

IPR2018-00200  
U.S. Patent No. 8,886,739 B2

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SNAP INC.,  
Petitioner

v.

VAPORSTREAM, INC.,  
Patent Owner

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\_\_\_\_\_  
Case IPR2018-00200  
Patent 8,886,739

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**PATENT OWNER'S NOTICE OF APPEAL**  
**37 C.F.R § 90.2(a)**

Pursuant to 28 U.S.C. § 1295(a)(4)(A), 35 U.S.C. §§ 141, 142, and 319, 37 C.F.R. §§ 90.2(a) and 90.3, and Rule 4(a) of the Federal Rules of Appellate Procedure, notice is hereby given that Patent Owner Vaporstream, Inc. (“Patent Owner”) hereby appeals to the United States Court of Appeals for the Federal Circuit from the Final Written Decision of the Patent Trial and Appeal Board entered on June 4, 2019 (Paper 46) (the “Final Written Decision”) as it relates to claims of U.S. Patent No. 8,886,739 (“the ’739 Patent”), and from all underlying orders, decisions, rulings, findings, determinations, and opinions supporting or relating to that decision. A copy of the Final Written Decision is attached hereto as Exhibit A.

In accordance with 37 C.F.R. § 90.2(a)(3)(ii), the expected issues on appeal include, but are not limited to, the Patent Trial and Appeal Board’s determination that claims 1 and 4-6 have been shown to be unpatentable, and any finding or determination supporting or related to those issues, as well as other issues decided adversely to Patent Owner in any orders, decisions, rulings and opinions and other issues Petitioner Snap Inc. may pursue on appeal.

Simultaneously with this submission, a copy of this Notice of Appeal is being filed electronically with the Patent Trial and Appeal Board. In addition, this Notice of Appeal, along with the required docketing fee, is being filed with the Clerk’s Office for the United States Court of Appeals for the Federal Circuit.

IPR2018-00200  
U.S. Patent No. 8,886,739 B2

Date: August 5, 2019

Respectfully submitted,

By: / *Michael F. Heim* /

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## CERTIFICATION OF SERVICE

I hereby certify that on August 5, 2019, in addition to being filed electronically through the Board's E2E System, the original of the foregoing Notice of Appeal has been sent via Express Mail with the Director of the United States Patent and Trademark Office, at the following address:

Director of the United States Patent and Trademark Office  
Office of the General Counsel  
United States Patent and Trademark Office  
Post Office Box 1450  
Alexandria, Virginia 22313-1450

I hereby certify that on August 5, 2019, a true and correct copy of the foregoing Notice of Appeal was filed electronically via CM/ECF with the Clerk's Office of the United States Court of Appeals for the Federal Circuit.

I also certify that on August 5, 2019, a true and correct copy of this Notice of Appeal is being served via electronic mail upon counsel of record for the Petitioner Snap Inc. at the following addresses:

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# EXHIBIT A

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SNAP INC.,  
Petitioner,

v.

VAPORSTREAM, INC.,  
Patent Owner.

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Case IPR2018-00200  
Patent 8,886,739 B2

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Before JUSTIN T. ARBES, STACEY G. WHITE, and  
JENNIFER MEYER CHAGNON, *Administrative Patent Judges*.

WHITE, *Administrative Patent Judge*.

FINAL WRITTEN DECISION  
*35 U.S.C. § 318(a)*

## I. INTRODUCTION

Petitioner, Snap Inc., filed a Petition for *inter partes* review of claims 1 and 4–6 of U.S. Patent No. 8,886,739 B2 (Ex. 1001, “the ’739 patent”). Paper 2 (“Pet.”). We instituted trial on claims 1 and 4–6 on all asserted grounds of unpatentability. Paper 13 (“Decision”). Patent Owner, Vaporstream, Inc., filed a Patent Owner Response (Paper 25, “PO Resp.”), Petitioner filed a Reply (Paper 30, “Reply”), and Patent Owner filed a Sur-Reply (Paper 32, “Sur-Reply”). Patent Owner also filed a Motion to Exclude (Paper 34) to which Petitioner filed an Opposition (Paper 36).

An oral hearing was held on March 27, 2019, and a transcript of the hearing is included in the record. Paper 44 (“Tr.”).

We have authority under 35 U.S.C. § 6. This Decision is issued pursuant to 35 U.S.C. § 318(a). For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 1 and 4–6 of the ’739 patent are unpatentable.

### A. *Related Matters*

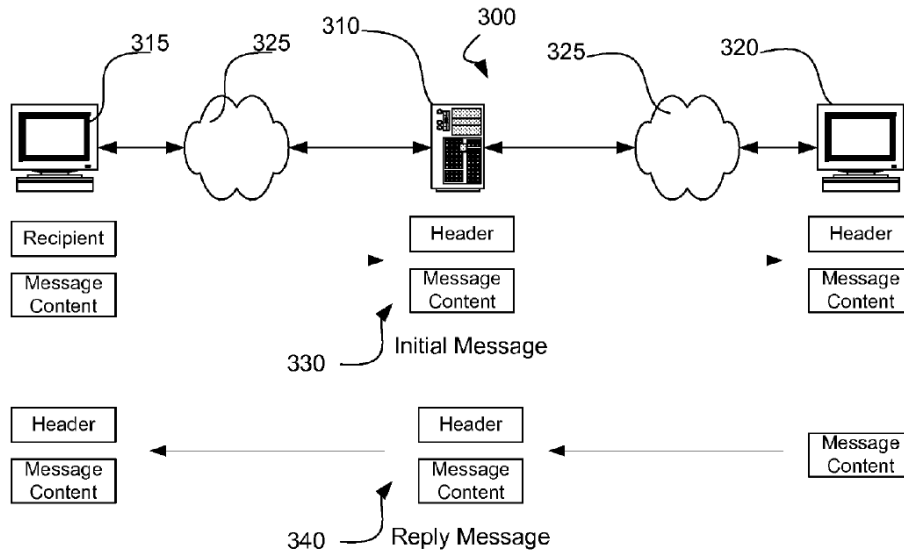
The ’739 patent is at issue in *Vaporstream, Inc. v. Snap Inc.*, No. 2:17-cv-00220-MLH-KS (C.D. Cal.). Paper 3; Pet. 1. Petitioner has filed at least nine other petitions for *inter partes* review directed to related patents that are owned by Patent Owner. Paper 9.

### B. *The ’739 Patent*

The ’739 patent is directed to “[a]n electronic messaging system and method with reduced traceability.” Ex. 1001, Abstract. As noted in the ’739 patent specification, “[t]ypically, an electronic message between two people is not private.” *Id.* at 1:53–54. Messages may be intercepted by third parties; logged and archived; or copied, cut, pasted, or printed. *Id.* at 1:54–

58. “This may give a message a ‘shelf-life’ that is often uncontrollable by the sender or even the recipient.” *Id.* at 1:59–60. The challenged claims are directed to a “sender-side” method for reducing traceability of an electronic message. *See id.* at 2:14–22, 18:50–19:12.

Figure 3 of the '739 patent is reproduced below.

