IN THE UNITED STATES PATENT TRIAL AND APPEAL BOARD

In re *Covered Business Method Review* of:

U.S. Patent No. 7,856,430

Issued: December 21, 2010

Inventor: Paul J. POLLASTRO

Application No.: 11/944,153

Filed: November 21, 2007

For: METHOD FOR GENERATING INCREASED NUMBERS OF LEADS VIA THE INTERNET

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PETITION FOR COVERED BUSINESS METHOD REVIEW UNDER 35 U.S.C. § 321 AND § 18 OF THE LEAHY-SMITH AMERICA INVENTS ACT

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The undersigned hereby requests Covered Business Method ("CBM") review of claims 1-17 of U.S. Patent No. 7,856,430 ("the '430 Patent," attached as Petition Exhibit 1001), pursuant to 35 U.S.C. § 321 and § 18 of the Leahy-Smith America Invents Act ("AIA") and pursuant to 37 C.F.R. § 42.300 *et seq*. An electronic payment for the CBM petition fee specified by 37 C.F.R § 42.15(b)(1) is being paid at the time of filing this petition; however, please charge any shortage in the required fees to deposit account no. 50-0665.

I. PRELIMINARY STATEMENT

Fundamentally, the '430 Patent claims an abstract business idea—generating sales leads by creating a catalog of product information (such as part numbers) that potential customers can access and review. The only addition to this abstract idea recited in the patent is providing this catalog "via the Internet," through the use of admittedly well-known features of the Internet (*e.g.*, hyperlinks and web pages). Claiming the abstract idea of a product catalog as implemented on the Internet, however, is not sufficient to make the idea patentable. *See Bilski v. Kappos*, 130 S. Ct. 3218, 3230 (2010) ("[T]he prohibition against patenting abstract ideas 'cannot be circumvented by attempting to limit the use of the formula to a particular technological environment'....) (quoting *Diamond v. Diehr,* 450 U.S. 175, 191-92 (1981)).

Indeed, the Examiner originally *rejected all claims* of the '430 Patent during prosecution as drawn to non-statutory subject matter. To overcome this rejection, which was made under the then-controlling "machine or transformation" test, the patentee simply amended the preamble of the independent claims to recite that the claimed method is implemented "by a computer executing computer readable instructions." However, the Federal Circuit has since held explicitly that the mere addition of a general purpose computer cannot rescue a claim from abstractness. *See CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1375 (Fed. Cir. 2011). That is all that the patentee did in this case.

Thus, as set forth in detail below, the '430 Patent is a CBM patent that is unpatentable under 35 U.S.C. § 101, and the Board should institute a review.

II. MANDATORY NOTICES

Pursuant to 37 C.F.R. § 42.304 and 42.8, Petitioner submits the following Mandatory Notices.

A. Real Party-in-Interest

In accordance with 37 C.F.R. § 42.8(b)(1), Petitioner identifies the real party-in-interest as LinkedIn Corporation.

B. Related Matters

In accordance with 37 C.F.R. § 42.8(b)(2), Petitioner identifies the following related proceeding: *AvMarkets, Inc. v. LinkedIn Corporation*, No. 13-cv-00230-LPS (D. Del.).

C. Lead and Back-Up Counsel

In accordance with 37 C.F.R. § 42.8(b)(3), Petitioner identifies Jordan Becker as lead counsel and Bing Ai as back-up counsel:

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III. GROUNDS FOR STANDING

A. At Least One Challenged Claim Is Unpatentable.

Claims 1-17 of the '430 Patent are invalid under 35 U.S.C. § 101 for the reasons set forth below. Accordingly, Petitioner has standing because "it is more likely than not that at least 1 of the claims [of the '430 Patent] is unpatentable." 35 U.S.C. § 324(a).

B. Claims 1-17 Are Directed to a Covered Business Method.

The AIA defines a "covered business method" patent as 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[.]" AIA § 18(d)(1); *see also* 37 C.F.R. § 42.301.

The Board has concluded that the AIA's definition of CBM patents should "be broadly interpreted and encompass patents claiming activities that are financial in nature, incidental to a financial activity or complementary to a financial activity." *SAP America, Inc. v. Versata Development Group, Inc.*, No. CBM2012-00001, at 21-22 (P.T.A.B. January 9, 2013) (Decision regarding the Institution of Covered Business Method Review), *citing* 77 Fed. Reg. 157 (August 14, 2012) at 48736. In particular, the Board has held that it does "not interpret the statute as requiring the literal recitation of the terms financial products or services [and that the] term financial is an adjective that simply means relating to monetary matters." *Id.* at 23. "At its most basic, a financial product is an agreement between two

parties stipulating movements of money or other consideration now or in the future," and encompasses "patents [that] apply to administration of business transactions." *Id.*, *quoting* 157 Cong. Rec. S5432 (daily ed. Sept. 8 2011) (statement of Sen. Schumer).

