

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SLACK TECHNOLOGIES, LLC,
Petitioner,

v.

GINEGAR LLC,
Patent Owner.

IPR2022-00541
Patent 9,367,521 B2

Before HYUN J. JUNG, MONICA S. ULLAGADDI, and
MICHAEL T. CYGAN, *Administrative Patent Judges*.

JUNG, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. *Background and Summary*

Slack Technologies, LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting institution of an *inter partes* review of claims 1 and 2 of

U.S. Patent No. 9,367,521 B2 (Ex. 1001, “the ’521 patent”). Ginegar LLC (“Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.”).

Under 35 U.S.C. § 314, an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Upon consideration of the Petition in view of the present record and for the reasons explained below, we determine that Petitioner has shown a reasonable likelihood of prevailing with respect to at least one of the challenged claims.

Thus, we institute an *inter partes* review of claims 1 and 2 of the ’521 patent on all presented challenges.

B. Real Parties in Interest

Petitioner identifies itself, “a wholly owned subsidiary of Salesforce.com, Inc.” as a real party in interest. Pet. 62. Petitioner also states that “[n]o unnamed entity is funding, controlling, or directing this Petition, or otherwise has had an opportunity to control or direct this Petition or Petitioner’s participation in any resulting IPR.” *Id.* at 62–63.

Patent Owner identifies itself as a real party in interest and indicates that its parent is KMizra, LLC. Paper 4, 2; Paper 5, 2. Patent Owner indicates that no publicly held corporation owns 10% or more of the stock of KMizra, LLC or Ginegar, LLC. *Id.*

C. Related Matters

Petitioner identifies *Ginegar LLC v. Slack Technologies, Inc.*, 1:21-cv-00494-RMR-STV (D. Col.) as a related matter that has been transferred to the Northern District of California and is now identified as 3:22-cv-00044-WHO (N.D. Cal.). Pet. 63. Petitioner also indicates that another petition has been filed for a related patent. *Id.* A petition for U.S. Patent No. 9,760,865 B2 owned by Patent Owner was filed in IPR2021-00542.

Patent Owner identifies the Northern District of California litigation as a related matter. Paper 4, 2; Paper 5, 2.

D. The '521 Patent (Ex. 1001)

The '521 patent issued on June 14, 2016, from an application filed on January 30, 2008. Ex. 1001, codes (22), (45).

The '521 patent relates to “systems, computer-implemented methods and computer program products for the implementation of content and/or context based handling of instant messages in an instant message environment.” Ex. 1001, 1:6–9. Figure 4 of the '521 patent is reproduced below.

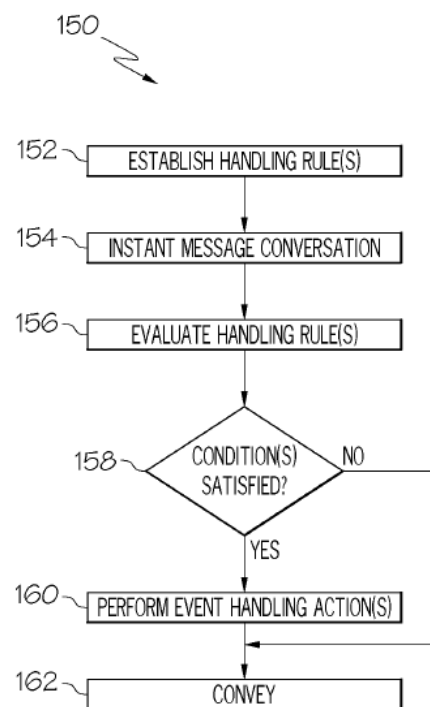


FIG. 4

Figure 4 “is a flow chart of a method for implementing content and/or context based handling of instant messages in an instant message environment.” Ex. 1001, 2:53–55. “[M]ethod 150 comprises establishing at least one handling rule at 152 that is evaluated in an instant messaging

environment.” *Id.* at 8:23–25. At 154, a “user engages in an instant messaging communication with a correspondent.” *Id.* at 8:46–47.

At 156, “[d]uring the instant message conversation, event handling rules are evaluated.” Ex. 1001, 8:47–48. “Each established handling rule may define a condition based upon an identified content or identified context,” “may also designate a corresponding event handling action to be performed within the instant message environment if the condition is satisfied,” and “may be created, stored and evaluated locally and/or via a corresponding server.” *Id.* at 8:25–31. “Conditions may be satisfied by literally meeting the specified conditions, by detecting correlations or other statistical patterns indicative of a condition being satisfied, etc.,” and “satisfying one or more predicates of a condition may be sufficient to satisfy the event handling rule.” *Id.* at 8:40–45.

“If a condition of an event handling rule is satisfied at 158, then a corresponding event handling action is implemented at 160.” Ex. 1001, 8:55–57. The “action may be to suppress or otherwise delay a pop up window that would otherwise take focus on the user’s processing device when an instant message is received on the user’s processing device 102” or “automatically formatting and transmitting a response message, etc.” *Id.* at 8:57–63.

“If the conditions are not satisfied at 158 or if the event handling action of a satisfied rule has been performed, the result of the instant message transaction is conveyed at 162.” Ex. 1001, 8:64–66. “If a handling rule was satisfied at 158 and an event handling action was performed at 160, a conveyance may comprise logging a record of an instant message communication into a transcript log without causing a pop up window to take the active focus from another application operating on the desktop of

the user's processing device 102.” *Id.* at 9:4–9. “In the event that the conditions of the handling rules are not satisfied, the conveyance at 162 may comprise causing a pop up window to appear on a display of the user's processing device.” *Id.* at 8:66–9:3.

An instant message server software can include “an adaptive and/or autonomic behavior manager” that “may interact with the other components of the instant messaging server software 112 to learn, derive, modify, create, delete or otherwise manipulate preference rules for each instant message system user.” Ex. 1001, 6:66–7:6. For example, “the autonomic capabilities may dynamically adjust the preferences for a given user based [upon] characteristics specific to that user or based upon characteristics of classes or groups of users or based upon knowledge learned across the instant message community and/or network.” *Id.* at 7:7–11.

E. Challenged Claims

The '521 patent includes only claims 1 and 2, reproduced below, both of which Petitioner challenges.

1. A method of processing instant message transactions comprising:
 - logging a first instant message client into an instant message server;
 - obtaining from the instant message server, at least one handling rule that is evaluated in an instant messaging environment in response to receipt of a message, each handling rule defining a condition based upon at least one of identified content or identified context, and a corresponding event handling action to be performed within the instant message environment;
 - identifying an instant message conversation within the instant message environment between a user and a correspondent;
 - evaluating each handling rule;

performing the corresponding event handling action of an associated handling rule if it is determined that the condition of that handling rule is satisfied; and

conveying to the user participating in the instant message conversation, an indication that the corresponding event handling action was performed.

2. The method according to claim 1, wherein at least one handling rule is autonomically generated based upon a dynamic evaluation of at least one of a user or a community of instant message users.

Ex. 1001, 18:2–26.

