

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 IPR2018-00312  
Patent 9,306,885

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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 14, 2019 (Paper 43) (the “Final Written Decision”) as it relates to claims of U.S. Patent No. 9,306,885 (“the ’885 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 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.

IPR2018-00312  
U.S. Patent No. 9,306,885 B2

Date: August 12, 2019

Respectfully submitted,

By: / *Michael F. Heim* /

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**CERTIFICATION OF SERVICE**

I hereby certify that on August 12, 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 12, 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 12, 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.,  
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v.

VAPORSTREAM, INC.,  
Patent Owner.

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Case IPR2018-00312  
Patent 9,306,885 B2

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

CHAGNON, *Administrative Patent Judge*.

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

## I. INTRODUCTION

We have jurisdiction to hear this *inter partes* review under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed herein, we determine that Snap Inc. (“Petitioner”) has shown, by a preponderance of the evidence, that claims 1 and 6 (“the challenged claims”) of U.S. Patent No. 9,306,885 B2 (Ex. 1001, “the ’885 patent”) are unpatentable.

### A. Procedural History

Petitioner filed a Petition for *inter partes* review of claims 1 and 6 of the ’885 patent. Paper 2 (“Pet.”). Petitioner provided a Declaration of Sandeep Chatterjee, Ph.D. (Ex. 1002) to support its positions. Vaporstream, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 8), supported by the Declaration of Michael Shamos, Ph.D. (Ex. 2001). Pursuant to 35 U.S.C. § 314(a), on June 18, 2018, *inter partes* review was instituted on the following grounds:

whether claims 1 and 6 would have been obvious under 35 U.S.C. § 103(a) in view of Namias<sup>1</sup>, PC Magazine<sup>2</sup>, Saffer<sup>3</sup>, and Smith<sup>4</sup>; and

whether claims 1 and 6 would have been obvious under 35 U.S.C. § 103(a) in view of Namias, PC Magazine, RFC 2821<sup>5</sup>, and Hazel<sup>6</sup>.

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<sup>1</sup> U.S. Patent Appl. Pub. No. 2002/0112005 A1, published Aug. 15, 2002 (Ex. 1003).

<sup>2</sup> Neil J. Rubenking, *Disabling Print Screen*, P.C. MAGAZINE, Aug. 1988, at 450 (“PC Magazine”) (Ex. 1033).

<sup>3</sup> U.S. Patent Appl. Pub. No. 2003/0122922 A1, published July 3, 2003 (Ex. 1004).

<sup>4</sup> U.S. Patent No. 6,192,407 B1, issued Feb. 20, 2001 (Ex. 1005).

See Paper 13 (“Inst. Dec.”). Subsequent to institution, Patent Owner filed a Patent Owner Response (Paper 24, “PO Resp.”), along with a Declaration of Kevin C. Almeroth, Ph.D. (Ex. 2009) to support its positions. Petitioner filed a Reply (Paper 27, “Pet. Reply”) to the Patent Owner Response, along with a Reply Declaration of Dr. Chatterjee (Ex. 1043), and Patent Owner filed a Sur-Reply (Paper 30, “PO Sur-Reply”). Patent Owner filed a Motion to Exclude (Paper 32), to which Petitioner filed an Opposition (Paper 34).

An oral hearing was held on March 27, 2019. A transcript of the hearing is included in the record. Paper 41 (“Tr.”).

#### *B. Related Proceedings*

The parties indicate that the ’885 patent is the subject of the following district court proceeding involving Petitioner and Patent Owner:

*Vaporstream, Inc. v. Snap Inc.*, Case No. 2:17-cv-00220-MLH-KS (C.D. Cal.). Pet. 1; Paper 5, 1.

Petitioner filed nine additional petitions for *inter partes* review of various other patents owned by Patent Owner, “each of which claims priority to the same priority application as the ‘885 patent” (Paper 7, 1): Cases IPR2018-00200, IPR2018-00369, IPR2018-00397, IPR2018-00404, IPR2018-00408, IPR2018-00416, IPR2018-00439, IPR2018-00455, and IPR2018-00458. See Paper 7, 1–2; Pet. 1. *Inter partes* review was instituted in each of these proceedings.

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<sup>5</sup> *Simple Mail Transfer Protocol*, Network Working Group, Request for Comments 2821 (J. Klensin ed., AT&T Labs), published April 2001 (Ex. 1008).

<sup>6</sup> PHILIP HAZEL, EXIM: THE MAIL TRANSFER AGENT (2001) (Ex. 1011).



