

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LINKEDIN CORPORATION,
Petitioner,

v.

EBUDDY TECHNOLOGIES B.V.,
Patent Owner.

IPR2022-00164
Patent 8,230,135 B2

Before JAMESON LEE, JASON M. REPKO, and
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

REPKO, *Administrative Patent Judge*.

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

I. INTRODUCTION

LinkedIn Corporation (“Petitioner”) filed a petition requesting *inter partes* review of claims 1–3 and 6–10 of U.S. Patent No. 8,230,135 B2 (Ex. 1001, “the ’135 patent”). Paper 2 (“Pet.”). eBuddy Technologies B.V. (“Patent Owner”) filed a Preliminary Response. Paper 11 (“Prelim. Resp.”).

We authorized additional briefing on (1) whether we should exercise our discretion to deny the petition based on the parallel co-pending litigation and (2) the significance of the differences and alleged inconsistencies between Patent Owner’s claim-construction brief in district court and its Preliminary Responses here. Paper 12 (authorizing the first reply and sur-reply on the first topic), Paper 15 (authorizing the second reply and sur-reply on the second topic). Petitioner filed two Replies. Paper 13 (“First Reply”), Paper 16 (“Second Reply”). Petitioner filed two Sur-Replies. Paper 14 (“First Sur-reply”), Paper 17 (“Second Sur-reply”).

To institute an *inter partes* review, we must determine “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). For the reasons discussed below, Petitioner has shown a reasonable likelihood that it would prevail with respect to at least one claim challenged in the Petition. And we have not been provided a sufficient reason to exercise our discretion to deny institution. Thus, we institute an *inter partes* review.

A. Related Matters

According to the parties, the ’135 patent has been asserted in *eBuddy Technologies B.V. v. LinkedIn Corporation*, No. 1:20-cv-01501 (D. Del.). Pet. 1; Paper 3, 1. Petitioner also identifies IPR2022-00164 as related. Paper 9, 1.

B. The '135 Patent

The '135 patent relates to notifications for emails, instant messages (IM), and other “events.” Ex. 1001, 1:62–2:9; 4:63–64, 5:20–23. To notify the user, the system displays a message in a title bar of a window or task bar. *Id.* at 6:13–19. Figures 3C and 3D are screenshots of an example IM notification. *Id.* at 2:20–21. Figure 3C is reproduced below.

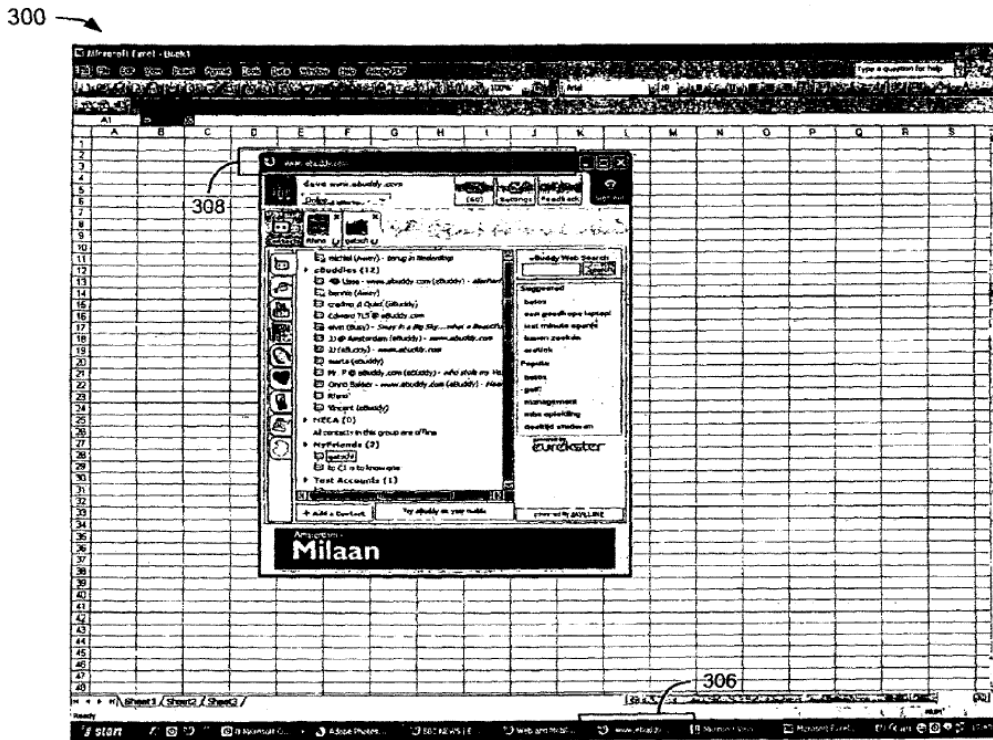


FIG. 3C

Although not readily visible from Figure 3C, above, taskbar item 306 and titlebar 308 indicate that the site www.ebuddy.com is open in a web browser. *Id.* at 5:41–65.

The system changes both the title bar and task bar when a new message is received. *Id.* at 5:65–67. In Figure 3D, the text of titlebar 312 and taskbar item 310 have been changed in response to the new message. *Id.* at 6:1–16. In particular, when “an event that calls for user notification is processed,” the system generates a title string for the event. *Id.* at 9:15–26.

Title strings are stored in an array. *Id.* at 9:27–29. The string is sent from the array to a process. *Id.* at 9:35–37. The process can be an IM client in the Windows operating system, for example. *Id.* The string is then displayed as the title. *Id.* at 9:34–40. For an IM client in Windows, this means that the string is shown at least in the title bar of the open window. *Id.* at 9:40–48.

C. Claims

Claim 1, below, is independent, and claims 2, 3, and 6–10 depend from claim 1.

1. A method comprising:

receiving information of an event that calls for user notification;

generating an event notification for the event;

associating the event notification with at least one of the plurality of character strings in a title array that includes a plurality of character strings for provisioning for display in a titlebar or taskbar of a display device;

providing the at least one of the plurality of character strings in the title array to a process executed by a processor;

providing an alternative title based on the at least one of the plurality of character strings to the process;

using the alternative title as a title in association with the process.

Ex. 1001, 12:42–56.

D. Asserted References

Name	Reference	Exhibit No.
Eaton	US 2003/0208545 A1, published Nov. 6, 2003	1006
Cheung	US 2004/0061716 A1, published Apr. 1, 2004	1007
Kim	KR 2000-0036288, ¹ published July 5, 2000	1008
Odell	US 7,590,696 B1, issued Sept. 15, 2009	1016

E. Asserted Grounds

Petitioner asserts that claims 1–3 and 6–10 are unpatentable on the following grounds. Pet. 4–5.

Claims Challenged	Pre-AIA ² 35 U.S.C. §	Reference(s)/Basis
1–3, 6, 7, 9	102	Eaton
1–3, 6, 7, 9	103	Eaton
1–3, 6–10	103	Eaton, Cheung, Odell
1–3, 9	102	Kim
1–3, 9	103	Kim
1–3, 6–10	103	Kim, Cheung

II. ANALYSIS

A. Discretionary Denial Under 35 U.S.C. § 314(a)

Under § 314(a), the Director has discretion to deny institution of a petition for *inter partes* review. *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016). In determining whether to exercise that discretion on behalf of the Director, the Board considers an early trial date in related litigation, among other factors, as part of an assessment of all relevant circumstances of the case—including the merits—to balance considerations

¹ We refer to Petitioner’s certified English-language translation of Kim.

² Congress amended § 103 when it passed the Leahy-Smith America Invents Act (AIA). Pub. L. No. 112–29, § 3(c), 125 Stat. 284, 287 (2011). Here, the previous version of § 103 applies.

such as system efficiency, fairness, and patent quality. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5 (PTAB Mar. 20, 2020) (precedential). For example, “concerns of inefficiency and the possibility of conflicting decisions” are implicated when the same prior art is submitted in district court and to the Board. *Fintiv*, Paper 11 at 12.

According to our precedent, one way to mitigate those concerns is for a petitioner to present a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the Board. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020) (precedential); *accord* Katherine K. Vidal, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022) (“Consistent with [*Sotera*], the PTAB will not discretionarily deny institution in view of parallel district court litigation where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB.”).³ Such a “stipulation ensures that an *inter partes* review is a ‘true alternative’ to the district court proceeding.” *Sotera*, Paper 12 at 19 (citing *Sand Revolution II LLC v. Cont’l Intermodal Grp.*, IPR2019-01393, Paper 24, 12 n.5 (PTAB June 16, 2020) (informative, designated July 13, 2020)).

Here, it is undisputed that “the entirety of [Petitioner’s] arguments in the Petition are also made in the co-pending litigation” between the parties (referred to as “the Delaware Action”⁴). First Sur-reply 4. But Petitioner

³ https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf

⁴ *eBuddy Tech. B.V. v. LinkedIn Corp.*, No. 1:20-cv-01501 (D. Del.)

asserts that it “will file in the parallel district court litigation a stipulation that, if IPR is instituted, it will not pursue in the parallel litigation any ground that is raised or that could have reasonably been raised in an IPR.” Pet. 85–86.

Although Petitioner has not yet filed a stipulation in the Delaware Action (First Sur-reply 4), Petitioner’s assurances in the Petition that it will file such a stipulation are sufficient to mitigate concerns over duplication because the Petition provides Patent Owner with a written record. *See, e.g., Micron Tech., Inc., v. Vervain, LLC*, IPR2021-01547, Paper 13 at 39 (PTAB Apr. 8, 2022) (“With Petitioner’s representations made in the Petition, Patent Owner has a written record of Petitioner’s assurances and we see no reason to require more.”).

Petitioner’s stipulation broadly covers “any ground that is raised or that could have reasonably been raised in an IPR” (Pet. 85–86), like the one in *Sotera* (Paper 12 at 19). Such a broad stipulation “mitigates any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions.” *Sotera*, Paper 12 at 19; *see also Sand Revolution II*, Paper 24 at 12 n.5.

We disagree with Patent Owner that Petitioner’s use of the term “ground” renders the stipulation unclear. *See* First Sur-reply 4. In the case cited by Patent Owner, the petitioner stipulated that it “will not pursue in their current district court proceedings . . . any of the same prior art grounds presented in an instituted IPR petition(s).” *Google, Inc. v. Agis Soft. Development, LLC*, IPR2020-00873, Paper 16 at 14 (PTAB Nov. 25, 2020), *cited in* First Sur-reply 4. There, the Board noted that “Petitioner could still rely on the same prior art for many of the same claim elements so long as it also includes another prior art reference in a manner that would, at least

arguably, establish the ground to be a ‘different’ ground than the ones presented here.” *Id.* By contrast, Petitioner’s stipulation covers grounds “that could have reasonably been raised.” Pet. 85–86. In this way, Petitioner’s stipulation is broader than the one in *Google*, and does not raise the same concerns that the Board had about limiting the stipulation to the “specific grounds asserted in the Petition.” *Google*, Paper 16 at 14.

