

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIBRANT MEDIA, INCORPORATED,
Petitioner,

v.

GENERAL ELECTRIC COMPANY,
Patent Owner.

Case IPR2013-00170
Patent 6,581,065 B1

Before JONI Y. CHANG, JAMES B. ARPIN,
MITCHELL G. WEATHERLY, *Administrative Patent Judges.*

CHANG, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

Vibrant Media Corporation (“Vibrant Media”) filed a petition on February 27, 2013, requesting an *inter partes* review of claim 1-42 of Patent No. US 6,581,065 B1 (Ex. 1001; “the ’065 patent”). Paper 7 (“Pet.”). General Electric Company (“GE”) did not file a patent owner preliminary response. We determined that the information presented in the petition demonstrated that there was a reasonable likelihood that Vibrant Media would prevail with respect to claims 1-42. Pursuant to 35 U.S.C. § 314, we instituted this trial as to those claims. Paper 14 (“Dec.”).

After institution, GE filed a patent owner response (Paper 25, “PO Resp.”) but elected not to file a motion to amend claims. In response, Vibrant Media filed a reply to the patent owner response (Paper 31, “Reply”). Oral hearing was held on February 24, 2014.¹

We have jurisdiction under 35 U.S.C. § 6(c). This final written decision is entered pursuant to 35 U.S.C. § 318(a). We conclude that claims 1 and 22 are unpatentable under 35 U.S.C. § 102(a), and claims 1-42 are unpatentable under 35 U.S.C. §103(a).

A. *Related Proceeding*

Vibrant Media indicates that the ’065 patent is the subject of litigation titled *General Electric Co. v. Vibrant Media, Inc.*, No. 1:12-cv-00526-UNA (D. Del.). Pet. 1. Vibrant Media also filed another petition in IPR2013-

¹This proceeding and IPR2013-00172 involve the same parties and similar issues. The oral arguments for both *inter partes* reviews were merged and conducted at the same time. A transcript of the oral hearing is included in the record as Paper 55.

00172, seeking *inter partes* review of Patent No. US 6,092,074, which is the parent of the '065 patent.

B. The '065 patent

The '065 patent relates to a method and computer system for providing hypertext anchor codes and destination addresses for a user-readable text file automatically. Ex. 1001, 1:14-16. At the time of the invention, hypertext was a common method of linking related computer files or pages. *Id.* at 1:26-30. According to the '065 patent, it would be desirable to provide a system that automatically enters hypertext links into a computer file, such as a news article or other sequence of user-readable character strings. *Id.* at 3:41-44.

C. Illustrative Claim

Of the challenged claims, claims 1 and 22 are independent claims. Claims 2-21 ultimately depend from claim 1, and claims 23-42 ultimately depend from claim 22. Claim 1, reproduced below, is illustrative:

1. A computer system for providing hypertext links for a plurality of character strings including a first character string, wherein the character strings have no associated hypertext link, said computer system comprising:

an annotation database associated with a primary computer which comprises a plurality of linkable character strings;

a destination database associated with said primary computer which comprises a plurality of destination addresses;

determining means associated with said primary computer for determining a matching linkable character string for said first character string, if present, in said annotation database;

wherein said matching linkable character string is associated with at least one of said destination addresses.

Id. at 24:64–25:12.

D. Prior Art Relied Upon

Vibrant Media relies upon the following prior art references:

van Hoff	US 5,822,539	Oct. 13, 1998	(Ex. 1004)
Anthony	US 5,815,830	Sep. 29, 1998	(Ex. 1005)
Edelstein	US 5,764,906	June 9, 1998	(Ex. 1008)
Borden	US 5,495,606	Feb. 27, 1996	(Ex. 1009)
Logue	US 5,935,207	Aug. 10, 1999	(Ex. 1010)

E. Grounds of Unpatentability

We instituted the instant trial based on the following grounds of unpatentability:

Claim	Basis	References
1 and 22	§ 102(a)	van Hoff
1-11, 17-20, 22-32, and 38-41	§ 103(a)	van Hoff and Anthony
12, 13, 21, 33, 34, and 42	§ 103(a)	van Hoff, Anthony, and Borden
14-16 and 35-37	§ 103(a)	van Hoff, Anthony, and Edelstein
20 and 41	§ 103(a)	van Hoff, Anthony, and Logue

II. ANALYSIS

A. Claim Construction

Consistent with the statutory language and legislative history of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), we interpret claims using the broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *see also* Office Patent Trial Practice Guide, 77 Fed. Reg.

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48,756, 48,766 (Aug. 14, 2012). This is true even if a district court has construed the patent claims. *See* Changes to Implement *Inter Partes* Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, Final Rules, 77 Fed. Reg. 48,680, 48,697 (Aug. 14, 2012) (citing *In re NTP, Inc.*, 654 F.3d 1269, 1274 (Fed. Cir. 2011)); *see also* *SAP America, Inc. v. Versata Development Group, Inc.*, CBM2012-00001, slip op. 7-19 (PTAB June 11, 2013) (Paper 70) (discussing the history of broadest reasonable interpretation at the Office and its application to AIA proceedings).

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. Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). An inventor may rebut that presumption by providing a definition of the term in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). In the absence of such a definition, limitations are not to be read from the specification into the claims. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

In its patent owner response, GE argues that applying the broadest reasonable construction standard in the instant proceeding is improper, because GE “has neither elected to make any amendments nor reopen prosecution itself.” PO Resp. 4-5. That argument is unpersuasive.

GE had the opportunity to file a motion to amend its claims, but chose not to amend its claims. The mere fact that GE did not choose to amend its claims is not sufficient reason to justify changing the claim construction standard. Notably, Petitioner submitted in its petition its patentability

analysis and support evidence based on the broadest reasonable construction standard. We also determined whether to institute an *inter partes* review based on the broadest reasonable construction standard. Dec. 5-20.

Changing the claim construction standard now essentially would require us to start the entire proceeding over again. Such a procedure would be inefficient, causing unnecessary delays and costs, contrary to the statutory and regulatory mandates. *See* 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b) (all of the Board’s trial rules are “construed to secure the just, speedy, and inexpensive resolution of every proceeding”).

For the foregoing reasons, we are not persuaded by GE’s argument that we should deviate from the broadest reasonable construction standard.

Means-Plus-Function Limitations

In the decision on institution, we set forth the claim constructions for ten means-plus-function elements under 35 U.S.C. § 112, ¶ 6.² Dec. 9-20. Neither GE nor Vibrant Media disagrees with our claim constructions for those elements. PO Resp. 6; Reply 2-4. Our claim constructions set forth in the decision on institution for those means-plus-function elements also apply here in this decision.

