UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SNAP INC.,
Petitioner

v.

VAPORSTREAM, INC.,
Patent Owner

Case IPR2018-00458
Patent 9,313,156 B2

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 August 30, 2019 (Paper 41) (the "Final Written Decision") as it relates to claims of U.S. Patent No. 9,313,156 ("the '156 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 1-3 and 6-8 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.

Date: October 9, 2019

Respectfully submitted,

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CERTIFICATION OF SERVICE

I hereby certify that on October 9, 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 October 9, 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 October 9, 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

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Paper No. 41
Filed: August 30, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SNAP INC.,
Petitioner,

v.

VAPORSTREAM, INC.,
Patent Owner.

Case IPR2018-00458
Patent 9,313,156 B2

Before STEPHEN C. SIU, JUSTIN T. ARBES, and STACEY G. WHITE, *Administrative Patent Judges*.

Opinion of the Board filed by *Administrative Patent Judge* WHITE.

Opinion Concurring filed by *Administrative Patent Judge* SIU.

FINAL WRITTEN DECISION
Determining All Challenged Claims Unpatentable
Denying Patent Owner's Motion to Amend
35 U.S.C. § 318(a)

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 1–3 and 6–8 ("the challenged claims") of U.S. Patent No. 9,313,156 B2 (Ex. 1001, "the '156 patent") are unpatentable.

A. Procedural History

Petitioner requested *inter partes* review of the challenged claims. Paper 2 ("Petition"). Petitioner provided a Declaration of Sandeep Chatterjee, Ph.D. (Ex. 1002) to support its positions. Vaporstream, Inc. ("Patent Owner") filed a Patent Owner Preliminary Response, supported by the Declaration of Michael Shamos, Ph.D. (Ex. 2001). Paper 9. Based on our review of these submissions, we instituted a trial on all of Petitioner's challenges as described in the Petition. Paper 10 ("Dec."). Petitioner contends the challenged claims are unpatentable under 35 U.S.C. § 103 on the following specific grounds (Pet. 5):

References	Claim(s) Challenged
Namias[1], PC Magazine[2], Saffer[3], and Smith[4]	1, 2, and 6–8
Namias, PC Magazine, RFC 2821[5], and Hazel[6]	1, 2 and 6–8
Namias, PC Magazine, Ford[7], Saffer and Smith	3
Namias, PC Magazine, Ford, RFC 2821, and Hazel	3

Patent Owner filed a Patent Owner Response (Paper 18, "PO Resp.") along with a Declaration of Kevin C. Almeroth, Ph.D. (Ex. 2009), Petitioner filed a Reply (Paper 24, "Reply") along with a Reply Declaration of Dr. Chatterjee (Ex. 1043), and Patent Owner filed a Sur-Reply (Paper 26, "Sur-Reply"). Patent Owner also filed a Motion to Amend (Paper 19, "MTA") to which Petitioner filed an Opposition (Paper 23, "MTA Opp."), Patent Owner filed a Reply (Paper 27, "MTA Reply"), and Petitioner filed a Sur-Reply (Paper 33, "MTA Sur-Reply").

An oral hearing was held on April 17, 2019, and a transcript of the hearing is included in the record (Paper 39, "Tr.").

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

[2] Neil J. Rubenking, *Disabling Print Screen*, P.C. MAGAZINE, Aug. 1988, at 450 ("PC Magazine") (Ex. 1033).

[3] U.S. Patent Appl. Pub. No. 2003/0122922 A1, published July 3, 2003 (Ex. 1004).

[4] U.S. Patent No. 6,192,407 B1, issued Feb. 20, 2001 (Ex. 1005).

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

[6] PHILIP HAZEL, EXIM: THE MAIL TRANSFER AGENT (2001) (Ex. 1011).

[7] U.S. Patent Application Publication No. 2005/0014493 A1, published January 20, 2005 (Ex. 1035, "Ford").

B. Related Proceedings

The parties indicate that the '156 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 4, 1.

Petitioner filed nine additional petitions for *inter partes* review of various other patents owned by Patent Owner, "each of which is related to the '156 patent and claims priority to the same priority application as the '156 patent" (Paper 4, 1–2): Cases IPR2018-00200, IPR2018-00369, IPR2018-00312, IPR2018-00397, IPR2018-00404, IPR2018-00408, IPR2018-00416, IPR2018-00439, and IPR2018-00455. *See* Paper 4, 1–2; Pet. 1. *Inter partes* review was instituted in each of these proceedings and final written decisions have issued[8] for each of these cases.

C. The '156 Patent

The '156 patent is titled "Electronic Message Send Device Handling System and Method with Separated Display and Transmission of Message Content and Header Information," was filed on December 17, 2014[9], and issued April 12, 2016. Ex. 1001. The '156 patent relates to an electronic messaging method "with reduced traceability." *Id.* at [57]. The '156 patent

[8] At this time, some of the final written decisions have been appealed to the U.S. Court of Appeals for the Federal Circuit.

[9] 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.

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.

Figure 3 of the '156 patent is reproduced below.

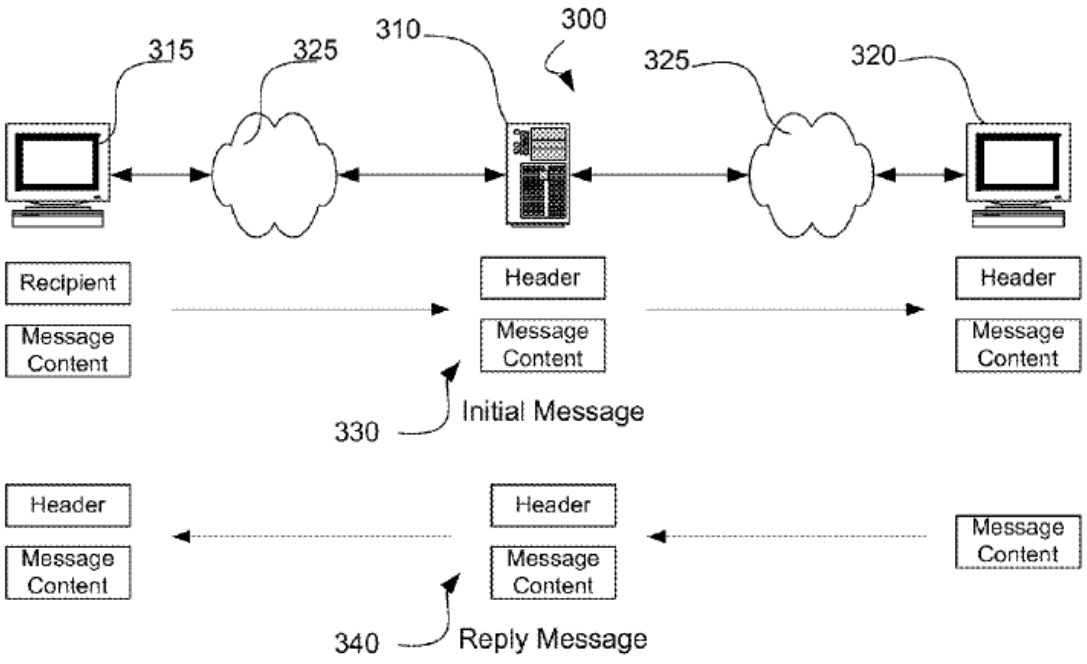

FIG. 3

Figure 3, above, illustrates an example of a messaging system according to the '156 patent. *Id.* at 10:67–11:1. System 300 includes user computers 315, 320 and server computer 310, connected via network 325. *Id.* at 11:1–4. Electronic message 330 is communicated via this system using a method

detailed below. *Id.* at 11:4–5. Reply electronic message 340 also is illustrated, but is not discussed in further detail herein. *Id.* at 11:5–6.

Figure 5 of the '156 patent is reproduced below.

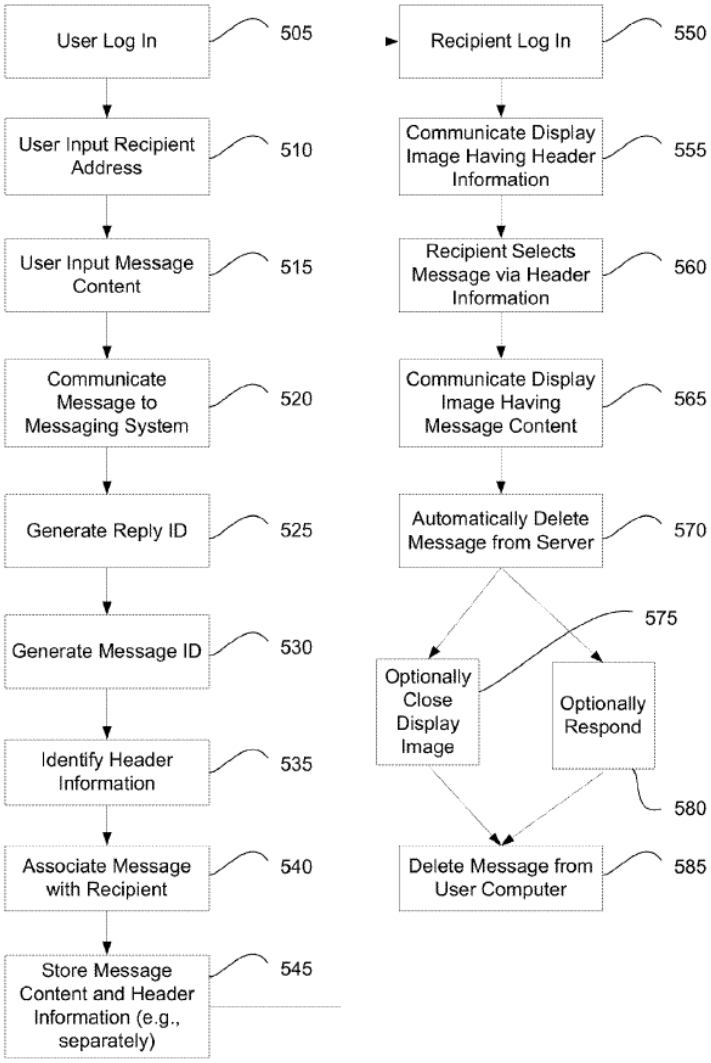

FIG. 5

Figure 5, above, is a flow chart of an exemplary method of the '156 patent. *Id.* at 3:47–48. In step 510, the user inputs a recipient address on a screen. *See id.* at 11:49–50, 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 7:12–24.

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 11:58–60, Fig. 9. "An electronic message may be any electronic file, data, and/or other information transmitted between one or more user computers." *Id.* at 7:55–57. The electronic message may include text, image, video, audio, or other types of data. *Id.* at 7:57–64. In one embodiment, "the recipient address and the message content are entered on separate display screens." *Id.* at 11:64–65. 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 9:20–27, 12: 2–3.

At step 520, the message content is communicated to server 310. *Id.* at 12:10–12. 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 12:13–17. "[A] correlation (e.g., a non-identifying message ID . . .) may be utilized to associate the two components." *Id.* at 7:7–9. 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 12:42–46; *see*

also id. at 13:34–37 ("A message ID [is] used to maintain a correspondence between the separated components of electronic message 330."). The '156 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 13:43–14:31.

