

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CHEGG INC., MATCH GROUP, LLC, AND RPX CORPORATION,  
Petitioner,

v.

NETSOC, LLC,  
Patent Owner.

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IPR2019-01165  
Patent 9,978,107 B2

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Before KALYAN K. DESHPANDE, SHEILA F. McSHANE, and  
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

McSHANE, *Administrative Patent Judge*.

DECISION  
Granting Institution of *Inter Partes* Review  
*35 U.S.C. § 314(a)*

## I. INTRODUCTION

### *A. Background*

Chegg, Inc., Match Group, LLC, and RPX Corporation (collectively, “Petitioner”)<sup>1</sup> filed a Petition requesting *inter partes* review of claims 1–11 (“the challenged claims”) of U.S. Patent No. 9,978,107 B2 (Ex. 1001, “the ’107 patent”) pursuant to 35 U.S.C. §§ 311–319, along with the supporting Declaration of Benjamin Goldberg, Ph.D. Paper 4 (“Pet.”); Ex. 1004. NETSOC, LLC (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 12 (“Prelim. Resp.”).

We have authority under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” We determine that Petitioner has demonstrated that there is a reasonable likelihood that it would prevail in showing the unpatentability of at least one of the challenged claims. For the reasons set forth below, and pursuant to 35 U.S.C. § 314, we institute an *inter partes* review of claims 1–11 of the ’107 patent.

### *B. Related Proceedings*

The parties identify these proceedings involving the ’107 patent: *NetSoc, LLC v. Match Group, Inc.*, 2:18-cv-00217 (E.D. Tex.); *NetSoc, LLC v. Match Group, LLC et al.*, 3:18-cv-01809 (N.D. Tex.); *NetSoc, LLC v. Chegg Inc.*, 1:18-cv-10262 (S.D.N.Y.); *NetSoc, LLC v. LinkedIn Corp.*,

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<sup>1</sup> Petitioner identifies IAC/InterActiveCorp, Humor Rainbow, Inc., PlentyOfFish Media, ULC, and Match Group, Inc. as other real parties-in-interest. Pet. 1.

1:18-cv-12215 (S.D.N.Y.); *NetSoc, LLC v. Quora, Inc.*, 1:18-cv-12250 (S.D.N.Y.); and *NetSoc, LLC v. Yahoo! Inc.*, 1:18-cv-12267 (S.D.N.Y.). Pet. 1–3; Paper 7, 2. The parties indicate that *NetSoc, LLC v. Teladoc Health, Inc.*, 2:18-cv-00542 (E.D. Tex.) involves U.S. Patent No. 7,565,344 (“the ’344 Patent”), which is related to the ’107 patent. Pet. 2; Paper 7, 2.

The parties also indicate that another *inter partes* review Petition was filed by Petitioner in IPR2019-01171, also challenging the claims of the ’107 patent (“the -01171 case”). Pet. 1; Paper 7, 3. We authorized Petitioner to file a Notice in each proceeding to (1) identify the ranking of the Petitions in the order in which it wishes the Board to consider the merits, and (2) identify the difference between the Petitions, why the differences are material, and why the we should consider the additional Petition. Paper 10. We also authorized Patent Owner to file a response. *Id.* Accordingly, Petitioner filed a Notice regarding the ranking of multiple petitions (Paper 11), and Patent Owner filed a Response (Paper 13).

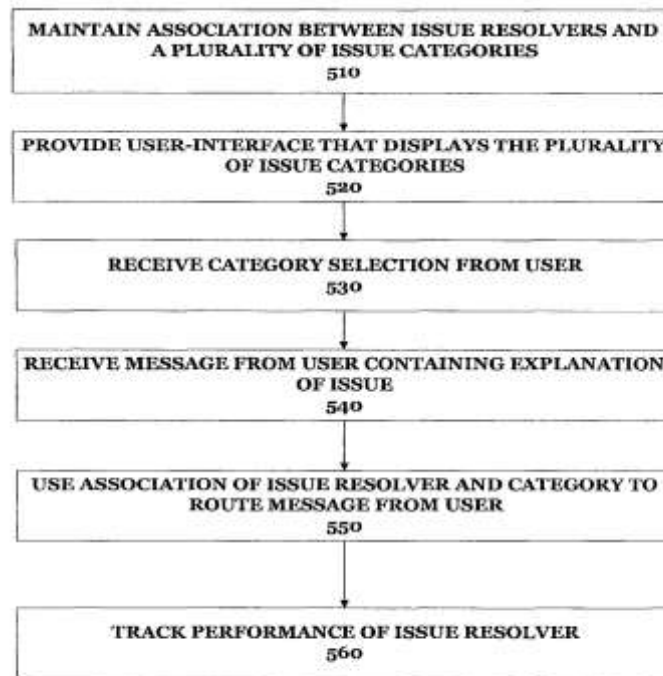
### *C. The ’107 Patent*

The ’107 patent is entitled “Method and System for Establishing and Using a Social Network to Facilitate People in Life Issues” and issued on May 22, 2018 from an application filed on December 18, 2015. Ex. 1001, code (22), (45), (54). The ’107 patent claims priority as a continuation or continuation-in-part of several applications, and claims priority to provisional application No. 60/499,543, filed on September 3, 2003. *Id.*, codes (60), (63).

The ’107 patent is directed to “applications and implementations of a social network to facilitate individuals to resolve various life issues.” Ex. 1001, code (57). Under its embodiments, a social network may be

established and used to assist individuals with issues to be resolved at a particular geographic location, including maintaining a list of participants who can assist in resolving issues at that location. *Id.* at 2:17–23. Users may submit inquiries to the service, and the service may select which participants are best suited to respond to inquiries. *Id.* at 3:39–41.

Figure 5A, reproduced below, presents a method of implementation for issue resolution. Ex. 1001, 9:13–17.



**FIG. 5A**

As shown in Figure 5A, above, an association is formed between issue resolvers and categories (step 510); a user-interface is displayed with the categories (step 520); a user selects a category (step 530); a message is received from the user containing an explanation of the issue that falls within the category (step 540); the user's message is routed to a participant by the service that may use a database to determine the association between

the category and assigned participant (step 550); and the performance of the particular issue resolver is tracked (step 560). Ex. 1001, 9:21–59. As part of step 550, the user may submit an email, but the recipient of the email is not known to the user. *Id.* at 9:55–57.

Challenged claims 1 and 6 of the '107 patent are independent. Claim 1, an illustrative independent claim of the '107 patent, is reproduced below, with sub-paragraphing added to the limitations for reference purposes.

1. A method for establishing a social network, the method being implemented on a network computer system and comprising:

[a] maintaining a list comprising a plurality of participants, wherein each participant in the plurality of participants corresponds to one or more individuals, wherein the list also includes information associated with at least one of each participant or the one or more individuals that correspond to each participant;

[b] presenting a user with an interface from which the user makes a selection of a category from a plurality of categories;

[c] in response to receiving the selection of the category by the user, displaying, for the user, some of the information associated with each of multiple participants from the plurality of participants which match the selection of the category by the user, while shielding contact information associated with each of the multiple participants;

[d] wherein displaying some of the information associated with each of the multiple participants is based at least in part on a rating of individual participants in the plurality of participants;

[e] enabling the user to send an inquiry message to one or more of the multiple participants, while shielding the contact information from the user, the contact information including any messaging identifier that is associated with each of the one or more participants;

[f] tracking a response time of each of the one or more participants who received the message from the user; and

[g] updating the rating associated with each of the one or more participants based at least in part on the tracked response time.