The '430 Patent easily fails within the definition of a CBM patent under the AIA. As confirmed in its title, abstract, throughout the specification, and in each claim, the '430 Patent is directed to a method of data processing for increasing sales leads for a business. Generating sales leads is a fundamental business practice and is directly tied to the pursuit of future monetary transactions (*i.e.*, actual sales). The '430 Patent is therefore plainly addressed to "activities that are financial in nature, incidental to a financial activity or complementary to a financial activity." *SAP America*, No. CBM2012-00001, at 23.[1]

Indeed, the '430 Patent is expressly classified as a data processing patent under Class 705, which concerns data processing in the "financial, business

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[1] Senator Schumer, a principal author of Section 18 of the AIA, explained the breadth of the "practice, administration and management" language in Section 18(d)(1), in terms directly applicable here: "[T]he 'practice, administration and management' language is intended to cover any ancillary activities related to a financial product or service, including, without limitation, ***marketing, customer interfaces, Web site management and functionality, transmission or management of data***, servicing, underwriting, customer communications, and back office operations--e.g., payment processing, stock clearing." Exh. 1003, 157 Cong. Rec. S1360, S1365 (daily ed. March 8, 2011) (statement of Sen. Schumer) (emphasis added).

practice, management, or cost/price determination" fields.[2] According to the USPTO, "patents subject to covered business method patent review are anticipated to be typically classifiable in Class 705." Exh. 1002, 77 Fed. Reg. 157 (August 14, 2012) at 48739.

For these reasons, the '430 Patent qualifies as a CBM patent subject to Section 18 review.

C. Claims 1-17 Are Not Directed to a "Technological Invention."

The AIA excludes "patents for technological inventions" from the definition of CBM patents. AIA § 18(d)(2). To determine whether a patent concerns a technological invention, "the following will be considered on a case-by-case basis: whether the claimed subject matter as a whole recites a technological feature that is novel and unobvious over the prior art; and solves a technical problem using a technical solution." 37 C.F.R. § 42.301.

The Board has cited the following guidance regarding claimed inventions that would typically be considered non-technical under 37 C.F.R. 42.301:

> (a) Mere recitation of known technologies, such as computer hardware, communication or computer networks, software, memory, computer readable storage medium, scanners, display devices or databases, or specialized machines, such as an ATM or point of sale device.

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[2] *See* USPTO Classification Definitions, available at http://www.uspto.gov/web/patents/classification/index.htm.

> (b) Reciting the use of known prior art technology to accomplish a process or method, even if that process or method is novel and non-obvious.
>
> (c) Combining prior art structures to achieve the normal, expected, or predictable result of that combination.

SAP America, Inc. v. Versata Development Group, Inc., No. CBM2012-00001, at 25-26 (P.T.A.B. January 9, 2013), *citing* 77 Fed. Reg. 157 (August 14, 2012) at 48763-48764.

The '430 Patent does not concern a "technological invention" under these criteria, because it does not recite a novel and unobvious technical feature or present a technical solution to a technical problem.

To the contrary, the '430 Patent merely recites the use of conventional, non-specialized computers, as well as known Internet technologies, to accomplish the purported goal of increasing sales leads. Claim 1 of the '430 Patent is representative of the claimed invention in this regard:

> A method for generating increased numbers of sales leads for each of a plurality of sellers of parts via a network implemented by a computer executing computer readable instructions to perform the steps of:
>
> [1] receiving one or more part numbers for said parts from each of the plurality of sellers;
>
> [2] listing each of said part numbers as a part number hyperlink on a Web page; and
>
> [3] generating a part number Web page for any activated part number hyperlink wherein the part number Web page includes two or more components each of which

> incorporates the part number from said activated part number hyperlink, wherein each such component is selected from the group consisting of a title, a URL, a meta-tag and a text entry.

