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Paper 38
Entered: June 28, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SNAP INC.,
Petitioner,

v.

VAPORSTREAM, INC.,
Patent Owner.

Case IPR2018-00404
Patent 8,935,351 B2

Before JUSTIN T. ARBES, STACEY G. WHITE, and JENNIFER MEYER CHAGNON, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a)

I. BACKGROUND

Petitioner Snap Inc. filed a Petition (Paper 2, "Pet.") requesting *inter partes* review of claims 1, 5, 6, 9, 11, and 12 of U.S. Patent No. 8,935,351 B2 (Ex. 1001, "the '351 patent") pursuant to 35 U.S.C. § 311(a). On July 10, 2018, we instituted an *inter partes* review of all challenges raised in the Petition. Paper 11 ("Dec. on Inst."). Patent Owner Vaporstream, Inc. subsequently filed a Patent Owner Response (Paper 22, "PO Resp."), Petitioner filed a Reply (Paper 26, "Reply"), and Patent Owner filed a Sur-Reply (Paper 29, "Sur-Reply"). An oral hearing was held on March 27, 2019, and a transcript of the hearing is included in the record (Paper 36, "Tr.").

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a). For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 1, 5, 6, 9, 11, and 12 are unpatentable.

A. Related Proceedings

The parties indicate that the '351 patent is the subject of the following district court proceeding involving Petitioner and Patent Owner: *Vaporstream, Inc. v. Snap Inc.*, Case No. 2:17-cv-00220-MLH-KS (C.D. Cal.). *See* Pet. 1; Paper 4, 1. Petitioner filed nine additional petitions for *inter partes* review of various related patents owned by Patent Owner in Cases IPR2018-00200, IPR2018-00312, IPR2018-00369, IPR2018-00397, IPR2018-00408, IPR2018-00416, IPR2018-00439, IPR2018-00455, and IPR2018-00458. *See* Pet. 1–2; Paper 4, 1–3. *Inter partes* review was instituted in each of these proceedings.

B. The '351 Patent

The '351 patent discloses "[a]n electronic messaging system and method with reduced traceability." Ex. 1001, Abstract. The '351 patent notes that "[t]ypically, an electronic message between two people is not private." *Id.* at col. 1, ll. 53–54. For example, messages may be intercepted by third parties; logged and archived; or copied, cut, pasted, or printed. *Id.* at col. 1, ll. 54–59. "This may give a message a 'shelf-life' that is often uncontrollable by the sender or even the recipient." *Id.* at col. 1, ll. 59–60. As such, according to the '351 patent, there was "a demand for a system and method for reducing the traceability of electronic messages." *Id.* at col. 2, ll. 6–8. Figure 3 of the '351 patent is reproduced below.

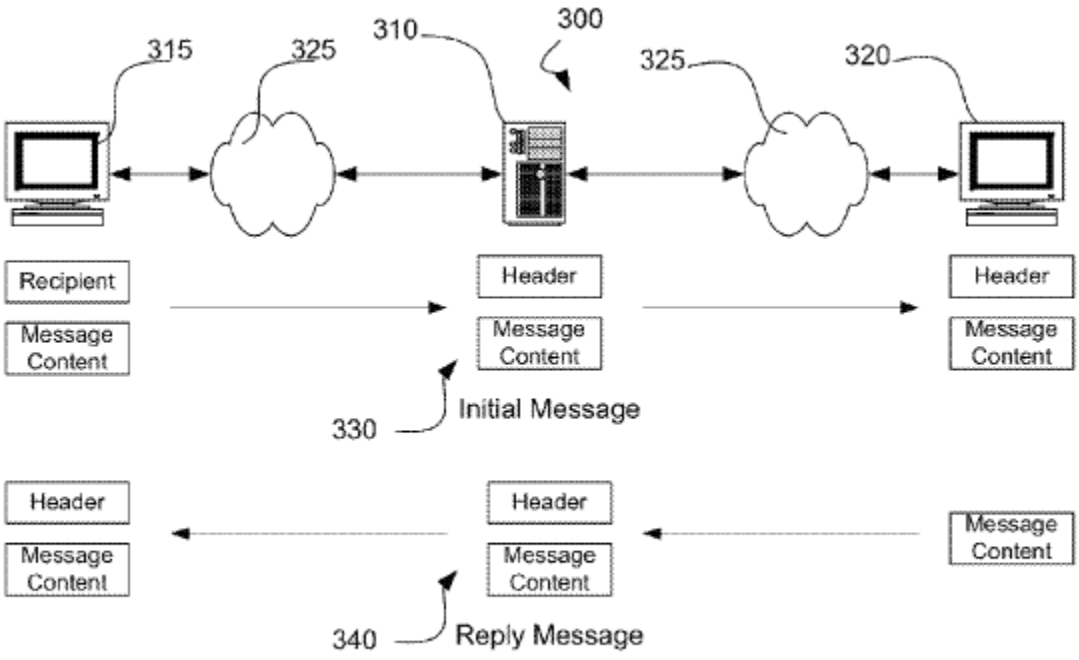

FIG. 3

Figure 3 above depicts system 300 for communicating electronic message 330 from user computer 315 to user computer 320 over network 325 using server 310. *Id.* at col. 10, ll. 51–56. "An electronic message may be any

electronic file, data, and/or other information transmitted between one or more user computers." *Id.* at col. 7, ll. 39–41. The electronic message may include text, image, video, audio, or other types of data. *Id.* at col. 7, ll. 41–49.

Figure 5 of the '351 patent is reproduced below.