Ex. 1001, 17:15–48.

*D. Asserted Grounds of Unpatentability*

Petitioner challenges the patentability of claims 1–11 of the '107 patent on the following grounds:

<b>Claims Challenged</b>	<b>35 U.S.C. §</b>	<b>References</b>
1–3, 5–8, 10, 11	103(a)	Beaudoin <sup>2</sup> , Shubov <sup>3</sup>
4, 9	103(a)	Beaudoin, Shubov, Herz <sup>4</sup>

Pet. 5.

II. ANALYSIS

*A. § 314(a) and § 325(d) Issues*

*1. Discretionary Denial Under 35 U.S.C. § 314(a)*

Patent Owner argues that the Board should exercise its discretion under 35 U.S.C. § 314(a) and deny institution under *General Plastic* because: (a) two petitions have been filed and institution of both is inefficient and unfair; and (b) proceeding with *inter partes* review of this Petition would be inefficient in view of the status of the district court proceedings. Prelim. Resp. 2–10 (citing *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 9–10 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i) (“*General Plastic*”); Paper 13, 1–4. The arguments that Patent Owner raises under *General Plastic* are solely directed to efficiency factors, that is, the Board’s ability to meet statutory deadlines

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<sup>2</sup> US 7,096,193 B1, issued August 22, 2006, claiming priority to Provisional Application No. 60/135,522, filed on May 21, 1999. Ex. 1005.

<sup>3</sup> US Pub. No. 2002/0038233 A1, published March 28, 2002. Ex. 1006.

<sup>4</sup> US Pub. No. 2004/0019579 A1, published January 29, 2004. Ex. 1007.

and the speedy resolution of proceedings (factors 6 and 7). *General Plastic* at 9–10. Our decision focuses on only factors 6 and 7 because factors 1–5 apply only to “follow-on” or serial petitions and no other *General Plastic* factors are raised or argued by Patent Owner. *See General Plastic* at 15.

*a. Multiple Petitions*

Petitioner filed two Petitions requesting *inter partes* review of claims 1–11 of the ’107 patent in the instant proceeding and in the -01171 proceeding on the same day, June 6, 2019. In its Notice, Petitioner requested that the Board consider the -01171 Petition first in order to the instant Petition. Paper 11, 2. The following table summarizes the unpatentability grounds asserted against the ’107 patent in the two respective proceedings:

<b>Claims Challenged</b>	<b>IPR2019-01165</b>	<b>IPR2019-01171</b>
1–3, 5–8, 10, 11	Beaudoin, Shubov	Collins, Walker
4, 9	Beaudoin, Shubov, Herz	Collins, Walker, Herz
3, 8		Collins, Walker, Abrams

Patent Owner asserts that, under the circumstances, the institution of two proceedings would be inefficient and unfair to Patent Owner. Prelim. Resp. 4–10; Paper 13, 1–14. Patent Owner refers to the July 2019 Trial Practice Guide Update, and its discussion on instituting multiple parallel petitions in view of efficiency and fairness considerations. Prelim. Resp. 5–6 (citing Trial Practice Guide Update (July 2019), available at <https://www.uspto.gov/sites/default/files/documents/trial-practice-guide-update3.pdf> (“TPGU”), at 26).

Petitioner argues that institution of *inter partes* review on both Petitions is justified because (1) a material difference between the two Petitions is the application of the art based on the meaning and scope of the claim limitations; (2) Patent Owner may antedate multiple references in the -01171 proceeding; and (3) Petitioner has presented only two Petitions on behalf of three petitioners representing seven real parties-in-interest in the district court proceeding, which allows for an efficient administration of the proceedings. Paper 11, 1–5.

First, Petitioner argues that the Petitions are materially different in the application of the prior art based on the meaning of the “shielding contact information” limitation, “updating the rating” limitation, and “displaying an image” limitation. Paper 11, 2–4. Petitioner argues that the “petitions combine different references in different ways to arrive at the claimed limitations.” *Id.* at 2.

Second, Petitioner asserts that two petitions are justified here because Patent Owner would be able to antedate references, i.e., Collins and Abrams, in the -01171 proceeding, whereas in the instant proceeding swearing behind the prior art references would be impractical. Paper 11, 5; *see* Ex. 1001, 1:8–34, code (60); Abrams, US 2005/0021750 A1, code (22), published Jan. 27, 2005 (IPR2019-01171, Ex. 1008); Collins, US 2005/0038688 A1, code (22), published Feb. 17, 2005 (IPR2019-01171, Ex. 1010). Petitioner explains that the ’107 patent claims priority to a provisional application filed September 3, 2003, and Collins has a filing date less than three weeks earlier, i.e., August 15, 2003. *See id.*

Third, Petitioner contends that Patent Owner “filed suit against eight defendants . . . alleging infringement of the ’107 Patent and/or related family



member patents.” Paper 11, 1; *see* Paper 7, 2. Petitioner indicates that “to streamline the proceedings and utilize the Board’s resources in a more efficient manner, three petitioners” representing seven real parties-in-interest “joined efforts and filed two petitions” instead of “each party individually filing separate petitions.” Paper 11, 1. Petitioner asserts that if this “joint approach was not taken, it could lead to the undesirable effect of encouraging defendants to file separate petitions” and taking diverging positions based on each defendant’s litigation strategy, and thus could “adversely impact the Board’s goal for efficiency.” *Id.* at 1–2.

We are persuaded by Petitioner to decline to exercise our discretion under 35 U.S.C. § 314(a) to deny this Petition. Although we are not persuaded by Petitioner’s argument that the Petitions are materially different because the “petitions combine different references in different ways to arrive at the claimed limitations,” we are persuaded by Petitioner that Patent Owner may antedate multiple prior art references asserted in the -01171 proceeding, and Petitioner’s submission of only two Petitions on behalf of seven defendants of the district court proceedings leads to efficient administration of the proceedings. The Trial Practice Guideline Update indicates that circumstances such as disputed priority dates should be considered in determining whether more than one petition may be warranted. TPGU at 26. In the -01171 case, the primary prior art asserted, i.e., Collins, has a priority date of August 15, 2003, which is very close to the September 3, 2003 date of the ’107 patent’s provisional application. Although we suggested in our Order that “Patent Owner may seek to avoid additional Petitions by proffering a stipulation that certain claim limitations or priority dates are not disputed” (Paper 10, 4 n.4; *see* TPGU at 28), Patent Owner

declined to offer any stipulations to seek to avoid additional Petitions, including stipulating that Collins and Abrams qualify as prior art (Paper 13, 4). Absent a stipulation by Patent Owner that Collins and Abrams qualify as prior art, we are persuaded by Petitioner that Patent Owner's ability to present evidence and argue that Collins and Abrams do not qualify as prior art is a material difference between the Petitions.

