

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SNAP INC.,
Petitioner

v.

VAPORSTREAM, INC.,
Patent Owner

Cases IPR2018-00439
U.S. Patent No. 9,413,711 B2

**PETITIONER SNAP INC.'S
NOTICE OF APPEAL**

INTRODUCTION

Petitioner Snap Inc. (“Petitioner”) appeals from the Patent Trial and Appeal Board’s Final Written Decision entered on August 1, 2019 (Paper 43) (the “FWD”) in the above-captioned *inter partes* review of United States Patent No. 9,413,711 B2. This notice is timely filed within 63 days of the FWD. 37 C.F.R. § 90.3(a)(1).

PETITIONER'S APPEAL

Please take notice that under 35 U.S.C. §§ 141(c), 142, 319 and 37 C.F.R. §§ 90.2(a), 90.3(a), Petitioner hereby appeals to the United States Court of Appeals for the Federal Circuit from the FWD, including all underlying orders, decisions, rulings, and opinions related thereto or subsumed therein.

PETITIONER'S ISSUES ON APPEAL

In accordance with 37 C.F.R. § 90.2(a)(3)(ii), Petitioner’s issues on appeal include at least: (i) the Board’s finding that claim 13 has not been shown to be unpatentable under 35 U.S.C. § 103 over the combination of Namias, Wren, Fardella, Stevenson, Yuan, RFC 2821, and Hazel; and (ii) any findings or determinations supporting or related to the aforementioned issues in any orders, decisions, rulings, phone conference decisions, and/or opinions.

Simultaneous with this submission, Petitioner is filing a true and correct copy of this Notice of Appeal with the Director of the United States Patent and Trademark Office and a true and correct copy of the same, along with the required docketing

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fee, with the Clerk of the United States Court of Appeals for the Federal Circuit as set forth in the accompanying Certificate of Filing.

Dated: September 17, 2019

Respectfully submitted,

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CERTIFICATE OF FILING

Pursuant to 37 C.F.R. §§ 90.2(a)(1) and 104.2(b), the undersigned hereby certifies that on September 17, 2019, the original of the foregoing Notice of Appeal was filed with the Director of the United States Patent and Trademark Office **by hand-delivery**, at the following address:

Director of the United States Patent and Trademark Office
c/o Office of the General Counsel
10B20, Madison Building East
600 Dulany Street
Alexandria, VA 22313-5793

In addition, pursuant to 37 C.F.R. §§ 42.6(b) and 90.2(a)(1), the undersigned certifies that on September 17, 2019, a copy of the foregoing Notice of Appeal was filed **electronically** with the Board through the Board's E2E system.

Further, pursuant to 37 C.F.R. § 90.2(a)(2) and Federal Circuit Rule 15(a)(1), this undersigned certifies that on September 17, 2019, the requisite fee for the appeal and a true and correct copy of the foregoing Notice of Appeal was electronically filed with the Clerk of Court of the United States Court of Appeals for the Federal Circuit at the following address: <http://ecf.cafc.uscourts.gov>.

Respectfully submitted,

/s/ Heidi L. Keefe
Heidi L. Keefe
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CERTIFICATION OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e)(4) and 90.2(a)(3)(ii), the undersigned certifies that on September 17, 2019, a true and correct copy of the foregoing Notice of Appeal was electronically served on the patent owner by serving the correspondence email addresses of record below:

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DATED: September 17, 2019

ATTACHMENT 1

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SNAP INC.,
Petitioner,

v.

VAPORSTREAM, INC.,
Patent Owner.

Cases IPR2018-00416 and IPR2018-00439
Patent 9,413,711 B2

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

Snap Inc., (“Petitioner”) filed two Petitions requesting *inter partes* review of claims 1, 4–6, 11, 13, 15, and 16 of U.S. Patent No. 9,413,711 B2 (Ex. 1001,¹ “the ’711 patent”) in IPR2018-00416 and IPR2018-00439. Paper 2 (“Pet.”). In each proceeding, Vaporstream Inc. (“Patent Owner”) filed a Patent Owner Response, Petitioner filed a Reply, and Patent Owner filed a Sur-Reply, as listed in the following chart.

Case	Claim(s)	Institution Decision	Petition	Response	Reply	Sur-Reply
IPR2018-00416	1, 4–6, 11, 15, and 16	Paper 10 (“Dec.”)	Paper 2 (“Pet.”)	Paper 20 (“PO Resp.”)	Paper 24 (“Reply”)	Paper 26 (“Sur-Reply”)
IPR2018-00439	13	Paper 10 (“439 Dec.”)	Paper 2 (“439 Pet.”)	Paper 20 (“439 PO Resp.”)	Paper 26 (“439 Reply”)	Paper 28 (“439 Sur-Reply”)

As to the 439 Proceeding, Patent Owner also filed a Motion to Amend (439 Paper 21, “Mot.”), Petitioner filed an Opposition (439 Paper 24), Patent Owner filed a Reply (439 Paper 29), and Petitioner filed a Sur-Reply (439 Paper 35). A combined oral hearing was held on April 17, 2019, and a transcript of the hearing is included in the record (Paper 34, “Tr.”).

IPR2018-00416 and IPR2018-00439 involve the same challenged patent and parties, and there is overlap in the evidence submitted by the

¹ Unless otherwise specified with the prefix “439,” we refer to papers and exhibits filed in IPR2018-00416.

parties.² To administer the proceedings more efficiently, we exercise our authority under 35 U.S.C. § 315(d) to consolidate the two proceedings for purpose of issuing one final written decision.

We have jurisdiction 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 not shown by a preponderance of the evidence that claims 1, 4–6, 11, 13, 15, and 16 of the '711 patent are unpatentable.

A. Related Matters

The parties indicate that the '711 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.). *See* Pet. 1; Paper 3, 1. Petitioner filed eight additional petitions for *inter partes* review of various related patents owned by Patent Owner in IPR2018-00200, IPR2018-00312, IPR2018-00369, IPR2018-00397, IPR2018-00404, IPR2018-00408, IPR2018-00455, and IPR2018-00458. *See* Pet. 1–2; Paper 3, 1–3. *Inter partes* review was instituted in each of these proceedings.

B. The '711 Patent

The '711 patent is directed to “[a]n electronic messaging system and method with reduced traceability.” Ex. 1001, Abstract. As noted in the '711 patent specification, “[t]ypically, an electronic message between two people is not private.” *Id.* at 1:45–46. Messages may be intercepted by third

² The parties’ arguments and evidence are substantially identical between the two proceedings as relates to the issues discussed in this Final Written Decision. We will highlight any areas where the parties made additional or different arguments between the two proceedings.

parties; logged and archived; or copied, cut, pasted, or printed. *Id.* at 1:46–51. “This may give a message a ‘shelf-life’ that is often uncontrollable by the sender or even the recipient.” *Id.* at 1:51–52.

Figure 3 of the '711 patent is reproduced below.

