

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner,

v.

ALFONSO CIOFFI, MEGAN ELIZABETH ROZMAN, MELANIE
ROZMAN, AND MORGAN LEE ROZMAN,
Patent Owner.

Case CBM2017-00009
Patent RE43,529

Before JENNIFER S. BISK, BRIAN J. McNAMARA, and
CHRISTOPHER M. KAISER, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

DECISION

Denying Institution of Covered Business Method Patent Review
37 C.F.R. § 42.208

INTRODUCTION

A. Background

This is a preliminary proceeding to decide whether, under § 18 of the Leahy-Smith America Invents Act, Pub. L. No. 112–29, 125 Stat. 284, 331 (2011) (“AIA”), a covered business method patent review of U.S. Patent No. RE43,529 (Ex. 1001, “the ’529 patent”) should be instituted under 35 U.S.C. § 324(a). Google Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting covered business method patent review of claims 21–23, 25, 26, 30, 36–38, 40–42, 45, and 49 of the ’529 patent. Alfonso Cioffi, Megan Elizabeth Rozman, Melanie Ann Rozman, and Morgan Lee Rozman (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”).

We authorized both parties to file additional briefs addressing the impact of *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 1376 (Fed. Cir. 2016), and *Secure Axxess, LLC v. PNC Bank Nat’l Assoc.*, 848 F.3d 1370 (Fed. Cir. 2017), which were decided after the Petition was filed. The parties submitted their respective papers on this issue. Paper 8 (“PO Supp. Br.”); Paper 9 (“Pet. Supp. Br.”).

Upon consideration of the parties’ briefing and supporting evidence, we determine that Petitioner has not shown sufficiently that the ’529 patent qualifies as a covered business method patent. Accordingly, we do not institute a covered business patent review.

B. Related Matters

The parties indicate that the ’529 patent is involved in *Cioffi v. Google Inc.*, 2:13-cv-00103 (E.D. Tex.). Pet. ix; Prelim. Resp. 3; Paper 5, 1. In addition, Petitioner filed a second Petition challenging the ’529 patent, which is being decided in Case No. CBM2017-00016. Prelim. Resp. 4.

C. The Asserted Grounds of Unpatentability

Petitioner's arguments rely on a Declaration from Dr. Michael Kogan. Ex. 1022 ("the Kogan Declaration" or "Kogan Decl.").

Petitioner argues that claims 21–23, 25, 26, 30, 36–38, 40–42, 45, and 49 of the '529 patent are unpatentable on the following grounds: (1) claims 21–23, 25, 26, 36–38, 40–42, and 45 are unpatentable under 35 U.S.C. § 251 for recapture of subject matter that was surrendered during prosecution of the original patent claims; (2) claims 21–23, 25, 26, 30, 36–38, 40–42, 45, and 49 are unpatentable under 35 U.S.C. § 251 for failing to comply with the original patent requirement; (3) claims 21–23, 25, 26, 30, 36–38, 40–42, 45, and 49 are unpatentable under 35 U.S.C. § 112 for lack of enablement; and (4) 21–23, 25, 26, 30, 36–38, 40–42, 45, and 49 are unpatentable under 35 U.S.C. § 101 for lack of patent-eligible subject matter. Pet. 18–19, 32–66.

D. The '529 Patent

The '529 patent is a reissue of U.S. Patent No. 7,484,247, titled "System and Method for Protecting a Computer System from Malicious Software." Ex. 1001, 1:14–16. According to the specification, exponential growth of the Internet combined with software and hardware designed with open interconnection architecture has led to significant security problems, including the rise of unwanted malicious software ("malware"). *Id.* at 3:7–43.

The '529 patent explains that security vulnerabilities exist, in-part, because existing operating systems allow computer resources, such as RAM, to be shared by several programs simultaneously. *Id.* at 4:7–30, 5:21–25. Although efficient, the '529 patent reports that such sharing of resources can give malware a conduit to access and corrupt other programs, including the

operating system itself. *Id.* at 5:21–25. For example, a network interface program (e.g., an Internet browser) typically resides on the same processor, and shares memory space with, the operating system and other trusted programs. *Id.* at 6:36–40. Malware exploiting this arrangement is capable of corrupting critical files stored by this shared memory. *Id.* at 6:40–44. In response to this problem, the ’529 patent proposes “isolating the network interface program from the main computer system” by giving it “access to a separate, protected memory area,” and preventing it from accessing the main computer’s memory storage area. *Id.* at 6:48–63.