D. Challenged Claims

We instituted review of claims 1–3 and 6–8 of the '156 patent of which claim 1 is independent. Claim 1 of the '156 patent is illustrative of the claimed subject matter and is 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 a header information 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 identifier of a recipient being part of a header information for the electronic message, the electronic instructions acting on the displays at the sending user device such that the header information 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;
>
> 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, 18:64–19:31.

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.[10] *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). Petitioner, however, 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 obvious in view of the asserted prior art. We analyze the asserted grounds of unpatentability in accordance with these principles.

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

[10] The parties have not asserted or otherwise directed our attention to any objective evidence of non-obviousness.

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. 6 (citing Ex. 1002 ¶¶ 13–15). 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 '156 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. Based on the full record, including our review of the '156 patent and the types of problems and solutions described in the '156 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 obtained 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)[11]. "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. *Translogic*, 504 F.3dat 1257.

Patent Owner seeks construction of the phrase "message content including a media component" and the term "correlation." PO Resp. 23–25. Petitioner does not seek express construction of any term of the '156 patent, but responds to Patent Owner's proposed constructions in its Reply. Pet. 7. For purposes of this Decision, we need only discuss the construction of the phrase "message content including a media component." [12] *See, e.g.*, *Nidec*

[11] 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) (codified at 37 C.F.R. § 42.100 (2019)).

[12] As to the term "correlation," Petitioner acknowledges that in the district court proceeding, the parties agreed that the term should be construed to mean "data corresponding to a message used to associate two components of a message." Reply 16; *see* PO Resp. 27 (citing Ex. 2003, 9). Petitioner, however, asserts that in this proceeding a broader construction would be appropriate due to the different claim construction standard applicable to this *inter partes* review. Reply 16–17. Regardless, Petitioner asserts that "the district court interpretation of 'correlation' is clearly disclosed by the combination of Saffer and Smith based on the reasoning in the Petition." *Id.*

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 user device to the server computer," and where "the identifier of a recipient and the message content including a media component each includ[es] 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. 25. In support of this construction, Patent Owner relies on a passage from the '156 patent, which states that "a message content of an electronic message may include an attached and/or linked file." Ex. 1001, 7:55–8:1 (cited at

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at 17. As discussed in § II.D.5.f, we determine that the cited art teaches the required "correlation" even under Patent Owner's proposed construction. Thus, we need not provide an express construction of the term.

PO Resp. 24). Patent Owner also directs us to testimony from Petitioner's declarant, Dr. Chatterjee. PO Resp. 25 (citing Ex. 1002 ¶ 112 n.25). 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 23–25.

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.'" Reply 8 (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, 8:4–8 (cited at Reply 8–9) (emphasis added). Petitioner explains that "[t]he URL (Uniform Resource Locator) in the proposed combination [of Namias and Saffer] therefore does not qualify as 'message content' because it identifies 'the location of' the video message on the video server in Saffer." Reply 9 (citing Ex. 1004 ¶ 28).

We agree with Petitioner's arguments. The specification of the '156 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, 7:65–8:4. 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 8:1–4. 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. 25 (citing Ex. 1002 ¶ 112 n.25).
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 ¶ 112 n.25 (emphases added). Dr. Chatterjee's testimony makes clear that "actual content" is distinct from "just a URL" that points to the content.

Thus, we determine that 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*, 868 F.3d at 1017.

D. Asserted Obviousness in View of Namias, PC Magazine, Saffer, and Smith (and Ford)

Petitioner contends that claims 1, 2, and 6–8 are unpatentable under 35 U.S.C. § 103 as obvious over Namias, PC Magazine, Saffer, and Smith, and claim 3 is unpatentable under 35 U.S.C. § 103 as obvious over Namias, PC Magazine, Saffer, Smith, and Ford. Pet. 5. 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. Patent Owner, relying on the testimony of Dr. Almeroth, disputes Petitioner's contentions. PO Resp. 27–69; Ex. 2009. 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.

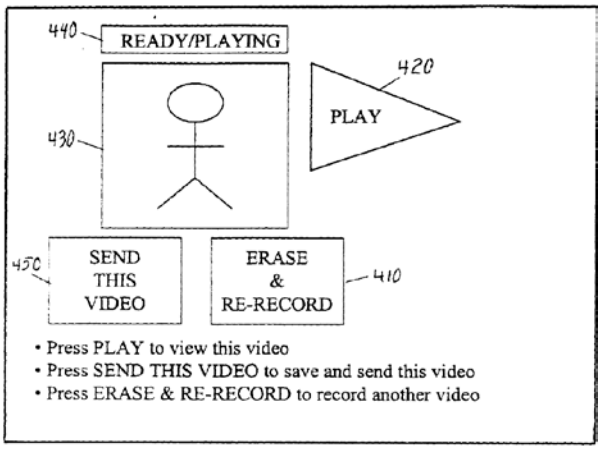

FIG. 4A

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.

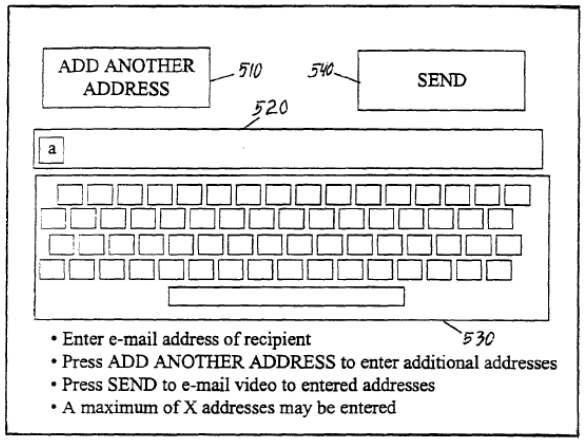

FIG. 5

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.[13] 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 a header information 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 to teach the claimed "sending user device" and on the video or picture message sent using the kiosk as teaching the claimed "electronic message." Pet. 14–18 (citing Ex. 1002 ¶ 57, 59–62). 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 "also includes 'a header information' that takes the form of at least the recipient's

[13] Citations to Exhibit 1033 are to the original pagination of the magazine.

email address (requested from the sender)." *Id.* at 14–15 (citing Ex. 1003, at [57], ¶ 54; Ex. 1002 ¶ 57) (emphasis omitted). According to Petitioner, "[b]ecause 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.* at 15 (citing Ex. 1002 ¶ 59) (emphasis omitted)); Namias "makes clear" that its method is "[a] computer-implemented method" (*id.* at 15–16 (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 16 (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 electronic instructions stored at the kiosk (*id.* at 16–17 (citing Ex. 1003 ¶¶ 20, 31–33; Ex. 1002 ¶¶ 61–62)). We agree, and adopt Petitioner's rationale as stated in the Petition. Pet. 14–18.

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. 18–20. 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 18–19 (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. 19. If the sender is satisfied with the video, pressing "SEND THIS VIDEO" button 450 saves and sends the video. Pet. 19–20 (citing Ex. 1003

¶ 37, Fig. 4A; Ex. 1002 ¶ 65). 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 ¶ 65 (emphasis omitted); Pet. 20. We agree, and adopt Petitioner's rationale as stated in the Petition. *Id.* at 18–20.

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. 20–21. 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 ¶ 66). 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. 21. The user presses "SEND" button 540 "to email [the] video to [the] entered addresses." Ex. 1003, Fig. 5; Pet. 21. Dr. Chatterjee testifies that these teachings of Namias disclose this claim limitation. Ex. 1002 ¶ 67. We agree, and adopt Petitioner's rationale as stated in the Petition. Pet. 20–21.

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 identifier of a recipient being part of a header information for the electronic message, the electronic instructions acting on the displays at the sending user device such that the header information 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"

Petitioner relies on Namias and PC Magazine to teach this limitation. Pet. 22–27. 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 22 (citing Ex. 1003 ¶ 32; Ex. 1002 ¶ 69). 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 22–23 (citing Ex. 1003 ¶¶ 37, 40, 55, 58; Ex. 1002 ¶¶ 70–74). Petitioner continues, "the 'header information for the electronic message' also corresponds to at least the recipient's email address" and "the preview screen 400 ('first display') clearly does not show the recipient's email address ('header information')" while "'the second display prevent[s] a single screen capture of both the identifier of a recipient and the media component,'" as claimed. *Id.* at 23–25 (citing Ex. 1002 ¶ 77) (emphases omitted); *see also id.* at 24–26 (citing Ex. 1003 ¶¶ 23–29, 31–33, 40, 58–64, Fig. 5; Ex. 1002 ¶¶ 72–74, 80–90; 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 26 (citing Ex. 1002 ¶ 90) (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 26–27 (citing Ex. 1033, 450–451; Ex. 1002 ¶ 91).

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. 52–55. Patent Owner argues that

> Petitioner has failed to demonstrate that the combination of Namias with Saffer would include separate displays. . . . [A person of ordinary skill in the art] intent on combining Namias with Saffer, looking at the entirety of those references, would almost certainly choose Saffer's single email composition display screen (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 some specific design application . . . But Petitioner has not identified any reason, such as a particular design application, that would reasonably lead a skilled artisan to select the Namias interface instead of the Saffer single composition screen.

Id. at 53 (citing Ex. 2009 ¶¶ 126–27). 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 ¶ 126; PO Resp. 53.

Petitioner responds by directing us to the Federal Circuit decision in *In re Fulton*, 391 F.3d 1195 (Fed. Cir. 2004). Reply 6–7. There, the applicant argued that the record before the Board was insufficient to establish that the features of the relied upon reference "are preferred over other alternatives disclosed in the prior art." *Fulton*, 391 F.3d at 1200. Our reviewing court held that "[t]his argument fails because our case law does not require that a particular combination must be the preferred, or the most desirable, combination described in the prior art in order to provide

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

Petitioner asserts that "while Saffer's interface may offer certain benefits that make it desirable in certain circumstances, Namias's interface likewise provides other advantages that would have motivated [a person of ordinary skill in the art] to use it in a video messaging system." Reply 15 (citing Ex. 1043 ¶¶ 37–8). According to Petitioner, the chief advantage of Namias's two-screen interface "is its simplicity." *Id.* Patent Owner's declarant, Dr. Shamos, 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); *see also id.* ¶ 31 ("The only aspects that Namias has in common with the '156 patent are that Namias discloses (1) sending a media component by email; and (2) different screens for entering message content and recipient address. However, the reason for Namias's different screens is not reduced traceability, but to present a *simple* interface to a user who has never used the kiosk before." (emphasis added)); *id.* ¶ 80 ("It is true that the drawings [of Namias] illustrate different displays, but this is a matter of user interface design simplification . . . ."). Petitioner asserts that one of ordinary skill in the art would have recognized "that Namias's multiscreen interface is an

example of a well-known user interface technique known as 'wizards.'" Reply 16; *see* Ex. 1043 ¶¶ 40–43. 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 ¶ 41 (quoting Ex. 1048[14], 335–36).