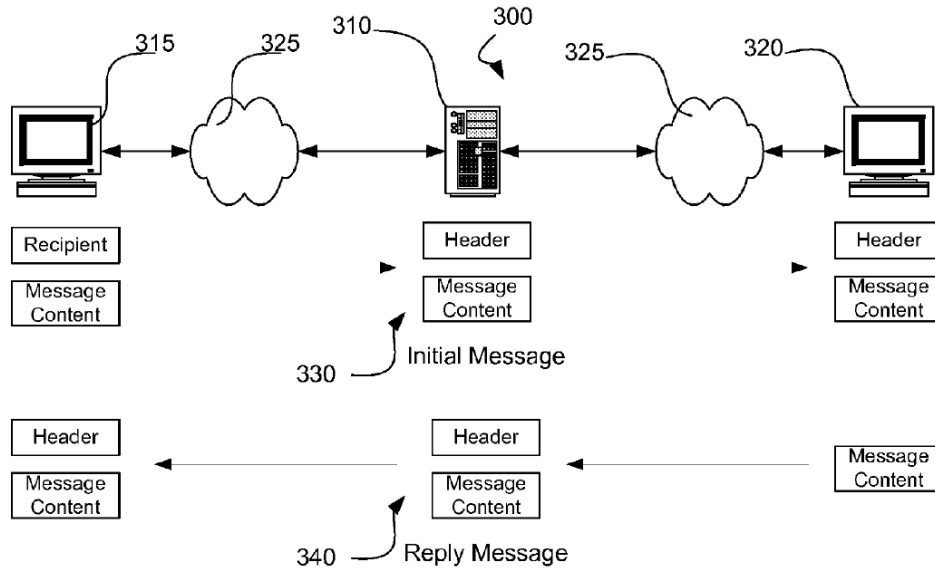


FIG. 3

Figure 3 depicts an example of the '711 patent's messaging system. *Id.* at 4:20–22. System 300 includes user computers 315, 320 and server computer 310, connected via network 325. *Id.* at 12:3–6. Electronic message 330 is communicated via this system using a method detailed below. *Id.* at 12:6–7, 12:17–19. Reply electronic message 340 also is illustrated, but is not discussed in further detail herein. *Id.* at 12:7–10.

Figure 5 of the '711 patent is reproduced below.

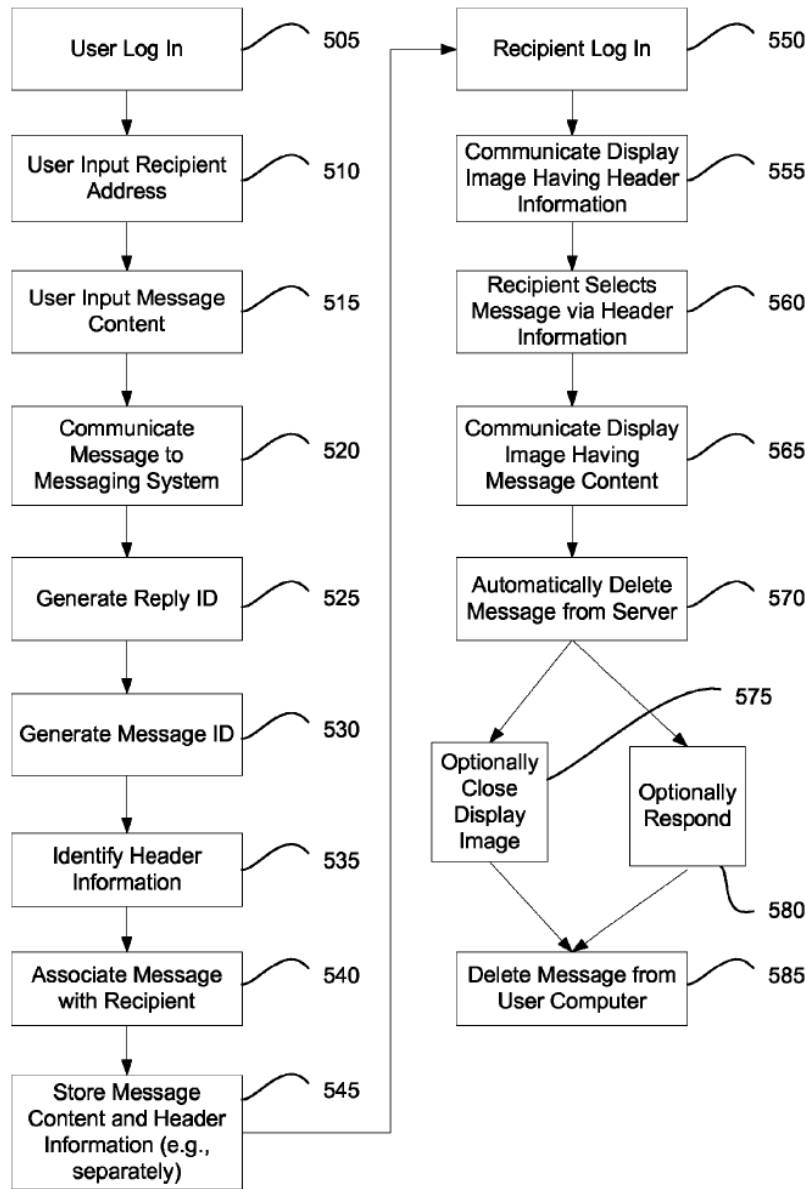


FIG. 5

Figure 5 is a flow chart depicting an exemplary method of the '711 patent. *Id.* at 4:26–27. In step 510, the user inputs the recipient's address on a screen. *See id.* at 12:48–50, 12:60–63, 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 8:19–26.

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 12:63–66, Fig. 9. “An electronic message may be any electronic file, data, and/or other information transmitted between one or more user computers.” *Id.* at 8:56–58. The electronic message may include text, image, video, audio, or other types of data. *Id.* at 8:58–66. In one embodiment, “the recipient address and the message content are entered on separate display screens.” *Id.* at 12:66–67. 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 10:25–29, 13:2–5.

At step 520, the message content is communicated to the server. *Id.* at 13:12–15. 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 13:15–19. “[A] correlation (e.g., a non-identifying message ID . . .) may be utilized to associate the two components.” *Id.* at 8:6–10; *see also id.* at 9:23–27 (“Utilizing a message ID associated with an electronic message, such as electronic message 105, system 100 may handle (e.g., store, deliver, display, etc.) a header information and a message content of a particular electronic message separately with the ability to correlate the two at a later time.”). In this regard, “at step 530, system 300 generates a message ID for associating the separated message content and header information of

electronic message 330. Server 310 maintains a correspondence between the message content and header information.” *Id.* at 13:44–48; *see also id.* at 9:15–17 (“A message ID is used to associate a container (i.e., header) information with a corresponding separately-stored message content.”). The ’711 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 14:45–15:34.

To retrieve the message, the recipient first logs in to the system at step 550. *Id.* at Fig. 5, 15:35–37. At step 555, the server communicates to the recipient user computer a display image showing header information for multiple messages. *Id.* at 15:41–43, Fig. 10. For example, the display image may show a display name and date/time for each message, but not show the content itself for any of the messages. *Id.* In one embodiment, the header information may include “a sequence number (ex: 1, 2, 3, etc.) assigned to each electronic message,” where each sequence number is associated with a corresponding message ID for the respective message. *Id.* at 9:29–33, 15:63–67. At step 560, the user selects one of the electronic messages to be displayed by, for example, selecting a “read” link displayed with the respective header information. *Id.* at 16:7–10. At step 565, the server communicates to the recipient user computer a display image with the content of the chosen message (but not header information for the message). *Id.* at 16:29–31, Fig. 11. At step 570, the message is automatically and permanently deleted from the server at a predetermined time. *Id.* at 16:55–57. At step 575, the user closes the display image, returns to the message listing, or chooses to respond to the message. *Id.* at 17:44–47. At step 585,

the message content is automatically deleted from the recipient user computer after viewing. *Id.* at 17:53–56.

