UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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FACEBOOK, INC.
Petitioner

v.

WINDY CITY INNOVATIONS, LLC
Patent Owner

U.S. Pat. No. 8,694,657
Issue Date: April 8, 2014
Title: REAL TIME COMMUNICATIONS SYSTEM
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PATENT OWNER'S NOTICE OF APPEAL

Case No. IPR2016-01155[1]
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[1] Case No. IPR2017-00622 has been joined with this proceeding.

Pursuant to 35 U.S.C. §§ 141 and 142 and 37 C.F.R. §§ 90.2 and 90.3,

Patent Owner Windy City Innovations, LLC hereby provides notice that it appeals

to the United States Court of Appeals for the Federal Circuit from the Final

Written Decision entered December 6, 2017 (Paper 63) and from all underlying

orders, decisions, rulings, and opinions regarding U.S. Patent No. 8,694,657 (the

"'657 patent") in Case No. IPR2016-01155. This notice is timely under 37 C.F.R.

§ 90.3, having been filed within 63 days after the date of the Final Written

Decision.

For the limited purpose of providing the Director with the information

requested in 37 C.F.R. § 90.2(a)(3)(ii), Patent Owner anticipates that the issues on

appeal may include, but are not limited to: the Board's decision to join IPR2017-

00622 with IPR2016-01155 (Paper 32) with respect to only a subset of the claims

for which the IPR2016-01155 petition sought invalidation; the Board's decision to

maintain the IPR2016-01155 "in abeyance" without a petitioner (Paper 31); the

Board's decision denying termination as to Patent Owner (Paper 33); the Board's

decision denying Patent Owner's request for rehearing with respect to joinder and

termination (Paper 53); the Board's claim constructions, the Board's prior art

determinations, and the Board's determination that claims 189 and 465 of the '657

patent are unpatentable under 35 U.S.C. § 103 (Paper 63); the findings, rulings and

conclusions supporting or relating to those determinations; and any other issues

decided adversely to Patent Owner in any orders, decisions, rulings, or opinions in

IPR2016-01155 and IPR2017-00622.

Simultaneous with this submission, three (3) copies of this Notice of Appeal

are being filed with the Clerk of the United States Court of Appeals for the Federal

Circuit and being submitted electronically through the Court's CM/ECF system,

together with the requisite fee in the amount of $500. In addition, a copy of this

Notice of Appeal is being filed with the Patent Trial and Appeal Board and served

upon counsel of record for Facebook, Inc.

Respectfully submitted,

Dated: February 7, 2018

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FACEBOOK, INC.,
Petitioner,

v.

WINDY CITY INNOVATIONS LLC,
Patent Owner.

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Case IPR2016-01155[1]
Patent 8,694,657 B1

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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

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[1] Case IPR2017-00622 has been joined with this proceeding.

I. INTRODUCTION

A. Background

Microsoft Corporation filed a Petition (Paper 1, "Pet.") to institute an *inter partes* review of claims 1, 2, 18, 27, 35, 43, 51, 65, 79, 93, 100, 108, 114, 126, 138, 150, 156, 168, 170, 172, 176, 178, 180, 182–90, 202, 208, 214, 220, 226, 238, 250, 262, 268, 274, 280, 292, 304, 316, 322, 328, 334, 336, 340, 342, 344, 346, 348, 350, 352–54, 362, 366, 370, 374, 378, 386, 394, 402, 406, 410, 414, 422, 430, 438, 442, 450, 452, 454, 456, 458, 460, 462, 464–66, 476, 481, 486, 491, 496, 505, 515, 525, 530, 535, 545, 555, 565, 570, 580, 582, 584, 586, 588, 590, 592, 594, 596–98, 606, 607, 615–17, 619, 621, 622, 624–26, 628, 630, 632–34, 636, 638, 640–42, 644, 646, and 648–71 of U.S. Patent No. 8,694,657 B1 (Ex. 1001, "the '657 patent"). Windy City Innovations LLC ("Patent Owner") filed a Preliminary Response (Paper 9, "Prelim. Resp.").

Pursuant to 35 U.S.C. § 314, in our Institution Decision (Paper 12, "Dec."), we instituted this proceeding as to each of these challenged claims.

Patent Owner filed a Patent Owner's Response (Paper 27, "PO Resp."), and Petitioner filed a Reply to the Patent Owner's Response (Paper 44, "Reply").

Between the PO Response and the Reply, Facebook, Inc. ("Petitioner") filed a Petition (IPR2017-00622, Paper 2, "Joinder Pet.") for *inter partes* review of claims 189 and 465 of the '657 patent in IPR2017-00622 along with a Motion for Joinder with this proceeding (IPR2017-0622, Paper 3). Before we ruled on the Motion for Joinder, Microsoft and Patent Owner settled and moved to terminate this proceeding. Paper 29. We granted the Motion to Terminate as to Microsoft, but not as to Patent Owner.

Paper 31. Subsequently, we instituted an *inter partes* review of claims 189 and 465 in IPR2017-0622, granted Petitioner's motion for joinder, and dismissed all challenged claims except for 189 and 465. Paper 32 ("Joinder Dec."). We then denied the Motion to Terminate as to Patent Owner. Paper 33. We also denied a Request for Rehearing of our decision denying the Motion to Terminate. Paper 53.

Petitioner relies on the Declarations of Christopher M. Schmandt (Ex. 1003, "Schmandt Decl."; Ex. 1100, "Schmandt Reply Decl."). Patent Owner relies on the Declaration of Jaime G. Carbonell, Ph.D. (Ex. 2006, "Carbonell Decl.").

An oral argument was held on October 19, 2017 (Paper 62, "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 189 and 465. Based on the record before us, Petitioner has proved, by a preponderance of the evidence, that claims 189 and 465 of the '657 patent are unpatentable.

B. Related Matters

The parties indicate that the '657 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. 3; Paper 7, 1. The '657 patent also is the subject of an *inter partes* review petition in IPR2016-01159. Pet. 3; Paper 7, 1. Related U.S. Patent Nos. 8,458,245, 8,407,356, and 8,473,552 are subject to additional *inter partes* reviews. Pet. 3.

C. Asserted Prior Art References

Petitioner relies on the following prior art:

U.S. Patent No. 5,941,947, issued Aug. 24, 1999, filed Aug. 18, 1995
    (Ex. 1012, "Brown"); and

Donath & Robertson, *The Sociable Web* (Ex. 1019, "Sociable Web").[2]

D. The Instituted Ground

We instituted a trial on the ground of unpatentability of claims 189 and 465 as obvious, under 35 U.S.C. § 103(a), over Brown and Sociable Web. Dec. 36–37; Joinder Dec. 17–18.

E. The '657 Patent

The '657 patent describes an Internet "chat room." According to the '657 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 "America On Line." Ex. 1001, 1:33–37. The '657 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 because "[t]he 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

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[2] Petitioner also submitted Exhibit 1030, which Petitioner contends is a version of Sociable Web archived by the Internet Archive at https://web.archive.org/web/19980111061831/http:/judith.www.media.mit. edu/SocialWeb/SociableWeb.html. Pet. 18.

the platform that would be encountered on the Internet." *Id.* at 1:38–44,
1:50–52.

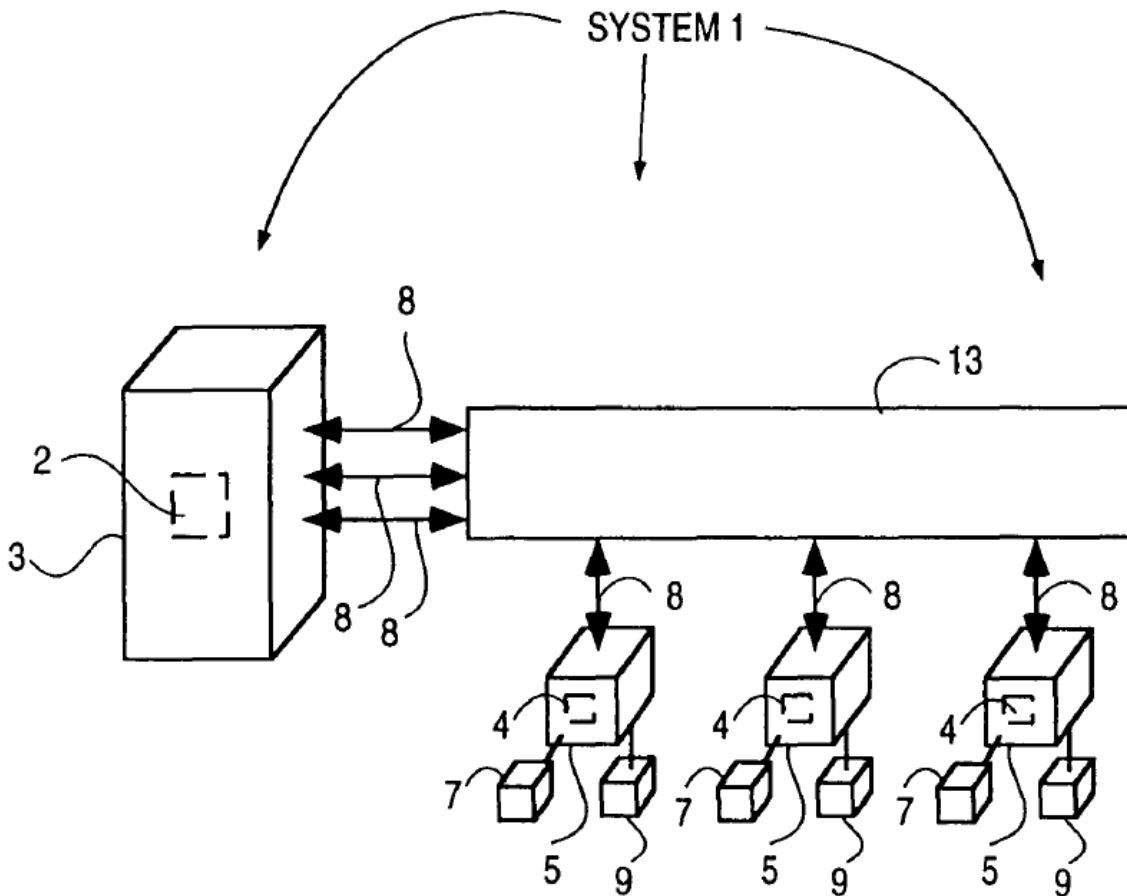Figure 1, reproduced below, illustrates an embodiment of the
invention:

Figure 1 is a block diagram showing the components and data flow of a
computerized human communication arbitrating and distributing system.
Id. at 4:36–40. The system includes controller computer 3 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 4:41–60.

Controller computer 3 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 4:61–67. The software uses "identity tokens," or pieces of information associated with user identity, in the arbitration. *Id.* at 7:49–52. The tokens are stored in a memory in a control computer database along with personal information about the users. *Id.* at 7:52–57.

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 7:62–8:6. 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—quantity, type, and subject.

Id. at 8:11–19.

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 5:11–16.

Claims 189 and 465, reproduced below, are the only claims

challenged in this proceeding:

189. 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, 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; and

determining whether the first user identity and the second user identity are able to form a group to send and to receive real-time communications; and

determining whether the first user identity is individually censored from sending data in the communications, the data presenting at least one of a pointer, video, audio, a graphic, and multimedia by determining whether a respective at least one parameter corresponding to the first user identity has been determined by an other of the user identities; and

if the user identities are able to form the group, forming the group and facilitating sending the communications that are not censored from the first participator computer to the second participator computer, wherein the sending is in real time and via the Internet network, and wherein, for the communications which are received and which present an Internet URL, facilitating handling the Internet URL via the computer system so as to find content specified by the Internet URL and

presenting the content at an output device of the second participator computer, and

if the first user identity is censored from the sending of the data, not allowing sending the data that is censored from the first participator computer to the second participator computer.

465. An Internet network communications system, the system including:

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, the computer system in communication with a first of the participator computers responsive to a first authenticated user identity and with a second of the participator computers responsive to a second authenticated user identity, wherein the computer system

determines whether the first user identity and the second of the user identity are able to form a group to send and to receive real-time communications; and

determines whether the first user identity, is individually censored from sending data in the communications, the data presenting at least one of a pointer, video, audio, a graphic, and multimedia by determining whether a respective at least one parameter corresponding to the first user identity has been determined by an other of the user identities; and

if the user identities are determined to be able to form the group, forms the group and facilitates sending the communications that are not censored from the first participator computer to the second participator computer, wherein the sending is in real time and via the Internet network, and wherein the computer system facilitates, for the communications which

are received and which present an Internet URL, handling the Internet URL via the computer system so as to find content specified by the Internet URL and facilitates presenting the content at an output device of the second participator computer; and

if the first user identity is censored from sending the data, does not facilitate sending the data that is censored from the first participator computer to the second participator computer.

II. ANALYSIS

A. *Claim Construction*

We interpret claims of an unexpired patent using the broadest reasonable construction in light of the specification of the patent in which they appear. *See* 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–45 (2016). Nevertheless, the '657 patent is expired. "[T]he Board's review of the claims of an expired patent is similar to that of a district court's review." *In re Rambus Inc.*, 694 F.3d 42, 46 (Fed. Cir. 2012) (internal citations omitted). District courts construe claims in accordance with their ordinary and customary meanings, as would be understood by a person of ordinary skill in the art, in the context of the specification. *See Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

1. Constructions in the Institution Decision

In the Institution Decision, we preliminarily construed the following terms (Dec. 8–15; Joinder Dec. 10):

Claim Term	Preliminary Construction
"token"	"piece of information associated with user identity"
"censor"	"control what is said in a group"
"the first user identity is individually censored from sending data in the communications"[3]	refers to control of data sent by the first user identity, 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"
"a pointer-triggered message on demand"[4]	"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. 11, and challenges our construction of "censor," *id.* at 15–16. Petitioner accepts our construction of "censor" and presents arguments in favor of that construction. Reply 5–6. We maintain

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[3] The Institution Decision (at 12–16) construed the term "the first user identity is individually censored from receiving data in the communications," recited in claim 1, no longer challenged. The Joinder Decision (at 10) construed the similar term "the first user identity is individually censored from sending data in the communications," recited in claim 189.