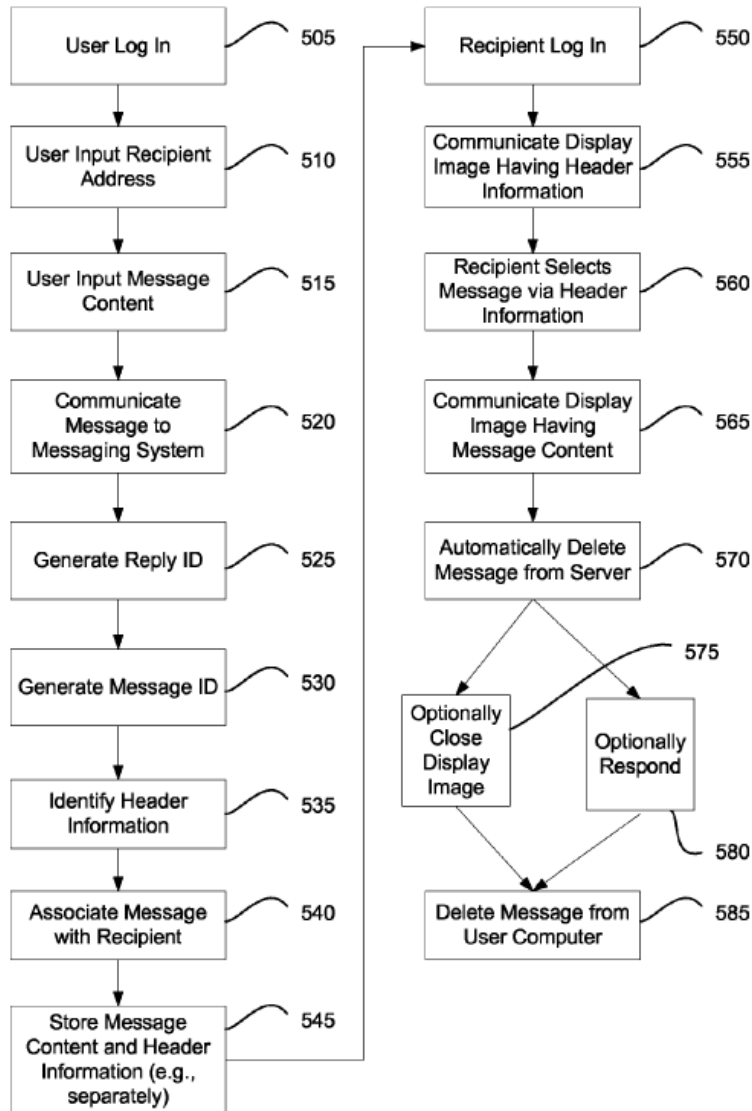


**FIG. 3**

Figure 3 depicts an example of the '739 patent's messaging system. *Id.* at 10:51–52. System 300 includes user computers 315 and 320 and single server computer 310. *Id.* at 10:52–54. Electronic message 330 is communicated via this system using a method detailed below.



Figure 5 of the '739 patent is reproduced below.



**FIG. 5**

Figure 5 is a flow chart depicting an exemplary method of the '739 patent. *Id.* at 3:31–32. In step 510, the user inputs the recipient's address on a screen. *See id.* at 11:30–35, 11:42–45, Fig. 8. A recipient address identifies a particular desired recipient and may be a unique identifier (e.g., a screen name, a login name, a messaging name, etc.) that has been established for use with this system or it may be a preexisting address such as an email address, Short Message Service (SMS) address, telephone number, or

Blackberry personal identification number. *Id.* at 6:63–7:9. After the recipient address has been entered, the system will proceed to step 515 and display another screen wherein the user may input the content of an electronic message. *Id.* at 11:42–48, Fig. 9. “An electronic message may be any electronic file, data and/or other information transmitted between one or more user computers.” *Id.* at 7:39–41. The electronic message may include text, image, video, audio, or other types of data. *Id.* at 7:41–49. In one embodiment, “the recipient address and the message content are entered on separate display screens.” *Id.* at 11:48–49. “Separation of the entry of the recipient address and message content further reduces the traceability of an electronic message by, in part, reducing the ability of logging at computer 315” that receives the message, for example, by preventing screenshot logging from capturing the recipient address and message content simultaneously. *Id.* at 9:9–11, 11:51–54.

At step 520, the message content is communicated to the server. *Id.* at 11:61–63. The recipient address is communicated to the server separately from the corresponding message content in order to reduce the ability to intercept the entire message during communication to the server. *Id.* at 11:64–12:1. “[A] correlation (e.g., a non-identifying message ID . . . ) may be utilized to associate the two components.” *Id.* at 6:58–60. In this regard, “at step 530, system 300 generates a message ID for associating the separated message content and header information [(which includes the recipient address)] of electronic message 330. Server 310 maintains a correspondence between the message content and header information.” *Id.* at 12:26–30, 6:46–54; *see also id.* at 13:19–21 (“A message ID [is] used to maintain correspondence between the separated components of electronic

message 330.”). The ’739 patent describes an example in which the message ID is included both in the Extensible Markup Language (XML) file storing the header information and in the XML file storing the message content. *See id.* at 13:33–14:17.

### *C. Illustrative Claim*

We instituted challenges to independent claim 1 and dependent claims 4–6 of the ’739 patent. Claim 1 is illustrative of the claimed subject matter:

1. A computer-implemented method of handling an electronic message, the method comprising:

providing a first display and a second display at a sending user device, the first display configured to allow a sending user to associate a first message content including a media component with the electronic message, the second display configured to allow the sending user to input a first recipient address corresponding to the first message content, the first and second displays not being displayed at the same time;

displaying via the first display a first message content including a media component;

receiving via the second display a first recipient address, wherein the first message content including a media component and the first recipient address are not displayed to the sending user at the same time;

associating a message ID with the first message content including a media component, the message ID correlating the first recipient address and the first message content including a media component; and

transmitting the recipient address and the first message content including a media component from the sending user device to a server computer, the first message content including a media component being transmitted to the server computer separately from the recipient address, the first message content including a media component not being accessible by the sending user for display via the sending user device after said transmitting the media component to the server computer.

*Id.* at 18:50–19:12.

*D. Asserted Grounds of Unpatentability*

Petitioner, with the support of testimony from Sandeep Chatterjee, Ph.D. (Exs. 1002, 1043), contends that claims 1 and 4–6 of the ’739 patent would have been obvious over the teachings of Namias<sup>1</sup>, Saffer<sup>2</sup>, and Smith<sup>3</sup>; and over the teachings of Namias, Blum<sup>4</sup>, Hazel<sup>5</sup>, RFC 2821<sup>6</sup>, and Boyce<sup>7</sup>. Pet. 3.

*E. Person of Ordinary Skill in the Art*

On behalf of Petitioner, Dr. Chatterjee opines that a person of ordinary skill in the art would have had “at least a bachelor’s degree in software engineering, computer science, or computer engineering with at least two years of experience in the design and implementation of systems for sending and receiving messages over a communications network, such as the Internet (or equivalent degree or experience).” Pet. 4 (citing Ex. 1002 ¶¶ 13–16). Patent Owner’s declarant, Kevin Almeroth, Ph.D., “generally agree[s]” with Petitioner’s characterization of the person of ordinary skill with the caveat “that such a person of ordinary skill would also have a working knowledge of design principles for software user interfaces. Such knowledge often would be learned in an undergraduate course in Human Computer Interaction (HCI).” Ex. 2009 ¶ 21; *see also* Ex. 2001 ¶ 14 (Patent

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<sup>1</sup> U.S. Patent Pub. 2002/0112005 A1 (Aug. 15, 2002) (Ex. 1003, “Namias”).

<sup>2</sup> U.S. Patent Pub. 2003/0122922 A1 (July 3, 2003) (Ex. 1004, “Saffer”).

<sup>3</sup> U.S. Patent 6,192,407 B1 (Feb. 20, 2001) (Ex. 1005, “Smith”).

<sup>4</sup> Richard Blum, *Postfix* (2001) (Ex. 1010, “Blum”).

<sup>5</sup> Philip Hazel, *Exim: The Mail Transfer Agent* (2001) (Ex. 1011, “Hazel”).

<sup>6</sup> *Simple Mail Transfer Protocol (SMTP)*, Request for Comments (RFC) 2821, published Apr. 2001 (Ex. 1008, “RFC 2821”).

<sup>7</sup> Jim Boyce, *Microsoft Outlook Version 2002* (2001) (Ex. 1012, “Boyce”).

Owner’s previous declarant, Michael Shamos Ph.D., also was in general agreement with this description). Dr. Almeroth’s caveat is well taken because the ’739 patent discusses the design of an interface that purports to reduce issues of traceability. *See, e.g.*, Ex. 1001, 1:46–3:9. In the Institution Decision, we adopted Petitioner’s proposed description of the person of ordinary skill in the art. Dec. 7. We have reviewed the full record in this case and based on our analysis, for the purposes of this Decision, adopt Petitioner’s description of the person of ordinary skill, with the caveat that such an individual would have had a working knowledge of design principles for software user interfaces, which may be achieved via study of human-computer interaction (HCI).

