

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.,
Petitioner,

v.

PALO ALTO RESEARCH CENTER INC.,
Patent Owner.

IPR2021-01472
Patent 9,137,190 B2

Before KARL D. EASTHOM, DANIEL J. GALLIGAN, and
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

GALLIGAN, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Facebook, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 9–16 of U.S. Patent No. 9,137,190 B2 (“the ’190 patent,” Ex. 1001). Paper 2 (“Pet.”). Palo Alto Research Center Inc. (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

Under 37 C.F.R. § 42.4(a), we have authority to determine whether to institute review. The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted unless the information presented in the Petition and the Preliminary Response shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

For the reasons explained below, we institute an *inter partes* review of all challenged claims on all grounds raised in the Petition.

B. Related Matters

As required by 37 C.F.R. § 42.8(b)(2), the parties identify various related matters, including another petition for *inter partes* review challenging different claims of the ’190 patent. Pet. 1; Paper 4, 2–3.

C. Real Parties in Interest

Petitioner identifies itself as the real party in interest. Pet. 1. Patent Owner identifies itself, Xerox Corp., and Xerox Holdings Corp. as real parties in interest. Paper 4, 2.

D. The ’190 Patent and Illustrative Claim

The ’190 patent is generally directed to content-based message distribution. Ex. 1001, code (57). Claim 9, which is the only independent claim that is challenged, is reproduced below.

9. A method for content-based message distribution, comprising the steps of:
- receiving an incoming message with a recipient address and a tag address comprising one or more content tags, each of the content tags associated with one or more users;
 - identifying at least one of the content tags within the tag address and a recipient associated with the recipient address;
 - adding the recipient to the at least one content tag as one of the users;
 - displaying the incoming message to at least one of the users associated with the at least one content tag; and
 - delivering to the recipient an additional message comprising a notification that the recipient has been added to the at least one content tag, wherein the additional message further comprises a removal button and the recipient is removed from the at least one content tag upon activating the removal button,
- wherein the steps are performed by a suitably-programmed computer.

E. Asserted Grounds of Unpatentability

Petitioner presents the following grounds:

Claims Challenged	35 U.S.C. §	References/Basis
9–16	103	Heidloff, ¹ Riggsby, ² RFC 5233, ³ Low, ⁴ RFC 2369 ⁵

¹ US 7,543,031 B2, issued June 2, 2009 (Ex. 1003).

² Matt Riggsby et al., *Mastering Lotus Notes and Domino 6* (Ex. 1004). On this record, we are persuaded that Riggsby is a prior art printed publication. *See* Pet. 7 (citing Ex. 1015 ¶¶ 42–47).

³ K. Murchison, Request for Comments 5233, “Sieve Email Filtering: Subaddress Extension,” dated Jan. 2008 (Ex. 1005). On this record, we are persuaded that RFC 5233 is a prior art printed publication. *See* Pet. 7 (citing Ex. 1002 ¶ 53; Ex. 1016).

⁴ US 2007/0038777 A1, published Feb. 15, 2007 (Ex. 1006).

⁵ G. Neufeld et al., Request for Comments 2369, “The Use of URLs as Meta-Syntax for Core Mail List Commands and their Transport through Message Header Fields,” dated July 1998 (Ex. 1007). On this record, we are

Claims Challenged	35 U.S.C. §	References/Basis
9–16	103	Heidloff, Riggsby, RFC 5233, Low, RFC 2369, Hazel ⁶

II. ANALYSIS

A. Principles of Law

A patent claim is unpatentable under 35 U.S.C. § 103 if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (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) any secondary considerations, if in evidence.⁷ *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 17–18 (1966).

B. Level of Ordinary Skill in the Art

Citing the testimony of its declarant, Christopher M. Schmandt, Petitioner contends that a person of ordinary skill in the art

persuaded that RFC 2369 is a prior art printed publication. See Pet. 7 (citing Ex. 1002 ¶ 53; Ex. 1017).

