Trials@uspto.gov
571-272-7822

Paper No. 47
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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 IPR2016-01158
Patent 8,473,552 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

I. INTRODUCTION

A. Background

Facebook, Inc. ("Petitioner") filed a Petition (Paper 1, "Pet.") to institute an *inter partes* review of claims 1–61 and 64 of U.S. Patent No. 8,473,552 B1 (Ex. 1001, "the '552 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 1–59 and 64, but not claims 60 and 61.

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.").

An oral argument was held on October 19, 2017 (Paper 46, "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 1–59 and 64. Based on the record before us, Petitioner has proved, by a preponderance of the evidence, that claims 2, 3, 5, 7, 10–17, 59, and 64 of the '552 patent are unpatentable, but has not proved that claims 1, 4, 6, 8, 9, and 18–58 are unpatentable.

B. Related Matters

The parties indicate that the '552 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 '552 patent was the subject of *inter partes* review petitions in IPR2016-01138, IPR2016-01137, IPR2016-01146, and IPR2016-01147. Paper 4, 1–2. The '552 patent also was the subject of IPR2017-00603, which Microsoft Corp. filed and sought to join with this proceeding prior to settling with Patent Owner. Patents related to the '552 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");

TOM LICHTY, THE OFFICIAL AMERICA ONLINE FOR MACINTOSH MEMBERSHIP KIT & TOUR GUIDE (2nd ed. 1994) (Ex. 1007, "Lichty").

D. The Instituted Ground

We instituted a trial on the ground of unpatentability of claims 1–59 and 64 as obvious, under 35 U.S.C. § 103(a), over Roseman, Rissanen, Vetter, Pike, and Lichty. Dec. 37.

E. The '552 Patent

The '552 patent describes an Internet "chat room." According to the '552 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 '552 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

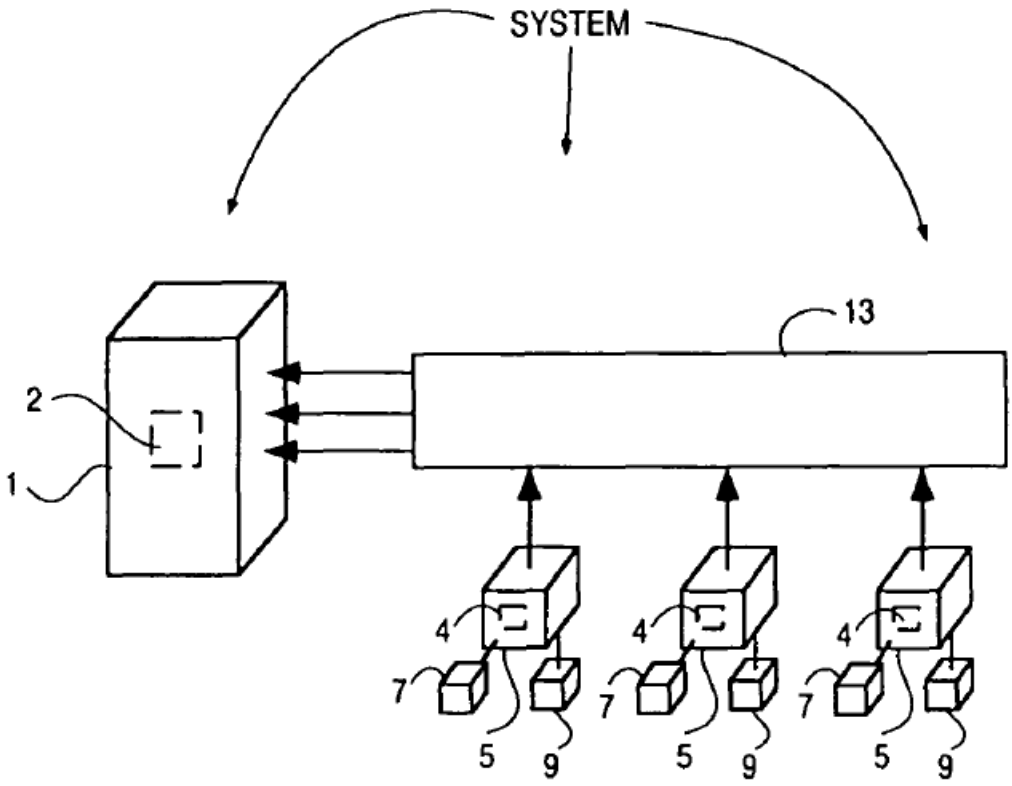

Figure 1 is a block diagram showing the components and data flow of a computerized human communication arbitrating and distributing system. *Id.* at 4:50–54. The system includes a controller computer (shown as 1 in Figure 1 but described as 3 in the written description) in communication with several 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 4:55–5:7.

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 5:8–14. The software uses "identity tokens," or pieces of information associated with user identity, in the arbitration. *Id.* at 7:61–64. The tokens are stored in memory 11 in a control computer database along with personal information about the users. *Id.* at 7:64–8:2.

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 8:8–20. 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 8:24–32.

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 5:25–30.

Claim 2, reproduced below (disputed terms in italics), is illustrative of the claimed subject matter:

> 2. A method of communicating *via an Internet network* by using a 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 a plurality of participator computers which are otherwise independent of each other, wherein the controller computer system is programmed to *provide access to the controller computer system via any of two client software alternatives*, wherein both of the two client software alternatives allow the respective user identities to be recognized by the controller computer system and allow at least some of the participator computers to form at least one group in which members can send communications and receive communications from another of the members, wherein at least some of the communications are received in real time via the Internet network, and wherein the at least one of client software alternatives *allows the controller computer system to determine whether at least one of the user identities, individually, is censored from data* representing at least one of a pointer, video, audio, graphic, and multimedia such that the data that is censored is not presented by the corresponding participator computer, the method including:
>
> affording some of the information to a first of the participator computers via the Internet network, responsive to an authenticated first user identity;
>
> affording some of the information to a second of the participator computers via the Internet network, responsive to an authenticated second user identity;
>
> permitting at least the first user identity and the second user identity to form a group; and
>
> permitting sending communications in real time, via the Internet network, among the participator computers corresponding to the user identities in the group, wherein at least some of the communications include messages comprising more than one data

> type, and at least some other of the communications include *a pointer that produces a pointer-triggered message on demand*.

II. ANALYSIS

A. Claim Construction

1. Constructions in the Institution Decision

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).

In the Institution Decision, we preliminarily construed the following terms (Dec. 7–15):

Claim Term	**Preliminary Construction**
"token"	"piece of information associated with user identity"
"database"	"a collection of logically related data"
"censor"	"control what is said in a group"
"at least one of the user identities, individually, is censored from data"	refers to control of data received by the at least one of the user identities, individually, and is not limited to data suppressed based on the content of those data or by a moderator
"pointer"	"a link or reference to a file, data, or service"

Claim Term	Preliminary Construction
"a pointer-triggered message on demand"	"a message, where the content of the message is specified by a pointer and found on demand of the operator of the participator software"

Patent Owner adopts our construction of "token" (which Petitioner initially proposed) PO Resp. 8, and challenges our constructions of "database" and "censor," *id.* at 8–13. Petitioner accepts our constructions of "database" and "censor" and presents arguments in favor of those constructions. Reply 1–7. We maintain our construction of "token" on the complete record. We address the constructions of "database" and "censor," below, as well as the construction of the related term "at least one of the user identities, individually, is censored from data." Neither party challenges our constructions of "pointer" and "a pointer-triggered message on demand," and we maintain those constructions on the complete record.

2. "database"

In the Petition, relying on Dr. Lavian's testimony, Petitioner argues that "[a] person of ordinary skill in the art would have understood the claimed 'database' under its broadest reasonable construction to simply refer to a stored collection of tokens. The patent does not require that the database be any particular type, such as relational." Pet. 19 (citing Ex. 1002 ¶ 56). Dr. Lavian, in turn, relies on the specification's description of tokens being "stored in memory 11 in a control computer database, along with personal information about the user, such as the user's age." Ex. 1002 ¶ 56 (citing Ex. 1001, 7:64–66).

Patent Owner urges a construction that is narrower in two regards: (1) Patent Owner contends that a database is a collection of logically-related data "which is stored with persistence"; and (2) Patent Owner contends that a database includes "associated tools for interacting with the data such as a DBMS." PO Resp. 12.