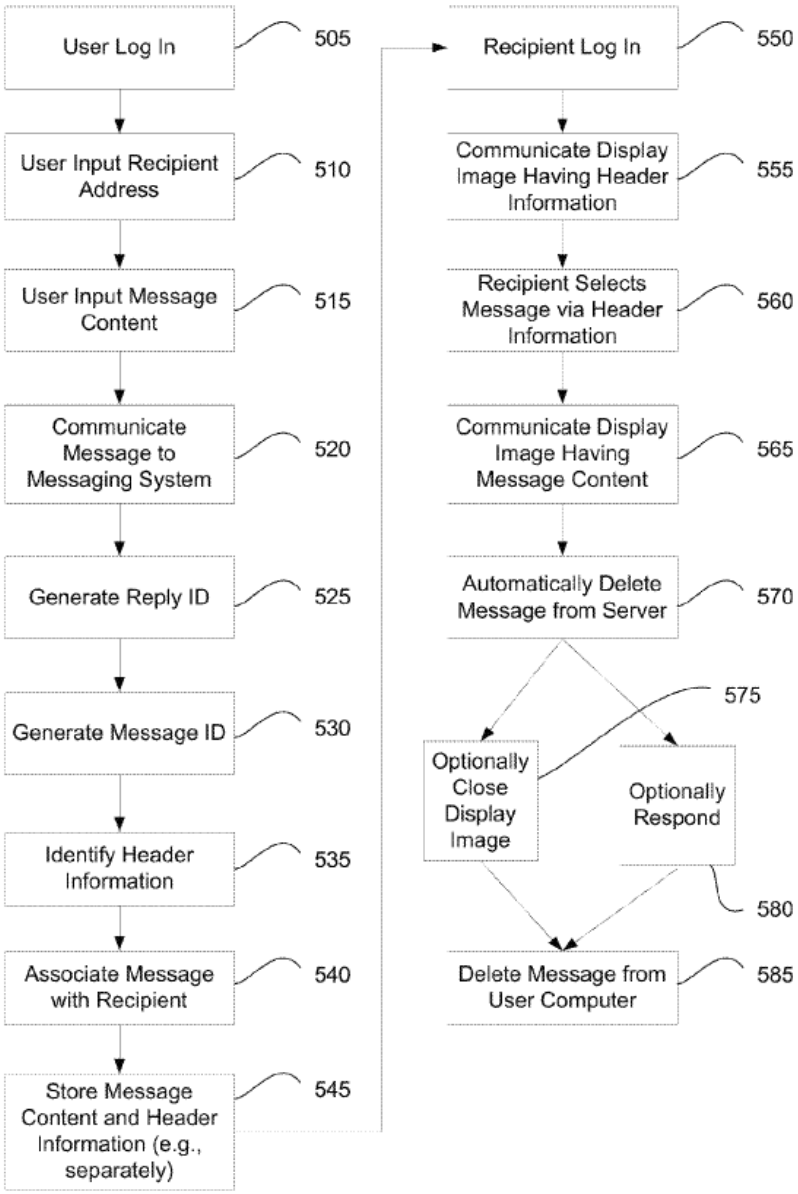

FIG. 5

Figure 5 depicts the process by which the electronic message is sent from the first user computer and received by the second user computer. *Id.* at col. 10, l. 66–col. 11, l. 1. At steps 510–520, the user inputs a recipient address (e.g., a unique identifier, such as an email address) and message content, using separate screens provided by the server computer, and the message is communicated from the user computer to the server. *Id.* at col. 11, l. 26–col. 12, l. 15, Figs. 8, 9. The server then performs various actions to process the message at steps 525–545. *Id.* at col. 12, l. 16–col. 14, l. 17. For example, the server identifies header information (e.g., information that "identifies the sending user, recipient user, location of the electronic message, [or] timing of [the] electronic message") separate from the content of the message itself and generates a message ID associated with the header information and message content. *Id.* at col. 12, ll. 26–38, col. 13, ll. 19–21 ("A message ID [is] used to maintain a correspondence between the separated components of electronic message 330."). The '351 patent describes an example in which the message ID is included both in an Extensible Markup Language (XML) file storing the header information and in an XML file storing the message content. *Id.* at col. 13, l. 27–col. 14, l. 17.

To retrieve the message, the recipient first logs in to the system at step 550. *Id.* at col. 14, ll. 18–20. At step 555, the server communicates to the recipient user computer a display image showing header information for multiple messages. *Id.* at col. 14, ll. 24–40, Fig. 10. For example, the display image may show a display name and date/time for each message, but not show the content itself for any of the messages. *Id.* In one embodiment, the header information may include "a sequence number (ex: 1, 2, 3, etc.) assigned to each electronic message," where each sequence number is

associated with a corresponding message ID for the respective message. *Id.* at col. 14, ll. 45–56. At step 560, the user selects one of the electronic messages to be displayed by, for example, selecting a "read" link displayed with the respective header information. *Id.* at col. 14, ll. 57–60. At step 565, the server communicates to the recipient user computer a display image with the content of the chosen message (but not header information for the message). *Id.* at col. 15, ll. 13–22, Fig. 11. At step 570, the message is automatically and permanently deleted from the server at a predetermined time. *Id.* at col. 15, ll. 39–41. At step 575, the user closes the display image, returns to the message listing, or chooses to respond to the message. *Id.* at col. 16, ll. 28–34. At step 585, the message content is automatically deleted from the recipient user computer after viewing. *Id.* at col. 16, ll. 37–45. According to the '351 patent, displaying header information and message content separately, and automatically deleting message content, reduce the traceability of electronic messages. *Id.* at col. 3, l. 48–col. 4, l. 3.

C. Illustrative Claim

Claim 1 of the '351 patent recites:

> 1. A computer-implemented method of handling an electronic message, the method comprising:
>
> receiving at a recipient user device a first header information corresponding to a first message content that includes a media component;
>
> providing a first display via the recipient user device, the first display including the first header information in a message list, the first display not displaying the media component;
>
> receiving at the recipient user device the first message content including the media component, wherein the first message content including the media component is associated

with a unique message ID that correlates the first message content including the media component with the first header information;

receiving a selection by the recipient user via the first display, the selection directed to a portion of the message list corresponding to the first header information;

in response to the selection, providing a second display via the recipient user device, the second display displaying the first message content including the media component without displaying a username associated with the first header information; and

automatically deleting the first message content including the media component at a predetermined amount of time after being displayed such that after the second display is terminated from view, the first message content including the media component is no longer available to the recipient user.

D. Prior Art

The pending grounds of unpatentability in the instant *inter partes* review are based on the following prior art:

U.S. Patent No. 7,356,564 B2, filed Jan. 9, 2002, issued Apr. 8, 2008 (Ex. 1014, "Hartselle");

U.S. Patent No. 7,054,905 B1, filed Mar. 30, 2000, issued May 30, 2006 (Ex. 1005, "Hanna");

U.S. Patent No. 5,958,005, issued Sept. 28, 1999 (Ex. 1006, "Thorne");

U.S. Patent Application Publication No. 2005/0021803 A1, published Jan. 27, 2005 (Ex. 1003, "Wren"); and

U.S. Patent Application Publication No. 2003/0152203 A1, published Aug. 14, 2003 (Ex. 1004, "Berger").

E. Pending Grounds of Unpatentability

The instant *inter partes* review involves the following grounds of unpatentability:

References	Basis	Claim(s) Challenged
Wren, Berger, and Thorne	35 U.S.C. § 103(a)[1]	1, 5, 6, and 11
Wren, Berger, Thorne, and Hartselle	35 U.S.C. § 103(a)	9
Wren, Berger, Thorne, and Hanna	35 U.S.C. § 103(a)	12

II. ANALYSIS

A. Claim Interpretation

According to the rules applicable to this proceeding, we interpret claims in an unexpired patent using the "broadest reasonable construction in light of the specification of the patent in which [they] appear[]." 37 C.F.R. § 42.100(b) (2017).[2] Under this standard, we interpret claim terms using

[1] The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) ("AIA"), amended 35 U.S.C. § 103. Because the challenged claims of the '351 patent have an effective filing date before the effective date of the applicable AIA amendment, we refer to the pre-AIA version of 35 U.S.C. § 103.

[2] The Petition in this proceeding was filed on December 27, 2017, prior to the effective date of the rule change that replaces the broadest reasonable interpretation standard with the federal court claim interpretation standard. *See* Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340, 51,340 (Oct. 11, 2018) (amending 37 C.F.R. § 42.100(b) effective November 13, 2018).

"the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification." *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). "Under a broadest reasonable interpretation, words of the claim must be given their plain meaning, unless such meaning is inconsistent with the specification and prosecution history." *TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1062 (Fed. Cir. 2016); *see Tempo Lighting, Inc. v. Tivoli, LLC*, 742 F.3d 973, 977 (Fed. Cir. 2014) ("In claim construction, [our reviewing] court gives primacy to the language of the claims, followed by the specification. Additionally, the prosecution history, while not literally within the patent document, serves as intrinsic evidence for purposes of claim construction.").

In the Decision on Institution, based on the record at the time, we preliminarily interpreted "correlates" in claim 1 to mean "associates." Dec. on Inst. 8–9. The parties agreed on this interpretation in the related litigation and the district court adopted it. Ex. 2002, 8–9. Patent Owner argues in its Response that we should maintain our preliminary interpretation, Petitioner does not argue otherwise in its Reply, and we do not perceive any reason or evidence that compels any deviation from the preliminary interpretation. *See* PO Resp. 6. We adopt the previous analysis for purposes of this Decision.

In addition, Patent Owner seeks interpretation of the phrase "message content that includes a media component." *Id.* at 7–11. Petitioner does not seek express interpretation of any term of the '351 patent, but responds to Patent Owner's proposed interpretation in its Reply. Reply 17–21.

