

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*.

JUDGMENT
Final Written Decision
Determining All Claims Unpatentable
35 U.S.C. § 318(a)

Denying in Part and Dismissing in Part Patent Owner's Motion to Exclude
37 C.F.R. § 42.64

I. INTRODUCTION

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”). eBuddy Technologies B.V. (“Patent Owner”) filed a Preliminary Response to the Petition (Paper 8, “Prelim. Resp.”; *see* Paper 4, 1). We instituted an *inter partes* review of claims 1–11 of the ’395 patent on all grounds of unpatentability alleged in the Petition. Paper 13 (“Institution Decision” or “Dec.”).

After institution, Patent Owner filed a Response. Paper 18 (“PO Resp.”). Petitioner filed a Reply. Paper 26 (“Pet. Reply”). Patent Owner filed a Sur-Reply. Paper 33 (“PO Sur-Reply”). Patent Owner also filed a Motion to Exclude Evidence, in which Patent Owner moves to exclude Exhibits 1021–1028 and 1030. Paper 31 (“Mot. Excl.”). Petitioner filed an Opposition to Patent Owner’s Motion to Exclude Evidence (Paper 32), and Patent Owner filed a Reply to Petitioner’s Opposition to Patent Owner’s Motion to Exclude Evidence (Paper 34). We held a hearing on February 21, 2023, and a transcript of the hearing appears in the record. Paper 35 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6 (2018). Under the applicable evidentiary standard, Petitioner has the burden to prove unpatentability by a preponderance of the evidence. *See* 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d) (2022). “Preponderance of the evidence means the greater weight of evidence, evidence which is more convincing than the evidence which is offered in opposition to it.” *United States v. C.H. Robinson Co.*, 760 F.3d 1376, 1383 (Fed. Cir. 2014) (internal quotations

omitted). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

For the reasons discussed below, we determine Petitioner has established by a preponderance of the evidence that claims 1–11 of the ’395 patent are unpatentable.

A. Related Matters

The parties indicate that the ’395 patent, along with three other patents, namely U.S. Patents Nos. 8,230,135, 8,402,179, and 9,584,453, 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; Ex. 2004, 2.

B. 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.

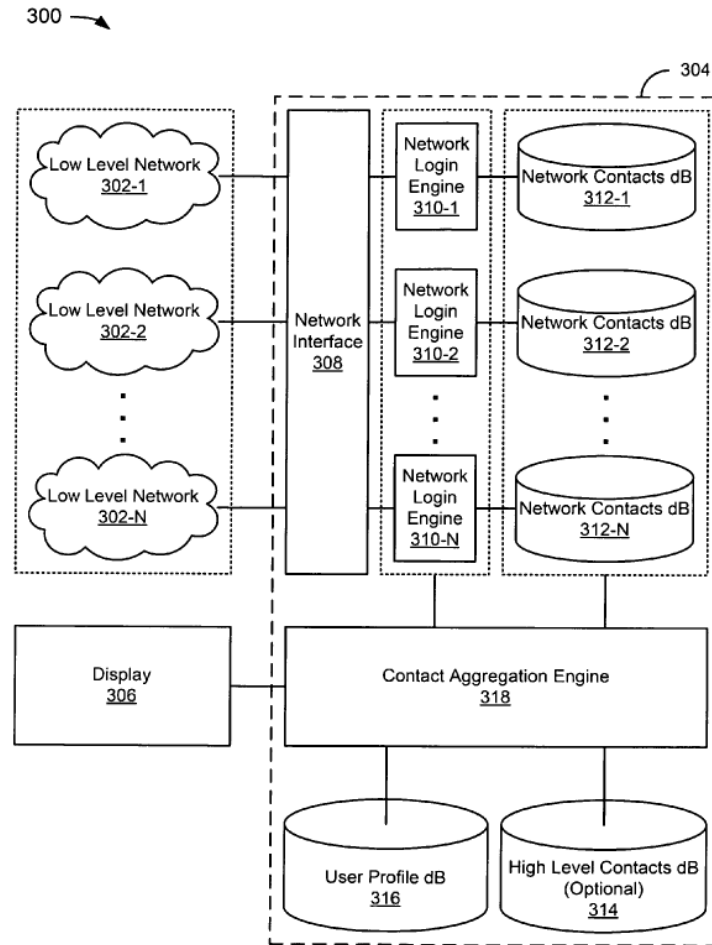


FIG. 3

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.

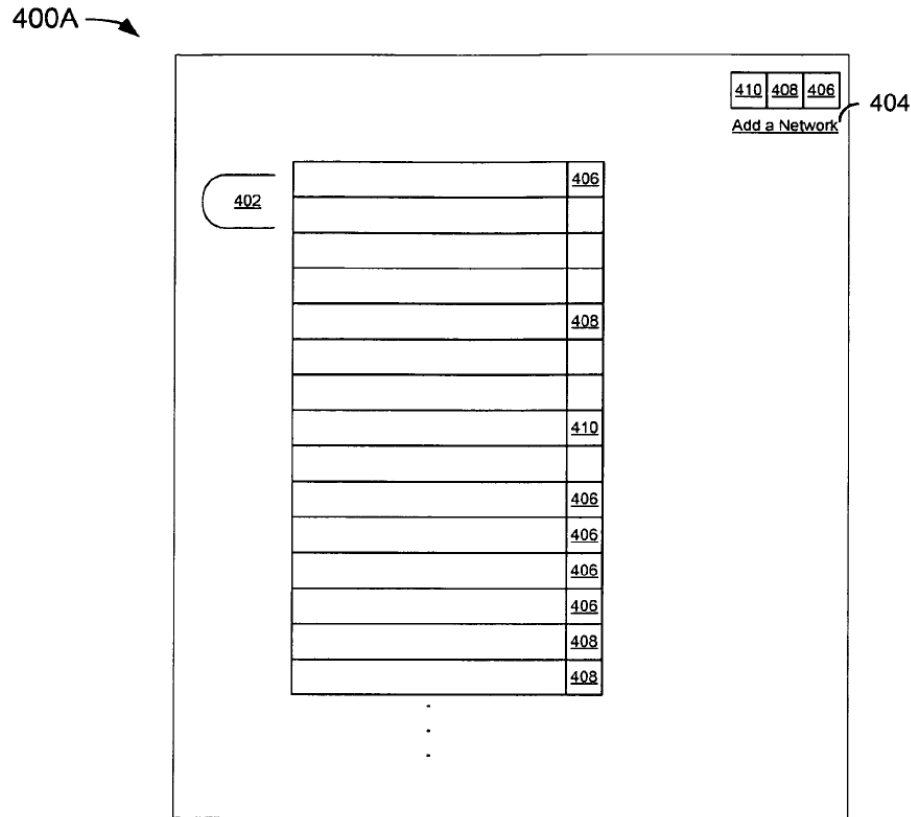


FIG. 4A

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.

C. Illustrative Claim

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

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 network 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.

7. A method comprising:

joining a high level network;

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;
obtaining a first contact list associated with the first messaging service provider;
obtaining a second contact list associated with the second messaging service provider;
maintaining an aggregated contact [list] that comprises the first contact list and the second contact list;
logging into the high level network;
displaying the aggregated contact list.

Ex. 1001, 13:11–14:4.

D. Evidence of Record

Petitioner relies on the following patent evidence.

Name	Patent Document	Exhibit
Odell	US 7,590,696 B1	1006
Daniell	US 7,185,059 B2	1007

Pet. 6.

Petitioner also relies on the Declarations of Dean Willis (Exs. 1004, 1040).

Patent Owner relies on the Declaration of Dr. Rajeev Surati (Ex. 2006).

E. Asserted Grounds of Unpatentability

We instituted *inter partes* review of claims 1–11 of the '395 patent on the following grounds asserted by Petitioner. Dec. 2–3, 52; Pet. 6.

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

II. 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. To prevail in its challenges to the patentability of the claims, Petitioner must establish unpatentability by a preponderance of the evidence. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). “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”)). 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).

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.

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

² Patent Owner did not present any evidence or arguments directed to secondary considerations during this proceeding.

skill in the art. *In re Piasecki*, 745 F.2d 1468, 1471–72 (Fed. Cir. 1984). When evaluating a combination of independent prior-art elements, 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)).

The Supreme Court has made clear that we apply “an expansive and flexible approach” to the question of obviousness. *Id.* at 415. Whether a patent claiming a combination of prior-art elements would have been obvious is determined by whether the improvement is more than the predictable use of prior-art elements according to their established functions. *Id.* at 417. To reach this conclusion, however, requires more than a mere showing that the prior art includes separate references covering each separate limitation in a claim under consideration. *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011). Rather, obviousness requires the additional showing that a person of ordinary skill at the time of the invention would have selected and combined those prior-art elements in the normal course of research and development to yield the claimed invention. *Id.* “To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

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, [the skilled artisan] would possess equivalent additional formal education such as graduate studies, or work experience to replace formal education.

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

Patent Owner does not dispute Petitioner's definition. *See* PO Resp., PO Sur-Reply.

In determining the level of ordinary skill in the art, various factors may be considered, including the "type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field." *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (citation omitted). The level of ordinary skill in the art also is reflected by the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001).

Considering the subject matter of the '395 patent, the background technical field, the prior art, and Petitioner's unopposed proposed definition of the skilled artisan, we apply the level of skill set forth above, which also is consistent with the testimony of Mr. Willis (Ex. 1004 ¶¶ 31–34).

Regardless, 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.

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); *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 contends 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, Petitioner does not provide any express claim construction for any term in the Challenged Claims. Thus, in our Institution Decision, we encouraged the parties to provide supported constructions for three terms that the parties plainly disputed, namely “aggregated contact list,” “contact aggregation engine,” and “messaging service provider.” We construe these terms below seriatim and then turn to the terms “high level network” and “low level network,” which the parties also plainly disputed during this proceeding.

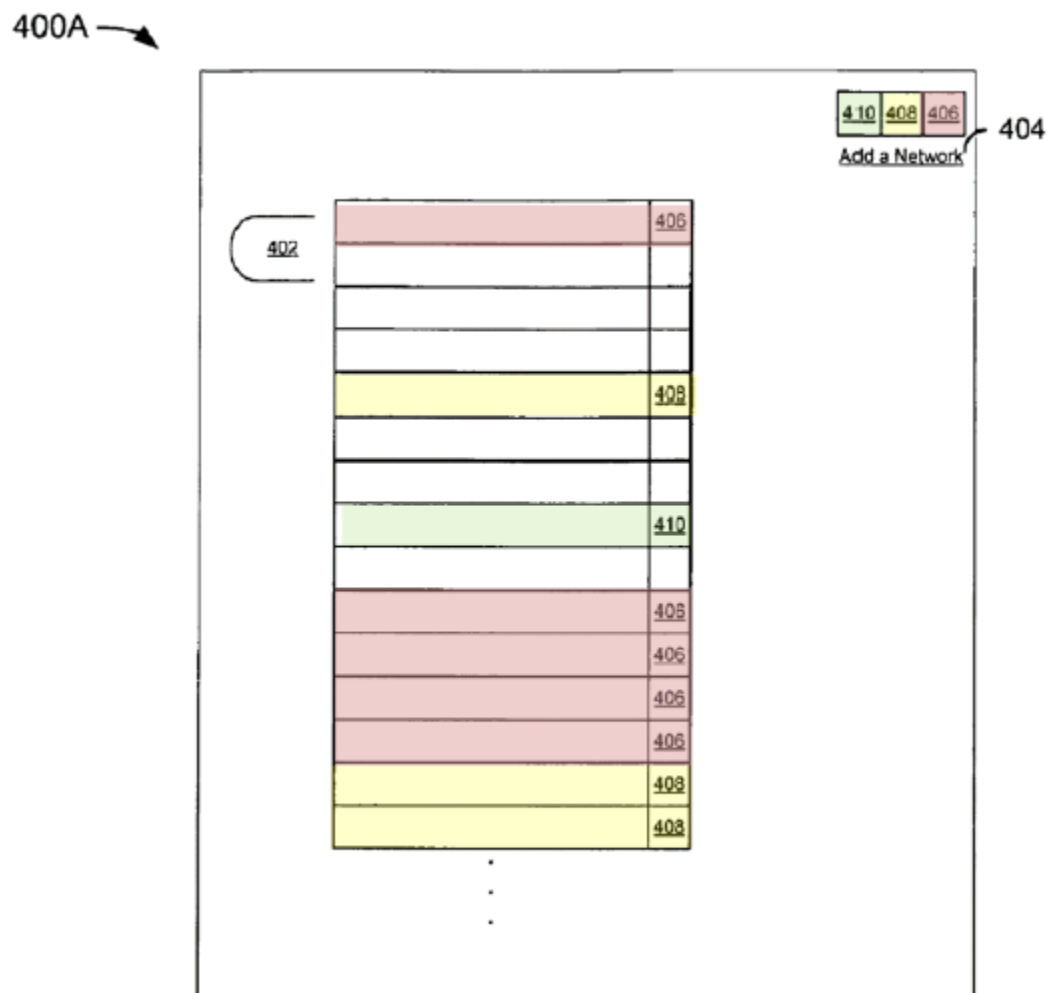
1. “aggregated contact list”

Both challenged independent claims 1 and 7 recite, in part, an “aggregated contact list.” Ex. 1001, 12:51 (claim 1), 14:1 (claim 7). In claim 1, the aggregated contact list is stored at the recited web server and provided to a display device. *Id.* at 12:56–58. In claim 7, an aggregated contact list is maintained and displayed. *Id.* at 14:1–4.

Petitioner argues “a ‘contact list’ is an ordinary term in this field that includes ‘buddy lists,’ as in Odell, and that the plain English term, ‘aggregated,’ simply means gathered or collected.” Pet. Reply 3 (citing Ex. 1039, 16:25–17:10, 34:19–35:25, 98:5–14; PO Resp. 6). Thus, Petitioner contends “the plain and ordinary meaning of ‘aggregated contact

list’ is simply contacts that have been put together, gathered, or collected.”
Pet. Reply 3 (citing Ex. 2013, 57:15–59:8).

Patent Owner disagrees and argues the skilled artisan “would consider the term ‘aggregated contact list’ to mean ‘a single, integrated contact list that has been aggregated from contacts of a plurality of contact lists and is a separate list from the other contact lists from which it is aggregated.’” PO Resp. 4 (citing Ex. 2006 ¶ 55). Patent Owner argues that Figure 4A, reproduced below with Patent Owner’s coloring, shows an aggregated contact list. *Id.* at 4–6.



Ex. 1001, 2:28–29; PO Resp. 6. When a network is added, the user’s contacts for that network are added to the contacts-list tab 402. Ex. 1001, 7:4–7. Icons 406, 408, and 410 correspond to the contact’s associated network. *Id.* at 7:7–9, 20–25. Patent Owner highlights contacts associated with MSN, Yahoo!, and AIM in red, yellow, and green, respectively. PO Resp. 4–6.

Patent Owner argues that Figure 4A supports its construction because the figure shows a “single integrated contact list” with contacts from lists associated with several networks: MSN, Yahoo!, and AIM. PO Resp. 5–6 (citing Ex. 2006 ¶ 57). According to Patent Owner, the figure shows “a separate list from the contact lists from which it is aggregated,” instead of multiple separate lists. *Id.* at 5 (citing Ex. 2006 ¶ 57). In Patent Owner’s view, Figure 4A shows that “aggregated” means “collecting or gathering into a whole.” *Id.* at 6 (citing Ex. 2006 ¶ 57; Ex. 2017; Ex. 2018; Ex. 2019).

Both parties agree that the term “aggregated” means collected or gathered. *See* Pet. Reply 3; PO Resp. 4–6. The experts’ testimony in this case sufficiently supports this position. *See, e.g.*, Ex. 2013, 58:12–14 (testifying that “putting a bunch of things together” is aggregation); Ex. 1039, 97:22–99:7 (testifying that aggregation includes collecting or gathering “into a mass or whole”); Ex. 1040 ¶¶ 19–22.

Petitioner argues that the claim requires an aggregation of contacts. Pet. Reply 3. Patent Owner’s construction further explains that the source of aggregated contacts is “a plurality of contact lists.” PO Resp. 4; *see also* PO Sur-Reply 6 (arguing there must already be “at least two separate lists to aggregate”). Patent Owner’s additional detail about the contacts’ source is largely consistent with Petitioner’s position. *See, e.g.*, Pet. 38 (discussing

aggregation of buddy lists “obtained from accounts in a multitude of networks”).

From the plain language of the claims, we determine that the recited contacts come from other contact lists: Claim 1 recites obtaining contact information from the first and second messaging service providers. *See* Ex. 1001, 12:48–50. Claim 7 recites first and second contact lists, and that contacts associated with the first and second messaging service providers are displayed as an aggregated contact list. *See id.* at 13:18–14:4. Thus, we determine that a contact-list aggregation means gathering and collecting contacts from multiple contacts lists, resulting in the recited “aggregated contact list.” Patent Owner’s construction incorporates these features to the extent that it requires a “contact list that has been aggregated from contacts of a plurality of contact lists.” PO Resp. 4; *see also* PO Sur-Reply 4. We turn next to whether an “aggregated contact list” must be a single, integrated list separate from individual contact lists.

*An “Aggregated Contact List” Need Not Be a
Single, Integrated, and Separate List*

According to Patent Owner’s construction, the “aggregated contact list” *also* must be (1) a single list, (2) an integrated list, and (3) “a separate list from the other contact lists from which it is aggregated.” PO Resp. 4 (citing Ex. 2006 ¶ 55); *see* PO Sur-Reply 7.

In Patent Owner’s view, “[a] ‘set’ of individual lists, especially one involving non-simultaneous display, is not an aggregated list.” PO Resp. 11; *see also* PO Resp. 49; PO Sur-Reply 20 (distinguishing multiple lists from an aggregated list). Patent Owner argues the skilled artisan “would not understand that simultaneously displayed separate contact lists, especially when each separate list can be individually collapsed and thus not displayed

in the set, constitute an aggregated contact list.” PO Resp. 10–11 (citing Ex. 2006 ¶ 59); *see* PO Sur-Reply 2, 6.

Contrary to Patent Owner’s arguments, the ’395 patent discloses splitting and organizing contacts into individual folders. Ex. 1001, 6:64–7:25. Specifically, Figure 4A (reproduced above) shows contacts list tab 402. *Id.* at 6:64–65. One embodiment adds a user’s contacts to the tab 402 when a network is added. *Id.* at 7:4–9. A user, however, may organize contacts in various folders. *Id.* at 6:64–65. For example, the “Offline” folder contains all contacts who are not currently online. *Id.* at 7:1–3. The “Offline” folder could be “split into two folders”—“one which indicates a contact is offline, and one that indicates a contact is a member of a network that has not been added.” *Id.* at 7:16–20.

This description of splitting contacts contradicts Patent Owner’s argument because it shows that an “aggregated contact list” need not be a single or integrated list. PO Resp. 4, 10–11. Rather, the ’395 patent’s description of splitting and organizing contacts into folders suggests at least some division, separation, or grouping. *See* Ex. 1001, 6:57–7:25. For example, the ’395 patent’s description of “two folders” for offline contacts indicates that a single, visually uninterrupted list is not required. *Id.*

Patent Owner argues that the Petitioner’s prior art adds a screen name to one list, which causes the screen name to be added to other lists. PO Resp. 12. In Patent Owner’s view, this duplication “would be unnecessary if a single, aggregated buddy list were present because it would simply result in duplicate entries in that single list.” *Id.* But the ’395 patent also discloses that a single contact may be listed in multiple folders. *See* Ex. 1001, 6:65–7:1 (“A single contact may be listed in no folders, one folder, or multiple folders, depending upon implementation and user configurations.”).

