

Trials@uspto.gov
Tel: 571-272-7822

Paper 11
Entered: February 9, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GREAT WEST CASUALTY COMPANY,
BITCO GENERAL INSURANCE CORPORATION, and
BITCO NATIONAL INSURANCE COMPANY,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

Case IPR2015-01707
Patent 7,516,177 B2

Before MICHAEL W. KIM, PETER P. CHEN and
ROBERT A. POLLOCK, *Administrative Patent Judges*.

KIM, *Administrative Patent Judge*.

DECISION
Decision Instituting *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

A. *Background*

Great West Casualty Company, BITCO General Insurance Corporation, and BITCO National Insurance Company (collectively “Petitioner”) filed a Petition to institute an *inter partes* review of claims 1–20 of U.S. Patent No. 7,516,177 B2 (Ex. 1001, “the ’177 patent”). Paper 1 (“Pet.”). Intellectual Ventures II LLC (“Patent Owner”) filed a Preliminary Response (Paper 8; “Prelim. Resp.”), in which Patent Owner indicated that it had filed a statutory disclaimer under 35 U.S.C. § 253 of claims 1–10. Prelim. Resp. 1 (citing Ex. 2001).

We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted unless the information presented in the Petition shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Taking into account Patent Owner’s Preliminary Response, and for the reasons that follow, we conclude that the information presented in the Petition establishes that there is a reasonable likelihood that Petitioner will prevail in challenging claims 11–13 and 15–20 as unpatentable. We conclude also that there is not a reasonable likelihood that Petitioner will prevail in challenging claim 14 as unpatentable. Pursuant to 35 U.S.C. § 314, we hereby authorize an *inter partes* review to be instituted as to claims 11–13 and 15–20 of the ’177 patent.

B. *Related Proceedings*

Petitioner and Patent Owner identify the following district court proceedings concerning the ’177 patent: *Intellectual Ventures II LLC v. BITCO General Insurance Corporation f/k/a Bituminous Casualty*

Corporation et al., Civ. No. 6-15-cv-00059 (E.D. Tex.); *Intellectual Ventures II LLC v. Great West Casualty Company*, Civ. No. 6-15-cv-00060 (E.D. Tex.); and *Intellectual Ventures I LLC et al. v. HCC Insurance Holdings, Inc. et al.*, Civ. No. 6-15-cv-00660 (E.D. Tex.). Pet. 1–2; Paper 5,

1. Petitioner and Patent Owner identify also the following requests for review of the '177 patent involving the same parties: CBM2015-00171; IPR2015-01706. Pet. 2; Paper 5, 1.

C. The '177 Patent

The '177 patent discloses the following under the heading “Technical Field”:

This invention pertains to electronic commerce and business. More particularly, the present invention relates to aggregating, enhancing, and distributing content objects with customers over a network-based environment such as via the Internet or some other form of interactive network.

Ex. 1001, 1:22–26. The '177 patent asserts that the storage and retrieval of information has evolved from storing and retrieving information in textbooks and libraries, to storing and retrieving information from online networks such as the Internet. Ex. 1001, 1:30–33. According to the '177 patent, while such advances have led to a significant increase in information available to users, the users now have the problem of being overwhelmed by the amount of information, resulting in a failure to find specific information or losing track of the information that had already been found. Ex. 1001, 1:33–46. Thus, the '177 patent asserts that there is a need to provide improvements in the way demand for information is identified, content is generated in response to a defined demand, and the way in which users access desired information. Ex. 1001, 2:23–26.

D. Illustrative Claim

Petitioner challenges claims 1–20 of the '177 patent, of which claims 1–10 have been disclaimed. Prelim. Resp. 1 (citing Ex. 2001). Claims 11 and 16 are the only remaining independent claims. Independent claim 11 is illustrative of the challenged claims and is reproduced below:

11. An apparatus for distributing content through one or more distributed information access points to a centralized access point of a user, comprising:

at least one server operative to store one or more of: a) content, b) links to content, c) information about content, and d) information about users including information about which content a user has chosen;

a centralized access point of a user accessible via a communications link and operative to provide the user with access to content chosen by or for the user;

at least one distributed information access point accessible via a communications link and operative to implement one or more of: a) list one or more content objects, b) allow a user to choose content for addition to their centralized access point, and c) provide the user with logon access to their centralized access point; and

an administrative interface in communication with the server and operative to create groupings of content into one or more distributed information access points;

wherein a user is enabled with the capability to log on to their centralized access point from one or more distributed information access point(s) and access content chosen from one or more distributed information access point(s).

