

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.
Petitioner,

v.

WINDY CITY INNOVATIONS, LLC,
Patent Owner.

Case IPR2016-01141¹
Patent 8,458,245 B1

Before KARL D. EASTHOM, DAVID C. McKONE, and
MELISSA A. HAAPALA, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

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

¹ The Board joined IPR2017-00655 with IPR2016-01141.

I. INTRODUCTION

Microsoft Corp. filed a Petition (Paper 1) to institute an *inter partes* review of claims 1–58 U.S. Patent No. 8,458,245 B1 (Ex. 1001, “the ’245 patent”). The Board instituted this proceeding as to challenged claims 1–40. Paper 8 (“1st Inst. Dec.”).

In IPR2017-00655, Facebook, Inc. (“Petitioner”) filed a Petition (IPR2017-00655, Paper 8, “Pet.”) to institute an *inter partes* review of claims 1–15, 17 and 18 of the ’245 patent.² Windy City Innovations, LLC (“Patent Owner”) filed a Preliminary Response (IPR2017-00655, Paper 7).

Joining Facebook to the instant proceeding as a party (*see* note 2), pursuant to 35 U.S.C. § 314, in our Second Institution Decision (Paper 28, “2nd Inst. Dec.”), we instituted this proceeding as to claims 1–15, 17, and 18 (the “challenged claims”).³ We also dismissed claims 16 and 19–40 from this proceeding (the claims challenged by Microsoft, but not by Petitioner). 2nd Inst. Dec. 9–10.

² Petitioner Facebook filed the Petition and a motion for joinder in *Facebook, Inc. v. Windy City Innovs., LLC*, Case IPR2016-00655 (Papers 2 and 3, with that proceeding now terminated due to joinder with the instant proceeding).

³ The Board terminated Microsoft Corp. as a party based on a settlement agreement with Patent Owner. *See* Papers 25–27. In the Second Institution Decision (Paper 28), the Board determined the two Petitions presented “materially the same arguments based on the same evidence” with the only exception being that Facebook challenged a subset of claims 1–58 that Microsoft challenged. *See* 2nd Inst. Dec. 7.

Prior to the Second Institution Decision, Patent Owner filed a Patent Owner's Response (Paper 23, "PO Resp."), and after the Second Institution Decision, Petitioner filed a Reply (Paper 40, "Pet. Reply").

Petitioner relies on two declarations of Christopher M. Schmandt: Ex. 1003 ("Schmandt Declaration"); Ex. 1100 ("Schmandt Reply Declaration"). Patent Owner relies on the Declaration of Jaime Carbonell, Ph.D.: Ex. 2005 ("Carbonell Declaration"). An Oral Hearing occurred on October 19, 2017 (Paper 58, "Tr.").

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision issues under 35 U.S.C. § 318(a). Based on the record before us, Petitioner has demonstrated, by a preponderance of the evidence, that the challenged claims, claims 1–15, 17, and 18 of the '245 patent, are unpatentable.

A. Related Cases

The parties identify the following district court cases as related to this proceeding: *Windy City Innovations, LLC v. Microsoft Corp.*, 4:16-cv-01729-YGR (N.D. Cal.); *Windy City Innovations, LLC v. Facebook, Inc.*, 4:16-cv-01730-YGR (N.D. Cal.). Pet. 3–4. The instant *inter partes* review relates to several other *inter partes* reviews challenging three other patents and the '245 patent that each have a common underlying original application: Terminated IPR2017-00624 joined with IPR2016-01067 (Patent 8,407,356 B1); terminated IPR2017-00622 joined with IPR2016-01155 (Patent 8,694,657 B1); terminated IPR2017-00709 joined with IPR2016-01156 (Patent 8,458,245 B1); IPR2016-01157 (Patent 8,407,356 B1); IPR2016-01158 (Patent 8,473,552 B1); and terminated IPR2017-00659 joined with IPR2016-01159 (Patent 8,694,657 B15).

B. The '245 Patent

The '245 patent describes connecting users with participator computers to an Internet “chat room” via a controller computer. *See* Ex. 1001, 2:25–27, 9:18–28, Fig. 1, Fig. 7 (showing “Login to Chat” button). According to the '245 patent, known prior art systems linked computers together to form chat rooms in which users communicated by text, graphics, and multimedia, for example, via a system provided by the Internet service provider “America On Line.” Ex. 1001, 1:40–46. The '245 patent acknowledges that chat rooms have been implemented on the Internet, albeit with “limited chat capability,” but contends that the complex chat room communications capable with Internet service providers had not been developed on the Internet “at least in part because Internet was structured for one-way communications analogous to electronic mail, rather than for real time group chat room communications” and because “there is no particular control over the platform that would be encountered on the Internet.” *Id.* at 1:54–56, 1:60–62. During the Oral Hearing, Patent Owner explained that a key distinction over prior art chat systems on the Internet involved providing security by using tokens, as known Internet chat systems were “closed” and did not require security. *See* Tr. 49:2–6 (“And so what Dr. Marks invented here, what he saw as a problem was security concerns over the Internet and doing the types of things you might want to do in a closed system like America Online or like potentially some BBS systems and to add those features to an Internet-capable system.”).

To implement the chat room communications, “participator computers” operate in conjunction with a “controller computer” to “handle multiplexing operations for communications involving groups of some of the

participator computers.” Ex. 1001, 1:23–30. Figure 1 of the ’245 patent, reproduced below, depicts an embodiment of such a system.

FIG. 1

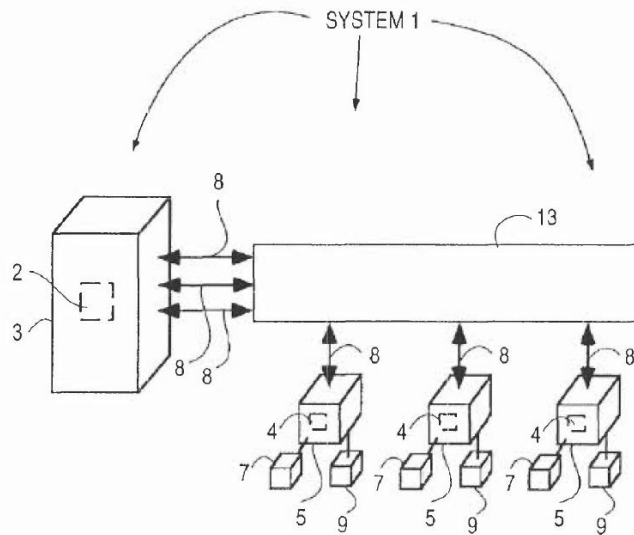
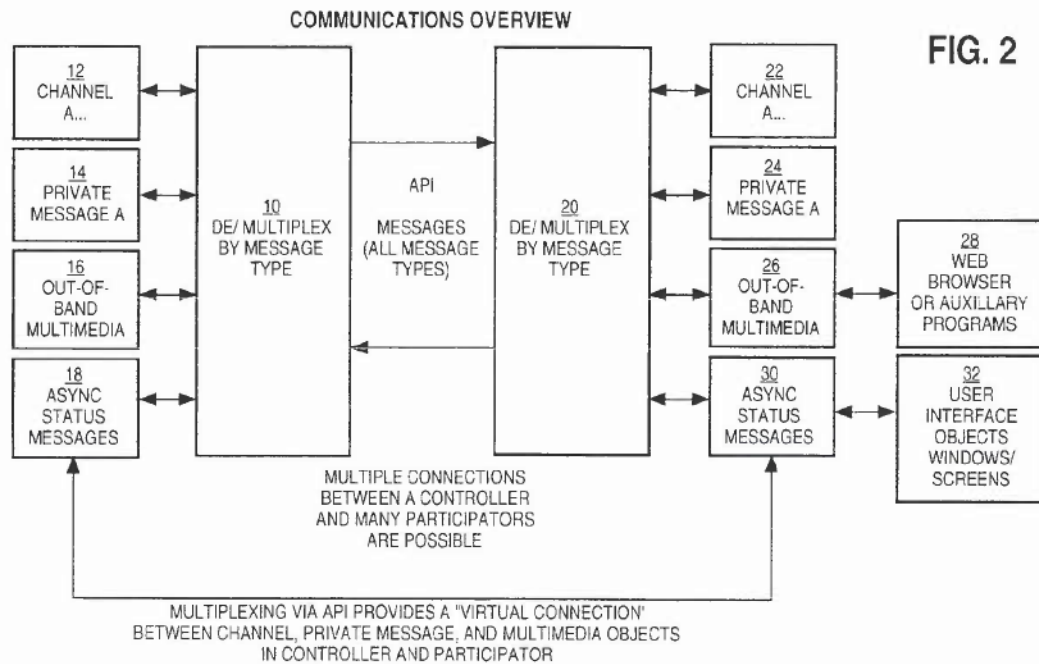


Figure 1 depicts computerized arbitrating and distributing system 1, which includes controller computer 3 and a plurality of participator computers 5. *Id.* at 4:67–5:6. Controller software 2 controls the operation of controller computer 3, and each participator computers 5 operates under the control of participator software 4. *Id.* at 5:21–29. Controller computer 3 and participator computers 5 connect via connection 13 (e.g., an Internet connection). *Id.* at 5:17–20. A user of one participator computer 5 may send multimedia information message 8 to controller computer 3, which arbitrates which participator computers 5 receive the message. *Id.* at 5:28–37. All multimedia information may be transmitted as pointers, such as URLs (Uniform Resource Locators), pointing to pre-stored audio and video communications that controller computer 3 can fetch to communicate to participator computers 5. *Id.* at 5:38–43.

Figure 2, reproduced below, represents an overview of the communications described in the '245 patent.



Blocks 10, 12, 14, 16, and 18 in Figure 2 illustrate operations under controller software 2, and Blocks 20, 22, 24, 26, and 30 illustrate operations under participator software 4. *Id.* at 5:45–54, 5:58–6:2. For example, Block 14 represents the handling of a private message. *Id.* at 5:50–51.