This duplication of contacts shows that the recited “aggregated contact list” is not limited in the way that Patent Owner describes. *See* PO Resp. 4–6, 9–16. Rather, the contacts within an “aggregated contact list” can be found in multiple folders.

Similarly, Patent Owner argues that an “aggregated [contact] *list*” is not an “aggregation of *lists*” (i.e., that contact lists must not be separate). PO Sur-Reply 7; *see, e.g.*, PO Resp. 13 (discussing “separateness”); 13–14 (arguing Odell discloses each account has a “*separate* buddy list”); 16 (arguing about Odell’s separate accounts or aliases and display of separate lists); PO Sur-Reply 4. But the ’395 patent’s description of organizing contacts into multiple folders indicates at least some level of separation. *See* Ex. 1001, 6:57–7:25. For example, the description of splitting the “Offline” folder into two folders indicates that contacts are separated into those folders by the disclosed criteria. *Id.* at 7:16–20.

Patent Owner argues that, in the context of the prior art, “organizing or maintaining multiple separate buddy lists, including by screen name, would not result in an aggregated contact list.” PO Resp. 14 (citing Ex. 2006 ¶ 156). To the contrary, the ’395 patent suggests that a folder may contain contacts from a particular network. Ex. 1001, 7:16–20. The particular network may have an associated “user name.” *Id.* at 6:3–6. Thus, these passages indicate that contacts can be organized by screen name in the system described in the ’395 patent. *See id.*

Patent Owner’s arguments rely heavily on Figure 4A to support its construction. *See* PO Resp. 4–16. But Figures 4A and 4B are “examples.” Ex. 1001, 2:28–29. The patent explains that the “preceding examples . . . are exemplary and not limiting to the scope of the present invention.” *See id.* at 12:24–34. So, although we have considered these examples in our analysis

of the “aggregated contact list” as discussed above, we disagree with Patent Owner to the extent that the claims should be limited to the specific ordering and layout shown in the exemplary figures. *See* PO Resp. 4–16.

We do not credit Dr. Surati’s testimony on this issue of a “single,” “integrated” list (*see, e.g.*, Ex. 2006 ¶¶ 42, 55–59, 145–146, 150, 155–156, 168, 188), because Dr. Surati does not give sufficient weight to the folders described in the ’395 patent (*see, e.g.*, Ex. 1001, 6:57–7:25, 12:24–34) and mischaracterizes the examples as limiting the claim.

Considering the totality of the arguments and evidence presented in this proceeding, we determine that “aggregated contact list” means a contact list resulting from gathering and collecting contacts from multiple contacts lists.

2. “*contact aggregation engine*”

Claim 1 recites, in part, “a contact aggregation engine coupled to the network login engine and the network contacts database.” Ex. 1001, 12:41–42. According to the “wherein” clause of claim 1, the contact aggregation engine, in operation, must perform five functions:

wherein, in operation, the contact aggregation engine:

[1] 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,

[2] updates the networks contacts database with contact information obtained from the first messaging service provider and the second messaging service provider,

[3] 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,

[4] stores the aggregated contact list in a non-transitory computer readable medium at the web server, and

[5] provides the aggregated contact list to a display device.

Id. at 12:43–58 (formatting and numbering added). Claim 7, the other independent claim, does not recite a “contact aggregation engine.” *See id.* at 13:11–14:4.

Petitioner asserts that a content aggregation engine can be one or more servers. *See* Pet. 40–41 (quoting Ex. 1001, 3:10). Generally, the parties agree that “engine” means “a system or software component.” Pet. Reply 10; PO Resp. 41; PO Sur-Reply 10–11.

As for the term “contact aggregation,” Petitioner asserts that claim 1 “defines the generic functions that the ‘contact aggregation engine’ performs, including ‘maintaining’ an ‘aggregated contact list.’” Pet. Reply 10. According to Petitioner, “the plain meaning of this phrase should control, as in the Petition, which is merely a ‘system or software component for contact aggregation.’” Pet. Reply 10 (citing Ex. 1039, 116:5–11; Ex. 1040 ¶¶ 12–18).

Patent Owner argues that the term “contact aggregation engine” requires storing the “aggregated contact list” on a network, not locally:

In the context of the ‘395 Patent, [the skilled artisan] would consider the term contact aggregation engine to mean “a system or software component that, at minimum, updates a networks contacts database contact information and provides an aggregated contact list *that is stored on a network and not stored locally.*”

PO Resp. 41 (citing Ex. 2006 ¶¶ 46–51) (emphasis added). Patent Owner argues that “contact aggregation engine” does not have a plain and ordinary meaning. PO Sur-Reply 11. According to Patent Owner, it “acted as its own lexicographer in coining this term.” *Id.* (citing Ex. 2006 ¶¶ 86–91;

Ex. 1001, 1:61–66, 2:5–10, 8:30–41, 12:56–57, 13:12–14:4). Patent Owner argues that “a proper understanding of the term in the context of the claims and specification leads to” a construction that requires network storage. *Id.*

Claim 1, though, already recites that the contact aggregation engine “stores the aggregated contact list in a non-transitory computer readable medium at the web server.” So, we see no reason to construe the term “contact aggregation engine” *itself* to require network storage. Rather, Patent Owner’s network-storage argument supports the conclusion that “contact aggregation engine” is defined by the functions expressly recited in the claim. *See* PO Sur-Reply 11.

We also disagree that Patent Owner acted as its own lexicographer. PO Sur-Reply 11. “The patentee’s lexicography must . . . appear ‘with reasonable clarity, deliberateness, and precision’ before it can affect the claim.” *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998). Here, the passages cited by Patent Owner lack the requisite clarity, deliberateness, and precision for lexicography. PO Sur-Reply 11 (citing Ex. 1001, 1:61–66, 2:5–10, 8:30–41, 12:56–57, 13:12–14:4). Specifically, the patent describes how the contact aggregation engine may function, without discussing the term’s meaning or otherwise attempting to define it. Ex. 1001, 1:61–66, 2:5–10, 8:30–41, 12:56–57, 13:12–14:4. In fact, the patent states that those embodiments do not limit the claims. *See id.* at 1:54–60 (explaining that the embodiments “are meant to be exemplary and illustrative, not limiting in scope”).

Patent Owner disagrees that the passages it cites are non-limiting. PO Sur-Reply 12. In Patent Owner’s view, “a contact aggregation engine would be an ‘aspect’ of certain embodiments, not the ‘systems, tools, and methods’ that such aspects are ‘described and illustrated in conjunction with.’” *Id.*

(quoting Ex. 1001, 1:54–57). But it does not matter whether the contact aggregation engine is an “aspect” or an “embodiment” because the ’395 patent indicates that aspects, embodiments, and aspects of embodiments are illustrative and non-limiting. *See* Ex. 1001, 12:21–23 (“As used herein, the term ‘embodiment’ means an embodiment that serves to illustrate by way of example but not limitation.”); 1:54–60 (referring to “embodiments *and* aspects”) (emphasis added); 2:47 (referring to “aspects *of* various embodiments”) (emphasis added). Thus, we disagree with Patent Owner’s argument about lexicography. PO Sur-Reply 11; PO Resp. 41. For the same reasons, we assign little weight to the corresponding testimony from Dr. Surati (Ex. 2006 ¶¶ 86–91).

It is undisputed that “engine” means “a system or software component.” *See, e.g.*, Pet. Reply 10; PO Resp. 41; PO Sur-Reply 10–11; Ex. 1039, 116:5–11 (testifying on cross-examination that “engine” simply means “code that accomplishes something”). The claim expressly recites what the contact aggregation engine performs in the wherein clause: “controls the network login engine . . . , updates the networks contacts database . . . , maintains an aggregated contact list . . . , stores the aggregated contact list . . . , and provides the aggregated contact list to a display device.” Ex. 1001, 12:43–58. We see no reason to impose additional unrecited limitations on the contact aggregation engine’s operation. Nor do we need to define the term “contact aggregation engine” itself to require the functions explicitly recited in the “wherein” clause.

Thus, based on the entire record, we determine that “contact aggregation engine” means a system or software component that aggregates contacts by performing the functions recited in the “wherein” clause—i.e., controlling, updating, maintaining, storing, and providing as recited. That is,

using Dr. Surati’s phrasing that an “engine” is “code that accomplishes something” (Ex. 1039, 116:5–11), the functions recited in the “wherein” clause define what that “something” is. Under this construction, claim 1 does not require any additional unrecited functions.

Lastly, we note that the term “contact aggregation” modifying “engine” is not meaningless for at least the reason that it serves to distinguish the “contact aggregation engine” from the “network login engine.”

3. “*messaging service provider [MSP]*”

Claim 1 recites, in part, the “contact aggregation engine” (*see supra* Section II.C.2) “controls the network login engine to login or facilitate login to a first network associated with *a first messaging service provider [MSP]* and a second network associated with *a second messaging service provider.*” Ex. 1001, 12:43–47 (emphases added). The parties dispute the meaning and scope of the term “messaging service provider” as used, for example, in independent claim 1. *See, e.g.*, Pet. 41–43; PO Resp. 7–8; Pet. Reply 1–2, 7–9; PO Sur-Reply 7–10.

In our Institution Decision, we stated, “neither claim 1 nor the Specification of the ’395 patent defines or distinguishes ‘networks’ or ‘messaging service provider[s]’ based on ownership or control,” and preliminarily determined “the ’395 patent recognizes that AIM [America Online Instant Messenger] and ICQ [derived from the English phrase “I Seek You”] are distinct messaging services.” Dec. 33–34 (citing, *inter alia*, Ex. 1001, 1:40–45).

Patent Owner still contends the skilled artisan “would understand the term messaging service provider to mean ‘*the entity* that provides the instant messaging service.’” PO Resp. 7 (citing Ex. 2006 ¶ 61) (emphasis added).

Patent Owner also acknowledges that “[t]he phrase ‘messaging service provider’ is *only used in the claims* of the ‘395 Patent,” although the Specification uses the terms “messaging service” and “messaging services.” *Id.* Patent Owner argues the skilled artisan “would understand that for a particular messaging service, an entity (e.g., Microsoft, Google and Yahoo!) was the service provider for such service.” *Id.* at 7–8 (citing Ex. 2006 ¶¶ 61–62).

Petitioner argues the skilled artisan “would understand that a ‘messaging service provider’ . . . would be ‘a computer, series of computers, system, software, element, or business for providing messaging services’ or, in other words, a ‘discrete messaging platform,’” and submits “[t]his is consistent with how that term was used in other references in the messaging space from the relevant timeframe.” Pet. Reply 9 (citing Ex. 1040 ¶¶ 30–33; Ex. 1041 ¶¶ 23, 27, 48, 72). Petitioner argues Patent Owner improperly “injects elements of ownership or control” into the alleged meaning of “messaging service provider.” *Id.* at 1. According to Petitioner, “Patent Owner does not explain or show how ‘messaging service provider’ could be construed to mean that AIM and ICQ constitute a single provider when the ‘395 Patent expressly states the opposite—that they are distinct ‘instant messaging services’ known on the ‘public Internet.’” *Id.* at 2. Petitioner submits:

Patent Owner’s position should also be rejected because it presupposes that corporate ownership—even if it were proven, which it has not been—determines what system or network provides messaging services. It does not. Ex[1040], Reply Willis Decl., ¶¶27–29. For instance, Petitioner LinkedIn is a wholly owned subsidiary of Microsoft Corporation (Pet. 1), but LinkedIn still provides linkedin.com as a separate domain,

service, and network from microsoft.com, which Microsoft provides. *Id.*, ¶29.

Id. at 2; *see id.* at 8 (“Corporate ownership does not establish that separate IM services were consolidated in a technical manner to operate on the same network or as the same entity. Patent Owner offers no evidence that this is the case. It is not.”).

In response, Patent Owner doubles down not only on “messaging service provider” allegedly being a corporate “entity (*e.g.*, business)” but also that what constitutes a “messaging service provider” depends on corporate ownership and control of that “messaging service provider” (entity). PO Sur-Reply 7–10; Tr. 46:20–48:4. Patent Owner argues this meaning is supported by analogizing the term “messaging service provider” with the term “Internet Service Provider,” which itself is recited neither in the claims nor Specification of the ’395 patent. *See, e.g.*, PO Sur-Reply 7–8. Patent Owner argues “[e]ven if AIM and ICQ are different messaging services, they are still provided by the same MSP – America Online.” *Id.* at 8. Patent Owner argues “[a]lthough messaging services operate on networks, MSPs are entities not the networks upon which their messaging services operate.” *Id.* In a nutshell, Patent Owner proffers that where company A owns network A (or messaging service platform A) and company B owns network B (or messaging service platform B), this would constitute two “messaging service providers”; but were company A to purchase company B’s network B (messaging service platform B), then—by that mere business transaction without more—there would exist only one “messaging service provider.” *See* Tr. 45:14–25. We find Patent Owner’s proposed construction for “messaging service provider,” which requires

knowledge of corporate ownership and control, unworkable, unsupported by the record, and contradicted by the intrinsic evidence to the '395 patent.

Indeed, Patent Owner has not provided a workable standard to distinguish among business relationships between IM services, or importantly, one that is rooted in the '395 patent. *See* PO Resp. 7–8; PO Sur-Reply 7–10. Rather, treating the IM services together based on common ownership would appear to contradict the '395 patent's describing them as distinct services. *See* Ex. 1001, 3:52–55; *see also* Ex. 1001, 8:18–32.

For the foregoing reasons, we disagree with Patent Owner that a “messaging service provider” as recited in the claims is *the entity* that provides the instant messaging service (PO Resp. 7–8), and assign little weight to Dr. Surati's testimony on this point (Ex. 2006 ¶¶ 114–118). Instead, we find persuasive Petitioner's proposed meaning for “messaging service provider” and underlying arguments discussed above, namely, that this term means the computer system or platform providing a distinct messaging service (and not which company at any given time might own that system or platform), and credit the testimony of Mr. Willis in this regard (*see* Ex. 1040 ¶ 27 (“Two different homes in two different cities and rented to two different families are not one house, even if they are owned by the same investor.”); *see also* Ex. 1040 ¶¶ 23–33).

4. “*high level network*” and “*low level network*”

Patent Owner provides a construction for “high level network” and “low level network.” PO Resp. 27. According to Patent Owner, “a ‘high level network’ is ‘an IM network that joins or has joined another IM network to access the contact list of the other IM network.’” *Id.* (citing Ex. 2006 ¶¶ 86–91; Ex. 1001, 1:61–66, 2:5–10, 8:30–41, 12:56–57, 13:12–14:4). Patent Owner argues that “a ‘low level network’ is [an]

‘IM network that is joined or has been joined from another IM network which accesses its contact list.’” *Id.* (citing Ex. 2006 ¶¶ 96–99; Ex. 1001, 1:61–63, 2:5–10, 8:30–41).

As with its construction for “contact aggregation engine,” Patent Owner’s construction contains limitations that are recited elsewhere in the relevant claims. *See* Ex. 1001, 13:11–14:4 (claim 7 – reciting “joining”); PO Resp. 27. For example, Patent Owner’s construction incorporates the concept of joining: “IM network that is joined or has been joined from another IM network” (low level network) and “an IM network that joins or has joined another IM network” (high level network). *See* PO Resp. 27. Yet independent claim 7, for example, already recites “joining a high level network” and “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.” Ex. 1001, 13:13–16. Thus, we agree with Patent Owner to the extent that the claims already recite high- and low-level network to require joining in claim 7.

Also, Patent Owner’s construction requires that the purpose of joining is “to access the contact list of the other IM network” (high level network) or “another IM network which accesses its contact list” (low level network). PO Resp. 27. Claim 7, though, expressly requires this feature by reciting “obtaining a first contact list associated with the first messaging service provider” and “obtaining a second contact list associated with the second messaging service provider.” Ex. 1001, 13:17–20. Claim 1 also recites a similar limitation: “contact information obtained from the first messaging service provider and the second messaging service provider.” *Id.* at 12:48–50. Thus, we agree with Patent Owner to the extent that the claims already recite this contact-list access.

Patent Owner adds that the high-level network “stores an aggregated contact list in a non-local storage location.” PO Resp. 27. Claim 1 recites that the contact aggregation engine “stores the aggregated contact list in a non-transitory computer readable medium *at the web server*.” Ex. 1001, 12:56–57 (emphasis added). In the context of claim 1, “at the web server” is more specific than “non-local storage.” Thus, Patent Owner’s requirement about non-local storage already is reflected in the language of claim 1 (we note that claim 2, which depends from claim 1, refers to a “high level contacts database,” and claim 3, which depends from claim 1, refers to a plurality of “low level networks”).

In sum, Patent Owner’s constructions for “high level network” and “low level network” as “an IM network that joins or has joined another IM network to access the contact list of the other IM network” and “IM network that is joined or has been joined from another IM network which accesses its contact list,” respectively (PO Resp. 27), incorporate features expressly required elsewhere in the claims.

In some ways, however, Patent Owner’s construction imposes additional limitations not found in claim 7 or other relevant claims. For example, unlike claim 1, claim 7 does not recite a server. Ex. 1001, 13:11–14:4. Because the ’395 patent describes the server embodiment as non-limiting, it would be improper to import an unrecited server feature into claim 7. *See, e.g., id.* at 12:21–23.

Based on the foregoing, we construe “high-level network” and “low-level network” to be conventional IM networks that are defined by the functions recited in the claims. Our analysis of the Petition under this construction is the same in many respects to the analysis under Patent Owner’s construction because Patent Owner’s construction simply repeats

the functions recited in the claims. PO Resp. 27. But, unlike Patent Owner's construction (*id.*), our construction does not improperly import unclaimed examples and better aligns with the '395 patent's written description.

The written description supports the interpretation that high- and low-level networks can be conventional networks. For example, the '395 patent describes, "The low level networks 302 may include, by way of example but not limitation, various IM networks." Ex. 1001, 5:54–55. These IM networks could be "MSN Messenger, Yahoo! Messenger, AIM AOL, ICQ, QO, Jabber, Google Talk, IRC, *or some other known or convenient IM network.*" *Id.* at 3:52–55 (emphasis added); *see also id.* at 8:19–22 (the IM network could be "MSN Messenger, Yahoo! Instant Messenger, AIM, *or any other known or convenient network*") (emphasis added).

A low-level network need not be structurally different from a high-level network. *See* Tr. 48:25–49:9 (Patent Owner acknowledging that low- and high-level networks are defined by what they do). Conventional IM networks could function as low-level networks or high-level networks. *See* Ex. 1001, 8:22–24. Patent Owner acknowledged this scenario at the oral hearing:

JUDGE BELISLE: And counsel, just to follow up on that, and I think from some arguments that Petitioner has made earlier, can a low level network be a high level network in some situations and vice versa? It just depends which one has been logged into first and then accesses the other networks?

MR. SCHLATHER: Well, I think there's -- to answer the first part of your question, I think there could be a scenario where a low level network could become a high level network. I mean, that's not something that's described in Odell but I could maybe think of a scenario where that could be true including, for example, if one of the low level networks then joins additional

networks, if that what we're calling a low level network logs into those and the '453 and '395 patents talk specifically about that example in column 8, I believe, how those kind of example would work. So I think there could be a scenario where that would be true.

Tr. 49:11–24. In column 8, the '395 patent describes a scenario where a high-level network could be “thought of as a mid-level network” or “treated as [a] low level network[.]” Ex. 1001, 8:30–32. So, the record here shows that low- and high-level networks are conventional instant-messaging networks that are defined by how they function within the system. *See* Ex. 1001, 8:18–32, 5:51–57, 9:24–29; Tr. 48:25–49:9.

Petitioner argues that a high-level network can be one that is “used to sign in to the communications system, which then successively and automatically signs into other ‘low level’ linked networks.” Pet. 56.

