UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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HULU, LLC, NETFLIX, INC., and SPOTIFY USA INC.,
Petitioner,

v.

CRFD RESEARCH, INC.,
Patent Owner.
_____

Case IPR2015-00259
Patent 7,191,233 B2
_____

Before JUSTIN T. ARBES, THOMAS L. GIANNETTI, and
CHARLES J. BOUDREAU, *Administrative Patent Judges.*

ARBES, *Administrative Patent Judge.*

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

I. BACKGROUND

Petitioners Hulu, LLC, Netflix, Inc., and Spotify USA Inc. (collectively, "Petitioner") filed a Petition (Paper 1, "Pet.") seeking *inter partes* review of claims 1–6, 8–11, 13–15, 17–20, 23–25, 29–31, 34–36, and 38–41 of U.S. Patent No. 7,191,233 B2 (Ex. 1001, "the '233 patent") pursuant to 35 U.S.C. §§ 311–319. On June 3, 2015, we instituted an *inter partes* review of claims 1–6, 8–11, 13–15, 17–20, 23–25, 29–31, 34–36, and 38–41 on four grounds of unpatentability (Paper 8, "Dec. on Inst."). Patent Owner CRFD Research, Inc. filed a Patent Owner Response (Paper 13, "PO Resp."), and Petitioner filed a Reply (Paper 16, "Reply"). An oral hearing was held on January 19, 2016, and a transcript of the hearing is included in the record (Paper 24, "Tr.").

We have jurisdiction under 35 U.S.C. § 6(c). This final written decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

For the reasons that follow, we determine that Petitioner has not shown by a preponderance of the evidence that claims 1–6, 8–11, 13–15, 17–20, 23–25, 29–31, 34–36, and 38–41 are unpatentable.

A. The '233 Patent[1]

The '233 patent describes a system and method for "user-directed transfer of an on-going software-based session from one device to another

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[1] The '233 patent also is the subject of Cases IPR2015-00055 and IPR2015-00627, in which *inter partes* reviews were instituted, and was the subject of Case IPR2015-00157, in which the request for *inter partes* review was denied. On April 22, 2016, we issued a final written decision in Case IPR2015-00055 determining that claims 1, 4–6, and 8–11 of the '233 patent had been shown to be unpatentable.

device." Ex. 1001, col. 1, ll. 8–11. A user may have a number of communication-enabled devices (e.g., cellular telephone, wireless personal digital assistant (PDA), laptop computer, desktop computer) through which the user conducts software application sessions. *Id.* at col. 1, ll. 15–52. The user may conduct a session on one device and then decide to switch to another device. *Id.* at col. 1, ll. 53–59. For example, the user may want to switch from a stationary device to a mobile device, or to switch to a device with a different graphical user interface. *Id.* According to the '233 patent, conventional systems that required the user to "discontinue the current session on the first device and reinitiate a new session on the second device" could entail inconveniences such as the history of the original session being lost or time delays involved in logging off and reinitiating. *Id.* at col. 1, ll. 59–66.

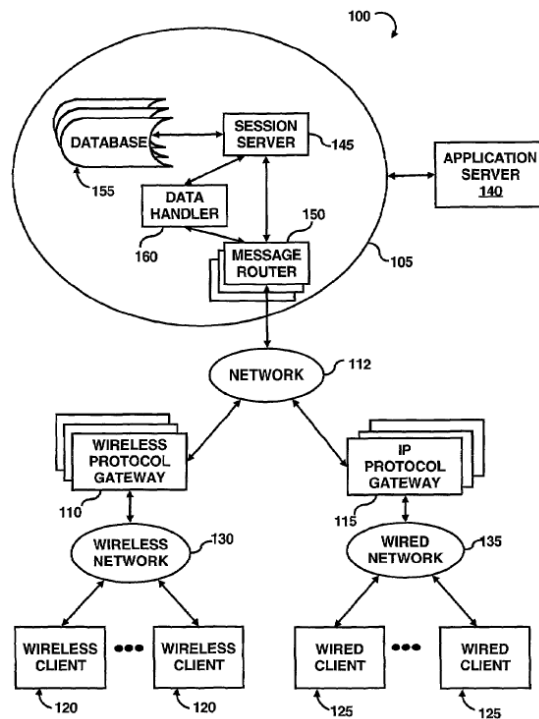Figure 1 of the '233 patent is reproduced below.

