

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.,
Petitioner,

v.

PALO ALTO RESEARCH CENTER INC.,
Patent Owner.

IPR2021-01294
Patent 8,489,599 B2

Before KARL D. EASTHOM, SHEILA F. McSHANE, and
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

McSHANE, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Facebook, Inc. (“Petitioner” or “Facebook”) filed a Petition for *inter partes* review of claims 1, 4, 6, 7, 9–12, 15, 17–19, 22, 24, and 25 of U.S. Patent No. 8,489,599 B2 (Ex. 1001, “the ’599 patent”), along with the Declaration of Christopher M. Schmandt. Paper 2 (“Pet.”); Ex. 1002. Palo Alto Research Center Inc. (“Patent Owner”)¹ filed a Preliminary Response. Paper 12 (“Prelim. Resp.”). Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (2018). Upon consideration of the Petition, the Preliminary Response, and the evidence of record, we determine that Petitioner has established a reasonable likelihood of prevailing with respect to the unpatentability of at least one claim of the ’599 patent. Accordingly, for the reasons that follow, we institute an *inter partes* review of claims 1, 4, 6, 7, 9–12, 15, 17–19, 22, 24, and 25 of the ’599 patent.

A. Related Matters

The parties indicate this Petition is related to the district court litigations *Palo Alto Research Center Inc. v. Facebook, Inc.*, No. 2:20-CV-10753-AB-MRW (C.D. Cal.), *Palo Alto Research Center Inc. v. Snap Inc.*, No. 2:20-CV-10755-AB-MRW (C.D. Cal.), and *Palo Alto Research Center*

¹ Patent Owner states that Palo Alto Research Center Inc. is a wholly owned subsidiary of Xerox Corporation, and Xerox Corporation is a wholly owned subsidiary of Xerox Holdings Corporation. Paper 4, 2.

Inc. v. Twitter, Inc., No. 2:20-CV-10754-AB-MRW (C.D. Cal.). Pet. 1; Paper 4, 2–3.

B. The '599 Patent

The '599 patent is titled “Context And Activity-Driven Content Delivery And Interaction” and issued on July 16, 2013, from an application filed on December 2, 2008. Ex. 1001, codes (22), (45), (54).

The '599 patent is directed to “a computing device that delivers personally-defined context-based content to a user.” Ex. 1001, code (57).

The '599 patent states that

[t]his computing device receives a set of contextual information with respect to the user, and processes the contextual information to determine whether some aspect of the current context can be associated with a probable activity being performed by the user. The computing device then determines whether either or both the context and current activity of the user satisfy a trigger condition which has been previously defined by the user. If so, the computing device selects content from a content database, based on the context or activity, to present to the user, and presents the selected content.

Ex. 1001, 1:52–62. Figure 1, reproduced below, illustrates a content management system in accordance with the invention. *Id.* at 2:54–55.

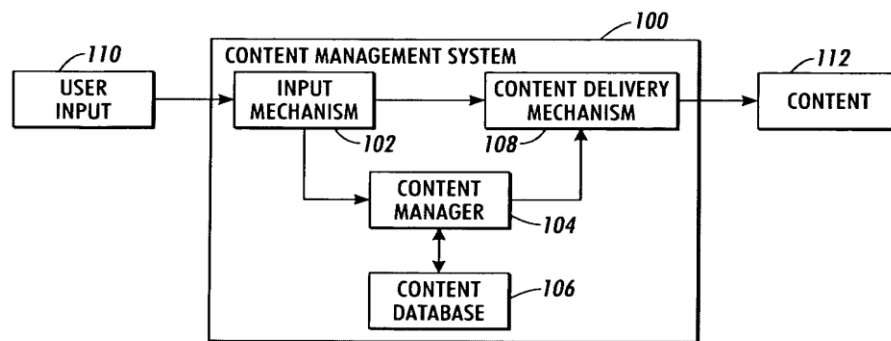


FIG. 1

As depicted in Figure 1, above, content management system 100 presents content 112 to a user. Ex. 1001, 5:18–19. Content 112 can be presented in response to actions being performed by the user, or in accordance with other information associated with the user. *Id.* at 5:18–21. Content management system 100 allows a user to create and store content, and associate the content with a given user-defined context. *Id.* at 5:21–23. For instance, content management system 100 can remind a user to buy groceries as the user is driving past a grocery store after work or can read specific items on a grocery list to a user when walking across a specific grocery store aisle. *Id.* at 5:28–32. Input mechanism 102 receives user input 101, content manager 104 controls how content 112 is stored in content database 106 and how it is selected for playback, and content delivery mechanism 108 controls how content 112 is presented to a user. *Id.* at 5:36–57.

C. Illustrative Claim

Petitioner challenges claims 1, 4, 6, 7, 9–12, 15, 17–19, 22, 24, and 25 of the '599 patent. Claims 1, 12, and 19 are the only independent claims,

and claim 1, which is illustrative, is reproduced below, with bracketed letters added to the limitations for reference purposes.

1. A method for delivering context-based content to a first user, the method comprising:

- [a] receiving at least one content package, wherein the content package includes at least one content piece and a set of rules associated with the content package, wherein the set of rules includes a trigger condition and an expected response, and wherein the trigger condition specifies a context that triggers a presentation of the content piece;
- [b] receiving a set of contextual information with respect to the first user;
- [c] processing the contextual information to determine a current context for the first user;
- [d] determining whether the current context satisfies the trigger condition;
- [e] in response to the trigger condition being satisfied, presenting the content piece to the first user;
- [f] receiving a response from the first user corresponding to the presented content piece;
- [g] determining whether the received response matches the expected response; and
- [h] performing an action based on an outcome of the determination.