We agree with Petitioner that “[t]his is consistent with how the '395 Patent discloses the potential and purported difference between a ‘high level’ network and a ‘low level’ network.” *Id.* (citing Ex. 1001, 6:45–49).

The '395 patent provides an example of how a user logs into a low-level network “through” the high-level network:

In the example of FIG. 6, the flowchart 600 continues to module 604 where *a user logs into a low level network through the high level network*. Depending upon the implementation and/or user configurations, the user may be logged into the low level network automatically when logging into the high level network, explicitly by the user, or the user may be logged into the low level network when the user selects a contact that is associated with the low level network.

Id. at 9:22–29 (emphasis added). Here, the user can explicitly log into the low-level network, or the system can do it automatically. *Id.*

Thus, based on the complete record before us, we construe “high level network” and “low level network” to be conventional IM networks that perform the corresponding functions recited in the claims.

D. 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; Pet. Reply 1–24. Patent Owner opposes Petitioner’s contentions. PO Resp. 1–60; PO Sur-Reply 1–24. For the reasons expressed below, and based on the complete record before us, we determine that Petitioner has demonstrated by a preponderance of the evidence that claims 1–11 are unpatentable as anticipated by Odell. 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.

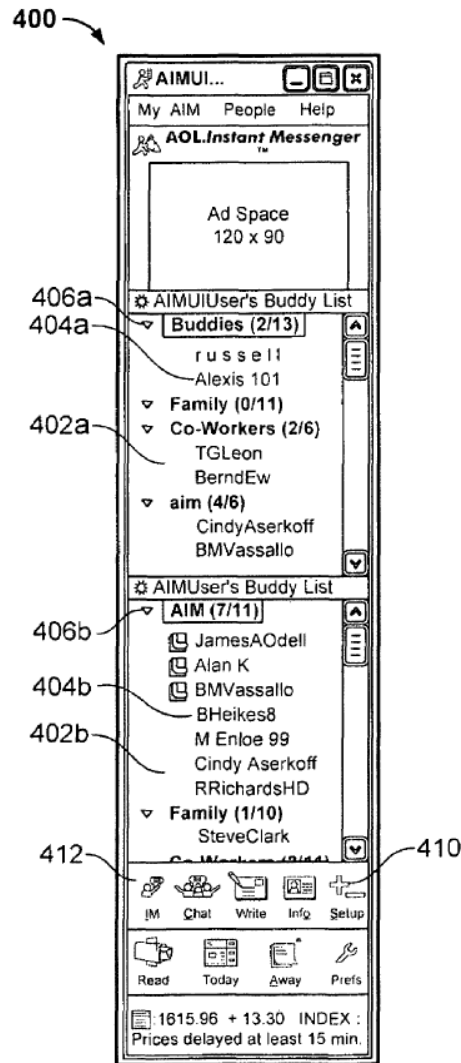


FIG. 4C

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.

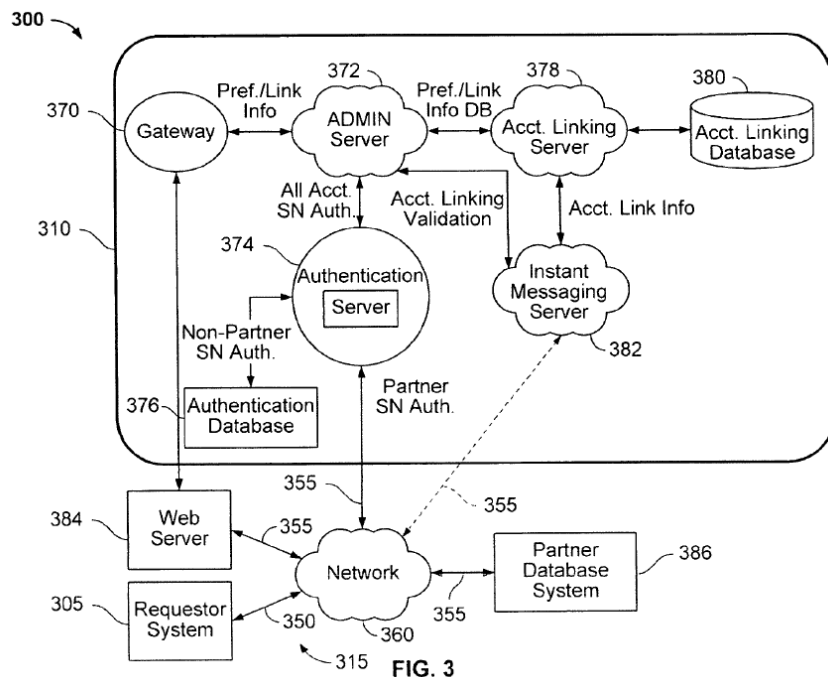


Figure 3 depicts a block diagram of communications system 300.

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. *Independent Claim 1*

Petitioner provides an element-by-element analysis of independent claim 1 in relation to Odell. Pet. 18–55; Pet. Reply 12–22. Petitioner's analysis relies on testimony from its declarant, Mr. Willis. Ex. 1004 ¶¶ 61–127. Patent Owner opposes. PO Resp. 8–24, 32–52; PO Sur-Reply 13–22. As discussed below, Petitioner contends each limitation in claim 1 is disclosed by Odell.

a. *Preamble*

The preamble of claim 1 recites merely “[a] system comprising.” Ex. 1001, 12:36.

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). Neither Petitioner nor Patent Owner takes a position as to whether the preamble is limiting, nor does Patent Owner dispute that Odell discloses a “system,” generally. *See* Pet. 18–19; *see generally* PO Resp.; PO Sur-Reply. Any such argument has been waived by Patent Owner. *See* 37 C.F.R. § 42.23(a) (“Any material fact not specifically denied may be considered admitted.”); *In re NuVasive, Inc.*, 842 F.3d 1376, 1379–82 (Fed. Cir. 2016) (holding that patent owner waived arguments that were not raised in its response after institution); *see also Papst Licensing GmbH & Co. KG v. Samsung Elecs. Am., Inc.*, 924 F.3d 1243, 1250 (Fed. Cir. 2019) (holding patent owner forfeited argument for patentability not presented to the Board); *Bradium Techs. LLC v. Iancu*, 923 F.3d 1032, 1048 (Fed. Cir. 2019) (explaining that arguments not presented to the Board are waived). Because

we find that Petitioner’s cited disclosure from Odell discloses a “system,” we need not determine whether the preamble is limiting. *See Nidec*, 868 F.3d at 1017.

b. Contact Aggregation Engine

Claim 1 recites, in part, “a contact aggregation engine coupled to the network login engine and the network contacts database.” Ex. 1001, 12:41–42.

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). As discussed below, we find persuasive Petitioner’s alternative contention here, namely that the combination of admin server 372 and account linking server 378 discloses the claimed “contact aggregation engine,” and thus, need not and do not reach whether admin server 372 alone also does so. *See* PO Resp. 42–43 (Patent Owner arguing “the Willis Declaration was incorrect” in stating admin server 372 alone discloses the “contact aggregation engine.”).

Patent Owner’s arguments are not specifically directed to whether the contact aggregation engine is *coupled to* the network login engine and the network contacts database. *See* PO Resp. 41–44. Rather, Patent Owner’s arguments are based on whether Odell aggregates contacts or stores aggregated contact lists on a server. *See id.*

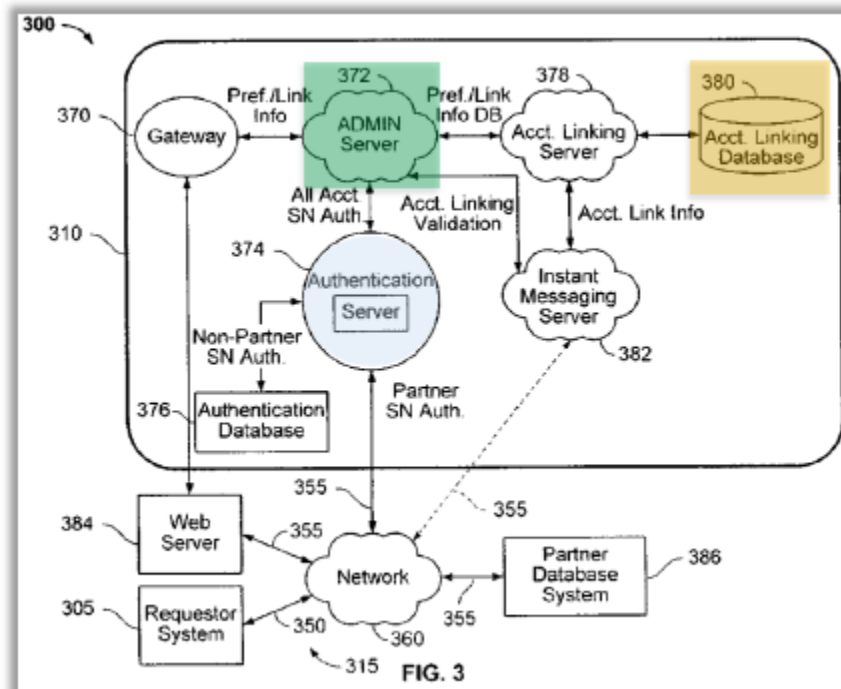
For the reasons discussed above in Section II.C.2 (claim construction), “contact aggregation engine” means a system or software component that aggregates contacts by performing the functions recited in the “wherein” clause—i.e., controlling, updating, maintaining, storing, and providing as recited. Under this construction, Petitioner shows sufficiently that Odell’s admin server 372 and account linking server 378 perform these functions for the reasons discussed in the sections that follow. *See infra* Sections

II.D.2.b.i–vi. We disagree with Patent Owner’s arguments and explain why in the sections that follow. *Id.*

As for the “coupled to” limitation, Petitioner asserts that admin server 372 and account linking server 378 are “coupled to the network login engine and the network contacts database”—i.e., authentication server 374 and the account linking database 380, under Petitioner’s rationale.

Pet. 37–41. Patent Owner does not specifically dispute the assertion that Odell’s admin server 372, account linking server 378, authentication server 374, and account linking database 380 are coupled or communicate in this way. *See generally* PO Resp.; PO Sur-Reply.

Considering the totality of the evidence, we agree with Petitioner that admin server 372 and account linking server 378 are “coupled to” authentication server 374 and account linking database 380. *See* Pet. 37–41. In particular, Odell’s Figure 3 is reproduced below with Petitioner’s annotations:



Odell's Figure 3 shows admin server 372 (highlighted in green) and account linking database 380 (highlighted in yellow). *Id.* at 39. The figure shows a double-headed arrow between admin server 372 and authentication server 374 (the recited "network login engine"). *Id.* The figure also shows admin server 372 connected to account linking database 380 via two double-headed arrows through account linking server 378. *Id.*

According to Odell, "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." Ex. 1006, 7:20-24 (*quoted in* Pet. 40). Petitioner asserts that Figure 3 "shows that 'Acct. Link Info' is communicated between each 'Instant Messaging Server' and the account linking server 378." Pet. 40.

Based on the complete record before us, Petitioner shows sufficiently that admin server 372 and account linking server 378 (the recited "contact aggregation engine") are "coupled to" authentication server 374 (the recited "network login engine") and account linking database 380 (the recited "network contacts database"). *See id.* at 37–41.

Claim 1 expressly recites five functions that the contact aggregation engine performs "in operation." Ex. 1001, 12:43–58. Because the contact aggregation engine is defined by how it operates, we address whether admin server 372 and account linking server 378 are a "contact aggregation engine" in the sections that follow.

i. Network Login Engine

Claim 1 recites, in part, that "in operation, the contact aggregation engine[] controls the network login engine." Ex. 1001, 12:43–44.

Petitioner contends that Odell's admin server 372 controls authentication server 374 (the recited "network login engine") to login or facilitate login to numerous networks. Pet. 41.

Patent Owner argues that "the Petition fails to provide any description, including any disclosure from Odell, of whether or how the combination of the admin server [372] and the account linking server [378] controls the [authentication] server [374]." PO Resp. 46³ (citing Ex. 2006 ¶ 135); *see* PO Sur-Reply 19. We disagree.

Petitioner supports its position by pointing out that "Odell's admin server 372 controls the network login engine (the authentication server 374) by sending requests for account validation and login." Pet. 42 (citing Ex. 1004 ¶¶ 106–107). Petitioner's assertion and Mr. Willis's corresponding testimony are sufficiently supported by Odell's disclosure.

Odell describes admin server 372 as a "clearinghouse" for "linked account validation functions." Ex. 1006, 6:57–60 (*quoted in* Pet. 41–42). Odell's "authentication server 374 is configured to process and to validate account authentication requests from the admin server 372 against the authentication database 376 and any partner database system 386." Ex. 1006, 7:4–7 (*quoted in* Pet. 42). We agree with Petitioner that, in at least this way, admin server 372 controls authentication server 374, and we credit the declaration of Mr. Willis on this issue. *See* Pet. 41–43; Ex. 1004 ¶¶ 105–107.

³ Here, Patent Owner uses the term "*authorization* server" instead of "*authentication* server." PO Resp. 46 (emphasis added). Because Petitioner maps Odell's authentication server 374 to the "network login engine" (Pet. 25–26), we understand Patent Owner's references to "authorization server" to mean "authentication server" (PO Resp. 46).

Odell also describes admin server 372 as a “clearinghouse” for “account linking information.” Ex. 1006, 6:57–60 (*quoted in* Pet. 41–42). Odell discloses that accounts from multiple communication systems are linked together, and accounts linked to the primary account are signed into sequentially and automatically. *See id.* at 7:60–65, 8:14–32, 14:36–15:3 (*cited in* Pet. 42). We agree with Petitioner that, in this additional way, admin server 372 controls authentication server 374, to sequentially login to multiple networks, and we credit the declaration of Mr. Willis on this issue. *See* Pet. 41–43; Ex. 1004 ¶¶ 105–107.

Dr. Surati’s testimony on this issue does not give sufficient weight to Odell’s disclosure of how authentication server 374 is configured to process and to validate account authentication requests from admin server 372. *See, e.g.,* Ex. 2006 ¶ 135. Thus, we do not credit Dr. Surati’s testimony on this issue. *See id.*

Based on the complete record before us, we find Petitioner shows sufficiently that Odell discloses that “in operation, the contact aggregation engine[] controls the network login engine.” *See* Pet. 41–43. We also find, *a fortiori*, Petitioner shows sufficiently that Odell discloses the underlying “network login engine” being “control[led]” in this limitation for the same reasons. *See* Pet. 20–26; PO Resp. 32–38; Pet. Reply 12–14; PO Sur-Reply 13–15.

ii. Login

Claim 1 recites, in part, that 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.” Ex. 1001, 12:43–47.

We find Petitioner shows sufficiently that Odell discloses this limitation, as discussed below.

(a) *Messaging Service Provider*

We construe “messaging service provider” to mean the computer system or platform providing a distinct messaging service (and not the company at any given time that might own that system or platform), as discussed above in Section II.C.3 (claim construction).

Petitioner contends that Odell discloses 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)). 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).

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’s declarant, Mr. Willis, testifies that “[t]hese multiple accounts are equivalent to first and second ‘networks’ and ‘messaging services.’” Ex. 1004 ¶ 105.

Indeed, the ’395 patent recognizes that AIM and ICQ, for example, 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, 1:40–43 (emphasis added) (*cited in* Pet. 41). Patent Owner does not dispute this. *See, e.g.*, Tr. 40:13–23 (“[Judge:] So Counsel, you agree that AOL Instant Messenger and ICQ are different messaging services? [Patent Owner’s counsel:] That is what the patent says, yes.”), 42:14–19 (“[Judge:] And counsel, just perhaps to clarify a prior question [of mine], is it Patent Owner’s position that AIM and ICQ would constitute the first -- a first messaging service and a second messaging service? [Patent Owner’s counsel:] I think they could because the patent, as I mentioned, the patent describes them as different messaging services.”). Patent Owner’s expert, Dr. Surati, also stated that they can be considered separate services:

Q And in this passage, AOL Instant Messenger is listed separately from ICQ; correct?

A Yeah. They're -- they can be considered separate communication services.

Ex. 1039, 120:12–16.

Nonetheless, Patent Owner asserts repeatedly that Odell's "accounts" are not "networks" and AOL, AIM, and ICQ are not distinct messaging service *providers* but rather a single network or communications system operated by America Online. *See, e.g.*, PO Resp. 44–46; *see also supra* Section II.C.3. But Patent Owner's arguments here depend on its proposed construction of "messaging service provider" that we do not adopt. *See supra* Section II.C.3; *see also infra* Section II.D.2.b.ii.b (discussing accounts versus networks).

For example, Patent Owner argues that Odell discloses a single network and a single messaging service provider. PO Resp. 25 (citing Ex. 1006, Figs. 1, 3; 3:57–60, 6:32–34); *see id.* at 34 (citing Ex. 1006, 7:62–65). In Patent Owner's view, Odell has no need for first and second networks (or high- or low-level networks (*see infra* Section II.D.2.b.ii.b)) because the America Online network is the only network. *Id.* at 29 (citing Ex. 2006 ¶ 175), 30 (citing Ex. 2006 ¶ 176). Patent Owner argues that "AOL, AIM and ICQ were owned and provided by America Online at the time of the inventions of the '395 Patent." *Id.* at 34 (citing Ex. 2006 ¶¶ 109–113; Ex. 2002; Ex. 2014; Ex. 2015; Ex. 2016). Patent Owner argues that, even if "AOL, AIM and ICQ were separate communication systems," each would be associated with a *single* messaging service and "provided by only a *single* messaging service *provider*, America Online." *Id.* at 37 (emphases added).

Patent Owner argues that Figures 6A through 6D show that the AIM and AOL screen names can be linked, but AOL and AIM were commonly owned and operated by America Online. PO Resp. 37. Patent Owner argues that the buddy lists in Figure 4C are from the same communications system and same network: AIM. *Id.* at 22–23 (citing Ex. 2006 ¶ 145; Ex. 1006, 9:15–26).

We disagree with Patent Owner’s arguments about Odell’s figures, and do not credit Dr. Surati’s testimony on these points. *See* PO Resp. 22–23, 36–38; Ex. 2006 ¶¶ 84, 117–118, 145. Odell describes an AIM account as being different from a dating-service or gaming-club account:

In addition, accounts from partner domains may be linked. For example, accounts of an online gaming club may communicate using the AIM communications system, and *the accounts from the gaming club may be linked to AIM accounts* such that communications may be sent and received by gaming club accounts while not signed into the gaming club on a gaming device. Similarly, *accounts from a dating service that uses the AIM communications system may be linked to other accounts* such that the members of the dating service can communicate *with their dating service accounts* while not logged in to the dating service.

Ex. 1006, 8:19–29 (emphases added). This suggests that Odell uses more than a single system. *See id.*

Also, Patent Owner and Dr. Surati do not give sufficient weight to Odell’s disclosure that not all accounts are maintained by the provider system. *See* PO Resp. 20–25, 33–38; Ex. 2006 ¶¶ 84, 117–118, 145. According to Odell, “[f]or accounts that are *not maintained by the provider system 310*, the authentication server 374 is configured to communicate the authentication requests to an appropriate partner database system 386 for

authentication and validation.” Ex. 1006, 7:15-19 (emphasis added). These authentication requests suggest that an IM network must join another IM network to access the contact list of the other IM network, even under Patent Owner’s definition. *See, e.g.*, PO Resp. 27 (arguing that “a ‘high level network’ is ‘an IM network that joins or has joined another IM network to access the contact list of the other IM network.’”). Petitioner’s position is further bolstered by Patent Owner’s evidence showing that the AIM and ICQ networks were “not interoperable.” Ex. 2015, 5 (“With the introduction of AIM, ICQ, Yahoo! Messenger, and MSN Messenger[,] IM became a field where large corporations were developing proprietary code, *which were not interoperable.*”).

