

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LINKEDIN CORPORATION,
Petitioner,

v.

EBUDDY TECHNOLOGIES B.V.,
Patent Owner.

IPR2022-00176
Patent 8,510,395 B2

Before GARTH D. BAER, JASON M. REPKO, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

BELISLE, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. *Case Posture*

LinkedIn Corporation (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1–11 (“Challenged Claims”) of U.S. Patent No. 8,510,395 B2 (Ex. 1001, “the ’395 patent”). Petitioner identifies itself and Microsoft Corporation as real parties in interest. Pet. 1. eBuddy Technologies B.V. (“Patent Owner”) identifies itself as a real party in interest (Paper 4, 1), and timely filed a Preliminary Response to the Petition (Paper 8, “Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314(b) (2018); 37 C.F.R. § 42.4(a) (2021). We may not institute an *inter partes* review “unless . . . 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). 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. 37 C.F.R. § 42.108(a).

Applying those standards, and upon consideration of the information presented in the Petition and Preliminary Response, we determine that Petitioner has demonstrated a reasonable likelihood of success in proving that at least one claim of the ’395 patent is unpatentable. Accordingly, we institute an *inter partes* review as to all Challenged Claims of the ’395 patent on all grounds raised in the Petition. We base our factual findings and conclusions at this stage of the proceeding on the evidentiary record developed so far. This is not a final decision as to the construction of any claim term or the patentability of any claim. Any final decision shall be

based on the full trial record, including any response timely filed by Patent Owner. Any arguments not raised by Patent Owner in a timely filed response may be deemed waived, even if they were presented in the Preliminary Response.

B. Related Proceeding

The parties indicate that the '395 patent, along with three other patents, namely U.S. Patents Nos. 8,230,135 (“the '135 Patent”), 8,402,179 (“the '179 Patent”), and 9,584,453 (“the '453 Patent”), are involved in one U.S. district court action, namely, *eBuddy Technologies B.V. v. LinkedIn Corporation*, No. 1:20-cv-01501 (D. Del.) (“District Court Case”). Pet. 1; Paper 4, 1.

Petitioner also indicates that, concurrently with its Petition here, it “has filed or will file petitions for *inter partes review*” of each of the '135, '179, and '453 Patents. Pet. 1.

C. The '395 Patent

The '395 patent is titled “Contact List Display System and Method,” and issued on August 13, 2013, from U.S. Patent Application No. 12/774,700, filed May 5, 2010, and claims priority through a continuation application to U.S. Provisional Patent Application No. 60/748,988, filed December 9, 2005. Ex. 1001, codes (10), (21), (22), (45), (54), (60), (63).

The '395 patent relates to a “technique for contact list aggregation across a plurality of different networks,” which provides an “aggregated contact list” that “includes a listing of [various] designated IM [instant message] client contacts” from “IM networks, such as MSN Messenger,

Yahoo! Instant Messenger, [and] AIM,” as shown, for example, in Figure 3, reproduced below. Ex. 1001, 1:61–62, 2:5–15, 6:57–59, 8:18–24, Fig. 3.

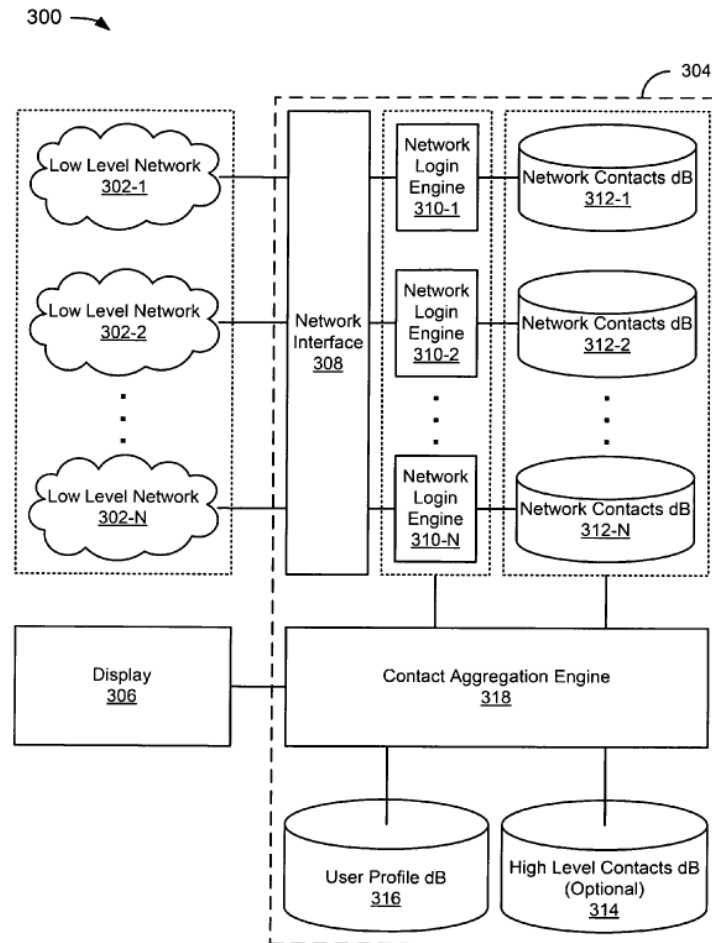


FIG. 3

Figure 3 depicts an exemplary system capable of contact aggregation and display.

Ex. 1001, 2:26–27, Fig. 3.

As shown in Figure 3, “system 300 includes low level networks 302–1 to 302–N (collectively referred to as the low level networks 302), a computer 304, and a display 306.” Ex. 1001, 5:50–53. “The low level networks 302 may include . . . various IM networks” such as “MSN

Messenger, Yahoo! Instant Messenger, AIM, or any other known or convenient network.” *Id.* at 5:54–55, 8:18–24.

According to the ’395 patent, computer 304 includes:

a network interface 308, network login engines 310–1 to 310–N (collectively referred to as network login engines 310), network contacts databases 312–1 to 312–N (collectively referred to as the network contacts database 312), a high level contacts database 314, a user profile database 316, and a contact aggregation engine 318.

Ex. 1001, 5:58–63. Network login engines 310 “facilitate[] login to the various low level networks 302,” e.g., by logging into respective low level networks using respective user name and password information. *Id.* at 6:1–13. Network contacts database 312 “includes contacts data associated with any of the networks into which a user has logged.” *Id.* at 6:14–19.

Additionally, high level contacts database 314 “includes contacts associated with a high level network.” *Id.* at 6:20–22. Network contacts database 312 and high level contacts database 314 “are accessed in such a way that a list of contacts stored in the network contacts database 312 is aggregated and displayed on the display 306.” *Id.* at 6:40–44; *see id.* at Figs. 4A–4B.

System 300 “will automatically login the user to various low level accounts” by “storing login credentials so that the system can automatically login the user to each [account].” Ex. 1001, 6:45–51. After logging into network accounts, “a contact list associated with one or more of the low level networks is maintained.” *Id.* at 8:40–41. For example, as shown in Figure 4A, reproduced below, “contacts list tab 402 includes a listing of designated IM client contacts” and “when a network is added, contacts of the user in the added network are added to the contacts list tab 402.” *Id.* at 6:57–60, 7:4–9; *see* Figs. 4A–4B.

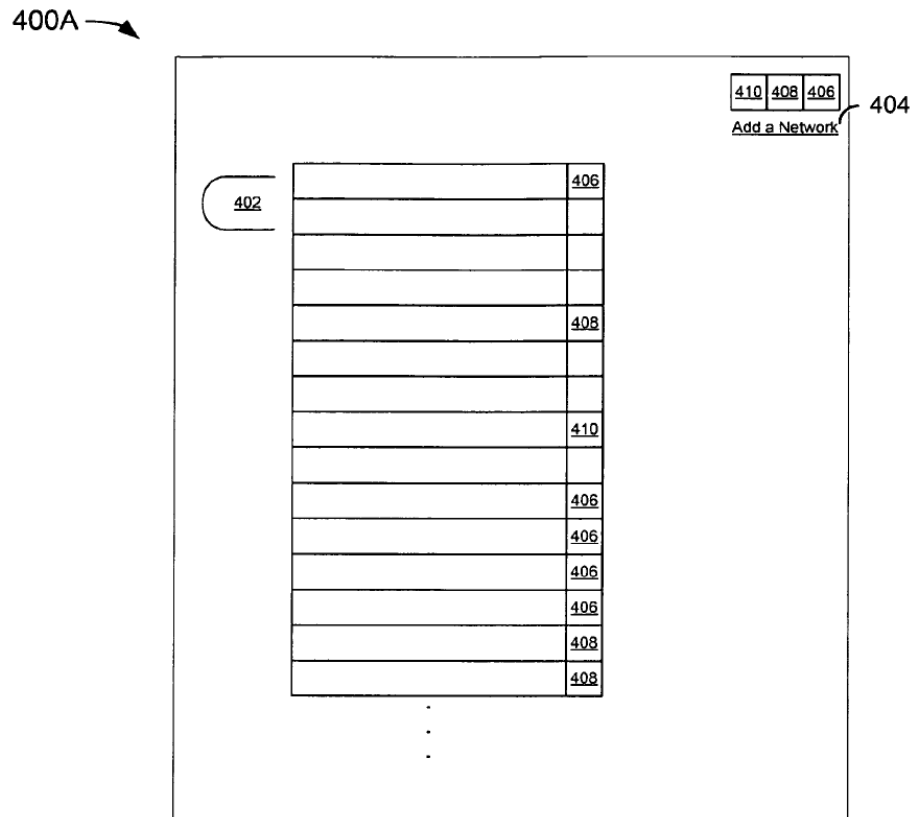


FIG. 4A

Figure 4A depicts an example of a screen shot 400A for a full screen display.