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

[14] Theo Mandel, THE ELEMENTS OF USER INTERFACE DESIGN (1997) ("Mandel"). Citations to Exhibit 1048 are to the original pagination of the book.

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 ¶ 41 (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 ¶ 41). 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 '156 patent. *See* Ex. 1048, Preface, xv (emphases omitted).

In addition, we are not persuaded that Petitioner's argument in its Reply is untimely. *See* Reply 15–16 (citing Ex. 1043 ¶¶ 38–43). 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. 8, 22–23. 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. 53. 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 '156 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. 28–37. 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 28 (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 28–33; Ex. 1002 ¶¶ 94–99, 103. 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. 28 (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. 28–29 (citing Ex. 1002 ¶ 94). 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 29 (emphases omitted).

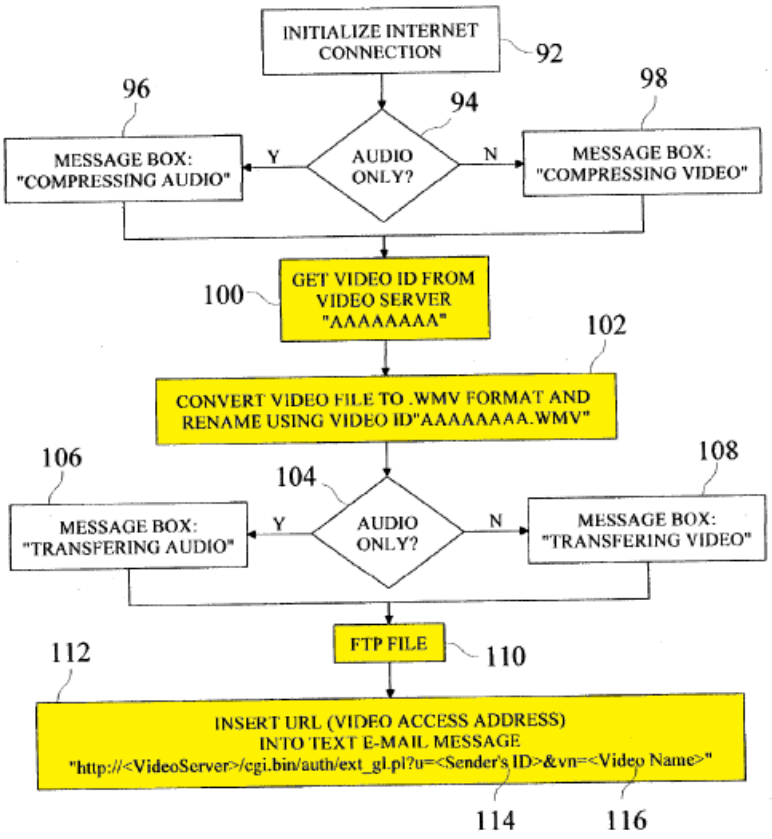

FIG.3

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. 33), to provide further explanation of its position.

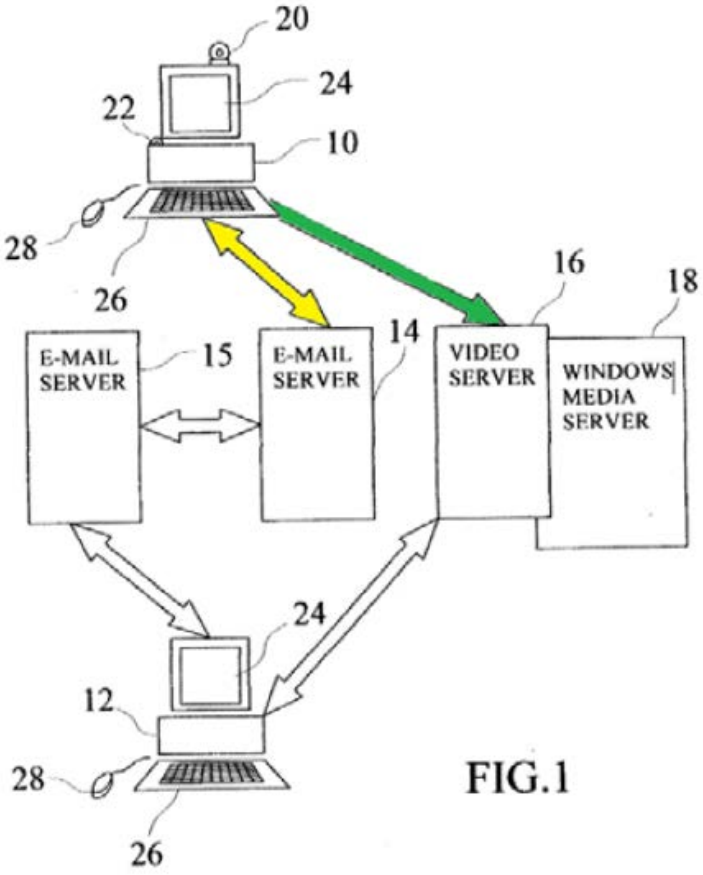

FIG.1

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. 33. As noted by Petitioner, the sending device of Saffer sends the e-mail message with the URL and recipient address to the e-mail 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 30–31 (citing Ex. 1004 ¶¶ 4, 44–47, Fig. 3; Ex. 1002 ¶¶ 95–99). 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 32–33. "This is because [the] transmissions . . . are separated by an intervening step, and separately conveyed to the server." *Id.* at 32 (citing Ex. 1002 ¶¶ 99–103) (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 ¶ 99 (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. 31 (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. 45–52. 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 50–51. 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 51. 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. 46. 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." Reply 7. 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.[15] Pet. 23–33. Petitioner explains that Saffer describes two separate transmissions with an intervening step between the

[15] Under Petitioner's combination, the message content is "simply the video message content in Namias, with no user-provided text or other content." Pet. 34 n.4; *see* Ex. 1002 ¶ 100. "[T]he only message content the user can input is the actual video or picture data." Pet. 34 n.4 (citing Ex. 1003, Fig. 4A).

transmissions. *Id.* at 32–33. Specifically, Saffer describes uploading the compressed video to a server. *See* Ex. 1002 ¶ 95 (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.* ¶ 97. 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.* ¶ 98. 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 party is able to access a transmitted message with both the recipient address and a public URL to the media component, that party will be able to create a complete record of the message" and thus, the asserted combination would "fail[] to achieve the very purpose of the claimed invention." PO Resp. 43–44. Petitioner responds by asserting that "this 'purpose' is nowhere recited in the claim."

Reply 10. The specification of the '156 patent discusses systems and methods for reducing traceability of an electronic message. *See, e.g.*, Ex. 1001, 3:64–65. The challenged claims of this patent, however, do not directly reference "reducing traceability." In addition, none of the challenged claims mentions traceability at all. *See id.* at 18:64–22:53 (the only reference to traceability is in claims 9, 16, and 31, not challenged in this proceeding, which recite not including information that would provide "a traceable identity of the sender").[16]

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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[16] 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'), that discloses specific protections against unauthorized access of data through a URL." Reply 10 (citing Ex. 1002 ¶¶ 138–139); *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. 37–43. In particular, Petitioner points to the video ID of Saffer, adapted according to the teachings of Smith, as teaching the claimed correlation. *Id.* at 37–38. 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 38–40 (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 40–41 (citing Ex. 1002 ¶ 123) (emphases omitted); *see also id.* at 41–43 (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 the intended recipient." *Id.* at 41 (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. 44 (citing Ex. 1002 ¶ 130). 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 46 (emphases omitted); *see id.* at 46–47; Ex. 1002 ¶ 133.

Patent Owner asserts that the cited art fails to teach the claimed correlation. PO Resp. 47–52. According to Patent Owner, "Petitioner's alleged 'correlation' (the video ID 'jxvTSgpc' adapted to include the recipient's email address wsolomon@connectmail.com) appears only in the message content section of Saffer and is not incorporated in the recipient identifier portion of the message (*i.e.*, as part of the header information)." *Id.* at 49.

Petitioner argues that claim 1 does not require that "the 'correlation' be physically stored alongside both the message content and recipient identifier." Reply 19 (citing Ex. 2009 ¶ 121 (Dr. Almeroth's testimony that the proposed combination fails because the video ID is not stored with the recipient identifier)). Petitioner asserts that the claim only requires that the recipient identifier and message content include a correlation, with no limitation as to where that correlation is stored. *Id.* According to Petitioner, "[t]he claim does not preclude a single piece of data from serving as the correlation for both the recipient identifier and the message content." *Id.*

Petitioner further argues that claim 1 is unpatentable even under Patent Owner's view as to the scope of the recited "correlation." *Id.* at 19–20. According to Petitioner, "[t]he combination of Saffer and Smith would have resulted in a system in which the URL of Saffer . . . includes the video ID and, *directly following the video ID*, the recipient identifier such as the recipient email address." *Id.* at 20. Dr. Chatterjee testifies that "the video ID in the URL – which is analogous to the store item identifier in Smith – would be further appended with a recipient identifier such as the recipient's email address (*e.g.*, <http://[...]jxvTSgpc-wsolomon@connectmail.com>)."[17] Ex. 1002 ¶ 129 (in this example, "jxvTSgpc" is the video ID and "wsolomon@connectmail.com" is the recipient ID). Smith describes an exemplary PURL, http://posta.tumbleweed.com/cgi/posta.dll?pu=0-233-33982-FIAAAV4. Pet. 42 (citing Ex. 1005, 16:21–26). As disclosed in Smith, "the PURL includes a store item identifier ('233') immediately followed by a recipient identifier ('33982')." *Id.* (citing Ex. 1005, 16:27–38) (emphases omitted). Thus, Petitioner's proposed modification uses the PURL structure of Smith with the video ID of Saffer in place of Smith's store item identifier, and the email address of Saffer in place of Smith's recipient identifier.

Dr. Chatterjee further opines that "[t]he video ID in Saffer is clearly very similar to the 'message ID' described in the '156 patent because like the 'message ID,' the video ID is associated with a corresponding video message recorded and delivered using the video messaging service taught by Saffer." *Id.* ¶ 131. Finally, Dr. Chatterjee opines that the proposed

[17] As described in Smith, the "store item identifier uniquely identifies which document a given recipient desires to obtain." Ex. 1005, 16:49–51.

"mapping of the 'correlation' limitation is also similar to an embodiment in the '156 [patent] specification where the message ID is coupled to header information stored in one XML file, and the same message ID is also coupled to the message content stored in a separate XML file." *Id.* ¶ 132 (citing Ex. 1001, 13:42–14:31). Dr. Chatterjee also states that it is "a general understanding in the field of computing that coupling the same identifier to two different pieces of information establishes a 'correlation' between them." *Id.* (citing Ex. 1034, A-131).

Patent Owner asserts that this is a new theory proffered for the first time on Reply. Sur-Reply 20. Specifically, Patent Owner asserts that Petitioner is no longer relying upon Smith's recipient identifier. *Id.* We disagree with that assertion. Petitioner is relying on both Saffer and Smith for this limitation. *See e.g.*, Pet. 37–43; Reply 17 (arguing that the claimed "'correlation' is clearly disclosed by the combination of Saffer and Smith based on the reasoning in the Petition"). As described above, Smith is relied upon expressly, in combination with Saffer, to provide the structure for the correlation. Thus, we are not persuaded that Petitioner is advocating a new theory that excludes Smith.

