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Paper No. 44
April 25, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTERNATIONAL BUSINESS MACHINES CORPORATION,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

Case IPR2015-00092
Patent 6,546,002 B1

Before GREGG I. ANDERSON, JON B. TORNQUIST, and ROBERT J. WEINSCHENK, *Administrative Patent Judges.*

ANDERSON, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

International Business Machines Corporation ("Petitioner") filed a Petition (Paper 2, "Pet.") pursuant to 35 U.S.C. §§ 311–319 to institute *inter partes* review of claims 25–49 of U.S. Patent No. 6,546,002 ("the '002 patent," Ex. 1004). Intellectual Ventures II LLC ("Patent Owner") filed a Preliminary Response. Paper 6 ("Prelim. Resp."). Based on these submissions, on April 27, 2015, we granted the Petition and instituted trial for claims 25, 26, 28, and 30–49 of the '002 patent. Paper 8 ("Institution Decision" or "Dec. Inst.").

After institution of trial, Patent Owner filed a Patent Owner Response. Paper 19 ("PO Resp."). Petitioner filed a Reply. Paper 27 ("Pet. Reply"). In addition, the parties rely upon expert testimony. Petitioner proffered the Declaration of Henry Lieberman ("Lieberman Declaration," Ex. 1001). Patent Owner proffered the Declaration of Dr. Tim Williams ("Williams Declaration," Ex. 2005). A transcript of the deposition of Dr. Williams ("Williams Dep.," Ex. 1032) was submitted by Petitioner. A transcript of the deposition of Mr. Lieberman ("Lieberman Dep.," Ex. 1022) was taken by Patent Owner but filed as an exhibit by Petitioner.

Patent Owner filed a Motion to Exclude Under 37 C.F.R. § 42.64(c) ("Motion," "Mot.," Paper 32). Petitioner filed an Opposition to Patent Owner's Motion to Exclude ("Opposition," "Opp.," Paper 37), and Patent Owner filed a Reply to the Opposition to Motion ("Reply to Opposition," "PO Reply," Paper 38). The Motion is denied for the reasons set out below.

An oral hearing was held on January 15, 2016. The transcript of the consolidated hearing for this case and IPR 2015-00089 has been entered into the record. Paper 43 ("Tr.").

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a). We conclude for the reasons that follow that Petitioner has shown by a preponderance of the evidence that claims 25, 26, 28, and 30–49 of the '002 patent are unpatentable.

B. Related Proceedings

Petitioner advises us that Patent Owner ("IV" in the case listing that follows) has asserted the '002 patent in seven patent infringement lawsuits, none of which name Petitioner as a defendant: (1) *IV v. PNC Fin. Servs. Grp., Inc.*, 2:13-cv-00740 (W.D. Pa.); (2) *IV v. Capital One Fin. Corp.*, 8:14-cv-00111 (D. Md.); (3) *IV v. PNC Fin. Servs. Grp., Inc.*, 2:14-cv-00832 (W.D. Pa.); (4) *IV v. Citigroup, Inc.*, 1:14-cv-04638 (S.D.N.Y.); (5) *IV v. Erie Indem. Co.*, 1:14-cv-00220 (W.D. Pa.); (6) *IV v. Old Republic Gen. Ins. Grp., Inc.*, 2:14-cv-01130 (W.D. Pa.); and (7) *IV v. Highmark, Inc.*, 2:14-cv-01131 (W.D. Pa.). Pet. 1. Petitioner also has filed a petition for an *inter partes* review of claims 1–24 of the '002 patent.[1] *Id.*

C. The '002 Patent

The '002 patent describes a system and method for using a mobile interface agent to access information of a user. Ex. 1004, Abstract. The '002 patent describes using a mobile interface agent that allows a user to "access documents, files, programs, applications, URL bookmarks, IP

[1] The co-pending petition is IPR2015-00089.

addresses, telephone numbers, television channels, radio stations, and other menu items from any computer." *Id.* The information accessed is specific to the user. *Id.*

Figure 15 of the '002 patent is reproduced below:

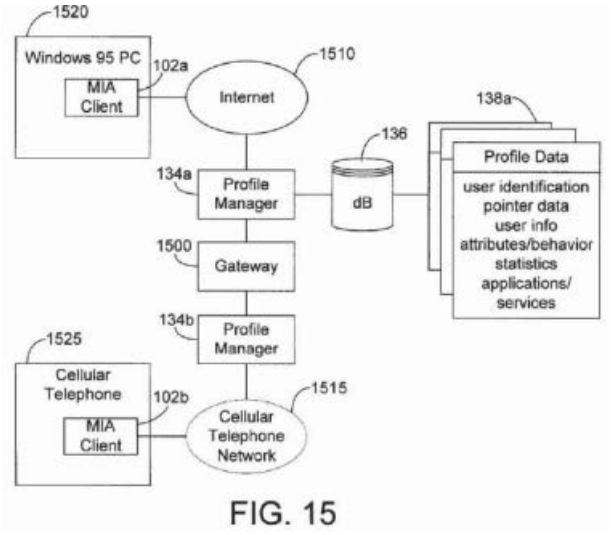


FIG. 15

Figure 15 is a block diagram showing profile managers of multiple communication networks connected by a gateway. Ex. 1004, 5:41–44. Figure 15 shows mobile interface agent ("MIA") 102a running on a Windows 95 PC and MIA 102b running on a cellular telephone. *Id.* at 16:36–54. The MIA of the '002 patent allows "access to a user's menu items (e.g., software programs, applications, files, folders, documents, telephone numbers, radio stations, and television channels), URL bookmarks, and user profile data." *Id.* at 5:58–61. The MIA may also "periodically update or query user profile data, facilitate the sharing of memory and data structures between applications/services both local and remote, allow various types of user interfaces to be attached (voice menu system, humanlike graphical icon, etc.) and perform intelligent multi-platform conversion of application data." *Id.* at 5:62–67.

The MIA "can be accessible using any computer from any geographical location so long as the computer can be connected to a network." Ex. 1004, Abstract. For example, "the mobile interface agent can be accessible using a computer, cable set top box, cellular phone, or other device from any geographical location." *Id.* at 4:44–46.

The '002 patent further explains that during the process of initializing and creating a MIA, "the MIA 102 downloads the appropriate information such as user profile, URL links, applications registered, etc. Some of the information downloaded may depend on the platform, geographical location, etc. that corresponds to the user's connection location." Ex. 1004, 14:50–54. "For example, if a user has purchased a Windows 98 only license for MS Word and moved to an Apple MacOS device, then the MS Word menu item may be disabled or not downloaded." *Id.* at 14:54–57.

Figure 1B is reproduced below:



FIG. 1B

Figure 1B illustrates a menu used by the MIA once a user has logged on to the computer. *Id.* at 5:1–3. The set of menu items included in a MIA are "associated with a user's specific configuration and profile." *Id.* at 14:33–

34. The "menu items/pointers shown in the user interface can be used to access and retrieve user specific resources and information." *Id.* at 6:14–16.

D. Illustrative Claims

Independent claims 25, 34, 40, and 49 are apparatus or system claims. Claims 25 and 40 are illustrative of the challenged claims and are reproduced below.

> 25. A mobile interface used for accessing user specific resources and information stored either on a local computer device or a network server, the mobile interface comprising:
>
> means for interfacing any local computer device with the network server;
>
> means for presenting a plurality of pointers on any local device corresponding to user specific resources and information to a user; and
>
> means for accessing the user specific resources and information using the plurality of pointers.

Ex. 1004, 18:47–57.

> 40. A system for storing and accessing user specific resources and information, the system comprising:
>
> a network for accessing the user specific resources and information stored in a network server;
>
> a local device communicating with the network and having a local memory and a mobile interface, wherein the local memory also includes user specific resources and information, and the mobile interface includes pointers corresponding to the user specific resources and information that are stored either on the local device or the network server, wherein the pointers provide links to access the corresponding user specific resources and information.

Id. at19:47–2:6.

E. Grounds Upon Which Trial was Instituted

Inter partes review was instituted on the following grounds.

(1) claims 25, 26, 30, 31, 34–36, 40–43, and 47–49 as anticipated under 35 U.S.C. § 102 by Richardson; [2]

(2) claim 28 as obvious over under 35 U.S.C. § 103 over Richardson and Pezzullo;[3]

(3) claims 32, 37, and 44 as obvious under 35 U.S.C. § 103 over Richardson and Arnold;[4]

(4) claims 33, 38, and 45 as obvious under 35 U.S.C. § 103 over Richardson and Pocock;[5]

(5) claims 39 and 46 as obvious under 35 U.S.C. § 103 over Richardson and Davis;[6]

(6) claims 25, 26, 31, 34, 35, 40, 41, 43, and 47–49 as anticipated under 35 U.S.C. § 102 by Murray;[7]

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[2] Tristan Richardson, *et al.*, *Virtual Network Computing*, IEEE INTERNET COMPUTING, Vol. 2, No. 1, 33–38 Jan./Feb. 1998 ("Richardson," Exs. 1006 and 1007 (proof of publication)).
[3] U.S. Patent No. 5,615,257 to Pezzullo, et al., issued Mar. 25, 1997 ("Pezzullo," Ex. 1011).
[4] Int'l App. Publ. No. WO 98/12833 to Arnold et al., published Mar. 26, 1998 ("Arnold," Ex. 1013).
[5] Eur. Patent No. 0396062 B1 to Pocock et al., published Oct. 23, 1996 ("Pocock," Ex. 1014).
[6] U.S. Patent No. 5,473,692 to Davis, issued Dec. 5, 1995 ("Davis," Ex. 1012).
[7] Mark Murray and Troy Roberts, *Effective Use of Individual User Profiles with Software Distribution*, Digest of the Large Scale System, Administration

(7) claims 30, 36, and 42 as obvious under 35 U.S.C. § 103 over Murray;

(8) claims 32, 37, and 44 as obvious under 35 U.S.C. § 103 over Murray and Arnold; and

(9) claims 39 and 46 as obvious under 35 U.S.C. § 103 over Murray and Davis;

II. ANALYSIS

A. Claim Construction

In *inter partes* review, claim terms are given their broadest reasonable interpretation in light of the Specification in which they appear. *See* 37 C.F.R. § 42.100(b). We presume that claim terms have their ordinary and customary meaning. *See Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 105 (Fed. Cir. 2016) ("Under a broadest reasonable interpretation, words of the claim must be given their plain meaning, unless such meaning is inconsistent with the specification and prosecution history"); *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Any special definition for a claim term must be set forth in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). In the absence of such a special definition or other consideration, "limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

Petitioner and Patent Owner both propose constructions for the terms "mobile interface" and "pointer" as recited in claims 1 and 11. Pet. 5–7, PO Resp. 9–13. We construe both terms in sections II.A.1. and II.A.2. below.

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of Windows NT Workshop, 1–9 (Aug. 1997) ("Murray," Exs. 1008 and 1009 (proof of publication)).

Several of the challenged claims are written in means plus function format. "An element in a claim for a combination . . . expressed as a means . . . for performing a specified function without the recital of structure, material, or acts in support thereof . . . shall be construed to cover the corresponding structure . . . described in the specification and equivalents thereof." 35 U.S.C. §112, ¶ 6 (2007).[8] Petitioner includes proposed constructions for means plus function terms. Pet. 7–12. With one exception, Patent Owner's Response does not contest the construction of the means plus function terms from the Institution Decision. Dec. Inst. 11–16; PO Resp. 9–13. Regardless, for the sake of completeness, we repeat our construction from the Institution Decision in sections II.A.3.a–j. below.