Id. at 6:51–52, 2:28–29, Fig. 4A. As shown above in Figure 4A, screenshot 400A includes contacts list tab 402, an “Add a Network” hyperlink 404, a plurality of MSN icons 406, a plurality of Yahoo! icons 408, and a plurality of AIM icons 410. *Id.* at 6:52–56.

In some embodiments, “the contact list could be maintained in a high level network (i.e., all contacts are listed in the contact list, even if the contacts are from a network that has not been added).” Ex. 1001, 7:10–13. The “contacts from each of the low level networks are displayed in an aggregated contact list” and “the contact list could include high level

contacts, too.” *Id.* at 8:59–67. Additionally, if the system logs out of a particular low level network, then “relevant low level contacts are removed from the aggregated display,” i.e., “contacts that are in the contact list associated with the low level network from which logout was elected.” *Id.* at 9:37–48.

D. Illustrative Claim

The ’395 patent includes eleven claims, all of which are challenged. Claims 1 and 7 are the challenged independent claims. Claim 1 is illustrative and reproduced below.

1. A system comprising:
 - a network login engine;
 - a network contacts database embodied in one or more non-transitory computer readable mediums;
 - a web server coupled to the network contacts database;
 - a contact aggregation engine coupled to the network login engine and the network contacts database;wherein, in operation, the contact aggregation engine:
 - controls the network login engine to login or facilitate login to a first network associated with a first messaging service provider and a second network associated with a second messaging service provider,
 - updates the networks contacts database with contact information obtained from the first messaging service provider and the second messaging service provider,
 - maintains an aggregated contact list that comprises a first contact list associated with the contact information from the first messaging service provider and a second contact list associated with the contact information from the second messaging service provider,
 - stores the aggregated contact list in a non-transitory computer readable medium at the web server, and
 - provides the aggregated contact list to a display device.

Ex. 1001, 12:36–58.

E. Applied References

Petitioner relies upon the following references:

Odell et al., U.S. Patent No. 7,590,696 B1 (Ex. 1006, “Odell”), filed July 21, 2004, issued September 15, 2009.

Daniell et al., U.S. Patent No. 7,185,059 B2 (Ex. 1007, “Daniell”), filed December 19, 2002, issued February 27, 2007.

Pet. 6. Petitioner also relies upon the Declaration of Dean Willis (Ex. 1004).

F. Asserted Grounds of Unpatentability

Petitioner challenges the patentability of claims 1–11 of the ’395 patent based on the following grounds.

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1–11	102 ¹	Odell
1–11	103	Odell
1–11	103	Odell, Daniell

Pet. 6.

II. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 314(a)

A. Overview

Patent Owner requests that we exercise our discretion under 35 U.S.C. § 314(a) to deny the Petition under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). Prelim. Resp. 61–66; see *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”). According to Patent Owner, referring to the District

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. §§ 102 and 103. Because the ’395 patent was filed before March 16, 2013, the effective date of the relevant amendment, the pre-AIA versions of §§ 102 and 103 apply.

Court Case, “Petitioner waited until the very last possible moment to file its petition.” Prelim. Resp. 61. For the reasons that follow, we decline to exercise our discretion to deny *inter partes* review.

In assessing whether to exercise such discretion, the Board weighs the following factors:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

Fintiv at 6. Recognizing that “there is some overlap among these factors” and that “[s]ome facts may be relevant to more than one factor,” the Board “takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.*

We address each *Fintiv* factor below.

B. Factor 1 (Stay of Parallel Proceeding)

“A district court stay of the litigation pending resolution of the PTAB trial allays concerns about inefficiency and duplication of efforts. This fact has strongly weighed against exercising the authority to deny institution under *NHK*.” *Id.* (citing *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential)).

Here, the court in the District Court Case denied Petitioner's stay request but stated,

to the extent it is helpful for the PTAB's institution analysis, the Court can say that: (a) if all four petitions are instituted, Defendant will have a good chance of then obtaining a stay of the case (though the Court would still give Plaintiff an opportunity to argue why a stay is not warranted); (b) if all four petitions are denied, obviously no stay will be sought or granted; and (c) if some petitions are granted and some are denied, it is difficult to predict what will happen in terms of a subsequent stay request.

Ex. 1036. The court ordered the parties to provide a report "indicating the outcome of the petitions and whether Defendant [in the District Court Case] wishes to renew its Motion" after the Board decided whether to institute all four petitions. *Id.* Because the Board has not yet reviewed all the petitions, we cannot say whether the District Court Case has a "good chance" (*id.*) of being stayed. According to the Order, it is "difficult to predict what will happen" if some, but not all, petitions are instituted. *Id.*

Absent specific evidence, the Board, typically, "will not attempt to predict how the district court in the related district court litigation will proceed because the court may determine whether or not to stay any individual case . . . based on a variety of circumstances and facts beyond our control and to which the Board is not privy." *Sand Revolution II LLC v. Cont'l Intermodal Grp.*, IPR2019-01393, Paper 24, 7 (PTAB June 16, 2020) (informative, designated July 13, 2020). We decline to speculate here, and find this factor does not weigh for or against exercising discretion to deny *inter partes* review in this case.

C. Factor 2 (Proximity of Court's Trial Date)

“If the court’s trial date is *earlier than* the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under *NHK*.” *Fintiv* at 9 (emphasis added). That is not the case here: According to the Scheduling Order in the District Court Case, the trial date is June 12, 2023, which is after the Board’s projected statutory deadline for a final decision in May 2023. Ex. 1010, 16. The record lacks any specific evidence showing that the District Court Case’s trial date is in doubt. *See, e.g.*, Prelim. Resp. 62–63; Pet. 83. Because the currently scheduled trial date in the District Court Case is after the projected Board’s deadline to issue a final written decision, we find this factor weighs against exercising discretion to deny *inter partes* review.

D. Factor 3 (Investment in Parallel Proceeding)

Patent Owner argues that, in the District Court Case, “the parties have served infringement and validity contentions, have fully brief[ed] claim construction matters and, by the date of the institution decision will have completed a significant amount of discovery[,] . . . and Patent Owner will have served its final infringement contentions.” Prelim. Resp. 63 (citing Ex. 2003). According to the Oral Order on the Motion to Stay issued on March 4, 2022, in the District Court Case, “the parties are in the later stages of the discovery period, and have already gone back and forth quite a bit regarding disputes over deposition scheduling or e-discovery production.” Ex. 1036.

The Scheduling Order in the District Court Case indicates that the arguments on claim construction have been heard. *See* Ex. 2003, 19 (showing that arguments on claim construction were scheduled for

March 16, 2022); Ex. 1036 (Oral Order on Mar. 4, 2022) (“[T]he parties and the Court are in the midst of preparing for a Markman hearing.”). The claim construction issues potentially overlap somewhat with the issues before the Board because they involve terms such as “aggregated contact list” and high- and low-level networks. *See, e.g.*, Ex. 2001, 15–21 (Petitioner’s Answering Claim Construction Brief); *see infra* §§ III.E.2.a, III.E.2.b (analyzing the arguments about those terms). Thus, considering the type of investment and the overall progress, we have some concerns “instituting would lead to duplicative costs.” *Fintiv* at 9–10 (emphasis added).

Even so, the third *Fintiv* factor also considers Petitioner’s diligence in filing: “If the evidence shows that the petitioner filed the petition expeditiously, such as promptly after becoming aware of the claims being asserted, this fact has weighed against exercising the authority to deny institution under *NHK*.” *Fintiv* at 11. According to Patent Owner, “Petitioner waited until November 10, 2021, almost one year to the day after it was served in the parallel action.” Prelim. Resp. 64.

Petitioner, though, argues that “Patent Owner served infringement contentions about two months [before the Petition was filed], on August 30, 2021.” Pet. 83. “Petitioner has diligently prepared four IPR petitions challenging over 40 claims across four patents identified in Patent Owner’s infringement contentions.” Pet. 83–84. We agree with Petitioner that, in this case, Petitioner acted diligently by filing this Petition two months after being served the infringement contentions. *See, e.g., Dish Network L.L.C. v. Broadband iTV, Inc.*, IPR2020-01359, Paper 15 at 17–20 (PTAB Feb. 12, 2021) (weighing *Fintiv* factor three against discretionary denial when the petition was filed three months after first receiving notice of Patent Owner’s

infringement positions for all asserted claims); *Samsung Elecs. v. Power2B*, IPR2021-01257, Paper 12 at 12 (PTAB Jan. 18, 2022) (determining “that Petitioner has acted diligently in filing the Petition less than two months after receiving preliminary infringement contentions”).

In sum, there has been some investment in the District Court Case so far, but Petitioner was diligent in filing the Petition. Thus, in our overall assessment, we find this factor does not weigh for or against exercising discretion to deny *inter partes* review in this case.

E. Factor 4 (Overlap with Issues Raised in Parallel Proceeding)

“[I]f the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.” *Fintiv* at 12.

Patent Owner argues that “the grounds in Petitioner’s invalidity contentions are the same as in this Petition.” Prelim. Resp. 64 (citing Ex. 2005 (“Exhibit C-1 re Odell”); Ex. 2004 (Petitioner’s Preliminary Invalidity Contentions), 9–13, 24–29). In Patent Owner’s view, the Board would be duplicating the substantial amount of work done in the District Court Case. *Id.* at 64–65.

Petitioner, however, 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. 84.

Although Patent Owner argues that Petitioner has not filed a stipulation in the District Court Case (Prelim. Resp. 65), Petitioner’s assurances in the Petition are sufficient to mitigate concerns over duplication because the Petition provides Patent Owner with a written record. *See*

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. 84), like the one in *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020) (precedential). 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.” *Id.*; *see also Sand II*, Paper 24 at 12 n.5.

Because of Petitioner’s stipulation, we find this factor weighs strongly against exercising discretion to deny *inter partes* review. *See Sotera*, Paper 12 at 19.