Based on the complete record before us, we find Petitioner shows sufficiently that Odell discloses a plurality of computer systems or platforms providing distinct messaging services (e.g., AOL, AIM, and ICQ), and therefore, discloses first and second messaging service providers as recited, for example, in claim 1.

(b) *First and Second Networks (e.g., High- and Low-Level Networks)*

We also determine that the evidence favors the conclusion that the distinct messaging service providers (e.g., first and second providers) have distinct associated networks, which correspond to the recited first and second networks (and may also include high- and low-level networks as used in the ’395 patent). *See, e.g.*, Pet. 41. Because it is unclear from Patent Owner’s Response and Sur-Reply whether Patent Owner intends its arguments concerning high- and low-level networks to support its position concerning the “first” and “second” networks recited in claim 1, or to otherwise undermine Petitioner’s showing regarding those limitations,

we address below Patent Owner’s arguments concerning high- and low-level networks as they might be considered relevant to whether Odell discloses a first network associated with a first messaging service provider and a second network associated with a second messaging service provider.

To begin, we disagree with Patent Owner’s characterization of the Petition. *See* PO Sur-Reply 14. According to Patent Owner, Petitioner “argues that an ‘account’ is a ‘network.’” *Id.* (citing Reply 12). This mischaracterizes Petitioner’s position. Petitioner characterizes Patent Owner’s argument as divorcing “accounts from networks,” not that the accounts themselves are networks. Pet. Reply 12. Petitioner explains that “[c]ommunications ‘systems’ include networks,” and argues that Patent Owner “equates ‘systems’ with ‘networks’ as well.” Pet. Reply 13 (citing Ex. 1001, 1:40–45, 3:52–55; PO Resp. 45–46). Petitioner’s assertions about networks were made in support of its rebuttal that Odell is not limited to a single network. *See id.* at 12–14.

To be clear, Petitioner asserts that the accounts are *associated with* a network. Pet. Reply. 13. We agree there are multiple networks. *See id.* For example, Odell discloses that the accounts come “from multiple communication systems,” and they “may be linked together.” Ex. 1006, 8:14–32. The accounts can be from AOL, AIM, and ICQ. *Id.* According to the Petition, Odell’s primary account is in, for example, the AIM network, and Odell’s linked accounts can be in, for example, the ICQ network, among others. Pet. 20–25 (*discussed in* Pet. Reply 13–14). The Petition’s analysis of the claimed “network login engine” relies on Odell’s authentication server 374. Pet. 25. According to the Petition, authentication server 374 logs into the networks. *See* Pet. 25 (citing Ex. 1004 ¶¶ 67–76).

We agree with Petitioner that Odell's multiple networks include a first network associated with a first messaging service provider and a second network associated with a second messaging service provider (and that Odell discloses such first and second networks are, or at least may include, high- and low-level networks). Pet. 20 ("The 'primary account' of Odell corresponds to an account in the 'high level network' of Claim 1 . . . , while the other 'linked accounts' accessible via the 'primary account' correspond to accounts in the 'low level networks' of Claim 1." (citing Ex. 1006, 2:65–3:12; Ex. 1004 ¶ 70)); *see* Pet. 27, 41–43. Although not recited explicitly in claim 1, we note that we have construed "high-level network" and "low-level network" for purposes of other challenged claims to mean conventional IM networks that perform the corresponding functions recited in the claims. *See supra* Section II.C.4 (claim construction).

Petitioner shows sufficiently that Odell discloses such networks. In particular, Petitioner asserts that the networks associated with Odell's primary account and linked accounts correspond to the recited high-level network and low-level networks. Pet. 20, 41–43. According to Mr. Willis, each "screen name" in Odell represents an account, the primary service provider corresponds to the high-level network, and a third-party "linked account" service provider corresponds to the low-level network. Ex. 1004 ¶¶ 108–109 (citing Ex. 1006, 6:58–7:10). Petitioner asserts that Odell discloses "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," as recited in claim 1, because Odell's authentication server 374 "facilitate[s] 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. 25 (citing Ex. 1004 ¶¶ 67–76).

Petitioner shows sufficiently that Odell’s system logs the user into the network associated with the linked account when logging the user into the network associated with the primary account. *See* Pet. 41–43. Specifically, Petitioner asserts that 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” Pet. Reply 23. Petitioner asserts that, in Odell’s embodiments, the high- and low-level networks are the AOL network and the networks associated with AIM or ICQ:

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.

We agree that Odell’s networks are first and second networks, as recited in claim 1, and also constitute high- and low-level networks (as recited in other challenged claims). *See* Pet. 42–43. Odell discloses that first “authentication information for a primary account for signing into the communication system is entered and verified,” and later, a set of accounts are “linked to the primary account.” Ex. 1006, 14:38–49 (*quoted in* Pet. 24). Odell explains that “the accounts that are linked to the primary account are signed in to the communications system sequentially.” Ex. 1006, 14:65–67. These passages indicate that the networks have different roles in Odell and, for this reason, they are not a single network.

We find Patent Owner’s arguments to the contrary unavailing. *See* PO Resp. 25–30, 44–46. Patent Owner argues that Odell’s accounts “are merely aliases for the same user of the system and network provided by a single messaging service provider.” *Id.* at 24–25. Patent Owner argues that “Odell discloses that the primary account and ‘the linked accounts all may appear to be logged into the communications system simultaneously’, *i.e.*, in a single network.” *Id.* at 30 (citing Ex. 2006 ¶ 73); *see id.* (arguing that Odell has a single network); Ex. 1006, 3:3–6.

But Patent Owner’s argument that Odell discloses one system (PO Resp. 30) does not give sufficient weight to Odell’s disclosure of several distinct messaging services, *e.g.*, AIM and ICQ, that are linked and are associated with other systems and networks. *See, e.g.*, PO Resp. 25–30. For the same reason, we do not credit the corresponding parts of Dr. Surati’s Declaration. *See, e.g.*, Ex. 2006 ¶¶ 71–76.

The record better supports Petitioner’s argument that Odell discloses “numerous 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.” Pet. 41 (citing Ex. 1001, 1:40–45). The relationship between Odell’s networks is similar to the relationship between high- and low-level networks in the ’395 patent:

The network login engines 310 may include logic and storage that facilitates login to the various low level networks 302. For example, the network login engine 310-1 may include a user name (and perhaps a password, if the password is not requested from the user at each login) associated with the low level network 302-1.

Ex. 1001, 6:1–6 (*quoted in* Pet. 25–26). Likewise, Odell’s servers sequentially log into a first account associated with AOL and a second account associated with AIM or ICQ, through a network associated with the “primary account”—i.e., the primary network. *See* Pet. 42–43. Because it is consistent with Odell on this point, we credit the Willis Declaration.

Ex. 1004 ¶¶ 105–107.

Nor do we agree with Patent Owner’s argument that Odell describes a single system because “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.” PO Resp. 28 (quoting Ex. 1006, 7:60–65) (emphasis added). That is, Patent Owner argues “the communications system” means that Odell uses a single system. *Id.* at 30. But, even if “the communication system” is a single system, we see little support for the proposition that the linked account can only login to that system and no other. *See id.* at 25–30, 32–38. For example, Odell’s linked accounts may be used to sign on to “the communication system” as well as other third-party messaging services. *See* Ex. 1006, 7:63–65.

Still, Patent Owner’s argument that the same account can be used to sign on to the communication system (PO Resp. 32–34) does not account for Odell’s disclosure that “account attributes may be forwarded from the authentication database 376 through the authentication server 374” (Ex. 1006, 7:12–15). This disclosure indicates that Odell’s system facilitates communication with other systems and is not a single system or network. *See id.*

We disagree with Patent Owner that the Petition “fails to specify any ‘low level network’” (PO Resp. 26). In the context of the ’395 patent, AIM

and ICQ, which are used in Odell, can be low-level networks. Ex. 1001, 3:52–55. Specifically, “low level networks 302 may include, by way of example but not limitation, various IM networks.” *Id.* at 5:54–55. These IM networks could be “MSN Messenger, Yahoo! Messenger, AIM AOL, ICQ, QQ, Jabber, Google Talk, IRC, or some other known or convenient IM network.” *Id.* at 3:52–55; *see also id.* at 8:19–22 (“Low level networks may include IM networks, such as MSN Messenger, Yahoo! Instant Messenger, AIM, or any other known or convenient network.”). Thus, the patent indicates that AIM and ICQ, as used in Odell, can be “low level networks.” *See id.* at 5:54–55, 3:52–55, 8:19–22.

We also find Patent Owner’s arguments about the high-level network unavailing. PO Resp. 25–30. Patent Owner disagrees that Odell’s “primary account” is on the high-level network because “the primary account is merely ‘chosen by the user to sign into the communication system.’” *Id.* at 27–28 (citing Ex. 1006, 3:11–12; Ex. 2006 ¶ 105).

But we see no reason why the user’s choice disqualifies Odell’s network from being a high-level network. For example, the patent describes that the method could also work by joining high-level networks as if the high-level networks were low-level. Ex. 1001, 8:22–24 (describing Figure 5) (*cited in* PO Resp. 29). During oral argument, Patent Owner’s counsel explained that the same network could be a high-level network or a low-level network. Tr. 49:11–24. That is, the challenged patent discloses that a high-level network is not a ridged classification that must be established at the time of design. *See* Ex. 1001, 8:18–32. Rather, how a network functions in the system determines whether it is a high- or low-level network, which means that the role of a network could be chosen during the

operation of the system—e.g., by a user. *See id.* at 8:18–32; Tr. 49:7–9; *see also supra* Section II.C.4 (construing high- and low-level network).

Patent Owner argues that the Willis Declaration “admits that Odell does not disclose ‘high level’ and ‘low level’ networks.” PO Resp. 29 (citing Ex. 1004 ¶ 154). We disagree. The cited part of the Willis Declaration explains that Odell uses different language to describe the same thing: “Instead of ‘high level’ and ‘low level’ networks, ‘696 Odell *uses the language* ‘primary account’ and ‘linked account(s).’” Ex. 1004 ¶ 154 (citing Ex. 1006, 3:11–16) (emphasis added). Again, the high- and low-level networks are classified as such based on how they function. *See, e.g.*, Ex. 1001, 8:18–32; Tr. 49:7–9. On this point, we credit the Willis Declaration for all the reasons discussed above. Ex. 1004 ¶ 154.

Patent Owner argues that the high-level network stores an aggregated contact list in non-local storage. PO Resp. 27. Patent Owner argues that, “in the absence of an aggregated contact list stored in non-local storage, Odell does not disclose a high level network.” PO Resp. 29 (citing Ex. 2006 ¶¶ 86–91). But, as discussed above in Section II.C.4 on claim construction, claim 1 already recites that the contact aggregation engine “stores the aggregated contact list in a non-transitory computer readable medium *at the web server.*” Ex. 1001, 12:56–57 (emphasis added). We disagree with Patent Owner’s argument for the same reasons discussed in Section II.C.4—i.e., the claim does not require non-local storage beyond what is otherwise recited elsewhere in the claim. Also, we disagree that Odell lacks non-local storage or storage “at the web server” for the same reasons discussed in Sections II.C.2 and II.D.2.b.v.

Thus, based on the complete record before us, we find Petitioner shows sufficiently that Odell discloses that 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,” as recited in claim 1.

iii. Network Contacts Database

Claim 1 recites, in part, “a network contacts database embodied in one or more non-transitory computer-readable mediums,” and “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.” Ex. 1001, 12:38–39, 12:48–50.

Petitioner contends that Odell discloses the “network contacts database” 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); *see* Pet. Reply 14–16. 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.”); *see* Pet. Reply 14–16. 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).

Petitioner contends that Odell discloses the “update[ing] the networks contacts database” 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). We find Petitioner arguments persuasive.

Patent Owner argues that Odell’s account linking database 380 does not store buddy lists. PO Resp. 38–41. In particular, Odell states that account linking database 380 “maintains user buddy list and account linking *information*.” Ex. 1006, 7:20–22 (emphasis added). So, Patent Owner argues that, here, Odell’s “buddy list information” is “*not* the buddy list itself.” PO Resp. 39 (citing Ex. 1001, 7:20–22). In Patent Owner’s view, “buddy list information” could be information about the buddy list, and “account linking information” could be a pointer or other locator that identifies the actual location where the user’s linked buddy lists are stored. *Id.* at 39 (“information about buddy lists”), 41 (citing Ex. 1006, 7:24–27; Ex. 2006 ¶ 117); *see* PO Sur-Reply 15–17. Patent Owner argues that Odell does not disclose where the buddy lists are stored. PO Resp. 39, 41.

According to the Willis declaration, “[t]he ‘buddy list information’ stored and maintained in account linking [database] 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[s] as part of storing all ‘buddy list information.’” Ex. 1004 ¶ 78 (citing Ex. 1006, 14:36–15:3). On this point, we find the Willis declaration is adequately supported: The cited part of Odell explains that “buddy lists for the primary and linked accounts” are displayed. *See, e.g.*, Ex. 1006, 15:1–3. Also, Odell states that “account linking database 380

. . . stores and maintains user buddy list and account linking information.”
Id. at 7:20–22 (*cited in* Pet. 26).

As for this Odell passage, we disagree with Patent Owner’s argument that buddy lists are different from the buddy list information. PO Resp. 38–41. Under Patent Owner’s reasoning, for example, Odell would store buddy lists locally on the user’s machine, and account linking database 380 would store some other information associated with the locally stored lists. *Id.* at 40–41. We see no evidence that indicates that Odell’s account linking database 380 would need to store additional information somehow corresponding to the buddy list but excluding the contacts themselves. *See id.*

Rather, Odell’s system needs the contacts from the buddy list because the interface displays those contacts to the user. *See, e.g.*, Ex. 1006, 2:47–49, 14:67–15:3. Dr. Surati explained that “if it’s going to display [the buddy list], it has to have the buddy list somewhere.” Ex. 1039, 129:17–19. Storing information other than the buddy list would require additional steps to create the displayed buddy list. *See, e.g.*, Ex. 1039, 130:1–23 (discussing the possibility of constituting the buddy lists at the client right before it is displayed). We see no evidence that such additional steps would provide any benefit or outweigh the costs of the extra processing that the client must perform, for example. Instead, Petitioner has provided sufficient evidence to show that Odell’s account linking database 380 must store a list of contacts, so that Odell’s system can perform the account-linking and display functions. *See* Pet. 26–28; Ex. 1004 ¶ 78 (citing Ex. 1006, 14:36–15:3).

As with other limitations, Patent Owner also argues repeatedly that Odell does not disclose first and second messaging service providers, and therefore, cannot disclose this limitation. *See* PO Resp. 46–48. But, as

discussed above in Sections II.C.3 and II.D.2.b.ii.a, we find Patent Owner’s premise here unavailing.

Thus, based on the complete record before us, we find Petitioner shows sufficiently that Odell discloses “a network contacts database embodied in one or more non-transitory computer-readable mediums,” and “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,” as recited in claim 1.

iv. Aggregated Contact List

Claim 1 recites, in part, “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.” Ex. 1001, 12:43, 51–55. We construe “aggregated contact list” to mean a contact list resulting from gathering and collecting contacts from multiple contacts lists, as discussed above in Section II.C.1 (claim construction).

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).

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

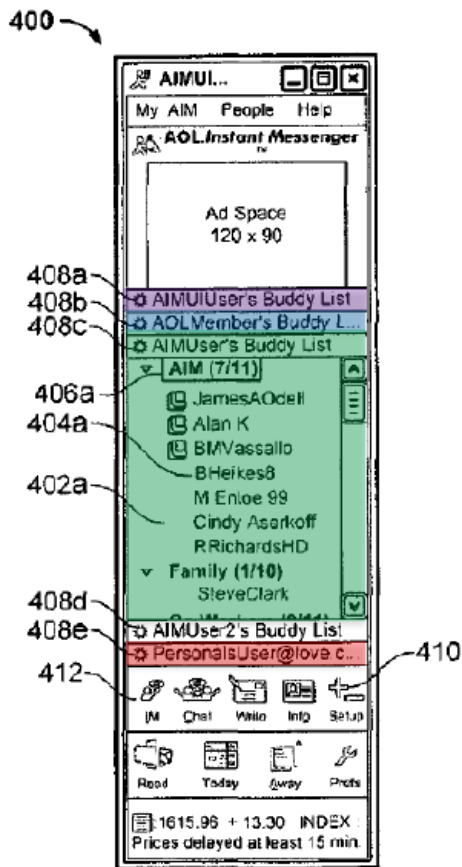


FIG. 4A

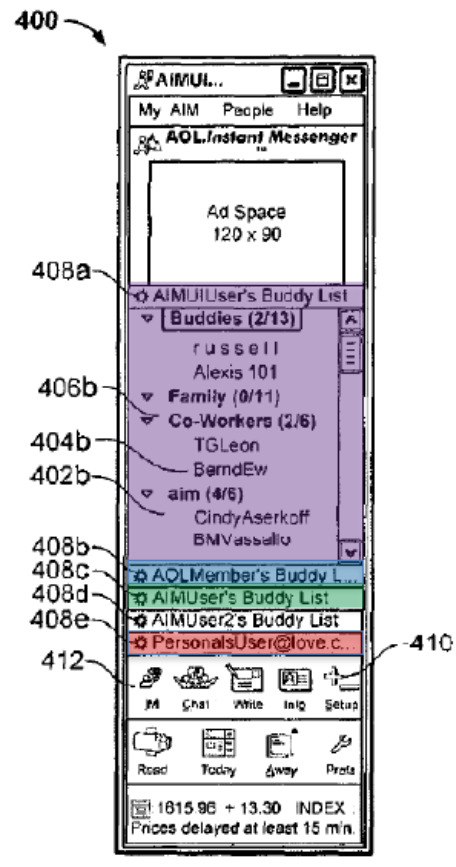


FIG. 4B

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.

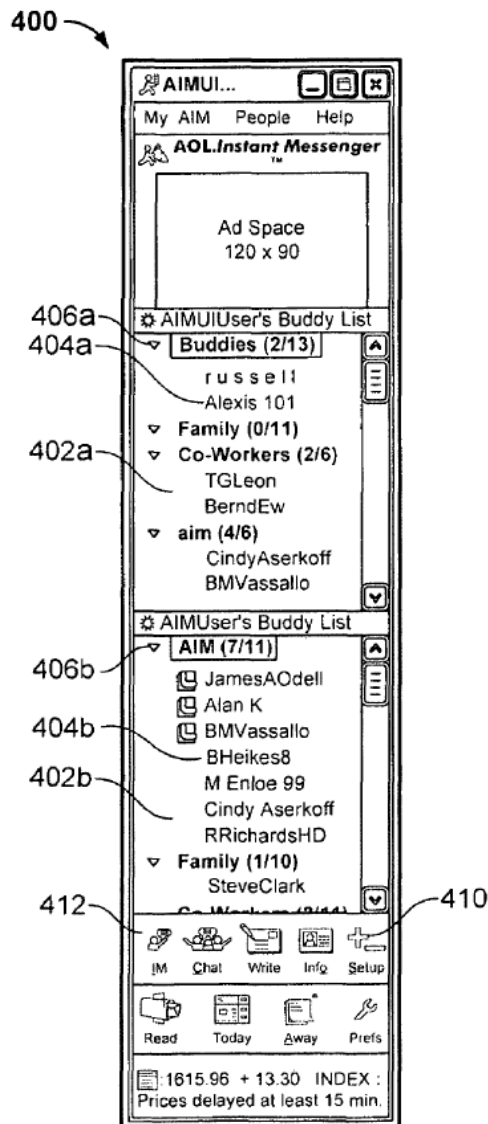


FIG. 4C

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 that Odell’s Figure 4C shows a “set of buddy lists,” not an aggregated list. PO Resp. 9–10 (citing Ex. 1006, 2:43–49, 3:23–36, 8:55–56; Ex. 2006 ¶¶ 59, 145). In Patent Owner’s view, Odell’s GUI simultaneously displays multiple, single, non-aggregated lists. *Id.* at 10–11, 15 (citing, *inter alia*, Ex. 2006 ¶ 59), 49 (citing Ex. 2006 ¶ 150). Patent Owner annotates Odell’s Figure 4C to allegedly support its argument, as reproduced below. *Id.* at 9–10.

