

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE, INC.,
Petitioner,

v.

B.E. TECHNOLOGY, L.L.C.,
Patent Owner.

Case IPR2014-00031
Case IPR2014-00033
Patent 6,771,290 B1

Before SALLY C. MEDLEY, KALYAN K. DESHPANDE, and
LYNNE E. PETTIGREW, *Administrative Patent Judges.*

PETTIGREW, *Administrative Patent Judge.*

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

I. INTRODUCTION

We have jurisdiction to hear these *inter partes* reviews under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed herein,

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Petitioner has shown by a preponderance of the evidence that claims 2 and 3 of U.S. Patent No. 6,771,290 B1 are unpatentable.

A. Procedural History

Petitioner, Google, Inc., filed two Petitions¹ for *inter partes* review of claims 2 and 3 of U.S. Patent No. 6,771,290 B1 (31 Ex. 1001, “the ’290 patent”).² 31 Paper 1 (“31 Pet.”); 33 Paper 1 (“33 Pet.”). Patent Owner, B.E. Technology, L.L.C., did not file a Preliminary Response to either Petition. On April 9, 2014, pursuant to 35 U.S.C. § 314, we instituted *inter partes* reviews for claims 2 and 3 of the ’290 patent on the grounds of anticipation by Kikinis³ under 35 U.S.C. § 102(b) and obviousness over Foley⁴ under 35 U.S.C. § 103(a). 31 Paper 9; 33 Paper 9.

In each proceeding, subsequent to institution, Patent Owner filed a Patent Owner Response (31 Paper 23, “31 PO Resp.”; 33 Paper 23, “33 PO Resp.”), and Petitioner filed a Reply to the Patent Owner Response (31 Paper 25, “31 Reply”; 33 Paper 25, “33 Reply”). On December 11, 2014, we held a consolidated hearing for five *inter partes* reviews involving

¹ Citations may be preceded by “31” to designate IPR2014-00031 or “33” to designate IPR2014-00033.

² In IPR2014-00033, the ’290 patent also is entered in the record as Exhibit 1001.

³ PCT International Publication Number WO 97/09682, published Mar. 13, 1997 (31 Ex. 1002) (“Kikinis”).

⁴ U.S. Patent No. 5,706,502, issued Jan. 6, 1998 (33 Ex. 1002) (“Foley”).

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the '290 patent.⁵ A transcript of the oral hearing is included in the record. 31 Paper 32 (“31 Tr.”); 33 Paper 32 (“33 Tr.”).

B. Related Proceedings

The parties indicate that the '290 patent is at issue in *B.E. Technology, L.L.C. v. Google, Inc.*, No. 2:12-cv-02830 (W.D. Tenn.), and numerous other district court cases filed by Patent Owner against other defendants. 31 Pet. 1; 31 Paper 4, 1–3 (Patent Owner’s Mandatory Notices). As noted, the '290 patent is the subject of three other *inter partes* reviews: IPR2014-00029, IPR2014-00040, and IPR2014-00044.

C. The '290 Patent

The '290 patent describes a system that provides remote storage of user-specific files and resources that can be accessed over a network, such as the Internet. 31 Ex. 1001, 5:43–50, 12:45–50. The disclosed system includes client computers, each running a client software application that provides access via a network to an advertising and data management (ADM) server. *Id.* at 11:42–49. The server includes a user database that stores a user profile and a user library for each user. *Id.* at 12:45–13:12. The user profile is accessed by the client software application using a unique identifier for the user via a login. *Id.* at 12:52–56. The user profile may contain user-specific customized settings for the operating system used by the client computer. *Id.* at 12:56–58. Additionally, the user profile may

⁵ *Sony Mobile Commc’ns (USA) Inc. v. B.E. Tech., L.L.C.*, Case IPR2014-00029; *Google Inc. v. B.E. Tech., L.L.C.*, Case IPR2014-00031; *Google Inc. v. B.E. Tech., L.L.C.*, Case IPR2014-00033; *Microsoft Corp. v. B.E. Tech., L.L.C.*, Case IPR2014-00040; *Samsung Elecs. Am., Inc. v. B.E. Tech., L.L.C.*, Case IPR2014-00044.

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contain “bookmarks, shortcuts, and other such links to files and information resources accessible via” the network. *Id.* at 12:67–13:3. The user library “enables the user to store files (documents, executable programs, email messages, audio clips, video clip, or other files) that can then be accessed from any client computer.” *Id.* at 13:4–7. By storing user profiles and user libraries on the server, users “can have world-wide access to their preferences, addresses, bookmarks, email, and files without having to physically transport them from one place to another.” *Id.* at 13:9–12.

The ’290 patent further describes a user interface on a client computer, provided by a graphical user interface (GUI) module. *Id.* at 13:41–43. The user interface comprises an application window with selectable items such as icons. *Id.* at 13:43–53. As shown in Figure 5b, the application window may include “icons that represent various files and links to information resources.” *Id.* at 15:48–53.

