

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner,

v.

AT HOME BONDHOLDERS' LIQUIDATING TRUST,
Patent Owner.

Cases IPR2015-00662 and IPR2015-00666
Patent 6,014,698

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

ARBES, *Administrative Patent Judge*.

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

Petitioner Google Inc. filed two Petitions requesting *inter partes* review of claims 1–3, 5–7, 9, 11–20, 22–31, 34–39, 41–47, and 49 of U.S. Patent No. 6,014,698 (Ex. 1001, “the ’698 patent”)¹ pursuant to 35 U.S.C. §§ 311–19. Patent Owner At Home Bondholders’ Liquidating Trust filed a Preliminary Response in each proceeding, as listed in the following chart.

Case Number	Challenged Claims	Petition	Preliminary Response
IPR2015-00662	1–3, 5–7, 9, 11–16, and 23	Paper 2 (“Pet.”)	Paper 10 (“Prelim. Resp.”)
IPR2015-00666	17–20, 22–31, 34–39, 41–47, and 49	Paper 2 (“-666 Pet.”)	Paper 12 (“-666 Prelim. Resp.”)

We have jurisdiction under 35 U.S.C. § 314. Pursuant to 35 U.S.C. § 314(a), the Director may not authorize an *inter partes* review unless the information in the petition and preliminary response “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.” For the reasons that follow, we institute an *inter partes* review as to claims 1–3, 5–7, 9, 11–20, 22, 24–31, 34–39, 41–47, and 49 of the ’698 patent on certain grounds of unpatentability. To administer the proceedings more efficiently, we also exercise our authority under 35 U.S.C. § 315(d) to consolidate the two proceedings and conduct the proceedings as one trial.

¹ Unless otherwise specified, references to exhibits are to those filed in Case IPR2015-00662.

I. BACKGROUND

A. *The '698 Patent*²

The '698 patent describes a “system for the storage, management, and delivery of information on a computer network” that provides for the “efficient and accurate counting of advertising information displayed on terminals connected to the computer network.” Ex. 1001, col. 1, ll. 19–23. According to the '698 patent, prior art systems could not count accurately the number of times a banner (e.g., a graphic of an advertisement) is displayed to users due to the use of caching. *Id.* at col. 3, ll. 16–37, col. 6, ll. 22–29, col. 7, ll. 9–20. For example, when a web page and associated banner are stored on a user’s terminal or an intermediary proxy server connected to the user’s terminal, a subsequent request for the information may be satisfied from the cache, such that no request is forwarded over the computer network to a server and the server cannot obtain an accurate count of banner displays. *Id.* at col. 13, ll. 1–14, Fig. 3. Prior art systems attempted to overcome this problem by prohibiting caching on the user’s terminal or proxy server, but doing so introduced other problems, such as increased network traffic and increased retrieval time due to the need to retransmit the information over the network every time it is requested. *Id.* at col. 13, l. 40–col. 14, l. 44.

The '698 patent states that its disclosed system is able to count accurately banner displays while at the same time taking advantage of the performance gains obtained from caching. *Id.* at col. 14, ll. 45–57. The user’s terminal first requests and receives a web page that has an associated

² The '698 patent is a continuation-in-part of U.S. Patent No. 6,286,045 B1, which is being challenged in Cases IPR2015-00657, IPR2015-00658, and IPR2015-00660.

banner. *Id.* at col. 9, ll. 38–49. The terminal then sends an initial banner request signal, which may include a general content Uniform Resource Locator (“URL”) address that does not specify which banner is to be displayed. *Id.* at col. 17, ll. 34–38, Fig. 4 (step 112). Because software on the user’s terminal (e.g., web browser) or a proxy server might block the initial banner request signal if the banner had been cached previously, the strings “cgi-bin” and “?” may be included in the signal to “prevent[] the terminal from blocking” the signal. *Id.* at col. 19, ll. 24–57. Then, rather than returning the banner itself (as in the prior art), the recipient of the initial banner request signal selects which banner is to be displayed on the terminal, increments the count of displays, and returns a banner address to the user’s terminal. *Id.* at col. 15, ll. 42–56, Fig. 4 (steps 113 and 114). The return information may be, for example, a specific content URL address in the form of a “Status HTTP 302 Redirect (temporary) signal” indicating where the selected banner is stored. *Id.* at col. 17, ll. 38–49. The user’s terminal then retrieves the banner, either from a local cache or proxy server cache, or a remote server if the banner had not been cached. *Id.* at col. 15, l. 60–col. 16, l. 34. In that way, the disclosed system is able to maintain an accurate count of banner displays, while also retaining the performance benefits of caching. *Id.* at col. 14, ll. 45–57.

B. Illustrative Claim

Claim 1 of the ’698 patent recites:

1. A method for delivering information to a terminal connected to a computer network, wherein information delivered over the computer network from a primary server to the terminal contains references to other information to be delivered to the terminal from the primary server or from one or

more other servers connected to the computer network, comprising:

serving a first portion of information to the terminal, wherein said first portion of information contains a reference to a second portion of information;

sending a first request signal from the terminal to the primary server requesting a location address for said second portion of information from which said second portion of information can be served to the terminal, wherein said first request signal cannot be blocked from reaching said primary server by either the terminal or any intermediary device located topologically between the terminal and the primary server as a result of previous caching or storing of said first portion of information or said second portion of information by the terminal or said intermediary device;

sending a location signal from the primary server to the terminal providing said location address of said second portion of information; and

determining if said second portion of information is already stored on the terminal and, if said second portion of information is not already stored on the terminal, sending a second request signal from the terminal containing said location address of said second portion of information and requesting that said second portion of information be served to the terminal for display on the terminal, and, if said second portion of information is already stored on the terminal, displaying said second portion of information on the terminal.

C. The Prior Art

Petitioner relies on the following prior art:

U.S. Patent No. 5,796,952, filed Mar. 21, 1997, issued Aug. 18, 1998 (Ex. 1014, “Davis”);

U.S. Patent No. 5,933,811, filed Aug. 20, 1996, issued Aug. 3, 1999 (Ex. 1012, “Angles”);

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