We are also persuaded by Petitioner's argument that the filing of two Petitions on behalf of several parties leads to efficient administration of the proceedings. *See General Plastic* at 9–10 (Factors 6 and 7). Petitioner filed two Petitions on behalf of three parties (Chegg, Inc., Match Group, LLC, and RPX Corporation), representing four other real parties-in-interest (IAC/InterActiveCorp, Humor Rainbow, Inc., PlentyOfFish Media, ULC, and Match Group, Inc.), which includes defendants in the related district court proceeding. Paper 11, 1. As such, Petitioner potentially consolidated the filing of several petitions. Accordingly, we are persuaded that Petitioner filing of two Petitions on behalf of a group of multiple real parties-in-interest weighs in favor of exercising our discretion to institute both Petitions under efficiency considerations in *General Plastic*.

Accordingly, based on the record before us, we are persuaded that consideration of both Petitions is warranted.

*b. Potential Inefficiencies in View of District Court Proceedings*

Patent Owner argues that we should exercise our discretion to deny institution of these proceedings because *inter partes* review would be inefficient in view of the status of related district court proceedings. Prelim. Resp. 3–10. On July 22, 2019, a district court granted a Motion to Dismiss, finding that claims 1–11 of the '107 patent fail to satisfy 35 U.S.C. § 101

because they encompass patent-ineligible subject matter, and entered final judgment. Ex. 1010; Ex. 1011, 2–5. On August 19, 2019, Patent Owner filed a motion requesting that the district court alter or amend the judgment “on the grounds of (1) manifest error in law and (2) manifest error in fact.” *Id.* On October 23, 2019, the district court denied the motion. Ex. 3002. On November 18, 2019, Patent Owner appealed the judgment to the Federal Circuit. Ex. 3003.

Patent Owner asserts that under *NHK* the Board should exercise its discretion to deny both of Petitioner’s petitions because instituting an *inter partes* review “would be an inefficient allocation of resources” and not “an effective and efficient alternative to district court litigation.” Prelim. Resp. 6–7, 9–10 (citing *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 19–20 (PTAB Sept. 12, 2018) (precedential) (Decision Denying Institution) (“*NHK*”)). In particular, Patent Owner argues that “[t]he District Court litigation has already occurred with an adjudication of the claims of the present patent being directed to ineligible subject matter.” *Id.* at 9. Patent Owner also argues that “[t]he advanced state of the district court proceeding (more advanced than in *NHK*) weighs in favor of” petition denial under § 314(a). *Id.*

We are not persuaded by Patent Owner’s arguments. In *NHK*, the Board exercised its discretion under § 314(a) to deny the petition, considering the “status of the district court proceeding between the parties” in light of the AIA’s objective “to provide an effective and efficient alternative to district court litigation.” *Id.* at 12, 19–20 (quoting *Gen. Plastic*, at 16–17). Here, there is no overlap between the issues presented in the Petitions. The issue before the district court was patent subject matter

eligibility under § 101, whereas the issues presented by the Petitions are unpatentability based on obviousness. Unlike *NHK*, there is nothing in the record indicating that issues addressed by the district court overlap with issues in these proceedings. Patent Owner does not argue or identify anything in the record that indicates that the district court has considered any issues other than § 101 ineligibility, which is not (and cannot be) at issue in these proceedings. *See* Prelim. Resp. 6–10. In addition, Patent Owner does not represent that Petitioner relies on the same prior art and arguments to establish unpatentability before the Board and invalidity in the district court. *Id.*

Moreover, unlike *NHK*, we are not persuaded that the advanced stage of the district court proceeding weighs in favor of exercising our discretion to deny institution of *inter partes* review. We recognize that although the district court has entered final judgment, Patent Owner has sought appellate review. Patent Owner notes that the proceedings here could be terminated by the grant of a joint motion with invalidation of all challenged claims and if no appellate review has been sought or those reviews have been exhausted. Prelim. Resp. 10. However, Patent Owner states that “[a]t this point, the parties have not agreed to do as such” and Patent Owner has sought appellate review. *Id.*; Ex. 3003. Thus, at this time, we decline to speculate as to when the parallel proceedings will conclude. We note, however, that the parties should keep the Board apprised of the status of the appellate review. Depending on the circumstances, if the judgment of the district court is affirmed in a final, non-appealable judgment, this proceeding may be terminated.

Accordingly, based on the record before us, in view of the lack of overlap of issues and the posture of the district court litigation, we are not persuaded that any potential inefficiencies favor the exercise of our discretion to deny institution. Additionally, in considering the merits on the record before us, for the reasons expressed below, we find Petitioner's proposed grounds to be sufficiently strong to also weigh in favor of not exercising our discretion to deny institution based on § 314(a). *See* TPGU at 31.

*2. Discretionary Denial Under 35 U.S.C. § 325(d)*

Patent Owner contends that institution should be denied under 35 U.S.C. § 325(d). Prelim. Resp. 17–38; *see Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to § III.C.5) (“*Becton*”).

Section 325(d) states that “[i]n determining whether to institute . . . the Director may take into account whether . . . the same or substantially the same prior art or arguments previously were presented to the Office.” In evaluating whether to exercise our discretion under Section 325(d), we consider the non-exclusive *Becton* factors, such as:

- (1) the similarities and material differences between the asserted art and the prior art involved during examination;
- (2) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (3) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (4) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;

(5) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and

(6) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

*See Becton* at 17–18 (formatting added).

Our institution of *inter partes* review is discretionary. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“the PTO is permitted, but never compelled, to institute an IPR proceeding”). In view of the record in this case, we determine that the factors weigh against exercising our discretion under § 325(d) to deny institution of *inter partes* review.

During the prosecution of the ’107 patent, the original application included only independent claim 1, and the Examiner rejected independent claim 1 under § 103(a) in the initial Office action as obvious over Beacher, Goedken, and Lunt. Ex. 3001, 123–26, 180–211; *see also* Exs. 2001, 2002. In response, the applicant amended claim 1,<sup>5</sup> and added dependent claims 2–

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<sup>5</sup> The applicant amended claim 1 by deleting some limitations and adding other limitations, i.e., “displaying some of the information associated with each of the multiple participants is based at least in part on a rating of individual participants in the plurality of participants”; “wherein displaying some of the information associated with each of the multiple participants is based at least in part on a rating of individual participants in the plurality of participants”; “enabling the user to send an inquiry message to one or more of the multiple participants, while shielding the contact information from the user, the contact information including any messaging identifier that is associated with each of the one or more participants”; “tracking a response time of each of the one or more participants who received the message from the user”; and updating the rating associated with each of the one or more participants based at least in part on the tracked response time.” Ex. 3001, 105–106.

11. *Id.* at 105–109. In the next Office action, the Examiner allowed the claims. *Id.* at 79–80; *see id.* at 35–36. The Examiner listed Work (Ex. 2003) in a notice of references cited, and did not otherwise refer to the reference. *See id.* at 34–37, 61, 75–81, 119–28.