⁶ Philip Hazel, *Exim: The Mail Transfer Agent* (2001) (Ex. 1008). On this record, we are persuaded that Hazel is a prior art printed publication. See Pet. 7 (citing Ex. 1015 ¶¶ 48–53)

⁷ At this stage, Patent Owner does not present any objective evidence of nonobviousness (i.e., secondary considerations) as to any of the challenged claims.

would have possessed at least a bachelor's degree in electrical engineering or computer science, and two years of work experience in the design and implementation of electronic messaging and content distribution and management systems. A person could also have qualified as a person of ordinary skill in the art with some combination of (1) more formal education (such as a master's of science degree) and less technical experience, or (2) less formal education and more technical or professional experience in the fields identified.

Pet. 4 (citing Ex. 1002 ¶ 12).

Patent Owner does not dispute this assessment or offer its own assessment. *See* Prelim. Resp.

To the extent necessary, and for purposes of this Decision, we accept the uncontested assessment offered by Petitioner as supported by the '190 patent specification and the prior art of record, except that we delete the qualifier "at least" to eliminate vagueness as to the amount of education. The qualifier expands the range indefinitely without an upper bound and thus precludes a meaningful indication of the level of ordinary skill in the art.

C. Claim Construction

We interpret claim terms using "the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent." 37 C.F.R. § 42.100(b) (2021).

Petitioner argues that no express constructions are necessary. Pet. 9. Patent Owner does not address claim construction at this stage. *See* Prelim. Resp.

On this record, we determine that no terms or phrases in the claims require express construction. *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))).

*D. Alleged Obviousness over
Heidloff, Riggsby, RFC 5233, Low, and RFC 2369
(Claims 9–16)*

Petitioner asserts that claims 9–16 are unpatentable under 35 U.S.C. § 103 over the combined teachings of Heidloff, Riggsby, RFC 5233, Low, and RFC 2369. Pet. 2, 10–68. Patent Owner opposes. Prelim. Resp. 8–18.

1. Overview of the Prior Art

Heidloff discloses “allowing users to send email messages to shared sources by using natural language destination email addresses,” which are then “parsed for keywords, which may include topics or phrases, that have been registered as interest profiles associated with corresponding shared sources.” Ex. 1003, 1:60–66. Heidloff explains that, “[i]f a match with a keyword is found, the message is forwarded to a predetermined email destination associated with the shared source that registered the keyword as part of its interest profile.” Ex. 1003, 1:66–2:2. Additional pertinent details of Heidloff and the other applied references are discussed below.

2. Claim 9

a) Preamble

Petitioner contends that Heidloff teaches “[a] method for content-based message distribution,” as recited in the preamble of claim 1.

Pet. 10–15 (citing Ex. 1003, code (57), 1:21–22, 1:28–30, 1:32–33, 1:46–48, 1:58–2:8, 2:10–13, 2:51–3:10, 3:15–19, 3:56–4:11, 4:34–5:18, Figs. 1, 2; Ex. 1002 ¶¶ 64, 66–70, 72–73). In particular, Petitioner contends that, “[b]ecause the distribution of a given message to shared sources depends on the topic or topics to which it relates – which would be based in turn on the message’s content – Heidloff teaches and suggests a ‘content based’ message distribution system.” Pet. 15 (emphasis omitted) (citing Ex. 1002 ¶¶ 68–69, 73). At this stage, Patent Owner does not dispute this contention. On this record, Petitioner’s contentions for the preamble are persuasive.⁸

b) “Receiving an incoming message”

The first step of claim 9 recites “receiving an incoming message with a recipient address and a tag address comprising one or more content tags, each of the content tags associated with one or more users.”