Block 10 and Block 20 illustrate software multiplexing and demultiplexing of messages by message type on the controller computer and a participator computer, respectively. *Id.*

The Specification further describes logging in to begin a chat session:

Turning now to an illustration of using the invention, the session starts with verifying the user's identity (at FIG. 7). The login/password screen is shown, and the user enters his/her assigned login/password combination and clicks the "Login To Chat" button. If the password was entered correctly, a confirmation box appears on the screen.

Ex. 1001, 9:16–21. Figure 7 follows:

FIG. 7

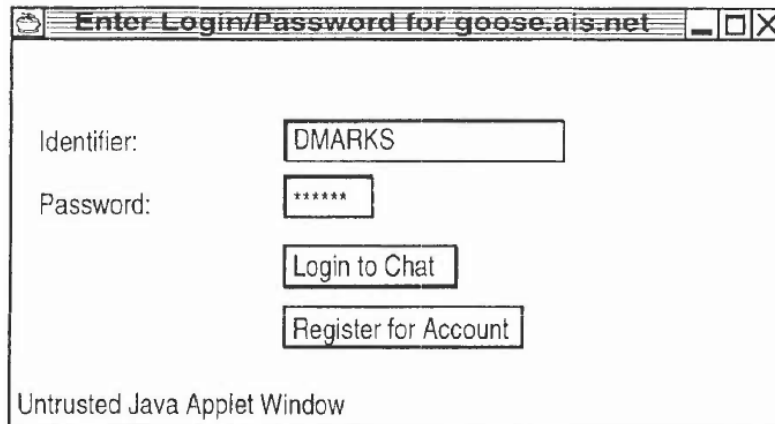


Figure 7 of the '245 patent, reproduced above, illustrates an aspect of the invention as including a menu at a user's computer for entering login and password information of a user. *See* Ex. 1001, 9:16–21. Such information, stored in a database, represents a token that controls access to the system. *See id.* at 8:6–58, 11:4–14.

Figure 28, reproduced below, is similar to Figure 7, but represents an “alternate embodiment using a text-based interface” (*id.* at 11:14–16):

FIG. 28

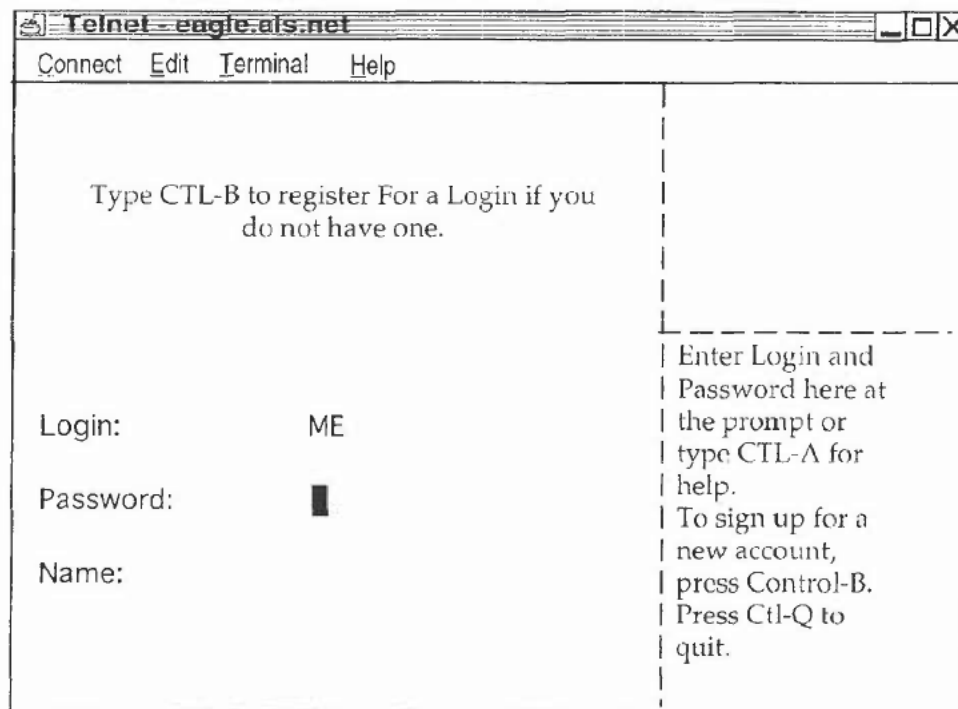


Figure 28 reveals a login interface using a Telnet feature (as indicated at the top of the figure). “The user must now enter his/her login and password to identify themselves.” *Id.* at 11:18–19. Figure 27 represents a “Property Editor” interface that allows “a user with sufficient permissions (tokens)” to “change any of the tokens.” *Id.* at 11:12–13.

C. Challenged Claims

Independent challenged claims 1 and 7 recite similar subject matter. Each of the remaining challenged claims depends directly or indirectly from claims 1 or 7. Illustrative claim 1 follows:

1. A computer apparatus distributing a communication over an Internet network, the apparatus including:

a controller computer system adapted to communicate responsive to a respective authenticated user identity

corresponding respectively to each of a plurality of participator computers,

each said participator computer communicatively connected to said Internet network, each said participator computer programmed to enable the communication, the communication including at least one of a pre-stored sound, video, graphic, and multimedia,

the controller computer system including a controller computer and a database which serves as a repository of tokens for other programs to access, thereby affording information to each of the participator computers which are otherwise independent of each other;

wherein one said authenticated user identity is used to communicate a pointer-triggered private message from a first of said participator computers to said controller computer and from said controller computer to a second of said participator computers that invokes said pointer-triggered private message to fetch and receive the communication from a computer other than said first or said second said participator computers in real time over the Internet network

such that the second of said participator computers internally determines whether or not the second of the participator computers can present the communication, if it is determined that the second of the participator computers can not present the communication then obtaining an agent with an ability to present the communication, and otherwise presenting the communication independent of the first of the independent participator computers and the computer.

D. Asserted Grounds of Unpatentability

The Board instituted on the ground that claims 1–15, 17, and 18 would have been obvious over under 35 U.S.C. § 103(a) based on the combined teachings of Major BBS⁴ and Higley.⁵ 2nd Inst. Dec. 2, 7, 10.

II. ANALYSIS

A. Claim Construction

We interpret claim terms in an unexpired patent using the broadest reasonable construction in light of the specification of the patent in which they appear. *See* 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–45 (2016). In applying a broadest reasonable construction, claim terms generally carry their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

In the First Institution Decision, we preliminarily construed “token,” “censored,” and “pointer/pointer-triggered message on demand.” 1st Inst. Dec. 7–10. In the institution decision in related IPR2016-01158, Paper 7, 7–15, which involves a common ancestor application to the ’245 patent, we construed those or similar terms in the same fashion, and other terms, as follows:

⁴ GALACTICOMM, INC., THE MAJOR BBS VERSION 6.2 SYSTEM OPERATIONS MANUAL (1994) (Ex. 1012, “Major BBS”).

⁵ U.S. Patent No. 5,790,793, filed Apr. 4, 1995, issued Aug. 4, 1998 (Ex. 1010, “Higley”).

Claim Term	Construction
“token”	“piece of information associated with user identity”
“database”	“a collection of logically related data”
“censor”	“control what is said in a group”
“a pointer-triggered message on demand”	“a message, where the content of the message is specified by a pointer and found on demand of the operator of the participator software”
“pointer”	“a link or reference to a file, data, or service”

Patent Owner presents different constructions of “database” and “censor.” See PO Resp. 7–12 (treating censor, censorship, and censored, in materially the same manner). Petitioner accepts all of our constructions and presents arguments supporting our constructions of “database” and “censor.” See Pet. Reply 1–7.

We maintain our constructions of each term. In the final written decision in IPR2016-01158, we address the parties’ arguments regarding the construction of “database” (as claims 1 and 7 challenged here recite) and “censor” (challenged claims 6 and 8 here recite “censored”). See IPR2016-01158, Paper 47, Section II.A. Patent Owner presents materially the same evidence and arguments here that the Board addresses in IPR2016-01158, Paper 47, Section II.A. See PO Resp. 7–12 (citing Ex. 1001; Ex. 2002; Ex. 2003; Ex. 2004; Ex. 2005; Ex. 2007). We adopt and incorporate by reference the analysis in IPR2016-01158, Paper 47, Section II.A. Notwithstanding the parties’ different positions on the construction of “database” and “censor,” Patent Owner’s Response does not present a clear argument that turns on the construction as it relates to Petitioner’s obviousness challenges.

No other terms require express construction for purposes of this Final Written Decision. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (holding that terms need only be construed to the extent necessary to resolve the controversy at issue).

B. Alleged Unpatentability Under § 103(a)

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 the following factors: (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) objective evidence of nonobviousness, i.e., secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

1. Overview of Major BBS

The Major BBS Manual, a system operations manual, describes Galacticom Inc.’s “The Major BBS” or “Major BBS” software for a bulletin board system (“BBS”). *See* Ex. 1012, 1–3. According to Robert Stein, a former employee of Galacticom and the author of the Major BBS Manual, Galacticom distributed the Major BBS Manual to customers (typically a “Sysop” who manages the BBS) who purchased the Major BBS software. Ex. 1011 ¶¶ 9, 11–12, 14–15. According further to Mr. Stein,

[c]ustomers of The Major BBS bought the software to set up and manage their own bulletin board. The bulletin board owner was known as the “Sysop” for that particular bulletin board. The

Sysop would need the System Operation's Manual to install and operate The Major BBS.

Id. ¶ 9.

The Major BBS Manual describes the software system as supporting a multi-user BBS for users simultaneously communicating over modems, serial connections, local area network ("LAN") circuits, and X.25 packet-switching networks. Ex. 1012, 2.

A bulletin board system is a centralized service that users with computers and modems dial up over telephone lines. A user can download information, answer questionnaires, and exchange messages or files with other users.

A BBS is usually a computer hooked up to a bunch of modems and telephone lines. Typically, the user's side is one computer and one modem on a phone line.

Id. at 1.