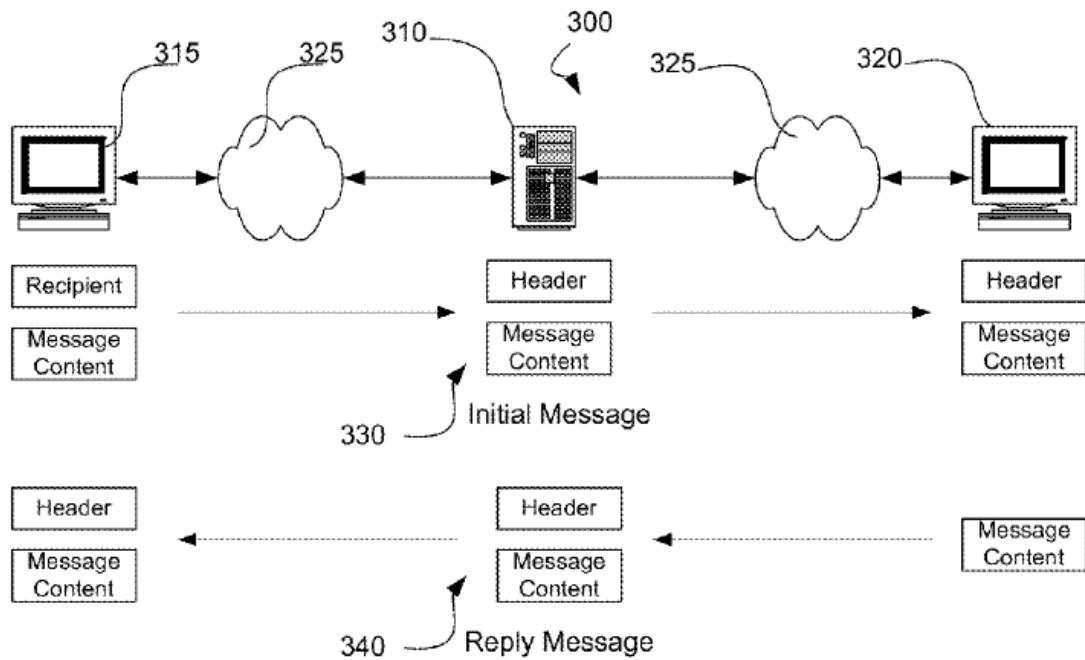
*C. The '885 Patent*

The '885 patent is titled “Electronic Message Send Device Handling System and Method with Media Component and Header Information Separation,” was filed on December 17, 2014<sup>7</sup>, and issued April 5, 2016. Ex. 1001, at [22], [45], [54]. The '885 patent relates to an electronic messaging method “with reduced traceability.” *Id.* at [57]. The '885 patent notes that “[t]ypically, an electronic message between two people is not private.” *Id.* at 2:7–8. For example, messages may be intercepted by third parties; logged and archived; or copied, cut, pasted, or printed. *Id.* at 2:8–12. “This may give a message a ‘shelf-life’ that is often uncontrollable by the sender or even the recipient.” *Id.* at 2:13–14. The challenged claims are directed to an “electronic message send device handling . . . method” for reducing traceability of an electronic message. *See id.* at 1:67–2:3, 2:27–29, 18:58–19:24, 19:45–48.

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<sup>7</sup> The '885 patent claims priority, through a chain of continuation applications, to application No. 11/401,148, filed on April 10, 2006, and provisional application No. 60/703,367, filed on July 28, 2005. Ex. 1001, at [60], [63]. The specific priority date of the challenged claims is not at issue in this proceeding, and we need not make any determination in this regard.

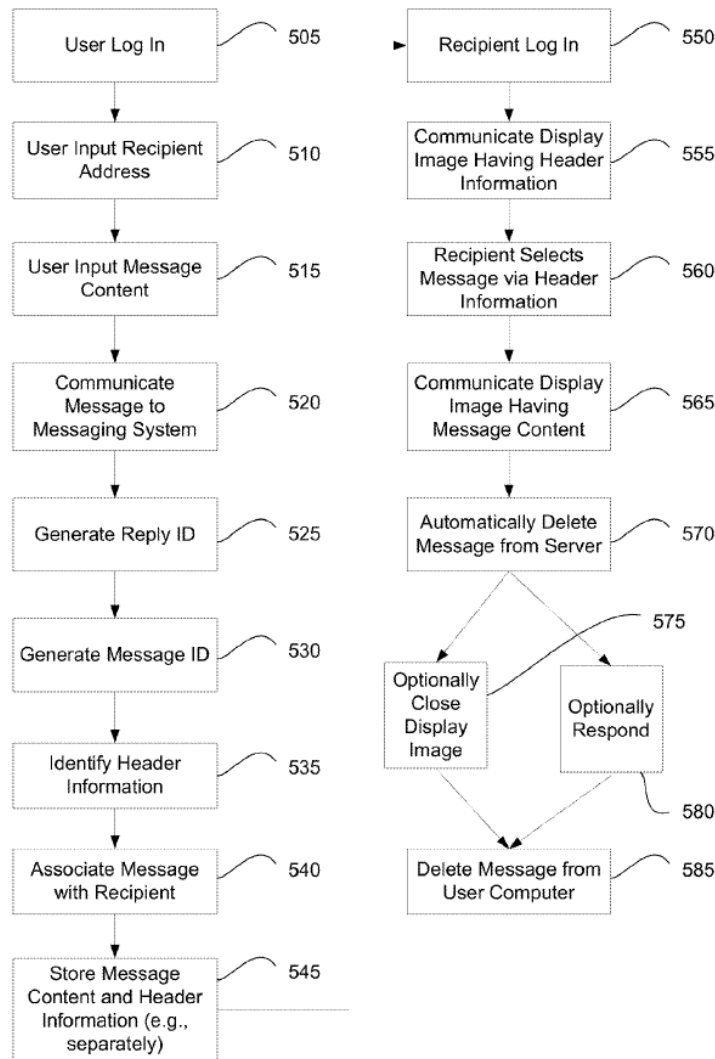
Figure 3 of the '885 patent is reproduced below:



**FIG. 3**

Figure 3, above, illustrates an example of a messaging system according to the '885 patent. *Id.* at 10:62–63. System 300 includes user computers 315, 320 and server computer 310, connected via network 325. *Id.* at 10:63–66. Electronic message 330 is communicated via this system using a method detailed below. *Id.* at 10:66–67. Reply electronic message 340 also is illustrated, but is not discussed in further detail herein. *Id.* at 10:67–11:1.

Figure 5 of the '885 patent is reproduced below:



**FIG. 5**

Figure 5, above, is a flow chart of an exemplary method of the '885 patent. Ex. 1001, 3:43–44. In step 510, the user inputs a recipient address on a screen. *See id.* at 11:41–45, 11:53–56, 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.) established specifically for use with [this] system” or it “may be a pre-established [e-mail] address, text messaging address, instant messaging address, Short Messaging Service

(SMS) address, a telephone number . . . , BLACKBERRY personal identification number (PIN), or the like.” *Id.* at 7:7–19.

After the recipient address has been entered, the system will proceed to step 515 and display another screen where the user may input the content of an electronic message. *Id.* at 11:53–60, Fig. 9. “An electronic message may be any electronic file, data and/or other information transmitted between one or more user computers.” *Id.* at 7:50–52. The electronic message may include text, image, video, audio, or other types of data. *Id.* at 7:52–60. In one embodiment, “the recipient address and the message content are entered on separate display screens.” *Id.* at 11:59–60. This separate entry “further reduces the traceability of an electronic message by, in part, reducing the ability of logging at computer 315,” for example, by preventing screenshot logging from capturing the recipient address and message content simultaneously. *Id.* at 9:20–22, 11:62–65.

At step 520, the message content is communicated to server 310. *Id.* at 12:5–8. 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 12:8–12. “[A] correlation (e.g., a non-identifying message ID . . . ) may be utilized to associate the two components.” *Id.* at 7:2–4. 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 12:37–41, 6:57–65; *see also id.* at 13:28–32 (“A message ID [is] used to maintain correspondence between the separated components of electronic message

330.”). The ’885 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 13:43–14:26.

