

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KAHOOT! ASA and KAHOOT! EDU, INC.,
Petitioner,

v.

AVIEL D. RUBIN,
Patent Owner.

IPR2023-00693
Patent 9,064,376 B1

Before KEN B. BARRETT, KEVIN W. CHERRY, and
CYNTHIA L. MURPHY, *Administrative Patent Judges*.

MURPHY, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE
PATENT OWNER'S MOTION TO AMEND

I. INTRODUCTION

On September 8, 2023, we instituted trial as to claims 1–5, 9, 10, 12–17, and 23–25 of U.S. Patent No. 9,064,376 B1 (“the ’376 patent”). Paper 10. After institution, Patent Owner filed a Motion to Amend that is not contingent on the patentability of claims 1–5, 9, 10, 12–17, and 23–25. Paper 19 (“Mot.”). Petitioner filed an Opposition on February 23, 2024. Paper 20 (“Opp.”).

In the Motion, Patent Owner requested that we provide preliminary guidance concerning the Motion in accordance with the Board’s pilot program concerning motion to amend practice and procedures. Mot. 2; *see also* Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board, 84 Fed. Reg. 9,497 (Mar. 15, 2019) (providing a patent owner with the option to receive preliminary guidance from the Board on its motion to amend) (“Notice”). We have considered Patent Owner’s Motion and Petitioner’s Opposition.

In this Preliminary Guidance, we provide information indicating our initial, preliminary, non-binding views on whether Patent Owner has shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend in an *inter partes* review and whether Petitioner (or the record) establishes a reasonable likelihood that the substitute claims are unpatentable. *See* Notice, 84 Fed. Reg. at 9,497 (“The preliminary guidance . . . provides preliminary, non-binding guidance from the Board to the parties about the [motion to amend]”); *see also* 35 U.S.C. § 316(d) (statutory requirements for a motion to amend); 37 C.F.R. § 42.121 (regulatory requirements and burdens for a motion to amend); *Lectrosonics, Inc. v Zaxcom, Inc.*, IPR2018-

01129, Paper 15 (PTAB Feb. 25, 2019) (precedential) (providing information and guidance regarding motions to amend).

For purposes of this Preliminary Guidance, we focus on the proposed substitute claims, and specifically on the amendments proposed in the Motion. *See* Notice, 84 Fed. Reg. at 9,497. We do not address the patentability of the originally challenged claims. *Id.* Moreover, in formulating our preliminary views on the Motion and Opposition, we have not considered the parties' other substantive papers on the underlying merits of Petitioner's challenges. We emphasize that the views expressed in this Preliminary Guidance are subject to change upon consideration of the complete record, including any revision to the Motion filed by Patent Owner. Thus, this Preliminary Guidance is not binding on the Board when rendering a final written decision. *See id.* at 9,500.

II. PRELIMINARY GUIDANCE

A. Statutory and Regulatory Requirements

For the reasons discussed below, at this stage of the proceeding, and based on the current record, it appears that Patent Owner has not shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend.

1. Reasonable Number of Substitute Claims

Does Patent Owner propose a reasonable number of substitute claims? (35 U.S.C. § 316(d)(1)(B))
Yes. Patent Owner proposes no more than one substitute claim for each of challenged claims 1–5, 9, 10, 12–17, and 23–25. Mot. 2; <i>see id.</i> at App. A. Petitioner does not argue otherwise. <i>See generally</i> Opp.

2. Respond to Ground of Unpatentability

Does the Motion respond to a ground of unpatentability involved in the trial? (37 C.F.R. § 42.121(a)(2)(i))

Yes.

Patent Owner's Motion responds to the grounds of unpatentability on which we instituted trial—that Zha¹ in view of POSITA's knowledge,² or in view of POSITA's knowledge and Tsushima,³ would have rendered challenged claims 1–4, 9, 13, 14, 16, and 23–25 obvious; and Takahashi⁴ in view of POSITA's knowledge, or in view of POSITA's knowledge and Tsushima, would have rendered challenged claims 1–5, 9, 10, 12–14, 16, 17 and 23–25 obvious. Mot. 3, 11–19. Upon review of Patent Owner's Motion, we agree that proposed substitute independent claims 26 and 41 recite new elements constituting a *bona fide* response to the instituted grounds of unpatentability. *See id.* For example, proposed substitute independent claims 26 and 41 each newly recite “using application specific authentication information,” and “wherein the application specific authentication information used on the first device is different from the application specific authentication information used on the second device.” *Id.* at App. A 3, 8. Patent Owner argues that these limitations are not disclosed in Zha, Tsushima, or Takahashi. Mot. 13–14, 15, 16–18. Because Patent Owner explicitly addresses the Zha, Tsushima, and Takahashi references underlying our Decision on Institution, the Motion responds to at least one ground of unpatentability involved in the trial. *Id.* We also agree that proposed substitute dependent claims 27–40 recite new elements at least in view of their dependency on independent claim 26—constituting a *bona fide* response to the instituted ground of unpatentability. Petitioner does not argue otherwise. *See generally* Opp.

¹ US 9,497,565 B1, filed Feb. 10, 2015, issued November 15, 2016, foreign priority date Dec. 11, 2013 (“Zha,” Ex. 1004).

² “POSITA” refers to a “person of ordinary skill in the art.”

³ US 2014/0006485 A1, filed May 22, 2013, published January 2, 2014 (“Tsushima,” Ex. 1010).

⁴ US 2015/0011318 A1, filed Nov. 27, 2012, published January 8, 2015 (“Takahashi,” Ex. 1007).

3. Scope of Amended Claims

Does the amendment seek to enlarge the scope of the claims? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))

No.

Each of the proposed substitute claims include narrowing limitations.

For example, proposed substitute independent claims 26 and 41 are narrower than their corresponding original claims 1 and 25, respectively, because they newly recite that the first user is “being logged into the application using application specific authentication information at both the first and second devices, wherein the application specific authentication information used on the first device is different from the application specific authentication information used on the second device” rather than “being logged into the application at both the first and second devices.” *Compare* Mot., App. A 3, 8 *with* Ex. 1001, 15:30–31, 17:19–20.

As another example, proposed substitute claim 30 is narrower than its corresponding original claim 5 at least because it newly recites “providing a notification by the application on the second device” rather than “providing a notification on the second device.” *Compare* Mot., App. A 5 *with* Ex. 1001, 15:54.

Similarly, proposed substitute claim 35 is narrower than its corresponding original claim 14 at least because it adds a new limitation, “further comprising displaying a graphical identifier on the first device and a corresponding graphical indicator on the second device indicating a link between the information displayed on the respective devices.” *Compare* Mot., App. A 6 *with* Ex. 1001, 16:25–27.