Claim 1 recites various limitations pertaining to a "message content that includes a media component." For example, claim 1 recites "receiving at a recipient user device a first header information corresponding to a first message content that includes a media component," "receiving at the recipient user device the first message content including the media component," "providing a second display . . . displaying the first message content including the media component," and "automatically deleting the first message content including the media component at a predetermined amount of time after being displayed."

The district court construed the phrase to mean "message content that includes sound and/or visual information and does not include header information." Ex. 2002, 22–24. Patent Owner argues that we should adopt the district court's construction "with the understanding that it includes message content that is attached to the email or linked via publicly accessible [Uniform Resource Locator (URL)]." PO Resp. 10–11. According to Patent Owner, "'message content' encompasses a URL that provides the access path to media content." *Id.* at 7. In support of its proposed interpretation, Patent Owner relies on a passage from the Specification of the '351 patent stating that "a message content of an electronic message may include an attached and/or linked file." Ex. 1001, col. 7, ll. 39–52 (cited at PO Resp. 8). Patent Owner also directs us to testimony from Petitioner's declarant, Sandeep Chatterjee, Ph.D., in a different *inter partes* review involving a patent related to the '351 patent. PO Resp. 8–9 (citing Ex. 2010 ¶ 100 n.25). Patent Owner characterizes Dr. Chatterjee's testimony as "mak[ing] clear [that] passing the actual content and passing a link that provides access to that content, such as a

URL, are both examples of 'passing information,'" and "[t]he same is true of 'message content.'" *Id.* Thus, in Patent Owner's view, the recited "message content including a media component" broadly includes both a URL in a message (linking to content accessible via that URL) and a file attached to the message. *See id.* at 7–11.

Petitioner responds by arguing that although "the [S]pecification states that [the] 'message content' may include a 'linked file,' it never states that the *link itself* is 'message content.'" Reply 18. In addition, Petitioner directs us to a further statement in the Specification that "[t]ypically, a message content, such as message content 140 does not include information that in itself identifies the message sender, recipient, *location of the electronic message*, or time/date associated with the electronic message." Ex. 1001, col. 7, ll. 55–59 (cited at Reply 18–19) (emphasis added). Petitioner explains that "[t]he URL . . . in the proposed combination [of Wren, Berger, Thorne, and Hanna] does not qualify as 'message content' because it identifies 'the location of' the video message on the server in Hanna." Reply 19 (citing Ex. 1005, col. 5, ll. 26–28). According to Petitioner, a person of ordinary skill in the art would "think of a URL as a pointer to content," i.e., "how you get to the content" rather than "the content itself." Tr. 23:12–24:5. In short, Petitioner contends that "[i]t's . . . the *file* that's the content, not the link itself." *Id*. at 23:6 (emphasis added).

We agree with Petitioner's arguments. The Specification of the '351 patent states that

> [i]n one example, a message content of an electronic message may include embedded information. In another example, a message content of an electronic message may include an attached and/or linked file. In such an example with an attached

> and/or linked file, the attached and/or linked file may be automatically deleted from the messaging system after being viewed by a recipient.

Ex. 1001, col. 7, 49–55. Thus, the Specification indicates that message content may be communicated to the user via embedded information, attached files, or linked files. Embedding, attaching, and linking are three ways to provide access to information. In other words, the email recipient may gain access to the information or content in a variety of ways; however, the method of providing access to information or content is not the same thing as the underlying information or content. In the passage quoted above, privacy may be enhanced by automatically deleting "the attached and/or linked file" from the messaging system after the file is viewed. *Id.* at col. 7, ll. 52–55. The Specification makes no provisions for deleting the URL or link to the file, but rather the focus is on the information itself. That information, or "message content," is located in the file itself regardless of the method by which the recipient accesses that information. Contrary to Patent Owner's assertion, Dr. Chatterjee's testimony cited by Patent Owner also supports this conclusion. *See* PO Resp. 8–9 (citing Ex. 2010 ¶ 100 n.25). Dr. Chatterjee testifies that there is a "distinction between transmitting the *actual content* to the recipient in a message, versus transmitting *just a URL* that points to or is an address for the content." Ex. 2010 ¶ 100 n.25 (emphases added). Dr. Chatterjee's testimony makes clear that "actual content" is distinct from "just a URL" that points to the content.

Thus, we determine that the broadest reasonable interpretation of the phrase "message content that includes a media component" does not encompass a URL in a message (linked to content accessible via that URL).

No further express interpretation of this phrase is necessary for purposes of this Decision. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) ("Because we need only construe terms 'that are in controversy, and only to the extent necessary to resolve the controversy,' we need not construe [a particular claim limitation] where the construction is not 'material to the . . . dispute.'" (citations omitted)).

B. Principles of Law

To prevail in challenging claims 1, 5, 6, 9, 11, and 12 of the '351 patent, Petitioner must demonstrate by a preponderance of the evidence that the claims are unpatentable. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d).

A claim is unpatentable for obviousness if, to one of ordinary skill in the pertinent art, "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (quoting 35 U.S.C. § 103(a)). The question of obviousness is resolved on the basis of underlying factual determinations, including "the scope and content of the prior art"; "differences between the prior art and the claims at issue"; and "the level of ordinary skill in the pertinent art."[3] *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

[3] Additionally, secondary considerations, such as "commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy." *Graham*, 383 U.S. at 17–18. Patent Owner, however, has not presented any such evidence.

A patent claim "is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR*, 550 U.S. at 418. An obviousness determination requires finding "both 'that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.'" *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367–68 (Fed. Cir. 2016) (citation omitted); *see KSR*, 550 U.S. at 418 (for an obviousness analysis, "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does").
A petitioner's assertion of obviousness "cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness." *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016) (citing *KSR*, 550 U.S. at 418).

C. Level of Ordinary Skill in the Art

Petitioner argues that a person of ordinary skill in the art at the time of the '351 patent "would have possessed at least a bachelor's degree in software engineering, computer science, or computer engineering with at least two years of experience in the design and implementation of systems for sending and receiving messages over a communications network, such as the Internet (or equivalent degree or experience)," relying on testimony from its declarant, Dr. Chatterjee. Pet. 5–6 (citing Ex. 1002 ¶¶ 13–15). Patent Owner does not propose a different level of ordinary skill in the art in its

Response. Patent Owner's declarant, Kevin C. Almeroth, Ph.D., "generally agree[s]" with Petitioner's characterization of the person of ordinary skill in the art, with the caveat that "such a person of ordinary skill would also have a working knowledge of design principles for software user interfaces. Such knowledge often would be learned in an undergraduate course in Human Computer Interaction (HCI)." Ex. 2009 ¶ 21. We agree, as the '351 patent describes the design of a software user interface that purportedly provides for reduced traceability of electronic messages. *See, e.g.*, Ex. 1001, Abstract, col. 1, l. 44–col. 3, l. 9. Based on the record developed during trial, including our review of the '351 patent and the types of problems and solutions described in the '351 patent and cited prior art, we agree with and adopt Petitioner's assessment of the level of ordinary skill in the art, with the caveat that such an individual would have had a working knowledge of design principles for software user interfaces, which may be achieved via study of human-computer interaction (HCI).