For the “tag address comprising one or more content tags,” Petitioner argues that Heidloff discloses “sender-provided keywords specifying the topic(s) of interest for the message.” Pet. 18 (citing Ex. 1003, 1:63–66, 2:3–7, 2:60–64, 3:17–19, 4:45–53; Ex. 1002 ¶¶ 106–108). Heidloff discloses that

a user creates and sends an email message for publication that has a natural language destination address. For example, using an embodiment of the disclosed system, a user can create an email message with a destination or “TO:” field value of “publish: RCP, smart client, Eclipse”. In this example, the predetermined command string “publish:” is followed by free

⁸ Because we determine that, on the record before us, the cited evidence supports Petitioner’s undisputed contentions regarding the preamble, we need not decide whether the preamble is limiting for purposes of this Decision.

text consisting of a comma separated list of keywords such as words, acronyms, phrases or other text strings.

Ex. 1003, 4:45–53. Petitioner argues that RCP, smart client, and Eclipse are content tags “because each can specify a topic of interest for the message.” Pet. 18 (citing Ex. 1003, 1:63–66, 2:3–7, 3:17–19, 3:58–64; Ex. 1002 ¶¶ 87, 94).

Petitioner further relies on Heidloff’s disclosure of processing the keywords at the email server. Pet. 20 (citing Ex. 1003, 5:1–14). Heidloff explains that the free text entered by the user is compared to keywords and that, “[i]f any of the strings ‘RCP’, ‘smart client’, or ‘Eclipse’ matches a registered keyword, the message is forwarded to the email address of the associated shared content source.” Ex. 1003, 5:1–6. As an example, Heidloff discloses that “RCP,” “smart client,” and “Eclipse” may be registered as keywords with the email address RCPTeamroom@ibm.com, in which case “the email server system would operate to forward the publishable email message to the email address ‘RCPTeamroom@us.ibm.com.’” Ex. 1003, 5:6–14.

Although “RCP” is a keyword in Heidloff and is in the email address, Petitioner does not rely on this disclosure to show the “tag address” recited in claim 9. Pet. 20. Rather, Petitioner argues that it would have been obvious to “includ[e] the sender-identified topical keyword(s) (‘content tags’) in the full email address used to route a message from the email server to its destination” in view of RFC 5233 and Riggsby. Pet. 21 (emphasis omitted). In particular, Petitioner relies on RFC 5233’s disclosure of

subaddressing. Pet. 22–23 (citing Ex. 1005, pp.1–4⁹). RFC 5233 discloses that “[s]ubaddressing is the practice of augmenting the local-part of an [RFC2822] address with some ‘detail’ information in order to give some extra meaning to that address.” Ex. 1005, p.2, *quoted in* Pet. 22–23. RFC 5233 explains that a “common way of encoding ‘detail’ information into the local-part is to add a ‘separator character sequence’, such as ‘+’, to form a boundary between the ‘user’ (original local-part) and ‘detail’ sub-parts of the address,” such that “[a] message addressed to ‘ken+sieve@example.org’ is delivered into a mailbox called ‘sieve’ belonging to the user ‘ken.’” Ex. 1005, p.2.

Petitioner argues that combining RFC 5233’s disclosures of subaddressing with Heidloff would “have improved Heidloff by providing the recipient database with the sender-identified topical keyword(s) associated with a given message (‘incoming message’), thus allowing the database to readily access, and use, this additional information.” Pet. 27 (emphasis omitted) (citing Ex. 1002 ¶¶ 100, 102, 107–111). Petitioner also argues that “RFC 5233 provides an express motivation to combine by teaching that subaddressing augments an existing email address by injecting it with ‘some “detail” information in order to give extra meaning to that address.’” Pet. 26 (emphasis omitted) (citing Ex. 1005, p.2). Petitioner argues that Riggsby’s disclosure of organizing documents in a database around categories further supports the motivation to combine. Pet. 30–31 (citing Ex. 1004, pp. 115, 194, 211, Fig. 7.3; Ex. 1002 ¶¶ 49, 93–96, 98).