Fig. 1

3

Figure 1 depicts wireless clients 120 (e.g., a cellular telephone or PDA) and wired clients 125 (e.g., a desktop or laptop computer) of a user that connect over various networks to application services network 105. *Id*. at col. 4, ll. 4–11, 30–33, col. 5, ll. 3–6. Wireless clients 120 and wired clients 125 execute client programs that support session services for the respective devices, and are "configured to have a preferred mode of interaction, i.e., modality," such as a graphical user interface for transferring sessions between devices. *Id*. at col. 4, ll. 33–50. Application services network 105 provides session-based services (e.g., instant messaging, database querying), and application server 140 provides applications for those services (e.g., instant messaging application, database querying application), to wireless clients 120 and wired clients 125. *Id*. at col. 5, ll. 21–30.

The '233 patent describes the method of session transfer as follows: (1) a "redirect or transfer command" is sent from a first device (wireless client 120 or wired client 125); (2) session server 145 begins intercepting messages destined for the first device; (3) the first device transmits a "transaction or session history" to session server 145; (4) session server 145 retrieves the previously stored "device profile" of the second device to which the session is to be redirected, "convert[s] the stored messages [of the session history] into a data format" and/or modality compatible with the second device, and converts the "state" of the session to a state compatible with the second device; and (5) when the user activates the second device, session server 145 "pushes the converted session to the redirected device over the network 100 as a normal session with the converted transaction log." *Id*. at col. 7, l. 46–col. 8, l. 58, Figs. 3A–3B.

B. Illustrative Claim

Claim 1 of the '233 patent recites:

1. A method for redirecting an on-going, software based session comprising:

conducting a session with a first device;

specifying a second device;

discontinuing said session on said first device; and

transmitting a session history of said first device from said first device to a session transfer module after said session is discontinued on said first device; and

resuming said session on said second device with said session history.

C. Prior Art

The pending grounds of unpatentability in the instant *inter partes* review are based on the following prior art:

U.S. Patent No. 6,963,901 B1, filed July 24, 2000, issued Nov. 8, 2005 (Ex. 1004, "Bates");

Mun Choon Chan & Thomas Y. C. Woo, *Next-Generation Wireless Data Services: Architecture and Experience*, IEEE PERS. COMM., Feb. 1999, 20 (Ex. 1005, "Chan"); and

Bo Zou, Mobile ID Protocol: A Badge-Activated Application Level Handoff of a Multimedia Streaming to Support User Mobility (2000) (M.S. thesis, University of Illinois at Urbana-Champaign) (Ex. 1006, "Zou").

D. Pending Grounds of Unpatentability

The instant *inter partes* review involves the following grounds of

unpatentability:

Reference(s)	Basis	Claim(s)
Bates	35 U.S.C. § 102(e)	1–3, 23, and 24
Bates and Chan	35 U.S.C. § 103(a)	1–6, 8–11, 23–25, and 29–31
Bates and Zou	35 U.S.C. § 103(a)	13, 14, 34, and 35
Bates, Zou, and Chan	35 U.S.C. § 103(a)	15, 17–20, 36, and 38–41

II. ANALYSIS

A. Claim Interpretation

The Board interprets 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 In re Cuozzo Speed Techs., LLC*,

793 F.3d 1268, 1278–79 (Fed. Cir. 2015), *cert. granted sub nom. Cuozzo

Speed Techs. LLC v. Lee*, 136 S. Ct. 890 (mem.) (2016). Under this

standard, we interpret claim terms using "the broadest reasonable meaning

of the words in their ordinary usage as they would be understood by one of

ordinary skill in the art, taking into account whatever enlightenment by way

of definitions or otherwise that may be afforded by the written description

contained in the applicant's specification." *In re Morris*, 127 F.3d 1048,

1054 (Fed. Cir. 1997). We presume that claim terms have their ordinary and

customary meaning. *See Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1062

(Fed. Cir. 2016) ("Under a broadest reasonable interpretation, words of the

claim must be given their plain meaning, unless such meaning is inconsistent with the specification and prosecution history."); *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) ("The ordinary and customary meaning is the meaning that the term would have to a person of ordinary skill in the art in question." (internal quotation marks omitted)). A patentee, however, may rebut this presumption by acting as his or her own lexicographer, 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 Decisions on Institution in Cases IPR2015-00055, IPR2015-00157, IPR2015-00259, and IPR2015-00627, we interpreted various claim terms of the '233 patent as follows:

Claim Term	Interpretation
"modality"	a preferred mode of interaction
"device profile"	information pertaining to the operation of a device, such as the data format or modality of the device
"in response to . . . activation of said second device"	in response to the second device being made active, such as by a user logging on to the second device
"session"	a series of information transactions between communicating devices during a particular time period
"discontinuing"	terminating or otherwise stopping, with the ability to be resumed
"discontinued"	terminated or otherwise stopped, with the ability to be resumed
"session transfer module"	computer hardware and/or software that participates in the transfer of a session

