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Paper 11
Entered: June 11, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.,
Petitioner,

v.

MOBILE DATA TECHNOLOGIES LLC,
Patent Owner.

IPR2024-00248
Patent 9,032,039 B2

Before CHRISTOPHER M. KAISER, KEVIN C. TROCK, and SCOTT B. HOWARD, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background and Summary

Meta Platforms, Inc. ("Petitioner") filed a Petition (Paper 2, "Pet.") requesting *inter partes* review of claims 19–23 ("the challenged claims") of U.S. Patent No 9,032,039 B2 (Ex. 1001, "the '039 patent"). Mobile Data Technologies LLC ("Patent Owner") filed a Preliminary Response (Paper 6, "Prelim. Resp."). With our authorization, Petitioner filed a Reply to the Preliminary Response (Paper 8, "Prelim. Reply") and Patent Owner filed a Preliminary Sur-reply (Paper 10, "Prelim. Sur-reply").

We have authority, acting on the designation of the Director, to determine whether to institute an *inter partes* review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). *Inter partes* review may not be instituted unless "the information presented in the petition filed under [35 U.S.C.] section 311 and any response filed under [35 U.S.C.] section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a) (2018). "When instituting *inter partes* review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim." 37 C.F.R. § 42.108(a) (2023).

For the reasons set forth below, upon considering the briefing and the evidence of record, we determine that the information presented in the Petition establishes a reasonable likelihood that Petitioner will prevail with respect to at least one of the challenged claims, and we institute *inter partes* review on all of the challenged claims based on all of the grounds identified in the Petition.

B. Real Parties in Interest

Petitioner identifies itself as the real party in interest. Pet. 1.

Patent Owner identifies itself as the real party in interest. Paper 5, 1[1] (Patent Owner's Mandatory Notices).

C. Related Matters

The parties identify the following district court proceeding as a related matter: *Mobile Data Technologies LLC v. Meta Platforms, Inc.*, Case No. 7:22-cv-00244-ADA-DTG (W.D. Tex.). Pet. 1; Paper 5, 1.

D. The '039 Patent

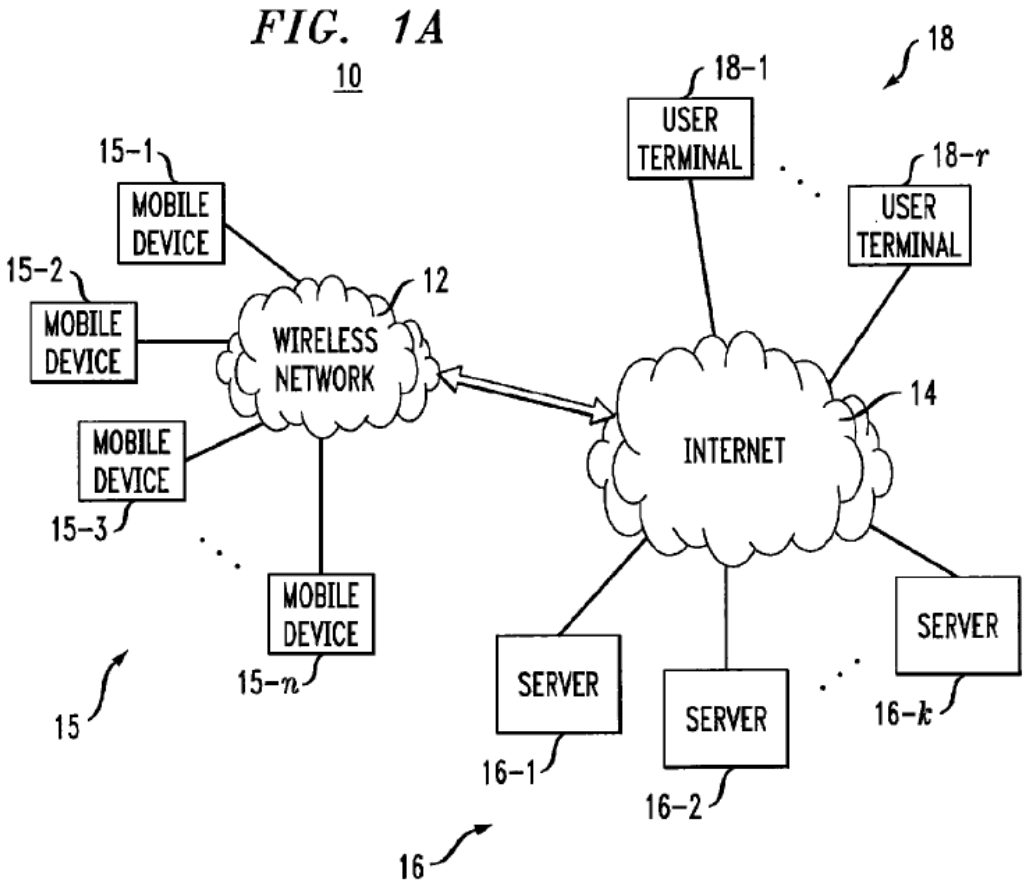
The '039 patent is titled "Method, Apparatus and System for Management of Information Content for Enhanced Accessibility Over Wireless Communication Networks." Ex. 1001, code (54). The application leading to this patent was filed on September 11, 2014, claiming priority to applications filed as early as June 18, 2002. *Id.* at codes (22), (60), (63).

The '039 patent observes the increasing access to information content over wireless networks through Web-enabled mobile devices, but notes the challenge of "creating, publishing, distributing or otherwise managing information content so as to provide optimal presentation consistent with the limited display space and navigational capabilities of typical mobile devices." Ex. 1001, 1:34–48. For example, "conventional techniques such as web site authoring tools and web logging ('blogging') are not optimized for use in the generation of information content for shared access via mobile devices." *Id.* at 1:53–56. The '039 patent thus recognizes a need "for improved techniques for managing information content in a manner that overcomes" the shortcomings of conventional techniques. *Id.* at 2:4–7. The '039 patent provides "for efficient generation and management of mobile

[1] Patent Owner did not paginate its Mandatory Notices. All citations are based on the page after the title page being page 1.

sites that are advantageously integrated with wireless networking functionality of a wireless network in a network-based communication system." *Id.* at 2:11–15.