D. Obviousness Ground Based on Wren, Berger, and Thorne (Claims 1, 5, 6, and 11)

1. Wren

Wren describes "a multimedia video messaging system that provides an end-user with the ability to record and send arbitrary-length audio and video content" as "audiovisual messages that are automatically addressed to recipients based on one-touch activation." Ex. 1003, Abstract, ¶ 2. The sending user (referred to in Wren as the "end-user") "initiate[s] the method from a menu, address-book or an active voice or audio call screen" on the user's device (e.g., a mobile phone). *Id.* ¶¶ 10, 23. For example, the device

may provide the end-user with a "Send" option, which "will auto-compose the message [to the desired recipient(s)] based on parameters submitted to the method from the point of initiation" or "may prompt the user for the to: address that will typically be a phone number or e-mail address, subject text and body text." *Id.* ¶ 29. The device then sends the movie message in one of two ways. *Id.* ¶¶ 11, 29. If the video is less than a certain size, it is sent as an attachment to the message. *Id.* ¶ 11. If the video is above that size, however, "the video and audio streams to a remote disk that is available on the world-wide web and a message is created and sent with a [Uniform Resource Identifier (URI)[4]] to the streamed media embedded in the body of the message." *Id.* "When the message is received, an end-user can click on the attachment or the URI to play the video and audio." *Id.*

Figures 9A–9C of Wren are "an illustration of the end-user experience receiving the one-touch message with a compatible mobile phone or [personal computer (PC)] with a compatible e-mail client." *Id.* ¶ 22.

[4] Dr. Chatterjee explains that a URI is a "sequence of characters that identifies a resource," the most common example of which is a URL, and "[t]he terms URL and URI are often used interchangeably when the resource being identified is accessible over the Internet, as is the case in Wren." Ex. 1002 ¶ 33 n.5.

Figures 9A and 9B of Wren are reproduced below.

FIG 9A

FIG 9B

Figure 9A depicts "a notification of a new message," and Figure 9B depicts "a view of the Movie once the user selects play from a new message notification." *Id.* ¶ 32. Wren also includes Figure 9C, which is reproduced below.

FIG 9C

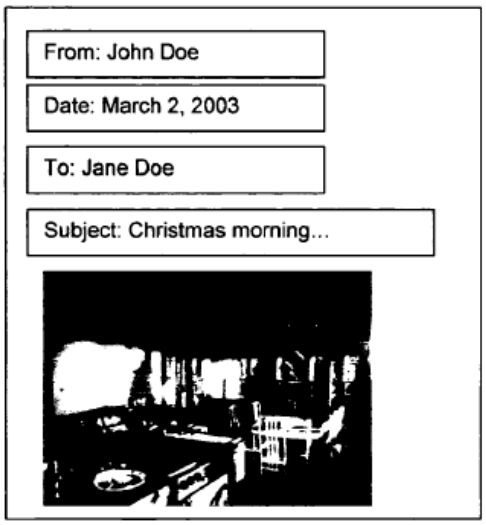

Figure 9C depicts "an e-mail message containing the Movie." *Id.*

2. Berger

Berger describes a unified messaging (UM) system where a user can access different types of messages (e.g., voicemail, email, facsimile, video) from a remote UM messaging server with a "seamless user interface"

presented on a mobile phone. Ex. 1004 ¶¶ 1, 28. The messaging server converts data as necessary (e.g., text to speech, and vice versa) so that it can be accessed and provided to the user. *Id.* ¶¶ 1–4, 28–30. Figure 4 of Berger is reproduced below.

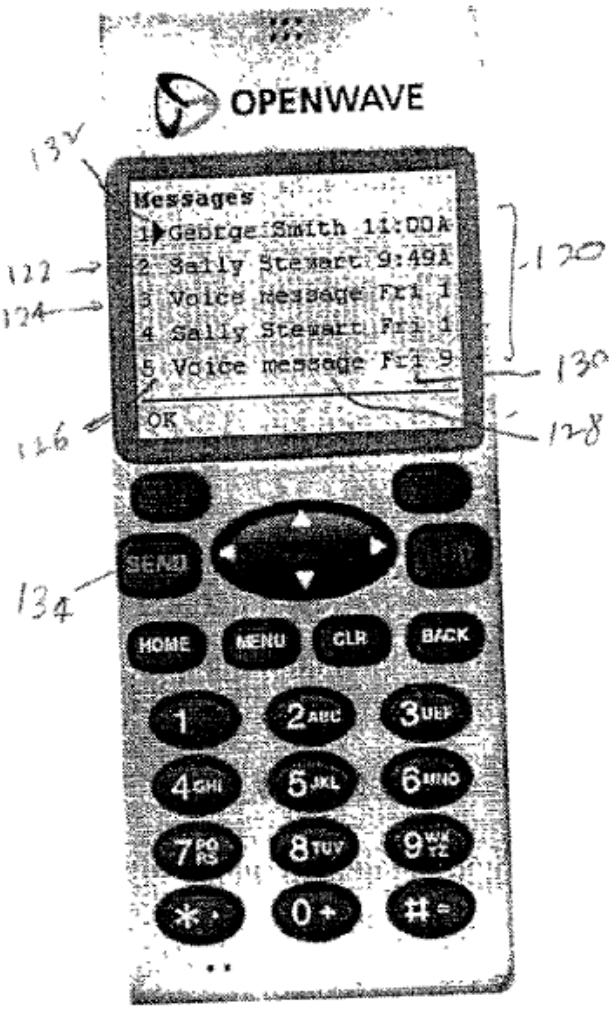

Figure 4 depicts list of available messages 120 displayed on the user's mobile phone, including email messages 122 and voice messages 124. *Id.* ¶ 41. The list is provided to the user's phone as "a web page, in a markup language compatible with the requesting device," and displayed as "hyperlinked messages." *Id.* The user selects a particular message by

moving cursor 132 up and down and pressing SEND button 134. *Id.* ¶ 42. Upon doing so, the phone's browser sends a Hypertext Transfer Protocol (HTTP) request to the messaging server, and the messaging server performs any necessary conversion of the message and "deliver[s] . . . the message (in the form of a web page, using HTTP) to the phone" for display to the user. *Id.* ¶¶ 43–44. Berger discloses that each message has an associated message number (displayed as 1–5 in Figure 4 above), which is included in each hyperlink of the displayed list and the HTTP request from the phone. *Id.* ¶¶ 45–57.

3. Thorne

Thorne describes a method of "communicating data text messages, such as E-Mail, between computers connected to a network while providing selectable degrees of security for each message." Ex. 1006, Abstract. In relevant part, Thorne describes starting a timer when an "E-Mail message is opened and the text displayed," determining whether a "maximum display time has been exceeded," and, if so, closing the message display and "delet[ing] and purg[ing]" the message. *Id.* at col. 10, ll. 35–38, col. 11, ll. 5–11, Fig. 5B (steps 548, 550, and 564). "This feature is provided in order to [e]nsure that a user does not bring the message up and leave it displayed for hours." *Id.* at col. 10, ll. 38–40.

4. Claim 1

Petitioner explains in detail how Wren, Berger, and Thorne teach all of the limitations of claim 1, relying on the testimony of Dr. Chatterjee as support. *See* Pet. 21–53 (citing Ex. 1002). Petitioner relies on Wren for the

majority of the limitations of claim 1. Petitioner argues that Wren teaches a computer-implemented method of handling an "electronic message" (i.e., movie message) comprising (1) receiving, at a "recipient user device" (i.e., the recipient's mobile phone), a "first header information" (i.e., sender identification ("Jane Doe") and time ("9:30AM")) corresponding to a "first message content that includes a media component" (i.e., video); (2) providing a "first display" via the recipient user device including the first header information but "not displaying the media component" (i.e., the screen display shown in Figure 9A, which does not show the video); (3) receiving the first message content including the media component at the recipient user device; (4) receiving a "selection" by the recipient user via the first display (i.e., the user selecting "Play" on the screen display shown in Figure 9A); and (5) "in response to the selection," providing a "second display" via the recipient user device with the message content including the media component "without displaying a username associated with the first header information" (i.e., the screen display shown in Figure 9B, which does not show a username). *Id.* at 21–26, 30–31, 44–45, 47–48.