To join the Major BBS, a user calls into the BBS (controlled by the Sysop), signs up, answers questions, and picks a User-ID and password. *Id.* at 4, 293. Users can connect, for example, using a computer, a modem, and terminal emulation software. *Id.* at 293. The Sysop assigns all users a key of a certain level that defines features available to the user. *Id.* at 107. The keys open locks such as "NORMAL," which gives "[a]ccess to most standard features." *Id.* at 107–08. At the formation of the BBS, the system grants a SYSOP key to the Sysop, which gives "[s]weeping powers across all BBS services." *Id.* at 108. The Sysop can assign multiple users the same key by class (a "class keyring"), thereby granting a class of users the same access privileges and restrictions (e.g., NORMAL or MODERATE (allows those users to moderate teleconferences)). *Id.*

After obtaining a User-ID and password (which the users chooses), the user can log on to the system. *Id.* at 301–02. Different users register

different language preferences. *Id.* at 300 (for example, German). Once logged in, the user can participate in various electronic Forums.

Forums are for gathering people and information. . . . In a Forum, lots of people write messages and lots of people read or search or scan messages. You can direct a message to all users or to a specific user. You can search for messages in many ways: chronologically, by topic, by conversation threads, by message content, by lists of keywords, or by the unique message number.

Id. at 324. In a Forum, users post public messages that many users can read.

Id. at 304. A user optionally can attach and upload a file to a Forum message, which another user reading the message can download. *Id.* at 306. The system can assign different access levels to different users for accessing Forums, including “Read” access, in which a “user can read Forum messages, but not download files attached to the messages”; “Write” access, in which a “user can write Forum messages, but not upload files”; and “Forum-Op” access, in which a user “can approve uploads, maintain bulletins, and set the access levels of other users.” *Id.* at 139.

Each Forum can have its own Teleconference channel, in which the topic of the channel is the topic of the Forum. *Id.* at 246, 315, 339. According to the Major BBS Manual, “[t]eleconferencing simply allows several users to converse with one another over their terminals. When you type something, that message goes out to all the other users in the same Teleconference channel, telling them what you typed.” *Id.* at 315. The Major BBS Manual states “[t]eleconference channels have nothing to do with the communication channels that you use for your session on the BBS. Teleconference channels are just a method of keeping track of who is talking to whom.” *Id.* In other words, a “channel” specifies a group of people sending messages on a Forum or during a chat. *See id.*

Users can view a list of the services provided by a particular BBS in the form of menus in a tree structure. *Id.* at 59–60. Menus can be presented using *RIPscrip*, enabling some presentation of graphics in the menus. *Id.* at 64, 92. The system can present different menus depending on the key assigned or communication channel assigned to the user. *Id.* at 107.

2. Overview of Higley

Higley discloses a “method and system for sending and receiving Uniform Resource Locators (URLs) in electronic mail over the Internet.” Ex. 1010, Abstract. URLs are addresses that enable an Internet browser, such as Mosaic, to access HTML (Hypertext Markup Language) documents and other resources on the Internet. *Id.* at 1:30–43. HTML “provides for a mingling of text, graphics, video, sound and hypertext links.” *Id.* at 1:24–30. Mosaic, one example of “Multimedia Internet Browsers,” can access such content. *Id.* at 1:37–43.

According to Higley, URLs were often incorporated into e-mail messages, but users were required to manually type them into a separate browser program to access the linked information. *Id.* at 1:47–53. Higley describes a solution whereby a URL contained in a message is recognized (e.g., via HTML) and “the information of the URL is looked up, retrieved over the Internet or other network, and displayed by the receiver’s multimedia browser.” *Id.* at 5:1–53, Fig. 4. This can be accomplished responsive to a user’s “click” on the URL, or automatically without user input. *Id.* According to Higley, prior art “passive” browsers “access or ‘pull’ data from the Internet by use of various network addressing schemes.” *Id.* at 1:56–58. “[T]hey do not ‘push’ data that is on the Internet to users,

nor do the [prior art] browsers . . . allow for the receiving of such pushed data.” *Id.* at 1:60–63.

3. *Petitioner’s Obviousness Showing of Claim 1*

Petitioner asserts that claim 1 would have been obvious based on the combined teachings the Major BBS Manual and Higley. The Petition sets forth detailed contentions and identifies specific evidence to support this asserted ground of unpatentability. Pet. 17–39.

Claim 1 recites “a controller computer system,” including a “controller computer” adapted to communicate with “each of a plurality of participator computers,” with “each said participator computer communicatively connected to said Internet network.” Claim 1 also recites “distributing a communication over an Internet network.” As Petitioner contends, Major BBS describes BBS software installed on an IBM computer, which then communicates with users who access the BBS over modem connections with their computers. *See id.* at 17, 21; Ex. 1012, 1–11, 23–45.

With respect to the “Internet network” limitations, the Petition relies on combining the Major BBS Manual with Higley. Pet. 17–21. As Petitioner shows, Higley describes computers accessing information over the Internet via URLs included in e-mail and other types of messages. *See id.* at 19–20; Ex. 1010, 1:27–36, 3:1–5, 3:9–20, 5:1–53; Ex. 1003 ¶ 130. Higley explains one advantage of using URLs over the Internet: “[T]he received document is not necessarily an actual copy of the information from the URL but is the address of the location of the desired information,” which enables content to be “updated so that the person looking up the URL will always have access to the latest information.” Ex. 1010, 3:21–28. Petitioner points

out that using URLs on the Internet allows users to transfer multimedia. Pet. 20 (citing Ex. 1010, 1:27–36; Ex. 1010 ¶ 130). Higley discloses that its method provides for efficient transfer of information on the Internet using URLs. Ex. 1010, 3:1–5. Petitioner’s declarant, Mr. Schmandt, testifies that a person of ordinary skill would have been motivated to combine the distribution of multimedia content over the Internet to Internet-connected computers, as taught in Higley, with the BBS software of Major BBS, based on the benefits Higley touts, including the efficient transfer and viewing of the latest multimedia information. *See* Ex. 1003 ¶¶ 130–33.

Further, according to Mr. Schmandt, a person of ordinary skill would have considered connecting the Major BBS Manual’s functionality to the Internet would have been “no more than the arrangement of old elements with each performing the same function it had been known to perform and yielding no more than one would expect from such an arrangement, i.e., the ability of Major BBS users to exchange information over the Internet.” *Id.* ¶ 128. Mr. Schmandt also testifies that an ordinary artisan would have been motivated to combine Higley with the Major BBS Manual to “reach the large number of computer users who were connected to the Internet,” consistent with references in the Major BBS Manual for “worldwide access” and “universal access around the world.” *Id.* ¶ 129 (quoting Ex. 1012, 7).

Claim 1 recites “a respective authenticated user identity corresponding respectively to each of a plurality of participator computers,” and “a database which serves as a repository of tokens for other programs to access.” Petitioner contends Major BBS teaches these limitations. Pet. 22–23, 27–28 (citations omitted). The Major BBS Manual describes a “User Account Database,” which includes, for example, the UserID, real name,

password, and other personal information for users of The Major BBS. *Id.* at 28; Ex. 1012, 107–37, 381–82; Ex. 1003 ¶¶ 163–64, 167–68. The Major BBS Manual discloses that each user has a User-ID and password, stored in the User Account Database. Pet. 28; Ex. 1012, 4, 381–82. The User Account Database also includes keyrings. Pet. 28 (citing Ex. 1012, 384; Ex. 1003 ¶ 167); Ex. 1012, 381–82 (showing user information for “Diane Staten,” including “Current Class (Keyring)”).

After a user logs in (thereby accessing token information), Major BBS provides access to services such as teleconferences and forums, including through control of access by the keyrings. See Ex. 1012 at 301–02, 381–82. A “token,” as construed above, is “a piece of information associated with user identity.” Mr. Schmandt also testifies, *inter alia*, that Major BBS’s discussion of users accessing user information teaches “other programs” accessing the tokens. See Ex. 1003 ¶¶ 173–76.

According to Petitioner, “other programs” includes the Sysop (systems operator) software of the controller computer, other software utilized by users to access account information, Telnet, a communication protocol, and other terminal emulation software employed with Telnet. See Pet. 30–31 (citing Ex. 1003 ¶¶ 172–74, 176–77; Ex. 1012, 232, 369–70, 373–377); Ex. 1012, 4, 97–98, 121–22, 230, 369–77); Ex. 1003 ¶¶ 163–78. Mr. Schmandt describes “many instances of telnet application programs on various operating systems,” whereby Telnet and other terminal emulation software allows any authorized user to connect to Major BBS. See Ex. 1003 ¶ 176, ¶¶ 173–76. The Petitioner also refers to remote access by the Sysop. Pet. 31 (citing Ex. 1012, 230; Ex. 1003 ¶ 177). As examples of participator computers accessing database tokens, the Petition cites the Major BBS

Manual's disclosure of various menus that allow users to access, search, and edit their user account information and that of other users. *Id.* at 30–31 (citing Ex. 2012, 232, 369–70, 373–77).

Claim 1 recites “distributing a communication over an Internet network,” and “the communication including at least one of a pre-stored sound, video, graphic, and multimedia.” In addition, claim 1 recites a “pointer-triggered private message” sent from a first to a second participator computer (via the controller computer), and that the second computer “invokes said pointer-triggered private message to fetch and receive the communication . . . in real time over the Internet network,” with the communication being fetched and received from a computer other than either of the two recited participator computers.

Thus, claim 1 recites a “communication”—which includes “at least one of a pre-stored sound, video, graphic, and multimedia”—and a “pointer-triggered private message,” which causes the “communication” to be fetched and received by the computer that “invokes” the message. Further, the “communication” is not fetched from either the participator computer that sent the message or the participator computer that received the message, and the “communication” (but not necessarily the private message) is received “in real time over the Internet network.”

Petitioner identifies the teleconference feature of Major BBS as teaching the sending of private messages from one user to another via the BBS computer, including chat and whisper messages. *See* Pet. 34–35 (citing Ex. 1003 ¶¶ 140–46, 184–86; Ex. 1012, 316). As Petitioner contends, Major BBS describes a “WHISPER TO” command that sends “a private message to just one other user,” and a “CHAT” command that “allows two users to

enter chat mode where they can converse directly with one another.”

Ex. 1012, 316, 318.