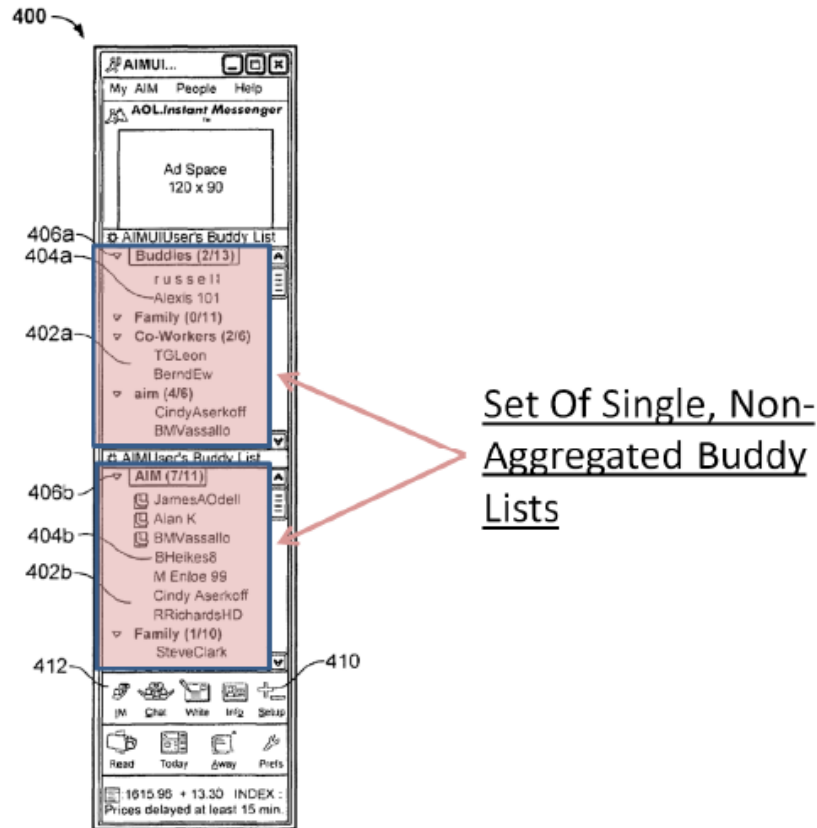


FIG. 4C

Figure 4C is reproduced above with Patent Owner’s annotation on the contacts shown in Odell’s GUIs. PO Resp. 9–10. Patent Owner’s annotation identifies what it alleges are a set of single, non-aggregated buddy lists. *Id.* Patent Owner argues that Odell’s list can be individually collapsed and each linked account has one tab, which further shows that it is not aggregated. *Id.* at 10–12 (citing Ex. 2006 ¶ 59; Ex. 1006, 8:47–40, 8:55–59). Patent Owner argues that Figures 4A and 4B are different embodiments that show only a single list at a time. *Id.* at 9–10 (citing Ex. 1006, 2:43–49, 3:23–36, 8:55–56, 9:30–32; Ex. 2006 ¶¶ 59, 145); *id.* at 13 (arguing that Petitioner blurs the lines between embodiments).

As discussed above in Section II.C.1 (construing “aggregated contact list”), we disagree that the “aggregated contact list” cannot have its contacts organized into folders or other divisions, collapsible or not. Rather, it is

sufficient that Odell discloses that “a single GUI shows a buddy list . . . for the primary account and each of the linked accounts.” Ex. 1006, 3:11–16. Like Odell’s disclosed GUI, the ’395 patent discloses a buddy list with contacts organized or split into groups and tabs. *Compare* Ex. 1001, 6:57–7:25 (describing tabs and folders), *with* Ex. 1006, 8:47–63 (describing tabs). In at least this way, Odell discloses features of the aggregated contact list described in the ’395 patent.

Patent Owner argues that Odell discloses that each account has a separate buddy list. PO Resp. 13–14 (citing Ex. 1006, 3:17–25; Ex. 2006 ¶ 155). Patent Owner argues that Odell emphasizes “separateness and non-aggregation” throughout its disclosure. *Id.* at 13 (citing Ex. 1006, 17:34–40). Patent Owner argues that separate lists are not aggregated lists. *Id.* at 14–16 (citing, *inter alia*, Ex. 2006 ¶ 121). In Patent Owner’s view, Odell’s Figures 4A and 4B, in particular, display individual buddy lists. *Id.* at 15–16 (citing Ex. 1006, 8:47–49, 9:1–5). Patent Owner’s argument here is undermined by the ’395 patent’s disclosure that a folder may contain contacts from a particular network. Ex. 1001, 7:16–20. That particular network may have an associated “user name.” *Id.* at 6:3–6. This indicates that, like Odell, the ’395 patent can organize contacts by screen name. *See id.* at 7:16–20. In fact, Odell discloses that its system can organize information in different ways. Ex. 1006, 7:27–32 (*discussed in* PO Resp. 14). This bolsters Petitioner’s argument that Odell’s list discloses the claimed list. *See* Pet. 44–48. For this reason, we disagree that the claim somehow excludes Odell’s GUI on the basis that it organizes the contacts in a particular way, and we give little weight to Dr. Surati’s testimony on the issue of screen-name organization (Ex. 2006 ¶ 156).

Patent Owner points out that “Odell clarifies that ‘adding a screen name to a buddy list of a linked account causes the screen name to be added to the buddy lists of the other linked accounts.’” PO Resp. 12 (quoting Ex. 1006, 9:1–5). In Patent Owner’s view, “[t]his would be unnecessary if a single, aggregated buddy list were present because it would simply result in duplicate entries in that single list.” *Id.* Patent Owner argues that “Odell must perform this action, however, because Odell maintains separate buddy lists, not an aggregated buddy list.” *Id.* (citing Ex. 2006 ¶¶ 145–146.).

We disagree for reasons similar to those discussed above in Section II.C.1. In particular, Patent Owner’s argument about duplicate contacts is undermined by the ’395 patent’s disclosure that a single contact may be listed in multiple folders. Ex. 1001, 6:64–7:3; *see also* Tr. 31:23–26. We give little weight to Dr. Surati’s testimony on this issue (Ex. 2006 ¶¶ 145–146) because the testimony is not consistent with the ’395 patent’s written description and it is based on Patent Owner’s improperly narrow claim construction. *See supra* Section II.C.1.

Also, we see little support for Patent Owner’s claim that Odell’s tabs somehow indicate that the buddy lists are separately maintained. PO Resp. 11–12 (citing Ex. 1006, 8:47–50, 8:55–59; Ex. 2006 ¶ 150). Rather, for the reasons discussed above in Section II.D.2.b.iii and below in Section II.D.2.b.v, Petitioner shows sufficiently that Odell’s account linking database 380 stores and maintains buddy-list information. Pet. 28 (citing Ex. 1006, 34:64–35:13). Thus, we disagree with Patent Owner’s argument (PO Resp. 11–12) and give little weight to Dr. Surati’s testimony on this issue (Ex. 2006 ¶¶ 145–146).

According to Patent Owner, “the fact that Odell must link to each different list in order to have it included [in] Odell’s GUI” shows that Odell

lacks an aggregated contact list. PO Resp. 44. But it is unclear *why*. Patent Owner provides no support for this statement. Patent Owner offers no citations to the testimony of Dr. Surati or any evidence of record. Nor is there any reasoning apart from this bare assertion. For at least these reasons, this argument is unclear and unpersuasive. Also, to the extent this argument relies on Patent Owner's construction, we disagree with it for the reasons discussed above in Section II.C.1. To the extent that the unstated reasoning behind this argument is similar to Patent Owner's reasoning about Odell's tabs (*id.* at 9–16), we disagree for the same reasons discussed above.

Patent Owner argues that “the only simultaneous display of the separate buddy lists, which is found on Fig. 4C, only involves AIM accounts.” PO Resp. 10 (citing Ex. 1006, Fig. 4A; Ex. 2006 ¶¶ 59, 145; Ex. 1006, 9:15–26). According to Patent Owner, “[t]his is described in the specification as groups, i.e., buddy lists 406a and 406b, which are described as being from ‘the communications system,’ *i.e.*, from ‘the’ same communications system.” *Id.* (citing Ex. 2006 ¶¶ 59, 145; Ex. 1006, 9:15–26).

For reasons similar to those discussed above in Section II.D.2.b.ii, we disagree with Patent Owner's argument (PO Resp. 10) and give little weight to Dr. Surati's testimony on this issue (Ex. 2006 ¶¶ 59, 145). In particular, Patent Owner's argument that Odell discloses one system (PO Resp. 10) does not give sufficient weight to Odell's disclosure of several messaging service providers, e.g., the AIM and ICQ platforms, that are linked and are associated with other systems and networks, as discussed above in Section II.D.2.b.ii. For the same reason, we do not credit the corresponding parts of Dr. Surati's Declaration (Ex. 2006 ¶¶ 59, 145). Instead, the record better supports Petitioner's argument that Odell discloses

more than one system and messaging service provider. *See, e.g.*, Pet. 41 (citing Ex. 1001, 1:40–45).

Patent Owner argues that a single GUI is “only a convenient way of displaying multiple, separate lists,” but it is not an “aggregated buddy list.” PO Resp. 16 (citing Ex. 2006 ¶¶ 145–146); PO Sur-Reply 18 (arguing Odell “merely displays non-aggregated buddy lists on the same screen”). Although Petitioner notes that Odell displays lists from three messaging service providers in a single GUI, that is not the sole basis for its challenge. *See* Pet. 44–48 (*cited in* PO Resp. 15–16). Patent Owner’s argument here does not give sufficient weight to Mr. Willis’s testimony about the interaction with the networks and messaging services (Ex. 1004 ¶¶ 111–114) or Petitioner’s explanation of how Odell gathers and collects the buddy lists (*see, e.g.*, Pet. 26–28, 44–48).

For example, Petitioner shows sufficiently that Odell discloses gathering and collecting contacts from multiple contacts lists, and the result is the recited “aggregated contact list.” *See supra* Section II.C.1. In particular, we agree that Petitioner shows sufficiently that Odell’s system logs into a first network associated with a first messaging service provider (e.g., AOL) and a second network associated with a second messaging service provider (e.g., AIM or ICQ), and the system stores all buddy lists from those networks in account linking database 380. *See* Pet. 44–48; *supra* Section II.D.2.b.iii. For example, Odell explains that “buddy lists for the primary account and the linked accounts” are displayed. *See, e.g.*, Ex. 1006, 15:1–3. Odell’s account linking database 380 “stores and maintains user buddy list and account linking information.” *Id.* at 7:20–22. We credit Mr. Willis’s testimony about the aggregated contact list (*see* Ex. 1004

¶¶ 111–114), because, for example, it is consistent with the above-cited disclosures from Odell.

Thus, based on the complete record before us, we find Petitioner shows sufficiently that Odell discloses “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,” as recited in claim 1.

v. *Web Server*

Claim 1 recites, in part, “a web server coupled to the network contacts database” and “wherein, in operation, the contact aggregation engine . . . stores the aggregated contact list in a non-transitory computer readable medium at the web server.” Ex. 1001, 12:40, 56–57.

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.” PO Resp. 50 (citing Ex. 2006 ¶¶ 159–166); see *id.* at 50–51. Patent Owner also argues, as it did concerning the “network contacts database” discussed above (*see supra* Section II.D.2.b.iii), 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 50. 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 (emphases added). Patent Owner’s expert, Dr. Surati, disputes Mr. Willis’s testimony (e.g., one testifies “necessarily” disclosed, and the other testifies “not” so). *See* Ex. 2006 ¶¶ 159–166 (*cited in* PO Resp. 50–51).

Petitioner responds:

Patent Owner does not and cannot dispute that both the admin server 372 and the web server 384 would necessarily (*i.e.*, inherently) store the aggregated contact list as part of their operation in controlling the flow of information and serving the aggregated contact list to the user via interfaces such as in Figures 4A-C, as established in the Petition (at 48-52).

Patent Owner also fails to rebut the evidence that it has similarly interpreted this claim limitation in the related litigation.

Pet. Reply 21.

Patent Owner argues Petitioner’s “inherency” argument here is “untimely and improper,” but does not explain its position as to *why*. PO Sur-Reply 21. Indeed, Petitioner argued inherency regarding the subject limitation in its Petition (*see, e.g.*, Pet. 50 (arguing “the admin server 372 would necessarily store the aggregated contact list”)), and Petitioner’s expert, Mr. Willis, testified as to the inherent disclosure of the subject limitation in his original declaration (*see, e.g.*, Ex. 1004 ¶ 123 (“‘[S]toring’ (as interpreted in view of the ‘395 Patent) the aggregated contact list in some computer-readable medium at the admin server 372 would be necessary for it to perform these functions.”)). Patent Owner also attempts to dismiss Petitioner’s argument concerning Patent Owner’s infringement contentions by arguing that Odell does not disclose an “aggregated contact list” (with which we do not agree (*see supra* Section II.D.2.b.iv)), whereas Petitioner’s

accused system allegedly does use such a list. PO Sur-Reply 21–22. Thus, we find Patent Owner’s arguments unavailing. Also, having considered the dueling testimony of the parties’ experts on the subject limitation, we credit the testimony of Petitioner’s expert, Mr. Willis, as that testimony better aligns with Odell’s disclosure and our construction of “aggregated contact list.”

Patent Owner also argues that “Odell does not disclose a contact aggregation engine or aggregated contact list,” and therefore, cannot disclose this limitation. PO Resp. 50. But, as discussed above in Sections II.C.1, II.C.2, and II.D.2.b, based on the complete record before us, we find Patent Owner’s premise here unavailing.

Thus, based on the complete record before us, we find Petitioner shows sufficiently that Odell discloses “a web server coupled to the network contacts database” and “wherein, in operation, the contact aggregation engine . . . stores the aggregated contact list in a non-transitory computer readable medium at the web server,” as recited in claim 1.

vi. Display Device

Claim 1 recites, in part, “wherein, in operation, the contact aggregation engine . . . provides the aggregated contact list to a display device.” Ex. 1001, 12:43, 58.

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).

We agree with Petitioner that Odell’s system provides the aggregated contact list including the contact information to a display device.

Pet. 52–55. In particular, Odell discloses a general-purpose computer that views content, which includes an instant-messaging client. Ex. 1006, 5:33–53 (*cited in* Pet. 54–55); *see also* Ex. 1006, 3:47–62 (discussing computers), 5:24–26 (describing the communication system), 6:32–46 (describing the system in Figure 3 (*cited in* Pet. 57)). We credit Mr. Willis’s analysis of these sections because the analysis is consistent with Odell’s description of the display and communication systems. Ex. 1004 ¶¶ 126–127.

Patent Owner again argues that “Odell does not disclose a contact aggregation engine or aggregated contact list,” and therefore, cannot disclose this limitation. PO Resp. 52; PO Sur-Reply 22. But, as discussed above in Sections II.C.1, II.C.2, and II.D.2.b, based on the complete record before us, we find Patent Owner’s premise here unavailing.

Thus, based on the complete record before us, we find Petitioner shows sufficiently that Odell discloses “wherein, in operation, the contact aggregation engine . . . provides the aggregated contact list to a display device,” as recited in claim 1.

c. Summary

For the foregoing reasons, and the reasons stated in the Petition (Pet. 18–55), we conclude that Petitioner has demonstrated by a preponderance of the evidence that independent claim 1 is unpatentable as anticipated by Odell.

3. *Claim 2*

Claim 2 recites: “The system of claim 1, further comprising a high level contacts database embodied in a non-transitory computer readable medium, wherein, in operation, contacts from the high level contacts database are included in the aggregated contact list.” Ex. 1001, 12:59–63.

Petitioner asserts that Odell’s account linking database 380 meets the recited “network contacts database” limitation. Pet. 55 (citing Ex. 1004 ¶ 128); *see supra* Section II.D.2.b.iii. According to the Petition, Odell’s account linking database 380 stores the buddy lists for all accounts linked from the multiple messaging service networks. Pet. 55. According to the Petition, admin server 372 in combination with account linking server 378 aggregates all buddy lists, including the user’s contacts, for display as an aggregated contact list. *Id.* Petitioner asserts that 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.” *Id.* at 56. For the reasons discussed above in Section II.D.2 analyzing claim 1, we agree with all these assertions.

As for the “high level contacts database” recited in claim 2, Petitioner asserts that Odell stores buddy lists for all accounts and “aggregates all of a user’s contact lists,” which “includes contacts from a ‘high level contacts database.’” Pet. 55.

Patent Owner disagrees and argues that Odell does not disclose the high- or low-level networks or “a high level contacts database.” PO Resp. 52. Patent Owner’s view of what the recited “high level contacts database” means depends on its view of the recited high- and low-level networks:

Here, a high level contacts database would at minimum be a database which stores the buddy list of a high level network, as distinguished from a low level contacts database, which would at minimum be a database which stores the buddy list of a low level network.

Id. at 52–53. As with claim 1, Patent Owner argues that the Petition does not explain how or why Odell’s “primary” account is associated with a high-level network. *Id.* at 53–54 (citing Pet. 56–57; Ex. 2006 ¶¶ 170–173; Ex. 1006, 7:60–65); PO Sur-Reply 22–23 (citing, *inter alia*, Ex. 1006, 7:60–65). Similar to its arguments about claim 1, Patent Owner argues with respect to claim 2 that because a user can sign into Odell’s system with any account, Odell has no need for high- or low-level networks, and Odell’s partner domains and system use AIM. PO Sur-Reply 22–23.

We disagree with Patent Owner’s construction of high- and low-level networks for the reasons discussed above in Section II.C.4 on claim construction, and we disagree with Patent Owner that Odell lacks high- and low-level networks for the reasons discussed above in Section II.D.2.b, which contains our analysis of “contact aggregation engine” recited in claim 1. For the reasons discussed in Sections II.C.1 and II.D.2.b, we disagree with Patent Owner’s arguments about contact aggregation and Odell’s GUI. *See* PO Resp. 53–54 (citing, *inter alia*, Pet. 56–57; Ex. 2006 ¶¶ 170–173). So, to the extent that the arguments about claim 1 are the basis for Patent Owner’s arguments about claim 2, we disagree with them for the same reasons as those discussed in the above-noted sections in connection with claim 1. Rather, for the reasons discussed in those sections, we agree with Petitioner (Pet. 55–58) that Odell stores and aggregates buddy lists with contacts for all accounts, including those accounts corresponding to both high- and low-level networks (or first and second networks).

We disagree with Patent Owner that Odell’s “primary” account is not associated with a “high level” messaging network or “high level contacts database.” PO Resp. 53 (citing Pet. 56; Ex. 2006 ¶¶ 170–173; Ex. 1006, 7:60–65). Likewise, we assign little weight to Dr. Surati’s testimony on this issue (Ex. 2006 ¶¶ 170–173). In particular, the challenged patent discloses that a high-level network is defined by how a network functions in the system, which could be chosen during the operation of the system by a user, for example. *See* Ex. 1001, 8:18–32; Tr. 49:7–9; *see also supra* Section II.C.4. Here, we construe “high-level network” and “low-level network” to be conventional IM networks that are defined by the functions recited in the claims. *See* Ex. 1001, 3:52–55, 5:54–55, 8:19–22; *supra* Section II.C.4.