Figure 1A, reproduced below, illustrates a network-based communication system.



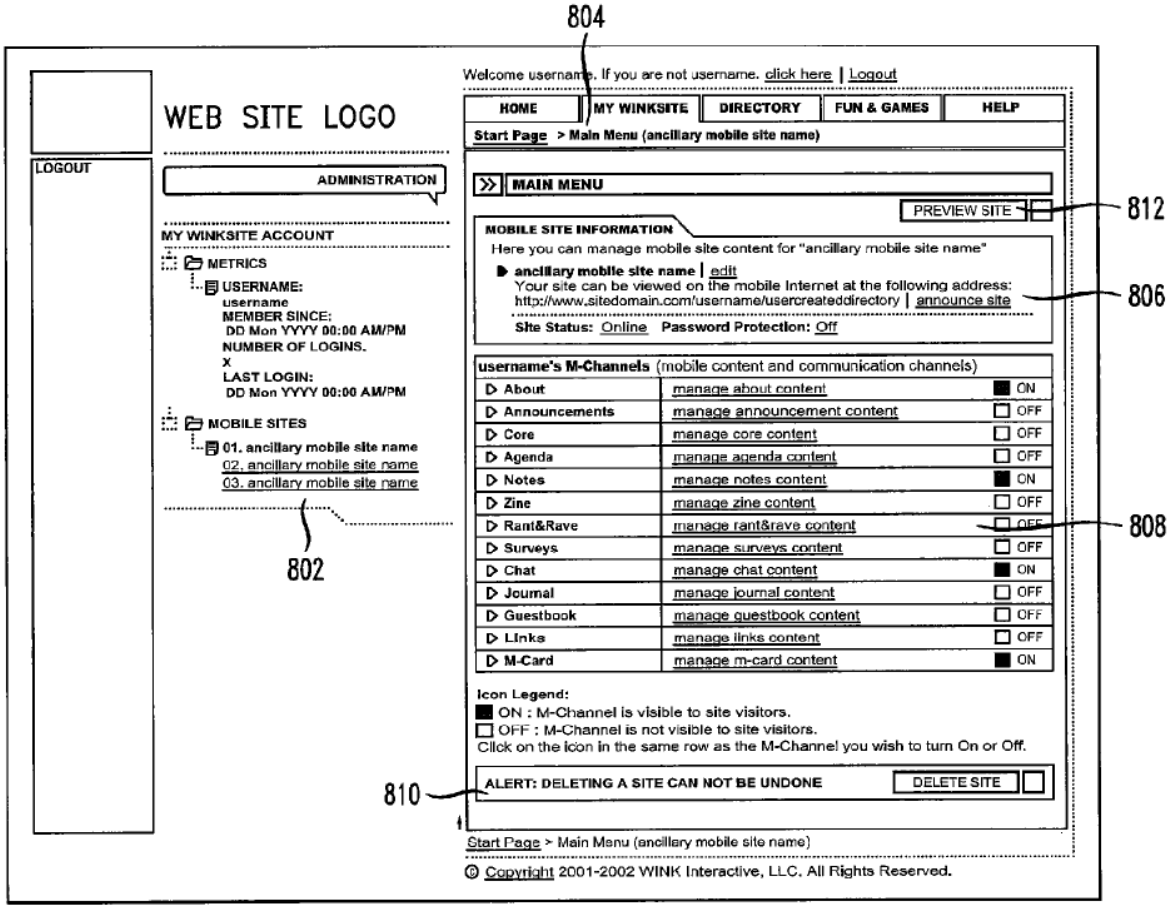
As shown in in Figure 1A, network-based communication system 10 includes a network configuration including wireless network 12 and Internet 14. Ex. 1001, 4:1–2. System 10 further includes mobile devices 15 and user terminals 18, generally referred to as user devices, connected to network 12 and Internet 14, respectively, and servers 16 coupled to Internet 14. *Id.* at 3:44–49, 3:58–59. In system 10, one of servers 16 may support a content

management site accessible by mobile devices 15 or user terminals 18. *Id.* at 5:6–29. In particular, a "content management site permits the user to enter information in accordance with a specified format comprising a plurality of selectable mobile information channels each corresponding to an information category," where such channels are "referred to as 'M-channels.'" *Id.* at 5:12–17.

Further, a content management site may be used to create a mobile site accessible by mobile devices 15, and the information content of a mobile site "may be configured so as to integrate therewith information associated with at least one wireless networking functionality of the wireless network 12." Ex. 1001, 5:26–29, 5:51–54. For example, such information may be determined based on parameters of M-channels, such as "information specifying at least one messaging action implementable over the wireless network," or "information specifying at least one location-based service action implementable over the wireless network." *Id.* at 5:57–65. "M-channels are utilized at the content management site . . . to facilitate the generation of mobile sites and the management of associated content," and "allow unsophisticated users to easily and efficiently author message data or other types of information content to be made accessible . . . ." *Id.* at 8:2–8. Moreover, the configuration of M-channels varies according to the implementation, "depending upon factors such as the particular wireless networking functionalities available in the system." *Id.* at 8:16–20.

Figure 8, reproduced below, illustrates a "main menu page of the content management site for managing a given mobile site associated with a system user." Ex. 1001, 13:31–33.