E. Asserted Grounds of Unpatentability

Petitioner initially challenged claims 1–20 of the '177 patent as being anticipated or obvious over the prior art. Pet. 2–3. In light of Patent

Owner's statutory disclaimer of claims 1–10, the following grounds are before us.

Reference(s)	Basis	Challenged Claims
Payne ¹	§ 102(b)	11, 12, 16–20
Payne	§ 103(a)	11, 12, 16–20
Payne and Ackley ²	§ 103(a)	13–15

II. ANALYSIS

A. *Claim Construction*

As a step in our analysis for determining whether to institute a review, we determine the meaning of the claims for purposes of this Decision. In an *inter partes* review, a claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears. 37 C.F.R. § 42.100(b); *see also In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1278 (Fed. Cir. 2015) (“We conclude that Congress implicitly approved the broadest reasonable interpretation standard in enacting the AIA.”), *cert. granted sub nom. Cuozzo Speed Techs., LLC v. Lee*, 84 U.S.L.W. 3218 (U.S. Jan. 15, 2016) (No. 15-446). Under the broadest reasonable construction standard, claim terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech.*,

¹ U.S. Patent No. 5,715,314 issued February 3, 1998 (Ex. 1006).

² U.S. Patent No. 8,601,373 B1 issued December 3, 2013, filed November 16, 1999 (Ex. 1009).

Inc., 504 F.3d 1249, 1257 (Fed. Cir. 2007). Any special definition for a claim term must be set forth in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). We must be careful not to read a particular embodiment appearing in the written description into the claim if the claim language is broader than the embodiment. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993). Only terms which are in controversy need to be construed, and then only to the extent necessary to resolve the controversy. *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

For the purposes of this Decision, only the following terms require construction.

1. whether the preamble is limiting

The preamble of independent claim 11 recites “[a]n apparatus for distributing content through one or more distributed information access points to a centralized access point of a user.” Patent Owner asserts that the preamble should be limiting because “it ‘recit[es] additional structure or steps underscored as important by the specification.’” Prelim. Resp. 29–30 (citing Ex. 1001, 1:23–25, 2:40–41, 2:44–45, 2:58–59, 3:10–11). We disagree.

Generally, a preamble is not construed as a limitation. *Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1346 (Fed. Cir. 2002). In particular, “when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention,” the preamble is not considered a limitation. *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 809 (Fed. Cir. 2002) (citing *IMS Tech., Inc. v. Haas Automation, Inc.*, 206, F.3d 1422,

1434 (Fed. Cir. 2000)). Accordingly, we begin from the general premise that the preamble is not limiting, and from there we determine that deleting the preamble of independent claim 11 would not affect the rest of the claim. For example, no claim limitation has an antecedent basis in the preamble, and the body of the claim appears to recite a complete apparatus. Indeed, the body of the claim appears to be a complete implementation that fulfills what is recited in the preamble. To that end, Patent Owner’s citations to the specification are unavailing, as they disclose distributing content to users, and we are unclear how the body of independent claim 11 fails to distribute content to users.

On this record, we are unpersuaded that the preamble of independent claim 11 is limiting. For the similar reasons, we are unpersuaded that the preamble of independent claim 16 is limiting.

2. “access to content”

Independent claim 11 recites “access to content.” In evaluating Patent Owner’s assertions concerning the prior art, we determine that it is necessary to construe “access to content.” Specifically, Patent Owner asserts that the presence of links to content is insufficient to confer “access to content.” Prelim. Resp. 38–42. We disagree. The specification discloses the following:

The World Wide Web (WWW) is a network system that enables easy *access* to distributed documents over the Internet using a client/server architecture. The World Wide Web provides an Internet facility that links documents locally and remotely. A Web document, referred to as a Web page, includes links in a page that let users jump from page to page (hypertext links) whether the pages are stored on the same server or on servers around the world. These Web pages are *accessed* and read via a Web browser such as Netscape Navigator or Internet Explorer.