F. Asserted Prior Art and Proffered Testimonial Evidence

Petitioner identifies the following references as prior art in the asserted grounds of unpatentability:

Name	Reference	Exhibit
Patron	US 7,209,957 B2, issued Apr. 24, 2007	1006
Biggs	US 8,145,708 B2, filed Nov. 10, 2006, issued Mar. 27, 2012	1004
Borden	US 2004/0111479 A1, published June 10, 2004	1005

Pet. 3–4. Petitioner contends that Borden and Patron are prior art under § 102(b) and that Biggs is prior art under § 102(e).¹ *Id.* at 10–13. Petitioner also provides a Declaration of Arthur T. Brody, Ph.D. Ex. 1003.

¹ The relevant sections of the Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, 125 Stat. 284 (Sept. 16, 2011), took effect on March 16, 2013. Because the ’521 patent claims priority to an application filed before that date, our citations to 35 U.S.C. §§ 102 and 103 in this Decision are to their pre-AIA versions. *See also* Pet. 7 (stating that “[f]or the purpose of this Petition, Petitioner assumes the priority date of January 30, 2008”).

G. Asserted Grounds

Petitioner asserts that claims 1 and 2 are unpatentable on the following grounds:

Claims Challenged	35 U.S.C. §	References/Basis
1, 2	103(a)	Biggs, Borden
1, 2	103(a)	Biggs, Patron
1, 2	103(a)	Biggs, Borden, Patron

Pet. 3–4.

II. ANALYSIS

A. Legal Standards

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent [claim] it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016). This burden of persuasion never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). The Board may authorize an *inter partes* review if we determine that the information presented in the Petition shows that there is a reasonable likelihood that Petitioner will prevail with respect to at least one of the claims challenged in the petition. 35 U.S.C. § 314(a).

Petitioner contends that claims 1 and 2 of the ’521 patent are unpatentable under § 103. Pet. 3–4. A claim is unpatentable under § 103 if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying

factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). When evaluating a combination of teachings, we must also “determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Whether a combination of elements produces a predictable result weighs in the ultimate determination of obviousness. *Id.* at 416–417.

B. Level of Ordinary Skill in the Art

Petitioner asserts that one of ordinary skill in the art

would have had a bachelor’s degree in computer science, computer engineering, electrical engineering, or a similar field (or equivalent work experience to such a degree) with at least two years of experience in communications systems and systems for textual processing and analysis, or . . . a master’s degree in computer science, computer engineering, electrical engineering, or a similar field with a specialization in communications systems including instant messaging and systems for analyzing language.

Pet. 9–10 (citing Ex. 1003 ¶¶ 57–60). Petitioner also argues that such an ordinary skilled artisan “would have known and had the skills necessary to design or implement communications systems and applications in compliance with standards such as TCP/IP, UDP, XMPP and SIMPLE, to implement known techniques for natural language processing (NLP), and to understand common techniques for identifying patterns in text.” *Id.* at 10 (citing Ex. 1003 ¶¶ 57–60).

At this stage, Patent Owner does not present a proposed level of ordinary skill in the art and does not dispute Petitioner's proposed level of ordinary skill in the art. *See generally* Prelim. Resp.

Thus, based on the preliminary record, we adopt Petitioner's asserted level of ordinary skill only to determine whether there is a reasonable likelihood that Petitioner would prevail with respect to at least one of the claims challenged in the Petition. This level of skill in the art is consistent with the disclosure of the '521 patent and the prior art of record. *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (citing *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

C. Claim Construction

In an *inter partes* review based on a petition filed on or after November 13, 2018, the claims are construed

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

37 C.F.R. § 42.100(b) (2021); *see Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc).

Petitioner proposes an interpretation for “autonomically generated,” if the term needs to be construed. Pet. 4–5. Patent Owner does not present any arguments in response to Petitioner's proposed interpretation and does not propose any interpretation for any claim term. *See generally* Prelim. Resp.

At this preliminary stage, because determining whether Petitioner shows a reasonable likelihood of prevailing does not depend on a particular

interpretation for any claim term, we determine that no claim term requires express interpretation. *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’”) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

D. Asserted Obviousness Based on Biggs and Borden

Petitioner contends that Biggs teaches all the limitations of claims 1 and 2 with citations to the record. Pet. 16, 17–18, 20–23, 24–25, 27, 29, 30–31, 32–34, 35–36. With further citations to the record, Petitioner alternatively contends, to the extent that Biggs is not explicit or sufficient, Borden teaches almost all of the same limitations (*id.* at 16–17, 18–20, 23–24, 25–27, 27–28, 29–30, 31–32, 34, 36–38) and provides a reason for combining Biggs and Borden (*id.* at 14–16).

Patent Owner responds that Petitioner does not identify the specific grounds of invalidity, does not show that Biggs and Borden teach all the limitations, does not argue sufficiently a motivation to combine, and does not establish a reasonable expectation of success. Prelim. Resp. 2–3, 11–32.

For the reasons discussed below, Petitioner shows a reasonable likelihood of prevailing with respect to its challenge based on Biggs and Borden.

1. Biggs (Ex. 1004)

Biggs describes embodiments that “can provide a virtual online robot (bot) or security agent . . . termed a ‘guardian.’” Ex. 1004, 1:46–47. The “guardian” “can monitor on line conversations and can act to intervene in an event a conversation’s content meets certain definable criteria that indicates

that the content might be inappropriate or possibly harmful or risky.” *Id.* at 1:47–51.

The agent or guardian is part of or employed in an instant messaging application. Ex. 1004, 2:30–32, 3:2–3, 7:1–3. The instant messaging application resides on a computer-readable media 106 of computing device 102, and instant messaging protocols are “understood by the skilled artisan.” *Id.* at 3:49–55, 4:16–17. A presence-based network can support the use of the instant messaging application. *Id.* at 4:9–16.

The agent or guardian can be “part of a server that performs monitoring and evaluation on behalf of individual users.” Ex. 1004, 2:38–40. Figure 5 of Biggs is reproduced below.

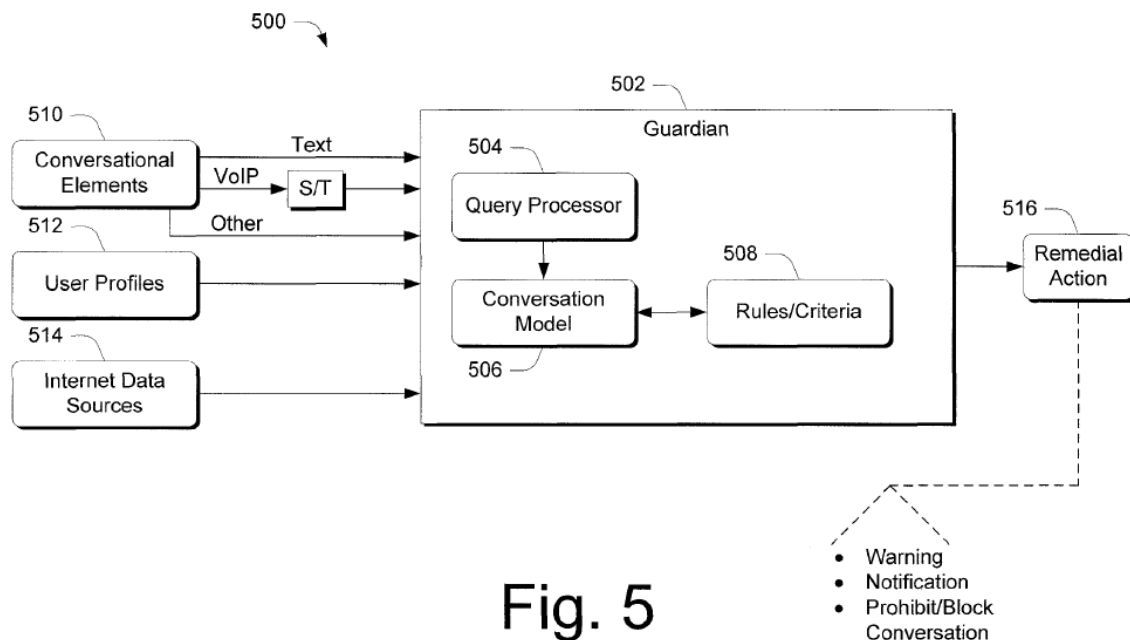


Figure 5 shows an exemplary guardian. Ex. 1004, 2:9–10, 5:35.