Other Claim Terms

The parties proposed claim constructions for several other terms. Pet. 5-9; PO Resp. 9-11. For the purposes of this final written decision, we find it necessary to interpret expressly only the following claim terms:

² Section 4(c) of the AIA re-designated 35 U.S.C. § 112, ¶ 6, as 35 U.S.C. § 112(f). Pub. L. 112-29, 125 Stat. 284, 296-07 (2011). Because the ’065 patent has a filing date before September 16, 2012 (effective date), we will refer to the pre-AIA version of 35 U.S.C. § 112, in this decision.

“destination addresses,” “class codes,” “major class code,” and “preferred major class code.”

1. “*Destination addresses*” (claims 1 and 22)

The term “destination addresses” is recited, for example, in claim 1—“a destination database associated with said primary computer which comprises a plurality of *destination addresses*” (emphasis added). As Vibrant Media points out, the Specification of the ’065 patent defines the term “destination addresses” as “a variable that designates the location of a network resource such as a Web page; may take the form of a URL.” Pet. 5; Ex. 1001, 11:21-23. GE agrees with Vibrant Media’s claim construction. PO Resp. 7. As the definition is set forth with sufficient clarity in the Specification, we also agree with Vibrant Media’s construction, and adopt it as the broadest reasonable interpretation for the claim term “destination addresses.” *See Paulsen*, 30 F.3d at 1480.

2. “*Class codes*” (claims 4 and 25), “*major class code*” (claims 17 and 38), and “*preferred major class code*” (claims 17-19 and 38-40)

The claim term “class codes” is recited, for example, in claim 4—“wherein said annotation database further comprises a plurality of *class codes* which are associated with said plurality of linkable character strings” (emphasis added). The claim term “major class code” is recited, for example, in claim 17—“wherein at least some of said linkable character strings in said annotation database have an associated *major class code*” (emphasis added). The claim term “preferred major class code” is recited, for example, in claim 17—“qualifying means associated with said annotation database for qualifying the matching linkable character string

according to qualification criteria which requires the major class code of the matching linkable character string to match a *preferred major class code*” (emphasis added).

The parties proposed the following claim constructions:

Claim Terms	Vibrant Media’s proposed claim constructions	GE’s proposed claim constructions
Class code	Identifiers or descriptors (including descriptive metadata) or any form, each identifying or referring to (i) a particular area or type of subject or topic, and/or (ii) a category or function of an associated destination address. Pet. 5-6 (citing, <i>e.g.</i> , Ex. 1001, 13:52-57).	Codes that can designate or identify a particular context or subject area or control the number and type of a destination address. PO Resp. 7 (citing, <i>e.g.</i> , Ex. 1001, 5:11-29; 8:35-49; 13:52-57; 18:7-38).
Major class code	An identifier that references or identifies a topic area that (i) may be broader, or of less specificity, relative to some other class codes, and/or (ii) encompasses certain other class codes or types of class codes. Pet. 6-7 (citing, <i>e.g.</i> , Ex. 1001, 19:67-20:2).	Class codes that can designate or identify a particular context or subject area. PO Resp. 7 (citing, <i>e.g.</i> , Ex. 1001, 6:35-42; 8:1-6; 18:7-38; 19:49-20:22).
Preferred major class code	An identifier that represents a “major class code” that is desired or otherwise is given priority over others, for example, one having a topic area known to be relevant or related to a particular article. Pet. 7 (citing, <i>e.g.</i> , Ex. 1001, 20:14-21).	Major class code that is desired so as to bypass matching linkable character strings with other major class codes. PO Resp. 10 (citing, <i>e.g.</i> , Ex. 1001, 6:35-48; 9:40-49).

Vibrant Media disagrees with GE’s proposed claim constructions for the claim terms “class code” and “major class code.” Reply 2-4.

Nevertheless, we observe that GE's constructions for those claim terms do not present a difference from Vibrant Media's constructions that would affect the outcome of the prior art analysis. Vibrant Media agrees. *See* Reply 11; *see also* Tr. 8:23-10:14. Moreover, because GE's claim constructions for those terms appear consistent with the Specification and do not import limitations from the Specification into the claims, we adopt those constructions as the broadest reasonable interpretations. *See* Ex. 1001, 5:11-29, 6:35-42, 8:1-6, 8:35-49, 13:52-57, 18:7-38, 19:49-20:22, 20:41-52.

However, we decline to adopt GE's proposed construction for the claim term "preferred major class code"—"major class code that is desired *so as to bypass matching linkable character strings with other major class codes*" (PO Resp. 7 (emphasis added))—as it would import improperly a limitation from the Specification into the claims. *See Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004) ("Though understanding the claim language may be aided by the explanations contained in the written description, it is important not to import into a claim limitations that are not a part of the claim."). GE has not directed our attention to a special definition set forth in the Specification. Nor does GE allege that the inventors of the '065 patent acted as their own lexicographer and provided a special definition in the Specification for the claim term that is different from its recognized meaning to one with ordinary skill in the art. It is well settled that, if a feature is not necessary to give meaning to what the inventor means by a claim term, it would be "extraneous" and should not be read into the claim. *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998); *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1433 (Fed. Cir. 1988).

Accordingly, we construe the claim term “preferred major class code” as a major class code that is desired or given priority, consistent with the ordinary and customary meaning of the term as would be understood by one of ordinary skill in the art in the context of the written description of the ’065 patent. *See, e.g.*, Ex. 1001, 6:35-48, 9:40-49, 20:11-21.

B. Principles of Law

To establish anticipation, each and every element in a claim, arranged as recited in the claim, must be found in a single prior art reference. *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008); *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001). Prior art references must be “considered together with the knowledge of one of ordinary skill in the pertinent art.” *Paulsen*, 30 F.3d at 1480 (citation and internal quotation marks omitted). Moreover, “it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.” *In re Preda*, 401 F.2d 825, 826 (CCPA 1968).

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966).

In that regard, an obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR*, 550 U.S. at 418; *see also Translogic*, 504 F.3d at 1259. A prima facie case of obviousness is established when the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976). The level of ordinary skill in the art may be reflected by the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978).

We analyze the instituted grounds of unpatentability in accordance with the above-stated principles.

A. Claims 1 and 22 – Anticipated by van Hoff

Vibrant Media asserts that claims 1 and 22 are unpatentable under 35 U.S.C. § 102(a) as anticipated by van Hoff. Pet. 16-22. As support, Vibrant Media provides detailed explanations as to how each claim limitation is met by van Hoff, and directs our attention to Dr. Eric Hellman’s declaration. *Id.* (citing Ex. 1003 ¶¶ 38-40, 43-44, 46, 48-49).

In general, van Hoff describes both a system and a method for annotating automatically a received document so as to interconnect that document via hypertext links to a set of documents known to contain supplemental information. Ex. 1004, Abs., 1:8-11, 2:7-11.