We note that unlike certain claims in patents related to the '351 patent, claim 1 does not recite that the displays are "reduced traceability displays" or that all identifying information and message content for the message are displayed separately. In other words, claim 1 of the '351 patent may be satisfied as long as the first display includes "a first header information" but does not display "a media component" that is included in the second display, and the second display includes "a first message content" including the media component but does not display "a username associated with the first header information." By contrast, the

challenged claims of the patents involved in Cases IPR2018-00397 and IPR2018-00408 recite "reduced traceability displays," which we interpreted in those *inter partes* reviews to mean "an arrangement of displays that enables reduced traceability of electronic messages (e.g., by separately displaying identifying information and message content)." *See* IPR2018-00397, Paper 10, 8–9; IPR2018-00408, Paper 10, 8–9.

Petitioner relies on Berger for two limitations of claim 1. First, claim 1 recites that the first display "includ[es] the first header information in a message list" and that the recipient user makes a "selection" that is "directed to a portion of the message list corresponding to the first header information." Because Wren displays only a single message at a time, Petitioner relies on Berger for these limitations, citing the list of messages shown in Figure 4 of Berger, which displays "header information" for individual messages and allows the user to select a particular message by moving the cursor. Pet. 26–28, 44–48 & n.3. Petitioner explains that in the asserted combination, "Figure 9A of Wren (the 'first display') would be further adapted to display a message list containing multiple messages, each item in the list listing header information as disclosed in Berger." *Id.* at 28 (emphases omitted).

Second, claim 1 recites that "the first message content including the media component is associated with a unique message ID that correlates the first message content including the media component with the first header information." As explained above, we interpret "correlates" to mean associates. *See supra* Section II.A. According to Petitioner and Dr. Chatterjee, a person of ordinary skill in the art would have understood that Wren must correlate the header information and message content

because, when the user selects "Play" on the screen with the header information shown in Figure 9A, Wren plays the video corresponding to that information, as shown in Figure 9B. Pet. 30–32 (citing Ex. 1002 ¶ 67). Petitioner acknowledges, though, that Wren does not disclose a "unique message ID" that correlates the two components, and thus also relies on Berger. *Id.* at 32–39. Specifically, Petitioner contends that in Berger, a message number is "associated with each row of displayed header information" and included in the URL used to retrieve the message. *Id.* at 32–37. Petitioner also cites Berger's alternative embodiment that combines the message number and user ID into a single cryptographic hash value that is similarly included in the URL. *Id.* at 34–35, 37–38. Petitioner argues that the message number, either (1) alone, (2) in combination with the user ID, or (3) combined with the user ID as a cryptographic hash value, is a "unique message ID" as claimed because it is "uniquely associated with a specific message content stored at the server and used to identify the appropriate message content to be delivered to the recipient, thus correlating that message content with the corresponding displayed header information." *Id.* at 32–38 (citing Ex. 1002 ¶¶ 73–74). We agree with Petitioner's analysis on all three bases.

Petitioner further explains why a person of ordinary skill in the art would have been able and motivated to modify Wren's system based on the teachings of Berger. *Id.* at 28–30, 39–44, 46. Petitioner argues that both references teach similar techniques for delivering message content and presenting that content on a mobile phone with a small screen, and an ordinarily skilled artisan would have viewed "the ability to display and allow selection from among a multiplicity of received messages," rather than

displaying one message at a time, as a "distinct improvement" to the system of Wren. *Id.* at 28–30.

Petitioner relies on Thorne for the final limitation of claim 1, "automatically deleting the first message content including the media component at a predetermined amount of time after being displayed such that after the second display is terminated from view, the first message content including the media component is no longer available to the recipient user," citing Thorne's teaching of automatic deletion after a "maximum display time." *Id.* at 48–50 (citing Ex. 1006, col. 10, ll. 35–45, col. 11, ll. 5–12). Petitioner contends that an ordinarily skilled artisan would have been motivated to incorporate such a feature, for example, to "improve the confidentiality of movie messages received using the system of Wren." *Id.* at 50–53.

Petitioner's analysis for each of the limitations of claim 1, and explanation why a person of ordinary skill in the art would have been motivated to combine the references' teachings, are supported by the testimony of Dr. Chatterjee and persuasive. *See* Pet. 21–53; Ex. 1002 ¶¶ 48–96. Patent Owner makes two arguments with respect to claim 1, which we do not agree with for the reasons explained below.

a. Response Limitation

Patent Owner argues that the combination of Wren and Berger does not teach "in response to the selection, providing a second display via the recipient user device, the second display displaying the first message content including the media component" (the "response" limitation). PO Resp.

20–36 (citing Ex. 2009 ¶¶ 52, 61); Sur-Reply 3–15. Specifically, Patent Owner contends that Petitioner has not met its burden to show that a person of ordinary skill in the art would have combined the teachings of Wren and Berger in a manner that results in the response limitation. PO Resp. 25–26.[5] We begin by restating the particular combination articulated by Petitioner in the Petition, and then address Patent Owner's arguments.

Petitioner asserts that a person of ordinary skill in the art would have combined the teachings of Wren and Berger in the following manner: (1) Figure 9A of Wren would be adapted to display a "message list" with header information for multiple messages (rather than for just one message, as in Wren), relying on Berger's disclosure of a list of available messages, and (2) the user would select a message by selecting particular header information in the message list, citing Berger's disclosure of user selection

[5] Patent Owner's position is that "[e]ven assuming there was a motivation to combine Berger with Wren, which Patent Owner does not concede, Petitioner has failed to show that the combination of references discloses or suggests [the response limitation]." PO Resp. 25. Patent Owner, however, does not explain why Petitioner's stated reasons why a person of ordinary skill in the art would have been motivated to combine the references' teachings are incorrect or insufficient. *See* Reply 5. Nor does Patent Owner's declarant, Dr. Almeroth, provide any testimony in that regard. As explained above, we find those reasons, supported by the testimony of Dr. Chatterjee, to be persuasive. *See, e.g.*, Pet. 28–30, 39–44, 46, 50–53; Ex. 1002 ¶¶ 61–65, 77–83, 93–96. Thus, the question we must resolve is whether an ordinarily skilled artisan would have combined the references in the *way* that Petitioner asserts (to accomplish the two claim limitations disputed by Patent Owner).

by moving a cursor up and down and pressing a button. Pet. 26–28, 46–48 & n.3 (citing Ex. 1004 ¶¶ 41–42, Fig. 4).[6]

First, Patent Owner argues that Petitioner "assumes without explanation that the selection of a message from the Berger list would lead directly to Wren Figure 9B," but this would require "remov[ing] a key aspect of each reference: the Play button in Wren's Figure 9A and 'the message' referenced in Berger's paragraph 43." PO Resp. 25–29, 34–35 (arguing that without "use of the 'Play' button, there is no mechanism disclosed to launch . . . video playback software" or view text of the message in Petitioner's proposed combination). As explained above, Petitioner's proposed combination is premised on modifying Wren's method based on the teachings of Berger, not the reverse. Thus, to the extent Patent Owner contends that Petitioner must show a rationale for the reverse modification, we disagree. *See id.* at 21–22 (incorrectly asserting that "Petitioner is

[6] In its Reply, Petitioner provides a modified version of Figure 9A of Wren "to better visualize the combination described in the Petition." Reply 2. Notably, the modified figure removes certain text present in Figure 9A (e.g., "New Movie," "From:," "Time:," "Length: 5 minutes") and adds text from Figure 4 of Berger (e.g., "Messages," "George Smith") as well as entirely new text (e.g., "Joe Schmoe 8:11 AM," "Tyler Smith 2:57 AM") not present in either reference. *See id.* Although Petitioner explained generally in the Petition how a person of ordinary skill in the art would have combined the references' teachings, it did not discuss any of those specific modifications. For example, it is unclear why a person of ordinary skill in the art, when combining Wren with Berger to show multiple messages in a "message list," would keep some individual components of Figure 9A but remove others, as Petitioner contends. For purposes of this Decision, we do not rely on any of Petitioner's arguments or Dr. Chatterjee's testimony pertaining to the modified figure specifically. *See id.* at 2–3, 8–9; Ex. 1049 ¶¶ 6, 11; 37 C.F.R. § 42.23(b) (a reply "may only respond to arguments raised in the corresponding . . . patent owner response").

effectively arguing that it would have been obvious to modify Wren to display messages in a list as per Berger, *and* it would also have been obvious to modify Berger to play an attached or appended movie without displaying any header information when selecting a message from the Berger list"), 25–29, 33.