See Dec. on Inst. 6–9; *DISH Network Corp. v. CRFD Research, Inc.*,
Case IPR2015-00627, slip op. at 6–9 (PTAB June 3, 2015) (Paper 9);
Unified Patents Inc. v. CRFD Research, Inc., Case IPR2015-00157, slip op.
at 6–9 (PTAB Apr. 30, 2015) (Paper 8); *Iron Dome LLC v. CRFD Research,
Inc.*, Case IPR2015-00055, slip op. at 6–10 (PTAB Apr. 27, 2015)
(Paper 10). The parties do not dispute these interpretations in their Patent
Owner Response and Reply. We do not perceive any reason or evidence
that compels any deviation from these interpretations. Accordingly, we
adopt our previous analysis for purposes of this Decision.

We note one additional issue regarding the ordering of steps in the
claims. To determine whether the steps of a method claim that do not
otherwise recite an order must nonetheless be performed in a particular
order, we first "look to the claim language to determine if, as a matter of
logic or grammar, they must be performed in the order written." *Altiris, Inc.
v. Symantec Corp.*, 318 F.3d 1363, 1369 (Fed. Cir. 2003). "If not, we next
look to the rest of the specification to determine whether it 'directly or
implicitly requires such a narrow construction.'" *Id.* at 1370 (citation and
emphasis omitted); *see also Mformation Techs., Inc. v. Research In Motion
Ltd.*, 764 F.3d 1392, 1398–99 (Fed. Cir. 2014) ("a claim 'requires an
ordering of steps when the claim language, as a matter of logic or grammar,
requires that the steps be performed in the order written, or the specification
directly or implicitly requires' an order of steps" (citation omitted)).

Claim 1 expressly requires that "transmitting a session history of said
first device from said first device to a session transfer module" take place
"after said session is discontinued on said first device." Independent claims
13, 23, and 34 similarly recite that the session history is transmitted "after"

the session is discontinued on the first device. The parties agree that the claims require a specific order for transmitting the session history and discontinuing the session on the first device (i.e., the session must be discontinued first). *See* Pet. 23–24; PO Resp. 5.[2]

B. Asserted Grounds

Petitioner argues that claims 1–3, 23, and 24 are anticipated by Bates under 35 U.S.C. § 102(e); that claims 1–6, 8–11, 23–25, and 29–31 are unpatentable over Bates and Chan under 35 U.S.C. § 103(a); that claims 13, 14, 34, and 35 are unpatentable over Bates and Zou under 35 U.S.C. § 103(a); and that claims 15, 17–20, 36, and 38–41 are unpatentable over Bates, Zou, and Chan under 35 U.S.C. § 103(a). Pet. 15–47. We have reviewed the Petition, Patent Owner Response, and Reply, as well as the evidence discussed in each of those papers, and are not persuaded, by a preponderance of the evidence, that the challenged claims are unpatentable based on any of the asserted grounds.

1. Bates

Bates describes a method of "sharing . . . browser information between at least two browser applications." Ex. 1004, col. 1, ll. 63–66. A user may operate one browser program (e.g., Netscape Navigator) on a

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[2] In the final written decision in Case IPR2015-00055, we interpreted claim 1 not to require that the "specifying" step take place before the "discontinuing" step. *Iron Dome LLC v. CRFD Research, Inc.*, Case IPR2015-00055, slip op. at 8–10 (PTAB Apr. 22, 2016) (Paper 30). Given our analysis herein regarding whether Bates teaches the "transmitting" step, we need not interpret the "specifying" step for purposes of this Decision.

first client computer, and then choose to use a different browser program (e.g., Internet Explorer) on a second client computer. *Id*. at col. 4, ll. 41–47. The first client computer stores "browser information" and transmits the information to the second client computer for use with the second browser program. *Id*. at col. 4, ll. 49–61. Bates describes the browser information as "information generated during a browsing session, i.e., a period of time when the browser 240 is executing on a client computer 106 and a network connection exists between the client 106 and the network 104 allowing a user to traverse network addresses corresponding to the servers 108." *Id*. at col. 4, ll. 61–67. For example, browser information may include a history of websites visited during a browsing session, bookmarks, cookies, and browser configurations. *Id*. at col. 4, l. 67–col. 5, l. 6.

