

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.,
Petitioner,

v.

SITNET LLC,
Patent Owner

U.S. Patent No. 8,249,932

IPR Case No.: 2024-00528

**SITNET LLC'S PRELIMINARY RESPONSE TO PETITION FOR *INTER PARTES*
REVIEW OF U.S. PATENT NO. 8,249,932**

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	CLAIM CONSTRUCTION	1
	A. 37 C.F.R. § 42.100(b) Statement	1
	B. Situational Network.....	1
III.	RESPONSE TO GROUNDS FOR INVALIDITY RAISED.....	10
	A. Ground 1: Claims 1-4, 6-11, 22, and 23 Are Not Obvious Over Carlson in View of Shahine	10
	B. Ground 2: Claims 1-4, 6-11, 22 and 23 Are Not Obvious over Carlson-Shahine in View of Lundy	15
	C. Grounds 3 and 4: Claim 5 Is Not Obvious over Carlson-Shahine nor Carlson- Shahine-Lundy in View of Roskind	15
	D. Ground 5: Claims 1-11, 22, and 23 Are Not Obvious over Amidon in View of Walsh and Shahine.....	16
	E. Grounds 6: Claim 8 Is Not Obvious over Amidon-Walsh-Shahine in View of Jones	21
IV.	FINTIV FACTORS STRONGLY FAVOR DENIAL	21
V.	CONCLUSION	24

EXHIBIT LIST

No.	Exhibit Description
2001	Joint Claim Construction Brief in <i>SitNet LLC v. Meta Platforms, Inc.</i> , No. 1:23-cv-06389-AS (Dkt. 57).
2002	Amended Joint Claim Construction Chart in <i>SitNet LLC v. Meta Platforms, Inc.</i> , No. 1:23-cv-06389-AS (Dkt. 58).
2003	Order regarding Trial Schedule in <i>SitNet LLC v. Meta Platforms, Inc.</i> , No. 1:23-cv-06389-AS (Dkt. 32).
2004	Statistics for Southern District of New York Judges
2005	Expert Report of Dr. Aviel D. Rubin

I. INTRODUCTION

Pursuant to 35 U.S.C. § 313 and 37 C.F.R. § 42.107, Patent Owner SitNet LLC (“SitNet”) submits the following Preliminary Response to the Petition for *Inter Partes* Review of claims 1-11, 22, and 23 of U.S. Patent No. 8,249,932 (“the 932 Patent”) filed by Petitioner, Meta Platforms, Inc. (“Petitioner” or “Meta”).

The patent at issue is currently being asserted against Petitioner in *SitNet LLC v. Meta Platforms, Inc.*, No. 1:23-cv-06389-AS (S.D.N.Y. July 24, 2023). Petitioner and Patent Owner have exchanged *Markman* briefs and a Markman hearing is scheduled for July 1, 2024. In the District Court proceedings, Petitioner has requested the District Court construe the challenged claims contrary to the specific grounds asserted in the Petition. Accordingly, it is unlikely that Petitioner could credibly pursue the asserted grounds. *Inter partes* review, consequently, should not be instituted.

II. CLAIM CONSTRUCTION

A. 37 C.F.R. § 42.100(b) Statement

A *Markman* hearing regarding the challenged claims is currently pending in *SitNet LLC v. Meta Platforms, Inc.*, No. 1:23-cv-06389-AS (S.D.N.Y. July 24, 2024). The Parties filed a Joint Claim Construction Brief on February 26, 2024, a copy of which is attached as Exhibit 2001. On May 1, 2024, the Parties filed an Amended Joint Claim Construction Brief, a copy of which is attached hereto as Exhibit 2002. A Markman hearing is scheduled for July 1, 2024. When the District Court issues its claim construction, Patent Owner will file a request asking the Board to consider and adopt the District Court’s construction.

B. Situational Network

The term “situational network” appears in claims 1, 10, 11, 12, 14 and 22 of the 932 Patent.

Though Petitioner and Patent Owner have proposed different constructions of “situational network” in *SitNet LLC v. Meta Platforms, Inc.*, there are points of agreement. Both agree that a “situational network” is created in response to the occurrence of an event or situation.

Petitioner’s proposed construction of the term is:

“a network *created when an occurrence or expected occurrence of an event or situation* causes connections to be established between, within or among a set of participants”

Exhibit 2001, at 6-10 (emphasis added). Petitioner has thus proposed a construction requiring a situational network to be created in response to the occurrence of an event or situation. Patent Owner, likewise, proposed such a construction. Specifically, Patent Owner’s proposed construction of the term is:

“a network that is a subset of a larger network, comprising member nodes, *formed in response to an event or situation*”

Exhibit 2001, at 7 (emphasis added). Accordingly, neither party disputes that a “situational network” is created in response to the occurrence of an event or situation.

The parties also agree that a “situational network” is a network, which finds support in the specification, which describes:

Referring generally to FIG. 1, a situational network 3000 is created when an occurrence or expected occurrence of an event or situation 3005 causes connections, also referred to as links, to be established between, within or among a set of participants 250, 207...

Some or all of the participants included in the situational network (SitNet) 3000 may have no prior knowledge of or connection or contact with each other or other participants of the situational network through *any other type of social network* or personal interactions.

932 Patent, 3:46-58 (emphasis added). In recognizing “*any other type* of social network” as alternatives to a situational network, the 932 Patent classifies a “situational network” as a type of

social network. Accordingly, a “situational network” is a social network created in response to the occurrence of an event or situation. As the Petitioner acknowledges in its proposed construction, a situational network is formed by “caus[ing] connections, also referred to as links, to be established between, within or among a set of participants 250, 207.” 932 Patent, 3:48-50. The specification further states:

...individual users, members, entities, communities, or other aggregations of entities within the NDSN [(N - dimensional social network)] are associated with the nodes... Each node is capable of communicating in a peer-to-peer fashion with other nodes in the NDSN, and thus is a user’s point of connection to the NDSN, providing a user with access to information that can be obtained from other users of the NDSN with whom the user has a relationship.