Ex. 1001, 1:55–64 (emphases added). From the above, while the latter use regarding Web browsers may arguably support Patent Owner’s position, the former use regarding the World Wide Web generally unequivocally supports a construction that “access to content” is broad enough to be met by the presence of links to content. *See also* Ex. 1001, 6:30–34 (“FIG. 59 is a diagram of a screen display showing that tutorials can contain links to external Web pages, and that *access* to such pages is implemented via the same pop-up navigational tool present within the HowZone.com system” (emphasis added)). *Webster’s New World Trade & Computer Dictionary* defines “access” as “[t]he right or ability to gain entry to a computer system and make use of its resources.” *Webster’s New World & Trade; Computer Dictionary*,

<http://search.credoreference.com/content/entry/webstercom/access/0> (last visited Feb. 5, 2016) (Ex. 3001); *accord Hargrave’s Communications Dictionary*

<http://search.credoreference.com/content/entry/hargravecomms/access/0> (last visited Feb. 5, 2016) (“[t]he means of gaining entry to a system or network so that its resources may be utilized”) (Ex. 3002). The above dictionary definitions confirm that “access to content” only requires the *right or ability* to gain entry to and make use of the content, which is broader than requiring the presence of the content itself.

We construe “access to content” as including the presence of links to content. Independent claim 16 recites “access to the selected content,” which is construed in the same manner.

3. “*manage content*”

Dependent claims 14 and 15 each recite “manage . . . content.” In evaluating Patent Owner’s assertions concerning the prior art, we determine that it is necessary to construe “*manage content*.” Specifically, Patent Owner asserts that the ability to request the display of content, by itself, is insufficient to “*manage content*.” Prelim. Resp. 51. We agree. The specification discloses the following concerning “*manage*”: “[a]s will be described below in greater detail, staff and administrators at Applicant’s web site are able to *manage* content categories, *manage* suggestions for content objects, *manage* content contributors, *manage* content objects, co-brand categories, and place commerce on content categories” (Ex. 1001, 8:38–42 (emphases added)); “[i]n order to *manage* suggestions for content objects, site visitors make suggestions which staff at Applicant’s web site review and approve” (Ex. 1001, 8:54–56 (emphasis added)). We discern that all of the above examples of “*manage*” require more than merely requesting the display of content alone, especially the last example, which equates “*manage*” to “review and approve.” *See also* Ex. 1001, 17:22–26, 22:33–38. 46:8–65, 47:27–30, 48:66–49:4.

The American Heritage Dictionary of the English Language defines “*manage*” as “[t]o have charge of” and “[t]o exert control over.” *The American Heritage Dictionary of the English Language*, <http://search.credoreference.com/content/entry/hmdictenglang/manage/0> (last visited Feb. 5, 2016) (Ex. 3003). *The Authoritative Dictionary of IEEE Standard Terms* defines “management” as “[a] process that consists of functions such as planning, organizing, controlling and supervising, and is performed to set and meet the stated objectives.” THE Authoritative

Dictionary of IEEE Standard Terms, 662 (7th ed. 2000) (Ex. 3004). A common thread through these definitions is the notion of “control,” which is consistent with the specification’s use of the term “manage.” We discern that requesting the display of content does not amount to controlling that content.

We construe “manage content” as not being met by requesting the display of content alone.