[4] Neither of the currently challenged claims recites "a pointer-triggered message on demand."

our construction of "token" on the complete record. We address the construction of "censor," below, as well as the construction of the related term "the first user identity is individually censored from sending data in the communications." Neither party challenges our construction of "pointer" and we maintain that construction on the complete record.[5] Patent Owner also proposes construing "database." PO Resp. 11–15. We agree with Petitioner (Reply 1–2), however, that Patent Owner does not argue that the construction of "database" affects any disputed issue in this proceeding. Thus, it is not necessary to expressly construe "database" to resolve the parties' dispute. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g*, Inc., 200 F.3d 795, 803 (Fed. Cir. 1999) ("[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.").

2. *"censor" / "the first user identity is individually censored from sending data in the communications"*

Claim 189 recites "determining whether the first user identity is individually censored from sending data in the communications." Claim 465 includes a similar recitation. As noted above, we preliminarily construed "censor" to mean "control what is said in a group" and explained that "the first user identity is individually censored from receiving data in the communications" refers to control of data received by the first user identity, individually, and is not limited to data suppressed based on the content of those data or by a moderator. Dec. 14–15. In the Joinder Decision (at 10),

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[5] Although this decision analyzes the claims under the *Phillips* standard, in related proceedings, we reach substantially the same constructions of these claim terms under the broadest reasonable interpretation.

we made clear that, for the same reasons as given in the Institution Decision for claim 1, "the first user identity is individually censored from sending data in the communications," as recited in claim 189, refers to control of data sent by the first user identity, individually, and is not limited to data suppressed based on the content of those data or by a moderator.

We based our construction on the description of that term in the specification. *Id.* at 13–14. 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 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, 8:10–19 (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 "proposes that censorship be construed as 'examine in order to suppress or delete anything considered objectionable.'" PO Resp. 16. 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.* at 15. 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 7–9). 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 189 recites "determining whether the first user identity is individually censored from sending data in the communications." 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 14), 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 v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005) (en banc) ("[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 189, for example, "determining whether the first user identity is individually censored from sending data in the communications" refers to

control of data received by first user identity, 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 claim 465.

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

In an obviousness analysis, some reason must be shown as to why a person of ordinary skill would have combined or modified the prior art to achieve the patented invention. *See Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1374 (Fed. Cir. 2008). A reason to combine or modify the prior art may be found explicitly or implicitly in market forces; design incentives; the "interrelated teachings of multiple patents"; "any need or problem known in the field of endeavor at the time of invention and addressed by the

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

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 Mr. Schmandt's testimony, Petitioner contends that a
person of ordinary skill in the art "would have been a person with a Bachelor
of Science degree in Computer Science, or equivalent, with at least two
years' experience designing and programming distributed multimedia
computer systems, including experience with teleconferencing and on-line
chat systems, such as on-line bulletin boards." Pet. 5 (citing Ex. 1003
¶ 140); Joinder Pet. 6. Patent Owner does not contest this statement in its
Response. On the complete record, we adopt Petitioner's statement of the
level of ordinary skill.

2. Scope and Content of the Prior Art

Petitioner contends that claims 189 and 465 would have been obvious
over Brown, alone or in combination with Sociable Web. Specifically,
Petitioner cites Sociable Web for teachings of "via an Internet network"
(Pet. 19–20; Joinder Pet. 19–20), "a pointer" (Pet. 28–29; Joinder Pet. 30–
31), and "an Internet URL" (Pet. 31; Joinder Pet. 33–34) to the extent we
find that those claim limitations are not taught in Brown.

a. Overview of Brown

Brown describes a system and method for controlling user access to content objects, such as bulletin board systems ("BBS") and chat conferences, in a computer network. Ex. 1012, 2:20–39. User access rights are stored in a database, which is implemented as a relational database on one or more security servers connected to application servers by a local area network ("LAN"). *Id.* at 2:59–66. Access rights data are stored in association with multiple "tokens," which identify categories or groupings of content objects. *Id.* at 2:66–3:7. Service applications running on application servers query the access rights database to obtain access rights lists of specific users. *Id.* at 3:26–29. A user's access rights can be categorized in the form of a privilege level (e.g., "viewer," "user," "host," "sysop," and "supersysop"), which translate into specific sets of access capabilities by the service applications. *Id.* at 3:46–62.

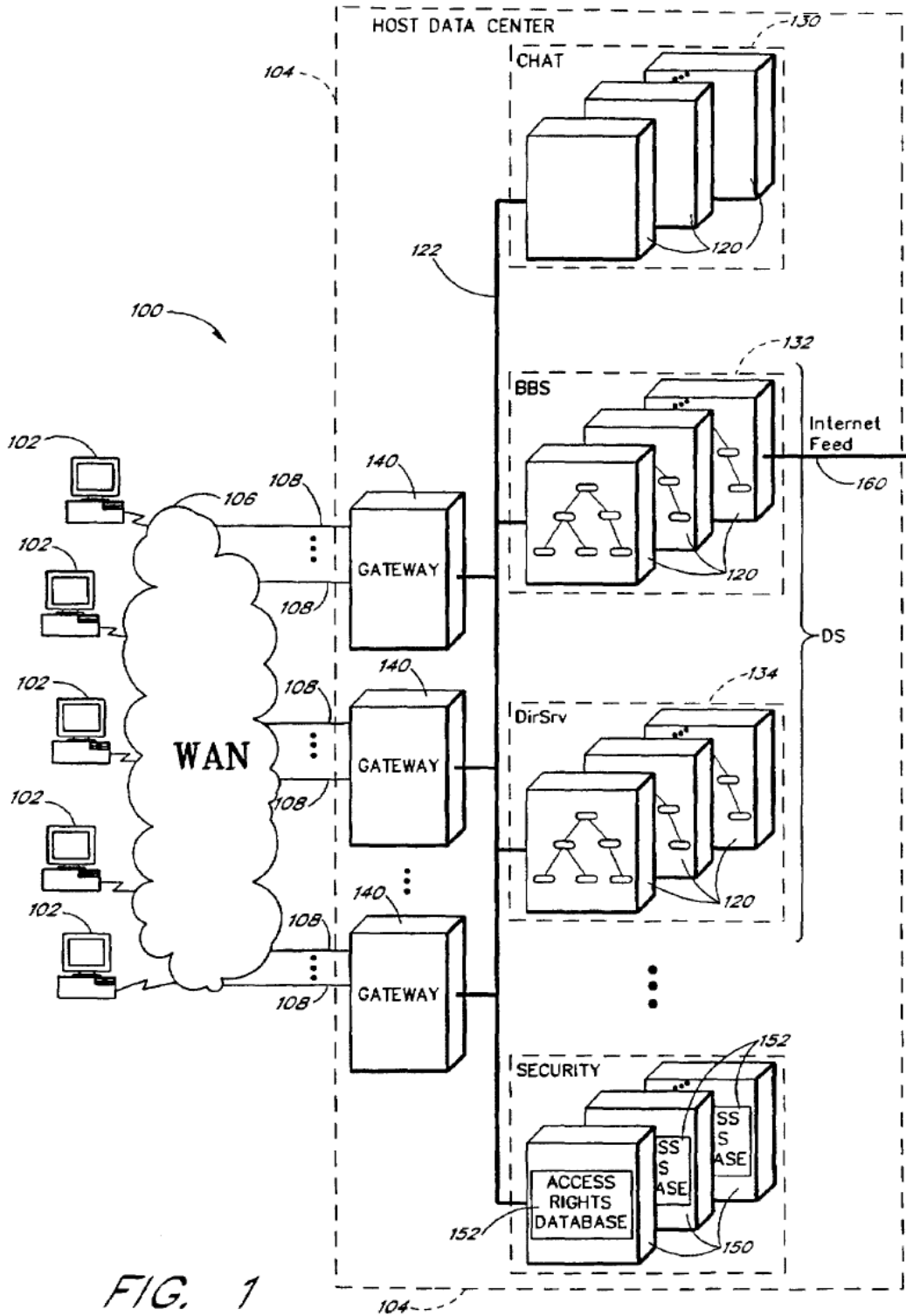Figure 1, reproduced below, illustrates an example:

FIG. 1

Figure 1 is a block diagram of the general architecture of an on-line services network. *Id.* at 5:26–28, 6:62–63. On-line services network 100 includes

multiple client computers 102 connected to host data center 104 by wide area network ("WAN") 106 provided by one or more telecommunications providers. *Id.* at 6:62–7:1. WAN lines 108 of WAN network 106 can include Transmission Control Protocol/Internet Protocol ("TCP/IP") lines. *Id.* at 7:4–6. Host data center 104 includes application servers 120 arranged into service groups corresponding to on-line services (e.g., CHAT group 130 and BBS group 132) and connected over LAN 122. *Id.* at 7:9–11, 7:18–24. Multiple security servers 150, each maintaining relational database 152, are connected to LAN 122. *Id.* at 7:48–53.

Relational database 152 is organized as a set of two or more interrelated tables that contain the access rights data for all users of on-line services network 100. *Id.* at 7:53–56. Tokens also can correspond to content categories, or groups. *Id.* at 20:1–3. In one example, "[t]he content category 'Family and Friends for Brown Family' may similarly be formed to allow private correspondence between a small group of subscribers (e.g., Brown family members plus designated friends), and may contain, for example, Chat and BBS objects which have been designated for this purpose." *Id.* at 20:19–24, 7:53–56. Brown describes the following example of assigning such access rights:

> To provide a specific example, suppose that a system administrator wants to create a Chat room to allow members of a certain organization to carry on an interactive conversation. To create such a Chat room, the system administrator initially creates a Chat room node, specifying a unique security token for the Chat room. The system administrator then updates the group-member table 602 so as to create a new group that consists of the accounts of the members of the organization. (If the group is small, the system administrator may forego creating a new user group, and may alternatively generate one user-specific row in

the account-token table 606 for each member of the organization.) Finally, the system administrator adds a row to the group-token table 604, specifying (1) the group ID of the newly-created user group, (2) the security token of the Chat room, and (3) an appropriate access rights value.

Id. at 31:5–21.

Brown describes its chat service as "an interactive communications service which allows users to have real time conversations with other users on specific topics. Chat conversations or 'conferences' are organized as 'Chat rooms' which may be entered or exited by end users to join or leave the corresponding conferences." *Id.* at 9:45–50. According to Brown, "[p]articipants in a Chat conference can type in textual messages which will be displayed on the monitors of other participants. Voice and/or video capabilities may additionally be provided." *Id.* at 9:52–55.

When a user navigates to a chat room, the Chat service calls an application program interface to determine the rights of the user with respect to the Chat room. *Id.* at 15:66–16:4. Chat servers 120 can generate such calls as a user moves from Chat object to Chat object within the Chat service. *Id.* at 27:28–30. The general privilege levels of the access rights are transformed into specific access capabilities for the on-line service. *Id.* at 17:25–28. "For example, the Chat service may give moderator-type access capabilities to users that have the privilege level of 'host.'" *Id.* at 17:28–30; *see also id.* at 17:57–60.

b. *Sociable Web*

(1)*Prior art status of Sociable Web*

Sociable Web is a paper, archived by the Internet Archive, that
Petitioner argues was presented to conference goers along with a live
presentation at The Second International WWW Conference '94 in Chicago
in late October 1994. Pet. 18. Petitioner contends that Exhibit 1030 is the
Internet Archive version of Sociable Web. *Id.* In support of the assertion
that Sociable Web was presented at the 1994 conference in Chicago,
Petitioner cites to conference proceedings referring to the title of the paper
and presenters (Ex. 1021, ix)[7], and a declaration of one of the authors, Judith
Donath (Ex. 1031). Dr. Donath testifies that she presented the paper
(Ex. 1019) at the 1994 conference and made the paper available on the
conference's website by the time of the conference. Ex. 1031 ¶ 7.
Dr. Donath also testifies that the paper was available on her MIT web page
at that time. *Id.* ¶ 9.

Patent Owner argues that Petitioner has not shown that Sociable Web
is prior art. Specifically, Patent Owner argues that Sociable Web "is a web
resource which, on its face, lists a date from the Web Archive in 1998—well
after the priority date of the '657 Patent." PO Resp. 8. Patent Owner further
argues that Dr. Donath does not have copies or backups of Sociable Web
bearing a date prior to 1998. *Id.* According to Patent Owner, Dr. Donath
testified in deposition that there was a time when the images on her web
page were not working. *Id.* (citing Ex. 2009, 14:22–15:2). Patent Owner

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[7] Petitioner cites to Exhibit 1015, which is not in the record. This appears to
be a typographical error, and we assume that Petitioner intended to cite to
Exhibit 1021, which is the document to which Petitioner refers.

also asserts that Dr. Donath was paid by Microsoft and, accordingly, we should give little to no weight to her testimony. *Id.* at 9 (citing Ex. 2009, 10:19–21, 11:3–8).

According to the Federal Circuit, "[b]ecause there are many ways in which a reference may be disseminated to the interested public, 'public accessibility' has been called the touchstone in determining whether a reference constitutes a 'printed publication'" under Section 102. *Kyocera Wireless Corp. v. Int'l Trade Comm'n*, 545 F.3d 1340, 1350 (Fed. Cir. 2008) (quoting *In re Hall*, 781 F.2d 897, 898–99 (Fed. Cir. 1986)). A reference is publicly accessible "upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it." *SRI Int'l*, *Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1194 (Fed. Cir. 2008). We assess public accessibility on a case-by-case basis. *See Kyocera*, 545 F.3d at 1350.