As such, proposed substitute claims 26–41 add limitations as compared to the corresponding original claims, and therefore, do not enlarge the scope of challenged claims 1–5, 9, 10, 12–17, and 23–25. Mot. 3; *see id.* at App. A. Proposed substitute claims 27–29, 31–34, and 36–40 merely change the dependency of challenged claims 2–4, 9, 10, 12, 13, 15–17, 23, and 24 of the ’376 patent. *Id.* at 3; *see id.* at App. A. Petitioner does not argue otherwise. *See generally* Opp.

4. New Matter

Does the amendment seek to add new subject matter? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))

No, as to substitute claims 26–29, 31–34, and 36–41. On this record, Patent Owner appears to have identified adequate written description support for proposed substitute claims 26–29, 31–34, and 36–41 in the specification of U.S. Patent Application No. 14/444,995 (Ex. 2005, “the ’995 application”). *See* Mot. 3–7.

Petitioner asserts that the term “application specific authentication information” recited in proposed substitute claims 26 and 41 is not found in the original ’376 patent specification and Patent Owner has not offered a claim construction for the term. Opp. 2–3 (citing Ex. 2005). Petitioner argues that none of the portions of the original specification identified by Patent Owner provides written description support for the term “application specific authentication information.” Opp. 3–6.

We tend not to agree with Petitioner’s argument based on the current record. It is true that the term “application specific authentication information” does not appear in the ’995 application, but there nevertheless appears to be adequate written description support for “application specific authentication information,” “wherein the application specific authentication information used on the first device is different from the application specific authentication information used on the second device,” as recited in substitute claims 26 and 41. *See, e.g.*, Mot. 4, 7 (citing Ex. 2005 ¶¶ 26, 33, 75, 83, 89, 90, 92, Figure 10).

For example, as cited by Patent Owner, Figure 10 of the ’995 application and its associated description appear to provide support for the term because they show hashes of different passwords of a particular user for logging into a banking application on different devices, e.g., a first device and a second device. *See* Ex. 2005, Figure 10, ¶ 75; Mot. 4, 7 (citing the same). The ’995 application explains:

When a user submits a password on a device, the device hashes the password and sends the hash to the central server over a secure connection (e.g., SSL). The central server extracts the stored password from the database shown in the figure and compares the two. If they match, then *authentication is successful*.

Ex. 2005 ¶ 75 (emphasis added). The '995 application also describes “[a]pplication-specific components of an online application” as including “functions within the application that are specific to that application.” Ex. 2005 ¶ 72 (emphasis added). As such, it appears that a POSITA would have understood that the different passwords of a particular user for logging into a banking application on the first and second devices as described in the '995 application correspond to “application specific authentication information,” “wherein the application specific authentication information used on the first device is different from the application specific authentication information used on the second device” as recited in substitute claims 26 and 41.

For at least these reasons, on this record, it does not appear that the amendments in claims 26–41 seek to add new subject matter based on “application specific authentication information.”

Claim Construction: “Application Specific Authentication Information”

For purposes of this Preliminary Guidance, we provide our preliminary construction of the term “application specific authentication information,” which appears to be in dispute between the parties.

Proposed substitute claims 26 and 41 recite “application specific authentication information,” “wherein the application specific authentication information used on the first device is different from the application specific authentication information used on the second device.” Mot. 3, 8. As explained above, while it is true that the term “application specific authentication information” does not appear in the '995 application, there appears to be adequate written description support in the specification for the limitation.

While the parties dispute whether the asserted prior art discloses or suggests “application specific authentication information,” neither Patent Owner nor Petitioner appears to provide a construction of the term. *See generally* Mot. 13–18; Opp. 16–22.

Based on the current record, we give the term “application specific authentication information” its ordinary and customary meaning as would have been understood by one of ordinary skill in the art in the context of the entire patent, including the specification. *See* 37 C.F.R. § 42.100(b); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–14 (Fed. Cir. 2005) (*en*

banc). As noted above, the '995 application describes “[a]pplication-specific components of an online application” as including “functions within the application that are *specific to that application*.” Ex. 1001, 9:29–32 (emphasis added); *see also* Ex. 2005 ¶ 72. In view of the foregoing, we preliminarily construe the term “application specific authentication information” as information for authentication that is specific to an application. This appears to be consistent with the embodiment discussed above, where a user submits a password for logging into a banking application (i.e., information for authentication that is specific to an application) on, e.g., the first device, and authentication is successful if the submitted password and the stored password match. *See* Ex. 1001, 9:65–10:22, Figures 9–10; *see also* Ex. 2005 ¶¶ 74–75, Figures 9–10.

We emphasize that our construction of “application specific authentication information” is preliminary, and invite the parties to address this issue, as well as issues that depend on this preliminary construction, in further briefing and/or in a revised motion.

Yes, as to substitute claims 30 and 35. On this record, Patent Owner does not appear to have identified adequate written description support for proposed substitute claims 30 and 35 in the Specification of the '995 application. *See* Mot. 5–6.

Regarding substitute dependent claim 30, Patent Owner proposes to amend the “providing” step by adding the underlined feature as follows:

“providing a notification by the application on the second device”

Mot., App. A 5. Patent Owner asserts that support for the amended limitation is provided in the '995 application. Mot. 5 (citing Ex. 2005 ¶ 33, claim 5 at 28). Regarding substitute dependent claim 35, Patent Owner proposes to amend original claim 14, *inter alia*, to depend from substitute claim 30, thus incorporating all the limitations of substitute claim 30. Mot., App. A 6.

Petitioner argues that “the application on the second device” lacks antecedent basis since substitute claim 26, from which substitute claim 30 depends, recites an “application at the server.” Opp. 6. Petitioner also argues that none of the portions of the '995 application identified by Patent Owner provides written description support for “the application on the second device.” Opp. 6–7.

On the current record, and in accord with our preliminary construction of substitute claim 30, we tend to agree with Petitioner that “the application on the second device” does not appear to have written description support from the portions of the ’995 application identified by Patent Owner because none of them appears to describe the application on the second device, let alone providing a notification by the application on the second device. *See* Ex. 2005 ¶ 33, claim 5 at 28. Furthermore, we tend to agree with Petitioner that “the application on the second device” recited in substitute dependent claim 30 does not appear to have antecedent basis because, as Petitioner points out, substitute claim 26, from which substitute claim 30 depends, indirectly recites “the same application at the server,” not an application on the second device. *Compare* Mot., App. A 5 (“the application on the second device” in substitute claim 30) *with id.* at App. A 3 (“the same application at the server” in substitute claim 26).

For at least these reasons, on this record, it appears that the amendments in claims 30 and 35 seek to add new subject matter based on “the application on the second device.”