Addressing the “pointer-triggered” private message, Petitioner relies on Higley for its discussion of messages including URLs. *Id.* at 34–36. Specifically, Higley describes a “‘URL’ type” message that “is essentially a pointer to another location or address on the Internet.” Ex. 1010, 5:27–30. Upon receiving such a message, “the URL contained in the message would automatically be looked up on the Internet and displayed.” *Id.* at 5:30–34. Higley also describes an “‘HTML’ type” message containing a URL that a user can “‘click’ . . . so that the information of the URL is looked up, retrieved over the Internet or other network, and displayed by the receiver’s multimedia browser.” *Id.* at 5:42–51.

The Petition identifies both Major BBS and Higley as teaching that the recited “communication” includes “at least one of a pre-stored sound, video, graphic, and multimedia.” Pet. 25–27. With respect to the Major BBS Manual, Petitioner identifies teachings regarding file transfers, graphics for a RIPaint program, and graphics menus. *Id.* at 25. Higley describes content on the Internet available via URLs as “files or formatted data using [HTML],” which “provides for a mingling of text, graphics, video, sound and hypertext links.” Pet. 26–27 (citing Ex. 1010, 1:27–30; Ex. 1003 ¶¶ 130–32).

Petitioner asserts that a person of ordinary skill would be motivated to combine these teachings of Higley and the Major BBS Manual because doing so would “release the client computers from the computational load of providing the URL content” themselves. Pet. 35–36 (citing Ex. 1003 ¶ 189). In addition, Petitioner asserts that multimedia “was a key aspect of web

pages and the Internet and was well known to one of ordinary skill.” Pet. 26 (citing Ex. 1003 ¶ 157; Ex. 1035, 2:44–47, 2:22–28).

Petitioner shows persuasively that the combination of Major BBS and Higley would have rendered obvious the “communication” and “private message” limitations of claim 1. Specifically, Petitioner persuasively shows that the asserted art teaches sending a private message containing a URL via a BBS (i.e., the controller computer), whereby the receiving user’s computer invokes the URL to fetch multimedia content (i.e., the communication) from another location via the Internet in real time (e.g., automatically).

Claim 1 recites that the participator computer receiving the pointer-triggered private message “internally determines” whether it can present the communication. If the computer determines it cannot present the communication, it obtains “an agent with an ability to present the communication.” Otherwise (i.e., if the computer determines it can present the communication), the communication is presented.

According to Petitioner, the combined teachings of Major BBS and Higley renders obvious these limitations of claim 1. Pet. 37–39. Specifically, Higley discusses recognizing an e-mail as a HTML-type message containing a URL, and displaying the HTML “via a MIB [(Multimedia Internet Browser)] as an external viewer.” Ex. 1010, 7:62–8:5. If the user clicks on the URL, “the information relating to the URL would be retrieved via the Internet and displayed”; this also may be performed “automatically . . . without user intervention.” *Id.* at 8:5–12. As explained by Higley, “Multimedia Internet Browsers” (“MIBs”) are capable of displaying HTML content that enables “a mingling of text, graphics, video, sound and hypertext links.” *Id.* at 1:23–46.

Claim 1 also recites

the second of said participator computers internally determines whether or not the second of the participator computers can present the communication, if it is determined that the second of the participator computers can not present the communication then obtaining an agent with an ability to present the communication, and otherwise presenting the communication independent of the first of the independent participator computers and the computer.

Addressing this limitation, Petitioner persuasively argues that

[i]n the combined system of Major BBS with Higley, the client software on the receiving participator computer (“*second of the participator computers*”) would determine if an incoming message contained a URL (“*internally determines whether or not the second of the participator computers can present the communication*”). If so, the terminal emulator program would invoke a[] multimedia web browser as an external agent to display the media located at the URL (“*obtaining an agent with an ability to present the communication*”).

Pet. 38 (citing Ex. 1003 ¶ 203); *see also id.* at 34–37 (explaining further how the combination suggests pointer-triggered private messages provided during chats or whisper messages and suggests real-time messages).

Petitioner also explains

the terminal emulator program would have already passed the responsibility of display to the web browser. Ex. 1003 ¶ 203. *Moreover, it would have been well known to one of ordinary skill in the art that the web browser itself would launch an external application in order to handle content that the browser could not render.* Ex. 1003 ¶ 203; Ex. 1005 (Mosaic Quick Tour) at 61–64 (describing how to specify which applications Mosaic should launch based on the type of content encountered), 93–107 (describing the various applications that the Mosaic web browser would invoke to handle various types of multimedia content referenced by a URL).

Id. at 38–39 (emphasis added).

According to Mr. Schmandt, these aspects of Higley, when combined with Major BBS (i.e., a participator computer receiving a private message), would have taught a person of ordinary skill the “internally determines whether or not [the receiving participator computer] can present the communication” and “obtaining an agent with an ability to present the communication” limitations of claim 1. Ex. 1003 ¶¶ 200–04. In other words, Petitioner persuasively shows the combination of Higley and the Major BBS Manual renders obvious the “internally determines” and “obtaining an agent” clause. See Pet. 38–39; Ex. 1003 ¶¶ 200–04.

Petitioner’s interpretation tracks Figure 6 of the ’245 patent. Figure 6 describes an “agent,” but it does not specify a location for the “agent.” See Ex. 1001, 7:34–55. The “NO” branch of flow box 102 in Figure 6 indicates the “AGENT” must be invoked when the multimedia type is not “INTERNALLY HANDLABLE,” but the Specification simply does not specify if the “agent” resides on the second participator computer or not. See *id.* (not specifying an agent location and not describing it as an external agent); *id.* at 10:63–65 (“To do this, the participator software 6 either uses built in rules to decide how the graphical multimedia data is to be presented, or locates another program suitable to present the data. In this case, the software 6 is utilizing Netscape Navigator[], a program for displaying graphical multimedia documents specified by a URL.”).

Patent Owner refers to this “internally determines” and “obtaining an agent” clause as “out-of-band handling” and states the “out-of-band handling is only described in the context of ‘participator software,’ which runs on every participator computer” and “that has its own software modules.” PO

Resp. 24.⁶ This argument implies an internal determination may be performed by software modules, but it does not dispute or address Petitioner’s showing with respect to the internal determination and an “agent”—e.g., as an agent either on the second participator computer but running separate from proprietary participator software code (including but not limited to a group of modules), or as an “external application” launched by known browsers suggested by Higley. *See* Pet. 35, 38–39 (“external application” launched by browser); note 6; Ex. 1001, 4:53–55 (stating “the appendix includes code for two different embodiments”).

Petitioner contends a combined client computer as suggested by Higley internally determines it cannot handle a URL and “fetch[es] the media from a computer other than the first or second computer,” either automatically or manually (i.e., after an operator clicks on the URL), thereby relieving the “computational load” on the second participator computer. *See* Pet. 35–36 (citing Ex. 1003 ¶¶ 188–189; Ex. 1005, 85–92; Ex. 1010, 5:45–53, Fig. 5 (displaying various flow boxes representing “separate functional blocks,” 6:34–37)), 38–39 (quoted above).⁷ In other words, prior to a manual clicking on the URL, or after the computer automatically determines a URL exists that it cannot handle, as Higley suggests in combination with the Major BBS Manual, the second computer first determines that a message

⁶ Patent Owner cites the whole of Figure 6 and its surrounding disclosure to support this “out-of-band handling” limitation. *See* PO Resp. 23–24 (quoting Ex. 1001, 7:34–55, reproducing Figure 6).

⁷ In Higley, at Figure 5, the browser MIB 512 represents a “separate functional block” from “translator 506,” which “examines a header or markers in the data content of the mail to determine the form of the mail.” Ex. 1010, 6:34–35.

includes an URL (and displays it), but does not display its associated media, thereby internally determining the second computer cannot present the multimedia message associated with the URL link. *See* Pet. 35–36, 38–39; Ex. 1005, 5:43–51, 6:39–52. Petitioner also notes that the Major BBS Manual discloses client computers running software. Pet. 40 (citing Ex. 1012, 7, 379; Ex. 1003 ¶¶ 149–59).

Higley supports Petitioner’s showing, as it teaches “separate functional block[s]” for the MIB 512 (browser) and other software, such as translator 506 that “examines a header or markers in the data content of the mail to determine the form of the mail,” including whether it is text, HTML, or a URL, so those may be further processed. *See* Ex. 1010, 6:34–44, 5:18–26 (generally processing messages using known techniques). Higley and known browser implementations also suggest invoking a separate external application as noted above, thereby also suggesting, in the combined system of Higley and the Major BBS Manual, an internal determination not to process the URL prior to invoking the external application. *See* Pet. 37–39 (citing Ex. 1005, 61–64; Ex. 1003 ¶¶ 199–05; Ex. 1010, 9:25–10:46, 10:63–11:1). The automatic and/or manual rendering after detecting the URL type in a separate functional block (e.g., translator 506, Ex. 1005, Fig. 5, 6:38–44), also track(s) a disclosed participator software aspect of Figure 6 in the ’245 patent that pertains to URLs: “If a URL is detected at Block 116, Block 118 invokes an external data type viewer only on demand of the operator of the participator software, and otherwise Block 120 stores the reference for future use by the operator of the participator software, or treats the reference as an externally handled multimedia type (at the user’s

option).” Ex. 1001, 7:50–55.⁸ In other words, Petitioner shows persuasively that the recited software functionality of claim 1 that relates, according to Patent Owner, to the disclosed “out-of-band handling” associated with Figure 6 of the ’245 patent (PO Resp. 22–23 (citing Ex. 1001, Fig. 6)), reads on internal software on client computers or terminals that invoke browser agents to handle multimedia the second participator computer determines it otherwise cannot handle without the browser, which the combination of Higley and the Major BBS Manual renders obvious.

Based on the foregoing discussion, and after considering Patent Owner’s arguments discussed below in light of the record, Petitioner has shown by a preponderance of evidence claim 1 would have been obvious over the Major BBS Manual and Higley.

4. Obviousness of Independent Claim 7

Petitioner contends that claim 7 would have been obvious over the Major BBS Manual and Higley, relying on essentially the same arguments as for claim 1. See Pet. 44–48. Claims 1 and 7 recite materially similar subject matter. For the same reasons to those discussed above for claim 1, Petitioner has shown by a preponderance of evidence that claim 7 would have been obvious over the combination of Major BBS and Higley.

