

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.,
Petitioner,

v.

MYMAIL, LTD.,
Patent Owner.

Case IPR2017-00967
Patent 8,275,863 B2

Before KEVIN F. TURNER, KAMRAN JIVANI, and
MONICA S. ULLAGADDI Administrative Patent Judges.

ULLAGADDI, Administrative Patent Judge.

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

I. INTRODUCTION

A. Background

Unified Patents Inc. (“Petitioner”) filed a Petition pursuant to 35 U.S.C. §§ 311–319 requesting an *inter partes* review of claims 1, 2, 4, 5, 10, 11, 14–17, 20, and 23 of U.S. Patent No. 8,275,863 B2, issued on September 25, 2012 (Ex. 1001, “the ’863 patent”). Paper 2. As the original Petition lacked page numbers, we instructed Petitioner to file a Second Corrected Petition on September 6, 2017, which we cite herein.¹ Paper 9 (“Pet.”), Paper 8 (authorizing Second Corrected Petition). My Mail, Ltd. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

On September 13, 2017, we entered a Decision on Institution (“Inst. Dec.” Paper 10) instituting an *inter partes* review as to all of the challenged claims. Specifically, we instituted review as to claims 1, 2, 4, 5, 10, 11, 14–17, 20, and 23 over Filepp and Morten and claims 2 and 10 over Filepp, Morten, and Olsen.² Inst. Dec. 22. We did not institute review as to

¹ Petitioner indicated that the original Petition did not comply with the word count limit set forth in 37 C.F.R. § 42.24. See Paper 8; see Paper 9, 66 (stating that the word count for the Second Corrected Petition is 14,134 words). Due to the short time frame, we instructed Petitioner to file the Second Corrected Petition, which we refer to herein as “Petition” or “Pet.,” with no changes except to add page numbers, and we indicated that we would disregard any portion of the Petition in excess of the word count. Paper 8. Petitioner’s ground 6, based on Reilly and December, includes the portion of the Petition that is in excess of the word limit by 134 words. Pet. 66. In view of our disposition, we need not consider what, if any, effect our disregarding the 134 words (see Paper 8) would have had on a decision on the merits with respect to ground 6.

² In our Decision on Institution, we instituted review with respect to claims 2 and 10 over Filepp, Morten, and Olsen, instead of Filepp and Olsen as

challenges based on Filepp alone, Reilly alone, or Reilly in combination with other references.

After institution of trial, Patent Owner filed a Patent Owner Response (“PO Resp.” Paper 16), to which Petitioner filed a Reply (“Reply” Paper 20).

On May 1, 2018, a conference call was held among Judges Jivani, Turner, and Ullagaddi and counsel for the parties. During the call, we gave the parties an opportunity to discuss the impact of the Supreme Court’s holding in *SAS Institute Inc. v. Iancu*, 2018 WL 1914661, at *10 (U.S. Apr. 24, 2018) with respect to the instant proceeding. Following the call, we entered an Order (Paper 27) which modified the Decision on Institution to include review of all grounds of unpatentability of the challenged claims as presented in the Petition. In that Order, we authorized additional briefing to address the modification to the Decision on Institution.

Petitioner filed a Supplemental Reply (“Supp. Reply” Paper 32) and Patent Owner filed a Supplemental Response (“Supp. Resp.” Paper 30). Patent Owner also filed a Motion to Strike (“Motion” or “Mot.” Paper 29), to which Petitioner responded with an Opposition to Motion to Strike (“Opposition” or “Opp.” Paper 31).

A hearing for IPR2017-00967 was held on June 22, 2018. The transcript of the hearing has been entered into the record. Paper 35 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This final written decision is issued pursuant to 35 U.S.C. § 318(a).

originally set forth by Petitioner. Inst. Dec. 19. In view of our Order following *SAS*, we revert to Petitioner’s original challenge to claims 2 and 10 over Filepp and Olsen. Paper 27, 5.

Based on the complete record now before us, we conclude Petitioner has not shown, by a preponderance of the evidence, that any of challenged claims 1, 2, 4, 5, 10, 11, 14–17, 20, and 23 of the '863 patent are unpatentable.

B. Related Proceedings

The parties inform us that the '863 patent is or has been the subject of numerous lawsuits in district court. Pet. 7; Paper 4, 1–2.

In addition, the '863 patent was the subject of IPR2015-00269 (the "'269 IPR"), which, according to Petitioner, "was instituted and later settled." Pet. 7; Paper 4, 2; Ex. 1021 ("'269 Institution Decision"). Petitioner represents that the asserted grounds in the Petition are the same as those upon which trial was instituted in the '269 IPR and that the content of the Petition is substantially the same as the petition in that proceeding. Pet. 5.