FIG. 8



As shown in Figure 8, the main menu page includes "information 802 identifying user account information and the particular mobile sites associated with that user, page navigational links 804, mobile site information 806 associated with a selected one of the mobile sites associated with the user, [and] M-channel information 808." *Id.* at 13:31–41. "[A] user selects a particular M-channel by activating the corresponding link 808," and authors content through a subordinate user interface. *Id.* at 14:1–8; *see also id.* at 13:42–64.

E. Illustrative Claim

Claims 19, 22, and 23 of the '039 patent are independent claims. Claim 19 is illustrative, and is reproduced below.

> 19. A method comprising:
>
> [a] receiving, at a server from a mobile device, content for insertion into a previously established application-based information channel, the previously established application-based information channel permitting interaction between a user of the mobile device and one or more additional users;
>
> [b] receiving, at the server from the mobile device, information associated with at least one wireless networking functionality of the mobile device;
>
> [c] integrating the content and the information associated with said at least one wireless networking functionality of the mobile device into the previously established application-based information channel; and
>
> [d] inserting other content from at least one of the additional users into the previously established application-based information channel.

Ex. 1001, 20:20–36 (reference letters added).

F. Prior Art and Asserted Grounds

Petitioner asserts the following grounds of unpatentability (Pet. 3, 12–56):

Claim(s) Challenged	35 U.S.C.[2] §	Reference(s)/Basis
19, 20, 22, 23	103(a)	Neibauer,[3] Cheng,[4] Squibbs[5]
21	103(a)	Neibauer, Cheng, Squibbs, Bandera[6]
19, 20, 22, 23	103(a)	Neibauer, Cheng, Squibbs, Harvey[7]
21	103(a)	Neibauer, Cheng, Squibbs, Bandera, Harvey

In support, Petitioner relies on the testimony of Vijay K. Madisetti, Ph.D. (Ex. 1002). Patent Owner relies on the testimony of Kevin C. Almeroth, Ph.D. (Ex. 2001).

II. ANALYSIS

A. Legal Standards

In *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), the Supreme Court set out a framework for assessing obviousness under 35 U.S.C. § 103 that requires consideration of four factors: (1) the "level of ordinary skill in the pertinent art," (2) the "scope and content of the prior

[2] The Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. §§ 102 and 103 effective March 16, 2013. The '039 patent claims priority to an application filed before that date, so we refer to the pre-AIA version of the statute, but our findings and analysis would be the same under the current version of the statute.

[3] *How to Do Everything with Yahoo!* (2000) (Ex. 1003).

[4] US 7,574,486 B1, issued Aug. 11, 2009 (Ex. 1005).

[5] US 2001/0015759 A1, published Aug. 23, 2001 (Ex. 1011).

[6] US 6,332,127 B1, issued Dec. 18, 2001 (Ex. 1017).

[7] US 6,487,583 B1, issued Nov. 26, 2002 (Ex. 1010).

art," (3) the "differences between the prior art and the claims at issue," and (4) if in evidence, "secondary considerations" of non-obviousness, such as "commercial success, long-felt but unsolved needs, failure of others, etc." *Id.* at 17–18. "While the sequence of these questions might be reordered in any particular case," *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 407 (2007), the U.S. Court of Appeals for the Federal Circuit has repeatedly emphasized that "it is error to reach a conclusion of obviousness until all those factors are considered," *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1328 (Fed. Cir. 2016). Because Patent Owner does not address objective evidence of non-obviousness, we focus solely on the first three *Graham* factors.

B. Level of Ordinary Skill in the Art

The level of ordinary skill in the pertinent art at the time of the invention is a factor in how we construe patent claims. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc). It is also one of the factors we consider when determining whether a patent claim is obvious over the prior art. *See Graham*, 383 U.S. at 17–18.

Factors pertinent to a determination of the level of ordinary skill in the art include "(1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field." *Envtl. Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 696–697 (Fed. Cir. 1983) (citing *Orthopedic Equip. Co. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1381–82 (Fed. Cir. 1983)). "Not all such factors may be present in every case, and one or more of these or other factors may predominate in a particular case." *Id.*

Petitioner asserts that the level of ordinary skill in the art corresponds to "a bachelor's degree in electrical engineering, computer science, or similar field, with two years of experience in developing and implementing network-based computer systems that interact with mobile devices, such as systems for storing and retrieving information over the Internet or communicating using the Web using wireless mobile devices." Pet. 6–7 (citing Ex. 1002 ¶¶ 14–18).

At this stage, Patent Owner "applies Petitioner's characterization of a person of ordinary skill in the art." *See* Prelim. Resp. 19.

For purposes of this Decision, we adopt Petitioner's proposed level of skill, as articulated above. We are satisfied that Petitioner's proposed definition generally comports with the level of skill necessary to understand and implement the teachings of the '039 patent and the asserted prior art. This definition is also supported by the testimony of Dr. Madisetti. *See* Ex. 1002 ¶¶ 14–18.[8]

C. Claim Construction

We apply the same claim construction standard used in the federal courts, in other words, the claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b), which is articulated in *Phillips*. *See* 37 C.F.R. § 42.100(b). Under the *Phillips*

[8] If Patent Owner disagrees with this formulation of the level of skill in the art, it must raise that disagreement in its Response. If a different level of skill would affect the outcome in this case, the parties must brief that issue as well. The failure of Patent Owner to describe how a different level of skill in the art is determinative will be a forfeiture of that argument. If there is a dispute regarding the level of ordinary skill in the art, then the parties are also encouraged to submit evidence, other than conclusory expert testimony, that supports their position.

standard, the "words of a claim 'are generally given their ordinary and customary meaning,'" which "is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Phillips*, 415 F.3d at 1312–13.

"Petitioner does not believe express claim construction is necessary at this time." Pet. 9. Petitioner also discusses various claim construction arguments made in the district court proceeding. *See id.* at 26–28, 53–54. At this stage, Patent Owner agrees with Petitioner that "no express claim constructions are required." Prelim. Resp. 19.