Patent Owner argues that *Becton*'s second factor weighs in favor of denying the Petition because asserted prior art in the Petition (Beaudoin, Shubov, and Herz) is cumulative to the prior art (Beacher, Lunt, and Work) considered during prosecution of the '107 patent. Prelim. Resp. 17–38.

We are not persuaded by Patent Owner. With respect to the second *Becton* factor, although Patent Owner alleges that Beaudoin, Shubov, and Herz are cumulative to some of the prior art considered during prosecution of the '107 patent asserted here, Patent Owner fails to provide sufficient evidence and arguments explaining why Beaudoin, Shubov, and Herz are cumulative to Beacher, Lunt, and Work. *See* Prelim. Resp. 17–38; Ex. 2004. Instead, Patent Owner provides multiple string cites for the respective references, with no identification or explanation of the cumulative nature of the prior art. *See id.* Absent specific arguments from Patent Owner identifying that the asserted prior art is cumulative to that considered during examination, we are not persuaded to exercise our discretion under 35 U.S.C. § 325(d) to deny institution of *inter partes* review.

Moreover, we do not agree that the prior art is cumulative. Work is listed under the references cited, but Patent Owner does not present any evidence that Work was considered any further by the Examiner. Furthermore, we are not persuaded that similar isolated teachings between asserted references and those cited during examination render the asserted references cumulative for the claims at issue. Additionally, we discern no

relevant teachings in *Work*, or the other references in the prosecution history, that are cumulative to *Beaudoin* or the combination of *Beaudoin* and *Shubov* for the teachings of limitations [f] and [g] of claim 1. *See infra* Section II.E.3; Ex. 2003 ¶¶ 175, 176–181, 189, 193, Figs. 8, 9; Ex. 2004, 3.

Patent Owner does not present any arguments towards factors 1 and 3–6 of *Becton*. Accordingly, we are not persuaded that the remaining factors of *Becton* favor denial of the Petition.

Thus, the *Becton* factors do not weigh in favor of exercising our discretion. Accordingly, we decline to exercise our discretion to deny institution under § 325(d).

### *C. Level of Ordinary Skill in the Art*

Petitioner asserts that a person of ordinary skill in the art would have a “Bachelor of Science degree in computer science or a similar technical field together with 2 years of educational practicum or work experience in the field of software development (including programming for client-server systems, databases and networks), or related areas.” Pet. 8. In support, Dr. Goldberg testifies that a person of skill would be familiar with the technologies, such as user interfaces, databases, networks, etc., “underlying existing social networks, including participant matching systems,” and would have understood how to implement such systems. Ex. 1004 ¶ 11.

Patent Owner contends that a person of ordinary skill in the art would have a bachelor’s degree in computer science, or highly related field, and at least four years’ experience in computer networking, especially in social networking systems. Prelim. Resp. 12. Alternatively, Patent Owner asserts that eight years of experience in social networking systems would be sufficient qualifications, if an individual lacked a bachelor’s degree. *Id.* at



12–13. Patent Owner cites no evidence in support of its proposed qualifications. *Id.*

Based on the current record and for purposes of institution, we adopt Petitioner’s proposed skill level for the purposes of this decision because it is commensurate with the relevant technology and claims of the ’107 patent, as well as that of the asserted prior art.<sup>6</sup>

#### *D. Claim Construction*

The Petition for *inter partes* review was filed after November 13, 2018, and, accordingly, the Board interprets claim terms in accordance with the standard used in federal district court in a civil action involving the validity or infringement of a patent. *See* Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340 (Oct. 11, 2018) (codified at 37 C.F.R. § 42.100(b) (2019)). Under the principles set forth by our reviewing court, the “words of a claim ‘are generally given their ordinary and customary meaning,’” as would be understood by a person of ordinary skill in the art in question at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)). “In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc.*

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<sup>6</sup> If Patent Owner argues a different level of ordinary skill in the art in its Response, the parties are encouraged to address whether there are any material differences between the two proposals and what impact, if any, the different level has on the obviousness analysis.

*v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1015, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17).

*“contact information”*

As discussed below, *infra*, at Section II.E.3, the interpretation of the term “contact information” used in independent claims 1 and 6 of the ’107 patent is at issue in the disputes between the parties concerning the alleged teachings of the prior art.

The parties do not present a proposed construction of the term “contact information.” Independent claims 1 and 6 recite that “the contact information includ[es] any messaging identifier that is associated with one of more participants.” Ex. 1001, 17:38–42, 18:28–32. The ’107 patent specification states that in an embodiment of the invention that a service handling a request from a user may be forwarded to the identified participant (Ex. 1001, 8:55–57), where

In such an embodiment, an email address or other contact information may be shielded from the user. In one variation, it is also possible to shield the identity of the participant, or the end person who will be communicating with the user.

*Id.* at 8:57–61. That is, “contact information,” such as an email address, is differentiated from a participant’s identity.

The ’107 patent specification also refers to biographies that may be stored under an embodiment of the invention, where the biographies include “email addresses (or [instant messaging] IM tags or other contact information) to enable the individuals behind the biographies to meet each other.” Ex. 1001, 15:25–28. Additionally, in a user interface, the biography page includes “Contact Information” that includes “What is the best way for someone . . . to contact . . .?” and “They can email me directly at . . . .” *Id.*

at 6:57–58, Fig. 6D. These specification portions further support that contact information is identified as messaging identifiers, such as an email address.

Thus, the intrinsic record indicates that the type of information included as “contact information” is that which allows a user to directly contact a participant. For the purposes of this decision, we construe the term “contact information” to include “information, such as an email address, mailing address, or telephone number, that permits one entity to communicate directly with another entity.”

#### *Other Claim Terms*

We determine that it is not necessary to provide an express interpretation of any other term of the claims at this juncture. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017); *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (“[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.”).

#### *E. Alleged Obviousness of Claims 1–3, 5–8, 10, and 11 over Beaudoin and Shubov*

Petitioner contends that claims 1–3, 5–8, 10, and 11 are rendered obvious by Beaudoin and Shubov. Pet. 14–61. To support its contentions, Petitioner provides explanations as to how Beaudoin and Shubov teach each claim limitation. *Id.* Petitioner also relies upon the Goldberg Declaration (Ex. 1004) to support its positions. Patent Owner alleges that the combination of Beaudoin and Shubov fails to teach some of the limitations

of the claims and the rationale to combine the references is insufficient.  
Prelim. Resp. 38–71.

We begin our discussion with a brief summary of Beaudoin and Shubov and then address the evidence and arguments presented.

*1. Beaudoin (Ex. 1005)*

Beaudoin is directed to a method and system for matching consumers with service providers. Ex. 1005, 1:44–45. Beaudoin discloses an information environment to facilitate efficient identification of pre-qualified, appropriate service providers with consumers, to support more efficient communications, and to all comparison shopping. *Id.* at 4:45–53, 5:1–10.