Bates discloses various data input windows that allow the user to input parameters for the transfer. *Id*. at col. 5, l. 47–col. 8, l. 54. The user may enter "an e-mail address for a computer (e.g., a remote client computer 106) to which the browser information" will be sent. *Id*. at col. 5, ll. 51–56, Fig. 3. Bates discloses an exemplary embodiment where browser information is transmitted via email, but states that "any method or system (e.g., file transfer protocol (FTP))" may be used. *Id*. at col. 3, ll. 21–26. The user also may choose what browser information to share with the second client computer and when. *Id*. at col. 5, l. 64–col. 8, l. 54, Figs. 4, 5.
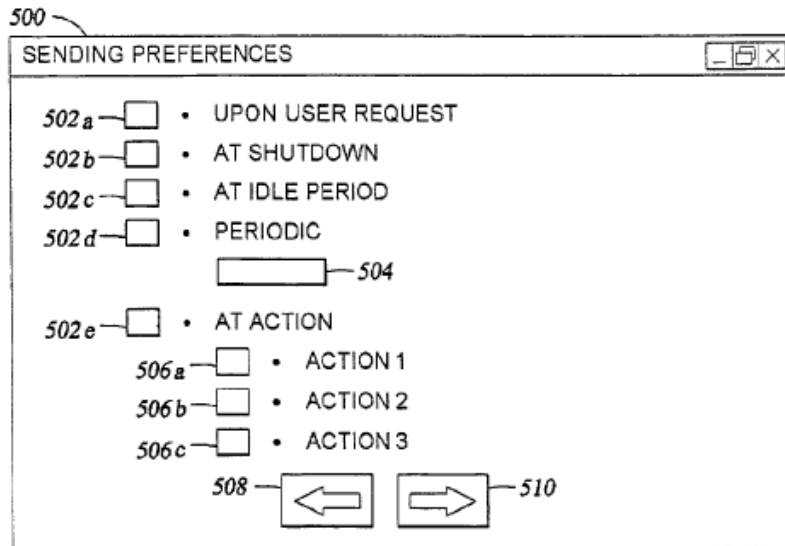
Figure 5 of Bates is reproduced below.

Fig. 5

Figure 5 depicts a data input window that allows a user to "select when browser information will be transmitted to a remote client computer 106," such as upon user request, at shutdown, or when the first client computer is idle ("e.g., when the computer 106 enters a standby or hibernation mode"). *Id*. at col. 7, l. 53–col. 8, l. 5. The first client computer transmits the browser information (e.g., in an email message) to the second client computer whenever such a "share event" occurs, and the second client computer uses the information to configure its browser program. *Id*. at col. 8, l. 55–col. 10, l. 55, Figs. 7, 8.

2. Anticipation Ground (Claims 1–3, 23, and 24)

Independent claims 1 and 23 recite transmitting the session history of a first device from the first device to a session transfer module "after said session is discontinued on said first device." Petitioner contends that Bates discloses transmitting the session history (i.e., browser information, such as

website history, bookmarks, and browser configurations) after session

discontinuation, citing Bates's disclosure of "terminat[ing] the browsing

session" and three "share events" shown in Figure 5: "upon user request,"

"at shutdown," and "at idle period." Pet. 20–24 (citing Ex. 1004, col. 10,

l. 61–col. 11, l. 1, Fig. 5). Specifically, Petitioner argues that

> Bates discloses that a user may choose when to send the browser information (i.e., the session history), including "upon user request," "at shutdown" or "at idle period" . . . . These time periods either necessarily would be, or could be, after discontinuation of the session on the first computer. At shutdown on the first computer, the session would be "discontinued" because it would be stopped, but could be resumed. If the session had idled on the first computer, it would also be "discontinued" because it would be stopped, but could be resumed. Finally, since Bates does not put any time restriction on when the user can request that the browser information be transferred "upon user request," Bates allows for browser information transmission at any number of user-selected times. One of ordinary skill in the art would appreciate that one of those times could be after the session is discontinued on the first device.

Id. at 23–24 (citations and emphasis omitted). Petitioner cites the testimony

of Mark Claypool, Ph.D., in support. *Id.* (citing Ex. 1003 ¶ 122).

Patent Owner responds that Petitioner's assertions as to when the

three share events "could" occur with respect to discontinuation of the

session on the first client computer are insufficient to demonstrate that Bates

discloses transmitting the session history "after said session is discontinued

on said first device," relying on the testimony of Prasant Mohapatra, Ph.D.

PO Resp. 15–22 (citing Ex. 2001 ¶¶ 27–32). According to Patent Owner,

transmission does not necessarily occur after discontinuation of the session

in Bates, and it is equally likely that transmission occurs during a session or

concurrently with the session being discontinued. *Id.* at 16–19. Patent Owner also points out that Bates describes the sequence of events in Figure 7, including the transmission of browser information (step 720), as occurring "during a browsing session"—not *after* a session is discontinued on the first client computer. *Id*. at 14–16 (citing Ex. 1004, col. 8, ll. 55–57).