Because Petitioner’s stipulation eliminates the inefficiency of duplicative efforts and the possibility of conflicting decisions, we decline to exercise our authority to deny institution of *inter partes* review based on the parallel litigation.

B. Level of Ordinary Skill in the Art

Petitioner asserts that a person having ordinary skill in the art would have a Bachelor’s degree in Computer Science, Computer Engineering, Electrical Engineering, or a related field, plus at least two years of professional experience in telecommunications or computer networking, and would have been familiar with popular Internet applications like web browsers, Google’s Gmail, AOL Instant Messenger, ICQ, Jabber, Trillian, and Yahoo Instant Messenger; development using Microsoft Windows, Java, Linux and the X-Window System (X11); and Internet Engineering Task Force (IETF) standards including “Extensible Messaging and Presence Protocol (XMPP): Core.” Pet. 6 (citing Ex. 1004 ¶¶ 32–35).

Petitioner’s alternative definition that “a PHOSITA would possess equivalent additional formal education such as graduate studies, or work experience to replace formal education” is unclear or, at best, does not meaningfully contribute to the first definition. *See id.* For example, Petitioner does not explain whether or how additional graduate studies would be both equivalent and additional to the education described in the first definition. *See id.*

Patent Owner asserts that a person having ordinary skill in the art “would be someone with a bachelor’s degree in computer science or electrical engineering, along with two or more years of experience with instant messaging and web-based servers and client systems.” Prelim. Resp. 15 (citing Ex. 2009 ¶ 23). Patent Owner’s declarant, Dr. Surati, testifies:

It is my belief that a POSITA [person with ordinary skill in the art] of the ‘135 patent would have possessed: a bachelor’s degree in computer science or electrical engineering, along with two or more years of experience with instant messaging and web-based servers and client systems. *If the qualifications of a POSITA were as stated by Petitioner’s expert Dr. Willis.* As noted above and on my CV [Ex. 2017], my qualifications exceed this description.

Ex. 2009 ¶ 23 (emphasis added). The italicized sentence in the paragraph above is ungrammatical and unclear. It could be interpreted in multiple contradictory ways: The sentence could mean that, in rendering his opinions, Dr. Surati has assumed the level of ordinary skill as stated by Dean Willis. Or it could mean that, “if the qualifications of a POSITA were as stated by Petitioner’s expert Dr. Willis,” Dr. Surati’s qualifications exceed those qualifications.

Nevertheless, we see no meaningful difference between Petitioner’s definition and Patent Owner’s. Rather, Patent Owner’s definition appears to be a simplified version of Petitioner’s. To the extent that Patent Owner disagrees, Patent Owner is encouraged to explain how the differences affect the obviousness analysis. Also, we preliminarily determine that Petitioner’s definition is supported by the testimony of Dean Willis (Ex. 1004 ¶¶ 32–35) and is consistent with the level of skill reflected in the asserted references (*cf. Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (explaining that the prior art itself can reflect an appropriate level of skill in the art)).

Thus, in this decision, we apply Petitioner’s proposed definition, without the alternative qualifier about “equivalent additional formal education . . . or work experience.” *See* Pet. 6.

C. Claim Construction

For petitions filed on or after November 13, 2018, we use 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 the 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). The Petition was filed on November 9, 2021. Paper 5. So we apply the claim construction standard from *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

Under the *Phillips* standard, claim terms are generally given their ordinary and customary meaning as would be understood by one with ordinary skill in the art in the context of the specification, the prosecution history, other claims, and even extrinsic evidence. *Id.* at 1312–17. But extrinsic evidence is “less significant” than the intrinsic record. *Id.* at 1317. The specification is the “single best guide” to a disputed term’s meaning. *Id.* at 1315. It “may reveal a special definition given to a claim term.” *Id.* at 1316. Or it may reveal “an intentional disclaimer, or disavowal, of claim scope.” *Id.*

1. “title array”

Petitioner asserts that “[t]he ’135 Patent discloses that a ‘title array’ is simply a table or list of event information or event strings.” Pet. 29 (citing Ex. 1001, 7:54–8:19).

Petitioner asserts that “[a]n ‘array’ is a fundamental data structure for storing information well-known to a PHOSITA.” *Id.* at 67 (citing Ex. 1004

¶ 214). To support this assertion, Petitioner cites a definition from a reference from 1983 about the Smalltalk system: an “‘array is a simple data structure object whose contents can be referenced by an integer index from one to a number that is the size of the array,’ such as an exemplary ‘array of seven strings described by the expression # (‘food’ ‘utilities’ ‘rent’ ‘household’ ‘transportation’ ‘taxes’ ‘recreation’).” *Id.* (quoting Ex. 1015 ¶ 43).

According to Patent Owner, “title array” means “an array that contains title strings and is stored in a computer readable medium” (Prelim. Resp. 4 (citing Ex. 1001, Fig. 6, 8:11–19)), and “array” means “a list of data values, all of the same type, any element of which can be referenced by an expression consisting of the array name followed by an indexing expression. Arrays are data structures” (*id.* (citing Ex. 2009 ¶ 42, Ex. 2016)).

Patent Owner alleges that Petitioner’s implied construction of “array” is “a simple data structure object whose contents can be referenced by an integer index from one to a number that is the size of the array.” *Id.* at 60 (citing Pet. 67). Patent Owner agrees “that an array is a ‘data structure object whose contents can be referenced by an integer index.’” *Id.* at 58 (citing Pet. 67). But Patent Owner argues that “something more than a mere displayed ‘list’ is required.” *Id.* at 59.

We need only construe terms that are in controversy and to the extent necessary to resolve the dispute. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (citing *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)). Patent Owner argues that “[i]t is not necessary for the Board to resolve this claim construction dispute for purposes of this Preliminary Response because both

Petitioner and Patent Owner agree, correctly, that arrays are data structures.” Prelim. Resp. 59 n.5. We agree with Patent Owner on this point. *See id.* That is, we construe the term “title array” to require a data structure, which is not disputed. But other than that, we need not further construe the term at this stage.

2. “titlebar”

In the related litigation, Petitioner argues that “titlebar” means “a horizontal space at the top of a window that contains the name of the window.” Ex. 2001, 23–24, *discussed in* Prelim. Resp. 37. Petitioner does not expressly construe “titlebar” in the Petition. *See, e.g.*, Pet. 5, 32–43. But Dean Willis, Petitioner’s declarant, testifies that the area at the top of a user interface is a title bar:

Further, [Eaton’s] display 420 and its display items shown in Figure 4 above is at the top of the user interface *and therefore* corresponds to a title bar of the user interface display of IM device 320.

Ex. 1004 ¶ 113 (emphasis added), *discussed in* Prelim. Resp. 39. Petitioner relies on Dean Willis’s definition in its analysis of Eaton. Pet. 34–35 (citing Ex. 1004 ¶¶ 113–114). Unlike the construction offered in district court, Petitioner’s implicit construction refers to the top of a user interface, not a window. *Compare id.*, with Ex. 2001, 23–24.

According to Patent Owner, “titlebar” means “a bar located or positioned at the top of the window, that displays information about the application and includes buttons for minimizing, maximizing or closing the window displaying the application.” Prelim. Resp. 17 (citing Ex. 2009 ¶¶ 36–37; Ex. 2010). Patent Owner argues that Eaton lacks a title bar under the proper construction. *See, e.g., id.* at 36. Patent Owner asserts that

“[w]indows may be displayed on user interfaces, but windows are not themselves user interfaces.” *Id.*

For the reasons discussed in Section II.D, we preliminarily determine that Kim discloses the “titlebar” under both the Petition’s implicit construction (Pet. 34–35) and Patent Owner’s construction (Prelim. Resp. 17). At this stage, the distinction between a user interface and a window does not appear to be relevant to the disputed issues connected to Eaton. *See supra* § II.F. And the question of whether the title bar must include buttons for minimizing, maximizing or closing, as in Patent Owner’s construction, is not germane to resolution of any issue at this stage. *See* Prelim. Resp. 17. Thus, we need not provide a full construction of “titlebar” in this Decision. *See id.* at 36. Rather, we provide an analysis under both the Petition’s implicit construction—i.e., the area at the top of a user interface—and a partial construction based on Patent Owner’s argument—i.e., the area at the top of a window. Pet. 34–35; Prelim. Resp. 17.

3. “taskbar”

According to Patent Owner, “taskbar” means “a bar, usually located at the bottom of a graphical user interface, that serves as a launching pad for applications and a holder for icons in indicating running programs.” Prelim. Resp. 18 (citing Ex. 2009 ¶¶ 37–38; Ex. 2011; Ex. 2012).

We do not need to construe the term “taskbar” to resolve the dispute at this stage: As discussed in Section II.F, Petitioner does not argue that Eaton discloses the recited task bar. Rather, Petitioner asserts that “[t]o the extent that it is argued or found that the event notifications provided in Eaton are not provisioned for display in a titlebar or taskbar of a display device (which they are, *at least in the titlebar . . .*)” Pet. 39 (emphasis added). Although Petitioner uses the phrase “at least” here, Petitioner offers no

alternative rationale for why Eaton discloses, teaches, or suggests the recited “taskbar.” *See id.* at 32–43. As for the other grounds, we preliminarily determine that Petitioner has shown that Kim discloses the recited taskbar even under Patent Owner’s construction. *See* § II.D. Whether the other references, Cheung and Odell, teach or suggest this limitation in combination with Eaton or Kim does not affect whether we institute review here.

Thus, we do not construe “taskbar” in this decision. *Nidec*, 868 F.3d at 1017.

4. “event” and “event notification”

Patent Owner argues that the ’135 Patent relates to “event-based programming.” Prelim. Resp. 18. According to Patent Owner, “event” in this context means a “detectable condition of a system that can trigger a notification.” *Id.* (citing Ex. 2009 ¶¶ 31–35; Ex. 2013; Ex. 2014; Ex. 2015). According to the Surati Declaration, “a condition must be detectable to be called an event,” and a “notification” means “an event-triggered signal sent to a run-time-defined recipient.” Ex. 2009 ¶ 30 (citing Ex. 2013, 3). Patent Owner argues that “an event notification is what is sent if a condition of a computer system meets the criteria for an event notification being issued by the system.” Prelim. Resp. 21. Under Patent Owner’s reasoning, data cannot be a notification of itself. *Id.* at 56.

Petitioner does not provide an explicit construction for “event” or “event notification.” *See* Pet.