As set forth in claim 1, the purported method to generate increased sales leads is implemented *entirely* "via a network implemented by a computer executing computer readable instructions." This recitation of a conventional, non-specialized "computer executing computer readable instructions" does not make the '430 Patent a technological invention. Indeed, the specification confirms that this is non-limiting language that effectively just requires the use of some generic computer or network:

> The invention may be described in the general context of computer-executable instructions, such as program modules, executed by one or more computers or other devices. Generally, program modules include, but are not limited to, routines, programs, objects, components, and data structures that perform particular tasks or implement particular abstract data types.... The invention may also be practiced in distributed computing environments where tasks are performed by remote processing devices that are linked through a communications network. In a distributed computing environment, program modules may be located in both local and remote computer storage media including memory storage devices.

Exh. 1001, '430 Patent, Col. 8:19-36.

Moreover, each of the recited steps of the claimed method is accomplished using admittedly known Internet technologies. Specifically, as exemplified in

Claim 1 above, the '430 Patent recites the steps of (1) receiving data items, such as part numbers, (2) listing each data item as a hyperlink on a web page, and (3) generating a new web page if a hyperlink is activated, wherein the new web page includes the received data item, such as a part number, in the web page's title, URL, meta-tags, or text. *See also* Exh. 1001, '430 Patent, Claims 5, 9, and 13.

Simply obtaining data, such as part numbers, from sellers of a product under step (1) was known in the art, and is any case not a technological invention because it can performed by pencil and paper.

Listing data items as hyperlinks on a web page under step (2) was also well-known in the prior art, as admitted in the '430 Patent. For example, the '430 Patent begins its discussion of the prior art in the field—in the "Description of the Related Art"—by describing the existence of hyperlinked data items on the Internet: "There are more than a billion documents available on the World Wide Web from the list of hyperlinked data of [sic] ("Web") over the Internet and this number continues to rapidly increase." Exh. 1001, '430 Patent, Col. 1:15-18.

The '430 Patent also explains that generating web pages upon the activation of a hyperlink, as recited in step (3), was well-known in the prior art. For example, the '430 Patent explains in its discussion of the prior art that a "dynamic Web page is generated based upon a stored file containing instructions and an associated database." Exh. 1001, '430 Patent, Col. 1:60-61. This disclosure corresponds with

the '430 Patent's discussion of generating a web page upon activation of hyperlink in the preferred embodiment: "The list of hyperlinked data 15 contained on main web page 14 is used to generate dynamic web pages[.]" Exh. 1001, '430 Patent, Col. 1:60-61. In other words, the patent does not claim or disclose any specialized method for generating a new web page upon activation of a hyperlink; this is accomplished as it had been before the patent was filed based on known Internet technologies.

The '430 Patent also cannot be considered a technological invention simply because it recites the inclusion of information in a web page's title, URL, meta-tags, or text. The '430 Patent explains that web pages are simply "documents" that "are stored as files on Web servers." Exh. 1001, '430 Patent, Col. 1:18-20. Documents and web pages are commonly known to include titles and content (*i.e.*, text), as described in the '430 Patent. *See, e.g.*, Exh. 1001, '430 Patent, Col. 3:4-6. In addition, the '430 Patent admits that the recited "URL" and "meta-tag" components were well-known in the art. For example, the specification discloses in its discussion of the prior art that web pages have "addresses . . . called Uniform Resource Locators (URLs) or Universal Resource Locators (URLs)," and that "[m]eta-tags are special HTML tags that provide information about a Web page." '430 Patent, Col. 1:20-21 (URLs) and 3:8-9 (meta-tags).

For these reasons, the '430 Patent is not a patent for a "technological invention."

D. Petitioner Has Been Sued for Infringement of the '430 Patent and Is Not Estopped.

Petitioner has been sued for infringement of at least claim 1 of the '430 Patent in *AvMarkets, Inc. v. LinkedIn Corporation*, No. 13-cv-00230-LPS (D. Del.). AvMarkets, Inc. commenced the suit on February 13, 2013, and it is currently pending. The Court has not yet made any determinations on the merits.

Further, Petitioner is not estopped from challenging the claims on the grounds identified in the petition. 37 C.F.R. 42.302(b). Petitioner has not been party to any other post-grant review of the challenged claims.

IV. STATEMENT OF PRECISE RELIEF REQUESTED FOR EACH CLAIM CHALLENGED

A. Claims For Which Review Is Requested

Petitioner respectfully requests review of Claims 1-17 of the '430 Patent under 35 U.S.C. § 321 and AIA § 18, and the cancellation of these claims as unpatentable.

B. Statutory Grounds of Challenge

Petitioner requests that Claims 1-17 be cancelled as unpatentable under 35 U.S.C. § 101. The claim constructions, reasons for unpatentability, and specific evidence supporting this request are detailed below.