932 Patent, 14:42-54. Nodes thus represent the participants in a “situational network”.

Accordingly, a situational network is a social network formed in response to the occurrence of an event or situation by forming connections between a subset of nodes representing participants of the social network.

As a “situational network” is a social network, connections formed in creating a situational network define a social network (e.g. friend request, connection request, follows, etc.). “Traditionally, a social network is a network that consists of individuals who are interconnected by various personal information and social metrics such as interests, location, demographics, community, and more.” Exhibit 2005, ¶ 27. The use of social networks to interconnect individuals based upon personal information and social metrics has become ubiquitous in society. For instance, people follow influencers, and others, posting on topics of interests on “X” (formerly Twitter), TikTok, Facebook, and Instagram. *Id.* Accordingly, the common activity of “following” someone interconnects a user to an influencer based on the social metric of an interest. *Id.* Social networks, such as LinkedIn and Facebook, permit users to

interconnect based upon community. For instance, a user on LinkedIn might send an invitation to connect with a former classmate or work colleague. Likewise, a user on Facebook might send a friend request to their neighbor. Accordingly, via invitations to connect and friendship requests, social networks interconnect individuals based on community. The connections creating and defining a social network are thus links representing the personal information and social metrics that interconnect users of the social networking service. *Id.* The specification makes clear the same holds true for the connections used to form a “situational network” social network.

Claim construction during IPR follows the *Phillips* standard, under which a claim term may be defined without any explicit definitional format. To the extent Petitioner cites *Thorner v. Sony Computer Entertainment America, LLC*, 669 F.3d 1362 (Fed. Cir. 2012) for the proposition that there is a heavy presumption that claim terms carry their accustomed meaning in the relevant community at the relevant time, which presumption can only be overcome in only two specific circumstances (*i.e.*, redefinition or disavowal), this is a common misapplication of *Phillips*. See *Trustees of Columbia Univ. v. Symantec*, 811 F.3d 1359, 1363 (Fed. Cir. 2016) (holding that the “case law does not require explicit redefinition or disavowal” and quoting *Aventis Pharma S.A. v. Hospira, Inc.*, 675 F.3d 1324, 1330 (Fed. Cir. 2012) (“This clear expression need not be *in haec verba* but may be inferred from clear limiting descriptions of the invention in the specification or prosecution history.”); further holding that the “en banc *Phillips* opinion rejected this very approach”).

Even when a claim term’s meaning in the specification differs from its meaning in the relevant community at the relevant time, “*Phillips* made clear, a claim term may be clearly redefined without an explicit statement of redefinition and even when guidance is not provided in

explicit definitional format, the specification may define claim terms by implication such that the meaning may be found in or ascertained by a reading of the patent documents.” *Symantec*, 811 F.3d at 1364 (Fed. Cir. 2016); *see also Trustees of Columbia Univ.*, 811 F.3d 1363 (Fed. Cir. 2016).

One manner of defining a claim term by implication is by consistent usage in the specification. “[W]hen a patentee uses a claim term throughout the entire patent specification, in a manner consistent with only a single meaning, he has defined that term ‘by implication.’” *Bell Atlantic Network Serv. v. Covad Communications*, 262 F.3d 1258, 1271 (Fed. Cir. 2001). Moreover, “[w]hether a claim must, in any particular case, be limited to the specific embodiment presented in the specification, depends in each case on the specificity of the description of the invention and on the prosecution history.” *Liebel-Flarsheim Company v. Medrad, Inc.*, 358 F.3d 898, 907 (Fed. Cir. 2004). Accordingly, *Liebel-Flarsheim* forecloses construing a claim term consistent with its usage in all disclosed embodiments, when “[t]he prosecution history [] affirmatively preclude[s] a narrow reading of the claim language.” *Irdeto Access, Inc. v. Echostar Satellite Corp.*, 383 F.3d 1295, 1302 (Fed. Cir. 2004). Absent such disclaimer, a consistent usage throughout the embodiments in the specification defines a claim term by implication.

When the specification does not contemplate an alternative, even permissive language does not negate an implied definition. *See Irdeto Access*, 383 F.3d at 1301 (“All examples in the specification, *Irdeto* argues, are permissive rather than mandatory, illustrative rather than exhaustive, and do not necessarily or explicitly exclude a group made up of all subscribers... Yet *Irdeto* cannot explain every example in the specification, all of which consistently point to an implicit definition of group as a subset of all subscribers in the system.).

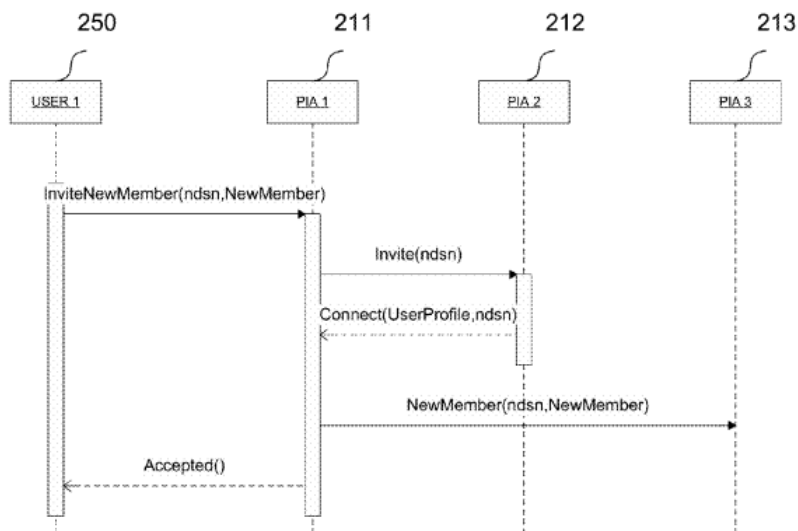
The connections forming and connecting a “situational network” social network are consistently described as being the standard links representing the personal information and social metrics that interconnect users within well recognized traditional social networks, and no other alternatives are presented. For example, users may be connected to the situational network in one of three specified ways:

Users 250 are connected via the situational network 3000 using devices 402...