1. "mobile interface"

Independent claim 25 recites a "mobile interface used for accessing user specific resources and information stored either on a local computer device or a network server." Independent claims 34, 40, and 49 also include recitations to a "mobile interface." In the Institution Decision, we preliminarily construed "mobile interface" to mean "a user interface accessible on different computing devices." Dec. Inst. 9.

Petitioner agrees with our construction from the Institution Decision and argues against adoption of Patent Owner's proposed construction. Pet. Reply. 2–4. Patent Owner proposes "mobile interface" be construed as "a user interface accessible on different computing devices and capable of dynamically accessing user-specific data on a network server and local

[8] The '002 patent was filed prior to the effective date of § 112, as amended by the America Invents Act, Public Law 112-29 ("AIA")—September 16, 2012— and is governed by the pre-AIA version of § 112. *See* AIA § 4(c).

device." PO Resp. 9–12.

Patent Owner's support for including "dynamically accessing" user-specific data as part of its proposed construction includes the following citation from the Specification:

> *The present invention is further directed to a mobile interface agent* that can be used to dynamically access resources stored either locally in the computer device or across a network including programs, applications, bookmarked URLs, user profiles, IP addresses, telephone numbers, television channels, radio stations, and the like *that are specific to a user via any computer device.*

PO Resp. 10 (citing Ex. 1004, 1:11–16). Patent Owner also relies on the Williams Declaration and other portions of the Specification that describe periodically updating and synchronizing the "profile data" and adjusting a pointer when the user moves from a Windows 95 machine to an Apple Macintosh machine. *Id.* at 11 (citing Ex. 1004, 5:61–62, 7:52–55, 13:21–27; Ex. 2005 ¶ 38). Patent Owner concludes that "[t]he Board's construction encompasses any interface—even those that are incapable of dynamically accessing data from different devices, locations, and computing platforms." *Id.* at 12; *see also* Ex. 2005 ¶ 41 ("the Board's construction encompasses any interface").

Our preliminary construction is consistent with the Specification. For example, the Specification describes a "mobile interface agent" ("MIA"),[9] which "allows the user to access documents, files, programs, applications, URL bookmarks, IP addresses, telephone numbers, television channels,

[9] Patent Owner states that "mobile interface" is sometimes referred to as "mobile interface agent." Tr. 35, 9–15. Our review of the Specification supports the conclusion that the terms are used synonymously. *See, e.g.*, Ex. 1004, Abstract.

radio stations, and other menu items from *any computer that is connected to a network*." Pet. 6 (citing Ex. 1004, 4:49–54 (emphasis in Petition); *id*. at 5:58–61). The Specification also explains that the interface is "mobile" because it is accessible by a user from "any computer type device connected to the network." Ex. 1004, 4:21–24.

The parties appear to agree that the mobile interface is an interface that is accessible on different computing devices. Patent Owner's proposal includes the additional language "dynamically accessing user specific data on a network server and local device." Although the term "dynamically access" is used in the Specification of the '002 patent, the meaning of the term is not explained. Also, the type and location of the data being accessed already is specified in the various claims of the '002 patent. *See*, *e.g.*, Ex. 1004, 17:9–11, 19:15–18, 19:33–35. Thus, we are not persuaded that the term "mobile interface" is appropriately limited by the method of data access or by the type and location of the data being accessed.

During oral argument Patent Owner was asked why insertion of "dynamically accessing" would not constitute reading a limitation from the Specification into the claims. Patent Owner argues support is found at column 1, lines 11 through 16, of the '002 patent reproduced above, which describes the "present invention." *See* PO Resp. 10, Tr. 53:23–54:22. Petitioner points out that "the '002 [patent Specification] refers to the 'present invention' 62 times to describe aspects of the mobile interface and potential uses." Pet. Reply 3. Dr. Williams's deposition includes testimony that his construction of "mobile interface" is based on the phrase "the present invention" in the Specification. Ex. 1032, 52:9–54:13. The use of "dynamically accessing" in association with "the present invention" at one

place in the Specification does not rise to the level of a special definition set forth with clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d at 1480.

Patent Owner does not explain why the '002 patent's descriptions of periodically updating, synchronizing, and adjusting pointer data are relevant to "dynamically accessing" user specific resources. The Williamson Declaration does not include persuasive testimony tending to support Patent Owner's position. *See* Ex. 2005 ¶¶ 36–41. Rather, the Williamson Declaration repeats the citations to the Specification and lacks any discussion of what a person of ordinary skill in the art would have understood. *Id.*

Finally, our preliminary construction is not so broad as to encompass "any interface" but rather only an interface that is "accessible on different computing devices." We are not persuaded that it should be narrowed by inclusion of "dynamically accessing."[10] As such our preliminary construction is the broadest reasonable construction consistent with the Specification. Thus, we adopt our preliminary construction of "mobile interface" as our final construction, namely we construe "mobile interface" to mean "a user interface accessible on different computing devices."

[10] A district court likewise did not include "dynamically accessing" in its construction and construed "mobile interface," as recited in the claims of the '002 patent, as "[a] user interface, accessible on various computing devices, allowing a user to access files and other data from various computing devices." Ex. 1031, 6 (Final Order Regarding Claim Construction and Patent Summaries, *IV v. Citigroup, Inc.*, 1:14-cv-04638 (S.D.N.Y. June 30, 2015, ECF No. 90)("*Citigroup* Litigation").

2. "pointer"

Independent claim 25 recites "the mobile interface comprising . . . means for presenting a plurality of *pointers* on any local device corresponding to the user specific resources and information to a user." Ex. 1004, 18:53–54. Emphasis added. Independent claims 34 and 40 also recite "plurality of pointers" (claim 34) or "pointers" (claim 40). In the Institution Decision we preliminarily construed "pointer as "a link or shortcut to an item." Dec. Inst. 11.

Petitioner agrees with our preliminary construction of "pointer." Pet. Reply 4. Patent Owner contends "[t]he inventor of the '002 Patent acted as his own lexicographer, defining pointer: 'A pointer in this context is a reference to a type of menu item that can be accessible on the computer, PDA or a server.'" PO Resp. 12 (citing Ex. 1004, 1:36–38, 10:8–10). According to Patent Owner, our preliminary construction is "incomplete." *Id.* Patent Owner cites a portion of the Specification that we relied on for our preliminary construction (Ex. 1004, 9:62–11:4).[11] *Id.* Notwithstanding that, Patent Owner argues Patent Owner continues to conclude that when a user activates a pointer it "accesses the corresponding item." *Id.* at 12–13 (citing Ex. 1004, 10:10–16). Patent Owner then argues the Specification explains that the accessed item "can be accessible on the computer, PDA or a server," thereby supporting its proposed construction. *Id.* at 12–13 (citing Ex. 1004, 1:36–38, 10:8–10).

The Specification states "[a] user interface in an [Operating System (OS)] generally includes 'pointers' to software programs, applications, files,

[11] Dec. Inst. 10 (citing Ex. 1004, 10:8–10).

folders, documents, and other menu items. *A pointer in this context is a reference to a type of menu item that can be accessible on the computer, [Portable Digital Assistants (PDA)] or a server*." Ex. 1004, 1:34–38)(emphasis added). The Specification describes that pointers are found on the "Start" menu bar and provide "a link to folders, files, and programs (e.g., a word processing program)." *Id.* at 1:39– 47. The Specification concludes with: "As discussed earlier, *a pointer is a link/shortcut to an item* such as a file, URL, IP address, telephone number, television channel, radio station, application, or service." *Id.* at 10:8–10 (emphasis added).

We are not persuaded that the construction proposed by Patent Owner represents the broadest reasonable construction of the term "pointer," as described in the '002 patent. The '002 patent discusses a broad array of electronic devices that may be used in conjunction with the mobile interface agent, including "a computer, cable set top box, cellular phone, or other device." *Id.* at 4:44–45. Patent Owner does not explain why the description of a "pointer" in one particular "context," i.e., on a computer or PDA, indicates a clear intent to require that all pointers be "a reference to a type of menu item" or "accessible on a computer, PDA, or server." Accordingly, we apply the broadest definition of the term provided in the '002 patent: "a link or shortcut to an item." Ex. 1001, 10:8–10 ("As discussed above, a pointer is a link/shortcut to an item such as . . . .").

At oral argument, Patent Owner represented that a "proper[] understand[ing]" of our preliminary construction can "get you to the same place" as its proposed construction. Tr. 37:4–8. Additionally, counsel argued it is important that there be a "reference" to an item, rather than only "a visual representation of an icon." *Id.* at 37:14–21, 38:2–5. We do not

adopt Patent Owner's proposed construction of "pointer" and therefore disagree that our preliminary construction requires a "reference" to an item. Neither do we agree that "a visual representation of an icon" is unequivocally not an icon. To say that our preliminary construction requires a "reference" is another way of reading one isolated sentence of the Specification into the construction. We decline to import limitations from the Specification into the claims. *See, e.g., Superguide Corp. v. DirecTV Enters, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004).

The record also includes extrinsic evidence that a pointer is understood in the computer field to mean "[a] data item that specifies the location of another data item." *IEEE Dictionary*, 785 (6th Ed., 1996), Ex. 2001. It is unnecessary to rely on extrinsic evidence to reach our construction when the term can be "understood from a careful reading of the public record." *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1584 (Fed. Cir. 1996). Incorporating the extrinsic evidence into the construction of "pointer" imports additional limitations into the construction.

In sum, adopting Patent Owner's construction requires importation of limitations from the Specification which are unnecessary to achieve the correct construction. Thus, our preliminary construction is the broadest reasonable construction consistent with the Specification, namely "pointer" is construed to mean "a link or shortcut to an item."

3. Means plus function limitations

Patent Owner contested terms set forth in II.A.3.a.–e. below in its Preliminary Response, but does not do so in its Response. *See* Dec. Inst. 11–15. In its Preliminary Response, Patent Owner did not contest terms set forth in II.A.3.f.–j. below and does not do so in its Response. *Id.* at 15–16.

In Patent Owner's Response, with the exception of III.A.3.c. (means for accessing), none of the means plus function constructions is contested. For sake of completeness, we repeat the constructions from the Institution Decision below, separately addressing means for accessing in Section III.A.3.c.

a. "means for interfacing any local computer device with the network server" (claim 25)

The recited function is "interfacing any local computer device with the network server." Petitioner cites to the Specification's network references and proposes that the corresponding structure is "a network." *See* Pet. 8 (citing Ex. 1004, 2:12–17). Petitioner's proposal of "a network" as the corresponding structure is the broadest reasonable construction consistent with the Specification. *See* Ex. 1004, 2:12–17. In determining the broadest reasonable interpretation consistent with the Specification, we find that the disclosed invention is based on using a local device to connect to a network. Ex. 1004, 4:29–41, 6:24–29 (network accessible by computer), 8:2–6 (network transfers user resources and information).

Thus, we construe the function as "interfacing any local computer device with the network server" and the corresponding structure as "a network."

b. "means for presenting a plurality of pointers on any local device corresponding to the user specific resources and information to a user" (claim 25)

The function is "presenting a plurality of pointers on any local device corresponding to the user specific resources and information to a user." For corresponding structure, Petitioner proposes "a screen," citing Figure 2 of the '002 patent illustrating "a *screen shot* of a conventional *Windows NT*

'Start' menu bar." *See* Pet. 8–9 (citing Ex. 1004, 1:39–47, Fig. 2 (emphases in Petition)). The Specification states that output is transmitted through interface 112 and the output includes graphics, animation, and sound. Ex. 1004, 6:39–40, 7:5–9). Audio output is disclosed as per claim 24 ("audioly presenting the user interface").