For the purposes of this Decision, we need not expressly construe any claim terms.[9] *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (noting that "we need only construe terms 'that are in controversy, and only to the extent necessary to resolve the controversy'" (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

[9] If either party intends to further argue claim construction at trial, including what is the plain and ordinary meaning of a term, they should do so in a clearly designated section of their briefing so as to expressly identify such arguments. *See, e.g.*, 37 C.F.R. § 42.104(b)(3) (content of petition); *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide, 84 Fed. Reg. 64,280, at 46, 48–45 (Nov. 2019) (available at https://www.uspto.gov/TrialPracticeGuideConsolidated). Claim construction arguments should not be relegated to patentability arguments on the facts. Failure to do so will result on forfeiture of all implicit claim construction arguments.

D. Discretionary Denial — 325(d)

1. Legal Standard

Patent Owner argues that we should exercise our discretion to deny institution of trial under 35 U.S.C. § 325(d). Prelim. Resp. 6–17. Under § 325(d), we have discretion to deny a petition that presents the same or substantially the same prior art or arguments as previously presented to the Office. In evaluating whether the factual predicate under § 325(d) is met, we consider a number of non-exclusive factors, as set forth in *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (Institution Decision) (precedential as to Section III.C.5, first paragraph) ("*Becton Dickinson* factors"):

> (a) the similarities and material differences between the asserted art and the prior art involved during examination;
>
> (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
>
> (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
>
> (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;
>
> (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and
>
> (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson, IPR2017-01586, Paper 8 at 17–18.

In performing an analysis under § 325(d), the Board uses the following two-part framework:

> (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. . . . If, after review of [*Becton Dickinson*] factors (a), (b), and (d), it is determined that the same or substantially the same art or arguments previously were presented to the Office, then factors (c), (e), and (f) relate to whether the petitioner has demonstrated a material error by the Office.

Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6 at 8, 10 (PTAB Feb. 13, 2020) (Institution Decision) (precedential) (footnote omitted). Consequently, we first turn to an analysis of *Becton Dickinson* factors (a), (b), and (d) to determine whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office.

2. Part One of the Advanced Bionics *Analysis*

Becton Dickinson factors (a), (b), and (d) require us to determine, respectively: (a) "the similarities and material differences between the asserted art and the prior art involved during examination;" (b) "the cumulative nature of the asserted art and the prior art evaluated during examination," and (d) "the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art." *Becton, Dickinson*, IPR2017-01586, Paper 8 at 17.

Patent Owner argues that "Petitioner correctly acknowledges that [Neibauer, Cheng, and Squibbs] were considered and made of record by the Examiner." Prelim. Resp. 9–10 (citing Ex. 1022, 170, 186, 199, 312). Patent Owner further argues that Bandera is "substantially similar to art previously before the Examiner." *Id.* at 12–13. Patent Owner does not argue that Harvey previously was before the Office. *Id.* at 12.

Petitioner argues that although Neibauer, Cheng, and Squibbs were considered during prosecution, they were only mentioned in an Information Disclosure Statement and were cited "among hundreds of other prior art references." Pet. 4. Petitioner further argues that the Office "cited and relied on both Neibauer and Cheng in a reexamination of [U.S. Patent No. 8,135,801] in the same family . . . , which resulted in cancellation of all claims." Pet. 5–6; *see also* Prelim. Reply 1–2.

Petitioner also argues that neither Bandera nor Harvey was presented during prosecution. Pet. 3–4; Prelim. Reply 2–3. Petitioner further argues that those references are not substantially the same as prior art considered by the Office. Prelim. Reply 2–3.

We disagree with Patent Owner that all of the references Petitioner is relying on are the same or substantially the same as references that were before the Office. In particular, there is no dispute that neither Harvey nor Bandera was considered by the Office, nor that Harvey is not substantially the same as any reference that was before the Office. Prelim. Resp. 10–13; Prelim. Reply 2–3. Further, we do not agree with Patent Owner that Bandera is substantially the same as Dowling. Specifically, Petitioner relies on Bandera to teach the delivery of advertising content on the same web page as other content requested by a mobile user, with the advertising content selected based on the mobile user's location. Pet. 49–53; Prelim.

Reply 2–3. We have reviewed the section of Dowling to which Patent Owner directs us (Ex. 1030,[10] code (57), ¶ 64), and we do not see substantially the same functionality. Although Dowling teaches delivering advertising content to a mobile user based on the physical location of the mobile user's device, Patent Owner does not explain, and it is not clear from our review of Dowling, that the advertising content is delivered alongside non-advertising content on the same web page. Ex. 1030 ¶ 64. If anything, Dowling appears to teach the delivery of a standalone web page instead. Specifically, Dowling discloses that, in response to "the mobile unit" "enter[ing] a new city, . . . a web page comes up and provides directions to the shopping mall and also optionally provides an inside map of the mall to include directions to the desired store." *Id.* Accordingly, we are not persuaded that Dowling is substantially the same as Bandera.

3. Conclusion

Based on our consideration of *Becton Dickinson* factors (a), (b), and (d), we find that the same or substantially the same art or arguments were not previously presented to the Office. Thus, our analysis ends at this point, and we need not proceed to part two of the *Advanced Bionics* framework. *See Advanced Bionics*, IPR2019-01469, Paper 6 at 8. We therefore decline to exercise our discretion to deny institution based on 35 U.S.C. § 325(d).

[10] Patent Owner refers to Exhibit 2003 as Dowling, but that exhibit is an unrelated published patent application by Oswald et al. Petitioner provides the Dowling reference as Exhibit 1030, so we cite to it instead. *See* Prelim. Reply 2.

E. Neibauer, Cheng, and Squibbs

Petitioner argues that claims 19, 20, 22, and 23 would have been obvious over Neibauer, Cheng, and Squibbs. Pet. 3, 12–48. Based on the current record, we are sufficiently persuaded that Petitioner has established a reasonable likelihood of prevailing on this asserted obviousness ground with respect to at least claim 19.