Beaudoin’s system provides a database for service providers based on information, such as name, address and years in operation, service types, geographic region and communication mechanisms, provided by the service providers, that is part of the Customer-driven Service Request (CRS) process. Ex. 1005, 5:27–30, 5:45–49, 10:24–28. In the CRS process, a user may select a category of services or the system may provide a path to identify the problem/issue to lead the user to an appropriate category. *Id.* at 8:32–38. A commerce facilitator platform brings together consumers and service providers by matching consumer needs to service providers’ capabilities. *Id.* at 9:5–10. Figure 7A, reproduced below, illustrates consumer interactions with the commerce facilitator platform. *Id.* at 2:38–40.

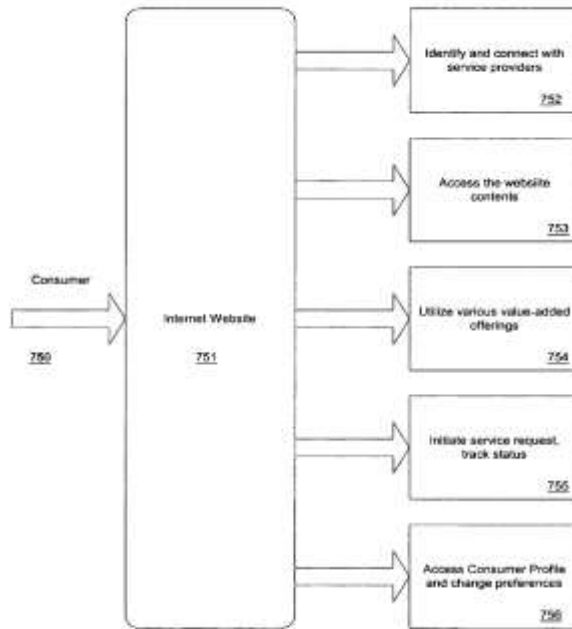


Figure 7a

As shown in Figure 7A, above, consumer 750 can access a website associated with commerce facilitator platform 751 to: (1) identify and connect with service providers to fulfill their local service needs 752; (2) access content relevant to these needs 753; (3) utilize various value-added offerings related to their fundamental local service needs 754; (4) track the status of these requests after initiation of a service request 755; and (5) access their consumer profile and change preferences 756. Ex. 1005, 9:17–26.

## 2. *Shubov* (Exs. 1006, 1009)

*Shubov* is directed to a system for matching consumers with professional service providers. Ex. 1006 ¶ 8. In *Shubov*, consumers can access a matching system, browse listings of service providers, and view more detailed information by clicking on buttons, and can also request bids

for services from service providers by posting a case. *Id.* ¶ 9. Screens are provided that allow a consumer to describe service needs and geographic location. *Id.* ¶ 10. The matching system posts the case and transmits case information to service providers, where the matching system only transmits consumer information to service providers in the same area of practice and geographic location by cross referencing the consumers' case information with the service provider database for the service provided and geographic location fields. *Id.* ¶¶ 10, 11.

A service provider has its own home page where submitted cases can be reviewed and the service provider can respond if interested in pursuing the case, with responses transmitted back to the consumer. Ex. 1006 ¶ 12. A consumer may review the service provider responses and obtain additional information including information on the service provider, such as rating information based on ratings and assessments from consumers. *Id.* ¶ 13.

Shubov claims priority to Provisional Application No. 60/210,857, filed June 9, 2000, and incorporates it by reference. Ex. 1006 ¶ 1; Ex. 1009.

### 3. Analysis

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 ordinary skill in the art; and (4) objective evidence of nonobviousness.<sup>7</sup> *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

*a. Independent Claim 1*

*i. Preamble and Limitations [a], [b]*

Petitioner asserts that Beaudoin teaches a method for establishing a social network implemented on a network computer system, as recited in the preamble of claim 1. Pet. 26. Petitioner relies upon Beaudoin’s disclosure of a method to match consumers and service providers that is consistent with the ’107 patent disclosures for a social network. *Id.* (citing Ex. 1005, 1:44–45; Ex. 1001, 2:4–6, 14:16–20, 15:30–31). For the disclosure of the implementation on a network computer system, Petitioner refers to Beaudoin’s disclosure of the use of an internet-based platform and network computer system. *Id.* (citing Ex. 1005, 2:23–28, 3:38–4:39, Figs. 1, 2).

Petitioner contends that Beaudoin teaches limitation [a] by its disclosure of the maintenance of a list of service providers, which includes information on the service providers including, for instance, individual service professionals. Pet. 27–28 (citing, e.g., Ex. 1004 ¶ 124; Ex. 1005, 10:63–65, 11:11–14, 11:21–23, 25:2, 41:2, 53:2, 95:2).

Petitioner asserts that Beaudoin teaches limitation [b] by its disclosure of a user interface that presents a listing of service categories, which a user can select from. Pet. 28–30 (citing, e.g., Ex. 1005, 8:42–43, 8:32–37, 25:2, 27:2).

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<sup>7</sup> Patent Owner presents no objective indicia in the Preliminary Response. *See generally* Prelim. Resp.

We find that Petitioner provides sufficient evidence that the prior art teaches the preamble, limitation [a], and limitation [b] of claim 1.<sup>8</sup> Patent Owner makes no arguments contesting the prior art teachings of these claim elements. *See generally* Prelim. Resp.

On this record, we are persuaded that Petitioner has provided sufficient evidence that the combination of Beaudoin and Shubov teaches the preamble and limitations [a] and [b] of claim 1.

*ii. Limitation [c]*

Petitioner contends that limitation [c] of claim 1 is taught by the combination of Beaudoin and Shubov, where Beaudoin discloses a system that matches service providers for selected categories in response to consumer's selections. Pet. 31 (citing, e.g., Ex. 1005, 9:5–10). Petitioner asserts that once a CRS, that is, a Consumer-driven Service Request, is completed, the matching process of Beaudoin uses information from service providers' profiles and consumer's category selection to identify a group of eligible service providers for the CSR. *Id.* (citing Ex. 1005, 8:20–54, 10:51–57, 10:63–11:10, Fig. 8). Petitioner contends the information associated with the matched multiple service providers is then displayed to the consumer. *Id.* at 32 (citing, e.g., Ex. 1005, 4:45–53, 9:5–15, 11:21–23, 14:50–60, 15:61–65, Fig. 8 (block 812), Fig. 11 (blocks 1107–1108)).

Petitioner acknowledges that Beaudoin does not explicitly disclose “shielding contact information associated with each of the multiple participants” of limitation 1[c]. Pet. 32. Petitioner asserts that Shubov

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<sup>8</sup> We make no determination in this Decision whether the preamble of claim 1 is limiting.



teaches contact information of a service provider can be shielded from a consumer. Pet. 32 (citing Ex. 1006 ¶¶ 4, 16–19, 39). Petitioner contends that in Shubov consumers and service providers can “communicate anonymously within the matching system,” and the displays of information in Shubov do not include identity or contact information. *Id.* at 33–34 (citing Ex. 1006 ¶¶ 16, 39; Ex. 1009, 246, 364). Petitioner further asserts that one of ordinary skill in the art would have found it obvious to modify Beaudoin to provide a feature of for a number of reasons, including to maintain anonymity, and/or prevent out-of-band communications. *Id.* (citing Ex. 1004 ¶¶ 25–29, 128–130). Dr. Goldberg testifies that the rationale for a skilled artisan to want to shield this information would be preservation of privacy and also that preventing a consumer from directly contacting a service provider by withholding contact information would prevent bypassing and allow an intermediary to benefit from a transaction. Ex. 1004 ¶¶ 27, 29.