C. Claim Construction

1. Broadest Reasonable Interpretation

In the instant proceeding, a claim in an unexpired patent is to be given its broadest reasonable construction in light of the specification in which it appears. 37 C.F.R. § 42.300(b); *see also In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). The '430 Patent has not expired, and thus its claims, for the purposes of this proceeding, should be given their broadest reasonable interpretation.

Pursuant to the USPTO's final Office Patent Trial Practice Guide, a party may provide "a simple statement that the claim terms are to be given their broadest reasonable interpretation, as understood by one of ordinary skill in the art and consistent with the disclosure." Exh. 1004, 77 Fed. Reg. 157 (August 14, 2012), at 48764. Petitioner so states for all terms, as supplemented by the discussion below as to terms that may be of particular interest in this proceeding.[3]

While it is Petitioner's view that none of the claim constructions should deviate from the broadest reasonable interpretation, Petitioner believes that furnishing a clear definition for each term will assist the Board. Some claim terms

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[3] Petitioner advocates the broadest reasonable interpretation for the claim terms of the '430 Patent for the purposes of this CBM review only. Claim construction is analyzed under a different legal standard for the purposes of litigation. *E.g.*, *In re Trans Texas Holdings Corp.*, 498 F.3d 1290, 1297 (Fed. Cir. 2007). As such, Petitioner reserves the right to advance different claim constructions in connection with litigation in federal court, including in connection with the currently pending litigation in *AvMarkets, Inc. v. LinkedIn Corporation*, No. 13-cv-00230-LPS (D. Del.).

may superficially appear technical or application-specific, yet their ordinary meanings in light of the patent specification make clear that they are not meaningfully limiting within the claim's field of use—the Internet.

2. Petitioner's Broadest Reasonable Interpretations and Supporting Evidence

Claim Term	**Broadest Reasonable Interpretation in View of the Specification**
"parts" *(Claims 1-4, 9-17)*	Products marketed by sellers.

The specification expressly equates "parts"—which are identified with "part numbers"—with "products" that sellers market in the normal course of business. *See, e.g.*, Exh. 1001, '430 Patent, Col. 5:44-46 ("The systems and methods of the present invention provide increased exposure and generation of sales leads for entities marketing products, particularly by part numbers[.]") and Col. 5:49-54 ("Typical Web-based marketplace sites provide only limited exposure or generation of sales leads in that a customer looking for a particular product generally must be aware of and/or subscribe to the marketplace site in order to search for a particular product by part number on such website[.]") (emphasis added). Thus, the term "parts" is used in the specification to refer to any particular product offered for sale.

Claim Term	**Broadest Reasonable Interpretation in View of the Specification**
"part number" *(Claims 1-4, 7, 9-17)*	Any number that could represent a product, part of a product, or a person.

The specification of the '430 Patent uses the phrase "part number" broadly to refer to any number or information that could identify a product, a part thereof, or a person. As discussed above, "part numbers" are typically associated with a product. However, the specification also uses the phrase to refer to a broad category of data that includes personally identifying information. For example, the '430 Patent explains that "there is a need for systems and methods that entice Web crawlers to index Web sites containing large databases of inventoried part numbers, such as aviation part numbers, book ISBNs, automotive part numbers, electronic part numbers, *phone numbers, zip codes, drivers license numbers,* document numbers, etc., … such that increased sales leads are generated for those Web sites and/or subscribers thereto and/or for authorized users thereof when a potential customer employs a search engine to search for one or more of the part numbers." Exh. 1001, '430 Patent, Col. 3:46-56 (emphasis added). As such, the '430 Patent not only contemplates that "part numbers" include typical product numbers, such as "aviation part numbers," but also personal data, expressly exemplified by "phone numbers," "zip codes" and "drivers license numbers."

Claim Term	**Broadest Reasonable Interpretation in View of the Specification**
"Web page" *(All claims)*	A document available on the World Wide Web.

The specification defines "Web pages" to mean "documents available on the World Wide Web" that "are stored as files on Web servers." Exh. 1001,'430 Patent, Col. 1:15-18. This is consistent with industry usage of the term. *See* Exh. 1005, Microsoft Computer Dictionary, 5th ed., at 564 (defining a "Web page" as "A document on the World Wide Web").

Claim Term	**Broadest Reasonable Interpretation in View of the Specification**
"hyperlink" *(All claims)*	A link on one document to retrieve another piece of that document or another document.