C. *Claims at Issue*

Petitioner challenges claims 1, 4–6, 11, 13, 15, and 16 of the '711 patent, of which claim 1 is the sole independent claim. Claim 1 is reproduced below:

1. A method of handling an electronic message between a sending user device and a recipient user device in a networked environment, the method comprising:

providing a first reduced traceability electronic messaging application program to a sending user device, the first reduced traceability electronic messaging application program including instructions executable by a first processor of the sending user device to provide a first plurality of reduced traceability displays via the sending user device;

providing a second reduced traceability electronic messaging application program to a recipient user device, the second reduced traceability electronic messaging application program including instructions executable by a second processor of the recipient user device to provide a second plurality of reduced traceability displays via the recipient user device;

receiving an electronic message at a server via a first network, the electronic message sent from the sending user device, wherein the electronic message received at the server includes an identifier of a recipient and a message content including a media component, the first plurality of reduced traceability displays including a first display and a second display, the first display configured to allow a user of the sending user mobile device to associate the message content including a media component with the electronic message, the second display configured to allow the user of the sending user mobile device to associate the identifier of a recipient with the electronic message, the

instructions executable by the first processor providing the first and second displays such that the identifier of the recipient is not displayed with the media component via the first display preventing a single screen capture of both the identifier of a recipient and the media component; and transmitting the electronic message from the server to the recipient user device via a second network that includes a wireless communications portion, wherein the electronic message transmitted to the recipient user device includes an identifier of a sending user and the message content including a media component, the second plurality of reduced traceability displays including a third display and a fourth display, the third display presenting the identifier of a sending user, the fourth display presenting the media component, the instructions executable by the second processor providing the third and fourth displays such that the identifier of a sending user is not displayed with the media component via the fourth display preventing a single screen capture of both the identifier of a sending user and the media component, wherein the identifier of a recipient and the message content received at the server each optionally include a correlation to allow the server to receive the identifier of a recipient and the message content separately and to relate the identifier of a recipient to the message content if the identifier of a recipient is received separately from the message content at the server, and wherein the identifier of a recipient and the message content transmitted from the server each optionally include a correlation to allow the identifier of a recipient and the message content to be related to each other by the second reduced traceability electronic messaging application program if the identifier of a recipient and the message content are transmitted from the server separately.

Id. at 24:8–25:4.

D. *Instituted Grounds of Unpatentability*

The instant consolidated *inter partes* review involves the following grounds of unpatentability:

References	Basis	Claim(s) Challenged
Namias, ³ Wren, ⁴ Fardella, ⁵ Stevenson, ⁶ and Yuan ⁷	§ 103	1, 4–6, and 11
Namias, Wren, Fardella, Stevenson, Yuan, and Thorne ⁸	§ 103	15 and 16
Namias, Wren, Fardella, Stevenson, Yuan, RFC 2821, ⁹ and Hazel ¹⁰	§ 103	13

E. *Person of Ordinary Skill in the Art*

On behalf of Petitioner, Sandeep Chatterjee, Ph.D., 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

³ U.S. Patent Pub. No. 2002/0112005 A1 (published Aug. 15, 2002) (Ex. 1003, “Namias”).

⁴ U.S. Patent Pub. No. 2005/0021803 A1 (filed June 9, 2003) (Ex. 1004, “Wren”).

⁵ U.S. Patent Pub. No. 2001/0032246 A1 (published Oct. 18, 2001) (Ex. 1005, “Fardella”).

⁶ Nancy Stevenson, *Tablet PCs for Dummies* (2003) (Ex. 1006, “Stevenson”).

⁷ Michael Juntao Yuan, *Enterprise J2ME: Developing Mobile Java Applications* (2004) (Ex. 1007, “Yuan”).

⁸ U.S. Patent No. 5,958,005 (issued Sept. 18, 1999) (Ex. 1008, “Thorne”).

⁹ *Simple Mail Transfer Protocol (SMTP)*, Request for Comments (RFC) 2821, Apr. 2001 (439 Ex. 1022, “RFC 2821”).

¹⁰ Philip Hazel, *Exim: The Mail Transfer Agent* (2001) (439 Ex. 1024, “Hazel”).

network, such as the Internet (or equivalent degree or experience).” Pet. 6–7 (citing Ex. 1002 ¶¶ 13–15). Patent Owner does not propose a different level of ordinary skill in the art in its Response. Patent Owner’s declarant, Kevin C. Almeroth, Ph.D., agrees with Petitioner’s characterization of the person of ordinary skill in the art, 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. We agree, as the ’711 patent describes the design of a software user interface that purportedly provides for reduced traceability of electronic messages. *See, e.g.*, Ex. 1001, Abstract, 1:36–4:5. Based on the record developed during trial, including our review of the ’711 patent and the types of problems and solutions described in the ’711 patent and cited prior art, we agree with and adopt Petitioner’s assessment of the level 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).

II. DISCUSSION

A. *Claim Construction*

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

(2018).¹¹ Petitioner does not seek express construction of any term of the '711 patent. Pet. 14. Patent Owner advocates for adoption of the district court's claim construction of "reduced traceability display" (PO Resp. 12 (citing Ex. 2003, 15–17)) and for the "correlation" terms (*id.* at 13–14).

In the Decisions on Institution, based on the record at the time, we preliminarily interpreted "reduced traceability displays" in claim 1 to mean "an arrangement of displays that enables reduced traceability of electronic messages (e.g., by separately displaying identifying information and message content)." Dec. 9–10. Patent Owner proposed this interpretation in the related litigation, and Petitioner applies it in the Petitions. *See* Ex. 2003, 15–17; Pet. 29. The parties do not dispute our preliminary interpretation of "reduced traceability displays," and we do not perceive any reason or evidence that compels any deviation from that interpretation. *See* PO Resp. 12.

Based on our review of the Petitions, Patent Owner Responses, and both parties' supporting evidence, we determine that no other terms require express construction 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.'")

¹¹ The Petitions in these proceeding were filed on December 31, 2017 (IPR2018-00416) and January 9, 2018 (IPR2018-00439), prior to the effective date of the rule change that replaces the broadest reasonable interpretation standard with the federal court claim interpretation standard. *See* Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340, 51,340 (Oct. 11, 2018) (amending 37 C.F.R. § 42.100(b) effective November 13, 2018).

(quoting *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

B. Asserted Obviousness Based on Combinations with Wren

Petitioner contends that claims 1, 4–6, and 11 of the '711 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Namias, Wren, Fardella, Stevenson, and Yuan. Pet. 18–67. In addition, Petitioner contends that dependent claims 15 and 16 are unpatentable over Namias, Wren, Fardella, Stevenson, Yuan, and Thorne under 35 U.S.C. § 103(a). *Id.* at 67–74. Petitioner also contends that dependent claim 13 would have been obvious over the combination of Namias, Wren, Fardella, Stevenson, Yuan, RFC 2821, and Hazel. 439 Pet. 12–71. A common thread in all of these grounds is Petitioner's reliance upon Wren to teach certain aspects of claim 1. For the reasons described below, we determine Petitioner has failed to establish the unpatentability of claims 1, 4–6, 11, 13, 15, and 16 by a preponderance of the evidence.