The '863 patent was also the subject of the IPR2018-00118 proceeding ("'118 IPR") in which we denied institution. See '118 IPR, Paper 5, 1–2 (discussing related litigations). A child of the '863 patent, U.S. Patent No. 9,021,070 (the "'070 patent"), was the subject of the IPR2018-00117 proceeding ("'117 IPR") in which we also denied institution. See '117 IPR, Paper 5, 1–2 (discussing related litigations).

C. The '863 Patent

The '863 patent relates to methods for modifying the toolbar of an Internet device. Ex. 1001, 1:1. Specifically, the claims relate to updating the toolbar of a user Internet device over the Internet. *Id.* at 29:28–63. Figure 16 is reproduced below:



FIG. 16

Figure 16 illustrates a toolbar.

According to the '863 patent, information related to updating the toolbar (also called a “button bar”), which may be provided as part of a browser, is obtained from button bar database 208. *Id.* at 10:7–15. Button bar database 208 stores “attributes” that define the toolbar’s buttons, including text, format, and function. *Id.* at 10:38–50 (alternately referring to button bar database with reference number 210). For example, a button can be configured to “go to the USA Today . . . web site,” or launch a script or a program. *Id.* at 10:38–11:4. The '863 patent discloses, “the Toolbar of the present invention has some unique properties as it can be dynamically changed or updated via a Pinger process or a MOT script.” *Id.* at 10:15–17. The '863 patent discloses that

[A] Pinger process comprises an entity that acts transparently as a services coordinator to provide and/or administer the following:

1. Heartbeat service to help maintain network connectivity with a client.
2. Authentication services that securely authenticate client access to email, commerce, and other public and private network servers and services.
3. Update services that can perform client software, database, and maintenance services during periods of inactivity.

The Pinger entity, as suggested above, has, as one of its functions, the responsibility of providing database updates to the client user.

Id. at 10:19–32. With respect to the MOT script, the '863 patent discloses that “it can be a ‘mime type’ definition part of an E-mail message, an HTTP web document download and so forth, which transparently automates the Toolbar update.” *Id.* at 10:32–35.

D. Illustrative Claim

Of the challenged claims, claim 1 is independent. Claim 1 is illustrative of the claims at issue and is reproduced below:

1. A method of modifying a toolbar, comprising the steps of:

a user Internet device displaying a toolbar comprising one or more buttons, the toolbar defined by toolbar data stored in one or more toolbar-defining databases, the toolbar data comprising a plurality of attributes, each attribute associated with a button of the toolbar, wherein for each button of the toolbar, at least one of the plurality of attributes identifying a function to be performed when the button is actuated by the user Internet device;

the user Internet device automatically sending a revision level of the one or more toolbar-defining databases to a predetermined network address;

a server at the predetermined network address determining, from the revision level, the user Internet device should receive the toolbar update data;

the user Internet device receiving toolbar update data from the Internet;

the user Internet device initiating without user interaction an operation to update the toolbar data in accordance with the toolbar update data received;

the user Internet device updating, by the operation, the toolbar data in accordance with the toolbar update data, thereby producing updated toolbar data, the updating comprising at least one of the following steps (a) and (b), each respectively comprising:

(a) writing at least one new attribute to the original toolbar data, wherein the writing at least one new attribute to the toolbar data comprises changing the one or more buttons of the toolbar by adding a button; and

(b) updating at least one attribute of the toolbar data; and the user Internet device displaying the toolbar as defined by the updated toolbar data.

Ex. 1001, 29:28–63.

E. Evidence of Record

Petitioner relies on the following references (*see* Pet. 9–10):

Reference or Declaration	Exhibit No.
U.S. Patent No. 5,740,549 (“Reilly”)	Ex. 1003
U.S. Patent No. 5,347,632 (“Filepp”)	Ex. 1004
U.S. Patent No. 5,021,949 (“Morten”)	Ex. 1005
U.S. Patent No. 5,644,737 (“Tuniman”)	Ex. 1006
J.W. Olsen, <i>Big Three On-Line Services Reach Out to the Internet</i> , PC Magazine, June 27, 1995 (“Olsen”)	Ex. 1007
John December and Neil Randall, <i>The World Wide Web Unleashed</i> (2d. ed. 1995) (“December”)	Ex. 1008

Petitioner supports its challenges with the Declarations of Dr. Benjamin B. Bederson (Exs. 1009, 1022).

Patent Owner supports its Patent Owner Response and Supplemental Response with the Declarations of Dr. Arthur M. Keller (Exs. 2003, 2017).