1. Overview of Neibauer

Neibauer describes a feature of the Yahoo! Web site called Yahoo! Clubs, which is "a group of Yahoo! members who share a common interest," and which "has its own message board and chat room, as well as places to share photographs, news, addresses, and links." Ex. 1003, 473.[11] According to Neibauer, there are official, listed, and unlisted clubs hosted by Yahoo! *Id.* Official clubs are created by Yahoo!, listed clubs are open to all Yahoo! members, and unlisted clubs are private clubs and only "members who were invited to join may join the club and be able to access it." *Id.* A founder can create a club "to share information privately," and "can invite others to join, delete members, control the contents of photo albums, and customize the photo and messages on the club's home page." *Id.* at 480.

Neibauer Figure 21-13, reproduced below, illustrates a club page.

[11] References to Neibauer are to the original page numbers, for consistency with the Petition.

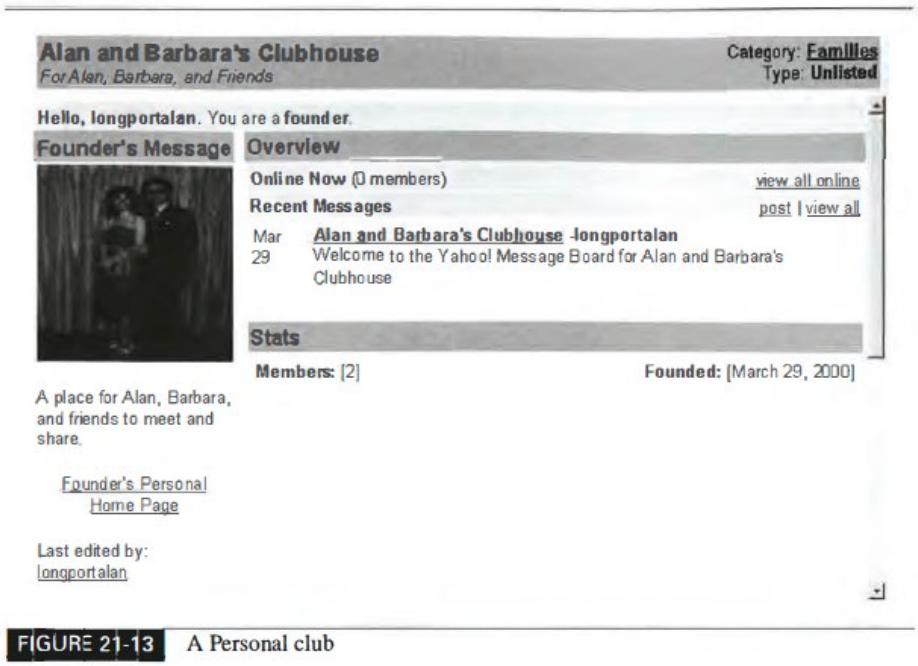


FIGURE 21-13 A Personal club

Figure 21-13 is an illustration of a personal club page. Ex. 1003, 482–83. According to Neibauer, it "contains all of the elements found on other club pages." *Id.* Club members may use a private message board to post messages or comment on other messages, as well as access a private chat area that provides for voice-chat and text-only chat. *Id.* at 477, 479. Club members may also share photographs organized in group or personal albums. *Id.* at 477.

Neibauer further describes a product called Yahoo! Mobile that "lets you get many Yahoo! services on mobile devices." Ex. 1003, 166. Within the Yahoo Mobile! product, a "Yahoo! To Go option lets you set up your mobile device and Yahoo! so that they work together, as well as specify the content that will be sent to your device." *Id.* at 167. For example, the Yahoo! On Your PDA feature "lets you set up to browse Yahoo! using a custom menu from the Web browser on your PDA." *Id.* at 171.

2. Overview of Cheng

Cheng is titled "Web Page Content Translator" and relates to "reformatting web content into a format readable on one or more mobile devices." Ex. 1005, codes (54), (57).

Cheng Figure 1 is reproduced below.