As discussed in Section II.D, Petitioner shows that Kim discloses the recited event and event notification under Patent Owner’s construction. Thus, we analyze the Petition under Patent Owner’s construction for those terms: (1) “event” means a “detectable condition of a system that can trigger

a notification” and (2) “an event notification is what is sent if a condition of a computer system meets the criteria for an event notification being issued by the system.” Prelim. Resp. 18, 21.

On the current record, however, we are uncertain that Patent Owner’s construction is the correct construction. *See id.* For example, the ’135 patent explains that the method processes “an event, such as *by way of example but not limitation*, a new mail event, a new instant message event, a reminder event, a calendar event, or *some other event*, and generating a string of characters that includes information associated with the event.” Ex. 1001, 1:67–2:5 (emphasis added). This sentence broadly covers “some other event.” *Id.* Also, the ’135 patent states that the events used in the embodiments are merely examples. *Id.*; *see also id.* at 12:26–28 (“As used herein, the term ‘embodiment’ means an embodiment that serves to illustrate by way of example but not limitation.”). But we do not need to provide an express construction for “event,” because even under Patent Owner’s proposed construction, Petitioner has made a sufficient showing for institution. *See* § II.D. The parties are invited to explain, in their respective post-institution briefings, i.e., Response, Reply, and Sur-reply, their construction of “event,” and in particular, address the question of whether “event” is limited to events in a computer system.

We need not construe any other terms in this decision.

D. Anticipation and Obviousness over Kim

1. Kim

Kim is a Korean laid-open patent publication. Ex. 1008, 12. Kim describes a system that uses a personal computer running Microsoft Windows and communicating with a server. *Id.* The user’s computer receives real-time information from the server, such as stock prices,

advertisements, and breaking news. *Id.* at 13. Using this information, the computer changes the title bar of a currently active window. *Id.* According to Kim, the window's title bar provides a convenient way to deliver accurate real-time breaking news to investors. *Id.* at 14.

2. *Claim 1*

Petitioner asserts claim 1 is anticipated or obvious over Kim. Pet. 62–74.

a) *An Event*

Claim 1 recites, in part, “A method comprising: receiving information of an event that calls for user notification.” Ex. 1001, 12:42–44.

Petitioner asserts that Kim discloses this limitation. Pet. 62–63 (citing Ex. 1004 ¶¶ 203–205; Ex. 1008, 12–13). According to Petitioner, Kim receives “real-time information to be displayed on the title bar on the Windows display screen.” *Id.* at 62. Petitioner asserts that “real-time information can include events such as ‘stock prices, advertisements, and breaking news.’” *Id.* at 63 (citing Ex. 1008, Abstract).

Patent Owner argues that Petitioner's analysis is based on an incorrect interpretation of the claimed “event.” Prelim. Resp. 51–52 (citing Pet. 62–63). In particular, Patent Owner argues that none of Kim's stock prices, advertisements, or breaking news are events because they are not detectable conditions of a system. *Id.* at 51. We disagree at this stage and on this record.

In particular, we preliminarily determine that Petitioner has shown that the information about “stock prices, advertisements, and breaking news” are detectable conditions of a system for at least the reason that the user's computer detects new information received from the corresponding server. Pet. 63. For example, the Petition explains that Kim updates the title bar

“whether new information is provided.” *Id.* at 62–63 (quoting Ex. 1008, 13). Because Patent Owner does not give sufficient weight to this feature of Kim, we disagree with its argument at this stage. *See* Prelim. Resp. 51–52. During trial, Patent Owner is invited to address how the personal computer in Kim is able to update the title bar without at least detecting the new information at some point when processing it, or why the receipt of the new information is not a system condition.

Patent Owner argues that Kim merely receives and displays third-party data. *Id.* at 52–54 (citing Ex. 1008, 12–14, Figs. 7a, 7b). According to Patent Owner, Kim’s system “does not make any distinction between the type of kind or information it receives and the information it displays.” *Id.* at 54.

Patent Owner, though, does not explain why we should require any distinction between received and displayed information. *See id.* To the contrary, the ’135 patent discloses that “[i]f a new message is received, then both the titlebar and the taskbar can be changed.” Ex. 1001, 5:65–67. The “exact information in a titlebar, taskbar, or other display area is implementation specific.” *Id.* at 6:4–5. In one example, the “actual message of an IM message” is displayed in the title. *Id.* at 9:5–6. In at least this case, there would be no distinction between the received IM message and the displayed message. *See id.* We see nothing in the claim that would exclude this embodiment at this stage.

Thus, we preliminarily determine that Petitioner has shown that Kim discloses the receiving step even under Patent Owner’s construction of “event.” *See* Pet. 62–63.

b) Event Notification

Claim 1 recites, in part, “generating an event notification for the event.” Ex. 1001, 12:45.

Petitioner asserts that Kim discloses this limitation. Pet. 63–65 (citing Ex. 1004 ¶¶ 206–210; Ex. 1008, 13, Figs. 2–5). According to Petitioner, Kim receives real-time information at computer 30 from real-time information server 10, as shown in the English translation of Figure 5 below. *Id.* at 64.

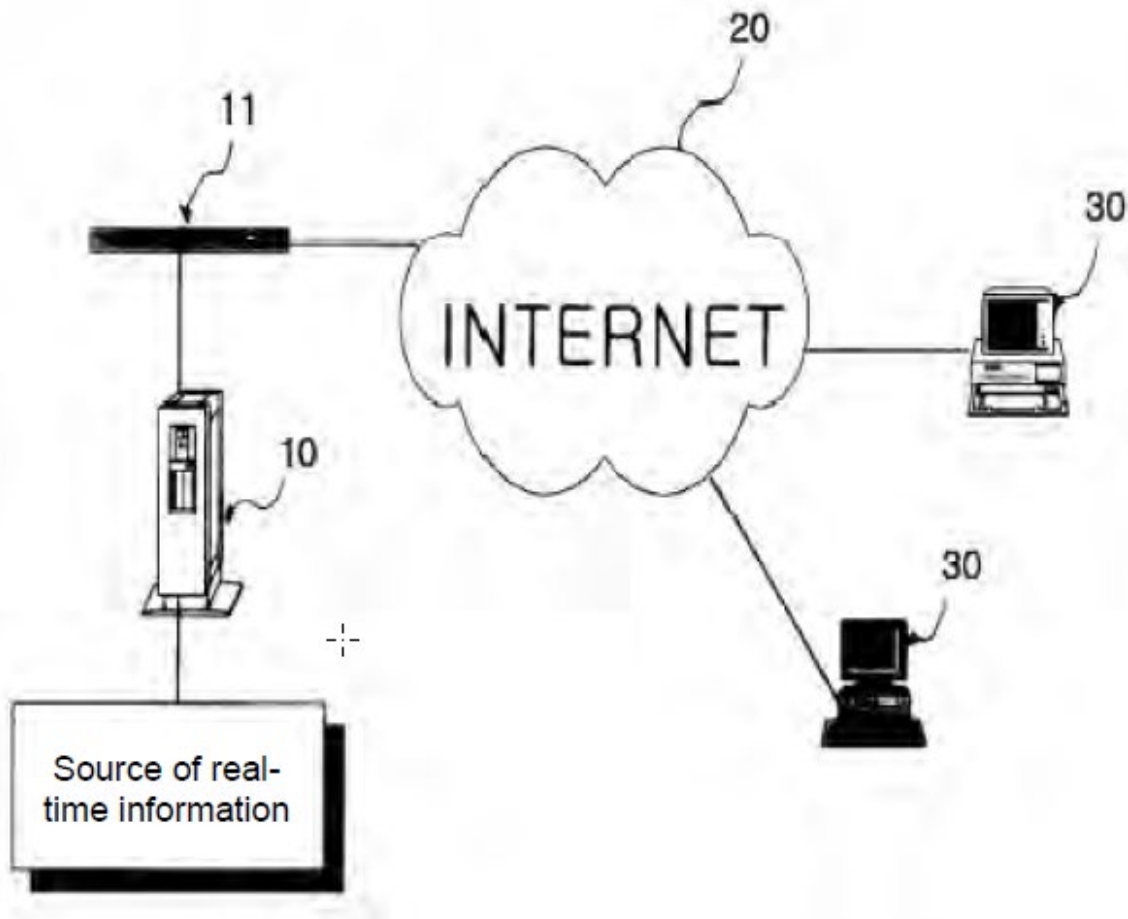


Figure 5, above, shows information server 10 connected to user computer 30 through the internet (20). *Id.* According to the Petition, both information server 10 and user computer 30 generate the recited notification:

Kim discloses that its real-time information server “generat[es] an event notification for the event” by sending a message with the event notification from the server to the user’s computer for display in the title bar of a Windows application, and the user’s computer also “generat[es] an event notification for the event” by creating the message for display in the title bar, in which the message comprises at least a “string of characters that includes information associated with the event.”

Pet. 65 (citing Ex. 1004 ¶¶ 206–210).

Patent Owner argues that Petitioner’s analysis of this limitation is flawed because Kim does not disclose an “event.” Prelim. Resp. 54. According to Patent Owner, an event is a “detectable condition of a system that can trigger a notification.” *Id.* Patent Owner asserts that, unlike the claimed invention, Kim displays real-time information without generating an event notification. *Id.* at 55 (citing Ex. 1008, 13, Fig. 3). Patent Owner argues that Kim displays the same information that it receives. *Id.* In Patent Owner’s view, data cannot be a notification of itself. *Id.* at 56.

As for the recited “event,” we disagree with Patent Owner’s argument for reasons similar to those discussed in Section II.D.2.a. For example, Petitioner asserts that Kim’s system produces messages. Pet. 63–65 (citing Ex. 1004 ¶¶ 206–210). Kim’s real-time information server sends the messages to the user’s computer. *See* Ex. 1008, 13, *cited in* Pet. 63–64. And Petitioner has shown at this stage that the information about “stock prices, advertisements, and breaking news” are detectable conditions of a system for at least the reason that the user’s computer detects new information received from the corresponding server. Pet. 63.

Nor do we agree that the claim excludes methods that display received information for similar reasons to those discussed in Section II.D.2.a. For

example, the '135 patent contains embodiments where the title bar displays the “actual message” that is received. Ex. 1001, 9:5–6.