Figure 1 of van Hoff, reproduced below, depicts van Hoff's distributed computer system:

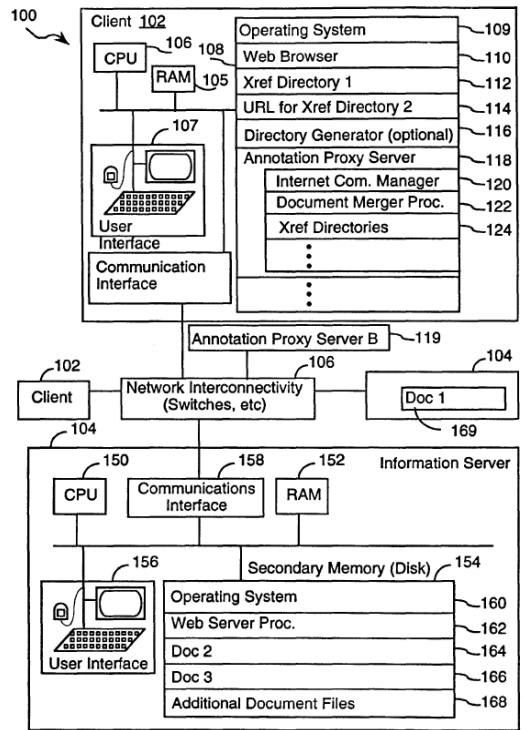


FIG. 1

As shown in Figure 1 of van Hoff, distributed computer system 100 includes many client computers 102 connected to information server computer 104 via Internet 106. Each client computer 102 includes communication interface 103, RAM 105, CPU 106, user interface 107, and memory 108. *Id.* at 4:1-21. Annotation proxy server 119 may be located on the same platform as client computer 102. *Id.* at 5:3-5.

Figure 2 of van Hoff is reproduced below with our annotations:

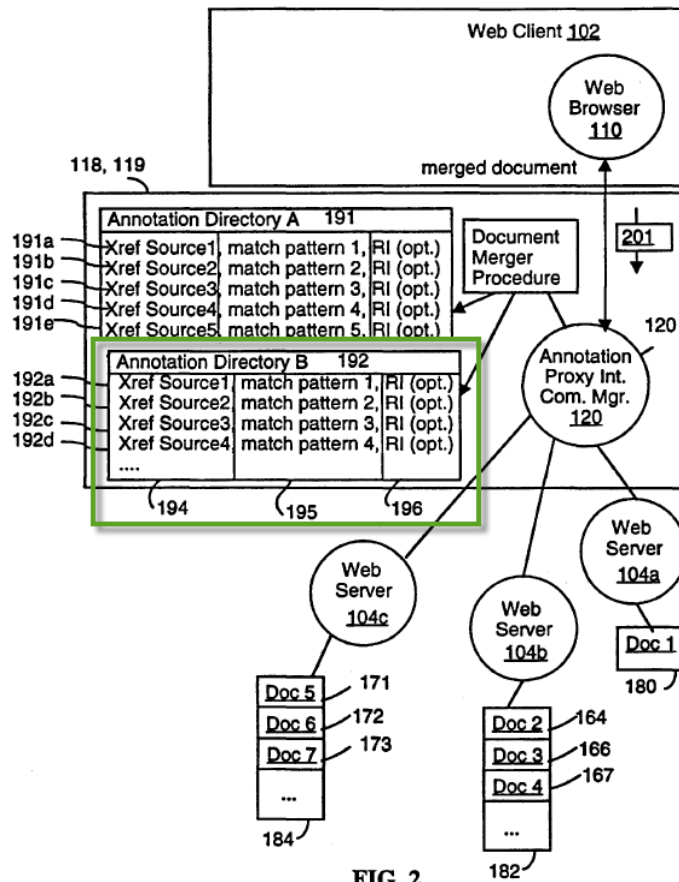


FIG. 2

As shown in Figure 2 of van Hoff, annotation proxy server 118, 119 having a plurality of annotation directories 191, 192. Each annotation directory includes a plurality of paired entries (e.g., 192a through 192d), and each entry includes: (1) cross reference document source field 194, which identifies the unique location of a cross reference document; (2) match pattern field 195, which defines a character pattern; and (3) other optional fields, such as relevance indicator field 196 to indicate the relevance or importance of associated match pattern 195 or cross-reference source 194. *Id.* at 5:27-40, 5:50-55.

If a character pattern is found in a requested document, an annotation linking the portion of the document associated with the matching pattern to

the paired cross reference source is inserted into the requested document. *Id.* at 5:41-54, 6:65-7:11. For instance, if a match pattern is the phrase “JAVA!” and the paired cross-reference source is SUN.COM.JAVAINFO, then a hyperlink annotation “<link to SUN.COM.JAVAINFO>” is added to the requested document in association with the “JAVA!” phrase pattern. *Id.* The hyperlink annotation also may be provided in a hierarchical format. *Id.* at 8:49-50. For example, when a term in the document satisfies the match pattern in the annotation directory, the link may reflect a hierarchical cross-reference list in order of increasing specificity such as “medical,” “oncology,” “melanoma,” “treatment,” and “radiation.” *Id.* In the situation in which a relevance indicator field is used, the hyperlink annotation includes a relevance index (RI) (*e.g.*, “<link to CR=URLX1, RI=2>”). *Id.* at 9:5-12 (emphasis added). The system allows the user to set a threshold during viewing to indicate which relevance indicator levels are to be displayed. *Id.* at 9:61-63.

As noted previously, GE did not file a patent owner preliminary response. At the time of instituting the instant *inter partes* review, we determined that there was a reasonable likelihood that Vibrant Media would prevail with respect to claims 1 and 22 based on the ground of unpatentability that van Hoff anticipates these claims. Dec. 20-23. In the Scheduling Order, we further provided GE a full opportunity to submit arguments for patentability as to all instituted grounds of unpatentability. Paper 15, 2-3.

In its patent owner response, however, GE does not direct us to any argument or evidence to persuade us that Vibrant Media fails to demonstrate that claims 1 and 22 are anticipated by van Hoff. Indeed, as noted by

Vibrant Media, GE did not respond “in any way to the ground that claims 1 and 22 are unpatentable under § 102 as anticipated by van Hoff.” Reply 4.

On the other hand, the explanations provided by Vibrant Media as to how each element of claims 1 and 22 is met by van Hoff have merit. Pet. 17-22. Upon consideration of Vibrant Media’s analysis and supporting evidence, we determine that Vibrant Media has demonstrated by a preponderance of the evidence that claims 1 and 22 are anticipated by van Hoff.

C. Claims 1-42 Obvious over van Hoff and Anthony, or further in view of Borden, Edelstein, or Logue

Vibrant Media asserts that claims 1-11, 17-20, 22-32, and 38-41 are unpatentable under 35 U.S.C. § 103(a) over van Hoff and Anthony. Pet. 17-26, 33-44, 47-52. Vibrant Media also asserts that claims 12, 13, 21, 33, 34, and 42 are unpatentable over van Hoff, Anthony, and Border; claims 14-16 and 35-37 are unpatentable over van Hoff, Anthony, and Edelstein; and claims 20 and 41 are unpatentable over van Hoff, Anthony, and Logue. *Id.* at 33-52. As support, Vibrant Media provides detailed explanations as to how each claim limitation is met by the aforementioned combinations of van Hoff, Anthony, Borden, Edelstein, and Logue. *Id.* Vibrant Media also proffers a declaration of Dr. Hellman. *Id.* (citing Ex. 1003).

