Trials@uspto.gov
571-272-7822

Paper 10
Entered: March 29, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.,
Petitioner,

v.

PALO ALTO RESEARCH CENTER INC.,
Patent Owner.

IPR2021-01536
Patent 8,489,599 B2

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

McSHANE, *Administrative Patent Judge*.

DECISION
Denying 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, and 18 of U.S. Patent No. 8,489,599 B2 (Ex. 1001, "the '599 patent"), along with the Declaration of Christopher M. Schmandt. Paper 3 ("Pet."); Ex. 1002. Petitioner also filed a Statement Re Multiple IPR Petitions. Paper 2 ("Stmt.") Palo Alto Research Center Inc. ("Patent Owner")[1] filed a Preliminary Response. Paper 9 ("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). For the reasons described below, we do not institute an *inter partes* review of the challenged claims.

II. RELATED PROCEEDINGS

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 Inc. v. Twitter, Inc.*, No. 2:20-CV-10754-AB-MRW (C.D. Cal.). Pet. 1; Paper 5, 2–3.

[1] Patent Owner states that Palo Alto Research Center Inc. is a wholly owned subsidiary of Xerox Corp., and Xerox Corporation is a wholly owned subsidiary of Xerox Holdings Corp. Paper 5, 2.

The '599 patent is also the subject of an earlier-filed *inter partes* review, IPR2021-01294, which was filed in July, 2021, and instituted on January 25, 2022 ("the -01294 IPR"). *Facebook, Inc. v. Palo Alto Research Center Inc.*, IPR2021-01294, Paper 13 (PTAB Jan. 25, 2022) (Institution Decision) ("the -01294 Dec."); *see also* Pet. 1; Paper 5, 3. Of note is that the Institution Decision in the -01294 IPR had not yet issued when the Petition and Preliminary Response were filed in this case.

In the -01294 IPR, we instituted an *inter partes* review of claims 1, 4, 6, 7, 9–12, 15, 17–19, 22, 24, and 25 of the '599 patent on these 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

-01294 Dec., 6, 30.

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[2] The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) ("AIA"), amended 35 U.S.C. §§ 103, 112, 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, 112.
[3] US 7,652,594 B2, filed April 7, 2006, issued January 26, 2010 (Ex. 1003).
[4] US 8,428,614 B2, filed July 10, 2007, issued April 23, 2013 (Ex. 1004).
[5] Wallace Wang, BEGINNING PROGRAMMING FOR DUMMIES, 1999 (Ex. 1006).
[6] US 9,467,530 B2, filed April 11, 2006, issued October 11, 2016 (Ex. 1007).
[7] Scott Meyers, THE DOWNLOADER'S COMPANION FOR WINDOWS, 1995 (Ex. 1008).

Petitioner states that the instant Petition is substantively identical to the first -01294 IPR petition, except that this Petition does not challenge claims 19, 22, 24, and 25 of the '599 patent. Stmt. 1. The asserted grounds in this Petition are:

Claim(s) Challenged	35 U.S.C §	Reference(s)/Basis
1, 4, 6, 7, 10–12, 15, 17, 18	103(a)	Lamont, Wolfe, Wang
9	103(a)	Lamont, Wolfe, Wang, Belimpasakis
1, 4, 6, 7, 10–12, 15, 17, 18	103(a)	Lamont , Wolfe , Wang, Meyers
9	103(a)	Lamont , Wolfe , Wang, Belimpasakis, Meyers

Pet. 3–4.

Petitioner indicates that it filed the instant Petition "to avoid possible indefiniteness issues as to claims 19, 22, and 24–25." *Id*. at 1–2. Petitioner points to independent claim 19, which recites "mechanism configured to" perform certain functions, and claims 22, 24, and 25 which depend from claim 19. *Id*. at 2. Petitioner refers to other *inter partes* review petitions, IPR2021-01458 and IPR2021-01459, filed after the -01294 IPR, and filed by another party, Twitter, Inc. *Id*. In the Twitter petitions, the issue of whether certain limitations of claims 19, 22, 24, and 25 could be construed as mean-plus-function terms under § 112(6) was raised. *Id*. Petitioner states that it filed the instant Petition "in an abundance of caution" in case the "mechanism" terms of claims 19, 22, 24, and 25 fall under § 112(6). *Id*.