We emphasize that our construction of “providing a notification by the application on the second device” is preliminary, and invite the parties to address this issue, as well as issues that depend on this preliminary construction, in further briefing and/or in a revised motion.

We acknowledge that Patent Owner has not yet had the opportunity to respond to Petitioner’s contention that proposed substitute claims 30 and 35 add new subject matter. Patent Owner will have the opportunity to do so in its reply to Petitioner’s Opposition (or in a revised motion) in this proceeding. Further, in a reply or a revised motion, we advise Patent Owner to further explain how the cited portions of the original disclosure support the limitations of the proposed substitute claims.

B. Patentability

For the reasons discussed below, at this stage of the proceeding, and based on the current record,⁵ it appears that Petitioner has shown a reasonable likelihood that proposed substitute claims 26–41 are unpatentable.

Does the record establish a reasonable likelihood that the proposed substitute claims are unpatentable?

Yes.

The record appears to establish a reasonable likelihood that (i) proposed substitute claims 30 and 35 are indefinite; and (ii) each of proposed substitute claims 26–41 would have been obvious based on at least one ground.

I. Indefiniteness

Yes, as to proposed substitute claims 30 and 35 based on “the application on the second device” recited in substitute claim 30.

Petitioner contends that the phrase “providing a notification by the application on the second device” recited in substitute claim 30 is indefinite under 35 U.S.C. § 112(a). Opp. 8–9. Petitioner argues that it lacks antecedent basis, rendering it indefinite, and is also “ambiguous because it is unclear whether the ‘the application’ is on the server or on the second device.” *Id.*

As discussed above in our discussion of whether the amendments to substitute claims 30 and 35 encompass new matter, we tend to agree with Petitioner that the phrase “the application on the second device” does not appear to have antecedent basis because, as Petitioner points out, substitute claim 26, from which substitute claim 30 depends, indirectly recites “the same application at the server,” not an application on the second device. *Compare* Mot. at App. A 5 (“the application on the second device” in

⁵ We express no view on the patentability of original claims 1–5, 9, 10, 12–17, and 23–25 in this Preliminary Guidance. Instead, we focus on limitations added to those claims in Patent Owner’s Motion to Amend.

substitute claim 30) *with id.* at App. A 3 (“the same application at the server” in substitute claim 26). As such, we also tend to agree with Petitioner that it is unclear whether the “the application” recited in substitute claim 30 is at the server, as recited in substitute claim 26, from which substitute claim 30 depends, or on the second device, as recited in substitute claim 30, rendering its scope ambiguous. *See* Opp. 8–9.

A patent claim is indefinite when that claim, “viewed in light of the specification and prosecution history, [does not] inform those skilled in the art about the scope of the invention with reasonable certainty.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 910 (2014). In view of the foregoing preliminary analysis, substitute claims 30 and 35, encompassing “the application on the second device,” appear to fail this test and thus appear to be indefinite.

We emphasize again that our construction of “providing a notification by the application on the second device” is preliminary, and invite the parties to address this issue, as well as issues that depend on this preliminary construction, in further briefing and/or in a revised motion.

No, as to proposed substitute claims 26–29, 31–34, and 36–41 based on “application specific authentication information” recited in substitute independent claims 26 and 41.

Petitioner contends that the term “application specific authentication information” is indefinite under 35 U.S.C. § 112(a). Opp. 7. Petitioner asserts that “[t]his is a new term that is not found in the patent, and [Patent Owner] does not offer a claim construction.” *Id.* Relying on Patent Owner’s alleged argument that “device specific” information cannot be “application specific,” Petitioner argues that Patent Owner “provides no meaningful contours to the new term and uses it in contradictory ways,” and therefore “the term fails to inform a POSITA of its scope.” *Id.* at 7–8.

We tend not to agree with Petitioner’s argument based on the current record. As explained above, while the term “application specific authentication information” does not appear in the specification, the specification appears to describe an example of the “application specific authentication information” as would be understood by one of ordinary skill in the art. As such, it appears that the substitute limitation of “application specific authentication information,” “viewed in light of the specification and prosecution history, inform[s] those skilled in the art

about the scope of the invention with reasonable certainty.” *Nautilus*, 572 U.S. at 910.

At this stage in the proceeding and on this record, Petitioner has not shown that proposed substitute claims 26–29, 31–34, and 36–41 are indefinite based on “application specific authentication information” recited in substitute independent claims 26 and 41.

We emphasize again that our construction of “application specific authentication information” is preliminary, and invite the parties to address this issue, as well as issues that depend on this preliminary construction, in further briefing and/or in a revised motion.

II. Obviousness

Yes.

Petitioner asserts that proposed substitute claims 26–41 are unpatentable under 35 U.S.C. § 103 for obviousness based on the following grounds:

- (1) Proposed substitute claims 26–29, 31, 34, 40, and 41 would have been obvious in view of newly cited prior art, Kling,⁶ and a POSITA’s knowledge. Opp. 12–16.
- (2) Proposed substitute claims 26–41 would have been obvious in view of the Zha Grounds (i.e., Grounds 1–6, *see* Paper 10, 10–11) and the POSITA’s additional general knowledge that an application can require two different passwords for the same user accessing the application from different devices. Opp. 16–20.
- (3) Proposed substitute claims 26–41 would have been obvious in view of the Zha Grounds (i.e., Grounds 1–6, *see* Paper 10, 10–11) in combination with Kling. Opp. 20.
- (4) Proposed substitute claims 26–35 and 37–41 would have been obvious in view of the Takahashi Grounds (i.e., Grounds 7–8, *see* Paper 10, 11) alone or in combination with the POSITA’s additional general knowledge that an application can require two different passwords where the same user accesses it from different devices. Opp. 20–24.

⁶ US 2012/0240203 A1, filed March 16, 2011, published September 20, 2012 (“Kling,” Ex. 1023).

(5) Proposed substitute claims 26–35 and 37–41 would have been obvious in view of the Takahashi Grounds (i.e., Grounds 7–8, *see* Paper 10, 11) in combination with Kling. Opp. 24.

On this record, it appears that Petitioner has shown a reasonable likelihood that each of the substitute claims is obvious based on at least one ground.

Claims 26–29, 31, 34, 40, and 41: Obviousness over Kling

Proposed Substitute Independent Claims 26 and 41

No.

Proposed substitute independent claims 26 and 41 replace original independent claims 1 and 25, respectively, and add new elements. *See* Mot. 2, App. A 3–4, 7–8.