Guardian 502 can include query processor 504, conversation model 506, and a rules/criteria component 508. *Id.* at 6:1–3. “[Q]uery processor 504 is part of the natural language processing system and typically operates upon an

input, such as a text string, to parse the input and build, from the parsed input, a conversation model, such as conversation model 506.” *Id.* at 6:4–8.

“Conversation model 506 is then evaluated in view of the rules/criteria component 508 to ascertain whether a conversation or portions thereof need to be further addressed.” Ex. 1004, 6:9–11. “The rules/criteria component constitutes a knowledge base of information that describes the rules and criteria by which conversations are evaluated.” *Id.* at 6:11–14; *see also id.* at 7:21–26 (describing extensions “to cover scenarios that are not covered by the standard agent or guardian”).

The agent or guardian can “take[] remedial measures in an event a conversation or portions of its content are deemed problematic or possibly harmful.” Ex. 1004, 4:62–67. “Using natural language processing techniques, the agent or guardian can then present notifications or warnings to individual users (or others) when a particular conversation or portion thereof is deemed problematic.” *Id.* at 2:45–48, 5:54–58. “Such warnings can appear prior to messages being sent, or inline with the communication as appropriate.” *Id.* at 2:48–50.

“Alternately or additionally, the agent or guardian can block or otherwise prevent display of portions of conversations that it deems problematic.” Ex. 1004, 2:50–52, 5:58–60. “As an intermediate between these two approaches, the guardian can prompt a warning asking the user to verify that a particular communication should proceed, and wait for the affirmative before sending the user’s response.” *Id.* at 5:60–64, Fig. 6.

2. *Borden (Ex. 1005)*

Borden “relates to the automated monitoring of computer communications networks,” particularly “monitoring the conduct of participants, and the content of messages in online chat rooms, instant

messaging environments and related electronic communications arenas.”
Ex. 1005 ¶ 2.

Borden’s “method and system for on-line monitoring of Internet communications include automatically monitoring text-based communications of . . . instant messaging participants to determine if a monitoring event has occurred.” Ex. 1005 ¶ 7. Borden provides “a ‘Chaperone’ to automatically monitor text-based communications of one or more chat room or instant messaging participants to determine if a monitoring event has occurred.” *Id.* ¶ 11. “The existence of a monitoring event can result in one or more predetermined actions being taken by the system, such as notification of a third party regarding the monitoring event or termination of the electronic communication.” *Id.* Figure 2 of Borden is reproduced below.

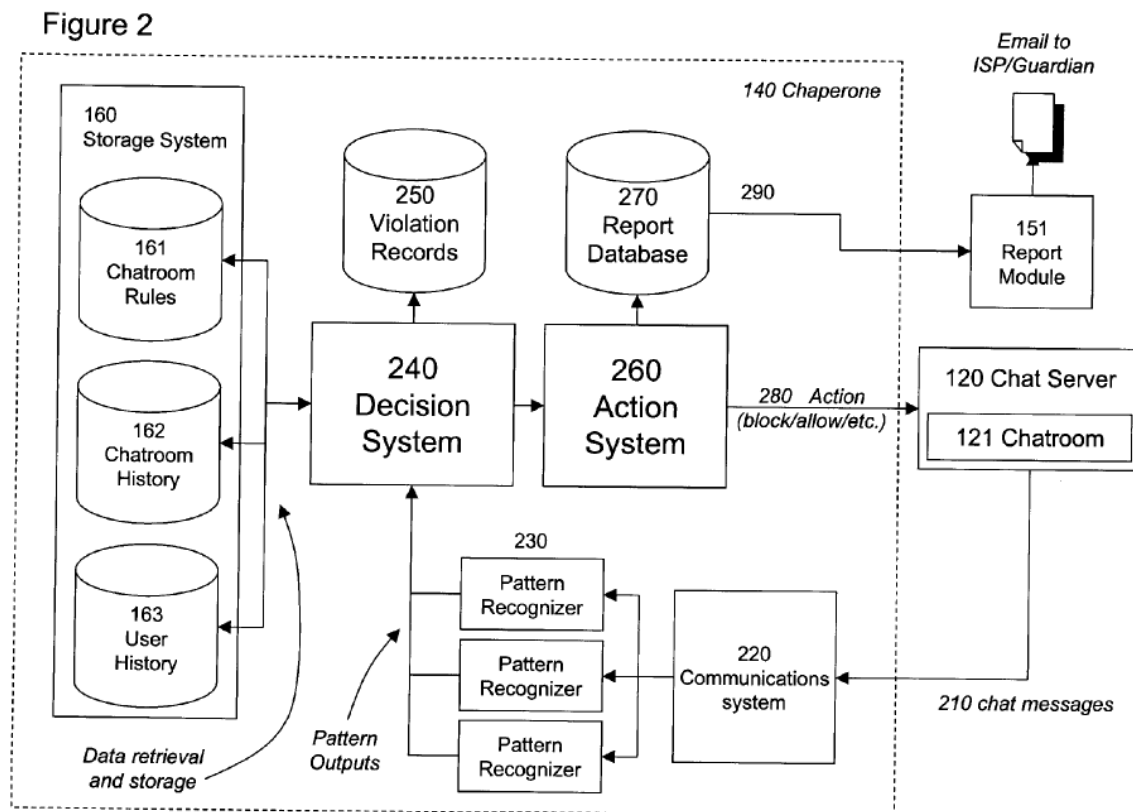


Figure 2 shows a “process for on-line monitoring of a chat.” Ex. 1005

¶ 10. Chaperone 140 can have artificial intelligence capabilities

to (i) recognize certain predefined and configured types of chat behavior (such as, for example, specifically inappropriate content or conversations with multiple chat room members in quick succession), and to (ii) then decide to act upon such recognized behavior to, for example, (a) interrupt the chat, (b) inform chat participant(s) of recognized violations of defined chat room rules of conduct, and/or (c) inform a third party (such as, for example, a child's guardian or ISP), based on certain predefined recognition algorithms and decision rules.

Id. ¶ 30.