## II. DISCUSSION

### A. Claim Construction<sup>8</sup>

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable constructions in light of the specification of the patent in which they appear. *See* 37 C.F.R. § 42.100(b). “In claim construction, [our reviewing] court gives primacy to the language of the claims, followed by the specification. Additionally, the prosecution history, while not literally within the patent document, serves as intrinsic evidence for purposes of claim construction.” *Tempo Lighting, Inc. v. Tivoli, LLC*, 742 F.3d 973, 977 (Fed. Cir. 2014). Otherwise, under the

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<sup>8</sup> The recent revisions to our claim construction standard do not apply to this proceeding because the new “rule is effective on November 13, 2018 and applies to all IPR, PGR and CBM petitions filed on or after the effective date.” Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51340 (Oct. 11, 2018) (to be codified at 37 C.F.R. § 42).

broadest reasonable construction standard, claim terms are presumed to have their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

Patent Owner seeks construction of the phrase “message content including a media component.” PO Resp. 23. Petitioner does not seek express construction of any term of the ’739 patent. Pet. 8–9.

Claim 1 recites various limitations pertaining to a “first message content including a media component.” For example, claim 1 recites providing a “first display configured to allow a sending user to associate a first message content including a media component with the electronic message,” the “first message content including a media component” being displayed at a different time than the “first recipient address,” “associating a message ID with the first message content including a media component,” and separately transmitting the “recipient address” and “first message content including a media component” such that the “first message content including a media component” is not “accessible by the sending user for display via the sending user device after said transmitting the media component to the server computer.”

Patent Owner contends that “‘message content including a media component’ encompasses media content included in the message via a publicly-accessible [Uniform Resource Locator (URL)].” PO Resp. 25. In support of this construction, Patent Owner relies on a passage from the ’739 patent, which states that “a message content of an electronic message may include an attached and/or linked file.” Ex. 1001, 7:51–52 (cited at PO Resp. 24). Patent Owner also directs us to testimony from Petitioner’s

declarant, Dr. Chatterjee. PO Resp. 25 (citing Ex. 1002 ¶ 100 n.25). Patent Owner characterizes this testimony as “mak[ing] clear [that] passing the actual content and passing a link that provides access to that content, such as a URL, are both examples of ‘passing information.’” *Id.* Thus, in Patent Owner’s view, the recited “message content including a media component” broadly includes both a URL in a message (linking to content accessible via that URL) and a file attached to the message. *Id.*

Petitioner responds by arguing that “although the specification states that ‘message content’ may include a ‘linked file,’ it never states that the *link itself* is ‘message content.’” Reply 9. In addition, Petitioner directs us to the specification, which states that “[t]ypically, a message content, such as message content 140 does not include information that in itself identifies the message sender, recipient, *location of the electronic message*, or time/date associated with the electronic message.” Ex. 1001, 7:55–59 (cited at Reply 10) (emphasis added). Petitioner explains that “[t]he URL (Uniform Resource Locator) in the proposed combination [of Namias and Saffer] therefore does not qualify as ‘message content’ because it identifies ‘the location of’ the video message on the video server in Saffer.” Reply 10 (citing Ex. 1004 ¶ 28). According to Petitioner, a person of ordinary skill in the art would “think of a URL as a pointer to content,” i.e., “how you get to the content” rather than “the content itself.” Tr. 23:12–24:5. In short, Petitioner contends that “[i]t’s . . . the file that’s the content, not the link itself.” *Id.* at 23:6.

We agree with Petitioner’s arguments. The specification states that [i]n another example, a message content of an electronic message may include embedded information. In another example, a message content of an electronic message may include an

attached and/or linked file. In such an example with an attached and/or linked file, the attached and/or linked file may be automatically deleted from the messaging system after being viewed by a recipient.

Ex. 1001, 7:49–55. Thus, the specification indicates that message content may be communicated to the user via embedded information, attached files, or linked files. Embedding, attaching, and linking are three ways to provide access to information. As such, the email recipient may gain access to the information or content in a variety of ways, however, the method of providing access is not the same thing as the underlying information or content. In the passage quoted above, privacy may be enhanced by automatically deleting “the attached and/or linked file” from the messaging system after the file is viewed. *Id.* at 7:53–54. The specification makes no provisions for deleting the URL or link to the file, but rather the focus is on the information itself. That information, or “message content,” is located in the file itself regardless of the method by which the recipient accesses that information. Contrary to Patent Owner’s assertion, Dr. Chatterjee’s testimony cited by Patent Owner also supports this conclusion. Dr. Chatterjee testifies that there is a “distinction between transmitting the *actual content* to the recipient in a message, versus transmitting *just a URL* that points to or is an address for the content.” Ex. 1002 ¶ 100 n.25 (emphases added). Dr. Chatterjee’s testimony makes clear that “actual content” is distinct from “just a URL” that points to the content.

Thus, we determine that that the broadest reasonable interpretation of the phrase “message content including a media component” does not encompass a URL in a message (linked to content accessible via that URL). No further express interpretation is necessary for the purposes of this



Decision. *See, e.g., Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Ltd.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“[W]e need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy.’”) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

*B. Asserted Obviousness Based on Namias, Saffer, and Smith*

Petitioner argues that claims 1 and 4–6 of the ’739 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over the teachings of Namias, Saffer, and Smith. Pet. 15–45. Relying on the testimony of Dr. Chatterjee, Petitioner contends that the combined references teach or suggest the subject matter of the challenged claims and that a person having ordinary skill in the art would have combined the teachings of the references in the manner asserted. *Id.*; Ex. 1002 ¶¶ 54–149. Patent Owner, relying on the testimony of Dr. Almeroth, disputes Petitioner’s contentions. PO Resp. 25–48. For the reasons described below, we determine Petitioner has established the unpatentability of these claims by a preponderance of the evidence.

*1. Overview of Namias*

Namias is directed to “[a] method and apparatus for providing a video e-mail kiosk for creating and sending video e-mail messages such as full motion videos or still snapshots.” Ex. 1003, Abstract. Namias’s video email kiosk comprises a digital processor, a touch-sensitive screen monitor, a digital video camera, a microphone, audio speakers, a credit card acceptor, a cash acceptor, and a digital network communications link. *Id.* ¶ 31. The kiosk displays an inactive screen until a user starts a transaction. *Id.* ¶ 34. Upon activation of the kiosk, a record screen is shown on the kiosk display

and the user may create a video recording or still image from this screen. *Id.*  
¶ 35. A preview screen is displayed after the user has recorded a full motion  
video or still snapshot message. *Id.* ¶ 36.

Figure 4a of Namias is reproduced below.

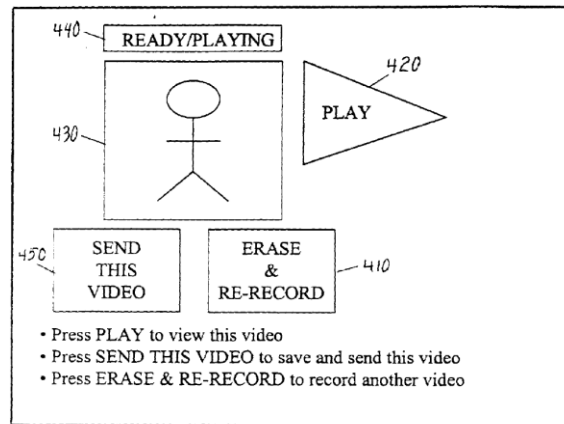


FIG. 4A

400

Figure 4a depicts “a preview screen that is displayed after a user has  
recorded a video message.” *Id.* ¶ 25. Preview screen 400 allows the user to  
review the recorded video or still image and decide whether the message is  
acceptable. *Id.* ¶ 36. If the user is satisfied with the message, then the user  
may press send button 450 and proceed to address screen 500. *Id.* ¶¶ 37, 40.