Patent Owner's primary argument in favor of construing "database" to require these limitations is that it filed, in a related application before the Patent Office, an information disclosure statement (IDS) that supports its construction. *Id.* at 9–10 (citing Ex. 2008). The IDS was submitted to the Patent Office in pending application 14/246,965 on January 1, 2017, after Petitioner filed the Petition and shortly after we instituted this proceeding and preliminarily rejected Patent Owner's claim construction arguments. In the IDS, Patent Owner argued, *inter alia*, that "attention is respectfully drawn to the defendants' contentions[1] of invalidity in view of the database and 'other programs' limitations that are common to all claims" and that "[b]ecause the database affords information to other programs and computers, it must store the data, such as the tokens, with persistence, such that tools can interact with the data such as a DBMS when providing the data to the participator computers of the authenticated users." Ex. 2008, 2. Patent Owner argues that we must accept its construction pursuant to *Verizon Services Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1306 (Fed. Cir. 2007), which held that, in some circumstances, a statement made by a patentee in the prosecution history of a related application can operate

[1] This appears to be a reference to invalidity contentions filed in a related district court proceeding.

as a disclaimer, even if the disclaimer occurred after the patent-in-suit had issued. PO Resp. 10.

Although we doubt that the Federal Circuit intended that an IDS in a related application should be a vehicle for overturning a disadvantageous claim construction in an adversarial proceeding,[2] we need not reach that issue. As the Federal Circuit also held, "[t]o operate as a disclaimer, the statement in the prosecution history must be clear and unambiguous, and constitute a clear disavowal of claim scope." *Verizon*, 503 F.3d at 1306. That is not the case here. The statements in Patent Owner's IDS are not in response to any rejection by the Examiner, do not accompany any

[2] *See Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1270 (Fed. Cir. 1986) ("A citation may be made at 'any time' either during prosecution or, as here, after the patent has issued. If made during prosecution, it is clear that the statements may be considered for claim interpretation purposes, just as any other document submitted during prosecution. If submitted after issuance, the answer, again, is it may be considered. To say that it *may* be considered is not to say what *weight* statements in the Citation are to be accorded. For example, a Citation filed during litigation might very well contain merely self-serving statements which likely would be accorded no more weight than testimony of an interested witness or argument of counsel. Issues of evidentiary weight are resolved on the circumstances of each case."); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005) (en banc) ("Like the specification, *the prosecution history provides evidence of how the PTO and the inventor understood the patent*. . . . Yet because the prosecution history represents an ongoing negotiation between the PTO and the applicant, rather than the final product of that negotiation, it often lacks the clarity of the specification and thus is less useful for claim construction purposes." (emphasis added)).

amendments, and are not directed to any particular claims, other than a general statement that the statements apply to "all claims."[3] Ex. 2008, 2.

Although Patent Owner argues that the IDS "supports the construction that a database is limited" in the manner that it argues, Patent Owner does not contend that the IDS constitutes a disclaimer of any subject matter. PO Resp. 10. We find that the IDS does not contain a "'clear and unmistakable' disclaimer that would have been evident to one skilled in the art." *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1064 (Fed. Cir. 2016). Therefore, we are not persuaded that we should apply prosecution history disclaimer to limit the scope of the term "database."

Patent Owner also cites to the testimony of Dr. Carbonell that "[t]wo hallmarks of a database are (1) persistence of the data, and (2) interactivity with the data via a database management system (DBMS)." *Id.* (quoting Ex. 2005 ¶ 33). As Petitioner points out (Reply 1–2), Dr. Carbonell's testimony on this point appears to be a copy of the testimony of Dr. Bajaj, who submitted a declaration in support of Patent Owner's Preliminary Response (*compare* Ex. 2005 ¶ 33, *with* Ex. 2001 ¶ 20), although Dr. Carbonell testified that he was unaware of Dr. Bajaj's declaration (Ex. 1016, 132:2–12). In any case, as Petitioner points out, Dr. Carbonell marshals the same evidence that did not persuade us at the institution stage without adding any additional evidence or even acknowledging our concerns with Dr. Bajaj's evidence. Reply 2 n.1.

[3] Adding to the ambiguity, it is not clear whether the IDS's reference to "all claims" refers to the claims in the pending application or the claims discussed in the defendants' contentions of invalidity to which the sentence is directed.

In particular, Patent Owner and Dr. Carbonell cite to the Macmillan Encyclopedia of Computers (Ex. 2004). PO Resp. 10–11; Carbonell Decl. ¶ 33. In the portion included in Exhibit 2004, The Macmillan Encyclopedia states that "[a] database system is a collection of related records stored in a manner that makes the storage and retrieval of the data very efficient. The four well-known data models for databases are the hierarchical, network, relational, and object-oriented models." Ex. 2004, 230. This definition does not require persistence and Patent Owner does not explain why persistence should be inferred from this definition. Moreover, as we observed in the Institution Decision, the Macmillan definition is consistent with the definition of "database" given by the IEEE Dictionary of Standards Terms. *See* IEEE 100 THE AUTHORITATIVE DICTIONARY OF IEEE STANDARDS TERMS 268 (7th ed. 2000) ("**database (DB)** . . . A collection of logically related data stored together in one or more computerized files.") (Ex. 3001). This definition also does not require persistence. Although this dictionary was published several years after the filing date of the '552 patent, Dr. Lavian testifies that the plain and ordinary meaning of "database" did not change during this time. Ex. 1021 ¶ 11. In support of this testimony, Dr. Lavian cites to a 1991 textbook, which defines "database" as "a collection of interrelated data," yet another definition that does not require "persistence." *See* Ex. 1017, 5. Moreover, we observe that Patent Owner provides no boundaries for "stored with persistence" to meaningfully limit the term. For example, all data accessed and stored by a program while the program is executing has some level of "persistence."

As to a DBMS, Macmillan explains:

> A database management system (DBMS) is a software package. Its main functions are (1) to provide the facility to set up the database, (2) to retrieve and store source data (actual data in the database), (3) to retrieve and store the data about the structure of the database (data dictionary), (4) to provide the facilities to enforce security rules, (5) to back up the database, and (6) to control the concurrent transactions so that one user's environment is protected from others.

Ex. 2004, 231. Patent Owner characterizes the DBMS as "another criteria of a database" that provides interactive querying capability not present in "[s]tandard storage" in temporary or permanent memory. PO Resp. 11. Dr. Carbonell repeats Patent Owner's arguments without citation to evidence and in testimony that largely copies that of Dr. Bajaj. Ex. 2005 ¶¶ 33–36; *see also* Ex. 2001 ¶¶ 20–23. Nevertheless, we read Macmillan to describe a DBMS as software that works with a database, rather than a part of a database or a component that necessarily accompanies a database. Dr. Carbonell's testimony, which does not identify its bases, adds little to Macmillan. *See* 37 C.F.R. § 42.65(a) ("Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.").

Patent Owner also argues that the disclosure of the '552 patent imposes "persistence" and DBMS limitations on the claimed database because it describes the database as storing security information such as tokens for other programs to access. PO Resp. 12. Patent Owner does not provide a citation to the '552 patent in support of its argument. Nevertheless, Patent Owner argues, again without citation, that "[o]ne of ordinary skill in the art would have expected that this type of security feature

would persist in a location other than in program memory so that other user programs could access the information." *Id.* Finally, Patent Owner argues that the '552 patent describes tokens stored in hierarchies, which, according to Patent Owner, "are typical of database storage organization, and natural schema when storing and managing access to diverse information." *Id.* None of these arguments supports reading persistence or a DBMS into the term "database." We note also that the other claim language, "serves as a repository of tokens for other programs to access," is a requirement we evaluate separately and do not read into the term "database."

As noted in the Institution Decision (at 10), the specification describes a database consistently with the Macmillan and IEEE definitions, explaining that tokens are "pieces of information associated with user identity," that tokens are "stored in memory 11 in a control computer database, along with personal information about the user," and that "[i]n the database, the storage of tokens can be by user, group, and content." Ex. 1001, 7:61–8:5. The specification does not require a DBMS (or similar software) or impose a persistence requirement.

On the complete record, we maintain our construction of database, namely, "a collection of logically related data." This is the construction most consistent with both the intrinsic evidence and dictionary definitions. However, we note that Petitioner contends, and we find, that the prior art shows a database with persistence and associated tools for interacting with the stored data, as explained below.

3. "censor" / "at least one of the user identities, individually, is censored from data"

Claim 2 recites "the at least one of client software alternatives allows the controller computer system to determine whether at least one of *the user identities, individually, is censored* from data representing at least one of a pointer, video, audio, graphic, and multimedia such that the data that is *censored* is not presented by the corresponding participator computer." The other challenged independent claims include similar recitations. As noted above, we preliminarily construed "censor" to mean "control what is said in a group" and explained that "at least one of the user identities, individually, is censored from data" refers to control of data received by the at least one of the user identities, individually, and is not limited to data suppressed based on the content of those data or by a moderator. Dec. 13.