“Chaperone 140 can, for example, interact with a storage system 160 . . . that can contain profile information 162 for chat participants 130 as well as chat rules 161 which can be used to monitor and evaluate chat conversations.” Ex. 1005 ¶ 33. “[S]torage system 160 can include a chat rules database 161 containing predetermined rules used by Chaperone 140 to evaluate parsed text from a chat.” *Id.* “The predetermined rules can include keywords or key phrases, the use of which by or to chat participants can qualify as a chat rule violation.” *Id.*

“Chaperone 140 can employ a set of known pattern recognition techniques to generate multiple predictions of the intention of a chat room participant.” Ex. 1005 ¶ 34. “The pattern recognition technology can operate on, for example, the content of a chat message, a conversation’s textual history, other non-textual information such as previous conversation participants, the amount of time a person is in a chat room, and a participants prior history of violations.” *Id.*; *see also id.* ¶¶ 53 (describing pattern recognizer 230 to find patterns in a conversation), 60 (describing that a Chaperone may include a special pattern recognizer).

“Decision System 240 evaluates the output of the pattern recognizers 230, including any chat rule violations, to determine action(s) to be taken” and “can contain decision rules which specify certain actions to be taken as a function of analysis performed by pattern recognizers 230.”

Ex. 1005 ¶ 45; *see also id.* ¶ 67 (describing the Chaperone’s decision system). If Chaperone 140 decides a violation has occurred, it “can warn a participant to cease a particular behavior, inform authorities, or block all communications of a particular chat participant or an entire chat room.” *Id.* ¶ 35.

Action system 260 via interface 280 with chat server 120 can implements the actions determined by decision system 240. Ex. 1005 ¶ 46. Based on the rule violation, “filters controlled by the Chaperone can immediately be updated (e.g., to block certain types of information), particular communications to or from a chat participant can be blocked, a chat participant can be contacted with a warning or instruction, or the Chaperone can immediately interrupt the chat.” *Id.*

“Chaperone server 150 also can include a report module 151” that “can create reports based on chat rule violations for transmission to a chat participant 130 and/or designated third parties.” Ex. 1005 ¶ 41. The report “can be transmitted, via interface 290, outside the internal Chaperone environment to report module 151.” *Id.* ¶ 46. “Report module 151, acting as a ‘report server’ of all reports generated by the Chaperone 140, can then distribute to an affected chat participant and/or a designated third party . . . a report.” *Id.* “For example, using a conventional report generator, a chat rule violation can be formatted into a text or voice message and queued for transmission out of the Chaperone 140.” *Id.*

3. *Claims 1 and 2*

For the preamble and each of the limitations of claim 1, Petitioner starts by arguing that Biggs in view of Borden teaches the preamble and limitations. Pet. 16, 17, 20, 24, 27, 29, 30, 32. In particular, Petitioner argues that both Biggs and Borden teach a “method of processing instant message transactions.” Pet. 16 (citing Ex. 1003 ¶¶ 80–82; Ex. 1004, 1:46–51, 2:19–3:3, 7:1–3; Ex. 1005 ¶¶ 3, 7, 18).

Petitioner argues that Biggs teaches “logging a first instant message client into an instant message server.” Pet. 17–18 (citing Ex. 1003 ¶¶ 9, 83, 84; Ex. 1004, 2:25–35, 3:53–56, 4:9–16, 7:29–34; Ex. 1012, 16). Petitioner also argues that Biggs teaches “obtaining from the instant message server, at least one handling rule that is evaluated in an instant messaging environment in response to receipt of a message.” *Id.* at 20–23 (citing Ex. 1003 ¶¶ 89, 90, 93; Ex. 1004, 2:38–40, 2:45–50, 4:9–13, 6:1–3, 6:11–14, 7:21–26, Fig. 3; Ex. 1012, 16). Petitioner further argues that Biggs teaches “each handling rule defining a condition based upon at least one of identified content or identified context, and a corresponding event handling action to be performed within the instant message environment.” *Id.* at 24–25 (citing Ex. 1003 ¶¶ 97, 99; Ex. 1004, 1:46–59, 6:9–14).

Petitioner contends that Biggs teaches “identifying an instant message conversation within the instant message environment between a user and a correspondent.” Pet 27 (citing Ex. 1003 ¶ 103; Ex. 1004, 2:58–61, 6:56–60). Petitioner also contends that Biggs teaches “evaluating each handling rule.” *Id.* at 29 (citing Ex. 1003 ¶ 107; Ex. 1004, 6:9–14). Petitioner further contends that Biggs teaches “performing the corresponding event handling action of an associated handling rule if it is determined that the condition of that handling rule is satisfied.” *Id.* at 30–31 (citing Ex. 1003 ¶¶ 111

Ex. 1004, 2:45–52, 4:62–67, 9:45–47). Petitioner additionally contends that Biggs teaches “conveying to the user participating in the instant message conversation, an indication that the corresponding event handling action was performed.” *Id.* at 32–34 (citing Ex. 1003 ¶¶ 116, 117; Ex. 1004, 5:54–64, 6:56–64, Fig. 6).

Petitioner also argues that, “[t]o the extent Patent Owner argues that Biggs’ teachings are not explicit and not sufficient,” Borden teaches the preamble and the limitations of claim 1 with citations to Borden and declarant testimony. Pet. 16, 18–20, 23–24, 25–26, 27–28, 29–30, 31–32, 34. Specifically, Petitioner argues that Borden teaches the logging step. *Id.* at 18–20 (citing Ex. 1003 ¶¶ 9, 84–86, 91; Ex. 1005 ¶¶ 18, 19, 24, 25, 27, 29, Fig. 1; Ex. 1012, 16). Petitioner also argues that Borden teaches the obtaining step. *Id.* at 23–24 (citing Ex. 1003 ¶ 92; Ex. 1005 ¶¶ 33, 34, 42, 53). Petitioner further argues that Borden teaches “each handling rule defining a condition based upon at least one of identified content or identified context, and a corresponding event handling action to be performed within the instant message environment.” *Id.* at 25–26 (citing Ex. 1003 ¶¶ 98, 100; Ex. 1005 ¶¶ 11, 30, 33, 34). According to Petitioner, Borden also teaches the identifying step. *Id.* at 27–28 (citing Ex. 1003 ¶ 104; Ex. 1005 ¶¶ 53, 60). Petitioner contends that Borden also teaches the evaluating step. *Id.* at 29–30 (citing Ex. 1003 ¶ 108; Ex. 1005 ¶¶ 33, 45, 67). Petitioner also contends that Borden teaches the performing step. *Id.* at 31–32 (citing Ex. 1003 ¶¶ 112, 113; Ex. 1005 ¶¶ 35, 41). Petitioner further contends that Borden also teaches the conveying step. *Id.* at 34 (citing Ex. 1003 ¶ 118; Ex. 1005 ¶ 46). For each of the limitations, Petitioner asserts why one of ordinary skill in the art would have modified Biggs in

view of Borden with support from declarant testimony. *Id.* at 16–17, 20, 24, 26–27, 28, 30, 32, 34.

For claim 2, Petitioner argues that Biggs in view of Borden teaches its limitation by presenting arguments in a manner similar to that used for claim 1. Pet. 35–38. Petitioner first argues that Biggs teaches the limitations of claim 2. *Id.* at 35–36. Petitioner then argues that, “[t]o the extent Patent Owner argues that Biggs’ teachings are not explicit and not sufficient,” Borden teaches the limitations of claim 2 and why one of ordinary skill in the art would have combined Biggs and Borden. *Id.* at 36–38.