In its patent owner response, GE counters that the combination of van Hoff and Anthony does not disclose certain claim features. PO Resp. 13-25. GE also advances several arguments under the premise that there is insufficient reason to combine the teachings of van Hoff and Anthony. *Id.* at 11-13. GE further proffers objective evidence of nonobviousness

(Exs. 2001-08, 2015-21) and directs our attention to the declaration of Dr. Ketan Mayer-Patel (Ex. 2014). *Id.* at 17-21.

We have reviewed the parties' contentions and supporting evidence, and determine that Vibrant Media has demonstrated by a preponderance of evidence that claims 1-42 are unpatentable over the aforementioned combinations of van Hoff, Anthony, Borden, Edelstein, and Logue. In our analysis below, we address GE's arguments presented in the patent owner response, focusing on the deficiencies alleged by GE with respect to the challenged claims.

A plurality of class codes

Claim 4 recites:

4. The computer system of claim 1, wherein said annotation database further comprises a plurality of class codes which are associated with said plurality of linkable character strings;

the matching linkable character string has a plurality of class codes associated therewith;

said destination database comprises a plurality of destination addresses corresponding to said plurality of class codes of the matching linkable character string;

querying means associated with said primary computer which queries said destination database to obtain the plurality of destination addresses corresponding to the associated plurality of class codes; and

means associated with said primary computer for providing a plurality of anchor codes which relate said matching linkable character string to said corresponding *plurality of destination addresses to provide a corresponding plurality of hypertext links for said first character string.*

Ex. 1001, 25:25-44 (emphases added). Claims 25 depends from claim 22 and recites similar claim features. As discussed above, van Hoff anticipates independent claims 1 and 22.

In its petition, Vibrant Media asserts that the combination of van Hoff and Anthony would have rendered the aforementioned “class codes” claim features obvious to one with ordinary skill in the art at the time of the invention. Pet. 36-40; Ex. 1003 ¶¶ 91-97. For instance, Vibrant Media asserts that the use of topic or reference names (i.e., class codes) to identify topic area was known in the art at the time of invention, as evidenced by Anthony. Pet. at 36-38 (citing Ex. 1005, 4:10-20, 4:60-65, 5:4-11, 7:53-72). As Vibrant Media explains, van Hoff discloses that a document term matching a match pattern may be hyperlinked with a hierarchical cross-reference list of document sources arranged in order of specificity over a number of topics. *Id.* at 38-39 (citing Ex. 1004, 8:49-54). Dr. Hellman testifies that van Hoff, in combination with Anthony, discloses that “these topics are associated with topic names (class codes), which are in turn associated with the matching document term and corresponding cross-reference document sources.” Ex. 1003 ¶ 100.

In general, Anthony discloses a computer system and method for generating hyperlinks automatically in a text document, to facilitate cross-referencing documents and to allow fast and easy access to relevant information. Ex. 1005, Abs, 1:6-8, 1:35-40, 2:34-43. Anthony describes a system for creating associations between links and data, referred to as “Auto_HyperlinkingTM.” *Id.* at 5:4-11. The system finds a word or phrase in a text document that matches a topic name, and then automatically hyperlinks the word or phrase to the topic. *Id.* The link is made with reference to a database that stores the topic text, reference name, the location of the information for each topic, and the navigational links for the hypertext jumps. *Id.* at 5:14-18.

In its patent owner response, GE counters that the combination of van Hoff and Anthony fails to teach or suggest the aforementioned class code claim features. PO Resp. 13-14. In particular, GE argues that one with ordinary skill in the art would not have “appreciated that a character string may be associated with *a number of topics* of different specificity, corresponding to different cross-reference source documents.” *Id.* at 15-16 (emphasis added). GE further alleges that “each linkable character string only appears once in the database and with at most one relevance indicator.” *Id.* GE also contends that the “topics” of Anthony are not class codes, but linkable character strings. *Id.* at 16.

We are not persuaded by GE’s arguments. Contrary to GE’s assertion that “[t]here is no indication that multiple links would be stored for the same term” (PO Resp. 15), van Hoff clearly discloses that an annotation for a matched term includes *a plurality of hypertext links*. Ex. 1004, 8:49-54.

Specifically, van Hoff discloses:

The annotation including hypertext links may be provided in a hierarchical format. For example, when a term in the document satisfies the match pattern in the annotation directory, the link may reflect a hierarchical cross-reference list in order of increasing specificity such as: “medical”, “oncology”, “melanoma”, “treatment”, and “radiation”.

Id. (emphases added). As Dr. Hellman testifies, the cited portion of van Hoff describes that “a single match pattern in the annotation directory can be associated with *a number of topics* of different specificity arranged in a hierarchy.” Ex. 1014 ¶ 17 (emphasis added). We credit Dr. Hellman’s testimony, as it is consistent with the express disclosure of van Hoff. *See* Ex. 1004, 8:49-54.

We also are not persuaded by GE’s argument that “each linkable character string is only associated with a *single portion* of the hierarchy.” *See* PO Resp. 15 (emphasis added). GE’s argument narrowly focuses on the term “the link” used in van Hoff’s *example* (*id.* at 18), and ignores the first sentence of the cited paragraph—“The annotation including *hypertext links* may be provided in a hierarchical format.” Ex. 1004, 8:49-50 (emphasis added). Importantly, van Hoff’s example also refers to a hierarchical cross-reference list of *topics*—in order of increasing specificity such as: “medical,” “oncology,” “melanoma,” “treatment,” and “radiation.” Ex. 1004, 8:49-54.

Further, GE’s argument that Anthony’s topic or reference names are not “class codes” is unavailing. Even under GE’s proposed claim construction which, as discussed above, we adopt as the broadest reasonable interpretation, the claim term “class code” reads on Anthony’s topic or reference names. GE specifically states that the claim term “class code” includes a code that identifies a particular *subject area*. PO Resp. 7. That construction is consistent with the Specification of the ’065 patent, which provides that *class codes* can be assigned to various *subject areas* such as business, sports, travel, books, and compact discs (e.g., # 100 = business). Ex. 1001, 13:52-57, 18:8-15.

Although the Specification of the ’065 patent provides *numerical* class codes as examples, GE’s expert, Dr. Mayer-Patel, confirms that a class code may be a *linkable character string* (e.g., “sports”). Ex. 1015, 94:12-23, 96:12-20. In fact, Dr. Mayer-Patel testifies that “[t]here’s nothing in [the ’065 patent] that prevents the major class codes from being strings instead of numerical numbers.” *Id.* at 96:6-8. Anthony specifically states that a

reference name “is a unique, meaningful *name which indicates the subject matter* of the data portion to which it refers,” and “may be a word, a phrase, or other *string indicative of the topic* of the data portion.” Ex. 1005, 4:10-20 (emphases added). Therefore, Anthony’s topic or reference names fall within the scope of the claim term “class codes.”