B. Claims 11, 12, and 16–20 as Obvious over Payne

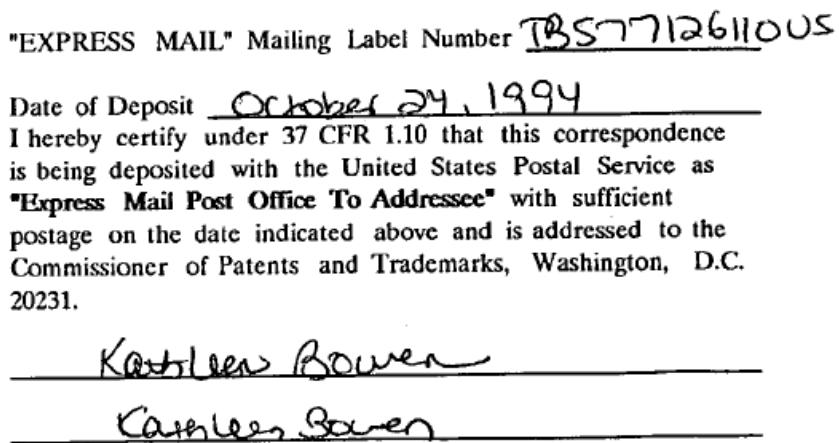
Petitioner contends that claims 11, 12, and 16–20 are obvious over Payne. Pet. 13–15, 32–44, 48–50 (citing Exs. 1003, 1006, 1007, 1008, 1030, 1032). Claims 11 and 16 are independent. Patent Owner responds to Petitioner’s contentions. Prelim. Resp. 31–50 (citing Exs. 1001, 1003, 1006, 1007).

1. Payne (Ex. 1006)

Payne relates to user-interactive network sales systems for implementing an open marketplace for goods or services over computer networks such as the Internet. Ex. 1006, 1:14–16. Payne discloses advertising documents for products, such as newspapers and newsletter articles available for purchase by buyers. Ex. 1006, 4:50–60. When requested by buyers, these advertising documents are sent from merchant computer 14 to buyer computer 12. Ex. 1006, 5:16–23. After browsing the advertising document, the buyer may purchase a product. Ex. 1006, 5:26–29. The buyer can later request display of a “smart statement” that lists purchase transactions for a given month. Ex. 1006, 8:33–35. The buyer may request display of a product included in the smart statement by sending an access URL contained in the smart statement. Ex. 1006, 9:41–50.

2. *Status of Appendix F (Ex. 1007)*

Petitioner makes several references to Appendix F of Payne. Pet. 38, 49–50 (citing Ex. 1007). Exhibit 1007 is 308 pages. Appendix F begins on page 109 of Exhibit 1007, and ostensibly includes 97 pages of computer code, although some of those pages are blank. Payne discloses the following concerning Appendix F: “[m]icrofiche appendices A–G, 4 sheets of 192 images total, are being submitted with the present application” (Ex. 1006, 1:4–5); “[a] printout of a computer program for use in creating such a ‘store’ in accordance with the present invention is provided as Appendix F” (Ex. 1006, 46–49); “[a] printout of a computer program for use in creating and operating such a ‘store’ in accordance with the present invention is provided as Appendix F” (Ex. 1006, 10:21–23). The following representation is made on the first page of Appendix F, page 109 of Exhibit 1007. The Figure below represents an Express Mail Certification pursuant to 37 C.F.R. § 1.10.



Express Mail Certification made pursuant to 37 C.F.R. § 1.10.

Pages 1 and 110 of Exhibit 1007 each include a stamp indicating that a copy of Exhibit 1007 was accorded an October 24, 1994 receipt date by the mail

room of the U.S. Patent and Trademark Office. Many pages of Appendix F bear the mark “THIS PAGE BLANK (USPTO),” for example, page 110 of Appendix F. The Image File Wrapper for Payne on Public PAIR indicates that an item titled “Appendix to the Specification” is 308 pages, and has a mail room date of October 24, 1994. A cursory inspection of Exhibit 1007 and the aforementioned “Appendix to the Specification” indicates that they appear to be identical. Microfiche of Appendix F was purportedly submitted into the file history of Payne via a Response filed on April 23, 1997, and a Letter to the Examiner filed June 11, 1997. Exs. 3005, 3006.