Figure 5b of the '290 patent is reproduced below:

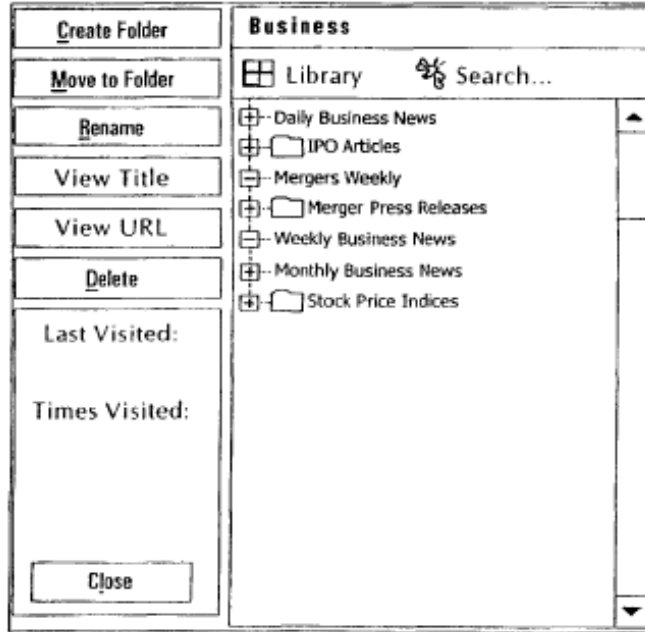


FIG. 5b

Figure 5b illustrates an application window with icons representing files and links to information resources.

The application window in Figure 5b includes a library icon, which, when selected, provides a display as shown in Figure 5c, reproduced below.

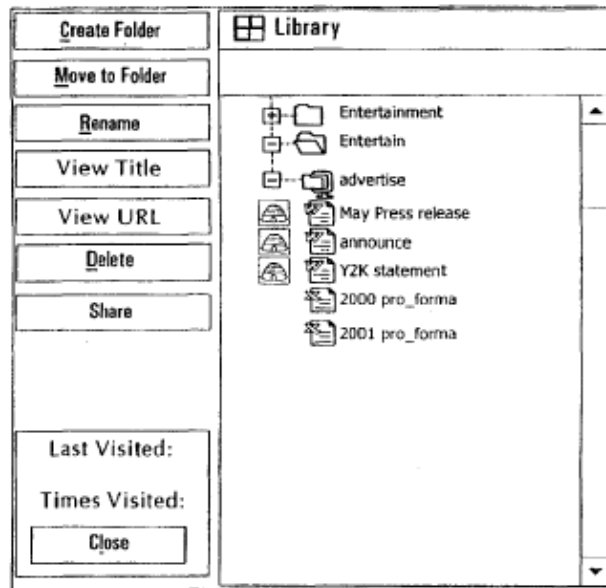


FIG. 5c

Figure 5c illustrates an application window displaying files in a user library.

The display in Figure 5c provides a list of all files contained in a user library. *Id.* at 15:55–56. From this window, “the user can access any of the files contained in his or her user library.” *Id.* at 15:56–57.

D. Claims

Petitioner challenges claims 2 and 3 of the '290 patent, which read:

2. A computer-readable memory for use by a client computer in conjunction with a server that is accessible by the client computer via a network, the server storing a user profile and user library for each of a number of different users, with the user library containing one or more files and the user profile containing at least one user link that provides a[] link to one of

the files in the user library, the computer-readable memory comprising:

a non-volatile data storage device;

a program stored on said non-volatile data storage device in a computer-readable format;

said program being operable upon execution to display a graphical user interface comprising an application window having a number of user-selectable items displayed therein, wherein each of said items has associated with it a link to an information resource accessible via the network and wherein said program is operable upon execution and in response to selection by a user of one of said items to access the associated information resource over the network;

said program being operable upon execution to receive from [the] server one of the user profiles and to display a user-selectable item for user links contained within the user profile, said program further being operable in response to selection by a user of one of the user links to access the file associated with the selected user link from the user library associated with the received user profile.

3. A computer-readable memory as defined in claim 2, wherein said program is operable upon execution and in response to selection by a user of one of said items to access the associated information resource over the network using a browser.

Id. at 39:1–40:16.

II. ANALYSIS

A. *Claim Construction*

In an *inter partes* review, we construe claim terms in an unexpired patent according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b). Patent Owner contends the Board’s adoption of the “broadest reasonable

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construction” standard exceeded the Office’s rulemaking authority and requests that we construe the claims in this case in a manner consistent with claim construction that would be applied in the district court. 31 PO Resp. 25–27; 33 PO Resp. 26–28. Recently, however, the United States Court of Appeals for the Federal Circuit held that “Congress implicitly adopted the broadest reasonable interpretation standard in enacting the [America Invents Act].” *In re Cuozzo Speed Techs., LLC*, 778 F.3d 1271, 1281 (Fed. Cir. 2015). The court further held that even if the broadest reasonable interpretation standard were not incorporated into the *inter partes* statutory provisions, the Office properly adopted the standard by regulation under the rulemaking authority provided by 35 U.S.C. § 316. *Id.* at 1282. Accordingly, we construe the claims in this proceeding using the broadest reasonable construction standard.

Consistent with the broadest reasonable construction standard, claim terms are presumed to have their ordinary and customary meaning, as understood by a person of ordinary skill in the art, in the context of the entire patent disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). An inventor may provide a meaning for a term that is different from its ordinary meaning by defining the term in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

1. Claim Terms Defined in the '290 Patent

The '290 patent recites explicit definitions for many terms. In the table below, we construe claim terms relevant to our decision in accordance

with the definitions provided in the '290 patent, which are set forth in the written description with reasonable clarity, deliberateness, and precision.

| Claim Term | Construction |
|----------------------------------|---|
| data set | “A group of data items; for example, links, keywords, or entries in an address book.” 31 Ex. 1001, 4:18–19. |
| file | “Any digital item, including information, documents, applications, audio/video components, and the like, that is stored in memory and is accessible via a file allocation table or other pointing or indexing structure.” 31 Ex. 1001, 4:25–28. |
| information resource | “A source of information stored on a server or other computer that is accessible to other computers over a network.” 31 Ex. 1001, 4:33–35. |
| link | “A data item that identifies the location or address of a program or information resource.” 31 Ex. 1001, 4:39–40. ⁶ |
| non-volatile data storage device | “A memory device that retains computer-readable data or programming code in the absence of externally-supplied power, including such things as a hard disk or a floppy disk, a compact disk read-only memory (CDROM), digital versatile disk [(J)DVD), magneto-optical disk, and so forth.” 31 Ex. 1001, 4:46–51. |

