

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HOSPITALITY CORE SERVICES, LLC,
Petitioners,

v.

NOMADIX, INC.,
Patent Owner.

Case IPR2016-00073
Patent 8,156,246 B2

Before HOWARD B. BLANKENSHIP, GLENN J. PERRY, and TREVOR
M. JEFFERSON, *Administrative Patent Judges*.

JEFFERSON, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Hospitality Core Services, LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) to institute an *inter partes* review of claims 1–17 of U.S. Patent No. 8,156,246 B2 (Ex. 1001, “the ’246 patent”) pursuant to 35 U.S.C. §§ 311–319. Patent Owner, Nomadix Inc., filed a Preliminary Response to the Petition. (Paper 6, “Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314(a). Section 314(a) provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” After considering the Petition, the Preliminary Response, and associated evidence, we conclude that Petitioner has not demonstrated a reasonable likelihood that it would prevail in showing unpatentability of claims 1–17.

A. *Related Proceedings*

Petitioner states that *Nomadix, Inc. v. Hospitality Core Services LLC, d/b/a Blueprint RF* (No. 2:14-CV-08256-DDP (VBKx) (C.D. Cal.) is related to the ’246 patent. Pet. 3.

B. *The ’246 Patent*

The ’246 patent generally describes systems and methods for managing and providing content and services on a network system. Ex. 1001 at [57]. In one embodiment, a gateway manages a user’s access to a network. For example, a hotel guest’s web page request may be redirected to a portal page, as shown in the figure below reproduced from page 3 of Patent Owner’s Preliminary Response.

Login

To start using this service, you must first read and agree to the terms and conditions of use.

Terms And Conditions

Using room No. and name:

24hrs Internet Access \$12.95 ▼

Room:

Last Name:

ACCEPT

Using PIN:

PIN:

ACCEPT

The above figure, reproduced from page 3 of the Preliminary Response, shows a login portal for purchasing Internet Access.

Figure 1 of the '246 patent provided below is a block diagram of an embodiment described in the Specification.

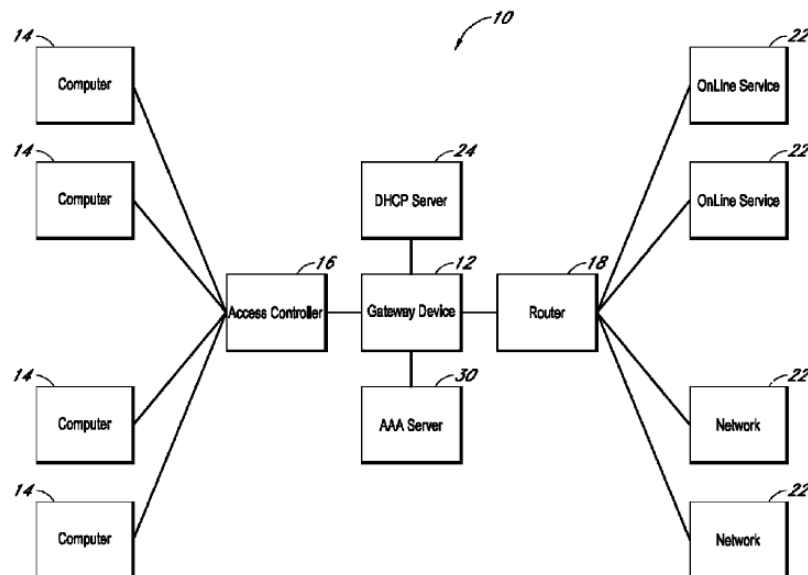


FIG. 1

Figure 1 shows computer system 10, which includes Access Controller 16, Gateway Device 12, DHCP Server 24, and AAA Server (authenticating, authorizing and accounting server) 30, for accessing networks and/or online services.