Patent Owner also argues that Petitioner's assertions fail because "Saffer's video ID is not included in the header information containing the recipient identifier." Sur-Reply 20. This argument, however, does not address the teachings of Smith as applied to Saffer. As noted above, Smith provides the structure for the URL that is transmitted with the header information. *See* Pet. 42 (citing Ex. 1005, 16:21–26). Dr. Chatterjee persuasively explains that "the combination of Saffer and Smith would have resulted in a system in which the URL of Saffer . . . includes the video ID

and, *right next to it*, the recipient identifier such as the recipient email address." Ex. 1043 ¶ 48. Specifically, he testified that "the video ID in the URL – which is analogous to the store item identifier in Smith – would be further appended with a recipient identifier such as the recipient's email address (e.g., <http://[...]jxvTSgpc-wsolomon@connectmail.com>29) by the kiosk." Ex. 1002 ¶ 129 (citing Ex. 1005, 16:21–59, Ex. 1004, Fig. 7). We credit this testimony, which is consistent with the disclosures of the references, and are persuaded that one of ordinary skill in the art would have viewed the disclosures of Smith and Saffer together as teaching the recited correlation through their discussion of the PURL that includes both the recipient information and the item identifier.

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. 33–34 (citing Ex. 1002 ¶¶ 104, 106–107). 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 33–34. 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 ¶ 104. 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.* ¶ 107. 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.* ¶ 108. 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.* ¶ 110.

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. 35–36; Ex. 1002 ¶¶ 111–114; 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 ¶ 114. 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. 35–36).

Patent Owner asserts that Petitioner has failed to provide a reason to combine Namias and Saffer (PO Resp. 27–32) and Petitioner has failed to consider these references as whole in making this combination (*id.* at 32–40).[18] 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 28 (quoting Pet. 35). 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. 34–37). In the end, according to Patent Owner, bandwidth savings are "only realized if the recipient never watches the video in its entirety." *Id.* at 30 (citing Ex. 2009 ¶¶ 92–93).

[18] 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 four- and five-reference combinations (PO Resp. 4).

Petitioner responds by asserting that "the combination of Namias and Saffer would have provided significant advantages with respect to at least (1) network bandwidth, (2) storage, and (3) the ability to stream the video message content to the recipient." Reply 1 (citing Pet. 35–37; Ex. 1002 ¶¶ 108–115). In particular, Petitioner contends that Patent Owner has ignored the benefits that would flow from allowing the recipient to stream the video. *Id.* at 1–2. Dr. Chatterjee explains that streaming is a beneficial way of delivering video to a recipient that provides benefits over sending a video file as an email attachment. *See, e.g.*, Ex. 1043 ¶ 9. "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 ¶ 114. In addition, streaming techniques "can be 'optimized to stream the video to the recipient computers 12 in a manner that can most easily [be] viewed by the recipient's computers 12.'" *Id.* ¶ 115 (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.*

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 5 (citing Ex. 2009 ¶ 96). 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 ¶ 96.

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. 1002 ¶ 114–115; Ex. 1043 ¶ 9.

Petitioner further argues that "Patent Owner's argument myopically focuses only on the 'first leg' of the transmission from the sending device to the server, and ignores the substantial bandwidth and storage benefits achieved for subsequent transmission from the *server to the recipient device*." Reply 3. 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 ¶ 111 (quoting Ex. 1006[19], 4:24–30). Petitioner asserts that the proposed combination would "avoid[] the need to send a potentially large video file to the recipient(s) until they actually have a need or desire to view it." Reply 3–4 (citing Ex. 1002 ¶¶ 111–112). 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 cobbled them together into an approximation of the '156 [patent] claims based 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 34, 36. 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

[19] Naick et al., U.S. Patent No. 7,409,425 B2, filed Nov. 13, 2003, issued Aug. 5, 2008.

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 ¶¶ 90, 91 (cited at Pet. 26–27). 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 ¶ 135 (cited at Pet. 47–48). 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.* ¶ 136 (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 that a person of ordinary skill in the art would have had reason to combine their teachings in the manner asserted. Accordingly, we determine the information presented demonstrates, by a preponderance of the evidence, that claim 1 is unpatentable.

6. Dependent Claims 2, 3 and 6–8

Claims 2, 3 and 6–8 depend from claim 1. Petitioner relies on Namias, PC Magazine, Saffer, and Smith to teach the limitations of claims 2 and 6–8. Pet. 49–51. Petitioner relies on Namias, PC Magazine, Saffer, Smith, and Ford to teach the limitations of claim 3. *Id.* at 51–54. Patent Owner does not include any additional arguments directed to these claims. *See generally* PO Resp.; *see also* Paper 11, 5 ("Patent Owner is cautioned that any arguments for patentability not raised in the response will be deemed waived."). We are persuaded by Petitioner's allegations as to claims 2, 3, and 6–8.

For example, claim 2 depends from claim 1 and further recites "wherein the media component is not displayed via the second display with the identifier of a recipient." Ex. 1001, 19:32–34. Petitioner relies upon Namias to teach this limitation. Pet. 49. Specifically, Petitioner directs us to Namias's Figure 5, which depicts a screen in which a user may enter an email address. *Id.* The recipient email address is displayed in display window 520 of Figure 5, but there is no component of the screen for displaying the media component. *Id.* We find Petitioner's arguments and evidence to be persuasive and we find that Petitioner has established by a

preponderance of the evidence the unpatentability of claim 2. We are similarly persuaded as to Petitioner's challenges to claims 6–8. *Id.* at 50. Petitioner has established by a preponderance of the evidence the unpatentability of claims 6–8.

As to claim 3, that claim also depends from claim 1 and further recites "wherein the media component is no longer on the sending user device after said transmitting the message content and the recipient address." Petitioner relies on Ford to teach that the media component is no longer on the sending device after the message has been transmitted. *Id.* at 51. Ford is a U.S. patent application publication titled "Apparatus and Method of Wireless Data Exchange with Automatic Delivery Confirmation." Ex. 1035, at [54]. As described in Ford, "after the message data has been successfully transmitted to the server, the message data, which can include picture and video content, is automatically deleted from the sending device." Pet. 51 (citing Ex. 1035 ¶ 28 ("[I]t is an object of the present embodiment of the invention to provide for the automatic deletion of [a] wireless data message stored on a wireless device after confirmation of the successful storage of that data on a remote server.")). Petitioner asserts that one of ordinary skill in the art would have been motivated to combine Ford with Namias because automatic deletion would conserve memory space. *Id.* at 52–53. We are persuaded by Petitioner's argument and evidence and we find that Petitioner has established by a preponderance of the evidence the unpatentability of dependent claim 3 over Namias, PC Magazine, Saffer, Smith, and Ford.

E. Asserted Obviousness in View of Namias, PC Magazine, RFC 2821, and Hazel (and Ford)

Petitioner contends that claims 1, 2 and 6–8 are unpatentable under 35 U.S.C. § 103 as obvious in view of Namias, PC Magazine, RFC 2821, and Hazel and claim 3 is unpatentable under 35 U.S.C. § 103 as obvious in view of Namias, PC Magazine, RFC 2821, Hazel, and Ford. Pet. 5, 56–71. 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. Because we determine that claims 1, 2 and 6–8 are unpatentable under § 103(a) as obvious over the combined teachings of Namias, PC Magazine, Saffer, and Smith, and claim 3 is unpatentable under § 103(a) as obvious over the combined teachings of Namias, PC Magazine, Saffer, Smith, and Ford, we need not separately assess the patentability of these claims under the additional asserted grounds.

III. CONTINGENT MOTION TO AMEND

Patent Owner filed a contingent Motion to Amend original claims 1 and 2 and replace them with proposed substitute claims 34 and 35. MTA 1 ("Contingent upon the Board finding claim 1 unpatentable, Patent Owner respectfully requests that the Board substitute claims 34–35 for challenged claims 1–2."). We have determined that original claims 1 and 2 of the '156 patent have been shown to be unpatentable by a preponderance of the evidence; therefore, we proceed to address Patent Owner's contingent Motion to Amend.

In an *inter partes* review, amended claims are not added to a patent as of right, but rather must be proposed as a part of a motion to amend. 35 U.S.C. § 316(d). We first must determine whether the motion to amend meets the statutory and regulatory requirements set forth in 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121. Specifically, we must determine whether (1) the amendment responds to a ground of unpatentability involved in the trial; (2) the amendment does not seek to enlarge the scope of the claims of the patent or introduce new subject matter; (3) the amendment proposes a reasonable number of substitute claims; and (4) the proposed claims are supported in the original disclosure. 37 C.F.R. § 42.121; *Lectrosonics, Inc. v. Zaxcom, Inc.*, Case IPR2018-01129 (PTAB Feb. 25, 2019) (Paper 15) (precedential).

Patent Owner "does not bear the burden of persuasion to demonstrate the patentability of [the proposed] substitute claims." *Lectrosonics*, slip op. at 4 (citing *Aqua Prods. Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017); *Bosch Auto. Serv. Sols. LLC v. Iancu*, 878 F.3d 1027 (Fed. Cir. 2017)). "Rather, as a result of the current state of the law and [U.S. Patent and Trademark Office] rules and guidance, the burden of persuasion will ordinarily lie with the petitioner to show that any proposed substitute claims are unpatentable by a preponderance of the evidence." *Id*.

A. Requirements Under 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121

Patent Owner asserts that proposed substitute claims 1 and 2 are responsive to an asserted ground of unpatentability (MTA 1–2), do not enlarge the scope of the originally issued claims (*id.* at 3), constitute a reasonable number of substitute claims (*id.* at 3), and are supported by the original specification (as well as the parent applications) (*id.* at 4–13).

Petitioner does not dispute Patent Owner's contentions on these points. *See generally* MTA Opp.

We have reviewed Patent Owner's arguments and cited evidence, and determine that Patent Owner has met the requirements of 35 U.S.C. § 316(d), 37 C.F.R. § 42.121(a)(2)(ii), and 37 C.F.R. § 42.121(a)(3). Patent Owner proposes a single substitute claim for each original claim, and therefore, meets the requirement for a reasonable number of substitute claims. *See* 37 C.F.R. § 42.121(a)(3); *see also Lectrosonics*, slip op. at 4 ("There is a rebuttable presumption that a reasonable number of substitute claims per challenged claim is one (1) substitute claim."). Further, based on the citations to Application Nos. 14/572,932 (Ex. 2021, 508–49, the application from which the '156 patent issued) and 11/401,148 (Ex. 2025, 452–92, the application at the start of the chain of continuation applications to which the '156 patent claims priority)[20] provided in the Motion, we find sufficient written description support for Patent Owner's proposed substitute claims. *See* MTA 1–13. Thus, we determine that the contingent Motion to Amend meets the requirements of 35 U.S.C. § 316(d), 37 C.F.R. § 42.121(a)(2)(ii), and 37 C.F.R. § 42.121(a)(3).