According to Petitioner, both Biggs and Borden are directed to the same field of invention with citations to these references and declarant testimony. Pet. 14–15. Petitioner also contends with citations to Borden and declarant testimony that Borden improves instant messaging and teaches detecting “a particular set of words” indicating a chat violation, learning to update its rules, and “using known AI technologies.” *Id.* at 15.

Petitioner argues with declarant support that its “proposed combination would have been nothing more than the combination of prior art elements according to known methods to yield predictable results (a better IM monitoring system).” Pet. 15. Petitioner also argues that one of ordinary skill in the art would have had a reasonable expectation of success in making the combination with support from declarant testimony. *Id.* at 15–16.

Based on the arguments and citations to record evidence presented in the Petition, Petitioner shows a reasonable likelihood of prevailing with respect to at least one of the challenged claims in its obviousness challenge based on Biggs and Borden.

a) Patent Owner's Preliminary Response

(1) identifying the grounds with particularity

Patent Owner responds that Petitioner fails to identify any differences between the challenged claims and the asserted prior art. Prelim. Resp. 13–17. In particular, Patent Owner argues with citations to the Petition that, for every limitation of claim 1, Petitioner relies on another reference if Patent Owner argues that the relied-upon teachings are not explicit and not sufficient. *Id.* at 13–16. Patent Owner, thus, contends that Petitioner fails to identify the differences and asks the Board to pick and choose the best combinations. *Id.* at 16–17. Patent Owner also contends that it does not have the burden to identify the differences between the prior art and the challenged claims. *Id.* at 17.

Petitioner's arguments for each limitation of claim 1 explicitly indicate that, in Petitioner's view, at least Biggs teaches the limitations. *See, e.g.,* Pet. 18, 41, 52. Petitioner is not arguing that there is a difference between Biggs and the challenged claims. *See, e.g., id.; see also* Ex. 1003 ¶¶ 83, 96, 102, 106, 110, 115, 122 (stating at these paragraphs that “[i]t is also my opinion that Biggs and Borden separately each teach this limitation”). Based on the circumstances of this proceeding, Petitioner's primary contention based only on Biggs satisfies Petitioner's burden to show with particularity why the challenged claims are unpatentable. *See Harmonic*, 815 F.3d at 1363; 35 U.S.C. § 312(a)(3). It “is well settled” that “a disclosure that anticipates . . . also renders the claim invalid under § 103, for ‘anticipation is the epitome of obviousness.’” *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1373 (Fed. Cir. 2019). Thus, a showing by Petitioner that Biggs discloses all of the claim limitations is sufficient to show obviousness over Biggs.

Because Petitioner primarily contends that Biggs sufficiently teaches the limitations, our analysis at this preliminary stage also focuses on Biggs to determine whether Petitioner sufficiently shows a reasonable likelihood of prevailing on at least one challenged claim. We provide our preliminary analysis below regarding the proposed combination to assist the parties in presenting their arguments during trial. Patent Owner should note for trial that Petitioner’s position is that Biggs and Borden each teach the limitations of claims 1 and 2. *See, e.g.*, Pet. 17 (“Biggs teaches . . .”), 18 (“Borden also explicitly teaches . . .”); Ex. 1003 ¶¶ 83, 96, 102, 106, 110, 115, 122.

In making our final determination of whether a preponderance of the evidence supports Petitioner’s argument that Biggs would have rendered obvious claims 1 and 2, if the full record indicates that Biggs does not teach or suggest all the limitations, we will consider the sufficiency of Petitioner’s arguments regarding why one of ordinary skill in the art would have combined Biggs with Borden to reach the missing limitation.

(2) *“obtaining from the instant message server, at least one handling rule that is evaluated in an instant messaging environment in response to receipt of a message”*

Patent Owner also responds that Petitioner fails to show that the proposed combination has a process wherein an instant message client logs into an instant message server and obtains handling rules from an instant message server. Prelim. Resp. 2. In its summary of Biggs, Patent Owner argues that Biggs does not disclose “obtaining from the instant message server, at least one handling rule that is evaluated in an instant messaging environment in response to receipt of a message” because Biggs locates its guardian either locally on the computing device or remotely across the network. *Id.* at 8–9 (citing Ex. 1004, 1:46–59, 4:63–67, 5:7–20, 6:1–26.

Patent Owner also argues that the rules of Biggs are found in the guardian, not an instant message server, and, thus, Biggs does not need to obtain any rules from any instant message server. *Id.* at 9 (citing Ex. 1004, 6:1–26). Thus, in Patent Owner’s view, “Biggs does not teach the use of an instant message server to store handling rules and logging into that instant message server to obtain handling rules that are evaluated in response to receipt of a message in an instant message conversation.” *Id.* Patent Owner specifically contends that Petitioner fails to show where Biggs teaches placing its guardian on an instant message server and, instead, “identifies several other locations where a guardian could be located.” *Id.* at 18.

According to Patent Owner, “Petitioner’s expert declaration provides no substantive guidance and appears to merely mimic the conclusory statements in the Petition.” Prelim. Resp. 3. Patent Owner also argues that Petitioner’s declarant explains that Biggs describes the guardian as residing in the instant messaging application, not an instant message server. *Id.* at 18 (citing Pet 20; Ex. 1003 ¶ 89; Ex. 1004, 2:24–30, 4:9–13, 5:10–16). Patent Owner notes that the claim recites “instant message server” and “instant message client” and, thus, distinguishes the two. *Id.* at 18–19 (citing Ex. 1001, 18:4–9).

Patent Owner further argues that Petitioner cites to a teaching that the guardian can be part of a server that performs monitoring and evaluation, but provides no evidence that this server is an instant message server. Prelim. Resp. 19 (citing Pet. 20–21; Ex. 1004, 2:38–40). Patent Owner contends that Biggs explains the monitoring and evaluation are part of the guardian, not instant messaging. *Id.* (citing Ex. 1004, Abstract, 1:47–55).

Regarding Petitioner’s reliance on Biggs’s presence and awareness network, Patent Owner argues that a network is not a server and that Biggs

teaches that a network has multiple servers. Prelim. Resp. 20 (citing Pet. 21; Ex. 1003 ¶ 89; Ex. 1004, 4:9–10). Patent Owner also argues that Petitioner ignores the fact that network is not server and provides no evidence to connect a guardian residing on a server of a network to an instant message server. *Id.* (citing Pet. 21; Ex. 1003 ¶ 89; Ex. 1004, 4:9–13). Patent Owner further argues that Biggs’s guardian “contains the rules, evaluates the rules, and enforces the rules” so that “there is no need for the guardian to obtain any rules from any other component.” *Id.* (citing Ex. 1004, 6:1–55).

Regarding Petitioner’s reliance on Biggs’s teaching that extensions can be downloaded and installed over a network, Patent Owner argues that this teaching does not explain from where the extensions are obtained. Prelim. Resp. 20 (citing Pet. 22; Ex. 1004, 7:21–26). Patent Owner also argues that Petitioner and its declarant only state without support that downloading would include the rules and come from an instant message server. *Id.* (citing Pet. 22; Ex. 1003 ¶ 90; Ex. 1004, 4:9–13). According to Patent Owner, the cited portion of Biggs does not discuss any downloads or the guardian. *Id.* (citing Ex. 1004, 4:9–13).