On this record, we are persuaded that Petitioner has provided sufficient evidence that the combination of Beaudoin and Shubov teach limitation 1[c] and a sufficient rationale to combine the references has been provided.

Patent Owner argues that Beaudoin fails to teach the “display . . . some of the information associated with each of multiple participants which match the selection of the category by the user” because in Beaudoin’s system a service provider indicates whether it wants its information to be shared by accepting and submitting a response. Prelim. Resp. 42–43. Patent Owner argues that presenting only a compiled list of only those service

providers who submit responses is different than the claimed limitation. *See id.*

On this record, Patent Owner is arguing that the intervening process steps for service providers who match a category prior to display preclude Beaudoin’s teaching of the claim limitation. We disagree with this argument because it is based upon limitations that do not appear in the claim. We are not persuaded by Patent Owner on this record that the claim is limited to a display of every multiple participant that matches the selection of a category. The parties may fully develop this issue during trial.

Patent Owner also alleges that Shubov does not teach the claim limitation “. . . shielding contact information associated with each of the multiple participants” of limitation 1[c]. Prelim. Resp. 50–52. Patent Owner argues that Shubov discloses a page with an “Attorney ID” that links to an “Attorney Profile” page, which provides attorney information. *See id.*

Although Shubov allows access to some information, such as attorney identity, we are not persuaded, on this record, that Shubov allows access to “contact information.” *See* Prelim Resp. 50–51 (citing Ex. 1009, 41, 102, 246, 364). As discussed above, we construe “contact information” to include “information, such as an email address, mailing address, or telephone number, that permits one entity to directly communicate with another entity.” *See* Section II.D. We are not persuaded, as discussed above, that the identity of a contact is the same as “contact information” because mere identity information does not provide “information . . . that permits one entity to directly communicate with another entity.”

Patent Owner also alleges that Beaudoin and Shubov are “teaching away” references that should not be considered. Prelim. Resp. 43–49, 52–

53. Patent Owner argues that Beaudoin discloses contact information for service providers is provided to users, and, additionally, user information is provided to service providers. *Id.* at 44–45. Patent Owner also asserts that in Shubov service provider contact information is provided to users. *Id.* at 46–49, 52–53.

As discussed above, Petitioner asserts that there is sufficient rationale to combine Beaudoin and Shubov in view of Dr. Goldberg’s supporting testimony stating that one of ordinary skill would want to shield service provider contact information to preserve privacy and prevent a consumer from directly contacting a service provider. We are not persuaded, on this record, that Beaudoin and Shubov’s teachings of instances where service provider contact information is disclosed to users is a teaching away. A reference does not teach away “if it merely expresses a general preference for an alternative invention but does not ‘criticize, discredit, or otherwise discourage’ investigation into the invention claimed.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1327 (Fed. Cir. 2009) (quoting *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004)). Although some of Shubov’s embodiments disclose that contact information is provided to users, Shubov also discloses that in some embodiments participant contact information is not provided or, in other words, is shielded from users. And we discern no teachings in either Shubov or Beaudoin discouraging shielding participant contact information. Additionally, Dr. Goldberg provides supporting testimony why one of skill in the art would be motivated to combine Shubov’s teaching of shielding participant contact information with Beaudoin’s teachings, which stands unrebutted.

Accordingly, we are not persuaded by Patent Owner's arguments on this issue.

*iii. Limitation [d]*

Petitioner asserts that Beaudoin teaches a rating and review process/quality seal that allows consumers to rate service providers, which is updated in real-time and displayed to consumers. Pet. 35. Petitioner further contends that the display of service providers' information may be based at least in part on their rating, such as by consumer sorting based on ratings. *Id.* (citing Ex. 1005, 16:13–16). Petitioner also refers to Beaudoin's disclosure that "the rating information may also serve as a component for the Matching Process 1106 by combining the individual scores, potentially with a weighting scheme, to create a composite score," so the results of a matching search are based in part on rating information. *Id.* at 35–36 (citing Ex. 1004 ¶ 134; Ex. 1005, 17:5–9, Fig. 11 (block 1112)).

On this record, we are persuaded that Petitioner has provided sufficient evidence that Beaudoin teaches limitation 1[d].

Patent Owner alleges that Beaudoin does not teach this claim limitation because it presents a listing of service providers to consumers who have accepted the consumer's job or task and does not disclose the rating for the service providers with that listing. Prelim. Resp. 53–55. Patent Owner alleges that Beaudoin merely discloses that a user or consumer can provide rating information. *Id.* at 55.

We are not persuaded by Patent Owner's arguments because they appear to be based on limitations not in the claim; as recited, the claim limitation requires that there be a display of some information based on a rating of participants, but the display does not have to include the rating

itself. Further, we find Beaudoin sufficiently discloses that its matching may include consideration of ratings, with subsequent display of information for the matched participants. *See* Ex. 1005, 17:5–9.

*iv. Limitation [e]*

Petitioner asserts that Beaudoin or the combination of Beaudoin and Shubov teaches limitation [e] by Beaudoin’s disclosure of consumer communications to service professionals, with contact information of the service professionals shielded from the consumer. Pet. 36–37. Petitioner refers to a messaging window of Beaudoin where the name and company of service professional is identified, but with no messaging identifier, such as an email address, provided. *Id.* at 37–38 (citing Ex. 1005, 95:2). Petitioner also contends that the combination of Beaudoin and Shubov teaches shielding this information, for reasons similar to those provided for limitation [c]. *Id.* at 38–41.

On this record, we are persuaded that Petitioner has provided sufficient evidence that the combination of Beaudoin and Shubov teaches limitation 1[e].

Patent Owner argues that Petitioner fails to provide sufficient evidence that Beaudoin and Shubov teach limitation 1[e] and the references teach away. Prelim. Resp. 55–61. Patent Owner presents similar arguments to those presented for limitation 1[c] (*compare* Prelim. Resp. 43–53, *with id.* at 55–61), which we do not find persuasive at this juncture for the reasons discussed above.

*v. Limitation [f]*

Petitioner asserts that Beaudoin teaches limitation 1[f] by its disclosure of “Process Tracking/Update” regarding service provider status

information and consumer request status. Pet. 41 (citing Ex. 1005, 6:9–13, 8:14–18, 9:17–18, Fig. 7a (block 755), 9:36–41, Fig. 7b (block 765), 13:33–36). Petitioner contends that provider’s response time to consumer’s message impacts the priority of specific service providers over others. *Id.* (citing Ex. 1005, 11:11–17). Petitioner also asserts that Beaudoin’s claims 4 and 11 recitals support the teaching of the limitation. *Id.* at 41–42 (citing, e.g., claim 4, Ex. 1005, 109:25–27 (“selecting home service providers from the second list based upon past response times of each respective home service provider”)).

