

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FACEBOOK, INC.,  
Petitioner,

v.

PALO ALTO RESEARCH CENTER INC.,  
Patent Owner.

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IPR2021-001294  
Patent 8,489,599 B2

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Before KARL D. EASTHOM, SHEILA F. McSHANE, and  
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

McSHANE, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE  
PATENT OWNER'S MOTION TO AMEND

## I. INTRODUCTION

On January 25, 2022, we instituted trial as to claims 1, 4, 6, 7, 9–12, 15, 17–19, 22, 24, and 25 of U.S. Patent No. 8,489,599 B2. Paper 13 (“Dec.”). After institution, Patent Owner filed a Contingent Motion to Amend, proposing substitute claims 26–40, to replace claims 1, 4, 6, 7, 9–12, 15, 17–19, 22, 24, and 25. Paper 20 (“Mot.”). Petitioner filed an Opposition. Paper 26 (“Opp.”).

In the Motion, Patent Owner requested that we provide preliminary guidance concerning the Motion in accordance with the Board’s pilot program concerning motion to amend practice and procedures. Mot. 1; *see also* Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board, 84 Fed. Reg. 9,497 (Mar. 15, 2019) (providing a patent owner with the option to receive preliminary guidance from the Board on its motion to amend) (“Notice”). We have considered Patent Owner’s Motion and Petitioner’s Opposition.

In this Preliminary Guidance, we provide information indicating our initial, preliminary, non-binding views on whether Patent Owner has shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend in an *inter partes* review and whether Petitioner (or the record) establishes a reasonable likelihood that the substitute claims are unpatentable. *See* Notice, 84 Fed. Reg. at 9,497 (“The preliminary guidance . . . provides preliminary, non-binding guidance from the Board to the parties about the [motion to amend].”); *see also* 35 U.S.C. § 316(d) (statutory requirements for a motion to amend); 37 C.F.R. § 42.121 (regulatory requirements and burdens for a motion to amend); *Lectrosonics, Inc. v Zaxcom, Inc.*, IPR2018-

01129, Paper 15 (PTAB Feb. 25, 2019) (precedential) (providing information and guidance regarding motions to amend).

For this Preliminary Guidance, we focus on the proposed substitute claims, and specifically on the amendments proposed in the Motion. *See* Notice, 84 Fed. Reg. at 9,497. We do not address the patentability of the originally challenged claims. *Id.* Moreover, in formulating our preliminary views on the Motion and Opposition, we have not considered the parties' other substantive papers on the underlying merits of Petitioner's challenges. We emphasize that the views expressed in this Preliminary Guidance are subject to change upon consideration of the complete record, including any revision to the Motion filed by Patent Owner. Thus, this Preliminary Guidance is not binding on the Board when rendering a final written decision. *See id.* at 9,500.

## II. PRELIMINARY GUIDANCE

### A. Statutory and Regulatory Requirements

For the reasons discussed below, at this stage of the proceeding, and based on the current record, it appears that Patent Owner has not shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend.

#### 1. Reasonable Number of Substitute Claims

Does Patent Owner propose a reasonable number of substitute claims? (35 U.S.C. § 316(d)(1)(B))
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<b>Yes.</b> Patent Owner proposes no more than one substitute claim for each challenged claim.
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#### 2. Respond to Ground of Unpatentability

Does the Motion respond to a ground of unpatentability involved in the trial? (37 C.F.R. § 42.121(a)(2)(i))
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**Yes.** Patent Owner responds to the grounds of unpatentability (“that the ‘determin[e/ing]’ limitation requires the possibility of unexpected responses”), which, according to Patent Owner, “address[es] Petitioner’s arguments.” Mot. 3. Petitioner does not argue otherwise. *See generally* Opp.

### 3. Scope of Amended Claims

Does the amendment seek to enlarge the scope of the claims? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))

**Yes.**

Patent Owner contends “the proposed substitute independent claims (i.e., 26, 33, and 37) retain all of the original independent claims’ (i.e., 1, 12, and 19) features and add narrowing elements,” and thus do not broaden claim scope. Mot. 3–4.

