

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAP AMERICA, INC.,
Petitioner,

v.

CYANDIA, INC.,
Patent Owner

IPR2024-01433
Patent 8,751,948 B2

Record of Oral Hearing
Held: January 15, 2026

BEFORE: JEFFREY S. SMITH, MITCHELL G. WEATHERLEY, and
GREGG I. ANDERSON, Administrative Patent Judges.

IPR2024-01433
Patent 8,751,948 B2

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The above-entitled matter came on for hearing on
January 15, 2026, commencing at 10:00 a.m.

P R O C E E D I N G S

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JUDGE SMITH: Please be seated. Good morning, everybody.

Welcome to the Patent Trial and Appeal Board. My name is Jeffrey Smith.

With me are Judges Mitch Weatherly and Gregg Anderson. Judge Anderson

is going to join us remotely. We're here today to hear SAP America v.

-- how do you say this? Cyandia?

MR. PRICE: Cyandia.

JUDGE SMITH: Cyandia. IPR 2024-01433. Let's see -- each

side has 45 minutes. Is there a LEAP request in this case? Do you have a

LEAP request?

MR. THACKER: Yes, Judge. Yeah. I submitted a LEAP request
and that was granted.

JUDGE SMITH: Okay. And how much time was granted for your
LEAP request?

MR. THACKER: An additional 15 minutes. So --

JUDGE SMITH: An additional 15 minutes.

MR. THACKER: -- it's 60 minutes.

JUDGE SMITH: Okay. So you'll have 60 minutes and you'll have
-- okay. So let's see. Let's start with Petitioner. Petitioner, please state your
name and the names of those who are here with you.

MR. THACKER: Samuel Thacker for Petitioner, SAP America.
And with me is my colleague, Andy Mason.

JUDGE SMITH: Okay. And do you wish to reserve time for
rebuttal?

1 MR. THACKER: Yes. I'd like to reserve 20 minutes for rebuttal.

2 JUDGE SMITH: Twenty minutes for rebuttal. Okay. And Patent
3 Owner, please state your name and the names of those you have here with
4 you.

5 MR. PRICE: Good morning, Your Honor. I'm Jeffrey Price on
6 behalf of Cyandia, Inc. and with me, James Hannah and Jenna Fuller.

7 JUDGE SMITH: And do you wish to reserve time for rebuttal?

8 MR. PRICE: Yes, I'll reserve 15 minutes for rebuttal.

9 JUDGE SMITH: Okay, thank you.

10 Okay. Petitioner, you have 40 minutes to present your case. You
11 may begin when ready.

12 MR. THACKER: May it please the Board. Sam Thacker on
13 behalf of Petitioner, SAP America. The primary issue and dispute in this
14 IPR centers on whether Patent Owner has shown that the challenged claims
15 which issued from a CIP application can be backdated to the earlier 2009
16 application, which has a much more limited, narrow disclosure. Without
17 that earlier 2009 priority date, Patent Owner does not dispute that all the
18 challenged claims are unpatentable.

19 In the 2009 application, Applicants were focused on providing
20 web-based channels to users' devices through a web services gateway. And
21 how the system worked is that the user would authenticate themselves and
22 then the channels are provided to the user's device in a grid via this web
23 services gateway.

24 Now, the 2009 application also discloses providing a visual or
25 auditory alert, but again, that alert is delivered through the web services
26 gateway. So the user has to have an active session. If they don't have an

1 active session, they don't receive an alert. In the 2011 CIP application,
2 however, Applicants expanded this system to provide other types of alerts
3 and to provide these alerts using other delivery mechanisms, such as SMS
4 text messages and email messages.

5 What this allowed the system to do was to notify the user even if
6 they didn't have an active session. To facilitate this new architecture, the
7 2011 CIP application added a notification manager. And this notification
8 manager would determine the notification method to use based on whether
9 or not the user's devices were active. The challenged claims are directed to
10 this new matter that was added in the CIP, and thus cannot be backdated to
11 the 2009 application. Turning to --

12 JUDGE WEATHERLY: When you say -- when you say that they
13 were directed to that new matter, is there a -- an affirmative statement in the
14 prosecution record indicating that or is that your contention?

15 MR. THACKER: Yes, that is -- our contention is that the claims
16 are directed to this new matter.

17 JUDGE WEATHERLY: Okay. The -- how did the issue get
18 handled in prosecution? I probably should know the answer, but I don't, so
19 I'm wondering if you do. In other words, did the examiner object to
20 something added to a claim and asked the applicant to point out where it was
21 supported in the spec? And if so, how did the applicant respond?

22 MR. THACKER: No. The examiner did not object to any claim
23 amendments.

24 JUDGE WEATHERLY: Okay.

25 MR. THACKER: However, if you -- if we turn to slide 6 -- we
26 turn to slide 6 to 7, for example, it's undisputed that when Applicant did add

1 the limitations directed to determining the notification method and
2 generating the notification data, they cited as support only paragraphs in the
3 CIP application where this new matter was added.

4 JUDGE WEATHERLY: Okay.

5 MR. THACKER: So --

6 JUDGE WEATHERLY: That -- that's a variation of the express
7 statement I was looking for. Okay.

8 JUDGE SMITH: Okay. What date did the examiner use when
9 applying prior art to the claims? Do you know?

10 MR. THACKER: Can you say that again? Sorry.

11 JUDGE SMITH: What effective filing date did the examiner give
12 to the claims when the examiner applied prior art to the claims?

13 MR. THACKER: So the examiner -- my understanding -- and I
14 will confirm this on rebuttal, but my recollection is that the examiner
15 -- when the original claims was filed, it didn't have these limitations. The
16 examiner said that they weren't entitled to the provisional date. And then
17 after Applicant made these amendments, the examiner had nothing further to
18 say about the priority date.

19 JUDGE SMITH: So the examiner used the provisional date?

20 MR. THACKER: No. The -- my understanding is that the
21 examiner never made an affirmative statement about what the date was.

22 JUDGE SMITH: Okay. Well, the art -- the examiner -- did the
23 examiner issue a prior art rejection? I haven't read through the prosecution
24 history, so I'm just asking, did the examiner make a prior art rejection to the
25 -- to these challenge claims? Do you know?

26 MR. THACKER: I will --

1 JUDGE SMITH: Okay.

2 MR. THACKER: I can get back to you on that --

3 JUDGE SMITH: Okay. That's fine. That's fine.

4 MR. THACKER: -- in rebuttal.

5 JUDGE SMITH: That's fine.

6 MR. THACKER: So I want to direct the Board to slide 2. The
7 2009 application does not provide written description support for
8 determining a notification method for the at least one alert. And turning first
9 to the determining a notification method, the claim recites determining a
10 notification method by which to provide the at least one alert on the at least
11 one external device based on the current state of the at least one external
12 device indicated by the session of data.

13 So here, the claim is saying, determine a method by which to
14 provide alert -- an alert on the at least one external device. Now, if we turn
15 to slide 22, the main piece of evidence that Patent Owner points to as alleged
16 support for this limitation is Paragraph 39 in the 2009 application, excerpted
17 portion of which is shown on slide 22.

18 But this paragraph discloses only one way to deliver alerts to the
19 user's active devices and does not disclose making any determination about
20 how the alert is delivered or presented. Specifically, what it discloses is that
21 the channel alert server may pass through the web services gateway to
22 provide the alert in the channel. So it determines the active devices and then
23 it just sends the alert in the only way it can, through the web services
24 gateway, to the user's active session. So there's no determination here
25 because there's just no other options. And although Paragraph 39 mentions
26 that the alert can be visual or audio -- auditory, there's no actual disclosure

1 of determining which of those forms of alerts to provide.

2 Now, the 2009 application's mention of generic user preferences in
3 early -- in an earlier paragraph, which is untethered from the alerts here,
4 cannot provide written description support for determining a notification
5 method. And you can look at the reply, which is paper 25 at 14 to 15 for our
6 arguments on that point.

7 JUDGE SMITH: I'm just -- I -- I'm sorry. I just want to make sure
8 I understand your argument. So you're saying with respect to -- let's see,
9 looking at slide 2 again, the providing at least one alert, you're saying there
10 -- there's no disclosure for an alert other than the visual or auditory alert? Is
11 --

12 MR. THACKER: Well, that is true but that is -- that's an
13 additional point --

14 JUDGE SMITH: I -- I'm sorry. Okay, I didn't -- maybe you could
15 just, like, re-summarize your argument --

16 MR. THACKER: Yeah.

17 JUDGE SMITH: -- so I understand.

18 MR. THACKER: So what I was -- what I was trying to say is that
19 all it's saying here is that it provides a visual or auditory alert. That
20 disclosure alone is not sufficient to provide written description support for
21 determining a notification method.

22 JUDGE SMITH: For the -- I see. That doesn't --

23 MR. THACKER: Right. So all it's saying is that these are two
24 possible alerts --

25 JUDGE SMITH: Okay.

26 MR. THACKER: -- but that's it. It doesn't say, determine which

1 one to use.

2 JUDGE SMITH: So -- okay, so we're on determining the method.

3 MR. THACKER: Yes.

4 JUDGE SMITH: And so you're saying it discloses determining
5 one alert or the other, but doesn't say how to choose one or the other. There
6 -- there's no support for choosing one or the other?

7 MR. THACKER: Well, correct, but it doesn't even say decide or
8 determine one or the other.

9 JUDGE SMITH: I understand.

10 MR. THACKER: Not only does it not say determine how to do it,
11 but it also just doesn't even say determine which one to use.

12 JUDGE SMITH: Okay. Okay.

13 JUDGE WEATHERLY: So is there some significance to the
14 -- this portion on slide 22 of the specification to the notion that what's being
15 passed through the web service gateway is a visual or auditory alert in the
16 channel 202? Is there some -- does that undermine the argument in your
17 view that an alert that is in that channel, if it's in that channel, it's not the
18 alert that's described in step 1F? My question is pretty terrible, but if you
19 -- if you don't understand it, reframe it for me and we can have a
20 conversation about it.

21 I -- it seems odd to me that you're arguing that the specification for
22 -- the early version of the specification describes sending an alert, but
23 doesn't describe which one of the alerts to send or doesn't describe
24 determining which one of the two to send. In particular, in the context of a
25 written description argument, that really isn't about the sort of specific words
26 that are in the spec, but how a person of ordinary skill would understand

1 them and whether a person of ordinary skill would understand the person
2 who wrote it would be, quote unquote, "in possession" of an invention. So
3 I'm trying to tease out exactly where is the flaw in this portion of the
4 specification in your view. And there may be multiple flaws. Is that a better
5 question for you? Does that --

6 MR. THACKER: Yeah. I mean, I think I -- two responses to that.

7 JUDGE WEATHERLY: Okay.

8 MR. THACKER: One is that if we -- if we turn to slide 4 --

9 JUDGE WEATHERLY: Yeah.

10 MR. THACKER: -- the claim says, determine the notification
11 method by which to provide the alert on the device based on the current state
12 of the device, right. So --

13 JUDGE WEATHERLY: Okay. So the determining has to be
14 more than just which kind of alert, but it has to somehow know some
15 characteristic of the external device, has to know something about the state
16 of the external device, and use that information to do the determining.

17 MR. THACKER: Correct.

18 JUDGE WEATHERLY: Okay. That's your contention?

19 MR. THACKER: Yes.

20 JUDGE WEATHERLY: Yeah. Okay. And so back to slide 22, if
21 this is indeed the only -- is this the best place -- the best part of the spec in
22 terms of providing written description support from your perspective? Like
23 the best candidate? I realize that you don't think it does provide written
24 description support, but is this the closest it comes to spec?