Thus, we construe the function as "presenting a plurality of pointers on any local device corresponding to the user specific resources and information to a user" and the corresponding structure as "a screen or an audio output mechanism."

c. "means for accessing the user specific resources and information using the plurality of pointers" (claim 25)

The function is "accessing the user specific resources and information using the plurality of pointers." Petitioner argues the structure is "a computer connected to a network." Pet. 9. Petitioner's support for a network as the structure is that the Specification discloses that computers are connected to a network and "[c]omputers on the network can conveniently manage and access software programs, applications, files, folders, documents, and the like from another computer or server." *Id.* (quoting Ex. 1004, 2:12–17). The Specification also makes it clear that the mobile interface or MIA is software running on a computer. Ex. 1004, 6:2–3.

Patent Owner argues the term's construction in the argument section of the Response, contending that "the corresponding structure for this claim element should specifically include a component that processes associated location information for an item and causes a local device to access the item using the associated location information." PO Resp. 25 (citing Ex. 2005 ¶ 59).

Patent Owner and its expert cite three portions of the Specification for support. The first is: "[w]hen a user activates a pointer using one of the input commands, this command signal will be transmitted to the pointer resolver 206 via the input interface 110 and the controller 200." *Id.* (citing Ex. 1004, 10:10–13). The second relates to controller 200 receiving input commands and "decod[ing] them into a more compact or standardized code." *Id.* (Ex. 1004, 10:5–7). Lastly, the pointer resolver 206 of the MIA "then receives the decoded input commands and accesses the corresponding item." *Id.* (Ex. 1004, 10:13–15).

The claim language for this term specifically recites "the mobile interface comprising" the "means for accessing," among other means plus function terms. The Specification makes it clear that the mobile interface or MIA is software running on a computer. Ex. 1004, 6:2–3. The MIA includes, among other things, the input interface and controller. *Id.* at 10:10–13. While not specifically cited, Dr. Williams testifies that because the MIA includes pointer resolver 206 (Ex. 1004, 9:64-65), the '002 patent requires "all processing of location information to occur on the local device." Ex. 2005 ¶ 60.

Patent Owner lists components that are part of the MIA software and therefore are run on the computer. We need not list the particular computer parts as part of the broadest reasonable interpretation of the term.[12]

We are not persuaded that these general assertions aid construction of the structure associated with this claim term. Neither are we convinced that

[12] We are not convinced that application of the district court construction standard would change the result. Regardless, we need not address that question.

the "local device" must access the item when claim 25's preamble recites that the "user specific resources and information [are] stored either on a local computer device or a network server."

Thus, we construe the function as "accessing the user specific resources and information using the plurality of pointers" and the corresponding structure as "a computer connected to a network."

d. "means for connecting the local device to the network server" (claim 49)

The function is "connecting the local device to the network server." Petitioner cites to the Specification's network references and proposes that the corresponding structure is "a network." *See* Pet. 9–10 (citing Ex. 1004, 2:12–17). The term here requires a "connection" between the local device and the network server. Applying the broadest reasonable interpretation standard, the structure that connects the local device and the network server is a network. Thus, we construe the function as "connecting the local device to the network server" and the corresponding structure as "a network."

e. "means for inputting a request for the user specific resource or information through the mobile interface displayed on the local device" (claim 49)

We construe the function as "inputting a request for the user specific resource or information through the mobile interface displayed on the local device" and the corresponding structure as "a keyboard, mouse, pad, voice interface, or event interface (*e.g.*, a timer)."

f. "means for downloading a mobile interface from the network server to the local device" (claim 49)

We construe the function as "downloading a mobile interface from the network server to the local device" and the corresponding structure as "a network." Pet. 10 (citing Ex. 1004, 2:12–17).

g. "means for displaying the mobile interface on the local device" (claim 49)

We construe the function as "displaying the mobile interface on the local device" and the corresponding structure is "a screen." *See* Pet. 10 (citing Ex. 1004, 1:45–47, Fig. 2).

h. "means for inputting a request for the user specific resource or information through the mobile interface displayed on the local device" (claim 49)

We construe this term consistently with "means for inputting a request" above. Thus, we construe the function as "inputting a request for the user specific resource or information through the mobile interface displayed on the local device" and the corresponding structure is "a keyboard, mouse, or pad voice interface, or event interface (*e.g.*, a timer)."

i. "means for retrieving the requested user specific resource or information from either the local device or the network server" (claim 49)

We construe the function as "retrieving[13] the requested user specific resource or information from either the local device or the network server" and the corresponding structure to be "a pointer." Pet. 11 (citing Ex. 1004, 6:13–16, 1:39–45, Fig. 2).

j. "means for displaying the requested user specific resource or information on the local device" (claim 49)

[13] As we note below, "retrieving" is "access." *See* II.B.2.d.

We construe the function as "displaying the requested user specific resource or information on the local device" and the corresponding structure is "a screen." Pet. 11–12 (citing Ex. 1004, Fig. 3).

B. Analysis of Anticipation Grounds Based on Richardson

In order for a prior art reference to serve as an anticipatory reference, it must disclose every limitation of the claimed invention, either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). We must analyze prior art references as a skilled artisan would. *See Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991) (to anticipate, "[t]here must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention"), *overruled on other grounds by Abbott Labs. v. Sandoz, Inc.*, 566 F.3d 1282 (Fed. Cir. 2009). As the Federal Circuit has held:

> This modest flexibility in the rule that "anticipation" requires that every element of the claims appear in a single reference accommodates situations where the common knowledge of technologists is not recorded in the reference; that is, where technological facts are known to those in the field of the invention, albeit not known to judges. It is not, however, a substitute for determination of patentability in terms of § 103.

Cont'l Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268–69 (Fed. Cir. 1991).

1. Richardson (Ex. 1006)

Richardson describes a Virtual Network Computing ("VNC") system where an entire desktop environment can be accessed from any Internet-connected machine. Ex. 1006, 33.[14] A Network Computer ("NC") "aims to

[14] Page references are to the page numbers in Richardson and not the exhibit page numbers provided by Petitioner.

give users access to centralized resources from simple inexpensive devices." *Id.* In VNC, the server is accessed in the same way as a NC but the server also supplies "an entire desktop environment that can be accessed from any Internet-connected machine using a simple software NC." *Id.*

"The technology underlying the VNC system is a simple protocol for remote access to graphical user interfaces." *Id.* at 35. Because it works at the framebuffer level, the protocol "applies to all operating systems, windowing systems, and applications—indeed to any device with some form of communications link." *Id.*

Figure 1 of Richardson is reproduced below:

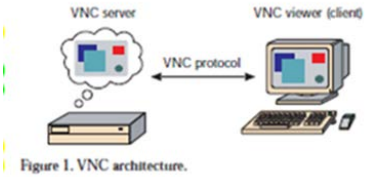


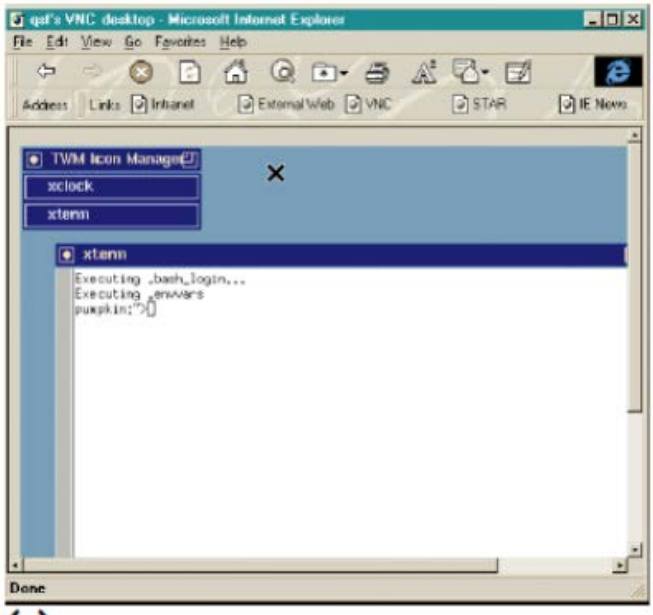
Figure 1. VNC architecture.

Figure 1 illustrates the VNC architecture. The VNC client interacts with the display and/or input devices. Ex. 1006, 35. The VNC server is the endpoint where changes to the framebuffer originate, i.e., the windowing system and applications. The client inputs to the server when the "user presses a key or pointer button." *Id.*

Figures 2(b) and 2(c) of Richardson are reproduced below.



(b)



(c)

Figure 2(b) illustrates "a Windows 95 desktop from an X viewer. Ex. 1006, 36. Figure 2(c) illustrates "a Unix desktop from a Java applet within Internet Explorer." *Id.*

The viewers may access the user's personal computing environment. Ex. 1006, 36. Richardson provides various examples of user desktops being accessed from different viewers using the VNC system. *Id.* at Fig. 2. Any

user interface may be accessed, including CDs, video recorders, telephone answering machines, and car stereos or GPS receivers. *Id.* at 36–37. Using the remote access protocol, a mobile phone could be used to access the devices. *Id.* at 37.

2. Independent Claims 25, 34, 40, and 49 as Anticipated by Richardson

Patent Owner identifies seven limitations from claims 25, 34, 40, and 49 the Patent Owner argues are not disclosed by Richardson. *See* PO Resp. 13–14, 16–31. As to the remaining limitations of claims 25, 34, 40, and 49, we are persuaded Petitioner has shown sufficiently that they are present in Richardson. *See* Pet. 4, 16–31 (including claim chart). The ground is supported by the Lieberman Declaration. Ex. 1001 ¶¶ 61–169. Our analysis of the limitations Patent Owner argues are addressed below.

a. "the mobile interface comprising . . . a plurality of pointers that correspond to the user specific resources and information" (claim 34)[15]

Claim 34 recites "the mobile interface comprising . . . a plurality of pointers that correspond to the user specific resources and information." Petitioner points to Richardson's disclosure "that a user's desktop provided by the VNC system is a mobile interface because it 'can be accessed from any Internet-connected machine,' providing 'access to home computing environments from anywhere in the world.'" Pet. 16[16] (Ex. 1006 at 33; Ex. 1001 ¶ 64), *see also* 26–27 (claim chart). Petitioner argues "the mobile

[15] Claims 25 and 40 have "analogous language." *See* PO Resp. 23.
[16] This cite relates to claim 25 but is cross-referenced in Petitioner's showing relating to claim 34. *See* Pet. 18. As noted above in n.7, claims 25 and 40 have "analogous language" to claim 34.

interface being adapted to move from one local device to another (e.g., can be accessed from any Internet-connected machine) and adapted to be displayed on the local device (e.g., the server and client negotiate desktop size)." *Id.* at 18 (citing Ex. 1001 ¶¶ 79–82).

Premised on the user's desktop being the "mobile interface," Petitioner argues Richardson further discloses:

> a plurality of pointers (e.g., icons and menu items) that correspond to the user specific resources and information (e.g., the applications and data available on a user's desktop), wherein upon initiating a pointer (e.g., sending an input even to the server), a user specific resource or information from either the local device or the network server (e.g., the VNC server) is retrieved (e.g., displayed on the desktop).