Patent Owner’s contention is not accurate, because, for example, in substitute claim 26, “an expected response” in the original claim is deleted and substituted with “at least one predefined response.” The claim also replaces “matches the expected response” with “is expected or unexpected, wherein the received response is expected if the received response matches one or more of the at least one predefined response, and wherein the received response is unexpected if the received response does not match any of the at least one predefined response.”

Petitioner argues Patent Owner is “improperly attempting to enlarge the scope of the original claims.” Opp. 1. Petitioner argues, “[i]f ‘an expected response’ means one or more expected responses, therefore, determining whether the received response ‘matches the expected response’ means that the received response must match [all of] the one or more previously-recited expected responses in the content package.” *Id.* at 3 (emphasis omitted). Petitioner then argues “the term ‘predefined response’ is broader than ‘expected response,’” because “an ‘expected response’ does not include any conceivable or possible response; it is a response that is expected.” *Id.* at 4–5 (emphasis omitted).

Petitioner’s points are supported by the record. For example, the Specification uses language about “determined” and “expected” responses throughout, but does not describe the terms together, to permit easy comparison. Further, the Specification describes that a “column entry may

also obtain an allowable set of values from a database of predefined names or tags with pre-set values which can be edited by the user” (Ex. 2014 (“Spec.”) ¶ 60), and that a “response column entry may obtain a value that describes an expected response from the user in the form of an audio stream or a text string” (*id.* ¶ 62). This implies there may be more predefined responses in a database than are expected, suggesting “predefined” is broader than “expected.” Further, Petitioner refers to the prosecution history, where the applicant distinguished a prior art reference that allowed users to provide ratings, by arguing that “receiving a user’s rating is different from receiving an expected response because it is not possible for the system to ‘expect’ a certain rating from the user,” which also suggests that applicant viewed “expected” in a limited manner. Opp. 6 (citing Ex. 2014, 419).

Patent Owner has asserted the original claims were retained, but language actually was removed. Mot. 4. Additionally, Patent Owner has not advanced assertions as to whether the substitute language is narrower or equivalent to the removed language, and the record suggests otherwise. Accordingly, Patent Owner has not sufficiently established, at this preliminary stage, that the proposed claim language does not broaden the claim scope.

#### 4. New Matter

Does the amendment seek to add new subject matter? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))

**No.**

The proposed independent claims include substitute language of “determining whether the expected response is expected or unexpected . . . wherein the received response is unexpected if the received response does not match any of the at least one predefined response.” *See, e.g.,* Mot., App. A, 1–2 (Claim 26).

Patent Owner contends written description support for this clause is present in the Specification at Tables 1 and 2, and paragraphs 46, 56, 62–64, and 67. Mot. 6–7. Petitioner does not argue otherwise. *See generally* Opp.

We agree with Patent Owner’s contention. For example, the claim recites “the content package includes at least one content piece and a set of rules

associated with the content package.” The expected response, or predetermined response, is associated with a particular content item. *See* Spec. ¶ 56. Thus, when performing the “determining” step, we construe the claim to mean the determining is confined to comparing expected/predetermined responses to received responses *only for the specific content presented*, not for all responses for all possible content. Because the Specification indicates that “a presentation rule can be defined in terms of one or more high-level abstractions” (Spec. ¶ 54), and “a user can provide content management system 240 with a list of allowable values (e.g., names or tags, and corresponding contextual information) for the entries of a given column e.g., the *time, location, state, or response* columns” (*id.* ¶ 59), the Patent Owner has sufficiently demonstrated that there is written description support for “determining . . . if the received response matches one or more of the at least one predefined response, and wherein the received response is unexpected if the received response does not match any of the at least one predefined response.”

#### B. Patentability

For the reasons discussed below, at this stage of the proceeding, and based on the current record, it appears that Petitioner (or the record) has shown a reasonable likelihood that proposed substitute claims 26–40 are unpatentable.

Does the record establish a reasonable likelihood that the proposed substitute claims are unpatentable?