The '430 Patent does not provide any special definition for the term "hyperlink," but rather uses the term "hyperlink" according to its customary meaning in the art; namely, that a "hyperlink" is simply a link from one document on the Web to another portion of that document or to another document that could be located on a remote web server. *See* Exh. 1001, '430 Patent, Col. 1:15-19 (discussing hyperlinked documents on the World Wide Web); Col. 2:64-65 (noting that a web "spider will 'crawl' a Web page by following the links found on the page"); *see also* Exh. 1006, Newton's Telecom Dictionary, 22nd ed., at 462

(defining a "hyperlink" as "A link from one part of a page on the Internet to another page, either on the same site or a distant site").

Claim Term	**Broadest Reasonable Interpretation in View of the Specification**
"meta-tag" *(All claims)*	An HTML tag that provides information about a Web page without affecting how the page is displayed. The information may consist of which keywords represent the page's content, who created the page, how often it is updated, and or what the page is about.

The specification expressly defines the term "Meta-tags":

> "Meta-tags are special HTML tags that provide information about a Web page. Unlike normal HTML tags, meta-tags do not affect how the page is displayed. Instead, they provide information such as who created the page, how often it is updated, what the page is about, and which keywords represent the page's content.".

Exh. 1001, '430 Patent, Col. 3:8-13.

This is consistent with the term's ordinary meaning in the art. *See, e.g.*, Exh. 1005, Microsoft Computer Dictionary, 5th ed., at 336 ("A tag in an HTML or XML document that allows a Web-page creator to include such information as the author's name, keywords identifying content, and descriptive details (for example, non-text objects on the page).")

Claim Term	**Broadest Reasonable Interpretation in View of the Specification**
"BLOB field" *(Claims 2, 6, 10, 14)*	A user input field for accepting Binary Large Objects, which comprises not only the traditional character, numeric, and memo fields but also pictures or any other data that consumes a large amount of space.

The '430 Patent provides that a BLOB field is a "Binary Large Object (BLOB) field" for receiving data input from a user or subscriber. Exh. 1001, '430 Patent, Col. 6:10-13 ("subscriber 22 preferably inputs his respective data 11 comprising part numbers 17 into a Binary Large Object (BLOB) field on the subscriber part number input page 21, as shown in FIG. 3."). Because the data items or part numbers that are disclosed as being received in the claimed method comprise a broad category of product-related or personal information, the BLOB field must accept a broad, non-specialized set of data. This is consistent with the normal meaning of the term, which provides that a BLOB "includes not only the traditional character, numeric, and memo fields but also pictures or other data that consumes a large amount of space." *See* Exh. 1006, Newton's Telecom Dictionary, 22nd ed., at 163.

V. CLAIMS 1-17 OF THE '430 PATENT ARE PATENT-INELIGIBLE UNDER 35 U.S.C. § 101

Laws of nature, natural phenomena and abstract ideas cannot be patented. *Mayo v. Prometheus*, 132 S. Ct. 1289, 1293 (2012). When a patent claim is drawn to an abstract idea, it must add "significantly more" to be patent-eligible. *Id.* at 1294.

In this case, the claims of the '430 Patent are at their core drawn to the abstract idea of generating sales leads by creating a catalog of product information (such as part numbers) that potential customers can access and review.[4] This basic idea is a well-established business concept—business owners have for decades prepared and distributed product catalogs as a way of generating sales. The only additional aspect claimed in the '430 Patent is the provision of such a product catalog "via the Internet." Exh. 1001, '430 Patent, Abstract (describing the invention as a "method for generating increased numbers of leads, such as sales leads for data items such as part numbers ... *via the Internet.*") (emphasis added).

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[4] Although the Federal Circuit's recent decision in *CLS Bank* produced no majority opinion, nine of the ten judges who heard the case opined explicitly or implicitly that the analysis should identify the abstract idea the claim encompasses. *See CLS Bank Int'l v. Alice Corp. Pty. Ltd.*, 2013 WL 1920941, at *9 (Fed. Cir. May 10, 2013) (Lourie, J., concurring, joined by four others) ("it is important at the outset to identify and define whatever fundamental concept appears wrapped up in the claim"); *id.* at *38 (Rader, C.J., Linn, J., Moore, J., and O'Malley, J., concurring in part and dissenting in part) ("The claim describes the general and theoretical concept of using a neutral intermediary in exchange transactions to reduce risk that one party will not honor the deal, i.e., an escrow arrangement.")

But that is not, and cannot be, sufficient to allow the patentee to obtain a patent covering an abstract idea.