⁶ The '290 patent further provides: “A URL [i.e., a uniform resource locator] is a link, as is a path and filename of an information resource.” 31 Ex. 1001, 4:40–41. We consider these to be examples of a “link,” not part of the definition, and, therefore, not part of our construction of the claim term.

| Claim Term | Construction |
|-------------------|---|
| profile | “User-specific information relating to an individual using a computer.” 31 Ex. 1001, 4:52–53. |
| program component | “A set of instructions stored in a file in computer-readable format, whether as object code or source code, and whether written in a compiled language, in byte code (such as Java™), or in a scripting or other interpreted language.” 31 Ex. 1001, 4:54–58. |
| program module | “One or more related program components.” 31 Ex. 1001, 4:60–61. |
| program | “One or more related program modules.” 31 Ex. 1001, 4:62. |

2. User library

Claim 2 recites a “server storing a . . . *user library* for each of a number of different users, with the user library containing one or more files.” 31 Ex. 1001, 39:3–5 (emphasis added). Claim 2 further provides that files in the user library are accessed via user links in a user profile.

Id. at 39:6–7, 40:8–11. Although the ’290 patent does not provide an explicit definition of “user library,” it provides the following description:

“[T]he User Database 46 of ADM server 22 can include a *user library* that enables the user to store files (documents, executable programs, email messages, audio clips, video clips, or other files) that can then be accessed from any client computer 40.” *Id.* at 13:3–7 (emphasis added). The written description of the ’290 patent further explains that a user library is “used to store [a user’s] individual files and resources that the user wishes to be able to access from anywhere on the network.” *Id.* at 5:56–58.

An ordinary meaning of “library” in the context of electronic document storage is a “collection of software or data files,”⁷ and, thus, a “user library” is a “collection of a user’s software or data files.” In view of this ordinary meaning and the claims and written description of the ’290 patent, the broadest reasonable construction of “user library” consistent with its use in the ’290 patent is “a collection of an individual’s stored files.”

B. Asserted Ground of Anticipation by Kikinis

Petitioner contends that claims 2 and 3 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Kikinis, relying on declaration testimony of Mr. Stephen Gray. 31 Pet. 14–30 (citing 31 Ex. 1004). Patent Owner responds, relying on declaration testimony of Dr. Cory Plock. 31 PO Resp. 8–25 (citing 31 Ex. 2001). Having considered the parties’ contentions and supporting evidence, we determine that Petitioner has demonstrated by a preponderance of the evidence that claims 2 and 3 are anticipated by Kikinis.

1. Summary of Kikinis

Kikinis describes a document management system that provides for remote storage and retrieval of electronic documents. 31 Ex. 1002, Abstract, 1:7–9. Figure 2, reproduced below, illustrates Kikinis’s electronic document system.

⁷ See MICROSOFT COMPUTER DICTIONARY 309 (5th ed. 2002).

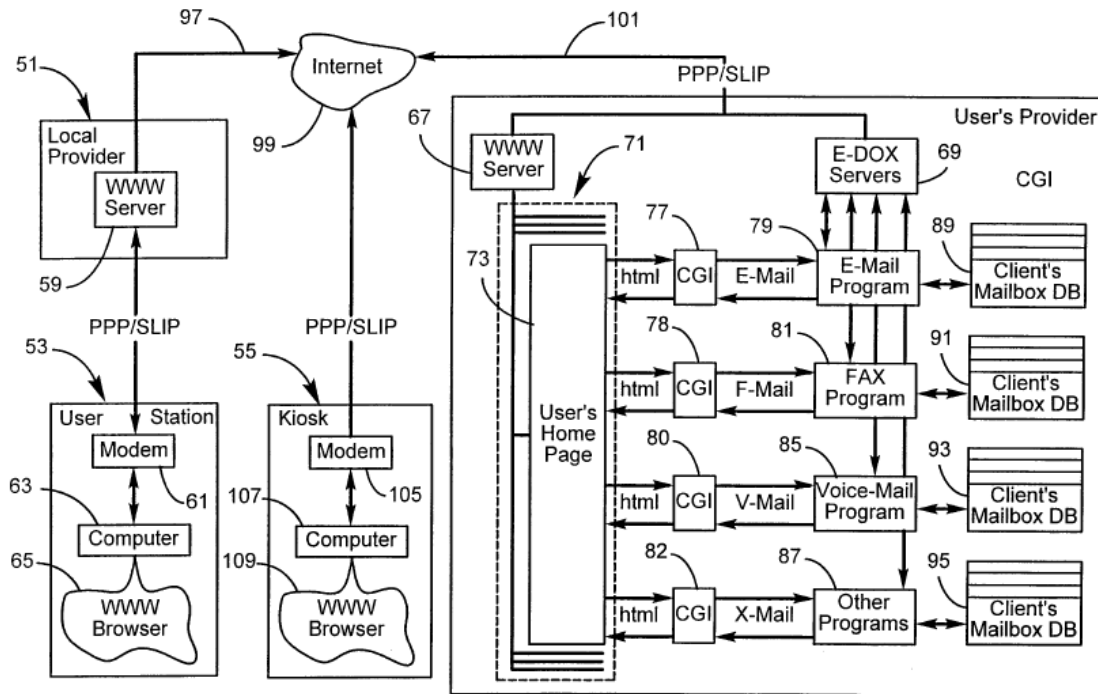


Fig. 2

As shown in Figure 2, Kikinis discloses user station 53 with a web browser that allows a user to access, via the Internet, servers provided by a remote Internet service provider (ISP), labeled “User’s Provider” in the figure.