#### 35 U.S.C. § 101 — Patent Eligibility

**Yes.**

Petitioner asserts that the Board may review substitute claims for patent eligibility under 35 U.S.C. § 101 and presents its contentions in that regard under the two-step test of *Alice Corp. Pty. v. CLS Bank Int’l*, 573 U.S. 208 (2014). Opp. 9–14.

Petitioner contends the “substitute claims are directed to the abstract idea of presenting interactive content to a user based on their context,” and “recite no inventive concept and instead merely invoke ‘well-understood, routine [and] conventional’ technology to carry out the abstract ideas.”

Opp. 9, 12 (citing *Intellectual Ventures ILLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1369–70 (Fed. Cir. 2015)). Petitioner contends the “substitute claims recite only high-level functional results,” but “without limiting them to technical means for performing the functions.” Opp. at 10 (citing *Intellectual Ventures ILLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1342 (Fed. Cir. 2017)).

At this stage of the proceeding, and even though Patent Owner has not had an opportunity to respond, we find merit in Petitioner’s contentions.

*Alice/Mayo Step 1; PTO Step 2A, Prong One*

Petitioner describes that the substitute independent claims recite that a “content package is received, context information is received and processed, a current context is determined, a condition is satisfied, a user response is received and determined to be expected or unexpected, and an action is performed in response.” Opp. 10.

This is a reasonable summary of substitute independent claim 26, which recites receiving data in a “content package,” receiving data in “a set of contextual information . . . from two or more different types of input sources,” “determin[ing] a current context for the first user and first device,” “determining whether the current context satisfies the trigger condition,” if the trigger condition is met “presenting” content to a user, receiving a response from the user [if the content was presented], “determining” whether the received response “matches one or more of the at least one predefined response” or “does not match,” and performing an action based on an outcome of the determination.” Mot., App. A, 1–2.

Claim 26 thus involves steps – receiving data, making determinations, and performing an action based on the determinations – that can be performed mentally by a person using observation, evaluation, judgement, and opinion. This is consistent with the case cited, which notes the claims in that case recited “similar concepts as being directed towards ineligible subject-matter” as in other Federal Circuit decisions, including *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370, 1373 (Fed. Cir. 2011) (“holding that ‘a method for verifying the validity of a credit card transaction over the Internet’ was directed to an abstract idea or unpatentable mental process”). *Intell. Ventures ILLC*, 792 F.3d at 1368, n.2. It is also consistent with Office Guidance. See 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50, 52 (2019)

“Guidance”). We thus agree at this preliminary stage that claim 26 appears to recite steps that can be performed with abstract mental processes.

*Alice/Mayo Step 2; PTO Step 2A, Prong 2, Step 2B*

In this step “we consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application,” in a “search for an ‘inventive concept.’” *Alice*, 573 U.S. at 217 (citing *Mayo Collaborative Servs. v. Prometheus Lab’ys, Inc.*, 566 U.S. 66, 78 (2012)).

Petitioner asserts, and we agree, that “[t]he substitute claims recite only high-level functional results that add nothing to the abstract idea.” Opp. 10. That is, “[a] content package is received, context information is received and processed, a current context is determined, a condition is satisfied, a user response is received and determined to be expected or unexpected, and an action is performed in response,” which “do not solve any technological problem.” *Id.* (citing *Customedia Techs., LLC v. Dish Network Corp.*, 951 F.3d 1359, 1365 (Fed. Cir. 2020)). Further, as Petitioner quotes, “[m]erely claiming [] functions in general terms, without limiting them to technical means for performing the functions that are arguably an advance, does not make a claim eligible.” *Id.* (quoting *Ericsson Inc. v. TCL Comm. Tech. Holdings Ltd.*, 955 F.3d 1317, 1328 (Fed. Cir. 2020)).