In instances of references cataloged in libraries, for example, "competent evidence of the general library practice may be relied upon to establish an approximate time when a thesis became accessible." *In re Hall*, 781 F.2d at 899. On the other hand, "a printed publication need not be easily searchable after publication if it was sufficiently disseminated at the time of its publication." *Suffolk Techs., LLC v. AOL Inc.*, 752 F.3d 1358, 1365 (Fed. Cir. 2014). In *Suffolk*, the Federal Circuit concluded that a posting to an internet newsgroup was sufficiently disseminated to those of ordinary skill in the art to be considered publicly accessible, after noting that the posting "elicited at least six responses over the week following its publication" and that "[m]any more people may have viewed the post

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without posting anything themselves." *Id.* The Court further noted: "the record indicates that those of ordinary skill in the art actually were using [the] newsgroups." *Id.* at 1364. In another example, the Federal Circuit found that a paper presented orally at a technical conference and handed out afterward upon request was publicly accessible where "between 50 and 500 persons interested and of ordinary skill in the subject matter were actually told of the existence of the paper and informed of its contents by the oral presentation, and the document itself was actually disseminated without restriction to at least six persons." *Mass. Inst. of Tech. v. AB Fortia*, 774 F.2d. 1104, 1108–09 (Fed. Cir. 1985) ("*MIT*"); *cf. In re Klopfenstein*, 380 F.3d 1345, 1347 (Fed. Cir. 2004) (a printed slide presentation displayed continuously for two and a half days at a meeting of a technical association and displayed for less than a day at a university held to be publicly accessible). Discussing the *MIT* case, the *Klopfenstein* court noted that "[t]he key to the court's finding [in *MIT*] was that actual copies of the presentation were distributed. The court did not consider the issue of indexing." 380 F.3d at 1349 (citing *MIT*, 774 F.2d at 1108–10).

As stated above, according to Dr. Donath, Sociable Web was presented at the 1994 conference, a premiere conference well-known to those of skill in the art, and was made available to attendees prior to the conference on the conference's website. Ex. 1031 ¶¶ 7–8. This is similar to the *MIT* and *Klopfenstein* cases, discussed above, in which papers presented at industry and academic conferences were found to be publicly accessible. Dr. Donath also testifies that she posted Sociable Web on her MIT Media Lab webpage prior to the conference and that her webpage was a popular Internet resource. *Id.* ¶ 9. Petitioner introduces uncontested evidence that a

paper by the same name, with the same authorship, was presented at this conference. Ex. 1021, ix. If the version of Sociable Web presented in this proceeding (Ex. 1019) is the same as the document presented at the conference and posted on her website in 1994, that document would have been publicly accessible as of the date of the conference.

Patent Owner is correct that Sociable Web does not bear a date early enough to establish it as prior art and that Dr. Donath has not introduced copies bearing such a date. PO Resp. 8. Nevertheless, Dr. Donath testifies that she reviewed the archived version of Sociable Web on her webpage and concluded that it is identical to the webpage that she posted in 1994. Ex. 1031 ¶ 10. She further testifies that she did not recall making any changes to the webpage between 1994 and the end of 1998. *Id.* We have examined the deposition testimony cited by Patent Owner (PO Resp. 8–9, citing Ex. 2009, 10:19–21, 11:3–8, 14:2–11, 14:22–15:2), including Dr. Donath's testimony that she was paid by Microsoft, but find nothing to suggest that Dr. Donath's direct testimony is dishonest or misleading. Rather, her testimony is consistent and credible. As to Patent Owner's argument that images on Dr. Donath's webpage were, at some point, not working, Dr. Donath further testified that the text of Sociable Web remained the same and that the substance of the images did not change. Ex. 2009, 14:22–15:25. After considering the evidence of record on this issue, we find that Petitioner establishes, by a preponderance of the evidence, that the copy of Sociable Web asserted in this proceeding (Ex. 1019) is identical to that posted on Dr. Donath's webpage in 1994 and presented at The Second International WWW Conference '94 in Chicago in late October 1994.
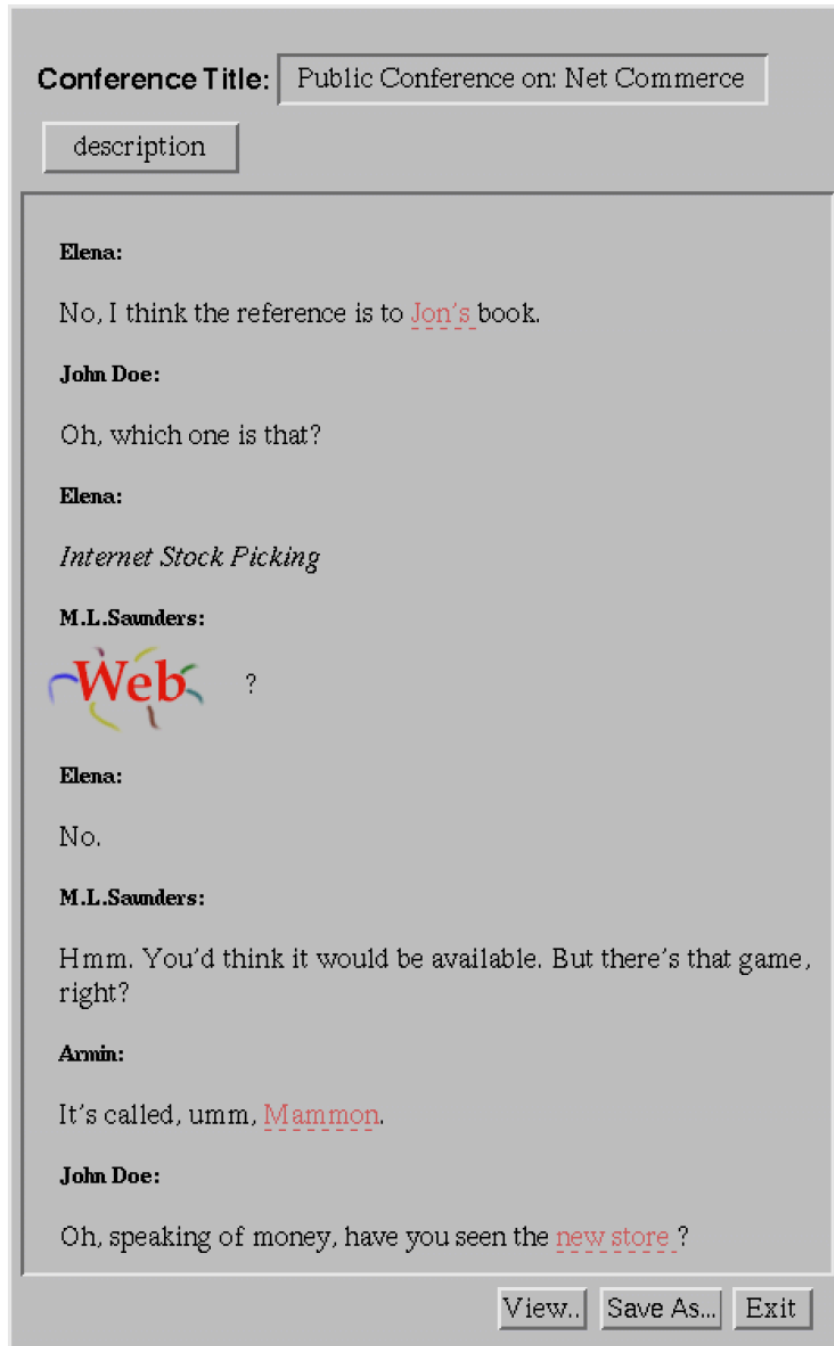
Accordingly, we find that Sociable Web was publicly accessible as of October 1994 and, thus, is prior art to the '657 patent.

(2) *Overview of Sociable Web*

Sociable Web describes a modified Web browser and server. Ex. 1019, 2. When the browser visits a Web page not served by a Sociable Web server, the browser behaves as a conventional browser. *Id.* On Web pages served by a Sociable Web server, however, the browser provides social and collaborative features, such as the ability to see who else is visiting the page and to have discussions with them. *Id.* at 2–3.

Using a WebTalk feature, users can have discussions that are live in that, when a user types a message, it appears instantly on the screens of the intended recipients. *Id.* at 3. The figure on page 4, reproduced below, illustrates such a discussion:

Conference Title: | Public Conference on: Net Commerce

description

Elena:

No, I think the reference is to Jon's book.

John Doe:

Oh, which one is that?

Elena:

Internet Stock Picking

M.L.Saunders:

Web ?

Elena:

No.

M.L.Saunders:

Hmm. You'd think it would be available. But there's that game, right?

Armin:

It's called, umm, Mammon.

John Doe:

Oh, speaking of money, have you seen the new store ?

View.. | Save As... | Exit

Discussion window (try the buttons and links).

The figure reproduced above is a picture of a discussion window. According to Sociable Web,

> [i]mages, sounds, and links to other pages can all be integrated with the flow of words. The WebTalk client includes several

> tools for fluency in hypertext conversation. For instance, the user can highlight a phrase and then, simply by clicking on a picture (or link) on any Web page, attach the chosen object to the phrase. When the phrase is sent, the recipient sees it as highlighted text; if the recipient clicks on it, he or she will receive the picture (or follow the link).

Id. at 4.

3. *Claim 189, Differences Between the Claimed Subject Matter and the Prior Art, and Reasons to Modify or Combine*

Microsoft's Petition presented the majority of its arguments for claim 1 (no longer challenged) and referenced those arguments for the remaining claims, including claim 189. Pet. 18–37. As explained in the Joinder Decision, at 9–10, claim 189 differs from claim 1 in that, where claim 1 recites "determining whether the first user identity is individually censored from receiving data" and "if the first user identity is censored from the receiving of the data," claim 189 recites "determining whether the first user identity is individually censored from sending data" and "if the first user identity is censored from the sending of the data." The Joinder Petition essentially copies the arguments from Microsoft's Petition but maps those arguments to claim 189 specifically. Joinder Pet. 18–35; Joinder Dec. 9. We refer to both petitions below.

a. *"A method of communicating via an Internet network"*

Petitioner contends that the network described in Brown is a WAN that complies with Internet Protocol ("IP"), which is used in Internet networks. Pet. 19; Joinder Petition 19. According to Brown, WAN lines

108 are "provided by one or more telecommunications providers, and which allow end users (i.e., users of the microcomputers 102) over a wide geographic area to access the host data center 104." Ex. 1012, 6:67–7:4. Brown continues, "[t]he WAN lines 108 may include, for example, X.25 lines, TCP/IP lines, and ISDN (Integrated Service Digital Network) lines. The host data center 104 provides a variety of information-related and communications-related on-line services to end users." *Id.* at 7:4–8. Mr. Schmandt testifies that "Brown's disclosure of TCP/IP lines refers to networks implementing the Transmission Control Protocol/Internet Protocol, which [w]as used in Internet networks." Ex. 1003 ¶ 162. Petitioner, citing Mr. Schmandt's testimony, argues that Brown's telecommunications providers would have been connected to, and would have been part of, the Internet. Pet. 19 (citing Ex. 1003 ¶ 163); Joinder Petition 19. Mr. Schmandt gives the example of Sprint providing Internet access via Sprint Link. Ex. 1003 ¶ 163 (citing Ex. 1018, 9).

Patent Owner does not respond meaningfully to this contention. Rather, Patent Owner argues that "Brown does not expressly disclose the Internet for communication as between users and the servers. Instead, the Board instituted based on the teaching in Brown of a 'WAN' and IP communications." PO Resp. 22–23. This argument implies that we did not institute on the basis that Brown alone teaches communication via an Internet network. Nevertheless, we did institute on that basis. Specifically, we explained that, "[a]lthough not expressly stated, Brown's description of communicating over a WAN, along with disclosure that Internet Protocol is the preferred protocol for such communications, is sufficient evidence at this stage that Brown's system communicates via an Internet network." Dec. 25.

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In addressing an "overall motivation to combine," Patent Owner argues that Brown expresses "skepticism" of communication via an Internet network that "can be seen by the fact that Brown explicitly lists the Internet as feeding into its BBS system but does not refer to the Internet for connections to its users." PO Resp. 23. Patent Owner cites to the testimony of Dr. Carbonell, who repeats this argument without adding to it meaningfully. *Id.* (citing Ex. 2006 ¶ 37).[8] As we explained in the Institution Decision, we do not draw from Brown's explicit reference to the Internet in connection with a BBS feature, an implication that Brown's WAN is not an Internet network. Dec. 25–26.

On the complete record, we find that Brown's description of communicating via a WAN using TCP/IP teaches "communicating via an Internet network," as recited in claim 189.

Petitioner further argues that, to the extent that we disagree that Brown teaches communicating via an Internet network, Sociable Web describes a chat system that communicates via the Internet. Pet. 19; Joinder Pet. 19. As Petitioner observes (Pet. 19; Joinder Pet. 19), Sociable Web is directed to adding communicating abilities, including its "WebTalk" chat functionality, to web browsers for communication via the World Wide Web. Ex. 1019, 1–3. According to Sociable Web:

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[8] Patent Owner also cites to paragraphs 35 and 36 of the Carbonell Declaration. These paragraphs do not address any alleged skepticism in Brown and, instead, present additional argument not discussed in the PO Response. Accordingly, we do not consider this additional testimony. *See* 37 C.F.R. § 42.6(a)(3) ("Arguments must not be incorporated by reference from one document into another document.").

> The main feature of the Sociable Web is WebTalk: the discussions that occur in the context of the Web and that use its rich hypermedia capabilities. WebTalk discussions are live: one types a message and it appears instantly (or at least reasonably fast) on the screens of the intended recipients. The discussions can be public conferences, open to all, or they can be private conversations between two people.

Id. at 3. Patent Owner does not dispute that communications over the World Wide Web would have occurred via the Internet.

Petitioner contends that it would have been obvious to combine Sociable Web's teaching of communication via the Internet with Brown "to expand and efficientize online communications." Pet. 19–20; Joinder Pet. 19–20. We find that Petitioner's reason to combine has rational underpinnings.

Patent Owner argues that a lack of motivation to combine Brown with Sociable Web is evidenced by 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. 23–24 (quoting Ex. 2011). Patent Owner offers no persuasive evidence, however, that Dr. Metcalfe's views were shared widely, or at all, by skilled artisans in 1995. Indeed, the article itself suggests the contrary. Ex. 2011 ("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. 2006 ¶ 40. 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. 2011. Thus, we are not persuaded that the Internet would have been an
inferior technology for videoconferencing in 1995. Moreover, claim 189 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."
In re Mouttet, 686 F.3d 1322, 1334 (Fed. Cir. 2012).[9]

On the complete record, we find that a skilled artisan would have had
reason to modify Brown's system to communicate via an Internet network in
light of Sociable Web's description of conducting similar communications
over the Internet.