Id. at 6:11–14, 6:24–26. In the embodiment shown in Figure 2, the remote ISP includes web server 67 and a set of electronic document servers 69, all of which have access to the Internet. *Id.* at 6:24–27.

Each electronic document server 69 runs software that supports a specific application. *Id.* at 6:27–29. As shown in Figure 2, examples include e-mail program 79, fax program 81, voice-mail program 85, and other programs 87, which provide access to other electronic documents. *Id.* at 6:29–31. Web server 67 stores a set of databases 71, each of which is associated with a different user. *Id.* at 6:32–35. Each database set 71 includes home page 73 that is individualized to a specific user and provides links to various lower-order databases maintained by electronic document

server 69 for each user, such as e-mail database 89, fax database 91, voice-mail database 93, and other electronic documents in database 95. *Id.* at 6:35–7:4. A user may be required to provide a password and user name to gain access to home page 73 of an electronic document database. *Id.* at 8:21–24.

A user who wishes to access electronic documents stored on an electronic document server invokes the web browser at a user station. *Id.* at 7:17–29. Figure 3 of Kikinis, reproduced below, illustrates a series of web browser windows for accessing electronic documents.

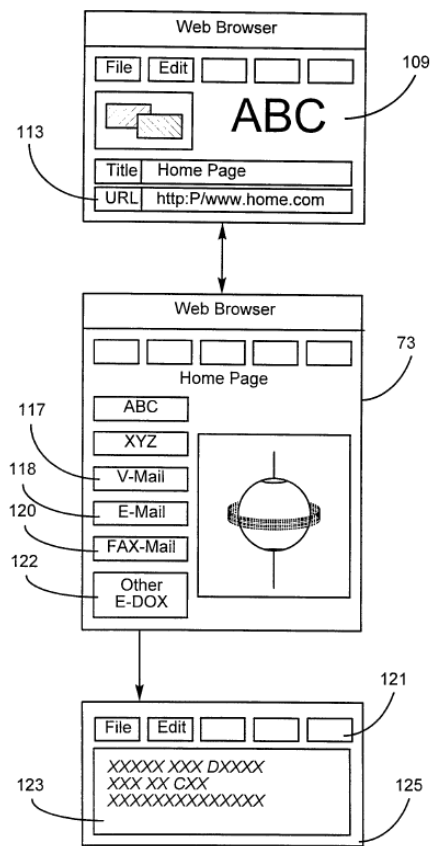


Fig. 3

As shown in Figure 3, a user enters a URL for his home page in field 113. *Id.* at 7:29–31. Home page 73 is retrieved from the remote server

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and displayed as a graphical user interface to data and other web destinations, with on-screen links to the user's electronic documents stored on the electronic document server. *Id.* at 7:31–8:1. For example, as shown in Figure 3, home page 73 provides links to the user's voice-mail (button 117), e-mail (button 118), faxes (button 120), and other electronic documents (button 122). *Id.* at 8:2–13. A user also may use home page 73 to link to other databases, “such as a personal multi-lingual dictionary featuring pronunciation, a spelling checker, or a thesaurus; or indeed, almost any other sort of digital data or control routines.” *Id.* at 8:14–18.

2. Claims 2 and 3

Independent claim 2 of the '290 patent is directed to a computer-readable memory for use by a client computer in conjunction with a server that is accessible by the client via a network and stores a user profile and a user library containing one or more files. 31 Ex. 1001, 39:1–5. The computer-readable memory on the client includes a “program stored on [a] non-volatile data storage device.” *Id.* at 39:10–11. The program is, among other things, “operable upon execution to receive from [the] server one of the user profiles and to display a user-selectable item for user links contained within the user profile,” and “operable in response to selection by a user of one of the user links to access the file associated with the selected user link from the user library associated with the received user profile.” *Id.* at 40:3–11. Claim 3 depends from claim 2 and specifies that the program uses a browser. *Id.* at 40:13–17.

Petitioner provides detailed analysis and claim charts showing where Kikinis describes each limitation of claims 2 and 3. 31 Pet. 15–30. In

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particular, Petitioner asserts that Kikinis discloses the recited “program” (a web browser on a user station), “user library” (user-specific databases, such as an e-mail database, a fax database, a voice-mail database, and an electronic document database, all of which contain user-specific files), and “user profile” (home page) with links to the user’s files. *Id.* at 16–21 (citing 31 Ex. 1004 ¶¶ 119–25). Patent Owner argues that Kikinis fails to describe (a) a program stored on a non-volatile data storage device that performs the functions recited in the claim, (b) a file associated with a selected user link, and (c) a user profile. 31 PO Resp. 8–24. Patent Owner contends that Kikinis does not anticipate claim 3 for the same reasons provided for claim 2. *Id.* at 25.

Having considered the parties’ contentions and supporting evidence, we determine that Petitioner has demonstrated by a preponderance of the evidence that Kikinis anticipates claims 2 and 3 of the ’290 patent. For the reasons discussed below, we are not persuaded by Patent Owner’s contentions.

a. Program stored on a non-volatile data storage device

Patent Owner contends that Kikinis does not disclose a program stored on a client that performs the functions of a “program” as recited in claim 2. 31 PO Resp. 8–16. Specifically, Patent Owner argues that Kikinis discloses a system that provides *indirect* access to electronic documents because it requires programs remotely stored on a server to access remotely stored electronic documents. *Id.* at 9. For example, each electronic document server shown in Figure 2 of Kikinis runs software that supports a specific application, such as an e-mail program or a voice-mail program.