F. Instituted Grounds of Unpatentability

We instituted review on the following grounds for challenge (*see* Pet. 10, 46; Inst. Dec. 22; Paper 27, 5):

Claims Challenged	Basis	Reference(s)
1, 11, 14–17, 20, and 23	§ 102(e)	Reilly
1, 4, 5, 11, 14–17, 20, and 23	§ 102(b)	Filepp
1, 2, 4, 5, 11, 14–17, 20, and 23	§ 103(a)	Filepp and Morten
1, 2, 11, 14–17, 20, and 23	§ 103(a)	Reilly and Tuniman

Claims Challenged	Basis	Reference(s)
2 and 10	§ 103(a)	Filepp and Olsen ³
2 and 10	§ 103(a)	Reilly and December

II. DISCUSSION

A. Claim Construction

Patent Owner asserts that the '863 patent expires before issuance of a Final Written Decision. Paper 30, 2. For claims of an expired patent, the Board's claim interpretation is similar to that of a district court. *See In re Rambus, Inc.*, 694 F.3d 42, 46 (Fed. Cir. 2012). Neither Patent Owner nor Petitioner object to construing the terms under a district court style construction. Paper 32, 5; Paper 30, 2–3; Tr. 6:21–7:6. “In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–17 (Fed. Cir. 2005) (en banc)). The words of a claim generally are given their ordinary and customary meaning, and that is the meaning the terms would have had to a person of ordinary skill at the time of the invention, in the context of the entire patent, including the specification. *See Phillips*, 415 F.3d at 1312–13.

In a related litigation, the district court found that “toolbar” was defined in the specification as having “unique properties.” Ex. 2018, 14 (quoting '070 patent, 10:16–26)). In particular, the district court explained that the specification required “‘the toolbar of the *present invention*’ [to have

³ See footnote 2.

the] ability to be updated via a Pinger Process or a MOT script” and is described in each embodiment of the ’070 patent, which shares a specification in common with the ’863 patent, in conjunction with the ability to be updated by a Pinger process or a MOT script and thus, is definitional. Ex. 2018, 14. In addition to this disclosure (see Ex. 1001, 10:15–29), with respect to the only toolbar depicted in the ’863 patent in Figure 16, the ’863 patent discloses that the toolbar can be generated using MOT script language in combination with data retrieved from the databases. Ex. 1001, 26:55–58, 26:58–60, 11:5–13 (disclosing how the toolbar is built automatically according to MOT script specifications and button bar database 208 information).

We agree with the district court that each embodiment disclosing a toolbar in the ’863 patent is accompanied by a disclosure indicating that the toolbar is generated or updated via a Pinger process or a MOT script. Moreover, while not dispositive in our determination, nearly every disclosure of the Pinger process and the MOT script is accompanied by a disclosure of how updating the databases, including button bar database 208, is part of its responsibilities. The ’863 patent *defines* a Pinger process as:

[A]n entity that acts transparently as a services coordinator to provide and/or administer the following:

1. Heartbeat service to help maintain network connectivity with a client.
2. Authentication services that securely authenticate client access to email, commerce, and other public and private network servers and services.
3. *Update services that can perform client software, database, and maintenance services during periods of inactivity.*

The Pinger entity, as suggested above, has, as one of its functions, the responsibility of providing *database updates to the client user*.

Ex. 1001, 10:17–32 (emphases added), 11:57–60 (disclosing the functions of the Pinger process as including read, write, and update capabilities for any of the databases, including button bar database 208), and 12:33–47 (disclosing how a Pinger process allows the download of database updates to user (computer) 110). Petitioner argues that the claimed “‘Pinger process’ would be satisfied by a process that sends messages to obtain, ascertain, or request information.” Reply 6; *see* Supp. Reply 6. Because we determine the disclosure in the ’863 patent to be definitional, we do not agree, as addressed in further detail in Sections II.D and II.E.

The ’863 patent discloses the MOT script as “a ‘mime type’ definition part of an E-mail message, an HTTP web document download . . . which transparently *automates the Toolbar update*,” and as “*defin[ing] how to build a button bar using the button bar database [208] and its database entries*.” Ex. 1001, 10:32–35, 11:5–13 (emphases added).

Because the ’863 patent discloses that a toolbar is necessarily generated and updated based on button bar database 208 and updates thereto, we determine that the disclosed toolbar is generated or updated via a Pinger process or MOT script. As such, we further determine that the ’863 patent defines “toolbar” as a button bar that can be generated, dynamically changed, or dynamically updated via a Pinger process or a MOT script. This construction is consistent with our determinations in the ’117 IPR and the ’118 IPR. *See* ’117 IPR, Paper 12, 12–13 (construing “toolbar” in the ’070 patent); *see* ’118 IPR, Paper 12, 12–13 (construing “toolbar” in the ’863 patent).