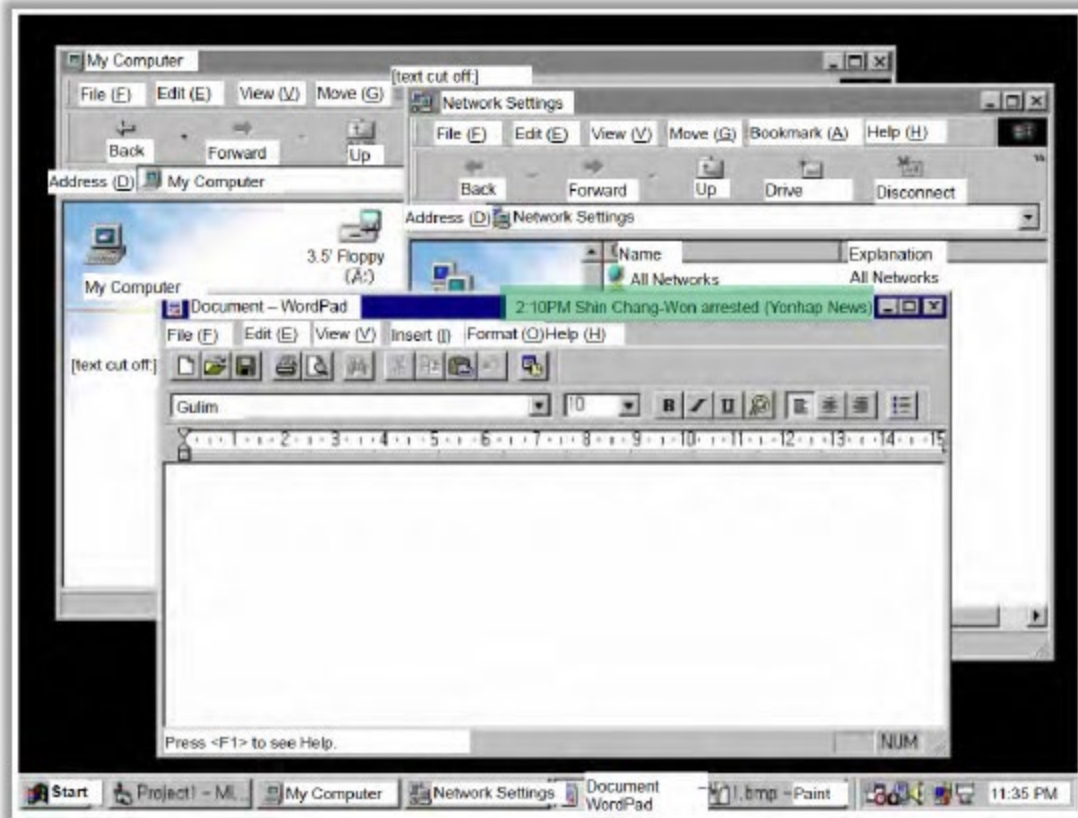
Thus, we disagree with Patent Owner at this stage on the issue of whether Kim discloses the recited events (Prelim. Resp. 54, 56), and for similar reasons, we do not credit the testimony of Dr. Surati on this issue (Ex. 2009 ¶¶ 31–34).

Patent Owner argues that the correct claim construction requires that the recited event is different from the event notification. Prelim. Resp. 56. Patent Owner argues that, contrary to this requirement, Petitioner has mapped Kim’s real-time information to both the claimed event and event notification. *Id.* (citing Pet. 63–65).

We disagree with Patent Owner’s characterization of the Petition, at this stage and on this record. *See id.* That is, the Petition does not map the same feature to two limitations. *Id.* Instead, Petitioner explains that “the ‘real-time information’ displayed in the title bar of an application in Kim constitutes ‘events that call for user notification’” (Pet. 63) and Kim generates an event notification “by creating the message for display in the title bar” (*id.* at 65). Thus, Petitioner maps the creation of Kim’s message to the recited generation of the notification. *Id.*

Under Patent Owner’s construction, “an event notification is what is sent if a condition of a computer system meets the criteria for an event notification being issued by the system.” *Supra* § II.C.4. The Petition explains that Kim updates the title bar when new information is provided. Pet. 62–63 (quoting Ex. 1008, 13). That is, the receipt of new information is “a condition of a computer system [that] meets the criteria for an event notification being issued by the system.”

For example, Kim provides the generated notification message “on the title bar of a Microsoft WordPad application window,” as shown in the figure reproduced below. *Id.* at 65.



According to the Petition, “the event notification message is shaded in green” in the above figure. *Id.* at 64–65. Here, the message is “2:10PM Shin Chang-Won arrested (Yonhap News).” *Id.*

The basis for Patent Owner argument is that the content or information conveyed by the notification must be different than the information received to trigger the notification. Prelim. Resp. 56. We disagree. At this stage, we preliminarily determine that such a limitation is inconsistent with the embodiments in the ’135 patent. For example, in one embodiment, the event may correspond to a new message (Ex. 1001, 5:54–62), and the notification can be the “actual message” (*id.* at 9:5–6).

Thus, even applying Patent Owner’s interpretations of “event” and “notification,” we preliminarily determine that Petitioner’s analysis of these limitations (Pet. 65) is sufficient for institution.

c) Title Array

Claim 1 recites, in part, “associating the event notification with at least one of the plurality of character strings in a title array that includes a plurality of character strings.” Ex. 1001, 12:16–48.

We construe the term “title array” to require a data structure, which is not disputed. *Supra* § II.C.1; Prelim. Resp. 58 (citing Pet. 67).

Petitioner asserts that Kim discloses, teaches, or suggests the recited associating step. Pet. 66–67 (citing Ex. 1004 ¶¶ 211–217; Ex. 1008, 13–14, Figs. 2–4; Ex. 1015, 43). According to Petitioner, Kim stores “new or combined” information in a list “so that a previously stored message can be displayed.” *Id.* at 66.

Patent Owner makes two sets of arguments: one set directed to the Petitioner’s anticipation ground and the other to the obviousness ground. *See* Prelim. Resp. 57–60. For the reasons that follow, we preliminarily determine that the current record favors Patent Owner’s argument on anticipation, but the Petition sufficiently shows, at this stage, that the associating step would have been obvious over Kim.

(1) Anticipation

Patent Owner argues that Kim does not disclose an array or title array. *Id.* at 57 (citing Pet. 66–67); *see also id.* at 60. Patent Owner argues that Kim does not support Petitioner’s assertion that Kim stores “new or combined event notifications” in a list. *Id.* (citing Pet. 66). According to Patent Owner, Kim does not use the words “array,” “title array,” or “list.” *Id.* In Patent Owner’s view, “Petitioner’s argument that ‘such information would be

stored in some type of list associated with character strings’ . . . is based upon speculation and conjecture.” *Id.* at 58 (citing Pet. 67).

Patent Owner argues that, even if Kim uses an array for its real-time information, it lacks “a title array that includes a plurality of character strings.” *Id.* at 57. In Patent Owner’s view, Kim does not need a list, and the displayed objects need not be organized in an array. *Id.* at 58. Patent Owner argues that “something more than a mere displayed ‘list’” meets this requirement. *Id.* at 59. Patent Owner argues that the Petition does not explain how Kim discloses that an event notification is associated with a character string in a title array. *Id.*

The preliminary record favors Patent Owner’s argument that Kim does not disclose a data structure that meets the “title array” limitation. *See id.* at 57–58.

The basis for Petitioner’s position appears to be that Kim’s stores the information in a “temporary memory.” Pet. 66 (citing Ex. 1008, 9–2). The claim recites that the character strings are “in a title array.” “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). So even accepting as true Dean Willis’s assertion that an array is simple and “suitable” for storing data (Ex. 1004 ¶ 215), Petitioner must show that Kim expressly or inherently describes an array data structure to prevail on its anticipation ground.

(2) *Obviousness*

Petitioner asserts that “[t]o the extent that it is argued or found that Kim does not disclose associating the event notification with at least one of

the plurality of character strings in a title array that includes a plurality of character strings, this would have been obvious.” Pet. 67.

Patent Owner argues Petitioner’s obviousness analysis lacks substance, has no support, and “is presented entirely without any articulated reasoning or factual bases and the Board should ignore and/or disregard it.” Prelim. Resp. 62 (citing Pet. 76–85). At this stage and on this record, we disagree.

Petitioner asserts that an array would be a suitable and desired data structure for storing the event notifications with a plurality of character strings in Kim. Pet. 67 (citing Ex. 1004 ¶ 215). Petitioner explains that Kim’s “temporary memory” could be used to store multiple events. *Id.* at 66. According to Petitioner, “an array would store the event notifications in a simple list of character strings that can be accessed with a known index, and the array will ‘respond to messages requesting access to [its] content[.]’” *Id.* (quoting Ex. 1015, 43).

Patent Owner argues that it would not have been obvious to use an array because doing so would not accomplish Kim’s stated goals. Prelim. Resp. 59–60. Patent Owner argues that Kim displays information in real time, so it is unnecessary to store the data together in an array. *Id.* at 60 (citing Ex. 1008, 13).

We disagree at this stage because Patent Owner’s argument (*id.*) does not squarely address Petitioner’s argument and evidence about Kim’s temporary memory. Pet. 67 (citing Ex. 1004 ¶¶ 211–213). According to the Willis Declaration, Kim’s temporary memory stores the real time events. Ex. 1004 ¶ 213. For example, Kim states that the “Windows title bar that receives real-time information to be displayed on the title bar on the Windows display screen of the personal computer from the information

server and stores it in temporary memory.” Ex. 1008, 13, *quoted in* Pet. 66. Petitioner asserts that Kim’s temporary memory allows it to display previously stored messages with new ones. Pet. 66. At this stage, Kim’s teachings about a temporary memory (Ex. 1008, 13) and the Willis Declaration’s assertions about it (Ex. 1004 ¶ 213) lead us to favor Petitioner’s reasoning over Patent Owner’s argument that it would have been unnecessary to store the data together in an array (Prelim. Resp. 59–60).

As discussed above in Section II.C on claim construction, both parties agree that the claimed “array” requires a data structure. *See id.* at 59 n.5. Patent Owner argues that “something more than a mere displayed ‘list’ is required.” *Id.* at 59. Even so, Petitioner’s analysis does not rely solely on a list. Instead, Petitioner has sufficiently shown that it would have been obvious to use an array because it is a simple, fundamental data structure, and it would respond to access requests. Pet. 66–67. And, at this stage, we see nothing in the present record that adequately rebuts these assertions. *See id.*

Thus, at this stage, we preliminarily determine that Petitioner has sufficiently shown that it would have been obvious to use an array in Kim to arrive at the claimed associating step: “associating the event notification with at least one of the plurality of character strings in a title array that includes a plurality of character strings.” *See id.* at 66–68.

d) Character Strings

Claim 1 recites, in part, “a plurality of character strings for provisioning for display in a titlebar or taskbar of a display device.” Ex. 1001, 12:48–49.

Petitioner asserts that “Kim discloses that the event notifications received at the user’s computer from the real-time information server(s) are

provisioned for display in a titlebar of a display device that displays the Microsoft WordPad process.” Pet. 68 (citing Ex. 1008, Abstract, 12–13).