We based our construction on the description of that term in the specification. *Id.* at 12. Specifically, the specification describes censorship as follows:

> 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—quantity, type, and subject.

Ex. 1001, 8:24–32 (emphasis added). Here, the specification describes "censorship" as "broadly encompass[ing] control of what is said in a group" and includes an example in which an action is taken on a user, rather than the data itself.

Patent Owner argues that "censorship should be construed to be 'examine in order to suppress or delete anything considered objectionable.'" PO Resp. 13. According to Patent Owner, "[i]n order to control what is said in a group, it is necessary to first know what is said (or proposed to be said)." *Id.* Patent Owner argues that this is consistent with the meaning given to "censor" and "censorship" in dictionaries, including "to examine in order to suppress or delete anything considered objectionable" (Webster's Collegiate Dictionary (Ex. 2002)) and "[t]he action of preventing material that a party considers objectionable from circulating within a system of communication over which that party has some power" (Microsoft Press Computer Dictionary (Ex. 2003)).

We are not persuaded by Patent Owner's arguments, which essentially track those presented in the Preliminary Response (at 6–7). The claim language itself does not support a construction of "censor" limited to analysis of the content of data and suppression based on that content. Claim 2 recites "at least one of *the user identities, individually, is censored* from data." The claim language focuses on censoring a user identity and does not specify that such censoring is based on the content of the data. As explained above, the specification describes censorship as an action taken on a user, rather than the data itself. As explained in the Institution Decision (at 12–13), extrinsic evidence such as dictionary definitions "may be used only to help the court come to the proper understanding of the claims; it may not be used to vary or contradict the claim language." *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1584 (Fed. Cir. 1996); *accord Phillips*, 415 F.3d at 1317 ("[W]hile extrinsic evidence can shed useful light on the relevant art, we have explained that it is less significant than the intrinsic

record in determining the legally operative meaning of claim language.") (internal citations and quotation marks omitted).

On the complete record, in accordance with the specification's definition, "censor" means "control what is said in a group." In the context of claim 2, for example, "at least one of the user identities, individually, is censored from data" refers to control of data received by the at least one of the user identities, individually, and is not limited to data suppressed based on the content of those data or by a moderator. We apply the same definition of "censor" in interpreting similar language in the remaining challenged independent claims.

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.[4] *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

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

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

Relying on Dr. Lavian's testimony, Petitioner contends that a person of ordinary skill in the art "would have had 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." Pet. 7–8 n.1 (citing Ex. 1002 ¶ 14). Patent Owner does not contest this statement in its Response. In his testimony, Dr. Carbonell proposes a similar level of skill, namely "a bachelor's degree in computer science (or a related field) and at least one year of work experience in programming in computer communication methods." Ex. 2005 ¶ 18. Dr. Carbonell states that his opinions would not change under a determination that Dr. Lavian's opinion regarding the level of ordinary skill is correct. *Id.* On the complete record, we adopt Petitioner's statement of

the level of ordinary skill, although we note that Dr. Carbonell's statement of the level of skill is not materially different.

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, and Lichty. Pet. 7–8.

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

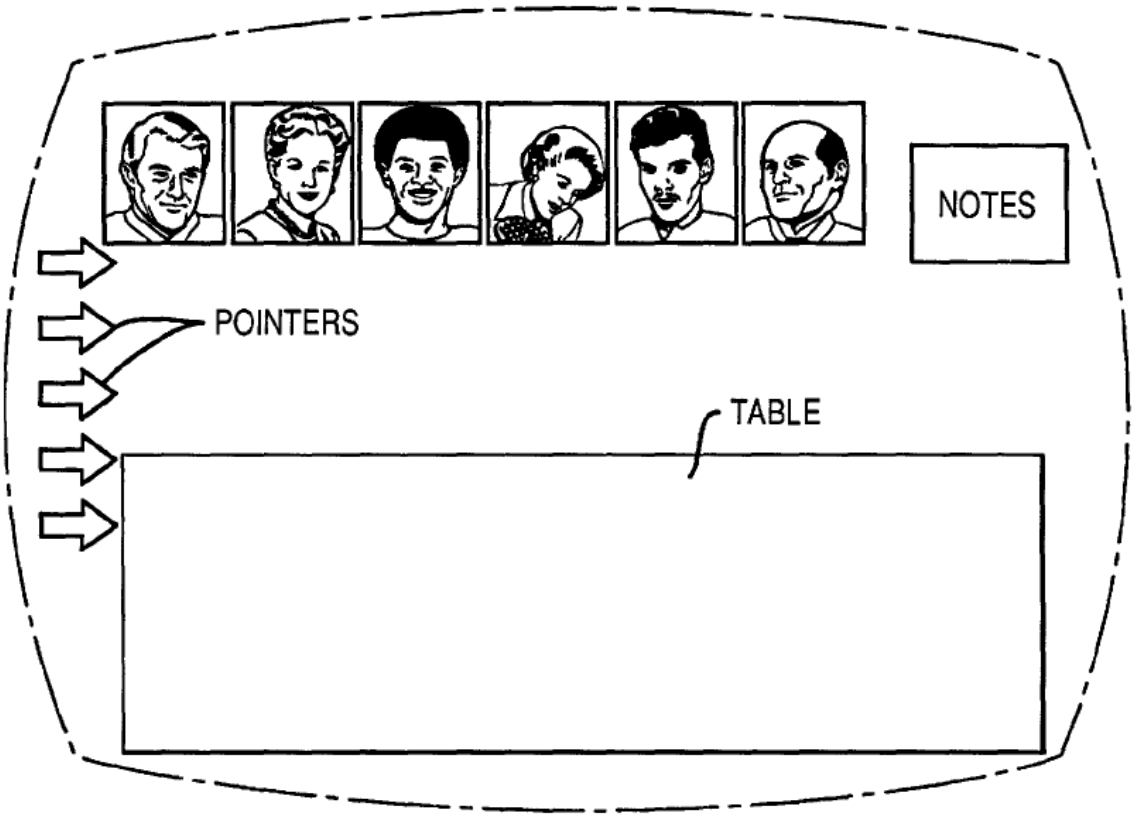

Figure 9 is a picture of a video screen that is generated by a host computer and distributed to all participants in a conference. *Id.* at 2:16–18.

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.*

e. 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. 1007, 1–3. Petitioner (Pet. 34) 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 2, Differences Between the Claimed Subject Matter and the Prior Art, and Reasons to Modify or Combine

Petitioner contends that Roseman teaches each limitation of claim 2, 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
>
> Lichty for a teaching of content filtering, in particular an "ignore" feature, which Petitioner equates to "censoring."

Pet. 7–8.

a. *"A method of communicating via an Internet network by using a 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 a plurality of participator computers which are otherwise independent of each other"*

Petitioner contends that Roseman's host computer is a controller computer. Pet. 16. Petitioner identifies Roseman's local computers as independent participator computers and argues that Roseman's various ways of communicating information (placing documents on a virtual table, shared notes, whisper conversations) are examples of affording information to those participator computers. Pet. 26–27. As detailed above, Roseman describes a system in which individual computers are connected to a central host computer via a combination of LANs and WANs. Ex. 1003, 3:14–19. According to Roseman, "[t]he host controls many of the events occurring during the conference, as well as those occurring both during initiation of the conference and after termination of the proceedings." *Id.* at 1:50–52. We find that Roseman's host computer is a "controller computer," that Roseman's local computers are "participator computers," and that Roseman's various ways of communicating information from the host to the local computers are examples of "affording information to each of a plurality of participator computers which are otherwise independent of each other," as recited in claim 2.[5]

[5] Patent Owner argues that "Petitioner does not address the issue that the **database** affords information to each of a plurality of computers." PO Resp. 21. Claim 2, however, does not recite that the database affords information to the plurality of computers.

The parties dispute whether Roseman describes "a database which serves as a repository of tokens for other programs to access." First, Petitioner contends that Roseman's "keys" are tokens. Pet. 17–18. As explained above, the parties agree that a "token" is "a piece of information associated with user identity." As also 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. Petitioner argues that this evidence shows that Roseman's keys are "pieces of information associated with a user identity," and thus, are "tokens." Pet. 18.