Ex. 1001, 23:20–41.

D. Asserted Grounds of Unpatentability

Petitioner asserts that claims 1, 4, 6, 7, 9–12, 15, 17–19, 22, 24, and 25 are unpatentable based on the following grounds:

Claim(s) Challenged	35 U.S.C §	Reference(s)/Basis
1, 4, 6, 7, 10–12, 15, 17–19, 22, 24, 25	103(a) ²	Lamont ³ , Wolfe ⁴ , Wang ⁵
9	103(a)	Lamont, Wolfe, Wang, Belimpasakis ⁶
1, 4, 6, 7, 10–12, 15, 17–19, 22, 24, 25	103(a)	Lamont , Wolfe , Wang, Meyers ⁷
9	103(a)	Lamont , Wolfe , Wang, Belimpasakis, Meyers

Pet. 3.

II. DISCRETIONARY DENIAL

Patent Owner requests that the Board exercise its discretion pursuant to 35 U.S.C. § 314(a) and deny institution. Prelim. Resp. 10–14. Patent Owner urges that institution should be denied based on the factors identified in *General Plastic. Id.; Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i, pages 15–19) (“*General Plastic*”).

² The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. § 103, and was effective on March 16, 2013. Because the ’599 patent has a filing date before the effective date of the applicable AIA amendments, we refer to the pre-AIA versions of 35 U.S.C. § 103.

³ US 7.652,594 B2, filed April 7, 2006, issued January 26, 2010 (Ex. 1003, “Lamont”).

⁴ US 8,428,614 B2, filed July 10, 2007, issued April 23, 2013 (Ex. 1004, “Wolfe”).

⁵ Wallace Wang, BEGINNING PROGRAMMING FOR DUMMIES, 1999 (Ex. 1006, “Wang”).

⁶ US 9,467,530 B2, filed April 11, 2006, issued October 11, 2016 (Ex. 1007, “Belimpasakis”).

⁷ Scott Meyers, THE DOWNLOADER’S COMPANION FOR WINDOWS, 1995 (Ex. 1008, “Meyers”).

As background, *General Plastic* identifies factors to be considered by the Board in evaluating whether to exercise discretion, under § 314(a), to deny a petition that challenges a patent that was previously challenged before the Board, which are:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;
4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and
7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

Gen. Plastic, Paper 19 at 15–16; *see also* Consolidated Trial Practice Guide, 56–58.⁸

Petitioner argues that there is no basis under § 314 for discretionary denial because (1) Petitioner acted diligently in filing the Petition; (2) there has been no significant progress in the District Court litigation; (3) Petitioner will not pursue invalidity of the '599 patent in the litigation based on any instituted ground in this proceeding; and (4) the case has been stayed in

⁸ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

accordance with the parties' joint stipulation. Pet. 4. Petitioner does not specifically address the *General Plastic* factors. *See id.*

Patent Owner argues that although the Petitioner here, Facebook, had not previously filed a petition directed to the claims challenged here when the current Petition had been filed, Snap, Inc. had filed a petition challenging the same claims. Prelim. Resp. 12 (referring to IPR2021-00987). Patent Owner contends that "Facebook and Snap (and Twitter) coordinated their invalidity contention work and served overlapping invalidity contentions in the parallel district court cases." *Id.* (citing Exs. 2003–2005). Patent Owner asserts that "Snap and Facebook knew, or should have known, about the prior art the other asserts in their respective petitions because of . . . Facebook's, Snap's, and Twitter's pre-trial coordination by at least the May 7, 2021 Joint Scheduling Conference." *Id.* at 13 (citing Ex. 2006). Patent Owner further argues that Petitioner had two months prior to the filing of its Petition to review Snap's petition. *Id.*

Patent Owner further contends that Petitioner fails to make any showing under the *General Plastic* factors. Prelim. Resp. 13. More specifically, Patent Owner argues that Petitioner has not shown that it did not know of the alleged prior art in its Petition at the time of Snap's petition filing on May 21, 2021, or that Petitioner only recently learned of its asserted prior art. *Id.* Patent Owner asserts that "[i]ndeed, it seems likely that Facebook knew of the alleged prior art by May 21, 2021, given that Facebook, Snap, and Twitter served their coordinated invalidity contentions." *Id.* Patent Owner additionally contends that Petitioner provides no explanation for the two month delay in filing this Petition after the filing of the Snap petition, nor why this Petition warrants the use of the Board's finite resources. *Id.* at 13–14.

General Plastic, a precedential decision, applied to an instance where a party filed initial petitions asserting certain art, preliminary responses were filed, and the Board denied institution on the earlier petitions. *Gen. Plastic* at 6, 10. The same party then filed follow-on petitions challenging the same patents and used the information provided in the previous filings as a roadmap for the later petitions. *Id.* at 17–18. Here, Petitioner Facebook has not previously filed any petitions challenging the ’599 patent. The Board’s precedential decisions using *General Plastic* factors recognize a discrete circumstance that is not limited to instances where multiple petitions are filed by the same petitioner. In *Valve*, the Board found that there was a significant relationship between a petitioner and a previous petitioner because they had been co-defendants in a district court litigation, both were sued on the same products, and there was a license agreement between the parties related to the technology of the product. *Valve Corp. v. Elec. Scripting Prods., Inc.*, Case IPR2019-00062, -00063, -00084 (PTAB Apr. 2, 2019) (Paper 11, 9–10) (precedential) (“*Valve*”). Due to the significant relationship between the prior petitioner and the petitioner at issue, *Valve* applied the *General Plastic* factors. *Id.* at 9–10.