> b. *"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, the method including:"*

Petitioner points to Brown's application servers 120 and client
microcomputers 102 as a controller computer and participator computers,
respectively. Pet. 20, 22; Joinder Pet. 20, 22. Petitioner argues that Brown's

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[9] Patent Owner also argues that "engineering issues highlighted in Vetter"
further weigh against a motivation to combine. Vetter is asserted as a prior
art reference in related proceedings, but is not part of the record of this
proceeding. Accordingly, Patent Owner's argument is not persuasive.

distribution of chat messages to participants teaches "affording information" to the participator computers. *Id.* at 22–23; Joinder Pet. 22–23. As explained in Brown:

> During a typical logon session, a client microcomputer 102 will maintain a communications link with a single Gateway 140, but may access multiple on-line services (and thus communicate with multiple application servers 120). . . .

> Throughout the service session, the Gateway 140 routes messages between the client microcomputer 102 and the application server 120 as the client and server portions of the service application communicate.

Ex. 1012, 9:12–15, 9:23–26. We find that this teaches "a controller computer . . . affording information to each of a plurality of participator computers which are otherwise independent of each other," as recited in claim 189.

As to "a database which serves as a repository of tokens for other programs to access," Petitioner cites Brown's access rights database, or relational database 152, which Brown describes as storing "multiple content category identifiers, or 'tokens,' which identify categories or groupings of content objects." Pet. 20–21; Joinder Pet. 20–21; Ex. 1012, 2:66–3:2. Petitioner contends that Brown's "tokens" correspond to the "tokens" recited in claim 189. Pet. 21; Joinder Pet. 21. Patent Owner does not dispute that Brown's access rights database is a "database which serves as a repository of tokens," as recited in claim 189. On this evidence, we find that it is.

Petitioner argues that Brown's database holds tokens for later use by services and programs within the network. Pet. 21; Joinder Pet. 21. According to Petitioner, "various application servers and gateways generate user-specific access rights queries in response to user requests." Pet. 21

(citing Ex.1012, 3:27–30, 3:48–62, 20:8–27, 24:1–11, 25:23–27, 25:64–
26:2); Joinder Pet. 21. For example, Brown describes multiple servers and
gateways accessing the database:

> In the preferred embodiment, each security server 150 is
> programmed to receive account-specific access rights queries
> from the application servers 120 and Gateways 140 within the
> network, and to respond to each such query by returning all of
> the access rights data of the user specified in the query.

Ex. 1012, 24:2–7. We find that Brown teaches a database that serves as a
repository of tokens "for other programs to access," as recited in claim 189.

Patent Owner argues that "Petitioner loses sight of the requirement
that the **database** allows other programs to access the tokens." PO Resp. 20.
Patent Owner contends that Mr. Schmandt testifies that Brown's database
contains a UserID and a password and that Mr. Schmandt, in deposition,
testified that Brown's participant computers use telnet as their client
software. PO Resp. 20–21.[10] Patent Owner argues that "Telnet is not an
'other program' within the context of the claims" and that Mr. Schmandt
does not explain how Telnet could access tokens in Brown's database. *Id.* at
22. Brown, however, does not refer to Telnet. As Petitioner points out
(Reply 9), Mr. Schmandt's deposition testimony was directed to different
prior art asserted in related proceedings. Patent Owner may have
inadvertently copied argument from briefing in a related proceeding into its
response in this proceeding. In any case, Patent Owner's arguments are not

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[10] Patent Owner cites to Exhibit 1023 ¶ 128 for Mr. Schmandt's direct
testimony. Exhibit 1023, however, does not include Mr. Schmandt's
testimony. Moreover, paragraph 128 of Exhibit 1003, the Schmandt
Declaration, does not include testimony relevant to this issue.

relevant to any issue in this proceeding. Patent Owner does not raise additional arguments as to these claim limitations.

On the complete record, we find that Brown teaches "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 189.

> c. *"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, we find that Brown teaches affording information to several client microcomputers, which correspond to participator computers. We also find that Brown teaches affording information via the Internet network.

Petitioner contends that Brown teaches affording information "responsive to an authenticated [first/second] user identity" through its description of authenticating the users' identities and requiring the users to have sufficient access rights before providing requested services. Pet. 23–24 (citing Ex. 1012, 14:18–25, 24:2–11); Joinder Pet. 23–24. On the complete record, we find that Brown teaches "affording some of the information to a [first/second] of the participator computers via the Internet network, responsive to an authenticated [first/second] user identity."

> d. *"determining whether the first user identity and the second user identity are able to form a group to send and to receive real-time communications"*

Petitioner contends that Brown discloses a system operator defining and assigning tokens for a chat room and the use of such tokens to define "user groups," or groups of users who will be given access to the chat room. Pet. 25–26 (citing, *inter alia*, Ex. 1012, 15:27–37, 31:5–21); Joinder Pet. 25–26. For example, Brown describes that a system administrator creates a chat room node for an organization specifying a unique security token for the chat room, updates a group-member table to create a new group consisting of accounts of the members of the organization, and adds a row to a group-token table specifying a group ID, the security token of the chat room, and an access rights value. Ex. 1012, 31:5–21. The particular group could be for private communications among family members. *Id.* at 15:27–37, 31:1–5. Petitioner contends that Brown discloses users forming groups when joining a particular chat room. Pet. 26 (citing Ex. 1012, 9:45–52); Joinder Pet. 26. Here, Brown explains that "Chat conversations or 'conferences' are organized as 'Chat rooms' which may be entered or exited by end users to join or leave the corresponding conferences. For example, an end user may enter a 'sports' Chat room to join an interactive conversation on sports-related topics." Ex. 1012, 9:47–52.

Petitioner argues that chat messages are sent and received in real time. Pet. 27 (citing Ex. 1012, 9:46–47); Joinder Pet. 27. Brown discloses that its "Chat service is an interactive communications service which allows users to have real time conversations with other users on specific topics." Ex. 1012, 9:45–47. Patent Owner appears to concede that Brown's chat communications are sent and received in real time. PO Resp. 27 ("At best,

joining a chat room may satisfy the determination as to whether two users can 'receive real-time communications,' . . . .").

Patent Owner argues that "[t]he users referred to in the limitation are the same users who were previously authenticated in the earlier claim limitations." PO Resp. 26. According to Patent Owner:

> a single user by himself cannot determine whether another user can form a group with him. While the creation of a chat room with permissions may be the prerequisite to forming a group, the step of creating a chat room does not involve any determination as to whether a group should be formed based on the claimed first and second user and thus cannot meet this limitation.

Id. We disagree with Patent Owner. In Petitioner's example, when a system administrator updates a group-member table to specify at least two user accounts that are permitted to participate in an organization's chat, the administrator determines whether those two user identities are able to form a group. Thus, contrary to Patent Owner's argument, the step of creating a chat room with permissions does involve the determination of whether a group that includes the two users can be formed.

Patent Owner also argues that in Brown, the act of joining a chat room and, thus, a determination of rights in the chat room, "is done on an individual user basis and the claims require determining whether **two users** are able to form a group[,] *i.e.* the claims require a determination where information about both users is considered in the determination step." PO Resp. 27. According to Patent Owner, "[a]ssessing chat-room permissions when joining a chat room does not meet this limitation." *Id.* Patent Owner also appears to contend that this claim limitation requires a two-step process in which the system determines whether two users can form a group and then determines that the users may receive real-time communications.

Id. ("At best, joining a chat room may satisfy the determination as to whether two users can 'receive real-time communications,' but joining the chat room could not satisfy both of these limitations.").

Patent Owner's arguments are not commensurate with the scope of the claim language. Claim 189 does not recite a simultaneous determination, at the time two users are authenticated, that those two users have permission to communicate with each other. Nor does claim 189 recite determining that the users have permission to send real-time communications. Rather, claim 189 recites determining whether a first user identity and a second user identity are able to form a group to send and to receive real-time communications. Real-time communications are a characteristic of the group. Indeed, the '657 patent describes a system similar to Brown's in which tokens are assessed to determine whether users have permission to join a group (also called a channel) in which real-time communications are exchanged: "Accordingly, tokens are used by the controller computer 5 to control a user's group priority and moderation privileges, as well as controlling who joins the group, who leaves the group, and the visibility of members in the group." Ex. 1001, 8:1–4. As Petitioner points out (Reply 13), Dr. Carbonell conceded in deposition that this limitation is satisfied by a disclosure that two users have the appropriate rights to join the same chat room:

> Q. . . . So if both users have the appropriate rights to join the same chat room, in your view the step of determining whether the first user identity and the second user identity are able to form a group is disclosed?

> A. That seems to me what the claim requires, what the claim element requires.

Ex. 1101, 127:5–13. Petitioner's evidence shows this to be the case in Brown.

In sum, we find that Brown's disclosure of a system administrator determining who can join a particular Chat room, along with disclosures that multiple users join such a Chat room and that the communications in the Chat room are in real time, teaches "determining whether the first user identity and the second user identity are able to form a group to send and to receive real-time communications," as recited in claim 189.

> e. "determining whether the first user identity is individually censored from sending data in the communications, the data presenting at least one of a pointer, video, audio, a graphic, and multimedia by determining whether a respective at least one parameter corresponding to the first user identity has been determined by an other of the user identities"
>
> "if the first user identity is censored from the sending of the data, not allowing sending the data that is censored from the first participator computer to the second participator computer"

Regarding "determining whether the first user identity is individually censored from sending data in the communications . . . by determining whether a respective at least one parameter corresponding to the first user identity has been determined by an other of the user identities," as recited in claim 189, Petitioner argues that Brown discloses that a user can be given a set of permissions, such as "observer," that does not include the right to send data. Pet. 34 (citing Ex. 1012, 17:35–18:5); Joinder Pet. 28–29. For example, according to Brown, a user with "observer" privileges "can see the existences of the node and can open the service, but cannot actively

participate in the service"; a user with "user" privileges "can do whatever is 'normal' for the particular service" such as "the ability to actively participate in public Chat conferences"; a user with "sysop" privileges "is given the access rights consistent with normal (entry-level) sysop-type activities for the service, such as the ability to delete BBS messages, or the ability to edit a certain subset of the properties of a node"; a user with "Sysop Manager" privileges "is given various ownership-type privileges with respect to the node" such as "the ability to change any of the properties (e.g., name, icon ID, etc.) for that node"; and a user with "SyperSysop" privileges "has the highest level of access authority provided by the service." Ex. 1012, 17:35–18:5. Petitioner argues that this teaches that a user, such as one with "observer" privileges, is individually censored from sending data because the user is prevented, based on privilege levels, from taking actions such as sending or posting messages. Pet. 34; Joinder Pet. 28–29.

Petitioner argues that, because one of the respective users in the group can have "SuperSysop" privileges and may modify the access rights of a lower-rank user in the group, the system determines whether a parameter corresponding to a first user identity (the lower-rank user) has been determined by another of the user identities (the SuperSysop user). Pet. 29; Joinder Pet. 31. According to Petitioner, this teaches censoring "by determining whether a respective at least one parameter corresponding to the first user identity has been determined by an other of the user identities." Pet. 29; Joinder Pet. 31.

We agree with Petitioner and find that Brown teaches determining whether a first user identity, e.g., one with "observer" privileges only, is individually censored from sending data in the communications (because the

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observer privileges do not allow sending data), by determining whether a respective at least one parameter corresponding to the first user identity has been determined by another of the user identities (e.g., one with "SuperSysop" privileges assigning the first user identity the "observer" privileges). This is consistent with our construction of "censor," detailed in Section II.A.2 above.

Petitioner marshals essentially the same evidence to show that Brown teaches "if the first user identity is censored from the sending of the data, not allowing the data that is censored to be presented from the second participator computer to the output device," as recited in claim 189. Pet. 36–37; Joinder Pet. 34–35. We agree, and find that, because a user with observer privileges does not have permission to send data, those data will not be presented to an output device.

As to "the data presenting at least one of a pointer, video, audio, a graphic, and multimedia," as recited in claim 189, Petitioner points to examples in which chat conferences involve text, voice, and/or video capabilities. Pet. 28 (citing Ex. 1012, 9:52–55); Joinder Pet. 30. We agree that these are examples of data presenting video, audio, a graphic, and multimedia (the "and/or" suggesting that multiple forms of media can be presented together). Because claim 189 recites the data presenting "at least one of" a pointer, video, audio, a graphic, and multimedia, showing any one of these is sufficient. Thus, we find that Brown teaches "the data presenting at least one of a pointer, video, audio, a graphic, and multimedia." We need not reach Petitioner's additional arguments (Pet. 28–29; Joinder Pet. 30–31) that Sociable Web teaches "a pointer."

We note that Patent Owner does not dispute that Brown teaches these limitations.

> f. *"if the user identities are able to form the group, forming the group and facilitating sending the communications that are not censored from the first participator computer to the second participator computer, wherein the sending is in real time and via the Internet network"*

As explained above, we find that Brown teaches user identities forming a group and communicating with each other in real time using a Chat service (provided they have permissions of "user" or above and, thus, are not censored from sending data), and that the communications can be via an Internet network. Thus, we find that Brown teaches this limitation.

> g. *"wherein, for the communications which are received and which present an Internet URL, facilitating handling the Internet URL via the computer system so as to find content specified by the Internet URL and presenting the content at an output device of the second participator computer"*

As explained above, we find that Brown teaches user identities forming a group and communicating with each other in real time using a Chat service, and that the communications can be via an Internet network.

Regarding communications "which present an Internet URL," Petitioner contends that Sociable Web teaches a chat functionality, WebTalk, that "allows users to 'insert hypertext links, sounds and images amidst their normal conversational text' in a chat window, as well as 'link[s] to other pages.'" Pet. 31 (quoting Ex. 1019, 1, 4); Joinder Pet. 33.