F. Factor 5 (Commonality of Parties in Parallel Proceeding)

There is no dispute that Petitioner is a party to the District Court Case. Pet. 84; Prelim. Resp. 65. However, because a final written decision is likely to issue before the district court trial, we weigh this factor against exercising discretion to deny *inter partes* review. *See Huawei Tech. Co. v. WSOU Inv., LLC*, IPR2021-00225, Paper 11 at 14 (PTAB June 14, 2021) (“[T]his factor favors denial if trial precedes the Board’s Final Written Decision and favors institution if the opposite is true.” (internal quotation marks omitted)); *Google LLC v. Parus Holdings, Inc.*, IPR2020-00846, Paper 9 at 21 (PTAB Oct. 21, 2020) (“Here, . . . Petitioner is the defendant in the parallel proceeding. This fact could weigh either in favor of, or

against, exercising discretion to deny institution, depending on which tribunal was likely to address the challenged patent first.”).

G. Factor 6 (Other Circumstances)

When considering whether to exercise discretion to deny a petition, the Board assesses “all the relevant circumstances in the case,” including the Petition’s merits. *Fintiv* at 14–16. Strong merits typically favor granting institution. *Id.* Weak merits favor denial. *Id.*

Petitioner has shown a reasonable likelihood of prevailing as to the unpatentability of at least one of the Challenged Claims. *Infra* § III. Thus, we determine this factor is neutral.

H. Holistic Assessment of Factors

We consider the above factors and take “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Fintiv* at 6. Thus, based on our assessment of the *Fintiv* factors as a whole, we decline to exercise our discretion under 35 U.S.C. § 314(a) to deny *inter partes* review.

III. PATENTABILITY

A. Applicable Law

Petitioner challenges the patentability of claims 1–11 of the ’395 patent on grounds that the claims would have been anticipated under 35 U.S.C. § 102 or obvious under 35 U.S.C. § 103 in light of various references, namely Odell and Daniell. “In an [*inter partes* review], the petitioner has the burden from the onset to show *with particularity* why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the

evidence that supports the grounds for the challenge to each claim”)) (emphasis added). This burden never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof in *inter partes* review).

To serve as an anticipatory reference under 35 U.S.C. § 102, “the reference must disclose each and every element of the claimed invention, whether it does so explicitly or inherently.” *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009). “The identical invention must be shown in as complete detail *as is contained in the . . . claim.*” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989) (emphasis added). The elements must be arranged as required by the claim, “but this is not an ‘*ipsissimis verbis*’ test,” i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 832–33 (Fed. Cir. 1990) (citing *Akzo N.V. v. United States Int’l Trade Comm’n*, 808 F.2d 1471, 1479 & n.11 (Fed. Cir. 1986)).

A claim is unpatentable under 35 U.S.C. § 103 if “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *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 skill in the art; and (4) when of record, objective evidence of obviousness or non-obviousness, i.e., secondary considerations. *Graham v.*

John Deere Co., 383 U.S. 1, 17–18 (1966). Secondary considerations may include the following: “commercial success, long felt but unsolved needs, failure of others, etc.”² *Id.* The totality of the evidence submitted may show that the challenged claims would not have been obvious to one of ordinary skill in the art. *In re Piasecki*, 745 F.2d 1468, 1471–72 (Fed. Cir. 1984). When evaluating a combination of teachings, we must also “determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

We analyze the challenges presented in the Petition in accordance with the above-stated principles.

B. Level of Ordinary Skill in the Art

Petitioner contends that a person of ordinary skill in the art, at the time of the invention of the ’395 patent:

would have [had] 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, Javascript, Linux and the X-Window System (X11); and Internet Engineering Task Force (IETF) standards including the Session Initiation Protocol and its messaging extension, as well as the “Extensible Messaging and Presence Protocol. Alternatively, a PHOSITA would possess equivalent additional formal education such as graduate studies, or work experience to replace formal education.

² At this stage of the proceeding, Patent Owner has not presented objective evidence of non-obviousness.

Pet. 7 (citing Ex. 1004 ¶¶ 31–34) (internal citations omitted).

Similarly, Patent Owner contends that the skilled artisan:

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. 11. Patent Owner submits that “Petitioner’s statement of the qualifications of [the skilled artisan] is somewhat different, but under either statement of qualifications, Petitioner’s arguments lack persuasiveness and a substantial new question of patentability has not been shown.” *Id.*

Neither party argues that the outcome of this case would differ based on our adoption of any particular definition of the level of ordinary skill in the art. Although slight differences exist in the formulation of such skill level between the parties, we discern no meaningful differences because none of those differences would affect the outcome of our analysis.

Accordingly, we apply the level of skill set forth in the preceding paragraphs, which also is consistent with the prior art before us. *See In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (determining that the Board of Patent Appeals and Interferences did not err in concluding that the level of ordinary skill in the art was best determined by the references of record).

C. Claim Construction

We construe claims “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) (2020); *see also Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

In this context, claim terms “are generally given their ordinary and customary meaning” as understood by a person of ordinary skill in the art in question at the time of the invention. *Phillips*, 415 F.3d at 1312–13; *see CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002) (There is “a ‘heavy presumption’ that a claim term carries its ordinary and customary meaning.”). “In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17). Extrinsic evidence is “less significant than the intrinsic record in determining ‘the legally operative meaning of claim language.’” *Phillips*, 415 F.3d at 1317.

Only those claim terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (stating that “we 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))).

Petitioner argues that “unless otherwise specifically noted [in the Petition], the claim terms in the ’395 Patent are accorded their ordinary and customary meaning.” Pet. 6. Petitioner also submits that its “interpretation of the claim terms is further explained for each claim limitation in relation to

the prior art discussed in invalidity Grounds 1 and 2 [in the Petition].”

Pet. 6. However, in the Petition, Petitioner does not provide any express claim construction for any term in the Challenged Claims, and instead, appears to invite us to interpret critical or dispositive terms, as Petitioner does, to accommodate Petitioner’s application of the applied references.

Patent Owner also does not provide any express claim construction for any term in the Challenged Claims. Instead, Patent Owner takes issue with Petitioner’s use of “ordinary and customary” meanings: “[N]o constructions are offered and no framework for evaluating the claims is proposed. . . . To the extent the petition alleges it is applying the ‘ordinary meaning’ of the claims, Petitioner has not explained what any ‘ordinary meanings’ of the claims are.” Prelim. Resp. 12 (internal citations omitted). Patent Owner argues that various critical or dispositive terms in the Challenged Claims do not accommodate Petitioner’s application of the applied references.

In determining whether Petitioner has demonstrated a reasonable likelihood of establishing unpatentability of at least one challenged claim in this case, we need not and do not construe expressly any claim terms. *See Nidec*, 868 F.3d at 1017.

Nevertheless, during trial, we encourage the parties to discuss whether the ordinary and customary meaning of each of the terms “aggregated contact list,” “contact aggregation engine,” and “messaging service provider” that is applied in the Petition is correct or whether the correct construction for any such term is different.

D. Obviousness of Claims 1–11 over Odell or over the Combination of Odell and Daniell

Petitioner asserts each of claims 1–11 is unpatentable under three separate and distinct grounds: (1) anticipation by Odell; (2) obviousness over Odell; and (3) obviousness over the combination of Odell and Daniell (although Petitioner defines (1) as “Ground 1” and (2) and (3) together as “Ground 2”). Pet. 6. Because we determine that Petitioner demonstrates a reasonable likelihood of success in establishing the unpatentability of claims 1–11 as anticipated by Odell such that we institute this proceeding, and because we must therefore institute *inter partes* review on all claims and all challenges in the Petition (*see SAS Inst.*, 138 S. Ct. at 1355–56; CTPG 64), for purposes of institution, we need not and do not address herein Petitioner’s assertions of obviousness of claims 1–11 over Odell alone or over the combination of Odell and Daniell. *See Cohesive Techs., Inc. v. Waters Corp.*, 543 F.3d 1351, 1364 (Fed. Cir. 2008) (“[I]t is commonly understood that prior art references that anticipate a claim will usually render that claim obvious.”).

E. Anticipation of Claims 1–11 by Odell

Petitioner contends claims 1–11 are unpatentable under 35 U.S.C. § 102 as anticipated by Odell (Ex. 1006). Pet. 18–70. Patent Owner opposes Petitioner’s contentions. Prelim. Resp. 1–10, 23–53. Based on our review of the record before us, we determine that Petitioner has established a reasonable likelihood that it would prevail in showing that claims 1–11 are unpatentable as anticipated by Odell, as discussed below. We turn first to an overview of Odell.

1. Overview of Odell (Ex. 1006)

Odell relates to a system that “link[s] multiple accounts that are held by [a] user for use in a communications system, such as an instant messaging system.” Ex. 1006, 1:31–32, 2:65–67. In particular, the system provides “a single [graphical user interface (GUI)] show[ing] a buddy list, or a list containing the users of the communications system . . . for the primary account and each of the linked accounts.” *Id.* at 3:12–17. Figure 4C, reproduced below, is an “exemplary interface[] for showing buddy lists for multiple linked instant messaging accounts.” *Id.* at 1:57–59.