In particular, proposed substitute independent claim 26 amends original claim 1 to recite:

[[1.]] 26. (Substitute for Claim 1) [26Pre]⁷ A method for transmitting information to multiple electronic devices, the method comprising:

[26a] electronically storing a set of information at a server;

[26b] identifying a first subset of the information and identifying a second subset of the information, wherein the first and second subsets of information are generated by the same application at the server and are specific to that application;

[26c] determining at the server whether both a first device in possession of and being directly operated by a first user and a second device also in possession of and being directly operated by the first user are accessible over at least one electronic communications network based on the first user being logged into the application using application specific authentication information at both the first and second devices, wherein the application specific authentication information used on the first device is different from

⁷ Substitute independent claim 26 is reproduced with annotations (brackets) inserting Patent Owner’s identifiers of claim limitations. *See* Mot. 4–7.

the application specific authentication information used on the second device;

[26d] if and only if both the first and second devices are determined to be accessible by the server, then:

transmitting [[a]] the first subset of the information to the first device from the server; and

transmitting [[a]] the second subset of the information to the second device from the server,

wherein the second subset of the information includes information not transmitted to the first device.

Mot., App. A 3–4.

Proposed substitute independent claim 41, as amended from original claim 25, is a system counterpart to substitute independent claim 26 and recites amendments substantially identical to those proposed for claim 26. *See id.* at App. A 7–8.

In the Opposition, Petitioner contends that substitute independent claims 26 and 41 are obvious in view of Kling and a POSITA’s knowledge. Opp. 12–13, 15–16.

As for limitation [26c] which includes new elements “using application specific authentication information” and “wherein the application specific authentication information used on the first device is different from the application specific authentication information used on the second device,” Petitioner contends that they are “disclosed by the server requiring the user to login at both the PC and the phone using passwords (application specific authentication information), ‘ideally using a different password [on the phone] than on the PC.’” Opp. 13 (quoting Ex. 1023 ¶ 18).

Based on, at least, Figure 4 of Kling, which is reproduced below, and the cited and other paragraphs of Kling, we tend to agree with Petitioner’s contention that Kling discloses limitation [26c], including “application specific authentication information . . . wherein the application specific authentication information used on the first device is different from the application specific authentication information used on the second device.”

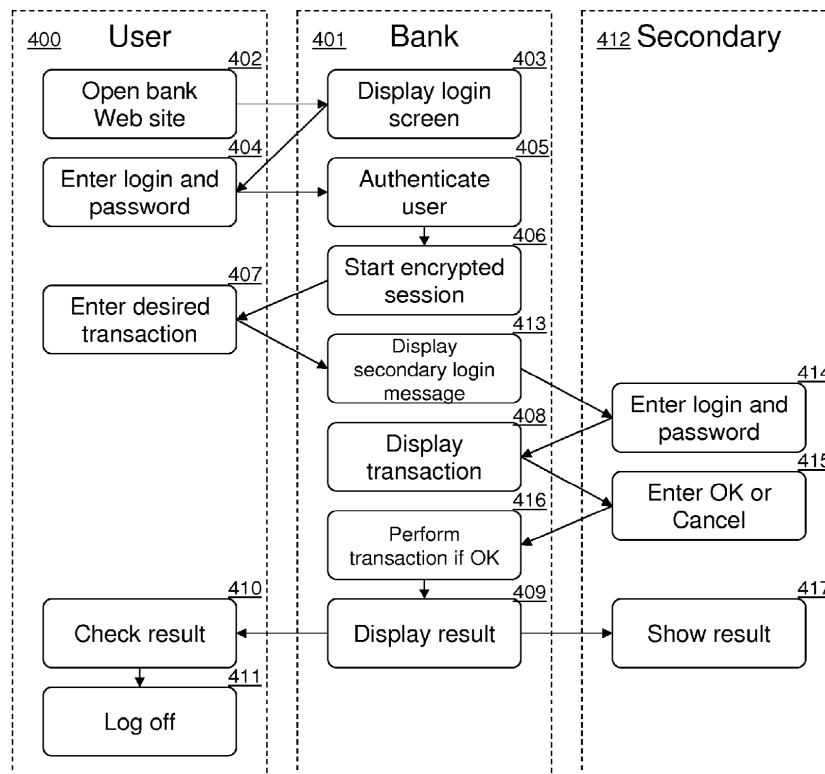


FIG. 4

Kling teaches requiring the user to “approve a specific secure transaction on a mobile device in addition to the original transaction performed on a PC.” Ex. 1023 ¶ 7. Figure 4 shows that a user enters a password (at step 404) for a bank Web site on a first device 400 (e.g., PC) to initiate a desired transaction. *See id.* ¶ 17; *see also id.* ¶ 14. Figure 4 also shows that the user is further prompted to enter a password (at step 414) on a second device 412 (e.g., mobile device) as secondary authentication. *See id.* ¶ 17. Kling teaches that “[t]ypically the user would be prompted to log into the mobile device, ideally using a different password than on the PC.” *Id.* ¶ 18. Petitioner’s reading of Kling appears to be consistent with our preliminary construction of “application specific authentication information” because the user’s password in Kling appears to correspond to information for authentication (e.g., a different password for secondary authentication) that is specific to an application (e.g., a bank Web site).

As for the other limitations of claim 26, rather than citing or quoting the relevant portions of Kling as disclosing or suggesting them, Petitioner mostly relies on the declaration of its expert, Dr. Meldal, which includes citations to Kling. *See generally* Opp. 12–13 (citing Ex. 1027 ¶¶ 73–78, 79–107, 125–139). This appears to be improper incorporation by reference

in violation of the Board's rule. *See* 37 C.F.R. § 42.6(a)(3). Furthermore, lack of supporting cites to evidence for many of Petitioner's arguments presented in the Opposition leaves us to guess at how Petitioner intends to prove that Kling discloses or suggests each claim element. *See generally* Opp. 12–13.

Although we recognize that Kling appears to disclose the amended limitation of substitute independent claims 26 and 41 as contended by Petitioner, at this stage of the proceeding, Petitioner does not appear to show a reasonable likelihood that Kling renders obvious the subject matter of proposed substitute independent claims 26 and 41, due to the defective format of its Opposition.

Proposed Substitute Dependent Claims 27–29, 31, 34, and 40

No.

Proposed substitute dependent claims 27–29, 31, 34, and 40 replace original dependent claims 2–4, 9, 13, and 24, respectively. *See* Mot. 2, App. A 4, 5, 7. They do not include any new limitations, aside from their dependency on proposed substitute independent claim 26. *See id.* at App. A 4, 5, 7.

At this stage of the proceeding, we find that Petitioner's Opposition does not appear to show a reasonable likelihood that Kling renders obvious the subject matter of proposed substitute dependent claims 27–29, 31, 34, and 40 because of Petitioner's failure to do so for proposed substitute independent claims 26 and 41, from which these claims depend, as explained above.