C. Illustrative Claim

Independent claim 1 is illustrative and reproduced below (Ex. 1001, 130:28–53):

1. A system for redirecting a computer in communication with a network, comprising:
 - a network access management system including at least one processor and at least one communications port, the network access management system configured to process an incoming request from the computer over the network for access to an external server that is outside of the network; and
 - a portal page redirection unit in communication with the network access management system, wherein the portal page redirection unit is configured to send, to the network access management system, redirection data identifying a portal page server, the portal page server being different from the external server;
 - wherein the network access management system sends to the computer an outgoing response based on the redirection data, the outgoing response configured to be responsive to the incoming request from the computer by pretending to be the external server in completing a connection handshake with the computer, and further by including a source address corresponding to the external server, whereby the outgoing response appears to have originated from the external server, and the outgoing response configured to cause the computer to initiate a second request for content from the portal page server.

D. Asserted Grounds of Unpatentability

The information presented in the Petition sets forth proposed grounds of unpatentability for the '246 patent as follows (Pet. 4–5):

Reference[s]	Basis	Claims Challenged
Slemmer ¹	35 U.S.C. § 102(e)	1–17
Slemmer and Vu ²	35 U.S.C. § 103(a)	1–17
Slemmer, IPORT, ³ and Applegate ⁴	35 U.S.C. § 103(a)	1–17

II. ANALYSIS

A. Claim Interpretation

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1278–79 (Fed. Cir. 2015), *cert. granted sub nom. Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 890 (mem.) (2016). There is a presumption that a claim term carries its ordinary and customary meaning. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002). The “ordinary and customary meaning” is that which the term

¹ US Patent 6,226,677 B2, issued May 1, 2001 (Ex. 1005, “Slemmer”).

² US Patent 5,623,601, issued April 22, 1997 (Ex. 1006, “Vu”).

³ IPORT™ INTERNET ACCESS SYSTEM, CONNECTION METHODS AND CONCEPTS FOR IPORT™ V2.X WHITE PAPER (Nov. 1998) (“IPORT V2x”). (Ex. 1007) and IPORT™ INTERNET ACCESS SYSTEM, IPORT CENTRAL OFFICE SOLUTION WHITE PAPER (Nov. 1998) (“IPORT CO”) (Ex. 1008), collectively referenced as “IPORT.”

⁴ US Patent 6,321,336 B1, issued November 20, 2001 (Ex. 1009, “Applegate”).

would have to a person of ordinary skill in the art in question. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Any special definition for a claim term must be set forth with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). Only those terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

1. “redirection server” (independent claims 6 and 9) and
“portal page redirection unit” (independent claim 1)

The term “redirection server” appears in independent claims 6 and 9. A related limitation that appears in independent claim 1 refers to a “portal page redirection unit.” Petitioner does not provide an express construction for the redirection unit, but Petitioner acknowledges that the claim term was construed in prior proceedings related to U.S. Patent No. 6,636,894 C1 (“the ’894 patent”). Pet. 30–31. Specifically, Petitioner states that the Director of the Central Reexamination Unit (CRU)—in a denial of a petition for the reexamination of the ’894 patent—states that “a redirection server [] is a piece of hardware that can be configured as a stand-alone unit or an add-in module for a gateway device The redirection server disclosed by and claimed in the ’894 patent is not software.” Pet. 16 (quoting Ex. 1004, 67).⁵ Petitioner argues that we should consider the CRU’s construction in light of

⁵ The ’246 patent was filed on September 26, 2011 as Application No. 13/244,866 and claims priority to U.S. Provisional Patent Application No. 60/111,497 through the ’894 patent. The Director of the CRU’s decision on the petition directly addressed the scope of the term “redirection unit” as recited in claims of the ’894 patent, through which the ’246 claims priority.

Patent Owner's contradictory claim construction, rather than just adopt the construction used in the reexamination of the '894 patent from which the '246 patent derives priority. Pet. 30.

Patent Owner contends that should the Board construe the term "redirection server," it should construe it to mean "a server that prepares a message instructing a computer receiving the message to redirect its browser to content differing from what was initially requested." Prelim. Resp. 7; *see* Ex. 1001, 44:1–3. Indeed, Patent Owner expressly "agrees that the broadest reasonable interpretation of *redirection server* does not require the redirection server to be a hardware component physically separate from the rest of the system." Prelim. Resp. 23.

