

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,

Petitioner

v.

PATRICK ZUILI,

Patent Owner.

Case CBM2016-00008

Patent 8,671,057 B1

Before KARL D. EASTHOM, SCOTT A. DANIELS, and
STACEY G. WHITE, *Administrative Patent Judges*.

WHITE, *Administrative Patent Judge*.

DECISION
Request for Rehearing
37 C.F.R. § 42.71(d)

SUMMARY

Petitioner, Google, Inc., requests rehearing of the Board’s decision (Paper 18, “Decision to Institute or Dec.”), entered April 25, 2016, instituting a covered business method patent review of claims 1, 5, 9, and 11 of U.S. Patent No. 8,671,057 B1 (“the ’057 patent”) as unpatentable under 35 U.S.C. § 101. Paper 20 (“Req. Reh’g”). Petitioner also had sought to institute a covered business method patent review of claims 1, 5, and 9 as obvious over IAB Study¹ and claims 5 and 11 as obvious over IAB Study and Laurent.² We denied institution of those asserted grounds because we were not persuaded that IAB Study taught “obtaining from the device on the client, a second code when said at least one user performs a first click on at least one of said links associated with at least one of said other web pages at a first time.” Dec. 22–26. Petitioner seeks rehearing of the denial of these asserted grounds. Req. Reh’g 4–10. For the reasons that follow, Petitioner’s request for rehearing is *granted*.

DISCUSSION

Petitioner argues that the Board misapprehended its argument as to “obtaining from the device on the client, a second code when said at least one user performs a first click on at least one of said links associated with at least one of

¹ Petitioner labels Exhibit 1037 as “IAB Study.” This Exhibit is the combination of IAB 1 (Ex. 1004) and IAB 2 (Ex. 1005):

Interactive Audience Measurement and Advertising Campaign Reporting and Audit Guidelines, Interactive Advertising Bureau, Jan. 2002 (Ex. 1004, “IAB 1”) (IAB 1 is presented as pages 1–12 of IAB Study).

IAB Online Ad Measurement Study, Dec. 2001 (Ex. 1005, “IAB 2”) (IAB 2 is presented as pages 13–64 of IAB Study).

² Simon St. Laurent, *Cookies*, Mar. 1998 (Ex. 1009, “Laurent”).

said other web pages at a first time.” Req. Reh’g 4–10. In the Decision, we stated that we were not persuaded that Petitioner had shown that IAB Study³ taught a second code that was obtained from the client device. Dec. 25.

Petitioner asserts that our analysis overlooked evidence that showed that IAB Study disclosed a step in which a browser clicks on an advertisement thereby causing the browser to request a target site from the Publisher Ad/Click Transaction Server. Req. Reh’g 5 (citing Ex. 1037, 31). In our Decision, we analyzed whether the 302 redirection request would have taught this limitation. Dec. 25. Petitioner, however, was not relying on the redirection request, which is referenced in step 2 of the Click Request and Counting Process, and thus, we will now analyze whether the communication between the browser and the Publisher Ad/Click Transaction Server referenced in step 1 would have taught this limitation.

The portion of the IAB documents relied upon is reproduced below.

³ Petitioner asserts IAB 1 and IAB 2 should be considered to be a single publication. Pet. 27; Ex. 1006 ¶ 93. In the Decision, we declined to address this issue because we found the disclosures to be insufficient to warrant institution. Dec. 23. In a related case between the same parties, Petitioner also argued that IAB 1 and IAB 2 constitutes a single publication. CBM2016-00021, Paper 1, 23. We adopt the analysis put forth in the institution decision in CBM2016-00021 and we also find that IAB 1 and IAB 2 are not a single publication. CBM2016-00021, slip op. at 41–44 (Paper 11). In this case, Petitioner puts forth the additional argument that even if IAB 1 and IAB 2 are separate publications the challenged claims would have been obvious over the combined teachings of these documents and that the teachings would have been combined because IAB 1 includes guidelines that were developed based on the study results published in IAB 2. Pet. 29. We find this argument to be reasonable on the present record, and we analyze the asserted ground of obviousness over the two publications. For ease of reference, we cite to Exhibit 1037, which is the combination of IAB 1 and IAB 2. IAB 1 is found on pages 1–12 of Exhibit 1037 and IAB 2 is found on pages 13–64 of Exhibit 1037.

Click Request and Counting Process

Narrative

1. Browser clicks on an ad which causes browser to request a target site from the Publisher Ad/Click Transaction Server. The target site URL is typically included in the request.