Patent Owner asserts that because Appendix F did not meet the requirements for being incorporated by reference into Payne, it should not be considered a part of Payne. Prelim. Resp. 31–33. We disagree. Although the relevant portions of Payne do not use the exact words “incorporation by reference” in conjunction with Appendix F, Payne explicitly refers to Appendix F on numerous occasions, and we are persuaded that the totality of circumstances supports the implications that the contents of Appendix F (1) were filed with the application on October 24, 1994, (2) were accessible as of the issue date of Payne, and (3) were intended to be a part of Payne.

3. Analysis

After considering the Petition and Preliminary Response, as well as all supporting evidence, we are persuaded that Petitioner has shown a reasonable likelihood that claims 11, 12, and 16–20 are unpatentable under 35 U.S.C. § 103 as obvious over Payne. Pet. 13–15, 32–44, 48–50; Prelim. Resp. 31–50. For example, independent claim 11 recites “at least one server operative to store one or more of: a) content . . . c) information about content.” Payne discloses merchant computer 14 storing advertising

documents for products, such as newspapers and newsletter articles available for purchase by buyers. Ex. 1006, 4:50–60. Independent claim 11 recites further “a centralized access point of a user accessible via a communications link and operative to provide the user with access to content chosen by or for the user.” Payne discloses a “smart statement” that lists purchase transactions for a given month. Ex. 1006, 8:33–35. The buyer may request display of a product included in the smart statement by sending an access URL contained in the smart statement. Ex. 1006, 9:41–50. Independent claim 11 recites additionally “at least one distributed information access point accessible via a communications link and operative to implement one or more of: . . . b) allow a user to choose content for addition to their centralized access point.” Payne discloses advertising documents for products, such as newspapers and newsletter articles available for purchase by buyers. Ex. 1006, 4:50–60.

After browsing the advertising document, the buyer may purchase a product. Ex. 1006, 5:26–29. The buyer can later request display of a “smart statement” that lists purchase transactions for a given month. Ex. 1006, 8:33–35. Independent claim 11 recites also “an administrative interface in communication with the server and operative to create groupings of content into one or more distributed information access points.” Payne discloses creation computer 20 communicates with merchant computer 14. Ex. 1006, 4:60–5:4. Petitioner cites Appendix F for disclosing “grouping content into product departments, such as ‘Boys’ department.” Pet. 49–50 (citing Ex. 1007 ¶¶ 129, 135). Independent claim 11 recites further “wherein a user is enabled with the capability to log on to their centralized access point from one or more distributed information access point(s) and access content

chosen from one or more distributed information access point(s).” Petitioner provides the following analysis concerning this claim limitation:

To the extent one might argue Payne does not disclose the ability to log on to a “*centralized access point*” from a “*distributed information access point*” as required by the “wherein clause” of claim 11, it would have been obvious to include that functionality in Payne. It was well-known in the art to include or link to a log in facility prominently on, for example, the homepage of a website. *See, e.g.*, U.S. Patent No. 5,987,440 to O’Neil et al. (Nov. 16, 1999) (Ex. 1008) at Fig. 25 (showing registration link on website homepage). The system of Payne already includes functionality requiring a user to log on to an account, Ex. 1006 at 6:9-42, 8:38-53, so it would have been trivial to place the log in functionality directly on the digital advertising documents, which are web pages, *see id.* at 9:64-10:1, 5:16-25, Fig. 5. Ex. 1003 at ¶ 240. When a patent simply arranges old elements, each performing the same function it had been known to perform and together yielding no more than one would expect from such an arrangement, the combination is obvious. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007).

Moreover, one of skill would have been motivated to include the log in functionality on the digital advertising documents of Payne. Placing a log in facility directly on an advertising document provides the user an efficient and user friendly way to purchase the content objects being advertised on the document or to make use of functionality of the system provided to registered users. *See, e.g.*, Linda A. Rich et al., *How Libraries are Providing Access to Electronic Serials: A Survey of Academic Library Web Sites*, 25:2 SERIALS REVIEW 35, 42 (1999) (Ex. 1032) (explaining that minimizing the number of clicks between web pages improves user accessibility); David Lidsky, *Home on the Web*, PC MAGAZINE, Sept. 1, 1998, at 137-39 (Ex. 1030) (critiquing MyYahoo’s user accessibility because certain features can only be found “many levels deep in the site”). For example, placing a log in facility on the advertising document would have permitted the user to quickly check if she had already purchased the advertised content object. Ex. 1003 at ¶ 241. Therefore, one of ordinary skill in the art

would have found it obvious to modify Payne to include a log in facility on the advertising documents.