Petitioner argues that a skilled artisan would have combined the teachings of Brown and Sociable Web to "maximize two important offerings available in the network" and to use Brown's improved access rights mechanism to enhance the security of Sociable Web's chat system. Pet. 31; Joinder Pet. 33–34.

Patent Owner argues that chats in Sociable Web "would have been hypertext, the actual images, graphics, sounds, or other media would not have been transferred between users" and that Sociable Web's teaching "directly contradicts Brown, which accomplishes all of its communications using servers as a conduit." PO Resp. 28. According to Patent Owner "one of ordinary skill in the art would not have wanted to break the server-based paradigm of Brown, which would have been a necessity according to the Sociable Web." *Id.* Petitioner takes issue with Patent Owner's characterization of Sociable Web, arguing that "Sociable Web contains extensive disclosures of server-based systems for multimedia communication over the Internet, and discusses non-server-based approaches only for the specific category of private messages." Reply 23–24 (citing Schmandt Reply Decl. (Ex. 1100) ¶¶ 48–49). According to Sociable Web,

> The WebTalk port is a tcp socket that is kept open for data transfer: it is through this socket that the Web Talk discussions take place. Private conversations and public conferences are handled differently, to minimize the load on the server. For private conversations, the server simply provides the two parties with each other's address; the connection is made directly between the two.

Ex. 1019, 5.

Patent Owner acknowledges this distinction between private conversations and public conferences. PO Resp. 27. Nevertheless, Dr. Carbonell argues (without citation), that "[t]he only communication of data such as images, graphics, or sound, would have been in the context of private messages, which bypass the server." Ex. 2006 ¶ 44. Sociable Web expressly states, however, that WebTalk can include both private conversations and public conferences, implying that communication of images, graphics, and sound would have been in the context of public conferences as well. Ex. 1019, 5. Thus, Dr. Carbonell's testimony is not credible on this point.

Moreover, Patent Owner's arguments amount to an argument that a skilled artisan would not have bodily incorporated Sociable Web into Brown. "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." *Mouttet*, 686 F.3d at 1332–33. Assuming that Sociable Web teaches communicating images, graphics, sounds, and video between users without such data passing through the same central server as its text-based communications, applying Sociable Web's teachings would not "contradict" or "break" Brown's teachings. Rather, Sociable Web's teachings would have added desirable functionality to Brown's system with Brown's existing functionality continuing to operate as described. Thus, a skilled artisan would have had reason to combine these teachings of Sociable Web with Brown.

Patent Owner further contends that a skilled artisan would have understood that "concerns such as bandwidth and server load were real world problems experienced on the Internet," and that, accordingly, "one of ordinary skill in the art would not have necessary looked to add the Internet web-server of the Sociable Web due to its limitations." PO Resp. 28. Dr. Carbonell repeats Patent Owner's arguments, nearly verbatim, in his testimony. Ex. 2006 ¶ 44. We reject those arguments for the reasons given in Section II.B.3.a above.

In sum, we find that Brown and Sociable Web teach "for the communications which are received and which present an Internet URL, facilitating handling the Internet URL via the computer system so as to find content specified by the Internet URL and presenting the content at an output device of the second participator computer," as recited in claim 189.

4. Claim 465

Petitioner contends that claim 465 "requires a system including in all material respects the elements and configured to perform the steps recited in claim 189, and is unpatentable for the same reasons." Pet. 38; Joinder Pet. 35. We have compared claim 465 to claim 189 and agree that these claims are materially indistinct, other than that claim 465 is a system claim and claim 189 is a method claim. We find that Brown and Sociable Web teach each limitation of claim 465 for the same reasons as given for claim 189, discussed above. We note that Patent Owner does not present separate arguments for claim 465.

5. *Conclusion of Obviousness*

As explained above, Brown and Sociable Web teach each limitation of claims 189 and 465. Petitioner has introduced persuasive evidence that a skilled artisan would have had reasons to combine the teachings of Brown and Sociable Web. 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 189 and 465 would have been obvious over Brown and Sociable Web.

III. PATENT OWNER'S MOTION TO EXCLUDE

Patent Owner filed a paper styled "Motion to Exclude Evidence," seeking to exclude certain portions of the Schmandt Reply Declaration that it argues exceeds the proper scope of a reply. Paper 51, 1. Specifically, Patent Owner seeks to exclude portions of paragraphs 21–23, 26–30, 42, and 45–51 of the Schmandt Reply Declaration. *Id.* at 1–7.

Petitioner opposes this motion on the ground that it is not directed to the admissibility of evidence and, therefore, is procedurally improper. Paper 55, 1–2. 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 57, 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, 1–3. 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. We do not rely on paragraphs 21–23, 26–30, and 42 of the Schmandt Reply Declaration. The testimony of paragraphs 45–51 properly responds to the arguments raised in the PO Response and, accordingly, does not exceed the scope of evidence appropriate for a reply.

IV.   CONCLUSION

Petitioner has proved by a preponderance of the evidence that claims 189 and 465 are unpatentable.

V. ORDER

For the reasons given, it is

ORDERED, based on a preponderance of the evidence, that claims 189 and 465 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.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

_____

FACEBOOK, INC.,
Petitioner,

v.

WINDY CITY INNOVATIONS, LLC,
Patent Owner.

_____

Case IPR2016-01155[1]
Patent 8,694,657 B1

_____

Before KARL D. EASTHOM, DAVID C. McKONE, and J. JOHN LEE,
Administrative Patent Judges.

McKONE, *Administrative Patent Judge*.

DECISION
Request for Rehearing
37 C.F.R. § 42.71

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[1] IPR2017-00622 has been joined with this proceeding.

INTRODUCTION

On June 3, 2016, Microsoft Corporation ("Microsoft") filed a petition
(Paper 1) in the present case seeking *inter partes* review of approximately
150 claims of U.S. Patent No. 8,694,657 B1 (Ex. 1001, "the '657 patent").
An *inter partes* review was instituted on each of the challenged claims on
December 8, 2016. Paper 8.

One month later, on January 7, 2017, Facebook, Inc. ("Facebook")
filed a petition in IPR2017-00622 ("622 IPR") seeking *inter partes* review of
claims 189 and 465 of the '657 patent. 622 IPR, Paper 2. Along with that
petition, Facebook filed a motion requesting joinder with the present
proceeding. 622 IPR, Paper 3. On February 6, 2017, Windy City filed an
Opposition to the Motion for Joinder. 622 IPR, Paper 7. Petitioner filed a
Reply to that Opposition on March 3, 2017. 622 IPR, Paper 8.
Subsequently, on April 17, 2017, Windy City filed a Preliminary Response
in the 622 IPR. 622 IPR, Paper 9.

While Facebook's petition and joinder motion were pending,
Microsoft and Patent Owner Windy City Innovations, LLC ("Windy City")
reached a settlement agreement and filed a Joint Motion to Terminate the
present proceeding on April 24, 2017. Paper 29. The Joint Motion did not
mention Facebook's joinder motion or the 622 IPR.

In a May 10, 2017, decision, we granted the Joint Motion to
Terminate in the present proceeding, but only with respect to Microsoft.
Paper 31 ("1st Term. Dec."). Noting Facebook's pending joinder motion,
we did not decide at that time whether to grant the motion with respect to the
entire proceeding, indicating we would do so after deciding whether
Facebook would be joined as a party to this proceeding. *Id.* at 2–3.

On June 1, 2017, we granted Facebook's joinder motion. Paper 32 ("Joinder Inst. Dec."). We noted that Facebook challenged claims 189 and 465 of the '657 patent on the same asserted grounds of unpatentability, based on the same arguments and evidence, as in Microsoft's petition with respect to those claims in the present proceeding. *Id.* at 3, 5–6. Further, we clarified that, after joinder, Facebook is "the petitioner" in this proceeding for purposes of 35 U.S.C. § 318(a), which in relevant part requires the Board to "issue a final written decision with respect to the patentability of any patent claim challenged by *the petitioner*" (emphasis added). *Id.* at 16. Thus, we made clear that all claims formerly challenged by Microsoft prior to its termination, but which were not challenged by Facebook, were no longer part of this proceeding. *Id.*

After joining Facebook as a party to the present proceeding, we issued a second decision on June 7, 2017, to address the remaining issues regarding the Joint Motion to Terminate. Paper 33 ("2nd Term. Dec."). In that decision, we denied the Joint Motion to Terminate with respect to Windy City because Facebook remained as an active petitioner. *Id.* at 2–3. On June 14, 2017, Windy City filed a Request for Rehearing. Paper 39 ("Req. Reh'g").

DISCUSSION

A party requesting rehearing bears the burden of showing the decision should be modified. *See* 37 C.F.R. § 42.71(d). The party must identify all matters it contends were misapprehended or overlooked by the Board. *See id*. Windy City requests rehearing of two decisions, each of which it contends was an abuse of discretion. First, Windy City contends that our

decision to terminate as to Microsoft, but not as to the entire proceeding, exceeded our statutory authority. Req. Reh'g 7–10. Second, Windy City contends we exceeded our statutory authority by joining Facebook to this proceeding despite that Facebook challenges only a portion of the claims originally challenged by Microsoft. *Id.* at 10–13. As explained below, neither contention is supported by the relevant authorities, and the Request for Rehearing is *denied*.

A.   *Termination as to Microsoft But Not as to Entire Proceeding*

As an initial matter, our decision to terminate as to Microsoft but not as to the entire proceeding was entered on May 10, 2017. *See* 1st Term. Dec. Windy City's Request for Rehearing was not filed until June 14, 2017. *See* Req. Reh'g. Thus, with respect to this termination decision, Windy City's Request was not timely filed. *See* 37 C.F.R. § 42.71(d)(1). For that reason alone, the Request for Rehearing should be denied as to this issue.

Moreover, even had the Request been timely filed, Windy City's arguments fail to establish that our decision was improper. It argues that our decision exceeded our statutory authority under 35 U.S.C. § 317(a). Req. Reh'g 7–10. Section 317(a) states the following:

> An inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed. . . . If no petitioner remains in the inter partes review, the Office may terminate the review or proceed to a final written decision under section 318(a).

Pursuant to the statute, we "terminated [the *inter partes* review] with respect to any petitioner upon the joint request of the petitioner and the patent

owner" by granting the Joint Motion to Terminate as to Microsoft. *See*

35 U.S.C. § 317(a); 1st Term. Dec. 2. Windy City does not contest that

aspect of our decision. Rather, it argues our decision failed to follow the

portion of § 317(a) that states, "[i]f no petitioner remains in the inter partes

review, the Office may terminate the review or proceed to a final written

decision." Req. Reh'g 8–10.

According to Windy City, once Microsoft was terminated, the Board

was obligated to either terminate the entire review or proceed to a final

written decision. *Id*. Indisputably, we did not terminate the entire review.

Thus, Windy City contends that the only other permissible option was to

proceed to a final written decision. *Id*. Windy City asserts that our decision

to hold in abeyance our ruling as to whether the entire proceeding should be

terminated (until after deciding Facebook's joinder motion) constituted a

"suspension of the [*inter partes*] review," which exceeded our authority

under § 317(a) because the Board was obligated instead to "proceed to a

final written decision." *Id*.

Windy City misconstrues the statute and our decision. First, the

statute does not mandate that the Board either terminate the entire review or

proceed to a final written decision. In contrast, as noted above, the same

statutory provision states that an *inter partes* review "shall" be terminated

with respect to a petitioner upon a joint request. Rather, it states explicitly

that the Board "may" do so. We further note that when, as here, there are

multiple cases before the Board involving the same patent, the Board is

explicitly granted discretion to "enter any appropriate order," including "the

stay, transfer, consolidation, or termination" of such cases. *See* 37 C.F.R.

§ 42.122(a); *see also* 35 U.S.C. § 315(d) (granting discretion to "determine

the manner in which the inter partes review or other proceeding or matter may proceed"). Consistent with this statutory framework, we considered Facebook's pending petition challenging the same patent and motion for joinder with this proceeding, and concluded that we would first decide Facebook's joinder motion (which was filed before the motion to terminate) before deciding whether to terminate the entire proceeding. 1st Term. Dec. 2–3; *see also* 37 C.F.R. § 42.71(a) ("The Board may take up petitions or motions for decisions in any order . . . .").

Second, Windy City is incorrect that "proceed[ing] to a final written decision" under § 317(a) precludes our decision here. Windy City appears to argue that once Microsoft was terminated, "proceed to a final written decision" meant that the Board should have proceeded *immediately* to issue a final written decision. *See* Req. Reh'g 8–10. In particular, Windy City argues that our decision incorrectly indicated the Board could "proceed with the trial" because doing so is inconsistent with "proceed[ing] to a final written decision" under § 317(a). *See id*. Section 317(a), however, does not specify when the final written decision should issue, much less require it to be issued immediately without further trial.[2] The applicable deadline for the final written decision remains one year from institution, as specified in 35 U.S.C. § 316(a)(11) and 37 C.F.R. § 42.100(c). Thus, our decision to proceed with the trial without immediately issuing a final written decision was consistent with the applicable statutory provisions and regulations.

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[2] We note that Windy City's interpretation of the statute could conflict with other statutory provisions. For example, proceeding immediately to issue a final written decision could circumvent patent owners' rights to an oral hearing under 35 U.S.C. § 316(a)(10).

Third, Windy City is mistaken that our decision "suspend[ed] indefinitely" this *inter partes* review. *See* Req. Reh'g 8; *see also id.* at 10 ("[T]he Board had no statutory authority to suspend [this proceeding] without a petitioner for three weeks . . . ."). To the contrary, our decision made clear that trial was to proceed. 1st Term. Dec. 3. Our decision did not state that the review was suspended, nor did it alter the case schedule in any way.[3] As explained above, proceeding with trial was consistent with § 317(a). It also was consistent with 37 C.F.R. § 42.74(a), contrary to Windy City's arguments. *See* Req. Reh'g 9–10. Rule 42.74(a) provides that "the Board is not a party to the settlement and may independently determine any question of jurisdiction, patentability, or Office practice." As explained in our decision (1st Term. Dec. 3), this provision indicates that the Board has the authority to proceed with the trial—i.e., "independently determine . . . patentability"—even when the petitioner has exited the case due to settlement. *See*, *e.g.*, *Blackberry Corp. v. MobileMedia Ideas LLC*, Case IPR2013-00016, slip op. at 2–3 (PTAB Dec. 11, 2013) (Paper 31) (granting termination as to all petitioners, but denying termination of the *inter partes* review and instead proceeding without a petitioner).