Patent Owner does not specifically rebut this assertion. *See* Prelim. Resp.

We determine that the current record supports Petitioner’s analysis. For example, Kim discloses that “the handle value on the currently active window is extracted according to the task management of the task management unit to replace the title bar value of the corresponding window with the information provided in real-time.” Ex. 1008, 14, *quoted in* Pet. 69. Thus, at this stage, we preliminarily determine that Petitioner sufficiently shows that Kim discloses the recited character strings. *See* Pet. 68–69 (citing Ex. 1004 ¶¶ 218–221; Ex. 1008, 12–14, Figs. 2–4).

e) Providing the Character Strings

Claim 1 recites, in part, “providing the at least one of the plurality of character strings in the title array to a process executed by a processor.” Ex. 1001, 12:50–52.

Petitioner asserts that Kim’s Figures 2 through 4 show event notifications being provided as recited in claim 1. Pet. 70–71 (citing Ex. 1004 ¶¶ 222–224; Ex. 1008, 12–13, Fig. 3). Petitioner argues that Kim’s system receives real-time information from a title array. *Id.* at 70.

Patent Owner argues that Kim’s Figure 3 merely shows displaying real-time information, not an array with character strings. Prelim. Resp. 61. Patent Owner argues that, even if Kim teaches a title array, Kim lacks a plurality of character strings in the array. *Id.* Patent Owner argues Kim does not disclose a title array for the same reasons that we analyzed and discussed in Section II.D.2.c. *Id.*

For similar reasons to those discussed above, we preliminarily determine that the current record favors Patent Owner’s anticipation arguments about the “title array,” but the Petition sufficiently shows at this stage that the “title array” would have been obvious over Kim. *See* § II.D.2.c. That is, as for obviousness, we preliminarily determine that Patent Owner’s argument (*id.*) does not squarely address Petitioner’s argument and evidence about Kim’s temporary memory or rebut Petitioner’s assertions about the advantages of an array. Pet. 67 (citing Ex. 1004 ¶¶ 211–213). According to the Willis Declaration, Kim’s temporary memory stores the real-time events. Ex. 1004 ¶ 213. For example, Kim states that “Windows title bar that receives real-time information to be displayed on the title bar on the Windows display screen of the personal computer from the information server and stores it in temporary memory.” Ex. 1008, 13, *quoted in* Pet. 66. Petitioner asserts that Kim’s temporary memory allows it to display previously stored messages with new ones. Pet. 66. At this stage, Kim’s teachings about a temporary memory (Ex. 1008, 13) and Dean Willis’s assertions about it (Ex. 1004 ¶ 213) lead us to favor Petitioner’s reasoning about the “title array” over Patent Owner’s arguments to the contrary.

f) Alternative Title

Claim 1 recites, in part, “providing an alternative title based on the at least one of the plurality of character strings to the process” and “using the alternative title as a title in association with the process.” Ex. 1001, 12:53–56.

Petitioner asserts that “Kim discloses providing alternative titles from the title array to the process.” Pet. 71. According to Petitioner, Figure 3 shows a breaking-news event notification to the title bar on the WordPad

application: “2:10pm Shin Chang-Won arrested (Yonhap News).” *Id.* at 71–72. Petitioner asserts that Figure 4 shows the alternative title. *Id.* at 72–74.

Patent Owner does not specifically rebut this assertion. *See* Prelim. Resp.

We preliminarily determine that the current record supports Petitioner’s analysis. Kim’s windows are shown below in a reproduction of Petitioner’s English translation.

Fig. 1

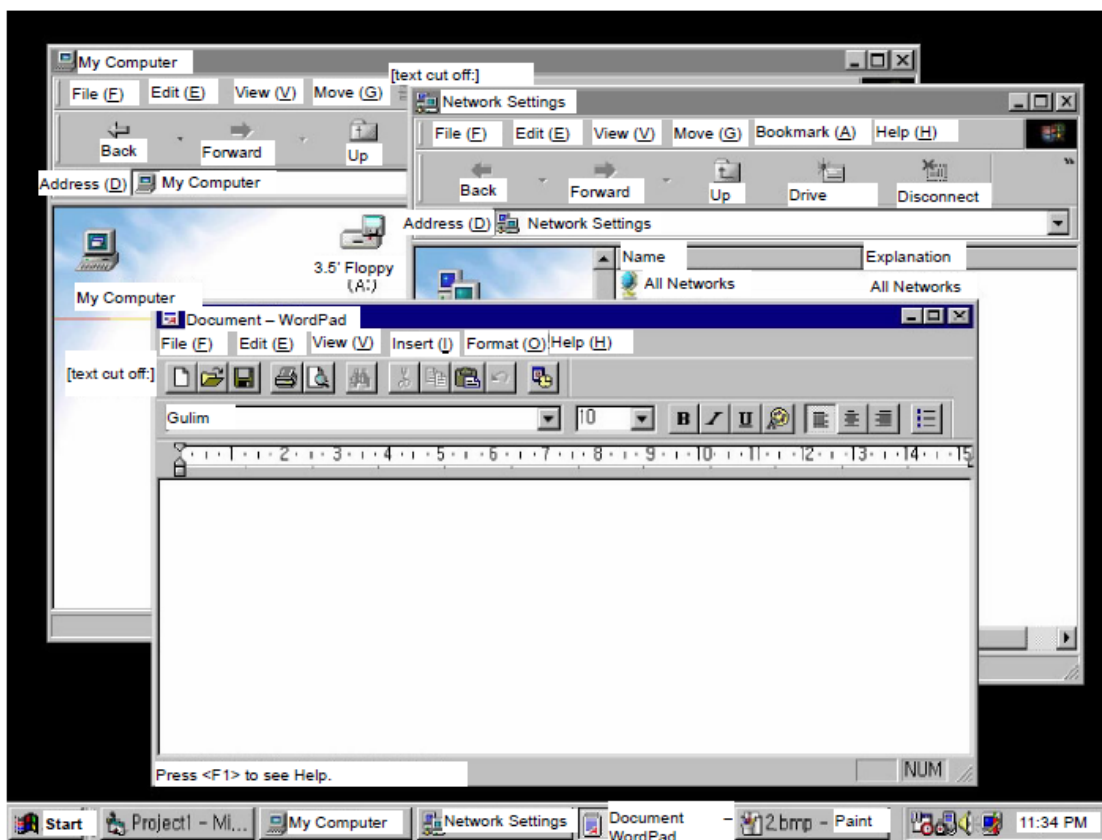


Figure 1 is a screen shot showing a Windows title bar before the real-time information is received. Ex. 1008, 12. In this state, the title bar only shows the information related to the corresponding program. *Id.*

Figures 3 and 4, below, show the same Windows title bar after the real-time information is received. *Id.*