#### *D. Challenged Claims*

We instituted review based on challenges to independent claim 1 and dependent claim 6. Claims 1 and 6 of the ’885 patent are reproduced below.

1. A computer-implemented method of handling an electronic message at a sending user device in a networked environment, the electronic message including an identifier of a recipient and a message content, the sending user device having access to electronic instructions, the electronic instructions being stored at the sending user device and/or at a server computer, the method comprising:

associating a message content including a media component with the electronic message via a first display at a sending user device;

associating an identifier of a recipient with the electronic message via a second display at the sending user device, the first and second displays being generated by the electronic instructions such that the first and second displays are not displayed at the same time via the sending user device, the electronic instructions acting on the displays at the sending user device such that the media component is not displayed with the identifier of a recipient via the second display preventing a single screen capture of both the identifier of a recipient and the media component;

transmitting the message content including a media component from the sending user device to a server computer;  
and

transmitting the identifier of a recipient from the sending user device to the server computer, said transmitting the message content including a media component and said

transmitting the identifier of a recipient occurring separately, the identifier of a recipient and the message content including a media component each including a correlation to allow the identifier of a recipient and the message content including a media component to be related to each other at a later time by the server computer.

Ex. 1001, 18:58–19:24.

6. A computer-implemented method according to claim 1, wherein the media component includes information selected from the group consisting of an image, video, audio, and any combinations thereof.

*Id.* at 19:45–48.

## II. ANALYSIS

### A. *Principles of Law*

To prevail in its challenges to the patentability of the claims, Petitioner must demonstrate by a preponderance of the evidence that the challenged claims are unpatentable. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). “In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). This burden of persuasion never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (discussing the burden of proof in *inter partes* review).

A claim is unpatentable for obviousness if, to one of ordinary skill in the pertinent art, “the differences between the subject matter sought to be

patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (quoting 35 U.S.C. § 103(a)). The question of obviousness is resolved 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 ordinary skill in the art; and (4) objective evidence of nonobviousness.<sup>8</sup> *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). An obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR*, 550 U.S. at 418; *accord In re Translogic Tech., Inc.*, 504 F.3d 1249, 1259 (Fed. Cir. 2007). However, Petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements,” but “must instead articulate specific reasoning, based on evidence of record” to support an obviousness determination. *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380–81 (Fed. Cir. 2016). Petitioner also must articulate a reason why a person of ordinary skill in the art would have combined the prior art references. *In re NuVasive*, 842 F.3d 1376, 1382 (Fed. 2016).

At this final stage, we determine whether a preponderance of the evidence of record shows that the challenged claims would have been rendered obvious in view of the asserted prior art. We analyze the asserted grounds of unpatentability in accordance with these principles.

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<sup>8</sup> The parties have not asserted or otherwise directed our attention to any objective evidence of non-obviousness.

*B. Level of Ordinary Skill in the Art*

We review the grounds of unpatentability in view of the understanding of a person of ordinary skill in the art at the time of the invention. *Graham*, 383 U.S. at 17. Petitioner contends 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. 4–5 (citing Ex. 1002 ¶¶ 13–16). Patent Owner’s declarant, Dr. Almeroth, “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 Owner’s previous declarant, Dr. Shamos, also was in general agreement with Petitioner’s description of one of ordinary skill). We agree, as the ’855 patent discusses the design of an interface that purports to reduce the traceability of electronic messages. *See, e.g.*, Ex. 1001, 1:66–3:21. In the Institution Decision, we adopted Petitioner’s proposed description of the person of ordinary skill in the art. Inst. Dec. 10–11. Based on the record developed during trial, including our review of the ’885 patent and the types of problems and solutions described in the ’885 patent and cited prior art, we agree with and adopt Petitioner’s description of the person of ordinary skill in the art, 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).

*C. Claim Construction*

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) (2018)<sup>9</sup>. “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 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” and the term “correlation.” PO Resp. 22–26. Petitioner does not seek express construction of any term of the ’885 patent, but responds to Patent Owner’s proposed constructions in its Reply. Pet. 9; Pet. Reply 1, 10–11, 22. For purposes of this Decision, we need only

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<sup>9</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. 51,340 (Oct. 11, 2018) (to be codified at 37 C.F.R. § 42).

discuss the construction of the phrase “message content including a media component.”<sup>10</sup> *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)).

Claim 1 recites various limitations pertaining to a “message content including a media component.” For example, claim 1 recites “associating a message content including a media component with the electronic message via a first display at a sending user device,” “transmitting the message content including a media component from the sending user device to a server computer,” where this transmission occurs separately from the “transmi[ssion of] the identifier of a recipient from the sending device to the server computer,” and where “the identifier of a recipient and the message content including a media component each includ[e] a correlation to allow the identifier of a recipient and the message content including a media component to be related to each other at a later time by 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. 24. In

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<sup>10</sup> We need not interpret “correlation” because Patent Owner’s arguments regarding the term pertain only to the asserted ground based on *Namias*, *PC Magazine*, *RFC 2821*, and *Hazel*, which we do not address in this Decision. *See* PO Resp. 25–26, 50–52; *infra* § II.E. Patent Owner does not dispute Petitioner’s contention that the recited “correlation” is taught by the combination of *Namias*, *PC Magazine*, *Saffer*, and *Smith*. *See* Pet. 38–44; *infra* § II.D.5.f.

support of this construction, Patent Owner relies on a passage from the '855 patent, which states that “a message content of an electronic message may include an attached and/or linked file.” Ex. 1001, 7:62–63 (cited at PO Resp. 23). Patent Owner also directs us to testimony from Petitioner’s declarant, Dr. Chatterjee. PO Resp. 24 (citing Ex. 1002 ¶ 107 n.23). Patent Owner characterizes Dr. Chatterjee’s 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. *See id.* at 22–24.

Petitioner responds by arguing that “although the specification states that [the] ‘message content’ may include a ‘linked file,’ it never states that the *link itself* is ‘message content.’” Pet. Reply 10 (internal citations omitted, emphasis Petitioner’s). In addition, Petitioner directs us to a further statement in the specification, 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, 7:66–8:3 (cited at Pet. Reply 11) (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.” Pet. Reply 11 (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 (emphasis added).