Having reviewed all of the parties' arguments and supporting evidence, we conclude that Petitioner has not shown, by a preponderance of the evidence, that Bates expressly or inherently discloses transmitting the session history "after said session is discontinued on said first device." *See Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1255–56 (Fed. Cir. 1989) ("Anticipation requires that every limitation of the claim in issue be disclosed, either expressly or under principles of inherency, in a single prior art reference.").

We begin by noting that there is nothing in Bates explicitly disclosing when the alleged "session" ends. Petitioner acknowledged this at the hearing. Tr. 42:5–8. Bates, however, does disclose what occurs *during* a "session." The term "session" in the claims means a series of information transactions between communicating devices during a particular time period. *See supra* Section II.A. Bates uses the slightly different term "browsing session," which it defines as the "period of time when the browser 240 is executing on a client computer 106 and a network connection exists between the client 106 and the network 104 allowing a user to traverse network addresses corresponding to the servers 108." Ex. 1004, col. 4, ll. 61–67. Thus, the "browsing session" in Bates is the period of time when the browser program is "executing" on the client computer and the client computer has an open connection to the network servers with which it is

communicating. During this time, the client computer in Bates generates
browser information in response to user input (e.g., by creating a history of
websites visited by the user). *See id.* at Abstract ("A first browser executing
on a first computer generates browser information in response to user
input."), col. 9, ll. 17–46 (describing the generation and storage of browser
information in buffer 242), col. 2, ll. 2–10 (reciting "generating the
user-configured browser information during execution of a first network
browser on a first computer in response to user-input commands"), claim 1
(same). Accordingly, the alleged "session" in Bates (i.e., the series of
information transactions between communicating devices) occurs during the
time period of what Bates refers to as the "browsing session."

Figure 7 of Bates depicts the steps performed by the client computer
"during a browsing session," *id.* at col. 8, ll. 55–57, and is reproduced
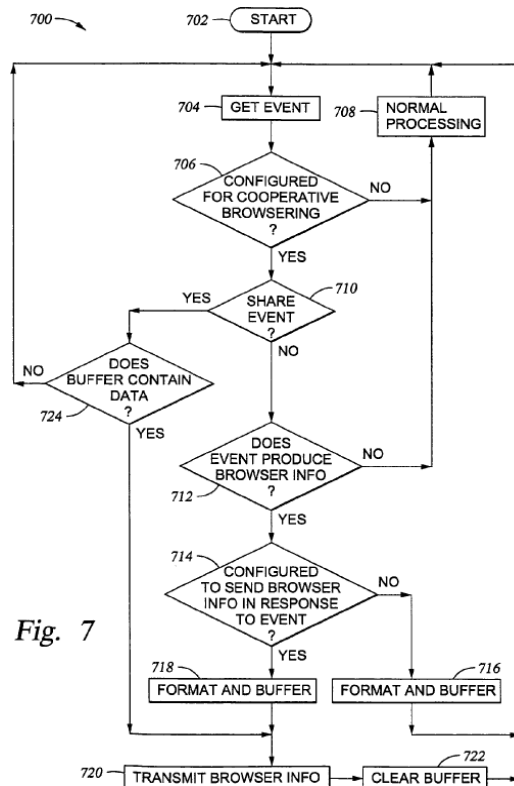below.

Fig. 7

14

As shown in Figure 7, the client computer begins processing an event at step 704, determines whether the event is a share event (e.g., "upon user request," "at shutdown," or "at idle period") at step 710, and transmits the browser information at step 720. *Id.* at col. 8, l. 55–col. 9, l. 37. Thus, we agree with Patent Owner and Dr. Mohapatra that transmission of the session history in Bates occurs *during* the session, not *after* the session is discontinued as required by the claims. *See* PO Resp. 12–16; Ex. 2001 ¶¶ 27–28.

We also note that, when asked at the hearing when in the sequence of steps in Figure 7 the "session" ends, Petitioner acknowledged that it is not disclosed explicitly, but stated that the "session" would end "at [step] 704" when a share event (e.g., "at shutdown") is first processed. Tr. 41:15–42:11. Patent Owner argued that the end of the "session" is not shown explicitly in Figure 7, but would occur at some point after transmission of the browser information in step 720. *Id.* at 34:5–15. Given Bates's disclosure that the entirety of Figure 7 occurs "during a browsing session," we agree with Patent Owner. *See* Ex. 1004, col. 8, ll. 55–57. Petitioner does not point to any specific disclosure in Bates, or provide any persuasive explanation, showing that the series of information transactions between the client computer and network server(s) would stop at step 704. Indeed, Petitioner argued at the hearing that it may be the case that the user has stopped browsing after the event at step 704, but acknowledged that if there was "anything you need to finish up at that point, . . . there could be some residual" communications. Tr. 42:12–20. Dr. Claypool also testified during cross-examination that certain steps of Figure 7 that take place after step 704, such as steps 706, 710, 712, 714, 716, and 718, run only when the

browser program is still executing. *See* Ex. 2004, 32:16–34:18. Thus, we are not persuaded by Petitioner's argument that the "session" is discontinued at step 704.