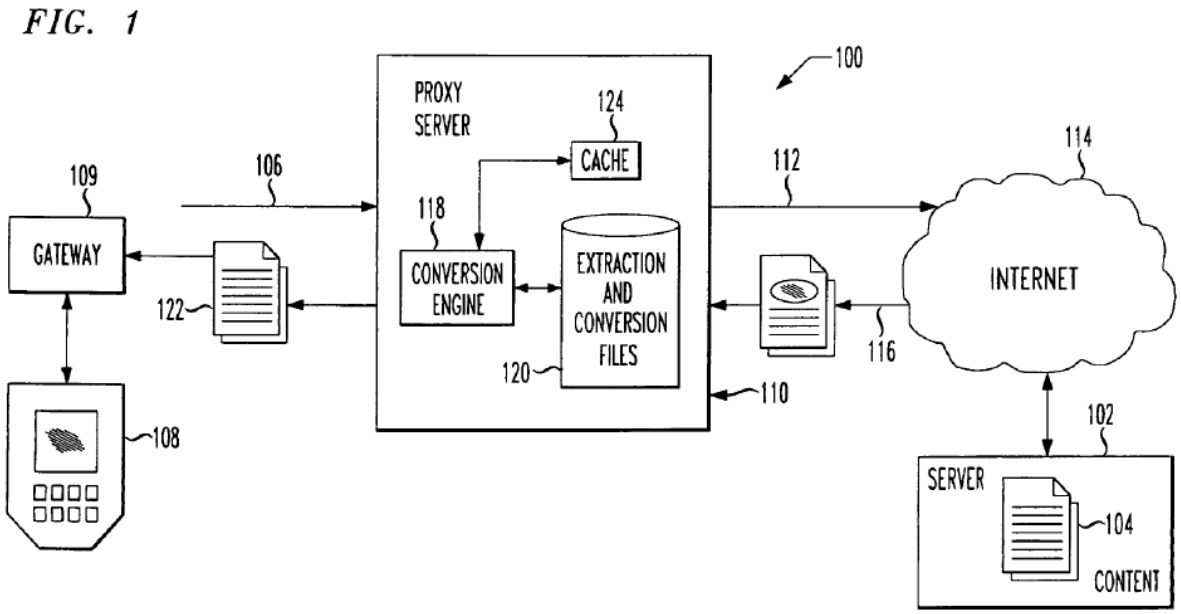


Figure 1 illustrates "a representative simplified block diagram of a mobile device, a proxy server, and a content server." Ex. 1005, 2:57–60. Specifically, architecture 100 includes proxy server 110, which "reformats/converts web content 104 on an origin web server 102 into a format 122 readable on any mobile device 108." *Id.* at 3:21–25. "Upon a request 106 from a mobile device 108 for a given web page 104 . . . the process for providing a reformatted/converted and extracted web page 104 begins." *Id.* at 3:58–63. If "the requested page 104 resides at the server 102, the proxy server 110 makes a request 112 for the page." *Id.* at 3:65–67. Proxy server 110 and server 102 are connected via network 114, which may be the Internet. *Id.* at 4:1–2. Server 102 returns web page 104 to proxy

server, where "web page 104 is typically an HTML file with references to any component .wav, .mov, and/or Joint Photographic Experts Group (JPEG) files." *Id.* at 4:8–13. Conversion engine 118 in proxy server 110 "accesses a predefined extraction and conversion file associated with the mobile device 108 and/or web page 104," and "uses the expressions defined therein" to perform designated operations on, for example, HTML code in web page 104. *Id.* at 4:17–21, 5:42–46. Reformatted web page 122 is then transmitted to mobile device 108. *Id.* at 5:46–49.

3. Overview of Squibbs

Squibbs relates to "a camera which can obtain location data about its current location and associate it with image recordings." Ex. 1011 ¶ 1. Specifically, Squibbs describes a photo system with a digital camera that includes location determining means, such as a GPS receiver, for generating digital photos that are stamped with location data indicating the location where the photo was taken. *Id.* ¶ 31. "Other data may also be associated with each photo, such as a timestamp, a camera ID, and a user ID," which is referred to as photo metadata. *Id.* Photos and their metadata may be downloaded to a computer where an "album program enables user to catalogue, manage and view their photos through a map-based interface, the photos being represented on a displayed map by a marker indicating the location they were taken." *Id.* ¶¶ 31–32.

In an embodiment where a digital camera does not have location determining means, a cell phone that can ascertain its location may be used for obtaining location information. *See id.* ¶¶ 95–98. The digital camera may obtain location data from the cell phone and associate it with a last-taken photo (*id.* ¶ 99), or, alternatively, a photo may be associated with location data by uploading photo image data through the cell phone to a

network store of a service system, during or after which location data is obtained from the cell phone or from a location server and then associated with the photo image data (*id.* ¶ 101, Fig. 11).

4. Analysis of Claim 19

a) Limitation 19a

Claim 19 recites "[19a] receiving, at a server from a mobile device, content for insertion into a previously established application-based information channel, the previously established application-based information channel permitting interaction between a user of the mobile device and one or more additional users." Ex. 1001, 20:21–26. For the reasons set forth below, we are sufficiently persuaded by Petitioner's argument and evidence that Neibauer teaches limitation 19a. *See* Pet. 13–26.[12]

Neibauer teaches a web-based interface, shown in Figure 21-8, that can be used to join a Yahoo! Club. Ex. 1003, 473–75; Ex. 1002 ¶¶ 50, 87. Figure 21-8 of Neibauer is reproduced below.

[12] Petitioner also presents alternative theories as to how the combination of Neibauer and Cheng teaches limitation 19a. *See* Pet. 13–26. For example, Petitioner relies on the features of Yahoo! Mobile "to the extent mobile device were construed as requiring a handheld device." *Id.* at 19. As another example, Petitioner argues that "[u]sing [Neibauer's] photo sharing feature through a mobile device would also have been obvious over Neibauer and in further view of Cheng." *Id.* at 19. As yet another alternative, Petitioner presents arguments based on claim constructions that were proposed in the pending district court litigation. *See* Pet. 26–28. Because we are sufficiently persuaded that Neibauer (without Yahoo! Mobile) teaches limitation 19a, we do not address Petitioner's alternative arguments.