The device 402 may be connected into the situational network automatically, by requesting a connection, or by receiving an invitation to connect, each of which is described in greater detail below.

932 Patent, 4:9-22.

The case in which a user is invited to join is shown in FIG. 16 of the 932 Patent (reproduced below).



“[T]he user 250 asks PIA1 211 to **invite** User2 252 to connect to the members of the NDSN by sending an InviteNewMember message to PIA1 211 with an argument ndsn identifying the NDSN, and an argument identifying the potential new user (User2 252). PIA1 211 sends an Invite message to PIA2 212 with an argument ndsn identifying the NDSN... To accept the

invitation, PIA2 212 responds by sending a Connect message to PIA1 211 with arguments that contain User2's user profile (UserProfile) and identify the NDSN (ndsn).” 932 Patent, 18:58-19:3.

An identical scenario is shown in FIG. 34 (reproduced below) in which an “event node” invites a user to join a situational network.

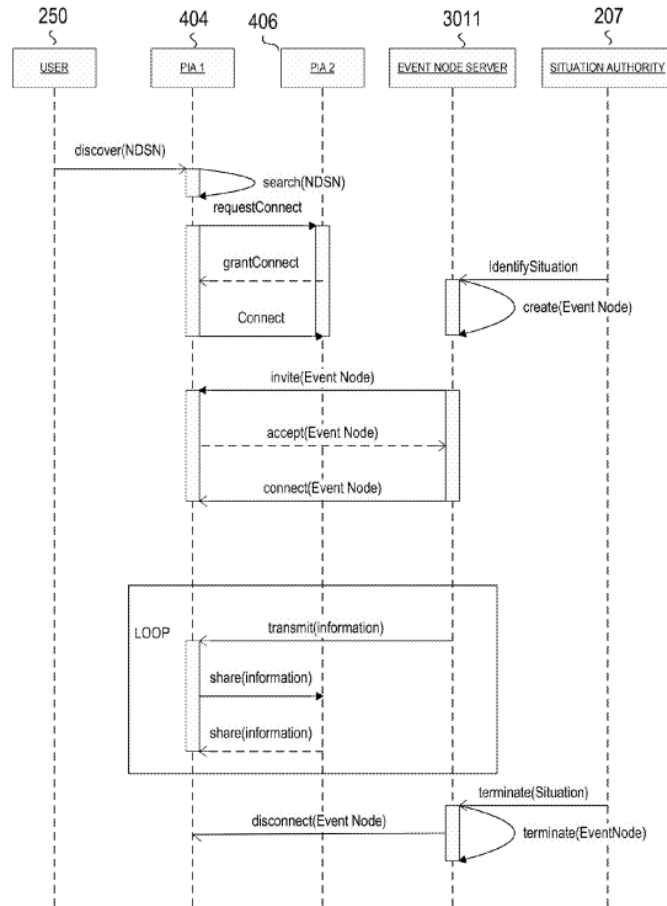


Fig. 34

Figure 34 shows a situation in which a user is invited to connect to an event node (“invite(Event Node)”) based on a likely interest in the event underlying the “situational network.”

Alternately, users may automatically be *invited* to connect to the event node corresponding to the event as shown in FIG. 34. The automatic invitation may be based on a stored user profile accessible to a situation authority server 3011 associated with the event node may crawl the network for user PIAS 404, 406 that would likely be interested in the information about the event. The user 250 may accept or decline the invitation based on their interest in the event or situation.

932 Patent, 19:58-66. Accordingly, a user may be invited to join a “situational network” by in essence receiving a Facebook like “friend-request” or a LinkedIn like “invitation to connect”.

Alternatively, the user may discover and send a friend request to connect to the “event node” within the situational network corresponding to the event or situation underlying the situational network, as shown in Figure 35 (reproduced below).