As explained below, Petitioner has proven, by a preponderance of the evidence based on the entirety of the record, that proposed substitute claims 34 and 35 are unpatentable under 35 U.S.C. § 103(a).

[20] Application Nos. 14/572,932 and 11/401,148 are substantially identical. Our review did not reveal, nor did Petitioner assert, any break in the priority chain between these applications.

B. Obviousness of Proposed Substitute Independent Claim 34

As a replacement for independent claim 1, Patent Owner proposes claim 34. MTA 4–6. Proposed substitute independent claim 34 is reproduced below with annotations showing amendments to original claim 1:

> 34. A computer-implemented method of handling an electronic message at a sending user device in a networked environment, the electronic message including a header information 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 identifier of a recipient being part of a header information for the electronic message, the electronic instructions acting on the displays at the sending user device such that the header information 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, if the message content includes a text, preventing a single screen capture of both the identifier of a recipient and the text**;
>
> 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, **such that if the message content includes a text, each of the text and the**

> **media component are transmitted separately from the identifier of a recipient and wherein the transmitted message content does not contain an identifier of a recipient,** 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.

Id. at i–ii (Claims Appendix).

The new language added to proposed substitute claim 34 recites steps that occur "if the message content includes a text." *See* MTA Reply 1 ("Substitute claim 34 contains two new limitations that are triggered 'if the message content includes a text . . . .'").[21] Petitioner asserts that these proposed amendments are not limiting if the condition precedent (the inclusion of text) is not met. MTA Opp. 2–3 (citing *In re Johnston*, 435 F.3d 1381, 1384 (Fed. Cir. 2006)). Thus, according to Petitioner, proposed substitute claim 34 would have been obvious over Namias, PC Magazine, Smith, and Saffer for the same reasons as claim 1. *Id.* at 3.

Patent Owner responds by arguing that "[w]hen Saffer's transmission system is used to transmit Namias's video emails (as per the Petition at 28–37), the message content in the transmitted email will necessarily 'include[] a text,' thereby triggering both conditions." MTA Reply 1–2 (emphasis omitted). Thus, Patent Owner's argument is not that the conditions must be

[21] We note that there appears to be an additional amendment to claim 34, the deletion of the article "a" in the phrase "the identifier of a recipient being part of ~~a~~ header information for the electronic message." MTA 5, i (Claims Appendix). Patent Owner provides no argument or discussion of this amendment. In addition, Patent Owner states that it is seeking to amend the claims to add two limitations, with no mention of any deletions. *Id.* at 2.

met to satisfy the proposed substitute claim, but rather that the combination applied to the claim would not render the claim obvious because that combination necessarily would include text.

Patent Owner acknowledges that "the Namias kiosk first uploads the video (which does not include any text) to Saffer's video server." MTA Reply 2. Patent Owner goes on to argue that

> Saffer's video server then sends Namias's video kiosk a *textual* 'video ID' corresponding to that uploaded video. Namias's video kiosk then will 'insert [that *textual*] video ID along with a [*textual*] URL or link to the video server into the code and/*or text* of the e-mail message. Finally, Namias's video kiosk will transmit to email server the email containing both (1) the header information with the recipient identifier and (2) the media content with the *textual* URL link and video ID that allows the recipient to view the video.

Id. (quoting Ex. 1004 ¶ 27) (internal citations omitted). Thus, Patent Owner asserts that "[t]his email necessarily contains the claimed 'message content that includes a text'—at least the *textual* URL link and video ID, as shown in Saffer Fig. 8." *Id.* at 2. Further Patent Owner contends that "[a]ny combination that eliminates the textual message body would make Saffer inoperable and/or unsuitable for its intended purpose." *Id.* at 3.

Petitioner contends and we agree that this argument mischaracterizes what Petitioner asserts in the prior art to be the claimed "message content." *See* MTA Sur-Reply 2. As we determined above, the broadest reasonable interpretation of the phrase "message content including a media component" does not encompass a URL in a message. *Supra* § II.C. Thus, the URL link, which includes the video ID, would not constitute "message content that includes a text." In addition, Petitioner contends that

> [t]he plain language of substitute claim 34 makes clear that the two new limitations are only triggered 'if ***the*** message content includes a text,' with "the message content" referring back to the earlier step of claim 34 reciting, "associating **a** message content, including a media component, with the electronic message via a first display at a sending user device.

MTA Sur-Reply 1. Petitioner asserts that "[t]he 'message content' that can potentially trigger the contingent limitation, therefore, is the same message content that was associated with the electronic message via the 'first display.'" *Id.* (emphasis omitted). Petitioner relies on Namias's video message as the message content and Namias's video message does not include text. *See* MTA Reply 2 (Patent Owner acknowledging that Namias's video message does not include text). Therefore, we determine that the proposed Namias, PC Magazine, Saffer, and Smith combination does not "necessarily" include text within the message content, as Patent Owner contends.

This leaves us to analyze proposed substitute claim 34 in light of the combined teachings of Namias, PC Magazine, Saffer, and Smith – which is a combination that does not necessarily include text. Typically, the prior art need not describe conditional steps set forth in a method claim if, after giving the claim its broadest reasonable construction, the method as claimed does not invoke them. *See Cybersettle, Inc. v. Nat'l Arbitration Forum, Inc.*, 243 F. App'x 603, 607 (Fed. Cir. 2007) ("It is of course true that method steps may be contingent. If the condition for performing a contingent step is not satisfied, the performance recited by the step need not be carried out in order for the claimed method to be performed."). Proposed substitute claim 34 is broad enough to cover a method which does not include text. *See In re Johnston*, 435 F.3d 1381, 1384 (Fed. Cir. 2006) ("[O]ptional elements do

not narrow the claim because they can always be omitted."). This is true because the plain language of the claim includes the conditional word "if" and, as Patent Owner acknowledges, these "two new limitations . . . are triggered 'if the message content includes a text.'" MTA Reply 1; *see Ex parte Schulhauser*, Appeal 2013-007847, 2016 WL 6277792, at *2–6 (PTAB Apr. 28, 2016) (precedential) (interpreting similar "if" conditional language in a method claim). Therefore, because the inclusion of text is a conditional event that may not occur (the message content may be, for example, just a video without text), the text is optional. As such, the prior art does not need to disclose the two proposed amendments in order to meet the limitations of proposed substitute claim 34.

For the foregoing reasons, we agree with Petitioner that proposed substitute claim 34 would have been obvious over Namias, PC Magazine, Saffer, and Smith for the same reasons discussed above with respect to claim 1. Therefore, Petitioner has established, by a preponderance of the evidence, that proposed substitute claim 34 is unpatentable under 35 U.S.C. § 103(a) over Namias, PC Magazine, Saffer, and Smith.

C. Definiteness/Obviousness of Proposed Substitute Claim 35

Patent Owner proposes substitute claim 35 as a replacement for original claim 2. MTA 2–3. Proposed substitute claim 35 is reproduced below with annotations showing amendments:

> 35. A computer-implemented method according to claim **34[1]**,
> wherein the media component is not displayed via the second display with the identifier of a recipient**,**
> **wherein the message content includes a text, and said text is not displayed via the second display with the identifier of a recipient; and**

wherein said correlation does not identify a recipient and is not message content.

Id. at ii (Claims Appendix). Proposed substitute claim 35 depends from proposed substitute claim 34 and recites further limitations as to the handling of a message content that includes text. Petitioner makes several arguments as to the unpatentability of this proposed substitute claim. First, Petitioner asserts that the phrase "wherein said correlation . . . is not message content" is indefinite under 35 U.S.C. § 112. MTA Opp. 5–11. Second, Petitioner contends that proposed substitute claim 35 would have been obvious under 35 U.S.C. § 103(a) over Namias, PC Magazine, Saffer, Smith, Frey,[22] and Sadun.[23] *Id.* at 12–23. We address these arguments in turn.

Petitioner asserts that "wherein said correlation . . . is not message content" is an indefinite claim limitation because it lacks proper antecedent basis. *Id.* at 5. There is no article in front of the term "message content." According to Petitioner, the claim is unclear as to whether it is referring to the message content recited in proposed substitute claim 34 or some other message content. *Id.* at 5–6. We are not persuaded by this argument.

Whether this claim, despite its lack of explicit antecedent basis for "message content," nonetheless has a reasonably ascertainable meaning must be decided in context. *See Energizer Holdings, Inc. v. Int'l Trade Comm'n*, 435 F.3d 1366, 1370 (Fed. Cir. 2006). "Claim definiteness is analyzed 'not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing

[22] International Patent Application Publication No. WO 00/58850, published October 5, 2000 (Ex. 1052, "Frey").
[23] Erica Sadun, DIGITAL VIDEO ESSENTIALS (2003) (Ex. 1053, "Sadun").

the ordinary level of skill in the pertinent art.'" *Id.* (quoting *In re Moore*, 439 F.2d 1232, 1235 (1971)). Patent Owner asserts that one of ordinary skill in the art would have understood the lack of an article to preface the "message content" to mean that the correlation could not be message content of any kind (not just the specific message content of claim 34). MTA Reply 4. We find that Patent Owner's argument goes too far because claim 35 is not directed to "message content of any kind." Claim 34 is directed to a method of handling an electronic message. The first step of claim 34 associates "a message content" with "the electronic message." MTA i (Claims Appendix). Claim 35 recites a method "according to claim 34." As such, we determine that one of ordinary skill in the art would have understood claim 35 to be further addressing the handling of the electronic message of claim 34. As noted, claim 34's electronic message is associated with "a message content" and our review of the record provides us with no evidence that one of ordinary skill in the art would have disassociated the only recited message content from the recited electronic message. We determine that one of ordinary skill in the art would have understood claim 35 to be referring to the message content associated with the electronic message of claim 34. Therefore, we do not find claim 35 to be indefinite due to a lack of antecedent basis for "message content."

Next, Petitioner asserts that claim 35 would have been obvious over the grounds previously asserted[24] against claim 1 with the addition of Frey

[24] Petitioner relies on both its challenges based on Namias, PC Magazine, Saffer, and Smith; and Namias, PC Magazine, RFC 2821, and Hazel. We did not reach Petitioner's challenge based on Namias, PC Magazine, RFC 2821, and Hazel and likewise need not refer to that challenge in our discussion of the patentability of proposed substitute claim 35.

and Sadun. Petitioner asserts and we agree that claim 35 requires the satisfaction of the conditional limitations of claim 34 because it triggers those limitations due to its requirement that "the message content includes a text." MTA Opp. 12. Above, we provided a full discussion of Petitioner's assertion that claim 1 would have been obvious over Namias, Saffer, PC Magazine, and Smith. *Supra* § II.D. We address herein the proposed amended limitations and Petitioner's assertions as to why claim 35 including those limtiations would have been obvious over that combination of references with Frey and Sadun.