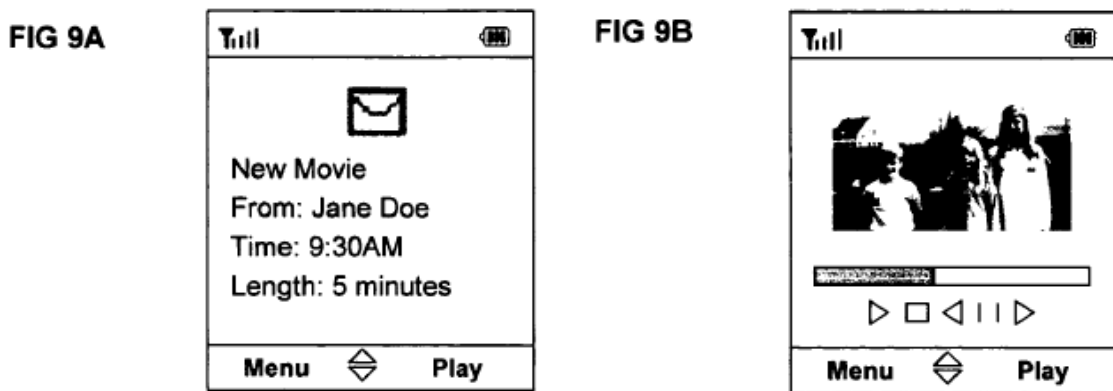
1. Overview of Wren

Wren describes “a multimedia video messaging system that provides an end-user with the ability to record and send arbitrary-length audio and video content” as “audiovisual messages that are automatically addressed to recipients based on one-touch activation.” Ex. 1004, Abstract, ¶ 2. The sending user (referred to in Wren as the “end-user”) “initiate[s] the method from a menu, address-book or an active voice or audio call screen” on the user's device (e.g., a mobile phone). *Id.* ¶¶ 10, 23. For example, the device may provide the end-user with a “Send” option, which “will auto-compose the message [to the desired recipient(s)] based on parameters submitted to the method from the point of initiation” or “may prompt the user for the to:

address that will typically be a phone number or e-mail address, subject text and body text.” *Id.* ¶ 29. The device then sends the movie message in one of two ways. *Id.* ¶¶ 11, 29. If the video is less than a certain size, the video is sent as an attachment to the message. *Id.* ¶ 11. If the video is above that size, however, “the video and audio streams to a remote disk that is available on the world-wide web and a message is created and sent with a [Uniform Resource Identifier (URI)]¹² to the streamed media embedded in the body of the message.” *Id.* “When the message is received, an end-user can click on the attachment or the URI to play the video and audio.” *Id.*

Figures 9A–9C of Wren are “an illustration of the end-user experience receiving the one-touch message with a compatible mobile phone or [personal computer (PC)] with a compatible e-mail client.” *Id.* ¶ 22.

Figures 9A and 9B of Wren are reproduced below.



¹² Petitioner’s declarant, Dr. Chatterjee, testified that a “[Uniform Resource Locator (URL)] is a specific type of a URI, which is a uniform resource identifier. And the difference between – URL is – you can think about it as like a subset of a URI. And it’s a subset because the URL indicates a location as well.” Ex. 2012, 20:22–21:1. Patent Owner’s declarant, Michael Shamos, Ph.D., explained that “[a]s used in Wren, ‘URI’ has the same meaning as ‘URL.’” Ex. 2001 ¶ 43 n.4. For the purposes of this Decision, we will consider the terms URL and URI to be interchangeable.

Figure 9A depicts “a notification of a new message,” and Figure 9B depicts “a view of the Movie once the user selects play from a new message notification.” *Id.* ¶ 32. Wren also includes Figure 9C, which is reproduced below.

FIG 9C

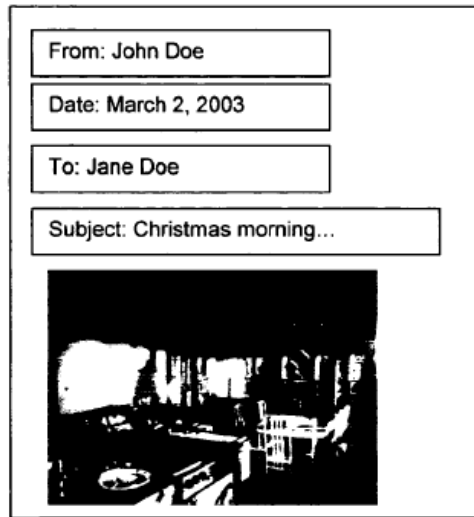


Figure 9C depicts “an e-mail message containing the Movie.” *Id.*

2. Analysis

Claim 1 is directed to a method of handling an electronic message and it includes limitations directed to both the sending and receiving portions of the electronic message system. Ex. 1001, 24:8–25:4. With respect to the latter, claim 1 recites the following limitations pertaining to a “second plurality of reduced traceability displays” including a “third display” and “fourth display”:

providing a second reduced traceability electronic messaging application program to a recipient user device, the second reduced traceability electronic messaging application program including instructions executable by a second processor of the recipient user device to provide a second plurality of reduced traceability displays via the recipient user device; [and]

...

transmitting the electronic message from the server to the recipient user device via a second network that includes a wireless communications portion, wherein the electronic message transmitted to the recipient user device includes an identifier of a sending user and the message content including a media component, the second plurality of reduced traceability displays including a third display and a fourth display, the third display presenting the identifier of a sending user, the fourth display presenting the media component, the instructions executable by the second processor providing the third and fourth displays such that the identifier of a sending user is not displayed with the media component via the fourth display preventing a single screen capture of both the identifier of a sending user and the media component, wherein the identifier of a recipient and the message content received at the server each optionally include a correlation to allow the server to receive the identifier of a recipient and the message content separately and to relate the identifier of a recipient to the message content if the identifier of a recipient is received separately from the message content at the server, and wherein the identifier of a recipient and the message content transmitted from the server each optionally include a correlation to allow the identifier of a recipient and the message content to be related to each other by the second reduced traceability electronic messaging application program if the identifier of a recipient and the message content are transmitted from the server separately.

For reasons described below, we determine that Petitioner has not met its burden to establish that the cited art teaches the receiving portions of the claim.

Petitioner relies upon Wren to teach the details of the recipient user device. Pet. 20 (citing Ex. 1002 ¶ 46). Petitioner asserts that “Wren expressly discloses that the video message can be delivered to a ‘recipient user device’ in the form of a mobile phone.” *Id.* (citing Ex. 1004 ¶¶ 8, 9, 22) (emphasis omitted). “Wren illustrates the ‘end-user experience’ of receiving a video message (which Wren calls a ‘movie message’) on a mobile phone.”

Id. at 34 (citing Ex. 1004 ¶ 22). Petitioner cites to Figures 9A and 9B of Wren to teach the “second ‘plurality of reduced traceability displays’” on the recipient user device. *Id.* at 34–35 (citing Ex. 1002 ¶¶ 81–82). “Figure 9A of Wren shows identifying information associated with the message (*e.g.*, sender identification ‘Jane Doe’ and time ‘9:30AM’), but does not display any of the movie message content. Conversely, Figure 9B shows the movie message content, but does not include any identifying information.” *Id.* at 35. Petitioner relies on Wren’s Figures 9A and 9B respectively to teach the claimed third and fourth displays, which, according to Petitioner, separately “present[] the identifier of a sending user” and “present[] the media component.” *Id.* at 52.

Claim 1 recites providing a “second plurality of reduced traceability displays via the recipient user device.” Patent Owner argues that Wren does not teach such reduced traceability displays. PO Resp. 46–57. As explained above, we interpret “reduced traceability displays” in claim 1 to mean an arrangement of displays that enables reduced traceability of electronic messages (*e.g.*, by separately displaying identifying information and message content). *See supra* Section II.A. We have reviewed Petitioner’s arguments and evidence in light of the construction and for the reasons that follow, we determine that Petitioner has not met its burden to establish that this limitation would have been obvious over the cited art.

Again, Petitioner argues that the screen displays shown in Figures 9A and 9B of Wren are “reduced traceability displays” because they display

header information and message content separately. Pet. 34–36, 52¹³ (arguing that the limitation is satisfied “because [Figures 9A and 9B of Wren] display message content and recipient identifying information separately”). Wren discloses: “FIG. 9A shows a notification of a new message. FIG. 9B shows a view of the Movie once the user selects play from a new message notification.” *Id.* at 33–34 (quoting Ex. 1004 ¶ 32). Petitioner asserts that “Figure 9A of Wren shows identifying information associated with the message (*e.g.*, sender identification ‘Jane Doe’ and time ‘9:30AM’), but does not display any of the movie message content.” *Id.* at 35.