Pet. 48–49. Petitioner provides similar analysis for claims 12 and 16–20.

Patent Owner asserts that independent claim 11 covers embodiments where content itself, and not just links to content, is available on the recited “centralized access point.” Prelim. Resp. 38. Accordingly, because Payne’s alleged “centralized access point,” the “smart statement,” only includes links to content, and not the content itself, it cannot correspond properly to the recited “centralized access point.” Prelim. Resp. 39–42. Patent Owner’s assertions are misplaced, as a claim limitation’s coverage of an embodiment does not indicate that the prior art must include such an embodiment in order to meet that claim limitation. As an analogy, if the claim limitation is *fruit* which covers embodiments including *apples*, prior art disclosing *oranges* would meet the claim limitation *fruit*, even if the prior art did not disclose *apples*.

Patent Owner’s assertions are further misplaced because independent claim 11 recites “a centralized access point . . . operative to provide the user with access to content chosen by or for the user.” As set forth above, we construe “access to content” as being met by the presence of links to content. Payne discloses that a buyer may request display of a product included in the smart statement by sending an access URL contained in the smart statement. Ex. 1006, 9:41–50.

In a similar vein, Patent Owner asserts that Payne does not disclose the recited preamble and “wherein” limitations of independent claim 11, because Payne does not disclose “no content is distributed through the advertising document to the smart statement.” Prelim. Resp. 44. As an initial matter, we note that we determined above that the preamble of

independent claim 11 is not limiting. Furthermore, Patent Owner's assertions are misplaced, as the recited "wherein" limitation does not require content to be distributed through the advertising document to the smart statement.

Patent Owner asserts also that Payne does not disclose "accessing the centralized access point of the particular user from one or more distributed information access points to gain access to the selected content," as recited in independent claim 16, because "[a] user cannot access the smart statement from an advertising document to gain access to selected newspaper or newsletter articles with the smart statement." Prelim. Resp. 48. We agree with Patent Owner that Petitioner has not shown sufficiently that Payne discloses explicitly the aforementioned claim limitation.

Apparently foreseeing this possibility, Petitioner asserts the following:

To the extent one might argue Payne does not explicitly disclose this claim element, it would have been obvious to include a link on the advertising document to the user's smart statement. Such linking between documents was known in the prior art, including linking from a generally available web page to a personal web page. *See, e.g., U.S. Patent No. 5,987,440 to O'Neil et al. (Nov. 16, 1999) (Ex. 1008)* at Fig. 25 (showing registration link on website homepage). The use of such functionality would therefore have been nothing more than the use of known technique in the ordinary manner to achieve predictable results. Moreover, a person of ordinary skill in the art would have been motivated to include such functionality in the system of Payne in order to permit the user quickly check her purchase history from the advertising document, so as not to mistakenly purchase the same content twice.

Ex. 1003 ¶ 272 (underlining added). Patent Owner asserts that the underlined rationale for modifying Payne is insufficient because Payne's system already prevents a user from mistakenly purchasing the same content

twice. Prelim. Resp. 49–50. We agree. Petitioner’s proffered modification, however, is including a link on the advertising document of Payne to the user’s smart statement. On this record, we determine that Petitioner’s other articulated rationale for the aforementioned modification is adequate for the purposes of institution, namely, that “[t]he use of such functionality would therefore have been nothing more than the use of known technique in the ordinary manner to achieve predictable results.” Ex. 1003 ¶ 272.

4. Conclusion

We determine that Petitioner has shown a reasonable likelihood that claims 11, 12, and 16–20 are unpatentable under 35 U.S.C. § 103 as obvious over Payne.

