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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.,
Petitioner,

v.

WINDY CITY INNOVATIONS, LLC,
Patent Owner.

Case IPR2016-01156[1]
Patent 8,458,245 B1

Before KARL D. EASTHOM, DAVID C. MCKONE, and MELISSA A. HAAPALA, *Administrative Patent Judges*.

MCKONE, *Administrative Patent Judge*.

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

[1] Case IPR2017-00709 has been joined with this proceeding.

I. INTRODUCTION

A. Background

Facebook, Inc. ("Petitioner") filed a Petition (Paper 1, "Pet.") seeking *inter partes* review of claims 1–15, 17, and 18 of U.S. Patent No. 8,458,245 B1 (Ex. 1001, "the '245 Patent"). Windy City Innovations, LLC ("Patent Owner") filed a Preliminary Response (Paper 6, "Prelim. Resp.").

Pursuant to 35 U.S.C. § 314, in our Institution Decision (Paper 7, "Dec."), we instituted this proceeding as to claims 1–15, 17, and 18.

Patent Owner filed a Patent Owner's Response (Paper 22, "PO Resp."), and Petitioner filed a Reply to the Patent Owner's Response (Paper 31, "Reply").

Petitioner relies on the Declarations of Tal Lavian, Ph.D. (Ex. 1002, "Lavian Decl."; Ex. 1021, "2nd Lavian Decl."). Patent Owner relies on the Declaration of Jaime G. Carbonell, Ph.D. (Ex. 2005, "Carbonell Decl.").

On January 17, 2017, Petitioner filed a petition seeking *inter partes* review of claims 19 and 22–25 of the '245 patent and sought to join that proceeding to this proceeding. IPR2017-00709, Paper 2 ("the '709 Pet."), Paper 3 (Mot. for Joinder). We instituted a trial in that proceeding and joined it to this proceeding. Paper 34 ("the '709 Dec."). Petitioner relies on the Declaration of Dr. Lavian in the '709 proceeding (IPR2017-00709, Ex. 1002 ("Lavian '709 Decl.").

As to the additional claims challenged in the '709 Petition, Patent Owner filed a Supplemental Patent Owner's Response (Paper 45, "Supp. PO Resp.") and Petitioner filed a Supplemental Reply (Paper 46, "Supp. Reply").

An oral argument was held on October 19, 2017 (Paper 51, "Tr.").

We have jurisdiction under 35 U.S.C. § 6. This Decision is a final written decision under 35 U.S.C. § 318(a) as to the patentability of claims 1–15, 17–19, and 22–25. Based on the record before us, Petitioner has not proved, by a preponderance of the evidence, that any claim of the '245 patent is unpatentable.

B. Related Matters

The parties indicate that the '245 patent has been asserted in *Windy City Innovations, LLC v. Microsoft Corp*., Civ. A. No. 15-cv-00103-GM (W.D.N.C.) (transferred to 16-cv-1729 (N.D. Cal.)), and *Windy City Innovations, LLC v. Facebook, Inc.*, Civ. A. No. 15-cv-00102-GM (W.D.N.C.) (transferred to 16-cv-1730 (N.D. Cal.)). Pet. 1; Paper 4, 1. The '245 patent also is the subject of *inter partes* review petitions in IPR2016-01141, Paper 4, 1, and IPR2017-00655, which was joined to IPR2016-01141. The '245 patent was the subject of IPR2017-00669 (now terminated), which Microsoft Corp. filed and sought to join with this proceeding prior to settling with Patent Owner. Patents related to the '245 patent are subjects of additional *inter partes* review petitions.

C. Asserted Prior Art References

Petitioner relies on the following prior art:

U.S. Patent No. 6,608,636 B1, issued Aug. 19, 2003, filed May 13, 1992 (Ex. 1003, "Roseman");

Published European Pat. App. No. 0 621 532 A1, published Oct. 26, 1994 (Ex. 1004, "Rissanen");

Ronald J. Vetter, *Videoconferencing on the Internet*, IEEE COMPUTER SOCIETY 77–79 (Jan. 1995) (Ex. 1005, "Vetter");

MARY ANN PIKE ET AL., USING MOSAIC (1994) (Ex. 1006, "Pike");

U.S. Patent No. 5,226,176, issued July 6, 1993 (Ex. 1007, "Westaway"); and

TOM LICHTY, THE OFFICIAL AMERICA ONLINE FOR MACINTOSH MEMBERSHIP KIT & TOUR GUIDE (2nd ed. 1994) (Ex. 1008, "Lichty").

D. The Instituted Grounds

We instituted a trial on the following grounds of unpatentability. Dec. 30; '709 Dec. 6–7.

References	Basis	Claims Challenged
Roseman, Rissanen, Vetter, Pike, and Westaway	§ 103(a)	1–5, 7, 9–14, 19, and 22–25
Roseman, Rissanen, Vetter, Pike, Westaway, and Lichty	§ 103(a)	6, 8, 15, 17, and 18

E. The '245 Patent

The '245 patent describes an Internet "chat room." According to the '245 patent, it was known to link computers together to form chat rooms in which users communicated by text, graphics, and multimedia, giving the example of the Internet service provider "America On Line." Ex. 1001, 1:40–46. The '245 patent acknowledges that chat rooms have been implemented on the Internet, albeit with "limited chat capability," but contends that the complex chat room communications capable with Internet service providers had not been developed on the Internet "at least in part

because [the] Internet was structured for one-way communications analogous to electronic mail, rather than for real time group chat room communications" and because "there is no particular control over the platform that would be encountered on the Internet." *Id.* at 1:47–54, 1:60–62.