For the foregoing reasons, we determine that Vibrant Media has shown sufficiently that a person of ordinary skill in the art would have been found it obvious to modify van Hoff’s system in light of Anthony’s teachings of topic or reference names to arrive at the “class code” claim features.

Reasons to combine van Hoff and Anthony

In its petition, Vibrant Media further submits several rationales for modifying van Hoff’s system in light of Anthony’s disclosure to arrive at the claimed “class code” features. Pet. 33, 37-38; Ex. 1003 ¶¶ 95-97. Notably, Vibrant Media indicates that combining the use of class codes as a known technique taught by Anthony, with known elements from van Hoff, according to known database methods, yields the predictable result of achieving dynamic hyperlinking based on related topics. Pet. 37-38. By adding a plurality of class codes (*e.g.*, topic or reference names) to van Hoff’s annotation directory (*e.g.*, utilizing van Hoff’s optional fields in the annotation directory, similarly to relevance indicator field 196), in light of Anthony’s teachings, each match pattern would have a plurality of class codes associated therewith, and van Hoff’s annotation directory would have a plurality of cross-reference document sources corresponding to the plurality of class codes. Furthermore, in doing so, van Hoff’s annotation proxy server 118, 119 could obtain the plurality of cross-reference sources

corresponding to the associated plurality of class codes, and a user could qualify the match pattern according to the relevance index associated with the class code or the hierarchical cross-reference list.

Dr. Hellman also points out that the prior art would have directed one with ordinary skill in the art to make the combination of van Hoff and Anthony, as van Hoff describes the goal of linking a character string of a document with one or more documents related by subject or topic. Ex. 1003 ¶ 95 (citing Ex. 1004, 1:9-24, 1:6-2:11). Indeed, van Hoff specifically states that “[i]t is a goal of the present invention to provide a system and method for automatically annotating a received document so as to interconnect that document via **HYPertext LINKS** to a set of documents known to contain supplemental information *related to the topic* of the received document.” Ex. 1004, 2:7-11 (emphasis added).

However, GE counters that one with ordinary skill in the art would not have combined van Hoff and Anthony. PO Resp. 11-13 (citing Ex. 2014 ¶ 20). In particular, GE alleges that the topologies—the patterns of connections between the computers that are participating in the system—used in van Hoff and Anthony are quite different, and that Anthony’s system is “self-contained while van Hoff’s system is not.” *Id.* at 11. GE also contends that one would need to change the principle of operation of Anthony to combine it with van Hoff, because Anthony’s text to be annotated is stored directly in a database, whereas van Hoff’s text to be annotated is not stored in the local database, but rather a link to the text is stored. *Id.* at 12.

We are not persuaded by GE’s arguments, as they narrowly focus on small differences between van Hoff and Anthony, and fail to consider the

collective teachings of van Hoff and Anthony from the perspective of one with ordinary skill in the art. *See KSR*, 550 U.S. at 420 (“[F]amiliar items may have obvious uses beyond their primary purpose, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.”); *In re Heck*, 699 F.2d 1331, 1333 (Fed. Cir. 1983); *In re Lemelson*, 397 F.2d 1006, 1009 (CCPA 1968). More importantly, a prior art reference must be considered for everything it teaches by way of technology and is not limited to the particular invention it is describing and attempting to protect. *EWP Corp. v. Reliance Universal Inc.*, 755 F.2d 898, 907 (Fed. Cir. 1985).

As noted by Vibrant Media, there are significant consistency and overlap between the systems in van Hoff and Anthony. Pet. 17-26; Reply 5-6. For instance, van Hoff’s proxy server and annotation directory may be located on the same platform as the client or on a computer, such as a Web server 104, different from the client on which the document request was initiated. Ex. 1004, 5:3-10, figs. 1-2. Anthony describes a computer system in a network, in which “the store of data in the form of a database may be centrally located, with each network user having access to the information therein.” Ex. 1005, 3:36-48.

Further, Anthony discloses:

[T]he invention advantageously provides *links*, known as Auto_HyperlinksTM, meaning that the word or phrase in the text found to be a match with a topic name is highlighted on the display, and linked to the topic to which the topic name refers. . . . The link is made with reference to *the database which stores* the topic text, reference name and other *identifiers*. *Such identifiers note the location of the data for each topic, and provide the navigational links for the hypertext jumps.*

Ex. 1005, 5:5-18 (emphases added). Therefore, GE's arguments do not undermine Vibrant Media's rationales to combine the teachings of van Hoff and Anthony because the cited references pertain to storing hyperlinks in a database and achieving dynamic hyperlinking automatically.

GE also relies on the principle set forth in *In re Ratti*, 270 F.2d 810, 813 (CCPA 1959) to substantiate its position that "one would be changing the principle of operation of Anthony in order to combine it with van Hoff." PO Resp. 12 ("If the proposed modification or combination of the prior art would change *the principle of operation of the prior art invention being modified*, then the teachings of the references are not sufficient to render the claims prima facie obvious" (emphasis added)). That argument, however, is inapposite in the context of the particular facts in the instant proceeding. Notably, Vibrant Media proposes to modify van Hoff (the primary reference, i.e., "the prior art invention being modified"), in light of Anthony's teaching of topic or reference names (i.e., class codes—a code that identifies a particular subject area). GE does not explain sufficiently why *using class codes* in van Hoff's annotation directories would change impermissibly van Hoff's principle of operation—adding hyperlinks into documents automatically. In fact, the proposed modification would improve van Hoff's system because it would provide hyperlinks (destination addresses) dynamically based on topics that are relevant to the content in the documents. *See In re Umberger*, 407 F.2d 425, 430-31 (CCPA 1969) (finding *Ratti* inapplicable where the modified apparatus will operate "on the same principles as before").

GE also argues that "there is no evidence to support a finding that one of ordinary skill in the art would have combined van Hoff and Anthony,"

because van Hoff already provided pattern matching, and Anthony’s topics also correspond to linkable character strings. PO Resp. 12. However, that argument incorrectly assumes that Vibrant Media’s proposed combination is to solve merely the problem of inserting destination addresses in documents automatically. As noted by Vibrant Media, the combination of van Hoff and Anthony automatically would have provided destination addresses that are also *relevant to the content in the documents*. Reply 7-8; Pet. 38.

For the foregoing reasons, we agree with Vibrant Media that one with ordinary skill in the art at the time of the invention would have recognized that a combination of Anthony’s topic or reference names (class codes) with van Hoff’s association of a character string to multiple topics and source documents is no more than a combination of familiar elements that would yield “predictable results of achieving dynamic hyperlinking and making those hyperlinks relevant” (Reply 7). Put simply, such a combination is a predictable use of prior art elements according to their established functions—an obvious improvement. *KSR*, 550 U.S. at 417.