Claims 26–41: Obviousness in view of Zha Grounds and Kling

In our Institution Decision, we determined that Petitioner had demonstrated a reasonable likelihood of prevailing in its challenge to:

- Claims 1–4, 9, 13, 14, 16, and 23–25 as being rendered obvious over Zha, when viewed in the context of POSITA's knowledge (Ground 1);
- Claims 1–4, 9, 13, 14, 16, and 23–25 as being rendered obvious over Zha and Tsushima, when viewed in the context of POSITA's knowledge (Ground 2);

- Claims 5 and 15 as being rendered obvious over Zha and Gumbula,⁸ when viewed in the context of POSITA’s knowledge (Ground 3);
- Claims 5 and 15 as being rendered obvious over Zha, Tsushima, and Gumbula, when viewed in the context of POSITA’s knowledge (Ground 4);
- Claim 10 as being rendered obvious over Zha and Stafford,⁹ when viewed in the context of POSITA’s knowledge (Ground 5); and
- Claim 10 as being rendered obvious over Zha, Tsushima, and Stafford, when viewed in the context of POSITA’s knowledge (Ground 6).

Paper 10, 10–11, 16–20 (Grounds 1–6, collectively “Zha Grounds”). Here, Petitioner contends that the subject matter of proposed substitute claims 26–41 would have been obvious in view of the Zha Grounds, in combination with POSITA’s additional general knowledge that an application can require two different passwords for the same user accessing the application from different devices or with Kling. Opp. 16, 20.

Proposed Substitute Independent Claims 26 and 41

Yes.

Patent Owner contends that neither Zha nor Tsushima is analogous art. Mot. 19–22. Patent Owner asserts that “[t]he field of endeavor for the ’376 [p]atent is online security,” and neither Zha nor Tsushima relates to online security. *Id.* at 20–22. Patent Owner also asserts that Zha and Tsushima attempt to solve different problems than the ’376 patent. *Id.* at 21–22.

Based on the current record, we are not persuaded by Patent Owner’s argument that Zha and Tsushima are not analogous art. Patent Owner appears to be viewing the fields of endeavor for the ’376 patent, Zha, and Tsushima too narrowly. “The field of endeavor of a patent is not limited to the specific point of novelty, the narrowest possible conception of the field, or the particular focus within a given field.” *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1001 (Fed. Cir. 2016). Here, Zha and

⁸ US 9,591,083 B1, filed November 23, 2005, issued March 7, 2017 (“Gumbula,” Ex. 1011).

⁹ US 2012/0017236 A1, filed July 13, 2010, published January 19, 2012 (“Stafford,” Ex. 1012).

Tsushima are in the same field of endeavor as the claimed invention because they also relate to a system or method in which a user interacts with “a first [electronic] device and a second [electronic] device throughout the use of an online application.” Ex. 1001, 2:29–31. Based on the current record, we are also persuaded by Petitioner’s argument that Patent Owner is wrong to assert that the prior art must address the same problem as the ’376 patent. *See* Opp. 24 (citing *Ex parte Talkowski*, Appeal No. 2012-002290 (PTAB May 24, 2013) (informative)).

Regarding limitation [26c] which includes new elements “using application specific authentication information” and “wherein the application specific authentication information used on the first device is different from the application specific authentication information used on the second device,” Patent Owner argues that “Zha does not mention or disclose the use of authentication information that is ‘application specific’ and that the application specific authentication information is different for determining login to the application at the first and second devices.” Mot. 13 (citing Ex. 2004 ¶ 52).

Petitioner disagrees and argues that “password authentication for an application like *Zha*’s microblog (e.g., Facebook) is ‘application specific,’” and “it was well known by 2014 . . . that two different passwords could be used for different devices accessing the same account” as “evidenced by *Kling*’s disclosure (discussed above), and by U.S. Patent No. 7,865,950 (*Lipetz*).” Opp. 19 (citing Ex. 1027 ¶ 163; Ex. 1026, 72:4–9), 16 (citing Ex. 1027 ¶¶ 144–149).

Petitioner further contends that “it would be obvious to combine *Kling*’s use of multiple/different passwords with *Zha*’s microblog application.” Opp. 20 (citing Ex. 1027 ¶¶ 180–181). Petitioner contends that “*Kling* provides the motivation to modify *Zha*’s system (to protect against malware).” *Id.*; *see also id.* at 16 (“[*Kling* and *Lipetz*] both provide a motivation to combine a POSITA’s knowledge of using different passwords with *Zha*’s microblog—i.e., to enhance security against malware in that system.”) (citing Ex. 1027 ¶ 151). Petitioner also contends that “a POSITA would have a reasonable expectation of success in making this modification because, by 2014, implementing a password login authentication scheme was trivial.” *Id.* (citing Ex. 1027 ¶¶ 180–181, 173–179, 152–154).

For purposes of this Preliminary Guidance and based on the current record, we are persuaded by Petitioner’s argument that the combination of *Zha* and

Kling teaches this amended limitation. We find Patent Owner’s argument that Zha does not teach “application specific authentication information” unpersuasive because Zha disclosing a user logging in to the account of a microblog application program through two or more terminals appears to correspond to providing information for authentication that is specific to the microblog application, consistent with our preliminary construction of the term “application specific authentication information” discussed above. *See also* Opp. 18–19. We also find that Petitioner’s rationale for the combination, applying Kling’s use of multiple/different passwords to Zha’s microblog application, appears to be reasonable because the combination would appear to have improved Zha’s microblog application by enhancing security against malware in that system.

Proposed substitute independent claims 26 and 41 are not modified from their corresponding original claims 1 and 25, except for the above discussed amended limitation involving “application specific authentication information.” *See* Mot., App. A 3–4, 7–8. As discussed in our Decision to Institute, Petitioner had demonstrated a reasonable likelihood that Zha, or the combination of Zha and Tsushima, discloses or suggests all the limitations of original claims 1 and 25. Paper 10, 16–20.

Accordingly, at this stage of the proceeding and based on the current record, it appears that Petitioner has shown a reasonable likelihood that proposed substitute claims 26 and 41 are unpatentable under 35 U.S.C. § 103 as obvious over at least the combination of Zha and Kling, or Zha, Tsushima, and Kling.

Proposed Substitute Dependent Claims 27–29, 31, 32, 34, 36, 37, 39, and 40

Yes.

Claim Construction: “Sensitive Information”

For purposes of this Preliminary Guidance, we provide our preliminary construction of the term “sensitive information,” which appears to be in dispute between the parties.

Proposed substitute claims 28 and 37 recite “sensitive information.” Mot., App. A 4, 6. Patent Owner proposes to construe the term “sensitive information” found in substitute claims 28, 30, 35, 37, and 38 to mean “information that will not be automatically shared with the first device.”