For the foregoing reasons, we determine that “toolbar” should be construed as “a button bar that can be generated, dynamically changed, or dynamically updated via a Pinger process or a MOT script.” Although our construction differs from the district court’s construction in the addition of “generating,” the absence of the term “generating” does not change our conclusion that Petitioner fails to demonstrate, by a preponderance of the evidence, unpatentability of any of the challenged claims.

B. Principles of Law

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

A claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made 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 based on underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and, when in evidence, (4) objective evidence of nonobviousness, i.e., secondary considerations. *See Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966).

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed.

Cir. 2016) (citing 35 U.S.C. § 312(a)(3)) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”). This burden never shifts to Patent Owner. See *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof in *inter partes* review). Furthermore, Petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

Thus, to prevail in an *inter partes* review, Petitioner must explain how the prior art anticipates the challenged claims and how the proposed combinations of prior art would have rendered the challenged claims unpatentable. We analyze the challenges presented in the Petition in accordance with the above-stated principles.

C. Level of Ordinary Skill in the Art

In determining whether an invention would have been obvious at the time it was made, we consider the level of ordinary skill in the pertinent art at the time of the invention. *Graham*, 383 U.S. at 17. “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991).

Petitioner asserts that “[a] Person of Ordinary Skill In The Art (‘POSITA’) would generally have had either (i) a Bachelors' degree in Computer Science or a similar field, and three or four years of work experience in software application design or related fields, or (ii) a Masters' degree in Computer Science or a similar field and two or three years of work

experience in software application design or related fields.” Pet. 11 (citing Ex. 1009 ¶¶ 63–66)

Patent Owner asserts that “a person of ordinary skill in the art (‘POSITA’) would have a Bachelor’s degree in Computer Science or an equivalent field as well as at least three years of academic or industry experience in distributed systems and software application design for graphical user interfaces. PO Resp. 4 (citing Ex. 2017 ¶ 29).

Based on our review of the ’863 patent, the types of problems and solutions described in the ’863 patent and cited prior art, the testimony of Petitioner’s and Patent Owner’s declarants, and the arguments and evidence adduced at trial, we agree with and apply Petitioner’s definition of a person of ordinary skill in the art at the time of the claimed invention. We note, however, that our analysis would not change under either definition.

D. Asserted Grounds of Unpatentability Based on Reilly

1. Overview of Reilly

Reilly discloses data viewer 208, with center section 248 that displays news stories, which are selected using category buttons 250 and/or subcategory buttons 252. Ex. 1003, 13:38–48, Fig. 10. The category to which each news story is assigned is represented in one or more Data Access Tables 136. *Id.* at 4:48–49. Also with respect to the categories, Data Access Tables 186 are disclosed as being “used to access news stories, advertisements and display scripts associated with each of the categories of news items that are to be displayed on the subscriber’s workstation.” *Id.* at 6:57–61. Reilly further discloses user profile 194 that includes category and subcategory preferences information 216, along with timestamps 217a–217c, which indicate the time of the last update to the subscriber computer’s

locally stored set of news stories and administrative files. *Id.* at 7:45–9. A default connection schedule calls for the subscriber’s computer to initiate a connection to the information server to receive updates. *Id.* at 8:19–24.

Reilly discloses that

Based on the time of day and the information in the transmitted user profile, the application server determines (A) what type of update is to be performed (i.e., a news item update or an administrative update), and (B) what new information needs to be downloaded to the client computer and what items in the client computer's local information database should be deleted. The application server 272 then makes calls to one or more data servers 274 to collect all the information that needs to be sent to the client computer and then sends those items to the client computer, along with instructions on what items, if any, should be deleted from the client computer's local information database.

Id. at 14:62–15:6. The client computer thereafter loads the information and makes changes as needed, including updating Data Access Tables 186. *Id.* at 15:7–14.

2. Petitioner’s Contentions

In its Petition, Petitioner specifically points to category buttons 250 shown in Figure 10 of Reilly as teaching the claimed “toolbar” recited in the sole independent claim, claim 1. *See* Pet. 19–20. In its Supplemental Reply, Petitioner asserts that “*Reilly* discloses a toolbar (250) generated by scripts that is automatically periodically updated.” Supp. Reply 9 (citing Pet. 16–28; Ex. 1003, 13:38–48, Fig. 10). Petitioner further asserts that “[t]he toolbar information is stored in Data Access Tables 186, and updates thereto are directed to both software modules and the content of the toolbar (e.g., categories, sub-categories, and news items).” *Id.* at 10 (citing Ex. 1003,

4:42–49, 6:57–61, 15:8–15; Pet. 17–18, 20–21, 25–26; Ex. 1021, 9–11). Specifically, Petitioner points to Reilly’s disclosure of display scripts as teaching that the toolbar can be generated via either a MOT script or a Pinger process. *Id.* at 10–11 (citing Pet. 16; Ex. 1003, 6:57–61).