Based on the record before us, neither Petitioner nor Patent Owner has provided sufficient evidence or argument that the CRU's interpretation of "redirection server" should be discarded. Petitioner's support for rejecting the CRU's construction is to point to Patent Owner's comments after the CRU's reexamination decision in the '894 patent. Pet. 31 (citing Ex. 1004, 1–2; Ex. 1001, 24:60–66, 36:52–55). Patent Owner's comments do not definitively refute the reasoning and construction of "redirection server" and "redirection unit" set out by the CRU and applied in the '894 reexamination. *See* Ex. 1004, 1–2; Ex. 1004, 67. We are also not persuaded by Patent Owner's argument that the Specification of the '246 patent indicates that the "redirection server" or "redirection unit" need not be a separate device. Prelim. Resp. 7. The Specification states that the redirection server may be located within the gateway device, which does not directly refute the CRU's construction.

Based on the record before us, we determine that the CRU's interpretation of "redirection server" as claimed is not in error. Accordingly, we determine that "a redirection server [or portal page redirection unit] is a piece of hardware that can be configured as a stand-alone unit or an add-in module for a gateway device" and "is not software." Ex. 1004, 67.

B. Anticipation Based on Slemmer (Ex. 1005) and Obviousness Based on Slemmer (Ex. 1005) and Vu (Ex. 1006)

1. Slemmer (Ex. 1005)

Slemmer describes "controlled communications over a global computer network." Ex. 1005, Title. Slemmer Figure 1 is reproduced below.

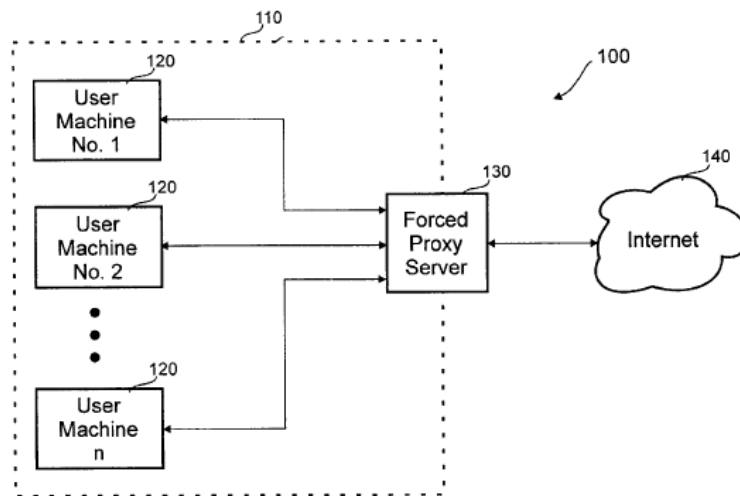


Fig. 1

Figure 1 depicts system 100, which includes user machines 120 that are a part of intranet 110 isolated from Internet 140 by a firewall that may be implemented on a forced proxy server 130 that handles signal traffic to/from user machines 120. The output side of server 130 includes ports that

communicate with the Internet 140. Ex. 1005, 3:65–4:2. The Specification describes controlling communication of a TCP (Transmission Control Protocol) packet from a user machine 120. During a browser request, a TCP packet from user machine 120 arrives at forced proxy server 130. The TCP packet includes a field holding a first destination IP address. If the packet is intended to be transmitted over the Internet, its port designation is “80.” *Id.* at 4:19–31. Forced proxy server 130 analyzes the TCP packet. Port 80 packets that 1) have a first destination IP address, and 2) do not correspond to a “sandboxed” domain, are changed so as to be delivered to a different port, and the destination address is changed to a predetermined second destination IP address to reroute the TCP packet to another IP address on the Internet. The rerouted IP address provides content to the user machine in which at least a majority of the content is different from that expected to be obtained by the user machine. *Id.* at 4:31–50.