On the preliminary record, Petitioner makes a sufficient showing for “obtaining from the instant message server, at least one handling rule that is evaluated in an instant messaging environment in response to receipt of a message.” Petitioner argues that “Biggs in view of Borden teaches this limitation.” Pet. 20 (citing Ex. 1003 ¶¶ 89–95). In particular, Petitioner argues that Biggs teaches the obtaining step. *Id.* at 20–23 (citing Ex. 1003 ¶¶ 89, 90, 93; Ex. 1004, 2:38–40, 2:45–50, 4:9–13, 6:1–3, 6:11–14, 7:21–26, Fig. 3; Ex. 1012, 16).

As for Patent Owner’s responsive arguments regarding obtaining handling rules from an instant message server, a relied-upon portion of

Biggs teaches that the “guardian may comprise part of a server that performs monitoring and evaluation.” Ex. 1004, 2:38–40. Another relied-upon portion teaches that presence-based network 112 includes servers 114 that implement the presence network and “includes or supports the use of instant messaging.” *Id.* at 4:9–13. Figure 3 of Biggs shows that guardian components 300 can be located in various locations in its system 100. *See also id.* at 5:7–9 (stating that “guardian components 300 are provided” and “can reside at different locations with system 100”), 5:10–11 (stating that “guardian component 300 can reside locally on the end user’s computing device”), 5:15–20 (stating that “additionally, guardian component 300 can reside on or otherwise be accessible via a network such as the Internet” and “additionally, guardian component 300 can be provided or otherwise accessed through the presence-based network”); Prelim. Resp. 8–9 (arguing that Biggs locates the guardian locally or remotely).

Petitioner also cites a portion of Biggs that teaches that “guardian 502 includes . . . rules/criteria component 508” and that the guardian can be extended by downloading and installing over a network. Ex. 1004, 6:1–3, 7:21–26; *see also* Prelim. Resp. 9 (arguing rules are found in the guardian) (citing Ex. 1004, 6:1–26).

Moreover, Biggs teaches that system 100 includes applications 108 on computer-readable media 106 of computing device 102. Ex. 1004, 3:47–53, Fig. 1. Biggs also teaches that the application can be in the form of an instant messaging application. *Id.* at 3:54–55. Biggs’s “presence-based network includes one or more applications or bots 116, typically hosted by or on a server 114, which can communicate with a user of computing device 102 (through any suitable means such as instant messaging . . . and the like).” *Id.* at 4:19–24.

In view of the teachings upon which Petitioner relies, Petitioner sufficiently shows on the present record that Biggs teaches that presence-based network 112 has servers that implement the use of instant messaging. Ex. 1004, 3:47–55, 4:9–13, 5:7–9, 5:17–20, Figs. 1, 3. Biggs also indicates that the guardian can be part of a server and rules/criteria component 508 of guardian 502 can be downloaded contrary to Patent Owner’s responsive argument that the relied-upon server is not an instant message server. *Id.* at 2:38–40, 4:19–24, 6:1–3. At this stage, Petitioner’s cited portions of Biggs sufficiently show that Biggs teaches, or at least suggests, that rules are downloaded from a server that may also implement the use of instant messaging.

(3) *Borden*

Patent Owner also responds that Borden’s Chaperone is located on a Chaperone server that is distinct from an instant message server. Prelim. Resp. 10 (citing Ex. 1005, Abstract, ¶¶ 26–27). Patent Owner argues that Borden discusses the benefit of having the Chaperone on a Chaperone server, such as making it difficult to override the system and collecting data about multiple users. *Id.* (citing Ex. 1005 ¶¶ 27–29). Patent Owner also argues that the Chaperone contains the rules and “does not need to obtain any rules from an instant message server.” *Id.* at 10–11.

Patent Owner contends that Petitioner fails to show that Borden discloses “obtaining from the instant message server, at least one handling rule.” Prelim. Resp. 22–24. In particular, Patent Owner argues that Petitioner’s relied-upon portion of Borden teaches its Chaperone resides on a Chaperone server, not a separately identified Chat Server, or on a chat participant’s computer as an applet. *Id.* at 22–23 (citing Pet. 19; Ex. 1005 ¶ 26, Fig. 1). According to Patent Owner, Petitioner does not argue that

Borden discloses the obtaining any handling rule from an instant message server and merely asserts that Borden's handling rules are evaluated in an instant messaging environment, and Petitioner's declarant only provides conclusory testimony without support. *Id.* at 24 (citing Pet. 23–24; Ex. 1003 ¶ 92).

As Patent Owner contends, Petitioner relies only on Biggs for teaching “obtaining from the instant message server, at least one handling rule.” Pet. 20 (“Biggs teaches obtaining handling rules from the instant message server.”). After presenting arguments that Biggs also teaches evaluating handling rules in an instant message environment in response to receipt of a message (*id.* at 22–23), Petitioner argues that “[t]o the extent Patent Owner argues that Biggs’ teachings are not explicit and not sufficient to disclose this limitation, the handling rule of Borden is also evaluated in an instant messaging environment in response to receipt of a message” (*id.* at 23).

Petitioner alternatively relies on Borden for teaching the limitation “at least one handling rule that is evaluated in an instant messaging environment in response to receipt of a message,” but does not rely on Borden for teaching “obtaining from the instant message server, at least one handling rule,” as argued by Patent Owner. *See* Pet. 22–23. As discussed above, because of how Petitioner presents its arguments, we are primarily considering Biggs at this preliminary stage, and Patent Owner's arguments regarding Borden does not provide a basis for determining that Petitioner fails to show a reasonable likelihood of prevailing in its challenge based on Biggs.

(4) Petitioner's asserted motivation to combine

Patent Owner further responds that Petitioner fails to provide a motivation to combine the references in the manner proposed. Prelim. Resp. 2; *see also id.* at 3 (arguing that “Petitioner’s expert declaration provides no substantive guidance and appears to merely mimic the conclusory statements in the Petition”). We need not determine this issue for purposes of institution, because we have determined that Petitioner has shown obviousness over Biggs alone. However, we provide this discussion to provide further guidance to the parties on this issue.

According to Patent Owner, Petitioner does not present a motivation to combine any of the cited references because Petitioner “does not identify any differences between the challenged claims and the prior art references” and “argues only that the prior art references share the same field, share the same objective, and share the same methods to solve the same issues.” Prelim. Resp. 26. Patent Owner also argues that Petitioner’s “arguments are nothing more than ‘a broad characterization of [two prior art references] as both falling within the same alleged field’” and are insufficient to articulate a motivation to combine. *Id.* at 30–31 (alteration in original).

Patent Owner further responds that Petitioner fails to establish a reasonable expectation of success for making the proposed combination. Prelim. Resp. 31. Patent Owner argues that Petitioner “has not proposed any specific combination of prior art elements, much less any evidence with respect to ‘reasonable expectation of success’ for those unarticulated combinations” and merely presents conclusory arguments that should be given no weight. *Id.* at 31–32.

Petitioner’s asserted motivation to combine is focused on claim 2. *See* Pet. 14–15, 35–38. As summarized above, Petitioner argues that both Biggs

and Borden are in the same field of invention. *Id.* at 14–15. Petitioner also goes on to argue that Borden improves instant messaging and teaches (1) detecting “a particular set of words” indicating a chat violation, (2) learning to update its rules, and (3) “using known AI technologies.” *Id.* at 15.