25 MR. THACKER: According to Patent Owner, yes.

26 JUDGE WEATHERLY: Okay.

1 MR. THACKER: And --

2 JUDGE WEATHERLY: And what do you think?

3 MR. THACKER: This is -- I mean, this is the only paragraph that
4 talks about the alerts --

5 JUDGE WEATHERLY: Okay.

6 MR. THACKER: -- at all, so yes.

7 JUDGE SMITH: So the --

8 JUDGE WEATHERLY: Not sure that that's really responding to
9 my question. My question is about what do you think is the best portion of
10 the spec, not what does Patent Owner contend the best --

11 MR. THACKER: Okay. I --

12 JUDGE WEATHERLY: -- portion of the spec to be?

13 MR. THACKER: I would agree that Paragraph 39 is the best
14 portion.

15 JUDGE WEATHERLY: Okay.

16 JUDGE SMITH: Is it --

17 JUDGE WEATHERLY: Still falls short, but --

18 MR. THACKER: Still falls short, yes.

19 JUDGE SMITH: Is it --

20 JUDGE WEATHERLY: But --

21 JUDGE SMITH: Oh, go ahead.

22 JUDGE WEATHERLY: Is -- do you also refer to a different
23 paragraph? I think you characterized the paragraph as preceding, if I'm not
24 -- if I -- my memory is correct. Which other paragraph are you referring to
25 as being perhaps relevant to this issue, or written description, or at least
26 something that the patent owner says is relevant?

1 MR. THACKER: Yeah. So, for example, Patent Owner points to
2 Paragraph 21, where it discloses user preferences, generic -- in the reply, we
3 noted that these were generic preferences that were untethered from the
4 alerts. So unlike Paragraph 130 -- and this is on -- shown on slide 5.
5 Unlike Paragraph 130 of the CIP application, which expressly discloses
6 notification preferences -- so these are notification-specific preferences, and
7 it expressly discloses that those notification-specific preferences impact the
8 determination of the notification method. We have none of this in the 2009.
9 We don't have notification-specific preferences and we don't have any
10 disclosure, express disclosure, that preferences impact the determination of
11 the notification method.

12 JUDGE SMITH: Why wouldn't preferences determine the
13 notification method? I mean, if I say -- you know, I put my phone on
14 vibrate, why would the notification ring my phone if I put it on vibrate?

15 MR. THACKER: So sorry, are you talking about preferences on --

16 JUDGE SMITH: Well, if I select -- I -- yeah, again, I -- I'm just
17 asking the question off the top of my head. Let me rephrase it so it matches
18 the claim more (INDISCERNIBLE). So if I say my preference is, you
19 know, when you -- when you text me, don't have my phone chime, have my
20 phone vibrate. That's my preference.

21 MR. THACKER: Right.

22 JUDGE SMITH: Because I'm going to be in meetings all day,
23 don't chime my phone. Why isn't that enough?

24 MR. THACKER: Well, first of all, that would have to be a
25 preference that the server has, not a preference that's on the end-user device,
26 because these claims are written from the perspective of an apparatus or a

1 server, and that server is -- according to Paragraph 130, the CIP application,
2 that server is respecting user preferences, not the end-user device. So if the
3 end-user device has some setting that the user has set themselves telling the
4 phone what to do based on a message from the server that's telling it to go
5 into alert mode, that's not enough.

6 JUDGE SMITH: So the preferences that they're talking about are
7 set by the user on the end-user device?

8 MR. THACKER: No. What -- oh, in Paragraph 21 of the 2009?

9 JUDGE SMITH: Yeah.

10 MR. THACKER: Well, I think that Paragraph 21 of the 2009 is
11 just talking about general user preferences, and it's not --

12 JUDGE SMITH: But who -- I mean, what device honors those
13 preferences?

14 MR. THACKER: These are preferences that are sort of built into
15 the channel, so presumably it's unclear whether those are on the end-user
16 device or on the server. But even if they were on the server, Mr. Schmandt
17 explained that these general user preferences don't tell a skilled artisan that
18 -- how to provide the alert. For example, if you look at Exhibit --

19 JUDGE WEATHERLY: Are they also not a state of the external
20 device, which is part of what the determining has to be done for -- done
21 based on? In other words, preferences associated with the user may or may
22 not say anything at all about the state of an external device.

23 MR. THACKER: Correct. The user preferences could just be
24 -- I -- you know, what news source I prefer. I prefer CNN to Fox News.
25 And there's just simply nothing in the 2009 application that says that those
26 user preferences are telling the server what to do based on whether the user's

1 device is online or offline. So again, turning back to Paragraph 130 in the
2 CIP application, what it discloses is that there are specific online preferences
3 and offline preferences, and that if, you know, the user is online, for
4 example, the user may prefer to be notified within their active sessions.

5 JUDGE WEATHERLY: Well, but now you're talking about
6 something that sounds more like a current state of an external device, online
7 or offline.

8 MR. THACKER: Right.

9 JUDGE WEATHERLY: And I'm having trouble following
10 whether what you're -- and it's because I'm trying to do more than one thing
11 at the same time. Is this -- that disclosure, is that only found in the CIP?
12 The disclosure of knowing whether the user's device is on -- or the user is
13 online or offline, is that only in the CIP, but not in the parent application?

14 MR. THACKER: The parent application discloses determining the
15 active devices of the user. That's in Paragraph 39.

16 JUDGE WEATHERLY: Okay.

17 MR. THACKER: But it's not what the -- what is missing in
18 Paragraph 39 is any determination of a notification method by which to
19 provide at least one alert on those active devices based on the state of those
20 devices, right. So all the 2009 application discloses is, I've determined
21 active devices, send alert to those active devices.

22 JUDGE WEATHERLY: All right. I think maybe the best way for
23 me to do this is to back you up a little bit and go back to the claim language
24 that's at issue and identify exactly, and with granular precision which claim
25 language you're contending is not supported by the spec. My understanding
26 so far has been that it's the entirety of the limitation that's tagged as 1F in the

1 claim. I don't know if you've tagged it in a different way. When I say 1F,
2 you know what I mean? I'm referring to, "Determining a notification
3 method by which to provide." It's the part at the bottom of column 31 in the
4 patent.

5 So if you could step me through that language and tell me which
6 words or phrases specifically are not supported by the original, the parent
7 disclosure, and then direct me to -- you understand what I'm asking for?
8 Correlate the failures to specific phrases in the claims instead of talking
9 about the claim limitation as a whole in the abstract. Walk me through it, if
10 you wouldn't -- if you wouldn't mind. Have I identified the right portion of
11 the claim that's the problem?

12 MR. THACKER: Yeah, it's -- it -- there's -- I mean, there -- there's
13 no written description support for step F or G, but if we're looking at --

14 JUDGE WEATHERLY: Let me ask about G before you -- so F is
15 where the battle is being fought from my perspective. And G, as I
16 understand it, you're saying that G, which says, "Generating" -- let me see.
17 "Generating notification data according to the determined notification
18 method wherein the notification data is continuing to cause the at least one
19 external device to provide the at least one alert." You focused on, in your
20 slide 2, at least one alert. To me, that seems like a sort of derivative
21 argument. It's not the alert that is introduced in 1F, therefore 1G isn't met
22 anymore. So those two arguments don't really seem to be two arguments to
23 me. They seem to be just variations of the same argument. If I'm wrong
24 about that, that's part of what you need to unravel for me.

25 MR. THACKER: Okay.

26 JUDGE WEATHERLY: You follow what I'm saying?

1 MR. THACKER: Yeah. So just to make sure I hear you clearly, is
2 it that --

3 JUDGE WEATHERLY: The spec clearly does show sending an
4 alert. It's visual or auditory. It shows -- it says that in Paragraph 39. But if
5 it's not the type of alert that's described in 1F of the claim, then I understand
6 an argument that therefore the spec doesn't support 1G either. You see why
7 I consider those things to be a variation of the same argument though? It
8 really all turns on whether the alert that is described in the spec is the kind of
9 alert that's described in step 1F. If it is, then 1G is met also. If it's not, then
10 1G is not met. But it's not -- I don't see any arguments that it's possible to
11 meet the written description requirement for 1F, but not for 1G or vice versa,
12 by the way.

13 MR. THACKER: I agree with that.

14 JUDGE WEATHERLY: Okay. So either they both work or they
15 both fail --

16 MR. THACKER: Correct.

17 JUDGE WEATHERLY: -- according to description.

18 MR. THACKER: Correct.

19 JUDGE WEATHERLY: Okay. Okay. Now, back to 1F and
20 stepping you through the phrases that are set forth in 1F.

21 MR. THACKER: Yeah. So you asked me to identify specific
22 phrases in -- within 1F, which are --

23 JUDGE WEATHERLY: Is the problem with the alert? Is the
24 problem with the external device? Is the problem with the current state of
25 the external device? Is the problem with determining? Or is the problem
26 with all of those things? Or some of those things? With -- and if so,

1 which ones?

2 MR. THACKER: Yeah. I think the real issue here is the
3 -- determining the notification method based on the current state, as --

4 JUDGE WEATHERLY: Okay.

5 MR. THACKER: -- is shown in the highlight on slide 4.

6 JUDGE WEATHERLY: Okay.

7 MR. THACKER: And the reason that we're even discussing the,
8 "By which to provide the at least one alert on the at least one external
9 device," is that when it says, "Provided on the at least one external device,"
10 that presumes that you know when you're sending it. You're sending it to
11 the at least one external device, right. So what this claim language is saying
12 is how? What method am I using to provide the alert?

13 JUDGE WEATHERLY: I think it says, more accurately, figure
14 out what method I'm going to use.

15 MR. THACKER: Yeah, exactly.

16 JUDGE WEATHERLY: That's the act of determining.

17 MR. THACKER: Right.

18 JUDGE WEATHERLY: Okay. And do that --

19 MR. THACKER: So --

20 JUDGE WEATHERLY: -- based on the state of the external -- the
21 current state of the external device.

22 MR. THACKER: That's correct.

23 JUDGE WEATHERLY: Okay.

24 MR. THACKER: And so what -- all we have in the 2009
25 application is send alert to active device.

26 JUDGE WEATHERLY: Without --

1 MR. THACKER: There's --

2 JUDGE WEATHERLY: -- knowing anything at all about the state
3 of that device.

4 MR. THACKER: All -- well, yeah. All I know is that it's active
5 and I'm sending the alert to it. But I'm -- there's no disclosure of figuring out
6 how to provide that alert based on the state of the device. And if we look at
7 Paragraph 130 in the CIP Application -- and this is on slide 5. What the
8 specification here is making clear is that based on the state of the device
9 -- so based on whether it's active or inactive, online, offline, I'm going to
10 figure out what notification method I'm using.

11 If I'm offline or inactive -- if the device is offline or inactive, I'm
12 going to send them a text message. But if they're online or active, I'm going
13 to alert them in their -- within their active session. That is, at least in the
14 2011 CIP, the best disclosure of determining a notification method based on
15 the state of the device.

16 JUDGE SMITH: Well, the -- I mean, based on the original 2009
17 document, the phrase and the 130 -- Paragraph 130, the sentence, "If online,
18 notify the user's active session." So in the -- in the original document you
19 have, determine if the device is online and if it's online, send a -- so at least
20 this sentence in the CIP document, "If online, notify the" -- at least that is
21 supported. So it -- the original document supports, determine if it's online, if
22 it's online, send a message.