We agree with Petitioner’s arguments. The specification of the ’885 patent states that

[i]n one 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, 7:60–66. 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. In other words, the email recipient may gain access to the information or content in a variety of ways, however, the method of providing access to information or content 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 7:64–66. 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. *See* PO Resp. 24 (citing Ex. 1002 ¶ 107 n.23).

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 ¶ 107 n.23 (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 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 of this phrase is necessary for the purposes of this Decision. *See, e.g., Nidec Motor Corp.*, 868 F.3d at 1017.

*D. Asserted Obviousness in View of Namias, PC Magazine, Saffer, and Smith*

Petitioner contends that claims 1 and 6 are unpatentable under 35 U.S.C. § 103 as obvious in view of *Namias*, *PC Magazine*, *Saffer*, and *Smith*. Pet. 4, 16–50. Relying on the testimony of Dr. Chatterjee, Petitioner asserts 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 ¶¶ 52–138. Patent Owner, relying on the testimony of Dr. Almeroth, disputes Petitioner’s contentions. PO Resp. 26–50; Ex. 2009 ¶¶ 79–115. For the reasons discussed below, we determine Petitioner has established the unpatentability of these claims by a preponderance of the evidence.

*1. Overview of Namias (Ex. 1003)*

*Namias* relates 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, at [57]. The video e-mail kiosk of Namias includes 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:

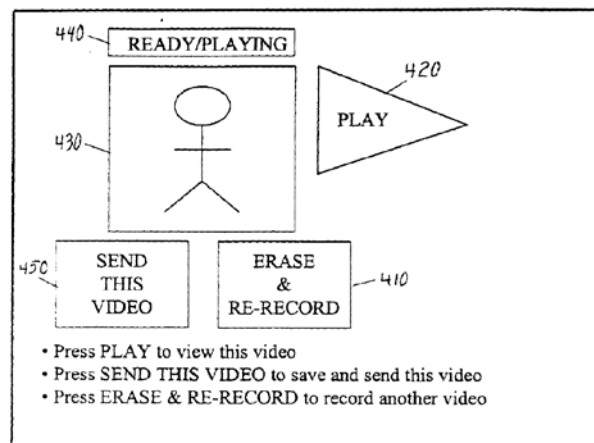


FIG. 4A

400

Figure 4A, above, illustrates “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:

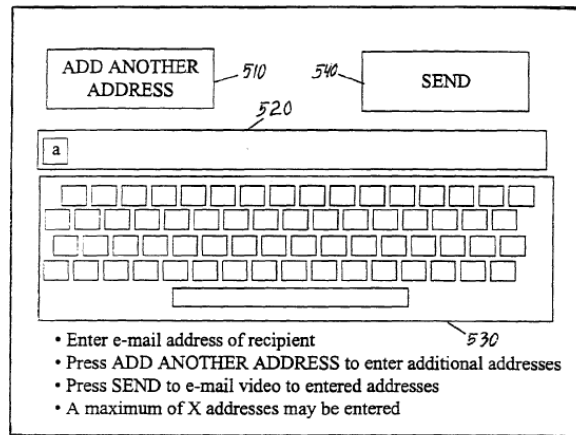


FIG. 5

Figure 5, above, illustrates an address screen on which a user is prompted to enter a recipient's e-mail 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 e-mail address of the recipient. *Id.* ¶ 40. Once the e-mail address(es) 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.

## 2. Overview of Saffer (Ex. 1004)

Saffer relates to 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, at [57]. 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, 108). 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 (Ex. 1005)

Smith relates to “[a] document delivery architecture [that] dynamically generates a private Uniform Resource Locator (URL) to distribute information.” Ex. 1005, at [57]. 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 [57], 15:8–11. 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 that 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 15:13–16. 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. Overview of PC Magazine (Ex. 1033)

PC Magazine refers to an article in PC Magazine, titled *Disabling Print Screen*. Ex. 1033, 450<sup>11</sup>. The article describes how to prevent a user from activating Print Screen functionality. *Id.*

5. Analysis of Petitioner’s Challenge to Claim 1

We begin by assessing Petitioner’s arguments as to how the combination of Namias, PC Magazine, Saffer, and Smith teaches the limitations of claim 1, and then turn to Petitioner’s arguments regarding why a person of ordinary skill in the art would have been motivated to combine the teachings of the references.

- a. *“A computer-implemented method of handling an electronic message at a sending user device in a networked environment, the electronic message including an identifier of a recipient and a message content, the sending user device having access to electronic instructions, the electronic instructions being stored at the sending user device and/or at a server computer”*

Petitioner relies on kiosk 100 of Namias as teaching the claimed “sending user device” and on the video or picture message sent using the kiosk as teaching the claimed “electronic message.” Pet. 16–17 (citing Ex. 1002 ¶ 54). Petitioner further contends that Namias discloses including “the recipient’s email address (requested from the sender)” and “the (recorded) video or picture content” as part of the video or picture message, thus teaching the claim requirement that “the electronic message includ[es] an identifier of a recipient and a message content.” *Id.* at 17 (citing

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<sup>11</sup> Citations to Exhibit 1033 are to the original pagination of the magazine.

Ex. 1003, at [57], ¶ 54; Ex. 1002 ¶ 54). According to Petitioner, “because the kiosk in Namias creates, records, and sends the video or picture message, one of ordinary skill would have understood that Namias discloses ‘handling an electronic message at a sending user device’” (*id.* (citing Ex. 1002 ¶ 55) (emphasis omitted)); Namias “makes clear” that its method is “[a] computer-implemented method” (*id.* at 17–18 (citing Ex. 1003 ¶¶ 19, 20, 22, 31–33, Fig. 1)); because the kiosk sends the message via e-mail, it is “in a networked environment” (*id.* at 18–19 (citing Ex. 1003 ¶¶ 20, 31–33)); and one of skill in the art would have understood that the processor and memory of Namias’s kiosk teaches or suggests at least electronic instructions stored at the kiosk (*id.* at 19–20 (citing Ex. 1003 ¶¶ 20, 31–33; Ex. 1002 ¶¶ 57–58)). We agree, for the reasons stated in the Petition.