According to Patent Owner, “[t]he problem with Petitioner’s argument is that Figure 9A includes more than just header information—it includes the text ‘New Movie,’ which would not typically be considered header information.” PO Resp. 46. Dr. Chatterjee, on behalf of Petitioner, opines “that Figure 9A shows the text ‘New Movie,’ but there is nothing in Wren to suggest that this text was part of the message sent from Jane Doe.” Ex. 1002 ¶ 81¹⁴; *see also* Reply 11–21 (arguing that “New Movie” is not message content). Patent Owner argues that Petitioner fails to provide

¹³ We note that IPR2018-00439 is directed to the alleged unpatentability of dependent claim 13. As part of Petitioner’s analysis of claim 13, Petitioner addresses the unpatentability of claim 1. Petitioner’s allegations regarding claim 1 are substantially identical as to the “reduced traceability displays” limitation. *Compare* Pet. 34–36, 52, *with* 439 Pet. 26–28, 44–45; *compare* Reply 11–20, *with* 439 Reply 11–20. We refer to the papers and exhibits filed in IPR2018-00416 for convenience, but our analysis applies equally to both cases.

¹⁴ We note that Petitioner does not specifically discuss the “New Movie” text in either Petition, but its declarant, Dr. Chatterjee, does discuss this language in his original declaration.

sufficient proof that “New Movie” is not “message content,” and thus, has not shown that Wren teaches providing “reduced traceability displays.” PO Resp. 46–57; Sur-Reply 12–17.

Initially, we note that Petitioner does not point to—and we do not find—any express disclosure in Wren of the concept of separating header information and message content for display to a message recipient. Indeed, the vast majority of the reference is directed to functionality at the sender-side, such as how the messaging functionality is initiated, how a message is created, and how video content is sent as a message. *See* Ex. 1004 ¶¶ 2, 8–12, 23–31, Figs. 1–8. Only one paragraph of Wren’s written description pertains to what happens at the receiver-side:

FIG. 9 is an illustration of a recipient receiving the one-touch arbitrary length movie message with video and audio. FIG. 9A shows a notification of a new message. FIG. 9B shows a view of the Movie once the user selects play from a new message notification. FIG. 9C shows an e-mail message containing the Movie. This illustration is of an image that is automatically played inline with the e-mail reader.

Id. ¶ 32. Paragraph 32 includes little detail about what is shown in the figures, and does not reference the “New Movie” text in particular. Also, as both parties and their declarants agree, Wren is silent as to where “New Movie” originated—whether from the sending device, the recipient mobile phone, or something else. *See* PO Resp. 47; Reply 20; Ex. 2009 ¶ 76; Ex. 2012, 43:2–45:16. Thus, what we must determine is how a person of ordinary skill in the art, reading paragraph 32 and the cited figures in context with the rest of Wren, would have understood “New Movie” in Figure 9A. *See Life Techs., Inc. v. Clontech Labs., Inc.*, 224 F.3d 1320, 1325 (Fed. Cir. 2000) (obviousness is “assessed from the perspective of the

hypothetical person of ordinary skill in the art”). According to Petitioner, the “most reasonable inference” is that “New Movie” is generated and displayed by the recipient device. Reply 17. Patent Owner responds that nothing in Wren supports Petitioner’s reading, and in fact the reference suggests the opposite, i.e., that the text is part of the message sent by the sending device. PO Resp. 51–56; Sur-Reply 14. We address each of Petitioner’s contentions, and Patent Owner’s responses, in turn.

First, Dr. Chatterjee opines that “there is nothing in Wren to suggest that [the ‘New Movie’] text was part of the message sent from Jane Doe.” Ex. 1002 ¶ 81 (cited on page 35 of the Petition). As explained above, however, neither does Wren disclose the opposite. Wren is completely silent as to whether “New Movie” came from the sending device as part of the message or whether it was generated by the recipient device on its own. In such circumstances, the fact that Wren does not contain an express disclosure of the former is not automatically proof of the latter. Petitioner bears the burden to prove unpatentability by a preponderance of the evidence, 35 U.S.C. § 316(e), including the articulation of “specific reasoning, based on evidence of record, to support the legal conclusion of obviousness,” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016). Petitioner’s reliance on Wren’s lack of disclosure of where “New Movie” originated and argument that “*Patent Owner* points to nothing in Wren to suggest that ‘New Movie’ is message content originating from the sender,” therefore, are not persuasive. *See* Reply 13 (emphasis added). It is Petitioner’s burden to show that a person of ordinary skill in the art would have understood Figure 9A in Wren to include no message content,

not Patent Owner's burden to prove the opposite. *See* PO Resp. 47; Sur-Reply 13.

Dr. Chatterjee further opines that “[a] person of ordinary skill in the art would have recognized that the recipient mobile phone generates and displays [the ‘New Movie’] text as part of a ‘notification of a new message.’” Ex. 1002 ¶ 81 (quoting Ex. 1004 ¶ 32). According to Dr. Chatterjee, “the ‘New Movie’ descriptor is generally applicable to all ‘movie messages’” in Wren, and a person of ordinary skill in the art “would have appreciated that generating this element at the recipient mobile phone is preferable to requiring that [the] sending device transmit it as part of each outgoing message, as this allows for the communication of smaller messages and hence decreased burdens on network bandwidth and device memory.” *Id.* ¶ 81 n.15.

We do not find these points persuasive because they are not supported sufficiently by the disclosure of Wren (or any other evidence in the record). Dr. Chatterjee cites only paragraphs 8, 22, and 32 of Wren in support of his opinions. *See id.* ¶ 81. Paragraph 8 states that “[t]he primary object of the invention is to provide an end-user with a one-touch messaging capability to send movie messages containing video and audio of arbitrary length to recipients independent of the recipient's device capabilities over a network such as the Internet,” paragraph 22 states that “FIG. 9 is an illustration of the end-user experience receiving the one-touch message with a compatible mobile phone or PC with a compatible e-mail client,” and paragraph 32 states that “FIG. 9A shows a notification of a new message.” Ex. 1004 ¶¶ 8, 22, 32.

There are multiple lines of text and images in Figure 9A, but these paragraphs of Wren say nothing about the recipient device generating any portion of that content or that doing so would be preferable over other alternatives. Nor do they differentiate between content clearly received by the recipient device in connection with the message (e.g., an identification of the sender “Jane Doe”) and any content that might be generated by the recipient device on its own, as would be the case in Dr. Chatterjee’s opinion. We also do not read the single reference to “new message” in paragraph 32 of Wren as supporting Dr. Chatterjee’s view, given that the relevant text in Figure 9A (“New Movie”) is not the same. Indeed, Petitioner acknowledges that there is nothing in Wren disclosing any determination by the recipient device of whether to display “New Movie” for a movie message and something different for other types of messages. *See* Tr. 20:21–21:18. Further, Dr. Chatterjee’s opinion that “New Movie” would apply to “all” movie messages in Wren is contradicted by the fact that Figure 9C (discussed further below) also depicts a movie message, but does not include that language. *Compare* Ex. 1002 ¶ 81 n.15 (opining that “New Movie” applied to all movie messages), *with* Ex. 1004 ¶¶ 22 (referring to Figures 9A–C together as illustrating “the end-user experience receiving the one-touch message”), 32 (referring to Figures 9A–C together as illustrating “a recipient receiving the one-touch arbitrary length movie message”); Ex. 2012, 57:24–58:4 (Dr. Chatterjee acknowledging that Figure 9C depicts a movie message).