Mot. 8. Patent Owner asserts that “[t]he claims of the ’376 [p]atent teach that ‘sensitive information’ is information shared with the second device” since the claims “unmistakably teach that ‘sensitive information’ is delivered to the second device.” *Id.* at 9 (citing Ex. 1001, 15:43–45 (original claim 3), 16:35–39 (original claim 16)). Patent Owner also asserts that “[t]he specification teaches that with respect to the claimed invention, ‘sensitive information’ is information that an application practicing the ’376 [p]atent should not automatically share with the first device out of concern the first device may be compromised by malware.” *Id.* For example, Patent Owner refers to the description of a game server communicating the user’s hole cards to the second device, but not to the first device. *See id.* at 9–10 (citing Ex. 2005 ¶¶ 23, 31).

Petitioner disagrees and argues that Patent Owner’s proposed construction of “sensitive information” improperly imports limitations from the specification. Opp. 9. Petitioner also argues that Patent Owner’s proposed construction contradicts specification embodiments, pointing to “an embodiment where sensitive information (e.g., hole cards) is shared automatically with the first device when the second device is not present.” *Id.* at 10 (referring to Ex. 1001, 4:10–12, Figure 7 (step 718)). Petitioner also argues that Patent Owner’s proposed construction of “sensitive information” renders substitute claim 29, which recites “information that ‘is *more sensitive* than the information received at the first device,’” non-sensical. *Id.* (emphasis in original). Petitioner does not appear to provide a separate construction of “sensitive information.” *See generally id.* at 9–11.

Based on the current record, we tend to agree with Petitioner’s argument that Patent Owner’s proposed construction of “sensitive information” improperly imports limitations from the specification, and is inconsistent with at least one embodiment described in the specification as well as the claim language “more sensitive” recited in substitute claim 29. *See* Opp. 9–10. Accordingly, for purposes of this Preliminary Guidance, we decline to adopt Patent Owner’s proposed construction of “sensitive information” and instead give the term its ordinary and customary meaning as would have been understood by one of ordinary skill in the art. *See, e.g.,* Ex. 3002, Margaret Rouse, *Sensitive Information*, TECHOPEDIA, <https://www.techopedia.com/definition/25260/sensitive-information#> (last updated Sept. 26, 2012) (last visited Mar. 6, 2024) (“Sensitive information refers to privileged or proprietary information that only certain people are allowed to see and that is therefore not accessible to everyone.”).

We emphasize that our construction of “sensitive information” is preliminary, and invite the parties to address this issue, as well as issues that depend on this preliminary construction, in further briefing and/or in a revised motion.

Patent Owner argues that Zha does not disclose “sensitive information,” which is recited in substitute claims 28 and 37. Mot. 14. Patent Owner asserts that Zha’s private messages sent via the microblog’s private message interface are not the claimed sensitive information because they are not “(i) **generated by the application** (ii) **at the server** and (iii) **specific to the application.**” *Id.* (citing Ex. 2004 ¶ 63) (emphasis in original). Patent Owner also asserts that Zha’s private messages are not equivalent to “sensitive information” because “Zha’s disclosure of a ‘private message application’ as part of a microblog is simply describing the ‘direct messaging’ (or ‘DM’) component of a microblog such as Facebook or Twitter.” *Id.* (citing Ex. 2004 ¶ 64).

Based on the current record, we find Patent Owner’s argument unpersuasive because it appears to be inconsistent with our preliminary construction of “sensitive information” discussed above. Patent Owner’s argument appears to be based on its overly narrow construction of “sensitive information,” which, as explained above, we decline to adopt at this time for purposes of this Preliminary Guidance. *See* Mot. 8–10. Petitioner’s argument that the claimed sensitive information is not required to be (i) generated by the application (ii) at the server and (iii) specific to the application appears to be more reasonable and consistent with our preliminary construction of “sensitive information.” *See* Opp. 19–20. As for the sensitive information being “specific to the application,” proposed substitute independent claim 26 (from which claims 28 and 37 depend), sets forth that “the first and second subsets of information are generated by the same application at the server and are specific to that application.” Mot., App. A 4, 3. As pointed out by Petitioner this requirement could relate “only to the ‘subsets’ of information,” not the information contained in the subsets themselves. Opp. at 19.

Proposed substitute claims 27–29, 31, 32, 34, 36, 37, 39, and 40 depend from claim 26 and do not otherwise amend the language of their corresponding original claims. Accordingly, at this stage of the proceeding

and based on the current record, it also appears that Petitioner has shown a reasonable likelihood that proposed substitute claims 27–29, 31, 32, 34, 36, 37, 39, and 40 are unpatentable under 35 U.S.C. § 103 as obvious over at least the Zha Grounds in combination with Kling.

Proposed Substitute Dependent Claims 30 and 35

Yes.

Proposed substitute claim 30 is amended to (i) depend from substitute claim 28 (corresponding to original claim 3), and (ii) include “by the application” in the “providing” step. Mot., App. A 4–5. As discussed above, it appears that Petitioner has shown sufficiently that proposed substitute claim 30 is indefinite based on “the application on the second device” recited in substitute claim 30. *See* Opp. 8–9. As for the remaining limitations (corresponding to original claims 3 and 5), as discussed in our Decision to Institute, Petitioner had demonstrated a reasonable likelihood that the combination of Zha and Gumbula, or the combination of Zha, Tsushima, and Gumbula, discloses or suggests them. Paper 10, 10–11, 20; *see also* Opp. 17–18.

Proposed substitute claim 35 is amended to (i) depend from substitute claim 30 (corresponding to original claims 3 and 5), and (ii) include the following additional step: “further comprising displaying a graphical identifier on the first device and a corresponding graphical indicator on the second device indicating a link between the information displayed on the respective devices.” Mot., App. A 6. We note that this amended limitation appears to be identical to the limitation recited in substitute claim 32 (corresponding to original claim 10). *Compare id. with id.* at App. A 5. As discussed in our Decision to Institute, Petitioner had demonstrated a reasonable likelihood that the combination of Zha and Stafford, or the combination of Zha, Tsushima, and Stafford, discloses or suggests the limitations of original claim 10. Paper 10, 11, 20; *see also* Opp. 18. As discussed above, Petitioner had also demonstrated a reasonable likelihood that the combination of Zha and Gumbula, or the combination of Zha, Tsushima, and Gumbula, discloses or suggests the limitations of original claims 3 and 5. Paper 10, 10–11, 20.

Petitioner contends that “[a] POSITA would be motivated to combine *Gumbula* with *Zha*’s private messaging interface . . . and would be motivated to combine *Stafford* with *Zha*’s game interface.” Opp. 18.