In this case, Patent Owner’s arguments do not persuade us to discretionarily deny institution of review. Patent Owner does not explain sufficiently why the rationale of *General Plastic* extends to the situation here. Facebook has not previously been a petitioner as to the ’599 patent. Although both Facebook and Snap have both been sued by Patent Owner, and it appears that the parties have coordinated some activities in the respective district court litigations such as preparation of a scheduling conference report and invalidity contentions, there is no evidence on the preliminary record that the infringement allegations concern the same

products nor that there are licensing agreements between the parties. *See* Exs. 2003–2006. Accordingly, we do not find that the evidence indicates that there is a significant relationship between the parties that is similar to that found in *Valve*.

Application of the *General Plastic* factors would also not persuade us to exercise discretionary denial in this proceeding. Because Petitioner has not challenged the '599 patent in previous petitions and we do not find that there is a significant relationship between Petitioner and Snap, factor 1 weighs against the exercise of discretionary discretion. Likewise under factor 2, “whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it,” is of little probative value—Facebook did not file the first petition and we do not find there is a significant relationship between Petitioner and Snap, so the issue of whether Petitioner could have raised the prior art at issue here in the first petition is not relevant. *Gen. Plastic* at 19–20. As to factor 3, there had been no preliminary response filed or Board decision issued for the first petition when the instant Facebook Petition was filed on July 20, 2021, so no issues arise relative to this factor that indicate that Facebook could have engaged in strategic road-mapping. *Id.* at 17.

Patent Owner argues that factors 4 and 5 favor discretionary denial of institution because Petitioner was likely aware of the prior art asserted here by May 21, 2021, and Petitioner also has not provided an explanation for the time elapsed between the filings of the respective petitions. *Prelim. Resp.* 13–14. The evidence indicates that Petitioner was aware of the primary prior art asserted in the instant Petition, i.e. Lamont, Wolfe, Wang, Belimpasakis, and Meyers, by at least the time of the filing of its initial invalidity contentions in the district court proceeding on June 15, 2021. *Ex.*

2003. But even if Petitioner were aware of that prior art by May 21, 2021, as Patent Owner asserts, we nevertheless do not discern that the two month time gap before the filing the instant Petition reflects an unreasonable delay in view of time required for the preparation of a petition.

Under factors 6 and 7, we do not discern that the institution of this proceeding would tax unduly the resources of the Board or that we could not meet the requirement of 35 U.S.C. § 316(a)(11) to issue a final determination within one year after institution, so those factors do not provide support for discretionary denial.

Accordingly, considering all the *General Plastic* factors, we decline to exercise our discretion to deny institution.

Additionally, Petitioner later filed another petition, Case IPR2021-1536, on September 20, 2021, requesting institution of *inter partes* review of the '599 patent. Petitioner filed a "Statement Re Multiple IPR Petitions" (Paper 9) with its explanation of the circumstances as to why there is a need justifying more than one petition. Patent Owner disputes the need for more than one petition. Prelim. Resp. 22–23. For the reasons discussed below, we institute *inter partes* review of the instant earlier-filed Petition here, and we will address the issue of the need for multiple petitions in the later-filed IPR2021-1536 case.

III. ANALYSIS

A. *Level of Ordinary Skill in the Art*

Relying on the testimony of Mr. Schmandt, Petitioner proposes that a person of ordinary skill in the art at the time of the '599 patent would have possessed "at least a bachelor's degree in electrical engineering or computer science, and two years of work experience in multimedia data

communications and user interfaces.” Pet. 5 (citing Ex. 1002 ¶¶ 17–22). Petitioner further asserts that additional education, but less work experience, and vice versa may also qualify. *Id.* Patent Owner presents no proposed qualifications. *See generally* Prelim. Resp.

In determining the level of ordinary skill in the art, various factors may be considered, including the “type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.” *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (citation omitted). The level of ordinary skill in the art is also reflected by the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001). For purposes of this Decision, we adopt the assessment offered by Petitioner as it is consistent with the ’599 patent and the asserted prior art.

B. Claim Construction

In this *inter partes* review, claims are construed using the same claim construction standard that would be used to construe the claims in a civil action under 35 U.S.C. § 282(b). 37 C.F.R. § 42.100(b) (2021). Under the principles set forth by our reviewing court, the “words of a claim ‘are generally given their ordinary and customary meaning,’” as would be understood by a person of ordinary skill in the art in question at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)). “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*, 415 F.3d at 1312–17).

Petitioner asserts that no express constructions of any claim terms are required to assess the prior art under the Petition’s challenges. Pet. 6. Patent Owner does not present any proposed claim constructions. *See generally* Prelim. Resp.

We determine that we need not expressly construe any claim terms to resolve the parties’ disputes on the current record. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“[W]e need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

C. Principles of Law

A patent claim is unpatentable under 35 U.S.C. § 103 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.” 35 U.S.C. § 103 (2006); *see also KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) when in evidence, objective indicia of obviousness or nonobviousness⁹. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

⁹ No evidence of objective indicia are presented in the Petition or in Patent Owner’s Preliminary Response. *See generally* Petition, Prelim. Resp.