Second, Dr. Chatterjee testifies that the fact that “Wren refers to the movie message as a ‘one-touch’ message in which the sender can send messages to a recipient without further user input” supports his opinion that

“New Movie” is generated by the recipient device. Ex. 1002 ¶ 81 (citing Ex. 1004 ¶¶ 6–8, 32, claim 2) (cited on page 35 of the Petition); Reply 18–20. Again, we are not persuaded that the disclosure of Wren supports Dr. Chatterjee’s opinion.

Wren discloses the procedures by which the end-user can create and send a message. The end-user initiates the disclosed method using “a menu, address-book or an active voice or audio call screen.” Ex. 1004 ¶ 10. When an address-book is used, the end-user “populate[s] the address-book via add prompts pre and post voice and video calls or sync[s] with an address-book residing on a network such as the Internet.” *Id.* ¶ 23. The sending device displays “a selection of entries” in the address-book and the end-user selects “a highlighted entry” as the recipient of the message. *Id.* ¶ 23, Fig. 1A. Once the end-user has recorded a video, the device presents “send,” “cancel,” and “save” options. *Id.* ¶ 29, Fig. 6. Wren describes the “send” option as follows:

The Send option will auto-compose the message based on parameters submitted to the method from the point of initiation. In an alternative implementation, the method may prompt the user for the to: address that will typically be a phone number or e-mail address, subject text and body text. Once composition is complete, the method will attach the complete video and audio message or insert a URI that refers to the originating network location source for the video and audio stream, assemble and send a message using an interoperable protocol such as the [Internet Engineering Task Force (IETF)] e-mail protocols of the receiving server, and prompt the user to save or simply exit the message.

Id. ¶ 29.

Figure 8 of Wren is reproduced below.

FIG 8

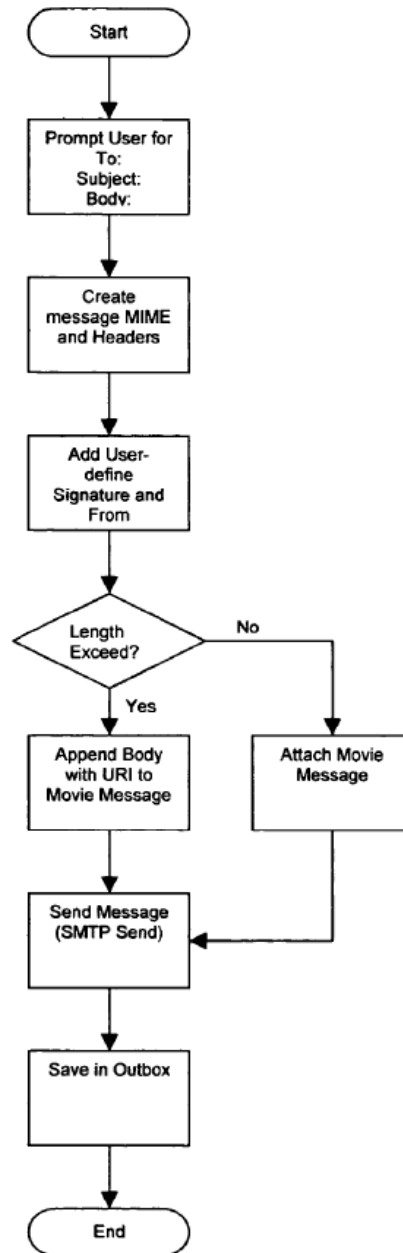


Figure 8 “illustrates the compose and send function.” *Id.* ¶ 31. Wren describes the functionality shown in Figure 8 as follows:

Once the movie message is recorded, the method invokes the process to compose and the[n] send the message. The compose will automatically construct the message To:, CC:, Subject: and Body:. An alternative implementation will allow an end-user to specify these fields or override the method’s defaults. The steps

will then attach the full audio and video or a URI pointing to the audio and video residing on the originating network depending on the network threshold. When completed, the process will transport the message using a standard Internet message transport protocol such as [Simple Mail Transfer Protocol (SMTP)].

Id.

Petitioner argues that the above language discloses two different embodiments, namely a “primary one-touch implementation [where] the user is provided no opportunity to enter ‘New Movie’ or any other text” and “an ‘alternative implementation’ in which the user can input header fields such as [a] subject.” Reply 19 (citing Ex. 1043 ¶ 29; Ex. 1052, 6, 18). According to Petitioner and Dr. Chatterjee, a person of ordinary skill in the art would have understood that Figures 9A and 9B show the “one-touch” implementation, and it also would have been obvious to send the message of Figures 9A and 9B using that implementation. *Id.* at 19–20 (citing Ex. 1043 ¶¶ 30–31).

We disagree, and find that the above disclosure actually supports Patent Owner’s position. Figure 8 depicts the “*compose* and send function” in which the sending device (in both alleged implementations) creates the “To:, CC:, Subject: and Body:” fields of the message that are sent to the recipient device. Ex. 1004 ¶ 31 (emphasis added). On the other hand, Wren does not disclose the recipient device creating anything. Thus, as Patent Owner correctly points out, “the only disclosed methods for generating ‘New Movie’ come from the send side, not the receiving device.” *See* Sur-Reply 14. Petitioner also acknowledges that it is “absolutely possible” that the user could have entered the “New Movie” text and that

text would be sent automatically in the one-touch implementation. *See* Tr. 17:8–12.

Moreover, for purposes of determining whether “New Movie” is generated by the recipient device (as Petitioner contends) or by the sending device (as Patent Owner contends), what matters is whether the text is sent by the sending device to the recipient device, not whether (or when) the end-user inputted the text. *See id.* at 49:18–25. Wren discloses that the sending device automatically creates the message including “To:, CC:, Subject: and Body:” fields or allows the end-user to enter them and “override” their “defaults.” Ex. 1004 ¶¶ 29, 31, claim 3 (reciting the step of “automatically addressing recipients based on attributes in the address-book or menu . . . and populating other message fields such as the body and subject with pre-configured settings”). The fields plainly exist at the time the message is sent, regardless of whether they are entered by the end-user when prompted or populated by the sending device. *See id.* We agree with Patent Owner and Dr. Almeroth that “Wren does not disclose that the auto-compose feature uses [any] information that did not originate with the sender.” *See* Sur-Reply 15; Ex. 2009 ¶ 84. For example, the recipient’s address comes from the selected address book entry populated previously by the end-user or from end-user input at the time of sending the message. Ex. 1004 ¶¶ 23 (“An end-user can populate the address-book via add prompts”), 29 (the sending device “creates the message “based on parameters submitted to the method from the point of initiation” or “prompt[s] the user for the to: address that will typically be a phone number or e-mail address, subject text and body text”).