Fig. 3

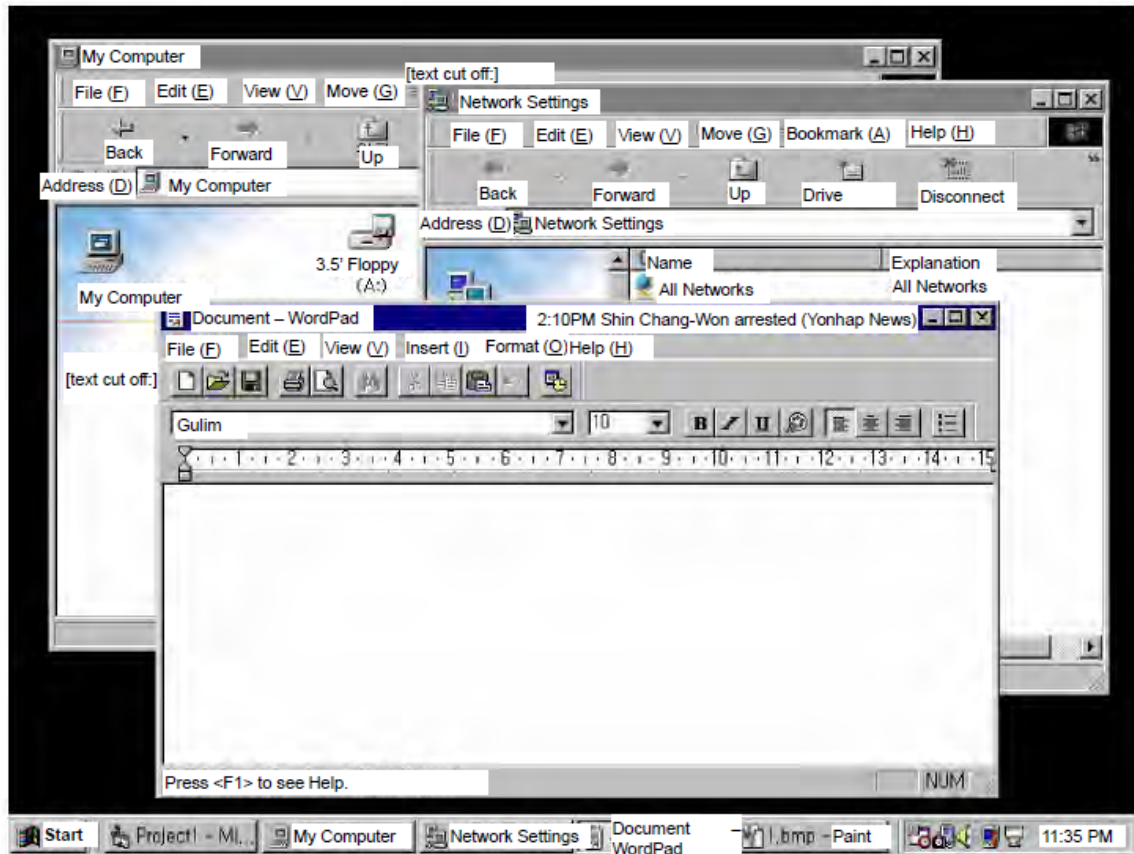


Fig. 4

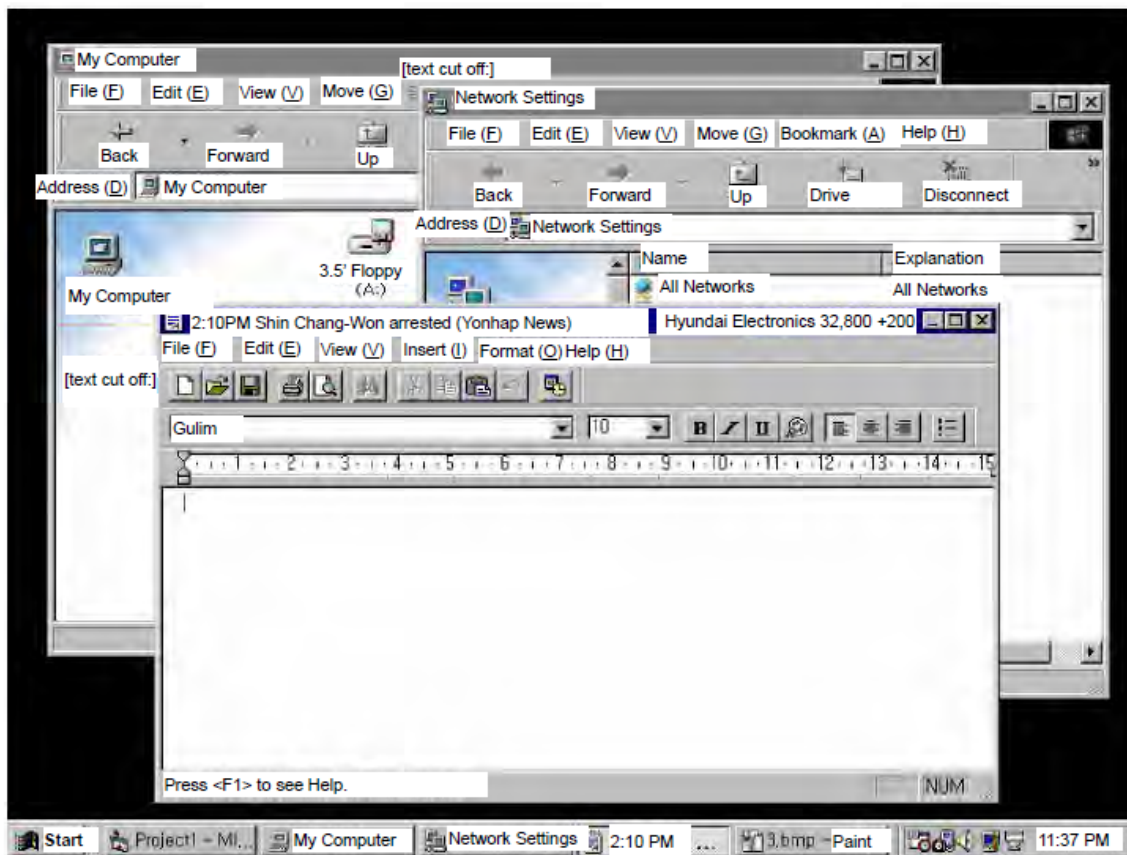


Figure 3 shows a title bar that displays breaking news: “210PM Shin Chang-Won arrested (Yonhap News).” *Id.* Figure 4 shows a title bar that also displays a stock price: “Hyundai Electronics 32,800 +200.” *Id.* On this record, Petitioner sufficiently shows that Kim discloses “providing an alternative title based on the at least one of the plurality of character strings to the process” and “using the alternative title as a title in association with the process.”

Thus, Petitioner has shown a reasonable likelihood that it would establish obviousness of claim 1 over Kim.

3. Claims 2, 3, and 9

Petitioner asserts claims 2, 3, and 9 are anticipated by or obvious over Kim. Pet. 74–76. These claims depend from and incorporate all the limitations from claim 1.

Petitioner sufficiently addresses claims 2, 3, and 9 in the obviousness analysis. *Id.* Patent Owner does not present arguments specifically directed to Petitioner’s assertions about claims 2, 3, and 9. *See* Prelim. Resp. Petitioner has shown a reasonable likelihood that it would prevail in establishing the obviousness of claims 2, 3, and 9 over Kim.

E. Obviousness over Kim and Cheung

Petitioner asserts that claims 1–3 and 6–10 are unpatentable as obvious over the combination of Kim and Cheung. Pet. 76–84; *see id.* at 62–76.

1. Cheung

Cheung describes a “central notifications manager user interface.” Ex. 1007, Abstract, ¶ 27. This interface manages notifications and alerts. *Id.* ¶ 27. Figure 3A, below, is an example of this interface. *Id.* ¶¶ 14, 27.

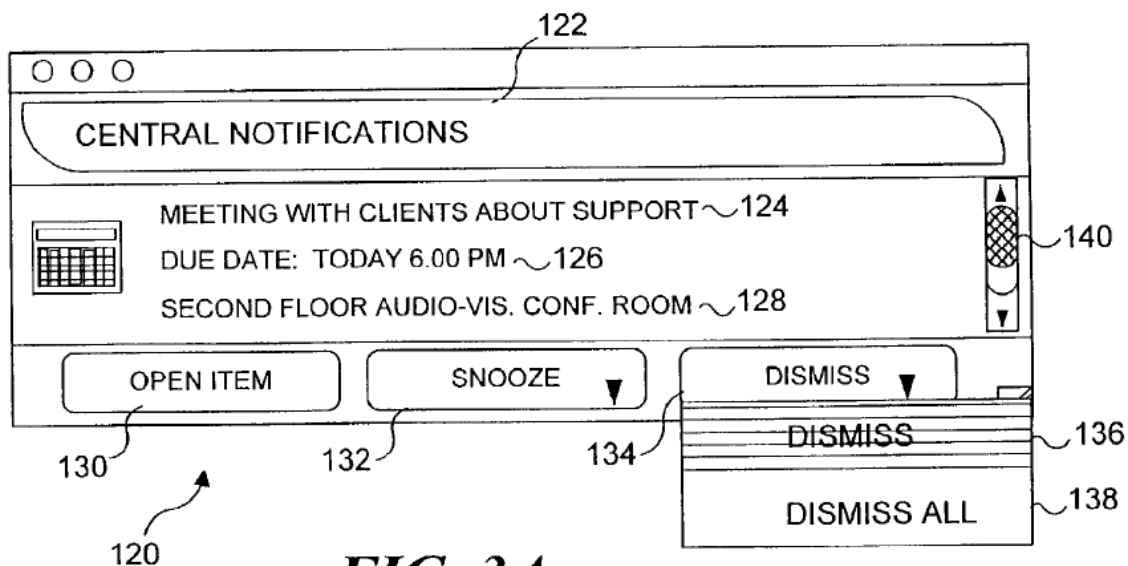


Figure 3A, above, shows central-notification-manager user interface 120 with title bar 122. *Id.* ¶ 30. Title bar 122 “indicates that the current notification is generated by one of the [computer’s] software programs.” *Id.* The figure shows that interface 120 includes lines 124–128, which provide information about the notification to a user. *Id.*

Cheung describes another notification in Figure 5B, below. *Id.* ¶ 18.

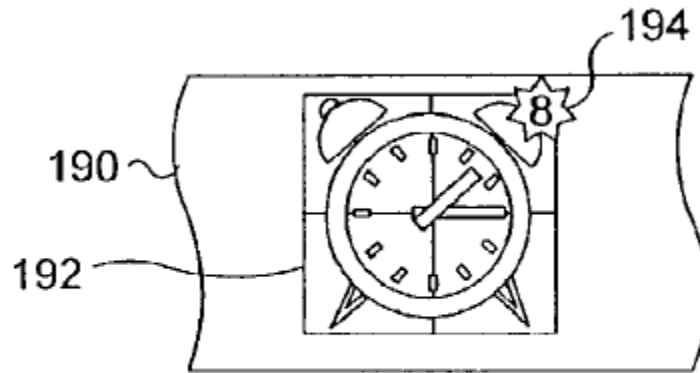


FIG. 5B

As shown in Figure 5B, “[w]hile the central notifications manager application is running, an icon 192 is provided in a dock (or taskbar) 190.” *Id.* ¶ 38. Figure 5B shows that “count 194” is “the number of active notifications and alerts that can be accessed if the user opens the central notifications user interface.” *Id.* In Figure 5B, an icon appears “in the dock or taskbar while the central notification manager is running” *Id.* ¶ 18. The icon shows the number of notifications and active alerts. *Id.*

2. Claims 1–3 and 6–10

Petitioner asserts that “Kim anticipates and/or renders obvious Claims 1-3 and 9 of the ’135 Patent as provided above in Ground 3,” but “[t]o the extent that there are arguably any meaningful differences between those claims and Kim’s disclosures, those differences would have been trivial and obvious modifications to make for a PHOSITA.” Pet. 76–77 (citing

Ex. 1004 ¶ 254). Petitioner explains that one would have been motivated to combine Kim and Cheung because (1) both are directed to Windows notifications, (2) Cheung expressly states a motivation for improving Kim, and (3) the combination involves known techniques to improve devices in a similar way. *Id.* at 82–83. Petitioner explains that “Cheung discloses that its event notification technique and central notifications UI can be used across numerous application suites (e.g., Microsoft Outlook and Microsoft Office),” and “Kim discloses a system and techniques for providing event notifications to an active Windows application window.” *Id.*

Apart from this analysis, Petitioner does not provide a mapping from Cheung’s teachings to the subject matter recited in claims 1–3 and 9. *Id.* at 76–84. Nor does Petitioner fully explain how Kim would be modified by Cheung to arrive at the subject matter recited in claims 1–3 and 9. *Id.* Petitioner’s obviousness rationale discusses the similarities between Cheung and Kim, not the limitations of claims 1–3 and 9. *Id.* at 82–83. Thus, at this stage and on this record, we have concerns about Petitioner’s obviousness analysis of claims 1–3 and 9 under the Kim-Cheung combination.

Claim 6 depends from claim 1 and adds “alternating using the event notification as a title in association with the process with a variation of the event [notification].” Ex. 1001, 13:6–8. Petitioner additionally relies on Cheung’s teaching of using an alleged event notification variation as shown in Cheung’s Figure 5B, i.e., icon 192 provided in taskbar 190, with which is associated count 194 of the number of active notification and alerts. Pet. 79.

Petitioner explains:

In this combination, the “count 194” notification icon of the “number of active notifications and alerts” [of Cheung] would be provided on the titlebar in Kim as an alternating title to show the number of notifications that Kim’s system has received for

display, such as the number of “breaking news” events. This variation on the event notification associated with the breaking news event, for example, would let a user know how many such events had been received for display. EX[1004], ¶¶ 258–59.

Id. at 78–79. But Petitioner does not identify where Cheung describes “the count 194” notification icon as an “alternating” icon relative to some other notification or alert. It appears that this icon is always on display as long as the central notifications manager application is running. Ex. 1007 ¶ 38.

Also, as for the rationale to combine the teachings, Petitioner explains that Cheung discloses that there is a clear benefit for a user of a computing device to receive information of potential value and Cheung notes a “need to better manage the various kinds of notifications and alerts that are presented to a user on a display.” Pet. 82–83 (citing Ex. 1007 ¶ 3; Ex. 1004 ¶¶ 248–251). Dean Willis, Petitioner’s declarant, testifies that “the prior art provides a PHOSITA with the explicit motivation to look to ‘716 Cheung’s display techniques to improve the event notification scheme in ‘288 Kim.” Ex. 1004 ¶ 250. Such alleged motivation to combine teachings is vague and nebulous. Neither Petitioner nor its declarant Dean Willis identifies any specific benefit or advantage to use in Kim the “count 194” notification icon of Cheung as an alternating event notification, in light of the fact that Kim’s events are real-time breaking news or stock prices, which do not require a response.