The preferred embodiment of the ’529 patent is a computer system with two processors, the first processor coupled to two memory spaces, and the second processor coupled to the second memory space and a network interface device. *Id.* at 8:12–28. The second processor is capable of exchanging data across a network via the network interface device, but does not have access to the first memory space. *Id.*

E. Illustrative Claims

Of the challenged claims of the ’529 patent, claims 21, 36, and 45 are independent. Claim 21 is illustrative of the claims at issue; it recites:

21. A method of generating data for display of website content on a portable computer employing a common operating system in a secure manner, comprising:

distributing website content, via a network of one or more computers, to the portable computer capable of executing a secure web browser process, wherein the website content potentially contains malware;

wherein the secure web browser process is capable of executing on at least one electronic data processor and comprises a first web browser process and at least one second protected web browser process, the first web

browser process and the at least one second protected web browser process being configured to access the website content via the network of one or more computers, the at least one electronic data processor capable of being communicatively coupled to a first memory space and to a second protected memory space, the first memory space having at least one system file, the secure web browser process configured for:

executing instructions in the first web browser process, wherein the first web browser process is configured to access data contained in the first memory space and to initialize the at least one second protected web browser process;

passing data from the first web browser process to the at least one second protected web browser process;

executing instructions in the at least one second protected web browser process, wherein the at least one second protected web browser process is configured to access data contained in the second protected memory space but is denied access to the first memory space;

generating data for display of the distributed website content potentially containing malware;

wherein the secure web browser process is configured such that the at least one system file residing on the first memory space is protected from corruption by the website content potentially containing malware executing in the at least one second protected web browser process.

Ex. 1001, 21:13–52.

ANALYSIS

A. Claim Construction

In a covered business method patent review, we construe claim terms in an unexpired patent according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R.

§ 42.300(b). Claim terms generally 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., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). An inventor, however, may define specific terms used to describe an invention, but must do so “with reasonable clarity, deliberateness, and precision” and must “‘set out his uncommon definition in some manner within the patent disclosure’ so as to give one of ordinary skill in the art notice of the change” in meaning. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (quoting *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387–88 (Fed. Cir. 1992)). For purposes of this decision, we determine that no claim terms require express construction.

B. Covered Business Method Patent

Section 18 of the AIA provides for the creation of a transitional program for reviewing covered business method patents. A “covered business method patent” is a patent that “claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.” AIA § 18(d)(1); *see* 37 C.F.R. § 42.301(a).

“‘[F]inancial product or service’ should be interpreted broadly.” *Unwired Planet*, 841 F.3d at 1381 n.6. “[B]roadly” in this context, however, does not mean without limits. As the Federal Circuit explained, “[t]he plain text of the statutory definition contained in § 18(d)(1)—‘performing . . . operations used in the practice, administration, or management of a financial product or service’—on its face covers a wide range of *finance-related activities*.” *Versata Dev. Grp., Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1325

(Fed. Cir. 2015) (emphasis added). Although the range of “finance-related activities” encompassed by the phrase “financial product or service” is broad, “it cannot be the case that a patent covering a method and corresponding apparatuses becomes a CBM patent because its practice could involve a potential sale of a good or service.” *Unwired Planet*, 841 F.3d at 1382. Instead, the *claims must be directed to* a method or apparatus “used in the practice, administration, or management of a financial product or service.” *Id.* In other words, “the statutory definition of a CBM patent requires that the patent have a claim that contains, however phrased, a financial activity element.” *Secure Access*, 848 F.3d at 1381; *see also Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1340 (Fed. Cir. 2016) (stating that “§ 18(d)(1) directs us to examine *the claims* when deciding whether a patent is a CBM patent”).

1. Internet Banking Embodiment

Petitioner asserts that the ’529 patent qualifies as a covered business method patent because all of the challenged claims “cover and imply using a secure web browser in the specification’s Internet banking embodiment, which is indisputably a financial activity.” Pet. 6. Petitioner relies, for this assertion, on a preferred embodiment that uses encryption to protect user files and data, including passwords, bank account numbers, and credit card numbers. *Id.* at 7 (citing Ex. 1001, 17:38–42, 18:1–3, 18:21–55). According to Petitioner, “this embodiment is financial in nature because it protects financial information, such as bank account numbers, and other personal information to prevent theft of ‘money or securities, etc.’” *Id.* at 8 (citing 17:42–45). Petitioner also points to testimony by Patent Owner’s witness in related litigation as agreeing that “claims of the ’529 [patent] cover the

Internet banking embodiment so long as the claim includes a ‘first web browser process that can access website data via the network.’” *Id.* at 8–9 (citing Ex. 1014, 271:21–272:5, 274:10–22, 278:13–279:3).

Patent Owner counters that none of the challenged claims satisfy the financial product or service requirement. Prelim. Resp. 15–24. According to Patent Owner, the claims are “of general utility with no explicit or inherent finance-related terminology or limitations.” *Id.* at 17 (quoting *Plaid Techs., Inc. v. Yodlee, Inc.*, Case CBM2016-00082, slip op. at 11 (PTAB Oct. 6, 2016) (Paper 8)). Patent Owner argues that the embodiment related to Internet banking is not sufficient to confer covered business method patent eligibility to the claims because the claims are not *directed to* the internet banking embodiment, but rather to a web browser process that is capable of accessing data via a network covering many different embodiments. *Id.* at 21–24 (citing Ex. 2001 ¶ 55; Ex. 1001, 18:40–42).