23 MR. THACKER: Correct. But that's the only way to provide the
24 alert in the 2009, is you're just determining which devices are active and
25 then you're sending the alert. There's no disclosure of what happens if the
26 device is inactive. As I stated earlier, if the device is inactive in the 2009,

1 there's no alert delivery, because there's no contemplation of any other way
2 to provide the alert.

3 JUDGE SMITH: So the only determining that's supported by the
4 Parent Application is determining the status of the device. And the -- so this
5 phrase, "based on the current state of the at least one device," it -- it's
6 determining the current state of the device. But then once it determines the
7 current state of the device --

8 MR. THACKER: Yep.

9 JUDGE SMITH: -- the determining is over at that point.
10 Everything is predetermined after that. There's no more to determine?

11 MR. THACKER: Correct. The only determining in the 2009
12 Application is where to send the alert, which devices are active. There's no
13 determining of a notification method by which to provide the alert on that
14 device.

15 JUDGE WEATHERLY: Let me ask, is, quote unquote, "active" a
16 state of an external device?

17 MR. THACKER: Yes.

18 JUDGE WEATHERLY: And if the system as described in the
19 Parent Application, Exhibit 1106, describes checking to see if a device is
20 active before and send -- and only sending an alert if the device is active,
21 isn't that a form of determining a notification method based on state of the
22 external device?

23 MR. THACKER: No. The --

24 JUDGE WEATHERLY: It's active, so I'm going to send an alert.

25 MR. THACKER: Right. There's no determining a method by
26 which to provide the alert on that device based on the state of the device.

1 You're either sending the alert or you're not, right?

2 JUDGE WEATHERLY: Yeah. Well -- but you're not, if it's not
3 active. You are, if it is active. Active versus not active appears to me to be
4 discerning a state of the external device. I think you're arguing that there
5 needs to be some kind of disclosure of some kind of alternative notify
6 -- notification method if the device is inactive, but I don't know that I agree
7 that the claim requires that.

8 It's undisputed, very clear, that the CIP goes into a lot more detail
9 about this notification process. It's much more capable. So I mean, at the
10 same time, we're trying to discern the scope of the limitation and then
11 whether the applicant inventors demonstrated that they have possession of
12 the scope that's being asserted. So it's really a two-headed monster here.
13 We keep mixing the two issues together, which is why we're wandering so
14 much in this conversation.

15 MR. MASON: Yeah. So --

16 JUDGE WEATHERLY: I think you're cutting your co-counsel
17 off. He's trying to get your attention so --

18 MR. MASON: Well, if I may just momentarily --

19 JUDGE SMITH: Yeah.

20 MR. MASON: -- Your Honors --

21 JUDGE WEATHERLY: Sure.

22 MR. MASON: -- put it underneath that, I -- hopefully I can just
23 talk.

24 JUDGE SMITH: No. Yeah. I mean, he -- he's already used up his
25 15 minutes, so you can --

26 MR. MASON: Yeah.

1 JUDGE SMITH: -- you can talk as much as you want to.

2 MR. MASON: But -- yeah. No. No. But I want to let him finish.

3 JUDGE SMITH: Yeah.

4 MR. MASON: But just maybe to kind of speak to Judge
5 Weatherly and Judge Smith's questions and maybe get everybody on the
6 same page, I think if we -- yeah. If we have the claim language up here, I
7 think the hypothetical that Judge Weatherly just posed as to whether simply
8 saying, oh, I have an active session, you know, this is -- in the 2009
9 Application --

10 JUDGE SMITH: Right.

11 MR. MASON: -- it's undisputed, it discloses, okay, I -- and this is
12 Paragraph 39, which is the only paragraph that really speaks meaningfully to
13 alerts in that 2009 Application. And it says, okay, I have an alert to send. I
14 determine if there are any devices with an active session. If yes, I just send
15 the alert. There's no further determination that's made.

16 Now, if that satisfied this claim language or provided support for
17 this claim language, that effectively would read out the first line of Clause F.
18 That would read out the "determining a notification method by which to."
19 Instead, you're really just providing as to what --

20 JUDGE WEATHERLY: Guidance that -- that implies that there
21 needs to be more than one notification method to select from -- to determine
22 from?

23 MR. MASON: Correct. Yes. Yeah.

24 JUDGE WEATHERLY: And so is there a portion of the spec later
25 -- you know, the CIP spec, the spec that's at issue in the patent at issue, that
26 supports that kind of interpretation of determining the notification method?

1 And so where is that?

2 MR. MASON: Yes. Yeah. And that -- and that's Paragraph 130.
3 And I would first just submit, on this page, determining a notification
4 method means there -- the claim language has to mean something, so there
5 has to be a choice being made between two things.

6 But to your point, Paragraph 130 of the 2011 CIP talks about this
7 concept, right, where either, you know, there -- there's many notification
8 methods. It can either be via this active session, as was disclosed in 2009.
9 But the 2011 expanded it out to say, I can send this via email, I can send it
10 via text message. I can even -- you know, there's other examples they
11 provide. And so that's why you have to make a determination of the
12 notification method, because there -- there's more than one.

13 JUDGE WEATHERLY: I think what you're also arguing is that
14 the claim doesn't say, providing at least one alert based on the current state
15 of an external device.

16 MR. MASON: Correct. Yeah. I think -- and I think it --

17 JUDGE WEATHERLY: Which would be broader than
18 determining a method -- a notification method by which to provide an alert.

19 MR. MASON: Yes. That is correct.

20 JUDGE WEATHERLY: Okay.

21 MR. MASON: I think Patent Owner's arguments and its position
22 would effectively read out the "determining a notification method by which"
23 language from Clause F, and is --

24 JUDGE WEATHERLY: As if this claim -- this Clause F read
25 "providing at least one alert on the one external" --

26 MR. MASON: Yes.

1 JUDGE WEATHERLY: -- "device based on the current state of
2 the at least one external device"?

3 MR. MASON: Yeah.

4 JUDGE WEATHERLY: You're conceding that the parent spec
5 does describe providing an alert based on the state of an external device?

6 MR. MASON: Yeah. Yes. The Parent Application does describe
7 --

8 JUDGE WEATHERLY: Okay.

9 MR. MASON: You know, it says, I need to send an alert. I
10 identify the active sessions. And then there's no -- after that, there's no
11 choice between --

12 JUDGE WEATHERLY: Okay.

13 MR. MASON: -- different methods for notifying the user --

14 JUDGE WEATHERLY: All right.

15 MR. MASON: -- different methods for providing the alert. It
16 simply just sends the alert, and it's always sending it through this channel.
17 And it's always sending it -- yes. It's always sending it through the channel,
18 and it's always sending info for HTTP.

19 JUDGE WEATHERLY: Okay.

20 MR. MASON: So the protocol is always the same, and the manner
21 in which the user sees it is always that kind of odd grid-based format that's
22 on the user device.

23 JUDGE SMITH: So the disclosed -- the -- what was it? Visual or
24 auditory alerts --

25 MR. MASON: Uh-huh.

26 JUDGE SMITH: -- in the original patent, those aren't included in

1 the notification that's sent? It's only the receiving device that does that or --

2 MR. MASON: There's no discussion. And if you look at the 2009
3 Application, it says, you know, in this -- within this grid-based format,
4 things can be presented in an audio format, in visual format. It just -- you
5 know, basically it's saying -- describing the different things that can be
6 presented.

7 And then in Paragraph 39, which is on slide 22 of our
8 demonstratives, this is the only paragraph where it talks about how the alert
9 is provided, and it just -- all it says -- well -- and actually it's not in this
10 portion here, because this is just an excerpt of Paragraph 39, but it just says,
11 provide an audio or visual alert. And there's no -- it -- there's no --

12 JUDGE SMITH: No. It's there on that last line.

13 MR. MASON: -- determination -- oh, yeah. "To provide a visual
14 or auditory alert in the channel." And it never says, you know, make a
15 determination as to whether this alert should be provided as visual or
16 auditory. It presumes that it knows what type of alert to provide. It never
17 discloses, never describes a choice being made.

18 JUDGE SMITH: So the -- if we -- in order to find support for the
19 "determining the notification method" we would have to say that this phrase
20 "to provide a visual or auditory alert" means that after the device determines
21 that a -- an external device is online and determines that a notification needs
22 to be sent, that device then figures out which one of these visual or auditory
23 alerts to use -- to include with the alert to cause the alert to be either visual
24 or auditory. But the -- none of that is just in this phrase "provide a visual" --

25 MR. MASON: It's certainly not expressed in anything in the 2009
26 Application, and we don't think it's implicit either. There's just -- in 2009, if

1 you read the entire application, the -- what they were focused on is just
2 providing everything through this active session --

3 JUDGE SMITH: And the --

4 MR. MASON: -- through their own framework.

5 JUDGE SMITH: -- the Provisional Application doesn't have any
6 discussion of determining?

7 MR. MASON: The -- no. The Provisional Application does not
8 have any discussion of determining, and Patent Owner has not argued that
9 either.

10 JUDGE SMITH: Okay.

11 MR. MASON: They have not -- they have not made any
12 arguments about the 2008 Provisional providing written description for it.

13 JUDGE SMITH: Okay. Okay.

14 MR. MASON: They discussed it as background, but -- and as the
15 claim construction, but not in the -- on this issue. I -- yeah. So I think, you
16 know, just summing up on this point now. I'll pass it off to --

17 JUDGE SMITH: Okay.

18 MR. MASON: -- Mr. Thacker on the second point. But it
19 -- really, in 2009, there was no choice, no determination to be made. It was
20 like once you knew that there was an active session or active device, you just
21 sent the alert.

22 JUDGE WEATHERLY: Is it true that there was no determination
23 being made or is it --

24 MR. MASON: Well, there's a --

25 JUDGE WEATHERLY: -- or is it more accurate to say --

26 MR. MASON: Yeah.

1 JUDGE WEATHERLY: -- that they -- there's no description of
2 how the determination is made? I mean, it -- to me it implies -- if you say
3 I'm going to send a visual or auditory alert -- implied is that you're going to
4 determine which one to send. But what's not implied is how you determine
5 which one to send.

6 MR. MASON: Yes. I -- yeah. I agree that it's certainly not -- it's
7 not disclosing how to make that determination, and it's really -- it -- it's
8 really not even, you know, kind of --

9 JUDGE WEATHERLY: It's a little bit of a stretch even to say that
10 it implies that it's going to determine?

11 MR. MASON: Yeah. It's a stretch to say it's implying. It really is
12 just a -- it's an afterthought, and just, you know --

13 JUDGE WEATHERLY: Or even that the standard were to apply,
14 is whether a skilled artisan would consider the inventors to be in possession
15 of that determining method --

16 MR. MASON: Exactly.

17 JUDGE WEATHERLY: -- the how?

18 MR. MASON: Would someone -- would the public reading this
19 document think, oh, the inventors possess this?

20 JUDGE WEATHERLY: No. It's the public reading the document.

21 MR. MASON: Yeah. Sorry. Yeah. Skilled artisan -- skilled in
22 the art. Fair point.

23 JUDGE SMITH: Or even where the visual or auditory is
24 determined. If -- you know, going back to the earlier example of setting a
25 phone on vibrate, I mean, that's not done -- that wouldn't be done in the
26 server, so it may be --

1 JUDGE WEATHERLY: Right. That could be the external device
2 itself doing the determining, I just got an alert, but I'm set at -- to only
3 vibrate --

4 JUDGE SMITH: Yeah.

5 JUDGE WEATHERLY: -- so I'm going to vibrate instead of
6 providing your notification.

7 JUDGE SMITH: Yeah.

8 MR. MASON: Yeah. And yes. That -- that's correct. But again,
9 even that, it would only happen in the 2011 alleged invention, because --

10 JUDGE WEATHERLY: Okay.

11 MR. MASON: -- by that -- before 2011, they did not contemplate
12 sending it by any means other than through this active session, through their
13 --

14 JUDGE WEATHERLY: How much of a distinction between the
15 Parent Application, the 2009 Application, and the CIP is there on the
16 concept of external devices? Are external devices -- and I -- I'm revealing
17 how -- frankly, how little I know about the details of this case, and I
18 apologize for that.