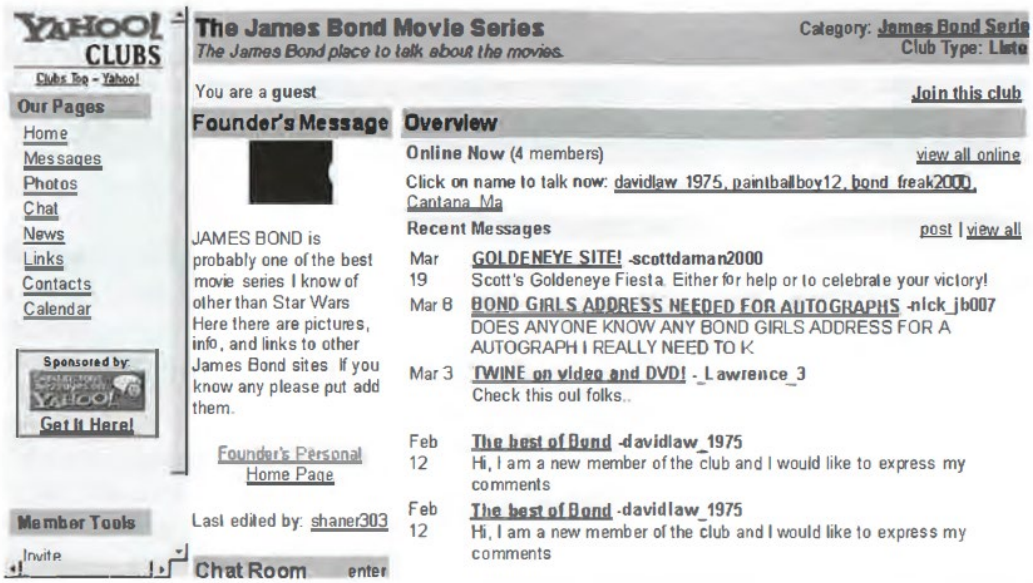


FIGURE 21-8 Club page

Ex. 1003, 475. Figure 21-8 shows the home page of a Yahoo! club. *Id.* at 473. A user joins the Yahoo! club "by clicking '**Join this club**,' shown on the top-right [of Figure 21-8]." Ex. 1003, 473; Ex. 1002 ¶ 87. Once the user joins the club, they can interact with other users who have joined the club in several ways. Ex. 1002 ¶ 87.

In particular, Neibauer teaches various ways that users of a Yahoo! club can share content. *See id.* One such way is the ability the share photographs with other Yahoo! club members. Ex. 1003, 477–78; Ex. 1002 ¶ 88. When a user uploads a photo to the Yahoo! club, they "move a copy of the photo into the club's Web space." Ex. 1003, 478; Ex. 1002 ¶ 88. Dr. Madisetti testifies that "[i]t was basic knowledge that a website such as the one described in Yahoo! would have required at least a web server accessible via the Internet," so "[i]t would have been obvious that the photo was received '**at a server**.'" Ex. 1002 ¶ 88. Thus, based on the present

record, Neibauer teaches "receiving, at a server . . . , content" as recited in claim 19.

Based on the current record, Neibauer teaches that photos uploaded to a Yahoo! club are received "for insertion into a[n] . . . application-based information channel, the previously established application-based information channel permitting interaction between a user of the mobile device and one or more additional users," as recited in claim 19. *See* Ex. 1002 ¶¶ 89–90. According to the '039 patent, a mobile information channel or M-channel "allow[s] unsophisticated users to easily and efficiently author message data or other types of information content to be made accessible via a collaborative workspace, a data mailbox, a collaborative community, or other type of mobile site or portion thereof generated or otherwise managed in the system 10." Ex. 1001, 8:5–11. Examples of M-channels include a "discussion forum," "chat," and "photo blog." *Id.* at 8:21–32. The last of these features is the same or substantially the same as Yahoo! club photo sharing feature described in Neibauer. Ex. 1002 ¶ 90. Thus, the photo sharing feature of the Yahoo! club is, on the present record, a "mobile information channel," which is "synonymous with" the "application-based information channel" of claim 19. *Id.*

Based on the current record, the information channel disclosed by Neibauer is "previously established," as recited in claim 19. The photo sharing feature of the Yahoo! club exists "as a feature of the club before the club member ch[ooses] to upload a new photo to a photo album." *Id.* ¶ 89.

Based on the current record, the "previously established application-based information channel" of Neibauer "permit[s] interaction between a user . . . and one or more additional users." "Any member [of the Yahoo! club] can place a photo in a group album," and any member can see "the

title, contributor's name, the photo's size, . . . the date it was posted, . . . [and] the photo." Ex. 1003, 477; Ex. 1002 ¶ 89.

Based on the current record, it would have been obvious to a person having ordinary skill in the art to use the features of the Yahoo! club (information channels) with a mobile device, thus sending the photo "from a mobile device" and "permitting interaction between a user of the mobile device and one or more additional users," as recited in claim 19. *See* Ex. 1002 ¶ 91. A person having ordinary skill in the art would have known that a person could use a conventional computer, such as a laptop computer, to run a web browser to visit pages on the internet, such as Yahoo!, including Yahoo! Clubs. *Id.* Because the '039 patent describes a laptop computer as a "mobile device," (Ex. 1001, 4:24–32), submitting a photo to a Yahoo! club from a laptop computer results in the receipt of the photo from a mobile device, as recited in claim 19.

Accordingly, on the present record, Neibauer teaches limitation 19a.

Patent Owner argues that aside from mapping the limitations identified above to disclosure in Neibauer,

> Petitioner does not provide any additional explanation for how Neibauer "receiv[es] . . . from a mobile device, content for insertion into a previously established application-based information channel" and "permit[s] interaction between a user of the mobile device and one or more additional users for sharing content between the first user and one or more additional users" as the limitations are arranged in the claim.

Prelim. Resp. 26. Specifically, Patent Owner argues that "Neibauer is devoid of such functionality as it is focused only on the read-only functionality of mobile access to traditional websites," and that "[t]here is no evidence that the Yahoo! Clubs functionality" Petitioner relies upon "could have been supported by users accessing the services on a mobile device."

Id. According to Patent Owner, Neibauer's disclosure of the Yahoo! Mobile and Yahoo! To Go functionalities do not cure this deficiency. *Id.* at 26–27. Importantly, Patent Owner argues, these functionalities are "limited to a user's one-way access and viewing of information originating with the Yahoo! software platform," and "[t]here is no evidence" they "would have allowed mobile users to actually post content" associated with Yahoo! club features. *Id.* (citing Ex. 1003, 156, 166–67; Ex. 2001 ¶¶ 60–62); *see also id.* at 27 (citing Ex. 2001 ¶¶ 59–62, 65–66).

We do not agree with Patent Owner's argument. First, as discussed above, based on the current record, Neibauer discusses ways that members of Yahoo! Clubs can interact using the photo sharing feature. For example, the photo sharing feature allows users to post photographs and view the photographs posted by other users. Ex. 1003, 477; Ex. 1002 ¶¶ 89–90.