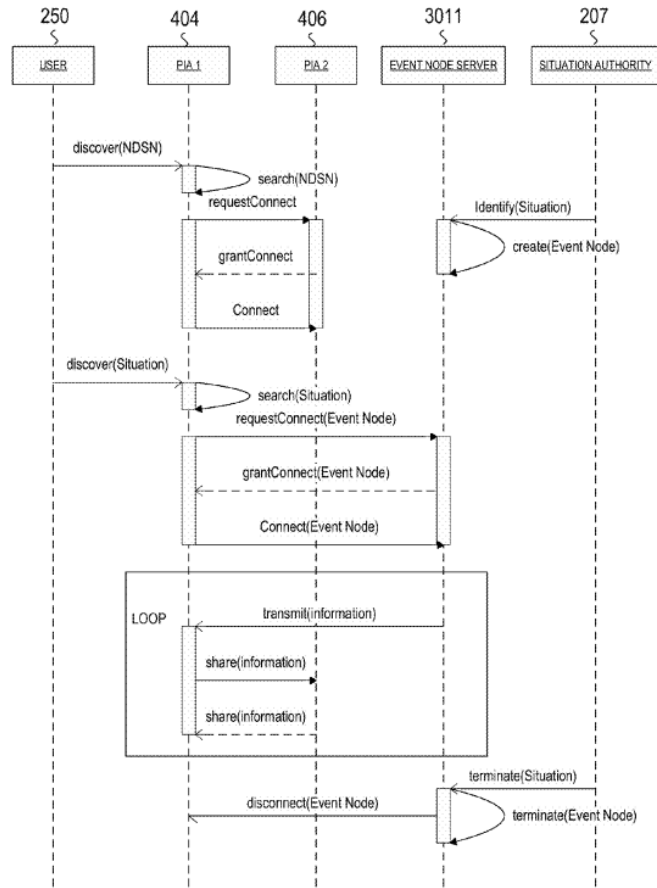


Fig. 35

Referring to FIG. 35, the event node corresponding to an event node server 3011 may be established, or hosted, by a situation authority 207 or trusted provider, such as news source (e.g., CNN or weather.com) or a government agency. The event node may be discovered by a user's PIA 404 corresponding to the user 250 based on the PIA 404 searching or crawling the network for information about the situation or event if the connection can not be automatically established based on the configurations of the PIA 404 and the event node server 3011. A user 250 can then **request connection** to the event node server 3011 through the PIA 404 in order to receive and share information about the situation with the situation authority 207.

932 Patent, 19:39-51. Accordingly, a user may request to join a situational network by sending a Facebook like “friend-request” or a LinkedIn like “invitation to connect.”

These descriptions are not meant to imply the way connections are created is limited. Rather, the connections within a situational network are defined by implication through consistent usage to be the links representing the personal information and social metrics that interconnect users of a social networking service. Furthermore, though the above embodiment may use permissive language, the specification does not contemplate an alternative.

Accordingly, the presence of permissive language does not negate the implied definition that connections created when forming a social network are the links representing the personal information and social metrics that interconnect users of the social networking service hosting the “situational network” to the underlying situation or event. *See Irdeto Access*, 383 F.3d at 1301 (“All examples in the specification, *Irdeto* argues, are permissive rather than mandatory, illustrative rather than exhaustive, and do not necessarily or explicitly exclude a group made up of all subscribers... Yet *Irdeto* cannot explain every example in the specification, all of which consistently point to an implicit definition of group as a subset of all subscribers in the system.).

A situational network, therefore, is a social network formed in response to the occurrence of an event or situation by forming connections between nodes which represent the personal information and social metrics that interconnect participants of the social networking service hosting the situational network to the underlying situation or event.

III. RESPONSE TO GROUNDS FOR INVALIDITY RAISED

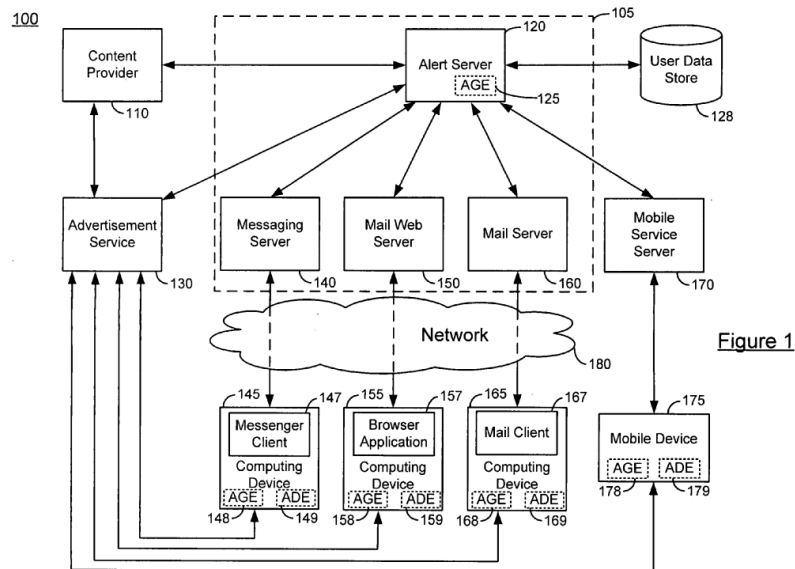
A. Ground 1: Claims 1-4, 6-11, 22, and 23 Are Not Obvious Over Carlson in View of Shahine

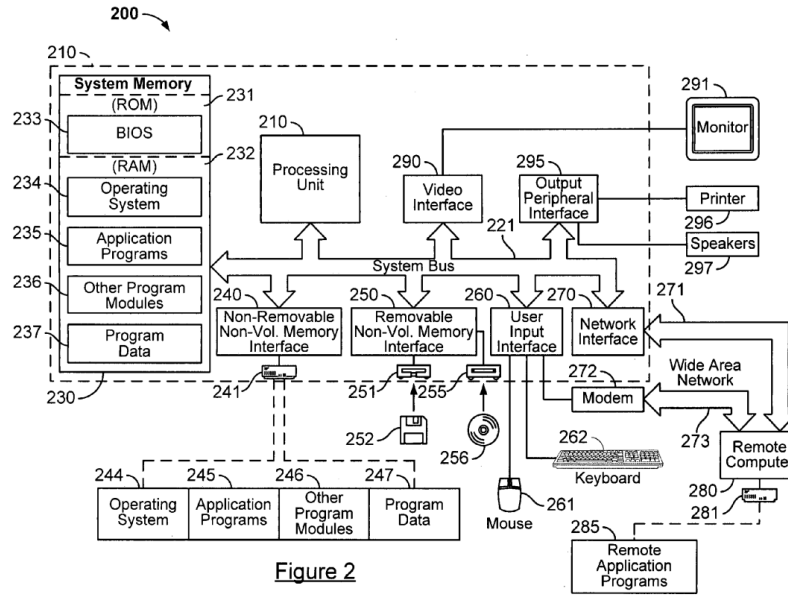
Independent claims 1 and 22 both recite a “situational network.” Consequently, dependent claims 2-4, 6-11, and 23 must also include a “situational network” as an element.