For the reasons explained above, our decision on May 10, 2017, to terminate as to Microsoft, but not the entire proceeding, was consistent with the applicable statutory provisions and Board rules. Thus, Windy City has not established that we misapprehended the law, or that our decision should be modified. Moreover, the Request for Rehearing with respect to this decision was not timely filed.

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[3] The only changes to the case schedule since our decision on the Joint Motion to Terminate were either jointly stipulated by the parties, including Windy City (Paper 34), or requested by Windy City (Paper 42).

B.   *Joinder of Facebook*

Windy City contends that our decision granting Facebook's joinder motion was an abuse of discretion because 35 U.S.C. § 315(c) does not "provide authority or discretion to join a party to a **portion** of an *inter partes* review." Req. Reh'g 10–11. Although it filed an Opposition to the Motion for Joinder, Windy City did not argue that joinder was improper or contrary to § 315(c) because Facebook only challenged a subset of the claims challenged by Microsoft. We could not misapprehend or overlook an argument that was never made. *See* 37 C.F.R. § 42.71(d). A request for rehearing cannot be used to advance new arguments not previously presented, and Windy City has waived this argument as a result. *See*, *e.g.*, *Sophos, Inc. v. Finjan, Inc.*, Case IPR2015-01022, slip op. at 5, 7–10 (PTAB Jan. 28, 2016) (Paper 9) (denying a request for rehearing because the arguments had not been previously made).

Even were we to consider Windy City's untimely argument, however, Windy City does not demonstrate that our decision was an abuse of discretion or inconsistent with applicable law. Section 315(c) states in relevant part, "the Director, in his or her discretion, may join as a party [to an instituted *inter partes* review] . . . any person who properly files a petition under section 311 that the Director . . . determines warrants the institution of an inter partes review." *See also* 37 C.F.R. § 42.122 (delegating the Director's authority over requests for joinder to the Board).

According to Windy City, § 315(c) does not "provide authority or discretion" to join a party that challenges fewer than all of the claims challenged by the original petitioner(s). *See* Req. Reh'g 11. Indeed, Windy City argues that joinder is only permissible in two scenarios: (1) "joining a

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party with an 'identical petition' to an instituted review in full," and (2) "allowing a party to present additional validity challenges." *Id.* at 11–12. Windy City's position, however, is not supported by the relevant authorities.

First, § 315(c) does not recite any limitations on the challenges presented by the party seeking joinder. To the contrary, § 315(c) states that "any person who properly files a petition under section 311" may be joined, requiring only that the petition "warrants the institution of an inter partes review." The statute does not address the specifics of challenged claims, asserted grounds of unpatentability, evidence relied upon, etc. Rather, such considerations are left to the Director's "discretion" (and, thus, the Board's discretion by delegation). 35 U.S.C. § 315(c) (stating "the Director, in his or her discretion, may join"); 37 C.F.R. § 42.122. Thus, far from failing to provide authority or discretion (Req. Reh'g 11), § 315(c) expressly provides for such discretion.

Second, Windy City's argument that joinder is only permissible in "two scenarios" is not supported by any cited authority. *See* Req. Reh'g 11–12. Windy City relies on the following statement in the legislative history of the Leahy-Smith America Invents Act:

> Sections 315(c) and 325(c) allow joinder of inter partes and post-grant reviews. The Office anticipates that joinder will be allowed as of right—if an inter partes review is instituted on the basis of a petition, for example, a party that files an identical petition will be joined to that proceeding, and thus allowed to file its own briefs and make its own arguments. If a party seeking joinder also presents additional challenges to validity that satisfy the threshold for instituting a proceeding, the Office will either join that party and its new arguments to the existing proceeding, or institute a second proceeding for the patent. The Director is given discretion, however, over whether to allow joinder.

157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl).[4]

Although the above statement mentions, "for example," a circumstance where "a party that files an identical petition" or "presents additional challenges to validity" (*id.*), Windy City does not identify any statement in the legislative history—or, indeed, any other authority—indicating that these examples are the *only* scenarios in which joinder is permissible. Moreover, to the extent that it provides guidance in understanding § 315(c), the above statement refutes Windy City's contention that the Board lacks discretion with regard to joinder. *Id.* ("The Director is given discretion, however, over whether to allow joinder.").

Finally, the two cases cited by Windy City also do not support its arguments. First, Windy City cites *ZTE Corporation v. Adaptix, Inc.*, Case IPR2015-01184, slip op. 4–7 (PTAB July 24, 2015) (Paper 10), noting that the panel denied joinder in that case "even when an otherwise identical petition was filed merely because the parties relied on a different expert." Req. Reh'g 12. The decision in *ZTE* did not, however, hold that the Board lacks discretion over joinder or that joinder is impermissible per se if the joinder petition is not identical. Rather, the panel in *ZTE* weighed multiple factors, including that joinder in that case would have required the patent owner to depose multiple experts and would have raised "new issues" for the patent owner to address. *ZTE*, slip op. at 4–5. In fact, the panel in *ZTE* recognized that "the decision to grant joinder is discretionary." *Id.* at 6. We note that Windy City does not identify in its Request for Rehearing any error

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[4] Windy City filed a copy of this legislative history, but it was misnumbered as Exhibit 2015. Windy City may refile it as Exhibit 2016.

in our determination that joinder with the present case would not involve any new evidence, or raise new issues or arguments. *See* Joinder Inst. Dec. 4–7.

Windy City also relies on *Dell Inc. v. Electronics and Telecommunications Research Institute*, Case IPR2015-00549, slip op. 7–8 (PTAB Mar. 26, 2015) (Paper 10) (representative). Req. Reh'g 13. The facts of *Dell*, however, are very different from those of the present case. In *Dell*, the petitioners sought joinder with an earlier-instituted *inter partes* review, IPR2014-00901, and challenged the same claims on the same grounds. *Id.* at 2–3. The panel held that the petitioners were estopped under 35 U.S.C. § 315(e)(1) from challenging all but two of the challenged claims based on a third, still-earlier *inter partes* review, IPR2013-00635, in which the Board had issued a final written decision. *Id.* at 4–6. Although the petitioners were not estopped from challenging the two remaining claims, the panel determined that joinder would "unnecessarily complicate" the earlier proceeding, which already had been subject to joinder and already had two petitioners, by adding new petitioners challenging a different set of claims than the existing petitioners (i.e., a subset), thereby imposing additional burdens on the patent owner. *Id.* at 7–8. Unlike *Dell*, the 622 IPR did not have an existing petitioner challenging a different set of claims because Microsoft had been terminated from the case, and joinder did not impose additional burdens on Windy City to respond to multiple petitioners with different challenges. Moreover, the panel in *Dell* made clear that its denial of joinder was an exercise of *discretion* based on the facts and circumstances of that case. *Id.* at 7–8. Thus, Windy City's assertions of inconsistency with *Dell* are unfounded, and *Dell* does not support its arguments on rehearing.

For the reasons set forth above, we conclude that our decision to join Facebook to the present proceeding was consistent with applicable law. Moreover, Windy City presents arguments that were not previously made, which is improper for a rehearing request.

CONCLUSION

As explained above, Windy City has not identified any matter that we misapprehended or overlooked, nor has Windy City established that our decisions were improper under governing law or an abuse of discretion. *See* 37 C.F.R. § 42.71. Therefore, Windy City has not carried its burden to show that our decisions should be modified. *Id*.

ORDER

It is

ORDERED that Windy City's Request for Rehearing is *denied*.

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UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
_____

FACEBOOK, INC.,
Petitioner,

v.

WINDY CITY INNOVATIONS LLC,
Patent Owner.
_____

Case IPR2016-01067 (Patent 8,407,356 B1)[1]
Case IPR2016-01141 (Patent 8,458,245 B1)[2]
Case IPR2016-01155 (Patent 8,694,657 B1)[3]
_____

Before KARL D. EASTHOM, DAVID C. McKONE, and J. JOHN LEE,
Administrative Patent Judges.

LEE, *Administrative Patent Judge*.

DECISION
Motion to Terminate
37 C.F.R. § 42.74

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[1] Case IPR2017-00624 has been joined with IPR2016-01067.

[2] Case IPR2017-00655 has been joined with IPR2016-01141.

[3] Case IPR2017-00622 has been joined with IPR2016-01155.

IPR2016-01067 (Patent 8,407,356 B1)
IPR2016-01141 (Patent 8,458,245 B1)
IPR2016-01155 (Patent 8,694,657 B1)

Microsoft Corporation ("Microsoft") initiated each of the above-captioned cases. *See*, *e.g.*, Paper 2 (original petition filed by Microsoft).[4] Following institution of trial in these cases, Facebook, Inc. ("Facebook" or "Petitioner") filed petitions in IPR2017-00622, IPR2017-00624, and IPR2017-00655, with accompanying motions for joinder to the above-captioned cases. *See*, *e.g.*, Paper 33, 2. After Facebook filed its motions for joinder, Microsoft and Patent Owner, Windy City Innovations LLC, reached a settlement agreement and filed a Joint Motion to Terminate Proceeding in each of the present cases ("Motions to Terminate"). *See*, *e.g.*, Paper 30. On May 10, 2017, we granted the Motions to Terminate but only as to Microsoft; we exercised our discretion under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74(a) to hold in abeyance our ruling on the Motions as to Patent Owner and each proceeding as a whole in light of Facebook's pending joinder motions. *E.g.*, Paper 32, 3. Ultimately, we granted the joinder motions and joined Facebook to the above-captioned cases. *E.g.*, Paper 33. As a result, Facebook is now the sole Petitioner in each proceeding. *See*, *e.g.*, *id.* at 9.

We now return to the Motions to Terminate. As we have previously recognized, 35 U.S.C. § 317(a) provides that "[a]n inter partes review instituted under this chapter shall be terminated *with respect to any petitioner* upon *the joint request of the petitioner* and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed" (emphases added). Pursuant to § 317(a), the present

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[4] All citations herein are to IPR2016-01067. Similar filings were made in all of the above-captioned cases.

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IPR2016-01067 (Patent 8,407,356 B1)
IPR2016-01141 (Patent 8,458,245 B1)
IPR2016-01155 (Patent 8,694,657 B1)

inter partes reviews have been terminated with respect to then-petitioner Microsoft upon the joint request of Microsoft and Patent Owner. The current Petitioner (Facebook), however, has not requested termination. In light of the fact that an active petitioner remains in each of these cases, we determine that termination of these proceedings is not warranted. Therefore, the Motions to Terminate are *denied* as to Patent Owner, and, as a result, each proceeding as a whole will not be terminated at this juncture.

ORDER

It is

ORDERED that the Motions to Terminate are *denied* as to Patent Owner, and each proceeding as a whole is not terminated at this time.

IPR2016-01067 (Patent 8,407,356 B1)
IPR2016-01141 (Patent 8,458,245 B1)
IPR2016-01155 (Patent 8,694,657 B1)

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UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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FACEBOOK, INC.,
Petitioner,

v.

WINDY CITY INNOVATIONS, LLC,
Patent Owner.

_____

Case IPR2017-00622
Patent 8,694,657 B1

_____

Before KARL D. EASTHOM, DAVID C. McKONE, and J. JOHN LEE,
Administrative Patent Judges.

McKONE, *Administrative Patent Judge*.

Institution of *Inter Partes* Review and
Order Granting Petitioner's Motion
for Joinder of IPR2017-00622 With IPR2016-01155
37 C.F.R. § 42.108
37C.F.R. § 42.122(b)

I. INTRODUCTION

On January 7, 2017, Facebook, Inc. ("Petitioner") filed a Petition (Paper 2, "Pet." or "Joinder Petition") for *inter partes* review of U.S. Patent No. 8,694,657 B1 (Ex. 1001, "the '657 patent"). With its Petition, Petitioner filed a Motion for Joinder (Paper 3, "Mot.") with *Microsoft Corp. v. Windy City Innovations, LLC*, Case No. IPR2016-01155 ("the Microsoft IPR"). Windy City Innovations, LLC ("Patent Owner") filed an Opposition to Facebook's Motion for Joinder (Paper 7, "Opp.") and a Preliminary Response (Paper 9, "Prelim. Resp."). Petitioner filed a Reply to Opposition to Motion for Joinder (Paper 8, "Reply").

The Petition was filed after the one-year statutory time period set forth in 35 U.S.C. § 315(b) and 37 C.F.R. § 42.101(b). Nevertheless, as Petitioner notes (Mot. 4), the time bar does not apply if the Petition is accompanied by a request for joinder and joinder is granted. *See* 35 U.S.C. § 315(b); 37 C.F.R. § 42.122(b). Since the filing of Petitioner's Motion for Joinder, Microsoft and Patent Owner settled and, on April 24, 2017, moved to terminate the Microsoft IPR. Microsoft IPR, Paper 29. On May 10, 2017, we granted the motion to terminate as to Microsoft, but held the motion in abeyance as to Patent Owner pending the outcome of Petitioner's Motion for Joinder. Microsoft IPR, Paper 31.

The Microsoft IPR involves challenges to approximately 150 claims of the '657 patent. Microsoft IPR, Paper 1, 3–4 ("Microsoft Petition" or "Original Petition"). By contrast, Petitioner challenges only two of those claims, claims 189 and 465. Mot. 1. On May 4, 2017, we held a conference call with Petitioner and Patent Owner to discuss the impact of settlement between Microsoft and Patent Owner on the Motion for Joinder. In

preparation for the conference call, we asked the parties to be prepared to discuss how the Motion to Terminate in the Microsoft IPR changes or affects the Motion for Joinder, in particular with respect to the following issues if joinder were to be granted: (1) case schedules, (2) discovery, and (3) claims on which trial was instituted in IPR2016-01155 but which Petitioner does not challenge in its Petition. Below, we grant the Joinder Motion, explain why the Petition establishes a reasonable likelihood that Petitioner will prevail with respect to claims 189 and 465, and explain that the scope of the joined proceeding is limited to the patentability of claims 189 and 465.