More specifically, Petitioner asserts that the "mechanism" claim terms should not be construed as mean-plus-function terms because they do not recite the term "means" so they are presumed not to fall under § 112(6)—

and no party has rebutted that presumption at this point. Stmt. 2. Petitioner argues that "because it does not appear that any party intends to argue that the 'mechanism' limitations are subject to §112(6), the Board should determine that the presumption against 'means-plus-function' treatment has not been overcome." *Id*. at 3. However, Petitioner notes that in the petition in IPR2021-01459, Twitter indicated that if terms in claims 19, 22, 24, and 25 are construed as mean-plus-function types, the claims would be indefinite and *inter partes* review should not be instituted. *Id*. at 3–4. Petitioner agrees with Twitter that if the "mechanism" terms were deemed to fall under § 112(6), then claims 19, 22, 24, and 25 would be indefinite. *Id*. at 4. Petitioner indicates that it filed this second petition to mitigate possible risk because these claims are included in -01294 IPR, and that "could potentially complicate the institution decision" in that case. *Id*. at 4–5. Petitioner asserts that depending on how claims 19, 22, 24, and 25 are addressed, "only <u>one</u> of these IPR petitions should be instituted and go forward." *Id*. at 5.

Patent Owner argues that, although Petitioner has premised the need for another petition on the potential of a mean-plus-function claim construction, no party, including Patent Owner, has asserted any means-plus-function arguments for claims 19, 22, 24, and 25 of the '599 patent. Prelim. Resp. 26. Patent Owner asserts that the second petition "does not warrant institution and is superfluous." *Id*.

III. DISCUSSION

As indicated above, the Petition and Preliminary Response in this case were filed prior to the issuance of the Institution Decision in the -01294 IPR. We note that in the -01294 IPR, trial was instituted on all challenged claims, that is, independent claims 1 and 12, and associated dependent claims 4, 6,

7, 9–11, 15, 17, and 18, which do not recite any "mechanism" limitations, as well as independent claim 19, and associated dependent claims 22, 24, and 25, which include "mechanism" recitals. -01294 Dec. 6, 30, *see also SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018) (the Board is not authorized to order a trial to proceed on fewer than all claims challenged in a petition). In the -01294 IPR, although the parties did not identify that claim 19 could have mean-plus-function type terms, or provide briefing on that issue, the Institution Decision stated that

> [w]e 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.

-01294 Dec. 26–27. Accordingly, we expect that the issue of whether claim 19 "mechanism" terms are means-plus-function limitations and how those terms should be construed will be addressed in the -01294 IPR.

Institution of an *inter partes* review is discretionary under 35 U.S.C. § 314(a). Here, it is unnecessary to institute review of claims 1, 4, 6, 7, 9–12, 15, 17, and 18 of the '599 patent because trial has already been commenced on these claims on the same grounds in the -01294 IPR. *Compare* Pet. 3–4, *with* -01294 Dec. 6. Neither party advocates that trial be instituted under these circumstances. Stmt. 5; Prelim. Resp. 26. To institute *inter partes* review under these circumstances would not be an efficient use

of the parties' or the Board's resources. Accordingly, we exercise our discretion under 35 U.S.C. § 314(a) to deny *inter partes* review.

IV. CONCLUSION

For the foregoing reasons, under the specific circumstances of this case, we exercise our discretion under 35 U.S.C. § 314(a) to deny *inter partes* review.

V. ORDER

Accordingly, it is

ORDERED that, the Petition is *denied* as to all challenged claims and grounds and no trial is instituted.

PETITIONER:

Heidi Keefe
Phillip Morton
Andrew Mace
COOLEY LLP
hkeefe@cooley.com
pmorton@cooley.com
amace@cooley.com

PATENT OWNER:

Ashley Moore
James Quigley
MCKOOL SMITH, P.C.
amoore@mckoolsmith.com
jquigley@mckoolsmith.com