Figure 1, reproduced below, illustrates an embodiment of the invention:

FIG. 1

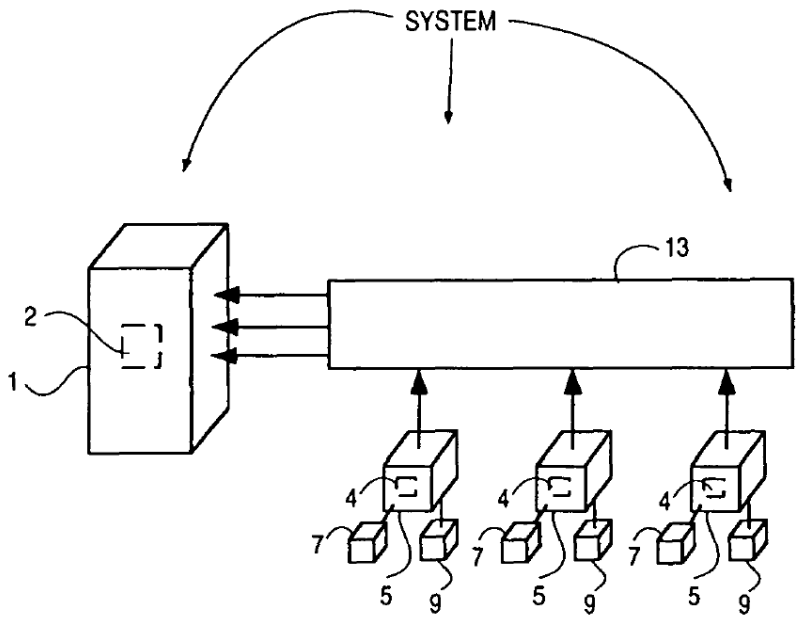

Figure 1 is a block diagram showing the components and data flow of a computerized human communication arbitrating and distributing system. *Id.* at 4:60–64. The system includes a controller computer (shown as 1 in Figure 1 but described as 3 in the written description) in communication with several participator computers 5 (e.g., IBM-compatible personal

computers) over connection 13 (e.g., an Internet connection or a World Wide Web connection). *Id.* at 4:65–5:17.

The controller computer runs under the control of controller software 2, and the software arbitrates, in accordance with predefined rules (including user identities), which participator computers 5 can interact in a group through the controller computer, and directs real-time data to the members of the group. *Id.* at 5:19–25. The software uses "identity tokens," or pieces of information associated with user identity, in the arbitration. *Id.* at 8:6–9. The tokens are stored in memory 11 in a control computer database along with personal information about the users. *Id.* at 8:9–14.

The arbitration can be used to control a user's ability to join or leave a group of participator computers, to moderate communications involving the group, and to see other users in the group. *Id.* at 8:21–32. Arbitration using tokens also can be used to perform censorship:

> Censorship, which broadly encompasses control of what is said in a group, is also arbitrated by means of the tokens. Censorship can control of access [sic] to system 1 by identity of the user, which is associated with the user's tokens. By checking the tokens, a user's access can be controlled per group, as well as in giving group priority, moderation privileges, etc.
>
> Censorship also can use the tokens for real time control of data (ascii, text, video, audio) from and to users, as well as control over multimedia URLs [Uniform Resource Locators]—quantity, type, and subject.

Id. at 8:36–44.

According to the specification, "[t]he present invention comprehends communicating all electrically communicable multimedia information as Message 8, by such means as pointers, for example, URLs. URLs can point to pre-stored audio and video communications, which the Controller

Computer 3 can fetch and communicate to the Participator Computers 5." *Id.* at 5:36–41.

The '245 patent also describes a participator computer that can locate an agent for presenting a communication that the participator computer, on its own, cannot present. *See id.* at 7:34–43. Figure 6, reproduced below, illustrates an example:

FIG. 6

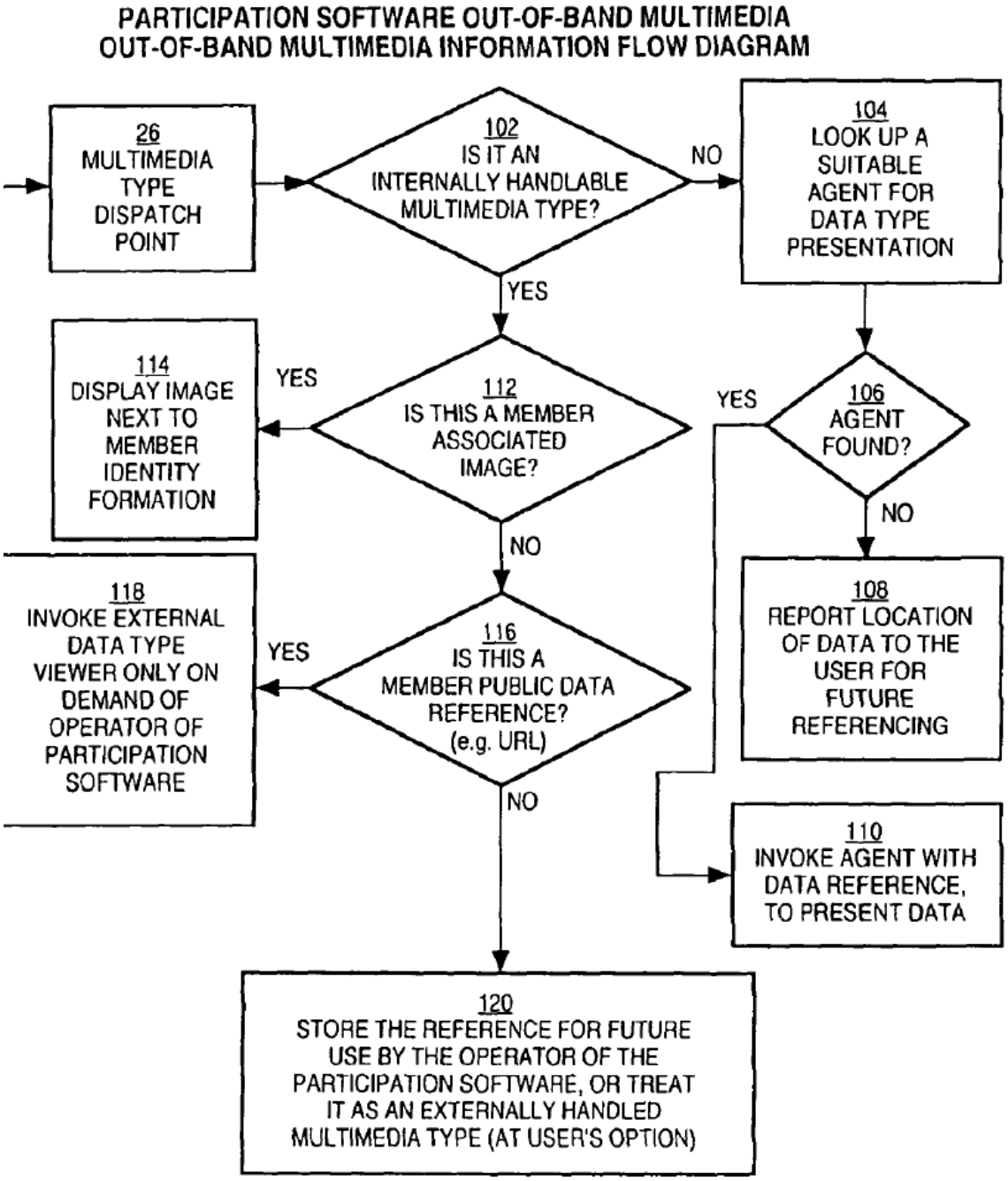

Figure 6 is a flow diagram of participator software for out-of-band multimedia handling. *Id.* at 2:64–65, 7:34–45. When the software identifies a type of multimedia (step 26), the software determines whether it is an

internally handlable multimedia type (step 102). *Id.* at 7:35–38. If not, the software looks up a suitable agent for presentation of that data type (step 104) and, if a suitable agent is found (step 106), the agent is invoked with a data reference (e.g., URL) to present the data (step 110). *Id.* at 7:38–43.

Claim 1, reproduced below, is illustrative of the claimed subject matter:

> 1. A computer apparatus distributing a communication over an Internet network, the apparatus including:
>
> a controller computer system adapted to communicate responsive to a respective authenticated user identity corresponding respectively to each of a plurality of participator computers,
>
> each said participator computer communicatively connected to said Internet network, each said participator computer programmed to enable the communication, the communication including at least one of a pre-stored sound, video, graphic, and multimedia,
>
> the controller computer system including a controller computer and a database which serves as a repository of tokens for other programs to access, thereby affording information to each of the participator computers which are otherwise independent of each other;
>
> wherein
>
> one said authenticated user identity is used to communicate a pointer-triggered private message from a first of said participator computers to said controller computer and from said controller computer to a second of said participator computers that invokes said pointer-triggered private message to fetch and receive the communication from a computer other than said first or said second said

> participator computers in real time over the Internet network
>
> such that the second of said participator computers internally determines whether or not the second of the participator computers can present the communication, if it is determined that the second of the participator computers can not present the communication then obtaining an agent with an ability to present the communication, and otherwise presenting the communication independent of the first of the independent participator computers and the computer.

II. ANALYSIS

A. Claim Construction

We interpret claims of an unexpired patent using the broadest reasonable construction in light of the specification of the patent in which they appear. *See* 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–45 (2016). In applying a broadest reasonable construction, claim terms generally are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

1. Constructions in the Institution Decision

In the Institution Decision, we preliminarily construed the following terms (Dec. 6–9):

Claim Term	Preliminary Construction
"token"	"piece of information associated with user identity"
"censored"	"controlled with respect to what is said in a group"

Patent Owner adopts our construction of "token" (which Petitioner initially proposed), PO Resp. 8, and challenges our construction of "censored," *id.* at 12–13. Petitioner accepts our construction of "censored" and presents arguments in favor of that construction. Reply 3. The parties also dispute the meaning of "database," PO Resp. 8–12; Reply 3–6. Nevertheless, we determine that construction of these terms is not necessary to resolve the dispute in this proceeding. *See 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.").

B. Asserted Grounds of Unpatentability

A 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." We resolve the question of obviousness on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) objective evidence of

nonobviousness, i.e., secondary considerations.[2] *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

In an obviousness analysis, some reason must be shown as to why a person of ordinary skill would have combined or modified the prior art to achieve the patented invention. *See Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1374 (Fed. Cir. 2008). A reason to combine or modify the prior art may be found explicitly or implicitly in market forces; design incentives; the "interrelated teachings of multiple patents"; "any need or problem known in the field of endeavor at the time of invention and addressed by the patent"; and the background knowledge, creativity, and common sense of the person of ordinary skill. *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1328–29 (Fed. Cir. 2009) (quoting *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418–21 (2007)).

1. Level of Ordinary Skill

Neither party proposes a level of ordinary skill in the art. Nevertheless, both parties' experts testify to similar levels of skill. Specifically, Dr. Lavian testifies that a skilled artisan "would possess at least a bachelor's degree in electrical engineering or computer science (or equivalent degree or experience) with practical experience or coursework in the design or development of systems for network-based communication between computer systems." Ex. 1002 ¶ 14. For his part, Dr. Carbonell testifies that a skilled artisan "would have had a bachelor's degree in

[2] The record does not include arguments or evidence regarding objective indicia of nonobviousness.

computer science (or a related field) and at least one year of work experience in programming in computer communication methods" and notes that his "opinions herein would not change even if the person having ordinary skill in the art were to be found to have the level of skill proposed by Dr. Lavian." Ex. 2005 ¶ 18. We adopt Dr. Lavian's proposal, as it is consistent with the level of skill reflected in the prior art of record. Nevertheless, we discern no material difference between his proposal and that of Dr. Carbonell. Thus, our findings and conclusions would be the same under either proposal.

2. Scope and Content of the Prior Art

Petitioner contends that the challenged claims would have been obvious over Roseman, alone or in combination with Rissanen, Vetter, Pike, Westaway, and Lichty. Pet. 7–8; '709 Pet. 6.

a. Overview of Roseman

Roseman describes a system for multimedia conferencing, in which parties are linked by both video and audio media. Ex. 1003, Abstract. In Roseman, a conference is represented visually as a common virtual conference table, in which each participant can place a document onto the table electronically, manipulate and write on the document, write on a virtual notepad, and move a pointer to draw other users' attention. *Id.* at 2:38–45, 7:55–8:37. Participants can see the events as they occur. *Id.* at 2:46–47. Figure 9, reproduced below, illustrates an example conference room:

FIG. 9

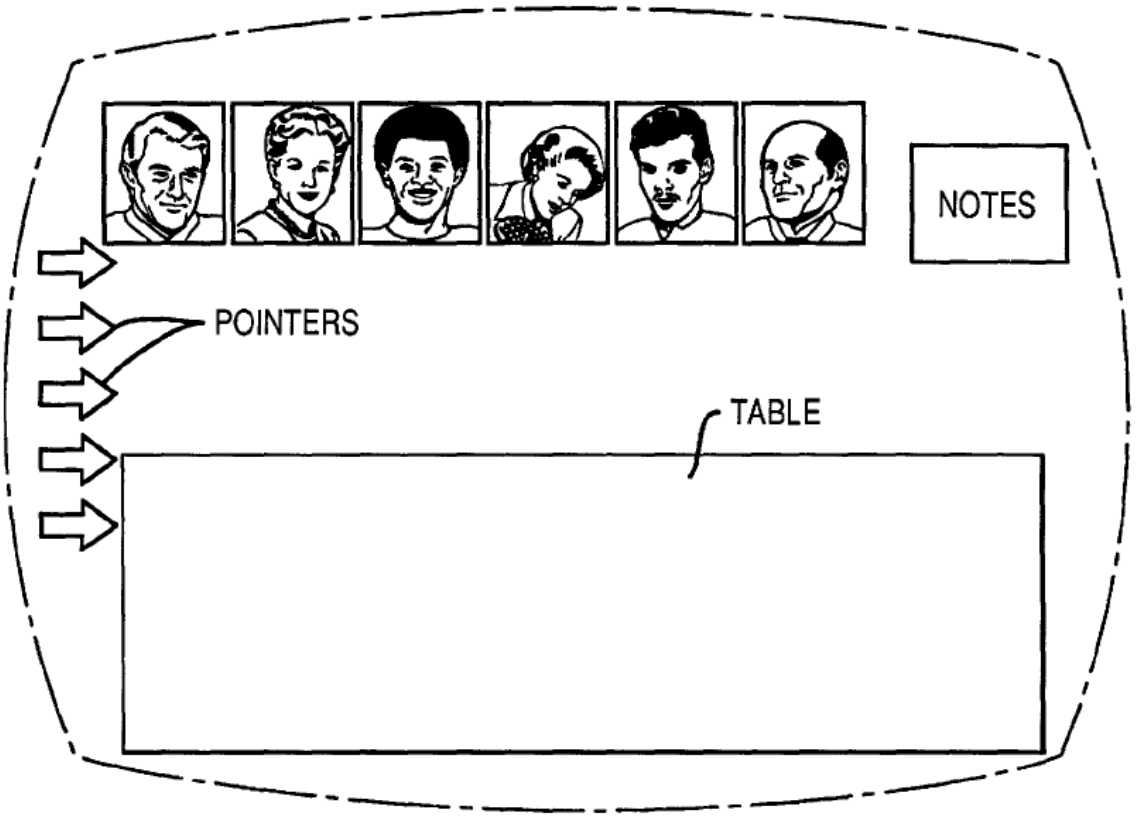

Figure 9 is a picture of a video screen that is generated by a host computer and distributed to all participants in a conference. *Id.* at 2:16–18.

The parties operate their own local computers (which include video cameras and speaker-type telephones) and, when a conference is established, connect to a host computer via commercially available local area networks ("LANs") and wide area networks ("WANs"). *Id.* at 1:34–41. In the conference, the host computer generates a common video screen (e.g., Figure 9, reproduced above) displayed at each of the local computers, and the parties send information, such as drawings, to be displayed on the common screen. *Id.* at 1:42–46. The telephones and video cameras allow the parties to see and speak with each other. *Id.* at 1:47–49.

Roseman includes a pseudo code appendix that details how its features are implemented. *Id.* at 12:66–13:2. According to the pseudo code, a participant interacts with the conference table, for example, by dragging an icon onto the table, which causes a data file to be transmitted to the host. *Id.* at 14:53–55. The host then transmits the icon to the table of each participant. *Id.* at 14:56–57. If another participant activates the icon, the host sends the open file to the tables of all participants. *Id.* at 14:58–61. If the participant drags the icon from the table to his own screen and activates the icon on his screen, the data file is presented to the participant. *Id.* at 14:62–66.

Roseman describes additional features, such as a party's ability to "whisper" to another party without being heard by others in the conference room, and the ability to "pass notes" by dragging a note to the picture of another party, while the other parties are unaware of the note. *Id.* at 9:16–31. Each room may also have "doors" to committee rooms or child-rooms. A child-room is created in the same way as a parent room and is dependent upon the parent room for access and existence. *Id.* at 10:18–23.

A meeting requester creates a conference by selecting the participants, the attributes of the virtual conference room (e.g., virtual equipment and room décor), and the rules of the conference (e.g., whether the requester has absolute control over voice and message interaction of the parties). *Id.* at 3:22–56. According to Roseman, "[t]he conference room itself is actually a combination of stored data and computer programs," the stored data can include conference proceedings, and "both the conference room and the proceedings of the conference have persistence in time." *Id.* at 12:16–25.

The meeting requester specifies a level for each invitation and compiles an invitation list. *Id.* at 9:34–36. Invitations include "keys" specifying the level, e.g., whether the invitation is for the invitee only or can be passed to a delegate or to anyone. *Id.* at 9:35–48. For example, "Level 1 keys may not be passed to any other person and may not be copied" while "Level 2 keys may be passed to exactly one other person and may not be copied." *Id.* at 9:42–45. According to Roseman, "[t]he meeting room 'knows' about each key and its invitation level. Persons with improper keys are not admitted to the room." *Id.* at 9:49–51. A key is distributed electronically as an object attached to the invitation. *Id.* at 9:54–55. To attend a meeting, a party walks a virtual "hallway" to the meeting room and opens the meeting room door by dropping the key onto a virtual "door lock." *Id.* at 10:30–32, 10:61–65. Moreover, the host "can automatically prevent filibustering" by "monitor[ing] the speech of each person, and plac[ing] a limit on the total time allowed to each person." *Id.* at 12:29–38.

b. Overview of Rissanen

Rissanen describes a system and method for validation of spoken passwords. Ex. 1004, 2:17–21. Rissanen's Background of the Invention discusses systems in which "business computer systems are arranged to initially record and store passwords assigned to users," a user is prompted for entry of a password, and "the system compares the keyboard entered password with the stored passwords and enables the user to access the system when the entered password matches the previously stored password." *Id.* at 1:21–28. In Rissanen's proposed solution, "[u]sers are initially entered into a password database stored in the computer system by assigning each

user an account code and a password, such as consisting of a number of numerical digits." *Id.* at 2:26–29.