Pet. 18 (citing Ex. 1001 ¶¶ 84–86). Petitioner argues Richardson discloses "pointers" including, for example, the "My Computer" icon retrieved from the VNC server. *Id.* (citing Ex. 1006, Fig. 2; Ex. 1001 ¶ 86). The user "sends input events to the server whenever the user presses a key or pointer button" through a "keyboard [or] multibutton pointing device." *Id.* (citing Ex. 1006, 35; Ex. 1001 ¶ 86).

Patent Owner argues Richardson does not disclose this limitation, particularly and cannot anticipate claim 34. PO Resp. 16, 19–23. Patent Owner identifies two reasons supporting its position. First, Patent Owner argues "the VNC desktop displayed at the VNC client—the alleged 'mobile interface'—does not include pointers." PO Resp. 19. Second, "the VNC desktop displayed at Richardson's VNC client does not dynamically access user-specific data on a network server and a local device." *Id.* These arguments are based, in part, on the constructions of "pointer" and "mobile interface."

Patent Owner argues Richardson operates differently than the claimed invention because "[w]hen the VNC client user clicks on an icon, the client computer does not retrieve resources and information; it merely transmits a click event for a given x-y display coordinate." PO Resp. 21 (citing Ex. 2005 ¶ 52). If a "user clicks on an icon with a pointing device," the VNC server sends a message with x-y coordinates, not pointers. *Id.* at 22 (citing Ex. 2005 ¶ 53). Based on the preceding, Patent Owner argues Richardson does not disclose a "pointer" under what is now the final construction of "pointer," "a link or shortcut to an item." *Id.* at 21.

The Williams Declaration testimony is that a VNC system, such as Richardson, takes messages from a client mouse or keyboard and communicates "screen change rectangles" between the VNC client and server. Ex. 2005 ¶ 55. Relying on this testimony, Patent Owner argues that the use of the x-y coordinates in Richardson are not "pointers" but merely "graphics primitives." PO Resp. 22–23 (citing Ex. 1006, 35; Ex. 2005 ¶ 55). Thus, Patent Owner concludes the VNC system of Richardson, i.e., "mobile interface," also does not include pointers. *Id.* at 22.

In sum, Patent Owner argues that "a visual representation of an icon" that is "resolved elsewhere–at the server, for instance" is not a pointer. *See* Tr. 37:22–38:5; *see also id.* at 41:8–21 (Richardson information "resides at the server"), 45:13–46:2 (Richardson does not bring the "resource down to the mobile interface"). Part of Patent Owner's contention regarding Richardson is that "the client computer does not retrieve the MS Word document when the icon is clicked, nor does the icon refer to the MS Word document." PO Resp. 7 (citing Ex. 2005 ¶ 56). To the extent Patent Owner

is arguing that where the "pointer data,"[17] is resolved (the client or the server), distinguishes Richardson from the claims, the claims do not specify a location. For example, claim 1 recites that the "pointers correspond[] to the user specific resources and information." *See* Ex. 1004, 17:14–17. Indeed, the Specification states that "pointer data" "may exist either locally in the computer device or may exist as a resource accessible across a network." *See* Pet. Reply 14 (citing Ex. 1004, 8:42–44, Fig. 15 (depicting remote database 136 storing "pointer data")).

We are not persuaded that the fact that Richardson's client transmits x-y coordinates or "screen change rectangles" means that Richardson falls outside our construction of "pointer." Fundamentally, computer displays, networked or not, use "pixels to display graphics, and the x-y location of the cursor is used to handle events." Pet. Reply 14–15 (citing Ex. 1022, 48:14–49:9; US 5,917,486, Ex. 1037, 1:9–56). There is no dispute that a VNC system, like Richardson, communicates between the VNC client and server. *See* PO Resp. 21 (citing Ex. 2005 ¶ 56).[18]

We rejected Patent Owner's proposed construction of "pointer" and construed "pointer" as "a link or shortcut to an item." We credit the Lieberman Declaration and testimony that the icons on the desktop of

[17] "To the user, this process would be automatic and transparent since the user can simply click a data file, *which is pointer data* in his/her mobile interface agent." Ex. 1004, 3:5–8 (emphasis added). The term "pointer data" is not a claim term.

[18] The Williams Declaration and the Response at page 23 reproduce Figure 4 of Global Teleporting with Java ("Global Teleporting") as exemplary of a VNC system. Ex. 2005 ¶ 55. While the discussion of Figure 4 of Global Teleporting has similarities to the VNC architecture disclosed in Richardson, Patent Owner does not explain how such similarities establish patentability over Richardson nor are any new arguments raised by the discussion.

Richardson are links or shortcuts to applications or items, meeting our construction of "pointers." *See* Ex. 1001 ¶ 86. We find nothing inconsistent with this conclusion in the Williams Declaration relating to the functionality of VNC systems.

We therefore determine that Petitioner has shown sufficiently that Richardson discloses the "the mobile interface comprising . . . a plurality of pointers" limitation.

b. "the mobile interface [that] includes pointers . . . [to] provide links to access the corresponding user specific resources and information" (claim 40)

Claim 40 recites "the mobile interface [that] includes pointers . . . [to] provide links to access the corresponding user specific resources and information." Richardson discloses a VNC viewer and a mobile interface, e.g., the VNC desktop, wherein the local memory also includes Internet Explorer Bookmarks such as "VNC," "STAR," and "IE News." Ex. 1006, 33, Fig 2(c). Petitioner argues the limitation is met by the VNC desktop, which includes pointers, e.g., icons and menu items, corresponding to the user specific resources and information, e.g., the applications and data available on a user's desktop, wherein the pointers provide links to access the corresponding user specific resources and information. Pet. 20 (citing Ex. 1001 ¶¶ 96–100), *see* 27–28 (claim chart).

Patent Owner argues the VNC desktop does not include pointers. PO Resp. 24. We are not persuaded by this argument for reasons discussed in the discussion in II.B.2.a. above.

Patent Owner also argues "the VNC desktop displayed at Richardson's VNC client does not dynamically access user-specific data on a network server and a local device." PO Resp. 24. The portion of this

argument requiring that the "mobile interface" have a "dynamically access" component is based on Patent Owner's proposed construction. We rejected that argument in our construction analysis.

Claims 34 and 40 recite similar limitations regarding "retrieving" or "storing" "a user specific resource or information" from or on "either the local device or the network server." Patent Owner denies this language is met by the disclosures of Richardson. We find the denial unpersuasive for the reasons discussed above, including, for example, retrieval of the "My Computer" icon from the VNC server. Ex. 1006, Fig. 2; Ex. 1001 ¶ 86.

We therefore determine that Petitioner has shown sufficiently that Richardson discloses "the mobile interface [that] includes pointers . . . [to] provide links to access the corresponding user specific resources and information" limitation.

c. "means for accessing the user specific resources and information using the plurality of pointers" (claim 25)

Claim 25 recites "means for accessing the user specific resources and information using the plurality of pointers." Richardson discloses icons which are used to access applications, data, and the like. Ex. 1006, 33. Richardson also discloses the structure we determined was required, a "computer connected to a network." *See* Ex. 1006, Fig. 1. Petitioner relies on the preceding to meet the recited "means for accessing" limitation. Pet. 18 (citing Ex. 1001 ¶¶ 75–76), *see* 24–25 (claim chart).

We construed this term in Section III.A.3.c. above. Patent Owner's arguments are all based on adoption of its proposed construction. *See* PO Resp. 25–26. We declined to adopt Patent Owner's proposal.

We therefore determine that Petitioner has shown sufficiently that Richardson discloses the "the means for accessing the user specific resources and information using the plurality of pointers" limitation.

> *d. "user specific resources or information . . . is retrieved" (claim 34) or "means for retrieving the requested user specific resource or information from either the local device or the network server" (claim 49).*

Claim 34 recites "user specific resources or information . . . is retrieved." Claim 49 recites "means for retrieving the requested user specific resource or information from either the local device or the network server."

Again, Richardson discloses a plurality of pointers, e.g., icons and menu items, such as the "My Computer" icon, that retrieves the "My Computer" window from the VNC server. Ex. 1006, Fig. 2(b). Richardson further discloses the icons are used to access applications, data, and the like. *Id.* at 33. In Richardson, the user "sends input events to the server whenever the user presses a key or pointer button" on the "keyboard [or] multibutton pointing device." *Id.* at 35. Petitioner relies on these disclosures, concluding that "a user specific resource or information from either the local device or the network server (e.g., the VNC server) is retrieved (e.g., displayed on the desktop), as recited in Claim 34, element [a]." Pet. 19 (citing Ex. 1001 ¶¶ 84–86), 26–27 (claim chart).

Patent Owner contends Richardson does "not retrieve anything." PO Resp. 28. Patent Owner again argues that Richardson transmits information from the server to the client in screen-change rectangles by placing "a rectangle of pixel data at a given x,y position." *Id.* (citing Ex. 1006, 35). Thus, Patent Owner contends only a display of, for example, the Microsoft

Word application is transmitted and "the VNC client is not running Microsoft Word." *Id.* (citing Ex. 2005 ¶ 63).

Above we determined that Richardson's client transmission of x-y coordinates or "screen change rectangles" falls within our construction of "pointer." We are not persuaded the operational difference Patent Owner relies on is outside the scope of the claim limitation under consideration here. Patent Owner fails to explain how the claim excludes retrieving a graphical representation of the Microsoft Word application. As Petitioner argues, the '002 patent Specification "confirms that running applications remotely is within the scope of retrieving resources." Pet. Reply 20 (citing Ex. 1004, 13:48–52)(describing that Microsoft Word "could be run remotely and the display interface returned to the user").

Petitioner also raises a potential inconsistency in Patent Owner's position here and that it advanced in its opening claim construction brief in the *Citigroup* Litigation. Applying a *Phillips* construction, Patent Owner argued the word "retrieve" means to "access" something. Pet. Reply 20 (citing Ex. 1036, 30). Patent Owner's only response here is "I'm not familiar enough with the District Court record . . . I don't know if they have litigated that particular issue." Tr. 57:16–20. To the extent this is an argument, it is not persuasive given the fact that this record has two exhibits from the *Citigroup* Litigation. *See* Exs. 1031 and 1036. Further, we are persuaded that "retrieving" is "access."

Patent Owner does not differentiate means plus function claim 49 from claim 34. *See also* PO Resp. 27 and 28 (e.g. *see* PO Resp. 28, n.1 noting Petitioner makes a "similar argument" for claims 34 and 49). Patent Owner contends both claims require retrieval of user-specific data. *Id.* at 27.

We therefore determine that Petitioner has shown sufficiently that Richardson discloses the retrieval of user-specific resources limitation.

e. "the mobile interface" (claims 25, 34, 40, and 49)

Patent Owner's argument that Richardson does not disclose the "mobile interface" limitation of independent claims 25, 34, 40, and 49 is based on its proposed construction for the term. PO Resp. 28–29. We do not adopt Patent Owner's "dynamically access user-specific data on a network server and local device" construction.

Petitioner argues, *inter alia*, Richardson discloses "dynamic[ly] access" because the VNC desktop synchronizes with the VNC server in real-time. Pet. Reply 11 (citing Ex. 1006, 33, 35; Ex. 1001 ¶ 52).[19] We agree with Petitioner and thus, even under Patent Owner's proposed construction of "mobile interface," Richardson discloses the limitation. However, we declined to include "dynamic access" as part of the "mobile interface" construction (II.A.1. above). Under our construction Richardson also meets the limitation. Patent Owner makes no additional arguments and, as a result, Patent Owner's argument is not persuasive.