On this record, we are persuaded that Petitioner has provided sufficient evidence that Beaudoin teaches limitation 1[f].

Patent Owner argues that Beaudoin does not teach tracking response time of the participants because the portions of Beaudoin that are relied upon merely disclose: (1) status information on consumer-specific CSRs; (2) encouragement for service providers to quickly reply; and (3) claim 4 relates only to a new list of service providers selected from a second list of service providers, formed after selection of the task, based on past responses or reply times. Prelim. Resp. 61–62.

We are not persuaded by Patent Owner’s arguments because they appear to be based on limitations not in the claim; as recited, the claim limitation requires that the response time of the participant is tracked. Further, we find Beaudoin sufficiently teaches tracking response times of participants as demonstrated in its disclosures of service provider status information. Moreover, Dr. Goldberg’s testimony on this issue stands un rebutted and states that, to the extent that Beaudoin only teaches tracking of service providers’ response times to initial consumer requests, it would

have been obvious to a person of ordinary skill in the art to track service providers' response times to subsequent consumer messages because the system encourages quick replies. Ex. 1004 ¶ 140.

*vi. Limitation [g]*

Petitioner contends that the combination of Beaudoin and Shubov teaches limitation [g] by Beaudoin's teachings of service quality ratings and prioritizing service providers based on tracked response times, with updating of ratings in real-time, and one of skill in the art would understand that a ratings update would include basing it on response time. Pet. 42–43 (citing Ex. 1004 ¶ 141). Petitioner additionally asserts that one of ordinary skill in the art would have had knowledge that response times commonly impact ratings, as reflected in the teachings of Shubov, with its update of service providers' ratings based at least on a tracked response time. *Id.* at 43–44 (citing Ex. 1004 ¶ 142; Ex. 1006 ¶¶ 154–156; Ex. 1009, 360). Petitioner argues that a person of skill would have applied Shubov's teachings to Beaudoin because doing so would have improved search results for a user to ensure access to quality service providers. *Id.* at 44–45. Petitioner further contends that this modification utilizes known features to function in the same manner and would yield predictable results. *Id.* at 45.

On this record, we are persuaded that Petitioner has provided sufficient evidence that the combination of Beaudoin and Shubov teaches limitation 1[g].

Patent Owner argues that Beaudoin does not teach the ratings nor tracking response times for participants. Prelim. Resp. 63. Patent Owner also argues that Shubov merely discloses that a computer can rate the performance of a participant on criteria including “respond[ing] in a timely

manner,” but does not disclose the claimed limitation, that is, “tracking a response-time and updating the rating of the attorneys or service providers based on the tracked response time.” *Id.* at 64–65.

At this juncture, we are not persuaded by Patent Owner’s arguments. In particular, Petitioner’s contention that Shubov’s disclosure of user ratings based at least on response times supports a motivation to modify Beaudoin and also supports the teaching of updating ratings based on tracked response times under the combination of Beaudoin and Shubov. *See* Pet. 43–45 (citing Ex. 1009, 360). Additionally, Dr. Goldberg provides supporting testimony why one of skill in the art would be motivated to combine Shubov’s teachings on response times with Beaudoin’s teachings, which stands un rebutted. Ex. 1004 ¶ 142. Accordingly, we are not persuaded by Patent Owner’s arguments on this issue.

*vii. Conclusion*

On this record, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing on its assertion that claim 1 would have been obvious over the combination of Beaudoin and Shubov.

*b. Independent Claim 6*

Independent claim 6 recites a computer system that includes a memory and a processor to maintain a list of participants, and steps that perform functions paralleling the steps of independent claim 1. *See* Ex. 1001, 18:5–38.

Petitioner contends that Beaudoin teaches the use of a memory and processors that may be programmed to perform steps. Pet. 55–57. Petitioner also asserts that the combination of Beaudoin and Shubov teach



the remainder of the limitations for claim 6 for similar reasons to those presented for claim 1. *Id.* at 57–59.

We are persuaded that Petitioner has provided sufficient evidence that the combination of Beaudoin and Shubov teaches the limitations of claim 6. Patent Owner presents no additional arguments relating to claim 6 besides those presented for claim 1, which we fail to find persuasive for the reasons discussed above.

On this record, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing on its assertion that claim 6 would have been obvious over the combination of Beaudoin and Shubov.

*c. Claims 2 and 7*

Claim 2 depends from claim 1 and additionally recites that “receiving the selection of the category from the plurality of categories includes receiving input that identifies a geographic location.” Ex. 1001, 17:49–51. Claim 7 recites a similar limitation. *Id.* at 18:39–42.

We have reviewed the evidence presented in the Petition and are persuaded that Petitioner has provided sufficient evidence that the combination of Beaudoin and Shubov teaches the limitations of claims 2 and 7. For instance, Petitioner contends that Shubov discloses a matching system that accounts for geographic locations. Pet. 46–47. Shubov discloses that in its matching system a consumer is presented with a display of questions that allow a consumer to describe service needs and geographic location (Ex. 1006 ¶ 10), and transmission of this information “to service providers in the same area of practice and same geographic location by cross referencing the consumer’s case information with the service provided and geographic location fields of the service provider database” (*id.* ¶ 11).

Petitioner asserts that a person of skill in the art would have applied Shubov's receiving input to similar teachings of Beaudoin with its selection of a category to provide improved search results. Pet. 47 (citing Dr. Goldberg's testimony on the same (Ex. 1004 ¶ 144)).

Patent Owner argues that Beaudoin does not disclose selection of the category that includes receiving input identifying a geographic location. Prelim. Resp. 66–68. Patent Owner also argues that Shubov describes presenting a series of questions, but not the claimed receipt of the selection of a category. *Id.* at 68–69.

At this juncture, we do not find Patent Owner's arguments to be persuasive because they disregard that Petitioner's contentions are based on a combination of Beaudoin and Shubov. Further, Patent Owner's arguments appear to be based on a bodily incorporation of Shubov into Beaudoin; however, "[t]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference . . . Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). Here, as Petitioner asserts, Beaudoin teaches the selection of a category, and Dr. Goldberg testifies that the inclusion of Shubov's input on geographic location would improve search results. *See* Ex. 1004 ¶ 144.

On this record, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing on its assertion that claims 2 and 7 would have been obvious over the combination of Beaudoin and Shubov.

*d. Claims 3 and 8*

Claim 3 depends from claim 1 and additionally recites that “displaying some of the information associated with each of multiple participants includes displaying an image that is included in the information associated with each of the multiple participants.” Ex. 1001, 17:53–55. Claim 8 recites a similar limitation. *Id.* at 18:43–47.

Petitioner contends that both Beaudoin and Shubov teach the display of information for multiple participants that includes an image. Pet. 48–51, 60.