Petitioner makes clear that "[a]lthough Rissanen also describes using spoken voice passwords, this Petition cites it for its more pedestrian teachings relating to database storage of passwords of any form." Pet. 12.

c. Overview of Vetter

Vetter is an IEEE Computer Society Magazine article discussing available tools for conducting teleconferencing over the Internet. According to Vetter, "[v]ideoconferences are becoming increasingly frequent on the Internet and are generating much research interest." Ex. 1005, 77. Vetter states that "the emerging multicast backbone (or MBone) can efficiently send traffic from a single source over the network to multiple recipients," and, "[a]t the same time, many workstations attached to the Internet are being equipped with video capture and sound cards to send and receive video and audio data streams." *Id.* Vetter concludes that "[t]he price/ performance of these hardware devices has finally reached a level that makes wide-scale deployment possible, which is perhaps the most important factor in the recent growth of videoconferencing applications." *Id.*

Vetter also describes challenges that faced implementation of audio, graphic, and video tools on the Internet, including "disturbing feedback when the microphones at multiple sites were left 'open' during a discussion," taking too much time to broadcast a simple graphic image to multiple participants when using "Whiteboard tools" (collaborative software tools that support a shared desktop whiteboard among a group of distributed users on the Internet), and use of video during a classroom presentation that

caused the workstations in the classroom lab to lock up. *Id.* at 78–79. Vetter also notes that the physical distance between two points on the Internet can be different from the electronic distance between those points. *Id.* at 79.

Vetter discusses in particular a CU-SeeMe platform from Cornell University that supported video and audio conferencing over the Internet, and a CU-SeeMe Reflector that allowed multiparty conferencing with CU-SeeMe. *Id.* at 78.

d. Overview of Pike

Pike is a reference and guide book for using the Web browser Mosaic. Ex. 1006, 2. Petitioner cites to Pike's discussion of URLs and hyperlinks. According to Pike, URLs were developed as a standard way of referencing items on the World Wide Web. *Id.* at 38. "A *URL* is a complete description of an item, containing the location of the item that you want to retrieve. The location of the item can range from a file on your local disk to a file on an Internet site halfway around the world." *Id.*

Pike also describes adding auxiliary software to Mosaic to allow Mosaic to handle documents it otherwise would not be able to handle. *Id.* at 55. For example, a user "may want to obtain additional software to allow Mosaic to handle things such as pictures, sounds, and animations (movies)" and could find such additional software at an anonymous FTP site identified in Pike. *Id.* at 55–56. According to Pike, "[a]fter you have a viewer installed and Mosaic knows where to find it and what type of files it displays, you can load files of that type and Mosaic automatically starts the viewer to display them." *Id.* at 96.

e. Overview of Westaway

Westaway is directed to "methods and apparatus for automatically loading missing system software without terminating current processing operations being executed by the data processing device in a data processing system." Ex. 1007, 1:10–16. Specifically, Westaway describes a system including "a plurality of data processing devices ('agents')" coupled to a network. *Id.* at 1:18–20. "System software resources," such as a disk drive or optical storage device coupled to the network, provide system software to agents on the network. *Id*. at 1:20–24. "In the event an agent requires certain software for execution, and the software is not available on the agent's local hard disk drive or internal memory, then it [is] accessed from one of the system software resources such as a disk drive, tape drive or the like." *Id.* at 1:24–29.

f. Overview of Lichty

Lichty is a book intended as a "tour guide" of America Online ("AOL"), an online email service, Internet gateway, and community. Ex. 1008, 1–3. Petitioner (Pet. 58–59) focuses on Lichty's description of AOL's real-time interactive "People Connection" feature. Ex. 1007, 251–78. People Connection includes chat rooms in which a user communicates with others by posting text messages to the other participants in a chat room. *Id*. at 252–55. Lichty describes, in particular, that a People Connection interface includes an "Ignore" button. *Id.* at 268–69. According to Lichty, "[i]f you wish to exclude a member's comments (or those of all the members in a conversation in which you're not interested), select the member's name in the People in this Room window and click the Ignore button. From then

on, that member's text will not appear on your screen." *Id.* at 269; *see also id.* at 510 (glossary definition of "Ignore—(1) Chat blinders; a way of blocking a member's chat from your view in a chat/conference room window. Ignore is most useful when the chat of another member becomes disruptive in the chat room.").

3. Claim 1, Differences Between the Claimed Subject Matter and the Prior Art, and Reasons to Modify or Combine

For the reasons given below, we conclude that Petitioner has not shown that claim 1 would have been obvious over Roseman, Rissanen, Vetter, Pike, and Westaway.

Petitioner contends that Roseman teaches the majority of the limitations of claim 1, but cites the remaining references for the following, should we determine that Roseman lacks such a teaching:

> Rissanen for a teaching that tokens could have been stored in a database;
>
> Vetter for a teaching that Roseman's communications could have been over the Internet;
>
> Pike for a teaching of URLs; and
>
> Pike and Westaway teachings of external software applications used to view certain types of content.

Pet. 7–8.

Claim 1 recites "a controller computer system," including a "controller computer," that communicates with "each of a plurality of participator computers." Petitioner contends (Pet. 17) that Roseman describes a "host computer" that communicates with "local computers" that

are used by the parties to a videoconference, the host computer overseeing the conference. Ex. 1003, 1:42–52; 3:14–19. With respect to the "Internet network" limitations, the Petition relies on combining the teachings of Roseman with Vetter. Pet. 17–19, 24. As Petitioner notes (*id.*), Vetter indicates explicitly that "[v]ideoconferences are becoming increasingly frequent on the Internet," and describes software that supports "video and audio conferencing over the Internet," including "multiparty conferencing." Ex. 1005, 77–78. Further, relying on Dr. Lavian's testimony, Petitioner asserts that a person of ordinary skill would have recognized Roseman's reference to connections via commercially available WANs to implicate the Internet. Pet. 17–18 (citing Ex. 1002 ¶ 51). According to Dr. Lavian, a person of ordinary skill in the art would have been motivated to combine the teachings of Roseman and Vetter, such that the videoconference communications described in Roseman occur over the Internet, based on the above disclosures of Vetter and Roseman, as well as the artisan's background knowledge regarding the Internet. Ex. 1002 ¶ 54.