We therefore determine that Petitioner has shown sufficiently that Richardson discloses the "mobile interface" limitation.

f. "a local device . . . having a local memory . . . wherein the local memory also includes user specific resources and information" (claim 40)

[19] Dr. Williams agreed that a user can "access the local resources on his home computer via the VNC desktop on his home computer," which Petitioner contends supports "synchronizing the VNC desktop with profile data on the VNC server in real-time." Pet. Reply 11 (citing Ex. 1006, 33, 35; Ex. 1032, 127:14–128:10).

Claim 40 recites "a local device . . . having a local memory . . . wherein the local memory also includes user specific resources and information."

Richardson discloses use of personalized Internet Explorer bookmarks such as "VNC" and "STAR" in Figure 2(c). Ex. 1006, Fig. 2(c). Petitioner relies on this disclosure and argues these are user-specific bookmarks for users of the Richardson VNC system. Pet. 20, 27–28.

Patent Owner argues that these IE bookmarks are not "user-specific" because the screenshot in Fig. 2(c) was taken from a shared computer at the VNC lab and not a personal computer. PO Resp. 30. However, nothing in the claims precludes user-specific resources from being shared by more than one user. As Petitioner notes, the Specification describes user-specific resources as including "shared items" such as "'radio stations,' 'television channels,' 'bookmarked URLs,' and 'telephone numbers.'" Pet. Reply 17 (citing Ex. 1004, 1:10–16). Petitioner argues Dr. Williams "also admitted that if a shared resource is in a user's environment, then it is specific to that user." *See id.* (citing Ex. 1032, 145:4–9).

Patent Owner points to the alleged inability of Mr. Lieberman to specify certain functionality of the icons in Figure 2(c) as support for its position. PO Resp. 30 (citing Ex. 1029, 92–93). The fact that Mr. Lieberman did not testify about the specifics of Figure 2(c) is not dispositive of the issue at hand. We give the testimony weight only about what would have been understood by a person of ordinary skill about Figure 2(b) from what is additionally shown in Figure 2(c), i.e., "[a] person of ordinary skill in the art at the time of the filing the alleged invention would have further understood that Internet Explorer stores bookmarked URLs." Ex. 1001 ¶

132; *see also* Pet. Reply 17–18 (citing Ex. 1022, 92:6–9, 9223–93:4), Pet. 20, 27; Ex. 1001 ¶ 98).

We therefore determine that Petitioner has shown sufficiently that Richardson discloses the "a local device . . . having a local memory . . . wherein the local memory also includes user specific resources and information" limitation.

3. Dependent Claims 26, 35, and 41 as Anticipated by Richardson

Claim 26 depends from claim 25. Claim 35 depends from claim 34 and claim 41 depends from claim 40. Each of claims 26, 35, and 41 recite as an additional limitation "wherein the user specific resources and information comprise . . . bookmarked URLs . . . and user profiles."

Richardson's Figure 2(b) includes an icon for "Internet Explorer," and an icon titled "Control Panel." Ex. 1006, Fig. 2. Petitioner argues that the Internet Explorer icon contains "'Links' to bookmarked URLs." Pet. 22 (citing Ex. 1001 ¶ 132). Petitioner then argues the icon "Control Panel" contains system files and system documents. *Id.* (citing 1001 ¶ 133). Petitioner concludes "[t]he VNC desktop includes the user's profile because the VNC desktop contains user profile data, such as the user's pointer data."[20] *Id.* (citing Ex. 1006, 33; Ex. 1001 ¶ 134).

Patent Owner argues the "wherein the user specific resources and information comprise . . . bookmarked URLs . . . and user profiles" as recited in dependent claims 26, 35, and 41 is not disclosed by Richardson. *See* PO Resp. 14, 31–33. Patent Owner again argues Richardson does not include user profile data because it only displays such data. *Id.* at 32. As

[20] The Specification of the '002 patent lists "pointer data" as part of "user profile data." Ex. 1004, 8:23–44, Fig. 3.

discussed above, the display of data on the desktop is the retrieval of user specific data.

Patent Owner acknowledges that Richardson discloses using the VNC system to access "personal computing environments." PO Resp. 32. But Patent Owner argues the Internet Explorer window in Figure 2(c) is not a user-specific Internet Explorer window since it is "used by lab members to access their personal computing environments." *Id.* (citing Ex. 2005 ¶ 70). Patent Owner argues Richardson's Figure 2(c) alleged "Links" to bookmarked URLs titled "VNC," "STAR," and "IE News" were not shown by Petitioner nor its expert to be user-specific resources and information. *Id.*

The Specification describes a user's personal environment as user-specific. Pet. Reply 18 (citing Pet. 13; Ex. 1004 at 2:35–40). Dr. Williams also concurs with this contention of Petitioner. *Id.* at 17 (citing Ex. 1032, 145:5–9 ("it would be specific to the user because it's in that user's environment.")). Thus, Richardson's bookmarked URLs are "user specific resources and information."

Figure 2(c) is cited by Petitioner for the purpose of showing what would have been understood by a person of ordinary skill from the Internet Explorer icon depicted in Figure 2(b) of Richardson. Pet. Reply 19 (citing Pet. 22; Ex. 1001 ¶ 132). Patent Owner points to the alleged inability of Mr. Lieberman to specify certain functionality of the icons in Figure 2(c) as support for its position. PO Resp. 33 (citing Ex. 1029, 92–93). The fact that Mr. Lieberman did not testify about the specifics of Figure 2(c) is not dispositive of the issue at hand. We give the testimony weight to the extent it explains what would have been understood by a person of ordinary skill about Figure 2(b) from what is additionally shown in Figure 2(c), i.e., "[a]

person of ordinary skill in the art at the time of the filing the alleged invention would have further understood that Internet Explorer stores bookmarked URLs." Ex. 1001 ¶ 100.

We have reviewed the Williams Declaration as to claims 26, 35, and 41. (Ex. 2005 ¶¶ 69–71). Dr. Williams testifies specifically that the Internet Explorer window of Figure 2(c) of Richardson is not user-specific because it is used by lab members and the "'VNC,' 'STAR,' and 'IE News' buttons in Figure 2(c) are also not user-specific." Ex. 2005 ¶ 70. This testimony is conclusory and not opinion based on any factual basis. It is repetitive of Patent Owner's Response, discussed above. Dr. Williams merely denies Petitioner's evidence that the icon for Internet Explorer is "a program and application, and contains 'Links' to bookmarked URLs." Pet. 18–19 (citing Ex. 1006, Fig. 2; Ex. 1001 ¶¶ 100, 102). We credit the testimony of Mr. Lieberman and find that the user's desktop of Richardson includes programs and applications that are user-specific resources.

Petitioner has shown by a preponderance of the evidence that claims 26, 35, and 41 are anticipated by Richardson.

4. Dependent Claims 30, 31, 36, 42–43, and 47–48 as Anticipated by Richardson

Claims 30, 36, and 42 depend from claims 25, 34, and 40 respectively. Claims 30, 36, and 42 each recite the pointers access the user specific resources and information stored on the network server via the Internet. Petitioner argues Richardson further discloses the limitation. Pet. 22 (citing Ex. 1006, 33, 35; Ex. 1001 ¶¶ 141–147), 25 (claim chart for claim 30).

Claims 31 and 43 depend from claims 25 and 40 respectively and recite that the plurality of pointers access the user specific resources and

information stored on the network server via one of a LAN, a MAN, and a WAN. Petitioner cites to the Lieberman Declaration to show that Richardson discloses the limitation, e.g., a WAN is the Internet. Pet. 22–23 (citing Ex. 1001 ¶¶ 149–156), 25–26 (claim chart for claim 31).

Petitioner cites to Richardson as disclosing "that the mobile interface is adapted to be loaded onto the local device (e.g., the server and client negotiate desktop size) from any geographical location (e.g., anywhere in the world) so long as the local device is communicating with the network server (e.g., is Internet-connected), as recited in Claim 47." Pet. 23 (citing Ex. 1001 ¶¶ 158–162), 28 (claim chart). Specifically, Petitioner argues Richardson discloses a "Connection Setup" process where the VNC desktop is loaded onto the local device from "anywhere in the world" when connected to the Internet. *Id.* (citing Ex. 1006 at 33, 35, 36; Ex. 1001 ¶ 162).

Claim 48 depends from claim 40 and recites the mobile interface is permanently stored in the network server. As above, Petitioner argues the VNC desktop is the mobile interface. Pet. 23 (citing Ex. 1001 ¶¶ 164–168), 28–29 (claim chart). According to Petitioner, "[b]y teaching that the VNC server is an 'endpoint' in the VNC architecture 'where changes to the framebuffer originate,' one having ordinary skill in the art at the time of the alleged invention would have understood that the VNC server permanently stores the VNC desktop." *Id.* (citing Ex. 1006, 35; Ex. 1001 ¶ 167).

Patent Owner does not specifically argue any of the limitations of claims 30, 31, 36, 42–43, and 47–48, relying on arguments made in connection with the independent claims 25, 34, and 40 discussed above. *See* PO Resp. 13–33.

Petitioner has shown by a preponderance of the evidence that claims 30, 31, 36, 42–43, and 47–48 are anticipated by Richardson.

5. Summary of Anticipation Grounds Based on Richardson

Petitioner has shown by a preponderance of the evidence that claims 25, 26, 30–31, 34–36, 40–43, and 47–49 are anticipated by Richardson.

C. Analysis of Obviousness Grounds Based on Richardson

A claim is unpatentable, under § 103(a), if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). 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 skill in the art; and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

After setting forth the factual inquiries regarding who is a person of ordinary skill in the art (Ex. 1001 ¶¶ 37–39), Mr. Lieberman testifies that "a person having ordinary skill in the relevant art at the time of the alleged invention is a person with a Bachelor of Science degree in Computer Science, Mathematics, Computer Engineering, Electrical Engineering, or other similar degree and one (1) year of related work experience. Ex. 1001 ¶ 40. Dr. Williams's testimony about the level of ordinary skill omits "[m]athematics" but is otherwise all but identical. Ex. 2005 ¶ 25. Neither party raises an issue as to what the level of ordinary skill is. Petitioner's

proposal is factually based and reasonable and we adopt it for purposes of this Decision.

Petitioner alleges claims 28, 32–33, 37–39, and 44–46 are obvious over Richardson and additional prior art references. Pet. 31–38 (including claim chart). The Petition is supported by the Lieberman Declaration. Ex. 1001 ¶¶ 171–227.

1. Claims 32, 37, and 44 as Obvious over Richardson and Arnold

Claims 32, 37, and 44 depend from claims 25, 34, and 40, respectively. Each claim recites "wherein the plurality of pointers access the user specific resources and information stored on the network server via a cellular network."

Petitioner relies on Arnold for its disclosure of "retrieving data from the Internet to their PCs via a network of base stations providing cell sites, i.e., a cellular network." Pet. 34 (citing Ex. 1013, 8:1–29, 10:27–30, Fig. 1; Ex. 1001 ¶¶ 194–196). Petitioner concludes, "[i]t would have been obvious to one having ordinary skill in the art at the time of the alleged invention to combine Richardson with the well-known features of Arnold to expand the geographical reach of the VNC system." *Id.* citing Ex. 1001 ¶¶ 202–203). Petitioner argues "Richardson's VNC system teaches that the VNC protocol could be used on 'any device with some form of communications link,' including 'on a mobile phone.'" *Id.* at 34–35 (citing Ex. 1006, 35, 37; Ex. 1001 ¶¶ 202–203).