Patent Owner argues that Roseman's keys are not tokens because they are associated only with conference rooms, rather than user identities. PO Resp. 19. Patent Owner points to Roseman's Figure 8, which shows a key associated with "CONFERENCE ROOM 17L (DATE, TIME)." *Id.* In describing Figure 8, however, Roseman explains "the key is, essentially, a block of data, or a code," that can be used if the Invitee may send a delegate, to give the Absentee-Invitee a "key," which enables access to the meeting. Ex. 1003, 6:54–61. "The Requester can leave the key in his local computer, in the form of an icon residing on the display, as shown in FIG. 8. Anyone entering the office can use the key." Ex. 1003, 6:60–63. In this example,

the key can be used only with a particular user's computer. Figure 8 also shows the "key" icon contained within a "vault" icon. *Id.* at 6:64–65. In this example,

> a user must use a "combination" to the "vault" to obtain the "key." In this latter example, the [] "combination" (ie, a pass-code) is obtained from the Absentee-Invitee in some appropriate way. At conference time, the Delegate opens the "vault," obtains the "key," and enters the conference room, by using the key.

Id. at 6:65–7:3. Patent Owner argues that Roseman's keys are "transferable to anyone—like a key to a door lock." PO Resp. 19. Patent Owner contends that Roseman teaches away from keys being associated with a specific user through its description that "***[k]eys may be copied and redistributed, if permitted***, or sent to another individual, if permitted." PO Resp., 19–20 (quoting Ex. 1003, 9:55–57) (emphasis by Patent Owner).

Patent Owner's arguments are not persuasive. Roseman describes keys that are transferable (Level 2 and 3 keys) and keys that are not transferable (Level 1 keys). Ex. 1003, 9:42–48. Petitioner's contentions (Pet. 18) are directed to Level 1 keys, which "may not be passed to any other person and may not be copied." *Id.* at 9:43–44. We find that keys that may not be passed to any other person are keys associated with that person. Figure 8 of Roseman is consistent with this because it describes passing a key to an "Absentee-Invitee" when the Invitee sends a delegate, i.e., a Level 2 key.

As to Level 1 keys, Patent Owner argues that a key is merely an attachment to an invitation, which "offers the only suggestion of an association with specific invitee." PO Resp. 20. Dr. Carbonell testifies (without identifying a basis) that Roseman's system could prevent the

transfer of a key using a "no-transfer or no-duplication policy of such a key to insure that [it] always stays in the possession of the first user," by making transferability an attribute of the key and having the system simply assume, without recording transfers, that a user in possession of a key is authorized to use it. Ex. 2005 ¶ 31. As Petitioner argues, however, the claim construction to which Patent Owner agreed does not require an association between a key and a user to be implemented in a certain way. Reply 15–16. Even if Dr. Carbonell is correct as to how Roseman's keys would be implemented, such a non-transferable key would still be associated with the person who is prevented from transferring it.

Petitioner further argues that Roseman discloses storing keys in "a database which serves as a repository of tokens," as recited in claim 2, because a meeting room that is accessed by a key "'knows' about each key and its invitation level." Pet. 18–19 (quoting Ex. 1003, 9:49–51). According to Petitioner, a copy of each key must be stored on the host computer for the meeting room to "know" about each key. *Id.* at 19. Petitioner argues that a skilled artisan would have understood a database to be a stored collection of tokens. *Id.* Roseman does not expressly describe storing tokens in a database. Thus, we understand Petitioner to argue that tokens necessarily are stored in a database in light of Petitioner's cited disclosure—in other words, that a database is inherent in Roseman.

Patent Owner, relying on Dr. Carbonell's testimony, argues that a meeting room's knowledge of a key could be implemented using a hash function, which would not have required storage of the key in a database. PO Resp. 21–22 (citing Ex. 2005 ¶ 40). Petitioner characterizes Patent Owner's argument as "based on pure speculation and conjecture" and

inconsistent with Roseman's disclosure. Reply 10–12. Nevertheless, we view both parties' respective theories of Roseman's implementation as speculation. Because Petitioner's position is speculative, it is insufficient to show that a database is inherent in Roseman.[6]

In the alternative, Petitioner 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. 20–21. Petitioner argues that Roseman's keys are analogous to user identity and passwords. *Id.* at 20. According to Petitioner and its expert, Roseman's key verification step might not function properly if the keys are not stored in a database. *Id.* at 21 (citing Ex. 1002 ¶ 58). 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. *Id.* at 21–22 (citing Ex. 1002 ¶¶ 58–59).

Patent Owner admits that "[Rissanen] does disclose a database," but argues that its database is used in a different type of system. PO Resp. 23. Thus, Patent Owner does not contest that Rissanen's database stores user identities and passwords in a persistent manner and is used in conjunction

[6] Patent Owner also argues that Roseman does not suggest storing keys in a manner that is persistent and does not disclose tools such as a DBMS. PO Resp. 22–23. Roseman does teach that the data associated with its conference rooms are stored in a manner that is persistent, Ex. 1003, 12:16–28, and this at least suggests that keys also would be stored in such a manner. As to a DBMS, we explain above that the construction of "database" does not require this feature. Nevertheless, as explained below, Rissanen teaches a database even under Patent Owner's proposed construction.

with tools such as a DBMS. For Petitioner, Dr. Lavian testifies that "Rissanen clearly discloses a relational database whose data is stored persistently and includes tools for interacting with the data such as a DBMS." Ex. 1021 ¶ 37. We find that Rissanen teaches a database that stores data with persistence and tools for interacting with the database.

Nevertheless, Patent Owner argues "[i]f one were going to combine Roseman and Rissenan in order to authenticate an individual (and not merely authenticate a key for a room) the necessary logic would be significantly more complicated." PO Resp. 23. Petitioner does not argue, however, that Rissanen's database would be bodily incorporated into Roseman's system. Rather, Petitioner argues that Rissanen teaches storing data "analogous to and serv[ing] the same purpose as" the keys in Roseman in a database. Pet. 20. *See In re Mouttet*, 686 F.3d 1322, 1332–33 (Fed. Cir. 2012) ("It is well-established that a determination of obviousness based on teachings from multiple references does not require an actual, physical substitution of elements. . . . Rather, the test for obviousness is what the combined teachings of the references would have suggested to those having ordinary skill in the art."). Given that Roseman describes using keys to access conference rooms that have persistence, we agree with Petitioner that a database, described in Rissanen as storing similar information for a similar purpose, would be a straightforward and predictable choice for storing Roseman's keys.

The parties also dispute whether Roseman and Rissanen teach that the database "serves as a repository of tokens *for other programs to access*, thereby affording information to each of a plurality of participator computers," as recited in claim 2. Petitioner argues that other programs

access the stored collection of tokens, including the various meeting or conference rooms maintained on the host computer. Pet. 22. Petitioner relies on disclosure in Roseman that a meeting room is accessible from a virtual hallway with doors to other meeting rooms. *Id.* (citing Ex. 1003, 9:63–65). According to Petitioner, "[e]ach meeting room . . . contains a number of computer programs, and each meeting room itself can be thought of as a program. These programs access the repository of keys when a user presents a key to obtain access to a conference room." *Id.*

Patent Owner argues that "Petitioner does not identify any programs that could access a database of tokens and receive information, other than the singular conference calling software running on the host computer of Roseman." PO Resp. 25. According to Patent Owner, "to the extent that there are multiple conference rooms programs [sic] in existence, that is because the Roseman system has instantiated the same conference room program with different parameters as there is no suggestion that there is different software associated with each conference room." *Id.* Patent Owner does not explain why "other programs" require different software rather than different instantiations of the same software, or point to evidence supporting this view. We are not persuaded that the claims should be limited in this way. Nevertheless, as Petitioner points out (Reply 18), Roseman characterizes its conference rooms as collections of different programs (Ex. 1003, 12:16–18) and makes clear that different conference rooms will have different attributes (different virtual equipment, different tools, different appearances, etc.) (*id.* at 3:42–50, 10:9–12). We find that Roseman at least suggests different conference rooms with different programs, even under Patent Owner's view. These programs determine whether a

participant can join a meeting room based on evaluations of keys that, in light of Rissanen, would have been stored in a database. Thus, we find that Roseman and Rissanen teach "a database which serves as a repository of tokens for other programs to access," as recited in claim 2.