Figure 9C of Wren also contradicts Petitioner's arguments. Figures 9A–C illustrate “the end-user experience receiving the *one-touch* message.” Ex. 1004 ¶ 22 (emphasis added); *see also id.* ¶ 32 (“the *one-touch* arbitrary length movie message” (emphasis added)). Figures 9A and 9B depict such a message received by a “compatible mobile phone” and Figure 9C depicts such a message received by a “PC with a compatible e-mail client,” but all three figures are described in Wren as reception of a “one-touch” message. *Id.* ¶¶ 22, 32. Thus, when drawing inferences as to how a person of ordinary skill in the art would have understood Wren's disclosed “one-touch” functionality, it is appropriate to look at all three figures. Figure 9C includes the text “Subject: Christmas morning... .” Dr. Chatterjee acknowledges that Figure 9C depicts a “one-touch” message and that the subject of “Christmas morning...” was provided by the sending end-user. Ex. 2012, 42:12–17, 59:15–60:7. Thus, Petitioner's position that Figures 9A and 9B depict a “one-touch” implementation where the end-user would have had no opportunity to enter “New Movie” or other text is belied by the fact that Figure 9C also depicts a “one-touch” message, yet the end-user entered text. *See* Reply 19; Tr. 49:6–17 (“There can't be . . . an inference that a one touch message in Wren does not include information . . . entered by the sender because we all agree that Figure 9C has information in it entered by the sender.”). Patent Owner's arguments, supported by the testimony of Dr. Almeroth, are persuasive in that regard. *See* PO Resp. 49–51; Sur-Reply 15–16; Ex. 2009 ¶¶ 76, 80–81, 86 (explaining that “Dr. Chatterjee's assertion that ‘New Movie’ was not entered by the sender when the only other embodiment shown in Figure 9C contains text that was

clearly generated by the sender is a significant logical leap not supported by any evidence he has provided”).

Figure 9C is relevant in another respect as well. Petitioner asserts that Wren’s “one-touch” message display in Figures 9A and 9B teaches the concept of separating header information and message content for display on different screens. Reply 19–20. Yet the only other illustration of a “one-touch” message, Figure 9C, shows just the opposite—header information (e.g., sender name, date of the message) and message content (e.g., video) on the same screen. This is another fact supporting Patent Owner’s position concerning the “New Movie” text in Figure 9A.

Third, Petitioner in its Reply makes various arguments it poses as applicable “to the extent the Patent Owner might speculate that the ‘New Movie’ text in Figure 9A corresponds to the ‘Subject’ of the incoming message.” Reply 14–16. Patent Owner responds that it is not taking that position. Sur-Reply 13–14. We do not see any indication in Wren that “New Movie” is a subject line of the message. Unlike Figure 9C, for example, which includes the text “Subject: Christmas morning...,” Figure 9A does not include “Subject:” before “New Movie.” Thus, whatever “New Movie” is (i.e., message content or something else), we agree with the parties that the evidence does not establish that “New Movie” is a subject line.

Fourth, Petitioner argues that the layout of Figure 9A supports its view that “New Movie” is not message content. Reply 16–17. Petitioner contends that, as shown in Figure 9A, there is “not enough screen space . . . to present any reasonably long textual body that could be entered by the user” because “any message body with more than a few words would

prevent the header information underneath from being displayed.” *Id.* (citing Ex. 1043 ¶ 26; Ex. 1044, 56:22–57:9, 58:2–7). Further, according to Petitioner, displaying a message body above the sender name and time is “inconsistent with how conventional messaging systems present messages, which typically present the message body below the header information.” *Id.* (citing Ex. 1043 ¶ 26).

We view these facts as nominal support for Petitioner’s position. Again, the written description of Wren does not mention the “New Movie” text at all. Wren does not include any disclosure about the size of the various lines of text shown in Figure 9A or how much text might fit in each line. Indeed, there appears to be blank space to the right of “New Movie” where additional text could appear. Figure 9A also includes up and down arrows on the bottom of the screen. As with “New Movie” though, Wren does not describe at all what the arrows do. It could be the case, as Dr. Chatterjee testifies, that the arrow icon permits the user to scroll to “a different message,” Ex. 1043 ¶ 27, but it is just as likely that the icon allows the user to scroll up and down to see additional text beyond “New Movie,” as Dr. Almeroth points out, Ex. 1045, 250:3–17; *see* Ex. 1004, Abstract, ¶¶ 11, 25, 29, 31, claim 3 (disclosing a message having a “body” with text, in addition to the video or link to the video). Wren does not say either way. Petitioner’s arguments and Dr. Chatterjee’s corresponding testimony regarding the length and positioning of “New Movie” in Figure 9A are plausible, but as with Petitioner’s other contentions, they do not find support in the remaining disclosure in Wren.

Upon review of all of the evidence, we find that Patent Owner’s declarant, Dr. Almeroth, articulates the more compelling position with

respect to “New Movie.” *See* Ex. 2009 ¶¶ 75–86. Dr. Almeroth points out the speculative nature of Petitioner’s arguments, explains the deficiencies in Petitioner’s reading of Wren’s “one-touch” message disclosure, and explains in detail why Petitioner’s view that “New Movie” is not message content is unfounded, in particular with reference to Figure 9C. *See id.* We credit Dr. Almeroth’s testimony on this issue and find it more persuasive than the testimony of Dr. Chatterjee, for all of the reasons explained above.

The instant facts are similar to those of *International Business Machines Corp. v. Iancu*, 759 F. App’x 1002 (Fed. Cir. 2019). The claims at issue in that case required a “single-sign-on operation,” which was interpreted to mean “a process by which a user is authenticated at a first entity and subsequently not required to perform another authentication before accessing a protected resource at a second entity.” *Id.* at 1008. The Board found that a prior art reference disclosed a single-sign-on operation, relying in part on the reference’s silence as to what information is included in a particular scenario described in the reference. *Id.* at 1010–11. The Federal Circuit reversed the Board’s decision, concluding that the fact that the reference was silent on the matter

would not alone support a finding that there was *no* user authentication action in this scenario if, as appears, the Board meant that it simply could not tell one way or the other whether the accessCard contains credentials. Silence in that sense would not by itself suffice for the Petitioner to meet its burden to prove, by a preponderance of the evidence, that there was *no* user authentication action in this scenario. Nor would that burden be met merely by adding a finding that [the patent owner] did not prove the opposite, *i.e.*, a finding of “the absence of sufficient evidence showing the provision or validation of a set credentials at the partner site” in this scenario.

Id. at 1011 (citations omitted). The Federal Circuit also found that the Board erred in its silence determination by “taking too narrow a view” of the reference and not reading the scenario description in context with other portions of the reference. *Id.* at 1011–12.

Similarly, Petitioner’s position in this proceeding is that Wren teaches the separation of header information and message content because there is *no* message content in Figure 9A. Wren’s silence as to what the “New Movie” text represents and where it originated is insufficient for Petitioner to prove that it is not message content. Also, reading the limited disclosure of paragraph 32 and Figures 9A and 9B in context with the rest of Wren, in particular with Wren’s description of “one-touch” messaging and Figure 9C, we agree with Patent Owner and Dr. Almeroth that Wren at least would have suggested to a person of ordinary skill in the art that the “New Movie” text is sent by the sending device to the recipient device as part of the message, not generated by the recipient device on its own as Petitioner contends.

Ultimately, it is Petitioner’s burden to prove unpatentability by a preponderance of the evidence, which includes in this instance proving that a person of ordinary skill in the art would have understood Wren to teach “provid[ing] a second plurality of reduced traceability displays via the recipient user device.” *See* 35 U.S.C. § 316(e); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.”). “In an *inter partes* review, the burden of persuasion is on the petitioner to prove ‘unpatentability by a preponderance of the evidence,’ and that burden *never shifts* to the

patentee.” *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (emphasis added; citation omitted); *see also Magnum Oil*, 829 F.3d at 1376 (“Where, as here, the only question presented is whether [claims would have been obvious], no burden shifts from the patent challenger to the patentee,” and “[t]his is especially true” when the issues are “what the prior art discloses, whether there would have been a motivation to combine the prior art, and whether that combination would render the patented claims obvious.”). “Failure to prove the matter as required by the applicable standard means that the party with the burden of persuasion loses on that point—thus, if the fact trier of the issue is left uncertain, the party with the burden loses.” *Dynamic Drinkware*, 800 F.3d at 1378–79 (quoting *Technology Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1327 (Fed. Cir. 2008)).