19 MR. MASON: Yeah. No. It's -- I -- if I --

20 JUDGE WEATHERLY: We're here, and I want to be as efficient
21 as possible.

22 MR. MASON: Yeah. Yeah. Your question is what discussion of
23 external devices is different between the two?

24 JUDGE WEATHERLY: Right. Right. How much discussion of
25 external devices at all exist in those previous applications --

26 MR. MASON: I know --

1 JUDGE WEATHERLY: -- separate and apart from this Channel
2 202? And that's accessible via the web services gateway?

3 MR. MASON: I -- I'm not able to speak kind of generally as to all
4 the differences, but one key difference that I know of between the 2009 and
5 the 2011 is that in 2009, what they were -- when they were contemplating
6 these external devices, it was that everything on these external devices that
7 was happening under this alleged invention was through that active session
8 --

9 JUDGE WEATHERLY: Okay.

10 MR. MASON: -- was through the special grid-based application --

11 JUDGE WEATHERLY: Okay.

12 MR. MASON: -- that was running on those devices. But in 2011
13 -- and this is --

14 JUDGE WEATHERLY: By active session, you're talking about,
15 like, an HTTP connection?

16 MR. MASON: Well, yeah. It's this web-based application that's
17 actually -- I think it's -- you know, if you look at slide -- I think it's on slide
18 22, this channel grid -- this channel grid, it's -- this idea of having an
19 application that pops up, and via web protocol, they're feeding all the
20 different information there. So in 2009, they really only contemplate
21 providing information or alerts through that grid channel application.
22 Whereas by 2011, the inventors, you know, described, we want to provide
23 information and alerts via other means when possible now. Right. We want
24 to provide it -- you know, the -- we don't -- we can't find any active sessions,
25 so we need to email the user now, or we need to text the user now. And
26 that's when the need for a choice arose.

1 JUDGE SMITH: You're going into your rebuttal time --

2 MR. MASON: Yeah. We're going into rebuttal.

3 JUDGE SMITH: -- which you're -- which you're free to do. I
4 don't want to --

5 MR. MASON: Yeah. Yeah. No. I want to just -- so -- and to an
6 earlier point that Judge Weatherly raised -- so I think -- you know, as to
7 what claim language is important here, I -- I've spoken to Issue 1, which is
8 that there's just no support whatsoever for this determining a notification, the
9 determining step is -- we'll just call it.

10 The second issue is whether the 2009 Application provides full-
11 scope support -- full-scope written description support for the "at least one
12 alert" claim language. And Mr. Thacker will speak to that beginning on
13 slide 14 of our demonstratives. But that's -- that is a separate and
14 independent reason why there is no written description support.

15 JUDGE SMITH: Be mindful that you're already in the rebuttal
16 time, by the way.

17 MR. MASON: He'll take three minutes.

18 MR. THACKER: Yeah. I can make this shorter. So the claims
19 that we saw earlier recite "at least one alert." And it is undisputed that this is
20 a broad category of alerts that encompasses tactile alerts. But in the 2009
21 Application, the applicants described only a visual or auditory alert. That
22 was it. They -- the language in Paragraph 39 does not say, provide an alert,
23 for example, a visual or auditory alert. It only discloses "a visual or auditory
24 alert."

25 So turning to slide 12 and 13, we can see what happened between
26 the 2009 Application and the 2011 Application. In 2011, now, Applicant is

1 -- and this is shown on slide 13. This is Paragraph 93 of the CIP. Applicant
2 is now saying, oh, well, examples of types of alerts may include, but are not
3 limited to, visual, auditory, tactile, et cetera.

4 So we cited several cases in our briefing, including D Three and
5 Gentry Gallery that support this idea that disclosure of two specific types
6 -- limiting disclosure of two specific types does not provide support for a
7 broad category. Now, Patent Owner's surreply did not address D Three or
8 Gentry Gallery.

9 JUDGE WEATHERLY: So that's a variation full scope of the
10 claims described?

11 MR. THACKER: Correct. There there's simply just no disclosure
12 of the broad category, right? It -- it's different than, like, Falkner --

13 JUDGE WEATHERLY: No. I think -- I don't think that's true.
14 There is a disclosure of the broad category, but the full breadth of the
15 category is disclosed differently in two applications, is what I understand
16 your argument to be. And it needs the -- and the fleshier disclosure of the
17 category in the 2011 Application does fully describe the full scope of the
18 claim. But the skinny disclosure, only having two species inside the
19 category, visual and auditory, isn't sufficiently broad to cover the full scope
20 of what the claim covers.

21 I realize I'm putting words in your mouth, but it's my attempt to try
22 to understand the nuance of your position. And this is a tough argument to
23 make and to lean on and, frankly, to defend against. And I'm unafraid to
24 struggle in front of the parties.

25 MR. THACKER: Well --

26 JUDGE WEATHERLY: And all I can do is promise you that we'll

1 work hard to resolve our struggle by the time we write a final written
2 decision. And I hope that the parties will at least conclude after we do that.
3 We'll understand how we resolved it, somebody is going to be unhappy. I'm
4 used to that. Everyone -- it's always true that someone is unhappy with
5 something I write in the final written decision.

6 Have I understood how you're arguing this correctly? Am I off
7 base in describing it as -- you understand why I say it -- it's not true that both
8 specs don't describe the broad category? The category is alert. That's a very
9 broad category, very abstract. Saying that the alert could be visual or
10 auditory, that certainly are -- those certainly are examples of alerts. It's not
11 the same list of examples that's provided in the later specification.

12 MR. THACKER: But it's not saying that they're examples. It's
13 saying that those are the only possibilities.

14 JUDGE WEATHERLY: No. No.

15 MR. THACKER: It says -- it doesn't say or --

16 JUDGE WEATHERLY: It's not saying they're the only
17 possibilities either. It implies that maybe. And of course they're examples.
18 It doesn't have to use the word example for visual or auditory to be read as
19 examples of an alert in my view. I mean, that -- if you just say a list of
20 things, you don't have to introduce your list as "for example" for the things
21 in your list to be examples. Grammatically, I don't think that's necessary,
22 and I hope that's not what you're arguing.

23 MR. THACKER: Well, the -- I think it's distinguishable from
24 Falkner, and this is shown on slide 19, where --

25 JUDGE WEATHERLY: From Falkner? Tell me what Falkner is.

26 MR. THACKER: Yeah, so Falkner v. Inglis, this is 448 F.3d 1357

1 --

2 JUDGE WEATHERLY: Okay. Okay.

3 MR. THACKER: -- Fed. Cir. 2006.

4 JUDGE WEATHERLY: Okay.

5 MR. THACKER: And this was quoted by the Reply (Paper 25), at
6 20. But there, the specification said -- described the broad category of pox
7 virus, and then said, "e.g. vaccinia virus." And there, the federal circuit
8 found, no, it's not limited -- this disclosure is not limited to the vaccinia
9 virus. And that's different than what we have here where it just says provide
10 a visual or auditory alert.

11 JUDGE WEATHERLY: Okay. I think we understand your
12 argument.

13 MR. THACKER: Okay.

14 JUDGE WEATHERLY: You -- you're saying it is because it only
15 discloses two, it's limited to two, and it doesn't identify them as examples so
16 -- I -- yeah. I think we get it.

17 MR. THACKER: Okay.

18 JUDGE WEATHERLY: Okay. All right. And was there any
19 other point you wanted to make in this issue? I don't want you to take too
20 much of your rebuttal time.

21 MR. THACKER: No. I'd like to reserve my remaining time for
22 rebuttal.

23 JUDGE WEATHERLY: Okay.

24 JUDGE SMITH: Remind me again how much time did you want
25 for rebuttal?

26 MR. PRICE: I believe I asked for 15 minutes rebuttal.

1 JUDGE SMITH: Fifteen. Okay. Yeah. I just want to know when
2 to remind you what -- so -- all right. So you have 45 minutes with just 30
3 minutes now and 15 for rebuttal. You may begin when ready.

4 MR. PRICE: Thank you, Your Honor.

5 And may it please the Board. So as was discussed during the
6 opening argument, the issue here is whether or not the claims of the '948
7 Patent are sufficiently supported by written description in the 2009 Parent.
8 If they are, then Austin-Lane, for example, is not prior art. 2009 Parent is
9 not prior art. I'm sorry. The PCT is not prior art.

10 And through the course of the briefing, there were these four
11 terms. There's three bullets, four terms.

12 JUDGE WEATHERLY: Which slide are you on?

13 MR. PRICE: I'm on slide 3 right now.

14 "Determining a notification method," which was obviously --

15 JUDGE WEATHERLY: I asked for the benefit of the record.

16 MR. PRICE: -- which is obviously the most discussed limitation,
17 "Providing an alert," and then "Providing an alert to the at least one external
18 device." And I assume based on Petitioner's reply, which didn't address this
19 limitation in the presentation today, that Petitioner doesn't dispute that
20 there's written description for providing at least -- an alert to the at least one
21 external device.

22 JUDGE WEATHERLY: I think I disagree with you.

23 MR. PRICE: I'm sorry?

24 JUDGE WEATHERLY: I disagree with you on that --

25 MR. PRICE: You disagree?

26 JUDGE WEATHERLY: -- that there's no dispute. To me, the

1 dispute about 1F and 1G are tied together. They either both win or they both
2 lose, but that doesn't mean there's no dispute in that. There is a dispute but --

3 MR. PRICE: You --

4 JUDGE WEATHERLY: -- it's not important, honestly, because
5 what I'm trying to -- all I'm trying to do is resolve the dispute, but I'm not
6 going to let you say something like the petitioner does not dispute --

7 MR. PRICE: Oh, no, no, no. Thank you, Your Honor. But I do
8 want to understand. So my argument about there not being a dispute was
9 about specifically that third limitation, which is the "Providing a -- an alert
10 to the at least one external device." That --

11 JUDGE WEATHERLY: The key is the word alert. Petitioner is
12 disputing whether what's provided to the external device that's described in
13 the 2009 Application is a, quote unquote, "alert" as claimed.

14 MR. PRICE: Okay. I understand your point. The only point I
15 would like to make is this third limitation --

16 JUDGE WEATHERLY: Yeah.

17 MR. PRICE: -- was all about whether or not you were supposed to
18 send live alerts to both offline devices and online devices. That -- that's
19 where the dispute over that last limitation came up.

20 JUDGE WEATHERLY: Yeah. Yeah.

21 MR. PRICE: Your Honors discussed that limitation in the
22 institution decision and it really -- we -- and we addressed it in our POR and
23 I'm --

24 JUDGE WEATHERLY: And I --

25 MR. PRICE: -- happy to talk about it.

26 JUDGE WEATHERLY: By the way, the way that you've put that

1 on the slide, you sort of distilled claim limitations down to these tiny phrases
2 out of context --

3 MR. PRICE: Uh-huh.

4 JUDGE WEATHERLY: -- is something that I can't afford to let
5 you get away with.

6 MR. PRICE: Understood. We -- and --

7 JUDGE WEATHERLY: And I'm going to -- just like I dragged
8 Petitioner back into the claim, if that's the way you're going to continue to
9 present the argument, I'm going to drag you back into the claim also.