⁹ Petitioner refers to the native pagination of RFC 5233, Riggsby, and RFC 2369 rather than the page numbers added to the exhibit. In this Decision, we also refer to the native pagination in these exhibits, which we denote with a prefix “p.” or “pp.”

For example, Riggsby discloses mail-in databases, in which documents can be emailed to a database, including discussion databases, and it also discloses category fields for documents in a discussion database. Ex. 1004, pp. 194, 211. Petitioner argues that, in its proposed combination, Heidloff's address RCPTeamroom@us.ibm.com would be augmented with a keyword, such as "Eclipse," to become "RCPTeamroom+Eclipse@us.ibm.com," which "takes the form of 'DatabaseOriginalLocalPart+Category@Domain.'" Pet. 34–35 (citing Ex. 1002 ¶¶ 94, 108, 111). Thus, Petitioner argues, the "Category" is a "content tag." Pet. 35.

Patent Owner disputes Petitioner's obviousness contentions for the "tag address" aspect of claim 9. Prelim. Resp. 9–13. We have reviewed Patent Owner's arguments, but on this record we do not agree with them. For example, Patent Owner argues that Heidloff and RFC 5233 are not compatible and that, "by turning Heidloff's keywords into email addresses with subaddresses, Heidloff loses its most critical feature: the ability to search for keywords and forward content based on keywords." Prelim. Resp. 10–11 (citing Ex. 1003, 4:47–49, 5:1–3). Petitioner, however, is not proposing to eliminate Heidloff's keyword teachings. Rather, Petitioner proposes that the user-entered keyword would simply be added as a subaddress to the email address that is associated with the keyword. See Pet. 24.

Patent Owner also argues that Petitioner "does not explain how Heidloff is changed through its proposed combination with RFC 5233 so that [Petitioner]'s hypothetical email system could accept email addresses, deviate from the conventional processing of those email addresses, and then match keywords." Prelim. Resp. 12. According to Patent Owner, the "proposed combination still requires the user to enter free text keywords, not

email addresses or a ‘tag address comprising one or more content tags’ as required by the ’190 Patent claim.” Prelim. Resp. 12–13. But in Petitioner’s proposed combination, the keyword the user enters is incorporated as a subaddress into the message as taught by RFC 5233. See Pet. 24 (“Upon identifying a match between the sender-identified destination keyword and one of the registered keywords (Heidloff, 4:18-21), Heidloff’s email server would incorporate the matching keyword ‘Eclipse’ into the full address applied to the message to route it to its destination, resulting in the following augmented address: RCPTeamroom+Eclipse@us.ibm.com.” (emphasis omitted) (citing Ex. 1005, p.2; Ex. 1002 ¶¶ 110–111)). Thus, on this record, Petitioner’s contention that the proposed combination teaches “receiving an incoming message with . . . a tag address comprising one or more content tags,” as recited in claim 9, is persuasive.

Patent Owner also disputes Petitioner’s reasoning to combine the references, arguing that Petitioner’s proposed combination “is inoperable” and that the asserted prior “art teaches away from combination with one another.” Prelim. Resp. 15–18. In particular, Patent Owner argues that “replac[ing] Heidloff’s ‘free text’ keywords with email addresses would destroy the functionality and purpose of Heidloff” and that Petitioner “has not explained why a [person of ordinary skill in the art], reading Heidloff, would be motivated to remove the entire keyword-based mechanism responsible for its function and replace it with the email addresses used in Riggsby, RFC 5233, and Low.” Prelim. Resp. 17–18. On this record, however, we do not see the incompatibilities that Patent Owner alleges. As discussed above, Heidloff looks for keywords and finds email addresses associated with those keywords. Ex. 1003, 5:1–14. Thus, Heidloff uses email addresses, contrary to Patent Owner’s assertion. See Prelim. Resp. 16

(“To start, Heidloff is a distribution system that uses keywords composed of ‘free text’—not email addresses—to determine how and to whom information should be disseminated.” (citing Ex. 1003, 4:45–53, 5:1–3)). On this record, Petitioner’s reasons to combine the references, summarized above, are persuasive.