Petitioner also argues that the following disclosure in Bates discloses the required session discontinuation:

> [C]onsider a user reading messages posted on a bulletin board, inputting data into a web page or performing some other task during a browsing session. Prior to completing the task, the user may be required to terminate a browsing session. In such an event, the necessary browser information may be collected and transmitted to a remote computer containing another browser program.

Ex. 1004, col. 10, ll. 58–65; *see* Pet. 20–21; Tr. 24:9–25:18. We are not persuaded that this portion of Bates implies a sequential order for the last two sentences (i.e., that the browsing session is terminated before transmission of the browser information). The fact that "the user may be required to terminate a browsing session" before completing a task does not mean necessarily that the browsing session actually is terminated at that time. To the contrary, as discussed above, Bates's description of Figure 7 indicates that transmission of browser information occurs "during a browsing session." *See* Ex. 1004, col. 8, l. 55–col. 9, l. 37.

Petitioner further points to the three share events themselves ("upon user request," "at shutdown," and "at idle period") and argues that when they occur, transmission of the session history "necessarily would be, or could be, *after* discontinuation of the session." Pet. 23–24. Dr. Claypool's corresponding testimony largely repeats Petitioner's arguments in the Petition. *See* Ex. 1003 ¶ 122. We are not persuaded. Petitioner does not explain sufficiently or point to sufficient supporting evidence showing that

transmission *must* occur after discontinuing the session in any of the three cited share events in Bates, as would be required for a finding of inherency. *See MEHL/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362, 1365 (Fed. Cir. 1999) (explaining that inherency requires that "the prior art necessarily functions in accordance with, or includes, the claimed limitations"). Further, Patent Owner explains why, for each of the three share events cited by Petitioner, it is at least equally likely that transmission occurs *before* discontinuing the session. PO Resp. 16–18. For example, Dr. Mohapatra testifies that

> a transmission that occurs "immediately upon user request" is not necessarily concurrent with a transmission after a session is discontinued. User requests may occur at any time, and are especially likely to occur during a browsing session as a user comes across interesting information or performs actions that the user wishes to preserve as browsing history or other session events. Therefore, it is equally, if not more, likely that such a user request will be made (and a corresponding transmission of session state effected) while the user is engaged in a current session.

Ex. 2001 ¶ 29. We find Dr. Mohapatra's testimony on these points persuasive and supported by the disclosure of Bates. *See id.* ¶¶ 27–32.

Nor is Petitioner's argument that transmission of the session history "could" occur after discontinuing the session in Bates persuasive. *See* Pet. 24; Reply 5–6, 9. Petitioner contends that because Bates "does not put any time restriction" on when the session history can be transmitted, it allows for transmission "at any number of user-selected times," such that "[o]ne of ordinary skill in the art would [have] appreciate[d] that one of those times could be after the session is discontinued on the first device." Pet. 24. However, "'[t]he mere fact that a certain thing may result from a given set of

17

circumstances is not sufficient' to show anticipation where the claim, as here, requires more." *Synopsys, Inc. v. Mentor Graphics Corp.*, 814 F.3d 1309, 1321 (Fed. Cir. 2016) (citation omitted); *see also MEHL/Biophile*, 192 F.3d at 1365 (noting that a "possibility" that under certain circumstances a laser designed for tattoo removal may be pointed at hair follicles "does not legally suffice to show anticipation" of a patent involving laser hair removal). Petitioner's position essentially disregards the specific ordering required by the claims, and would have a reference anticipate as long as there is some possibility of the required ordering, regardless of what the reference actually discloses. As explained above, Bates does not disclose explicitly when the alleged "session" ends, but does disclose that transmission occurs "during the browsing session," which is the period of time when the series of information transactions of the "session" takes place. *See* Ex. 1004, col. 8, l. 55–col. 9, l. 37.