The parties also dispute whether Roseman and Vetter teach "communicating via an Internet network," as recited in claim 2. As explained above, Roseman describes communicating between a host and local computers via commercially available LANs and WANs. Ex. 1003, 1:37–41, 3:14–19. Petitioner contends that a skilled artisan would have understood the Internet to be an example of the commercially available WAN described in Roseman. Pet. 23, 25; Ex. 1002 ¶¶ 65–66. According to Dr. Lavian, "a person of ordinary skill in the art would have recognized the Internet as one of the largest networks for connecting remote computers (if not the largest), making it the obvious Wide Area Network (WAN) for use with Roseman to connect the host and participant computers." Ex. 1002 ¶ 65; *see also* Ex. 2006 (Lavian Dep.), 104:12–105:23 ("Q So Roseman could have been implemented in that 1994 to '96 time frame with ATM technology? A If I'm looking at the specification of Roseman and what specifically Roseman disclose, it disclose as using a -- local computers become connected to host computer via commercially available Local Area Networks and Wide Area Networks. When you're talking about Local Area Networks and Wide Area Networks, this is the Internet. That's different name to Internet. Q So you're saying that Roseman by itself teaches the Internet? A Roseman by itself reference to remote computers commercially available, commercially available that said Internet. Local Area Networks,

definitely part of the Internet. Wide Area Networks, different name to the Internet. It's actually the Internet itself. . . .").

Petitioner further argues that Vetter teaches using the Internet to facilitate the same types of computer-based conferencing functions as described in Roseman. Pet. 23–24. Petitioner contends that Vetter itself identifies a reason to combine the teachings of Roseman and Vetter, namely "[v]ideoconferences are becoming increasingly frequent on the Internet" and the CU-SeeMe videoconferencing tool described in Vetter "is also becoming very popular." *Id.* at 25 (quoting Ex. 1005, 77 (emphases by Petitioner)).

Patent Owner argues that Vetter does not state that Internet videoconferencing would have been ubiquitous at the time of the invention; rather, Patent Owner argues, the Internet was beginning to support video conferencing. PO Resp. 26–27. Patent Owner further argues that Vetter discusses difficulties in applying videoconferencing on the Internet, including feedback when participants leave their microphones on, degraded performance when broadcasting simple graphic images, workstations that locked up in a classroom when video streams overwhelmed a network, and counter-intuitive paths that data can take when travelling from one site to another. *Id.* at 27–28 (citing Ex. 1005, 78–79). Dr. Carbonell testifies (without citation) that video traffic on the Internet would experience unpredictable delay that would interfere with re-assembling video streams at the receiving end in real time. Ex. 2005 ¶ 59. Dr. Carbonell testifies (again without citation to evidence) that one would not experience these problems on a private WAN because such a network would be of a more predictable configuration. *Id.* ¶ 61.

Patent Owner also points to a half-page article in a technical magazine by Robert Metcalfe, founder of 3Com, "[p]redicting the Internet's catastrophic collapse" at the end of 1995 due to reasons such as low user measurements, telecom company monopolies, and security and capacity concerns. PO Resp. 28–29 (quoting Ex. 2009). We agree with Petitioner, however, that "the incorrect prediction of a single individual would not have discouraged (and did not discourage) the industry from using the Internet." Reply 8. Patent Owner offers no persuasive evidence that Dr. Metcalfe's views were shared widely, or at all, by skilled artisans in 1995. Indeed, the article itself suggests the contrary. Ex. 2009 ("Almost all of the many predictions now being made about 1996 hinge on the Internet's continuing exponential growth.").

Citing Dr. Metcalfe's article, Dr. Carbonell testifies that other technologies such as Integrated Services Digital Network (ISDN) and Asynchronous Transfer Mode (ATM) would have been better suited than the Internet to handle video conferencing in the mid-1990's. Ex. 2005 ¶ 60. As explained above, Patent Owner has not explained persuasively why Dr. Metcalfe's magazine article is representative of the views of a skilled artisan. The article itself does not state that there were, or identify evidence of, technologies better suited than the Internet to handle videoconferencing. Ex. 2009. Thus, we are not persuaded that the Internet would have been an inferior technology for videoconferencing in 1995. Moreover, claim 2 on its face is not limited to videoconferencing. In any case, the Federal Circuit has explained that "just because better alternatives exist in the prior art does not mean that an inferior combination is inapt for obviousness purposes." *Mouttet*, 686 F.3d at 1334.

Roseman expressly states that its local computers and host communicate via a commercially available WAN. We credit Dr. Lavian's testimony that, to the extent that this is not an express reference to the Internet, the most suitable and obvious commercially available WAN would have been the Internet. We also find that Vetter suggests using the Internet for purposes similar to those of Roseman. Vetter describes an example in which features such as audio, video, and virtual whiteboard tools are used to conference over the Internet. Ex. 1005, 77–78. Thus, to the extent Roseman does not expressly suggest using the Internet, Vetter includes an express suggestion to update a system such as Roseman using modern electronic components, such as the Internet, to gain the commonly understood benefits of such adaptation. *See Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007); *cf., Muniauction, Inc. v. Thomson Corp.*, 532 F.3d 1318, 1326–27 (Fed. Cir. 2008) ("The record in this case demonstrates that adapting existing electronic processes to incorporate modern internet and web browser technology was similarly commonplace at the time the '099 patent application was filed."). Vetter reinforces our finding that the Internet would have been the most suitable commercially available WAN for use in Roseman's system.

To be sure, Vetter discusses challenges encountered in implementing videoconferencing on the Internet, but Vetter also teaches that existing tools can be tailored to specific applications on the Internet "so that their limitations can be *promptly recognized and corrected*." Ex. 1005, 79 (emphasis added). The Federal Circuit has recognized that "a given course of action often has simultaneous advantages and disadvantages, and this does not necessarily obviate motivation to combine." *Medichem, S.A. v.*

Rolabo, S.L., 437 F.3d 1157, 1165 (Fed. Cir. 2006). We find that addressing the challenges discussed in Vetter would have been well within the skill of an ordinarily skilled artisan, an engineer experienced in computer networking. Thus, we find that Roseman, Rissanen, and Vetter teach "[a] method of communicating via an Internet network" as recited in claim 2.

In sum, we find that the combination of Roseman, Rissanen, and Vetter teaches "a method of communicating via an Internet network by using a 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 a plurality of participator computers which are otherwise independent of each other," as recited in claim 2.

b. "wherein the controller computer system is programmed to provide access to the controller computer system via any of two client software alternatives"

In the Institution Decision, we determined that the claim language "the controller computer system is programmed to provide access to the controller computer system via any of two client software alternatives" refers to separate software platforms implementing user interfaces on two different participator computers, with both providing access to the control computer. Dec. 27. This is the reading most consistent with the '552 patent's description. Ex. 1001, 2:35–41 ("Participator software runs on each of the participator computers to program each of the participator computers to operate a user interface. The user interface permits one of the users to send and/or receive a multimedia information message to the controller computer, which arbitrates which of the participator computers receives the

multimedia information message."), 4:43–49 ("[T]he appendix includes code for two different embodiments: a Tellnet embodiment and a JAVA embodiment. . . . While platform controlled embodiments are within the scope of the invention, it is particularly advantageous to have a platform independent embodiment, i.e., an embodiment that is byte code compiled."), 5:15–19 ("The Participator Computers 5 are each running and under the control of Participator Software 4, which directs each of the Participator Computers 5 to handle a user Interface 6 permitting one said user to send a multimedia information Message 8 to the Controller Computer 3 . . . .").

Petitioner argues that Roseman describes its local computers as using a Windows operating system, but notes that other environments are within the level of skill in the art. Pet. 28 (citing Ex. 1003, 12:1–5, 12:9–10). Dr. Lavian testifies that it was well-known to provide software products for multiple computing platforms, such as Windows and Macintosh because it was more commercially attractive and would increase the number of users who could use the software. Ex. 1002 ¶ 73. Petitioner argues that it would have been obvious to provide alternatives for local computer software that would operate on Windows and Macintosh platforms. Pet. 28.

Patent Owner argues that "Roseman does not indicate how a second alternative would be able to communicate with the host computer to receive the common image or to interact with it" and that "Roseman's disclosure of the 'Windows Context' is not an affirmative teaching of another client software alternative." PO Resp. 35. Petitioner, however, does not argue that Roseman expressly teaches two client software alternatives. Rather, Petitioner argues that Roseman describes one software alternative, for the Windows platform, and expressly teaches that software for other platforms

would have been within the level of skill in the art. Pet. 28; Reply 22 ("The Petition explained that the claimed two client software alternatives were obvious, among other reasons, because it would have been obvious to adapt the participator software in Roseman to run on multiple computing platforms, such as Windows and Macintosh.").