Claims 1-4, 6-11, 22 and 23, therefore, each require a “situational network.” The Petition fails to establish either Carlson (U.S. Publication No. 2006/0282312) and/or Shahine (U.S. Patent No. 8,799,073) discloses a “situational network.” The combination of Carlson and Shahine, therefore, cannot render the challenged claims invalid and unpatentable.

As noted *supra*, the specification states a “situational network” is a social network. The Petition relies on Carlson to establish the presence of a “situational network” within the asserted art. Carlson, however, does not present the alert interface it discloses as utilizing or including social networks.

The Petition first asserts that Carlson’s alert interface includes a “situational network” “because the alerts and advertisements sent in response to a situation are sent over connections to a computer network.” Petition, at 10. In support of this proposition, the Petition cites paragraphs [0025] and [0049] of Carlson, which reference FIGS. 1 and 2 (reproduced below), respectively.





With regards to FIG. 1, Carlson states:

Relevant advertisement generation system 105 includes alert server 120, messaging server 140, mail web server 150, and mail server 160. System 105 communicates with content provider 110, advertisement service 130, user data store 128, mobile service provider 170, computing devices 145-165, and mobile device 175 over *network 180. In one embodiment, network 180 may be the Internet.*

Carlson, ¶ [0025] (emphasis added). With respect to FIG. 2, Carlson discloses:

The computer 210 may operate in a *networked environment using logical connections to one or more remote computers*, such as a remote computer 280... The logical connections depicted in FIG. 2 include a local area network (LAN) 271 and a wide area network (WAN) 273, but may also include other networks. Such networking environments are commonplace in offices, enterprise-wide computer networks, intranets and *the Internet.*

Carlson, ¶ [0049] (emphasis added). Thus, as the Petition recognizes, Carlson discloses that computing devices may “operate in a networked environment using logical connections to one or more remote computers” such as over the internet. Petition, at 10. Logical connections

permitting computers to exchange data over the internet and the like are *completely different* from the connections forming and defining a social network. As detailed *supra*, the connections forming a *social network* are links representing the personal information and social metrics that interconnect users of a social networking service, such as “friendship,” “work colleague,” “classmate,” “likes,” and “follows.” While a social networking service would require the use of a logical connection transmitting data for *access*, that sort of access network should not be confused with the social network itself, as the Petition has done. Exhibit 2005, ¶ 40. Accordingly, Carlson fails to disclose a situational network, as defined in the specification and claimed, because it merely discloses networks of logical connections used to connect remote computers—and *not* a social network.

In addition to confusing the connections used to access a situational network with those used to form a situational network, Petitioner has not demonstrated that the connections are formed at the required time. *Id.* at ¶¶ 38-39. In *SitNet LLC v. Meta Platforms, Inc.*, Petitioner asserted a “situational network” is “a network *created when an occurrence or expected occurrence of an event or situation causes connections to be established* between, within or among a set of participants.” Exhibit 2001, at 4 (emphasis added). What Petitioner has identified as “connections” between the users and services as participants of Carlson’s alert interface are subscriptions established *prior to* the occurrence or expected occurrence of an event or situation.

The Petition asserts that the data stored in user data store 128 of Carlson’s system constitutes connections within a social network. Petition, at 35-36. Carlson discloses, however, that “[u]ser data store 128 stores data and other information for users... The stored information can include data such as user account data for a mail provider service, user contact lists, *user*

alert subscription information, user instant messaging account information, user mobile device account information, and other data.” Carlson, ¶ [0030] (emphasis added). The stored data thus includes a user’s subscription to receive alert notifications. The other stored data enumerated by Carlson provides means of delivering the alerts the user subscribed to receive. For instance, “user account data for a mail provider service” would inform the system on how to deliver the alerts the user signed up to receive to the user’s e-mail. Likewise, “the user instant messaging account information” and “user mobile device account information” would inform how to deliver alerts the user requested to receive via the user’s cellular phone. “User contact list” would include other means of delivering the alerts the user subscribed to receive. Accordingly, the data stored within user data store 128 are subscriptions and delivery addresses for the subscriptions.

That the connections between users and various alert services are subscriptions established *prior to* the occurrence or expected occurrence of an event or situation is confirmed in the other portions of Carlson cited in the Petition. For example, the Petition cites the examples of a “weather service” and a “sporting news service” presented by Carlson in paragraph [0052]. Petition, at 35. Both are presented as examples of “a service the user has *accepted or subscribed to.*” Carlson, ¶ [0052] (emphasis added). Accordingly, the “[u]sers to receive the alert can include *users that have indicated a preference to receive information regarding the event detected*” determined by the alerts for services “*the user has subscribed to.*” Carlson, ¶ [0053] (emphasis added).

Subscribing to a service and/or indicating a preference requires establishing a connection with the service *prior to* the occurrence or expected occurrence of an event or situation. Exhibit 2005, ¶¶ 38-39. The very act of subscribing establishes a relationship with the service that interconnects the service and the subscriber. *Id.* Furthermore, indicating preferences to the

service also requires previously forming a relationship with the service that interconnects the service and the subscriber. The connections between the users and services disclosed in Carlson are thus formed *prior to* the occurrence or expected occurrence of an event or situation. *Id.* This is completely different than “a network *created when an occurrence or expected occurrence of an event or situation causes connections to be established* between, within or among a set of participants.” See Exhibit 2001. Consequently, whatever Carlson creates, it is not created in accordance with Petitioner’s asserted construction of a situational network. Carlson, therefore, fails to disclose a situational network as Petitioner asserts that term.