That is, in claim 1, the operations associated with high- and low-level networks are recited in the “wherein” clause—e.g., “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” Ex. 1001, 12:43–47. Thus, the claim is not limited in the way that Patent Owner argues. *See* PO Resp. 52–54.

We agree with Petitioner’s contentions about how Odell’s networks disclose the high- and low-level networks in our analysis of claim 1 in Section II.D.2. For example, Odell’s servers sequentially log into a first account associated with AOL and a second account associated with AIM or ICQ, through a network associated with the “primary account.” *See* Pet. 41–43. Odell discloses that first “authentication information for a primary account for signing into the communication system is entered and verified,” and later, a set of accounts are “linked to the primary account.”

Ex. 1006, 14:38–49 (*quoted in* Pet. 24–26); *see also* Pet. 55–58 (discussing these passages in the context of claim 2). Odell displays the aggregated contact lists in Figure 4C. Ex. 1006, 9:10–18 (*cited in* Pet. 55–58 (analyzing claim 2)); *see also supra* Section II.D.2.b.iv (discussing the aggregated contact list and Odell’s Figure 4C in context of claim 1).

We credit the testimony of Mr. Willis on this issue because it is consistent with these parts of Odell and for the reasons discussed in connection with claim 1 in Section II.D.2.b. *See* Ex. 1004 ¶¶ 105–109 (discussing claim 1), ¶ 128 (discussing claim 2).

Thus, Petitioner shows sufficiently that “[b]ecause Odell discloses that all a user’s contact lists are stored in account linking database 380 (the claimed ‘network contacts database’), these high level contacts are stored in that database as well (which also constitutes the ‘high level contacts database’).” Pet. 57.

To the extent that a second, separate database is required, Petitioner also shows sufficiently that Odell’s “account linking database 380—an element of Figure 3—can be a single database or multiple databases connected together for the specified operation of storing contact lists obtained from multiple messaging service networks, including the high level / primary network.” *Id.* at 58 (citing Ex. 1004 ¶ 129). Patent Owner does not specifically dispute this assertion. Petitioner’s analysis is adequately supported by Odell because Odell explains that Figure 3 may include “numerous interconnected computer and components,” not monolithic entities. *See* Ex. 1006, 3:48–56 (*cited in* Pet. 58).

For the reasons discussed above in Section II.D.2.b.v, Petitioner shows sufficiently that Odell stores all contacts, including those recited in claim 2, in the recited computer-readable medium. *See* Pet. 57–58

(reasoning that all contacts are stored, including those from a high-level contacts database).

Based on the complete record before us, we find Petitioner shows sufficiently that Odell discloses “a high level contacts database embodied in a non-transitory computer readable medium, wherein, in operation, contacts from the high level contacts database are included in the aggregated contact list,” as recited in claim 2. Accordingly, for the foregoing reasons, and the reasons stated in the Petition (Pet. 55–58), we conclude that Petitioner has demonstrated by a preponderance of the evidence that dependent claim 2 is unpatentable as anticipated by Odell.

4. *Claim 3*

Claim 3 recites: “The system of claim 1, wherein the network login engine includes a plurality of network login engines that include sufficient information to login or facilitate login to a respective plurality of low level networks.” Ex. 1001, 12:64–67.

Petitioner asserts that Odell’s authentication server 374 includes the plurality of recited network login engines because Odell’s authentication database 376 and account linking database 389 store username and password credentials, and Odell “facilitate[s] the login to multiple messaging service networks automatically and sequentially.” Pet. 59 (citing Ex. 1006, 6:58–7:65, 2:65–3:10, 8:14–20, 14:36–15:5).

Patent Owner argues that Odell lacks claim 1’s “network login engine” and multiple networks or messaging service providers. PO Resp. 54–55. As for the limitations specific to claim 3, Patent Owner argues that the Petition “fails to provide a detailed or sufficient explanation of how Odell meets the plurality of network engines limitation.” *Id.* In Patent Owner’s view, “the Petition merely argues that the system of Odell may

login in multiple messaging service networks automatically and sequentially, [Pet., 58–59], and that it ‘has the ability to log into multiple communications systems.’” *Id.* (alterations in original). Patent Owner argues that Petitioner does not explain how this shows that Odell’s system comprises the recited engines. *Id.*; *see also* PO Sur-Reply 23–24.

The parties agree that “engine” means “a system or software component.” Pet. Reply 10; PO Sur-Reply 11. The ’395 patent explains that the network login engines include logic that facilitates login to the low-level networks. Ex. 1001, 6:1–6 (*cited in* Pet. 58–59). This includes the usernames and passwords associated with those networks. *Id.* The patent gives an overview of these engines:

Conceptually, each of the network login engines 310 is intended to represent the capability of login to the low level networks 302 in a general sense.

Id. at 6:6–8 (*quoted in* Pet. 58–59).

We agree with Petitioner that, like the network-login engines described here (*id.*), Odell’s authentication server 374 includes similar logic because the server stores username and password credentials in authentication database 376 and account-linking database 389. Pet. 59 (citing Ex. 1006, 6:58–7:65, 2:65–3:10, 8:14–20, 14:36–15:5). We agree that Odell’s system has logic that facilitates login to multiple messaging service networks automatically and sequentially. *See id.* For example, Odell’s admin server 372 manages the account-linking information and profiles for each screen name. *See* Ex. 1006, 6:58–7:65. Odell discloses logging into the linked accounts using the screen name. *Id.* at 2:65–3:10; *see also id.* at 14:36–15:5 (describing a sign-in process shown in Figure 10). Thus, the Petition shows sufficiently why Odell’s authentication server 374

includes the plurality of recited network login engines. Pet. 58–59 (citing Ex. 1004 ¶¶ 131–135). Mr. Willis’s testimony in this regard (Ex. 1004 ¶¶ 131–135) is adequately supported by Odell, and thus, we credit this testimony on this issue.

Patent Owner also argues that “Odell does not disclose or suggest that automatic login of linked accounts may relate to multiple MSPs.” PO Sur-Reply 23–24. But we disagree that Odell lacks multiple messaging service providers as discussed above in Sections II.C.3 and II.D.2.b.ii. For the reasons discussed in those sections, we also do not credit Dr. Surati’s testimony on this issue (*see* Ex. 2006 ¶ 180).

Based on the complete record before us, we find Petitioner shows sufficiently that Odell discloses “wherein the network login engine includes a plurality of network login engines that include sufficient information to login or facilitate login to a respective plurality of low level networks,” as recited in claim 3. Accordingly, for the foregoing reasons, and the reasons stated in the Petition (Pet. 58–59), we conclude that Petitioner has demonstrated by a preponderance of the evidence that dependent claim 3 is unpatentable as anticipated by Odell.

5. *Claim 4*

Claim 4 recites: “The system of claim 1, further comprising a user profile database, embodied in a non-transitory computer readable medium and coupled to the network login engine, wherein, in operation, the user profile database includes a user-specific information that the network login engine uses to login or facilitate login to the one or more networks.” Ex. 1001, 13:1–6.

Petitioner asserts that Odell’s account linking database 380, authentication database 376, and partner database system 386 disclose the

subject matter recited in claim 4. Pet. 59 (citing Ex. 1004 ¶¶ 136–145). In particular, Odell’s authentication server 374, mapped to the claimed network login engine, is coupled to the databases that store user-specific information that it uses for logins. *Id.* at 59–61.

Patent Owner does not present any separate arguments that are distinct to dependent claim 4 (*see* PO Resp.; PO Sur-Reply), and therefore, has waived such arguments. *See* 37 C.F.R. § 42.23(a); *Nuvasive*, 842 F.3d at 1379–82; *Papst Licensing*, 924 F.3d at 1250; *Bradium*, 923 F.3d at 1048.

Based on the complete record before us, we are persuaded by Petitioner’s evidence and analysis (Pet. 59–61), and we credit Mr. Willis’s testimony on this issue (Ex. 1004 ¶¶ 136–145). In particular, Odell’s authentication server 374 processes and validates account-authentication requests against authentication database 376 and partner database system 386, as appropriate, depending on whether provider system 310 maintains the accounts. Ex. 1006, 7:4–19 (*cited in* Pet. 60). For validated accounts, Odell’s authentication database 376 forwards account attributes through the authentication server 374 for use, processing, or storage by the admin server 372. *Id.* In this way, like the recited user-profile database, Odell’s account linking database 380, authentication database 376, and partner database system 386 includes user-specific information that the network login engine uses to login to the networks. *See* Pet. 59–61.

We also agree that Odell’s databases are “coupled to” a network login engine, i.e., authentication server 374, as illustrated below in Petitioner’s annotated version of Odell’s Figure 3.



Figure 3, above, shows authentication database 376 and partner database system 386 shaded in orange, and authentication server 374 shaded in blue. Pet. 60–61.

Based on the complete record before us, we find Petitioner shows sufficiently that Odell discloses “a user profile database, embodied in a non-transitory computer readable medium and coupled to the network login engine, wherein, in operation, the user profile database includes a user-specific information that the network login engine uses to login or facilitate login to the one or more networks,” as recited in claim 4. Accordingly, for the foregoing reasons, and the reasons stated in the Petition (Pet. 59–61), we conclude that Petitioner has demonstrated by a preponderance of the evidence that dependent claim 4 is unpatentable as anticipated by Odell.

6. *Claim 5*

Claim 5 recites: “The system of claim 1, further comprising the display device.” Ex. 1001, 13:7–8.

Petitioner contends that Odell discloses a display device. Pet. 61 (citing Ex. 1004 ¶¶ 146–147).

Patent Owner does not present any separate arguments that are distinct to dependent claim 5 (*see* PO Resp.; PO Sur-Reply), and therefore, has waived such arguments. *See* 37 C.F.R. § 42.23(a); *Nuvasive*, 842 F.3d at 1379–82; *Papst Licensing*, 924 F.3d at 1250; *Bradium*, 923 F.3d at 1048.

For reasons similar to those in Section II.D.2.b.vi on providing contact lists to the display, as recited in claim 1, we determine Petitioner shows sufficiently that Odell’s system comprises a display device. In particular, Odell’s system allows for “viewing . . . electronic content.” Ex. 1006, 5:33–53. We credit Mr. Willis’s testimony regarding this limitation (Ex. 1004 ¶¶ 126–127, 146–147), because it is consistent with Odell’s description of the display and communication systems.

Based on the complete record before us, we find Petitioner shows sufficiently that Odell discloses a “display device,” as recited in claim 5. Accordingly, for the foregoing reasons, and the reasons stated in the Petition (Pet. 61), we conclude that Petitioner has demonstrated by a preponderance of the evidence that dependent claim 5 is unpatentable as anticipated by Odell.

7. *Claim 6*

Claim 6 recites: “The system of claim 1, further comprising the one or more networks.” Ex. 1001, 13:9–10.

Petitioner asserts “Odell discloses that its communication system can automatically login to and aggregate contact lists from multiple messaging

service networks (also referred to as ‘multiple communications systems’), including AOL, AIM, ICQ, and love.com.” Pet. 61–62 (citing Ex. 1004 ¶¶ 148–150).

Patent Owner does not present any separate arguments that are distinct to dependent claim 5 (*see* PO Resp.; PO Sur-Reply), and therefore, has waived such arguments. *See* 37 C.F.R. § 42.23(a); *Nuvasive*, 842 F.3d at 1379–82; *Papst Licensing*, 924 F.3d at 1250; *Bradium*, 923 F.3d at 1048.

Based on the complete record before us, we are persuaded by Petitioner’s evidence and analysis (Pet. 61–62), and we credit Mr. Willis’s testimony on this issue (Ex. 1004 ¶¶ 148–150). In particular, for the reasons discussed in Section II.D.2.b, Petitioner shows sufficiently that Odell discloses a plurality of low-level networks. In its analysis of claim 6, Petitioner shows that Odell’s system comprises such networks. Pet. 61–62.

Based on the complete record before us, we find Petitioner shows sufficiently that Odell discloses “one or more networks,” as recited in claim 6. Accordingly, for the foregoing reasons, and the reasons stated in the Petition (Pet. 61–62), we conclude that Petitioner has demonstrated by a preponderance of the evidence that dependent claim 6 is unpatentable as anticipated by Odell.

8. *Independent Claim 7*

Petitioner provides an element-by-element analysis of independent claim 7 in relation to Odell. Pet. 62–64; Pet. Reply 24. Petitioner’s analysis relies on testimony from its declarant, Mr. Willis. Ex. 1004 ¶¶ 150–169. Patent Owner opposes. PO Resp. 8–24, 55–58; PO Sur-Reply 24. As discussed below, Petitioner contends each limitation in claim 7 is disclosed by Odell.

a. Preamble

The preamble of claim 1 recites merely “[a] method comprising.” Ex. 1001, 13:11.

Petitioner asserts that “Odell discloses a method associated with [communications system 300] described above with reference to Claim 1 and that anticipates Claim 7.” Pet. 62 (citing Ex. 1006, 12:18–50, 14:36–15:5, 34:48–58; Ex. 1004 ¶ 150).

Neither Petitioner nor Patent Owner takes a position as to whether the preamble is limiting, nor does Patent Owner dispute that Odell discloses a “method,” generally. Because we find that Petitioner’s cited disclosure from Odell discloses a “method,” we need not determine whether the preamble is limiting. *See Nidec*, 868 F.3d at 1017.

b. Joining

Claim 7 recites, in part, “joining a high level network; 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.” Ex. 1001, 13:12–16.

Petitioner contends that Odell discloses “joining a high level network” 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 we understand to be 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 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).

Petitioner contends Odell discloses joining first and second low level networks for the same reasons given for the limitation of joining a high-level network in claim 7 discussed above. 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 argues that “Odell does not disclose multiple networks, high level networks, or low level networks, much less multiple low level networks” or those associated with “multiple messaging service providers or messaging services provided by multiple messaging service providers.” PO Resp. 55 (citing, *inter alia*, Ex. 2006 ¶¶ 177–179). In Patent Owner’s view, “Odell discloses, at most, that a system may permit a user to create or maintain multiple accounts on *a single network*.” *Id.* (citing Ex. 1006, 8:14–29, Figs. 1, 3). Patent Owner argues that this single network is America Online, and AOL, AIM, and ICQ do not have separate networks. *Id.* at 55–56. Patent Owner argues that, because of this, the linked accounts are on the same network and same messaging service. *Id.* (citing Ex. 1006, 8:14–15; Ex. 2006 ¶ 178). Applying similar reasoning to Petitioner’s analysis of the recited “messaging services providers,” Patent Owner argues “there is no disclosure in Odell of a first low level network associated with a *first messaging service provider* or a second low level network associated with a *second messaging service provider*.” PO Resp. 56–57 (citing Pet. 63).

We disagree with, and thus find unavailing, Patent Owner’s arguments that Odell discloses only a single network and messaging service provider for the reasons discussed above in Section II.D.2.b.ii, discussing “messaging service providers” and first and second networks (and high- and low-level networks) recited in claim 1, as well as America Online and the AOL, AIM, and ICQ platforms. Rather, based on the complete record before us, we find persuasive Petitioner’s arguments that Odell discloses the “joining” limitations of claim 7 (*see* Pet. 62–63). In particular, Odell explains that an account is needed to use the instant-messaging services, and that accounts from multiple communications systems are linked together.

Ex. 1006, 7:53–54, 8:14–20. We credit Mr. Willis’s testimony that Odell discloses “joining” the high- and low-level networks (Ex. 1004 ¶¶ 151–161), because his testimony is consistent with Odell’s disclosure of how the primary and linked accounts work. *See, e.g.*, Ex. 1006, 7:4–19 (describing adding another linked account), 10:49–56 (describing the account linking interface).

Patent Owner argues that the “Willis Declaration relies on the incorrect assumption that multiple linked *accounts* are the alleged ‘equivalent’ of multiple low-level *networks*.” PO Resp. 56 (quoting Ex. 1004 ¶ 106) (emphases added); *see also* Ex. 2006 ¶ 178. Patent Owner views Petitioner’s use of the term “equivalent” here as an admission that the claim limitation is not met. *Id.* We disagree that Petitioner or the Willis Declaration makes this assumption or any admission by using the word “equivalent.” Instead, the Petition clearly states, for example, that Odell’s accounts are “associated with” networks. *See, e.g.*, Pet. 56 (“The ‘primary account’ is *associated with* a ‘high level’ messaging network because it is used to sign in to the communications system” (emphasis added)); 41 (“numerous 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” (emphases added)); 42–43 (“[M]ultiple 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.” (emphases added)). For example, Odell’s users have accounts so that they can use the networks for instant-messaging services. *See, e.g.*, Ex. 1006, 8:19–29; Pet. 62–63; Ex. 1004 ¶¶ 151–156.

Because Dr. Surati's testimony also mischaracterizes the Petition as explaining that the accounts themselves are networks (*see* Ex. 2006 ¶ 178), we do not credit Dr. Surati's testimony on this point. For the reasons discussed above and in Section II.D.2.b, Petitioner shows sufficiently that the networks associated with Odell's linked accounts are the low-level networks recited in the claims. *See* Pet. 63.

Thus, based on the complete record before us, we find Petitioner shows sufficiently that Odell discloses “joining a high level network” and “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,” as recited in claim 7.

c. First Contact List

Claim 7 recites, in part, “obtaining a first contact list associated with the first messaging service provider.” Ex. 1001, 13:17–18.

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

Patent Owner argues that “Odell does not disclose multiple networks, high level networks, or low level networks, much less multiple low level networks” or those associated with “multiple messaging service providers or messaging services provided by multiple messaging service providers,” and thus, Odell cannot disclose this limitation. PO Resp. 55 (citing, *inter alia*, Ex. 2006 ¶¶ 177–179). But as discussed above in Sections II.D.2.b.iii and II.D.8.b, based on the complete record before us, we find Patent Owner's premise here unavailing.

Thus, for the reasons discussed above in Sections II.D.2.b.iii and II.D.8.b and based on the complete record before us, we find Petitioner shows sufficiently that Odell discloses “obtaining a first contact list associated with the first messaging service provider,” as recited in claim 7.

d. Second Contact List

Claim 7 recites, in part, “obtaining a second contact list associated with the second messaging service provider.” Ex. 1001, 13:19–20.

Petitioner contends Odell discloses this limitation for the same reasons given for the limitation of updating the networks contacts database in claim 1 (*see supra* Section II.D.2.b.iii). Pet. 64 (citing Ex. 1004 ¶ 164).

Patent Owner argues that “Odell does not disclose obtaining the user buddy list from a second messaging service provider, including because Odell discloses only a single messaging service provider – America Online,” and thus, Odell cannot disclose this limitation. PO Resp. 57 (citing, *inter alia*, Ex. 2006 ¶¶ 182–183). But as discussed above in Sections II.D.2.b.iii and II.D.8.b, based on the complete record before us, we find Patent Owner’s premise here unavailing.

Thus, for the reasons discussed above in Sections II.D.2.b.iii and II.D.8.b and based on the complete record before us, we find Petitioner shows sufficiently that Odell discloses “obtaining a second contact list associated with the second messaging service provider,” as recited in claim 7.

e. Maintaining an Aggregated Contact List

Claim 7 recites, in part, “maintaining an aggregated contact [list] that comprises the first contact list and the second contact list.” Ex. 1001, 14:1–2.

Petitioner contends Odell discloses this limitation for the same reasons given for the limitation of maintaining an aggregated contact list in claim 1 (*see supra* Section II.D.2.b.iv). Pet. 64 (citing Ex. 1004 ¶ 165).

Patent Owner argues that “Odell does not disclose that the buddy lists for a user’s accounts are maintained as an aggregated [contact] list,” and thus, Odell cannot disclose this limitation. PO Resp. 57. But as discussed above in Section II.D.2.b.iv, based on the complete record before us, we find Patent Owner’s premise here unavailing.