Figure 5 of Namias is reproduced below.

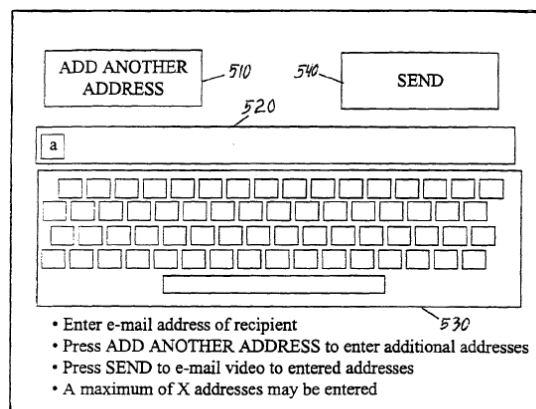


FIG. 5

500

Figure 5 depicts an address screen in which a user is prompted to enter a recipient's email address. *Id.* ¶ 27. “The address is a unique identifier which instructs routing computers where to send the message.” *Id.* ¶ 5. The user presses add address button 510 and then may use a keyboard to input the email address of the recipient. *Id.* ¶ 40. Once the email addresses have been entered, the user may press send button 540 to move to the next step in the process. *Id.*

“[F]inal screen 700 . . . is displayed at the end of the process after payment has been made and the video or photographic e-mail has been sent to the intended recipient or recipients.” *Id.* ¶ 42. A final display timer is monitored and upon expiration of the timer the kiosk reverts to the inactive screen display. *Id.* ¶ 68.

## 2. Overview of Saffer

Saffer describes “[a] computer implemented system and method in which a user can send e-mail messages that include full-motion video and audio (or, alternatively, audio only), along with (if desired) the text messages to an e-mail recipient.” Ex. 1004, Abstract. In Saffer, a user composes a message, records a video, and then hits the send button. *Id.* ¶ 4. The sender's computer retrieves a video ID from the server for that compressed video. *Id.* ¶¶ 4, 29, Fig. 3 (step 100). Software on the sender's computer compresses the video and transmits the compressed video to a server. *Id.* ¶¶ 4, 44, Fig. 3 (steps 102, 110). The sender's computer inserts the video ID (with a link or network address to the video server) into an email message, which is then sent to the recipient. *Id.* ¶¶ 4, 46, 47, Fig. 3 (step 112).

### 3. *Overview of Smith*

Smith describes “[a] document delivery architecture [that] dynamically generates a private Uniform Resource Locator (URL) to distribute information.” Ex. 1005, Abstract. Smith’s private URLs (“PURLs”) are temporary, dynamically generated URLs that uniquely identify the recipient of a document, the document to be delivered, and optionally may include other delivery parameters. *Id.* at Abstract, 15:8–9. A sender forwards a document to a server and the server temporarily stores the document. *Id.* at 15:29–31. “The server dynamically generates a URL for each intended recipient of the document.” *Id.* at 15:31–33. The recipient is sent an email message which includes the PURL. *Id.* at 15:38–41. The recipient uses the PURL and the Web to retrieve the document (or set of documents). *Id.* at 14:48–50, 15:41–42. “PURLS avoid attaching information to e-mail messages to send documents, but rather attach a general reference to a document to be sent, and then enable the recipient to access a document via the reference.” *Id.* at 15:12–15. When the recipient accesses the document by using a PURL, a server can intercept the document access request and provide additional services, such as tracking and security. *Id.* at 15:16–19.

### 4. *Analysis of Challenge to Claim 1*

First, we evaluate Petitioner’s arguments as to how the combination of Namias, Saffer, and Smith teaches the limitations of claim 1, and then we examine Petitioner’s contentions as to why a person of ordinary skill in the art would have been motivated to combine the teachings of the references.

*a. Preamble*

The preamble of independent claim 1 recites a “computer-implemented method of handling an electronic message.” Petitioner contends that, to the extent this preamble is a limitation, a person of ordinary skill in the art would have understood Namias to teach this aspect of the claim. Pet. 15–16. Namias describes “providing a video e-mail kiosk for creating and sending video e-mail messages such as full motion videos of still snapshots.” *Id.* at 15 (quoting Ex. 1003, Abstract). We agree, for the reasons stated in the Petition.

*b. “providing a first display and a second display at a sending user device, the first display configured to allow a sending user to associate a first message content including a media component with the electronic message, the second display configured to allow the sending user to input a first recipient address corresponding to the first message content, the first and second displays not being displayed at the same time”*

As recited in claim 1, the first display allows the user to enter message content and the second display allows the user to enter a recipient address. Petitioner contends that the recited first display is taught by Namias’s preview screen, which is depicted in Figure 4a. Pet. 17–18. As noted by Petitioner, Namias’s preview screen allows the user to manipulate message content by playing, erasing, and re-recording a video message. *Id.* at 18 (citing Ex. 1003 ¶¶ 36–37). When the user is satisfied with the message, the user may press “SEND THIS VIDEO” to save and send the recorded video or still image. *Id.* (citing Ex. 1003 ¶ 37). Petitioner contends that the recited second display is taught by Namias’s address screen, which is depicted in Figure 5. *Id.* at 19–20. “As shown, Figure 5 ‘allows the user to enter an e-mail address or addresses and thereby designate a recipient or recipients.’” *Id.* at 19 (citing Ex. 1003 ¶¶ 40, 27).

Petitioner relies upon Namias to teach the limitation that the first and second displays are not displayed at the same time. *Id.* at 20. “Namias explains that ‘FIG. 5 shows an address screen 500 that is displayed **after** the full motion video or still snapshot message has been satisfactorily recorded,’ the satisfactory recording of which uses the previously displayed screen shown in Figure 4A.” *Id.* (citing Ex. 1003 ¶ 40).

Patent Owner contends that Namias, as modified by Saffer and Smith, would not have separate displays for message content and address information. PO Resp. 45–48. Patent Owner argues that “both Namias and Saffer have user interfaces for composing video emails. Petitioner offers no reason—other than hindsight—why a [person of ordinary skill in the art] determined to combine Namias and Saffer and having considered the references *as a whole* would choose Namias’s user interface over Saffer’s user interface.” *Id.* at 32. Dr. Almeroth opines that “a [person of ordinary skill in the art] intent on combining Namias with Saffer would almost certainly choose Saffer’s single screen email composition display (which is integrated with Saffer and is far more efficient, robust, and less likely to cause navigational trauma) over Namias’s multi-screen navigation flow, absent extenuating circumstances.” Ex. 2009 ¶ 118.

Petitioner responds by directing us to the Federal Circuit decision in *In re Fulton*, 391 F.3d 1195 (Fed. Cir. 2004). Reply 15. There, the applicant argued that the record before the Board was insufficient to establish that the features of the relied upon reference “are preferred over other alternatives disclosed in the prior art.” *Fulton*, 391 F.3d at 1200. Our reviewing court held that “[t]his argument fails because our case law does not require that a particular combination must be the preferred, or the most

desirable, combination described in the prior art in order to provide motivation for the current invention.” *Id.* As such, we are tasked with determining “whether there is something in the prior art as a whole to suggest the *desirability*, and thus the obviousness, of making the combination’ not whether there is something in the prior art as a whole to suggest that the combination is the *most desirable* combination available.” *Id.* (quoting *In re Beattie*, 974 F.2d 1309, 1311 (Fed. Cir. 1992)).