Petitioner then argues that its “proposed combination would have been nothing more than the combination of prior art elements according to known methods to yield predictable results (a better IM monitoring system).” Pet. 15. Patent Owner does not yet address whether Biggs and Borden would have been such a combination of prior art elements. *See* Prelim. Resp. 26–32.

Like claim 1, Petitioner also argues that Biggs by itself teaches the limitations of claim 2 based on Petitioner’s proposed interpretation of the claim limitation “autonomically generated.” Pet. 35–36. Petitioner proposes combining Biggs with Borden “[t]o the extent Patent Owner argues that Biggs’ teachings are not explicit and not sufficient” because one of ordinary skill in the art “would have incorporated the AI learning and neural network learning features as taught by Borden into a system according to Biggs, because Borden specifically identifies the difficulties brought by intentional circumlocutions of the users.” *Id.* at 36–38.

We agree that at this stage, the evidence of record supports Petitioner’s asserted reason to combine. Pet. 14–16 (citing, *inter alia*, Ex. 1003 ¶¶ 71–78).

Because Petitioner makes clear that it is relying on its proposed interpretation of “autonomically generated,” and the parties may dispute Petitioner’s interpretation, Petitioner ostensibly presents an alternative argument if “autonomically generated” as recited in claim 2 requires AI

learning and neural network learning features. See Pet. 36–38. Based on the preliminary record, Petitioner’s asserted motivation to combine Biggs and Borden to include such features is sufficient for the purposes of institution.

E. Asserted Obviousness Based on Biggs and Patron

In a manner similar to that used for the challenge based on Biggs and Borden, Petitioner argues that Biggs and Patron would have rendered obvious claims 1 and 2 with references to previous arguments for Biggs and citations to the record.

Patent Owner responds that Petitioner does not identify the specific grounds of invalidity, does not show that Biggs and Patron teach all the limitations, does not argue sufficiently a motivation to combine, and does not establish a reasonable expectation of success. Prelim. Resp. 2–3, 11–32.

For the reasons discussed below, Petitioner shows a reasonable likelihood of prevailing with respect to its challenge based on Biggs and Patron.

1. Patron (Ex. 1006)

Patron “relates to methods and systems for instant messaging (IM).” Ex. 1006, 1:6–7. According to Patron, after signing up a minor for IM service, a “parent or guardian creates a profile comprising one or more control policies for usage of the IM service by the minor using a Web-based profile administrator interface.” *Id.* at code (57). “The IM server communicates information from the profile to the client device to modify the functionality of the client device to comply with at least one policy in the profile.” *Id.*

“The minor’s 14 usage is governed by a set of rules specified in a profile associated with the minor 14 and his/her client device 36,” and “minor 14 is allowed to use the IM service in multiple locations in

accordance with the rules specified by the user 12.” Ex. 1006, 4:60–65. In particular, a method of Patron “comprises providing, limiting or inhibiting the IM service to the minor 14 in accordance with the user-created profile.” *Id.* at 3:18–20.

Patron’s method can inhibit or enable a minor to communicate with users or join chat rooms. Ex. 1006, 3:20–28. The method can also enable or inhibit using a client device, logging on, and receiving messages during certain specified times. *Id.* at 3:28–39; *see also id.* at code (57) (“Thereafter, a request is received by an IM server from the minor to log on to the IM service using a client device.”), 2:63–65 (“As indicated by block 42, the method comprises receiving a request from the minor 14 to log on to the IM service.”).

“IM server 64 communicates profile information to the client device 36,” and based on that information, “client device 36 modifies its functionality to comply with the policies.” Ex. 1006, 3:43–46; *see also id.* at 2:40–48 (describing that the profile can include times-based controls to specify times when a minor can use client device 36, log on, and receive messages). “[T]he policies stored by the IM subscriber profile database 40 are downloaded to the client device 36.” *Id.* at 3:53–54. “Regardless of the specific type of client device 36, plug-in software components can be used to add the parental control functionality to standard IM clients.” *Id.* at 3:46–49.

In an embodiment, “policy engine 71 acts to provide, limit and/or inhibit use of the IM service on the client device 36.” Ex. 1006, 3:63–64; *see also id.* at 4:7–12 (describing that IM server 64 can limit IM service based on a stored profile). It “performs the actual task of verifying all access to ensure compliance with the policies,” “filters incoming and outgoing messages to other IM users or groups based on the policies,” and “may act to

send alerts, in the form of e-mails or instant messages, to the parent or guardian user 12 to alert him/her of the activity of the client device 36.” *Id.* at 3:55–62.

“IM server 64 periodically receives usage data from the client device 36.” Ex. 1006, 4:3–4. “[P]olicy engine 71 may periodically update usage data stored by either the IM server 64 or the IM subscriber profile database 40.” *Id.* at 4:1–3. “The usage data may comprise a log of actions taken to ensure compliance with the policies.” *Id.* at 4:4–6.

Patron states that the “use of the policy engine 71 makes the whole system more scaleable [sic] to a large number of users than a completely centralized model where servers filter through each incoming/outgoing message to any policy-controlled client device.” Ex. 1006, 4:12–16.

“[P]olicy data 124 defines the policies that are to be enforced, such as by the policy engine 71 of the client device 36.” Ex. 1006, 6:7–9. “[A]ction list data 126 comprises the action type as a primary key and an action description” and “is a catalog of types of predetermined actions that can be performed by the client device 36 based on events.” *Id.* at 6:10–13. “For example, an action may comprise ‘send e-mail to administrator when a message is blocked.’” *Id.* at 6:13–15.

2. *Claims 1 and 2*

For the preamble and each of the limitations of claim 1, Petitioner argues that Biggs in view of Patron teaches the preamble and limitations. Pet. 40, 41, 44, 45, 46, 47. Petitioner refers to previous arguments to contend that Biggs teaches the preamble and each of the limitations with additional citations to declarant testimony. *Id.* at 40, 41, 44, 45, 46, 47.

Petitioner also argues that, “[t]o the extent Patent Owner argues that Biggs’ teachings are not explicit and not sufficient,” Patron teaches the

preamble and the limitations of claim 1 with citations to Patron and declarant testimony. Pet. 40, 41–47. Petitioner further argues why one of ordinary skill in the art would have modified Biggs in view of Patron with support from declarant testimony. *Id.* at 40, 41, 44, 45, 46–47, 47–48.

For claim 2, Petitioner argues that Biggs in view of Patron teaches its limitation by referring to previous arguments regarding Biggs with citations to declarant testimony. Pet. 48.

According to Petitioner, both Biggs and Patron are directed to the same field of invention with citations to these references and declarant testimony. Pet. 38. Petitioner also contends with citations to Patron and declarant testimony that Patron teaches making an IM system “more scaleable [sic] to a large number of users.” *Id.* at 39. Petitioner argues with declarant support that its “proposed combination would have been nothing more than the combination of prior art elements according to known methods to yield predictable results (a better IM monitoring system where a user does not get less restrictive IM policies when the user changes devices, while the whole system is scaleable [sic] to a large number of users).” *Id.* Petitioner also argues that one of ordinary skill in the art would have had a reasonable expectation of success in making the combination with support from declarant testimony. *Id.* at 39–40.