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Id. at 9–10 (citing 31 Ex. 1002, 6:27–31). Patent Owner further submits that Kikinis’s web browser, although stored on a non-volatile data storage device on a client, does not perform the claimed functions of a “program” because it cannot access electronic documents by itself without additional software programs stored on a remote server. *Id.* at 14–16 (citing 31 Ex. 2001 ¶ 21). In other words, Patent Owner essentially contends that the client program recited in claim 2 must provide *direct* access to a file stored in a user library on the server, without the assistance of any program on the server. *See* 31 PO Resp. 9; *see also* 31 Ex. 2004, 24:3–24 (Dr. Plock testifying that Kikinis’s browser cannot correspond to the claimed “program” because it must use a server-side program to access databases, and thus “cannot directly access” the databases).

We are not persuaded by Patent Owner’s argument, which improperly reads “direct” access into the claim. Claim 2 simply requires the program to “access the file,” without precluding the involvement of software on the server to facilitate that access. The broadest reasonable interpretation of “access,” as used in the claim without any modifiers, encompasses the type of file access performed by the browser in the Kikinis system. Moreover, Patent Owner’s own expert admits that in any client-server system, such as the system described and claimed in the ’290 patent, software on a server necessarily is required for the server to respond to a request from a client program, such as a browser. *See* 31 Ex. 2005, 53:14–19, 54:13–18. Thus, we find that Kikinis’s web browser is a program stored on a client that is operable to perform the functions of the “program” recited in claim 2, including accessing a file on the server.

b. File associated with a selected user link

Patent Owner contends that Kikinis does not disclose “selection by a user of one of the user links to access *the file associated with the selected user link* from the user library,” as recited in claim 2. 31 PO Resp. 16–22. According to Patent Owner, Kikinis describes links to software programs and databases, but not links to specific files. *Id.* at 18. As part of its argument, Patent Owner submits that the ’290 patent describes a “one-click” system that provides a “direct link” from an item in the user profile to a specific file in the user library. *Id.* (citing 31 Ex. 1001, 15:12–13 (“The user has the ability to subscribe the channel by making *a direct link to a file . . .*”)).

As an initial matter, the plain language of claim 2 does not require “one-click” access or a “direct link” to files. Although the ’290 patent describes direct links to files, it also describes other means for accessing files. *See, e.g.*, 31 Ex. 1001, 15:12–15 (“The user has the ability to subscribe the channel by making a direct link to a file, *or* by combining various files under some category, *or* by providing a drop down list to a subscribed channel.” (emphases added)); *id.* at 15:53–57 (“[A] library icon . . . , when selected, provides a display as shown in FIG. 5c which contains a list of all of the files contained in the user library. *From here*, the user can access any of the files contained in his or her user library” (emphasis added)). Patent Owner does not present persuasive evidence or argument for importing a “one-click” limitation into claim 2.

Turning to Kikinis, we find that, contrary to Patent Owner’s arguments, Kikinis discloses the selection of a user link to access the file associated with the selected user link from the user library. Kikinis

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specifically states that its home page, which corresponds to the claimed user profile, has “on-screen links to electronic documents reserved for the home page ‘owner’, such as e-mail and faxes.” 31 Ex. 1002, 7:35–8:1. Patent Owner’s expert, Dr. Plock, agrees that this passage from Kikinis discloses links to electronic documents. 31 Ex. 2005, 66:6–20. Thus, Kikinis clearly discloses links on a user’s home page to individual, electronic documents, which are “files” as that term is defined in the ’290 patent. *See supra* II.A.1.

In addition, it is undisputed that Kikinis discloses a home page with links to databases. *See, e.g.*, 31 Pet. 17; 31 PO Resp. 20. As described in Kikinis, in connection with Figure 2, web server 67 stores a set of databases 71, each of which “belongs to (or is assigned to or is associated with) a different client.” 31 Ex. 1002, 6:32–35. Each database set 71 includes home page 73 that is individualized to a specific user and provides links to various lower-order databases maintained by electronic document server 69 for each user, such as e-mail database 89, fax database 91, voice-mail database 93, and database 95 containing other electronic documents. *Id.* at 6:35–7:4; *see id.* at Fig. 2 (showing client-specific databases 89, 91, 93, and 95).

Patent Owner agrees that Kikinis describes links to databases, but argues that databases are not files. 31 PO Resp. 17–18, 20; 31 Ex. 2001 ¶¶ 24–25. The ’290 patent, however, defines “file” as “[a]ny digital item, including information, documents, applications, audio/video components, and the like, that is stored in memory and is accessible via a file allocation table or other pointing or indexing structure.” 31 Ex. 1001, 4:25–28; *see supra* II.A.1. At his deposition, Patent Owner’s expert, Dr. Plock, admitted that the databases for e-mail, fax, voice-mail, and other electronic documents in Kikinis meet the requirements of a file, as that term is used in the

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'290 patent. *See* 31 Ex. 2005, 59:21–63:20. Specifically, Dr. Plock agreed that the databases are stored in digital form, *id.* at 63:15–20, are stored in memory, *id.* at 59:21–23, 62:21–24, and can be accessed using a pointing or indexing structure, *id.* at 59:24–60:1, 60:9–11, 62:25–63:7. Dr. Plock further agreed that a user accesses the databases in Kikinis via links on the home page, which corresponds to the claimed user profile. *Id.* at 71:19–72:8. The databases disclosed in Kikinis, therefore, are files associated with selected user links, as recited in claim 2.