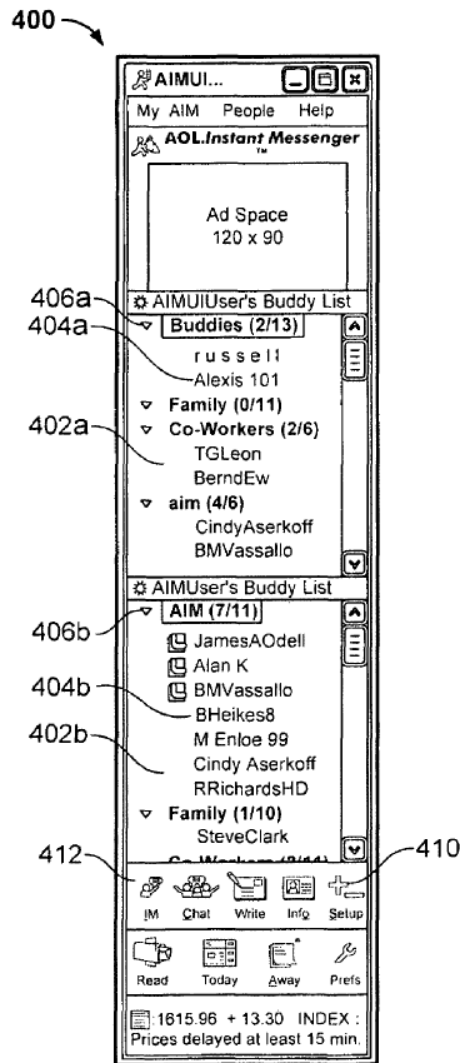


FIG. 4C

Figure 4C depicts a buddy list interface for displaying buddy lists for all linked accounts simultaneously.

Id. at 9:10–12, Fig. 4C.

As shown in Figure 4C above, “more than one of the buddy lists from the linked accounts may be simultaneously displayed to the user.” Ex. 1006, 3:22–25; 9:10–12. “[B]uddy list interface 400 includes a buddy list 402a for an account with a screen name AIMUIUser and a buddy list 402b for an account with a screen name AIMUser.” *Id.* at 9:12–15. Further, “[a]ccounts from multiple communications systems may be linked together. For

example, accounts from America Online (AOL), America Online Instant Messenger (AIM), and ICQ,” i.e., different communications systems, “may be linked together so that communications may be sent over multiple communications systems using only one client program.” *Id.* at 8:14–19.

Odell’s system for linking and displaying respective buddy lists, i.e., contacts, from multiple communications systems is shown in Figure 3, reproduced below.

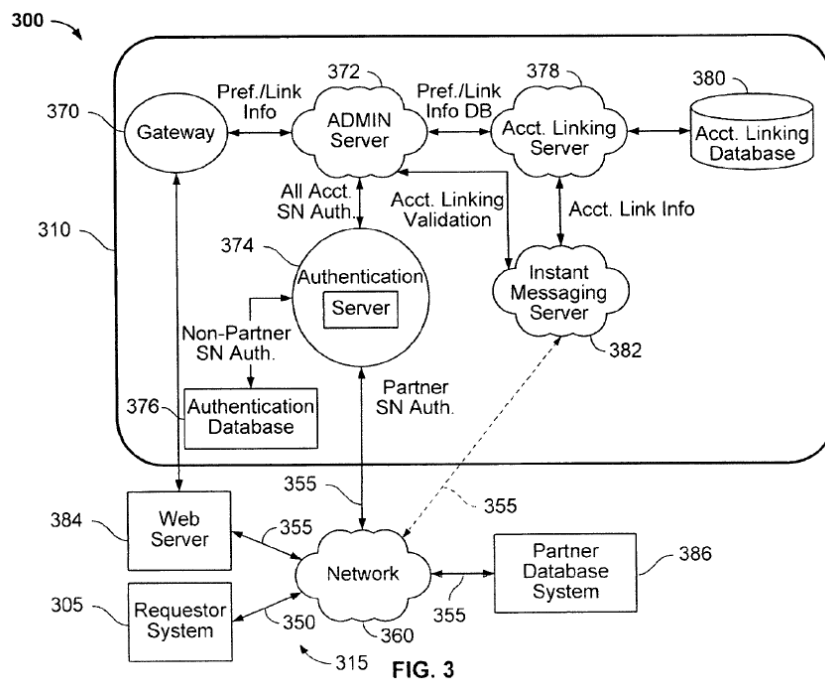


Figure 3 depicts a block diagram of communications system 300.

Ex. 1006, 1:53–55, 6:32, Fig. 3. As shown in Figure 3 above, communications system 300 includes requestor system 305 communicating with provider system 310 through communications link 315. *Id.* at 6:32–34, 4:18–21. “[P]rovider system 310 includes a gateway server 370, an administrative (‘admin’) server 372, an authentication server 374, an

authentication database 376, an account linking server 378, an account linking database 380, and an instant messaging server 382.” *Id.* at 6:47–51.

“[A]dmin server 372 acts as a clearinghouse for the account linking information management and linked account validation functions.”

Ex. 1006, 6:58–60. “Accounts may be authenticated and validated on different basis including the presence of a correct account name and password.” *Id.* at 7:10–12. Further, “admin server 372 manages the account linking information and profiles in association with each screen name,” and “saves linking information from successful processes in the account linking database 380 through the account linking server 378.” *Id.* at 6:60–65.

According to Odell, “[t]he account linking server 378 interacts with the account linking database 380, *which stores and maintains user buddy list and account linking information.*” Ex. 1006, 7:20–22 (emphasis added).

Odell explains:

The account linking server 378 is configured to manage the information flow to and from the account linking database 380. The type of information contained in the account linking database 380 may include, but is not limited to, users settings of account linking information. The account linking information may be organized in different manners. In one exemplary implementation, the account linking information is organized by screen name. In other implementations, the account linking information may be organized by guid, a unique identifier used in the Open Name Space.

Id. at 7:22–32. Further, “[o]nce accounts have been validated,” account linking server 378 updates that validated account information in account linking database 389. *Id.* at 7:7–10.

Odell’s communications system 300 provides “a single client program and a single, common GUI,” through which “communications can be sent

substantially simultaneously to and from the primary account and the aliases of the primary account,” i.e., linked additional accounts. Ex. 1006, 7:60–61, 8:2–5.

We further discuss below the disclosure of Odell in connection with the parties’ arguments.

2. *Analysis*

a) *Independent Claim 1*

Petitioner provides an element-by-element analysis of independent claim 1 in relation to Odell. Pet. 18–55. Petitioner’s analysis relies on testimony from its declarant, Mr. Willis. Ex. 1004 ¶¶ 61–127. Patent Owner opposes. Prelim. Resp. 23–46. As discussed below, Petitioner contends each limitation in claim 1 is disclosed by Odell.

(1) (Preamble) “A system comprising:”

Petitioner contends that Odell meets the preamble by disclosing communications system 300 as shown, for example, in Figure 3 of Odell. Pet. 18–19 (citing Ex. 1004 ¶¶ 61–66; Ex. 1006, 2:34–41, 2:65–67, Fig. 3). Patent Owner does not contend otherwise at this stage of the proceeding. Nonetheless, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378. For the reasons given by Petitioner, we determine that Odell discloses this element of the claim.³

³ Neither party at this stage of the proceeding argues that the preamble of claim 1 is limiting. We likewise express no view herein.

(2) *“a network login engine”*

Petitioner contends that Odell discloses this limitation by describing an authentication server 374 to facilitate a user’s login to multiple networks, including a “primary account” in order to automatically sign in to other “linked accounts” across various networks. Pet. 20–26 (citing Ex. 1004 ¶¶ 67–76; Ex. 1006, 2:47–49, 2:65–3:31, 6:32–65, 7:4–19, 7:33–40, 7:60–65, 8:14–32, 11:15–24, 12:18–50, 14:36–15:5, Figs. 3, 6B, 7, 10).

For the reasons stated in the Petition at pages 20–26, Petitioner sufficiently establishes that Odell discloses this limitation. Patent Owner does not contend otherwise at this stage of the proceeding.

(3) *“a network contacts database embodied in one or more non-transitory computer readable mediums”*

Petitioner contends that Odell discloses this limitation by describing “‘an account linking database 380’ that ‘stores and maintains user buddy list and account linking information.’” Pet. 26 (citing Ex. 1004 ¶¶ 77–83; Ex. 1006, 7:20–22, Fig. 3). Petitioner argues, *inter alia*, “the ‘user buddy list information’ that is ‘store[d]’ in account linking database 380 includes a user’s full ‘set of buddy lists’ from all linked accounts.” Pet. 26–27 (citing Ex. 1004 ¶¶ 77–78); *see* Pet. 27 (“This information—all of a user’s contacts (‘buddy lists’ in the language of Odell) from all linked accounts across ‘multiple communications systems’ (i.e., across networks)—is stored in the account linking database 380.”). Petitioner’s declarant, Mr. Willis, also testifies that “[t]he ‘buddy list information’ stored and maintained in account linking server 380 would by necessity include the ‘network contacts,’” and “account linking database 380 must store all buddy lists for a user from all

linked accounts across multiple communication system as part of storing all ‘buddy list information.’” Ex. 1004 ¶ 78.

Petitioner also argues account linking database 380 is a network database, because “it is in communication with the ‘account linking server 378,’ and Odell discloses that provider system 310—which includes the account linking database 380—is ‘arranged to operate within . . . one or more Local Area Networks (‘LANs’) and/or one or more Wide Area Networks (‘WANs’).” Pet. 27–28 (citing Ex. 1006, 4:6–10, 6:43–46) (alteration in original). Petitioner argues account linking database 380 is embodied in a non-transitory computer readable medium, because Odell discloses “stor[ing]” and maintaining buddy list information, and that “[s]torage devices suitable for tangibly embodying . . . data include all forms of non-volatile memory.” Pet. 28 (citing Ex. 1004 ¶ 82; Ex. 1006, 34:64–35:13, 10:63–66) (second alteration in original, emphasis omitted).

Patent Owner argues “Odell is silent as to where the user’s buddy lists are stored.” Prelim. Resp. 28. In particular, Patent Owner argues “[f]undamentally, the ‘account linking database’ on which the Petition relies does not contain the user’s buddy list or a contact list,” because “as Odell describes, the account linking server ‘maintains user buddy list and account linking information’ . . . , *i.e.*, information about the user buddy list – *not* the buddy list itself.” *Id.* Patent Owner proffers “the user’s buddy lists are likely stored separately by account and somewhere on the user’s local machine.” *Id.* We find Patent Owner’s attorney argument here unavailing, particularly in view of Mr. Willis’s uncontroverted testimony to the contrary (discussed above). *See In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974) (“Attorney’s argument in a brief cannot take the place of evidence.”).