For the recitation “each of the content tags associated with one or more users,” Petitioner relies on Riggsby’s disclosure of notifying users when messages are added to a certain category in the database. Pet. 35–37 (citing Ex. 1004, p.195, Fig. 7.6; Ex. 1002 ¶¶ 49, 59, 93–96, 98, 106–108, 112–113, 117–118, 122–125). Riggsby discloses a feature that informs a user of new documents that are added to discussion databases in certain categories. Ex. 1004, p.195, Fig. 7.6. Petitioner argues that this feature would have improved Heidloff’s system “by allowing users to be notified about new messages posted in individual information ‘categories,’ thus obviating the need for a user to constantly and repeatedly check to see if new messages of interest have been added to the database.” Pet. 37 (citing Ex. 1002 ¶¶ 117–118). At this stage, Patent Owner does not dispute these contentions. On this record, Petitioner’s contentions are persuasive.

In addition to the “tag address,” the “receiving” step of claim 9 recites that the incoming message has “a recipient address.” Petitioner argues that it would have been obvious for a message to have a recipient address in addition to a tag address because, “[a]s anyone who has ever used email would have appreciated, a sender can address a single email to multiple different addresses” using, for example, “TO:” and “CC:” fields. Pet. 38 (citing Ex. 1002 ¶ 83). At this stage, Patent Owner does not dispute this contention. On this record, Petitioner’s contention is persuasive.

In view of the foregoing and on this record, we are persuaded by Petitioner's contentions, summarized above, for the step of claim 9 reciting "receiving an incoming message with a recipient address and a tag address comprising one or more content tags, each of the content tags associated with one or more users."

c) *"Identifying" and "adding"*

Claim 9 recites "identifying at least one of the content tags within the tag address and a recipient associated with the recipient address" and "adding the recipient to the at least one content tag as one of the users." Petitioner argues that it would have been obvious that the content tag would be identified in the proposed combination so that the message can be categorized according to the tag. Pet. 40 (citing Ex. 1005, p.2; Ex. 1002 ¶ 121). Petitioner further relies on Low for these steps. Pet. 40–45. In particular, Petitioner argues that Low discloses using a single email address for multiple recipients in a conversation and adding a new recipient to the address associated with the conversation. Pet. 40–42 (citing Ex. 1006 ¶¶ 7, 56–67; Ex. 1002 ¶¶ 132–134). For example, Low discloses that "an email can be sent to a single email address, and all participants will be forwarded a copy of the email, once a discussion has been established." Ex. 1006 ¶ 7. Low also discloses adding new participants to the conversation:

The forward component 118 in processing an email addressed to the conversation address determines whether additional recipient addresses are included in the email, which are not already participants to the identified conversation (step 220). If so, the forward component 118 instructs the establishment component 114 to add the additional recipient addresses as participant addresses by storing them in the database 122 against the conversation (step 222).

Ex. 1006 ¶ 61.

Petitioner argues that applying Low’s teachings “would have predictably resulted in the Heidloff-Riggsby-RFC 5233 system with the added ability to identify an additional recipient in the incoming message and add that recipient to the group of users who will be notified of new messages in the category specified in the tag address (e.g. ‘Eclipse’).” Pet. 43 (citing Ex. 1002 ¶¶ 132–134). Petitioner contends that Low’s disclosure would have “provid[ed] perhaps the simplest and most convenient way for one user to add someone else as a group participant to be notified about ongoing messages relating to a particular information ‘category’ – simply identify that person as an individual recipient within a message to be published to the associated group.” Pet. 44 (citing Ex. 1006 ¶ 66; Ex. 1002 ¶ 137).