Major class code

Claim 17 recites:

The computer system of claim 1, wherein at least some of said linkable character strings in said annotation database have an associated *major class code*, further comprising:

qualifying means associated with said annotation database for qualifying the matching linkable character string according to qualification criteria which requires the major class code of the matching linkable character string to match a *preferred major class code*.

Ex. 1001, 26:64-27:6 (emphases added). Claim 38 depends from claim 22 and recites similar features. *Id.* at 29:29-30:4.

In its petition, Vibrant Media asserts that van Hoff, in combination with Anthony, describes “an associated *major class code*” because van Hoff discloses “[t]he annotation including hypertext links” and “the link may reflect a hierarchical cross-reference list in order of increasing specificity such as: ‘*medical*’” Pet. 47-48 (citing Ex. 1004, 8:49-54 (emphasis added)). Vibrant Media further maintains that van Hoff, in combination with Anthony, discloses “the use of relevance indicators for indicating the closeness or relevance of match patterns to a topic area, and a merger procedure for qualifying a match pattern as having a relevance indicator that meets a relevance threshold of a broad topic area (preferred major class code).” *Id.* (citing Ex. 1004, 8:39-40 (“Hypertext links may also contain a hierarchy of relevance indicators based on predetermined relevance rules.”); *id.* at 10:65-11:16 (“[T]he document merger procedure 122 looks for partial matches . . . that meets a threshold match requirement . . . only annotations with an assigned relevance value equal to or higher than the relevance threshold . . . are added to user requested documents.”)).

In response, GE counters that the combination of references does not teach a “major class code” and a “preferred major class code” because *the relevance indicator of van Hoff is not a major class code*. PO Resp. 22-24 (citing Ex. 2014 ¶ 37). In particular, GE alleges that “Dr. Hellman is using the terminology of ‘major’ and ‘broad’ to improperly connote a hierarchy where ‘major class code’ does not connote a hierarchy as ‘major class codes’ can be used without minor class codes and are therefore not defined by any relationship to minor class codes.” *Id.* (citing Ex. 1001, 19:49-50).

Although we agree with GE that a major class code does not connote a hierarchy and can be used without minor class codes, we nonetheless

observe that neither the claim term “major class code,” nor other claim language, precludes an annotation including hypertext links provided in a *hierarchical format*. As discussed above, we have adopted GE’s proposed construction as the broadest reasonable interpretation for the claim term “major class codes”—“class codes that can designate or identify a particular context or *subject area*” (PO Resp. 10 (emphasis added)). The topic “*medical*” as disclosed in van Hoff is a *subject area*, and, therefore, meets the definition of the claim term “major class code.”

In addition, we agree with Vibrant Media that “van Hoff’s relevance threshold can be a user-defined relevance value, set as a high relevance threshold for instance which would be the ‘preferred major class code,’” and “van Hoff’s merger procedure applies this relevance threshold to qualify a corresponding topic’s relevance value for a matching character string.” Reply 13; Pet. 39-40 (citing Ex. 1004, 8:39-40, 10:65-11:16). Indeed, van Hoff describes that, when the user specifies a relevance threshold to the merger procedure, only annotations with an assigned relevance value equal to or higher than the relevance threshold are added to user requested documents. Ex. 1004, 11:10-16.

For the foregoing reasons, we determine that Vibrant Media demonstrates sufficiently that van Hoff, in combination with Anthony, describes the “major class code” features, as recited in claims 17 and 38.

Objective evidence of nonobviousness

Factual inquiries for an obviousness determination include secondary considerations based on evaluation and crediting of objective evidence of nonobviousness. *Graham*, 383 U.S. at 17. Notwithstanding what the teachings of the prior art would have suggested to one with ordinary skill in

the art at the time of the '065 patent's invention, the totality of the evidence submitted, including objective evidence of nonobviousness, may lead to a conclusion that the claimed invention would not have been obvious to one with ordinary skill in the art. *In re Piasecki*, 745 F.2d 1468, 1471-1472 (Fed. Cir. 1984). Secondary considerations may include any of the following: long-felt but unsolved needs, failure of others, unexpected results, commercial success, copying, licensing, and praise.

Here, GE takes the position that the commercial success of Vibrant Media's products shows that the subject matter of GE's claims would not have been obvious over the combination of van Hoff and Anthony. PO Resp. 17. As support, GE proffers seven of Vibrant Media's press releases (Exs. 2001-2008), as well as the declaration of Dr. Mayer-Patel (Ex. 2014 ¶¶ 28-34) and other evidence (Exs. 2015-2019). PO Resp. 19-23.

In its reply, Vibrant Media responds that GE has not shown that Vibrant Media's system is commercially successful. Reply 12-13. Vibrant Media also alleges that GE has not shown a nexus between the purported commercial success and Vibrant Media's system allegedly practicing the claims of the '065 patent. *Id.* at 13-14.

We agree with Vibrant Media. GE's supporting evidence does not add sufficiently to the record to warrant a conclusion of nonobviousness, because the evidence before us does not demonstrate adequately that Vibrant Media's system was commercially successful.

To be of relevance, evidence of nonobviousness must be commensurate in scope with the claimed invention. *In re Kao*, 639 F.3d 1057, 1068 (Fed. Cir. 2011) (citing *In re Tiffin*, 448 F.2d 791, 792 (CCPA 1971)); *In re Hiniker*, 150 F.3d 1362, 1369 (Fed. Cir. 1998). In that regard,

in order to be accorded substantial weight, there must be a nexus between the merits of the claimed invention and the evidence of secondary considerations. *GPAC*, 57 F.3d at 1580. “Nexus” is a legally and factually sufficient connection between the objective evidence and the claimed invention, such that the objective evidence should be considered in determining nonobviousness. *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988). The burden of showing that there is a nexus lies with the patent owner. *Id.*; *Paulsen*, 30 F.3d at 1482.

To substantiate its position that Vibrant Media’s system was commercially successful, GE directs our attention to several of Vibrant Media’s press releases. PO Resp. 17-19 (Exs. 2001-2008). According to GE, Vibrant Media’s press releases show that: (1) Vibrant Media has “over 6,600 premium publishers and more than 300 million unique users per month by 2013” (*id.* at 18 (citing Ex. 2006)); (2) “69% [of the 500 women surveyed] report[ed] being more likely to pay attention to ads relevant to what they are reading” (*id.* (citing Ex. 2002)); and (3) “online video ad spending is projected to reach \$ 7.1 billion by 2015 up from \$ 2.2 billion spent in 2011” (*id.* at 18-19 (citing Ex. 2003)).