Accordingly, for the reasons stated in the Petition at pages 26–28, Petitioner sufficiently establishes that Odell discloses this limitation.

(4) *“a web server coupled to the network contacts database”*

Petitioner contends that admin server 372 in Odell discloses this limitation, “because the admin server 372 is disclosed as operating within a LAN or WAN (exemplary ‘networks’ that the ’395 Patent discloses the ‘web server’ operating within) and because it is coupled to account linking database 380 in Odell (the claimed ‘network contacts database’).” Pet. 34 (citing Ex. 1004 ¶¶ 84–91); *see* Pet. 29–34 (citing, *inter alia*, Ex. 1006, 4:6–10, 6:43–46, 6:57–65, Fig. 3); *see also* Pet. 34–37 (arguing in the alternative that Odell’s web server 384 discloses this limitation) (citing Ex. 1004 ¶¶ 92–95; Ex. 1006, 4:57–65, 6:32–65, Fig. 3).

For the reasons stated in the Petition at pages 29–37, Petitioner sufficiently establishes that Odell discloses this limitation. Patent Owner does not contend otherwise at this stage of the proceeding.

(5) *“a contact aggregation engine coupled to the network login engine and the network contacts database”*

Petitioner contends that Odell discloses this limitation by describing admin server 372 (“contact aggregation engine”), which is coupled to authentication server 374 (“network login engine”) and account linking database 380 (“network contacts database”). Pet. 37–39 (citing, *inter alia*, Ex. 1004 ¶¶ 96–104; Ex. 1006, Fig. 3). Petitioner argues (and to which Mr. Willis also testifies (Ex. 1004 ¶¶ 100–101)):

admin server 372 handles the aggregation or linking of buddy lists obtained from accounts in a multitude of networks because

... Odell discloses that the admin server 372 is the “clearinghouse” server for “linking information management”: “The admin server 372 acts as a clearinghouse for the account linking information management and linked account validation functions,” including “manag[ing] the account linking information and profiles in association with each screen name,” and the “admin server 372 . . . saves linking information from successful [linking and authentication] processes in the account linking database 380 through the account linking server 378.” [Ex. 1006], 6:57–65 (emphasis added). Furthermore, “[o]nce accounts have been validated, the admin server” will “update that information in the account linking database 389 through the account linking server 378.” *Id.*, 7:4–10 (emphasis added).

Pet. 38 (alterations in original). Petitioner also contends, in the alternative, the combination of admin server 372 and account linking server 378 discloses the claimed “contact aggregation engine.” Pet. 40–41 (citing, *inter alia*, Ex. 1004 ¶¶ 96–104). Petitioner argues admin server 372 manages account linking information and profile information for each linked account, and it interacts with the account linking server 378 to do this: “Odell further explains that the ‘account linking server 378 interacts with the account linking database 380, which stores and maintains user buddy list and account linking information,’ and the ‘account linking server 378 is configured to manage the information flow to and from the account linking database 380.’” Pet. 40 (citing Ex. 1006, 7:20–24).

Patent Owner argues, “[d]espite the Petition’s claim that ‘admin server 372 handles the aggregation or linking of buddy lists obtained from accounts in a multitude of networks,’ there simply is no such disclosure in Odell.” Prelim. Resp. 30. Patent Owner argues “Odell does not describe aggregation of any type – and certainly no aggregation of buddy lists.” *Id.* Patent Owner argues “[t]he described account linking of Odell, which

merely links different accounts, each having its own contact list, does not result in an aggregated contact list described and claimed in the ‘395 Patent.” *Id.* But Patent Owner does not direct us to any evidence supporting these plain attorney arguments, which we find unavailing, particularly in view of Mr. Willis’s uncontroverted testimony to the contrary (discussed above). *See In re Pearson*, 494 F.2d at 1405.

We note that most, if not all, of Patent Owner’s arguments against unpatentability in this proceeding, at least at this stage, are premised on its position that although “Odell teaches that multiple, single, non-aggregated buddy lists may be displayed concurrently in a single GUI [graphic user interface],” “[a] single GUI with concurrently displayed but separate, non-aggregated lists is not an aggregated buddy list.” Prelim. Resp. 27; *see, e.g., id.* at 9 (“[T]wo single and separate buddy lists, even when displayed simultaneously, do not comprise or disclose an aggregated contact list.”). Based on the record before us, however, we disagree with this premise, as further discussed below in Section III.E.2.a.8.

Accordingly, for the reasons stated in the Petition at pages 37–41, Petitioner sufficiently establishes that Odell discloses this limitation.

- (6) *“wherein, in operation, the contact aggregation engine: controls the network login engine to login or facilitate login to a first network associated with a first messaging service provider and a second network associated with a second messaging service provider”*

Petitioner contends that Odell discloses this limitation by describing admin server 372 as controlling authentication server 374 (“network login engine”) to sequentially login to multiple networks associated with more

than one messaging service, “such as a first network associated with America Online (AOL) and a second network associated with America Online Instant Messenger (AIM) or ICQ [derived from the English phrase “I Seek You”].” Pet. 41 (citing Ex. 1004 ¶¶ 105–107). Petitioner argues the ’395 patent “expressly recognizes at least AIM and ICQ as distinct ‘instant messaging services.’” Pet. 41 (citing Ex. 1001, 1:40–45); *see* Ex. 1001, 3:52–55 (“The IM network 108 may include one or a combination of *networks* selected from MSN Messenger, Yahoo! Messenger, *AIM AOL*, *ICQ*, QQ, Jabber, Google Talk, IRC, or some other known or convenient IM *network*.” (emphases added)).

Petitioner argues “Odell discloses that a first account and subsequent accounts, such as a second account, are logged into sequentially and automatically.”

For instance, “[w]hen a first account is linked to a second account . . . either account may be used to sign on to the communications system initially and then any other linked accounts may be signed on to the communications system automatically.” Ex[1006], 7:60-65 (emphasis added). In other words, “accounts that are linked to the primary account are signed in to the communications system sequentially.” *Id.*, 14:36-15:3 (emphasis added). Odell also expressly discloses that “[a]ccounts from multiple communications systems may be linked together,” such as “accounts from America Online (AOL), America Online Instant Messenger (AIM), and ICQ.” *Id.*, 8:14-32 (emphasis added).

Pet. 42 (alterations in original). Petitioner submits that Odell discloses this limitation because Odell’s “admin server 372 controls the authentication server 374 (the claimed ‘network login engine’) to sequentially login into multiple networks, such as a first account associated with the AOL messaging service provider and a second account associated with another

messaging service provider such as AIM or ICQ.” Pet. 42–43 (citing Ex. 1004 ¶¶ 105–107). Petitioner’s declarant, Mr. Willis, testifies that “[t]hese multiple accounts are equivalent to first and second ‘networks’ and ‘messaging services’.” Ex. 1004 ¶ 105.

Patent Owner argues Odell does not disclose (a) a first network associated with a first messaging service provider or (b) a second network associated with a second messaging service provider, because “[a]t most, Odell describes a single messaging service system provided by America Online.” Prelim. Resp. 31. Alternatively, Patent Owner argues:

Even if the example of AOL, AIM and ICQ is considered to disclose multiple stand-alone systems (not sub-systems of America Online’s system, which is what they are) – there is still no disclosure in Odell of first and second networks associated with first and second messaging service providers. Rather, as discussed above, it discloses a single “provider system” which may comprise multiple “accounts,” all of which are on a single network and part of a single messaging service provider.

Id. at 31–32. Based on the record before us, we find Patent Owner’s arguments unavailing.

Patent Owner asserts repeatedly that Odell’s “accounts” are not “networks” and AOL, AIM, and ICQ are not different messaging service providers but rather a single network or communications system operated by America Online. Prelim. Resp. 31–34. But it does so divorced from the actual, broad limitations of claim 1, using only attorney-argument, and without telling us, for example, why the claimed “messaging service provider[s]” cannot encompass AOL, AIM, and ICQ. Patent Owner’s argument here also appears belied by the ’395 patent itself, which, as noted by Petitioner (Pet. 41), explicitly describes at least AIM and ICQ as distinct “instant messaging services” and as each being associated with a “network”

(Ex. 1001, 1:40–45, 3:52–55). Indeed, Patent Owner appears to argue—with no evidentiary support—that because America Online allegedly owned or operated each of AOL, AIM, and ICQ at the time of Odell, those systems must constitute a single network of a single messaging service provider (Prelim. Resp. 31–32). But neither claim 1 nor the Specification of the ’395 patent defines or distinguishes “networks” or “messaging service provider[s]” based on ownership or control.

At this stage of the proceeding, we preliminarily determine the ’395 patent recognizes that AIM and ICQ are distinct messaging services:

Popular instant messaging services on the public Internet include .NET Messenger Service, *AOL Instant Messenger*, Excite/Pal, Gadu-Gadu, Google Talk, iChat, *ICQ*, Jabber, Qnext, QQ, Meetro, Skype, Trillian and Yahoo! Messenger.

Ex. 1001, 1:40–45 (emphases added). Similarly, Odell explains that “America Online (AOL), America Online Instant Messenger (AIM), and ICQ may be linked together so that communications may be sent over *multiple communications systems* using only one client program.” Ex. 1006, 8:14–19 (emphasis added). Thus, based on the record before us, we preliminarily determine that Petitioner has sufficiently shown that at least AIM and ICQ, as disclosed by Odell, are distinct messaging services. *See* Pet. 41–43.

Accordingly, for the reasons stated in the Petition at pages 41–43, Petitioner sufficiently establishes that Odell discloses this limitation.