As to "a respective authenticated user identity corresponding respectively to each of a plurality of participator computers," the Petition relies on Roseman's discussion of "keys" provided to invitees to a videoconference—for example, a "Level 1 key" that is restricted to a specific user only—which are used by the invitees to access the conference and enable communications among the users and the host computer. Pet. 21–23 (citing Ex. 1003, 9:34–55, 10:61–65, 11:10–17).

With respect to "a database which serves as a repository of tokens for other programs to access," as recited in claim 1, Petitioner cites to the combination of Roseman and Rissanen. Pet. 26–33. Petitioner contends that

Roseman's "keys" are blocks of data that are associated with users' identities and, thus, are tokens. *Id.* at 26–27. As explained above, Roseman describes that an invitor, in setting up a meeting, creates an invitation that includes a key that conforms to an invitation level. Ex. 1003, 9:34–48. A key "is an electronic object attached to the invitation." *Id.* at 9:54–55. The "level" of a key determines who can use it. For example, "Level 1 keys may not be passed to any other person and may not be copied." *Id.* at 9:42–44. According to Roseman, "[t]o open a door with a key, the user drops the key onto the door lock. If the key is valid and the user has the authority to use the key, the door opens and the user is admitted to the room." *Id.* at 10:61–64.

As to "a database which serves as a repository of tokens for other programs to access," as recited in claim 1, Petitioner argues that Roseman explains that each conference room "knows" about each key to that room, reasoning that Roseman, thus, teaches the host computer storing each key so users' keys can be recognized. Pet. 27–28 (citing Ex. 1003, 9:49–51; Ex. 1002 ¶ 68). Once a key is recognized and a user is granted access to a room, each of the participants in the room are notified of the user's entry, and data (e.g., the video signal of the user) is communicated to the participants. Ex. 1003, 10:61–65, 11:11–17. According to Petitioner, Roseman indicates that each virtual conference room provided by the host computer "is actually a combination of stored data and computer programs." Pet. 30 (quoting Ex. 1003, 12:16–18). Therefore, Petitioner asserts that Roseman teaches "other programs" (i.e., the conference rooms) accessing a central repository of tokens (i.e., keys), thereby affording information to

each of the participator computers (i.e., communicating data to each participant in a conference).

Petitioner additionally argues that Rissanen teaches storing user authentication information, such as user identity information and passwords, in a database, and that such teaching would have been applicable to the keys of Roseman. Pet. 28–29. Petitioner argues that Roseman's keys are analogous to user identity and passwords. *Id.* Petitioner further argues that storing keys in a database is one of a finite number of known solutions for verifying whether a previously issued key matches to a key later presented by a user to access a conference room. Pet. 30 (citing Ex. 1002 ¶¶ 71–72).

As to "affording information to each of the participator computers," as recited in claim 1, Petitioner argues that Roseman describes allowing a user to communicate with others in the conference (e.g., by audio and video links, and by placing documents on a virtual table), upon that user being admitted via acceptance of a key. Pet. 31–32 (citing Ex. 1003, 8:1–4, 11:11–22).

Regarding participator computers that are "otherwise independent of each other," Petitioner argues that each of Roseman's local computers is independent of the others because the computers are located at different geographic locations and only become part of a virtual conference when connected to the host computer. Pet. 32–33 (citing Ex. 1003, 3:14–19).

The Petition identifies Roseman's description of conference participants placing a document or file onto the virtual conference table as an example of "communicat[ing] a pointer-triggered private message from a first of said participator computers to said controller computer and from said controller computer to a second of said participator computers," as recited in

claim 1. Pet. 24–26, 34. Roseman describes a procedure where a participant in a conference can "drag-and-drop" a file from the participant's computer onto the table in the virtual conference room. Ex. 1003, 8:1–13, Figs. 10, 11. According to Roseman, the file may be "of any suitable kind: data, text, or graphic." *Id.* at 8:1–4. Roseman indicates that the participant may do this by dragging an icon "represent[ing]" the file. Ex. 1003, 8:1–13. When any participant "activates" the icon on the table, the file associated with the icon is "presented" on the table by the host computer and sent to all participants. *Id.* at 14:58–61. Petitioner contends that this icon is a "pointer-triggered message" because the icon contains information that points to and is used to present an underlying document. Pet. 35.

Petitioner further argues that, to the extent that a "pointer" requires an Internet URL or the like, a skilled artisan would have consulted Pike for a teaching of basic Internet concepts, such as URLs. Pet. 36–39. According to Petitioner, "[t]his would have predictably resulted in the virtual conferencing system of Roseman in which the clickable icons used to access content (such as a document placed on the table) included a URL that identified the location of the document on the host computer." *Id.* at 36–37. Petitioner argues that Pike's URL would "identify content stored on the host computer of Roseman which, upon activation, would fetch the requested content and transmit it to second meeting participant computer over the Internet." *Id.* at 37. Petitioner argues that this would have saved bandwidth "because the file content need not be communicated from the host computer to the participant (thus consuming network bandwidth) unless the participant requests to view the content by invoking the URL." *Id.* at 38. Thus, Petitioner argues that Roseman's icon causes the second participator

computer to fetch and receive the underlying content by virtue of the host fetching and receiving the content and forwarding it to the second participator computer. *Id.* at 41.

The parties dispute whether the prior art teaches

> such that the second of said participator computers internally determines whether or not the second of the participator computers can present the communication, if it is determined that the second of the participator computers can not present the communication then obtaining an agent with an ability to present the communication,

as recited in claim 1. PO Resp. 36–38; Reply 22–23. Petitioner concedes that "Roseman does not appear to contemplate the scenario in which the second participant computer ***internally determines that it cannot present the communication***." Pet. 43. According to Petitioner, however the combination of Roseman, Pike, and Westaway teaches these limitations. *Id.* at 42–50.