More specifically, we first note that the receiving of data is considered insignificant extra-solution activity, undeserving of patentable weight. Guidance at 55 n.31. Moreover, as to the “receiving a set of contextual information with respect to the first user and the first device” limitation, Petitioner argues, and we agree, that the claims do not specify details on the “input sources” and “contextual information “ received. Opp. 11. As Petitioner further asserts, the written description supports “that this step relies on nothing more than conventional techniques,” such as GPS, detection of motion, or downloaded Internet information. *Id.* at 11–12 (citing Ex. 1001, 6:34–45, 6:58–65). As to the last-recited limitation, “performing an action” is described in the original Specification, according to Patent Owner, at paragraphs 9, 46, 48, 56, 62–64, and 67, and Tables 1 and 2. Mot. 6–7. There, “performing an action” is described as including “updating the content entries in the content database and updating the context or activity entries in the context manager” (¶ 9), “defin[ing] a delay period” (¶ 46), “present[ing] content” (¶ 48),



“repeat[ing]” content (§ 56), “delet[ing] or alter[ing] . . . the corresponding content entry” (§ 64), and “delet[ing] the content entry” (§ 67). Under a broad reading of the claim, the limitation encompasses actions that are mere output operations, which are also considered insignificant extra-resolution activity. Guidance at 55 n.31. This is also true for the limitation “in response to the trigger condition being satisfied, presenting the content piece to the first user.”

After setting aside for now the data gathering/receipt and output steps in substitute claim 26, the following limitations remain:

- processing the contextual information to determine a current context for the first user and the first device;

- determining whether the current context satisfies the trigger condition;

- determining whether the received response matches the expected response is expected or unexpected, wherein the received response is expected if the received response matches one or more of the at least one predefined response, and wherein the received response is unexpected if the received response does not match any of the at least one predefined response.

Within these limitations, we encounter only one potential “additional element,” the “first device.” (*see* Guidance at 55 n.24). However, as discussed above, the contextual information that is processed for the “first device” in this claim limitation does not reflect an improvement in the functioning of a computer, or an improvement to a technology or technical field (Spec. ¶ 1), because the computing technology specified for implementing the abstract mental steps is general purpose (Spec. ¶¶ 92–94). Guidance at 55. Therefore, the “additional element” does not “integrate the exception into a practical application.” *Id.*

In addition, the “additional element” and data gathering and output steps, alone or in combination, represent “well-understood, routine, conventional activity,” because the first device is a general-purpose computer or “mobile device,” which performs common data processing functions such as receiving, processing, and outputting data. Opp. 12–13; *see* Spec. ¶¶ 2, 36, 37, 42. Therefore, the claim elements, individually and considered as a whole, do not appear to “amount to significantly more than the [mentally-performed process] itself.” Guidance at 56.

The analysis and result are essentially the same for substitute independent claims 33 and 37.

*Conclusion*

Thus, at this preliminary point of the proceeding, Petitioner has shown a reasonable likelihood of demonstrating that the substitute claims recite ineligible subject matter in the form of steps that can be performed with abstract mental processes, implemented on general-purpose computing devices, without reciting elements that “transform the nature of the claim” into a patent-eligible application.” *Alice*, 573 U.S. at 217.

35 U.S.C. § 103(a) — Obviousness

**Yes.**

Petitioner contends the substitute claims are unpatentable as obvious under four scenarios: original ground 1 (Lamont (Ex. 1003), Wolfe, Wang); original ground 3 (Lamont, Wolfe, Wang, Meyers); and two new grounds dependent on a narrow construction of “two or more different types of input sources,” with each relying on either of original grounds 1 or 3, along with the addition in each of either Lynch or Wehrenberg. Opp. 14–15.

Patent Owner contends the substitute claims are not obvious under original grounds 1 and 3, but has not had an opportunity to respond to the new grounds relying on either Lynch or Wehrenberg. Mot. 15–23.