Finally, we note that Petitioner makes three arguments in its Reply that are procedurally improper and not entitled to consideration. Pursuant to 37 C.F.R. § 42.23(b), a reply "may only respond to arguments raised in the corresponding . . . patent owner response." *See also Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, – F.3d –, 2016 WL 2620512, at *8–9 (Fed. Cir. May 9, 2016) (concluding that the Board did not abuse its discretion in refusing to consider reply brief arguments advocating a "new theory" of unpatentability under 37 C.F.R. § 42.23(b)); *Apple Inc. v. e-Watch, Inc.*, Case IPR2015-00412, slip op. at 44 (PTAB May 6, 2016) (Paper 50) ("'Respond,' in the context of 37 C.F.R. § 42.23(b), does not mean embark in a new direction with a new approach as compared to the position originally taken in the Petition. Accepting such belatedly presented new

arguments would be unjust to the Patent Owner and we decline to do so."); Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions; Final Rule, 77 Fed. Reg. 48,612, 48,620 (Aug. 14, 2012) ("Oppositions and replies may rely upon appropriate evidence to support the positions asserted. Reply evidence, however, must be responsive and not merely new evidence that could have been presented earlier to support the movant's motion."); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012) ("While replies can help crystalize issues for decision, a reply that raises a new issue or belatedly presents evidence will not be considered and may be returned. . . . Examples of indications that a new issue has been raised in a reply include new evidence necessary to make out a *prima facie* case for the patentability or unpatentability of an original or proposed substitute claim, and new evidence that could have been presented in a prior filing.").

First, Petitioner provides a lengthy explanation as to how a person of ordinary skill in the art would have understood Bates to operate based on the alleged timing of Microsoft Windows shutdown signals and the interaction between a browser application and email software. Reply 6–9. Petitioner's explanation amounts to a new theory for why Bates allegedly discloses transmitting the session history "after said session is discontinued on said first device" that was not discussed in the Petition. *See* Pet. 20–24 (citing only Bates's disclosure of the events "upon user request," "at shutdown," and "at idle period"); Tr. 9:1–4 (acknowledging that shutdown signals are not discussed in the Petition). Indeed, Petitioner does not cite in its Reply any testimony from Dr. Claypool's declaration or other evidence submitted with the Petition, but rather relies solely on the cross-examination testimony

of Patent Owner's declarant, Dr. Mohapatra. *See* Pet. 20–24 (citing Ex. 1003); Reply 6–9 (citing Ex. 1018); Tr. 13:18–21.

Further, even if considered, Petitioner's new theory is not persuasive. Petitioner, for example, cites distinct portions of Dr. Mohapatra's testimony where he answered questions about how Bates's system "could" operate—not how a person of ordinary skill in the art would have understood the system actually to operate. *See* Reply 6–9 (citing Ex. 1018, 58:16–19, 59:3–6, 77:9–13, 120:13–18); Tr. 35:24–36:14. From these excerpts of testimony and others, Petitioner pieces together an alleged sequence of events that would occur in Bates. *See* Reply 6–9. Petitioner, however, never cites any portion of the testimony where Dr. Mohapatra was provided the full sequence of events proposed by Petitioner and agreed that Bates operates in that manner. This deficiency was evident at the oral hearing, where Petitioner utilized a demonstrative exhibit showing five steps and argued that disparate excerpts from Dr. Mohapatra's testimony support aspects of that alleged sequence. *See* Paper 23, 12; Tr. 15:9–16:6, 22:15–23:20. We do not agree that Dr. Mohapatra's testimony supports Petitioner's new theory for how a person of ordinary skill in the art would have understood Bates's system to operate, and Petitioner points to no other evidence to support its theory.

Second, Petitioner argues that if the user selects "periodic" as the share event, the session history can be transmitted before or after the session is discontinued. Reply 9. In its Petition, however, Petitioner relied only on the "upon user request," "at shutdown," and "at idle period" share events shown in Figure 5 of Bates. Pet. 23–24. Petitioner's new theory as to the "periodic" share event, therefore, is an improper new argument as well.

Third, Petitioner argues that even if Bates does not transmit session history from the "current session" after session discontinuation, Bates discloses transmitting session history from "prior sessions." Reply 9–10 (citing Figure 4 of Bates and its accompanying description). Petitioner never argued this theory in its Petition, and it was improper to raise it for the first time in the Reply. *See* Pet. 23–24 (discussing the session history for the current session).

Based on all of the evidence of record, we are not persuaded that Bates discloses, either expressly or inherently, transmitting the session history "after said session is discontinued on said first device," as recited in claims 1 and 23. Claims 2 and 3 depend from claim 1. Claim 24 depends from claim 23. Accordingly, we determine that Petitioner has not shown, by a preponderance of the evidence, that claims 1–3, 23, and 24 are anticipated by Bates under 35 U.S.C. § 102(e).

3. Level of Ordinary Skill in the Art

> Section 103(a) forbids issuance of a patent when "the differences between the subject matter sought to be patented 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) (quoting 35 U.S.C. § 103(a)). Petitioner argues that a person of ordinary skill in the art would have had "a Bachelor of Science in Computer Science, Computer Engineering, Electrical Engineering, or an equivalent field as well as at least two years of academic or industry experience in the software field," citing the testimony of Dr. Claypool. Pet. 8 (citing Ex. 1003 ¶¶ 55–58).