The Petition fails to assert that Shahine discloses a situational network or otherwise overcomes the deficiencies. Exhibit 2005 ¶ 42. Consequently, the Petition has not established that Carlson in combination with Shahine discloses and/or suggests all the elements of claims 1-4, 6-11, 22 and 23, and thus has not established that claims 1-4, 6-11, 22 and 23 are obvious over Carlson in view of Shahine.

B. Ground 2: Claims 1-4, 6-11, 22 and 23 Are Not Obvious over Carlson-Shahine in View of Lundy

For the reasons detailed *supra*, Carlson-Shahine fails to disclose all the elements of claims 1-4, 6-11, 22 and 23. The Petition fails to assert that Lundy (U.S. Publication No. 2008/0092162) overcomes the deficiencies. Exhibit 2005 ¶ 43. Consequently, the Petition has not established that Carlson-Shahine in further combination with Lundy discloses and/or suggests all the elements of claims 1-4, 6-11, 22 and 23, and thus has not established that claims 1-4, 6-11, 22 and 23 are obvious over Carlson-Shahine in view of Lundy.

C. Grounds 3 and 4: Claim 5 Is Not Obvious over Carlson-Shahine nor Carlson-Shahine-Lundy in View of Roskind

For the reasons detailed *supra*, Carlson-Shahine and Carlson-Shahine-Lundy fail to disclose all the elements of claim 1 from which claim 5 depends. The Petition fails to assert

Roskind (U.S. Patent No. 7,263,614) overcomes the deficiencies. Exhibit 2005 ¶ 45.

Consequently, the Petition has not established that Carlson-Shahine nor Carlson-Shahine-Lundy in further combination with Roskind discloses and/or suggests all the elements of claim 5, and thus has not established that claim 5 is obvious over Carlson-Shahine and/or Carlson-Shahine-Lundy in view of Roskind.

D. Ground 5: Claims 1-11, 22, and 23 Are Not Obvious over Amidon in View of Walsh and Shahine

Independent claims 1 and 22 both recite a “situational network.” Consequently, dependent claims 2-11, and 23 must also include a “situational network” as an element. Claims 1-11, 22 and 23, therefore, each require a “situational network.” The Petition fails to establish Amidon (U.S. Patent No. 8,346,864), Walsh (U.S. Patent No. 9,195,996) and/or Shahine (U.S. Patent No. 8,799,073) discloses a “situational network.” The combination of Amidon, Walsh, and Shahine, therefore, cannot render the challenged claims invalid and unpatentable.

The Petition asserts Amidon’s architecture provides a “situational network”. Petition, at 56. As detailed *supra*, Petitioner and Patent Owner have both proposed constructions requiring a “situational network” to be created in response to the occurrence of an event or situation. In *SitNet LLC v. Meta Platforms, Inc.*, Petitioner asserted a “situational network” is “a network ***created when an occurrence or expected occurrence of an event or situation causes connections to be established*** between, within or among a set of participants”. Exhibit 2001, at 6-10 (emphasis added). Accordingly, as Petitioner understands the term, a situational network comprises connections newly created in response to the occurrence or expected occurrence of an event or situation. Amidon’s architecture does not create new connections but instead creates chatrooms, referred to as “conferences.” The chatrooms are created using existing social networks to determine the participants in a chatroom (i.e., conference). Likewise, existing

social networks are used to determine the distribution of messages within a chatroom. In each instance, data is extracted from existing social networks to populate participant and recipient lists that are returned to the appropriate server. Amidon does not disclose a “conference” creates a new social network or alter the connections within existing social networks. Rather, Amidon merely uses the existing connections within a social network to determine members matching inclusion rules and adds those matching members to a participant or recipient list.

Amidon discloses that users “participate in social network conferences by way of any suitable communication techniques.” Amidon, 3:4-5. The suitable communication techniques enumerated are examples of various chat communication protocols. “For example, conferences may comprise textual messages, such as instant message (IM) and short message service (SMS) messages.” Amidon, 3:5-8. Accordingly, Amidon’s conferences use the messaging protocols commonly employed by chat apps. Exhibit 2005, ¶ 29. Amidon goes on to state that “[c]onferences may comprise audio messages, such as voice chat via streamed audio content, shared audio files, telephone (including VoIP, cellular, or other telephonic communication), or other suitable technique.” Amidon, 3:8-11. Accordingly, conferences may comprise voice chat. In addition to text and voice chat, Amidon states, “[c]onferences may comprise video messages, such as video chat via streamed video, shared video files, or other suitable techniques.” Amidon, 3:11-13. Allowing participation via text, video, and/or voice chat, Amidon's conferences are chatrooms.

Amidon's conferencing chatrooms are created using existing social networks to determine the participants. Amidon's system allows users to “define and participate in conferences, with the extent of the participation and messaging within such conferences *based on the structure of the underlying social network.*” Amidon, 7:59-61 (emphasis added); see Abstract (“[T]he

members can define and participate in conferences, with the extent of the participation and messaging within such conferences based on the structure of the underlying social network(s).”). Thus, Amidon discloses “systems and methods for users to conduct online conferences based on underlying social network structures.” Amidon, 2:55-56. Amidon’s system does not create a new social network—rather, Amidon uses only existing social network structures.

The existing underlying social network data is used to identify participants based on existing relationships which satisfy distribution parameters set by the user. The method for creating a conference chat comprises “accessing social network data *identifying the relationship* between members of the social network” then “[b]ased on the social network data ... multiple other users may be identified for inclusion in a social network conference.” Amidon, 3:31-36 (emphasis added). Amidon's conference chatrooms are created based on existing connections within a social network, identifying users for inclusion based on relationships:

“For example, a first user may provide one or more distribution parameter(s) that identify inclusion or exclusion rules, such as *desired degree of separation* (relative to the first user) restricting which other users are to be included in the conference... [T]he conferencing system may determine which social network users fall within the *desired degree of [separation]* and include them the social network conference.