Thus, for the reasons discussed above in Sections II.D.2.b.iv and based on the complete record before us, we find Petitioner shows sufficiently that Odell discloses “maintaining an aggregated contact [list] that comprises the first contact list and the second contact list,” as recited in claim 7.

f. Logging into the High-Level Network

Claim 7 recites, in part, “logging into the high level network.” Ex. 1001, 14:3.

Petitioner contends Odell discloses this limitation for the same reasons given for the limitation of joining a high-level network in claim 7 (*see supra* Section II.D.8.b). Pet. 64 (citing Ex. 1004 ¶¶ 166–167; also citing Petitioner’s analysis for “Claim 1[i]” (i.e., “network login engine” (*see supra* Section II.D.2.b.i)) and “Claim 3,” which likely is a typographical error, as Petitioner’s analysis for Claim 2 discusses a “high level network” (*see supra* Section II.D.3), whereas Claim 3 involves “low level networks”).

Patent Owner argues that “Odell does not teach a high level network,” and thus, “there can be no ‘logging into the high level network.’” PO Resp. 57. But as discussed above in Section II.D.8.b, based on the complete record before us, we find Patent Owner’s premise here unavailing.

In this decision, we construe the “high level network” to be a conventional IM network that is defined by the functions recited in the claims. *See supra* Section II.C.4. For the reasons discussed in Sections II.D.2.b.i (network login engine), II.D.2.b.ii.b (login to first and second or high- and low-level networks), II.D.3 (high level contacts), and II.D.8.b (joining a high level network), Petitioner shows sufficiently that 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. *See* Pet. 20–21 (citing, *inter alia*, Ex. 1004 ¶¶ 67–76) (analyzing claim 1’s “network login engine”), 62–63 (referring to this analysis in connection with claim 7); Pet. Reply 23. Also, on this issue, we credit Mr. Willis’s testimony for the reasons discussed in Section II.D.2.b.ii.b and the other sections noted above (Ex. 1004 ¶¶ 67–76, 166–167). Thus, we disagree with Patent Owner that Odell lacks a high-level network (PO Resp. 57).

Thus, for the reasons discussed above in Sections II.D.8.b, II.D.2.b.i, II.D.2.b.ii.b, and II.D.3 and based on the complete record before us, we find Petitioner shows sufficiently that Odell discloses “logging into the high level network,” as recited in claim 7.

g. Displaying Aggregated Contact List

Claim 7 recites, in part, “displaying the aggregated contact list.”
Ex. 1001, 14:4.

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 supra* Section II.D.2.b.vi). 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. PO Resp. 58. But as discussed above in Section II.D.2.b.iv, based on the complete record before us, we find Patent Owner’s premise here unavailing.

Thus, for the reasons discussed above in Sections II.D.2.b.iv (aggregated contact list), II.D.2.b.vi (providing list to display device), and II.D.6 (display device) and based on the complete record before us, we find Petitioner shows sufficiently that Odell discloses “displaying the aggregated contact list,” as recited in claim 7.

h. Summary

For the foregoing reasons, and the reasons stated in the Petition (Pet. 62–64), we conclude that Petitioner has demonstrated by a preponderance of the evidence that independent claim 7 is unpatentable as anticipated by Odell.

9. Claim 8

Claim 8 recites: “The method of claim 7, further comprising logging into the one or more low level networks.” Ex. 1001, 14:5–6.

Petitioner contends Odell discloses this limitation for the same reasons given for the limitation of a network login engine in claim 1 (*see supra* Section II.D.2.b.i). Pet. 64 (citing Ex. 1004 ¶¶ 170–172).

Patent Owner does not present any separate arguments that are distinct to dependent claim 4 (*see* PO Resp.; PO Sur-Reply), and therefore, has waived such arguments. *See* 37 C.F.R. § 42.23(a); *Nuvasive*, 842 F.3d at 1379–82; *Papst Licensing*, 924 F.3d at 1250; *Bradium*, 923 F.3d at 1048.

Thus, for the reasons discussed above in Sections II.D.2.b.i and II.D.2.b.ii and based on the complete record before us, we find Petitioner shows sufficiently that Odell discloses “logging into the one or more low

level networks,” as recited in claim 8. Accordingly, for the foregoing reasons, and the reasons stated in the Petition (Pet. 64), we conclude that Petitioner has demonstrated by a preponderance of the evidence that dependent claim 8 is unpatentable as anticipated by Odell.

10. Claim 9

Claim 9 recites: “The method of claim 7, further comprising joining an additional low level [network] associated with an additional messaging service provider, wherein the aggregated contact list does not include contacts of the additional messaging service provider.” Ex. 1001, 14:7–10.

Petitioner contends that Odell discloses additional messaging service networks, which can be linked and added through an interface shown in Figures 6A–D. Pet. 65. Petitioner asserts that Odell’s Figure 10 shows the authentication, linking, and displaying process. *Id.* at 65–68 (citing, *inter alia*, Ex. 1006, 14:36–15:3).

Petitioner asserts that “Odell discloses that a new network can be joined and then linked to a primary account, such that before that happens the aggregated contact list (e.g., in Figures 4A-C) would not include contacts from the to-be joined network, but it would after the account is created (‘joined’) and linked.” Pet. 67 (citing Ex. 1004 ¶¶ 173–178). Petitioner provides an example of this involving AOL, AIM, and “love.com”:

For instance, Odell discloses that contacts from a first messaging service network (“AOL”), a second messaging service network (“AIM”), and a third / additional messaging service network (“love.com”) are displayed in an aggregated contact list in Figures 4A and 4B, as discussed above in Claim 1[v.c]. Before love.com was joined and linked in this example, the user interface would not have displayed those associated contacts (and they would not have been stored in the account linking database 380).

Id. at 67–68.

Patent Owner focuses its arguments on the feature of an “additional messaging service provider” (*see* PO Resp. 58–59), but does so based on a construction of “messaging service provider” that we do not adopt (*see supra* Section II.C.3). Patent Owner argues that the Petition “fails to identify the ‘additional messaging service provider’ required by claim 9.” *Id.* According to Patent Owner, “Odell does not disclose joining an additional low level network associated with an additional messaging service provider.” *Id.* (citing Ex. 1004 ¶ 174; Pet. 67; Ex. 1006, Figs. 1–3, 7:53–54, 8:19–29, 8:50–55). Patent Owner argues that Odell discloses services provided by the “same MSP—America Online.” PO Sur-Reply 24 (citing Pet. 67). Patent Owner also disputes whether Odell discloses the aggregated contact list *not including* contacts of the additional messaging service provider, and argues Petitioner contradicts itself in trying to show this. PO Resp. 60 (citing Pet. 26–27, 67–68; Ex. 2006 ¶¶ 193–194). We disagree with Patent Owner’s arguments for the reasons discussed above in Sections II.C.3 (construing “messaging service provider”), II.C.4 (construing high- and low-level networks), and II.D.2.b. (discussing logging in to networks associated with messaging service providers) and below.

Rather, Petitioner shows sufficiently that Odell discloses additional low-level networks associated with additional messaging service providers and that Odell discloses a situation where the aggregated contact list “does not include contacts of the additional low level network,” as recited. During the linking process, Odell signs into accounts sequentially. Ex. 1006, 14:65–67 (“In this manner, the accounts that are linked to the primary account are signed in to the communications system sequentially.” (*quoted in* Pet. 67)). Petitioner asserts that, before a network is joined and linked,

the user interface would not have displayed the contacts, and likewise, the account linking database 380 would not have stored the contacts. Pet. 67–68 (citing Ex. 1004 ¶¶ 173–178).

We disagree with Patent Owner that the evidence of record shows that contacts from any new network must be included. PO Resp. 60 (citing Pet. 26–27, 67–68; Ex. 2006 ¶¶ 193–194). Specifically, there is not sufficient evidence in the record that Odell would obtain the contacts without first joining and linking.

Instead, Odell’s Figure 10, reproduced below, indicates that the system links and accesses the accounts *before* it displays the list. Ex. 1006, Fig. 10.

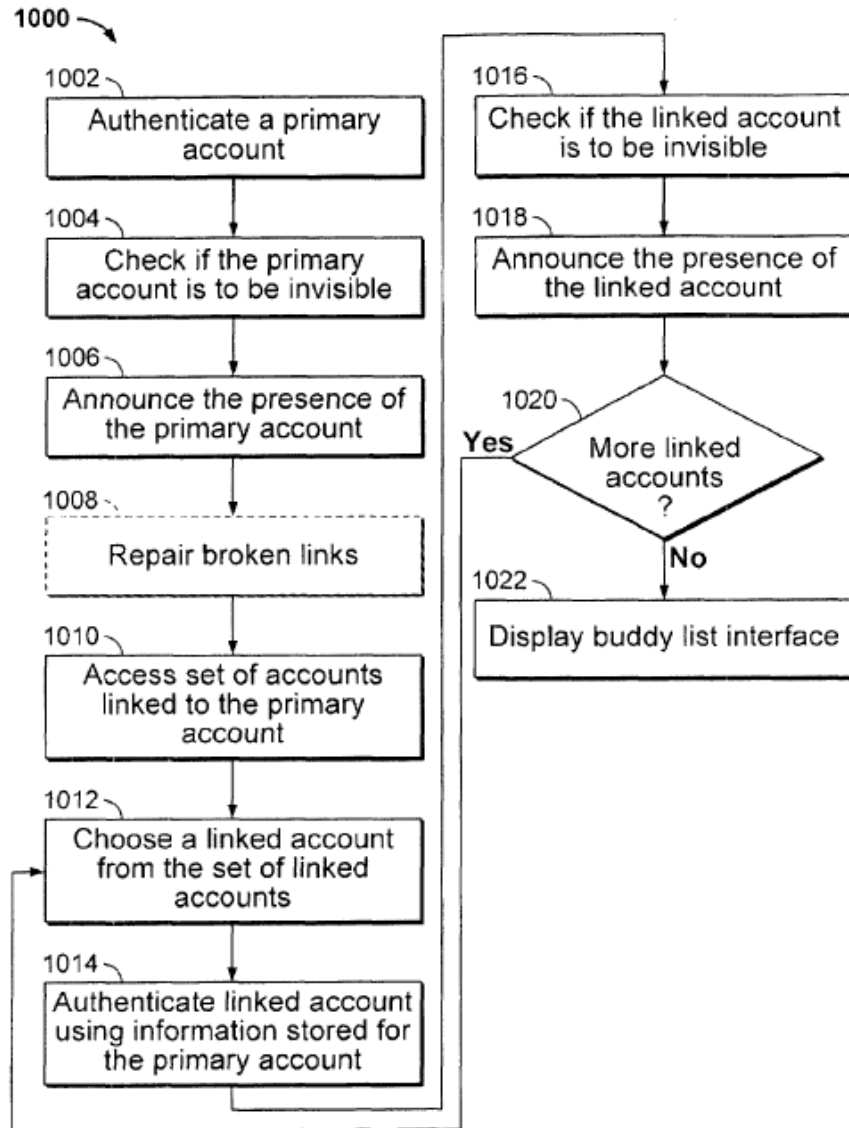


FIG. 10

Figure 10, above, shows a flow chart where the set of accounts linked to the primary accounts is accessed (step 1010: “Access set of accounts linked to the primary account”) before the buddy-list interface is displayed (step 1022: “Display buddy list interface”). *See id.* at 14:36–15:3. The system chooses a linked account (step 1012), and authenticates it (step 1014). *Id.* at 14:59–67. The interface is only displayed when the system determines that all linked accounts have been chosen (step 1020: “More linked accounts?”). *Id.* Because Dr. Surati does not give sufficient weight to

Odell's Figure 10 or Petitioner's reasoning about when the contacts are included, we disagree with Patent Owner's argument (PO Resp. 60) and do not credit Dr. Surati's testimony on this issue (Ex. 2006 ¶¶ 193–194).

Likewise, we disagree that the Petition's assertion that Odell displays a user's buddy list from all linked accounts contradicts Petitioner's arguments with respect to claim 9, because Petitioner's rationale focuses on a specific time when the contact list does not include certain contacts—i.e., before the network is joined. PO Resp. 60 (citing Pet. 26–27, 67–68). Petitioner does not argue that the contact list never includes contacts of the additional low-level network. Pet. 67–68.

Nor does the claim require it. In fact, Patent Owner argues that claim 9 does not have a “before the network is joined” requirement. *See* PO Resp. 60 (citing Pet. 67). But the lack of such a requirement only broadens the claim. That is, in the absence of a limitation about when the contact list has or does not have certain contacts, Petitioner need not show that the aggregated contact list never—or at other unrecited specific times—includes contacts of the additional low-level network. Thus, we disagree with Patent Owner that Petitioner's challenge is deficient for focusing on a specific time in which the contacts are not included. *See* PO Resp. 60. Also, we do not credit Dr. Surati's testimony in this regard because it is based on Patent Owner's reasoning about the scope of claim 9. *See* Ex. 2006 ¶ 194.

In addition, to be clear, based on our construction of “messaging service provider” to mean a “computer system or platform providing a distinct messaging service,” we agree with Petitioner that “love.com” as disclosed in Odell represents a platform providing a distinct messaging service, i.e., an “additional messaging service network.” *See* Pet. 67–68; Ex. 1004 ¶¶ 173–178.

Based on the complete record before us, we find Petitioner shows sufficiently that Odell discloses “joining an additional low level [network] associated with an additional messaging service provider, wherein the aggregated contact list does not include contacts of the additional messaging service provider,” as recited in claim 9. Accordingly, for the foregoing reasons, and the reasons stated in the Petition (Pet. 65–68), we conclude that Petitioner has demonstrated by a preponderance of the evidence that dependent claim 9 is unpatentable as anticipated by Odell.

11. Claim 10

Claim 10 recites:

The method of claim 7, further comprising:

[i] logging into the first and second low level networks and an additional low level network associated with an additional messaging service provider;

[ii] displaying contacts associated with the first, second, and additional messaging service providers in the aggregated contact list; [and]

[iii] logging out of the additional low level network.

Ex. 1001, 14:11–18 (roman numerals added).

In addressing limitations [i] and [ii], Petitioner relies on its analysis of claim 9. Pet. 68. Patent Owner does not provide specific arguments or evidence about Petitioner’s analysis of limitations [i] and [ii] in claim 10 (*see* PO Resp.; PO Sur-Reply), and therefore, has waived such arguments. *See* 37 C.F.R. § 42.23(a); *Nuvasive*, 842 F.3d at 1379–82; *Papst Licensing*, 924 F.3d at 1250; *Bradium*, 923 F.3d at 1048.

Based on the complete record before us, we are persuaded by Petitioner’s analysis. Pet. 68 (citing Ex. 1004 ¶¶ 179–182). Our reasoning about the analysis for claim 9 in Section II.D.10 also applies here to

claim 10. Also, Odell discloses a process for logging into multiple accounts. *See, e.g.*, Ex. 1006, 7:4–19 (discussing a name-and-password requirement and validation); 14:36–58 (discussing the sign-in process in Figure 10). In this way, Odell is consistent with Mr. Willis’s testimony, and we credit Mr. Willis’s testimony on this issue. Ex. 1004 ¶¶ 179–182 (*cited in* Pet. 68).

As for limitation [iii], Petitioner asserts that Odell also expressly and inherently discloses logging out of the additional low-level network. Pet. 68–69 (citing Ex. 1006, 11:1–9, 3:11–18, 2:53–55, Fig. 6A; Ex. 1004 ¶¶ 183–185). Mr. Willis testifies that, even though logging out “is a necessary action for anything one can log into,” Odell discloses selective disconnection. Ex. 1004 ¶ 183 (citing Ex. 1006, 14:21–36). Patent Owner does not provide specific arguments or evidence about Petitioner’s analysis of limitation [iii] of claim 10, and therefore, has waived such arguments. *See* PO Resp.; PO Sur-Reply.

Based on the complete record before us, we are persuaded by Petitioner’s analysis, and we credit Mr. Willis’s testimony on this issue. Pet. 68–69; Ex. 1004 ¶¶ 183–185. Our reasoning about the analysis for low-level networks above applies here in the context of claim 10. Also, Odell discloses an “unlink button” to break links. Ex. 1006, 11:1–9 (*cited in* Pet. 68). Odell discloses that only linked accounts are signed into. *Id.* at 3:11–18. Thus, Petitioner shows sufficiently that “unlinking a linked account, such as the third / additional low level network discussed in Claim 9 (‘love.com’), would necessarily log the user out of that network.” Pet. 68–69.

Also, Odell states that a “co-user just logged on or logged off the system.” Ex. 1006, 2:53–55. We agree with Petitioner that this discloses that “users can log out of a communications system (which would

necessarily include the third / additional low level network discussed in Claim 9, love.com).” Pet. 69 (citing Ex. 1006, 2:53–55). For this additional reason, Petitioner shows sufficiently that Odell discloses “logging out of the additional low level network.” *See id.*

Based on the complete record before us, we find Petitioner shows sufficiently that Odell discloses the limitations of claim 10. Accordingly, for the foregoing reasons, and the reasons stated in the Petition (Pet. 68–69), we conclude that Petitioner has demonstrated by a preponderance of the evidence that dependent claim 10 is unpatentable as anticipated by Odell.

12. Claim 11

Claim 11 recites: “The method of claim 7, further comprising logging out of the high level network.” Ex. 1001, 14:19–20.

Petitioner contends that Odell discloses this limitation for the reasons discussed in connection with claim 10:

[T]he disclosed ability to log in to the primary account (the “high level” network) and to unlink accounts necessarily discloses the ability to log out of or unlink those networks, especially as Odell expressly discloses the unlinking function with respect to Figure 6A, in which the primary account “ScreenName1” can be selected for unlinking.

Pet. 69 (citing Ex. 1004 ¶¶ 186–188).

Patent Owner does not present any separate arguments that are distinct to dependent claim 11 (*see* PO Resp.; PO Sur-Reply), and therefore, has waived such arguments. *See* 37 C.F.R. § 42.23(a); *Nuvasive*, 842 F.3d at 1379–82; *Papst Licensing*, 924 F.3d at 1250; *Bradium*, 923 F.3d at 1048.

Based on the complete record before us, we are persuaded by Petitioner’s analysis, and we credit Mr. Willis’s testimony on this issue. Pet. 69–70 (citing Ex. 1004 ¶¶ 186–189). For the reasons discussed in

Section II.D.11 (claim 10), we are persuaded by Petitioner’s arguments and evidence in connection with the logging-out limitation of claim 10. For the reasons discussed in Section II.D.2.b, Petitioner shows sufficiently that Odell discloses a high-level network.

Odell explains that users can “logon and logoff.” Ex. 1006, 2:52–55. Also, Petitioner shows that Odell’s interface has a “Sign Off” feature as shown in Figure 5A, reproduced below. Pet. 69–70 (citing Ex. 1006, Fig. 5A).