Petitioner asserts that “while Saffer’s interface may offer certain benefits that make it desirable in certain circumstances, Namias’s interface likewise provides other advantages that would have motivated a [person of ordinary skill in the art] to use it in a video messaging system.” Reply 17 (citing Ex. 1043 ¶ 37). According to Petitioner, the chief advantage of Namias’s two-screen interface “is its simplicity.” *Id.* Petitioner directs us to testimony from Patent Owner’s declarant, Dr. Shamos, wherein he testified that “drawings of Namias show, in an incidental manner, that message content and email addresses are entered on different screens; this is a matter of user interface design *simplification*, and not to achieve reduced traceability.” Ex. 2001 ¶ 73 (emphasis added) (cited at Reply 17); *see also id.* ¶ 31 (“The only aspects that Namias has in common with the ’739 patent are that Namias discloses (1) sending a media component by email; and (2) separate screens for entering message content and recipient address. However, the reason for the separate screen is not reduced traceability, but to present a *simple* interface to a user who has never used the kiosk before.” (emphasis added)); ¶ 74 (“It is true that the drawings [of Namias] illustrate different displays, but this is a matter of user interface design simplification . . .”). Petitioner asserts that one of ordinary skill in the art

would have recognized “that Namias’s multiscreen interface is an example of a well-known user interface technique known as ‘wizards.’” Reply 18 (citing Ex. 1043 ¶¶ 39–41). As noted by Dr. Chatterjee,

a *wizard* is a special form of user assistance that automates a task through a dialog with the user. Wizards help the user accomplish tasks that can be complex and require experience. Wizards can automate almost any task . . . . They are especially useful for complex or infrequent tasks that the user may have difficulty learning or doing.

Ex. 1043 ¶ 40 (quoting Ex. 1048<sup>9</sup>, 335–36). According to Petitioner, certain users find it easier to use a simpler interface with fewer options on each page. Tr. 16:8–13 (“[I]t’s far easier for them to have a wizard type scenario to walk through the things that they have to do, so that they don’t get confused by multiple options on a single page.”).

Patent Owner responds by asserting that Petitioner “has not provided any competent evidence that Namias’s multi-screen interface is simpler than Saffer’s.” Sur-Reply 18. Patent Owner also contends that arguments regarding the simplicity of Namias’s interface and the utility of wizards are untimely because they were first presented in Petitioner’s Reply. *Id.*

In light of the evidence and arguments presented on this point, we determine that Petitioner is correct in asserting that one of skill in the art would have understood the combination of Namias with Saffer and Smith to teach separate displays as recited in claim 1. Namias’s Figures 4a and 5 are separate displays. Patent Owner concedes as much in its comparison of the multi-screen configuration of Namias with the single screen configuration of Saffer. *See* Sur-Reply 18–19. There, Patent Owner compares Namias’s

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<sup>9</sup> Theo Mandel, *The Elements of User Interface Design* (1997) (“Mandel”).



“sequence of seven separate screens” with “Saffer’s single integrated screen.” *Id.* at 18. Namias’s Figure 5, the recited “second display,” is not accessible to the user until after the media content is handled via the “first display” of Figure 4. *See* Ex. 1003 ¶ 40. Thus, Namias’s screens perform the recited tasks with the required separation.

We are not persuaded by Patent Owner’s argument that one of skill in the art would not have selected Namias’s multi-screen interface over Saffer’s integrated interface. As Petitioner has pointed out, under Federal Circuit precedent, obviousness “does not require that the motivation be the *best* option, only that it be a *suitable* option from which the prior art did not teach away.” *PAR Pharm., Inc. v. TWI Pharms., Inc.*, 773 F.3d 1186, 1197–98 (Fed. Cir. 2014) (citing *Galderma Labs., L.P. v. Tolmar, Inc.*, 737 F.3d 731, 738 (Fed. Cir. 2013)). Here, we are presented with persuasive evidence from Dr. Chatterjee showing that one of skill in the art would have looked to Namias to design a video messaging system that was easy to use. Dr. Chatterjee’s opinion is supported by a 1997 reference book, Mandel, discussing the elements of user interface design. *See* Ex. 1043 ¶ 40 (citing Mandel). Indeed, Mandel indicates that wizard-type layouts (like the one disclosed in Namias) are useful because “[i]t is better to have a greater number of simple pages with fewer choices than a smaller number of complex pages with too many options or text.” Ex. 1048, 64. Further, as Patent Owner’s declarant, Dr. Almeroth, noted, a person of ordinary skill in the art would be versed in user interface design and may have taken undergraduate courses in human-computer interaction (HCI). Ex. 2009 ¶ 21. Thus, Mandel with its focus on “Foundations of User Interface Design,” including “understanding . . . how humans read, learn, and think to help

design computers that work within the psychological capabilities and limitations of the people for whom they are designed,” would be indicative of the knowledge of a person of ordinary skill at the time of the invention of the ’739 patent. *See* Ex. 1048, 1, 17 (emphases omitted).

In addition, we are not persuaded that Petitioner’s argument in its Reply is untimely. *See* Reply 16–18 (citing Ex. 1043 ¶¶ 37–40). As described in the Petition, Petitioner relied on Figures 4a and 5 of Namias for the recited separate displays, noting that “the user interface in Namias uses separate displays to solicit the recipient address and message content from the user,” and asserted a combination with Saffer for certain claim limitations pertaining to message IDs. Pet. 9, 16–17, 22. Patent Owner argued in response that Petitioner failed to explain why a person of ordinary skill in the art would have chosen “the Namias interface over the Saffer single composition screen.” PO Resp. 46. Notably, however, Patent Owner’s declarant described Namias’s multi-screen format as a “user interface design simplification.” Ex. 2001 ¶ 73. Then in its Reply, Petitioner responded to Patent Owner’s arguments regarding the desirability of a multi-screen format as opposed to a single-screen format by explaining why Patent Owner is incorrect and further explaining the previous discussion of separate display screens with supporting evidence (such as Mandel) showing how one of ordinary skill in the art would have understood Namias’s disclosures. Thus, we are persuaded that this is not an untimely argument, but rather a proper responsive argument that builds upon the existing record. For all of these reasons, we are persuaded that Petitioner has established that the cited art teaches separate displays as recited in claim 1 of the ’739 patent.

*c. “displaying via the first display a first message content including a media component”*

As discussed above, Petitioner contends that Namias’s preview screen teaches the recited first display. Claim 1 requires this first display to display message content, which includes a media component. Petitioner relies upon Namias’s “image window,” which is depicted in Figure 4a to teach this limitation. Pet. 20. As described in Namias, the image window displays the recorded message or still image that is to be sent to a recipient. *Id.* at 20–21 (citing Ex. 1003 ¶ 37, Fig. 4a). We agree, for the reasons stated in the Petition.

*d. “receiving via the second display a first recipient address, wherein the first message content including a media component and the first recipient address are not displayed to the sending user at the same time”*

As discussed above, Petitioner contends that Namias’s address screen teaches the recited second display. Claim 1 requires the second display to display the address of the message’s intended recipient and requires that this display not be shown at the same time as the first display, which includes the message content. As described in Namias, the address screen allows the user to enter an email address and this screen is displayed after the user presses the send button on the preview screen. Ex. 1003 ¶ 40. Petitioner’s declarant, Dr. Chatterjee, testifies that Namias’s “figures make clear that the video or picture message content and the recipient’s email address ‘are not displayed to the sending user at the same time’ at any point during the method of handling a message taught by Namias.” Ex. 1002 ¶ 73 (emphases omitted). We agree, for the reasons stated in the Petition.

- e. “associating a message ID with the first message content including a media component, the message ID correlating the first recipient address and the first message content including a media component”*

According to Petitioner, Saffer and Namias both disclose systems in which a user can send an email message that includes a video. Pet. 22. (citing Ex. 1003 ¶ 42; Ex. 1004, Abstract, ¶¶ 2–3). Petitioner argues that Namias discloses sending the video or picture message, but it does not detail the mechanics of how this occurs. *Id.* In order to provide the necessary implementation details, Petitioner relies upon the disclosures of Saffer to describe the mechanism by which the media content/message is associated with an ID. *Id.* According to Petitioner, Saffer describes the following steps, which are used to effectuate the transmission of a video message:

- (1) The sending device requests and obtains a “video ID” from a video server, which will be used to uniquely identify the recorded video. (Saffer, ¶¶0004, 0029, Figure 3 (Step 100).)
- (2) The sending device uses the video ID received in step (1) to rename the video file. (Saffer, ¶¶0004, 0044, Fig. 3 (Step 102).)
- (3) The sending device then uploads the renamed video file to the video server for storage. (Saffer, ¶¶0004, 0044, Fig. 3 (Step 110).)
- (4) After the upload, the sending device inserts a link into the body of the email message (in the form of a Uniform Resource Locator (URL)), the link including the video ID that identifies the video file on the video server. (Saffer, ¶¶0004, 0046, Fig. 3 (Step 112), ¶0027.)
- (5) Finally, the sending device sends the email containing the link (but not containing the previously-uploaded video content) to an email server. (Saffer, ¶¶0004, 0047.)