Petitioner contends Lamont discloses a “first device,” corresponding to new claim language, at column 8, lines 54–55, and “receiving a set of contextual information with respect to the first user and the first device,” “[b]ecause the contextual information in Lamont is received while the first user is in physical possession of the client device, that information pertains to the ‘first user and the first device.’” Opp. 15–16 (citing Pet. 24–35; Ex. 1002 ¶¶ 103–20). Petitioner also contends Lamont discloses a “predetermined response,” because Lamont’s example answer, “Lincoln,” “was defined beforehand and incorporated into the Lamont tour script provided to and executing on the client device.” Opp. 16 (citing Pet. 18–24; Ex. 1016 ¶ 72). Additionally, Petitioner contends Wolfe discloses determining if a response is expected or unexpected, at least at Figure 3. Opp. 17–18.

As to “two or more different types of input sources,” Petitioner contends “Lamont discloses receiving time information from a clock device and location information from a GPS receiver device.” Opp. 18 (citing Pet. 25–26; Ex. 1003, 14:29–37, 14:56–62; Ex. 1002 ¶¶ 103, 104, 107). Petitioner contends the prior art discloses a first input source at either the “network interface of the client device in Lamont, alone or in combination with the device’s clock,” or Lamont’s internal clock device, or Lynch’s “technique in which a mobile device can receive a signal from cellular base station that the mobile device can use to determine the correct local time.” Opp. 18–20. Petitioner contends the prior art discloses a second input source at either Lamont’s GPS component (Opp. 18), or Wehrenberg’s accelerometer (*id.* at 21).

Petitioner appears to have established a reasonable case that the claims are unpatentable over the prior art cited in the Petition and/or Opposition.

Patent Owner raises two arguments that are related to unpatentability issues associated with the original claims, as well as the substitute claims, which Patent Owner and Petitioner have also addressed in Patent Owner Response (Paper 23) and Petitioner Reply (Paper 15). First, Patent Owner contends there is no reason to combine Lamont’s system “with a different complete system teaching an alternate and inconsistent understanding of ‘treasure hunt’ (Wolfe).” Mot. 20. Patent Owner argues that in Lamont, “treasure hunt” is in a list of potential uses of the invention, but also is used to refer to a tour where “each point on the tour is inactive until the point immediately preceding it has been triggered.” *Id.* at 17–18 (citing Ex. 1003, 2:24–29, 15:56–59). In contrast, Patent Owner asserts that Wolfe “instead [] ask[s] a user to solve puzzles,” and Dr. Martin testifies that “Lamont’s treasure hunt is the hunt for the required locations, while Wolfe’s treasure hunt is a series of separate puzzles at the physical locations.” *Id.* at 18; Ex. 2010 ¶ 141. We do not find Patent Owner’s argument persuasive on this issue because, as discussed in in the Decision on Institution, Wolfe is directed to “a location-based mobile phone application for providing a treasure hunt game consisting of puzzles solved at specific physical locations.” Dec. 15 (quoting Ex. 1004, 1:14–16). As such, in Wolfe, as well as Lamont, users are searching to find locations in a treasure hunt.

Second, Patent Owner contends Lamont has “extremely limited feedback,” and, for the determining and performing limitations, Petitioner relies on Wolfe, but the combination “results in an incomplete system with

undescribed (and therefore unknown) input capabilities.” Mot. 17. Patent Owner further argues the Petition “never addresses Lamont’s limited disclosure or how the combination would remedy Lamont’s input capabilities,” which “includes extremely limited feedback, such as just two keys or buttons.” *Id.*

We are unpersuaded by Patent Owner’s arguments. Lamont discloses a “user feedback monitor,” which “is responsible for monitoring the user feedback keys,” which “may be connected to the device using hardware wiring or Bluetooth, or another radio system.” Ex. 1003, 20:56–63. Lamont discloses the use of “current mobile phones or mobile PC client devices” as “user device 200.” *Id.* at 8:46–55. Given the expansive options for input on mobile phones and mobile PC’s, we do not find Lamont’s feedback input mechanism limited.

At this point of the proceeding, Petitioner has demonstrated a reasonable likelihood of establishing that the substitute independent claims are unpatentable as obvious under at least original ground 1, or the new ground combining original ground 1 with Lynch and/or Wehrenberg.

IPR2021-01294  
Patent 8,489,599 B2

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