However, that evidence does not establish sufficiently that the alleged sales number constitutes commercial success when considered in relation to overall market share. In particular, it is unclear the numbers of publishers and users are “sales numbers” or revenue amounts. GE does not provide the fee amounts that Vibrant Media charges the publishers and users. More importantly, there is no indication that the alleged numbers of publishers and users represent a substantial quantity in the overall market share. Accordingly, GE’s objective evidence is accorded little weight. *See Cable*

Elec. Prods., Inc. v. Genmark, Inc., 770 F.2d 1015, 1026-27 (Fed. Cir. 1985) (finding that sales of 5 million units represent a minimal showing of commercial success because “without further economic evidence . . . it would be improper to infer that the reported sales represent a substantial share of any definable market”); *see also In re Baxter Travenol Labs*, 952 F.2d 388, 392 (Fed. Cir. 1991) (“Information solely on numbers of units sold is insufficient to establish commercial success.”).

After weighing the evidence of obviousness and nonobviousness of record, on balance, we conclude that the strong evidence of obviousness outweighs the weak evidence of nonobviousness.

Conclusion

For the foregoing reasons, we determine that Vibrant Media has demonstrated by a preponderance of evidence that claims 1-11, 17-20, 22-32, and 38-41 are unpatentable under 35 U.S.C. § 103(a) over van Hoff and Anthony; claims 12, 13, 21, 33, 34, and 42 are unpatentable over van Hoff, Anthony, and Border; claims 14-16 and 35-37 are unpatentable over van Hoff, Anthony, and Edelstein; and claims 20 and 41 are unpatentable over van Hoff, Anthony, and Logue.

D. Vibrant Media’s Motion to Exclude

Vibrant Media seeks to exclude GE’s objective evidence of nonobviousness (Exs. 2001-08, 2015-21, 2023-34, 2013 ¶¶ 30-34, 2036 ¶¶ 6-8). Paper 36 (“Pet. Mot.”). GE opposes Vibrant Media’s motion to exclude. Paper 45. In response, Vibrant Media filed a reply to GE’s opposition to its motion to exclude. Paper 48.

On this record, it is not necessary for us to assess the merits of Vibrant Media’s motion to exclude. GE filed press releases, HTML codes,

screenshots, and Dr. Mayer-Patel's testimony (Exs. 2001-08, 2015-21, 2023-34, 2013 ¶¶ 30-34, 2036 ¶¶ 6-8) as evidence of nonobviousness to rebut Vibrant Media's assertion that claims 1-42 would have been obvious over the various combinations of van Hoff, Anthony, Borden, Edelstein, and Logue. PO Resp. 17-21. As discussed above, even without excluding GE's supporting evidence, we have determined that Vibrant Media has demonstrated by a preponderance of the evidence that claims 1-42 are unpatentable over the combinations of cited prior art.

Accordingly, Vibrant Media's motion to exclude evidence is *dismissed* as moot.

E. GE's Motion to Exclude

GE seeks to exclude numerous portions of Dr. Hellman's rebuttal declaration (Ex. 1014). Paper 40 ("PO Mot."). Vibrant Media opposes GE's motion to exclude. Paper 43 ("Opp."). In response, GE filed a reply to Vibrant Media's opposition to its motion to exclude. Paper 49 ("PO Reply").

As the movant, GE has the burden of proof to establish that it is entitled to the requested relief. *See* 37 C.F.R. § 42.20(c). For the reasons stated below, GE's motion to exclude is *denied*.

1. Rebuttal Declaration

In its motion to exclude evidence, GE essentially argues that Dr. Hellman's rebuttal declaration is improper rebuttal evidence which should have been presented with the petition. PO Mot. 1-4. GE further argues that Dr. Hellman's rebuttal declaration should be excluded under

Federal Rules of Evidence 403 and 602³ because GE's expert did not have an opportunity to address the new testimony. PO Mot. 4. Vibrant Media counters that Dr. Hellman's rebuttal declaration should not be excluded, arguing that his testimony merely elaborates on his earlier opinions and responds to GE's arguments. Opp. 1-9.

Having considered the parties' contentions and evidence, we are not persuaded that Dr. Hellman's rebuttal declaration should be excluded. At the outset, GE's motion contains improper arguments. PO Mot. 1-4. Notably, GE argues that "[p]ortions of paragraphs 4, 10, 13, 14, 15, 18, 20, 26, 28 and 30 [of Dr. Hellman's rebuttal declaration] are untimely . . . as they belatedly present opinions which were required to be disclosed in Petitioner's original petition." *Id.* A motion to exclude is not a mechanism to argue that a reply contains new arguments or relies on evidence necessary to make out a prima facie case. A motion to exclude, for instance, must state why the evidence is inadmissible (e.g., based on relevance or hearsay), identify the corresponding objection in the record, and explain the objection. *See* 37 C.F.R. § 42.64(c); Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,767. Whether a reply contains arguments or evidence that are outside the scope of a proper reply under 37 C.F.R. § 42.23(b) is left to our determination. Therefore, GE's argument that Dr. Hellman's rebuttal declaration filed in support of Vibrant Media's reply is untimely is improper.

In any event, the mere fact that the rebuttal declaration includes evidence that was not discussed specifically in the petition is insufficient to establish the impropriety of such evidence, much less inadmissibility under

³ As stated in 37 C.F.R. § 42.62, the Federal Rules of Evidence generally apply to an *inter partes* review.

the Federal Rules of Evidence. The very nature of a reply is to respond to the opposition, which in this case is the patent owner response. *See* 37 C.F.R. § 42.23(b). The need for relying on evidence not previously discussed in the petition may not exist until a certain point has been raised in the patent owner response. Much depends on the specific arguments made in the patent owner response. As the movant, GE has the burden of proof to establish that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). Here, GE's motion does not contain any meaningful discussion of the arguments that GE has made in its patent owner response, which reasonably might or might not have triggered Vibrant Media's reliance on the testimony GE now seeks to exclude. Without such discussion, GE has not shown that Dr. Hellman's rebuttal declaration exceeds the proper scope of reply evidence.

In addition, GE does not articulate a persuasive reason why we should exclude paragraph 4 of Dr. Hellman's rebuttal declaration (PO Mot. 2). Dr. Hellman's rebuttal testimony simply addresses GE's argument presented in the patent owner response (PO Resp. 4) that Dr. Hellman's initial declaration does not use the "preponderance of the evidence" standard. Moreover, we do not agree with GE that 35 U.S.C. § 316(e) requires an expert declaration to recite or apply the "preponderance of the evidence" standard expressly in order for the expert testimony to be accorded weight. Rather, it is within our discretion to assign the appropriate weight to be accorded to evidence based on whether the expert testimony discloses the underlying facts or data on which the opinion is based. *See* 37 C.F.R. § 42.64(a).