C. *Dependent Claims 13–15 as Obvious over Payne and Ackley*

Petitioner contends that dependent claims 13–15 are obvious over a combination of Payne and Ackley. Pet. 54–60 (citing Exs. 1003, 1006, 1009). Patent Owner disagrees. Prelim. Resp. 50–52 (citing Ex. 1001, 1006).

1. Ackley

Ackley relates “to computer-based systems and methods that enable sales transactions between third parties through a communications network, such as internet auction and classified systems.” Ex. 1009, 1:21–24.

2. *Dependent Claims 13 and 15*

After considering the Petition and Preliminary Response, as well as all supporting evidence, we are persuaded that Petitioner has shown a reasonable likelihood that dependent claims 13 and 15 are unpatentable under 35 U.S.C. § 103 as obvious over Payne and Ackley. Pet. 54–60; Prelim. Resp. 50–52.

Patent Owner asserts the following concerning claim 13:

The Petition makes vague, hand-waving arguments about the alleged obviousness of combining Payne and Ackley. The proposed combination smacks of hindsight bias. Notably, the Petition does not actually propose how to accomplish the combination. The Petition alleges the advertising documents correspond with the recited distributed information access point in independent claim 11. Paper 1 at 35–36. Yet, the Petition does not explain how those of skill in the art could possibly modify those advertising documents to accept content contributions from a user. *Id.* at 58. There is no *prima facie* invalidity case for this claim.

Prelim. Resp. 50–51. We are unpersuaded. Petitioner asserts the following:

Claim 13 recites the “*apparatus of claim 11 wherein the distributed information access point is further operative to accept content contributions from a user.*” Payne discloses digital advertising documents (“*distributed information access points*”) that allow users to login to their account to purchase products. Ex. 1006 at 4:60-63, 6:9-42. As described above with respect to claim 9, it would have been obvious to modify Payne’s user functionality to allow a logged-in user to contribute products [to] the network sales system (“*accept content contributions from a user*”), per the teachings of Ackley. Ex. 1003 at ¶ Payne in view of Ackley therefore render claim 13 obvious.

Pet. 58. The relevant portion of Petitioner’s analysis concerning claim 9 reads as follows:

In early 2000, it would have been obvious to modify Payne’s buyer computer (“*selection client*”) to allow a logged-in user to contribute content for sale on the network sales system (“*accept content contributions from a user*”), per the teachings of Ackley. Payne discloses existing web functionality that allow a user to purchase items, Ex. 1006 at 5:26-31, 10:9-13, and a merchant to list items for sale, *id.* at 4:65-5:4. Allowing a single user to perform both roles simply arranges existing functionality in Payne to perform the same role previously performed, to yield no more than one would expect: a single user buying and selling

products. Ex. 1003 at ¶ 210. Additionally, an Ordinary Artisan would have been motivated to incorporate this functionality so as to expand the content available in Payne's network sales system. *See* Ex. 1009 at Fig. 4; Ex. 1003 at 210. Therefore, modifying Payne's buyer computer to allow a user to contribute content for sale on the network sales system would have been the straightforward combination of existing techniques, and therefore obvious. Ex. 1003 at ¶ 210.

Pet. 57. As we understand Petitioner's assertions, the buyer computer with a logged-in user of Payne, which meets the recited "selection client" of claim 9, is being replaced in the above analysis with an advertising document that allows users to login to their account, of Payne, in order to meet the "distributed information access point" of claim 13. Petitioner asserts that the level of ordinary skill would have been "a Bachelor's degree in Computer Science or equivalent field and at least one year of experience building database-backed Web applications." Pet. 3 (citing Ex. 1003 ¶¶ 110–112). On this record, we credit Petitioner's proffered level of ordinary skill. Accordingly, given that both the buyer computer and advertising document of Payne start with the premise of login capability, we are persuaded that Petitioner's proffered modification of allowing a logged-in user to contribute content, on this record, would have been within the abilities of one of ordinary skill.

3. *Dependent Claim 14*

Dependent claim 14 recites "wherein the centralized access point is further operative to enable a user to manage any content contributed by them." After considering the Petition and Preliminary Response, as well as all supporting evidence, we are not persuaded that Petitioner has shown a reasonable likelihood that dependent claim 14 is unpatentable under 35 U.S.C. § 103 as obvious over Payne and Ackley. Pet. 58–59; Prelim.