First, under the established Supreme Court precedent, it is not sufficient to limit an otherwise unpatentable claim to "a particular technological environment." *Mayo*, 132 S. Ct. at 1297, *quoting Bilski v. Kappos*, 130 S. Ct. 3218, 3230 (2010). For example, "simply implementing [an abstract idea] on a physical machine, namely a computer," is *not* a patentable application because it is overly broad and does not differ significantly from a claim that just says "apply the [idea]." *Mayo*, 132 S. Ct. at 1301. The patentee's attempt here to take an abstract idea and simply apply it broadly to the "Internet" fails for this reason alone.

Second, it is also well-established that a patentee may not render a claim to an abstract idea patentable merely by adding "well-understood, routine, conventional activity." *Mayo*, 132 S. Ct. at 1298. If, putting the abstract idea to the side, the other steps or combination of steps in the claim are "'well-known,' to the point where ... there [is] no 'inventive concept' in the claimed application" of the idea, the claim is unpatentable. *Id.* at 1299. Under this analysis, the claims of the '430 Patent fail as well, as all of the specific limitations in the claims merely recite the well-known, routine operations of the Internet.

Finally, although the "machine-or-transformation" test is no longer definitive, the claims of the '430 Patent fail that test as well. The claimed

invention is admittedly not "tied to a particular machine or apparatus" and does not "transform a particular article into a different state or thing."

A. The '430 Patent Claims An Abstract Idea—Creating a Product Catalog—That Is Provided "Via The Internet."

The claims of the '430 Patent are fundamentally drawn to the abstract idea of generating sales leads by cataloguing product data. The claims are not limited to any specific implementation of this idea, but require simply that the product data be listed in a searchable format on a document found on the World Wide Web, so that existing search engines will index it. *See* Exh. 1001, '430 Patent, Col. 2:27-31, 2:53-58, 3:4-14, 25-33, 40-56, 6:53-7:9. Merely claiming the abstract idea of providing a product catalog on the Internet, however, is not sufficient to make the claims patentable.

Claim 1, which is representative, purports to cover:

> A method for generating increased numbers of sales leads for each of a plurality of sellers of parts via a network implemented by a computer executing computer readable instructions to perform the steps of:
>
> [1] receiving one or more part numbers for said parts from each of the plurality of sellers;
>
> [2] listing each of said part numbers as a part number hyperlink on a Web page; and
>
> [3] generating a part number Web page for any activated part number hyperlink wherein the part number Web page includes two or more components each of which incorporates the part number from said activated part number hyperlink, wherein each such component is

> selected from the group consisting of a title, a URL, a meta-tag and a text entry.

The first step is a data-gathering step requiring no specific implementation in computer hardware or software, or on a machine at all: "receiving one or more part numbers for said parts from each of the plurality of sellers."[5] The second and third steps use the data collected in the first step by listing the gathered part numbers as hyperlinks on a web page, and for any part number clicked on, generating a separate web page with the part number in two or more text formats. In simple terms, the '430 Patent's claims simply recite the gathering and organizing of product information in order to "generat[e] increased numbers of sales leads."

As an initial matter, both the Supreme Court and the Federal Circuit have consistently held that claims drawn merely to a commercially advantageous method of gathering and organizing data are unpatentably abstract. *See, e.g.*, *CyberSource*, 654 F.3d at 1370 (finding the "mere collection and organization of data" as part of credit-card verification method insufficient to satisfy § 101); *In re Grams*, 888 F.2d 835, 840 (Fed. Cir. 1989) (holding that "data-gathering" steps cannot make an otherwise ineligible claim patent-eligible); *Ex parte Gutta*, 2009

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[5] Other claims add similar, non-specific data-gathering steps, such as "generating an index of non-duplicative part number from the received plurality of data items," *see* Exh. 1001, Claims 9-17, 5-8 ("data items" instead of "part numbers"), and "issuing unique access credentials to each of a plurality of authorized users of a Web site," then "receiving numbers of said parts from two or more of said plurality of authorized users". *See* Exh. 1001, Claims 13-17.

WL 112393 (BPAI, Jan. 15, 2009) (rejecting claims to "computerized method" for "recommending one or more available items to a target user" that included steps of "obtaining a history" of items selected by others and generating target user profiles and recommendation scores).