Petitioner also asserts that “Data Access Tables 186 provide data used to define how the toolbar (*data viewer in Reilly*) is displayed,” as “[i]t contains detailed scripting instructions for such actions.” *Id.* at 11 (citing Ex. 1003, 9:65–11:35) (emphasis added); *see id.* at 10–11 (citing Pet. 16; Ex. 1003, 6:57–61). During oral argument, Petitioner did not appear to address the category buttons 250 with respect to its initial position that this element of Reilly discloses the claimed “toolbar,” but rather focused its remarks on Reilly’s *data viewer* and using display scripts to render news stories within the data viewer. *See e.g.*, Tr. 19:15–16, 22:10–22.

3. Patent Owner’s Contentions

First, Patent Owner argues “Petitioner merely points to ‘category buttons 250’ of Reilly, but Petitioner makes no attempt to show that Reilly’s alleged toolbar ‘can be dynamically changed or updated via a Pinger process or a MOT script.’” Supp. Resp. 12 (citing Pet. 19–20), 13 (arguing “Petitioner has thus not addressed how . . . Reilly’s ‘category buttons 250’ constituted the recited ‘*toolbar*’ under the proper district court claim construction standard”). Specifically, Patent Owner argues that, with respect to the display scripts,

[T]hose are *the scripts that would modify the movement of images across the screen during a screen saver*. That’s what it is. It’s nothing to do with modifying a toolbar. And if it were to qualify as an MOT script, *what petitioner would need to show is that you could use a display script in Reilly to actually modify the toolbar*.

They can't show that because nowhere in Reilly does it ever say the display scripts can be used for that.

Tr. 36:6–13 (emphases added).

Second, Patent Owner further argues that the updating software “doesn't involve an interpretive programming language . . . [s]o to the extent there's anything called a script in Reilly . . . the display script in Reilly is that script and has nothing to do with updating the toolbar.” *Id.* at 38:18–39:2; *see id.* at 38:3–11.

Third, Patent Owner takes the position that the '863 patent specification defines Pinger process as including a heartbeat service, an authentication service and an update service. *Id.* at 29:9–20. Patent Owner argues that “Petitioner chose not to address how Reilly's alleged toolbar can be updated by such a process.” Supp. Resp. 12; *see* Tr. 37:10–18.

4. Analysis

Petitioner's position that Reilly's data viewer constitutes the “toolbar” was not advanced in its Petition. *See generally* Pet. As set forth above, Petitioner cited Reilly's *category buttons 250* as teaching the “toolbar.” *See id.* at 19–20. As Petitioner notes in the Petition, “[t]he category list can be updated by the personnel operating the information server, typically to add and delete special new categories associated with major news events such as a famous trial or event which generates many news stories.” *Id.* at 20–21 (quoting Ex. 1003, 4:42–49). Petitioner further asserts that Reilly discloses, “the list of predefined categories is automatically updated based on changed information on the information server.” *See* Pet. 26 (quoting Ex. 1003, cl.

7). Petitioner supports its position with the First Declaration of Dr. Bederson, who testifies that

Since the list of predefined categories in Reilly can be automatically changed based on the information in the information server, the toolbar is completely dynamic. New buttons can be added, existing buttons can be removed, and existing buttons can be changed. Thus, any attribute can be added, removed, or changed.

Ex. 1009 ¶ 99. Although Petitioner shows that Reilly discloses that the categories can be automatically updated, Petitioner does not persuade us that the ordinarily skilled artisan would have understood that category buttons 250 could have been updated by a MOT script or a Pinger process for the reasons discussed below.

*MOT Script*⁴

Reilly discloses that application server 272 determines whether a news item update or an administrative update is to be performed. Ex. 1003, 14:63–65. Application server 272 further collects “all the information that needs to be sent to the client computer and sends those items . . . along with instructions on what items, if any, should be deleted from the client computer’s local information database.” *Id.* at 15:1–6. Even assuming, *arguendo*, that application server 272 updates the list of predefined categories on the information server, Petitioner does not establish that category buttons 250 could be updated by a *script*. Conversely, although

⁴ During oral argument, there was some discussion of whether “MOT” was a nonce word. We do not determine whether “MOT” is a nonce word as such, a determination is not necessary to reach our conclusion that Petitioner has not demonstrated unpatentability of any of the challenged claims.