We have reviewed the evidence presented in the Petition and are persuaded that Petitioner has provided sufficient evidence that the combination of Beaudoin and Shubov teaches the limitations of claims 3 and 8. For instance, Petitioner contends that Beaudoin discloses that in its display of information associated with the multiple providers, it provides an image such as a banner. Pet. 48–49.

Patent Owner argues that information as claimed is not available in the disclosures of Beaudoin and Shubov that Petitioner relies upon. Prelim. Resp. 69–71. We are not persuaded by Patent Owner’s argument because information on the participants, including an image, appears to part of the display that Petitioner relies upon in Beaudoin. *See* Ex. 1005, 89:2, 91:2, 99:2.

On this record, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing on its assertion that claims 3 and 8 would have been obvious over the combination of Beaudoin and Shubov.

*e. Claims 5 and 10*

Claim 5 depends from claim 1 and additionally recites that “displaying some of the information associated with each of the multiple participants includes displaying information associated with individual participants who match the category selection and have a higher rating in favor of information associated with individual participants who match the category selection and have a lower rating.” Ex. 1001, 17:61–18:4. Claim 10 recites a similar limitation. *Id.* at 18:53–59.

Petitioner contends that both Beaudoin and Shubov teach display of information for multiple participants based on respective ratings. Pet. 52–54, 60–61.

We have reviewed the evidence presented in the Petition and are persuaded that Petitioner has provided sufficient evidence that the combination of Beaudoin and Shubov teaches the limitations of claims 5 and 10. For instance, Petitioner contends that Beaudoin discloses sorting the presentation order based on different variables, including composite ratings, with service providers replying promptly given priority. Pet. 52.

Patent Owner asserts that Beaudoin fails to teach this claim limitation because a compiled list of service providers is presented to a user, without considering their ratings, and the user may then sort. Prelim. Resp. 76–78. We are not persuaded by Patent Owner’s arguments because they are based on limitations not appearing in the claims. Beaudoin discloses that the display of participant information, and although it is the consumer who can then sort the information based on ratings (Ex. 1005, 16:13–16), the later-sorting and display by ratings would nonetheless teach the claim limitation.

On this record, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing on its assertion that claims 5 and 10 would have been obvious over the combination of Beaudoin and Shubov.

*f. Claim 11*

Claim 11 depends from claim 6 and additionally recites that “the computer system corresponds to a server, or a combination of servers.” Ex. 1001, 18:60–62.

Petitioner contends that Beaudoin teaches a computer system that includes servers. Pet. 61.

We have reviewed the evidence presented in the Petition and are persuaded that Petitioner has provided sufficient evidence that the combination of Beaudoin teaches the limitations of claim 11. For instance, Petitioner contends that Beaudoin discloses the use of a system that uses an electronic network that includes servers. Pet. 61. Patent Owner presents no additional arguments for claim 11, except for alleged deficiencies related to claim 6, which we do not find persuasive for the reasons discussed above. *See* Prelim. Resp. 80.

On this record, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing on its assertion that claim 11 would have been obvious over the combination of Beaudoin and Shubov.

*F. Alleged Obviousness of Claims 4 and 9  
over Beaudoin, Shubov, and Herz*

Petitioner contends that claims 4 and 9 are rendered obvious by Beaudoin, Shubov, and Herz. Pet. 63–69. To support its contentions, Petitioner provides explanations as to how Beaudoin, Shubov, and Herz teach each claim limitation. *Id.* Petitioner also relies upon the Goldberg

Declaration (Ex. 1004) to support its positions. Patent Owner alleges that the combination of Beaudoin and Herz fail to teach some of the limitations of the claims. Prelim. Resp. 72–75.

We begin our discussion with a brief summary of Herz and then address the evidence and arguments presented.

*1. Herz (Ex. 1007)*

Herz is directed to a professional referral network using the network to provide greater efficiency in the referral process. Ex. 1007 ¶ 5. The referral network is made available via a web interface over the Internet, and consists of a client ratings database, professional ratings database, an availability list, and a referral bid engine. *Id.* ¶ 14. Specialized professionals looking for clients may register with the system and a referring professional may provide a client’s identity and needs to the referral network, and the referral network will then present the most suitable candidates to the referring professional. *Id.* ¶¶ 20–22. Patients may rate physicians, and, additionally, physicians may rate referral physicians who are referred to their patients. *Id.* ¶ 31.

*2. Analysis*

Claim 4 depends from claim 1 and further recites “identifying information for another participant that matches the category selection of the user based on a referral provided by one or more users of the network computer system.” Ex. 1001, 17:56–60. Claim 9 contains a similar limitation. *Id.* at 18:48–52.

Petitioner relies upon Beaudoin’s disclosure that an “enrolling service provider may be encouraged to identify potential Service Provider participants that can be contacted regarding the service (‘Referred

Prospects’)” teaches the claim limitation. Pet. 67 (citing Ex. 1005, 15:15–20). Petitioner also contends that the concept of referrals was known, as demonstrated in Herz, which discloses referring physicians choosing appropriate specialists for clients. *Id.* at 67–68.

Petitioner’s contentions are based upon an interpretation of the claim limitations in view of the disclosures of the ’107 patent. Pet. 65–66.

Petitioner asserts that the ’107 patent provides one example regarding referrals as below:

For example, in one situation, the individual (“Connection 1”) that the user has selected may not be able to solve the problem or answer the question the user has submitted. In other instances, Connection 1 may see other questions or issues the user has on their bio which are not related to the question posed. In either case, Connection 1 may know of others, either inside or outside of his or her network of contacts (online, personal, friends, family etc.), who may be able to assist the user with either the original issue or other issues that become apparent.

Pet. 65–66 (citing Ex. 1001, 12:11–20).

Petitioner asserts that the referenced “first issue resolver” or participant may be the referral source, so “the ’107 Patent only contemplates participants referring other participants.” Pet. 65–66 (citing Ex. 1004 ¶ 158).

Petitioner does not present any other arguments in support of its interpretation that address meaning of “user” and “participant” in the context of the claims and specification. More specifically, Petitioner does not more fully address the meaning of “participant” and “user” in view of the intrinsic record, and whether those terms define mutually exclusive entities.

Although Petitioner's arguments may prevail after a full trial, we invite the parties to present additional briefing in the Response, Reply, and Sur-reply on the interpretation of the terms of claims 4 and 9, as well as the prior art's teachings of the respective limitation of the claims.

### III. CONCLUSION

Based on the arguments and evidence presented in the Petition, the Preliminary Response, and accompanying exhibits, we have determined there is a reasonable likelihood Petitioner would prevail with respect to at least one claim challenged in the Petition. We conclude that the threshold has been met for instituting *inter partes* review, and we institute on all challenged claims and all grounds. *See SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1354 (2018); *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018). We have not made a final determination on claim construction or as to the patentability of any of the challenged claims. Our final determination will be based on the record as fully developed during trial.

### IV. ORDER

Accordingly, it is:

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review is instituted as to challenged claims 1–11 of the '107 patent for all grounds raised in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial, which commences on the entry date of this Order.



IPR2019-01165  
Patent 9,978,107 B2

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