⁸ This description corresponds to the “YES” branch exiting flow box 102 of Figure 6, ultimately arriving at URL processing in flow boxes 116 and 118. See Ex. 1001, Fig. 6. In box 102, the program decides the multimedia type is “INTERNALLY HANDLABLE,” even though the message includes a URL, and that branch then “INVOKE[S] EXTERNAL DATA TYPE VIEWER” in flow box 118. See *id.* That branch does not refer explicitly to an “agent,” however, whereas the other branch described above does.

5. Obviousness of Dependent Claims 2–6, 8–15, 17, and 18

Petitioner contends that each of the dependent claims would have been obvious over the combination of Major BBS and Higley. Pet. 39–44. Claim 2 depends from claim 1 and recites “[t]he apparatus of claim 1, wherein the computer system includes a world wide web communication.” As explained above, the Major BBS Manual and Higley would have rendered obvious an Internet connection. Petitioner shows “Higley discloses that the communications include communicating URL links to HTML formatted pages by way of the Internet. . . . Persons of skill in the art would have understood such communications to be world wide web communications.” *Id.* at 39–40 (citing Ex. 1010, 1:16–36); Ex. 1010, 1:17–24 (“[G]rowth in the use of the Internet has been explosive. Much of the recent growth is attributable to the popularity of the World Wide Web (WWW), originally developed between 1989 and 1991 by CERN . . . and the more recent development of a software program called ‘Mosaic.’ Mosaic is a multimedia, hypertext linked browser for the Internet.”).

Dependent claims 3–5, 10–14, and 18 further require the computer system to include data representing one or more of sound, video, multimedia, text, ASCII, and a member-associated image communications. As Petitioner persuasively contends, the Major BBS Manual discloses communicating all manner of data types, and Higley further shows such systems would have been routine and obvious for the purpose of transferring available information. *See* Pet. 40–41; Ex. 1003 ¶ 156 (citing Ex. 1010, 1:27–30 (Higley teaches sending multi-media URLs efficiently, providing motivation to send URLs, and URLs include a mingling of text, graphics, sounds, and hypertext links)).

As an example, Petitioner points out that users can send files to each other that an ordinary artisan would understand to be sound, video, graphic, and multimedia. *See id.* at 40 (citing Ex. 1003 ¶¶ 145, 149–59). As noted above, users must log on to the Major BBS with a User ID and password. Ex. 1012, 4, 301–02; Ex. 1003 ¶¶ 142–44. When a user sends or merely stores graphic, image, or video data, the Major BBS alone or as modified by Higley associates all data transfers with a user, via a User-ID (Major BBS) or message identifier (Higley), thereby teaching a “member-associated image communications,” as claim 14 recites. *See* Ex. 1012, 308 (sending files attachments uploaded from a user’s computer); Ex. 1010, Fig. 8 (message indicating “From: A. Userauser@zzz.com”); Ex. 1003 ¶¶ 144 (quoting Ex. 1012, 316 (“Just hitting <Enter> tells you who else is on your Teleconference channel, listing their USER-IDs,” similar function in “WHISPER” mode)), 152–54 (citing Ex. 1012, 3, 55–56, 64, 92, 103–04 (disclosing ready-made images in the BBS’s .MSG files and RIP graphics that users may edit)). This member association tracks the ’245 patent Specification. *See, e.g.,* Ex. 1001:10:45–63, Fig. 25 (moderator DMARKS sends a URL).

Claims 6 and 8 each recite determining whether the recited “message,” “pointer,” or “communication” is not “censored.” Petitioner supports its contention that Major BBS teaches these limitations. Petitioner asserts that Major BBS “discloses a granular system of permissions for its teleconference functionality.” Pet. 41 (citing Ex. 1012, 318–19). Petitioner also states that Major BBS indicates the system “will determine in at least some instances that a user is not ‘squelched’ and therefore determine that it should not censor the messages from that user.” *Id.* at 44 (citing Ex. 1012,

318–19).⁹ As Petitioner contends, the Major BBS Manual describes commands available in a teleconference to “squench” (i.e., silence) a user. Ex. 1012, 318–19. As discussed above, “censored” means “controlled with respect to what is said in a group.” *Supra* Section II.A.

The Major BBS Manual generally teaches that a Sysop can squench or not squench a user from providing messages (i.e., private messages, including those containing pointers/URLs, communications/data), and also provide other permissions, so that the system then determines to censor or not censor the data. *See* Pet. 42–43; Ex. 1012, 4–5, 238–41, 247, 318–19; Ex. 1003 ¶¶ 218–21.

Petitioner articulates sufficient reasoning with rational underpinning as to why a person of ordinary skill would have been motivated to combine the permissions functions of Major BBS (i.e., squenching) with Higley’s teaching of including multimedia via URLs in messages. Pet. 42–43. For example, based on Mr. Schmandt’s testimony, Petitioner contends an ordinary artisan would have recognized the benefits of such a combination, including enabling the Sysop and Sysop computer as disclosed in the Major BBS Manual to maintain security, pricing, and control of similar file pointer and other information provided to users, adding the efficient processing of URL based multimedia content as suggested by Higley. *See id.* (citing Ex. 1003 ¶¶ 156–58, 184–86, 223–24; Ex. 1012, 5).

Claim 9 recites “the apparatus of claim 7, wherein the computer system includes the pointer as a pointer that causes the communication to be

⁹ The Petition cites Exhibit 1014 for this allegation, but this appears to be a clear typographical error (i.e., harmless error), because the same pages in the Major BBS Manual (Ex. 1012) relate to the “squench” feature of Major BBS.

produced on demand.” Petitioner shows the combined system of the Major BBS Manual and Higley suggest such a pointer. *See* Pet. 48–49 (citing Ex. 1003 ¶¶ 253–55). As discussed above in connection with claim 1, Higley suggests pointers, including URLs, which operate to provide stored information on demand, thereby providing current information to a user efficiently.

Claim 15 recites “the apparatus of claim 7, wherein the computer system provides a chat channel via the Internet network between at least two of the plurality of independent computers.” Petitioner establishes that the Major BBS Manual discloses a chat functionality, with the combination of the Major BBS Manual and Higley suggesting the Internet, for reasons similar to those discussed above. *See* Pet. 49 (citing Ex. 1003 ¶¶ 122–134).

Claim 17 recites “the apparatus of claim 7, wherein the computer system includes a user age corresponding to each of the user identities.” Petitioner shows the Major BBS Manual discloses storing various information about each user, including birth dates, in a user account database. Pet. 50–51 (citing Ex. 1012, 381–82). Petitioner cites to other indications of tracking age in the Major BBS Manual. *See id.* (discussing “Age vs. Computer Type,” and “Age Totals” (citing Ex. 1003 ¶ 284; Ex. 1012, 206–07). Petitioner shows the Major BBS Manual discusses changing targeting strategies for users depending on their age, and shows it would have been obvious to store users’ ages to generate demographics data in order to target various users with services. *See id.* (citing Ex. 1003 ¶ 284; Ex. 1012, 206–07).

Based on the foregoing discussion, and after considering Patent Owner’s arguments as discussed below in light of the record, Petitioner has

shown by a preponderance of evidence claims 2–6, 8–15, 17, and 18 would have been obvious over the Major BBS Manual and Higley.

6. Patent Owner’s Arguments

Patent Owner initially summarizes Petitioner’s showing as “purely hindsight based.” PO Resp. 15. Patent Owner bases the assertion partly on testimony by Mr. Schmandt during deposition, contending that “Petitioner’s analysis does not begin with the references.” *See id.* at 15–16 (citing and discussing Ex. 2006, 125:12–126:3). Patent Owner’s reliance on a limited portion of Mr. Schmandt’s deposition testimony does not support the argument and mischaracterizes his testimony. The testimony quoted by Patent Owner essentially shows Mr. Schmandt testifies he would have combined known desired features to create a desired system, and he believes the challenged claims would have been obvious. *See id.* Prior to the quoted testimony, Mr. Schmandt specifically answers “[n]o” to Patent Owner’s question of whether he would start with the claims to create a system, and he also testifies he “already know[s] about BBS,” “these [claimed] functions were well-known at the time from BBS systems,” and he would start with “a bunch of that function described in Major BBS.” *See* Ex. 2006, 123:25–125:5. Moreover, Mr. Schmandt relies on the references and the knowledge of a skilled artisan with the appropriate obviousness framework. *See, e.g.,* Ex. 1003 ¶¶ 22–33 (setting up obviousness framework), ¶¶ 105–288 (starting with the Major BBS Manual and Higley, addressing the skill level of an ordinary artisan, and applying the prior art to the claims).

In opening its Response, Patent Owner generally contends

[t]he cited art fails to teach or disclose one or more of (1) the “database” that “affords” limitation, (2) “tokens” as construed by the Board, (3) “via the Internet network,” (4) “internally determines” whether or not it can present the communication, and (5) “censoring.”

PO Resp. 2.

Nevertheless, Patent Owner does not present any substantive arguments regarding items (2), (4), and (5), items addressed in the analysis and findings above. See Pet. Reply 7–8 nn.1, 3. Rather, Patent Owner provides substantive arguments that respond to Petitioner’s showing by presenting the following three arguments. See Pet. Reply 7–8 nn.1, 3.

i. Database of Tokens for Other Programs to Access

Independent challenged claim 1 recites “the controller computer system including a controller computer and *a database which serves as a repository of tokens for other programs to access*, thereby affording information to each of the participator computers which are otherwise independent of each other.” Ex. 1001, 21:39–40 (emphasis added).

Independent challenged claim 7 recites a similar limitation.

Patent Owner argues that “Petitioner loses sight of the requirement that the **database** allows other programs to access the tokens.” PO Resp. 16 (citing Ex. 2005 ¶ 31). This argument, which emphasizes “database” without specifying a reason, fails to address Petitioner’s showing with respect to the database in a meaningful manner.