- (7) “[wherein, in operation, the contact aggregation engine:] updates the networks contacts database with contact information obtained from the first messaging service provider and the second messaging service provider”

Petitioner contends that Odell discloses this limitation by describing admin server 372 (“contact aggregation engine”) as updating account linking database 380 (“network contacts database”) with contact information from all linked accounts, including across IM networks.” Pet. 43–44 (citing, *inter alia*, Ex. 1004 ¶¶ 108–110). Specifically, Petitioner argues:

The admin server 372 acts as a clearinghouse for the account linking information management and linked account validation functions. The admin server 372 manages the account linking information and profiles in association with each screen name. The admin server 372 is configured to process requests received from the gateway 370 and saves linking information from successful processes in the account linking database 380 through the account linking server 378. . . . Once accounts have been validated, the admin server may be configured to **update that information in the account linking database [380] through the account linking server 378.**

Pet. 43–44 (quoting Ex. 1006, 6:58–7:10). Petitioner argues “the account linking server 378 that interacts with and is managed by the admin server 372 further ‘interacts with the account linking database 380, which stores and maintains user buddy list and account linking information.”

Pet. 44 (citing Ex. 1006, 7:20–24).

Patent Owner again argues repeatedly that Odell does not disclose first and second messaging service providers, and therefore, cannot disclose this limitation. Prelim. Resp. 34–37. But as discussed above in Section

III.E.2.a.6, based on the record before us, we find Patent Owner’s premise here unavailing.

Accordingly, for the reasons stated in the Petition at pages 43–44, Petitioner sufficiently establishes that Odell discloses this limitation.

(8) “[wherein, in operation, the contact aggregation engine:] maintains an aggregated contact list that comprises a first contact list associated with the contact information from the first messaging service provider and a second contact list associated with the contact information from the second messaging service provider”

Petitioner contends that Odell discloses this limitation by describing “maintenance and display of an aggregated contact list that comprises the contact lists (i.e., buddy lists) from all linked accounts across the multiple messaging service providers.” Pet. 45 (citing Ex. 1004 ¶¶ 111–112).

In its Petition, Petitioner relies on annotated versions of Odell’s Figures 4A and 4B, reproduced below.

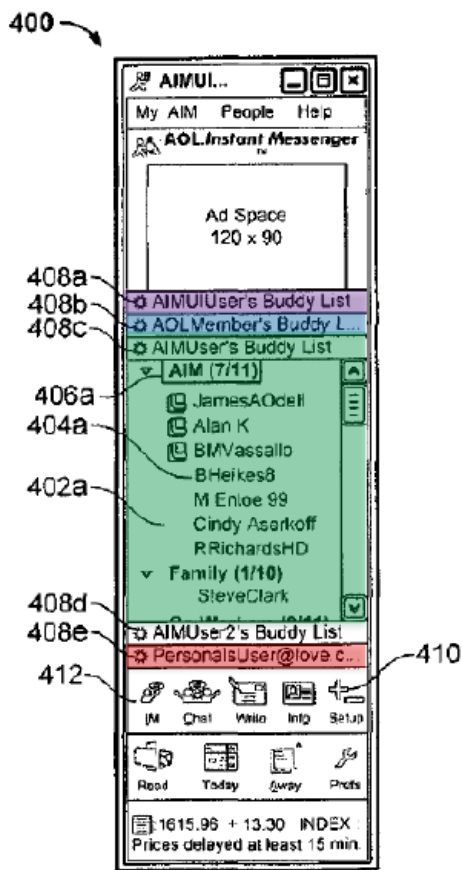


FIG. 4A

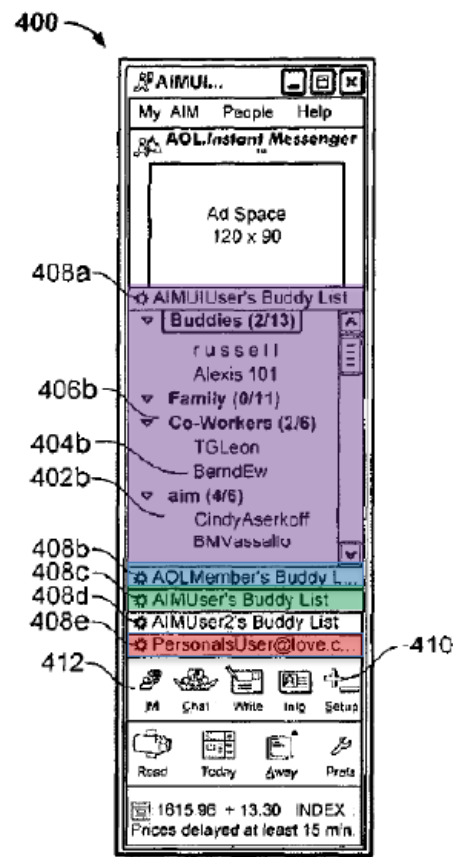


FIG. 4B

Figures 4A and 4B, as annotated by Petitioner, depict exemplary interfaces for showing buddy lists for multiple linked instant messaging accounts.

Pet. 47; Ex. 1006, 1:56–58, Figs. 4A, 4B.

Petitioner also relies on Odell's Figure 4C, reproduced below.

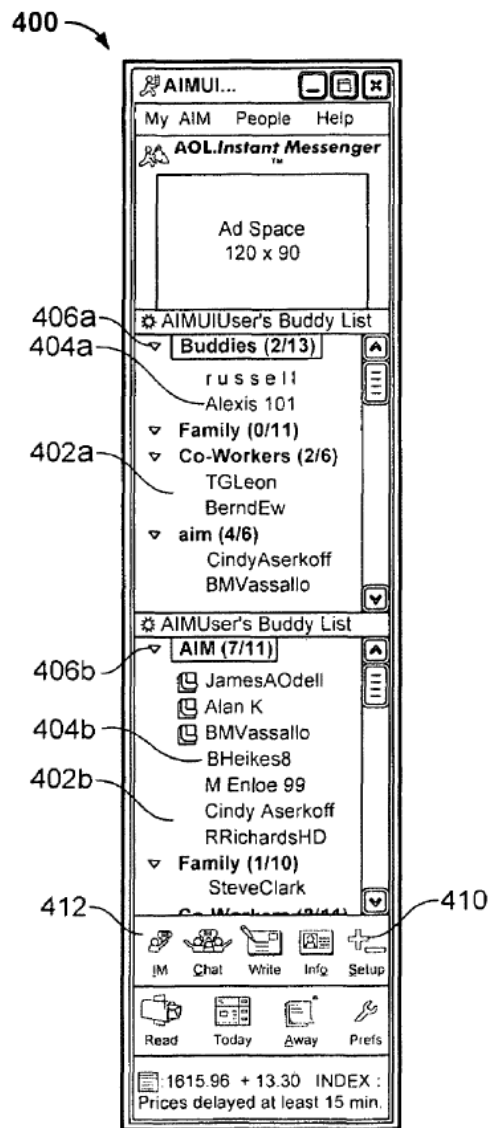


FIG. 4C

Figure 4C depicts a buddy list interface for displaying buddy lists for all linked accounts simultaneously.

Ex. 1006, 9:10–12, Fig. 4C.

Petitioner argues:

Odell discloses that a “primary account is chosen by the user to sign in to the communications system” and “[a]fter the primary account is authenticated, a single GUI shows a buddy list, or a list containing the users of the communications system with which communications regularly occur, for the primary account

and each of the linked accounts.” Ex[1006], 3:11-16 (emphasis added); *see also id.*, 14:36-15:3 (“Once all of the linked accounts have been signed into the communications system (1020), a buddy list interface displaying the buddy lists for the primary account and the linked accounts is displayed (1022).”) (emphasis added). “Thus, by signing onto a single account, the user’s other linked accounts also may be started.” *Id.*, 3:16-17. Figure 3 shows “an example of a communications system for implementing [these] techniques.” *Id.*, 3:48-50. And examples of a single GUI for displaying all of a user’s contact lists are shown in Figures 4A-C, where 4A and 4B divide the various lists into selectable tabs and Figure 4C shows all lists simultaneously. *See id.*, 1:56-59 (“FIGS. 4A-4C, 5A and 11 are illustrations of exemplary interfaces for showing buddy lists for multiple linked instant messaging accounts”), 3:17-31, 8:33-9:42.

Pet. 45–46. Petitioner argues Odell’s Figures 4A and 4B (above) disclose “contact lists from five accounts comprising at least three messaging service providers—AOL, AIM, and love.com (each shaded in a different color)—are aggregated in one tabbed list in a single GUI.” Pet. 46–48 (citing Ex. 1004 ¶¶ 111–114).

Patent Owner argues Tab 402 in the ’395 patent’s Figure 4A, reproduced below, “shows an embodiment of how contacts from different messaging service providers are brought together in a single aggregated contact list.” Prelim. Resp. 37.