Resp. 51. In its analysis of dependent claim 14, Petitioner asserts that “Payne’s smart statement lists all financial activity for a given period of time, Ex. 1006 at 8:33-35, with options to manage each given transaction, *id.* at 9:26-50.” Pet. 59. We disagree. We find that the only user initiated transaction-level action we are able to discern from the aforementioned portions of Payne, is to request display of a product for a given transaction. As set forth above, we construe “manage content” as not being met by requesting the display of content alone.

4. Conclusion

We determine that Petitioner has shown a reasonable likelihood that dependent claims 13 and 15 are unpatentable under 35 U.S.C. § 103 as obvious over Payne and Ackley. We determine also that Petitioner has not shown a reasonable likelihood that dependent claim 14 is unpatentable under 35 U.S.C. § 103 as obvious over Payne and Ackley.

D. Claims 11, 12, and 16–20 as Anticipated by Payne

Petitioner contends that claims 11, 12, and 16–20 are anticipated by Payne. Pet. 32–44. We disagree. As set forth above in our analysis of independent claim 11 as unpatentable under 35 U.S.C. § 103 over Payne, we determine that Payne does not disclose “wherein a user is enabled with the capability to log on to their centralized access point from one or more distributed information access point(s) and access content chosen from one or more distributed information access point(s),” as recited in independent claim 11. As also set forth above in our analysis of independent claim 16 as unpatentable under 35 U.S.C. § 103 over Payne, we determine that Payne does not disclose “accessing the centralized access point of the particular

user from one or more distributed information access points to gain access to the selected content,” as recited in independent claim 16.

E. Patent Owner’s Other Assertions

Patent Owner asserts that the Board should exercise its discretion and deny institution of certain grounds across IPR2015-01706 and IPR2015-01707 because they are duplicative. Prelim. Resp. 5–13. While we have considered Patent Owner’s assertions, we decline to do so.

Patent Owner asserts further that the Petition should be denied because it does not meet the particularity requirements of 35 U.S.C. § 312(a) and 37 C.F.R. § 42.104(b)(4). Prelim. Resp. 52–53. Again, while we have considered Patent Owner’s assertions, we are unpersuaded that Petitioner has not met the particularity requirements of 35 U.S.C. § 312(a) and 37 C.F.R. § 42.104(b)(4).

F. Conclusion

On this record, we are persuaded that there is a reasonable likelihood that Petitioner would prevail in showing that claims 11–13 and 15–20 of the ’177 patent are unpatentable. We are also unpersuaded that there is a reasonable likelihood that Petitioner would prevail in showing that claim 14 of the ’177 patent is unpatentable. The Board has not made a final determination concerning patentability of any of the challenged claims.

III. ORDER

After due consideration of the record before us, and for the foregoing reasons, it is:

ORDERED that pursuant to 35 U.S.C. § 314, an *inter partes* review is hereby instituted as to claims 11–13 and 15–20 of the ’177 patent on the following grounds:

- claims 11, 12, and 16–20 as unpatentable under 35 U.S.C. § 103(a) over Payne; and
- claims 13 and 15 as unpatentable under 35 U.S.C. § 103(a) over a combination of Payne and Ackley;

FURTHER ORDERED that no other grounds are instituted; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of the '177 patent is hereby instituted commencing on the entry date of this Order, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial.

For PETITIONER:

Joseph A.Micallef
Russell E. Cass
Erik J. Carlson
SIDLEY AUSTIN LLP
jmicallef@sidley.com
rcass@sidley.com
ecarlson@sidley.com

For PATENT OWNER:

Brenton R. Babcock
Ted M. Cannon
Bridget A. Smith
Tim Seeley
James Hietala
KNOBBE, MARTENS, OLSEN & BEAR, LLP
2BRB@knobbe.com
2tmc@knobbe.com
2bzs@knobbe.com
tim@intven.com
jhietala@intven.com
boxpgl28@knobbe.com