Second, although not explicitly stated in the Preliminary Response, based on the cited testimony of Dr. Almeroth, it appears that Patent Owner's primary issue is the lack of a teaching in Neibauer that connects the features of Yahoo! Clubs with Yahoo! Mobile. *See* Ex. 2001 ¶¶ 54–66. However, as discussed above, we do not rely on Petitioner's alternate arguments directed to handheld devices using Yahoo! Mobile. Instead, we focus on the use of laptop computers and Yahoo! clubs. Patent Owner does not address that combination. *See* Prelim. Resp. 24–28.

Patent Owner further argues that Cheng does not cure the deficiencies of Neibauer because Cheng is limited to "provid[ing] one-way access and viewing of information by a mobile device of content originating at a server." *Id.* at 27–28 (citing Ex. 1005, 3:31–33, 4:56–5:10; Ex. 2001 ¶¶ 70–76, 80).

Similarly, Patent Owner argues that Petitioner's combination of Neibauer and Cheng relies on a "basic fallacy" in which "mobile devices available at the time of the invention were capable of receiving and displaying complex websites such as those shown in Neibauer at all, much less capable of supporting the internal functionality needed for the interactive features of" Yahoo! Clubs. Prelim. Resp. 29. Patent Owner asserts that Petitioner fails to provide "evidence that a [person having ordinary skill in the art] actually ***could*** have achieved such a combination," and that "Petitioner's arguments that a [person having ordinary skill in the art] ***would*** have sought to do so amount to nothing more than anachronistic, impermissible hindsight." *Id.*; *see also id.* at 29–38 (detailed discussion).

Patent Owner's arguments relating to Cheng are inapposite. As discussed above, for limitation 19a, we rely on Petitioner's argument based on Neibauer and do not rely on the alternate argument based on the combination of Neibauer and Cheng. *See* Pet. 19, 22 (explaining that Cheng is an alternate argument: "Using the photo sharing feature through a mobile device *would also have been* obvious over Neibauer and in further view of Cheng." (emphasis added)). Even if we agreed with Patent Owner's arguments regarding Cheng, that agreement would have no impact on our preliminary determination based on Neibauer.

b) Undisputed Limitations 19b, 19c, and 19d

Claim 19 also recites

> [19b] receiving, at the server from the mobile device, information associated with at least one wireless networking functionality of the mobile device;
>
> [19c] integrating the content and the information associated with said at least one wireless networking functionality of the mobile

> device into the previously established application-based information channel; and
>
> [19d] inserting other content from at least one of the additional users into the previously established application-based information channel.

Ex. 1001, 20:27–36. Petitioner argues that these additional limitations would have been obvious over the combination of Neibauer, Cheng, and Squibbs. *See* Pet. 28–43.

After reviewing Petitioner's arguments and information regarding the limitations identified immediately above, including the Madisetti Declaration, which are not addressed by Patent Owner at this stage[13] (*see* Prelim. Resp.), we are persuaded that Petitioner sufficiently demonstrates, for purposes of this Decision, that limitations 19b, 19c, and 19d would have been obvious to a person having ordinary skill in the art in light of Neibauer, Cheng, and Squibbs.

c) Conclusion Regarding Claim 19

Based on the current record, there is a reasonable likelihood that Petitioner will prevail in demonstrating that claim 19 is unpatentable as obvious in view of Neibauer, Cheng, and Squibbs.

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[13] We note that although Patent Owner raises arguments as to why a person having ordinary skill in the art would not have combined the Yahoo! Clubs of Neibauer with the specific implementations of Yahoo Mobile! and Cheng, Patent Owner does not rebut Petitioner's evidence regarding using a well-known cellular communication platform such as GSM with mobile devices such as a laptop. *See* Prelim Resp. 24–38. To the extent Patent Owner argues that such a combination would not have been obvious to a person having ordinary skill in the art, Patent Owner must explicitly do so in the Response or forfeit the argument.

5. Analysis of Claims 20–23

Because Petitioner demonstrates a reasonable likelihood of success in proving that at least one claim of the '039 patent is unpatentable, we institute on all grounds and all claims raised in the Petition. *See* 37 C.F.R. § 42.108(a). Therefore, at this stage of the proceeding, it is not necessary for us to provide an assessment of every challenge raised by Petitioner, especially, as in this case, when Patent Owner does not separately argue those claims. Those challenges, in our view, are best left for trial after full development of the record.

F. Remaining Grounds

Petitioner also challenges the patentability of claims 19, 20, 22, and 23 based on the addition of Harvey to the combination discussed above, and challenges the patentability of claim 21 by additionally relying on Bandera, with or without Harvey. *See* Pet. 3, 49–56. Patent Owner does not separately address the merits of Petitioner's other prior art challenges. *See* Prelim. Resp. 38.

Because Petitioner meets the threshold for institution by demonstrating a reasonable likelihood that at least claim 19 is unpatentable as obvious, we need not decide whether Petitioner's other challenges demonstrate the same. Those challenges, in our view, are best left for trial after full development of the record.

III. CONCLUSION

Following 35 U.S.C. § 314, we have determined that the totality of the information presented at this stage shows there is a reasonable likelihood that Petitioner would prevail with respect to at least one of the claims challenged in the Petition, and we institute on all grounds raised and all

claims challenged in the Petition. Additionally, we decline to exercise our discretion under § 325(d) to deny institution.

Our factual findings, conclusions of law, and determinations at this stage of the proceeding are preliminary, and based on the evidentiary record developed thus far. This is not a final decision as to the patentability of claims for which *inter partes* review is instituted. Our final decision will be based on the record as fully developed during trial.

IV. ORDER

In consideration of the foregoing, it is hereby

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review is instituted for claims 19–23 of the '039 patent on the unpatentability grounds asserted in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial, which commences on the entry date of this Decision.

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