Dr. Mohapatra similarly testifies that a person of ordinary skill in the art would have had "a Bachelor of Science degree in computer science or computer engineering with approximately 2 years of practical work experience or post-graduate research in a field such as computer networking and/or distributed systems." Ex. 2001 ¶ 11. Based on our review of the '233 patent, the types of problems and solutions described in the '233 patent and cited prior art, and the testimony of the parties' declarants, we conclude that a person of ordinary skill in the art would have had a bachelor's degree in computer science or computer engineering (or its equivalent), and at least two years of experience with computer networking, distributed systems, or similar fields. *See, e.g.*, Ex. 1001, col. 1, ll. 5–67 (disclosing that "[t]he invention generally relates to session management in a distributed computer network," and describing issues in the prior art when a user has "several communication-enabled devices" and wants to switch between them). We apply this level of ordinary skill in the art for purposes of this Decision.

4. Obviousness Grounds
(Claims 1–6, 8–11, 13–15, 17–20, 23–25, 29–31, 34–36, and 38–41)

Independent claims 1, 13, 23, and 34 each recite the transmission of a session history of a first device from the first device to a session transfer module "after said session is discontinued on said first device." Each of the remaining challenged claims directly or indirectly depends from one of independent claims 1, 13, 23, and 34, and, therefore, also includes this limitation. For all of the asserted obviousness grounds, Petitioner relies solely on Bates as allegedly teaching this limitation. *See* Pet. 20–24, 31–32, 41. We are not persuaded for the reasons explained above. *See supra*

Section II.B.2. Petitioner does not argue that the limitation is taught or

suggested by the combined teachings of Bates and Chan or the combined

teachings of Bates and Zou.[3] *See* Pet. 20–24, 31–32, 41. Accordingly,

based on all of the evidence of record, we determine that Petitioner has not

shown, by a preponderance of the evidence, that claims 1–6, 8–11, 23–25,

and 29–31 are unpatentable over Bates and Chan under 35 U.S.C. § 103(a);

that claims 13, 14, 34, and 35 are unpatentable over Bates and Zou under

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[3] Petitioner argued, in a different asserted ground on which trial was not
instituted, that it would have been obvious based on Bates to transmit the
session history "after said session is discontinued on said first device." *See*
Pet. 27–28; Dec. on Inst. 18. Petitioner did not make this argument,
however, in the asserted grounds on which we instituted the trial. *See*
Pet. 28–47. Even if Petitioner had, though, we would not have been
persuaded that the independent claims would have been obvious based on
Bates alone. Petitioner argued that

> [t]he goal of Bates is to "preserve" the session from one
> computer to a next. Transferring the browser information after
> discontinuation would accomplish the goal by ensuring that the
> entire session is transferred. Nothing more would be happening
> with the session on the first device at the time of transfer; the
> session would have already been discontinued there.

Id. at 27–28 (citations omitted); *see* Reply 11; Ex. 1003 ¶¶ 127–28.
Although it is true that Bates's system "preserves the *current status* of a
browsing session to be resumed at another location," Ex. 1004, col. 11,
ll. 6–8 (emphasis added), as Patent Owner points out, that goal is
accomplished if the browser information is transmitted upon user request, at
shutdown, or at an idle period during a browsing session, *see* PO Resp.
27–28. Thus, Petitioner did not provide a sufficient reason for why a person
of ordinary skill in the art would have modified the sequence of operations
in Bates to discontinue the session before transmitting the browser
information. *See KSR*, 550 U.S. at 418 ("there must be some articulated
reasoning with some rational underpinning to support the legal conclusion of
obviousness" (citation omitted)).

35 U.S.C. § 103(a); or that claims 15, 17–20, 36, and 38–41 are unpatentable over Bates, Zou, and Chan under 35 U.S.C. § 103(a).

III. ORDER

Petitioner has not demonstrated, by a preponderance of the evidence, that claims 1–3, 23, and 24 are anticipated by Bates under 35 U.S.C. § 102(e); that claims 1–6, 8–11, 23–25, and 29–31 are unpatentable over Bates and Chan under 35 U.S.C. § 103(a); that claims 13, 14, 34, and 35 are unpatentable over Bates and Zou under 35 U.S.C. § 103(a); or that claims 15, 17–20, 36, and 38–41 are unpatentable over Bates, Zou, and Chan under 35 U.S.C. § 103(a).

In consideration of the foregoing, it is hereby:

ORDERED that claims 1–6, 8–11, 13–15, 17–20, 23–25, 29–31, 34–36, and 38–41 of the '233 patent have not been shown to be unpatentable.

This is a final 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.

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