1a. Ad/Click Transaction Server records the click.

2. Ad/Click Transaction Server responds to the Browser with a redirect (HTTP 302) to Target Site location.

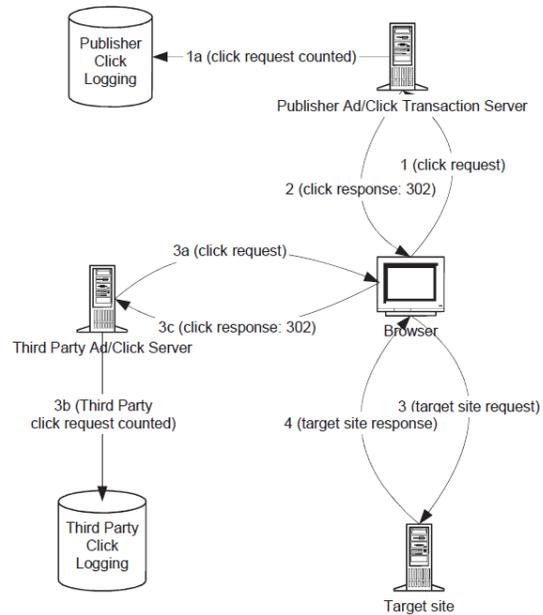
3. Browser follows redirect to Target Site.

3a. In the case of a third party-served ad, the target site location is actually that of the Third Party Ad server.

3b. The Third Party Ad/Click Server records the click request.

3c. The Third Party Ad/Click Server responds with redirect to the Target Site.

4. Target Site server responds to the Browser.



The Click Request and Counting Process is depicted in the Figure above. Ex. 1037, 31. Petitioner relies upon the first step of the Click Request and Counting Process to teach the limitation at issue. Req. Reh’g 5. As described in the Petition, the request sent from the browser to the Publisher Ad/Click Transaction Server typically also includes a target site URL. Pet. 32. According to Petitioner, “this step clearly shows that the second code [the target site URL] is obtained from the client because it is included in the request from the client device [the browser].” Req. Reh’g 5.

At issue here is whether the second code is *obtained from* the client device when the user clicks on a link. The IAB documents discuss click-through, which is the measurement of the user-initiated action of clicking on an advertisement that causes a redirect to another web location. Ex. 1037, 4. The target site URL is the internet address to which the user’s browser is redirected. *See id* at 31. Prior to the redirection, a communication is sent from the user’s browser to Publisher Ad/Click Transaction server in order to allow that server to increment its count of clicks associated with an advertisement. *Id.* As described in the references, the number

of clicks is not equal to the number of redirections because some users may click on an advertisement and not go forward to the indicated URL. *Id.* at 5.

Petitioner's declarant, Mr. Stephen Gray, states that the "target site URL included in the HTTP request [sent to the Publisher Ad/Click Transaction Server] corresponds to the 'second code' because it is obtained 'from the device on the client side.'" Ex. 1006 ¶ 108. Thus, on this record, we are persuaded that Petitioner has made a sufficient showing that the Publisher Ad/Click Transaction Server obtains the target site URL from the communication described in step 1, which is sent by the browser in order to facilitate the counting of clicks.

We are persuaded that Petitioner has met the threshold of 35 U.S.C. § 324 in regards to its assertion that claims 1, 5, and 9 would have been obvious over IAB 1 and IAB 2 (Pet. 29–41) and that claims 5 and 11 would have been obvious over IAB 1, IAB 2, and Laurent (*id.* at 41–44). As to independent claim 1, Petitioner asserts that the generation of the first code is taught by the cited art's discussion of a "cost-per-action model' that based revenue on click results." Pet. 30 (citing Ex. 1037, 20). This model is described as using cookies to track clicks. *Id.* (citing Ex. 1037, 5). Petitioner's declarant testifies that these cookies are generated by the web server and they uniquely identify the client on which the cookie has been stored. *Id.* (citing Ex. 1006 ¶ 105). As to the third code, it is Petitioner's assertion that this code is taught by the previously discussed target site URL. *Id.* at 32. Petitioner contends that Patent Owner has stated that "if the codes identify the device, the two clicks from the same device would result in the first code being the same as the second code, because both codes identify the device being used by the user." *Id.* (quoting Ex. 1035, 1–2 (Brite Smart's⁴ Opening Claim Construction

⁴Brite Smart was the previous owner of the '057 patent. Subsequent to the filing of that claim construction brief, the '057 patent was assigned to Patrick Zuili.