Moreover, the '430 Patent ultimately claims nothing more and nothing less than the abstract idea of generating sales leads by putting product data in a searchable index, adding only the instruction to "apply it" in the broadest field of use imaginable—*the Internet*. *Mayo*, 132 S. Ct. at 1294. That does not suffice to make these claims patentable. The idea of cataloguing customer and product data in the field of use of "the Internet" necessarily implies putting them in the formats known to be searchable on the Internet. The claims add nothing that is not already implicit in the abstract idea. Because the steps are "as a practical matter … necessary to every practical use" of the abstract idea of making commercial data searchable on the Web, they are "not truly limiting." *CLS Bank*, 2013 WL 1920941 at *11, *citing Mayo*, 132 S. Ct. at 1298 (Lourie, J. concurring); *see id.* at *28-*29 (Rader, J., concurring) (key inquiry is "whether the claim covers every practical application of [the] abstract idea" but even if not, "it still will not be limited meaningfully if it … only … identif[ies] a relevant audience, a category of use, field of use, or technological environment"). The Internet is in fact so broad an area of application, it can barely be said to limit the claim even to a field of use.

CyberSource Corp. v. Retail Decisions, Inc., 620 F. Supp. 2d 1068, 1077 (N.D. Cal. 2009) ("The internet continues to exist despite the addition or subtraction of any particular piece of hardware … [T]he internet is an abstraction. … One can touch a computer or a network cable, but one cannot touch 'the internet.'"), *aff'd*, 654 F.3d 1366.

Indeed, the Examiner originally rejected during prosecution all of the claims of '430 Patent—which contain the very same limitations that ultimately issued—as drawn to non-statutory subject matter. *See* Exh. 1007, Office Action, dated December 23, 2009, at 2. The patentee overcame the rejection by simply revising *the preamble* of the claims to state that the claimed method is implemented by "a computer executing computer readable instructions." *See* Exh. 1008, Applicant's Response and Amendment, dated March 19, 2010, at 3-6; Exh. 1009, Office Action, dated May 12, 2010, at 2. However, the Federal Circuit has subsequently made clear that the mere recitation of a general-purpose computer, whether phrased as such or as "computer readable program code" or the like, cannot save a claim from abstractness. *CyberSource*, 654 F.3d at 1374-75; *CLS Bank*, 2013 WL 1920941, at *14, *15-16 (Lourie, J., concurring) (neither generic "computer" nor claims in Beauregard format suffices); *id.* at *30 (Rader, C.J., Linn, J., Moore, J., and O'Malley, J., concurring in part and dissenting in part) ("mere reference to a

general purpose computer will not save a method claim from being deemed too abstract to be patent eligible").

B. The '430 Patent Adds Only Conventional, Routine Elements to the Abstract Idea of Creating a Product Catalog.

Additionally, the '430 Patent is unpatentable because it merely adds conventional and routine limitations to the underlying abstract idea of creating a product catalog. *See Mayo*, 132 S. Ct. at 1301 ("'[P]ost-solution activity' that is purely 'conventional or obvious' can[not] transform an unpatentable principle into a patentable process.") (quoting *Parker v. Flook*, 437 U.S. 584, 589-590 (1978)); *CLS Bank*, 2013 WL 1920941 at *10-11 (Lourie, J. concurring) (the "inventive concept" must "represent more than a trivial appendix to the underlying abstract idea," and not be "tangential, routine, well-understood, or conventional").

As discussed above (*see* Section II.C *supra*), the claims of the '430 Patent simply recite well-known operations of the Internet. They consist of nothing more than receiving data, and then listing the data as hyperlinks and as Web page content, so that the data could be searched for and retrieved on the Internet, which was well-known in the art. *See supra* at 6-9. These limitations denote the generic storage and retrieval of data on the Internet, and as such are not an inventive concept. *See Bancorp Servs., LLC v. Sun Life Assurance Co. of Canada*, 771 F. Supp. 2d 1054, 1065 (E.D. Mo. 2011) ("storing, retrieving, and providing data ... are inconsequential data gathering and insignificant post solution activity"

for purposes of Section 101 analysis), *aff'd*, 687 F.3d 1266 (quotations, citation omitted).

Apart from the abstract idea of generating sales leads by providing a product catalog that potential customers can access and review—which is not patent-eligible—all the other limitations of the claimed invention, alone or in combination, "were in context obvious, already in use, or purely conventional." *Mayo*, 132 S. Ct. at 1299.