A software control program running on the server 130 is in communication with that software port to which the packet is redirected. This software port responds to the user machine request as if it were the web server on the Internet 140 to which the request was originally directed. The proxy server program or control program assumes control of the web request by fulfilling the actual request from the user machine 120 or implementing other predetermined steps. *Id.* at 4:40–50. Such other predetermined steps relate to providing information to the user machine 120 from one or more particular web pages of a web site different from the user machine 120’s requested site. The identification of the web pages to be directed to the particular user machine can be based on a number of factors including: the

input to the user machine 120 by the user or operator of that machine and provided to the browser on the user machine 120; the Internet or MAC address associated with the particular user machine 120; and other factors such as whether or not the Internet 140 is accessible to the capability of deactivating or essentially bypassing such controls in the sense of allowing a particular user machine 120 to freely access the Internet 140 as if the proxy server 130 were not interposed between the particular user machine 120 and the Internet 140. *Id.* at 4:51–63.

2. Analysis

Petitioner contends that claims 1–17 are anticipated by Slemmer (Ex. 1005) (Pet. 36–39) and rendered obvious by Slemmer and Vu (Ex. 1006) (Pet. 39–40). Petitioner relies on the “software control program” in Slemmer (Ex. 1005, 4:40–42) to disclose the “portal page redirection unit” in claim 1 and the “redirection server” in claims 6 and 9 of the ’246 patent. Petitioner concedes, however, that if “redirection server” and “portal page redirection unit” are construed as in the ’894 patent reexamination proceedings “to exclude a software proxy running on the gateway,” then the software proxy of Slemmer does not disclose the recited “redirection server” or “portal page redirection unit.” Pet. 36, 40. Based on our construction of “redirection server” and “portal page redirection unit” discussed above, we agree with Petitioner that the software program of Slemmer does not disclose the “portal page redirection unit” in claim 1 and the “redirection server” in claims 6 and 9 of the ’246 patent.

Accordingly, we find that Petitioner has not demonstrated that there is a reasonable likelihood that it would prevail in showing that claims 1–17 are

unpatentable as obvious under 35 U.S.C. § 103(a) over Slemmer and Vu, or unpatentable as anticipated by Slemmer under 35 U.S.C. § 102(e).

*C. Obviousness Based on Slemmer, IPORT (Exs. 1007 and 1008),
and Applegate (Ex. 1009)*

1. Printed Publication of IPORT

Patent Owner in its Preliminary Response contests that the documents of IPORT are prior art “printed publications” in accordance with 35 U.S.C. §§ 102 and 311(b). Prelim. Resp. 23–24. We look to the underlying facts to make a legal determination as to whether a document is a printed publication. *Suffolk Techs., LLC v. AOL Inc.*, 752 F.3d 1358, 1364 (Fed. Cir. 2014). The determination of whether a document is a “printed publication” under 35 U.S.C. § 102(b) involves a case-by-case inquiry into the facts and circumstances surrounding its disclosure to members of the public. *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004). Public accessibility is a key question in determining whether a document is a printed publication and is determined on a case-by-case basis. *Suffolk Techs.*, 752 F.3d at 1364. To qualify as a printed publication, a document “must have been sufficiently accessible to the public interested in the art.” *In re Lister*, 583 F.3d 1307, 1311 (Fed. Cir. 2009).

Petitioner relies on the Declaration by Mr. Keith Olsen (Ex. 1011) to “authenticate[] the publication and content” of the IPORT documents and a number of supporting documents (Ex. 1032–1037). Pet. 26–27. Mr. Olsen testifies that he served as the lead software programmer for ATCOM, Inc. from 1996 through the sale of the company in 2000. Ex. 1011 ¶ 1. ATCOM developed and released the IPORT system. *Id.* at ¶¶ 3, 4. According to Mr.