We also do not agree with Patent Owner that modifying Wren (based on the teachings of Berger) to display a "message list" would have required removing the "Play" button shown in Figure 9A. *See* Reply 8–9. Activating the "Play" button is a *selection* made by the recipient, and causes the transition from the screen shown in Figure 9A for a particular message to the screen shown in Figure 9B where the video for that message is displayed. *See* Ex. 1003 ¶ 32 (Figure 9B "shows a view of the Movie once the user *selects* play from a new message notification" (emphasis added)); Pet. 31–32 (explaining that the recipient device in Wren is able to "identify the movie message content that corresponds to the displayed header information"), 44–45 (arguing that Wren teaches a "selection" directed to what is shown in Figure 9A); PO Resp. 34 ("The Play button causes video playback software to be initiated on the user's computer that then operates to play back the transmitted video on the user's screen."). Similarly, Berger discloses the user making a "select[ion]" by moving a cursor and activating a button, or similar functionality:

> The user may then select (88) any of the messages for review by moving a cursor 132 up and down to reach the message of interest and then pressing the SEND button 134. A variety of other techniques could be used to enable the user to select a message, including a touchscreen or pointing device, available on some mobile devices.

Ex. 1004 ¶ 42; *see* Pet. 45–46. We are persuaded that a person of ordinary skill in the art reading Wren and Berger together would have extended the display of Figure 9A to multiple messages, and permitted the user to navigate between the messages and use the "Play" button to select one for display of an associated video, as Petitioner asserts.[7]

Second, Patent Owner argues in a number of places in its papers that Berger fails to teach displaying message content in response to a selection from a message list, as recited in claim 1. *See, e.g.*, PO Resp. 21 ("the Berger disclosure does not teach displaying only message content in response to the selection of a message from a message list"), 29–30 ("Berger does not disclose separate display of message content"); Sur-Reply 6. These arguments attacking Berger individually are not persuasive. *See In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) ("Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references."). Again, Petitioner's obviousness analysis is premised on a combination of Wren and Berger, where Wren's Figure 9A is modified to display a list of messages and permit selection of one of those messages for display as in

[7] Patent Owner argues that Petitioner's theory in this proceeding is inconsistent with an argument it made in Case IPR2018-00408 involving a related patent, specifically that in a combination of Wren, Berger, and Hanna, "pressing the 'Play' button on Figure 9A would activate the URL and retrieve the movie message content." PO Resp. 32–33 (quoting Ex. 2011, 59) (emphasis omitted); Sur-Reply 9. We do not view Petitioner's arguments as inconsistent, at least because the claim language being addressed in Case IPR2018-00408 pertained to the "second display" and what happens after it is provided (i.e., deletion of the message content), not a "first display" including a "message list," as recited in claim 1 of the '351 patent. *See* Ex. 2011, 58–59.

Figure 9B. We consider the references as a whole, but the fact that Berger lacks a feature taught by Wren does not mean automatically that the analysis is improper.

Third, Patent Owner argues that a person of ordinary skill in the art would have understood that "getting from a list of email messages (such as that depicted in Figure 4 of Berger) to playing media content attached to an email was at least a two-step process," and "Petitioner does not explain . . . why the selection of a message from a list would jump straight to playing an attachment to an email rather than displaying the email itself, in direct contradiction of both Wren and Berger." PO Resp. 33. Patent Owner contends that because Wren's Figure 1 only involves a single message,

> [i]f Wren's interface were implemented with another interface that provided a message list, then the recipient would have already selected the specific message from a list of messages before Figure 9A of Wren was displayed. In other words, two steps are still required after a message is selected from the Berger message list in both Berger and in Wren in order for message content to be displayed. In the case of Wren, the most logical progression would have been to display Figure 9A of Wren after a message is selected so that the information included in Figure 9A could be displayed consistent with the Wren (and Berger) teachings.

Sur-Reply 7. We disagree that the two-step process described by Patent Owner would have been the "most logical progression" for a person of ordinary skill in the art. To the contrary, as Petitioner correctly points out, Figures 9A and 9B of Wren "show[] a direct transition from the display of message header information (in Figure 9A) to the display of the video message content (in Figure 9B)." *See* Reply 10 (citing Ex. 1003 ¶ 32; Ex. 1049 ¶ 16). They also depict a mechanism for "select[ion]" by the user to move from one screen to a screen showing associated message content.

See Ex. 1003 ¶ 32. Petitioner's analysis, therefore, is consistent with Wren's disclosure.

Further, to the extent Patent Owner's argument is that a two-step process would have been preferable over Petitioner's proposed combination, *In re Fulton*, 391 F.3d 1195 (Fed. Cir. 2004), is instructive. *See* Reply 11 n.4. In that case, the applicant argued that the record before the Board was insufficient to establish that the features of the relied upon reference "are preferred over other alternatives disclosed in the prior art." *Fulton*, 391 F.3d at 1200. Our reviewing court held that "[t]his argument fails because our case law does not require that a particular combination must be the preferred, or the most desirable, combination described in the prior art in order to provide motivation for the current invention." *Id.* As such, we are tasked with determining "'whether there is something in the prior art as a whole to suggest the *desirability*, and thus the obviousness, of making the combination,' not whether there is something in the prior art as a whole to suggest that the combination is the *most desirable* combination available." *Id.* (quoting *In re Beattie*, 974 F.2d 1309, 1311 (Fed. Cir. 1992)).

We find that the combination of Wren and Berger teaches the response limitation of claim 1.

b. Unique Message ID Limitation

Patent Owner argues that the combination of Wren and Berger does not teach a "unique message ID that correlates the first message content including the media component with the first header information" (the "unique message ID" limitation). PO Resp. 36–39 (citing Ex. 2009 ¶¶ 52, 69); Sur-Reply 16–19. Patent Owner points out that when the user selects a

particular email message in Berger, the phone retrieves "the entire email message" (i.e., both message content and header information), not just message content. PO Resp. 37–39. Thus, the alleged "unique message ID" in Berger (i.e., message number, message number and user ID, or cryptographic hash value included in the URL) does not correlate "first message content" with "first header information" according to Patent Owner. *Id.* Patent Owner further argues that the Specification of the '351 patent "makes clear that a message ID is used when the header information and message content are stored separately." Sur-Reply 17–18 (citing Ex. 1001, col. 7, ll. 64–66, col. 13, ll. 19–21).