The prosecution history of the '430 Patent further confirms that the patent does not concern a novel technological improvement over the prior art. Specifically, the patentee admitted that the prior art references cited by the Examiner during prosecution disclosed the technological features of the Internet recited in the claims -- *i.e.*, receiving part numbers from a seller and listing the part numbers as hyperlinks on the Internet, as well as generating a new Web page that included part numbers in one of the static fields (title, URL, meta-tags or text). However, the patentee argued that the claimed invention was novel because it purportedly generated increased sales leads for *each of a plurality of sellers*, as opposed to just *some* sellers (as in the prior art). *See* Exh. 1010, Applicant's Amendment, dated October 12, 2010 at 2-5. This is a business consideration and not a technological feature. Indeed, in his stated reasons for allowance, the Examiner relied solely on the patentee's addition of the "generating sales leads for

each of a plurality of sellers" limitation in the claim preambles, and not on any novel technical feature. *See* Exh. 1011, Notice of Allowance, dated November 1, 2010 at 2.

C. The '430 Patent Does Not Satisfy the Machine-or-Transformation Test.

The claims of the '430 Patent are not eligible under § 101 for the additional reason that they are not tied to any particular machine and do not transform any article into a different state or thing. Although the machine-or-transformation test is no longer the "definitive test of patent eligibility," it remains "an important and useful clue." *Mayo*, 132 S. Ct. at 1296.

To satisfy the "machine" prong of the test, it is not sufficient to claim "a general purpose computer that has been programmed in some unspecified manner." *Dealertrack v. Huber*, 674 F.3d 1315, 1332 (Fed. Cir. 2012) (quotations, citations omitted). Instead, the claimed computer must be "specially programmed." *Id.* The claimed functions in the '430 Patent of gathering data, creating indexes, providing hyperlinks, and generating Web pages do not meet this requirement because the claims do not require a specially programmed computer to perform them. In fact, the specification of the '430 Patent emphasizes that the possible software implementations of the invention are boundless, explaining that the invention is "in the general context of computer-executable instructions, such as program modules, ... includ[ing] but not limited to, routines, programs, objects,

components, and data structures that perform particular tasks or implement particular abstract data types." Exh. 1001, '430 Patent, Col. 8:19-25. The Board rejected a similar "computerized method" of "inputting multiple extensible Markup Language (XML) documents" and representing them as "fixed sets of tables" in a relational database. *Ex parte Nawathe*, 2009 WL 327520, at *1 (BPAI, Feb. 9, 2009). The claim did not require "a particular computer specifically programmed for executing the steps of the claimed method" and accordingly the Board upheld the Examiner's finding that the claim was drawn to an abstract idea. *Id.*, at *3-4.

Likewise, the '430 Patent does not transform any article into a different state or thing. Collecting and organizing data does not meet the transformation prong, *see CyberSource*, 654 F.3d at 1370, nor does modification of computerized documents such as Web pages *see Ex parte Nawathe*, 2009 WL 327520, at *4 (such "documents are not an article (i.e., physical entities) ... [but] mere data that represent such entities").

VI. CONCLUSION

For the foregoing reason, Petitioner respectfully requests review of Claims 1-17 of the '430 Patent under 35 U.S.C. § 321 and AIA § 18, and the cancellation of these claims as unpatentable.

The undersigned attorneys welcome a telephone call should the Office have any requests or questions. If there are any additional fees due in connection with

the filing of this paper, please charge the required fees to our deposit account no. 50-0665.

Dated: May 29, 2013

Respectfully submitted,

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Lead Counsel for Petitioner

CERTIFICATE OF SERVICE – MAIL

STATE OF CALIFORNIA, COUNTY OF SANTA CLARA

I am and was at all times herein mentioned employed in the County of Santa Clara, State of California. I am over the age of 18 years and not a party to the within action or proceeding. My business address is 3150 Porter Drive, Palo Alto, California 94304-1212.

On **May 29, 2013**, I served a true copy of the following document(s);

PETITION FOR COVERED BUSINESS METHOD REVIEW UNDER 35 U.S.C. § 321 AND § 18, OF THE LEAHY-SMITH AMERICA INVENTS ACT

as filed with the United States Patent Office on the patent owner by mailing said document (listed below) enclosed in a sealed envelope (for collection and mailing, with postage thereon fully prepaid, on the same date, following ordinary business practices) by Express Mail, addressed as follows:

Paul Bangor Jr.
Thorp Reed & Armstrong, LLP
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301 Grant Street, 14th Floor
Pittsburgh, PA 15219-1425

I declare under penalty of perjury under the laws of the State of California and the United States of America that the foregoing is true and correct; that I am employed in the office of a member of the Santa Clara bar at whose direction this service was made; and that this Proof of Service was executed on **May 29, 2013**, at Palo Alto, California.

Diane Hawley

Diane Hawley