Amidon, 3:40-47 (emphasis added). Accordingly, Amidon teaches that existing connections may limit conference chatrooms to users that are direct friends or friends-of-a-friend of a first user. The type of connection may also limit participants in Amidon's conference chat rooms. “For instance, the user may wish to conference with user within two degrees of separation in the *‘friend’ network* and only within a single degree of separation in the *‘work’ network*.” Amidon,

13:4-7. Amidon, accordingly, discloses using the structure of the underlying social network as represented by connections between users to define participation in conference chatrooms.

The distribution parameters specifying the connections to be used to create a conference chatroom are inputted by a user and packaged into “conference metadata.” A user “specifies one or more distribution parameters by interacting with a user interface ... and the parameter(s) are packaged into conference meta data...” Amidon, 10:25-28. To assist users in selecting the existing connections to include within the conference metadata, the user “may receive information about the user's respective social networks ... such as a diagram or chart of the social network. After reviewing the information, interested users may provide one or more social network parameters ... defining participation.” Amidon, 9:62-66. Thus, after a user has reviewed the structure of a social network and selected the type of connections within that structure, conference metadata is sent off, indicating the type of connections as distribution parameters that define members to be included within the conference chatroom.

The delivery of messages within Amidon's conference chatrooms is also dependent on connections of existing social networks selected by users. “For example, user A may wish to begin a side discussion with only the closest of contacts...” and “specify that the message is to be distributed only to members within one degree of separation.” Amidon, 11:2-6. Recipients of replies are also defined by existing connections. For instance, “user C may limit distribution of the reply to users within one degree of separation.” Amidon, 12:4-5.

Amidon thus discloses a system which creates chatrooms and delivers messages within a chatroom based upon user defined connections included within metadata. In each instance, data is extracted from existing social networks to populate participant and recipient lists that are returned to the appropriate server. As Amidon explains, “the conference metadata is sent to

messaging server 14” which then “provide[s] data identifying the social network in question and the distribution parameters to social network server 16” which “uses the distribution parameters and other information to assemble *a participant list* for potential inclusion in the social network conference.” Amidon, 10:32-39 (emphasis added). Accordingly, the connections specified within the metadata are used to mine the social network for matching members that are included within a participant list.

Specified connections are also used to mine social networks to generate recipient lists when sending messages within a conference chatroom. “Based on the message metadata and data defining the social network, *a recipient list* can be determined and the message can be sent to the user(s) in the *recipient list*.” Amidon, 3:54-56 (emphasis added). Thus, sending a message within one of Amidon's conference chatrooms entails sending instructions “to access social network data identifying *relationships between members of the social network*; to determine, based on data including the social network data and the message metadata, *a recipient list* for the message; and to send the message to one or more users included in *the recipient list*.” Amidon, 4:54-59 (emphasis added). Accordingly, Amidon describes, when creating a conference chatroom or sending a message within a conference chatroom, user defined connections included within metadata are used to mine social networks for matching users. Amidon does not disclose a “conference” that creates a new social network or alters the connections within existing social networks. Rather, Amidon merely uses the existing connections within a social network to determine members matching inclusion rules and adds those matching members to a participant or recipient list.

As detailed *supra*, a “situational network”, however, has been construed by both the Patent Owner and Petitioner to be created in response to the occurrence of an event or situation.

In *SitNet LLC v. Meta Platforms, Inc.*, Petitioner asserted a “situational network” is “a network *created when an occurrence or expected occurrence of an event or situation causes connections to be established* between, within or among a set of participants”. Exhibit 2001, at 6-10 (emphasis added). Accordingly, as Petitioner understands the term, a “situational network” comprises connections newly created in response to the occurrence or expected occurrence of an event or situation. But Amidon’s architecture does not create new connections and instead uses connections to mine existing social networks to populate lists. Accordingly, whatever Amidon’s architecture creates by mining social networks, it is not a “situational network.”

The Petition fails to assert that Walsh and/or Shahine discloses a situational network or otherwise overcomes the deficiencies of Amidon. Exhibit 2005, ¶¶ 55-58. Consequently, the Petition has not established that Amidon in combination with Walsh and Shahine discloses and/or suggests all the elements of claims 1-11, 22 and 23, and thus has not established that claims 1-11, 22 and 23 are obvious over Amidon in view of Walsh and Shahine.

E. Grounds 6: Claim 8 Is Not Obvious over Amidon-Walsh-Shahine in View of Jones

For the reasons detailed supra, Amidon-Walsh-Shahine fails to disclose all the elements of claim 1 from which claim 8 depends. The Petition fails to assert Jones (U.S. Publication No. 2006/0095320) overcomes the deficiencies. Exhibit 2005, ¶¶ 59-61. Consequently, the Petition has not established that Amidon-Walsh-Shahine in further combination with Jones discloses and/or suggests all the elements of claim 8, and thus has not established that claim 8 is obvious over Amidon-Walsh-Shahine in view of Jones.

IV. FINTIV FACTORS STRONGLY FAVOR DENIAL

In addition to the reasons that the Board should not institute set forth above, discretionary denial is warranted under *Fintiv* because an analysis of the *Fintiv* factors all weigh in favor of it. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential).