10 MR. PRICE: It's not -- I -- it is not. We will talk in detail about --

11 JUDGE WEATHERLY: Okay.

12 MR. PRICE: -- the actual language of the claims, and I'm happy to
13 answer any and all of your questions --

14 JUDGE WEATHERLY: I'm saying that so that we can not waste
15 time with me dragging anyone anywhere.

16 MR. PRICE: Understood. Okay. So thank you, Your Honor. I'm
17 going to jump right into the "determining a notification method" --

18 JUDGE WEATHERLY: Yes.

19 MR. PRICE: -- limitation. I think as Your Honor brought up in
20 the opening argument, there is a claim construction aspect here and whether,
21 you know, there's a dispute between the parties over whether or not
22 determining --

23 JUDGE WEATHERLY: Which slide are you on?

24 MR. PRICE: I'm on Page 10.

25 JUDGE WEATHERLY: Page 10. Okay.

26 JUDGE SMITH: Yeah. If you don't mind, just call out -- when

1 you change slides, just call out, so we know what -- and then the court
2 reporter also knows.

3 MR. PRICE: Yes, Your Honor.

4 JUDGE SMITH: Okay. Thank you.

5 JUDGE WEATHERLY: It also makes the transcript a lot easier
6 for us later.

7 MR. PRICE: Yes, Your Honor. So on Page 10, we have this
8 claim construction issue that -- it did not come up much during the opening
9 argument, but the parties do dispute whether or not determining a
10 notification method actually requires what the parties have referred to as the
11 third aspect, which is determining how the alert will be presented on the
12 external device. We don't think that's a limitation of the claims. We think
13 that it -- Petitioner is reading that limitation into the claims. All we need to
14 know is -- are -- is the -- is there a disclosure of determining a notification
15 method by which to provide at least one alert?

16 A notification method does not require that you specify exactly
17 how it behaves on the external device. All it requires is determining which
18 devices to send it to and how you're sending the alert. You know, Paragraph
19 39 of the 2009 Parent Application, for example, has an embodiment where
20 the device itself makes the determination of how to present it. You know,
21 that's the last sentence in Paragraph 39.

22 JUDGE WEATHERLY: Be more concrete when you --

23 MR. PRICE: I'm sorry?

24 JUDGE WEATHERLY: What do you mean by that?

25 MR. PRICE: So the last paragraph in Paragraph 39 says, "The
26 alert can appear as defined on other platforms, such as a mobile device, a

1 television, a Blu-ray player, and other devices." And this is important,
2 because if you read through the petition, the main argument -- one of the
3 main arguments is merely sending -- determining to send a text message to
4 an external device is sufficient. And we can look, for example --

5 JUDGE WEATHERLY: Is sufficient, meaning it's --

6 MR. PRICE: It's sufficient to determine the notification method.

7 JUDGE WEATHERLY: -- it's within the -- it's within the scope of
8 the claim?

9 MR. PRICE: It's within the scope of the claim.

10 JUDGE WEATHERLY: Okay.

11 MR. PRICE: There's no -- you know, there is an embodiment, and
12 it's in the 2009 specification, when we get there about how the system
13 determines how it's presented, right? This -- the idea of providing a visual
14 alert in the channel means that you've decided how to present that alert on
15 the device.

16 JUDGE WEATHERLY: Okay.

17 MR. PRICE: So -- but we don't think that the claims are -- require
18 the -- this third aspect, which is how to present the alert on the device.

19 JUDGE WEATHERLY: When you say how to present, do you
20 mean to be saying, pick among the method of notification?

21 MR. PRICE: Sure. Visual or auditory.

22 JUDGE WEATHERLY: Okay.

23 MR. PRICE: Or, you know --

24 JUDGE WEATHERLY: And -- or/and -- as distinct from, like,
25 how to get the alert from the sender to the receiver?

26 MR. PRICE: Well, and that's aspect, too. That's the -- you know,

1 that's choosing, okay, I'm going to send it via text message. I'm going to
2 send it via an email. I'm going to send it via the channel. I'm going to send
3 it via --

4 JUDGE WEATHERLY: Okay. So --

5 MR. PRICE: -- a channel application that uses HTTP. I'm going
6 to use a channel application that uses SMPT (sic) for email.

7 JUDGE WEATHERLY: -- so when your slide 10 talks about how
8 the alert will be presented or how to send the alert, "how to send" refers to
9 the mechanism for transmitting the alert.

10 MR. PRICE: Right. And I think the parties talked about a
11 protocol, for example.

12 JUDGE WEATHERLY: And how the alert will be presented
13 refers to the type of alert that occurs.

14 MR. PRICE: Well, it -- it's specifically how it's presented on the
15 device. If I get a text message, I'll get a little bubble, right?

16 JUDGE WEATHERLY: Yeah.

17 MR. PRICE: If I get an email, I'll get --

18 JUDGE WEATHERLY: Is it presented visually? Is it presented --

19 MR. PRICE: Right. Yeah. Am I going to get -- am I also going to
20 get a ding when it comes through, right? And those things are disclosed.

21 We just don't think that they're necessary parts of determining an --

22 JUDGE WEATHERLY: They're disclosed in the CIP?

23 MR. PRICE: They're -- no, they're certainly disclosed in the CIP.
24 I don't think there's any --

25 JUDGE WEATHERLY: No --

26 MR. PRICE: -- issue there. They're disclosed in the 2009

1 application and I will get to that point. This is --

2 JUDGE WEATHERLY: Yeah.

3 MR. PRICE: I -- I'm trying not to confuse the claim construction
4 and --

5 JUDGE WEATHERLY: Okay. Has the petitioner, on their slide
6 22 -- have they focused on too little of Paragraph 39 from the 2009 --

7 MR. PRICE: They both are reading Paragraph 39 too narrowly --

8 JUDGE WEATHERLY: Okay.

9 MR. PRICE: -- one. And they're ignoring a lot of other
10 disclosures.

11 JUDGE WEATHERLY: Okay.

12 MR. PRICE: Including -- and admissions from their expert.

13 JUDGE WEATHERLY: Okay.

14 MR. PRICE: Which very clearly explain that all of this stuff
15 happens. The determination happens by --

16 JUDGE WEATHERLY: Okay.

17 MR. PRICE: And I'll get there, but by looking at the user's
18 prefaces. Okay. So I -- just, you know, to talk about what providing an alert
19 on at least one external device means, this is Paragraph 39. If an established
20 --

21 JUDGE SMITH: Which line are you on?

22 MR. PRICE: I'm -- oh, I'm sorry. I jumped back to Page 8 but I
23 didn't mean to. I'm -- -- I'm on Page 11 now. So continuing claim
24 construction, Petitioner didn't argue for its narrow construction in the district
25 court.

26 JUDGE WEATHERLY: I don't care.

1 JUDGE SMITH: No. We understand that's your argument, but
2 that's not going to help us resolve this issue.

3 MR. PRICE: I --

4 JUDGE SMITH: If you want to spend time on it, it's your time,
5 but --

6 JUDGE WEATHERLY: Yeah.

7 JUDGE SMITH: You know.

8 MR. PRICE: I -- they are articulating two different constructions
9 in the two proceedings.

10 JUDGE WEATHERLY: As is typical of the (INDISCERNIBLE).

11 MR. PRICE: It's not typical and there are now cases, both Revvo
12 and Tesla, which --

13 JUDGE WEATHERLY: I'm the author of the Revvo --

14 MR. PRICE: Okay. Well --

15 JUDGE WEATHERLY: So we entered our -- we entered our
16 institution decision yesterday.

17 MR. PRICE: Okay.

18 JUDGE WEATHERLY: So the director --

19 MR. PRICE: I won't spend any more time on it. I'm onto Page
20 -- I'm onto Page 12.

21 JUDGE WEATHERLY: Yeah.

22 MR. PRICE: So again, Petitioner's overly narrow construction
23 imports limitations and excludes embodiment. So this is my point is that
24 this excludes the embodiment where the user's device says, okay, when I get
25 a text message, it's going to ding or it's going to be silent, right. So that's an
26 embodiment in the specification. Determining a notification method doesn't

1 exclude that embodiment, so it would be improper to require that third
2 aspect to be part of the construction.

3 Moving on to Page 13, now we're getting into the disclosure. Even
4 if Your Honors think that the claims require the notification method to
5 actually specify at the server how the alert is going to be presented on the
6 external devices, that is --

7 JUDGE SMITH: Which -- before we get to that, let me just make
8 sure. So on slide 11 here, you're saying that the claims determine a
9 notification method in step F based on the current state of the external
10 device. It's determining whether to send -- so you're pointing to this is what?
11 Testimony from the expert?

12 MR. PRICE: This is testimony from Petitioner's expert and --

13 JUDGE SMITH: Okay. Let me just take a step back then. Just
14 the original disclosure, the parent application, does it disclose sending -- you
15 can either send email or text message or --

16 MR. PRICE: Yes.

17 JUDGE SMITH: -- some other --

18 MR. PRICE: Yes. So if we turn to -- let me move to the slides
19 because --

20 JUDGE SMITH: Okay.

21 MR. PRICE: -- I have slides specifically --

22 JUDGE SMITH: Okay.

23 MR. PRICE: -- about that. Okay, so I'm on slide 14. So this is
24 about determining how to send the alert. You know, what protocol --

25 JUDGE SMITH: Okay.

26 MR. PRICE: -- for example. So Petitioner's argument is that the

1 2009 Parent discloses only using a predetermined HTTP protocol. That's not
2 true. So the 2009 Parent also discloses preventing -- presenting alerts via an
3 email application or a text application and those applications use different
4 protocols. There's nothing --

5 JUDGE SMITH: Okay. So --

6 MR. PRICE: Yeah.

7 JUDGE SMITH: -- so it's determining, but if I have either text or
8 email -- okay, so if I have a device, let's say I have a phone, but let's see, I
9 guess is the alert coming to a phone?

10 MR. PRICE: It can. That's one of the external devices is a mobile
11 phone.

12 JUDGE SMITH: In the original application --

13 MR. PRICE: Oh, for sure.

14 JUDGE SMITH: -- what -- okay. So the alert could be either
15 SMS or text. And it's determining whether to send SMS or email based on
16 the current state of the phone?

17 MR. PRICE: Okay. So I can jump right into this. So I want to
18 talk about Pages 15 and -- slides 15 and 16. And I'm going to walk through
19 this bit, because I think it will answer all of these questions. Paragraph 20,
20 in -- let me actually just step back. This whole invention is about how to
21 present information across different computing platforms. So it assumes the
22 user has many different kinds of devices, desktop computers, mobile phones,
23 any kind of device that's -- you know, there's a laundry list of possible
24 external devices disclosed in the 2009 Parent at Paragraph 20. Servers,
25 networks of servers, desktop computers, laptop computers, tablet computers,
26 network computing devices.

1 The point is that these are all different platforms and presenting
2 data on these different platforms is a challenge. So what does the 2009
3 Parent tell you about that? Users may define the type and the manner of
4 delivery of information. These -- and information should be broadly
5 interpreted to include, by the way of non-limiting samples, any appropriate
6 type of content or data. So what does this say? Users -- you have user
7 preferences. You determine which devices you're -- you know, you set up
8 all your devices, you set up your user preferences about how each one is
9 going to receive and present information. That's the -- and if we can look to
10 their expert, Mr. Schmandt's testimony about this -- and this is on Page 26 of
11 our patent owner response: "So you agree that the PCT publication teaches a
12 user profile that identifies user preferences as to how the user wishes
13 information to behave on a selected platform?

14 "Yes."