Patent Owner and its expert contend that Kikinis's lower-order databases (e-mail database 89, fax database 91, voice-mail database 93, and database 95 for other electronic documents) do not comprise a "user library," as required by claim 2, because the databases contain e-mails, voice-mails, and faxes for multiple users. *See* 31 Tr. 32:11–25; 31 Ex. 2004, 36:3–14; 31 Ex. 2005, 56:20–57:1. This argument, however, is inconsistent with the disclosures in Kikinis, including the client-specific databases shown in Figure 2. *See* 31 Ex. 1002, 8:30–31 (describing electronic document databases as belonging to a user). Kikinis, therefore, discloses a user library (i.e., a collection of databases stored for a user) containing one or more files (i.e., databases 89, 91, 93, and 95), which may be selected by a user link in a user profile (i.e., home page).

Thus, Kikinis discloses selection of a link to access a file associated with the selected link from a user library in at least two ways—via a link to an electronic document stored in a user's database of electronic documents, which corresponds to the recited "user library," and via a link to one of the user's databases, e.g., the user's e-mail database, which is a "file" as that

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term is defined in the '290 patent and which, together with other databases, comprise a “user library.”

c. User profile

Patent Owner contends that the home page disclosed in Kikinis is not a “user profile” as recited in claim 2 because Kikinis contains no mention of any “user-specific information relating to an individual using a computer” found within the home page. 31 PO Resp. 23. Kikinis, however, describes a home page as “a graphical interface unique to an individual user” that “functions in part as a table of contents.” 31 Ex. 1002, 2:3–5. Further, Kikinis specifically indicates the home page has “indicia identifying the home page owner” and is “individualized to a specific client.” *Id.* at 3:3–4, 6:34–35. Patent Owner’s argument fails to account for these express disclosures of “user-specific information” in Kikinis.

C. Asserted Ground of Obviousness over Foley

Petitioner contends that claims 2 and 3 are unpatentable under 35 U.S.C. § 103(a) for obviousness over Foley, relying on declaration testimony of Mr. Gray.⁸ 33 Pet. 13–43 (citing 33 Ex. 1003). Patent Owner responds, relying on declaration testimony of Dr. Plock. 33 PO Resp. 8–26 (citing 33 Ex. 2001). Having considered the parties’ contentions and

⁸ Patent Owner argues that the testimony submitted by Petitioner from Mr. Gray is not in the form of an affidavit and, therefore, does not comply with 37 C.F.R. § 42.53. 33 PO Resp. 26. Patent Owner, however, did not serve objections to this testimony within ten days of the institution of trial and did not file a motion to exclude this testimony. *See* 33 Tr. 52:6–17. Accordingly, Patent Owner has withdrawn the objection to Mr. Gray’s testimony. *Id.* at 52:18–53:3.

supporting evidence, we determine that Petitioner has demonstrated by a preponderance of the evidence that claims 2 and 3 would have been obvious over Foley.

1. Summary of Foley

Foley describes a software development and file management system that enables users to create and work with portfolios of software projects that are distributed over a set of networked computers connected to the Internet. 33 Ex. 1002, 1:5–8, 2:46–49. The system includes a software application called the Java Workshop (JWS) program stored in memory on a first computer of the set of networked computers. *Id.* at 3:63–66, 4:28–31. The JWS program allows a user to organize various projects, including executable programs (Java applets and standalone executable programs) and non-executable files (image files and Java class libraries), into collections called portfolios. *Id.* at 3:66–4:3. In particular, the JWS program has an integrated browser that allows a user to create and work with portfolios that are remote from the user’s computer and local network, in addition to portfolios that are local. *Id.* at 4:3–8. A user can create and name a new portfolio, and add or import projects to the portfolio. *Id.* at 7:66–8:10. The creator of a portfolio can keep it private or publish it on the Internet to be accessed by others. *Id.* at 8:11–13.

In a preferred embodiment, “a portfolio file represents one portfolio and includes respective references to members of a set of project files.” *Id.* at 2:55–57. Figure 5 of Foley, reproduced below, illustrates the structure of a portfolio file and its constituent projects. *Id.* at 7:29–46.