*b. “associating a message content including a media component with the electronic message via a first display at a sending user device”*

Petitioner relies on Namias to teach this limitation. Pet. 20–22. Petitioner points to preview screen 400 of Figure 4A of Namias as teaching the claimed first display, via which message content (i.e., a video) is associated with the electronic message. *Id.* at 20–21 (citing Ex. 1003, at [57], ¶¶ 20, 23–29, 31–32, Figs. 2, 3, 4A, 4B, 5, 6, 7). As described in Namias, preview screen 400 appears after the sender has recorded a video, and allows the user to play the recorded video. Ex. 1003 ¶¶ 25, 36–37; Pet. 21. If the sender is satisfied with the video, pressing “SEND THIS VIDEO” button 450 saves and sends the video. Pet. 22 (citing Ex. 1003 ¶ 37, Fig. 4A; Ex. 1002 ¶ 61). Dr. Chatterjee testifies that “[b]ecause the display in Figure 4A allows the user to save previously input content for

sending via email,” Namias discloses this claim limitation. Ex. 1002 ¶ 61 (emphasis omitted); Pet. 22. We agree, for the reasons stated in the Petition.

- c. *“associating an identifier of a recipient with the electronic message via a second display at the sending user device”*

Petitioner relies on Namias to teach this limitation. Pet. 22–23. Petitioner points to address screen 500 of Figure 5 of Namias as teaching the claimed second display, via which an identifier of a recipient (i.e., a recipient’s e-mail address) is associated with the electronic message. *Id.* (citing Ex. 1003 ¶¶ 27, 40, Fig. 5; Ex. 1002 ¶ 64). As described in Namias, Figure 5 “allows the user to enter an e-mail address or addresses and thereby designate a recipient or recipients.” Ex. 1003 ¶ 40; Pet. 23. The user presses “SEND” button 540 “to email [the] video to [the] entered addresses.” Ex. 1003, Fig. 5; Pet. 23. Dr. Chatterjee testifies that these teachings of Namias disclose this claim limitation. Ex. 1002 ¶ 64. We agree, for the reasons stated in the Petition.

- d. *“the first and second displays being generated by the electronic instructions such that the first and second displays are not displayed at the same time via the sending user device, the electronic instructions acting on the displays at the sending user device such that the media component is not displayed with the identifier of a recipient via the second display preventing a single screen capture of both the identifier of a recipient and the media component”*

Petitioner relies on Namias and PC Magazine to teach this limitation. Pet. 24–29. Petitioner contends that a person of ordinary skill in the art would have understood that the electronic instructions stored at the kiosk (discussed *supra* § II.D.5.a) would have generated the first and second displays. *Id.* at 24 (citing Ex. 1003 ¶ 32; Ex. 1002 ¶ 65). Further, according

to Petitioner, “Namias makes clear that the screen corresponding to the ‘first display,’ shown in Figure 4A, and the screen corresponding to the ‘second display,’ shown in Figure 5, are not displayed at the same time.” *Id.*; *see id.* at 24–25 (citing Ex. 1003 ¶¶ 37, 40, 55, 58; Ex. 1002 ¶¶ 65–70). Petitioner continues, “because the address screen 500 displays only the recipient’s email address and not any component of the recorded picture or video, one of ordinary skill would have understood that ‘the second display prevent[s] a single screen capture of both the identifier of a recipient and the media component,’” as claimed. *Id.* at 26–27 (citing Ex. 1002 ¶ 74) (emphases omitted); *see also id.* at 25–28 (citing Ex. 1003 ¶¶ 23–29, 31–33, 40, 58–64, Fig. 5; Ex. 1002 ¶¶ 68–70, 74–85; Ex. 1001, 9:18–22, 18:6–9). Further, Petitioner contends that “nothing in Namias suggests that the kiosk even includes ‘screen capture’ functionality.” *Id.* at 28 (citing Ex. 1002 ¶ 85) (emphasis omitted). Petitioner, however, points to PC Magazine as teaching expressly that screen capture functionality, even if present in the kiosk of Namias, could be disabled easily by one of ordinary skill in the art. *Id.* at 28–29 (citing Ex. 1033, 450–451; Ex. 1002 ¶ 86).

Patent Owner contends that Namias, as modified by Saffer, does not teach or suggest that “the first and second displays are not displayed at the same time” (the “separate displays” limitation). PO. Resp. 47–50. 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 33. 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 ¶ 114; PO Resp. 48.

Petitioner responds by directing us to the Federal Circuit decision in *In re Fulton*, 391 F.3d 1195 (Fed. Cir. 2004). Pet. Reply 16. 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." Pet. Reply 18 (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 ¶ 82 (emphasis added) (cited at Pet. Reply 18); *see also id.* ¶ 31 (“The only aspects that Namias has in common with the ’885 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)); ¶ 77 (“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.’” Pet. Reply 19; *see* 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>12</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.”).

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<sup>12</sup> Theo Mandel, *The Elements of User Interface Design* (1997) (“Mandel”). Citations to Exhibit 1048 are to the original pagination of the book.

Patent Owner responds by asserting that “Petitioner has not provided any competent evidence that Namias’s multi-screen interface is simpler than Saffer’s.” PO 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 to teach the separate displays limitation of 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* PO Sur-Reply 18–19. There, Patent Owner compares Namias’s “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 4A. *See* Ex. 1003 ¶ 40. Thus, Namias’s screens are not displayed at the same time, as recited in claim 1.

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. 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 (Ex. 1048), discussing the elements of user interface design. *See* Ex. 1043 ¶ 40 (citing Ex. 1048). 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, 341 (cited at Ex. 1043 ¶ 40). 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 ’885 patent. *See* Ex. 1048, Cover, xv (emphases omitted).

In addition, we are not persuaded that Petitioner’s argument in its Reply is untimely. *See* Pet. Reply 17–19 (citing Ex. 1043 ¶¶ 36–41). As described in the Petition, Petitioner relies on Figures 4A and 5 of Namias for the separate displays limitation, noting that “the user interface in Namias uses separate displays to solicit the recipient identification and message content from the user.” Pet. 10, 24–25. Petitioner’s asserted combination with Saffer is for other claim limitations—namely the separate transmissions limitation discussed below (*infra* § II.D.5.e). Patent Owner argues in its Patent Owner Response that Petitioner failed to explain why a person of ordinary skill in the art would have chosen “the Namias interface instead of



the Saffer single composition screen.” PO Resp. 48. 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 the separate displays limitation of claim 1 of the ’885 patent.