Patent Owner's arguments are not commensurate with the scope of the claim. Claim 1 requires only that the first message content be associated with a "unique message ID that correlates the first message content including the media component with the first header information." The claim does not include any further limitations with respect to the "unique message ID" or how it is applied. Nor is there any language in the claim requiring that the first message content and first header information be stored or transmitted separately; claim 1 only requires that they be "receiv[ed] at [the] recipient user device." Indeed, dependent claim 12 recites that the first header information and first message content are communicated over a network "separately."[8] Dependent claim 16 also recites that the media component and first header information are "kept separated during communication from the server computer to the recipient

[8] Petitioner challenges claim 12 in a different ground addressed below, relying on a combination with Hanna for the separate transmission limitation. *See infra* Section II.F.

user device." The presence of these limitations requiring separate transmission supports Petitioner's view that there is no such requirement in claim 1. *See* Reply 15–16; *Nazomi Comm'cns, Inc. v. ARM Holdings, PLC*, 403 F.3d 1364, 1370 (Fed. Cir. 2005) ("The concept of claim differentiation 'normally means that limitations stated in dependent claims are not to be read into the independent claim from which they depend.'" (citation omitted)). Further, the parties agree that claim 1 does not require the "unique message ID" to *only* be associated with the first message content. *See* Reply 15 n.5; Sur-Reply 17. Rather, the "unique message ID" correlates the first message content with the first header information, and in that way is associated with both.

Regardless, though, Petitioner's position is that the combination of Wren and Berger, not Berger alone, teaches the unique message ID limitation. *See* Pet. 30–44 ("This limitation is . . . satisfied by Wren in combination with Berger." (emphases omitted)). Petitioner relies on Wren as teaching both "first header information" (i.e., sender identification and time) and "first message content that includes a media component" (i.e., video shown in Figure 9B), and argues that they are correlated with each other in Wren because the recipient device transitions from the screen shown in Figure 9A to the screen shown in Figure 9B when the user selects "Play." *Id.* at 24, 30–32. According to Petitioner and Dr. Chatterjee, a person of ordinary skill in the art would have understood from that transition that "the movie message content would have been correlated with the header information so the phone could identify the movie message content that corresponds to the displayed header information." *Id.* at 32 (citing Ex. 1002 ¶ 67).

Wren, however, does not disclose using a "unique message ID" to achieve that correlation. *Id.* Petitioner argues that doing so would have been obvious based on a combination with Berger, which teaches a message number for a message being displayed with header information for the message and included in the URL used to retrieve the message. *Id.* at 32–39; *see, e.g.*, Ex. 1004 ¶¶ 52–53 (disclosing that "the message server must have a way to 'remember' . . . which message the user wants to access," and one way to do so is to "embed, in the URLs included in the list provided from the server to the browser, the information needed to . . . identify the desired message," where "[t]he server knows the user's ID and the message identifier when it assembles the list to be sent to the browser"). Thus, as argued by Petitioner, the combination of Wren and Berger

> would have predictably resulted in the mobile phone user interface of Wren (as shown in Figure 9A and Figure 9B) in which the movie message content is associated with a unique message ID (such as the message number or hash in Berger) that correlates the movie content (as shown in Figure 9B) with the message header information (as shown in Figure 9A).

Pet. 39 (citing Ex. 1002 ¶ 77). Further, when displaying multiple messages in a list in the proposed combination, there would "need[] to be some way to connect each of the header information shown in the message list with the underlying message content," and it would have been obvious to use a "unique message ID" like the message number in Berger "to allow the recipient device in Wren to retrieve the movie message content that corresponds to the selected header information." *Id.* at 40 (citing Ex. 1002 ¶ 79).

We agree with Petitioner and Dr. Chatterjee that Wren teaches correlating "first header information" and "first message content that

includes a media component" but does not disclose the specific mechanism for doing so, Berger teaches one such mechanism as a "unique message ID" included in a URL, and a person of ordinary skill in the art would have been motivated to modify Wren's method based on Berger to use a "unique message ID." Patent Owner's arguments based on the fact that Berger alone retrieves the entire message using the alleged "unique message ID" do not address the combined teachings of Wren and Berger as asserted by Petitioner and are not persuasive. We find that the combination of Wren and Berger teaches the unique message ID limitation of claim 1.

c. Conclusion

For the reasons set forth by Petitioner and explained above, we are persuaded that Wren, Berger, and Thorne collectively teach all of the limitations of claim 1, and that a person of ordinary skill in the art would have had reason to combine the references' teachings to achieve the method recited in the claim and would have had a reasonable expectation of success in doing so. Petitioner has proven, by a preponderance of the evidence, that claim 1 would have been obvious based on Wren, Berger, and Thorne under 35 U.S.C. § 103(a).

5. Claims 5, 6, and 11

Claims 5, 6, and 11 depend from claim 1. Petitioner explains how the limitations of dependent claims 5, 6, and 11 are taught by the combination of Wren, Berger, and Thorne, with supporting testimony from Dr. Chatterjee. *See* Pet. 53–56; Ex. 1002 ¶¶ 97–105. Claim 5 recites that "the recipient user device is a device selected from the group consisting of a personal computer,

a workstation computer, a server computer, a laptop computer, a handheld device, a mobile telephone, a personal digital assistant, and any combinations thereof." Petitioner argues that Wren teaches a "mobile telephone" as the recipient device. Pet. 53 (citing Ex. 1003 ¶ 22). Claim 6 recites that "the media component includes information selected from the group consisting of an image, video, audio, and any combinations thereof." Petitioner argues that Wren teaches a movie message containing "video" and "audio." *Id.* (citing Ex. 1003 ¶ 8). Claim 11 recites that "providing a first display includes displaying information representing electronic messages available for viewing." Petitioner argues that in the combination of Wren and Berger described above for claim 1, the first display would include header information in a message list representing "actual electronic messages that can be viewed upon user selection." *Id.* at 53–56 (citing Ex. 1002 ¶ 103). Patent Owner does not argue separately dependent claims 5, 6, and 11 in its Response. PO Resp. 20–39. We have reviewed Petitioner's contentions and supporting evidence, including the testimony of Dr. Chatterjee, and are persuaded that Petitioner has proven, by a preponderance of the evidence, that dependent claims 5, 6, and 11 would have been obvious based on Wren, Berger, and Thorne under 35 U.S.C. § 103(a), for the reasons stated by Petitioner.

E. Obviousness Ground Based on Wren, Berger, Thorne, and Hartselle (Claim 9)

Petitioner contends that claim 9 is unpatentable over Wren, Berger, Thorne, and Hartselle under 35 U.S.C. § 103(a). Pet. 56–60. Claim 9 depends from claim 1, and recites that "providing a second display includes

preventing screenshot logging at the recipient user device from capturing the media component and the first header information simultaneously." Petitioner argues that because the screen shown in Figure 9B of Wren does not include any header information, any "screenshot logging" would not capture header information. *Id.* at 56–58. Additionally, Petitioner relies on Hartselle's teaching of preventing *all* screenshot logging when using a messaging application. *Id.* at 58 (citing Ex. 1014, col. 7, ll. 6–10, col. 9, l. 67–col. 10, l. 7). Petitioner argues that a person of ordinary skill in the art would have been motivated to prevent screenshot logging, for example, to "improve the confidentiality of movie messages received using . . . Wren's system." *Id.* at 58–60 (citing Ex. 1014, col. 1, ll. 24–37, 56–61; Ex. 1002 ¶¶ 111–114). Patent Owner does not argue separately dependent claim 9 in its Response, only disputing Petitioner's contentions with respect to parent claim 1. PO Resp. 39–40. We have reviewed Petitioner's contentions and supporting evidence, including the testimony of Dr. Chatterjee, and are persuaded that Petitioner has proven, by a preponderance of the evidence, that dependent claim 9 would have been obvious based on Wren, Berger, Thorne, and Hartselle under 35 U.S.C. § 103(a), for the reasons stated by Petitioner.