Patent Owner does not dispute that the Major BBS Manual discloses a database that stores tokens. For example, Patent Owner points out that Petitioner relies on “the user authentication database of the Major BBS as allegedly satisfying the ‘database’ portion of this limitation” and “Mr. Schmandt argues that the ‘database contains a UserID and a Password.’”

Id. at 17 (citing Ex. 1003 ¶ 128).¹⁰ After pointing out the reliance by Petitioner, Patent Owner does not dispute it. *See id.* In addition, during the Oral Hearing, Patent Owner conceded that “the [Sysop as disclosed in the Major BBS Manual] would have to at least allow some access to the database to modify user rights. Our contention is that it’s just no different from the participator software itself, and you still just have participator software, the BBS. It’s all the BBS.” Tr. 68:4–7. At another point, Patent Owner asserted that the Major BBS Manual’s Sysop “may behave as the controller computer software, and we would contend that it’s not the participator computer module.” *Id.* at 63:11–13.

In other words, Patent Owner disputes that the Major BBS Manual teaches the “other programs” limitation as recited in the challenged claims. In its Response, similar to its Oral Hearing arguments that the Major BBS constitutes a single program, Patent Owner contends “Telnet is not another program within the context of the claims. Instead, it is merely a conduit to access software running on the server, thus in the context of Major BBS,

¹⁰ This citation appears to be in error. At paragraph 163, Mr. Schmandt testifies the Major BBS Manual “describes a User Account database that includes the user’s ID, real name, address, class, password, and other information.” Ex. 1003 ¶ 163 (citing Ex. 1012, 381–82).

there is only a single program, the Major BBS software on the server, and no other programs.” PO Resp. 17 (citing Ex. 2005 ¶ 32).¹¹

Even if the Major BBS helps to access the database and tokens, the ’245 patent Specification and the challenged claims do not require “other programs” to be separate from the underlying software (and Patent Owner does not make that assertion). *See supra* note 8 (Patent Owner asserting during the Oral Hearing that its software code includes “other programs” as part of the controller and/or participator software). In describing its Telnet feature per the ’245 patent Specification, Patent Owner contended “*Telnet is a separate thing* that interacts with the [disclosed] participator software module remotely.” Tr. 60:24–25 (emphasis added). When asked whether the ’245 patent’s disclosed software “use[s] Telnet as an underlying protocol to talk to these different modules,” Patent Owner answered “that’s essentially correct, Your Honor, with the option of the participator software running on a third remote computer that you can Telnet into.” *Id.* at 61:8–12. Thus, the Telnet feature of the Major BBS software is similar to

¹¹ Patent Owner asserted during the Oral Hearing “[t]hose other programs [in the ’245 patent Specification] are, for example, the controller computer software and the participator computer software which is disclosed in our spec, throughout the spec as controller computer software and participator computer software.” Tr. 58:10–11. Patent Owner asserted that its written code includes “two distinct software modules running, a server software module and then the participator software module.” *Id.* at 60:22–24. Patent Owner explained “we disclose it [i.e., separate controller and participator software modules] in our source code embodiment itself”—i.e., the source code attached as an appendix to the ’245 patent application. *Id.* at 60:18–19; Ex. 1001, 4:55–57 (“Note that the appendix includes code for two different embodiments: Tel[net]net embodiment and a JAVA embodiment.”).

disclosed embodiments in the '245 patent, as described further below. See *supra* Section I.B (describing Figure 28, a Telnet menu embodiment for logging in).

Furthermore, as quoted by Mr. Schmandt, page 1 of the Major BBS Manual essentially describes the Major BBS system as a suite of programs: “In addition to the software that handles users who call in, you will use lots of special programs to install, set up, customize, and operate your BBS.” Ex. 1003 ¶ 108 (quoting Ex. 1012, 1). And Mr. Schmandt agrees with Patent Owner that Telnet represents a network standard or communication protocol. Ex. 1100 ¶ 25 (“[T]elnet was a universally accepted standard of network communication that ran on many operating systems”).

Accordingly, Petitioner shows that the Telnet “conduit” (PO Resp. 17), which runs on different participator and Sysop computers as disclosed in the Major BBS Manual, constitutes “other programs.” See Pet. 31 (“An authorized user could connect to Major BBS from any computer which ran a telnet program; [T]elnet is both a simple network protocol and describes software which uses the telnet network connection with terminal emulation software.” (citing Ex. 1003 ¶ 176)); Ex. 1003 ¶ 176 (citing Telnet applications), 177 (testifying the Major BBS Manual “also discloses that the databases of the system can be remotely accessed by the Sysop using a terminal emulator or [T]elnet program” and citing, as an example of “other programs” using Telnet, the “Remote Sysop Menu” (citing Ex. 1012, 230)); Pet. Reply 9–10 (identifying Telnet client software as “other programs”); Ex. 2006, 74:3–19 (Mr. Schmandt testifying “other programs then can be any set of programs that the participant computers are using, different [T]elnet client software. And the program could also be remote access by

the Sysop who has special privileges and can do things to the database that other people can't.”); PO Resp. 17 (quoting Ex. 2006, 74:3–19).

In other words, the term “other programs” reads on different Major BBS participator or Sysop computers each running the same (or different) Telnet software, especially where the Telnet software supports different users communicating with different Major BBS features, including menu application features provided to different users. *See, e.g.*, Ex. 1003 ¶¶ 173–76; 1100 ¶ 25; Ex. 1012, 301–02 (login). As an example, Petitioner shows that a user of the Major BBS must log in using the user's credentials (i.e., password and user ID token information) to access information in the Major BBS and communicate with other users. *See* Pet. 30–31; Ex. 1012, 4; Ex. 1003 ¶¶ 173–76; Ex. 1100 ¶ 25; Ex. 1012, 301–02 (login).

In similar fashion, as described above in Section I.B, Figure 28 of the '245 patent represents using a Telnet login/password menu, and it represents “an alternate embodiment using a text-based interface. . . . The user must now enter his/her login and password to identify themselves.” Ex. 1001, 11:14–19. Figure 28 specifies “Telnet eagle.ais.net” at the top of the screen. This menu represents an example of “other programs” that access tokens (e.g., the login/password information) in a database using Telnet at least indirectly through the menu. *See id.* at 11:14–19, Fig. 28; Ex. 1100 ¶¶ 21–22 (testifying the Figure 28 embodiment represents a Telnet embodiment, “the patent specifically supports the use of Telnet as an ‘other program’”).

In addition to a login function accessing tokens, the Petition cites the Major BBS Manual's disclosure of various menus that allow users to access, search, and edit their user account information and that of other users. Pet. 30–31 (citing Ex. 2012, 232, 369–70, 373–77; Ex. 1012, 370). The

Sysop and Sysop's computer uses stored token information, including account information as edited by users, to set access levels, switch user classes, and generally provide information access to different users. *See* Pet. 30–31; Ex. 1012, 4–5; Ex. 1003 ¶¶ 173–77; Ex. 1100 ¶ 24.

Mr. Schmandt agreed with Patent Owner during his deposition that Telnet accesses the database: Q. “So the association between the information and the user identity is at least done in the Major BBS software on the server; right?” A. “Yes. It's stored in the user account database.” Ex. 2006, 86:11–15. He also testified “[t]he [T]elnet information is just giving you the token.” *Id.* at 87:19–20. This testimony further shows that “other programs” read on a Telnet application with various Major BBS menus or applications employing a Telnet protocol at multiple user computers to access tokens in a database. Furthermore, the claim limitation, “a database which serves as a repository of tokens for other programs to access,” does not necessarily require that the database itself be accessed by the “other programs,” but rather requires the “other programs” to access the *tokens* (either directly in the database or indirectly).

Petitioner also relies on, as “other programs,” Sysop controller software that controls a database on the controller computer, including a database that stores access to keys and locks, and including the ability to set forum access levels in the database. *See* Pet. 28, 31 (citing Ex. 1012, 97, 107–37, 381–82; Ex. 1003 ¶¶ 177, ¶¶ 163–78). Further addressing the control software, Mr. Schmandt testifies that the Major BBS Manual discloses a “Remote Sysop Menu,” which includes SEARCH (Account Database) and DETAIL (User ID) features so that “the databases of the system can be remotely accessed [and searched] by the Sysop using a

terminal emulator or telnet program.” Ex. 1003 ¶ 177 (citing Ex. 1012, 230; see also PO Resp. 17 (quoting Mr. Schmandt’s assertion of “remote access” Sysop software (quoting Ex. 2006, 74:3–19)). The Major BBS Manual describes “The Remote Sysop Menu” as follows: “dozens of powerful online commands and utilities that you [the Sysop] can make available to trusted assistants or Co-Sysops.” Ex. 1012, 97. “The Remote Sysop Menu,” a collection of “online commands” with sub-menus, provides different Sysop and Co-Sysop computers access to user database information including access levels and other information control features. See Ex. 1012, 97–98 (“The “User-ID Sysop has broad sweeping powers online, especially in the Remote Sysop Menu. . . . You could also appoint Co-Sysops and grant them similar powers, by switching them to the SYSOP class (using SWITCH command from the Remote Sysop’s ACCOUNT submenu, page 121).”).

In summary, Petitioner shows that the Major BBS Manual discloses or suggests “other programs.” As Petitioner shows, the “other programs” limitation reads on logging in with token information at different computers and accessing a token database, using the Remote Sysop Menu employed by different users (i.e., a Sysop and different Co-Sysops) at different computers in order to alter and access stored token information employed by the Sysop and the Sysop controller software to provide access to services, and otherwise using Telnet with such applications and other applications or menus at different computers. See Pet. 28–31. These Major BBS features appear to be similar in material respects to embodiments represented by Figures 7, 27, and 28 of the ’245 patent, which generally provide a user

screen to access tokens to alter them and also to login, as discussed above in Section I.B.

Based on the foregoing discussion, we determine and find by a preponderance of evidence that the Major BBS Manual teaches the disputed “other programs” phrase in claim 1, “a controller computer system including a controller computer and a database which serves as a repository of tokens for other programs to access,” and the similar “other programs” phrase in claim 7.

ii. Communicating Via an Internet Network

The preamble of challenged independent claim 1 recites “an apparatus distributing a communication over an Internet network,” and the body recites “each said participator computer communicatively connected to said Internet network.” The preamble of challenged independent claim 7 recites [a]n apparatus to communicate via an Internet network,” and the body of claim 7 recites “the communication being sent in real time and via the Internet network.”