Reilly discloses display scripts, these scripts are disclosed with respect to displaying news stories and advertisements in center section 248 of data viewer 208. Ex. 1003, 5:25–34, 13:38–39. Petitioner does not establish that Reilly’s display scripts could be used to generate, update, or change *category buttons 250*, the predefined categories, or the category list, dynamically or otherwise. *See generally* Pet.

Accordingly, Petitioner does not persuade us that Reilly discloses (inherently, implicitly, or expressly), teaches, or suggests that the categories corresponding to category buttons 250 could be generated, dynamically changed, or dynamically updated by a MOT script.

Pinger Process

As discussed above in Section II.A, the ’863 patent specification defines “Pinger process.” *Supra* § II.A (quoting Ex. 1001, 10:17–32). Although Petitioner states that it agrees the disclosure in the ’863 patent specification is definitional (*see* Tr. 46:4–9), Petitioner apparently takes the position that the capabilities of the Pinger process depend on whether it is being used in conjunction with an updateable toolbar, e-mail services, or services provided by Internet service providers (*see id.* at 46:9–47:10).

We do not agree that the definition of Pinger process, and specifically, its capabilities, varies based on the embodiment in which the Pinger process is discussed. *See id.* at 46:9–47:10. Rather, as set forth above, the ’863 patent specification defines a Pinger process as administering or providing the following services: a heartbeat service, an authentication service, and an update service. Ex. 1001, 10:17–32. To the extent that each of these services is not discussed in every embodiment, we determine that the capabilities of the Pinger process do not change based on the situation in

which it is being used, but rather that the Pinger process retains its capabilities even though it may not deploy each capability concurrently or in every situation.

Petitioner contends that “a ‘Pinger process’ would be satisfied by processes that send messages to obtain, ascertain, or request information.” Supp. Reply 6. Petitioner contends that Reilly discloses “ping-like messages” and updating a toolbar based on the same. Tr. 46:19–47:1. However, Petitioner does not identify a “Pinger process” in Reilly because it does not identify an entity capable of performing a heartbeat service, an authentication service, and an update service as disclosed in the ’863 patent. *See generally* Pet. We disagree with Petitioner’s interpretation of the district court’s claim construction analysis as requiring “neither the Pinger process nor the MOT script . . . in order to meet the construction.” Reply 4 (citing Ex. 2018, 23–24 (claim construction order issued in relation to the ’070 patent)). Rather, the district court stated that

[T]he “toolbar” of the claimed invention necessarily “*can be* dynamically changed or updated via a Pinger process or a MOT script.” ’070 Patent 10:16–26 (emphasis added). But the toolbar, or the toolbar data, is not defined such that it must be updated via a Pinger process or a MOT script. The Court declines to interpret *can be* in the definitional statement of the “present invention” as “*must be*.”

Ex. 2018, 23–24. To the extent that Petitioner fails to show that Reilly discloses, teaches, or suggests an entity capable of performing a heartbeat service, an authentication service, and an update service, we find that Petitioner also fails to show that Reilly discloses (inherently, implicitly, or

expressly), teaches, or suggests the category buttons 250 *could* be generated, dynamically updated, or dynamically changed by a Pinger process.

In the challenge based on Reilly and Tuniman, we note that Tuniman discloses a toolbar as well. *See* Pet. 50 (citing Ex. 1006, Figs. 2–5). However, the Petition does not cite to a portion of Tuniman that teaches or suggests that a toolbar could be generated, changed, or updated by a script or Pinger process, dynamically or otherwise. *See generally* Pet. Nor does the Petition cite to evidence that would support the position that the combination of Reilly and Tuniman would have taught or suggested the same to the ordinarily skilled artisan at the time of the invention. *See* Tr. 35:2–9 (Patent Owner arguing that Petitioner’s briefing does not identify any reason why one would modify Filepp or Reilly to include a Pinger process or a MOT script). A similar analysis applies to December, which was combined with Reilly in the challenges to dependent claims 2 and 10.

For the foregoing reasons, Petitioner fails to establish, by a preponderance of the evidence that any of Reilly, Tuniman, or December, either alone or in the asserted combinations, discloses (inherently, implicitly, or expressly), teaches, or suggests a “toolbar” as recited in independent claim 1.

5. Dependent Claims 2, 4, 5, 11, 14–17, 20, and 23

Insofar as Petitioner has failed to establish, by a preponderance of the evidence, that independent claim 1 is unpatentable, Petitioner also fails to establish that dependent claims 2, 4, 5, 11, 14–17, 20, and 23 are unpatentable.