First, there is no evidence that the District Court in *Sitnet v. Meta* will grant a stay in the event that an IPR is instituted nor is there any likelihood of it doing so. As set forth in the Petition, Petitioner has not filed a motion to stay. Judge Arun Subramanian, who presides over the case, received his judicial commission on April 13, 2023. His Honor has previously denied a motion to stay pending resolution of petitions for IPR, which appears to be his only decision relating to such a motion to stay. *See Nike, Inc. v. Lululemon USA Inc.*, Case No. 1:23-cv-00771-AS, Dkt. 97. Further, Judge Subramanian has locked in a “rocket docket” case schedule in the District Court proceedings, with fact discovery to be completed by July 17, 2024, all discovery to be completed by September 25, 2024, post-discovery summary judgment motion practice completed by November 20, 2024, and trial scheduled for January 20, 2025. See Exhibit 1017. A Markman hearing is currently scheduled for July 1, 2024. If IPR is ever instituted here, it will likely occur when fact discovery is almost over in the District Court, making the possibility of a stay near zero.

Second, a trial at the District Court will certainly conclude before the Board issues a Final Written Decision even if it institutes IPR here. Trial is set to begin on January 20, 2025, as Petitioner admits. The District Court action began on July 24, 2023, when Patent Owner filed its complaint. Petitioner’s median time-to-trial statistic in the Southern District of New York, 47 months, would result in trial beginning on June 24, 2027—a staggering (and virtually impossible) 29-month delay from the currently scheduled January 20, 2027 trial start date. The Director’s June 21, 2022 Guidance Memorandum quoted by Petitioner also advises that “[w]here the parties rely on time-to-trial statistics, the PT AB will also consider additional supporting factors such as the

number of cases before the judge in the parallel litigation and the speed and availability of other case dispositions.” Here, additional supporting factors abound. As set forth in the Court’s October 16, 2023 order, Judge Subramanian specifically discussed at the October 5, 2023 conference that “trial in this case will begin on January 20, 2025, and the final pretrial conference will be held on January 13, 2025, at 2:00p.m.” and ordered the parties to “submit a revised case-management plan, ***working backward from those dates.***” Ex. 2003 (emphasis added). In this case, the Court *explicitly ordered* a specific trial date, January 20, 2025, and has not wavered from that date—but, rather, forced the parties to conform their case management plan to the Court’s trial date. Further, the Court has expeditiously resolved all motions, including resolving a motion to dismiss in 172 days (less than half a year), granting motions for extensions of time on the same day (see Dkt. 13-14, 37-38) or at most one day (see Dkt. 30-31, 52-53), and resolving the parties’ sole discovery dispute in 3 days (see Dkt. 59-61). Additionally, Judge Subramanian, who is relatively new on the bench (he received his commission a little over one year ago), has a docket of only 235 open cases (as compared to the top six busiest judges in the district, with 400 cases each). See Exhibit 2004

Even assuming a potential delay of half a year, that would put a potential trial date in June 2025. Meanwhile, if IPR is instituted here, a Final Written Decision may not issue until later in 2025 or early 2026. *See* 35 U.S.C. § 316(a)(11) (final determination in an IPR no later than one year after institution, or possibly one-and-a-half years if extended); 37 C.F.R. § 42.100(c) (same).

Third, there has been and will continue to be significant investment by the Court in parallel proceedings. Not only is the case proceeding through fact discovery in the pending District Court litigation with Petitioner, but the Court is already intimately familiar with the patents and technology at issue as it dealt with them in a motion to dismiss, in which one of the asserted patents was found to be invalid in view of *Alice*.

Fourth, there is undoubtedly overlap in the issues here as in the District Court proceeding. Meta has asserted obviousness of the patent at issue as a defense and will undoubtedly raise the same prior art references.

Fifth, Meta is both the Petitioner here and a defendant in the District Court proceeding.

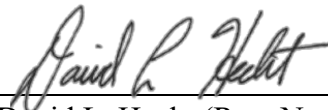
Sixth, there are no other circumstances that would disfavor denial.

V. CONCLUSION

The Petition fails to demonstrate a reasonable likelihood that the Petitioner will prevail as to any of the challenged claims. *Inter partes* review of the 932 Patent should therefore be denied.

Dated: June 21, 2024

Respectfully submitted by,

A handwritten signature in dark ink, appearing to read "David L. Hecht", is written over a horizontal line.

David L. Hecht (Reg. No. 61,618) (lead counsel)
dhecht@hechtpartners.com
HECHT PARTNERS LLP
125 Park Avenue, 25th Floor
New York, NY 10017
P: (212) 851-6821

CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that Patent Owner's Preliminary Response was served on June 21, 2024 by e-mailing copies to the following e-mail addresses as provided in Petitioner's Petition:

Jonathan Tuminaro - jtuminar-PTAB@sternekessler.com
Michael D. Specht - mspecht-PTAB@sternekessler.com
Steven M. Pappas - spappas-PTAB@sternekessler.com

Dated: June 21, 2024

Respectfully submitted,

By: /David L. Hecht/
David L Hecht Reg. No 61,618
Hecht Partners LLP
125 Park Avenue, 25th Floor
New York, NY 10017
Tel: 212-851-6821
E: dhecht@hechtpartners.com

Counsel for Patent Owner

CERTIFICATE OF WORD COUNT

Under the provisions of 37 C.F.R. § 42.24, the undersigned hereby certifies that word count for the foregoing Patent Owner Response (excluding the table of contents, certificate of service, word count, or listing of exhibits) total 6,189 words, which is less than the 14,000 words allowed under 37 C.F.R. § 42.24(b)(1).

Dated: June 21, 2024

Respectfully submitted,

By: /David L. Hecht/
David L Hecht Reg. No 61,618
Hecht Partners LLP
125 Park Avenue, 25th Floor
New York, NY 10017
Tel: 212-851-6821
E: dhecht@hechtpartners.com

Counsel for Patent Owner