Olsen, Exhibit 1007 is a true and accurate copy of a “white paper” entitled “Connection Methods and Concepts for IPORT V2x” dated November 1998. *Id.* ¶ 46. Exhibit 1008 is a “true and accurate copy” of a “white paper” titled “IPORT Central Office Solution” dated November 1998. *Id.* ¶ 47. Also according to Mr. Olsen, both IPORT documents were “created for marketing purposes, published and distributed to potential customers as part of an aggressive and successful marketing campaign for the IPORT ‘server only’ systems.” *Id.* ¶ 48. Mr. Olsen testifies further that a World Wide Web Uniform Resource Locator (hyperlink) on the third page of IPORT indicates that both IPORT documents were published on the company’s web site. *Id.* ¶ 49. Mr. Olsen testifies further:

Due to the high level of customer interest and the fast pace of product development, the company published the white papers on its website as soon as they were available. The specific versions of the white papers dated November 1998 were therefore published on the IPORT website in November of 1998 and distributed to a number of major hotel chains we were actively working with at the time including Hilton, Hyatt, Wingate Inns, and many other existing and prospective customers.

Id. ¶ 50.

IPORT contains the month and year “November 1998” on the face of the document, and at page 3, an apparent copyright notice without a specified year or date. Ex. 1008, 1, 3. The front page, at the lower right, contains the notation “CONFIDENTIAL” and underneath that notation “SEC00732.” *Id.* at 1. Each page, in fact, contains a similar “CONFIDENTIAL” notation, numbered sequentially to “SEC00753.” *Id.* at 22. Neither the Petition nor Mr. Olsen indicates why a “true and accurate

copy” (Ex. 1011 ¶ 47) would have been published on the company’s web site despite being “CONFIDENTIAL.”

Regardless of the confidential markings, Mr. Olsen does not indicate why, in his service as the lead software programmer (Ex. 1011 ¶ 1) with the “role of software development,” which included “working on all aspects of IPORT system including the development, implementation, and documentation” relating to the IPORT system (*id.* ¶ 3), he was privy to when, or whether, particular documents were placed on the company’s website. Further, although Mr. Olsen submits that documents including IPORT were “distributed to a number of major hotel chains,” and “many other existing and prospective customers” (*id.* ¶ 50) — with no clear indication of *when* — the Declaration does not allege or explain that distribution to those entities means that the document “must have been sufficiently accessible to the public interested in the art.” *Lister*, 583 F.3d at 1311. “A given reference is ‘publicly accessible’ upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1194 (Fed. Cir. 2008) (quoting *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006)). Further, although Mr. Olsen testifies (Ex. 1020 ¶ 49) that information “describing IPORT” was “published on [ATCOM’s] website,” the testimony does not indicate how one of ordinary skill in the art, exercising reasonable diligence, could locate the IPORT documents in question. *See SRI Int’l*, 511 F.3d at 1186.

We conclude that, on this record, Petitioner has failed to meet its burden of at least a preliminary showing that IPORT are printed publications as contemplated by 35 U.S.C. §§ 102 and 311(b).

2. Analysis

Petitioner explicitly relies on IPORT to “describe[] a system showing the gateway (network management system) and the redirection server (portal page redirection unit) located in different premises” to disclose the “redirection server” and “portal page redirection unit” limitations of the challenged claims. Pet. 40. In view of our finding above that IPORT has not been shown sufficiently to be a printed publication, Petitioner has not provided sufficient evidence to show that Slemmer and Applegate disclose a redirection server as a separate unit. Pet. 45 (claim chart citing IPORT for “redirection unit”).

Based on the foregoing, we find that Petitioner has not demonstrated that there is a reasonable likelihood that it would prevail in showing that claims 1–17 are unpatentable as obvious under 35 U.S.C. § 103(a) over Slemmer, IPORT, and Applegate.

III. CONCLUSION

For the foregoing reasons, we determine that the Petition fails to establish a reasonable likelihood of prevailing on the asserted grounds that claims 1–17 would have been unpatentable as anticipated under 35 U.S.C. § 103(e) over Slemmer; claims 1–17 would have been unpatentable as obvious under 35 U.S.C. § 103(a) over (1) Slemmer and Vu or (2) Slemmer, IPORT, and Applegate.

IV. ORDER

Accordingly, it is

ORDERED that the petition is denied as to all challenged claims and no trial is instituted.

IPR2016-00073
Patent 8,156,246 B2

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