E. Asserted Grounds of Unpatentability Based on Filepp

1. Overview of Filepp

Filepp discloses user interface 284 that includes command bar 290, which further includes a number of commands 291–298 that are executable by a user. Ex. 1004, 9:54–57. The display text and graphics necessary to create user interface 284 are formulated from pre-created objects, including page element objects (PEOs). *Id.* at 10:30–42, 66–68. The PEOs can be updated during version checking where the version ID of the stored object is checked with delivery system 20, and delivery system 20 advises as to whether the version ID matches the currency value, or whether it is necessary to “deliver a current object that will replace the stored object shown to be stale.” *Id.* at 89:1–17.

2. Petitioner’s Contentions

Petitioner cites command bar 290, which includes NEXT command 291, BACK command 292, PATH command 293, MENU command 294, ACTION command 295, JUMP command 296, HELP command 297, and EXIT command 298 as teaching the claimed “toolbar.” Pet. 33 (quoting Ex. 1004, 74:65–75:2). More particularly, Petitioner cites Filepp’s disclosure of a “filter program [that] can be attached to both the NEXT or BACK functions to modify their implicit sequential nature based upon the value of the occurrence in the object set id.” *Id.* at 36 (quoting Ex. 1004, 75:12–15).

First, with respect to a Pinger process, Petitioner contends that

Filepp’s technique of updating and/or changing its toolbar can be implemented with either a Pinger process or a MOT script. *Filepp’s* event based and period-based changes or updates to its objects, including its command bar, could be implemented using

a Pinger process because such changes or updates could be accomplished using the exchange of ping-like messages (e.g., a ping message to see if any updates are available, and a response with an update if they were). EX1022 at ¶¶ 41–42.

Reply 12–13. Second, with respect to a MOT script, Petitioner contends that

Filepp’s changes or updates could be implemented using a MOT script because *Filepp*’s configuration uses text-based templates with defined, tagged structures that are particularly susceptible to programmatic changes or updates via a script. *Id.* at ¶ 44; see e.g. EX1004 at 13:51–14:17. Dr. Bederson explains that the structured, text-based format disclosed in *Filepp* makes it possible to use code in the form of a script to apply changes to the relevant configuration files (e.g., Perl or JavaScript were well-known at the time for modifying structured text files). EX1022 at ¶ 44.

Id. at 13.

3. Patent Owner’s Contentions

Patent Owner contends, “Petitioner merely points to a command bar in *Filepp* but [makes] no attempt to show that *Filepp*’s command bar ‘can be dynamically changed or updated via a Pinger process or a MOT script.’” PO Resp. 10 (citing Pet. 31–32). Patent Owner further contends that both Petitioner and its expert, Dr. Bederson, improperly applied the broadest reasonable interpretation standard in the Petition and the supporting declaration (Ex. 1009), instead of the *Phillips* standard. *Id.* at 10–11.

4. Analysis

Pinger Process

As discussed above in Section II.D, we disagree with Petitioner that a Pinger process is sufficiently shown by the use of “ping-like messages, i.e., messages to request, ascertain, or obtain information.” Reply 12 (citing Ex. 1004, 93:34–35, 94:1–4, 94:20–24). Instead, we determined that it is

necessary to show an entity that is *capable* of performing the three services disclosed in the '863 patent, i.e., the heartbeat service, the authentication service, and the update service, irrespective of whether this entity *actually updates the toolbar*. See *supra* § II.D (quoting Ex. 1001, 10:17–32). As discussed above with respect to Reilly, we disagree that “neither the Pinger process nor the MOT script was required . . . in order to meet the construction,” nor do we agree that the district court so held. See Reply 4 (citing Ex. 2018, 23–24 (claim construction order issued in relation to the '070 patent)). In other words, although Petitioner does not have to show that command buttons 291–298 of command bar 290 *are* generated, dynamically changed, or dynamically updated by a Pinger process, Petitioner must show that command buttons 291–298 *could* be updated by an entity that is capable of performing a heartbeat service, an authentication service, and an update service. This requires demonstrating that an entity that includes among its capabilities a heartbeat service, an authentication service, and an update service *is* disclosed, taught, or suggested by the reference. Petitioner fails in this showing with respect to Filepp. See *generally* Pet. To the extent that Petitioner fails to show that Filepp discloses, teaches, or suggests a Pinger process, we find that Petitioner also fails to show that Filepp discloses (inherently, implicitly, or expressly), teaches, or suggests that one or more of command buttons 291–298 in command bar 290 *could* be generated, dynamically updated, or dynamically changed by a Pinger process.