II. ANALYSIS

A. *Petitioner Has Shown that Joinder Is Appropriate*

Other panels of this Board have counseled that a motion for joinder should (1) set forth reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *See, e.g., Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

As explained below, the Petition is substantively the same as the Microsoft Petition as to claims 189 and 465; thus, there are no new grounds of unpatentability or new evidence asserted in the Petition. Also, we expect the impact of joinder on the existing schedule, briefing, and discovery to be minimal. Petitioner filed its Petition and Motion for Joinder months before Microsoft and Patent Owner settled; thus, continuation of the Microsoft IPR

after settlement was foreseeable and any prejudice to Patent Owner due to continuation is not undue. Thus, joinder is appropriate.

1. *The Substance of the Petition Is the Same as the Microsoft IPR*

As Petitioner argues (Mot. 6), we "routinely grant[] motions for joinder where the party seeking joinder introduces <u>identical</u> arguments and the <u>same</u> grounds raised in the existing proceeding." *Samsung Electronics Co., Ltd. v. Raytheon Co.*, Case IPR2016-00962, slip op. at 9 (PTAB Aug. 24, 2016) (Paper 12) (emphases in original). The parties disagree whether the Petition advances the same substance for claims 189 and 465 as advanced in the Microsoft IPR.

According to Petitioner, "[t]he Joinder Petition [Paper 3] is substantively the same as the Original Petition [of IPR2016-01155] as to the subset of challenged claims, with only non-substantive differences such as those related to the formalities of the different party filing the petition." Mot. 7.

Patent Owner argues that Petitioner seeks to correct mistakes in the Microsoft Petition "by including nearly 18 pages worth of arguments against Claim 189" and "blatantly attempts to insert new arguments in its Joinder Petition." Opp. 2. Patent Owner cites generally to pages 32–37 of the Petition, but identifies no examples of corrections or new arguments. *Id.* Patent Owner further argues that Petitioner "propos[ed] multiple claim constructions on the same '657 Patent for each of the proposed terms in the Joinder Petition, positioning itself to improperly benefit from inconsistent and alternative constructions before the Board." *Id.* at 3. Patent Owner does not list any examples of such inconsistencies. We note that Petitioner has

copied the claim construction arguments presented by Microsoft in the Microsoft IPR. *Compare* Microsoft Pet. 8–12 *with* Pet. 9–14.

In reply, Petitioner argues that "[t]he Original Petition devoted 14 pages to Claim 1 plus a few additional pages to Claim 189 because much of the Claim 189 analysis referred back to similar limitations of Claim 1," and "[t]he Joinder Petition does not address Claim 1 and therefore presents the same substantive analysis as to Claim 189 in the first instance." Reply 1. According to Petitioner, "the Original Petition accounted for this difference between Claims 1 and 189, and the Joinder Petition adopts the same analysis that the Original Petition presented on these limitations." *Id.* at 2.

We have analyzed the Petition in this proceeding and the Microsoft Petition. In the Microsoft IPR, Microsoft presented its analysis primarily for claim 1. Microsoft Pet. 18–32. For claim 189, Microsoft referred back to its analysis of claim 1 for overlapping material and supplemented it with additional analysis particular to claim 189. *Id.* at 32–37. Petitioner's analysis of claim 189 in the Petition in this proceeding appears simply to copy the substance presented for both claim 1 and claim 189 in the Microsoft Petition, albeit presented together for claim 189. Pet. 18–35. Patent Owner has not pointed to any examples where Petitioner has deviated from the analysis presented by Microsoft and we find no substantive differences. Accordingly, we agree with Petitioner that the Petition's analysis of claim 189 in this proceeding is substantively the same as Microsoft's analysis in the Microsoft proceeding, and we reject Patent Owner's arguments to the contrary.

For claim 465, both the Microsoft Petition and the present Petition simply refer back to the respective analysis presented for claim 189.

Microsoft Pet. 38; Pet. 35. Thus, we agree with Petitioner that the substance
presented in this proceeding as to claim 465 is the same as presented in the
Microsoft IPR.

2. *Impact of Joinder on the Existing Schedule, Briefing, and Discovery*

The Motion for Joinder states that Petitioner's joinder "presents no
reason to materially delay or modify the existing trial schedule." Mot. 8.
Petitioner agrees to an "understudy" role until such time as Microsoft ceases
to take an active role in the proceeding, a condition that has come to pass.
Id. at 9–10. Patent Owner contends that it would be prejudiced by a grant of
joinder due to "inefficiencies of additional analyses and briefing, increased
expenditures of party and Board resources, and delayed resolution of the
proceedings." Opp. 3–4. Patent Owner, however, does not articulate with
specificity any such prejudice.

As noted above, Petitioner filed its Motion for Joinder on January 7,
2017, more than three months prior to Patent Owner's settlement with
Microsoft and Microsoft's subsequent termination. Thus, at the time the
Joinder Motion was filed, Patent Owner was aware that the trial in IPR2016-
01155 might proceed on its existing schedule regardless of settlement with
Microsoft. Petitioner does not ask for significant adjustment of the schedule
and Patent Owner does not specify a reason that adjustment will be
necessary. By terminating Microsoft as discussed above and further below,
and proceeding only on a subset of claims Microsoft challenged, Patent
Owner is not unduly prejudiced.

As to the scope of briefing and discovery, the Petition raises only a
subset of the challenges raised in the Microsoft Petition. Thus, briefing and

discovery should be simplified as compared to the anticipated scope of the proceeding prior to the termination of Microsoft. In sum, the impact of joinder on the schedule, briefing, and discovery in IPR2016-01155 should be minimal.

B. Petitioner Has Established a Reasonable Likelihood that It Would Prevail as to Claims 189 and 465

In our Institution Decision in IPR2016-01155, we only addressed claims 1 and 597 specifically. Microsoft IPR, Paper 12, 24–35 ("Microsoft Dec."). As to the remaining challenged claims, including claims 189 and 465, we exercised our discretion to institute on those claims in light of our determination that Microsoft had shown a reasonable likelihood of prevailing as to at least one claim. *Id.* at 36. Below, we address the similarities and differences between claim 1 and claim 189, and Petitioner's and Patent Owner's respective analyses thereof, and determine that the Petition establishes a reasonable likelihood that Petitioner would prevail as to claim 189 as obvious over Brown[1] and Sociable Web[2]. For the same reasons, we determine that the Petition establishes a reasonable likelihood that Petitioner would prevail as to claim 465 as obvious over Brown and Sociable Web.

We provided a background of the '657 patent in our Institution Decision in the Microsoft IPR. Microsoft Dec. 3–6. Likewise, we provided backgrounds of Brown and Sociable Web. *Id.* at 17–24. We preliminarily

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[1] U.S. Patent No. 5,941,947, issued Aug. 24, 1999, filed Aug. 18, 1995 (Ex. 1012, "Brown")

[2] Donath & Robertson, The Sociable Web (Ex. 1019, "Sociable Web")

construed the terms "token," "pointer," and "censor." *Id.* at 8–15. We also

made a preliminary determination as to the level of ordinary skill in the art.

Id. at 16. Each of these summaries and determinations remains applicable to

the joined proceeding.

Claim 189 recites (bracketed letters added) the following:

189. [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, the method including:

[b] affording some of the information to a first of the participator computers via the Internet network, responsive to an authenticated first user identity;

[c] affording some of the information to a second of the participator computers via the Internet network, responsive to an authenticated second user identity; and

[d] determining whether the first user identity and the second user identity are able to form a group to send and to receive real-time communications; and

[e] determining whether the first user identity is individually censored from sending data in the communications, the data presenting at least one of a pointer, video, audio, a graphic, and multimedia by determining whether a respective at least one parameter corresponding to the first user identity has been determined by an other of the user identities; and

[f] if the user identities are able to form the group, forming the group and facilitating sending the communications that are not censored from the first participator computer to the second participator computer, wherein the sending is in real time and via the Internet network, and wherein, for the

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communications which are received and which present an Internet URL, facilitating handling the Internet URL via the computer system so as to find content specified by the Internet URL and presenting the content at an output device of the second participator computer, and

[g] if the first user identity is censored from the sending of the data, not allowing sending the data that is censored from the first participator computer to the second participator computer.

Claim 189 is similar to claim 1. Limitations 189[a]–[d] appear verbatim in claim 1. In our Institution Decision in IPR2016-01155, we addressed Microsoft's allegations as to the limitations of claim 1 that correspond to limitations 189[a]–[d]. Microsoft Dec. 24–28. Patent Owner does not present new arguments as to these limitations. For the reasons given in our Institution Decision in the Microsoft IPR, Petitioner's evidence supports a finding that Brown and Sociable Web teach limitations 189[a]–[d].

We note that, in the Microsoft IPR, Patent Owner argued that Brown does not teach affording information via the Internet in its chat embodiment. Microsoft IPR, Paper 9, 18–21 ("Microsoft Prelim. Resp."). Patent Owner reiterates that argument in this proceeding, but does not add to it materially. Prelim. Resp. 6. The argument is still unpersuasive. *See* Microsoft Dec. 25.

As to limitations 189[e]–[g], they differ from corresponding limitations in claim 1 in that, where claim 1 recites "receiving" data, claim 189 recites "sending" data. Microsoft addressed these differences in its Petition, and Petitioner copied that analysis in its Petition in this proceeding. Microsoft Pet. 33–37; Pet. 28–29, 32, 34–35. In the Microsoft

IPR, Patent Owner incorporated its arguments as to claim 1 for claims 189 and 465. Microsoft Prelim. Resp. 23.

We addressed the limitations of claim 1 that correspond to limitations 189[e] and [g] at pages 29–30 of our Institution Decision in the Microsoft IPR. As an initial matter, in our preliminary construction of "censor," we addressed specifically the recitation of claim 1, "the first user identity is individually censored from receiving data in the communications," and noted that it "refers to control of data received by the first user identity, individually, and is not limited to data suppressed based on the content of those data or by a moderator." *Id.* at 12–15. For the same reasons, "the first user identity is individually censored from sending data in the communications," as recited in claim 189, refers to control of data sent by the first user identity, individually, and is not limited to data suppressed based on the content of those data or by a moderator.

In our Institution Decision in the Microsoft IPR, we pointed to Petitioner's identification in Brown of access controls specified in an access rights database, and Brown's description of varying privilege levels for users with access to a given group, as evidencing "determining whether the first user identity is individually censored from receiving data," as recited in claim 1. Microsoft Dec. 29–30. Microsoft argued that similar disclosure of limiting participation in or denying access to a chat room based on assigned privileges and access rights teaches "determining whether the first user identity is individually censored from sending data in the communications," as recited in claim 189. Microsoft Pet. 33–34. Petitioner copies these arguments. Pet. 28–29. For reasons similar to those given for claim 1, and

in light of our construction of "censor," noted above, Petitioner's evidence is sufficient to support a finding that Brown teaches limitation 189[e].

As to the limitation of claim 1 corresponding to limitation 189[g], we credited Microsoft's argument that Brown's access rights can prevent a user from receiving data and, thus, the data will not be presented from the second participator computer to the output device. Microsoft IPR, Paper 12, 30. Microsoft presented similar evidence in Brown of access rights preventing users from sending data. Microsoft Pet. 36–37. Petitioner copies these arguments. Pet. 34–35. For reasons similar to those given for claim 1, Petitioner's evidence is sufficient to support a finding that Brown teaches limitation 189[g].

We addressed the limitation of claim 1 that corresponds to limitation 189[f] at pages 31–32 of our Institution Decision in the Microsoft IPR. Microsoft contended that the same evidence showed limitation 189[f]. Microsoft Pet. 35–36. Petitioner copies this argument. Pet. 31–34.

As Microsoft did, Petitioner relies on two sets of disclosures in Brown as allegedly showing "determining whether the first user identity and the second user identity are able to form a group to send and to receive real-time communications," as recited in claim 189. First, according to Petitioner, Brown describes users who are system operators ("Syops") using Sysop Tools to add, delete, or modify chat rooms, defining and assigning tokens to define user groups that will be given access to the chat rooms. Pet. 25–26. Second, Petitioner argues that Brown's users form groups by joining a particular chat room. *Id.* at 26. Petitioner refers to these same examples in Brown as teaching "if the user identities are able to form the group, forming

the group and facilitating sending the communications that are not censored from the first participator computer to the second participator computer," as recited in claim 189. *Id.* at 31–32. In the Microsoft IPR, we determined that this evidence supported a finding that Brown teaches this limitation. Microsoft Dec. 31.

Patent Owner argues that Brown does not teach "if the user identities are able to form the group, forming the group and facilitating sending the communications that are not censored from the first participator computer to the second participator computer," as recited in claim 189. Prelim. Resp. 9. Patent Owner argues that Petitioner's analysis of this claim limitation (Pet. 31–32) is too conclusory and lacking in explanation. Prelim. Resp. 10–11. We disagree. In the Microsoft IPR, we explained, in reference to the corresponding limitation of claim 1, that Microsoft showed sufficiently that Brown teaches user identities forming a group and communicating with each other using a Chat service. Microsoft IPR, Paper 12, 31. We addressed this disclosure in detail in evaluating "determining whether the first user identity and the second user identity are able to form a group to send and to receive real-time communications," as recited in claim 1 and also in claim 189[d]. *Id.* at 28. Patent Owner's argument that this limitation was missing from claim 1 was unpersuasive at that stage of the case. Microsoft Prelim. Resp. 21–22; Microsoft Dec. 31.

In presenting a similar argument in this proceeding, Patent Owner appears to make a claim construction argument, contending that to meet the limitation "if the user identities are able to form the group, forming the group and facilitating sending the communications that are not censored from the first participator computer to the second participator computer," as

recited in claim 189, "the formation of the group must be predicated on the condition expressly required by the claim: that existing user identities possess certain capabilities that allow them to form a group including those user identities." Prelim. Resp. 11. Further, Patent Owner argues that this limitation requires "forming, i.e., creating, groups or predicating the formation of a group on the condition that user identities themselves possess the ability to form the group." *Id.* at 13.