15 "Is an alert information?"

16 "My answer to your question is yes."

17 So Paragraph 20 tells you that the user is given user preferences to
18 determine how the type and the manner of delivery of information. So this
19 idea that the -- this 2009 Parent only discloses providing alerts through a
20 channel, only discloses HTTP alerts through that channel. It's just not true.
21 There is no limit -- limitation in this 2009 Parent about which types of
22 -- about how the user is --

23 JUDGE WEATHERLY: So does the parent describe determining
24 a notification method using user preferences --

25 MR. PRICE: Of course. Yes.

26 JUDGE WEATHERLY: And --

1 MR. PRICE: And --

2 JUDGE WEATHERLY: -- is that a variation of determining the
3 method?

4 MR. PRICE: That is how the method is determined. Yes.

5 JUDGE WEATHERLY: Based on a current state of the external
6 device?

7 MR. PRICE: Yes. So --

8 JUDGE WEATHERLY: How are user preferences representative
9 of a current -- a state of a, quote, "current state" of the at least one external
10 device?

11 MR. PRICE: Okay. So Paragraph 20 again, you know, says, the
12 users may define the type and the manner of the delivery of information. It
13 could be any type. So again, this idea that, you know -- when we then go to
14 Paragraph 39 on Page -- on slide 16 --

15 JUDGE WEATHERLY: You're not answering my question.

16 MR. PRICE: Sorry. Can you repeat the question then so I --

17 JUDGE WEATHERLY: Yes.

18 MR. PRICE: Yes.

19 JUDGE WEATHERLY: I asked first, is -- are user preferences
20 -- is the determining a notification method as described in the 2009 Parent
21 based on user preferences, and I believe you said yes. And then I asked are
22 user -- or I was trying to ask, but you actually interrupted me while I was
23 asking.

24 MR. PRICE: I apologize.

25 JUDGE WEATHERLY: Are user preferences a type of current
26 state of the at least one external --

1 MR. PRICE: No, Your Honor. What happens -- and this is how
2 the prior art works as well in Austin-Lane, for example. This is just -- this is
3 how it works. (INDISCERNIBLE) is you -- there -- there's certainly here
4 the disclosure in 39, which we don't dispute that the system determines
5 which subscribers are active. And then it will consult the user preferences to
6 determine how to send that information to those active devices. So to
7 answer your question specifically, there will be user preferences that say, I
8 want to receive a visual alert in this channel for this specific alert, right. The
9 -- and again, we go back to -- Paragraph 23 talks about the assignment of
10 event alerts. It's not, you know -- it's not hard coded --

11 JUDGE WEATHERLY: When you say Paragraph 23, are you
12 referring to the 2009?

13 MR. PRICE: This is all the -- I -- I'm not -- I'm not talking about
14 the CIP at all unless I --

15 JUDGE WEATHERLY: I'm just trying to make a record of this.

16 MR. PRICE: And so how this works is you look to see which
17 devices are online and then you determine how you look at the user
18 preferences which define how that alert is going to be --

19 JUDGE WEATHERLY: And I think you understand my question
20 is that -- is directed to when you use user preferences like that, is that the
21 same thing as determining a notification method based on the current state of
22 the external device?

23 MR. PRICE: Of course it is, because if you have --

24 JUDGE WEATHERLY: You're not letting me finish my question.

25 MR. PRICE: I -- I'm so sorry.

26 JUDGE WEATHERLY: And it's very, very frustrating for me and

1 you can probably tell.

2 MR. PRICE: I can tell.

3 JUDGE WEATHERLY: And it's why I like doing things in
4 person. So you got to stop doing that. You got to stop talking over me,
5 okay?

6 MR. PRICE: Yes.

7 JUDGE WEATHERLY: Let me finish my question because every
8 word of my question is important and when you start talking before I finish
9 answering -- asking my question, it tells me you're not listening to my
10 question. And when you're here, I need you to respond to my questions.

11 MR. PRICE: I understand. Please proceed.

12 JUDGE WEATHERLY: You understand the disconnect that I'm
13 putting my finger on here?

14 MR. PRICE: I think I don't understand it. So --

15 JUDGE WEATHERLY: Okay. The disconnect I'm putting my
16 finger on here in your argument is you're saying, our original spec describes
17 user preferences which are used to figure out what type of notification to
18 send and our original spec also, for lack of a better word, polls the external
19 devices to see which ones are active. And then it sends the type of
20 notification to the external devices that are active based on user preferences.
21 This claim says determining a notification method based on the state of the
22 external device, not based on user preferences. Does that matter? Are user
23 preferences a type of state of the external device?

24 MR. PRICE: Okay. I think I now understand your question on it,
25 Your Honor. We don't think that every aspect of the notification method
26 necessarily has to be based on, you know -- all three aspects necessarily

1 have to be an option based on the state of device, but it is disclosed because
2 --

3 JUDGE WEATHERLY: Why? Doesn't -- isn't that what your
4 claim says?

5 MR. PRICE: We -- you determine the notification method based
6 on the state of the device.

7 JUDGE WEATHERLY: Right.

8 MR. PRICE: So when I determine that I have -- maybe I have five
9 external devices and I'm going to determine my notification methods based
10 on, you know, there are -- two of them are online, two -- three of them are
11 offline. So I'm -- I know my notification methods now are going to be
12 specific to the devices that are online and when I figure out how to alert that
13 user with those devices, those are defined in user preferences.

14 JUDGE SMITH: You only have support for determining which
15 devices are online and sending a -- I mean, well, let me take a step back.
16 The only disclosure we have of the current state of the external device is
17 online is the current state of the device and offline is the current state of the
18 device.

19 MR. PRICE: So the way it works is there's what's called session
20 data. And if your device is online, the session data --

21 JUDGE SMITH: Yeah. I didn't ask the question yet. I was just
22 making a statement. I don't -- so my question is: Are there any other states
23 of an external device other than online or offline? Are those the only two
24 external states of the device?

25 MR. PRICE: As far as I know, Your Honor, those are the only two
26 --

1 JUDGE SMITH: Those are the only two.

2 MR. PRICE: -- external states.

3 JUDGE SMITH: And there's support in the parent application for
4 determining if a device is online and, if so, sending that device a message.
5 But in terms of determining a notification method -- once a determination is
6 made that the device is online, after that, the notification method, that
7 doesn't depend on the current state of the device; is that correct?

8 MR. PRICE: Well, I think it does because it will determine not to
9 send whatever the preferred notification is to the devices that are offline.

10 JUDGE SMITH: So determining not to send a message is
11 determining a notification method?

12 MR. PRICE: Well, I --

13 JUDGE SMITH: Not notifying --

14 MR. PRICE: I would say determining to send it to the ones that
15 are online, not the ones that are offline, is determining a notification method
16 based -- by which to provide at least one alert --

17 JUDGE SMITH: I mean, it's --

18 MR. PRICE: Because -- and this is important, because one of the
19 things that came up with this limitation is that you don't even have to send
20 the alerts to all of the online devices, right. The -- this determining a
21 notification method to the at least one -- at least one external -- at least one
22 alert on the at least one external device, right. So this --

23 JUDGE WEATHERLY: When you say you don't have to, you
24 mean to be within the scope of the claim? You don't need to -- you don't
25 need to? Are you saying --

26 MR. PRICE: I -- to be within the scope of the --

1 JUDGE WEATHERLY: Or are you saying something about what
2 the 2009 spec describes? I --

3 MR. PRICE: So I'm looking -- this is just about what the claim
4 requires.

5 JUDGE WEATHERLY: Okay.

6 MR. PRICE: I'm looking just at limitation F of the claim,
7 determining a notification method by which to provide at least one alert on
8 the at least one external device based on the current state. So our reading of
9 this is consistent with the arguments that we made about the scope of this
10 limitation, which Your Honors agreed with during institution, which was
11 that -- so on Page 35 of the patent owner response, for example, we talked
12 about the plain language of the claim contemplates providing one alert on
13 the user's only external device, multiple alerts on the user's only external
14 device, one alert on a subset of the multiple users, multiple external devices,
15 multiple alerts on each device of the subset.

16 JUDGE SMITH: But getting back to my -- getting back to my
17 point, I mean, how does -- what -- how does any of that have anything to do
18 with the state of the device? Is there something about the state of the device
19 that determines if it's online, you send one alert, if it's offline, you send three
20 alerts? I mean, it's just --

21 MR. PRICE: Well --

22 JUDGE SMITH: -- send one, two, or three --

23 MR. PRICE: Yeah. No, Your Honor, I -- the point here is that
24 you can send it to -- you can choose to send it -- the notification method is
25 just you can choose which devices to send it to, but also it contemplates
26 -- you know, defining and sending multiple types of alerts.

1 JUDGE WEATHERLY: So --

2 MR. PRICE: And the user is -- there's no limitation as to how --

3 JUDGE SMITH: Let me ask you this.

4 MR. PRICE: Yeah.

5 JUDGE SMITH: The petitioner made the point that under -- if we
6 accept what you're saying, that if we accept that this idea that we determine
7 a device is online and then we send the device an alert, and we're using user
8 preferences, so we're determining what type of alert to send based on user
9 preferences. If we accept that as being within the scope of limitation F, what
10 we're doing is reading out -- determining a notification method, and what
11 we're left with is a claim that says, provide at least one alert on the one
12 external device based on the current state of the at least one device. So
13 determining the notification method based on the current, but that wouldn't
14 happen. It would just be provided -- provide the alert based on the current
15 state.

16 MR. PRICE: Well, again, Your Honor, I -- this is all -- all of these
17 things are definable in the user preferences. If the user -- I mean I -- and I
18 -- we'll go back to Paragraph 20, there's no limitation here in, you know -- as
19 Petitioner suggests, that the alerts are, you know, somehow hard coded.
20 There's only one type of alert. The user may define the type and manner of
21 delivery of information. Therefore --

22 JUDGE SMITH: But that's not what you have claimed. That's not
23 what the claim says. The claim doesn't say, determine a notification method
24 based on user preferences. That's not what it says. It says, "Determine a
25 notification method based on the current state of the at least one" -- now,
26 you want us to read based -- you want us to read this limitation as saying,

1 determine a notification method based on user preferences. That's not what
2 it says.

3 MR. PRICE: Well, then -- I mean, then the claims are not obvious
4 because that's how the prior art works as well. So the -- and this was also
5 Mr. Schmandt's --

6 JUDGE WEATHERLY: Then the claims are non-obvious because
7 that's how the prior art works?

8 MR. PRICE: Right. The Austin-Lane also teaches determining
9 the devices --

10 JUDGE WEATHERLY: I thought when the claims covered
11 something that the prior art describes, they were obvious.

12 MR. PRICE: No, no, no. If the -- if the use of user preferences to
13 figure out how to send the alert to the user is not -- that doesn't meet the
14 language of claims, then Austin-Lane also doesn't teach these claims. The --

15 JUDGE WEATHERLY: I -- what is -- forgive me for asking,
16 what is Austin-Lane?

17 MR. PRICE: Austin-Lane is one of the prior art references cited
18 against us.

19 JUDGE WEATHERLY: Okay. Okay. Okay. In combination
20 with this PCT reference?

21 MR. PRICE: With the PCT.

22 JUDGE WEATHERLY: All right.

23 MR. PRICE: So -- and, you know, again, I -- you know, Mr.
24 Schmandt, who is their expert, admitted that, you know, the PCT publication
25 teaches the user how -- defines how the information is to be presented on the
26 platform. So once you decide who you're sending it to, in order to figure

1 out, you know, what -- and that's certainly based on, you know -- who you're
2 sending it to is certainly based on the session data, then it's just a matter of
3 looking at the user preferences to figure out how that user wants to receive
4 it. That's all that this is about. So --

5 JUDGE SMITH: Who you're sending it to is based on the session
6 data because the session data that says that person is online.