Frey is directed to "an improved interactive photo kiosk for creating, storing and distributing electronic images, audio messages, and text messages electronically." Ex. 1052, 3:11–13. One of the objects of Frey is "to have a device which can create an electronic image of the user and to which the user can selectively add textual messages, audio data, and other visual images to the electronic image." *Id.* at 2:5–7. As described in Frey, "the user can transmit the electronic image created, as well as any added text message, audio data, and other visual image, via electronic transmission, such as over the Internet." *Id.* at 2:8–10. Frey's CPU obtains an image for a photo greeting and then "informs the user via the monitor and/or speaker that the user has the option of adding a banner to the image or having no banner added to the image." *Id.* at 6:11–12. If selected, the banner is superimposed on the image and may be composed of predetermined text (e.g., "Having A Great Vacation") or user created text. *Id.* at 6:12–18. Frey discloses "combining said electronic image, said optional banner message, said optional text message, and said optional audio message into one electronic file" before transmission. *Id.* at 16:2–5.

Sadun is a book titled "Digital Video Essentials: Shoot, Transfer, Edit, Share." Ex. 1053. This textbook "offers a complete introduction to video filming and production." *Id.* at 19. Petitioner directs us to Sadun's discussion of "[o]verlay[ing] text and pictures." *Id.* at 24. Specifically, Sadun describes that "VideoStudio's Overlay and Title steps allow you to add text, images, or video to display over your footage." *Id.* at 36.

Petitioner's allegations may be summarized as follows: Petitioner relies upon the disclosures of Namias, PC Magazine, Saffer, and Smith to teach the elements of proposed substitute claim 35 (and its independent claim proposed substitute claim 34) that are the same as claim 1. MTA Opp. 12. Petitioner supplements those disclosures discussed above with disclosures from Frey and Sadun. Specifically, Petitioner argues that "it would have been obvious in view of Frey and Sadun to adapt Figure 4A of Namias ('first display') to allow a text banner to be added or overlaid on top of the video (or picture) message content." *Id.* at 13 (emphases omitted). Petitioner points out that Frey and Namias are both directed to photo kiosks, but that Frey has the additional feature of being able to add text to the picture as a banner or an overlay prior to transmission. *Id.* at 13–14 (quoting Ex. 1052, 6:3–7:6). Petitioner further argues that "Sadun makes clear that superimposing text onto a video was a basic video-editing technique that had been offered by existing commercial software." *Id.* at 15 (citing Ex. 1053, 24). As such, Petitioner asserts that the combination of Namias, Frey, and Sadun would lead one of ordinary skill in the art to adapt Namias's first display (Fig. 4a) such that text would be "allow[ed] . . . to be overlaid onto the video (or picture) message content, and thereby associated with the video (or picture) message." *Id.*

Petitioner further argues that the disclosures of Frey and Sadun would have taught one of ordinary skill in the art to save the combined video and text into a single file prior to transmission. *Id.* at 20–21 (citing Ex. 1053, 157; Ex. 1052, 16:2–5; 15:15–16). Thus, Petitioner asserts that the cited references would have taught one of ordinary skill in the art to transmit the text and data as a single file in order to simplify the transmission such that the manner of transmission would not be dependent upon the contents of the files being transmitted. *Id.* at 21. In other words, transmissions would be the same regardless of whether text was included with the message. According to Petitioner, another advantage of combining the text and video into a single file prior to transmission would be that the viewing experience of the recipient would be the same regardless of whether text was included. *Id.* Petitioner's arguments are supported by the testimony of Dr. Chatterjee. *See* Ex. 1043 ¶¶ 77–100.

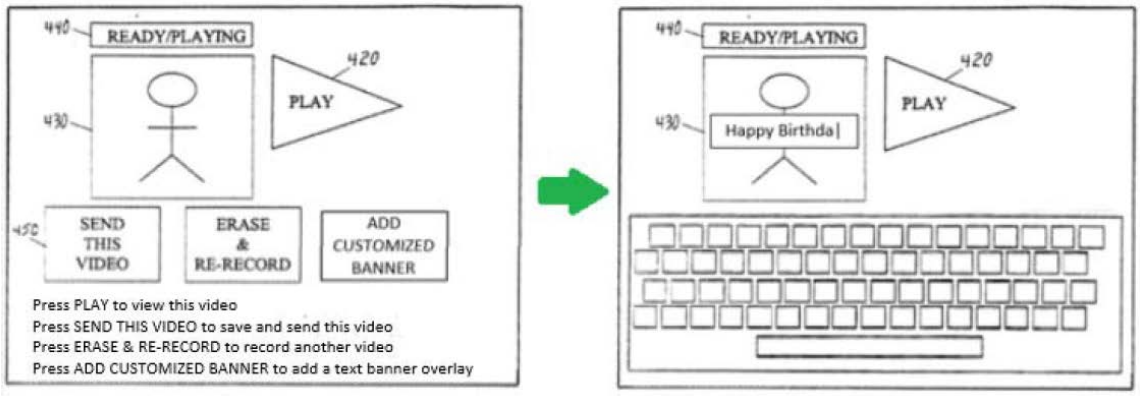
In response to Petitioner's assertions, Patent Owner repeats several of its arguments that were considered in relation to the analysis of Petitioner's challenge to claim 1. First, Patent Owner asserts that several of the references (including Saffer and Frey) include a unified email that transmits both the message content and the recipient identifier together. MTA Reply 7–8. As discussed above in conjunction with claim 1, however, Petitioner is relying on Namias to teach the recited separate displays and relying on Saffer to teach the recited separate transmissions. *See supra* § II.D.5.e. The additional modification here is that Petitioner also is relying on Frey and Sadun to teach that the video message could include overlaid text. MTA Opp. 20. Contrary to Patent Owner's assertion, however, Frey's disclosure of a unified email that includes both the recipient information and message

content does not teach away or otherwise take away from teachings relied upon from Saffer. As discussed above, Saffer discloses a method by which a video ID is obtained from the server, the video is renamed using that video ID, the renamed video is uploaded to the server, the sending device inserts a link to the uploaded video (URL) into an email, and then finally the sending device sends the email containing the link (but not the content) to an email server. Pet. 28–29; Ex. 1004 ¶¶ 4, 27, 29, 44, Fig. 3. Petitioner is relying on this process to teach the recited separate transmissions. Petitioner's assertion with respect to proposed substitute claim 35 is that the video and text are combined into a single file and that file is then transmitted per Saffer's method. MTA Opp. 20–21. Thus, we are persuaded that the cited art teaches the recited separate transmissions.

Next, Patent Owner contends that the cited art fails to teach a "correlation." MTA Reply 8–9. Here, Patent Owner relies on the same arguments discussed above in relation to claim 1. *Id.* at 9 (stating that Saffer's video ID is not the recited correlation and then citing Patent Owner's Response and Sur-Reply). We do not find this argument to be persuasive for the same reasons discussed above. *See supra* § II.D.5.f. For the same reasons discussed above, we determine that Petitioner has shown sufficiently that the cited art teaches the recited correlation. *Id.*

Finally, Patent Owner asserts that a person of ordinary skill in the art would not have combined the references in the manner proposed by Petitioner. MTA Reply 5–7. Petitioner contends that it would have been obvious to combine Namias, Frey, and Sadun because "[t]he combination would have predictably resulted in the messaging system of Namias in which the screen shown in Figure 4A is adapted to allow text to be overlaid

onto the video (or picture) message content, and thereby associated with the video (or picture) message, according to the techniques of Frey and Sadun." MTA Opp. 16. Dr. Chatterjee annotated Namias's Figure 4A to show what the interface of the combined system would look like (*id.*).



Above are the annotated Figures 4A of Namias as prepared by Dr. Chatterjee. Ex. 1043 ¶ 87. "On the left, Figure 4A of Namias is shown as being adapted to include a button to 'ADD CUSTOMIZED BANNER.' Upon pressing that button, as shown on the right, Figure 4A transitions to allow a text banner (e.g., 'Happy Birthday') to be added on top of the video content." *Id*. Petitioner argues that one of ordinary skill in the art would have been motivated to provide users with the option to add banner text (as taught by Sadun and Frey) to Namias's video in order to make for "a more compelling and powerful message." MTA Opp. 17 (citing Ex. 1043 ¶ 88).

Patent Owner contends that Petitioner's need for a six-reference combination in order to assert that this claim is unpatentable speaks to the high degree of hindsight being applied by Petitioner. MTA Reply 5. Patent Owner argues that any alleged simplicity to be gained from Namias's screens is lost due to the additional elements added to the screen as proposed by Dr. Chatterjee. *Id.* at 6. Patent Owner also asserts that there is no

support for Petitioner's contention that adding text makes the message more powerful and compelling. *Id.*

Petitioner responds by asserting that the benefits of combining image and text are undisputed. MTA Sur-Reply 6–7. Petitioner further asserts that "adding text overlay functionality to Figure 4A of Namias does not necessarily detract from its simplicity," but rather only augments existing editing functions. *Id.* at 7.

We are persuaded that Petitioner has shown sufficiently that one of ordinary skill in the art would have been motivated to combine the cited references. We agree that the combination of references would have entailed applying known methods and obtaining predictable results. *See* MTA Opp. 16. Sadun is an introductory textbook in the field of video editing and production. Ex. 1053, 19. Thus, we are persuaded that this is the sort of text that one of ordinary skill in the art would turn to in order to determine functionality that should be provided in the video messaging system. Namias itself recognizes that text is the traditional form for email communication and it sought to provide a method of communication that was not "confined to textual or other limited communications." *See* Ex. 1003 ¶¶ 6, 9. As such, we are persuaded that one of ordinary skill in the art would have been motivated to improve upon the messaging of Namias by adding overlaid text capabilities per Frey and Sadun.

In view of the foregoing, we determine that Petitioner has demonstrated by a preponderance of the evidence that the subject matter of proposed substitute claim 35 would have been obvious over Namias, PC Magazine, Saffer, Smith, Frey, and Sadun.

D. Asserted Unpatentability of Proposed Substitute Claims Under § 101

As discussed above, we find that Petitioner has established by a preponderance of the evidence the unpatentability of proposed substitute claims 34 and 35 as obvious over the cited art. In light of that determination, we do not address Petitioner's assertions of unpatentability under 35 U.S.C. § 101.

IV. CONCLUSION

Petitioner has demonstrated, by a preponderance of the evidence, that, under 35 U.S.C. § 103(a), claims 1, 2, and 6–8 are unpatentable over Namias, PC Magazine, Saffer, and Smith and claim 3 is unpatentable over Namias, PC Magazine, Ford, Saffer, and Smith. In light of our determination of unpatentability of claims 1–3 and 6–8, 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 (claims 1, 2, and 6–8) or over Namias, PC Magazine, Ford, RFC 2821, and Hazel (claim 3). Petitioner also has established by a preponderance of the evidence the unpatentability of Patent Owner's proposed substitute claims 34 and 35.

V. ORDER

Accordingly, it is

ORDERED that claims 1–3 and 6–8 of U.S. Patent No. 9,313,156 B2 have been shown to be unpatentable; and

FURTHER ORDERED that Patent Owner's Motion to Amend is *denied.*

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.