D. Asserted Obviousness of Claims 1, 4, 6, 7, 10–12, 15, 17–19, 22, 24, and 25 Over Lamont, Wolfe, and Wang

Petitioner contends that claims 1, 4, 6, 7, 10–12, 15, 17–19, 22, 24, and 25 are unpatentable under 35 U.S.C. § 103 as obvious over Lamont, Wolfe, and Wang. Pet. 10–56. In support, Petitioner also relies upon the Schmandt Declaration. Ex. 1002. Patent Owner argues that the prior art does not teach all the limitations of the claims and insufficient rationale to combine the references has been provided. Prelim. Resp. 14–22.

We begin our discussion with brief summaries of Lamont, Wolfe, and Wang, and then address the evidence and arguments presented.

1. Lamont (Ex. 1003)

Lamont discloses a system to construct a software-based tour “of a village, town, city, region or country employing locationally-sensitive information.” Ex. 1003, 1:16–19, 1:44–49. Lamont’s software architecture enables a designer “to create, edit, manage, and organize a matrix of trigger points that are situated in geographical space and are tagged with dynamic content” which are relay to a mobile device. *Id.* at 1:44–49. More specifically, the “tour script” contains “trigger points,” that specify a particular geographical space and the conditions for presenting particular audio and/or visual content to the user. *Id.* at 2:1–6, 3:38–48. The conditions can include, for instance, a user location, direction, and velocity, as well as the time of day. *Id.* at 4:4–13, 14:56–62, 17:15–18. Content, including media clips, are presented to the user if the trigger point conditions are satisfied. *Id.* at 2:24–29, 4:4–13, 5:18–20, 14:29–37. Lamont’s system, with its tour guide, may be used, for instance, for “an automated guided tour, a treasure hunt, a real estate tour, architectural overview, a line of

approach/instruction for trainee pilots, and distribution of targeted sales and marketing information.” *Id.* at 2:27–29.

2. *Wolfe* (Ex. 1004)

Wolfe is directed to “a location-based mobile phone application for providing a treasure hunt game consisting of puzzles solved at specific physical locations.” Ex. 1004, 1:14–16. A mobile phone provides location data to a server, which then may provide puzzle information to a mobile phone based on the mobile phone’s location and/or orientation. *Id.* at 3:35. For instance, there may be hints or clues provided to assist a user in finding an object or treasure in or around the user’s location such as a monument. *Id.* at 3:35–37. In Wolfe, the system may provide a puzzle challenge or question to the user to verify that a site, object, or treasure has been found. *Id.* at 3:32–39. Figure 4F and 4G, reproduced below, show screenshots of a mobile phone device.

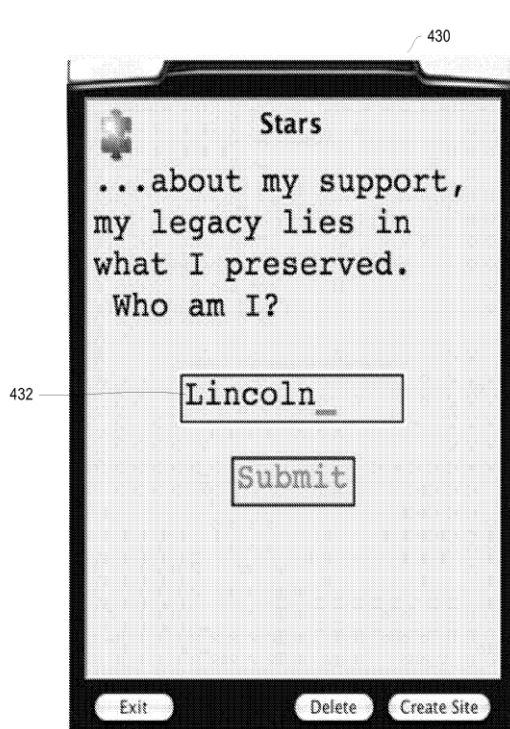


FIG. 4F

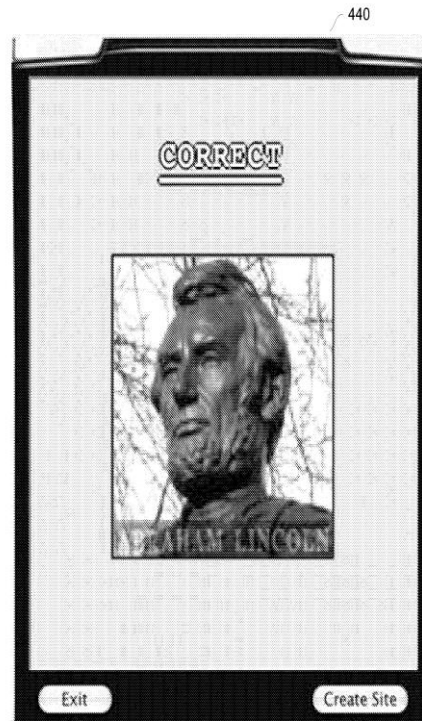


FIG. 4G

As shown in Figure 4G, above, the mobile phone screen includes a question presented to the user (e.g. “Who am I?”) and receiving the user’s correct response (“Lincoln”), results in the display shown in Figure 4G. Ex. 1004, 5:50–56.

3. Wang (Ex. 1006)

Wang is a book that is an introductory guide about computer programming. Ex. 1006, 14–17. Wang includes a description of how computers evaluate Boolean expressions. *Id.* at 23–40.