Specifically, Petitioner contends that Pike "discloses the '**determining**' and '**obtaining**' steps" of claim 1. *Id.* at 44. Petitioner argues that Pike "explains that there may be occasions when a user receives information over the Internet but his or her computer lacks the software needed to view it." *Id.* at 43 (citing Ex. 1006, 55–56). Here, Pike notes that, while the Mosaic Web browser displays normal Web documents, it might not handle things like pictures, sounds, and movies. Ex. 1006, 55. In those instances, Pike explains, a user could obtain additional software to handle such things at an anonymous FTP site, using an address Pike specifies. *Id.* at 55–56. As Petitioner notes, Pike explains that once a user has installed an external viewer in Mosaic, Mosaic knows where to find the viewer and automatically invokes it to display files supported by the viewer. Pet. 44

(citing Ex. 1006, 96). According to Petitioner, this functionality teaches that a computer with Mosaic must internally determine that it cannot display a file because "if it cannot read the file using Mosaic, and it cannot locate an appropriate viewer application, it cannot present the communication." *Id.* Here, Petitioner assumes that the claim language does not require the "obtaining" limitation to be performed automatically without user involvement—in other words, Petitioner argues that the "obtaining" limitation is satisfied by a user manually obtaining and installing an agent with an ability to present a communication after a participator computer internally determines that it cannot present the communication. *Id.* at 45.

Alternatively, if we determine that the claim language requires the "obtaining" limitation to be performed automatically, Petitioner contends that this is taught by Westaway. *Id*. Westaway explains in its Background of the Invention, that, in the event that a software data processing agent lacked certain software necessary to execute a file, the agent would attempt to access that software from a disk drive, tape drive, or the like. Ex. 1007, 1:24–29. Petitioner contends that this shows an agent automatically obtaining requisite software if there has been a determination that the system cannot execute a certain process. Pet. 47. Westaway's Background further explains that, when an executing process would attempt to use software that had not yet been loaded onto the system's software resources, the system would generate a "file not found" message instead of finding and loading the required programs without causing a termination of the executing process. Ex. 1007, 1:47–51, 1:64–2:2. Petitioner argues that this evidences an agent that internally determines whether or not it can present the file. Pet. 46. Petitioner notes that "[a]lthough Westaway does not expressly disclose that

the software determined to be missing and then obtained can include software for 'present[ing] [] communication,' that was already disclosed by Pike, as explained previously, which expressly contemplates that additional software may be required to present certain types of communications." *Id.* at 47.

Petitioner contends that it would have been predictable to combine Roseman, Pike, and Westaway. *Id.* at 47–48. Petitioner argues that "it was routine that a user could receive a document from someone else but be unable to open or access it because the user lacked the correct software" and that this would have been particularly applicable to Roseman because its system allowed a participant to drag and drop an icon of a document onto a table of a virtual conference room. *Id.* at 48. Petitioner contends that the teachings of Pike and Westaway would have been applied because of the possibility that a meeting participant would place a document on the table that other participants would not have the correct software to view. *Id.* at 49. In those instances, Petitioner argues, the skilled artisan would have followed the teachings of Pike and Westaway to obtain an external viewer software to handle files not supported by the participant's already-installed software. *Id.*

In response, Patent Owner argues that the '245 patent only describes these limitations in the context of participator software invoking an external data type viewer on demand of the operator of the participator software. PO Resp. 34–36 (citing Ex. 1001, 7:34–55). This is consistent with the language of claim 1, which recites "the *second of said participator computers* internally determines whether or not the second of the participator computers can present the communication" and "if it is determined that the *second of the participator computers* can not present the

communication then obtaining an agent with an ability to present the communication." Patent Owner argues that "Petitioner does not identify any software on the users' computers that could qualify as participator software" and contends that Roseman actually teaches the contrary and describes "that all graphics are generated on the host computer." *Id.* at 36 (citing Ex. 1003, 1:43–46, 14:48–50).

In the passages cited by Patent Owner, Roseman describes a host receiving communications from participant computers and generating a common video screen, which it sends to all of the participator computers:

> The parties send the information which they want displayed, such as drawings, to the host computer. The host computer generates a common video screen, which it distributes to the parties: they see the drawings at their own local computers.

Ex. 1003, 1:43–46. Other disclosure in Roseman confirms that its system operates in this manner. *Id.* at 7:30–34 ("[T]he host creates the conference room. The host does this by creating a common image, such as that shown in FIG. 9. The common image includes a picture of each invitee, a 'table,' and the room decor.").

The portions of Roseman cited by Petitioner (Pet. 42–43) also support Patent Owner's explanation of Roseman's system. For example, in its description of placing documents on a conference table, Roseman states that "[e]ach Invitee can transmit a file (of any suitable kind: data, text, or graphic) to the host, and the host will place the file onto the table, where all participants can see it." Ex. 1003, 8:1–4. Roseman's pseudo code, which both parties cite (PO Resp. 36; Pet. 42–43), makes clear that documents are received by the host and communicated to all of the participants as a common display:

IF PARTICIPANT DRAGS ICON TO THE TABLE ON HIS SCREEN

ICON (DATA FILE) TRANSMITTED TO HOST

HOST TRANSMITS ICON (DATA FILE) TO TABLE OF EACH PARTICIPANT

IF ANY PARTICIPANT ACTIVATES ICON ON TABLE DATA FILE PRESENTED ON TABLE BY HOST

HOST SENDS OPEN FILE TO ALL PARTICIPANTS TABLES

Ex. 1003, 14:53–62.

The disclosure in Roseman cited by both Petitioner and Patent Owner describes that the software that processes and renders images operates on Roseman's host. Indeed, Petitioner admits that "Roseman does not appear to contemplate the scenario in which the second participant computer ***internally determines that it cannot present the communication***." Pet. 43. Thus, Petitioner must show that this feature is taught elsewhere and that a skilled artisan would have had reason to combine that teaching with Roseman.

We are not persuaded that Pike provides that teaching. Petitioner relies on a description in Pike that a user could manually seek and install software to add to Mosaic. Pet. 43–44. Petitioner, however, does not explain why a skilled artisan would have incorporated this feature into Roseman's local computers (participator computers) in light of Roseman's system, which processes images at the host, not the local computers. The most logical reading of Roseman is that its local computers already have software sufficient to render the common image that the host provides to them. Thus, Petitioner's argument that Pike and Westaway would have been

applied because of the possibility that a meeting participant would place a document on the table that other participants would not have the correct software to view (Pet. 49) is not applicable to Roseman. Petitioner has not explained why, in the case where the *host* is unable to present a communication received from a local computer as part of its common image, a local computer would make an internal determination to that effect, or why users at the local computers would seek out software to present the communication.