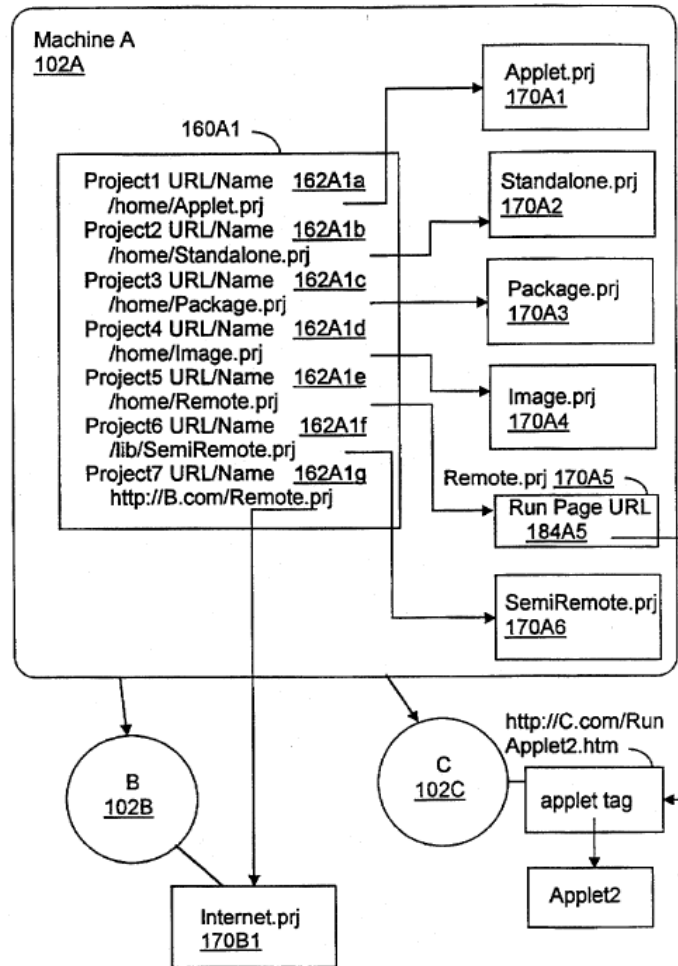


FIG. 5

As shown in Figure 5, portfolio file 160A1 contains references 162A1j to constituent projects. *Id.* at 7:29–40. For example, reference 162A1a (“Project1 URL/Name/home/Applet.prj”) provides a reference, or link, to project file 170A1 (“Applet.prj”), and reference 162A1b (“Project1 URL/Name/home/Standalone.prj”) provides a link to project file 170A2 (“Standalone.prj”). *Id.* Each reference to a project file can be a file name when the project file is local to the user’s computer (e.g., Machine A in

Figure 5) or a Web page URL when the project file is stored on a remote computer. *Id.* at 2:57–60, 7:35–40.

Figure 6 of Foley, reproduced below, depicts the graphical user interface of the JWS program on a user's computer with portfolio files and projects displayed. *Id.* at 12:63–13:25.

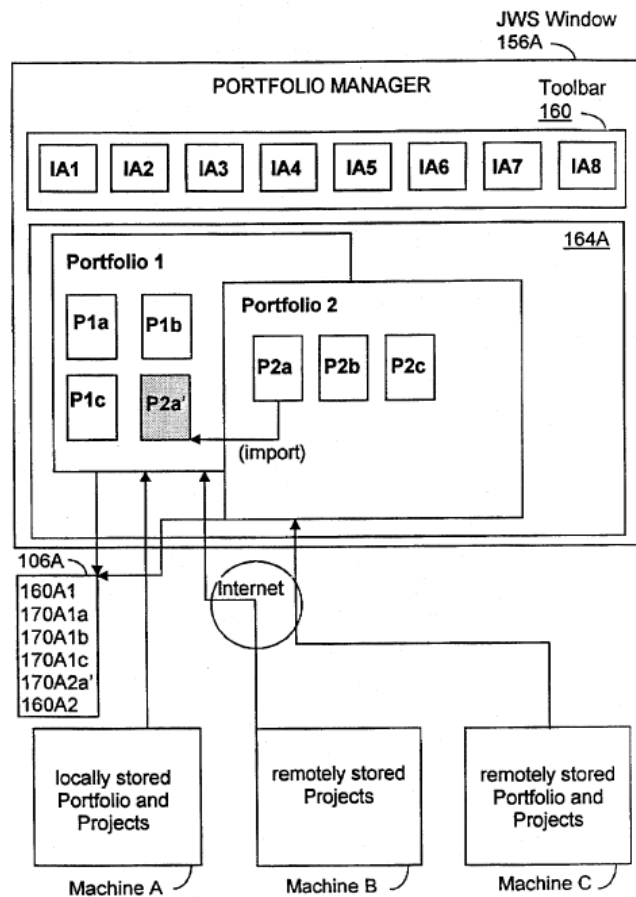


FIG. 6

As shown in Figure 6, Machine C is a remote computer that stores Portfolio 2 and its project files P2a, P2b, and P2c. *Id.* at 13:13–14. The user's computer obtains portfolio file and project information from Machine C over the Internet and displays the links to project files P2a, P2b, and P2c. *Id.* at 13:14–17. The user can interact with remote project files in

the same way as local project files, e.g., by double-clicking an icon representing an applet, or by selecting a project for editing. *Id.* at 4:22–25, 8:66–9:7.

2. *Claims 2 and 3*

Petitioner provides detailed analysis and claim charts showing where Foley teaches or suggests each limitation of claims 2 and 3. 33 Pet. 14–43. In particular, Petitioner asserts that Foley teaches a portfolio management system resident on a first computer, corresponding to the claimed “client,” and portfolio and project information on a remote computer, corresponding to the claimed “server.” 33 Pet. 14–15, 27. Petitioner further submits that Foley’s JWS program, which includes a browser, corresponds to the “program” recited in claims 2 and 3. *Id.* at 21–27, 32–43. As for the remaining limitations of claim 2, Petitioner asserts that Foley teaches a “user profile” (Foley’s portfolio file, e.g., A160A1 in Figure 5) containing “user links” (references to project files, e.g., A162A1a in Figure 5) that provide links to “files” (project files, e.g., 170A1 in Figure 5) contained in a “user library” (collection of a user’s project files, e.g., projects 170A1–A4 in Figure 5). *Id.* at 15–18, 27–32.

Claim 2 requires the server to store a user profile and user library for each of a number of different users. 33 Ex. 1001, 39:3–5. Petitioner asserts that Foley teaches, or at least suggests, that a single server can store both the portfolio file (corresponding to the claimed user profile) and the collection of project files (corresponding to the claimed user library), as shown in Figure 6 of Foley. 33 Pet. 18–19 (citing 33 Ex. 1002, Fig. 6, 12:63–13:25). Moreover, although Foley does not state explicitly that portfolios and project

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files for two or more users can be stored on the same computer (server), Petitioner asserts it would have been obvious to a person of ordinary skill in the art that multiple users could create portfolios with corresponding projects on the same computer for the purpose of convenient access and reduction in hardware costs. 33 Pet. 19–20 (citing 33 Ex. 1003 ¶¶ 122–23).