MOT Script

The cited portion in column 13, line 51 through column 14, line 17 of Filepp discloses data structures for various objects and segments, which are “structured to contain the display data,” that is, “text and graphics, to be

presented at screen partitions 250 and 290.” With respect to this cited portion of Filepp, Dr. Bederson testifies

Filepp’s changes or updates could be implemented using a MOT script because Filepp’s configuration uses text-based templates with defined, tagged structures that are particularly susceptible to programmatic changes or updates via a script. *see e.g.* EX1004 at 13:51-14:17. The structured, text-based format disclosed in Filepp makes it possible to use code in the form of a script to apply changes to the relevant configuration files (e.g., Tcl, Perl and JavaScript were well known at the time for modifying structured text files). I know this to be true because by 1997, I was heavily relying on the Tcl scripting language as part of Pad++ to do very similar work. Using Tcl, I wrote scripts that manipulated text-based templates to do the layout of the web history displayed in the images in ¶37.

Ex. 1022 ¶ 44. We understand that the district court’s claim construction order did not issue until after filing of the Petition. The burden, however, remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

Although Dr. Bederson testifies “Filepp’s changes or updates *could* be implemented using a MOT script” (*see* Ex. 1022 ¶ 44 (emphasis added)) because scripting languages were well-known, and he had personal experience doing the same, his testimony does not establish that *a person of ordinary skill in the art* at the time of the invention *would* have understood Filepp’s command buttons 291–298 in command bar 290 as being capable of being generated, dynamically updated, or dynamically changed by a script acting on Filepp’s PEOs. We cannot focus on what a skilled artisan would have been able to do, but, instead, must focus on what a skilled artisan would have been motivated to do at the time of the invention. *See InTouch Techs, Inc. v. VGO Commc’ns, Inc.*, 751 F.3d 1327, 1352 (Fed. Cir. 2014).

Dr. Bederson's testimony provides for a possibility that the ordinary artisan could implement Filepp's changes or updates using a MOT script, but does not persuade us that the ordinary artisan would have been motivated to make such modification as is required to establish obviousness.

With respect to the filter program, Filepp does not disclose, inherently, implicitly, or expressly, a script, nor does Petitioner initially advance a position that would support the finding that the ordinarily skilled artisan would have understood Filepp's filter program to be a script. *See generally* Pet.; *see* Ex. 1004.

In the challenge based on Filepp and Morten, the Petition does not cite to any portion of Morten that teaches or suggests that one or more of command buttons 291–298 in command bar 290 could be generated, changed, or updated by a script or Pinger process, dynamically or otherwise. *See generally* Pet. Nor does the Petition cite to evidence that would support the position that the combination of Filepp and Morten would have taught or suggested the same to the ordinarily skilled artisan at the time of the invention. *See* Tr. 35:2–9 (Patent Owner arguing that Petitioner's briefing does not identify any reason why one would modify Filepp or Reilly to include a Pinger process or a MOT script). A similar analysis applies to Olsen.

For the foregoing reasons, Petitioner fails to establish, by a preponderance of the evidence that any of Filepp, Morten, and Olsen, either alone or in the asserted combinations, discloses (inherently, implicitly, or

expressly), teaches, or suggests a “toolbar” as recited in independent claim 1.

5. Dependent Claims 2, 4, 5, 11, 14–17, 20, and 23

Insofar as Petitioner has failed to establish, by a preponderance of the evidence, that independent claim 1 is unpatentable, Petitioner also fails to establish that dependent claims 2, 4, 5, 11, 14–17, 20, and 23 are unpatentable.

F. Motion to Strike

Patent Owner argues that we should strike Sections II.C and II.D from Petitioner’s Reply as improperly attempting to cure “various fatal flaws” by “introducing new arguments that should have been made in its Petition, but were not.” Mot. 1. Specifically, these sections of the Reply discuss, respectively, the evidence cited with respect to the claim 1 limitation “for each button of the toolbar, at least one of the plurality of attributes identif[ies] a function to be performed when the button is actuated by the user Internet device” and the claimed “predetermined network address.” *Id.* at 2, 4. Even without considering Sections II.C and II.D of Petitioner’s Reply, we determine that Petitioner’s arguments and evidence do not meet the preponderance of the evidence standard for establishing anticipation or obviousness of any of the challenged claims. As a result, we dismiss Patent Owner’s Motion to Strike as moot.

III. CONCLUSION

We determine that Petitioner has not demonstrated by a preponderance of the evidence that any of challenged claims 1, 2, 4, 5, 10,

11, 14–17, 20, and 23 of the '863 patent are unpatentable over the asserted combinations of Reilly, Filepp, Morten, Tuniman, Olsen, and December.

IV. ORDER

It is, therefore,

ORDERED that claims 1, 2, 4, 5, 10, 11, 14–17, 20, and 23 of the '863 patent have not been shown by a preponderance of the evidence to be *unpatentable*;

FURTHER ORDERED that Patent Owner's Motion to Strike Evidence is *dismissed* as moot; and

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

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