Trials@uspto.gov
571-272-7822

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SNAP INC.,
Petitioner,

v.

VAPORSTREAM, INC.,
Patent Owner.

Case IPR2018-00458
Patent 9,313,156 B2

Before STEPHEN C. SIU, JUSTIN T. ARBES, and STACEY G. WHITE, *Administrative Patent Judges*.

Opinion Concurring filed by *Administrative Patent Judge* SIU.

I join the majority in its conclusion that Petitioner has demonstrated by a preponderance of the evidence that claims 1, 2, and 6–8 are unpatentable under 35 U.S.C. § 103(a) over Namias, PC Magazine, Saffer, and Smith and claim 3 is unpatentable under 35 U.S.C. § 103(a) over Namias, PC Magazine, Ford, Saffer, and Smith. I write separately to provide logical reasoning supporting this conclusion.

Petitioner argues that the combination of Namias, PC Magazine, Saffer, and Smith discloses or suggests claim limitations recited in claim 1. I agree with Petitioner for at least the reasons set forth in the Decision on Institution. *See*, *e.g.*, Paper 10, 9–27. For example, as Petitioner points out,

Namias discloses "screens provided by the kiosk during its operation" including a "preview screen . . . that appears after the sender has recorded a video" (a "first display") and a '"preview screen 400' that appears after the sender has recorded a video.'" (i.e., a "second display"). Pet. 18–19 (citing Ex. Namias ¶¶ 23–29, Figs. 2, 3, 4A, 4B, 5, 6, 7). Hence, based at least on Namias, one of ordinary skill in the art would have understood that it was known in the prior art to have provided at least a "first" and a "second" display. I agree with Petitioner.

Patent Owner argues that Namias and Saffer fail to disclose a first display and a (separate) second display, as recited in claim 1, because Saffer discloses a "single email composition display screen" that is "far more efficient, robust, and less likely to cause navigational trauma" than "Namias's multi-screen navigation flow" such that "a skilled artisan [would not] select the Namias interface." PO Resp. 53. In other words, Patent Owner argues that it would not have been obvious to one of skill in the art to have provided a first and second display, as disclosed by Namias, because a single display disclosed by Saffer is supposedly better. I am not persuaded by Patent Owner's argument at least because even assuming that a single display of Saffer provided certain advantages over the first and second display of Namias, as Patent Owner contends, a disclosure of a single display by Saffer does not negate the disclosure of Namias. In other words, one of skill in the art would have known the practice of providing a first and second display (of Namias) and would not have become unaware of such a practice merely because Saffer allegedly discloses an alternative use of a single display. Nor does Patent Owner assert or demonstrate persuasively that either one of Namias or Saffer discourages the use of multiple displays.

On the contrary, Namias, at least, explicitly discloses the use of multiple displays.

Petitioner argues that Namias and Saffer discloses transmitting message content separately from transmitting an identifier of a recipient. In particular, Petitioner argues that Saffer discloses a "sending device [that] uploads [a] video file to the video server" and that "[a]fter the upload, the sending device inserts a link [or URL] into the body of the email message" and "sends the email containing the link (but not containing the previously-uploaded video content) to an email server." Pet. 28–29. I agree with Petitioner.

Patent Owner argues that the combination of Namias and Saffer fails to disclose transmitting message content and transmitting the identifier of a recipient separately, as recited in claim 1 (PO Resp. 40), because Saffer discloses transmitting "both the recipient's email address and a public URL . . . to access a video," that a URL must be "message content" because the '156 patent supposedly discloses "that a linked file may qualify as message content," and that "[a]ny reasonable interpretation of 'message content including a media component' must encompass what the '156 specification expressly discloses is included . . . includ[ing] linked content, such as a video file accessible via Saffer's URL." PO Resp. 41–43 (citing Ex. 1001, 7:66–8:1 – "message content . . . may include . . . [a] linked file"). In other words, Patent Owner argues that Namias and Saffer disclose transmitting an identifier of a recipient with a URL and that a URL, according to Patent Owner, is "message content" such that the identifier of a recipient is transmitted with (and not separate from) "message content."

I am not persuaded by Patent Owner's arguments at least because Patent Owner does not argue persuasively that a "URL" must include or be characterized as "message content." Contrary to Patent Owner's contention, the '156 patent discloses an example in which "message content . . . may include" a linked file and does not disclose that "message content" is defined by including a URL. Even assuming that the '156 patent discloses that message content must include a linked file (it does not), one of skill in the art would have understood that a "URL" (or Universal Resource Locator) identifies (or "locates") a file (i.e., a "linked file") and is not the linked file itself.

Claim 1 recites that the identifier of a recipient and the message content each including a correlation. Petitioner argues that Saffer discloses an email message to a recipient with a URL that includes a "video ID," the "video ID" being the name of a corresponding video file that contains content. Pet. 38–41. Hence, Saffer discloses that the content (i.e., video) includes a correlation (i.e., a "video ID" or name of the video file).

Petitioner also argues that Smith, like Saffer, discloses an email message to a recipient with a URL and that the URL contains a "store item identifier" (i.e., a correlation for content) and a "recipient identifier 333" (i.e., an identifier of a recipient). Pet. 41–43. Hence, Saffer and Smith both disclose sending an email message to a recipient, the email message containing a URL that identifies message or video content (i.e., a URL containing a video ID) and Smith further discloses that one of skill in the art would have understood that the URL may also include an identifier that identifies the recipient (i.e., an identifier of a recipient) such that the

identifier of a recipient (or URL) includes a correlation (e.g., "store item identifier"). I agree with Petitioner.

Patent Owner argues that a "correlation" is "data corresponding to a message used to associate two components of a message" and that Namias, Saffer, and Smith fail to disclose the identifier of a recipient and the message content "each including a correlation," as recited in claim 1, because, according to Patent Owner, "the '156 specification does not teach that the correlation (*e.g.*, message ID in the '156 Patent) is a hyperlink." PO Resp. 43 (citing Ex. 1001, 8:17–21). In other words, Patent Owner argues that the claimed "correlation" must not include a URL. I am not persuaded by Patent Owner's argument because claim 1 does not recite that the "correlation" must not be a "URL." Also, contrary to Patent Owner's contention, the '156 patent discloses "a variety" of examples of a "correlation" but does not disclose that a "correlation" must not be a "URL." Ex. 1001, 8:17–20.

Patent Owner argues that Saffer and Smith fails to disclose a "correlation" that is "stored with the recipient identifier information." PO Resp. 50. Hence, Patent Owner appears to argue that the combination of Saffer and Smith fails to disclose that the identifier of a recipient includes a "correlation," as recited in claim 1. I disagree with Patent Owner for at least the reasons set forth by Petitioner and discussed above. For example, as Petitioner explains and as discussed above, Smith discloses a "URL" containing a "recipient identifier" (and "store item identifier"). Patent Owner does not explain a sufficient difference between the "recipient identifier" of Smith and the claimed "identifier of a recipient."

Petitioner argues that it would have been obvious to one of ordinary skill in the art to combine the teachings of Namias and Saffer at least because not only are Namias and Saffer "analogous references in the same field" that both disclose "methods for recording and sending video messages using email," but also, that the combination of the known feature of using a first and second display (e.g., "the Namias user interface (*e.g.*, Fig. 4A and Fig. 5)") with the known feature of "effectuat[ing] the actual transmission and delivery of the video message" using a Video ID (Saffer) would have resulted in no more than the predictable and expected result of using a user interface to effectuate transmission and delivery of a message with a Video ID. Pet. 33–35. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007). In addition, Petitioner enumerates various known advantages of using a "URL-based delivery technique" (e.g., Saffer or Namias) in transmitting messages with a first and second display (e.g., Namias). Pet. 35–36.

Patent Owner argues that it would not have been obvious to combine the teachings of Namias and Saffer because "there is no practical scenario where Saffer's link-based email transmission system conserves bandwidth or storage," "Namias would . . . have to transmit . . . recorded video to the video server, requiring use of . . . bandwidth," "there is no bandwidth reduction or storage savings" by "[r]eplacing Saffer's sender device with Namias's video email kiosk," "bandwidth savings [from the combination of Namias and Saffer] . . . is only realized if the recipient never watches the video in its entirety," and that "a person skilled in the art . . . designing a message exchange system that transfers media content using less bandwidth"

would not "look to Namias as a piece of that solution" and that there is "no reason – other than hindsight – why" one of skill in the art "would choose Namias's user interface over Saffer's user interface." PO Resp. 28–31, 33–34. In other words, Patent Owner argues that it would not have been obvious to one of skill in the art to have combined the teachings of Namias and Saffer because doing so would not result in a savings in bandwidth usage and because one of skill in the art would have chosen to use Saffer's user interface over the user interfaces of Namias.

I am not persuaded by Patent Owner's arguments at least because, as previously discussed, it would have been obvious to one of skill in the art to have combined a known use of first and second displays (Namias) with the known process of transmitting data responsive to user input in a display to achieve a known, predictable, and expected result of data transmission in response to input via displays regardless of the degree of savings in bandwidth usage or whether or not one of skill in the art would have arguably preferred one alternative of display screens over another. In other words, as previously explained, a known and obvious procedure (the use of first and second displays) does not become unknown or non-obvious merely because of the presence of a disclosure of an alternative embodiment.

To the extent that Patent Owner argues that it would not have been obvious to one of ordinary skill in the art to have bodily incorporated the display of Saffer into the system of Namias (or vice versa), I note that "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference . . . Rather, the test is what the combined teachings of those references would have

suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Patent Owner argues that bodily incorporating the user interface of Saffer into the system of Namias (or vice versa) does not constitute bodily incorporation of elements because, according to Patent Owner, "Patent Owner is not arguing that Saffer's entire system must be bodily incorporated into Namias's system" but is merely arguing that "if a skilled artisan were motivated to combine Namias and Saffer . . . he or she would look to the entirety of those references, and would logically choose Saffer's single email composition display screen . . . over Namias's less capable multiple email composition display screens." PO Resp. 38–39. In other words, Patent Owner argues that bodily incorporating the user interface of Saffer into the system of Namias (or vice versa) is not bodily incorporation because Saffer's user interface is somehow superior to that of Namias. I am not persuaded by Patent Owner's arguments at least because, even assuming that the user interface of Saffer is somehow preferred over the user interface of Namias, bodily incorporating a display of one system (e.g., the displays of Namias) into another system (e.g., the system of Saffer) is still bodily incorporation of elements of one reference into another even if one of the displays is better than the other for some reason.

Petitioner argues that it would have been obvious to one of ordinary skill in the art to have combined the teachings of Saffer and Smith because, not only are "Smith, Namias, and Saffer . . . analogous references in the same field of delivering content by using email [and] . . . similar techniques for delivering content using URLs," but also using "the recipient identifier" of Smith in the URL of Saffer would enable the user to "identify the specific

recipient," among other potential benefits. Pet. 47–48. I also agree with Petitioner that it would have been obvious to one of skill in the art to have combined the known feature of sending an email to a recipient that includes a URL containing an identifier of data content (i.e., "video ID") (either one of Saffer or Smith) with the known feature of including a "recipient identifier" in a URL (e.g., Saffer) to achieve the predictable and expected result of sending an email containing a URL (Saffer and/or Smith) that identifies data content intended for a recipient (Saffer and/or Smith) and an identifier for the recipient to receive the data content (Smith). "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).