Pet. 23. Petitioner contends that “[t]he video ID in Saffer discloses the claimed ‘message ID’ because it is clearly associated with a corresponding video message that was recorded and delivered using the video messaging

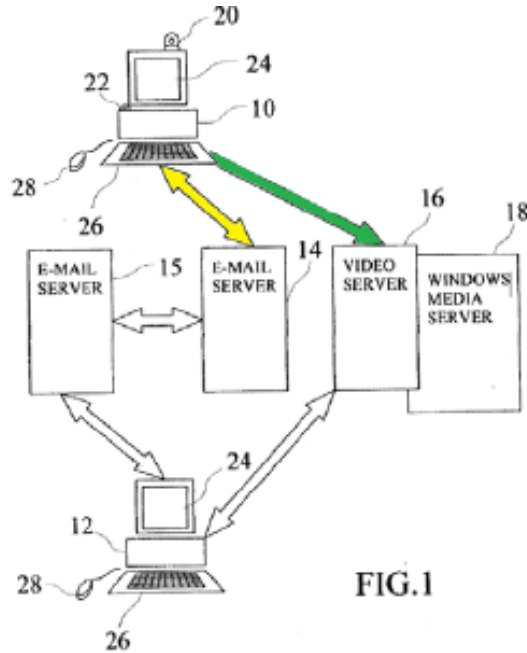
service taught by Saffer.” *Id.* at 25 (citing Ex. 1004 ¶ 4) (emphasis omitted). Petitioner also asserts that Saffer’s video ID correlates the first recipient address and the first message content. *Id.* at 26. According to Petitioner, this limitation is taught by Saffer because the video ID is included in the email message that contains the recipient’s email address. *Id.* at 26–27.

Petitioner further relies upon Smith for an additional teaching as to this limitation. Pet. 31. According to Petitioner, “[i]f the Patent Owner were to argue that the content of the message ID itself must explicitly show a correlation between ‘the first recipient address and the first message content including a media component,’ such a requirement would have been obvious in further view of Smith.” *Id.* (emphases omitted).

We agree with Petitioner’s arguments as set forth in the Petition.

*f. “transmitting the recipient address and the first message content including a media component from the sending user device to a server computer, the first message content including a media component being transmitted to the server computer separately from the recipient address”*

According to Petitioner, Namias discloses transmitting the address and the message, but Namias does not describe the transmission mechanism. Pet. 38. Petitioner relies upon Saffer to provide the details necessary to implement this transmission. *Id.* Petitioner provides an annotated version of Figure 1 of Saffer, reproduced below. *Id.* at 41.



Annotated Figure 1 of Saffer depicts the transmissions sent from Saffer’s user device. *Id.* According to Petitioner, “Saffer discloses an embodiment in which the video content is transmitted to a *video server* 16 (in green) and the email message to a *physically separate e-mail server* 15 (in yellow).” *Id.* Specifically, Petitioner asserts that

Saffer discloses at least two transmissions by the sending user device to transmit the video message: (1) the sending device first uploads the video file to the video server (Step 110) (¶¶0004, 0044; Fig. 3); and after an intervening step (Step 112) (¶¶0004, 0044-46; Fig. 3), (2) the sending device then sends the email message containing the URL and the recipient address (but not the video file) to the email server (¶¶0004, 0047).

*Id.* at 38. As such, Petitioner argues that the cited art teaches the separate transmission of the address and message content. *Id.* at 39–40. “This is because transmissions (1) and (2) above are transmissions that are separated by an intervening step, and separately convey to the server, respectively, the video content and the recipient address.” *Id.* at 40 (emphases omitted).

Dr. Chatterjee explains

that after [1] the video content has been uploaded, there is an intervening step of [2] “then . . . insert[ing] the video ID with a ‘link’ or network address to the video server into the text or code of the composed e-mail message” before [3] that email message, which contains the recipient’s email address in its “To:” field (Saffer, ¶0024), is uploaded.

Ex. 1002 ¶ 126 (emphases omitted). Thus, the transmission of the video content to the video server must occur first in order to be able to generate the link with the video ID that is inserted into the email message (that contains the recipient address), which is later sent to the email server. Petitioner also argues that Saffer teaches a video server and email server that constitute a single physical server. Pet. 39 (citing Ex. 1004 ¶¶ 4 (discussing the upload of compressed video to the video server “which may be the same server as the e-mail server”), 17, claim 5).

Further, as explained above in connection with the “associating” limitation of claim 1, Petitioner asserts that “Smith discloses a system similar to Saffer that uses a URL inserted in an email message to deliver a file to a recipient.” *Id.* at 31 (citing Ex. 1005, 14:42–49, 2:24–31, Abstract). Smith describes temporary, dynamically generated private URLs known as PURLs. Ex. 1005, Abstract, 15:8–9. “PURLs enable[] secure document delivery and tracking of document receipt.” *Id.* “Petition[er] relies only on Smith’s PURL disclosures to show that it would have been obvious to adapt the features of the Smith PURL to the Saffer URL, and relies on Saffer for the transmission of the video message to the server.” Pet. 37 n.6.

Patent Owner contends that the combined teachings of the references do not teach or suggest the “transmitting” limitation. PO Resp. 37–44. Specifically, Patent Owner asserts that a person of ordinary skill in the art would have understood that by placing Saffer’s URL into the body of an

email message, that email message would now contain both the recipient address and the media content. *Id.* at 38. In addition, even if the URL were not considered to be message content it would undermine the purpose of the claims if the URL and header information were in the same message because it would not allow for the sought reduced traceability. *Id.* at 41. We address each of these arguments in turn.

First, as noted above, we construed the term “message content including a media component” in a manner that excludes a URL in a message (linking to content accessible via that URL) from the definition of the phrase. *See supra* § II.A. Thus, per our construction, Saffer’s URL is not message content, but an identifier that provides access to message content that is stored elsewhere (e.g., the video server).

Patent Owner argues that Saffer’s system sends a transmission that includes both message content and header information. PO Resp. 38. Patent Owner asserts that Namias is silent as to the transmission of header information and message content and that Saffer includes this information together as depicted in Figures 6 and 7 of Saffer. *Id.* at 43. Petitioner correctly asserts that “Patent Owner ignores how Saffer’s technique would be adapted to the Namias system as proposed by Petitioner, and attacks Saffer individually.” Reply 8. Petitioner’s proposed combination, however, does not rely on Saffer’s user interfaces or input methods, but rather it relies upon Namias’s multi-screen user interface to provide the inputs to the Saffer transmission system. Petitioner explains that Saffer describes two separate transmissions with an intervening step between the transmissions. Pet. 40. Specifically, Saffer describes uploading the compressed video to a server. *See Ex. 1002 ¶ 123* (citing *Ex. 1004 ¶ 4*). Then, the sender’s device inserts



the video ID with a link (i.e., a URL) for the uploaded video into an email message before sending the email message as a second transmission that includes the URL to access the video and the remainder of the message. *Id.* Dr. Chatterjee opines that it would have been obvious to exclude the recipient address from the first transmission “because, among other reasons, the information would have served no purpose and it would have been a waste of processing and network bandwidth to transmit it.” *Id.* ¶ 124. He further testifies that “one of ordinary skill in the art would have understood that the recipient’s email address is not uploaded in the same transmission as the video content because it is not until *later* in the process, when the email message is sent, that the recipient’s email address is uploaded.” *Id.* In addition, Dr. Chatterjee testifies that one of ordinary skill would not have included the video file in the second transmission because it had already been uploaded and there was no reason to send it a second time. *Id.* Thus, via the testimony of Dr. Chatterjee, Petitioner provides persuasive evidence, supported by evidence in the record, that one of ordinary skill in the art would have understood the cited art to teach the recited separate transmissions.