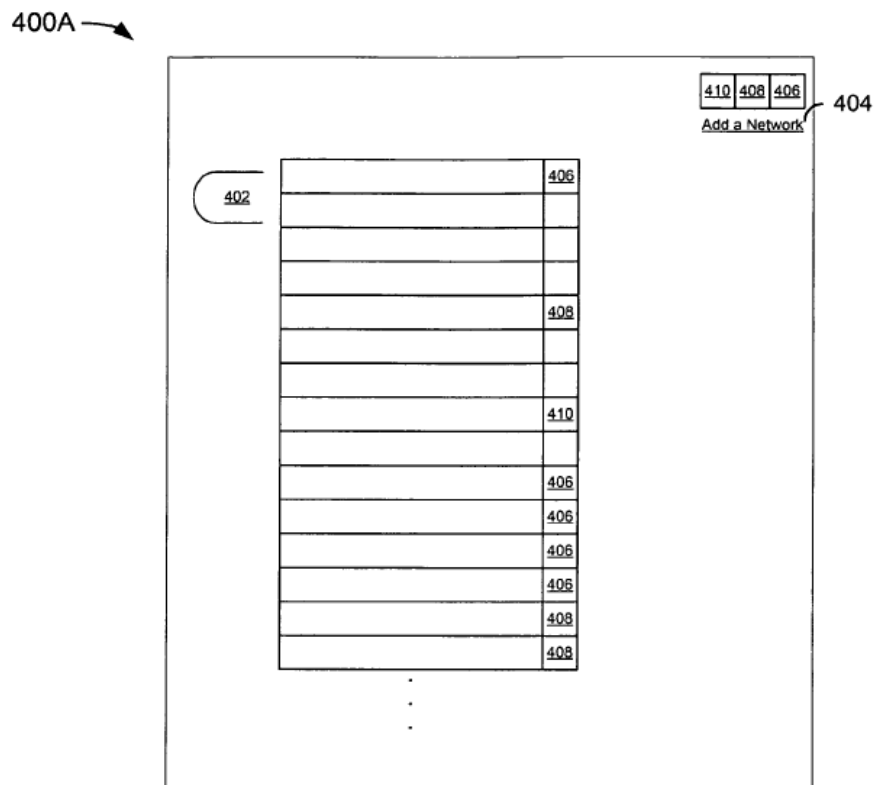


FIG. 4A

Figure 4A of the '395 patent depicts an example of a screen shot 400A for a full screen display.

Ex. 1001, 6:51–52, 2:28–29, Fig. 4A. Patent Owner argues Figure 4A “stands in contrast with Odell, which discloses separate lists notwithstanding their concurrent, but non-aggregated, display within the confines of a single GUI.” Prelim. Resp. 37. Patent Owner argues repeatedly, in various forms, that Odell does not disclose an aggregated contact list because Odell’s “two single and separate buddy lists, even when displayed simultaneously, do not comprise or disclose an aggregated contact list” (*id.* at 9):

The petition says the different lists can be displayed individually. But displays of separate lists does not an aggregated list make, even if the separate lists are displayed concurrently with one another. It is akin to displaying a to do list and a shopping list at the same time. No one would understand this to be an

“aggregated” shopping-to do list. Rather, there are two lists and that are being displayed concurrently.

Id. at 41; *see id.* at 8–10, 37–43. Based on the record before us, we find Patent Owner’s argument unavailing.

The issue before us here is not whether Odell discloses a contacts listing as shown in the ’395 patent’s Figure 4A, but rather whether Odell discloses an “aggregated contact list” *as recited in claim 1*. Based on the record before us, we disagree with Patent Owner’s arguments concerning the ’395 patent’s Figure 4A because we preliminarily determine that they are not commensurate with the scope of claim 1.

Claim 1 itself describes an “aggregated contact list” as comprising contact lists from at least two messaging service providers (i.e., (1) a first contact list associated with the contact information from the first messaging service provider and (2) a second contact list associated with the contact information from the second messaging service provider). As discussed above, Petitioner argues Odell discloses collecting, grouping, or gathering together contact lists from multiple messaging service providers, as shown, for example, in Odell’s Figures 4A–4C. Patent Owner does not explain *why* an “aggregated” contact list, as recited in claim 1, does not encompass contact lists that are collected, grouped, or gathered together as in Odell. Instead, Patent Owner appears to argue that “aggregated” here requires a merging (and perhaps sorting and filtering) of contact lists from multiple messaging service providers, but does so without citing to any evidentiary support for this more narrow interpretation of “aggregated.”

Accordingly, for the reasons stated in the Petition at pages 44–48, Petitioner sufficiently establishes that Odell discloses this limitation.

- (9) “[wherein, in operation, the contact aggregation engine:] stores the aggregated contact list in a non-transitory computer readable medium at the web server”

Petitioner argues Odell’s “web server” (admin server 372 or web server 384) “would be understood by [the skilled artisan] to store the aggregated contact list.” Pet. 48 (citing Ex. 1004 ¶¶ 115–125). Petitioner argues “[a]s part of aggregating all buddy lists from all linked accounts across multiple messaging networks, facilitating the storage of this information, and communicating it to the requestor system 305 (via the gateway 370 and web server 384), *the admin server 372 would necessarily store the aggregated contact list.*” Pet. 50 (citing Ex. 1004 ¶ 123); *see* Ex. 1006, 7:12–15 (“For validated accounts, account attributes may be forwarded from the authentication database 376 through the authentication server 374 for further use, processing, and/or storage by the admin server 372.”), 34:64–35:13 (non-volatile memory); Pet. 48–51.

Petitioner also contends, in the alternative, “Odell’s web server 384 would also necessarily store the aggregated contact list that is sent to it from the provider system 310 for display on the user’s requestor system 305 (e.g., on the interfaces depicted in Figures 4A-C . . . , as this would be required for the web server 384 to perform its disclosed functions.” Pet. 51–52 (citing Ex. 1004 ¶ 124). Petitioner submits that Patent Owner’s infringement contentions in the District Court Case support Petitioner’s position here:

Patent Owner contends in the related litigation that a web server stores an aggregated contact list because it “accessed” the list that is stored on an internal server. *See* Ex[1009],186. Odell likewise discloses that its web server 384 accesses the aggregated contact list that is stored on the provider system 310 (in the admin server 372, account linking server 378, and account linking

database 380) because it provides this information to the user's requestor system for display. *See* Ex[1004], ¶124; Ex[1006], 6:47-7:3, 7:20-22, 3:11-31, 5:33-53, 6:32-39.

Pet. 52; *see* Ex. 1004 ¶¶ 124–125.

Patent Owner argues “Odell does not disclose where any buddy lists are stored.” Prelim. Resp. 43; *see id.* at 44–45. Patent Owner also argues, as it did concerning the “network contacts database” discussed above (*see* Section III.E.2.a.3, *supra*), that “what is described as being stored by Odell is user buddy list *information* – not the user's actual buddy lists,” and therefore, Odell does not disclose storing buddy (or contact) lists or an “aggregated contact list.” *Id.* at 43. However, Petitioner's declarant, Mr. Willis, testifies that admin server 372 or web server 384 would necessarily store the aggregated contact list. Ex. 1004 ¶¶ 123–124. Mr. Willis also testifies that “[t]he ‘buddy list information’ stored and maintained in account linking server 380 would by necessity include the ‘network contacts,’” and “account linking database 380 must store all buddy lists for a user from all linked accounts across multiple communication system as part of storing all ‘buddy list information.’” *Id.* ¶ 78. Based on the record before us, we find Patent Owner's attorney arguments here unavailing, particularly in view of Mr. Willis's uncontroverted testimony to the contrary. *See In re Pearson*, 494 F.2d at 1405.

Patent Owner also argues that “Odell does not disclose an aggregated contact list,” and therefore, cannot disclose this limitation. Prelim. Resp. 44. But as discussed above in Section III.E.2.a.8, based on the record before us, we find Patent Owner's premise here unavailing.

Accordingly, for the reasons stated in the Petition at pages 48–52, Petitioner sufficiently establishes that Odell discloses this limitation.

(10) “[wherein, in operation, the contact aggregation engine:] provides the aggregated contact list to a display device”

Petitioner contends that Odell discloses this limitation by describing admin server 372 alone or in combination with account linking server 378 (“contact aggregation engine”) as “provid[ing] an aggregated contact list to the user’s requestor system for display via gateway server 370 and web server 384.” Pet. 52–53. Petitioner argues Odell’s Figures 4A–4C (reproduced above), and supporting disclosure, depict an aggregated contact list being provided to a display device (or graphical user interface (“GUI”)). Pet. 53–55 (citing, *inter alia*, Ex. 1004 ¶¶ 126–127).

Patent Owner again argues that “Odell does not disclose an aggregated contact list,” and therefore, cannot disclose this limitation. Prelim. Resp. 45–46. But as discussed above in Section III.E.2.a.8, based on the record before us, we find Patent Owner’s premise here unavailing.

Accordingly, for the reasons stated in the Petition at pages 52–55, Petitioner sufficiently establishes that Odell discloses this limitation.

(11) Conclusion

At this stage of the proceeding and based on the record before us, we are persuaded that Petitioner’s cited evidence sufficiently supports Petitioner’s contention that independent claim 1 is unpatentable as anticipated by Odell. Accordingly, we determine that Petitioner has established a reasonable likelihood that it would prevail in showing that independent claim 1 is unpatentable as anticipated by Odell.

b) Independent Claim 7

Petitioner provides an element-by-element analysis of independent claim 7 in relation to Odell, with heavy reliance on its analysis provided for

independent claim 1. Pet. 62–64; *see* Ex. 1001, 13:11–14:4 (claim 7). Petitioner’s analysis relies on testimony from its declarant, Mr. Willis. Ex. 1004 ¶¶ 150–169. Patent Owner opposes. Prelim. Resp. 46–53. As discussed below, Petitioner contends each limitation in claim 7 is disclosed by Odell.

(1) *(Preamble) “A method comprising:”*

Petitioner contends that Odell meets the preamble by disclosing “a method associated with [communications system 300] described above with reference to Claim 1.” Pet. 62 (citing Ex. 1004 ¶ 150; Ex. 1006, 12:18–50, 14:36–15:5, 34:48–58). Patent Owner does not contend otherwise at this stage of the proceeding. Nonetheless, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378. For the reasons given by Petitioner, we determine that Odell discloses this element of the claim.⁴

(2) *“joining a high level network”*

Petitioner contends that Odell discloses this limitation by describing “functionality for logging into a primary ‘high level’ network as well as multiple linked networks, or ‘low level networks.’” Pet. 62 (citing Petitioner’s analysis for “Claim 1[i]” (i.e., “network login engine”) and “Claim 3,” which likely is a typographical error, as Petitioner’s analysis for Claim 2 discusses a “high level network” whereas Claim 3 involves “low level networks”). Although Odell does not explicitly recite the terms “high level network” and “low level network” (Ex. 1004 ¶ 154), Petitioner argues

⁴ Neither party at this stage of the proceeding argues that the preamble of claim 7 is limiting. We likewise express no view herein.