4. Discussion

a. Claim 1

The Petition asserts that Lamont, Wolfe, and Wang render claim 1 obvious. Pet. 10–42. Below we consider the claim 1 limitations in turn.

i. Preamble and Limitations 1[a], 1[b], 1[c]

For the teachings of the preamble, Petitioner asserts that Lamont discloses a method for delivering context-based content to a first user because Lamont discloses a tour script that is used for a guided tour that can deliver context-based content to a user. Pet. 10–11 (citing Ex. 1003, 1:17–19, 2:67–3:6). Petitioner asserts that Lamont teaches several types of context information including user location and “direction, temporal state, velocity, rate of incline or decline, or any other variable.” *Id.* at 11 (citing Ex. 1003, 2:12–14, 4:58–61, 4:66–5:2, 5:18–19).

For limitation 1[a], Petitioner contends that Lamont’s “content package” consists of a tour guide and the audio and/or visual content associated with the tour script. Pet. 12–15. Petitioner asserts that Lamont discloses “a set of rules associated with the content package” by its disclosure of trigger points in the tour guide which may contain certain conditions. *Id.* at 15–17. Petitioner asserts that the claimed trigger condition is a trigger point, with conditions (context) associated with the trigger point “such as direction, time, velocity, as explained, which trigger presentation of the content.” *Id.* at 18 (citing Ex. 1003, 2:67–3:6, 17:15–18; Ex. 1002 ¶ 92). Petitioner refers to Lamont’s disclosure that trigger points may be grouped together that are assessed using Boolean operators to determine if a preset string of conditions has been met as an example of “rules.” *Id.* at 16–17 (citing Ex. 1002 ¶ 90; Ex. 1003, 3:65–4:13, 17:15–18). Petitioner further refers to a “content piece,” such as safety and directional information, for instance, which is presented upon a trigger. *Id.* at 14–15 (citing Ex. 1003, 5:5–7 (referring, e.g., to “Media List: City Hall”)).

Petitioner further contends that Lamont discloses the ability to receive feedback from the user and to respond to that feedback, but Lamont does not

provide detail regarding the feedback type a user can provide. Pet. 18 (citing Ex. 1003, code (57), 20:56–61). Petitioner then refers to Wolfe for the teaching of the limitation “wherein the set of rules includes . . . an expected response.” *Id.* Petitioner argues that Wolfe discloses prompting a user for a response when it reaches a particular listing for a destination that has been reached, where, for example, the prompt may ask a user to solve a puzzle or answer a question. *Id.* at 18–19 (citing Ex. 1002 ¶ 57; Ex. 1004, 5:3–9, 5:28–29, 5:47–58, Fig. 4F). Petitioner further refers to Wolfe’s disclosure that a user who answers a question correctly may receive textual content or multimedia feedback and, if the response is not correct, the request for input is again repeated. *Id.* at 19–20 (citing Ex. 1002 ¶ 96; Ex. 1004, 5:56–60, Figs. 3 (steps 311, 315), 4F, 4G).

Petitioner asserts that a person of ordinary skill in the art would have been motivated to combine Lamont and Wolfe because the references fall within the same field of endeavor as the claims at issue. Pet. 20–21. Petitioner argues that Lamont discloses that its tour system can be used for treasure hunt games, the use described in Wolfe, and Mr. Schmandt testifies that a person of ordinary skill in the art would have been motivated to include the question/response aspects of Wolfe in Lamont to provide the advantage of enhanced game play. *Id.* at 21; Ex. 1002 ¶ 99. Petitioner also contends that Wolfe’s features would have benefitted Lamont’s system because a response provided directly from a user under Wolfe would have “provided a clear and unequivocal indication that the user has reached a particular point in the tour—and that the user is aware of this fact.” *See id.* Petitioner argues that the combination of Lamont and Wolfe would have been straightforward and a person of ordinary skill would have had a reasonable expectation of success. Pet. 22 (citing Ex. 1002 ¶ 101). In

support, Mr. Schmandt testifies that it would have been trivial to modify Lamont because of its teaching delivery of content which is based on any number of variables and triggers. Ex. 1002 ¶ 101 (citing Ex. 1003, 2:12–14, 2:67–3:3). Mr. Schmandt also testifies that, although it is not clear in Wolfe whether the server or mobile device is responsible for receiving and processing user input, in the view of one of ordinary skill, the expected response would have been incorporated into the tour script of Lamont and executed locally on the client device. *Id.*

For limitation 1[b], Petitioner asserts that Lamont discloses components that receive notifications of changes to the location, velocity, and time with respect to users as the claimed “receiving . . . contextual information.” Pet. 24–26. For limitation 1[c], Petitioner argues that the “current context for a first user” is the current activity or status of a user based on processing the contextual information of a user relating to location, speed, or time. *Id.* at 27 (citing Ex. 1002 ¶ 106). Petitioner refers to Lamont’s disclosure that “[w]hen the condition monitor 220 detects that conditions 330 relevant to a tour have changed, it sends a signal containing an indication of the type of condition and a measurement of that condition to each of the elements of the relevant tour.” *Id.* at 27 (citing Ex. 1003, 15:1–23). Petitioner asserts that processing of contextual information may describe an activity in which a user may be engaged like “IF T1 Speed>30 mph AND T2 Direction is North Easterly OR T3 Direction is North westerly.” *Id.* at 28 (citing Ex. 1003, 4:4–13). Petitioner contends that the claimed context could be an event where the user travels in a particular direction at a certain time and speed. *Id.* at 28–29. Petitioner additionally refers to other exemplary conditions disclosed in Lamont, such as “traveling over 35 miles per hour,” or “between 10 am and 11:30 am,” or “heading

within 30 degrees of due east.” *Id.* at 29 (citing Ex. 1003, 17:18–21).