Second, Patent Owner argues that “[i]f a hacker is able to intercept a message with both the recipient address and a public URL to the media component, the hacker will be able to create a complete record of the message” and thus, the purpose of the claim invention would be frustrated. PO Resp. 41. Petitioner responds by asserting that “this ‘purpose’ is nowhere recited in the claim.” Reply 12. The specification of the ’739 patent discusses reduced traceability electronic message systems and methods. *See, e.g.*, Ex. 1001, 1:46–49. None of the challenged claims of

this patent, however, directly references “reduced traceability.” In addition, none of the challenged claims mentions traceability at all. *See id.* at 18:50–21:24 (the only reference to traceability is in claims 7 and 16, not challenged in this proceeding, which recite not including information that would provide “a traceable identity of the sender”).

Moreover, we agree with Petitioner that Patent Owner “ignores that Petitioner’s *proposed combination* . . . includes the Smith reference (entitled ‘*Private, Trackable URLs for Directed Document Delivery*’), which discloses specific protections against unauthorized access of data through a URL.” Reply 12 (citing Ex. 1002 ¶¶ 116–17). As noted above, Smith describes temporary, dynamically generated private URLs known as PURLs. Ex. 1005, Abstract, 15:8–9. As described in Smith, “[e]ach private URL (‘PURL’) uniquely identifies an intended recipient of a document, the document or set of documents to be delivered, and (optionally) other parameters specific to the delivery process. The intended recipient of a document uses the PURL to retrieve the document.” *Id.* at 2:25–31. As such, Smith’s system “allows the directed and secure distribution of documents.” *Id.* at 3:29–30. Thus, contrary to Patent Owner’s arguments, the proposed combination does not include public URLs. Therefore, even if the claims included the “purpose” alleged by Patent Owner, the proposed combination has safeguards by way of Smith’s PURLs to provide additional security to the URLs.

For the foregoing reasons, we are persuaded by Petitioner’s argument that the combination of Saffer, Namias, and Smith teaches this limitation.

g. “*the first message content including a media component not being accessible by the sending user for display via the sending user device after said transmitting the media component to the server computer*”

Petitioner relies on Namias to teach this limitation. Pet. 41. As described in Namias, a payment screen is presented to the user after the user has submitted the recipient email address(es) on the address screen. *Id.* (citing Ex. 1003 ¶¶ 28, 41–42, 65–67, 69). After payment has been made, the user is presented with a final screen (Ex. 1003, Fig. 7) that “contains text communicating that the video e-mail message has been sent and the transaction has been completed.” Pet. 42 (citing Ex. 1003 ¶ 42). The final screen is displayed for a predetermined amount of time and then, upon the expiration of that time, the kiosk returns to the inactive screen. *Id.* (citing Ex. 1003 ¶ 68). Dr. Chatterjee testifies that

neither the final screen 700 nor the inactive screen 200 allows a user to ‘access[]’ the transmitted video or picture content ‘for display.’ As a practical matter, moreover, it would have been obvious to implement Namias in this fashion because the video and picture content can consume large amounts of data, and thus, would preferably be removed from kiosk storage after they are transmitted as they are no longer needed.

Ex. 1002 ¶ 136 (emphases omitted). We agree with Petitioner’s arguments as set forth in the Petition.

*h. Motivation to Combine*

Petitioner contends that it would have been obvious to combine the teachings of Namias and Saffer, for example, because the combination would have had the predictable result of the message system of Namias handing over control to the transmission method described in Saffer, with various advantages to doing so. Pet. 27. Dr. Chatterjee opines that “[u]nder this combination, therefore, the kiosk in Namias would send the video

message [by] obtaining a video ID from the video server, renaming and uploading the video file to the video server, inserting a URL into the email message body that includes the video ID, and uploading the email message to the email server.” Ex. 1002 ¶ 92. Dr. Chatterjee further testifies that Namias does not provide details as to the method of transmission and “[i]t would thus have been obvious that the video message transmission system of Saffer could take over where Namias leaves off, resulting in a combined system that uses the Namias user interface (e.g., Fig. 4A and Fig. 5) for entering the video message content and recipient address, but then uses the technique in Saffer to effectuate the actual transmission of the video message.” *Id.* ¶ 95. In addition, Dr. Chatterjee states that one of ordinary skill in the art would have recognized that Saffer’s URL-based delivery technique would have improved Namias’s use of network bandwidth and storage. *Id.* ¶ 96. According to Dr. Chatterjee, a person of ordinary skill in the art would have understood that replacing the video content in the message with a URL, as disclosed in Saffer, would have provided distinct advantages because URLs are very small and video content can use up large amounts of bandwidth and memory. *Id.* ¶ 98.

In addition, Saffer discloses allowing a user to stream video content that provides the user with quick access to the video without requiring the entire video to be downloaded prior to the start of playback. Pet. 30. According to Dr. Chatterjee, streaming “would have been particularly significant in the context of video, which typically takes up significantly more data than other types of information, and thus, takes longer to transmit over a network.” Ex. 1002 ¶ 102. Petitioner also directs us to Saffer’s discussion of optimizing the video stream for a recipient “by checking the

recipient's configuration and/or bandwidth capabilities and streaming the video based upon this detected configuration/bandwidth." Ex. 1004 ¶ 22 (cited at Pet. 30).

As to Smith, Dr. Chatterjee opines that Smith discloses a similar, but more advanced URL identifier as compared to the URL technique described in Saffer. Ex. 1002 ¶ 105. Thus, Dr. Chatterjee testifies that one of ordinary skill in the art would have been motivated to improve upon Saffer's technique with Smith's technique, for example, in order to obtain the additional features (such as validating the file and recipient identifiers) recited in Smith. *Id.*

Patent Owner asserts that Petitioner has failed to provide a reason to combine Namias, Saffer, and Smith (PO Resp. 25–30) and Petitioner has failed to consider the references as whole in making this combination (*id.* at 30–37). We address each of these arguments in turn.

First, Patent Owner contends that "Petitioner's stated reason for combining Namias and Saffer is 'network bandwidth and storage are conserved.' . . . But there is no practical scenario where Saffer's link-based email transmission system conserves bandwidth or storage." *Id.* at 26. Further, "[e]ven under Saffer's distribution system, the kiosk in Namias would still have to transmit the recorded video to the video server, requiring use of the bandwidth that was supposedly saved by implementing Saffer." *Id.* (citing Ex. 1004 ¶ 27). Patent Owner also argues that "Petitioner does not identify why the proprietor of the Namias kiosk would be concerned with such bandwidth savings." *Id.* at 28 (citing Pet. 29–31). In the end, according to Patent Owner, bandwidth saving are "only realized if the recipient never watches the video in its entirety." *Id.* (citing Ex. 2009 ¶ 91).

Petitioner responds by asserting that “the combination of Namias and Saffer would have provided significant advantages with respect to at least (1) network bandwidth, (2) storage, and (3) the ability to stream the video message content to the recipient.” Reply 1 (citing Pet. 29–31; Ex. 1002 ¶¶ 96–103). In particular, Petitioner contends that Patent Owner has ignored the benefits that would flow from allowing the recipient to stream the video. *Id.* at 2. Dr. Chatterjee explains “that streaming is a beneficial way of delivering video to a recipient that provides benefits over sending a video file as an email attachment.” Ex. 1043 ¶ 8. “For example, in a streaming implementation, a user could begin playing back streaming video as the content is being received, rather than having to wait until the entire video file has been received.” Ex. 1002 ¶ 102. In addition, streaming techniques “can be ‘optimized to stream the video to the recipient computers 12 in a manner that can most easily viewed by the recipient’s computers 12.’” *Id.* ¶ 103 (quoting Ex. 1004 ¶ 22). As such, Dr. Chatterjee opines that “[o]ne of ordinary skill in the art would have appreciated that Saffer’s streaming delivery technique would have thus allowed a more optimized delivery of video content to the recipient device.” *Id.* Dr. Chatterjee also states that “[t]hese benefits apply regardless of whether the recipient watches all, or only part, of the received video content.” Ex. 1043 ¶ 8.