Patent Owner argues that it would not have been obvious to one of ordinary skill in the art to have combined the teachings of Saffer and Smith because "providing a recipient identifier in the message ID of the '156 Patent flies directly in the face of the '156 disclosure," including a recipient identifier "with Saffer's URL" would supposedly be disadvantageous, and "appending the recipient identifier to the video ID at the sending user is inconsistent with the teachings of Smith." PO Resp. 50–51. I am not persuaded by Patent Owner's argument at least because I do not agree with Patent Owner that Petitioner's explanation pertaining to combinability of the disputed references "flies directly in the face of the '156 disclosure." Nor does Patent Owner explain any plausible substantive disadvantages of "including a recipient identifier" in a URL (e.g., Smith includes a recipient identifier in a URL and does not disclose any specific disadvantages of doing so) or explain any specific "inconsistencies" with "appending the

recipient identifier" in a URL. For example, Smith "appends" the recipient identifier in a URL and does not disclose any specific "inconsistencies" in doing so.

To the extent that Patent Owner argues that it would not have been obvious to one of ordinary skill in the art to have bodily incorporated the URL or "recipient identifier" of Smith into a URL of Saffer, I would note that "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference . . . Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Petitioner further argues that claims 2 and 6–8, which depend from claim 1, are unpatentable under 35 U.S.C. § 103(a) over Namias, PC Magazine, Saffer, and Smith and claim 3 is unpatentable under 35 U.S.C. § 103(a) over Namias, PC Magazine, Saffer, Smith, and Ford. Pet. 49–54. I agree. Patent Owner does not provide additional arguments in support of claims 2, 3, and 6–8 or arguments with respect to Ford.

The above discussion addresses all the claims on appeal and are dispositive, rendering it unnecessary to reach the propriety of any remaining contentions. *See Beloit Corp. v. Valmet Oy*, 742 F.2d 1421, 1423 (Fed. Cir. 1984); *see also Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999). *See also In re Gleave*, 560 F.3d 1331, 1338 (Fed. Cir. 2009).

Hence, I would conclude that Petitioner has demonstrated by a preponderance of the evidence that the challenged claims are unpatentable for at least the reasons set forth in the concurrence.

MOTION TO AMEND

I join the majority in its ultimate denial of Patent Owner's motion to amend. I write separately to provide logical reasoning supporting this denial.

Patent Owner filed a contingent motion to substitute claims 1 and 2 with proposed claims 34 and 35, respectively, if claim 1 is found unpatentable. Paper 19.

Regarding Petitioner's proposed obviousness challenge of proposed claims 34 and 35, Patent Owner argues that Namias and Saffer fail to disclose "header information having a recipient identifier," as recited in substitute claim 34 (corresponding to original claim 1). Paper 19, 14. Hence, Patent Owner argues that Namias and Saffer fail to disclose "the identifier of a recipient being part of a header information," as recited in claim 34 (and original claim 1). This issue was previously addressed. For example, as Petitioner previously explained, Namias discloses a "recipient's email address" corresponding to the claimed "identifier of a recipient." Pet. 23. I am not persuaded by Patent Owner's argument.

Patent Owner argues that Namias and Saffer fail to disclose "message content having text" and Namias fails to "permit a user to enter message content with 'text,' as recited in substitute claims 34–35." Paper 19, 14. Claim 35 recites "message content includes a text." I am not persuaded that Namias and Saffer fail to at least suggest this feature. Namias discloses that message content "traditionally" included "text messages," that "any type of digital information" was "capable of" being transmitted" "including digital audio, graphics, and video," and further explains the goal of including "video clips and messages on the Internet" and "video communication" to

"expand" "network capabilities" "as a method of personal communication." Ex. 1003 ¶¶ 6–9. Given that transmitting message content with "text messages" was already known and practiced in the art and that the goal of Namias is to "expand" methods of "personal communication" by *including* additional forms of message content, such as "video communication," it would have been obvious to one of skill in the art to have transmitted message content including any known form of data such as "video communication" or "text."

Even assuming that Namias does not explicitly disclose that the "video" being transmitted must include "text," given that it was previously known to transmit "text" in message content and the desire to "expand" (and not limit) communication capabilities, it would have been obvious to *include* additional known forms of message content (i.e., add video) and not to have *excluded* known forms of message content (which would defeat efforts to "expand" communication capabilities).

Saffer further confirms that it would have been obvious to one of ordinary skill in the art to include video in message content and not to exclude previous forms of message content (such as text). For example, Saffer discloses a system "in which a user can send . . . full-motion video and audio . . . , along with (if desired) the text messages to an e-mail recipient." Ex. 1004, Abstract. In other words, Saffer confirms that it would have been known to one of ordinary skill in the art that message content may include different types of content, including video or text (or audio).

Patent Owner argues that "Saffer displays both [header information and message content] simultaneously" and "does not separately transmit header information and message content with text (as per claims 34–35)."

Paper 19, 15. As previously discussed, I am not persuaded by Patent Owner that the combination of Namias and Saffer fails to disclose transmitting header information (e.g., an identifier of a recipient) and message content separately or that message content may include text. See previous discussion above.

Patent Owner argues that "Saffer fails to disclose a 'correlation' that neither identifies a recipient and is not message content as per substitute claim 35." Paper 19, 15. As previously discussed, I disagree with Patent Owner that the combination of Namias, Saffer, and Smith fails to disclose a "correlation." To the extent that Patent Owner now argues that Saffer alone fails to disclose a "correlation," I note that the proposed ground of unpatentability is based on the combination of Namias, Saffer, and Smith and not on Saffer in isolation.

Petitioner argues that claim 35 (and claim 34 from which claim 35 depends) is also unpatentable over the combination of Namias, PC Magazine, Saffer, Smith, Frey, [25] and Sadun.[26] Paper 23, 12–23. Claim 35 recites message content includes a text, and the text is not displayed via the second display. Petitioner argues, for example, that Namias discloses a "first display," that Frey discloses "capture of an image" and "allows a text message banner to be added to the captured image," and that Sadun discloses "that superimposing text onto a video was a basic video-editing technique that had been offered by existing commercial software." Paper 23, 13–15 (citing Frey 6:3–7:6, Ex. 1053, Fig. 7.13, 24, 36, 37).

[25] WO 00/58850, Published October 5, 2000 (Exhibit 1052, "Frey").
[26] Sadun, Erica, "Digital Video Essentials," 2003 (Exhibit 1053, "Sadun").

Petitioner further argues that it would have been obvious to one of ordinary skill in the art to have combined the teachings of Namias, Frey, and Sadun because "Namias, Frey, and Sadun are all analogous references" and because "[t]he combination would have predictably resulted in [a] messaging system . . . [that] allow[s] text to be overlaid onto the video (or picture) message content." Paper 23, 16. Petitioner further argues that it would have been obvious to one of ordinary skill in the art to have combined the teachings of Namias, Frey, and Sadun to achieve various benefits (e.g., "make for a more compelling and powerful message," "add humor to the sender's message," or "market forces . . . [to] adapt a text overlay feature"). Paper 23, 17–18.

Patent Owner argues that it would not have been obvious to one of ordinary skill in the art to have combined the known feature of providing header information and a media component in first and second displays that are not displayed at the same time (e.g., Namias) and the known feature of providing text in the media component (e.g., Frey, Sadun, or Namias) to achieve the predictable and expected result of "allowing text to be overlaid onto the video (or picture) message content" because, according to Patent Owner, such a combination "flies in the face of the alleged 'simplicity' . . . [alleged to be] motivation." Paper 27, 6. However, contrary to Patent Owner's contention, demonstrating obviousness of combining references does not require a showing of "simplicity" of the combination of references.

In addition, even assuming that "simplicity" is somehow required, as Petitioner points out, "the banner in Frey is 'text' message content that gets superimposed on the . . . image" (Paper 23, 14) and "Sadun makes clear that superimposing text onto a video was a basic video-editing technique that had

been offered by existing commercial software." Paper 23, 14–15. Petitioner and Patent Owner do not indicate that Frey also discloses that superimposing "text" on message content is "complex" (or not "simple"). Nor does Sadun disclose that a "basic video-editing technique" of "superimposing text onto a video" was "complex" (or not "simple"). One of skill in the art would have understood that a "basic" technique would not have been overly "complex" in relation to the level of skill in the art, the technique being "basic."

Patent Owner argues that it would not have been obvious to one of ordinary skill in the art to have combined the teachings of Frey or Sadun with those of Namias because there is "nothing in Namias regarding the inclusion of any textual messages" and that "adding text emphasizes Petitioner's hindsight-driven approach." Paper 27, 6. I am not persuaded by Patent Owner's argument at least because Petitioner relies on the combination of Namias and Frey or Sadun and not on Namias in isolation. Also, as noted above, Namias discloses that transmitting text messages was known in the art. *See, e.g.*, Ex. 1003 ¶ 6 (". . . traditionally used for text messages, e-mail is capable of transferring any type of digital information, including digital audio, graphics, and video").

Patent Owner argues that Frey fails to disclose "separate transmissions." Paper 27, 7–8. However, Petitioner bases the proposed ground of unpatentability on the combination of Namias, Frey, and Saffer (among other references) and not on Frey in isolation. I am not persuaded by Patent Owner's argument.

Hence, I agree with Petitioner that proposed claims 34 and 35 are unpatentable under 35 U.S.C. § 103 as obvious over Namias, PC Magazine, Saffer, and Smith with or without the combination of Frey and/or Sadun.

In addition, Petitioner argues that proposed claim 35 recites "message content," which lacks antecedent basis. Paper 23, 5–11. As Petitioner points out, claim 34 recites a message content and claim 35, which depends from claim 34 recites "message content." In the absence of antecedent basis, the "message content" recited in claim 35 may or may not be the same "message content" recited in claim 34. I would agree with Petitioner that "message content," as recited in claim 35 lacks antecedent basis.

In addition, claim 34 recites that the identifier of a recipient and the message content including a media component each including a correlation. Hence, claim 34 recites that the identifier of a recipient includes a correlation and the message content also includes a correlation. Claim 35, which depends from claim 34 recites "said correlation." It is unclear to which correlation recited in claim 34 "said correlation" of claim 35 refers.

For at least these reasons, I would also agree with Petitioner that claim 35 is unpatentable under 35 U.S.C. § 112, second paragraph as indefinite.

The above discussion addresses all the claims subject to Patent Owner's Motion to Amend and are dispositive, rendering it unnecessary to reach the propriety of any remaining proposed grounds. *See Beloit Corp. v. Valmet Oy*, 742 F.2d 1421, 1423 (Fed. Cir. 1984); *see also Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999). *See also In re Gleave*, 560 F.3d 1331, 1338 (Fed. Cir. 2009).

Hence, I would deny Patent Owner's motion to amend for at least the reasons set forth in the concurrence.

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