Relying on its prior arguments relating to claims 25, 34, and 40, Patent Owner does not contest that the combination of Richardson and Arnold teaches the additional limitations of claims 32, 37, and 44. PO Resp. 34. Patent Owner does dispute that a person of ordinary skill in the art

would combine Richardson and Arnold. *Id.* Patent Owner contends "Arnold's cellular network would not have provided the reliable transport for Richardson's VNC system due to two limitations: (i) high bit error rates; and (ii) low bit rates." *Id.* Patent Owner relies on the Williams Declaration to establish that cellular networks like Arnold "[d]uring the 1999 timeframe of the '002 patent" had high bit rate errors. *Id.* at 34–35 (citing Ex. 2005 ¶ 77). According to Patent Owner, because Richardson's VNC system sends screen shots to the client, the display would have been of poor quality as a result of bit rate errors. *Id.* at 35 (citing Ex. 2005 ¶ 78). Patent Owner also relies on the Williams Declaration to establish that bit rates for cellular networks were low at the time the '002 patent. *Id.* (citing Ex. 2005 ¶ 79). Patent Owner concludes that because screen shots are sent between the VNC server and client of Richardson the use of Arnold's cellular network would have resulted in "a long latency to display the screenshot, leading to a poor user experience." *Id.*

In sum, Patent Owner argues the combination would cause speed and reliability problems. PO Resp. 34–35. However, the claims do not require a level of system performance. Patent Owner does not argue explicitly that "a poor user experience" would preclude one of ordinary skill in the art from making the combination, only that the resulting cellular network would not have provided "reliable transport." *See id.* at 34.

We agree with Petitioner that the combination would "have yielded predictable results, namely, VNC accessibility over a cellular network." Pet. Reply 22 (citing *KSR*, 550 U.S. at 416). Richardson discloses the VNC system is usable on a mobile phone. Ex. 1006, 37. We agree with Petitioner's motivation to combine Richardson and Arnold. Specifically,

Petitioner contends one having ordinary skill in the art at the time of the alleged invention would have sought to combine Richardson with the well-known features of Arnold to expand the geographical reach of the Windows NT roaming profile system. *See* Pet. 34 (citing Ex. 1001 ¶¶ 202–203).

We are persuaded that a person of ordinary skill in the art would combine the cellular network of Arnold with Richardson's VNC usable on a mobile phone.

Petitioner has shown by a preponderance of the evidence that claims 32, 37, and 44 would have been obvious over Richardson and Arnold.

2. Claims 39 and 46 as Obvious over Richardson and Davis

Claims 39 and 46 depend respectively from claims 34 and 40, and recite the same limitation, i.e., "wherein the user specific resources is retrieved based on a user licensing model." Petitioner has provided evidence that the combination of Richardson and Davis teaches the additional limitations of claims 39 and 46. Pet. 37–38 (including claim chart) (citing Ex. 1012, 1:59–2:21, 2:49–50; Ex. 1001 ¶ 220).

Petitioner argues it would have been obvious to combine Richardson with Davis to allow a user access to his or her programs from any computer under a single license. Pet. 37 (citing Ex. 1001 ¶¶ 226–227). Petitioner argues "Richardson's express teaching of a VNC system that is personal to the user and not limited to a particular device is analogous to Davis and provides further rationale to combine the references." *Id.* (citing Ex. 1001 ¶¶ 226–227). Petitioner argues Davis discloses "user-specific software licenses . . . using a 'dongle.'"[21] *Id.* (citing Ex. 1012, 1:59–61, 2:49–50; Ex.

[21] A "dongle" is a "piece of hardware connected to computers" to enforce software licenses. Ex. 1032, 149:19–150:14.

1001 ¶ 200). Thus, according to Petitioner, "[i]t would have been obvious to one having ordinary skill in the art to combine Richardson with the well-known teachings of Davis to allow a user access to his or her programs from any computer under a single license." *Id.* (citing Ex. 1001 ¶¶ 226–227).

The issue raised by Patent Owner is whether a person of ordinary skill in the art would have been motivated to combine the licensing scheme of Davis with the VNC of Richardson. PO Resp. 36–38. Patent Owner argues the combination would "frustrate the thin-client goals of Richardson and would not have been obvious to try and would not have improved the VNC client of Richardson." *Id.* at 37 (citing Ex. 2005 ¶ 73). Patent Owner's argument is based on "[a] stated goal of Richardson's VNC system is to 'achieve[ ] mobile computing without requiring the user to carry computing hardware.'" *Id.* (citing Ex. 1006, 34). Furthermore, Patent Owner argues the VNC protocol would need to be "augmented to carry the 'challenge' message of Davis to the connected dongle on the VNC client." *Id.* at 37–38 (citing Ex. 2005 ¶ 74). Patent Owner concludes that the added functionality and complexity required for the VNC client of Richardson would not lead one of ordinary skill in the art to combine Davis with Richardson. *Id.* at 38.

Petitioner's Reply points out it relied on Davis "for its disclosure of per-user licenses, not the enforcement mechanisms for such licenses, as none of the challenged claims recite such a feature." Pet. Reply 23 (citing Pet. 36–38). Further to the point, Petitioner argues Davis' disclosure of user-specific software licenses does not require the presence of dongles. *Id.* at 23–24 (citing Ex. 1012, 1:59–61). Petitioner concludes that physically combining Davis with Richardson is irrelevant because "obviousness does not require actual, physical substitution of Davis' dongle into the VNC

system." *Id.* at 24 (citing *In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012); *In re Etter*, 756 F.2d 852, 859 (Fed. Cir. 1985) (en banc)).

We agree with Petitioner that Patent Owner's argument is not relevant to the claim language, which does not recite anything about enforcement mechanisms or dongles. *See* Pet. Reply 24. Dr. Williams also testified that there are other ways to enforce software licenses that do not include dongles. *See id.* (citing Ex. 1032, 150:5–14).

Petitioner has shown by a preponderance of the evidence that claims 39 and 46 would have been obvious over Richardson and Davis.

3. Claims 33, 38, and 45 as Obvious over Richardson and Pocock

Claim 33 depends from claim 25. Claim 38 depends from claim 34. Claim 45 depends from claim 40. Claims 33, 38, and 45 each recite "wherein the plurality of pointers access the user specific resources and information stored on the network server via a television network." Petitioner argues the limitation is taught by Richardson and Pocock. Pet. 35–37 (including claim chart).

Petitioner cites to Richardson's teaching of pointers to access user specific information and its teaching that a "television set" can be used as a display for viewing the user's desktop. Pet. 35; *see* Ex. 1006, 35, 37. Pocock is cited by Petitioner for its disclosure of a cable television network as part of an interactive television system. *Id.* at 36 (citing Ex. 1014, 1:1–55). Petitioner argues Richardson discloses that the VNC protocol works on "any device with some sort of communications link" and that, "[i]f built into television sets, VNC viewers could allow them to act as displays for a very wide range of devices—including, of course, the PC at the office." *Id.* at 36

(citing Ex. 1006, 35, 37; Ex. 1001 ¶¶ 214–215). We are persuaded there is a rational basis for the combination.

Patent Owner does not separately argue claims 33, 38, and 45 but does include it in its arguments made in connection with claims independent claims 25, 34, and 40. PO Resp. 38. As discussed above, those arguments were determined to be unpersuasive.

Petitioner has shown by a preponderance of the evidence that claims 33, 38, and 45 would have been obvious over Richardson and Pocock.

4. Claim 28 as Obvious over Richardson and Pezzullo

Claim 28 depends from claim 25 and recites that the resources and information "comprise telephone numbers." Petitioner has provided evidence that the combination of Richardson and Pezzullo teaches the limitation of claim 28. Pet. 32–34 (including claim chart) (citing Ex. 1011, 2:51–57, Fig. 2 (directory telephone numbers stored as lists in a central switch); Ex.1001 ¶ 186).

Pezzullo discloses a telephone terminal that is controlled by remote signals, a similar interaction between devices as the claimed retrieval of "user specific resources and information." Ex. 1011, Abstract. Thus, we are persuaded by Petitioner's rationale that "one having ordinary skill in the art would have understood that providing user specific resources and information that comprise telephone numbers would have been a straightforward and predictable use of Richardson's VNC system on a computer or another interactive device." *Id.* (citing Ex. 1006, 35, 37; Ex. 1001 ¶¶ 188, 189).

Patent Owner does not separately argue claim 28 but does include it in its arguments made in connection with claims independent claims 25, 34,

and 40. PO Resp. 38. As discussed above, those arguments were determined to be unpersuasive.

Petitioner has shown by a preponderance of the evidence that claim 28 would have been obvious over Richardson and Pezzullo.

5. Summary of Obviousness Grounds Based on Richardson

Petitioner has shown by a preponderance of the evidence that claims 28, 32–33, 37–39, and 44–46 would have been obvious over the various recited combinations involving Richardson.

D. Analysis of Anticipation Grounds Based on Murray

1. Murray

Murray discloses a method for maintaining user specific settings through the user's individual profile. Ex. 1008, 1. Murray discloses a system of Windows NT "'roaming' profiles that are stored on the server and loaded down to the PC each time the user logs in." *Id.* at 3. The roaming profiles are "the files and directories that define each user's registry, desktop, start menu, etc." *Id.* The user's desktop, as defined by the user's profile, "allow[s] users to use any desktop [computer] to access . . . the same files and working environment that they would have on their local workstation." *Id.* The user's files and working environment are user-specific because they are the same as they would have on their local desktop workstation. *Id.* The user's files and working environment are retrieved from the network server because they are available from any computer on the network. *Id.*

2. Independent Claims 25, 34, 40, and 49 as Anticipated by Murray

Patent Owner identifies one limitation from claims 25, 34, 40, and 49 that it alleges is not disclosed by Murray. *See* PO Resp. 42–45. As to the

remaining limitations of claims 25, 34, 40, and 49, we are persuaded Petitioner has shown sufficiently that they are present in Murray. *See* Pet. 4, 38–52 (including claim chart). The ground is supported by the Lieberman Declaration. Ex. 1001 ¶¶ 228–310. Our analysis of Patent Owner's arguments is addressed below.

a. "mobile interface" (claims 25, 34, 40, and 49)[22]

Claim 25 is exemplary of the "mobile interface" limitation present in all four independent claims. The preamble of claim 25 recites "[a] mobile interface used for accessing user specific resources and information stored either on a local computer device or a network server."[23]

Petitioner argues the user's desktop as defined by the "roaming profiles" of Murray are the "mobile interface," noting it allows "users to use any desktop computer, in any office, to access 'the same files and working environment that they would have on their local workstation'—in other words, the user's personal desktop." Pet. 38 (citing Ex.1008, 3). Petitioner contends Murray discloses the "mobile interface" is used for accessing "user specific resources and information" because it provides access to the same files the user would have on his work station stored either on the local computer device or on the network server. *Id.* at 38–39 (citing Ex. 1001 ¶¶ 230–231).

[22] Patent Owner argues the limitation is not present in Murray for all four independent claims. *See* PO Resp. 45.

[23] Claim 34 also includes "mobile interface" in its preamble. Claims 40 and 49 include the term as part of a claim limitation: "a local device . . . having a local memory and a mobile interface" (claim 40); and "means for downloading a mobile interface from the network server to the local device" (claim 49).

