

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHEWY, INC.,
Petitioner,

v.

INTERNATIONAL BUSINESS MACHINES CORP.,
Patent Owner.

IPR2021-00757
Patent 7,076,443 B1

Before KEN B. BARRETT, KEVIN W. CHERRY, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

PESLAK, *Administrative Patent Judge*.

DECISION

Granting Institution of *Inter Partes* Review

35 U.S.C. § 314, 37 C.F.R. § 42.4

Granting Motion for Joinder- Paper 3

35 U.S.C. § 315, 37 C.F.R. § 42.122

I. INTRODUCTION

Chewy, Inc. (“Petitioner” or “Chewy”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1–7, 9–17, 19, and 20 (“the challenged claims”) of U.S. Patent 7,076,443 B1 (Ex. 1001, “the ’443 patent”). Petitioner concurrently filed a Motion for Joinder of this proceeding with IPR2020-01655 (the “1655 IPR” or “the Zillow IPR”). Paper 3 (“Motion” or “Mot.”). International Business Machines Corporation (“Patent Owner” or “IBM”) filed an Opposition to the Motion.¹ Paper 7 (“Opposition” or “Opp.”). Petitioner filed a Reply to the Opposition. Paper 8 (“Reply”).

We have authority, acting on the designation of the Director, to determine whether to institute an *inter partes* review under 35 U.S.C. § 314(a). *See also* 37 C.F.R § 42.4(a) (2019) (“The Board institutes the trial on behalf of the Director.”). Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless the information presented in the Petition shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons discussed below, we institute an *inter partes* review of all challenged claims of the ’443 patent on all grounds stated in the Petition. We also grant the Motion.

A. Related Matters

The ’443 patent is currently at issue in *Chewy, Inc. v. International Business Machines Corp.*, No. 1:21-cv-01319 (S.D.N.Y.) (the “New York litigation”) and *International Business Machines Corp. v. Zillow Group*,

¹ Patent Owner did not file a Preliminary Response to the Petition.

Case No. 2:20-cv-00851-TSZ (W.D. Wash.) (the “Washington litigation”).
Pet. 1, Paper 5, 1. The ’443 patent is at issue in IPR2020-01655. Paper 5, 1.

B. Real Parties in Interest

Petitioner and Patent Owner state that the named entities are the only real parties in interest. Pet. 1; Paper 5, 1.

C. The ’443 Patent

The ’443 patent “relates to e-commerce solutions that include target advertising.” Ex. 1001, 1:10–13. The patent explains that advertising to Internet users has typically involved the use of “banner ads,” which have drawbacks:

First, advertisements are made available to the users whether or not these ads have been specifically solicited. Second, banner ads rely on user profiling, which is burdensome to employ. Third, web site owners who are not technically savvy, or without available resources, can not easily acquire user profiling information.

Id. at 1:18–28. Additionally, shortcomings in the use of user profiles for targeted advertising include that collecting and building profiles is “cumbersome work,” that the information changes, and that it is “difficult to identify a specific user, i.e., a user interested in purchasing automobiles, and associate the correct advertisement profile to the user.” *Id.* at 1:46–56. The patent provides a method for use with search engine services that does not rely on user profiling, and is “uniquely different from the e-commerce method of user profiling.” *Id.* at 1:65–2:4; 4:54–56.

The patent relies on the idea that “if a user is interested in a specific piece of information, he or she may be interested in related or similar advertisements,” presented in banner advertisements, based on the results of

searches. *Id.* at 5:11–19. “[F]or each search result item 30, the method requires a match search 40 of related products.” *Id.* at 5:33–35.

The method of the ’443 patent includes the use of a “product database 110,” which “provides storage for a list of potential product advertisements.” *Id.* at 6:13–14. “The type of information pertaining to these products may be in the form of images, such as hyperlinks or full HTML pages, and the like. It is not necessary to dictate the details of this database, provided accessible images can be acquired.” *Id.* at 6:14–18. According to the ’443 patent:

product matching manager 140 takes the search engine results set and attempts to match at least one product to each of the search result items. This is accomplished, in part, through communication with the product database 110. For example, if the search had yielded twenty five (25) in the results set, the product matching manager 140 would, for each of those twenty five search result items, try to match at least one of the products found in the product database 110 to the individual search result item.

Id. at 6:35–43. The patent describes “using the URL of the search result item as a unique key identifier.” *Id.* at 6:47–49.

D. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–7, 9–17, 19, and 20 would have been unpatentable on the following grounds (Pet. 3–4)²:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–7, 9–17, 19, and 20	102	Linden ³

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. §§ 102, 103. Because the ’443 patent was filed before the effective date of the relevant amendment, the pre-AIA version of § 102 applies.

³ US 6,266,649 B1, issued July 24, 2001 (Ex. 1003, “Linden”).

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–7, 9–17, 19, and 20	102	Bull ⁴

E. The Challenged Claims

Claims 1 and 15 are independent and are reproduced below:

1. A method of targeting at least one associated advertisement from an Internet search having access to an information repository by a user, comprising:

- identifying at least one search result item from a search result of said Internet search by said user;
- searching for said at least one associated advertisement within said repository using said at least one search result item;
- identifying said at least one associated advertisement from said repository having at least one word that matches said at least one search result item; and
- correlating said at least one associated advertisement with said at least one search result item.

15. A method for providing related advertisements for search result items from a search of an information repository, comprising:

- matching said search result items to said related advertisements;
- designating each of said search result items that have said related advertisements matched therewith;
- providing a corresponding graphical user interface for each of said search result items so designated for subsequent user selection;
- searching and retrieving said related advertisement for one of said search result items when said corresponding graphical user interface is selected by a user; and
- formatting and displaying said related advertisements upon selection.

Ex. 1001, 8:5–17, 8:61–9:8.

⁴ US 5,995,943, issued Nov. 30, 1999 (Ex. 1004, “Bull”).

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