Patent Owner argues that Roseman does not "indicate how any of its client software could be modified so as to make [a] second software alternative." PO Resp. 35. According to Patent Owner, Dr. Lavian admitted in deposition that it is not always possible to make the same software programs for different operating systems. *Id.* at 36 (citing Ex. 2006, 157:6–158:11). Although it might not be possible to adapt every software program to work on every operating system, Roseman itself suggests adapting its software to different environments beyond Windows. Ex. 1003, 12:1–10. Thus, Patent Owner's argument is not persuasive.[7]

Patent Owner also argues that Windows and Macintosh are not client software, but instead are operating systems. PO Resp. 35–36. Petitioner, however, does not argue that Windows and Macintosh are the two software alternatives. Rather, Petitioner argues that Roseman describes a client software alternative that would work with the Windows operating system and suggests that another client software alternative working with the Macintosh operating system would have been within the level of skill in the art. Pet. 28; Reply 22–23 ("But the Petitioner did not point to Windows and

[7] Patent Owner also argues that a Telnet-based solution for Roseman would not work without graphical user interface (GUI) support. PO Resp. 35. This is inapposite, as Petitioner does not argue that Roseman would have been modified to accommodate a Telnet-based solution.

Macintosh *themselves* as the two client software alternatives, but rather, to versions of the participator software in Roseman adapted to run on those platforms."). Thus, Patent Owner's argument is not persuasive.

Patent Owner further contends that a skilled artisan would not have used two separate software alternatives to implement Roseman's client software with Windows and Macintosh platforms because the skilled artisan would have used Java instead. PO Resp. 36–37. According to Patent Owner, "Java and byte-code are cross-platform solutions that can run on both Windows and Macintosh." *Id.* at 36. Dr. Carbonell testifies that "one of ordinary skill in the art who was motivated to provide software that could work across different platforms and operating systems would have been motivated to utilize a single platform independent software implementation, such as a Java implementation and would not have been motivated to provide additional alternatives to that cross-platform software." Ex. 2005 ¶ 74.

Petitioner argues that the claim language does not exclude platform-specific embodiments and that the '552 patent specifically describes such embodiments as within the scope of the invention. Reply 23–24 (citing Ex. 1001, 4:46–49 ("While platform controlled embodiments are within the scope of the invention, it is particularly advantageous to have a platform independent embodiment, i.e., an embodiment that is byte code compiled."). We agree with Petitioner. As noted above, "just because better alternatives exist in the prior art does not mean that an inferior combination is inapt for obviousness purposes." *Mouttet*, 686 F.3d at 1334. Thus, even if Java would have been advantageous in some circumstances, we still find that

platform-specific client software embodiments would have been an apt extension of Roseman's system.

In light of Roseman's description of client software for the Windows environment and its express teaching that the software for other environments is within the level of skill, Ex. 1003, 12:1–10, we are persuaded that Roseman at least suggests client software for other platforms that were common at the time, such as Macintosh. We credit Dr. Lavian's testimony that providing software for use with both Windows and Macintosh would have made Roseman's system more commercially attractive by increasing the number of users who could use the software. Ex. 1002 ¶ 73. *See also KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) ("When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one."). Thus, we find that Roseman suggests "wherein the controller computer system is programmed to provide access to the controller computer system via any of two client software alternatives," as recited in claim 2.

c. *"wherein both of the two client software alternatives allow the respective user identities to be recognized by the controller computer system and allow at least some of the participator computers to form at least one group in which members can send communications and receive communications from another of the members" and*

"permitting at least the first user identity and the second user identity to form a group"

Petitioner contends that Roseman's software running on a local computer, which (as explained above) can be a software implementation for a Windows platform and a Macintosh platform, allows user identities to be recognized by the host computer. Pet. 30–31. Petitioner argues that a group of local computers is formed when a user of a local computer in Roseman drags other participants into a child-room. *Id.* at 32. In another example, Petitioner argues that Roseman's description of creating a virtual conference room, involving identifying the participants of the conference room and requiring invited users to have appropriate keys, teaches permitting at least a first user identity and a second user identity to form a group. *Id.* at 39–40.

We agree with Petitioner. When Roseman's users, via software running on their respective local computers, access conference rooms using keys, Roseman's host computer recognizes the users and allows them to send and receive communications from each other. Ex. 1003, 3:22–56. Thus, we find that Roseman teaches these limitations of claim 2. We note that Patent Owner does not contest that Roseman teaches these limitations.

d. "wherein at least some of the communications are received in real time via the Internet network" and

"permitting sending communications in real time, via the Internet network, among the participator computers corresponding to the user identities in the group"

Petitioner contends that communications in one of Roseman's conference rooms, such as placing documents on a table, drawing on a document, and moving a pointer, take place in real time because they are communicated to participants as the underlying events occur. Pet. 32, 40. For example, Roseman explains:

> In the invention, the participants share a common virtual conference table. Each participant can
>
> (1) place a document onto the table electronically,
>
> (2) write on the document, draw on it, and otherwise manipulate it, and
>
> (3) move a pointer to different positions on the document, to point to specific parts of it.
>
> All other participants see the [] preceding three events as they occur.

Ex. 1003, 2:38–47. We find that these are specific examples in Roseman of real-time communications sent and received by the participator computers in a group.

As explained in Section II.B.3.a above, Roseman and Vetter teach that such communications can be via an Internet network.

Thus, we find that Roseman and Vetter teach these limitations of claim 2. We note that Patent Owner does not contest that Roseman and Vetter teach these limitations.

> e. *"wherein the at least one of client software alternatives allows the controller computer system to determine whether at least one of the user identities, individually, is censored from data representing at least one of a pointer, video, audio, graphic, and multimedia such that the data that is censored is not presented by the corresponding participator computer"*

Petitioner argues that this limitation would have been obvious over Roseman and Lichty. Pet. 34. In particular, Petitioner points to the "Ignore" button of Lichty's user interface. *Id.* Petitioner notes that Roseman already has a feature in which a host computer limits the amount of information another participant can send in a meeting room (a group). *Id.* at 35 (citing Ex. 1003, 12:29–45). Petitioner argues that both Roseman and Lichty state essentially the same reason for their respective features, namely solving the common problem of dealing with potentially unwanted communications from conference participants. *Id.*; *see also* Ex. 1003, 12:29–33; Ex. 1007, 510. Petitioner argues that Lichty's solution would be equally applicable to Roseman. Pet. 35.

Patent Owner, relying on its proposed claim construction, argues that claim 2 requires that the data itself is censored and that this is not shown in Roseman and Lichty. Specifically, Patent Owner argues that "Roseman's procedures are inconsistent with the meaning of censorship" because "Roseman does not disclose restrictions ***based on data*** or other types of

content as the claim limitation requires." PO Resp. 38.[8] As explained in Section II.A.3 above, this limitation refers to control of data received by the at least one of the user identities, individually, and is not limited to data suppressed based on the content of those data or by a moderator. Thus, Patent Owner's argument is not persuasive.

As to Lichty, Patent Owner argues that it "does not explain how AOL works either at the user interface level or at the server level." PO Resp. 38. Patent Owner further argues that "Petitioner does not explain how Lichty teaches or discloses censoring whereby a determination as to whether to censor the information is made by the ***controller computer***" and that "Petitioner does not even suggest that Lichty teaches a controller computer." PO Resp. 40. According to Dr. Carbonell, "one would have understood that such ignore features were implemented locally on the user's computer as a filter, i.e. as a user-interface or presentation feature" and that "[o]ne of ordinary skill in the art would not have understood such features to be implemented at the server level." Ex. 2005 ¶ 27. In reply, Petitioner argues that where Lichty implemented the ignore feature is irrelevant because "[t]he Petition cited Lichty only for its disclosure of its censoring feature, and relied on the host in Roseman to carry out the features of the claim." Reply 20.

[8] Patent Owner also argues that "the claim limitation 'determines that the ***message*** is not censored' requires that the message itself is censored" and that "[t]here is no disclosure in either Roseman or Lichty of a system where data (*i.e.*, a message) is censored." PO Resp. 40. This language, however, is not part of any challenged claim. Thus, this argument is not persuasive.

We agree with Petitioner. As we explained in the Institution Decision (at 32), Roseman teaches a scheme in which a host (controller computer) determines whether a user identity should be prevented from sending data. Ex. 1003, 12:29–45. Specifically, Roseman describes a "moderator" feature in which a "host can automatically prevent filibustering, in several ways," including "[b]y plac[ing] a limit on the total time allowed to each person." *Id.* at 12:34–37. We find that this is an example of censoring performed at the controller computer. Petitioner cites Lichty to show that it was known to prevent a user identity from receiving data. Lichty explains why this feature is useful, including "[w]hen rooms become full and everyone is talking, it can be difficult to follow what's going on" and that "Ignore is most useful when the chat of another member becomes disruptive in the chat room." Ex. 1007, 269, 510. This closely tracks Roseman's reason for the moderator feature, namely, preserving free discussion that otherwise would be "defeated by an aggressive person who dominates the conference, and, in effect, maintains a 'filibuster.'" Ex. 1003, 12:29–33.