Petitioner asserts that Lamont discloses determining a current context for a user as part of a process where the software evaluates whether the individual trigger point conditions are satisfied. *Id.* at 28. Petitioner additionally relies upon Wang, which discloses details of software evaluation using Boolean operations, such as those in Lamont. *Id.* at 30–33.

Patent Owner argues that Petitioner has not sufficiently demonstrated that Lamont discloses “context” as claimed. Prelim. Resp. 14–18. Patent Owner asserts that “‘context’ is a key, but complex, concept in the ’599 Patent.” Prelim. Resp. 14. Patent Owner contends that contextual information serves as the basis for “context,” and the system of the patent “can be programmed to infer specific contexts about the user based on contextual information.” *Id.* at 14–15 (citing Ex. 1001, 7:30–33, 7:33–59).

More specifically, Patent Owner argues that Lamont does not teach “context” because “Lamont does not mention the words ‘current activity’ or ‘status’ in relation to other contextual information,” and, in contrast, in the ’599 patent, “context can be determined from a processed set of contextual information.” *Id.* at 15. Patent Owner also contends that Petitioner’s position that context is established by comparison to Lamont’s “trigger point conditions” is not correct. *Id.* at 16. Patent Owner argues that Petitioner’s position that Lamont establishes a context is incorrect because Lamont only analyzes whether a user’s activities have changed and this is not equivalent to the ’599 patent disclosure of processing contextual information to determine context, and then determining if a trigger condition has been met. *Id.*

Patent Owner further argues that context “is a state that the user is or was in” and “is not merely a monitored change in the user’s status as

Facebook seems to suggest.” Prelim. Resp. 16 (citing Pet. 26–27). Patent Owner asserts that Lamont only recognizes that a user is following a tour route, but the ’599 patent “can process multiple pieces of contextual information to determine what the user is doing, and then act accordingly.” *Id.* at 16–17. Patent Owner further contends that the processing step of limitation 1[c], “requires complex analysis of data from multiple sources to determine a context,” which Lamont or Wang do not contemplate. *Id.* at 17–18.

Patent Owner further argues that Petitioner fails to carry its burden to demonstrate that a person of ordinary skill would have combined Lamont and Wolfe. Prelim. Resp. 20–22. Patent Owner contends that Lamont has client-only architecture and Wolfe has client-server architecture and Petitioner has not shown why a person of ordinary skill would have taken select aspects of Wolfe and tried to move them into Lamont. *Id.* at 20–21. Patent Owner contends that Petitioner has not shown how the combination would be made or operate overall. *Id.* at 21. Patent Owner further argues that, even if one of ordinary skill could have combined the references, Petitioner has not shown how or why they would be combined in view of other claim limitations and the differences in architecture. *Id.*

At this juncture, we do not find that Patent Owner’s arguments undermine Petitioner’s showing because Patent Owner appears to misunderstand Petitioner’s arguments and also appears to interpret the claimed “context” to include additional limitations. The Petition maps notifications of changes to the location, velocity, and time as “contextual information,” which is processed to determine a “context,” such as the direction and rate of speed of user direction, where “a trigger condition” includes conditions, such as a certain velocity and direction, which trigger

presentation of a “content piece,” as described above. Pet. 14–18, 24–29. Although Patent Owner argues that Petitioner’s position is that Lamont only analyzes whether a user’s activities have changed to determine if a trigger condition has been met and, therefore, is not equivalent to the ’599 patent’s disclosure of processing contextual information to determine context, this does not appear to Petitioner’s position. Prelim. Resp. 15–17. Instead, Petitioner asserts that in Lamont changes are processed to determine parameters such as user velocity, and the processed information is used to trigger content presentation. See Pet. 25–29; Ex. 1002 ¶¶ 107–110; Ex. 1003, 15:1–23.

We also do not agree, at this juncture, with Patent Owner’s contentions that Lamont fails to sufficiently teach inferring a “context” or that it does not employ a “complex analysis of data from multiple sources to determine a context.” Prelim. Resp. 14–15. Claim 1 does not recite a method for inferring context, but rather requires that context be determined by processing contextual information. Ex. 1001, 23:30–31. Similarly, we discern no requirement in the claim that the determination of context be done by complex analysis from multiple sources. Additionally, Petitioner’s assertion that context could be a user’s “current status,” such as a user’s travel in a particular direction at a certain time, is consistent with the disclosure in the ’599 patent that “context is a set of data that describes an event or environmental factor associated with a user or the operational environment of content management system 100.” See Pet. 26–27 (quoting Ex. 1001, 7:36–39).

Further, at this juncture, we find that Petitioner has provided sufficient rationale why a person of ordinary skill in the art would have combined Lamont and Wolfe, that is, the combination would have provided the

benefits of enhanced game play and provided confirmation that a user was aware that they had reached a particular point in a tour. Pet. 21. Moreover, although Patent Owner points to differences in the architecture of Lamont and Wolfe, Petitioner does not assert that Wolfe would be bodily incorporated into Lamont—instead Petitioner relies upon the inclusion of Wolfe’s response functionality into the Lamont’s tour script. *Id.* at 23. Finally, on this record, we have the unrebutted testimony of Mr. Schmandt that combining the references would have been straightforward and would have had a reasonable expectation of success. Ex. 1002 ¶ 101.