7 MR. PRICE: Right.

8 JUDGE SMITH: And that's it?

9 MR. PRICE: It says that the user is online and so the system will
10 send it to the online devices per the user preferences. So all of that happens
11 --

12 JUDGE SMITH: But it doesn't say -- it doesn't say, send it to the
13 user per user preferences. It says, send it to the user per the current -- I mean
14 --

15 MR. PRICE: Okay, but that's disclosed elsewhere. I mean -- and
16 again, Mr. Schmandt --

17 JUDGE SMITH: What's disclosed elsewhere?

18 MR. PRICE: That the user preferences are -- define how alerts are
19 delivered to an --

20 JUDGE SMITH: There -- there's a disconnect between, like, I
21 guess, what we're saying and what you're responding to us. So we're talking
22 about determining a notification method based on the current state of the
23 device. So if it -- if it's online -- and there are only two states, online or
24 offline. If it's online, you send a text. If it's offline, you send an email.
25 There -- there's nothing in the parent application that does that.

26 MR. PRICE: Okay. There is no requirement to send a notification

1 in the claims to an offline device. So there's no requirement --

2 JUDGE SMITH: There is a requirement in the claim to send it
3 based on the current state of the device and there are only two current states,
4 online or offline.

5 MR. PRICE: Right. So you determine a notification method by
6 determining I have three of my five external devices online, and then I look
7 at my user preferences to see how to send those. That's --

8 JUDGE WEATHERLY: Okay.

9 MR. PRICE: -- that's it.

10 JUDGE WEATHERLY: We're disagreeing currently about --

11 JUDGE SMITH: Yeah.

12 JUDGE WEATHERLY: -- whether that constitutes basing the
13 determination of the method on the state of the external device.

14 MR. PRICE: I understand.

15 JUDGE SMITH: We understand your --

16 JUDGE WEATHERLY: It's not the -- it's not the end of it. It's not
17 -- I mean, listen, the way this actually works is, for me, anyway, I'm unafraid
18 to have -- ask any question and demand any answer. I don't walk out of this
19 hearing knowing how we're going to decide. I'm trying to gather as much
20 information as I can to help me decide. So there's no need for anyone to
21 walk away from this conversation. No-one's going to know who's going to
22 win or lose. You'll have feelings about it, but rest assured that what we're
23 going to do is study the record very deeply. And in terms of the timing for
24 when we do that, to be blunt, that happens in the course of writing the final
25 decision. I don't think -- I don't -- I'm not sure that we're going to make any
26 more progress on this particular point by continuing to talk about it. You're

1 free to talk about it if you'd like. I --

2 JUDGE SMITH: Yeah. I just want to highlight you're getting into
3 your rebuttal time.

4 JUDGE WEATHERLY: Yeah.

5 JUDGE SMITH: But if there are any other points you want to
6 make --

7 MR. PRICE: Right. So, Your Honor, I -- just to wrap this up, I
8 don't think that their -- the claims require the -- for example, aspect 2 and
9 aspect 3 to be toggleable, right, based on the session data. We think it's
10 sufficient to determine that you have devices online, you know which
11 devices that you're going to send it to based on that, and that's all based on
12 the --

13 JUDGE WEATHERLY: And aspect 2 and aspect 3, again, for my
14 use later, refers to your slide 10 --

15 MR. PRICE: Yes.

16 JUDGE WEATHERLY: -- framing? Okay.

17 MR. PRICE: And I believe it was Petitioner's language --

18 JUDGE WEATHERLY: Okay.

19 MR. PRICE: -- aspect.

20 JUDGE WEATHERLY: Good. Good.

21 MR. PRICE: So we believe that's all required is using the session
22 data to determine which devices you're going to send it to and then
23 consulting user preferences to make that notification. Just turning very, very
24 briefly to the alert issue, there was a broad disclosure of alerts in the 2009
25 application. Alerts -- patentee used the term alert is -- and is entitled to the
26 full scope of the plain and normal meaning of alert.

1 Alerts encompass all of the alerts that were known at the time,
2 which is undisputed, includes visual, auditory, and tactile alerts. Therefore,
3 there is no written description issue here. It's not as if, you know, sending a
4 tactile alert, which was specifically disclosed as an example in the 2001
5 -- 2011 CIP, changed the nature of what an alert is, for example, as it did in
6 the Power Oasis case. A broad disclosure of limitation is sufficient to
7 provide written description support.

8 JUDGE WEATHERLY: Sufficient to convince that a person of
9 ordinary skill (INDISCERNIBLE) possessed that type of alert --

10 MR. PRICE: Of course.

11 JUDGE WEATHERLY: -- within the scope. Okay.

12 MR. PRICE: Of course. So there are no more questions on that, I
13 will --

14 JUDGE WEATHERLY: At some point, I want to ask you about
15 this argument in your surrebuttal about vacating institution. And actually
16 my question really is for Petitioner, about whether they've had an
17 opportunity to respond to your argument, but I don't think they have. So I'll
18 reserve it for them.

19 MR. PRICE: Okay.

20 JUDGE SMITH: Thank you.

21 MR. THACKER: Thank you, Your Honor.

22 Okay. I'd like to address at least three points that Counsel raised
23 and possibly four, if I have time.

24 JUDGE SMITH: Let me just -- before you get into it, let me just
25 real -- did you get a chance to follow up on my question about the
26 prosecution history? Did the examiner -- what date did the examiner use?

1 MR. THACKER: Yeah, the examiner used the 2009 application
2 filing date in rejecting based on 2008 and 2007 prior art publications.

3 JUDGE SMITH: When rejecting claims in the CIP?

4 MR. THACKER: Correct.

5 JUDGE SMITH: Okay.

6 JUDGE WEATHERLY: So the examiner -- we refer to it as
7 intervening art, art that would have been prior art in the intervening period.
8 The examiner did not rely on any intervening art?

9 MR. THACKER: Correct.

10 JUDGE WEATHERLY: Okay.

11 JUDGE SMITH: Okay. All right. Thank you.

12 JUDGE WEATHERLY: At least someone who used to do patent
13 prosecution would refer to it that way.

14 MR. THACKER: Okay. So turning to slide 4, I'm going to return
15 to the claim language. There's some discussion about, you know, the key
16 issue here is determining a notification method based on the current state.
17 And it appears that from both Patent Owner's briefing and Patent Owner's
18 Counsel's argument just now, that determining the notification method
19 requires at least determining how to send an alert. So the -- and as we
20 explained, like, determining the notification method based on the current
21 state of the at least one external device requires at least determining how to
22 send that alert based on the state of the device.

23 JUDGE SMITH: Do you agree with Patent Owner that the only
24 external states are online and offline? Is that correct?

25 MR. THACKER: Those are the only states disclosed in the 2009.
26 Correct.

1 JUDGE SMITH: Okay. There are no other current states. It's just
2 either online or offline. When the claim says current state, they mean it's
3 online or offline?

4 MR. THACKER: Correct.

5 JUDGE SMITH: Okay.

6 MR. THACKER: And so, you know, what the 2011 CIP
7 application discloses on slide 5 is, you know, if online, send the active
8 session, if offline, for example, send a text message. Now, Counsel said that
9 the 2009 discloses multiple delivery mechanisms. And this is shown on
10 their slide 14, which I have up here. I want to make a few points about this.

11 So this argument that the 2009 Parent discloses alerts via an email,
12 SMTP, and SMS text, this is an impermissible new argument that they raised
13 for the first time in surreply. So if you notice here, they only cite to the
14 surreply. They don't cite to the POR. So first, this argument --

15 JUDGE WEATHERLY: When you're talking about this,
16 particularly referring to their slide 14?

17 MR. THACKER: Yeah. So slide 14 --

18 JUDGE WEATHERLY: Okay. Okay.

19 MR. THACKER: -- of the Patent Owners Demonstratives, they're
20 citing here to only the surreply for this contention that the 2009 discloses
21 other possible ways of alerting the user besides HTTP through the web
22 services gateway, right? So one, the Board should just not consider this
23 argument because it -- Patent Owner waived this argument by not raising it
24 in the POR.

25 JUDGE SMITH: We have the slides up here. Just tell us what's
26 going on.

1 MR. THACKER: Okay. Okay.

2 JUDGE SMITH: Unless you need to look at it.

3 MR. THACKER: No. I know. And secondly, if you -- I would
4 invite the Board to Exhibit 2022, which is the transcript from Mr.
5 Schmandt's first deposition. And he explained throughout this deposition
6 that the only way that the 2009 application discloses conveying information
7 to the user's devices is through the web services gateway using HTTP. If
8 you look at Exhibit 1106, Figure 2, shows all the information flowing
9 through the web services gateway. Paragraph 39 of 1106 says you send the
10 alert through the web services gateway. Undisputed that this web services
11 gateway uses the HTTP protocol. It wasn't until 2011 that the applicants
12 conveyed possession of using SMS through a carrier network or SMTP
13 email messages through a mail server. So I just want to --

14 JUDGE SMITH: But let me just --

15 MR. THACKER: One -- oh, sorry.

16 JUDGE SMITH: Yeah. I understand your point. You're saying
17 it's untimely, and even if it is timely, it just uses the HTTP. But let -- let's
18 say we accept their premise that it can choose either SMS or text or email.
19 Let -- let's just accept that. Would -- do you think that that's enough to
20 support determining a notification based on the current state of the external
21 device?

22 MR. THACKER: Do you mean that just disclosure of an email
23 application or a text application?

24 JUDGE SMITH: Right. The user sets its preference to send me an
25 email or send me a text that -- and so the server sends an email or sends a
26 text based on the user preference. Does that support determining

1 notification based on the current state of the at least one external device?

2 MR. THACKER: No, it does not. And I think this gets to what
3 Judge Weatherly was getting at earlier, is that just having a preference
4 doesn't say anything about how to determine a notification method based on
5 the state of the device, right? If I say I prefer a text over an email, that's not
6 dependent on the state of the device.

7 JUDGE SMITH: Okay. So -- okay. Got it. Thank you.

8 MR. THACKER: In this disclosure of an email application and a
9 text application, what's missing there is that this -- these are all web -- in the
10 2009, these are all web-based applications or channels. So it's -- the content
11 may be email content or text content, but that content is being delivered
12 through the web services gateway, right? So in Exhibit 2022, Page 77, Lines
13 3 through 7, Mr. Schmandt explained in response to the question, the web
14 services gateway --

15 JUDGE SMITH: I'm sorry, what page, 77 --

16 MR. THACKER: 77, Lines 3 to 7.

17 JUDGE SMITH: 3 to 7. Okay.

18 MR. THACKER: In response to the question, using the web
19 services gateway, does it communicate between a server and an end device
20 using a communication protocol? And Mr. Schmandt explained, using
21 HTTP, yes, a single protocol.

22 And then again, this is Page 75 of Exhibit 2022, Lines 14 to 24.
23 Mr. Schmandt explained, the fact that the channel can show email, which is
24 implied here, does not mean that the channel is using email protocols to
25 convey that information to the user. The channel is not running through
26 email. I see no disclosure about that. So what Mr. Schmandt explained

1 -- and I would invite -- I'm not going to read from his transcript, but some
2 pinned sites here.

