67, and 70-71

¹ U.S. Patent No. 5,933,811 (Exhibit 1012) (“Angles”).

Reference[s]	Basis	Claims challenged
Angles, Merriman, HTTP10, and Davis ⁴	§ 103	50 and 69
Wexler ⁵ and HTTP1.0	§ 103	49-53 and 55-57
Wexler, HTTP1.0, Meeker ⁶	§ 103	58, 64-67, and 69-71

C. THE '045 PATENT (EX. 1001)

The '045 patent is directed to a system for storing information on a computer network and allowing the information to be accessed by terminals connected to the computer network, either directly, or through an intermediary device such as a local or proxy server. Ex. 1001, Abstract. The system includes computers or web sites that store pages, which may include references to banners to be displayed in conjunction with the web pages on the terminal. *Id.* The '045 patent also discloses a method that “solves the initial problem of how to create accurate counts of banner information displays on user terminals while avoiding the problems created by requiring the banner information to be retransmitted across the computer network each time the banner information is requested by a user or a user’s

² U.S. Patent No. 5,948,061 (Exhibit 1013) (“Merriman”).

³ T. Berners-Lee et al., *HTTP Working Group Internet Draft Hypertext Transfer Protocol-HTTP/1.0*, (Feb. 19, 1996) (Exhibit 1008) (“HTTP1.0”).

⁴ U.S. Patent No. 5,796,952 (Exhibit 1014) (“Davis”).

⁵ U.S. Patent No. 5,960,409 (Exhibit 1007) (“Wexler”).

⁶ Mary Meeker, *Technology: Internet/New Media The Internet Advertising Report*, Morgan Stanley, U.S. Investment Research (Dec. 1996) (Exhibit 1010) (“Meeker”).

terminal.” *Id.* at 14:33–40. In one embodiment, the ’045 patent describes the use of an initial banner request signal that is a general content Uniform Resource Locator (“URL”) address generated by the terminal, where the URL does not specify which banner is to be displayed. *Id.* at 17:22–26. The recipient of the initial banner request signal selects which banner is to be displayed on the terminal, and returns a specific content URL address to the terminal, using a “Status HTTP 302 Redirect signal,” indicating the address of the selected banner. *Id.* at 17:26–36. Therefore, even though the banner may be cached or stored on the user’s terminal or on a proxy server, the specific content URL address signal is not cached, preventing the initial banner request signal from being blocked by either the terminal or the proxy server. *Id.* at 17:42–50.

D. ILLUSTRATIVE CLAIMS

Challenged claims 49 and 64 are independent, and are reproduced below.

49. A method for enabling distribution of a banner over a computer network to a device when the banner is referenced in a document served to the device, wherein the banner is stored in one or more servers connected to the computer network, and the device is connected to the computer network via an intermediary server, comprising:

causing a first banner request signal to be transmitted from the device to a first server requesting that a banner be served to the device, wherein said first banner request signal includes information intended to make said first banner request signal not blockable by the device or the intermediary server as a result of a storage in the device or the intermediary server of said requested banner prior to the generation of said first banner signal by the device;

sending a banner location signal from said first server to the device, wherein said banner location signal includes location information for said requested banner stored on a second server; and determining if said requested banner is stored on the device and, if said requested banner is not stored on the device, then causing a second banner request signal to be transmitted from the device to the intermediary server and determining if said requested banner is stored on the intermediary server, wherein if said requested banner is not stored on the intermediary server, causing at least a portion of said second banner request signal to be sent to said second server requesting that said second server serve said requested banner to said device.

64. A method for enabling accurate counting of displays of a banner on a client device, comprising:

receiving a first banner request signal at a first server requesting that a banner be served to a client device, wherein said first banner request includes information intended to prevent said first banner request signal from being blocked from said first server, even though there has been previous caching or storing of said banner by the client device or an intermediary device;

sending a banner location signal to the client device, wherein said banner location signal includes location information for a specified banner stored on a second server; and

causing a determination of whether said specified banner is stored on the client device and, if said specified banner is not stored on the client device, receiving a second banner request signal from the client device at said intermediary device and causing a determination of whether said specified banner is stored on said intermediary device, wherein if said specified banner is not stored on said intermediary device, receiving a third banner request signal at said second server requesting that said second server serve said specified banner to the client device.

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.