Patent Owner also argues that the '552 patent distinguishes AOL software. PO Resp. 39–40 (citing Ex. 1001, 1:41–44 ("Chat room communications . . . can involve graphics and certain multimedia capability, as exemplified by such Internet service providers as America On Line."), 1:45–56 ("On the Internet, 'chat room' communications analogous to America On Line have not been developed, at least in part because Internet was structured for one-way communications analogous to electronic mail, rather than for real time group chat room communications. Further, unlike the an Internet service provider, which has control over both the hardware platform and the computer program running on the platform to create the

'chat room', there is no particular control over the platform that would be encountered on the Internet. Therefore, development of multiplexing technology for such an environment has been minimal.")). Our focus here is on the disclosure of Lichty, not the '552 patent's characterization of the system disclosed by Lichty. In any case, Petitioner relies on the combination of Lichty and Roseman, rather than Lichty alone, to show censoring a user identity from data. Thus, Patent Owner's argument is not persuasive. *See In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) ("Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references.").

Patent Owner further argues that "Petitioner fails to address how the disclosure of Lichty's text-based user interface could predictably result in the virtual conferencing system of Roseman where at least one participant is censored from receiving audio data" and that "there is no teaching or suggestion provided by the Lichty reference that motivates any changes to a voice and/or video conferencing system." PO Resp. 41. We are not persuaded by this argument. Roseman teaches censoring senders in meetings that involve text, audio, and graphics. Ex. 1003, 12:26–45. Lichty is cited to show censoring from receiving data. In any case, given the level of skill in the art noted above, we are persuaded that the proposed combination would have been within that level of skill, including applying Lichty's teachings to other forms of data besides text, including audio, video, and pointers.

On the complete record, we find that Roseman and Lichty teach "wherein the at least one of client software alternatives allows the controller

computer system to determine whether at least one of the user identities, individually, is censored from data representing at least one of a pointer, video, audio, graphic, and multimedia such that the data that is censored is not presented by the corresponding participator computer," as recited in claim 2.

f. "affording some of the information to a first of the participator computers via the Internet network, responsive to an authenticated first user identity; affording some of the information to a second of the participator computers via the Internet network, responsive to an authenticated second user identity"

As explained above, Roseman describes admitting participants into a conference room when the participants present keys. Ex. 1003, 10:61–65. We find that this teaches "an authenticated first user identity" and "an authenticated second user identity." Additionally, Roseman describes various ways of affording information to local computers of users admitted to the conference room, including as follows:

> Objects (documents) can be shared in the conference room by placing them on the table. This might be done by dragging an icon of the object from the outside (users non-"meeting room" windows) onto the table. Ownership of the object is still maintained. If the object owner wishes, the object may be copied, borrowed by other users, or given to other users. The object may be altered (changed, annotated) by anyone with permission to do so.

Id. at 11:18–26. *See also* Pet. 36–38. As explained in Section II.B.3.a above, Roseman and Vetter teach that such communications can be via an Internet network.

Accordingly, we find that Roseman and Vetter teach these limitations of claim 2. We note that Patent Owner does not contest that Roseman and Vetter teach these limitations.

g. "wherein at least some of the communications include messages comprising more than one data type"

As noted by Petitioner, Roseman describes various forms of multimedia conferencing, including "multiple parties are linked by both video and audio media," Ex. 1003, Abstract, and "[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," *id.* at 8:1–4. Pet. 40–41. On this record, we find that Roseman teaches "wherein at least some of the communications include messages comprising more than one data type." We note that Patent Owner does not contest that Roseman teaches this limitation.

h. "at least some other of the communications include a pointer that produces a pointer-triggered message on demand"

Petitioner refers to Roseman's description of a user placing a document, represented by an icon, onto a virtual conference table. Pet. 41–42. Petitioner contends that Roseman's icon "serves as a 'pointer' because it points to, or references, the underlying document." *Id.* at 42. According to Petitioner, the icon points to a file and, when the icon is invoked, the host computer causes the file to appear on the table of each participant. *Id.* Petitioner argues that this teaches a pointer that produces a pointer-triggered message on demand. *Id.*

Patent Owner argues that Petitioner "conflates what appears on a GUI and the steps performed by [Roseman's] host computer," that "[t]he icon in Roseman is not a message, it is merely an indication that there is accessible information and clicking on the icon is merely a request to the host computer to send the appropriate data file" and, "[a]ccordingly, the icon itself is not a message, nor a pointer-triggered message." PO Resp. 32. This misstates Petitioner's argument. As explained above, Petitioner contends that Roseman's icon is a pointer, not a pointer-triggered message. The pointer-triggered message is the message that is delivered after a user clicks on the icon.

As explained in Section II.A above, a "pointer" is "a link or reference to a file, data, or service" and a "pointer-triggered message" is "a message, where the content of the message is specified by a pointer and found on demand of the operator of the participator software." Under these constructions, Roseman's icon is a pointer, as it is a link to a file. Likewise, the message retrieved when Roseman's icon is selected is a "pointer-triggered message" because its contents are specified by the icon and are found on demand of a user at a remote computer.

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. 42–43. Nevertheless, Patent Owner has not argued, and we do not find, that the claimed "pointer" is required to be a URL. Thus, we need not determine whether a skilled artisan would have sought out Pike's teachings of URLs.

On the complete record, we find that Roseman teaches "at least some other of the communications include a pointer that produces a pointer-triggered message on demand," as recited in claim 2.

In sum, we find that Roseman, Rissanen, Vetter, Pike, and Lichty teach each limitation of claim 2.

4. Remaining Challenged Independent Claims

Petitioner also challenges independent claims 1, 10, 18, 50, 54, 58, 59, and 64. The additional independent claims have significant overlap with claim 2. For example, each of the additional independent claims recites a "database which serves as a repository of tokens," an "Internet network" (or "the Internet"), "two client software alternatives," and "at least one of the user identities, individually, is censored from data," discussed in detail above. Petitioner shows in claim charts where each of the additional independent claims overlaps with claim 2 and provides analysis for the portions of those claims that do not overlap with claim 2. Pet. 46–70. We agree with Petitioner's identification of overlap and find that the overlapping limitations of claims 1, 10, 18, 50, 54, 59, and 64 are taught by Roseman, Rissanen, Vetter, and Lichty for the reasons given for claim 2, above. We agree with Petitioner that claim 10 does not add any limitations not covered by our analysis of claim 2. Pet. 51–52

Petitioner essentially addresses claims 1, 18, 50, 54, 58 together, referring back to claims 1 and 2 for its analysis of claims 18, 50, 54, and 58. Pet. 54–57, 59–66. Claim 1 recites "storing each said user identity and a respective authorization to send multimedia data" and "if permitted by the user identity corresponding to one of the participator computers, allowing

the one of the participator computers to send multimedia data to another of the participator computers." Petitioner argues that Roseman describes using stored keys, associated with user identities, for controlling admission to a particular conference. Pet. 48. Petitioner contends that "[e]ach 'key' [] relates to the identity of the participant and provides the permissions allowing access to the conference room." *Id.* (citing Ex. 1003, 9:34–55). The cited passage, however, only describes a key granting a user admission to a virtual conference room. It does not describe keys as determining what a user can do in a conference room once admitted. Ex. 1003, 9:34–55; *see also id.* at 10:61–65. Although Roseman's keys may be associated with a user identity in that a Level 1 key is given to a person and "may not be passed to any other person and may not be copied," Ex. 1003, 9:43–44, it does not follow that the key provides permissions for behavior within a conference room, such as authorization to send multimedia data.

Petitioner concludes, based on its citations to Roseman, that "Roseman discloses these limitations because a user identity that is not authorized to access a room cannot send multimedia data to conference participants." *Id.* at 49. It is true that a user denied access to a conference room would not be permitted to send multimedia data in that conference room, as Petitioner argues. Pet. 49. Petitioner, however, does not argue persuasively that a key that grants admission also includes an authorization to send multimedia data in that conference room. Roseman's key simply grants access to a conference room. We are not persuaded that such a key constitutes stored authorization to engage in certain activities once admitted to the conference room. Furthermore, Petitioner does not provide persuasive analysis that Roseman checks if the user identity is permitted to send

multimedia data before allowing the corresponding participator computer to send such data. Accordingly, Petitioner has not shown, by a preponderance of the evidence, that claim 1 would have been obvious over Roseman, Rissanen, Vetter, Lichty, and Pike.