Patent Owner argues that Petitioner’s proposed combination does not teach “adding the recipient to the at least one content tag as one of the users.” Prelim. Resp. 13–15. According to Patent Owner, “[t]he purpose of this claim limitation is to add a new user to a content tag, so the next time messages are sent with that content tag, the new user will get the message without having to be separately added as a recipient of the message.” Prelim. Resp. 13. Patent Owner contends that Petitioner “never mentions, much less explains, how Low or its combination with Heidloff, RFC 5233, and Riggsby, would add the recipient to the content tag rather than the email conversation itself.” Prelim. Resp. 14.

On this record, we disagree with Patent Owner’s contention that the asserted combination does not teach “adding the recipient to the at least one content tag as one of the users.” Patent Owner is correct that Low involves email conversations, but Petitioner’s proposed combination relies on this. Pet. 42–44. Petitioner contends that “[a] conversation in Low is directly analogous to an information ‘category’ in Riggsby’s discussion database, as

both provide a means for a group of users to exchange a series of messages over time, and be notified of new communications relating a particular topic or subject matter.” Pet. 43 (citing Ex. 1006 ¶ 7; Ex. 1002 ¶¶ 129, 133).

Petitioner further argues that “[a] skilled artisan would have found Low’s ability to add a recipient to the conversation analogous to adding a recipient to the group of users who will receive notifications of new messages in the specified category.” Pet. 44 (citing Ex. 1002 ¶¶ 133–134). Thus, Petitioner applies Low’s disclosure of adding new users to email conversations to the combination of Heidloff, Riggsby, and RFC 5233, discussed above in § II.D.2.b, in which users are notified when new messages involving particular categories are received. See Pet. 42–45. Thus, in Petitioner’s proposed combination, new users are added to the group of users associated with the content tag, i.e., the new user is added “to the at least one content tag as one of the users” associated with that tag.

On this record, we are persuaded by Petitioner’s contentions and evidence, summarized above, for the steps of claim 9 reciting “identifying at least one of the content tags within the tag address and a recipient associated with the recipient address” and “adding the recipient to the at least one content tag as one of the users.”

d) “Displaying the incoming message”

Claim 9 recites “displaying the incoming message to at least one of the users associated with the at least one content tag.” Petitioner argues that the asserted combination teaches this “because the message would be displayed based on its category (along with other messages in the same category).” Pet. 45–46 (citing Ex. 1004, pp. 192, 194, Fig. 7.3; Ex. 1002 ¶ 144). At this stage, Patent Owner does not dispute this contention apart

from arguments discussed above. On this record, Petitioner's contentions for this step are persuasive.

e) "Delivering . . . an additional message"

Claim 9 recites "delivering to the recipient an additional message comprising a notification that the recipient has been added to the at least one content tag, wherein the additional message further comprises a removal button and the recipient is removed from the at least one content tag upon activating the removal button." Petitioner argues that Low discloses sending a notification message to recipients who are added to an email conversation. Pet. 46–48 (citing Ex. 1006 ¶¶ 61–66; Ex. 1002 ¶¶ 145–147). In particular, Low discloses that, after a new recipient has been added to a conversation, "forward component 118 then instructs the send component 116 to generate a notification email for the new additional recipients to advise them of the conversation address, and this is sent to the new participants by the email server 106 (step 224)." Ex. 1006 ¶ 61. Petitioner argues that a person of ordinary skill in the art

would have been motivated to include this feature from Low because, under the proposed combination, the recipient could have been added to the notification group for a "category" by *someone else*, thus making it important to inform the recipient why he will now begin receiving messages about new messages in that "category."

Pet. 48 (citing Ex. 1002 ¶ 146).