Patent Owner does not cite evidence or provide reasoned analysis in support of its construction. Nevertheless, the '657 patent describes arbitrating users into a group using tokens assigned in advance to control the properties and access assigned to the users, much as is described in the example of Brown relied upon by Petitioner:

> Each token is used to control the ability of a user to gain access to other tokens in a token hierarchy arbitration process. The arbitration also includes controlling a user's ability to moderate communications involving a group or subgroup of the participator computers 5. Once in a group, temporary tokens are assigned for priority to moderate/submoderate groups (a group is sometimes known as a channel in multiplexing terminology).

> Accordingly, tokens are used by the controller computer 5 to control a user's group priority and moderation privileges, as well as controlling who joins the group, who leaves the group, and the visibility of members in the group. Visibility refers to whether a user is allowed to know another user is in the chat group.

Ex. 1001, 7:60–8:6; *see id.* at 9:1–15. Thus, we are not persuaded that the claim language excludes a system in which users join or form chat groups based on permissions assigned to them in advance by a Sysop.

Under its proposed construction, Patent Owner argues that configuring a family by using Sysop Tools to designate family members, as described in Brown, does not teach "if the user identities are able to form the

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group, forming the group and facilitating sending the communications that are not censored from the first participator computer to the second participator computer," as recited in claim 189, because "the alleged group formation is based on the actions of the Sysop, not the user identities." Prelim. Resp. 11. According to Patent Owner, "Brown's Syosp modifications do not amount to creating a group only upon the precondition that the user identities, which will form the group, are determined to have the ability to form the group." *Id.* at 12. Patent Owner argues that "the distinction between Brown and the claimed invention [is that] Brown requires a Sysop to add a group." *Id.* As explained above, we are not persuaded that claim 189 excludes groups formed by users according to parameters set in advance by a Sysop. Moreover, even if we were to adopt Patent Owner's implicit construction, Patent Owner's argument would not be persuasive because Petitioner cites to an example in Brown in which the Sysop is one of the users forming the group. Pet. 32.

Patent Owner also argues that a user joining an existing chat room, as described in Brown, does not teach "if the user identities are able to form the group, forming the group and facilitating sending the communications that are not censored from the first participator computer to the second participator computer," as recited in claim 189. Prelim. Resp. 12–13. According to Patent Owner, this example violates "the condition that user identities themselves possess the ability to form the group." *Id.* at 13. As noted above, Patent Owner does not provide any persuasive evidence or argument that this is a requirement of claim 189. Thus, Patent Owner's argument is unpersuasive.

In sum, Petitioner's evidence supports a finding that Brown teaches "if the user identities are able to form the group, forming the group and facilitating sending the communications that are not censored from the first participator computer to the second participator computer," as recited in claim 189. Accordingly, Petitioner has established a reasonable likelihood that it would prevail with respect to claim 189 as obvious over Brown and Sociable Web.

Claim 465 is a system claim that recites limitations substantially the same as the method steps of claim 189. Petitioner contends that claim 465 is unpatentable for the same reasons given for claim 189. Pet. 35. Patent Owner argues claims 189 and 465 together. Prelim. Resp. 9. For the reasons given for claim 189, Petitioner has established a reasonable likelihood that it would prevail with respect to claim 465 as obvious over Brown and Sociable Web.

C. Scope of the Challenge in the Joined Proceeding

As noted above, Microsoft challenged approximately 150 claims of the '657 patent in the Microsoft Petition. In contrast, Petitioner challenges only claims 189 and 465 in this proceeding. To guide the parties in conducting discovery and presenting arguments, we make clear that the parties should pursue only claims 189 and 465 in the joined proceeding.

According to the statute, "[i]f an inter partes review is instituted and not dismissed under this chapter, the Patent Trial and Appeal Board shall issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner and any new claim added under section 316(d)." 35 U.S.C. § 318(a). Thus, in the joined proceeding, we must issue

a final written decision regarding the patentability of "any patent claim
challenged by the petitioner." *Id.*

Although Microsoft challenged many claims in addition to claims 189
and 465, the Microsoft IPR has been terminated as to Microsoft under 35
U.S.C. § 317, which dictates that "[a]n inter partes review instituted under
this chapter shall be terminated with respect to any petitioner upon the joint
request of the petitioner and the patent owner, unless the Office has decided
the merits of the proceeding before the request for termination is filed."
Thus, petitioner Microsoft no longer challenges any claims of the '657
patent in the joined proceeding. Petitioner Facebook now is "the petitioner"
for purposes of § 318(a). Accordingly, we are required by § 318(a) to issue
a final written decision only as to the claims challenged by Facebook, i.e.,
claims 189 and 465. For the avoidance of doubt, we dismiss from the joined
proceeding and, for purposes of § 318(a), will not consider challenges to the
patentability of the following claims:

> 1, 2, 18, 27, 35, 43, 51, 65, 79, 93, 100, 108, 114, 126, 138, 150,
> 156, 168, 170, 172, 176, 178, 180, 182–88, 190, 202, 208, 214,
> 220, 226, 238, 250, 262, 268, 274, 280, 292, 304, 316, 322, 328,
> 334, 336, 340, 342, 344, 346, 348, 350, 352–54, 362, 366, 370,
> 374, 378, 386, 394, 402, 406, 410, 414, 422, 430, 438, 442, 450,
> 452, 454, 456, 458, 460, 462, 464, 466, 476, 481, 486, 491, 496,
> 505, 515, 525, 530, 535, 545, 555, 565, 570, 580, 582, 584, 586,
> 588, 590, 592, 594, 596–98, 606, 607, 615–17, 619, 621, 622,
> 624–26, 628, 630, 632–34, 636, 638, 640–42, 644, 646, and 648–
> 71.

III. CONCLUSION

Petitioner has established a reasonable likelihood that claims 189 and
465 are unpatentable. We have not yet made a final determination of the

patentability of these claims or the construction of any claim term. We grant
Petitioner's Motion for Joinder. The scope of the joined proceeding is
limited to the patentability of claims 189 and 465.

IV. ORDER

For the reasons given, it is:

ORDERED that *inter partes* review is instituted in IPR2017-00622 as
to claims 189 and 465 of U.S. Patent No. 8,694,657 B1 on the same grounds
as those in the Microsoft IPR, and no other grounds are authorized;

FURTHER ORDERED that IPR2017-00622 is joined to the
Microsoft IPR, the Scheduling Order in the Microsoft IPR is unchanged and
shall be applied to the joined proceeding;

FURTHER ORDERED that all further filings in the joined proceeding
shall be made in the Microsoft IPR, IPR2016-01155;

FURTHER ORDERED that, having joined IPR2017-00622 and
IPR2016-01155, under 37 C.F.R. § 42.72, IPR2017-00622 is terminated;

FURTHER ORDERED that challenges to the following claims are
dismissed from the joined proceeding:

> 1, 2, 18, 27, 35, 43, 51, 65, 79, 93, 100, 108, 114, 126, 138, 150,
> 156, 168, 170, 172, 176, 178, 180, 182–88, 190, 202, 208, 214,
> 220, 226, 238, 250, 262, 268, 274, 280, 292, 304, 316, 322, 328,
> 334, 336, 340, 342, 344, 346, 348, 350, 352–54, 362, 366, 370,
> 374, 378, 386, 394, 402, 406, 410, 414, 422, 430, 438, 442, 450,
> 452, 454, 456, 458, 460, 462, 464, 466, 476, 481, 486, 491, 496,
> 505, 515, 525, 530, 535, 545, 555, 565, 570, 580, 582, 584, 586,
> 588, 590, 592, 594, 596–98, 606, 607, 615–17, 619, 621, 622,

624–26, 628, 630, 632–34, 636, 638, 640–42, 644, 646, and 648–71; and

FURTHER ORDERED that the caption in IPR2016-01155 shall be changed to reflect joinder with IPR2017-00622 as shown on the attached page.

UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
_____

FACEBOOK, INC.,
Petitioner,

v.

WINDY CITY INNOVATIONS, LLC,
Patent Owner.
_____

Case IPR2016-01155[1]
Patent 8,694,657 B1
_____

[1] Case IPR2017-00622 has been joined with this proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE
_____

BEFORE THE PATENT TRIAL AND APPEAL BOARD
_____

MICROSOFT CORPORATION,
Petitioner,

v.

WINDY CITY INNOVATIONS LLC,
Patent Owner.

_____

Case IPR2016-01155 (Patent 8,694,657 B1)
Case IPR2016-01067 (Patent 8,407,356 B1)
Case IPR2016-01141 (Patent 8,458,245 B1)

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Before KARL D. EASTHOM, DAVID C. McKONE, and J. JOHN LEE,
Administrative Patent Judges.

McKONE, *Administrative Patent Judge*.

DECISION
Motion to Terminate
37 C.F.R. § 42.74

IPR2016-01155 (Patent 8,694,657 B1)
IPR2016-01067 (Patent 8,407,356 B1)
IPR2016-01141 (Patent 8,458,245 B1)

On April 24, 2017, Petitioner Microsoft Corporation and Patent Owner Windy City Innovations, LLC, filed a Joint Motion to Terminate Proceeding in each of the above-captioned proceedings (Paper 29[1]) and a Joint Motion to Treat Settlement Agreement as Business Confidential Information in each proceeding (Paper 30). The parties represent that they have reached a Settlement Agreement, which is in writing and a true copy of which has been filed in conjunction with the above motions as required under 37 C.F.R. § 42.74(b). Paper 28, 2; Ex. 2015. The parties also certify that no other agreements exist between the parties concerning these cases or the patents at issue. Paper 28, 2.

"An *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed." 35 U.S.C. § 317(a). Pursuant to Section 317(a), we grant the Motions to Terminate as to Petitioner Microsoft.

Prior to the settlement between Microsoft and Windy City, Facebook, Inc., filed Petitions for *inter partes* review of U.S. Patent Nos. 8,694,657 B1, 8,407,356 B1, and 8,458,245 B1, along with corresponding Motions for Joinder with IPR2016-01155, IPR2016-01067, and IPR2016-01141, respectively. *See Facebook, Inc. v. Windy City Innovations LLC.,* Case IPR2017-00622, Papers 2, 3; *Facebook, Inc. v. Windy City Innovations LLC.,* Case IPR2017-00624, Papers 2, 3; *Facebook,*

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[1] Unless otherwise specified, we refer to the paper and exhibit numbering in IPR2016-01155. Similar filings were made in each of the above-captioned cases.

IPR2016-01155 (Patent 8,694,657 B1)
IPR2016-01067 (Patent 8,407,356 B1)
IPR2016-01141 (Patent 8,458,245 B1)

Inc. v. Windy City Innovations LLC, Case IPR2017-00655, Papers 2, 3. Windy City filed its Preliminary Responses to Facebook's Petitions in IPR2017-0622 and IPR2017-00624 on April 17, 2017, and its Preliminary Response to Facebook's Petition in IPR2017-00655 on May 2, 2017. We have not yet ruled on Facebook's Petitions or its Motions for Joinder.

Under Section 317(a), if, after termination as to Microsoft, "no petitioner remains in the *inter partes* review, the Office may terminate the review or proceed to a final written decision under section 318(a)." Our rules echo our discretion to terminate as to Patent Owner or to proceed with the trial. *See* 37 C.F.R. § 42.74(a) ("[T]he Board is not a party to the settlement and may independently determine any question of jurisdiction, patentability, or Office practice."). In exercise of this discretion, we hold in abeyance our rulings on the Motions to Terminate as to Windy City until we have ruled on Facebook's Petitions and Motions for Joinder in IPR2017-00622, IPR2017-00624, and IPR2017-00655.

We further determine that the Settlement Agreement filed by the parties constitutes business confidential information. Therefore, the parties' Joint Motions to Treat Settlement Agreement as Business Confidential Information are granted.

ORDER

It is

ORDERED that the parties' Joint Motions to Terminate Proceedings are *granted* as to Petitioner Microsoft Corporation; and

FURTHER ORDERED that the parties' Joint Motions to Treat Settlement Agreement as Business Confidential Information are *granted*,

IPR2016-01155 (Patent 8,694,657 B1)
IPR2016-01067 (Patent 8,407,356 B1)
IPR2016-01141 (Patent 8,458,245 B1)

and Exhibit 2015 of IPR2016-01155, Exhibit 2015 of IPR2016-01067, and

Exhibit 2011 of IPR2016-01141, shall be kept separate from the pertinent

file consistent with 37 C.F.R. § 42.74(b).

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CERTIFICATE OF FILING

Pursuant to 37 C.F.R. §§ 90.2(a)(1) and 104.2(b), the undersigned hereby

certifies that on February 7, 2018, the original of the foregoing Notice of Appeal

was filed with the Director of the United States Patent and Trademark Office by

hand-delivery, at the following address:

Director of the United States Patent and Trademark Office

c/o Office of General Counsel

10B20, Madison Building East

600 Dulany Street

Alexandria, VA 22314-5793

In addition, pursuant to 37 C.F.R. § 90.2(a)(1) and 37 C.F.R. §42.6(b), the

undersigned certifies that on February 7, 2018, a copy of the foregoing Notice of

Appeal was filed electronically with the Board through the Board's Patent Review

Processing System.

In addition, pursuant to 37 C.F.R. § 90.2(a)(2) and Federal Circuit Rule

15(a)(1), the undersigned certifies that on February 7, 2018, the requisite fee for

the appeal and a true and correct copy of the foregoing Notice of Appeal were

electronically filed with the Clerk of Court of the United States Court of Appeals

for the Federal Circuit at the following address http://ecf.cafc.uscourts.gov.

Dated: February 7, 2018

/Peter Lambrianakos/

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4) and 37 C.F.R. § 90.2(a)(3)(ii), the

undersigned certifies that on February 7, 2018, a true and correct copy of the

foregoing the PATENT OWNER'S NOTICE OF APPEAL was served **via email**

on the Petitioner by serving the correspondence email addresses of record below:

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