Petitioner further asserts that the prior art provides one with ordinary skill in the art a reason “to look to Cheung’s techniques to improve the event notification scheme in Kim.” Pet. 82–83. Even so, that does not sufficiently establish what technique in Cheung, if adopted, would result in an improvement of Kim, and why Petitioner also asserts that one with ordinary skill in the art would have understood that Kim and Cheung’s techniques

“could be implemented in Kim with a full expectation of success.” *Id.* at 83. But Petitioner’s accounting lacks adequate explanation of which technique of Cheung one with ordinary skill in the art would have wanted to adopt in Kim for what reason and to achieve what benefit.

Petitioner further asserts that both Kim and Cheung are directed to providing event notifications to Microsoft Windows applications, are from the same time period and field, and concern solutions to similar problems. *Id.* As for the alleged motivation to combine the teachings, these are also vague and nebulous and do not adequately support the combination of teachings.

Claim 7 depends from claim 1 and adds “generating the alternative title as a variation of the event notification.” Ex. 1001, 13:9–10. Petitioner’s reasoning for a variation of event notification as the alternative title is the same as its reasoning for a variation of event notification as the title. Pet. 79. Our analysis for claim 6 applies here.

Claim 8 depends from claim 1 and adds “receiving affirmation that user notification was successful; clearing the array.” Ex. 1001, 13:11–13. Petitioner asserts that Cheung discloses “receiving affirmation that user notification was successful.” Pet. 79. Even assuming that Cheung discloses such a feature, for the same reasons discussed above in the context of claim 6, Petitioner has not adequately explained the motivation for applying Cheung’s teaching to Kim.

Claim 10 depends from claim 1 and adds “using the event notification as a title in association with the process one or more times; removing the event notification from the array.” Ex. 1001, 13:17–20. Petitioner relies on Cheung’s teaching of removing the event notification from storage. Pet. 82. Petitioner explains,

[A] PHOSITA would understand that Cheung's method of removing one or more (including all) event notifications from the associated storage device would improve system performance, including by freeing up storage and processing space (e.g., garbage collection, a well-known concept would be employed in Kim as disclosed in Cheung to improve Kim's system). Ex[1004] ¶ 251.

Id. at 83. The articulated reasoning has rational underpinning and is supported by the cited evidence. Patent Owner has not presented arguments to the contrary for claim 10 in that regard.

As discussed above, Petitioner did not fully explain how Kim would be modified by Cheung to arrive at the subject matter recited in independent claim 1. So, in assessing the Kim-Cheung combination used in the challenge to dependent claim 10, we understand Petitioner to be asserting that Kim teaches or suggests all limitations of claim 1. That is, Petitioner asserts that Kim teaches all the limitations of claim 10 that are from claim 1, and Petitioner relies on a combination of Kim and Cheung to teach the subject matter that is exclusively recited in claim 10. During trial, the parties are invited to discuss whether the Petition adequately supports this understanding. At this stage and on this record, however, Petitioner has shown a reasonable likelihood that it would prevail in establishing obviousness of claim 10 over Kim and Cheung because (1) our concern with respect to claim 1 as obvious over the Kim-Cheung combination, as noted above, is alleviated by Petitioner's express reliance on the teachings of Cheung for claim 10, and (2) Petitioner's argument and evidence for the unpatentability of claim 10 is sufficient for institution.

F. Anticipation and Obviousness over Eaton

Petitioner asserts that claims 1–3, 6, 7, and 9 are unpatentable as anticipated or obvious over Eaton. Pet. 24–53.

1. Eaton

Eaton relates to an instant-messaging system. Ex. 1006, Abstract.

Figure 1, below, is a block diagram of an example system. *Id.* ¶ 14.

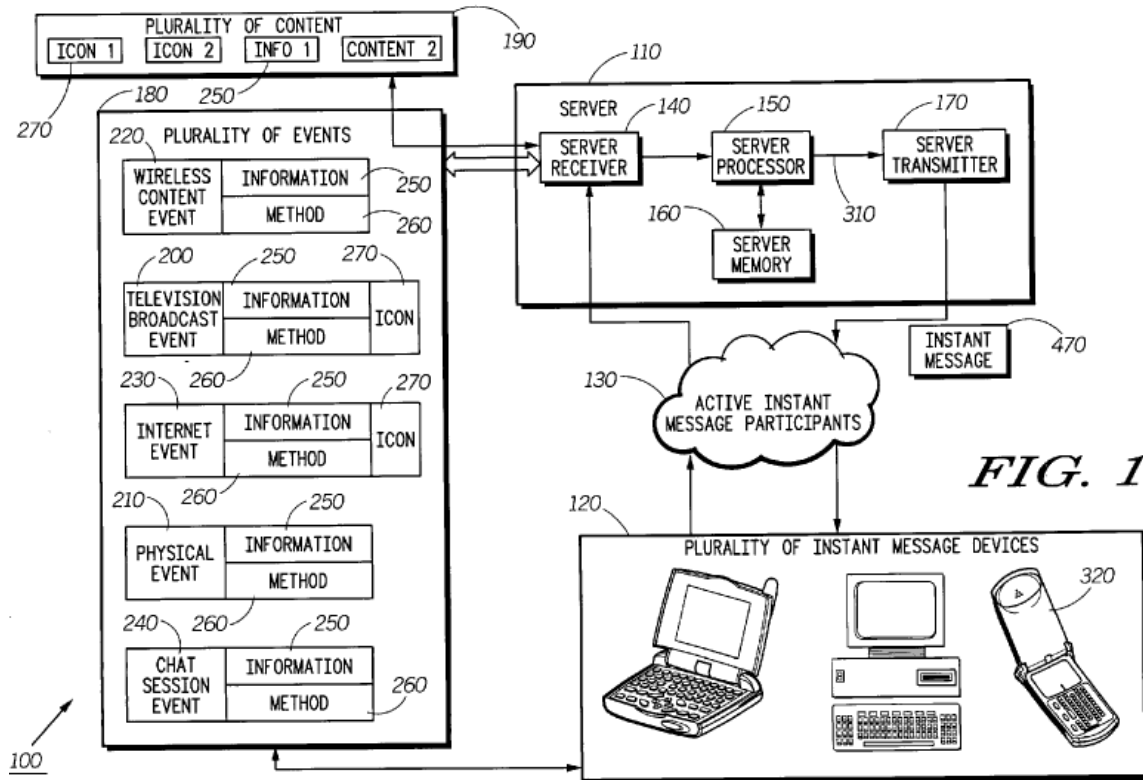


Figure 1, above, shows server 110, server receiver 140, and events 180. *Id.* ¶ 28. Events 180 include, for example, physical events 210 such as sporting events, television or radio broadcast events 200, wireless content events 220, internet events 230, and chat session events 240. *Id.* Events 180 are associated with content 190: event icons 270 and event information 250. *Id.* ¶ 29. Server 110 may use event notifications, schedules of events, or search engines to find available events 180. *Id.* ¶ 33.

In Eaton's interface, events are represented by screen names. *Id.* ¶ 31. Figure 2, below, is a block diagram of a server memory. *Id.* ¶ 15.

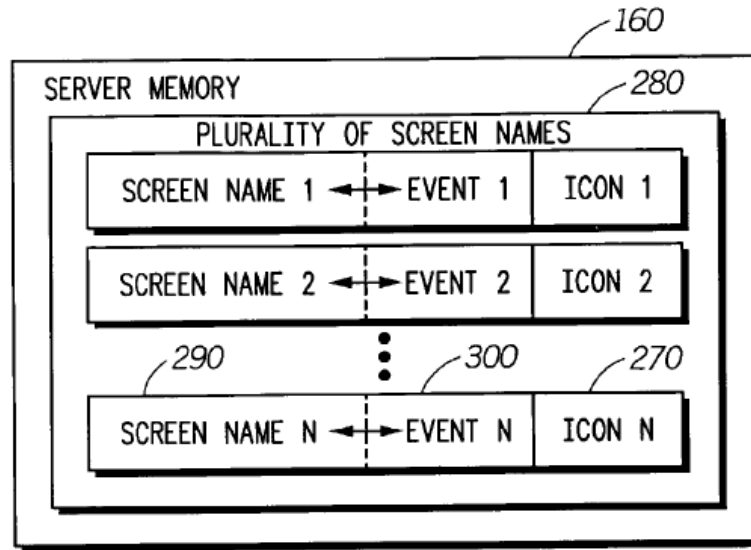


FIG. 2

Figure 2, above, shows server memory 160 storing screen names 280. *Id.* Each screen name 290 represents an event. *Id.* ¶ 31. The server activates a screen name “in response to the presence of” an event. *Id.* ¶ 32. To the user, the activated screen name looks just like any other active instant-message participant (130) in the system. *Id.*

2. Claim 1

Petitioner asserts that claim 1 is anticipated by or obvious over Eaton. Pet. 24–47. For the reasons that follow, we have concerns about the clarity of Petitioner’s analysis. We, however, invite the parties to discuss this ground further at trial.

Claim 1 recites, in part, “receiving information of an event that calls for user notification” and “generating an event notification for the event.” Ex. 1001, 12:42–45.

As for the recited events, Petitioner asserts that “Eaton discloses a server receiver 140 that is ‘coupled to and receives information about a plurality of events 180’ that ‘can include, for example, physical events 210

such as sporting events, television or radio broadcast events 200, wireless content events 220, internet events 230, chat session events 240, or an equivalent.” Pet. 25 (citing Ex. 1006 ¶ 28). These passages from the Petition could be interpreted as asserting that the information about events 180 is the event. *See id.* Alternatively, this sentence could be read as asserting that Eaton’s events, e.g., 210, 200, and 220, correspond to the recited events. *See id.*

In the section analyzing the events, Petitioner also asserts that Eaton’s client receives “information of an event that calls for user notification” because “device receiver 330 receives messages sent within the instant message communication system 100 such as event presence notification messages.” *Id.* at 26 (citing Ex. 1006 ¶¶ 36–38, Fig. 3). Here, it is unclear whether Petitioner regards the messages received by device receiver 330 as the events. *Id.* Apart from quoting Eaton directly and reproducing Figure 3, no further analysis is provided. *Id.* at 25–26.