Patent Owner contends “[o]ne of ordinary skill in the art in 1996 would not have been motivated to start with a BBS system in order to make a real-time communication platform over the Internet. . . . In 1996, BBSs and the Internet were seen as two diverging technical paths.” PO Resp. 19 (citing Ex. 2005 ¶ 35).

Patent Owner points out that “Robert Metcalfe, the inventor of the Ethernet protocol,” predicted in late 1995 “that the Internet would go ‘spectacularly supernova’ and catastrophically collapse in 1996.” *Id.* at 20 (citing Ex. 2008, (an article titled “Predicting the Internet’s Catastrophic Collapse and Ghost Sites Galore in 1996”)). Patent Owner further argues

that the Internet TCP/IP protocol caused packets to arrive at different times and therefore “need to be re-assembled” and “users were not guaranteed certain bandwidth for their traffic.” *Id.* at 21 (citing Ex. 2005 ¶ 37).

Dr. Carbonell similarly testifies that video traffic on the Internet would experience unpredictable delay and require reassembly of video streams at the receiving end in real time. *See* Ex. 2005 ¶ 37. Dr. Carbonell also testifies “Galacticomm attempted to bring their Major BBS product to the Internet, yet the company failed spectacularly.” *Id.* ¶ 35.

Regarding the latter assertion, Dr. Carbonell does not cite to evidence to support it, provide any foundation, or show how it relates to the unobviousness of using the Internet. As discussed below, Dr. Schmandt and the references of record show the obviousness of using the Internet in the relevant time frame. *See, e.g.*, Ex. 1010, 1:17–24 (“[G]rowth in the use of the Internet has been explosive. Much of the recent growth is attributable to the popularity of the World Wide Web (WWW), originally developed between 1989 and 1991 by CERN . . . and the more recent development of a software program called ‘Mosaic.’ Mosaic is a multimedia, hypertext linked browser for the Internet.”).

Regarding the Metcalfe article, which Patent Owner and Dr. Carbonell heavily rely upon, it spans a half-page and predicts the Internet’s collapse at the end of 1995 due to reasons such as low user measurements, telecom company monopolies, security, and capacity concerns. *See* PO Resp. 18–21 (discussing Ex. 2008); Ex. 2005 ¶¶ 36–39 (same). Patent Owner does not show that the incorrect prediction of a single individual (Mr. Metcalfe) would have discouraged artisans of ordinary skill from using the Internet. *See* Pet. Reply 13 (citing Ex. 1100 ¶¶ 38–41). Petitioner points

out that in another article, Mr. Metcalfe admitted “that his [prior] statements were ‘sarcastic’ and made ‘tongue-in-cheek.’” *Id.* (quoting Ex. 1103, 9).¹²

In other words, Patent Owner offers no persuasive evidence that skilled artisans in 1995 widely shared Mr. Metcalfe’s stated views of an Internet collapse. Furthermore, the ’245 patent contradicts Patent Owner, and shows the Internet was being employed by artisans of ordinary skill, at least with respect to Internet Service providers, and the challenged claims do not preclude using the system via an Internet Service provider. *See* Ex. 1001, 1:40–67.

Relying on Mr. Metcalfe’s article, Dr. Carbonell testifies that other technologies such as Integrated Services Digital Network (ISDN) and Asynchronous Transfer Mode (ATM) would have been better suited than the Internet to handle video conferencing in the mid-1990s. Ex. 2005 ¶¶ 38–39 (citing Ex. 2008). But the article does not cite to any evidence to support such a claim. *See* Ex. 2008. And as noted above, the article largely makes “tongue-in-cheek” arguments. For example, Mr. Metcalfe states “in 1996, CD-ROMs through Federal Express will emerge as the information superhighway,” and “[t]he Internet traffic carrying arguments about pornography on the Internet will in 1996 swamp the actual pornography, so

¹² Mr. Metcalfe’s opinions regarding the Internet and other topics appear nuanced, but he admits “I spice it up to make it interesting to people and provocative,” and he “never meant to suggest that [the Internet] was going to die.” Ex. 1103, 9 (“In my mind it was going to suffer catastrophic collapses, recover, collapse again, recover, collapse again, until it got fixed. I almost regret choosing the word collapse, because I’m a big fan of the Internet. I’ve never meant to suggest that it was going to die.”).

even the most sophisticated Web search engine will too often fail to find any. What quicker road to collapse?” Ex. 2008.

Contrary to Patent Owner’s related arguments, the record does not show the Internet would have been an inferior technology for videoconferencing in 1995. *See* PO Resp. 20–21. Moreover, as Petitioner argues, the challenged claims do not require videoconferencing or streaming video. *See* Pet. Reply 15. Specifically, claims 1 and 7 do not require videoconferencing or streaming video, and dependent claims 5 and 12 merely recite “data representing sound and video communication.” None of the claims specify a required bandwidth for video or any type of streaming video.

In other words, Patent Owner’s arguments regarding problems regarding video and bandwidth, and alleged better alternatives for video, are not commensurate in scope with the challenged claims. *See* PO Resp. 20–21. In any case, even if the challenged claims require video streaming over the Internet, “just because better alternatives exist in the prior art does not mean that an inferior combination is inapt for obviousness purposes.” *In re Mouttet*, 686 F.3d 1322, 1334 (Fed. Cir. 2012). Also, Dr. Metcalfe’s article and Patent Owner’s arguments and evidence indicate artisans of ordinary skill would have known how to reassemble video packets that may have been delayed, even if the network could not be “guaranteed certain bandwidth.” *See* PO Resp. 21 (citing Ex. 2005 ¶ 38); Ex. 2008. As noted, however, the challenged claims do not require any explicit bandwidth of video, and no evidence of record or argument suggests an implied bandwidth—at least one with a quantitative value that renders the claims unobvious. *See* Pet. Reply 14. Even if challenges existed, “a given course

of action often has simultaneous advantages and disadvantages, and this does not necessarily obviate motivation to combine.” *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006).

Addressing the challenges discussed by Patent Owner would have been well within the skill of an ordinarily skilled artisan, an engineer experienced in computer networking. The record evidence indicates an ordinary artisan reasonably would have expected successfully combining the related teachings of the Major BBS Manual and Higley. Mr. Schmandt also testifies, at the relevant time frame, telecommunications companies invested in expansion of fiber optics network, anticipating increased Internet traffic and providing sufficient bandwidth. *See* Ex. 1100 ¶ 41. Higley provides further evidence of the industry moving toward Internet and provides motivation for using it, including to provide efficient updated information using URLs, as discussed above. *See* Ex. 1010, 1:16–2:64 (citing numerous industry Internet-related articles and standards). In addition, as Petitioner notes, Patent Owner concedes the Internet contained “overwhelming amount of traffic” implemented using the “TCP/IP protocol.” *See* PO Resp. 20; Pet. Reply 15–16. This argument further shows skilled artisans already were using the Internet employing packets, similar to the Major BBS software. *See* Ex. 1012, 2 (disclosing “X.25 packet-switching networks”); Pet. 18 (“one of ordinary skill would have understood that [IPX direct, IPX virtual, or SPX connections] could provide Internet access” to the Major BBS (citing Ex. 1003 ¶ 124)).

The Petition points out the Major BBS Manual discloses a desire for diversity, further suggesting the Internet. Pet. 19 (citing Ex. 1012, 7; Ex. 1003 ¶ 128). The Major BBS Manual discloses users could be “across the

ocean—almost anywhere in the world—and the BBS services appear on their screens,” further suggesting the Internet. *Id.* at 2.

Based on the foregoing discussion, we find and determine by a preponderance of evidence that the Major BBS Manual and Higley teach the Internet limitation recited in the challenged claims.

iii. The Second of Said Participator Computers Internally Determines Whether or Not the Second of the Participator Computers Can Present the Communication, If It is Determined That the Second of the Participator Computers Can Not Present the Communication Then Obtaining an Agent with an Ability to Present the Communication

Claim 1 recites “the second of said participator computers internally determines whether or not the second of the participator computers can present the communication, if it is determined that the second of the participator computers can not present the communication then obtaining an agent with an ability to present the communication.” According to Patent Owner, “the ’245 Patent specification refers to these claimed determinations and the agent selection as out-of-band handling with respect to multimedia, which is made possible through participant software as shown in Fig. 6.” PO Resp. 22 (citing Ex. 2005 ¶ 40, reproducing Ex. 1001, Fig. 6).

Although Patent Owner points to the out-of-band limitation (i.e., internally determines and obtains an agent limitation) as quoted above, Patent Owner does not respond to Petitioner’s showing that the combination of the Major BBS Manual and Higley renders it obvious. *See* Pet. 37–39. Petitioner persuasively shows the combination renders it obvious, for the reasons explained above. *See* Pet. 37–39 (citing Ex. 1003 ¶ 203); *supra* Section B.3.

In other words, rather than addressing the “out-of-band handling” (PO Resp. 22) limitation quoted above, Patent Owner generally argues “Petitioner does not identify any software on the users’ computers that could qualify as participator software. Instead, the Major BBS [M]anual describes a system that utilizes a terminal such as Telnet, which merely receives strings of characters.” PO Resp. 25.¹³ This argument appears to contend Petitioner does not identify participator software in the Major BBS Manual, because in the same paragraph, Patent Owner acknowledges “Petitioner points to a different reference, Higley, to allegedly teach this limitation. (Pet. at 39.) Mr. Schmandt also admitted that the Major BBS [M]anual does not teach this limitation. (Ex. 2006, Schmandt Dep. Tr. at 89:23–90:18.) (Ex. 2005 at ¶ 40.)” PO Resp. 25.