Petitioner specifically argues Murray teaches that "the user's desktop, as defined by the roaming profile, is an interface that is mobile because it is 'stored on the server and loaded down to the PC each time the user logs in' and 'allow[s] users to roam between PCs on the network.'" Pet. 39 (citing Ex. 1008 at 3). As to "user specific resources and information," Petitioner specifies that the roaming profiles are "the files and directories that define each user's registry, desktop, start menu, etc." *Id.* (citing Ex. 1008, 3). Petitioner contends there are "user specific resources" because the files are those that the user would have in the "working environment that they would have on their local workstation." *Id.* (citing Ex. 1008, 3). As to location of the "user specific resources and information," Murray is cited as either on a local computer, in, for example, the "PC filespace," or network server, the "user filespace." *Id.* (citing Ex. 1008, 4–6).

Applying our construction of "mobile interface," Patent Owner argues Murray is not "mobile" because it is a Windows NT operating system desktop interface. PO Resp. 42 (citing Ex. 2005 ¶ 91). We rejected Patent Owner's proposed construction of "mobile interface," including "dynamically access" of user-specific data, and need not address Patent Owner's argument based on that construction. *See id.* at 42–43 (citing Ex. 2005 ¶ 92).

Patent Owner argues each of Murray's desktop or client devices has a standardized desktop interface which is a component of the Windows NT operating system. PO Resp. 43–44 (citing Ex. 1008, 2–3). Patent Owner argues Murray's roaming profile is stored on the server and downloaded to the individual PCs or client devices, the roaming profile being copied back to the server when the user logs out. *Id.* at 44 (citing Ex. 1008, 3). Patent

Owner concludes the roaming profile is "specific to the Windows NT operating system." *Id.* (citing Ex. 2005 ¶ 94).

Patent Owner contrasts the '002 patent to Murray where "[t]he mobile interface agent can be accessible using any computer from any geographical location so long as the computer can be connected to a network." PO Resp. 44 (citing Ex. 1001, Abstract). Patent Owner concludes the difference between the '002 patent and Murray is that the "mobile interface" of Murray "cannot be used across different operating systems or platforms and hence is not 'mobile' in light of the '002 Patent specification." *Id.* at 44–45.

Patent Owner's argument is not persuasive because our construction of "mobile interface" does not require the "mobile interface" to be operable on more than one operating system. The "mobile interface" is "mobile" by virtue of being accessible on different devices, not because the interface can be used across different operating systems. *See* Pet. 5–6. Neither is this argument born out in the claims. Indeed, without a mention of the claim language, Patent Owner argues the '002 patent differs from Murray "in light of the '002 Patent specification."

Petitioner has shown by a preponderance of the evidence that claims 25, 34, 40, and 49 are anticipated by Murray.

3. *Dependent Claim 48 as Anticipated by Murray*

Claim 48 depends from claim 40 and recites "wherein the mobile interface is permanently stored in the network server." Patent Owner contends this limitation is not disclosed in Murray. PO Resp. 45. Petitioner alleges "[o]ne having ordinary skill in the art at the time of the alleged invention would have understood that the roaming profiles would be stored

permanently on the network server, or else they would not be available each time the user logs in." Pet. 44 (citing Ex. 1001 ¶ 309).

Patent Owner argues Murray does not disclose claim 48 because the user's desktop is downloaded from the server. PO Resp. 45 (citing Ex. 2005 ¶ 98). As a result, the "mobile interface" alleged by Petitioner, and "the user-desktop as defined by the roaming profile," is not stored at the network server, only the roaming profile is stored on the network server. *Id.* (citing Ex. 2005 ¶ 98).

Stated differently, Patent Owner contends there are two parts to Murray's "mobile interface" and only one, the roaming profile, is stored on the network server. However, we agree with Petitioner that permanently storing the roaming profile also permanently stores the user's desktop because "the roaming profile consists of the files that define the user's desktop." Pet. Reply 9–10 (citing Ex. 1008, 3)("For Microsoft professionals, the term "profiles" or "user profiles" both refer to the files and directories that define each user's registry, desktop, start menu, etc. Using a Windows NT domain configuration, it is possible to have "roaming" profiles . . . .").

Patent Owner's argues that "the user's desktop is a component of the client's operating system." PO Resp. 45. This argument is not persuasive because the user interface defined by the roaming profile is not the user interface defined by local files at the client. *See* Pet. Reply 10.

Petitioner has shown by a preponderance of the evidence that claim 48 is anticipated by Murray.

4. Dependent Claims 26, 35, and 41 as Anticipated by Murray

Claims 26, 35, and 41 depend from claims 25, 34, and 40 respectively. Claims 26, 35, and 41 all recite "wherein the user specific resources and information comprise . . . bookmarked URLs, and user profiles." Petitioner relies on the Lieberman Declaration testimony that Murray discloses that the user profile includes configuration settings for applications such as Microsoft Office 97. Pet. 43 (citing Ex. 1001 ¶¶ 282–290).

Petitioner relies on the Lieberman Declaration testimony that Murray discloses that the user profile includes configuration settings for applications such as Microsoft Office 97. Pet. 43 (citing Ex. 1001 ¶¶ 282–290). Mr. Lieberman concludes that a person of ordinary skill in the art at the time of the alleged invention would have further understood that Microsoft Office 97 is both a program and an application. *See id.* (citing Ex. 1001 ¶ 285 (citing Ex. 1008, 6)).

Patent Owner does not separately argue claims 26, 35, and 41, but does include it in its arguments made in connection with claims independent claims 25, 34, and 40. PO Resp. 42–45. As discussed above, those arguments were determined to be unpersuasive.

Petitioner has shown by a preponderance of the evidence that claims 26, 35, and 41 are anticipated by Murray.

5. Dependent Claims 31, 43, and 47 as Anticipated by Murray

Claims 31, 43, and 47 depend from claims 25, 34, and 40 respectively. Claims 26 and 35 recite that the user specific resources and information are accessed via "one of a LAN, a MAN, and a WAN." Claim 47 is similar but recites "the mobile interface is adapted to be loaded onto the local device from any geographical location so long as the local device is communicating with the server."

As to claims 31 and 43, Petitioner cites to Murray as disclosing that the pointers access the user specific resources and information stored on the network server via one of a LAN, a MAN, and a WAN. Pet. 43–44 (citing Ex. 1008, 2 (Murray's roaming profiles are retrieved from servers on the company's WAN); Ex. 1001 ¶¶ 292–299)).

Patent Owner does not separately argue claims 31, 43, and 47 but does include it in its arguments made in connection with independent claims 25, 34, and 40. PO Resp. 42–45. As discussed above, those arguments were determined to be unpersuasive.

Petitioner has shown by a preponderance of the evidence that claims 31, 43, and 47 are anticipated by Murray.

6. Summary of Anticipation Grounds Based on Murray

Petitioner has shown by a preponderance of the evidence that claims 25, 26, 31, 34, 35, 40, 41, 43, and 47–49 are anticipated by Murray.

E. Analysis of Obviousness Grounds Based on Murray

Petitioner argues claims 30, 32, 36–37, 39, 42, 44, and 46 are obvious over Murray and other prior art references as discussed below. Pet. 55–60. Patent Owner does not specifically argue patentability of the enumerated dependent claims. PO Resp. 46.

1. Dependent Claims 30, 36, and 42 as Obvious over Murray

Claims 30, 36, and 42 depend respectively from claims 25, 34, and 40, each reciting "wherein the plurality of pointers access user specific resources and information stored on the network via the Internet." Petitioner has provided evidence that Murray teaches the limitations of claims 30, 36, and 42. Pet. 55–56 (including claim chart). Petitioner cites to Murray's teaching Windows NT uses roaming profiles to retrieve a user's desktop via a WAN.

Pet. 55 (citing Ex. 1008, 2–3[24]). Petitioner argues that a WAN is a type of network and that additional networks known to the person of ordinary skill in the art, including the Internet, would further the purpose of the roaming profile system. Pet. 55–56 (citing Ex. 1008, 3; Ex. 1001 ¶¶ 322–323). Furthermore, Petitioner notes that Murray teaches "that these local devices contain 'Internet browser bookmark files.'" *Id.* (citing Ex. 1008, 6).

Patent Owner does not separately argue claims 30, 36, and 42 but does include it in its arguments made in connection with claims independent claims 25, 34, and 40. PO Resp. 46. As discussed above, those arguments were determined to be unpersuasive.

Petitioner has shown by a preponderance of the evidence that claims 30, 36, and 42 would have been obvious over Murray.

2. Dependent Claims 32, 37, and 44 as Obvious over Murray and Arnold

Claims 32, 37, and 44 depend from claims 25, 34, and 40, respectively. Claims 32, 37, and 44 each recite "wherein the plurality of pointers access the user specific resources and information stored on the network server via a cellular network."

Petitioner relies on Arnold for its disclosure of "users retrieving data from the Internet to their PCs via a network of base stations providing cell sites, i.e., a cellular network." Pet. 57 (citing Ex. 1013, 8:1–29, 10:27–30, Fig. 1; Ex. 1001 ¶¶ 348-350). Mr. Lieberman opines on a motive to combine Murry and Arnold, testifying "it would have been obvious to one having ordinary skill in the art at the time of the alleged invention to combine Murray with the well-known features of Arnold to expand the

[24] Murray describes a "wide area network" at page 2 and "WAN" at page 4.

geographical reach of the Windows NT roaming profile system." Pet. 57 (citing Ex. 1001 ¶¶ 357–358).

Patent Owner does not separately argue claims 30, 36, and 42 but does include it in its arguments made in connection with independent claims 25, 374, and 40. PO Resp. 46. As discussed above, those arguments were determined to be unpersuasive.

Petitioner has shown by a preponderance of the evidence that claims 32, 37, and 44 would have been obvious over Murray and Arnold.

3. Dependent Claims 39 and 46 as Obvious over Murray and Davis

Claims 39 and 46 depend respectively from claims 34 and 40, and recite the same limitation, i.e., "wherein the user specific resources is retrieved based on a user licensing model." Petitioner argues "Davis discloses user-specific software licenses that are directed toward individuals and are enforced using a user-specific dongle." Pet. 59 (citing Ex. 1012, 1:59–2:21, 2:49–50; Ex. 1001 ¶ 375). As a motive to combine, Petitioner argues "[i]t would have been obvious to one having ordinary skill in the art to combine Murray with the well-known teachings of Davis to allow a user access to his or her programs from any computer under a single license." *Id.* (citing Ex. 1001 ¶¶ 381–382).

Petitioner argues it would have been obvious to combine Richardson with Davis to allow a user access to his or her programs from any computer under a single license. Pet. 37 (citing Ex. 1001 ¶¶ 226–227).

Patent Owner does not separately argue claims 39 and 46 but does include it in its arguments made in connection with claims independent claims 25, 34, and 40. PO Resp. 46. As discussed above, those arguments were determined to be unpersuasive.

Petitioner has shown by a preponderance of the evidence that claims 39 and 46 would have been obvious over Murray and Davis.

4. Summary of Obviousness Grounds Based on Murray

Petitioner has shown by a preponderance of the evidence that claims 30, 32, 36–37, 39, 42, 44, and 46 would have been obvious over the various recited combinations involving Murray.