In its Sur-Reply, Patent Owner argues that “streaming adds no benefit within the context of the claimed invention and the specific combination proposed by Petitioner.” Sur-Reply 2. According to Patent Owner, streaming does not save bandwidth or storage because the same video file must be uploaded to the server and then provided to the user. *Id.* at 3–4. “In fact, Saffer’s streaming technique actually increases storage requirements, as

streaming requires the video to be stored on the video server indefinitely (in case the recipient wants to view the video in the future).” *Id.* at 4 (citing Ex. 2009 ¶ 95). Dr. Almeroth testifies that implementing Namias’s system with streaming “would significantly increase the cost of the system” because it “would require an additional video server with a large storage capacity to store all the videos uploaded by the various video email kiosks.” Ex. 2009 ¶ 95.

We disagree with Patent Owner. As outlined above, Petitioner and Dr. Chatterjee provide a rational explanation, supported by evidence in the record, for the combination of the cited references. As we noted previously, under Federal Circuit precedent, obviousness “does not require that the motivation be the *best* option, only that it be a *suitable* option from which the prior art did not teach away.” *PAR Pharm.*, 773 F.3d at 1197–98. Here, Petitioner has provided evidence from Saffer and the testimony of Dr. Chatterjee that establishes that one of ordinary skill in the art would have been aware of benefits to streaming video. Patent Owner, for example, does not dispute Petitioner’s evidence that a video stream may be optimized for a particular recipient. *See, e.g.*, Ex. 1043 ¶ 8.

Petitioner further argues that “Patent Owner’s argument myopically focuses only on the ‘first leg’ of the transmission from the sending device to the server, and ignores the substantial bandwidth and storage benefits achieved for subsequent transmission from the server to the recipient device.” Reply 4. Petitioner contends that one of skill in the art would envision many scenarios in which bandwidth would be saved. Tr. 20:20–21:11. Dr. Chatterjee quotes a reference that noted a benefit of linking the message content with a URL is that “the recipients can decide when and if

they want to receive one or more of the attachments . . . advantageously reducing [either data] traffic resulting from email attachments in general or reducing instantaneous data traffic that typically results from sending an email with an attachment to multiple recipients.” Ex. 1002 ¶ 99 (quoting Ex. 1006, 4:24–30). Petitioner describes a scenario in which a video is sent to a large group of recipients and only a small subset wanted to watch the video. Tr. 20:20–21:11. In that situation, bandwidth would be saved because the video would only be provided to the people that wanted to see it, as opposed to sending the video file to the entire group. *Id.* According to Petitioner, “that is a situation that is as plausible, and in fact, probably more likely than the off chance of a viral video that would require multiple viewings.” *Id.* at 21:7–8. Thus, Petitioner asserts that the proposed combination would “avoid[] the need to send a potentially large video file to the recipient(s) until they actually have a need or desire to view it.” Reply 4 (citing Ex. 1002 ¶¶ 99–100). We are persuaded by Petitioner’s argument and evidence. We determine that one of ordinary skill in the art would have seen a benefit to the combination at least in so much as it would have allowed for the optimization of the video playback experience for users in light of the user’s particular device and available Internet connection. *See* 1004 ¶ 22.

Second, Patent Owner argues that “Petitioner has cherry-picked certain aspects of various prior art references (while ignoring others) and cobbled them together into an approximation of the ’739 claims based only on improper hindsight.” PO Resp. 31. Specifically, Patent Owner asserts that one of skill in the art, upon considering the references as a whole, would not select Namias and its multi-screen email composition. *Id.* at 32. Patent Owner argues that Namias’s multi-screen is inferior to Saffer’s single email



composition screen. We disagree with this argument for reasons discussed above in relation to Petitioner's arguments regarding the recited separate displays. *See supra* § II.B.4.b.

Thus, we determine that one of ordinary skill in the art would have been motivated to use Saffer's techniques to improve the usage of bandwidth in Namias's system and to provide benefits to the end user, such as optimization of video streaming. In addition, we conclude that one of ordinary skill would have looked to Smith to provide predictable improvements to Saffer's URL system, as explained by Petitioner and Dr. Chatterjee. Thus, we find that Petitioner has put forth a sufficient showing as to a motivation to combine Namias, Saffer, and Smith.

*i. Conclusion*

Petitioner has established that the combination of Namias, Saffer, and Smith teaches all of the limitations of claim 1 and has articulated a sufficient rationale for combining the teachings of the references, with a reasonable expectation of success in making the combination. Accordingly, we determine the information and argument presented demonstrates by a preponderance of the evidence that claim 1 would have been obvious over Namias, Saffer, and Smith.

*5. Dependent Claims 4–6*

Claims 4–6 depend from claim 1. Petitioner relies on Namias to teach the additional limitations in claims 4–6. Pet. 45–46. Patent Owner does not proffer any additional argument directed to claims 4–6. *See generally* PO Resp.; *see also* Paper 14, 6 (“The patent owner is cautioned that any arguments for patentability not raised in the response will be deemed waived.”). We have reviewed Petitioner's contentions and determine that

Petitioner has shown by a preponderance of the evidence that the combination of Namias, Saffer, and Smith renders obvious the claimed subject matter of claims 4–6.

For example, claim 4 depends from claim 1 and further recites that the user device is selected from a group consisting of a personal computer, a workstation, a server, a laptop, a handheld device, a mobile telephone, a personal digital assistant, or any combination thereof. Petitioner relies upon Namias’s disclosure that the video email kiosk could be a personal computer or a workstation. Pet. 45 (citing Ex. 1003 ¶¶ 31–32). We find Petitioner’s evidence and arguments to be credible, supported by evidence in the record, and sufficient to establish the unpatentability of claim 4 and the other challenged dependent claims. Accordingly, we determine the information provided establishes by a preponderance of the evidence that claims 4–6 would have been obvious over Namias, Saffer, and Smith.

*C. Asserted Obviousness Based on Namias, Blum, Hazel, RFC 2821, and Boyce*

Petitioner contends that claims 1 and 4–6 of the ’739 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Namias, Blum, Hazel, RFC 2821, and Boyce. Pet. 46–69. Relying on the testimony of Dr. Chatterjee, Petitioner contends that the combined references teach or suggest the subject matter of the challenged claims and that a person having ordinary skill in the art would have combined the teachings of the references in the manner asserted in the Petition. *Id.*; Ex. 1002 ¶¶ 150–200. Because we determine that claims 1 and 4–6 are unpatentable under § 103(a) as obvious over the combined teachings of

Namias, Saffer, and Smith, we need not separately assess the patentability of these claims under this asserted ground.

### III. PATENT OWNER'S MOTION TO EXCLUDE

Patent Owner filed a Motion to Exclude Exhibits 1050 and 1051 as lacking authentication as required by Federal Rule of Evidence 901. Paper 34, 2–3. Exhibits 1050 and 1051 are cited in Dr. Chatterjee's Reply Declaration. Ex. 1043 ¶ 42. We need not determine the admissibility of Exhibits 1050 and 1051 because we do not rely on them in making our determinations here. Thus, Patent Owner's Motion is moot.

### IV. CONCLUSION

Petitioner has demonstrated, by a preponderance of the evidence, that, under 35 U.S.C. § 103(a), claims 1 and 4–6 are unpatentable over Namias, Saffer, and Smith. In light of our determination of unpatentability of claims 1 and 4–6, we decline to address whether these claims also are unpatentable under 35 U.S.C. § 103(a) as obvious over Namias, Blum, Hazel, RFC 2821, and Boyce.

### V. ORDER

Accordingly, it is:

ORDERED that claims 1 and 4–6 of the '739 patent have been shown to be unpatentable; and

FURTHER ORDERED that Patent Owner's Motion to Exclude is dismissed as moot.

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

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