Patent Owner argues that Foley fails to teach (a) a user profile, (b) a user profile that is distinct from the user library, and (c) a program stored on a non-volatile data storage device that performs the functions recited in claim 2. 33 PO Resp. 8–25. Patent Owner contends that claim 3 would not have been obvious for the same reasons provided for claim 2. *Id.* at 26. For the reasons discussed below, we are not persuaded by Patent Owner’s contentions. Instead, having considered the parties’ contentions and supporting evidence, we determine that Petitioner has demonstrated by a preponderance of the evidence that Foley teaches or suggests all the limitations of claims 2 and 3 of the ’290 patent and that claims 2 and 3 would have been obvious over Foley.

a. User profile

Patent Owner contends that the portfolio file described in Foley is not a “user profile” as recited in claim 2 because the portfolio file incorporates no components that are “user-specific information relating to an individual using a computer,” according to the definition of a user profile provided in the ’290 patent. *See supra* II.A.1. 33 PO Resp. 13–14. We are not persuaded by Patent Owner’s argument. As Petitioner asserts, a portfolio file in Foley contains references or links to a user’s project files, which are created and named by the user. 33 Pet. 15 (citing 33 Ex. 1002, 7:66–8:13;

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33 Ex. 1003 ¶ 120). Foley also teaches that a user can create and name a new portfolio and keep it private instead of making it available for public use. 33 Ex. 1002, 7:66–8:13. Patent Owner’s expert, Dr. Plock, confirmed these teachings of Foley and agreed that a profile containing a user’s preferences of links is a profile including “user-specific information.” See 33 Ex. 1014, 19:2–5, 19:16–21, 21:22–22:2. Thus, we find that Foley teaches a user profile as recited in claim 2.

b. User profile distinct from user library

Patent Owner contends that Foley does not teach a “user profile” separate from a “user library.” 33 PO Resp. 8–13. We disagree. In its mapping between the disclosure of Foley and the limitations of claim 2, Petitioner asserts that Foley’s portfolio file corresponds to the claimed “user profile,” and the collection of a user’s project files in Foley corresponds to the claimed “user library.” 33 Pet. 15–18. Patent Owner does not dispute this mapping, but instead argues that Foley’s portfolio file and collection of project files “describe the same thing.” 33 PO Resp. 9.

Based on the evidence and our reading of Foley, we agree with Petitioner that Foley teaches a user profile (Foley’s portfolio file) that is distinct from a user library (Foley’s collection of project files). As depicted in Figure 5 of Foley, the portfolio file is a file that provides references or links to individual project files. 33 Ex. 1002, 7:29–40. For example, reference 162A1a (“Project1 URL/Name/home/Applet.prj”) in portfolio file 160A1 provides a link to project file 170A1 (“Applet.prj”). *Id.* at 7:38–40. The collection of project files, on the other hand, is the plurality of individual project files that can be linked from the portfolio file. *Id.* at

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Fig. 5; 33 Ex. 2003, 279:9–11 (Mr. Gray testifying that Foley’s “portfolio file has pointers that point into the collection [of] projects that . . . comprise the portfolio”); 33 Ex. 1003 ¶ 121. Contrary to Patent Owner’s argument, its own expert, Dr. Plock, agreed that a portfolio file contains references to project files and that the portfolio file is distinct from the collection of project files. 33 Ex. 1014, 16:3–12. For these reasons, we are not persuaded by Patent Owner’s contention that Foley fails to teach a user profile that is separate from a user library.

c. Program stored on a non-volatile data storage device

Patent Owner’s final argument is that Foley does not disclose a single program that performs all the functions recited in claim 2. 33 PO Resp. 17–25. Instead, Patent Owner contends that Foley describes two separate programs—JWS program 150 and JWS browser 154A—and that neither one alone is operable to perform all the recited functions. *Id.* Specifically, Patent Owner argues that the JWS program and JWS browser are not “related” program modules and, therefore, together do not qualify as a “program” as that term is defined in the ’290 patent. *Id.* at 18; *see supra* II.A.1 (defining “program” as “[o]ne or more related program modules”).

We are not persuaded by Patent Owner’s argument. First, the disclosure of Foley contradicts Patent Owner’s assertion, as it states explicitly that “[t]he JWS program 150A has an *integrated* JWS Browser 154A that allows a user seamlessly to create and work with portfolios that are remote . . . or local” and “the JWS program 150A *incorporates* a JWS Browser 154A.” 33 Ex. 1002, 4:4–8, 4:59–60 (emphases added). Thus, under the definition of “program” in the ’290 patent, a person of ordinary

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skill in the art would understand Foley’s JWS program to be a “program” and the JWS browser to be one “program module” within the JWS program. *See* 33 Reply 8.

Even if the JWS program and JWS browser are considered to be separate program modules, as Patent Owner contends, we find they are “related” program modules that together comprise a “program.” We are not persuaded by the opinion of Patent Owner’s expert that the JWS browser and JWS program have different features and capabilities and, therefore, are not related. *See, e.g.*, 33 Ex. 2001 ¶ 36. In addition to describing the JWS browser as integrated within the JWS program, Foley states that the browser is “employed by,” “triggered by,” or “under control of” the JWS program at various times. 33 Ex. 1002, 2:66–67, 5:2–4, 13:6–8. Accordingly, the JWS program and JWS browser described in Foley together satisfy the “program” limitation recited in claim 2. *See* 33 Pet. 21–27, 32–43.

III. CONCLUSION

Based on the evidence and arguments, Petitioner has demonstrated by a preponderance of the evidence that claims 2 and 3 of the ’290 patent are anticipated by Kikinis under 35 U.S.C. § 102(b), and claims 2 and 3 would have been obvious over Foley under 35 U.S.C. § 103(a).

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IV. ORDER

Accordingly, it is:

ORDERED that claims 2 and 3 of U.S. Patent No. 6,771,290 B1 are unpatentable.

This is a final written decision. Parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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