Petitioner argues that Figures 9A and 9B of Wren constitute “reduced traceability displays” because “New Movie” in Figure 9A is not message content and Wren thus displays header information and message content separately, citing the very limited disclosure of Wren regarding those displays and the testimony of Dr. Chatterjee as to what a person of ordinary skill in the art allegedly would have inferred from that disclosure. In response, Patent Owner provides persuasive evidence to the contrary that a person of ordinary skill in the art would have understood “New Movie” to be sent by the sending device to the recipient device as part of the message, or at the very least, that Wren is ambiguous on the point such that there is no basis to draw the inference advocated by Petitioner. Based on the record presented, we agree with Patent Owner and are not persuaded that there is

sufficient evidence to establish that Wren teaches providing a “second plurality of reduced traceability displays via the recipient user device.”

Petitioner makes the additional argument in its Reply that “the question of whether ‘New Movie’ shown in Figure 9A of Wren is message content is somewhat academic in light of the combination of Wren with Namias.” Reply 12 (emphasis omitted). According to Petitioner, “the video message received and displayed by the recipient device in Wren was originally composed and sent using the method of Namias.” *Id.* Petitioner points out Patent Owner previously has argued that “Namias makes ‘no provision for entering textual message content.’” *Id.* (quoting 439 Ex. 2009 ¶ 145 (declaration of Dr. Almeroth)). Thus, Petitioner contends that “it would have been obvious – indeed, most natural – that when Wren is implemented to receive a video message from the sending device in Namias, the screen display in Figure 9A would not present any textual message content for the simple reason that in the message received from Namias, there is no textual message content to display.” *Id.* at 13 (emphasis omitted) (citing Ex. 1043 ¶ 21).

We agree with Patent Owner that presentation of this theory in the Reply is improper because it was not raised adequately in the Petition. *See* Sur-Reply 17–18. Pursuant to 37 C.F.R. § 42.23(b), a reply “may only respond to arguments raised in the corresponding . . . patent owner response.” *See also Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369–70 (Fed. Cir. 2016) (concluding that the Board did not abuse its discretion in refusing to consider reply brief arguments advocating a “new theory” of unpatentability under 37 C.F.R. § 42.23(b)); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012) (“While

replies can help crystalize issues for decision, a reply that raises a new issue or belatedly presents evidence will not be considered and may be returned.

. . . Examples of indications that a new issue has been raised in a reply include new evidence necessary to make out a *prima facie* case for the patentability or unpatentability of an original or proposed substitute claim, and new evidence that could have been presented in a prior filing.”); Trial Practice Guide Update (Aug. 2018), 14–15, *available at* https://www.uspto.gov/sites/default/files/documents/2018_Revised_Trial_Practice_Guide.pdf (“‘[R]espond,’ in the context of § 42.23(b), does not mean embark in a new direction with a new approach as compared to positions taken in a prior filing. While replies and sur-replies can help crystalize issues for decision, a reply or sur-reply that raises a new issue or belatedly presents evidence may not be considered.”).

As explained above, Petitioner in its Petition relies solely on Wren as allegedly teaching the “provid[ing] a second plurality of reduced traceability displays via the recipient user device” limitation of claim 1. *See* Pet. 33–36 (arguing that the limitation is disclosed by Wren). Petitioner clearly explained its position as follows:

Figures 9A and 9B from Wren together qualify as the second “plurality of reduced traceability displays,” under its broadest reasonable interpretation, because they display message content and recipient identifying information separately. As shown, Figure 9A of Wren shows identifying information associated with the message (e.g., sender identification “Jane Doe” and time “9:30AM”), but does not display any of the movie message content. Conversely, Figure 9B shows the movie message content, but does not include any identifying information. Figures 9A and 9B thus disclose “a second plurality of reduced traceability displays.”

Pet. 34–35 (emphases and footnotes omitted). Petitioner never mentions Namias when addressing the limitation at pages 33–36 of the Petition. The only portion of the Petition cited by Petitioner in the Reply for the argument is pages 21–22, which pertain to Petitioner’s asserted motivation to combine the cited references. *See* Reply 12. In that section, Petitioner does not address how the absence of text in Namias would impact Wren. *See* Pet. 21–23. Moreover, even if Petitioner could now rely on a combination of Wren and Namias for the “second plurality of reduced traceability displays via the recipient user device” limitation, Petitioner never argued in the Petition that the proposed modified system would not support text (with video) in a message. *See* Sur-Reply 17–18.

In addition, we are not persuaded that one of ordinary skill in the art would have combined Namias’s disclosures with Wren such that the modified system would have been incapable of including text (e.g., “New Movie” or other text sent by the sending device). Namias is directed to a system that is not “confined to textual or other limited communications, such as the e-mail transmission of text and graphics.” Ex. 1003 ¶ 9. As noted in Namias, “[a]lthough traditionally used for text messages, e-mail is capable of transferring any type of digital information, including digital audio, graphics, and video.” *Id.* ¶ 6. Namias’s system includes “a conventional keyboard.” *Id.* ¶ 31. This keyboard is used for entering email addresses (*id.* ¶ 40), but Petitioner does not provide sufficient argument to establish that one of ordinary skill in the art would have understood that this keyboard could only be used for such a purpose. Thus, we agree that Namias does not expressly provide for text as part of the video message, but we are not persuaded that the inclusion of Namias would prohibit the inclusion of text.

For the reasons explained above, we find that Petitioner has not proven that “New Movie” is not message content and also did not present a theory in the Petition that the proposed modified system would not support textual messages. Based on the record presented, we are not persuaded by Petitioner’s new argument that the combination of Wren and Namias teaches or suggests providing a “second plurality of reduced traceability displays via the recipient user device.”

3. Conclusion

Petitioner has not shown that the asserted combinations based on Wren teach or suggest “provid[ing] a second plurality of reduced traceability displays via the recipient user device,” as recited in claim 1. None of the proposed combinations directed to dependent claims 4–6, 11, 13, 15, and 16 address the above described deficiency as to Petitioner’s allegations for claim 1. Thus, Petitioner has not shown, by a preponderance of the evidence, that claims 1, 4–6, 11, 13, 15, and 16 are unpatentable over the asserted combinations under 35 U.S.C. § 103(a).

C. Motion to Amend

In its Motion to Amend in IPR2018-00439, Patent Owner proposes substitute claim 50 for claim 13 “only if the Board concludes that claim 13 is unpatentable.” Mot. 1. As explained herein, we do not determine that claim 13 is unpatentable and, therefore, dismiss the Motion to Amend as moot.

III. CONCLUSION

After considering the evidence and arguments presented in the Petitions, Patent Owner Responses, Replies, and Sur-Replies, we determine Petitioner has not demonstrated, by a preponderance of the evidence, that claims 1, 4–6, and 11 of the ’711 patent are unpatentable under 35 U.S.C.

§ 103(a) as obvious over the combination of Namias, Wren, Fardella, Stevenson, and Yuan. Petitioner also has failed to prove by a preponderance of the evidence that dependent claims 15 and 16 are unpatentable over Namias, Wren, Fardella, Stevenson, Yuan, and Thorne under 35 U.S.C. § 103(a). In addition, Petitioner has failed to prove by a preponderance of the evidence that dependent claim 13 is unpatentable over Namias, Wren, Fardella, Stevenson, Yuan, RFC 2821, and Hazel under 35 U.S.C. § 103(a).

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 1, 4–6, 11, 13, 15, and 16 of the '711 patent have not been shown to be unpatentable; and

FURTHER ORDERED that Patent Owner's Motion to Amend 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.

IPR2018-00416 and IPR2018-00439
Patent 9,413,711 B2

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