Petitioner further contends that “[b]ecause *Gumbula* and *Stafford* modify different interfaces in *Zha*, a POSITA understands that they would not interfere with each other or otherwise impair the resulting system,” and “would reasonably expect success for this combination because it is the use of known technique (heartbeat messages in *Gumbula* and graphical indicators/identifiers in *Stafford*) to improve similar devices (messaging interfaces and game interfaces) in the same way (providing notification of connection disruption for messaging and a visual link between two devices for gaming).” *Id.* (citing Ex. 1027 ¶¶ 159–162). Based on the current record, we find that Petitioner’s rationale for the combination, applying *Gumbula* and *Stafford* to modify different interfaces in *Zha*, appears to be reasonable.

In addition, substitute claim 35 appears to be indefinite based on its dependency from substitute claim 30, which appears to be indefinite as discussed above. *See* Opp. 18.

Accordingly, at this stage of the proceeding and based on the current record, it appears that Petitioner has shown a reasonable likelihood that (i) proposed substitute claim 30 is unpatentable under 35 U.S.C. § 103 as obvious over at least the combination of *Zha*, *Gumbula*, and *Kling*, or the combination of *Zha*, *Tsushima*, *Gumbula*, and *Kling*; and (ii) proposed substitute claim 35 is unpatentable under 35 U.S.C. § 103 as obvious over at least the combination of *Zha*, *Gumbula*, *Stafford*, and *Kling*, or the combination of *Zha*, *Tsushima*, *Gumbula*, *Stafford*, and *Kling*, to the extent the scopes of substitute claims 30 and 35 are discernible. This preliminary obviousness conclusion assumes that claims 30 and 35 cover scenarios where the application is either on the server or the second device.

Proposed Substitute Dependent Claims 33 and 38

No.

We note that Petitioner did not challenge original claims 12 and 17 based on the *Zha* Grounds. *See* Pet. 6–47; Paper 10, 10–11. Petitioner does not appear to provide separate analysis in the Opposition to apply any of the *Zha* Grounds against proposed substitute claims 33 and 38, which correspond to claims 12 and 17, respectively. *See generally* Opp. 17.

Accordingly, at this stage of the proceeding and based on the current record, it appears that Petitioner has not shown a reasonable likelihood that substitute claims 33 and 38 are obvious in view of the *Zha* Grounds, when

viewed in the context of POSITA's knowledge or in combination with Kling.

Claims 26–35 and 37–41: Obviousness in view of Takahashi Grounds and Kling

In our Institution Decision, we determined that Petitioner had demonstrated a reasonable likelihood of prevailing in its challenge to:

- Claims 1–5, 9, 10, 12–14, 16, 17, and 23–25 as being rendered obvious over Takahashi, when viewed in the context of POSITA's knowledge (Ground 7); and
- Claims 1–5, 9, 10, 12–14, 16, 17, and 23–25 as being rendered obvious over Takahashi and Tsushima, when viewed in the context of POSITA's knowledge (Ground 8).

Paper 10, 11, 20 (Grounds 7–8, collectively “Takahashi Grounds”). Here, Petitioner contends that the subject matter of proposed substitute claims 26–35 and 37–41 would have been obvious in view of the Takahashi Grounds alone, in combination with POSITA's additional knowledge that an application can require two different passwords where the same user accesses it from different devices, or in combination with Kling. Opp. 20, 21, 24.

Proposed Substitute Independent Claims 26 and 41

Yes.

Patent Owner contends that “because *Takahashi* pertains to a different ‘field of endeavor’ and attempts to solve a different problem than the ’376 [p]atent, *Takahashi* is not analogous prior art.” Mot. 23. Patent Owner asserts that “[t]he field of endeavor for the ’376 [p]atent is online security,” but Takahashi “has nothing to do with securing online activities from potential malware.” *Id.* at 20, 22.

Based on the current record, we are not persuaded by Patent Owner's argument that Takahashi is not analogous art. As discussed above, Patent Owner appears to be viewing the fields of endeavor for the ’376 patent and Takahashi too narrowly. *See Unwired Planet*, 841 F.3d at 1001. Here, Takahashi is in the same field of endeavor as the claimed invention because it also relates to a system or method in which a user interacts with

“a first [electronic] device and a second [electronic] device throughout the use of an online application.” Ex. 1001, 2:29–31. Based on the current record, we are also persuaded by Petitioner’s argument that Patent Owner is wrong to assert that the prior art must address the same problem as the ’376 patent. *See* Opp. 24 (citing *Ex parte Talkowski*, Appeal No. 2012-002290 (PTAB May 24, 2013) (informative)).

Patent Owner argues that “*Takahashi* does not disclose being logged into the application using application specific authentication information at both the first and second devices, wherein the application specific authentication information used on the first device is different from the application specific authentication information used on the second device.” Mot. 16–17 (citing Ex. 2004 ¶¶ 90–91). Patent Owner contends that *Takahashi*’s “identification information” is device specific authentication information, not “application specific authentication information.” *Id.* at 17 (citing Ex. 2004 ¶¶ 93–94). Patent Owner also contends that “*Takahashi* discloses a login process which is then followed separately by an authentication process, not a login process using authentication information as provided in the Substitute Claims.” *Id.* at 16 (citing Ex. 2004 ¶¶ 90–91).

Petitioner contends that the proposed substitute claims, including claims 26 and 41, are “obvious in view of the *Takahashi* Grounds alone because *Takahashi* discloses the use of ‘identification information’ that is unique to each mobile terminal and used by the application to authenticate the same user logging in from different terminals.” Opp. 20 (citing Ex. 1027 ¶ 185). Petitioner also contends that Patent Owner’s argument that “the identification information is ‘device specific’ and, therefore, not ‘application specific’ . . . is incorrect” and “[t]here is simply no reason why ‘device specific’ information cannot also be ‘application specific,’ as in *Takahashi*.” *Id.* at 20 (citing Mot. 17), 21. Petitioner also contends that Patent Owner misreads *Takahashi* and *Takahashi* discloses the claimed login process, referring to the Figure 11 process of *Takahashi*. *Id.* at 23 (citing Ex. 1027 ¶ 208).

Petitioner further contends that “it would have been obvious to combine *Kling*’s disclosure of using multiple/different passwords with *Takahashi*’s game application,” and “*Kling*’s malware protection motivates modification of *Takahashi* in this manner.” Opp. 24 (citing Ex. 1027 ¶¶ 220–221); *see also id.* at 21 (“*Kling* and *Lipetz* both provide a motivation to combine a POSITA’s knowledge of using different

passwords with *Takahashi*'s game system—i.e., to enhance security against malware in that system.”) (citing Ex. 1027 ¶¶ 194–196). Petitioner contends that “[t]his modification of *Takahashi* represents the simple substitution of one known element (single password associated with a single account) for another known element (multiple passwords associated with a single account) to obtain predictable results (enhanced security against malware).” *Id.* at 21–22 (citing Ex. 1027 ¶ 197).