3 Page 28, Lines 3 to 13. Page 65, Lines 1 to 22. Page 68, Line 6,
4 through Page 69, Line 7. Page 76, Lines 1 through 7. Page 77, Lines 3 to
5 11, and Page 78, Lines 14 through 20. Mr. Schmandt is explaining that
6 there's only one possible delivery mechanism and that's through the web
7 services gateway using HTTP. There's no choice being made there. There's
8 certainly no choice being made based on the state of the device.

9 Are there any further questions from the Board?

10 JUDGE ANDERSON: Yeah. I got one. I know there's been
11 argument that there are only two states with respect to this Limitation 1F.
12 My question is, do user preferences have any impact on the state of the
13 external device?

14 MR. THACKER: And you're asking specifically about the 2009
15 application or the claims themselves?

16 JUDGE ANDERSON: Claims themselves.

17 MR. THACKER: The claims themselves do not recite user
18 preferences at all. What the claims recite is determining a notification
19 method based on the current state of the device. So there's -- according to
20 the claim, those -- there's no preferences that are -- it doesn't recite that there
21 are preferences that are dictating how -- which notification method to use
22 based on the current state of the device. Does that answer your question?

23 JUDGE ANDERSON: I'm not sure.

24 MR. THACKER: Right.

25 JUDGE ANDERSON: I kind of feel like we went in a circle.

26 MR. THACKER: Well, the user preferences do not dictate the

1 state of the device.

2 JUDGE WEATHERLY: Do they affect the state of the device?

3 MR. THACKER: No. The device is either active or inactive. The
4 user's preference, I mean, that doesn't relate to the state of the device.

5 JUDGE WEATHERLY: Okay. Judge Anderson, is that getting at
6 the concept that you're probing about or --

7 JUDGE ANDERSON: I'm going to take what we got right now.

8 JUDGE WEATHERLY: Okay.

9 MR. THACKER: I can --

10 JUDGE WEATHERLY: I have a question about this concept of
11 vacating the institutional decision based on Revvo Tech's case, and I know
12 Tesla cited also. I can't say I'm surprised that that issue arose in the surreply.
13 It seems somewhat unfair to not allow Petitioner to respond to that
14 argument. I'm also not sure that it's procedurally appropriate to essentially
15 move for dismissal of the case in the surreply without asking for
16 authorization to file a motion to dismiss.

17 It's an unusual issue for panel members of the Board to deal with.
18 Our guidance for dealing with the issue is likely to evolve. It would be
19 helpful if the parties would think about whether something more should be
20 submitted to the panel to assist us in unraveling that issue. I think that's all I
21 can say about it at this point. I'm familiar with the issue, as I probably
22 implied from revealing that I'm the author of the Revvo Tech decision, both
23 of them; the original institution and the one that we entered yesterday.

24 So take a look at that issue and see if there's something else. I will
25 tell you that my overarching goal is to make sure that every party that comes
26 in front of the Board has every opportunity to present the argument that they

1 want to present and to support it with evidence that they want to submit.
2 That's my goal. And I hope that provides useful context for how to proceed
3 on that issue. I don't have any other questions about this -- about your
4 presentation, Petitioner.

5 JUDGE SMITH: Yeah. I don't have any other questions. Okay.
6 Thank you, Petitioner.

7 MR. THACKER: Thanks.

8 MR. MASON: Judge, and I don't know that you were necessarily
9 asking for a response at this time. I mean, I think based on the current
10 record, we would submit that, you know, the Board already rejected Patent
11 Owner's request to file a discretionary denial, or to file a request for director
12 review on this issue. Mr. Schmandt --

13 JUDGE WEATHERLY: Sometimes that matters and sometimes it
14 doesn't.

15 MR. MASON: Yeah. I just want to remind all the parties,
16 everyone, that that's in the record and then also, you know, we're happy to
17 submit further briefing if that's what the Board would like.

18 JUDGE WEATHERLY: I don't know that I'm asking any of that.
19 I'm noting that it's a request in the surreply.

20 MR. MASON: Yeah. Yeah. And we --

21 JUDGE WEATHERLY: I'm not sure it's proper, procedurally. I
22 -- you know, I'm not -- I'm really not trying to telegraph what you should do
23 or shouldn't do. I'm just taking note. Frankly, I find it unfortunate. I
24 understand why you're -- a lot of times you submit why you put that in the
25 server slide. It's a new development in the overall body of law. And owe it
26 to your client to ask. There -- I have a variety of concerns about the way this

1 -- the procedural status of it, the merits. It's -- right now it's one paragraph in
2 your server slide. If that is the case, it's not -- I don't think it's that simple of
3 an issue, which will be apparent when you finally get a chance to read what
4 we entered yesterday in the decision on institution.

5 So I wanted to give everybody a heads-up about that. I'm not
6 asking you to do something. Contact us and ask for briefing or not ask for a
7 briefing. It's up to you to decide how you want to proceed on that -- on that
8 concept, both of you. If you want to speak, I'm committed to hearing.
9 That's all.

10 MR. MASON: Right. And thank you. And just on that, but just
11 to remove any lack of clarity, we submit that it would be improper for the
12 Board to decide that issue in Patent Owner's favor without further briefing.
13 And we certainly submit -- we understand why they submitted when they
14 did. We submit that it was improper to do it at that time and --

15 JUDGE WEATHERLY: In a sense, what you're doing is offering
16 an oral surrebuttal to the surreply, which I'm not sure is procedurally proper
17 either.

18 MR. MASON: (INDISCERNIBLE).

19 JUDGE WEATHERLY: It's a tricky issue. Think about it. If you
20 want to talk to us about it, let us know you want to talk to us about it. If you
21 don't, that's fine, too. That's all I'll say.

22 MR. THACKER: Okay. Am I back on the clock?

23 JUDGE SMITH: You're back on.

24 MR. THACKER: Okay. Thank you, Your Honor. I -- I'm just
25 briefly going to mention the vacator.

26 JUDGE SMITH: Is something not working?

1 MR. THACKER: The screen is not on.

2 JUDGE SMITH: Oh, the screen's not on. Do you need the screen?

3 MR. THACKER: I do need the screen.

4 JUDGE SMITH: We have the slides up here, if you would just tell
5 us what slide.

6 MR. THACKER: Well, I do need a screen because I --

7 JUDGE SMITH: Oh, okay.

8 MR. THACKER: -- I don't know which slide I'm on. I can just
9 bring it up here if it's easier.

10 MR. MASON: It's unplugged.

11 MR. THACKER: It's unplugged. Do you want me to unplug it
12 and plug it back in?

13 MR. MASON: I don't think it's necessary.

14 MR. THACKER: Okay.

15 MR. PRICE: While we're waiting, I agree, the vacator issue.
16 There was timing issues that related to why it was raised in the surreply.

17 JUDGE WEATHERLY: Of course. No, I understand.

18 MR. PRICE: Petitioner could have requested an opportunity to
19 respond. They didn't. We will read the new decision and --

20 JUDGE WEATHERLY: I don't want to decide a case based on
21 one paragraph that the other side has not had an opportunity to respond.

22 MR. PRICE: I completely --

23 JUDGE WEATHERLY: Personally. So --

24 MR. PRICE: -- completely understand.

25 JUDGE WEATHERLY: But I'm just one of three panel members
26 on this panel, so I have one vote, not three. And my preferences don't

1 always carry the day.

2 MR. PRICE: It just needed a laptop, is all.

3 JUDGE SMITH: Sorry about that.

4 MR. PRICE: These things happen. We had way worse technical
5 difficulties in our hearing about two weeks ago, so this is fine. So briefly on
6 the HTTP argument being the only method of alerting the user. First of all,
7 that argument was based on testimony that came up regarding cross-
8 examination, an argument that was first made in the reply. We're entitled to
9 respond to issues raised with (INDISCERNIBLE) or reply. On the merits,
10 there's an email application emailed or sent via SMPT (sic), not HTTP. And
11 if there's any question about whether or not the invention is limited to
12 disseminating information via HTTP, I'll turn back to Paragraph 20 of the
13 2009 Parent. It says the information -- the term information should be --

14 JUDGE SMITH: What slide is that on?

15 MR. PRICE: Yeah. I -- I'm not on a slide.

16 JUDGE SMITH: Oh, okay.

17 MR. PRICE: It's on slide 15.

18 JUDGE SMITH: Okay.

19 MR. PRICE: Where we talked about Paragraph 20.

20 JUDGE SMITH: Okay.

21 MR. PRICE: So the users may define the type and manner of
22 delivery of information. The term information should broadly -- be broadly
23 interpreted to include, by way of non-limiting example, any appropriate type
24 of content or data or not limited to HTTP. In fact, we're not even limited to
25 providing alerts through the channel. The claims don't require that the alert
26 be provided through the channel. That is certainly one embodiment.

1 However, Paragraph 23 says that the user can divine -- define
2 event alerts or triggers. The trigger may -- and this is also -- this is on -- this
3 is also on slide 15. The trigger may cause the information channel to change
4 its appearance or to take other actions that may be implemented by the
5 developer. By way of non-limited example, one action that may be
6 implemented is to provide a notification to the user. That notification
7 doesn't have to go through the channel. There are many, many different
8 types of notifications known in art. We're not limited to any particular one.

9 And then getting back to the issue on the determining notification
10 method and what it requires in terms of the state of the active devices. Back
11 on slide 16. The first thing that you do when you're determining how you're
12 going to send an alert when an event alert is triggered is you check to see the
13 -- which devices are online, and then you send those devices based on how
14 the user defined he or she wants to receive.

15 Therefore, that is based on -- you are determining that notification
16 method based on the session data, because you are using the session data to,
17 one, look at the device that you're sending it to, and determine -- then
18 looking at the user preferences to see how that device is going to use that
19 data. That notification method is based on the device being online. If you
20 -- if the device is not online, you don't look to see how you're going to send
21 the alert.

22 JUDGE SMITH: So deciding -- determining a notification method
23 using user preferences, in your view, is based on the current state of the
24 external device because the only time user preferences are consulted is when
25 a device is polled as online?

26 MR. PRICE: That's correct.

1 JUDGE SMITH: Okay. I understand your position.

2 MR. PRICE: You know, and I do want to also just go back to
3 Paragraph -- Page 27 of the Patent Owner Response which talks about Mr.
4 Schmandt's testimony. He's admitting that it's well-known in the art for a
5 user to set user preferences in the system to reference those -- reference the
6 user preferences to determine how to present the alert. And it -- he says it's
7 the only reasonable way for such a system to work, to be able -- to allow the
8 user to set those preferences. And that's what's disclosed in the 2009 Patent
9 Parent.

10 I don't think the issue of the other limitation about the alert came
11 up on rebuttal. So I'm here and happy to answer any further questions that
12 Your Honors have.

13 JUDGE SMITH: I don't have any further questions.

14 MR. THACKER: One more point. Paragraph 21 of the 2009
15 Parent specifically says, "Information may be delivered to a user based on
16 the user's identity as established by the system when the user session is
17 established because the user is known in authenticated preferences and rights
18 to certain information types can be defined and managed for the user." So
19 this is saying that you were -- you're delivering -- you're -- you define the
20 way that you want to receive the information and the information may be
21 delivered based on the user's identity as established when the user session is
22 established.

23 So I -- it's our position that that's really all that's required to be
24 Limitation F. Limitation G, I think rises and falls with Limitation F. So
25 -- unless Your Honors have any further questions today?

26 JUDGE ANDERSON: None from me.

1 JUDGE SMITH: Thank you.

2 MR. PRICE: Thank you, Your Honors.

3 JUDGE SMITH: Do you have -- do you have anything that you
4 didn't understand?

5 THE REPORTER: No questions from me.

6 (Whereupon, the above-entitled matter went off the record.)

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