

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EBAY INC.,
Petitioner,

v.

MASTEROBJECTS, INC.,
Patent Owner.

Case No. IPR2017-00740
U.S. Patent No. 8,539,024

PETITIONER EBAY INC.'S NOTICE OF APPEAL

Pursuant to 35 U.S.C. §§ 141, 142, and 319, and in accordance with 37 C.F.R. §§ 90.2-90.3, Petitioner eBay Inc. appeals to the United States Court of Appeals for the Federal Circuit from the Final Written Decision of the Patent Trial and Appeal Board entered on July 25, 2018 (Paper No. 48) in IPR2017-00740, and from all underlying findings, determinations, rulings, opinions, orders, and decisions regarding the *inter partes* review.

In accordance with 37 C.F.R. § 90.2(a)(3)(ii), Petitioner states that the issues on appeal may include, but are not limited to:

- (1) the Final Written Decision of the Patent Trial and Appeal Board that Petitioner has not shown, by a preponderance of the evidence, that (a) claims 1–3, 6, 7, 9, 12, 15–17, 21, 24, 25, 32, 33, 35, and 36 of U.S. Patent No. 8,539,024 are unpatentable as anticipated under 35 U.S.C. § 102(e) over U.S. Patent No. 6,704,727 (“Kravets”), (b) claims 1–3, 6, 7, 9, 12, 15–17, 21, 24-26, and 32-37 are unpatentable for obviousness over Kravets under 35 U.S.C. § 103; and (c) claims 1–3, 6, 7, 9, 12, 15–17, 21, 24-26, and 32-37 are unpatentable for obviousness over the combination of Kravets and U.S. Patent No. 6,751,603 (“Bauer”) under 35 U.S.C. § 103, and the sufficiency of the Board’s analysis and fact-findings regarding the same;

- (2) the Board erred as a matter of law in its analysis of claim scope, including, without limitation, (a) the scope of the claim language “return message,” and the related “checking” (e.g., claims 1, 32, and 35) claim functions (e.g., “checking that the return message corresponds to the latest query”), and “comparing” or “matching” (e.g., claims 36 and 37) claim functions, as recited in claims 1, 32, 35, 36, and 37, and (b) the scope of the limitations recited in claims 1, 32, 35, 36, and 37 related to the “usability test”;
- (3) the Board erred as a matter of law in its anticipation and obviousness analyses, in part by disregarding the rule of law that a prior art apparatus which sometimes, but not always, embodies a claimed function, nonetheless discloses and teaches that functional aspect of a claimed apparatus, and by accordingly failing to find anticipation and obviousness based on Kravets’ disclosure of the claimed “usability test” function at least at Kravets’ step T₆, with respect to the first return message R₁, when only a single return message is checked, as demonstrated by Petitioner;
- (4) the Board erred as matter of law in its obviousness analysis based on the single reference Kravets, and on the combination of Kravets and Bauer, in part by conflating obviousness with anticipation, conflating

what a reference teaches with what it discloses, and failing to conduct the obviousness analysis required by *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) and its progeny, including by failing to analyze whether it would have been obvious to modify Kravets' teachings (assuming no anticipation) to arrive at the claimed apparatus;

- (5) the Board erred in failing to afford Petitioner protections of the Administrative Procedure Act ("APA"), including, without limitation, 5 U.S.C. §§ 554(b)(3), 554(c)(1) and § 556(e), due to, without limitation, its failure to adequately explain the basis for (A) its conclusion that "no claim terms require express construction," (B) for disregarding Petitioner's argument and showing that Kravets disclosed the "test for usability" functionality for return message R₁, (C) and interpreting the claims (see, e.g., claim 35) to be limited to a "test for usability" where the client object checks only "the results of the one return message"; and
- (6) any finding or determination related to the foregoing issues, as well as all other issues decided adversely to Petitioner in any orders, decisions, rulings and/or opinions.

This Notice of Appeal is being filed with the Director of the United States Patent and Trademark Office as provided in 37 C.F.R. § 104.2, and is also being

filed with the Patent Trial and Appeal Board in the appropriate manner provided in 37 C.F.R. § 42.6(b), and with the Clerk's Office for the United States Court of Appeals for the Federal Circuit.

Respectfully submitted,

Dated: August 10, 2018

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Counsel for Petitioner and Appellant eBay
Inc.

CERTIFICATION OF FILING

The undersigned hereby certifies that Petitioner eBay Inc.'s Notice of Appeal was filed electronically through the Patent Trial and Appeal Board's End to End System (PTAB E2E) on August 10, 2018. A copy of this Notice of Appeal was also sent on August 10, 2018 by Priority Express Mail to the United States Patent and Trademark Office at the following address:

Director of the United States Patent and Trademark Office
c/o Office of the Solicitor
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Mail Stop 8
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The undersigned hereby certifies that Petitioner eBay Inc.'s Notice of Appeal was filed electronically through the United States Court of Appeals for the Federal Circuit's CM/ECF system on August 10, 2018. A copy of this Notice of Appeal was also sent on August 10, 2018 by Priority Express Mail to the Clerk of the Court of Appeals for the Federal Circuit at the following address:

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United States Court of Appeals for the Federal Circuit
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CERTIFICATE OF SERVICE

The undersigned certifies that on August 10, 2018, a complete copy of **Petitioner eBay Inc.'s Notice of Appeal** was served on counsel for MasterObjects, Inc., via electronic mail as follows:

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