Petitioner's arguments with respect to Westaway suffer from the same deficiencies. Although Petitioner cites to Westaway for a teaching of a program determining that it cannot present a communication and obtaining software that can (Pet. 45–47), Petitioner does not explain persuasively why a skilled artisan would have applied these teachings to Roseman such that Roseman's local computers would have implemented the functionality.

Petitioner simply states, without persuasive reasoning or evidence, that "[i]t would have been obvious to adapt the teachings of Pike and Westaway to Roseman, predictably resulting in the videoconferencing system of Roseman in which participant local computers determine whether or not they can present a particular communication." Pet. 48. Petitioner cites only to Dr. Lavian, who merely repeats Petitioner's argument, nearly verbatim, without citation to the basis for his testimony. *Id.* (citing Ex. 1002 ¶ 101). Thus, Dr. Lavian's testimony does not add materially to Petitioner's unpersuasive attorney argument. Moreover, Petitioner's position on this limitation is inconsistent with its arguments as to the "pointer-triggered private message" limitation, in which Petitioner argues for a system in which "a person of ordinary skill in the art [would] use the ubiquitous Internet URL

to identify content stored on the host computer of Roseman which, upon activation, would fetch the requested content and transmit it to [a] second meeting participant computer over the Internet" (i.e., Petitioner concedes it is the host in Roseman that fetches the requested content, not the local computers). *Id.* at 37.

At most, Petitioner's contentions establish that a skilled artisan applying Pike's and Westaway's teachings to Roseman's system would have modified Roseman's host to seek out appropriate software to process communications it otherwise could not present. Petitioner has not shown that a skilled artisan would have further modified Roseman's system to move this processing from the host to each individual local computer and has not provided any persuasive reason to make such a modification.

Therefore, we find that Petitioner has not shown that Roseman, Pike, and Westaway teach

> such that the second of said participator computers internally determines whether or not the second of the participator computers can present the communication, if it is determined that the second of the participator computers can not present the communication then obtaining an agent with an ability to present the communication,

as recited in claim 1. Accordingly, Petitioner has not shown, by a preponderance of the evidence, that claim 1 would have been obvious over Roseman, Rissanen, Vetter, Pike, and Westaway.

4. Claims 7 and 19

Independent claims 7 and 19 are apparatus claims similar in most respects to claim 1. In particular, claim 7 recites

> the second of the participator computers determines internally whether or not the second of the participator computers can present the communication, if it is determined that the second of the participator computers can not present the communication then obtaining an agent with an ability to present the communication;

and claim 19 recites

> the second participator computer internally determines whether or not the second participator computer can present the pre-stored data, if it is determined that the second participator computer can not present the pre-stored data then obtaining an agent with an ability to present the pre-stored data.

Petitioner contends that these limitations are taught by Roseman, Pike, and Westaway for the same reasons, detailed above, Petitioner gives for the corresponding limitation of claim 1,

> such that the second of said participator computers internally determines whether or not the second of the participator computers can present the communication, if it is determined that the second of the participator computers can not present the communication then obtaining an agent with an ability to present the communication.

Pet. 55; '709 Pet. 48–55 (substantially copying Pet. 42–49).

For the reasons given above, Petitioner has not shown that Roseman, Pike, and Westaway teach this limitation of claim 1. For the same reasons, Petitioner has not shown that Roseman, Pike and Westaway teach the corresponding limitations of claims 7 and 19. Accordingly, Petitioner has not shown, by a preponderance of the evidence, that claims 7 and 19 would have been obvious over Roseman, Rissanen, Vetter, Pike, and Westaway.

5. Claims 6 and 8

Claims 6 and 8 depend from claims 1 and 7, respectively, and add "wherein the computer system further determines that the message is not censored."

Petitioner argues that this limitation would have been obvious over Roseman and Lichty. Pet. 57–60. Nevertheless, Petitioner's evidence and argument for this limitation do not overcome the deficiencies noted above for claims 1 and 7. Thus, Petitioner has not demonstrated, by a preponderance of the evidence, that claims 6 and 8 would have been obvious over Roseman, Rissanen, Vetter, Pike, Westaway, and Lichty.

6. Remaining Challenged Dependent Claims

We have analyzed Petitioner's evidence and argument for claims 2–5, 9–15, 17, 18, 22–25. Pet. 50, 55–57, 61–63; '709 Pet. 56–58. Petitioner's evidence and argument for the additional limitations of these dependent claims do not overcome the deficiencies noted above for claims 1, 7, and 19. Thus, Petitioner has not demonstrated, by a preponderance of the evidence, that claims 2–5, 9–14, and 22–25 would have been obvious over Roseman, Rissanen, Vetter, Pike, and Westaway, or that claims 15, 17, and 18 would have been obvious over Roseman, Rissanen, Vetter, Pike, Westaway, and Lichty.

III. PATENT OWNER'S MOTION TO EXCLUDE

Patent Owner filed a paper styled "Motion to Exclude Evidence," seeking to exclude certain portions of the 2nd Lavian Declaration that it argues exceeds the proper scope of a reply. Paper 38, 1. In particular,

Patent Owner seeks to exclude portions of paragraphs 54 and 74 of the 2nd Lavian Declaration. *Id.* at 2–4. Petitioner opposes this motion on the ground that it is not directed to the admissibility of evidence and, therefore, is procedurally improper. Paper 41, 2. We do not consider paragraphs 54 and 74. Moreover, even if we were to consider the evidence Patent Owner seeks to exclude, Petitioner still has not shown, by a preponderance of the evidence, that any claim of the '245 patent is unpatentable. Accordingly, we dismiss Patent Owner's Motion to Exclude as moot.

III. CONCLUSION

Petitioner has not proved by a preponderance of the evidence that claims 1–15, 17–19, and 22–25 are unpatentable.

IV. ORDER

For the reasons given, it is:

ORDERED, that Petitioner has not shown, by a preponderance of the evidence, that claims 1–15, 17–19, and 22–25 are unpatentable;

FURTHER ORDERED, that Patent Owner's Motion to Exclude is dismissed as moot; and

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

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