- e. *“transmitting the message content including a media component from the sending user device to a server computer”; “transmitting the identifier of a recipient from the sending user device to the server computer, said transmitting the message content including a media component and said transmitting the identifier of a recipient occurring separately”*

Petitioner relies on Namias and Saffer to teach these limitations. Pet. 29–38. Petitioner acknowledges that, although “Namias makes clear that the system sends the video or picture message to a recipient,” it “does not disclose the detailed mechanics of how [the sending of a video to a recipient] takes place.” *Id.* at 29–30 (citing Ex. 1003 ¶ 42). Petitioner relies on Saffer as teaching these details, and in particular as teaching transmitting the message content to the server computer and transmitting the identifier of a recipient to the server computer, such transmitting steps occurring separately, as claimed. *See id.* at 29–34; Ex. 1002 ¶¶ 88–98. According to Petitioner, Saffer, like Namias, teaches a system in which a user can send

video (optionally, along with text) to an e-mail recipient. Pet. 30 (citing Ex. 1004, at [57], ¶¶ 2–3). Petitioner lays out the steps performed by Saffer, after the sender presses the “Send” button, as follows:

- (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. 30–31 (citing Ex. 1002 ¶ 89). As noted by Petitioner, “[s]teps (1)-(4) above are illustrated in Figure 3 [of Saffer (reproduced below)], which highlights in yellow Steps 100, 102, 110, and 112 from Saffer.” *Id.* at 31.

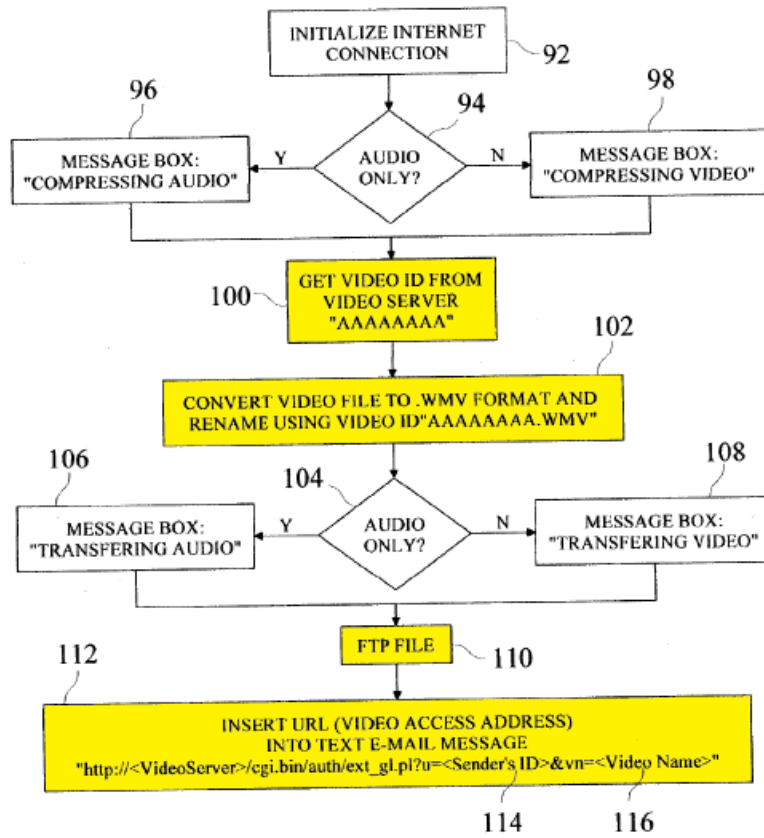
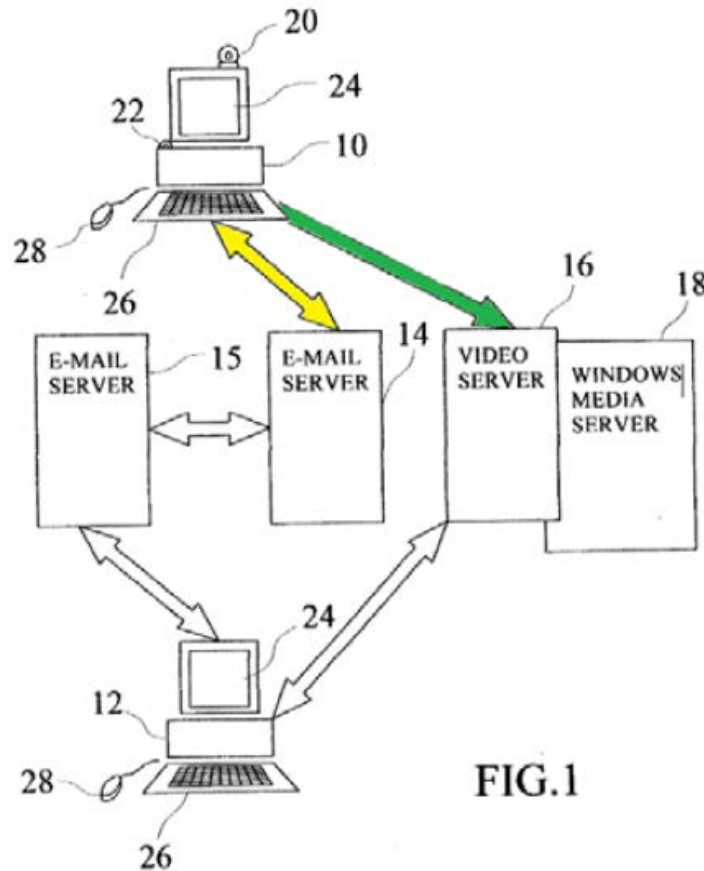


FIG.3

Figure 3 of Saffer, above, with highlighting added by Petitioner (*id.*), illustrates a flow diagram of “sending and compressing a video file to the video server with a unique ID.” Ex. 1004 ¶ 9.

Petitioner also relies on Figure 1 of Saffer, an annotated version of which is reproduced below (Pet. 34), to provide further explanation of its position.