Claim 18 recites

> the computer system: stores, for a first of the user identities, a respective authorization associated with multimedia data communication, and allows the participator computers to send in real time via the Internet network, and, based on the respective authorization, cause the multimedia data to be presented at one of the participator computers corresponding to a second of the user identities.

As to these limitations, although they differ somewhat from those of claim 1, Petitioner argues that "[t]he analysis for claim 1 as to these limitations accordingly applies to claim 18." As explained above, Petitioner's arguments are not persuasive for claim 1. As to claim 18, Petitioner does not include any additional argument as to why Roseman teaches "the computer system: stores, for a first of the user identities, a respective authorization associated with multimedia data communication." Furthermore, Petitioner does not include any analysis explaining how Roseman teaches "*based* on the respective authorization, cause the multimedia data to be presented" at a participator computer corresponding to a second user identity. Accordingly, Petitioner has not shown, by a preponderance of the evidence, that claim 18 would have been obvious over Roseman, Rissanen, Vetter, Lichty, and Pike.

Claim 50 recites

> wherein the controller computer system controls real-time communications among the participator computers by:

> associating with the user identities a respective authorization to communicate multimedia data; and
>
> sending multimedia data representing at least one of a pointer, video, audio, graphic, and multimedia if permitted by the respective authorization;

Claims 54 and 58 recite similar limitations. Petitioner does not explain how Roseman teaches associating with a user identity a respective authorization to communicate multimedia data. For example, Petitioner does not explain why simply showing that a user has access to a conference room is enough to show a respective authorization to communicate multimedia data associated with a user identity. Accordingly, Petitioner has not shown, by a preponderance of the evidence, that claims 50, 54, and 58 would have been obvious over Roseman, Rissanen, Vetter, Lichty, and Pike.

Claim 59 recites "groups in which members distribute, in accordance with the predefined rules, the user messages in real time to the respective ones of the participator computers." Similarly, claim 64 recites "groups in which members distribute, via predefined rules, the messages in real time to the respective ones of the participator computers."

Petitioner (Pet. 65) argues that Roseman discloses that a person setting up a conference can determine aspects of the meeting, such as: "What rules govern the conduct of the meeting? Does the Requester have absolute control of the voice and message interaction among the participants? Or Is the meeting a brainstorming free-for-all, where numerous people can speak at once?" Ex. 1003, 3:52–54. As to a specific example, Petitioner points to Roseman's "pencil" tool, through which a participant can write a message in a conference room using the pencil tool, and other participants are disabled from doing so while the first participant

has the pencil. Pet. 66 (citing Ex. 1003, Fig. 19). Petitioner also cites to Roseman's "Whisper Mode" for private voice conversations and "note-passing" for private textual conversations as examples of predefined rules that govern how users conduct real-time communications. *Id.* at 66–67 (citing Ex. 1003, 9:16–31, 15:12–15, Fig. 17C). We agree with Petitioner that these are examples of groups in which members distribute, in accordance with predefined rules, the user messages in real time. We find that Roseman teaches these limitations of claims 59 and 64. We note that Patent Owner does not present separate arguments for claims 59 and 64.

5. Challenged Dependent Claims

Claims 19–49 depend, directly or indirectly, from claim 18. Claims 51–53 depend, directly or indirectly, from claim 50. Claims 55–57 depend from claim 54. As explained above, Petitioner has not shown that claims 18, 50, and 54 would have been obvious. Petitioner's analysis of these dependent claims does not cure the deficiencies noted above for claims 18, 50, and 54. Accordingly, Petitioner has not shown, by a preponderance of the evidence, that claims 19–49, 51–53, and 55–57 would have been obvious over Roseman, Rissanen, Vetter, Lichty, and Pike.

Claims 3, 5, and 7 depend from claim 2 and add "wherein at least one of the messages includes data representing" sound, video, and both sound and video, respectively. Claims 11, 13, and 15 depend from claim 10 and recite "wherein at least one of the messages includes data representing" sound, video, and both sound and video, respectively. Petitioner has persuasively shown that the communications in Roseman's meetings can include sound, video, graphic, and multimedia. Pet. 71–72 (citing Ex. 1003,

1:42–46 (drawings), 3:40–41 (graphics), 7:35–38 (pictures of participants), 8:1–4 (graphics), 11:11–16 (audio and video), 12:34–45 (audio)). We find that Roseman teaches the additional limitations of claims 3, 5, 7, 11, 13, and 15.

Claims 4, 6, 8, and 9 depend, directly or indirectly, from claim 2 and recite "storing, for the first user identity, an authorization associated with presentation of multimedia" and "based on the authorization, presenting the multimedia at one of the participator computers corresponding to the second user identity." These limitations are substantially similar to those we found missing from claim 1, discussed above. Petitioner incorporates its analysis of claim 1 for this limitation.[9] For the reasons given for claim 1, Petitioner has not shown, by a preponderance of the evidence, that claims 4, 6, 8, and 9 would have been obvious over Roseman, Rissanen, Vetter, Lichty, and Pike.

Each of claims 12, 14, 16, and 17 depends indirectly from claim 10 and adds "the computer system is further programmed to provide access to a member-associated image." As Petitioner points out (Pet. 73), Roseman describes that "[a] small picture of each user is displayed in a meeting room to indicate presence." Ex. 1003, 11:11–14. We find that these are examples of member-associated images. Thus, we find that Roseman teaches the additional limitation of claims 12, 14, 16, and 17.

As to the challenged dependent claims, Patent Owner refers to its arguments for claim 2. PO Resp. 42. We note that Patent Owner does not present separate arguments for the challenged dependent claims.

[9] Petitioner cites to claim 10, but we read this as a typographical error. Claim 1, not claim 10, includes a recitation similar to that of claims 4, 6, 8, and 9.

6. Conclusion of Obviousness

As explained above, Roseman, Rissanen, Vetter, and Lichty teach each limitation of claims 2, 3, 5, 7, 10–17, 59, and 64. Petitioner has introduced persuasive evidence that a skilled artisan would have had reasons to combine the teachings of Roseman, Rissanen, Vetter, and Lichty. Patent Owner does not argue or introduce evidence of objective indicia of nonobviousness. In sum, upon consideration of all the evidence, we conclude that Petitioner has proved by a preponderance of the evidence, that claims 2, 3, 5, 7, 10–17, 59, and 64 would have been obvious over Roseman, Rissanen, Vetter, 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 37, 1. Specifically, Patent Owner moves to exclude portions of paragraphs 54, 74, and 75 of the 2nd Lavian Declaration. *Id.* at 2–5.

Petitioner opposes this motion on the ground that it is not directed to the admissibility of evidence and, therefore, is procedurally improper. Paper 39, 2. Patent Owner contends that arguments that exceed the scope of a reply are irrelevant, prejudicial, confusing, or misleading under Federal Rules of Evidence 401, 402, and 403. Paper 41, 1–2. As Petitioner points out, however, the Board repeatedly has denied, as improper, motions to exclude that merely argue that evidence is outside the proper scope of a reply. Paper 39, 2–3. Despite its invocation of Rules 401, 402, and 403, we agree that Patent Owner's Motion to Exclude is nothing more than an

argument that Petitioner's Reply exceeds its proper scope. Accordingly, we deny Patent Owner's Motion.

Nevertheless, we have considered Patent Owner's argument with respect to those portions of Petitioner's Reply that are relied upon in this decision, and determine they do not belatedly raise new issues or present evidence that should have been presented in the Petition. In any case, we do not rely on paragraphs 54, 74, and 75 of the 2nd Lavian Declaration.

III. CONCLUSION

Petitioner has proved by a preponderance of the evidence that claims 2, 3, 5, 7, 10–17, 59, and 64 are unpatentable, but has not proved claims 1, 4, 6, 8, 9, and 18–58 are unpatentable.

IV. ORDER

For the reasons given, it is:

ORDERED, based on a preponderance of the evidence, that claims 2, 3, 5, 7, 10–17, 59, and 64 are unpatentable; 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.

PETITIONER:

Heidi Keefe
hkeefe@cooley.com

Phillip Morton
pmorton@cooley.com

Andrew Mace
amace@cooley.com

PATENT OWNER:

Peter Lambrianakos
plambrianakos@brownrudnick.com

Vincent Rubino
vrubino@brownrudnick.com