Nevertheless, Patent Owner contends “Higley is primarily an e-mail based software solution.” *Id.* at 25. Patent Owner submits Mr. Schmandt does not “provide any indication as to how or why one of ordinary skill in the art would have been motivated to take a Telnet-based client program and

¹³ Claims 1 and 7 recite an “apparatus.” Claim 7 recites “the first of participator computers is running software” and “the second of the participator computers is running software.” Claim 1 recites “the second of said participator computers internally determines whether or not the second of the participator computers can present the communication.” We assume Patent Owner refers to the “running software” in claim 7, and the software associated with the “internally determines” functionality in claim 1, in its reference to “participator software.” See PO Resp. 25. As apparatus claims, such software need only have the capability of performing the recited functions. Petitioner generally identifies client computers as part of the Major BBS, which necessarily include various types of software. See Pet. 18–19, 31–32, 47; Ex. 1012, 292–93, 297 (disclosing several types of user computers, including IBM PCs, Apple, Atari, etc.).

modify it by building a graphical email program into that telnet client. (Ex. 2005 at ¶ 40.)” *Id.* at 25–26. According further to Patent Owner, “Mr. Schmandt’s motivation to combine is circular,” because

Mr. Schmandt stated in his declaration that one would look to Higley as teaching URLs in order to arrive at the “pointer triggered message” limitations – a limitation that was missing from the Major BBS. (E.g., Ex. 1003 at ¶ 186–90.) Then, at his deposition, he testified that communicating with a URL is the motivation to combine Higley with the Major BBS: “if people aren’t exchanging URLs, then there’s no need for Higley.” (Ex. 2006 at 94:2–3.) Petitioner’s circular reasoning cannot provide the motivation to combine these references. (Ex. 2005 at ¶ 40.)

Id. at 25.

Patent Owner’s arguments are not persuasive. As Petitioner argues, skilled artisans at the time of the invention were implementing URLs to provide Internet based information as Higley makes clear, providing an artisan of ordinary skill motivation to modify the Major BBS as described in the Major BBS Manual. *See* Pet. 22–32, 37–40; Ex. 1003 ¶¶ 130–32, 200–03; Pet. Reply 17–18 (citing Ex. 2006, 93:20–94:3).

As general background, the Petition notes Higley “describes an improvement on text-based communications systems to incorporate the multimedia capability from web browsers.” Pet. 16 (citing Ex. 1010, 3:1–5). The Petition points to “RIP software” for receiving graphical data from the Major BBS system. Pet. 25. The Petition also contends the combination of the Major BBS Manual and Higley renders obvious using “the second user computer” to “fetch[] the media” from “a separate server computer.” Pet. 35–36 (citing Ex. 1003 ¶¶ 184–192). The Petition also explains how the combined system of the Major BBS Manual and Higley would have

rendered obvious out-of-band handling functionality, including an agent, such as a web browser, explaining the “terminal emulator program would invoke a multimedia web browser as an external agent.” Pet. 37–39 (citing Ex. 1003 ¶¶ 199–05; Ex. 1010, 1:36–46, 5:45–53, 9:25–10:46, Figs. 6, 7). As explained above, Higley provides motivation, as the Petition cites, for transferring URLs to chat systems like that of the Major BBS Manual, including in order to transfer the latest version of popular URL information for efficient display on a user computer. *See id.* at 16–17 (citing Ex. 1010, 3:1–5), 20–21, 26, 35.

In other words, as Mr. Schmandt notes, Higley provides an efficient manner of providing URLs, so that a user can obtain information associated with URLs “quickly and easily”:

It is a further object of this invention to provide a new, useful and efficient manner of transmitting Uniform Resource Locators (URLs) over the Internet so that the receiver of the URL can quickly and easily view the information corresponding to the URL.

Ex. 1003 ¶ 130 (quoting Ex. 1010, 3:1–5); Pet. 16–17 (citing Ex. 1010, 3:1–5).

Petitioner also points out that Higley does not limit the usefulness of URLs to e-mails. *See* Ex. 1003 ¶ 132 (noting Higley “explains that his system may be used with other types of ‘received messages and information’” (quoting Ex. 1010, 5:25–26)); Pet Reply 16 (quoting Ex. 1010, 5:22–26). At the quoted passage Higley states

[f]or purposes of illustration, the present invention is described as operating with three types of received electronic mail, but of course, other types of electronic *mail and received messages and information may be used with the present invention.*

Ex. 1010, 5:22–26 (emphasis added). Higley also states “[a] first type which the *received document*/electronic mail/*message* might embody is a ‘URL’ type. This means the *message* is essentially a pointer to another location on the Internet.” Ex. 1010, 5:27–30 (emphases added). Therefore, as Petitioner argues, Higley’s teachings apply to messages in general, including real-time messages sent as disclosed in the Major BBS Manual. See Pet. 36 (citing Ex. 1012, 9, 318; Ex. 1003 ¶¶ 193, 196).

As Patent Owner notes, the Petition relies on the combination of Higley and the Major BBS Manual to teach the disputed participator software of the challenged claims. See PO Resp. 25; Pet. 35–36.

For example, the Petition persuasively asserts

[p]ersons of ordinary skill would have understood that URLs typically point to content on server computers rather than user client computers, and thus would understand that in the combined system of Major BBS and Higley that the second user computer would be fetching the media from a computer other than the first or second computer. One of ordinary skill would have been aware of many popular third-party internet sites that could be accessed by URLs. Ex. 1003 ¶189; Ex. 1005 (Mosaic Quick Tour) at 85–92 (providing numerous examples of popular URLs in the 1995 timeframe). In any case, persons of skill in the art would have been motivated to place the URL-specified on a separate server computer so as to release the client computers from the computational load of providing the URL content. Ex. 1003 ¶189. Also, user computers are not described as Web servers, so a person of ordinary skill would assume that they are not. Ex. 1003 ¶ 189.

Pet. 35.

Petitioner also contends Higley suggests using a web browser on a participator computer to fetch and display the content referenced by the URLs. See Pet. 37. In other words, Petitioner persuasively shows that

Higley suggests using client computers to fetch messages sent as suggested by the combination of the Major BBS Manual and Higley, so that users advantageously could obtain and transfer popular URLs pointing to current content on servers on the Internet. *Id.* (citing Ex. 1003 ¶ 200; Ex. 1010, 1:36–46; 5:45–53, Figs. 6, 7 (citing Higley’s “MIB” or “Multimedia Internet Browser”).

Based on the foregoing discussion, and for the reasons discussed *supra* Section B.3, Petitioner shows by a preponderance of evidence that Higley would have suggested providing URLs (pointer-triggered private messages) and sending them between Major BBS Manual’s user computers modified to run browser software and participator software at least to invoke the browser, wherein the second participator computer internally determines if the message has a URL that it cannot handle, and if so, obtains an agent to handle the URL, so that users could obtain relevant and current information available on the Internet efficiently and quickly. *See* Pet. 34–39; *supra* Section II.B.6.

7. Patent Owner’s Motion to Exclude

Patent Owner filed a paper styled as “Motion to Exclude Evidence,” seeking to exclude certain portions of the Schmandt Reply Declaration (Ex. 1100) that it argues exceeds the proper scope of a reply. Paper 48 (“Motion”), 1. Specifically, Patent Owner seeks to exclude portions of paragraphs 21–23, 27–32, and 48–53 of the Schmandt Reply Declaration. *Id.* at 1–7.

Petitioner opposes the Motion on the ground that it is not directed to the admissibility of evidence and, therefore, is procedurally improper. Paper 51 (“Opposition”), 1–2. Patent Owner replies that arguments that exceed the

scope of a reply are irrelevant, prejudicial, confusing, or misleading under Fed. R. Evid. 401, 402, and 403. Paper 53 (“Reply”), 1–4. Petitioner also contends the Schmandt Reply Declaration properly responds to Patent Owner’s evidence and arguments. *See* Opposition 2–3.

As movant, Patent Owner has the burden on its Motion. 42 C.F.R. § 20(c) (“The moving party has the burden of proof to establish that it is entitled to the requested relief.”). Patent Owner alleges improper scope of Petitioner’s Reply as a violation of the Federal Rules of Evidence 401, 402, and 403. *See* Motion 1. As Petitioner points out, the Board repeatedly has denied, as improper, motions to exclude that merely argue that evidence is outside the proper scope of a reply. Opposition 1–3. Despite the invocation of Fed. R. Evid. 401, 402, and 403, we agree with Petitioner that Patent Owner’s Motion constitutes an argument that Petitioner’s Reply exceeds its proper scope. In other words, the Motion constitutes an unauthorized motion to strike certain paragraphs of the Schmandt Reply Declaration (Ex. 1100).

Even if we treat the Motion as an authorized Motion to strike paragraphs 23, 27–32, and 48–53, the Motion is moot with respect to those paragraphs, because we do not rely on them in the Final Written Decision.

Addressing paragraphs 21 and 22, Patent Owner contends Petitioner cites to new sections of the ’245 patent, including Figure 28, to alter its showing as to “other programs.” Motion 3. Mr. Schmandt’s testimony fairly responds to Dr. Carbonell’s testimony that the “other programs” limitation does not read on the Major BBS Manual’s Telnet application software as run by different computers, which Patent Owner also raises in its Response, as discussed above. *See* Ex. 1100 ¶¶ 21–22 (discussing Ex. 2005

¶ 32); PO Resp. 17–18. Contrary to Patent Owner’s arguments, Petitioner’s responses do not constitute a “drastic departure” (Motion 1–2) from Petitioner’s original contentions. See Pet. 30–31 (Telnet and other features as other programs), 38–39 (terminal emulator program as participator software); Ex. 1003 ¶¶ 172–78 (discussing Telnet and other programs).

Accordingly, the Motion is *denied* with respect to striking paragraphs 21 and 22, and *moot* with respect to striking paragraphs 23, 27–32, and 48–53.

III. CONCLUSION

Petitioner has established by a preponderance of the evidence that claims 1–15, 17, and 18 of the ’245 patent are unpatentable.

IV. ORDER

For the reasons given, it is

ORDERED, based on a preponderance of the evidence, that claims 1–15, 17, and 18 are unpatentable;

FURTHER ORDERED Patent Owner’s Motion to Exclude Evidence is *denied* with respect to striking paragraphs 21 and 22, and *moot* with respect to striking paragraphs 23, 27–32, and 48–53; and

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

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