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Paper 15
Entered: August 10, 2016

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 IPR2015-00657
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.*

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

Google Inc. ("Petitioner") filed two Petitions requesting *inter partes* review of certain claims of U.S. Patent No. 6,286,045 B1 ("the '045 patent"). The Petition filed in IPR2015-00657 requested *inter partes* review of claims 20–31, 33, 43–44, 47–48, 59, 61–63, 72–73, 75, and 77–78. IPR2015-00657 ("'657 IPR"), Paper 2 ("'657 Pet."). The Petition filed in IPR2015-00660 requested *inter partes* review of claims 49–53, 55–58, 64–67, and 69–71. IPR2015-00660 ("'660 IPR"), Paper 2 ("'660 Pet."). At Home Bondholders' Liquidating Trust ("Patent Owner") filed a Preliminary Response in each of the proceedings. '657 IPR, Paper 10 ("Prelim. Resp."); '660 IPR, Paper 10. Upon consideration of both Petitions and the Preliminary Responses, we instituted trial as to claims 49–53, 55–59, 61–67, and 69–73 of the '045 patent on August 14, 2015. '657 IPR, Paper 14 ("'657 Dec."); '660 IPR, Paper 14 ("'660 Dec."). We consolidated the '660 IPR with the '657 IPR, and ordered all evidence and papers to be filed in the record of the '657 IPR proceeding. '660 Dec. 21.

Subsequent to institution, and in accordance with our order consolidating the two proceedings, Patent Owner filed a Patent Owner Response (Paper 24, "PO Resp."); and Petitioner filed a Reply (Paper 35, "Reply"). Oral argument was heard on April 7, 2016.[1]

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a). For the reasons discussed

[1] A transcript of the oral argument is entered in the record as Paper 41 ("Tr.").

herein, and in view of the record in this trial, we determine that Petitioner has not shown by a preponderance of the evidence that claims 49–53, 55–59, 61–67, and 69–73 of the '045 patent ("the challenged claims") are unpatentable.

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), and transferred to the U.S. District Court for the Northern District of California (Case No. 3:15-cv-00966). Paper 37.

B. INSTITUTED GROUNDS OF UNPATENTABILITY

We instituted trial based on the following grounds ('657 Dec. 23–24; '660 Dec. 20):

Reference[s]	**Basis**	**Claims challenged**
Angles,[2] Merriman,[3] HTTP 1.0[4]	§ 103	49, 51–53, 55–59, 61–67, and 70–73
Angles, Merriman, HTTP 1.0, and Davis[5]	§ 103	50 and 69

[2] U.S. Patent No. 5,933,811 (Exhibit 1012) ("Angles").
[3] U.S. Patent No. 5,948,061 (Exhibit 1013) ("Merriman").
[4] Fielding et al., *HTTP Working Group Internet Draft Hypertext Transfer Protocol–HTTP/1.0*, (Feb. 20, 1996) (Exhibit 1008) ("HTTP 1.0").
[5] U.S. Patent No. 5,796,952 (Exhibit 1014) ("Davis").

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 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

Of the challenged claims, claims 49, 59, 64, and 72 are independent. The remaining challenged claims depend directly or indirectly from a challenged independent claim. Claims 49 and 59, reproduced below, are illustrative of the challenged claims.

> 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.

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