For purposes of this Preliminary Guidance and based on the current record, we are persuaded by Petitioner's argument that the combination of *Takahashi* and *Kling* teaches the amended limitation of proposed substitute claims 26 and 41. We find Patent Owner's argument that *Takahashi* does not teach “application specific authentication information” unpersuasive because *Takahashi*'s use of “identification information” that is unique to each mobile terminal and used by the application to authenticate the same user logging in from different terminals appears to correspond to providing information for authentication that is specific to an application, consistent with our preliminary construction of “application specific authentication information.” *See* Opp. 20–21. We are also persuaded by Petitioner's argument that the claimed login process is disclosed in Figure 11 of *Takahashi*, which appears to show well-known password login/authentication. *See* Opp. 23; *see also* Ex. 1007, Figure 11, ¶ 110. We also find that Petitioner's rationale for the combination, applying *Kling*'s use of multiple/different passwords to *Takahashi*'s game application, appears to be reasonable because the combination would appear to have improved *Takahashi*'s game application by enhancing security against malware in that system.

Proposed substitute independent claims 26 and 41 are not modified from their corresponding original claims 1 and 25, except for the above discussed amended limitation involving “application specific authentication information.” *See* Mot., App. A 3–4, 7–8. As discussed in our Decision to Institute, Petitioner had demonstrated a reasonable likelihood that *Takahashi*, or the combination of *Takahashi* and *Tsushima*, discloses or suggests all the limitations of original claims 1 and 25. Paper 10, 11, 20.

Accordingly, at this stage of the proceeding and based on the current record, it appears that Petitioner has shown a reasonable likelihood that proposed substitute claims 26 and 41 are unpatentable under 35 U.S.C.

§ 103 as obvious over at least the combination of Takahashi and Kling, or Takahashi, Tsushima, and Kling.

Proposed Substitute Dependent Claims 27–29, 31–34, and 37–40

Yes.

Patent Owner argues that Takahashi does not disclose “sensitive information” because Takahashi’s “game results,” which Petitioner relies on as corresponding to “sensitive information,” are not information that is not automatically shared with the first device. Mot. 18–19 (referring to Patent Owner’s construction of “sensitive information”). Petitioner contends that Patent Owner’s argument is based on its incorrect construction of “sensitive information.” Opp. 23.

Based on the current record, we find Patent Owner’s argument unpersuasive because it appears to be inconsistent with our preliminary construction of “sensitive information” discussed above. Patent Owner’s argument appears to be based on its overly narrow construction of “sensitive information,” which, as explained above, we decline to adopt at this time for purposes of this Preliminary Guidance. *See* Mot. 8–10.

Proposed substitute claims 27–29, 31–34, 37 and 39–40 depend from claim 26 (and substitute claim 38 depends from claim 37, maintaining the original dependency) and do not otherwise amend the language of their corresponding original claims. Accordingly, at this stage of the proceeding and based on the current record, it also appears that Petitioner has shown a reasonable likelihood that proposed substitute claims 27–29, 31–34, and 37–40 are unpatentable under 35 U.S.C. § 103 as obvious over at least the Takahashi Grounds in combination with Kling.

Proposed Substitute Dependent Claims 30 and 35

Yes.

Proposed substitute claim 30 is amended to (i) depend from substitute claim 28 (corresponding to original claim 3), and (ii) include “by the application” in the “providing” step. Mot., App. A 4–5. As discussed above, it appears that Petitioner has shown sufficiently that proposed substitute claim 30 is indefinite based on “the application on the second

device” recited in substitute claim 30. *See* Opp. 8–9. As for the remaining limitations (corresponding to original claims 3 and 5), as discussed in our Decision to Institute, Petitioner had demonstrated a reasonable likelihood that Takahashi, or the combination of Takahashi and Tsushima, discloses or suggests them. Paper 10, 11, 20; *see also* Opp. 22.

Proposed substitute claim 35 is amended to (i) depend from substitute claim 30 (corresponding to original claims 3 and 5), and (ii) include the following additional step: “further comprising displaying a graphical identifier on the first device and a corresponding graphical indicator on the second device indicating a link between the information displayed on the respective devices.” Mot., App. A 6. As noted above, this amended limitation appears to be identical to the limitation recited in substitute claim 32 (corresponding to original claim 10). *Compare id. with id.* at App. A 5. As discussed in our Decision to Institute, Petitioner had demonstrated a reasonable likelihood that Takahashi, or the combination of Takahashi and Tsushima, discloses or suggests the limitations of original claim 10. Paper 10, 11, 20; *see also* Opp. 22–23. As discussed above, Petitioner had also demonstrated a reasonable likelihood that Takahashi, or the combination of Takahashi and Tsushima, discloses or suggests the limitations of original claims 3 and 5. Paper 10, 11, 20.

As explained above, substitute claim 35 also appears to be indefinite based on its dependency from substitute claim 30, which appears to be indefinite as discussed above. *See* Opp. 22.

Accordingly, at this stage of the proceeding and based on the current record, it appears that Petitioner has shown a reasonable likelihood that proposed substitute claims 30 and 35 are unpatentable under 35 U.S.C. § 103 as obvious over at least the combination of Takahashi and Kling, or the combination of Takahashi, Tsushima, and Kling, to the extent the scopes of substitute claims 30 and 35 are discernible. This preliminary obviousness conclusion assumes that claims 30 and 35 cover scenarios where the application is either on the server or the second device.

Based on the information presented at this stage of the proceeding, the evidence tends to suggest at least that Petitioner has shown there is a reasonable likelihood that it would prevail in proving that each of proposed substitute claims 26–41 is obvious based on at least one ground for the reasons set forth in Petitioner’s Opposition and the accompanying declaration.

We acknowledge that Patent Owner has not yet had the opportunity to address Kling, which Petitioner first made of record in support of its Opposition, or Petitioner's asserted combinations. Patent Owner will have the opportunity to do so in its reply to Petitioner's Opposition (or in a revised motion to amend) in this proceeding.

Based on the assumptions described above, at this preliminary stage of the proceeding, it appears that Petitioner has shown a reasonable likelihood that proposed substitute claims 26–41 are unpatentable.

III. CONCLUSION

This concludes the Preliminary Guidance, which is Patent Owner's first option under the Board's pilot program. Notice, 84 Fed. Reg. at 9,497. Patent Owner has an additional option under the Board's pilot program to file a revised MTA by DUE DATE 3. Paper 11.

In addition to those two options under the Board's pilot program, Patent Owner is reminded that amendments of the challenged claims may also be pursued in a separate reissue or reexamination proceeding before, during, or after an AIA trial proceeding, including subsequent to the issuance of the Final Written Decision. We draw Patent Owner's attention to the April 2019 *Notice 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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