Accordingly, at this juncture, we determine that Petitioner has provided sufficient evidence that the combination of Lamont, Wolfe, and Wang teaches the preamble¹⁰ and limitation 1[a], 1[b], and 1[c] of claim 1, and sufficient rationale to combine the references has been provided.

ii. Limitations 1[d]–1[h]

Petitioner contends that Lamont discloses determining whether a current context satisfies a trigger condition as recited in limitation 1[d]. Pet. 35–36 (citing Ex. 1002 ¶ 121). Petitioner argues that Lamont discloses comparing the current activity or status of a user “against preset conditions 330 associated with various trigger points 100,” to determine “what conditions 330, as may be required by the trigger point 100, are satisfied.” *Id.* at 35 (citing Ex. 1003, 14:29–37).

Petitioner contends that Lamont discloses that, in response to the trigger condition being satisfied, the content piece is presented to a user, as recited in limitation 1[e]. Pet. 37–38. Petitioner refers to Lamont’s

¹⁰ We make no determination in this Decision whether the preamble of claim 1 is limiting.

disclosure that “IF T1 Speed>30 mph AND T2 Direction is North Easterly OR T3 Direction is Northwesterly, THEN Trigger ‘You may be going to [sic; too] fast to make the right turn on Acacia Avenue (T2), so you may want to take right on Beverly Blvd (T3).’” *Id.* at 37 (citing Ex. 2003, 4:6–10). Petitioner asserts that this is an example of the presentation of content in response to a trigger condition being satisfied. *Id.*

Petitioner contends that the combination of Lamont and Wolfe discloses receiving a response from a user corresponding to the presented content piece as recited in limitation 1[f]. Pet. 39–41. Petitioner argues that Lamont discloses a user feedback monitor that receives input from a user with respect to the presented content piece, such as the content specified in a media list. *Id.* at 39 (citing Ex. 1003, 20:56–59). Petitioner further refers to the proposed combination with Wolfe, where under the proposed combination, Lamont’s client device is adapted to receive an answer to a puzzle or question from a user presented during a treasure hunt, and then determines if the answer was correct. *Id.* (citing Ex. 1004, 5:47–58).

Petitioner asserts that Wolfe discloses determining whether the received response matches the expected response as recited in limitation 1[g]. Pet. 41. Petitioner contends that step 311 of Figure 3 of Wolfe is the step “Correct input?” *Id.* (citing Ex. 1004, Fig. 3). Petitioner further contends that in Wolfe, “[i]f the answer is correct, the user may receive text feedback (step 311–313),” and “may also receive multimedia feedback that relates to the puzzle (i.e. sound, images, video, etc[.]).” *Id.* (citing Ex. 1004, 5:55–58).

Petitioner argues that the combination of Lamont and Wolfe teaches performing an action based on an outcome of the determination as recited in limitation 1[h]. Pet. 41–42 (citing Ex. 1002 ¶¶ 101–106). Petitioner asserts

that under the combination, “a treasure hunt implemented as a guided tour would perform the action of allowing the user to proceed to the next step in the tour upon determining that the user provided the correct answer (the ‘expected response’).” *Id.* at 42 (citing Ex. 1002 ¶ 130).

Patent Owner argues that Petitioner does not sufficiently support that the prior art teaches limitations 1[g] or 1[h]. Prelim. Resp. 18–22. Patent Owner contends that in “determining whether the received response matches the expected response;” and “performing an action based on an outcome of the determination,” “[t]his necessarily requires the system to allow for both expected and unexpected (*e.g.*, incorrect or undesired) responses, and to perform actions only when an expected response is received.” *Id.* at 18–20.

Patent Owner also argues that Petitioner impermissibly “lumps together its analysis of limitations 1[f]–[h],” conflating separate claim elements. Prelim. Resp. 19. Patent Owner additionally argues that Petitioner fails to carry its burden to demonstrate that a person of ordinary skill in the art would have combined Lamont and Wolfe in view of the differences in architecture and failure to identify why or how the references would be combined. *Id.* at 20–22.

At this juncture, we do not find that Patent Owner’s arguments undermine Petitioner’s showing. Limitation 1[g] requires only that there is a determination as to whether a received response matches the *expected* response and there is no recited limitation requiring that there be a determination made for an *unexpected* response. Further, Wolfe discloses not only determining whether a correct response has been received, but also determining whether an incorrect answer has been received. *See* Pet. 19–20. For instance, if an incorrect response is received to a question under Wolfe, the user would be asked again to provide input and would be prevented from

proceeding to the next listing until the user provides the correct response.
Ex. 1005, Fig. 3 (steps 307, 309, 311); Pet. 20.

Also, as discussed above, we find that Petitioner has provided sufficient support for the rationale to combine Lamont and Wolfe, as well as providing sufficient evidence and argument in support of the reasonable expectation of success of the combination. Additionally, we determine that Petitioner has provided sufficient evidence and argument for its assertions as to limitations 1[f] to 1[h] in view of the related nature of the respective limitations. *See* Pet. 39–42.

We have reviewed the evidence and argument and on this record we determine that Petitioner has presented sufficient evidence that Lamont, Wolfe, and Wang teach limitations 1[d]–1[h] of claim 1, and sufficient rationale to combine the references has been provided.

iii. Conclusion

Accordingly, we are persuaded that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing that claim 1 is rendered obvious by Lamont, Wolfe, and Wang.

b. Independent Claims 12 and 19

For the challenges to claims 12 and 19, Petitioner relies on similar evidence and argument to that presented for claim 1. Pet. 49, 50–55. Patent Owner presents the same arguments for these claims as those presented for claim 1, which we address above. Prelim. Resp. 14–23.