Based on the arguments and citations to record evidence presented in the Petition, Petitioner shows a reasonable likelihood of prevailing with respect to at least one of the challenged claims in its obviousness challenge based on Biggs and Patron.

a) Patent Owner's Preliminary Response

- (1) *“obtaining from the instant message server, at least one handling rule that is evaluated in an instant messaging environment in response to receipt of a message”*

Patent Owner responds that Patron “is drawn to controlling instant message usage” and “discloses the creation of a profile for a user, specifically one that provides usage limits.” Prelim. Resp. 11 (citing Ex. 1006, 1:11–22, 2:26–49). Patent Owner, thus, argues that the rules of Patron are applied before a conversation begins because they govern when and with whom the conversation occurs and control access to instant messaging. *Id.* (citing Ex. 1006, 3:18–43).

Patent Owner, therefore, argues that Patron does not disclose “obtaining from the instant message server, at least one handling rule that is evaluated . . . in response to receipt of a message” because Patron discloses creating a profile with control policies for an IM handle. Prelim. Resp. 24–25 (citing Ex. 1006, 2:27–30). Patent Owner contends that Petitioner acknowledges that the profile rules apply immediately after logging in. *Id.* (citing Pet. 43; Ex. 1006, 4:60–65). Patent Owner also contends that the profile rules are applied separately from any message and not “evaluated . . . in response to receipt of a message.” *Id.*

On the preliminary record, Patent Owner's arguments regarding Patron does not show a defect in Petitioner's position because they are not responsive to Petitioner's challenge. Petitioner refers to its arguments that Biggs teaches the obtaining step. Pet. 41. For the reasons discussed above, Petitioner shows sufficiently at this stage that Biggs teaches or suggests that rules are downloaded from a server that can also implement the use of instant messaging.

(2) *remaining responses*

Patent Owner also responds that Petitioner’s arguments do not identify the grounds of invalidity because those arguments do not identify the differences between the prior art and the challenged claims. Prelim. Resp. 13–17. For the same reasons discussed above for the Biggs and Borden challenge, Petitioner’s primary contention is that Biggs teaches all the limitations of claims 1 and 2. *See* Pet. 40–48. Petitioner, thus, sufficiently identifies the grounds of invalidity.

Patent Owner further responds that Petitioner’s asserted motivation to combine is insufficient because Petitioner does not identify any differences between the claims and the asserted art, only broadly characterizes the references, and fails to establish a reasonable expectation of success by merely presenting conclusory arguments. Prelim. Resp. 30–32.

As discussed above, because Petitioner primarily contends that Biggs teaches the limitations, our analysis at this preliminary stage focuses on Biggs. To assist the parties for trial, as summarized above, Petitioner argues that both Biggs and Patron are in the same field of invention. Pet. 38. Petitioner also argues that Patron teaches making an IM system scale with a larger number of users. *Id.* at 39. Petitioner further argues that its “proposed combination would have been nothing more than the combination of prior art elements according to known methods to yield predictable results (a better IM monitoring system where a user does not get less restrictive IM policies when the user changes devices, while the whole system is scaleable [sic] to a large number of users).” *Id.* at 39.

The evidence of record supports Petitioner’s asserted reason to combine. Pet. 39–40 (citing, *inter alia*, Ex. 1003 ¶ 136). We note that Patent Owner does not yet address whether combining Biggs and Patron

would have been “nothing more than the combination of prior art elements according to known methods to yield predictable results.” See Prelim. Resp. 30–32.

F. Asserted Obviousness Based on Biggs, Borden, and Patron

Petitioner argues that, if Patent Owner argues that Biggs and Borden fail to teach obtaining handling rules from an “instant message server,” then Patron teaches the limitation. Pet. 48–57.

Patent Owner responds that Petitioner does not identify the specific grounds of invalidity, does not show that Biggs and Patron teach all the limitations, does not argue sufficiently a motivation to combine, and does not establish a reasonable expectation of success. Prelim. Resp. 2–3, 11–32.

For the reasons discussed below, Petitioner shows a reasonable likelihood of prevailing with respect to its challenge based on Biggs, Borden, and Patron.

1. Claims 1 and 2

Petitioner refers to previous arguments to contend that Biggs teaches the preamble and each of the limitations of claim 1 with additional citations to declarant testimony. Pet. 51, 52, 54–56. Petitioner also refers to previous arguments that Patron teaches the preamble and the limitations of claim 1. *Id.* at 51, 52, 54–56. Petitioner provides additional arguments with citations to the record that Patron teaches downloading a handling rule from an instant message server. *Id.* at 52–54. Petitioner also argues why one of ordinary skill in the art would have modified Biggs and Borden in view of Patron with support from declarant testimony. *Id.* at 51, 52, 54–56. For claim 2, Petitioner argues that Biggs in view of Borden and Patron teaches its limitation by referring to previous arguments regarding Biggs with citations to declarant testimony. *Id.* at 56.

Petitioner argues with citations to the record that one of ordinary skill in the art would have been motivated to combine Biggs with Borden and Patron. Pet. 49–50. According to Petitioner, Borden teaches detecting chat room violations even though participants use continually changing vocabulary through known AI technologies, and, thus, one of ordinary skill in the art would have been motivated to combine Biggs and Borden. *Id.* at 49–50 (citing Ex. 1005 ¶¶ 48, 77, 125; Ex. 1005 ¶¶ 29, 36). Petitioner also argues that Patron teaches making an IM system scale up with more users, thereby motivating an ordinary skilled artisan to combine Biggs with Patron. *Id.* at 50 (citing Ex. 1003 ¶¶ 135, 149; Ex. 1006, 3:44–4:16, 5:1–4, 6:62–67, 8:3–8). Petitioner further argues with declarant support that its “proposed combination would have been nothing more than the combination of prior art elements according to known methods to yield predictable results (a better IM monitoring system).” *Id.* at 51 (citing Ex. 1003 ¶ 192). Petitioner further argues that one of ordinary skill in the art would have had a reasonable expectation of success in making the combination with support from declarant testimony. *Id.*

Based on the arguments and citations to record evidence presented in the Petition, Petitioner shows a reasonable likelihood of prevailing with respect to at least one of the challenged claims in its obviousness challenge based on Biggs, Borden, and Patron.

Patent Owner provides the same responses summarized above for the previous challenges. See Prelim. Resp. 11–32. For similar reasons discussed for those challenges, on the preliminary record, Petitioner demonstrates a reasonable likelihood of showing that at least one of the claims is unpatentable.

III. CONCLUSION

After considering the evidence and arguments presented in the Petition and the preliminary record, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing in proving that at least one of claims 1 and 2 of the '521 patent is unpatentable, and thus, we institute an *inter partes* review of all challenged claims on all presented challenges. *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018).

At this stage of the proceeding, the Board has not made a final determination as to the patentability of any challenged claim or any underlying factual and legal issues.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1 and 2 of U.S. Patent No. 9,367,521 B2 is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of U.S. Patent No. 9,367,521 B2 shall commence on the entry date of this Order, and notice is hereby given of the institution of a trial.

IPR2022-00541
Patent 9,367,521 B2

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