Petitioner further relies on RFC 2369 for including a "removal button" in the notification message. Pet. 48–51 (citing Ex. 1007, pp. 4–5, 11, 13; Ex. 1002 ¶¶ 151–156). RFC 2369 discloses an "unsubscribe" command that allows a user to be removed from a mailing list, and it explains that there can be an "Unsubscribe" button in a message. Ex. 1007, pp. 4, 13. RFC 2369

explains that “Unsubscribe” is a “key command[] needed by almost every list.” Ex. 1007, p.11. Petitioner argues that a removal button would have benefitted the combination because “the new recipient may have been added to the notification group for a ‘category’ by *someone else*, thus making it important to provide a way for the recipient to opt out of receiving further messages.” Pet. 50–51 (citing Ex. 1002 ¶ 155).

Patent Owner argues that, “[b]ecause the combination does not anticipate or render obvious the previous limitation of adding a recipient to the content tag, the combination also cannot render obvious removing that recipient from the content tag.” Prelim. Resp. 15. For the reasons discussed in section II.D.2.c, we disagree with Patent Owner’s arguments regarding adding a recipient to a content tag.

On this record, we are persuaded by Petitioner’s contentions and evidence, summarized above, for the step of claim 9 reciting “delivering to the recipient an additional message comprising a notification that the recipient has been added to the at least one content tag, wherein the additional message further comprises a removal button and the recipient is removed from the at least one content tag upon activating the removal button.”

f) “Performed by a . . . computer”

Claim 9 recites “wherein the steps are performed by a suitably-programmed computer.” Petitioner argues that it would have been obvious that the steps of claim 9 would have been performed by one or more computers in the proposed combination. Pet. 51–52 (citing Ex. 1002 ¶ 157; Ex. 1003, 5:19–56). At this stage, Patent Owner does not dispute this contention. On this record, Petitioner’s contention is persuasive.

g) Preliminary determination for claim 9

For the reasons discussed above and based on Petitioner's contentions and evidence, we determine, on this record, that Petitioner has shown a reasonable likelihood of prevailing in its argument that claim 9 is unpatentable as obvious over the combined teachings of Heidloff, Riggsby, RFC 5233, Low, and RFC 2369.

3. Claims 10–16

Petitioner also asserts that claims 10–16 are unpatentable as obvious over the combined teachings of Heidloff, Riggsby, RFC 5233, Low, and RFC 2369. Pet. 52–68. At this stage of the proceeding, Patent Owner does not separately address Petitioner's contentions for these claims. We have reviewed Petitioner's contentions, and we determine, on this record, that Petitioner has shown a reasonable likelihood of prevailing in its argument that claims 10–16 are unpatentable as obvious over the combined teachings of Heidloff, Riggsby, RFC 5233, Low, and RFC 2369.

E. Remaining Ground

As noted above in § I.E, Petitioner also asserts that claims 9–16 are unpatentable under 35 U.S.C. § 103 over the combined teachings of Heidloff, Riggsby, RFC 5233, Low, RFC 2369, and Hazel. Pet. 69–70. Petitioner includes Hazel in this ground to evidence the ordinary artisan's background knowledge of Internet mail. Pet. 69–70. At this stage of the proceeding, Patent Owner does not separately address Petitioner's contentions in this ground. We have reviewed Petitioner's contentions, and we determine, on this record, that Petitioner has shown a reasonable likelihood of prevailing on this ground.

III. CONCLUSION

For the foregoing reasons, we determine that the information presented in the Petition establishes that there is a reasonable likelihood that Petitioner would prevail in challenging at least one claim of the '190 patent, and we institute *inter partes* review of all challenged claims on all grounds raised in the Petition. See 37 C.F.R. 42.108(a) (“When instituting *inter partes* review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.”). At this stage of the proceeding, we have not made a final determination with respect to the patentability of any of the challenged claims or the construction of any claim term.

IV. ORDER

Accordingly, it is

ORDERED that, pursuant to 35 U.S.C. § 314(a) and 37 C.F.R. § 42.4, an *inter partes* review is hereby instituted as to claims 9–16 of the '190 patent on all challenges raised 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, which will commence on the entry date of this decision.

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Patent 9,137,190 B2

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