We agree with Patent Owner that the challenged claims are directed to a very general web browser process that is capable of accessing data. The claims do not recite any language indicating the type of web browser or the contents of the data to be accessed. Nothing in the claims specifies that the process is to be used for internet banking or the accessing of financial data. Instead, the challenged claims before us recite generic web browsers and data. In evaluating Petitioner’s arguments and evidence, we must focus on the claims, not on the fact that there are some embodiments described in the specification that are related to financial services. *See Secure Access*, 848 F.3d at 1378–79 (“the written description alone cannot substitute for what may be missing in the patent ‘claims,’ and therefore does not in isolation determine CBM status”).

In its supplemental brief, Petitioner argues that whether the claims are directed to Internet banking is “an issue of material fact” that “should be resolved in favor of the Petitioner at the institution stage.” Pet. Supp. Br. 2–3 (citing 37 C.F.R. § 42.108(c)). However, the Petition itself belies this argument. Although the Petition discusses the claim construction of several terms, including “web browser process,” none of Petitioner’s proposed interpretations include any reference to features that are related to the Internet banking embodiment or any other feature that is financial in nature. Pet. 30–32.

We are not persuaded otherwise by Petitioner’s reliance on testimony by Patent Owner’s expert that the challenged claims cover the Internet banking embodiment. Petitioner asserts that this evidence shows that the “claims are directed to a financial activity.” Pet. Supp. Br. 3. We disagree. This evidence is irrelevant to the question at hand—whether the claims are *directed to* Internet banking. As Patent Owner notes, PO Supp. Br. 4, “claims that could ‘cover’ but are not ‘directed to’ a banking application” do not satisfy the requirement that “the patent have a claim that contains, however phrased, a financial activity element.” *Secure Access*, 848 F.3d at 1381. The specification makes clear that the described process “can be embodied in a wide variety of specific contexts” (Ex. 1001, 10:15–18), that the illustrative embodiments are “not intended to be construed in a limiting sense” (*id.* at 18:48–50), and that the applications affected by malware include “email, internet browsing, search engines, interactive gaming, instant messaging, and many, many more” (*id.* at 3:23–26, 5:62–66). These disclaimers are consistent with the content of the specification, which

generally describes the invention without reference to any particular context or application.

2. *Internet Advertising Claims*

Petitioner argues that the presence of several claims directed to “internet advertising” in the ’529 patent renders it a covered business method patent. Pet. 12–13; Pet. Supp. Br. 3–5. Petitioner directs us to claim 25, which limits the “website content potentially containing malware” of claim 21 to that which “comprises internet advertising,” as well as to claim 40, which limits claim 36 similarly. Pet. 12–13; Ex. 1001, 21:65–67, 23:40–42. Specifically, Petitioner argues that internet advertising “is a financial activity.” Pet. 13; *see* Pet. Supp. Br. 4–5. Patent Owner argues that advertising need not be financial in nature. Prelim. Resp. 24–28.

We are not persuaded that advertising always must be treated as “a financial activity element” when it is recited in a claim. Although we recognize that Internet advertising generally involves the sale of ad space, the fact that a sale has occurred or may occur is not enough when the challenged claims neither recite a sale nor are otherwise directed to the practice, administration, or management of a financial product or service. *See Unwired Planet*, 841 F.3d at 1382. In addition, although Internet advertising might lead to a sale of a good or service, mere probabilities or possibilities fall short of demonstrating operations necessarily used in the practice, administration, or management of a financial product or service. *See id.* The Federal Circuit’s decision in *Blue Calypso* does not require otherwise. In that case, the claims recited a subsidy program in addition to advertising. *Blue Calypso*, 815 F.3d at 1336–37. The claims that recite

internet advertising in the '529 patent contain no such recitation of subsidies or other financial incentives or inducements.

Moreover, as Patent Owner notes, Prelim. Resp. 27, even if advertising typically could be seen as financial in nature, the '529 patent defines advertising broadly enough to encompass non-financial content. The '529 patent defines "Advertisement(s)" as "intended to broadly encompass *any* secondary content that is delivered or distributed to client devices in addition to the primary content." Ex. 1001, 8:32–34 (emphasis added). Examples of such "secondary content" include "community service messages, public service announcements, system information messages or announcements, . . . [and] artwork" in addition to "paid advertisements." *Id.* at 8:37–42. Accordingly, advertising within the scope of the claims of the '529 patent need not be financial in nature. As discussed above, the fact that advertising sometimes may be financial in nature is immaterial, because we have been instructed to determine not what the claims cover but what the claims are directed to. *Unwired Planet*, 841 F.3d at 1382.

Given the broad definition of advertising in the '529 patent and the fact that advertising need not be limited to financial contexts in general, we are not persuaded that the claims of the '529 patent that recite "internet advertising" have been shown to "contain[] . . . a financial activity element." *Secure Access*, 848 F.3d at 1381. Accordingly, Petitioner has not established that the '529 patent claims a method or apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service.

CONCLUSION

Upon consideration of the Petition, the Preliminary Response, the supplemental briefing, and the evidence presently before us, we conclude that the '529 patent is not a covered business method patent under AIA § 18(d)(1) and is not eligible for review using the transitional covered business method patent program.

ORDER

It is hereby

ORDERED that the Petition is denied, and no covered business method patent review is instituted.

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Patent RE43,529

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