F. Obviousness Ground Based on Wren, Berger, Thorne, and Hanna (Claim 12)

Petitioner contends that claim 12 is unpatentable over Wren, Berger, Thorne, and Hanna under 35 U.S.C. § 103(a). Pet. 60–72. Claim 12 depends from claim 1, and recites that "the first header information and the first message content are received at the recipient user device via a network,

wherein the first header information and the first message content are communicated over the network separately."

Petitioner argues that the recipient device in Wren receives "first header information" (i.e., sender identification and time) and "first message content that includes a media component" (i.e., video shown in Figure 9B) via a "network" (e.g., the Internet), but acknowledges that "Wren does not disclose the detailed mechanics of how the movie message . . . is transmitted from the server to the recipient's mobile phone." *Id.* at 60–61. Petitioner thus relies on both Berger and Hanna as teaching the recited separate transmission, including arguments with respect to both references. *Id.* at 61–66. We agree with Petitioner with respect to combining the teachings of Hanna with those of the other references discussed above in connection with parent claim 1, and therefore, need not address Petitioner's additional arguments regarding Berger.

Hanna teaches a system that replaces the file attachment in an email message with a URL to the file on a server, where the recipient then uses the URL to retrieve the file. *Id.* at 62 (citing Ex. 1005, col. 2, ll. 3–5, 55–57, col. 5, ll. 1–12, 26–28, 39–40, 57–66). Petitioner contends that, based on the combined teachings of the references,

> the header information in Wren (such as the sender name and date/time shown in Figure 9A) [would be] sent separately from the message content (the movie message shown in Figure 9B). This is because a message is initially sent from the server to the recipient device that does not include an attachment containing the movie message content – that message instead includes only the header information and a URL as disclosed in . . . Hanna, the URL identifying the location of the movie message content on a server. The recipient's mobile phone can later retrieve the movie message content (as shown in Figure 9B of Wren) from the

> server using the URL in a separate transmission according to the technique[] of . . . Hanna. Under this scenario, therefore, the header information is communicated separately from the movie message content.

Id. at 63 (emphases omitted). Petitioner argues that a person of ordinary skill in the art would have been motivated to make such a combination, for example, to provide better message tracking, asserting that "Hanna explains that its technique of replacing an email attachment with a URL prior to delivery provides superior message tracking because the system can log the recipient's request to retrieve the message content stored on the server, thus providing proof of receipt." *Id.* at 66–72 (citing Ex. 1002 ¶ 127; Ex. 1005, col. 6, ll. 1–5). Petitioner's arguments regarding the asserted combination with Hanna are supported by the testimony of Dr. Chatterjee. *See, e.g.*, Ex. 1002 ¶¶ 118, 120, 124–136.

Patent Owner responds that the asserted combination does not teach the limitation that "the first header information and the first message content are communicated over the network separately" (the "separate transmission" limitation) because "the email message including a publicly-accessible URL link to media content falls within the scope of 'message content' under the proper construction of that term." PO Resp. 40–51 (citing Ex. 2009 ¶¶ 52, 61, 73–75, 77–79, 81, 83–84); Sur-Reply 20–23. In other words, "[t]ransmitting a public URL *to the linked file* does not transmit the header information and message content separately" according to Patent Owner. Sur-Reply 21. As explained above, however, we disagree with Patent Owner's proposed interpretation of "message content that includes a media component" and instead interpret the term to exclude a URL in a message (linking to content accessible via that URL). *See supra* Section II.A. Thus,

per our interpretation, Hanna's URL is not message content, but an identifier that provides access to message content that is stored elsewhere (i.e., on a server) and would be transmitted separately from the header information in Petitioner's proposed combination.

Patent Owner also challenges certain aspects of Dr. Chatterjee's testimony. First, Patent Owner argues that Dr. Chatterjee is "internally inconsistent" in (1) opining that message content is transmitted separately in the proposed combination because Hanna's linked file is stored on a server and transmitted separately, and also (2) testifying during cross-examination that the linked file is not "part of that message that's being sent." PO Resp. 42–43 (citing Ex. 2012, 87:22–88:24, 92:7–13) (emphasis omitted).
We disagree. Reading Dr. Chatterjee's cross-examination statements in context with the surrounding testimony, it is clear that he was referring to Hanna's teaching of storing the file on a server and sending a URL so that the user may access it later (as opposed to sending the file itself), which is consistent with his declaration testimony about the asserted combination. *See, e.g.*, Ex. 2012, 87:22–88:4 ("[W]hat Hanna does is that it tears off the attachment, stores it, and then sends the email with the URL in it. It doesn't send that file that it tore off."), 90:2–13 ("[The linked file is] not being transmitted. That's the whole purpose of Hanna, that it's saying that I'm going to chop the attachment off, put it somewhere else, put a URL to where I put it, and then send the message on. So I think Hanna makes it pretty clear that that thing that it chopped off is not also being sent again. It's being chopped off and put somewhere into a server somewhere."), 91:11–92:15 (agreeing that "Hanna describes replacing that attachment with

a URL link to that attachment on the server"); Ex. 1002 ¶¶ 118, 120; Ex. 1049 ¶¶ 23–24.

Second, Patent Owner argues that "Dr. Chatterjee's opinion that the separate transmission limitation covers transmission of an email with a publicly-accessible link to a video such that the entirety of the email is accessible from a single interception eliminates the fundamental purpose of the claimed invention and simply cannot be correct." PO Resp. 45 (citing Ex. 2012, 96:4–17); Sur-Reply 20 (arguing that "providing a hyper-link to a file allows a hacker to access the file merely by clicking on that link"). Petitioner responds by asserting that "this 'purpose' is nowhere recited in the claim." Reply 20. We agree. The Specification of the '351 patent describes systems and methods for reducing traceability of an electronic message, but claim 12 does not include any express limitation regarding reduced "traceability." *See*, *e.g.*, Ex. 1001, col. 3, ll. 48–49. In addition, none of the challenged claims mention traceability at all. The only references to traceability are in claim 3, not challenged in this proceeding, which recites not including information that would provide "a traceable identity of the sender," and claim 18, also not challenged in this proceeding, which recites "[a] system for reducing traceability of an electronic message" in the preamble. Further, even if claim 12 included the "purpose" alleged by Patent Owner, Hanna "disclose[s] specific protections against unauthorized access of message content through a URL." *See* Reply 20–21; Ex. 1049 ¶ 29; Ex. 1005, col. 5, ll. 62–67 (explaining that user authentication, via "any of a number of authentication mechanisms, such as a password, a shared secret, public key cryptography and/or digital certificates," may be required before the user can receive the attachment referenced by the URL).

For the foregoing reasons, we are persuaded by Petitioner's argument, supported by evidence in the record, that the combination of Wren, Berger, Thorne, and Hanna teaches the separate transmission limitation of claim 12. We have reviewed Petitioner's contentions and supporting evidence, including the testimony of Dr. Chatterjee, and are persuaded that Petitioner has proven, by a preponderance of the evidence, that dependent claim 12 would have been obvious based on Wren, Berger, Thorne, and Hanna under 35 U.S.C. § 103(a), for the reasons stated by Petitioner.

III. ORDER

Petitioner has demonstrated, by a preponderance of the evidence, that claims 1, 5, 6, and 11 are unpatentable over Wren, Berger, and Thorne, that claim 9 is unpatentable over Wren, Berger, Thorne, and Hartselle, and that claim 12 is unpatentable over Wren, Berger, Thorne, and Hanna, under 35 U.S.C. § 103(a).

In consideration of the foregoing, it is hereby:

ORDERED that claims 1, 5, 6, 9, 11, and 12 of the '351 patent have been shown to be unpatentable.

This is a final decision. Parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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