Annotated Figure 1, above, is a block diagram of an exemplary embodiment of Saffer. Ex. 1004 ¶ 7. 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).” Pet. 34. As noted by Petitioner, the sending device of Saffer sends the e-mail message with the URL and recipient address to the email server, after uploading the video file to the server (i.e., Step 110) *and* after an intervening step of inserting the URL into the e-mail message (i.e.,

Step 112). *Id.* at 31–32 (citing Ex. 1004 ¶¶ 4, 44–47, Fig. 3; Ex. 1002 ¶¶ 90–94). As such, Petitioner argues that the cited art teaches separately transmitting the identifier of a recipient (i.e., the address) and the message content. *Id.* at 33–34. “This is because [the] transmissions . . . are separated by an intervening step, and separately conveyed to the server.” *Id.* at 33 (citing Ex. 1002 ¶¶ 94–98) (emphases omitted). Dr. Chatterjee explains

that after [a] the video content has been uploaded, there is an intervening step of [b] “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 [c] that email message, which contains the recipient’s email address in its “To:” field (Saffer, Fig. 7, ¶0024), is uploaded.

Ex. 1002 ¶ 94 (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. 32 (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).

Patent Owner asserts that the asserted combination does not teach or suggest “transmitting the message content including a media component and . . . transmitting the identifier of a recipient occurring separately” (the “separate transmissions” limitation). PO. Resp. 39–47. 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 40–41. In addition, Patent Owner argues that 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 43. We address each of these arguments in turn.

First, as noted above, we construe 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.C. 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. 40–41. 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 45. 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.” Pet. Reply 9. Petitioner’s proposed combination 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.<sup>13</sup> Pet. 24–34. Petitioner explains that Saffer describes two separate transmissions with an intervening step between the

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<sup>13</sup> Under Petitioner’s combination, the message content is “simply the video message content in Namias, with no user-provided text or other content.” Pet. 35 n.3; *see* Ex. 1002 ¶ 100. “[T]he only message content the user can input is the actual video or picture data.” Pet. 35 n.3 (citing Ex. 1003, Fig. 4A).

transmissions. *Id.* at 33–34. Specifically, Saffer describes uploading the compressed video to a server. *See* Ex. 1002 ¶ 90 (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.* ¶ 92. 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.* ¶ 93. 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 separate transmissions limitation.

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. 43. Petitioner responds by asserting that “this ‘purpose’ is nowhere recited in the claim.” Pet. Reply 13. The specification of the

'885 patent discusses systems and methods for reducing traceability of an electronic message. *See, e.g.*, Ex. 1001, 3:60–61. Neither of the challenged claims of this patent, however, directly references “reducing traceability.” In addition, none of the challenged claims mentions traceability at all. *See id.* at 18:58–22:42 (the only reference to traceability is in claims 8, 15, and 28, not challenged in this proceeding, which recite not including information that would provide “a traceable identity of the sender”).<sup>14</sup>

For the foregoing reasons, we are persuaded by Petitioner’s argument, supported by evidence in the record, that the combination of Namias and Saffer teaches these limitations.

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<sup>14</sup> 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.” Pet. Reply 13 (citing Ex. 1002 ¶¶ 133–134); *see infra* § II.D.5.f (discussing Petitioner’s reliance on the PURLs of Smith). 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 challenged claims included the “purpose” alleged by Patent Owner (which we are not persuaded that they do), the proposed combination has safeguards by way of Smith’s PURLs to provide additional security to the URLs.



*f. “the identifier of a recipient and the message content including a media component each including a correlation to allow the identifier of a recipient and the message content including a media component to be related to each other at a later time by the server computer”*

Petitioner relies on Namias, in view of Saffer and Smith, as teaching this claim limitation. *See* Pet. 38–44; Ex. 1002 ¶¶ 118, 120. In particular, Petitioner points to the video ID of Saffer, adapted according to the teachings of Smith, as teaching the claimed correlation. Pet. 38–39. As explained in the Petition, Saffer teaches “renam[ing] the file containing the video message content using the video ID” and “insert[ing] into the body of an e-mail message the video ID with a link.” *Id.* at 39–41 (citing Ex. 1004 ¶¶ 4, 9, 20, 29–46, Figs. 3, 8). Petitioner contends

it would have been obvious in further view of Smith that the video ID in the URL could be further appended with a recipient identifier (such as the recipient’s email address), thus establishing a “correlation” between (1) the recipient identifier – coupled to the video ID in the URL – and (2) the video message content – stored in a file named using the video ID.

*Id.* at 41–42 (citing Ex. 1002 ¶ 118) (emphases omitted); *see also id.* at 42–44 (citing Ex. 1005, at [57], 2:24–34, 9:1–3, 11:21–24, 14:42–53, 15:8–16, 15:37–44, 15:48–58, 16:27–43, 16:55–56, 17:12–29, Fig. 20). 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 42 (citing Ex. 1005, at [57], 2:24–31, 14:42–49). Smith describes temporary, dynamically generated private URLs known as PURLs. Ex. 1005, at [57], 15:8–9. “PURLs enable[] secure document delivery and tracking of document receipt.” *Id.* at [57].

According to Petitioner’s combination, the video ID (upon which Petitioner relies as teaching the claimed correlation) is coupled both to the message content (i.e., as the name of the file containing the message content) and to the recipient’s email address (i.e., in the URL embedded in the email sent to recipient). Pet. 45 (citing Ex. 1002 ¶ 125). Further, the

recipient’s email address (“identifier of a recipient”) in the URL and the video message content (“message content including a media component”) stored at the server are “related to each other . . . by the server computer” during the subsequent delivery of the video message content from the server to the recipient (“at a later time”).

*Id.* at 47 (emphases omitted); *see id.* at 47–48; Ex. 1002 ¶¶ 128–129.

We agree that Namias, in view of Saffer and Smith, teaches this claim limitation, for the reasons stated in the Petition.

*g. Reasons to Combine the Asserted References*

Petitioner asserts that the combination of Namias and Saffer, resulting in “the video message system of Namias in which, after the user approves the video message and enters the recipient addresses (using the displays in Figure 4A and 5 of Namias, respectively), the system hands over control to the method of Saffer to transmit the video message to a server using the technique described” in Saffer, would have been a “straightforward combination for a number of reasons.” Pet. 35 (citing Ex. 1002 ¶¶ 99, 101). 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. *Id.* at 34–35. Dr. Chatterjee opines that

“[u]nder this combination, therefore, the recipient’s email address and the video (or picture) message content [as entered using the displays in Figures 4A and 5 of Namias] would be transmitted to a server computer separately according to the techniques of Saffer.” Ex. 1002 ¶ 99.