Brief)). Petitioner extends this analysis (that was based on claim construction arguments for a related patent) to claim 1's third code by arguing that the third code would be the same as the second code if the two clicks were on the same advertisement. *Id.* Thus, Petitioner argues that IAB 2's disclosure of a target site URL included in the communication with the Publisher Ad/Click Transaction Server would have rendered obvious both the claimed second and third codes that are obtained after the user clicks an advertisement at a first and second time. Ex. 1006 ¶ 109. Finally, IAB 1 and IAB 2 are asserted to teach examining the difference between the first and second time through its disclosure of filtering out invalid clicks by reviewing the interval between clicks. Pet. 33–35 (citing Ex. 1037, 6, 8–9, 30–31, 40, 48). We find these arguments to be persuasive.

We also find Patent Owner's argument regarding this ground to be unpersuasive. Patent Owner argues that the IAB documents "only provided the general concept about the pay per click model." Paper 12, 19 ("Prelim. Resp."). On the record currently before us, we are persuaded that IAB 1 and IAB2 provide sufficient disclosures to teach the limitations of the challenged claims. On this record, Petitioner has demonstrated that it is more likely than not that claim 1 would have been obvious over the teachings of IAB1 and IAB2.

Claims 5 and 9 depend from claim 1 and respectively further recite sending the second code to a device and storing the first code as a cookie. Petitioner relies on IAB 2 to teach sending the second code to a device. Pet. 35–36. Specifically, Petitioner contends that the second code ("target site URL") is sent to the user's browser by the Publisher Ad/Click Transaction Server. This URL is part of the redirection request that is sent in response to the communication sent to the server to facilitate the counting of clicks. *Id.* at 35; *see also* Ex. 1037, 31 (describing step 2 as the 302 redirect sent in response to the request sent to the server in step 1). As

to claim 9, Petitioner relies on IAB 2's disclosure of "[t]he web server respond[ing] to the user browser by checking for an existing cookie and creating one if one does not exist" to teach storing the first code as a cookie. Pet. 41 (quoting Ex. 1037, 39). We find Petitioner's analysis to be persuasive. On this record, Petitioner has demonstrated that it is more likely than not that claims 5 and 9 would have been obvious over the teachings of IAB1 and IAB2.

Petitioner also challenges claims 5 and 11 over the combination of IAB1, IAB2, and Laurent. Pet. 41–44. Petitioner relies on Laurent to provide additional disclosures regarding cookies. Laurent is a book by Simon St. Laurent that is titled *Cookies*. Ex. 1009. Laurent discloses that cookies are a tool that may be used to store information between web page retrievals and to provide a context for transactions. *Id.* at 2. Laurent provides an example of a system in which a target site URL is sent to a client in a redirect response. Pet. 42 (citing Ex. 1009, 101; Ex. 1006 ¶ 120). Petitioner argues that this disclosure when viewed in conjunction with the teachings of IAB1 and IAB 2 would have taught sending the second code to a device as recited in dependent claim 5. Claim 11 depends from claim 1 and further recites that the second and third code are encoded. Petitioner relies upon Laurent's disclosure of encrypted cookies to teach this limitation. Pet. 43–44 (citing Ex. 1009, 22). Patent Owner did not direct any additional arguments to the combination of IAB1, IAB2, and Laurent. We are persuaded by Petitioner's arguments and evidence. On this record, Petitioner has demonstrated that it is more likely than not that claims 5 and 11 would have been obvious over the teachings of IAB1, IAB2, and Laurent.

CONCLUSION

Petitioner has persuaded us that we misapprehended its arguments in regards to the disclosures of the IAB references. Thus, we grant Petitioner's request for

CBM2016-00008
Patent 8,671,057 B1

rehearing and we determine that Petitioner has established that is more likely than not that claims 1, 5, and 9 would have been obvious over IAB 1 and IAB 2 and that claims 5 and 11 would have been obvious over IAB 1, IAB 2, and Laurent.

ORDER

For the reasons given, it is

ORDERED that the request for rehearing is *granted*;

FURTHER ORDERED that the trial for this covered business method patent review now includes the following additional grounds of unpatentability:

1. Claims 1, 5, and 9 as unpatentable for obviousness over IAB 1 and IAB 2; and
2. Claims 5 and 11 as unpatentable for obviousness over IAB 1, IAB 2, and Laurent.

PETITIONER:

Saqib Siddiqui
ssiddiqui@mayerbrown.com

PATENT OWNER:

Patrick Zuili
patick@tenderbox.tv