F. Patent Owner's Motion to Exclude

Patent Owner's Motion seeks to exclude Murray (Ex. 1008) on the grounds that it is not prior art and, as such, is irrelevant. Mot. 3–7. In addition, Patent Owner contends Murray is inadmissible hearsay. *Id.* at 3, 7–8. Petitioner opposes the Motion asserting, *inter alia*, that Patent Owner failed to make a relevance objection to Murray with respect to claims upon which trial was instituted and that Murray and its supporting proof of publication, *Large Scale System Administration of Windows NT Workshop*,[25] are not offered for the truth of the matter asserted and are not hearsay. Mot. Opp. 1 (citing Patent Owner's Objections to Petitioner's Evidence Pursuant to 37 C.F.R. § 42.64(b)(l), Ex. 2009, 4). Patent Owner's Reply to Opposition responds that it "timely objected to Murray on relevance grounds" and that Murray and the proof of publication are hearsay because they are offered to show the truth of the matter asserted, i.e., that the documents were publicly available before the critical date. PO Reply 1–3.

1. Relevance Objection

Patent Owner's objection asserted Murray was irrelevant "because cited portions are not relevant to any issues remaining in this proceeding.

[25] Exhibit 1009, offered as proof of publication of Murray, dated August 14–16, 1997.

E.g., Petition at pp. 47–50, Lieberman Decl. ¶¶ 288-320." Ex. 2009, 4. By referring to the Petition pages 47 through 50, Patent Owner's objection specifically refers to claims 3–5 and 13–15, claims upon which trial was not instituted. *See* Dec. Inst. 31–32, 35.

The relevance objection did not assert Murray was not prior art and thus irrelevant. We agree with Petitioner that the objection was not sufficiently particular to enable Petitioner to cure with supplemental evidence. *See* Opp. 3. Thus, Patent Owner's objection is not the same objection as Patent Owner attempts to raise in its Motion to Exclude under 37 C.F.R. § 42.64(c). The relevance objection to Murray is denied.

Because we have determined the objection based on whether Murray is relevant based on not being prior art was not preserved, we need not address the balance of Petitioner's arguments on relevance. Opp. 3–7.

2. Hearsay Objection

Patent Owner alleges both Murray and its proof of publication are offered for the proof of the matter asserted, that Murray was publicly available prior to the critical date of the '002 patent. Mot. 7. Petitioner contends the date on the face of Exhibits 1008 and 1009 are non hearsay "because they are verbal acts, not assertions." Opp. 7–8.

In support of its position, Petitioner cites several district court decisions and a decision on *inter partes* review that dates on prior art "serve a non-hearsay purpose for which it can be admitted—namely to prove that the document was available publicly as of that date." Opp. 8 (citing *EMC Corp. et al. v. PersonalWeb Techs., LLC et al.*, IPR2013-00082, op. at 61 (PTAB May 15, 2014)(Paper 83)). However, as Patent Owner notes, other panels have determined that dates on documents are hearsay. Mot. 7 (citing

Standard Innovation Corp. v. Lelo, Inc., IPR2014-00148, op. at 13-18) (PTAB Apr. 23, 2015)(Paper 42) (date on exhibit is inadmissible hearsay).

The Board has no precedential decision on the point and we are not bound by what other panels do on their particular facts. The Federal Rules of Evidence are applicable to an *inter partes* review such as the case at hand. *See* 37 C.F.R. § 42.62.

Petitioner argues Murray and the proof of publication are consistent with the Wayback Machine evidence. Opp. 9. The Wayback Machine evidence is an electronic document purporting to show when USENIX posted a publicly available summary of the Workshop Program and agenda on its website. *See id.* at 6. Although we are cognizant that electronic documents generally are not self-authenticating, it has been recognized that "[t]o authenticate printouts from a website, the party proffering the evidence must produce some statement or affidavit from someone with knowledge of the website . . . for example a web master or someone else with personal knowledge would be sufficient." *St. Luke's Cataract and Laser Institute v. Sanderson*, 2006 WL 1320242, *2 (M.D. Fla. 2006) (quoting *In re Homestore.com, Inc. Sec. Litig.*, 347 F. Supp. 2d 769, 782 (C.D. Cal. 2004)) (internal quotation marks omitted); Ex. 2024; *see also Market-Alerts Pty. Ltd. v. Bloomberg Finance L.P.*, 922 F. Supp. 2d 486, 493, n.12 (D. Del. 2013) (citing *Keystone Retaining Wall Sys., Inc. v. Basalite Concrete Prods., LLC*, 2011 WL 6436210, *9 n.9 (D. Minn. 2011)) (Documents generated by a website called the Wayback Machine have been accepted generally as evidence of prior art in the patent context.); *U.S. v. Bansal*, 663 F.3d 634, 667–68 (3d. Cir. 2011) (concluding that the screenshot images from the Internet Archive were authenticated

sufficiently under Federal Rule of Evidence 901(b)(1) by a witness with personal knowledge of its contents, verifying that the screenshot the party seeks to admit are true and accurate copies of Internet Archive's records).

The Wayback Machine evidence includes the authentication required by Federal Rule of Evidence 901(b)(1). *See Bansal*, 663 F.3d at 667–68. Specifically, Exhibit 1022 includes the Butler Affidavit, the Office Manager of the Internet Archive, which includes the Wayback Machine service. Ex. 1022, 1. Mr. Butler testifies that Exhibit A attached to his affidavit, the Workshop Program and agenda, each include a footer showing the date assigned by the Internet Archive. Ex. 1022 ¶ 5. Mr. Butler testifies the footer date may not be the same as the date the actual images were archived. *Id.* Mr. Butler further testifies that Exhibit A to his affidavit "are true and accurate copies of printouts of the Internet Archives records of the HTML files for the URLs and dates specified in the footer of the printout." *Id.* at ¶ 6. Thus, the archive dates of the two attachments forming Exhibit A were January 28, 1998, and June 6, 1997, respectively. *See id.* at ¶ 5, Exhibit 1022, 4, 40 (footers). The actual date of the seminar in the proof of publication is August 14–17, 1997. Ex. 1009, 1. Given Mr. Butler's testimony that the dates of the Wayback Machine evidence may not be the same as the actual archive date (Ex. 1022 ¶ 5), we do not find the discrepancies in the dates troubling, particularly given all the consistencies between the exhibits.

As a preliminary matter, the Butler Affidavit consists of statements made by the Mr. Butler while testifying in this proceeding, "at the current trial," and are not "hearsay." *See* Fed. R. Evid. 801(c). Further, Exhibit 1022 has been authenticated sufficiently to warrant the admissibility of the

Exhibit A attachments under Federal Rules of Evidence 901(b)(1), (b)(3), and (b)(4).

That Exhibit 1022 is not hearsay and authenticates Exhibit A's attachments does not necessarily overcome the hearsay objection to Murray and the proof of publication. Murray and the proof of publication are offered to show that as of their dates the exhibits were publicly available prior art. Absent some exception, they are hearsay. Contrary to Petitioner's assertion, they are not relevant for the fact that they are what they are but rather for what they say.

Petitioner additionally asserts that if Murray and its proof of publication are hearsay, the residual exception of Federal Rule of Evidence 807 applies. Opp. 8. Petitioner contends Murray and its proof of publication are admissible because they "contain circumstantial guarantees of trustworthiness." *Id.* at 8–10 (citing Fed. R. Evid. 807(a)(1)).

Federal Rule of Evidence 807 provides a "residual exception" to the hearsay rule, which may apply even if no specific exception of Federal Rule of Evidence 803 applies. To fall under this exception, the statement must: 1) have equivalent circumstantial guarantees of trustworthiness; 2) be offered as evidence of a material fact; 3) be more probative on the point for which it is offered than any other evidence that the proponent can obtain through reasonable efforts; and 4) be in the interests of justice to admit. Fed. R. Evid. 807. The residual exception to the hearsay rule is to be reserved for "exceptional cases," and is not "a broad license on trial judges to admit hearsay statements that do not fall within one of the other exceptions." *Conoco Inc. v. Dep't of Energy*, 99 F.3d 387, 392 (Fed. Cir. 1996), as amended on reh'g in part (Jan. 2, 1997) (internal quotations omitted). Trial

courts are accorded wide discretion in applying exception. *Doe v. United States*, 976 F.2d 1071, 1076–77 (7th Cir. 1992), *cert. denied* 510 U.S. 812 (1993); *United States v. North*, 910 F.2d 843, 909 (D.C. Cir. 1990) cert. denied 500 U.S. 941 (1991).

We are persuaded that Exhibits 1008, 1009, and 1022 are consistent as to the close proximity of the dates shown, corroborate each other, and are circumstantial evidence of trustworthiness. Exhibit 1022 establishes that attached Exhibit A's attachments, the Workshop Program (Ex. 1022, 1–39) and the agenda (Ex. 1022, 40–42), are true and correct copies of the Wayback Machine "files for the URLs and dates specified in the footer of the printout." Ex. 1022 ¶ 6. The agenda shows that a presentation entitled "Effective Usage of individual User NT Profiles with Software Distribution" was given by Mark Murray and Troy Roberts of Interprovincial Pipe on Saturday, August 16. Ex. 1002, 41. The proof of publication shows a date of August 14–16, 1997 for the entire workshop and August 16, 1997, as the date of presentation by Mr. Murray and Mr. Roberts. The Workshop Program title and proof of publication are the same and have all but the same title as Murray.[26] The presenters of the Workshop Program and the authors of Murray are the same. This evidence is sufficient to show "circumstantial guarantees of trustworthiness."

The other elements of Federal Rule of Evidence 807(c) are met. The evidence is offered to show a material fact, the date of Murray to show it is prior art. There is no other evidence of record "more probative on the point

[26] The word "Usage," rather than use, and the addition of the acronym NT in the Workshop Program and proof of publication titles are *di minimus* differences between their titles and the title of Murray. *See* Opp. 7.

for which it is offered." Petitioner represents that it made reasonable efforts to and no other evidence was available. Opp. 9 ("IV deprived IBM the opportunity to take any further reasonable efforts to prove Murray's (Ex. 1008) publication date because IV never properly objected to its status as prior art. *See* Ex. 2009 at 4."). Finally, we determine that admission of the evidence is in the interests of justice.

Petitioner's Exhibit 1022 also shows the Workshop Program and agenda, and thus Murray[27] were publicly available. For example, "there were no fewer than 15 attendees present during Murray's (Ex. 1008) presentation." Opp. 5 (citing Ex. 1022, 28–33). Inasmuch as we have found that Exhibit 1022 is admissible, its URL dates are evidence of publication on the Workshop Program's sponsor's (USENIX) website. *Id.* at 6.

We also note that Patent Owner's objection on both Exhibits 1008 and 1009 is a general objection to hearsay. The public accessibility of Murray is a substantive issue, not an evidentiary one, and is better suited for Patent Owner's Response than for a motion to exclude. The Response addresses Murray but fails to even mention public availability.

Under these circumstances, we exercise our discretion and admit Murray as prior art, as supported by the proof of publication (Exhibit 1009) and the Wayback Machine evidence (Exhibit 1022). We also determine that Petitioner has shown that Murray was publicly available.

Patent Owner's Motion to Exclude Murray based on a hearsay

[27] Murray states "The following paper was originally published in the Digest of the Large Scale System Administration of Windows NT Workshop Seattle, Washington, August 1997." Ex. 1008, 1.

objection is denied.

ORDER

For the reasons given, it is

ORDERED that Petitioner has shown by a preponderance of the evidence that claims 25, 26, 28, and 30–49 of U.S. Patent No. 6,546,002 B1 are unpatentable;

FURTHER ORDERED that Patent Owner's Motion to Exclude is denied; and

FURTHER ORDERED that, because this is a final written decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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