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 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.* ¶ 102. 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.* ¶ 103. 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 “typically only a handful of characters in length” and, thus, the message containing the URL would “consume[] very little network bandwidth and storage,” “whereas video content can be quite large.” *Id.* ¶ 105.

In addition, Saffer discloses that allowing a user to stream video content provides the user with quick access to the video without requiring the entire video to be downloaded prior to the start of playback. Pet. 37–38; Ex. 1002 ¶¶ 108–110; Ex. 1004 ¶¶ 2, 6, 19, 22. 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 ¶ 109. 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. 37–38).

Patent Owner asserts that Petitioner has failed to provide a reason to combine Namias and Saffer (PO Resp. 26–31) and Petitioner has failed to consider these references as whole in making this combination (*id.* at 31–39).<sup>15</sup> We address each of these arguments in turn.

First, Patent Owner argues 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 27 (quoting Pet. 37). 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 contends that “Petitioner does not identify why the proprietor of the Namias kiosk would be concerned with such bandwidth savings.” *Id.* at 29 (citing Pet. 36–38). 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 ¶ 87).

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<sup>15</sup> Patent Owner’s arguments against Petitioner’s reasons to combine do not address the additional combination with PC Magazine or Smith, apart from a general argument that Petitioner asserts a “complex concoction of prior art teachings from multiple unrelated references” (PO Resp. 3).

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.” Pet. Reply 2 (citing Pet. 36–38; Ex. 1002 ¶¶ 103–110). In particular, Petitioner contends that Patent Owner has ignored the benefits that would flow from allowing the recipient to stream the video. *Id.* at 2–3. 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 ¶ 109. 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.* ¶ 110 (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.” PO 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.

According to Patent Owner, “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 ¶ 91). 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 ¶ 91.

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.*” Pet. 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:

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 ¶ 106 (quoting Ex. 1006<sup>16</sup>, 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 21:7–9. 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.” Pet. Reply 5 (citing Ex. 1002 ¶¶ 106–107). 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* Ex. 1004 ¶ 22.

Second, Patent Owner argues that “Petitioner has cherry-picked certain aspects of various prior art references (while ignoring others) and

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<sup>16</sup> Naick et al., U.S. Patent No. 7,409,425 B2, filed Nov. 13, 2003, issued Aug. 5, 2008.

cobbled them together into an approximation of the '885 claims based only on improper hindsight.” PO Resp. 33. 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 interface. *Id.* at 35. Patent Owner argues that Namias’s multi-screen interface 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 separate displays limitation. *See supra* § II.D.5.d.

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. Thus, we find that Petitioner has put forth a sufficient showing as to a motivation to combine Namias and Saffer.

As to PC Magazine, Dr. Chatterjee opines that “nothing in Namias . . . suggests that the kiosk even includes ‘screen capture’ functionality,” but that, as evidenced by PC Magazine, “[o]ne of ordinary skill in the art would have been motivated to disable any existing screen capture functionality because . . . the kiosk does not provide any way of accessing or use for the output of a screen capture,” and “disabling [any possible screen capture] functionality outright would prevent any accidental and inconsequential triggering of that functionality, which would only unnecessarily divert resources of the kiosk, including memory and processing power, from the kiosk’s intended purpose of video messaging.” Ex. 1002 ¶¶ 85–86 (cited at Pet. 28–29). We agree with Petitioner for the reasons stated in the Petition.

As to Smith, Dr. Chatterjee opines that Saffer and Smith disclose “very similar techniques for delivering content through the use of URLs



embedded in email messages.” Ex. 1002 ¶ 130 (cited at Pet. 48–49). Dr. Chatterjee testifies that one of ordinary skill in the art would have been motivated to improve upon Saffer’s use of a video ID by further appending a recipient identifier (as in Smith’s PURL), in order to obtain the additional benefits of tracking and security described in Smith. *Id.* ¶ 131 (citing Ex. 1005, at [57], 14:36–41); Pet. 48–49. We conclude that one of ordinary skill would have looked to Smith to provide such improvements to Saffer’s URL system, utilized in combination with Namias, as explained by Petitioner and Dr. Chatterjee. We agree with Petitioner for the reasons stated in the Petition.

#### *h. Conclusion*

Petitioner has established that the combination of Namias, PC Magazine, 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 presented demonstrates, by a preponderance of the evidence, that claim 1 would have been obvious over Namias, PC Magazine, Saffer, and Smith.

#### *6. Dependent Claim 6*

Claim 6 depends from claim 1. Petitioner relies on Namias to teach the additional limitations of claim 6. Pet. 50. Patent Owner does not include any additional arguments directed to claim 6. *See generally* PO Resp.; *see also* Paper 14, 5 (“The patent owner is cautioned that any arguments for patentability not raised in the response will be deemed waived.”). Claim 6 recites “wherein the media component includes information selected from

the group consisting of an image, video, audio, and any combinations thereof.” Ex. 1001, 19:45–48. Namias discloses the “e-mail message ha[s] the recorded video and audio segments or snapshot as the body of the message.” Ex. 1003 ¶ 33 (cited at Pet. 50). We find Petitioner’s evidence and arguments to be credible, supported by evidence in the record, and sufficient to establish the unpatentability of claim 6. Accordingly, we determine the information provided establishes by a preponderance of the evidence that claim 6 would have been obvious over Namias, PC Magazine, Saffer, and Smith.

*E. Asserted Obviousness in View of Namias, PC Magazine, RFC 2821, and Hazel*

Petitioner contends that claims 1 and 6 are unpatentable under 35 U.S.C. § 103 as obvious in view of Namias, PC Magazine, RFC 2821, and Hazel. Pet. 4, 50–69. 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 ¶¶ 139–171. Because we determine that claims 1 and 6 are unpatentable under § 103(a) as obvious over the combined teachings of Namias, PC Magazine, 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 32, 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 6 are unpatentable over Namias, PC Magazine, Saffer, and Smith. In light of our determination of unpatentability of claims 1 and 6, we decline to address whether these claims also are unpatentable under 35 U.S.C. § 103(a) as obvious over Namias, PC Magazine, RFC 2821, and Hazel.

#### V. ORDER

Accordingly, it is

ORDERED that claims 1 and 6 of U.S. Patent No. 9,306,885 B2 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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Patent 9,306,885 B2

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