To support its view that we should exclude paragraphs 18 and 20 of Dr. Hellman’s rebuttal declaration, GE argues that “what could have been implemented” or “how things ‘can be configure[d]’ that are not actually disclosed in the references” are irrelevant to the proceeding. PO Mot. 4. We do not find that argument persuasive. Dr. Hellman’s testimony (Ex. 1014 ¶¶ 18, 20) was submitted appropriately to respond to GE’s arguments presented in its patent owner response— “[o]ne of ordinary skill in the art, in fact, would not have ‘appreciated that a character string may match.’” (PO Resp. 15-16). Dr. Hellman’s testimony provides examples to show that a one-to-many relationship was well known to a person of skill in the art, and explains what van Hoff actually discloses and what a person of skill in the art at the time of the invention would have understood in light of van Hoff’s teachings. Ex. 1014 ¶¶ 18, 20. Dr. Hellman’s testimony merely confirms the level of ordinary skill in the art—an issue that was raised by GE in its patent owner response (PO Resp. 15-16).

For the foregoing reasons, we decline to exclude paragraphs 4, 10, 13, 14, 15, 18, 20, 26, 28, and 30 of Dr. Hellman’s rebuttal declaration.

2. Whether Dr. Hellman is Qualified as an Expert

GE asserts that paragraph 13 of Dr. Hellman’s rebuttal declaration should be excluded under Federal Rules of Evidence 701 and 702 because Dr. Hellman is not qualified as an “advertising expert” to provide testimony regarding advertisement—“it is of course a common market demand that an advertisement be placed in a *relevant* location.” (Ex. 1014 ¶ 13 (emphasis added)). PO Mot. 4-5. In response, Vibrant Media counters that Dr. Hellman merely “illustrates a well-known problem by noting the common knowledge that advertisers have always sought to place advertisement in

relevant location, whether that is the location of a physical billboard or a destination address.” *Id.* at 9-10.

Upon consideration of the parties’ contentions and evidence on the record before us, we disagree with GE that an expert could not resort to common sense or common knowledge of one with ordinary skill in the art. According to Dr. Hellman’s curriculum vitae, he earned a Bachelor of Arts in Electrical Engineering and Computer Science, and a Master of Science in Electrical Engineering, as well as a Doctor of Philosophy in Electrical Engineering. Ex. 1003 ¶ 7. Furthermore, Dr. Hellman has 17 years of experience in the electronic publishing and library technology industries, including research and development that involved hyperlinked technology. *Id.* ¶ 5. As noted by Vibrant Media, Dr. Hellman simply provides an example to illustrate that “one problem to be solved was providing destination addresses that are relevant to the content of the article” and a person with ordinary skill in the art would have understood that problem. Opp. 9-10. On this record, we determine that Dr. Hellman is qualified to provide an opinion that “it is of course a common market demand that an advertisement be placed in a relevant location.” Ex. 1014 ¶ 13.

For the foregoing reasons, we decline to exclude Dr. Hellman’s testimony regarding placing advertisement in a relevant location.

3. Expert’s Choice of Words

GE argues that paragraphs 12, 13, 16, 20, and 22 of Dr. Hellman’s rebuttal declaration should be excluded because his testimony includes certain wordings—“within the grasp of one of ordinary skill in the art,” “being deterred,” and being “not excluded”—that are not applicable legal standards under 35 U.S.C. § 103(a). PO Mot. 5. Vibrant Media counters

that expert testimony should not be excluded for using words that are not used in 35 U.S.C. § 103(a). Opp. 11-12.

We agree with Vibrant Media. An expert may express his or her opinion using words that are not used expressly in the statute. Here, Dr. Hellman's testimony, concerning whether a person of ordinary skill in the art would have combined the cited prior art references, and what such artisan would have appreciated in light of the prior art teachings, was submitted appropriately in response to GE's arguments presented in the patent owner response (PO Resp. 11-13). Dr. Hellman's choice of words for formulating his opinion on the level of ordinary skill in the art is an issue directed to sufficiency of evidence to prove a particular fact and not an issue of admissibility.

A motion to exclude is not the proper vehicle to challenge the sufficiency of evidence to prove a particular fact. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,767. Rather, it is within our discretion to assign the appropriate weight to be accorded to evidence. *See, e.g., Yorkey v. Diab*, 601 F.3d 1279, 1284 (Fed. Cir. 2010) (holding the Board has discretion to give more weight to one item of evidence over another “unless no reasonable trier of fact could have done so”); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1368 (Fed. Cir. 2004) (“[T]he Board is entitled to weigh the declarations and conclude that the lack of factual corroboration warrants discounting the opinions expressed in the declarations.”); and *Velandar v. Garner*, 348 F.3d 1359, 1371 (Fed. Cir. 2003) (“In giving more weight to prior publications than to subsequent conclusory statements by experts, the Board acted well within [its] discretion.”).

For the foregoing reasons, we decline to exclude paragraphs 12, 13, 16, 20, and 22 of Dr. Hellman's declaration.

4. Legal Opinions

GE argues that paragraphs 5, 6, and 7 of Dr. Hellman's rebuttal declaration should be excluded under Federal Rules of Evidence 701 and 702, because Dr. Hellman provides legal opinions. PO Mot. 5-6.

That argument is not persuasive. We recognize that expert testimony on the ultimate "legal conclusion of obviousness is neither necessary nor controlling." *Avia Grp. Int'l, Inc. v. L.A. Gear Cal., Inc.*, 853 F.2d 1557, 1564 (Fed. Cir. 1988). Nevertheless, it is within our discretion to assign the appropriate weight to be accorded to evidence. *See, e.g., Donnelly Garment Co. v. NLRB*, 123 F.2d 215, 224 (8th Cir. 1942) ("One who is capable of ruling accurately upon the admissibility of evidence is equally capable of sifting it accurately after it has been received . . ."). We are capable of taking into account the support for and the reliability and persuasiveness of a witness's testimony on a particular issue, if any, when weighing all of the testimony of the witness.

For the foregoing reasons, we decline to exclude any portion of Dr. Hellman's rebuttal declaration.

III. CONCLUSION

Vibrant Media has met its burden of proof by a preponderance of the evidence in showing that claims 1-42 the '065 patent are unpatentable based on the following grounds of unpatentability:

Claim	Basis	References
1 and 22	§ 102(a)	van Hoff
1-11, 17-20, 22-32, and 38-41	§ 103(a)	van Hoff and Anthony
12, 13, 21, 33, 34, and 42	§ 103(a)	van Hoff, Anthony, and Borden
14-16 and 35-37	§ 103(a)	van Hoff, Anthony, and Edelstein
20 and 41	§ 103(a)	van Hoff, Anthony, and Logue

IV. ORDER

In consideration of the foregoing, it is
ORDERED that claims 1-42 of the '065 patent are held unpatentable;
FURTHER ORDERED that Vibrant Media's motion to exclude
evidence is *dismissed*;

FURTHER ORDERED that GE's motion to exclude evidence is
denied; and

FURTHER ORDERED that, because this is a final written decision,
parties to the proceeding seeking judicial review of the decision must
comply with the notice and service requirements of 37 C.F.R. § 90.2.

Case IPR2013-00170
Patent 6,581,065 B1

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