We note that claim 19 contains the terms “input mechanism,” “receiving mechanism,” and “content delivery mechanism.” *See* Ex. 1001, 25:52–26:14. The parties have not presented any briefing on how these claim terms should be construed and, more specifically, whether these terms

are means-plus-function limitations. At this juncture, and for the purpose of assessing the merits, we have assumed that the “mechanism” terms of claim 19 are not means-plus-function limitations for the purposes of this Decision. We invite additional briefing on this claim construction issue.

We have reviewed the evidence and argument and on this preliminary record we determine the information presented shows a reasonable likelihood that Petitioner would prevail in establishing that challenged independent claims 12 and 19 are rendered obvious by Lamont, Wolfe, and Wang.

c. Dependent Claims 4, 6, 7, 10, 11, 15, 17, 18, 22, 24, and 25

Petitioner presents evidence and argument in support of its contentions that dependent claims 4, 6, 7, 10, 11, 15, 17, 18, 22, 24, and 25 are rendered obvious by Lamont, Wolfe, and Wang. Pet. 42–56. We have reviewed the Petition’s showing for these claims and find that sufficient evidence has been provided in support of the challenges at this stage of the proceeding. Patent Owner does not contest those claims separately. See *generally* Prelim. Resp.

Accordingly, we are persuaded that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing that the subject matter of claims 4, 6, 7, 10, 11, 15, 17, 18, 22, 24, and 25 would have been obvious over Lamont, Wolfe, and Wang.

E. Asserted Obviousness of Claim 9 Over Lamont, Wolfe, Wang, and Belimpasakis

Petitioner contends that claim 9 is unpatentable under 35 U.S.C. § 103(a) as obvious over Lamont, Wolfe, Wang, and Belimpasakis. Pet. 56–61. In support, Petitioner also relies upon the Schmandt Declaration. Ex.

1002. Patent Owner does not provide any additional arguments specifically directed to this ground. *See generally* Prelim. Resp.

We begin our discussion with brief summary of Belimpasakis and then address the evidence and arguments presented.

1. Belimpasakis (Ex. 1007)

Belimpasakis is generally directed to methods and systems for content sharing. Ex. 1007, code (57). In particular, Belimpasakis describes a method of a user sharing content by the user selecting one to share the content with and the device will determine all necessary protocols and configuration for sharing the content. *Id.* at code (57), 4:56–5:1.

2. Analysis

Claim 9 recites the method of claim 1, “wherein presenting the content piece comprises sharing the content piece with a remote device.” Ex. 1001, 24:26–28. Petitioner contends that claim 9 would have been obvious over the combination of Lamont, Wolfe, and Wang in further view of Belimpasakis. Pet. 56–61. Petitioner asserts that Belimpasakis describes several techniques for sharing content with a remote device, including sending content through email or instant messaging using a mobile phone. *Id.* at 57 (citing Ex. 1002 ¶ 176, n.6; Ex. 1007, 1:27–50). Petitioner also refers to Belimpasakis’s disclosure of content sharing using a personal resource file that allows a sender to share content by selecting a recipient and the device obtains the content and sends it. *Id.* (citing Ex. 1007, 4:34–55, 7:22–28, 7:37–39). Petitioner asserts that a person of ordinary skill in the art would have been motivated to combine Belimpasakis with Lamont, Wolfe, and Wang because Belimpasakis provides an express motivation, stating, “People want to be able to share their content on many different

levels with others including, for example, their family, friends and colleagues.” *Id.* at 59 (citing Ex. 1007, 1:19–23). Petitioner asserts that a person of skill would have been motivated “to allow guided tour users to share the content with which they are presented during a tour.” *Id.* (citing Ex. 1002 ¶ 181).

We have reviewed the Petition’s showing for this claim and find that sufficient evidence has been provided in support of this challenge at this stage of the proceeding. Patent Owner does not provide any arguments specific to this ground. *See generally* Prelim. Resp.

Accordingly, we are persuaded that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing that the subject matter of claim 9 would have been obvious over Lamont, Wolfe, Wang, and Belimpasakis.

F. Asserted Obviousness Grounds With Meyers

Petitioner contends that claims 1, 4, 6, 7, 10–12, 15, 17–19, 22, 24, and 25 are unpatentable under 35 U.S.C. § 103(a) as obvious over Lamont, Wolfe, Wang, and Meyers and claim 9 as obvious over Lamont, Wolfe, Wang, Belimpasakis, and Meyers. Pet. 61–66. Petitioner relies on Meyers as an additional ground for the teaching of the “content package” recited in the independent claims. *Id.* at 61. Patent Owner does not present any arguments specific to these grounds. *See generally* Prelim. Resp.

As we discussed above, at this juncture, we have determined that evidence and argument provided to support that the combination of Lamont, Wolfe, and Wang teach the “content package” limitation. Accordingly, we need not reach the merits of these additional grounds at this time.

IV. CONCLUSION

For the foregoing reasons, we determine that the information presented establishes a reasonable likelihood that Petitioner would prevail in showing at least one of claims 1, 4, 6, 7, 9–12, 15, 17–19, 22, 24, and 25 of the '599 patent is unpatentable under 35 U.S.C. § 103.

V. ORDER

Accordingly, it is

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review is hereby instituted as to claims 1, 4, 6, 7, 9–12, 15, 17–19, 22, 24, and 25 of the '599 patent on the grounds set forth in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; the trial will commence on the entry date of this decision.

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