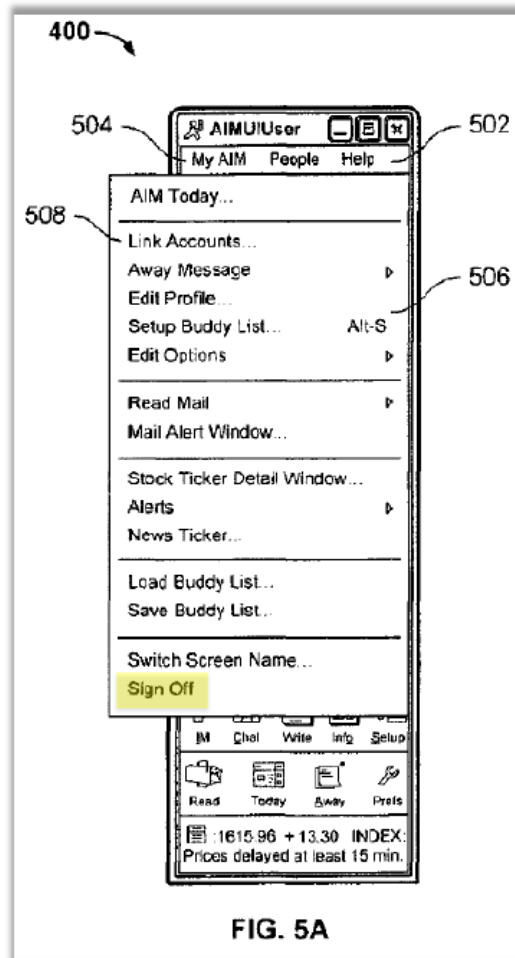


Figure 5A, above, shows a menu with the option “Sign Off” highlighted by Petitioner in yellow. Mr. Willis testifies that “Odell discloses a ‘Sign Off’

function, for example in Figure 5A, for the primary account, which corresponds to the claimed high level network.” Ex. 1004 ¶ 188.

Based on the complete record before us, we find Petitioner shows sufficiently that Odell discloses “logging out of the high level network,” as recited in claim 11. Accordingly, for the foregoing reasons, and the reasons stated in the Petition (Pet. 69–70), we conclude that Petitioner has demonstrated by a preponderance of the evidence that dependent claim 11 is unpatentable as anticipated by Odell.

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

Petitioner alternatively contends each of claims 1–11 is unpatentable under 35 U.S.C. § 103 as obvious over Odell⁴ (Ex. 1006) or obvious over the combination of Odell and Daniell (Ex. 1007). Pet. 6, 71–82; Pet. Reply 24–27. Patent Owner opposes Petitioner’s contentions. PO Resp. 60–66; PO Sur-Reply 25–26. For the reasons expressed below, and based on the complete record before us, we determine that Petitioner has demonstrated by a preponderance of the evidence that claims 1–11 are unpatentable as obvious over Odell and the combination of Odell and Daniell. We turn first to an overview of Daniell.

⁴ For similar reasons as discussed above regarding anticipation by Odell of claims 1–11 (*see* Section II.D), *a fortiori*, we determine that Petitioner has demonstrated by a preponderance of the evidence that claims 1–11 are unpatentable as obvious over Odell. *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.”).

1. Daniell

Daniell's user interface displays multiple contacts from multiple instant-messaging systems. Ex. 1007, code (57). Daniel's "roster window" displays the user's contacts. *Id.* at 7:45–51; *see id.* at 18:3–19. Figure 14, reproduced below, shows an exemplary roster window. *Id.* at 18:1–2.

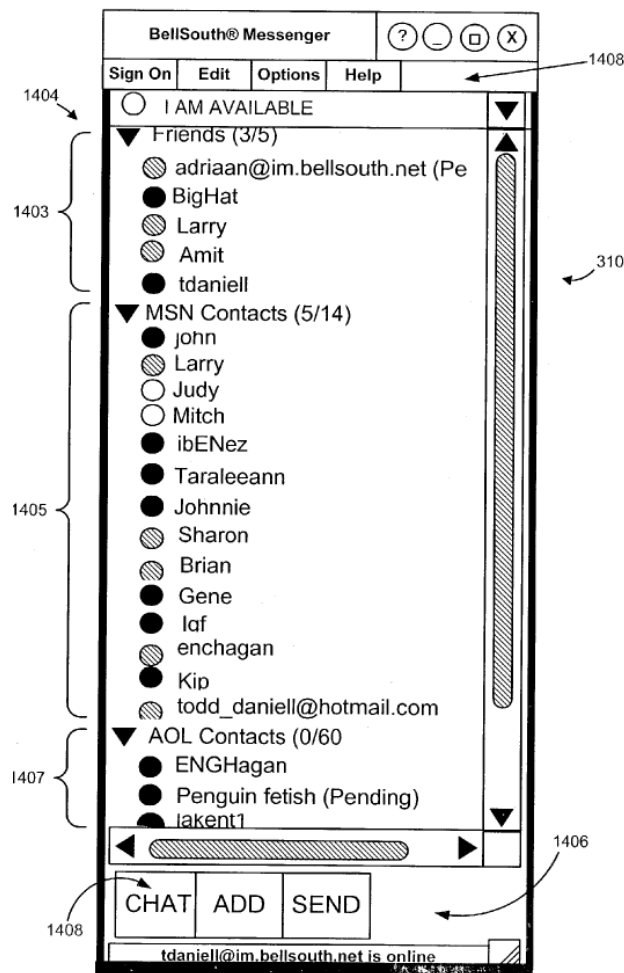


FIG. 14

Roster window 310 in Figure 14, above, displays a list of contacts (1404). *Id.* at 18:3–11.

2. Independent Claims 1 and 7

Petitioner argues, “to the extent that it is argued or found (incorrectly) that Odell discloses various, distinct embodiments” from which Petitioner identifies features for its anticipation challenge (*see supra* Section II.D),

it would have been obvious to the skilled artisan to combine such disclosures of Odell to achieve the inventions of independent claims 1 and 7.

Pet. 71–74.

Petitioner also argues, to the extent that Odell does not anticipate “stor[ing] the aggregated contact list in a non-transitory computer readable medium at the web server” as recited in independent claim 1 (*see supra* Section II.D.2.b.v), storing the aggregated contact list at Odell’s admin server 372 or webserver 384 would have been obvious in view of Odell alone or the combination of Odell and Daniell. Pet. 75–82 (citing, *inter alia*, Ex. 1004 ¶¶ 190–209).

As for Odell alone, Petitioner asserts that, “because both the admin server 372 and web server 384 access, process, and communicate the user’s aggregated contact list, it would have been obvious for those servers to store the list necessarily as part of that processing and/or to improve the speed and integrity of the system (e.g., more copies means more data fault tolerance).” Pet. 75 (citing Ex. 1004 ¶ 203).

As for the combination with Daniell, Petitioner argues that the skilled artisan would have been motivated to combine Odell and Daniell for numerous reasons including (1) both are directed to communications over multiple IM services, (2) Odell and Daniell provide express motivation for the combination, e.g., data duplication, and (3) “the combination involves the use of known techniques to improve similar devices in a predicable way.” Pet. 77–82.

Patent Owner argues that Daniell only stores an address book and requires the user to manually enter contact information into it. PO Resp. 64 (citing Ex. 2006 ¶¶ 204–205). In Patent Owner’s view, combining Daniell and Odell would not have been obvious to try because “the manual input and

potentially large database of contact information” would have made the combination impractical. *Id.* at 64–65.

We disagree that Petitioner is relying on manual input (PO Resp. 64–65). Rather, Petitioner relies on the operation of admin server 372:

[I]t would have been obvious, in view of this teaching in Daniell, to store the aggregated contact list in Odell (presented in the interfaces in Figures 4A-C and at least stored in the account linking database 380) at the admin server 372—as this server facilitates the authentication and logging-in operations for the user as discussed with respect to Claim 1 in Ground 1, akin to the arrangement disclosed in Daniell—or at Odell’s web server 384 that the user’s requestor system 305 logs into through the network 360.

Pet. 82 (citing Ex. 1004 ¶¶ 206–209). In this rationale, Petitioner relies on Daniell for its teachings about storing contacts. *Id.* at 77–78, 81–82.

Petitioner acknowledges that Daniell’s user “must manually add and edit” the contact. *Id.* at 78. But we disagree that this presents a technical hurdle for one of ordinary skill in the art (*see* PO Resp. 64–65; Ex. 2006 ¶¶ 202, 206) because, under Petitioner’s rationale, “Odell discloses a method to automate the obtaining, storing, and presentation of an aggregated contact list of all contacts from across multiple messaging service networks.”

Pet. 78. Thus, we disagree with Patent Owner for at least the reason that the arguments against the Odell-Daniell combination do not squarely address Petitioner’s obviousness rationale. *See* PO Resp. 63–65.

Also, Patent Owner’s argument assumes that Petitioner’s rationale depends on incorporating all the features from Daniell without further modification. *See* PO Resp. 64–65. But a person of ordinary skill in the art is also a person of ordinary creativity, not an automaton. *KSR*, 550 U.S. at 421. So, we see no reason why it would be necessary to incorporate

manual input in the Odell-Daniell combination because we agree with Petitioner that using Odell's automation to collect the contacts would not have been beyond the capabilities of one of ordinary skill in the art. *See* Pet. 77 (citing Ex. 1004 ¶ 193). Because Dr. Surati also assumes that Petitioner's combination requires manual input (*see* Ex. 2006 ¶¶ 204–205), we do not credit his testimony on this issue.

Rather, we agree with Petitioner that Daniell discloses advantages of storing IM contacts on a server. *See* Pet. 77. For example, Daniell's address book database 110 contains a user's contacts from multiple messaging services. Ex. 1007, 4:15–34. Daniell's Figure 13A, reproduced below, shows an example address book database 110. *Id.* at 17:1–3.

110 ADDRESS BOOK DATABASE

1310 1320 1330 1340 1350

ID	EMAIL ADDRESS	IM ADDRESS 1	IM ADDRESS 2	IM ADDRESS 3
C1 ID	C1 EMAIL ADDR. 1	C1 IM ADDR. 1	C1 ADDR. 2	C1 ADDR. 3
C2 ID	C2 EMAIL ADDR. 1	C2 IM ADDR. 1		
C3 ID		C3 IM ADDR. 1	C3 ADDR. 2	C3 ADDR. 3
C4 ID	C4 EMAIL ADDR. 1	C4 IM ADDR. 1	C4 ADDR. 2	
C5 ID	C5 EMAIL ADDR. 1			
C6 ID				
.	.	.	.	.
C _{I-1} ID	C _{I-1} EMAIL ADDR. 1			
C _I ID	C _I EMAIL ADDR. 1	C _I IM ADDR. 1		
C _{I+1} ID	C _{I+1} EMAIL ADDR. 1	C _{I+1} IM ADDR. 1		
.	.	.	.	.
C _{N-2} ID		C _{N-2} IM ADDR. 1	C _{N-2} ADDR. 2	C _{N-2} ADDR. 3
C _{N-1} ID	C _{N-1} EMAIL ADDR. 1	C _{N-1} IM ADDR. 1	C _{N-1} ADDR. 2	C _{N-1} ADDR. 3
C _N ID	C _N EMAIL ADDR. 1	C _N IM ADDR. 1	C _N ADDR. 2	C _N ADDR. 3

Figure 13, above, shows address book database 110 storing email address 1320 and corresponding contact identifier 1310. *Id.* at 17:20–23. The database also correlates IM addresses 1330, 1340, and 1350 with contact identifier 1310. *Id.* at 17:23–24.

Daniell explains that a client stores address book database 110 and a server stores a duplicate copy. Ex. 1007, 5:14–16. When the user logs into or out of the server, the server’s copy can be updated with the client machine’s copy. *Id.* at 5:16–26. Mr. Willis testifies that duplicating the

address book at the server would improve system performance and provide fault tolerance. Ex. 1004 ¶ 194. We credit Mr. Willis’s testimony on this issue because it is consistent with the teachings from the references. *See id.*

We also find persuasive Petitioner’s argument that Daniell’s teachings are compatible with Odell’s. *See* Pet. 78 (citing Ex. 1004 ¶ 195; Ex. 1007, 8:58–63; Ex. 1006, title page, 8:14–20). For example, like Odell, Daniell’s teachings relate to the AOL messaging service network and interface. *See* Ex. 1007, 8:58–63; Ex. 1006, title page, 8:14–20. We agree that Odell and Daniell address a similar problem: communication over multiple IM services. Pet. 77. We find persuasive and credit Mr. Willis’s testimony on this issue (*see* Ex. 1004 ¶¶ 192–195).

Patent Owner argues that Odell lacks an aggregated contact list to be stored. PO Resp. 62–66 (citing Ex. 2006 ¶¶ 199, 202–203, 207). We disagree for the reasons discussed above in Section II.D.2.b.iv and II.D.2.b.v. We also further note that, under the Odell-Daniell combination, Petitioner has provided ample additional support from Daniell’s Figure 13, which shows database 110 storing contacts from multiple messaging service networks (or messaging service providers). *See* Pet. 79–82 (citing, *inter alia*, Ex. 1007, 4:15–34, 5:14–26, 8:34–38, 8:57–63, 12:17–29, 17:1–8, Figs. 13A, 14). Patent Owner characterizes Daniell as disclosing “generally the concept of storing information on a sever,” but this fails to give sufficient weight to Daniell’s teachings in Figure 13 of an aggregated contact list. *See* PO Resp. 64; PO Sur-Reply 25.

Patent Owner argues that Petitioner does not specify “a single embodiment of Odell that would combine with Daniell to allegedly meet all claim elements.” PO Resp. 65. According to Patent Owner, Odell’s Figure 4C shows a simultaneous display of linked buddy lists, but Figure 4A

shows linked lists from AIM accounts on the same AIM communications system. *Id.* Patent Owner argues that, putting aside that AOL, AIM, and ICQ are on the same network, Figures 4A and 4B show buddy lists from AOL, AIM, and ICQ, but the embodiments in those figures “only allow for non-simultaneously display of different buddy lists.” *Id.*

We disagree. Petitioner’s challenge is based on obviousness. *See* Pet. 71–82. So, even assuming that Petitioner is relying on multiple embodiments, the Petition sufficiently explains how the teachings from Odell would have been combined with Daniell. *See id.* To the extent that Odell discloses multiple embodiments, the Petition also has a sufficient rationale for combining those embodiments. *See id.* at 71–74. For example, Petitioner argues that “it would have been obvious for [Odell’s] servers to store the list necessarily as part of that processing and/or to improve the speed and integrity of the system (e.g., more copies means more data fault tolerance).” *Id.* at 75 (Ex. 1004 ¶ 203). Also, Petitioner explains that the components described in Odell’s figures perform the same functions. *See, e.g., id.* at 73. We disagree with Patent Owner’s arguments (*see, e.g.,* PO Resp. 65) because they do not squarely address Petitioner’s rationale here.

In sum, we determine that Petitioner provides articulated reasoning, supported by rational underpinnings, why one of ordinary skill in the art would have made the proposed combination of Odell and Daniell. *See KSR*, 550 U.S. at 418. Considering the Petition’s analysis, we find that a person of ordinary skill in the art would have combined Odell and Daniell with an expectation of success, and doing so would have been within the level of ordinary skill in the art. *Id.* We also determine that the skilled artisan would have combined the features in Odell relied on by Petitioner to show

anticipation of independent claim 1 and 7, regardless if such features were found to rest in various Odell embodiments.

Based on the complete record before us, we find Petitioner shows sufficiently that Odell alone or in combination with Daniell teaches or at least fairly suggests all of the limitations in independent claims 1 and 7. Accordingly, for the foregoing reasons, and the reasons stated in the Petition (Pet. 71–82), we conclude that Petitioner has demonstrated by a preponderance of the evidence that claims 1–11 are unpatentable as obvious over Odell alone or in combination with Daniell.

3. *Claim 2*

Petitioner contends, “[t]o the extent that it is argued or found that the claimed ‘network contacts database’ (of Claim 1) and the ‘high level contacts database’ (of Claim 2) must be separate, this would have been obvious to [the skilled artisan] in view of Odell.” Pet. 76. Odell discloses:

For brevity, several elements in the figures described below are represented as monolithic entities. However, as would be understood by one skilled in the art, these elements each may include numerous interconnected computers and components designed to perform a set of specified operations and/or may be dedicated to a particular geographical region.

Ex. 1006, 3:48–56. Petitioner argues the skilled artisan “would understand that it would have been obvious that Odell’s account linking database 380 could be implemented as multiple databases—one for storing low level contacts and one for storing high level (i.e., ‘primary’ account contacts).” Pet. 76 (citing Ex. 1004 ¶ 204). According to Petitioner, this is “an express configuration option in Odell,” and the skilled artisan “would have been motivated to implement such a configuration, including to provide potentially quicker access to a user’s primary contacts.” Pet. 76.

Patent Owner does not present any separate arguments that are distinct to obviousness of dependent claim 2 (*see* PO Resp.; PO Sur-Reply), and therefore, has waived such arguments. *See* 37 C.F.R. § 42.23(a); *Nuvasive*, 842 F.3d at 1379–82; *Papst Licensing*, 924 F.3d at 1250; *Bradium*, 923 F.3d at 1048.

Based on the complete record before us, we find Petitioner shows sufficiently that Odell teaches or at least fairly suggests “a high level contacts database embodied in a non-transitory computer readable medium, wherein, in operation, contacts from the high level contacts database are included in the aggregated contact list,” as recited in claim 2. Accordingly, for the foregoing reasons, and the reasons stated in the Petition (Pet. 76), we conclude that Petitioner has demonstrated by a preponderance of the evidence that dependent claim 2 is unpatentable as obvious over Odell.

4. *Hindsight*

Patent Owner mentions “hindsight” in the Response, but without meaningful analysis. *See* PO Resp. 61 (“The arguments in the Petition rely heavily on hindsight and working backwards from the valid claims in an attempt to contort Odell into the claims.”). “Any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned only from applicant’s disclosure, such a reconstruction is proper.” *In re McLaughlin*, 443 F.2d 1392, 1313–14 (CCPA 1971). Here, Patent Owner does not direct us to any knowledge *gleaned only from applicant’s disclosure* that Petitioner allegedly relies upon to support its obviousness rationale. *See* PO Resp. 60–66. Thus, we find Patent Owner’s “hindsight” assertion unavailing.

III. MOTION TO EXCLUDE EVIDENCE

Patent Owner filed a Motion to Exclude Exhibits 1021–1028 and 1030. Mot. Excl. We note that the Motion asks for the exclusion of Exhibits 1021, 1024–1028, and 1030 in the “Relief Requested” and “Conclusion” sections, but the Motion also discusses Exhibits 1022 and 1023. *See* Mot. Excl. 2 (“Relief Requested”), 14 (“Conclusion”), 2–7 (Exs. 1022, 1023).

A Motion to Exclude “must identify the objections in the record in order and must explain the objections.” 37 C.F.R. § 42.64(c). Here, Patent Owner never filed or served any objections to Exhibits 1021, 1027, or 1028. On that basis, we deny Patent Owner’s Motion as to those exhibits.

Also, we do not rely on the content of Exhibits 1022–1026 or 1030 in reaching our decision on the patentability of the challenged claims. Thus, we dismiss as moot the Motion as to Exhibits 1022–1026 and 1030. *See* Consolidated Trial Practice Guide,⁵ 79–80 (Nov. 21, 2019) (“In the Board’s experience, consideration of the objected-to evidence is often unnecessary to resolve the patentability of the challenged claims, and the motion to exclude is moot.”). Even so, we note that Patent Owner’s Motion does not satisfy the requirements of 37 C.F.R. § 42.64(c) because it does not “identify the objections in the record.”

IV. CONCLUSION

Petitioner has met its burden to show that claims 1–11 are unpatentable.⁶

⁵ <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

⁶ Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner’s attention to the April 2019 Notice

Claim(s)	35 U.S.C. §	Reference(s)	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1–11	102	Odell	1–11	
1–11	103	Odell	1–11	
1–11	103	Odell, Daniell	1–11	
Overall Outcome			1–11	

V. ORDER

Upon consideration of the record, it is

ORDERED that claims 1–11 of U.S. Patent 8,510,395 B2 are unpatentable;

FURTHER ORDERED that Patent Owner’s Motion to Exclude Evidence (Paper 31) is denied in part and dismissed in part as moot; and

FURTHER ORDERED that, because this is a Final Written Decision, parties to this proceeding seeking judicial review of the Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding. *See* 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. *See* 37 C.F.R. § 42.8(a)(3), (b)(2).

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