As for the “event notification,” Petitioner quotes Eaton directly and underlines the phrase that reads, “screen names 280 represent one or more events such as event 300 of the plurality of events 180.” *Id.* at 28 (quoting Ex. 1006 ¶ 31). Petitioner then reproduces direct quotations from Eaton underlining the “event presence notification messages” without further analysis. *Id.* at 27–29. It is possible that Petitioner regards the “event presence notification” messages as the “event notification.” But, such an interpretation would contradict the discussion of the “event presence notification messages” in the section addressing the “events” that suggests the messages are the events. *Id.* at 26.

Claim 1 further recites, “associating the event notification with at least one of the plurality of character strings in a title array that includes a

plurality of character strings.” Ex. 1001, 12:46–49. To address this limitation, Petitioner introduces Eaton’s “topic screen names” into the analysis:

Eaton also discloses that the server memory 160 stores an array of event notifications in Figure 6, as shown with annotations below (“the event notification” in Claim 1 corresponding to any of them, such as “Topic N” that has associated “Event[s] AN-NN,” the first one being “Event AN”).

Pet. 30 (citing Ex. 1006 ¶¶ 56–58, Fig. 6) (emphasis added). Figure 6 with Petitioner’s annotations is reproduced below.

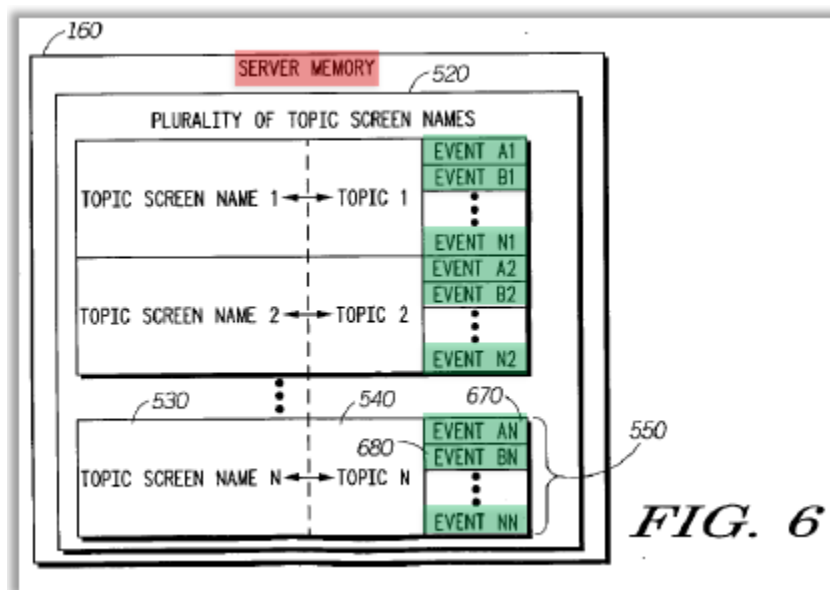


Figure 6, above, is a block diagram of a server memory. Ex. 1006 ¶ 19. This embodiment shows topic screen names 520. *Id.* ¶ 57. A topic may include one or more events. *Id.* ¶ 56. The topic screen names are stored in the server memory 160. *Id.*

Petitioner asserts that Figure 6, above, shows that “the event notifications are associated with the ‘Event AN,’ ‘Topic Screen Name N,’ and ‘Topic N’ character strings stored in the array in server memory 160.” Pet. 31 (citing Ex. 1004 ¶¶ 102–106). Petitioner asserts that Figure 4 also

shows “the event notifications are associated with ‘Event N’ and ‘Screen Name N.’” *Id.*

At this stage and on this record, we agree with Patent Owner that the Petition’s analysis of the “event” and “event notification” is vague:

Petitioner has alternatively and vaguely appeared to claim that “activating a screen name,” “event presence notification messages,” and “Events AN-NN” are event notifications. [Pet.; 27-29; 31]. Petitioner now argues that an event notification (e.g., “Event AN”) is associated with the “Event AN” (i.e., it is associated with itself).

Prelim. Resp. 33. We also agree with Patent Owner that one interpretation of the Petition is that “Event AN” is both the event and event notification.

Id. at 32. Another possible interpretation is that Eaton’s screen names are events and the activated screen name is the recited event notification. *Id.* Yet another is that the event-presence notification message is the event notification. *Id.* We preliminarily determine that these ambiguities also render the Petition’s analysis of the remaining limitations unclear, on this record and at this stage.

3. Character Strings and Title

Claim 1 further recites, “a plurality of character strings for provisioning for display in a titlebar or taskbar of a display device.”

Ex. 1001, 12:48–49 (emphasis added). The remaining limitations refer to these character strings and recite an alternative title:

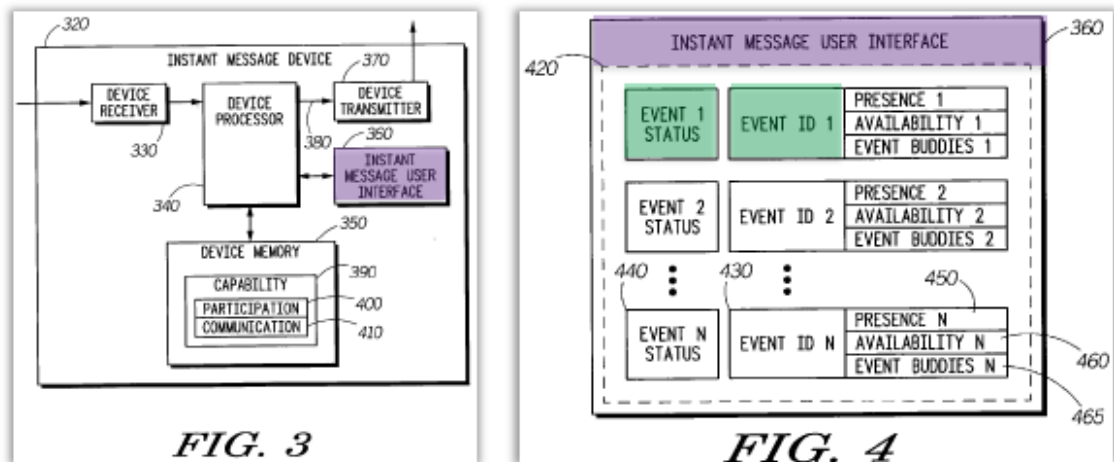
providing the at least one of the plurality of character strings in the title array to a process executed by a processor;

providing an alternative title based on the at least one of the plurality of character strings to the process;

using the alternative title as a title in association with the process.

Id. at 12:42–56.

Petitioner asserts that Eaton’s Figure 3 and 4 show that “each of the plurality of IM devices 120 includes ‘an instant message user interface 360.’” Pet. 33 (citing Ex. 1006 ¶ 37, 45). Eaton’s Figures 3 and 4 are shown below with Petitioner’s annotations.



In Petitioner’s view, Eaton’s “user interface is shaded in purple,” and “exemplary event notifications are shaded in green.” *Id.* That is, in this part of the analysis, Petitioner asserts that “Event 1 Status” and “Event ID 1” are the event notifications. *Id.* According to the Petition, “the display 420 and its display items shown in Figure 4 above is at the top of the user interface and therefore corresponds to a titlebar of the user interface display of IM device 320.” *Id.* at 34–35 (citing Ex. 1004 ¶¶ 112–113).

Even assuming that “Event 1 Status” and “Event ID 1” are the event notifications—putting aside any potential contradictions with other parts of the Petition—the claim requires associating the notifications with “at least one of the plurality of character strings in a title array that includes a plurality of character strings for provisioning for display in a titlebar or taskbar of a display device.” Ex. 1001, 12:45–49. At this stage, we agree with Patent Owner that Petitioner does not “tie the alleged plurality of character strings in the title array that are associated with an alleged event

notification to the character strings that it claims are displayed in Eaton.” Prelim. Resp. 35. In fact, the preliminary record does not indicate that the purple-shaded area in Figure 4 is a title bar at all. Pet. 33. Rather, the boundaries are defined by Petitioner with no clear basis in Eaton’s teachings. *See id.* at 34–35.

We preliminarily agree with Patent Owner that the Willis Declaration offers little support for Petitioner’s assertions about Figure 4 because it refers to “the top of the information displayed below any arguable titlebar, not to a titlebar” (Prelim. Resp. 39):

Further, the display 420 and its display items shown in Figure 4 above is at the top of the user interface and therefore corresponds to a title bar of the user interface display of IM device 320.

Ex. 1004 ¶ 113. This paragraph suggests that Figure 4 shows the actual window displayed to the user. But Eaton’s Figure 4 could be interpreted as a block diagram of an interface, with the elements represented by labeled boxes, not the actual interface elements. So, on this preliminary record, we see little support for the assertions made in paragraph 113 of the Willis Declaration. For these reasons, at this stage, we have concerns about Petitioner’s explanation under either the Petition’s implicit construction of title bar—i.e., the area at the top of a user interface—or a partial construction based on Patent Owner’s argument—i.e., the area at the top of a window. *See* Pet. 34–35; Prelim. Resp. 17; *supra* § II.C.2 (Claim Construction: “titlebar”).

Thus, for these reasons, the preliminary record favors Patent Owner’s arguments about the limitations to displaying the character strings and titles. *See* Prelim. Resp. 35–50.

4. *Claims 2, 3, 6, 7, and 9*

Petitioner asserts that claims 2, 3, 6, 7, and 9 are anticipated by or obvious over Eaton. Pet. 47–53. Petitioner relies on the analysis of independent claim 1 and Eaton based on anticipation. *See id.* So, for the reasons discussed above, we have concerns about the clarity of Petitioner’s analysis of Eaton. *See supra* § II.F. But we invite the parties to discuss this further at trial.

G. *Obviousness over Eaton in combination with Cheung, and Odell*

Petitioner asserts that claims 1–3 and 6–10 are unpatentable as obvious over the combination of Eaton, Cheung, and Odell. Pet. 56–62; *see id.* at 24–55. Petitioner relies on the analysis of independent claim 1 and Eaton based on anticipation. *See id.* We have reviewed the Eaton-Cheung-Odell combination and preliminarily determine that the additional references do not address the issues discussed above in connection with the ground that relies on Eaton alone. *See supra* § II.F. But we invite the parties to discuss this further at trial.

III. CONCLUSION

Petitioner has shown a reasonable likelihood of prevailing as to the unpatentability of at least one of the challenged claims. Thus, we institute an *inter partes* review on all claims challenged in the Petition and on all grounds.

IV. ORDER

It is

ORDERED that, under 35 U.S.C. § 314(a), an *inter partes* review of claims 1–3 and 6–10 of the '135 patent is instituted for all grounds in the Petition; and

FURTHER ORDERED that, under 35 U.S.C. § 314(a), *inter partes* review of the '135 patent is instituted on this Decision's entry date, and under 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is given of the trial's institution.

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