Odell discloses such features consistent with their application in the '395 patent:

[Odell's] "primary account" is associated with a "high level" messaging network because it is used to sign in to the communications system, which then successively and automatically signs into other "low level" linked networks, as discussed above (and in Claim 1[i]). This is consistent with how the '395 Patent discloses the potential and purported difference between a "high level" network and a "low level" network. *See* Ex[1001], 6:45-49 ("a user will login to a high level account and . . . the system will automatically login the user to various low level accounts"). And, again, Odell discloses that "[a]ccounts from multiple communications systems may be linked together," such as "accounts from America Online (AOL), America Online Instant Messenger (AIM), and IC." Ex[1006], 8:14-20. The messaging service associated with a user's "primary account" will be the "high level network" and the linked messaging service networks will be the "low level networks." Ex[1004], ¶128.

Pet. 56; *see* Pet. 20; Ex. 1004 ¶¶ 70–73 (Mr. Willis testifying that "'primary account' in '696 Odell corresponds to an account in the 'high level network' of the '395 Patent, while the other 'linked accounts' accessible via the 'primary account' in '696 Odell correspond to accounts in the 'low level networks' of the '395 Patent."). Petitioner argues that "[t]o the extent that 'joining' a network includes the antecedent step of creating an account with each network, that is also necessarily and expressly disclosed in Odell." Pet. 62–63 (citing Ex. 1004 ¶¶ 151–156; Ex. 1006, 3:11–25, 7:53–54, 8:14–20).

Patent Owner again argues Odell "only discloses a single network (*i.e.*, the America Online network[])," and therefore, "Odell does not disclose a high level network." Prelim. Resp. 47; *see id.* at 48 ("[I]n the absence of multiple networks – such as the case with Odell – there would be

no need for or disclosure of high level or low level networks.”). But as discussed above in Section III.E.2.a.6, based on the record before us, we find Patent Owner’s premise here unavailing.

For the reasons stated in the Petition at pages 62 and 63, Petitioner sufficiently establishes that Odell discloses this limitation.

(3) “*joining a first low level network associated with a first messaging service provider and a second low level network associated with a second messaging service provider*”

Petitioner contends Odell discloses this limitation for the same reasons given for the limitation of joining a high level network in claim 7 (see Section III.E.2.b.2, *supra*). Pet. 63 (citing Ex. 1004 ¶¶ 157–161). Petitioner argues “a user must ‘join’ each of the multiple messaging service networks that are linked to the primary account in Odell before the signing in and account linking can occur.” Pet. 63.

Patent Owner again argues “Odell only describes a single network (*i.e.*, America Online) which includes America Online, AOL Instant Messenger and ICQ,” and “Odell discloses, at most, that a system may permit a user to create or maintain multiple accounts on *a single network*,” and therefore, Odell cannot disclose the low level networks in this limitation. Prelim. Resp. 48–49. But as discussed above in Sections III.E.2.a.6 and III.E.2.b.2, based on the record before us, we find Patent Owner’s premise here unavailing.

For the reasons stated in the Petition at page 63, Petitioner sufficiently establishes that Odell discloses this limitation.

(4) *“obtaining a first contact list associated with the first messaging service provider”*

Petitioner contends Odell discloses this limitation for the same reasons given for the limitation of updating the networks contacts database in claim 1 (*see* Section III.E.2.a.7, *supra*). Pet. 63 (citing Ex. 1004 ¶¶ 162–163).

Patent Owner again argues Odell is a “single ‘provider system’ provided by America Online,” and therefore, Odell cannot disclose this limitation. Prelim. Resp. 49–51. But as discussed above in Sections III.E.2.a.6, III.E.2.b.2, and III.E.2.b.3, based on the record before us, we find Patent Owner’s premise here unavailing.

For the reasons stated in the Petition at page 63, Petitioner sufficiently establishes that Odell discloses this limitation.

(5) *“obtaining a second contact list associated with the second messaging service provider”*

Petitioner contends Odell discloses this limitation for the same reasons given for the limitation of updating the networks contacts database in claim 1 (*see* Section III.E.2.a.7, *supra*). Pet. 64 (citing Ex. 1004 ¶ 164).

Patent Owner submits the same argument here as given above for the limitation of obtaining a first contact list in claim 7 (*see* Section III.E.2.b.4, *supra*). Prelim. Resp. 51. But as discussed above in Sections III.E.2.a.6 and III.E.2.b.2–b.4, based on the record before us, we find Patent Owner’s argument unavailing.

For the reasons stated in the Petition at page 64, Petitioner sufficiently establishes that Odell discloses this limitation.

(6) “*maintaining an aggregated contact [list] that comprises the first contact list and the second contact list*”

Petitioner contends Odell discloses this limitation for the same reasons given for the limitation of maintaining an aggregated contact list in claim 1 (*see* Section III.E.2.a.8, *supra*). Pet. 64 (citing Ex. 1004 ¶ 165).

Patent Owner again argues “Odell shows that the buddy lists for a user’s separate accounts are maintained and displayed separately,” and therefore, Odell cannot disclose this limitation. Prelim. Resp. 51–52 (citing Ex. 1006, Figs. 4A–4C). But as discussed above in Section III.E.2.a.8, based on the record before us, we find Patent Owner’s premise here unavailing.

For the reasons stated in the Petition at page 64, Petitioner sufficiently establishes that Odell discloses this limitation.

(7) “*logging into the high level network*”

Petitioner contends Odell discloses this limitation for the same reasons given for the limitation of joining a high level network in claim 7 (*see* Section III.E.2.b.2, *supra*). Pet. 64 (citing Ex. 1004 ¶¶ 166–167; also citing Petitioner’s analysis for “Claim 1[i]” (i.e., “network login engine”) and “Claim 3,” which likely is a typographical error, as Petitioner’s analysis for Claim 2 discusses a “high level network” whereas Claim 3 involves “low level networks”)).

Patent Owner submits the same argument here as given above for the limitation of joining a high level network in claim 7 (*see* Section III.E.2.b.2, *supra*). Prelim. Resp. 52–53. But as discussed above in Sections III.E.2.a.6 and III.E.2.b.2, based on the record before us, we find Patent Owner’s argument unavailing.

For the reasons stated in the Petition at page 64, Petitioner sufficiently establishes that Odell discloses this limitation.

(8) *“displaying the aggregated contact list”*

Petitioner contends Odell discloses this limitation for the same reasons given for the limitation of providing an aggregated contact list to a display device in claim 1 (*see* Section III.E.2.a.10, *supra*). Pet. 64 (citing Ex. 1004 ¶ 168).

Patent Owner again argues “Odell does not teach an aggregated contact list,” and therefore, Odell cannot disclose this limitation. Prelim. Resp. 53. But as discussed above in Section III.E.2.a.8, based on the record before us, we find Patent Owner’s premise here unavailing.

For the reasons stated in the Petition at page 64, Petitioner sufficiently establishes that Odell discloses this limitation.

(9) *Conclusion*

At this stage of the proceeding and based on the record before us, we are persuaded that Petitioner’s cited evidence sufficiently supports Petitioner’s contention that independent claim 7 is unpatentable as anticipated by Odell. Accordingly, we determine that Petitioner has established a reasonable likelihood that it would prevail in showing that independent claim 7 is unpatentable as anticipated by Odell.

c) *Dependent Claims 2–6 and 8–11*

Petitioner contends claims 2–6 and 8–11, which depend directly from one of independent claims 1 and 7, are unpatentable as anticipated by Odell. Pet. 55–62, 64–70. The Petition provides a detailed assessment of these claims, with references to the Petition’s analysis of claims 1 and 7, disclosures in Odell, and the declaration testimony of Mr. Willis. Pet. 55–

62, 64–70. At this stage of the proceeding, Patent Owner does not present any separate arguments that are distinct to any of these claims. Rather, Patent Owner generally states the view that the alleged deficiencies in the Petition with respect to claims 1 and 7 are also applicable to all Challenged Claims. *See* Prelim. Resp. 1 n.2. As discussed above, we are persuaded that the cited evidence sufficiently supports Petitioner’s contention that independent claims 1 and 7 are unpatentable as anticipated by Odell. For the reasons set forth in the Petition (Pet. 55–62, 64–70), we also are persuaded that the current record sufficiently supports Petitioner’s challenges to dependent claims 2–6 and 8–11 for purposes of institution.

d) Summary

For the foregoing reasons, and the reasons stated in the Petition (Pet. 18–70), we determine that Petitioner demonstrates a reasonable likelihood of success in establishing the unpatentability of claims 1–11 as anticipated by Odell.

IV. CONCLUSION

Based on the evidence before us, we determine that Petitioner has established a reasonable likelihood that claims 1–11 of the ’395 patent are unpatentable. Accordingly, we institute trial on all the challenges in the Petition.

At this stage of the proceeding, the Board has not made a final determination on the construction of any claim term or the patentability of any challenged claim.

V. ORDER

Upon consideration of the record before us, it is:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–11 of the '395 patent is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of the '395 patent shall commence on the entry date of this Order, and notice is hereby given of the institution of a trial.

IPR2022-00176
Patent 8,510,395 B2

FOR PETITIONER:

Matthew W. Hindman
Christopher Kao
Brock S. Weber
PILLSBURY WINTHROP SHAW
PITTMAN LLP
matthew.hindman@pillsburylaw.com
christopher.kao@pillsburylaw.com
brock.weber@pillsburylaw.com

FOR PATENT OWNER:

Stephen F. Schlather
John J. Edmonds
EDMONDS & SCHLATHER, PLLC
sschlather@ip-lit.com
jedmonds@ip-lit.com

Tarek Fahmi
ASCENDA LAW GROUP, PC
tarek.fahmi@ascendalaw.com