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Paper 11
Entered: June 11, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.,
Petitioner,

v.

MOBILE DATA TECHNOLOGIES LLC,
Patent Owner.

IPR2024-00247
Patent 8,825,801 B2

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

HOWARD, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background and Summary

Meta Platforms, Inc. ("Petitioner") filed a Petition (Paper 2, "Pet.") requesting *inter partes* review of claims 1–25 ("the challenged claims") of U.S. Patent No 8,825,801 B2 (Ex. 1001, "the '801 patent"). Mobile Data Technologies LLC ("Patent Owner") filed a Preliminary Response (Paper 6, "Prelim. Resp."). With our authorization, Petitioner filed a Reply to the Preliminary Response (Paper 8, "Pet. Prelim. Reply") and Patent Owner filed a Preliminary Sur-reply (Paper 10, "PO Prelim. Sur-reply").

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

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

B. Real Parties in Interest

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

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

C. Related Matters

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

D. The '801 Patent

The '801 patent is titled "Method, Apparatus and System for Management of Information Content for Enhanced Accessibility over Wireless Communication Networks" and is directed "to techniques for information content management in" "network-based communication systems." Ex. 1001, code (54), 1:24–26.

The '801 patent observes that "[o]ne of the most rapidly expanding aspects of wireless networking involves the access to information content over wireless networks via web-enabled mobile devices," but notes the challenge of "creating, publishing, distributing or otherwise managing information content so as to provide optimal presentation consistent with the limited display space and navigational capabilities of typical mobile devices." Ex. 1001, 1:30–45. For example, "conventional techniques such as web site authoring tools and web logging ('blogging') are not optimized for use in the generation of information content for shared access via mobile devices." *Id.* at 1:50–53. The '801 patent thus recognizes a need "for improved techniques for managing information content in a manner that overcomes" the shortcomings of conventional techniques. *Id.* at 2:1–4. The

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

'801 patent provides "for efficient generation and management of mobile sites that are advantageously integrated with wireless networking functionality of a wireless network in a network-based communication system." *Id.* at 2:8–12.

Figure 1A is reproduced below.

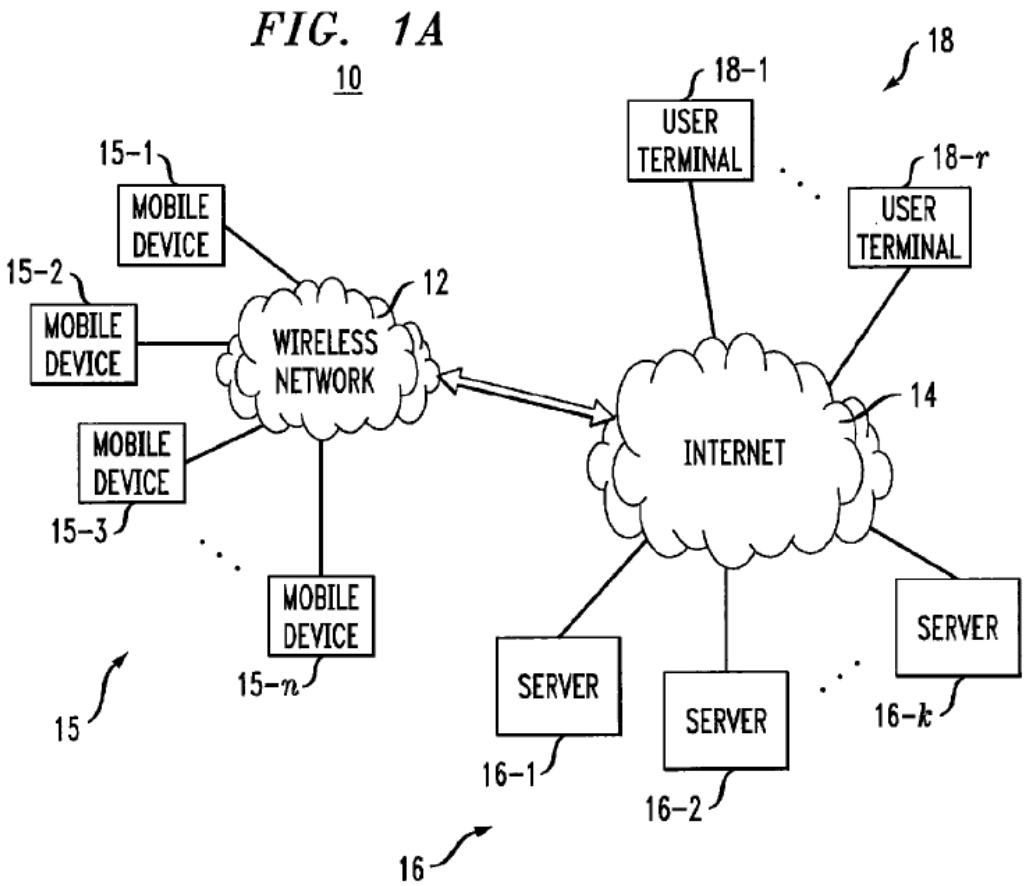

Figure 1A "is a block diagram of an example network-based communication system." Ex. 1001, 3:3–5. As shown in in Figure 1A, network-based communication system 10 includes wireless network 12 and Internet 14. Ex. 1001, 4:13–14. System 10 further includes mobile devices 15 and user terminals 18, generally referred to as user devices, connected to network 12 and Internet 14, respectively, and servers 16 coupled to Internet 14. *Id.* at

3:56–61, 4:3–4. In system 10, one of servers 16 may support a content management site accessible by mobile devices 15 or user terminals 18. *Id.* at 5:18–41. In particular, a "content management site permits the user to enter information in accordance with a specified format comprising a plurality of selectable mobile information channels each corresponding to an information category," where such channels are "referred to as 'M-channels.'" *Id.* at 5:25–29.

Further, a content management site may be used to create a mobile site accessible by mobile devices 15, and the information content of a mobile site "may be configured so as to integrate therewith information associated with at least one wireless networking functionality of the wireless network 12." Ex. 1001, 5:38–41, 5:63–66. For example, the wireless networking functionality information may be determined based on parameters of M-channels, such as "information specifying at least one messaging action implementable over the wireless network," or "information specifying at least one location-based service action implementable over the wireless network." *Id.* at 5:67–6:8. "M-channels are utilized at the content management site . . . to facilitate the generation of mobile sites and the management of associated content," and "allow unsophisticated users to easily and efficiently author message data or other types of information content to be made accessible . . . ." *Id.* at 8:14–20. The configuration of M-channels varies according to the implementation, "depending on factors such as the particular wireless networking functionalities available in the system." *Id.* at 8:28–32.

Figure 8 is reproduced below.

FIG. 8

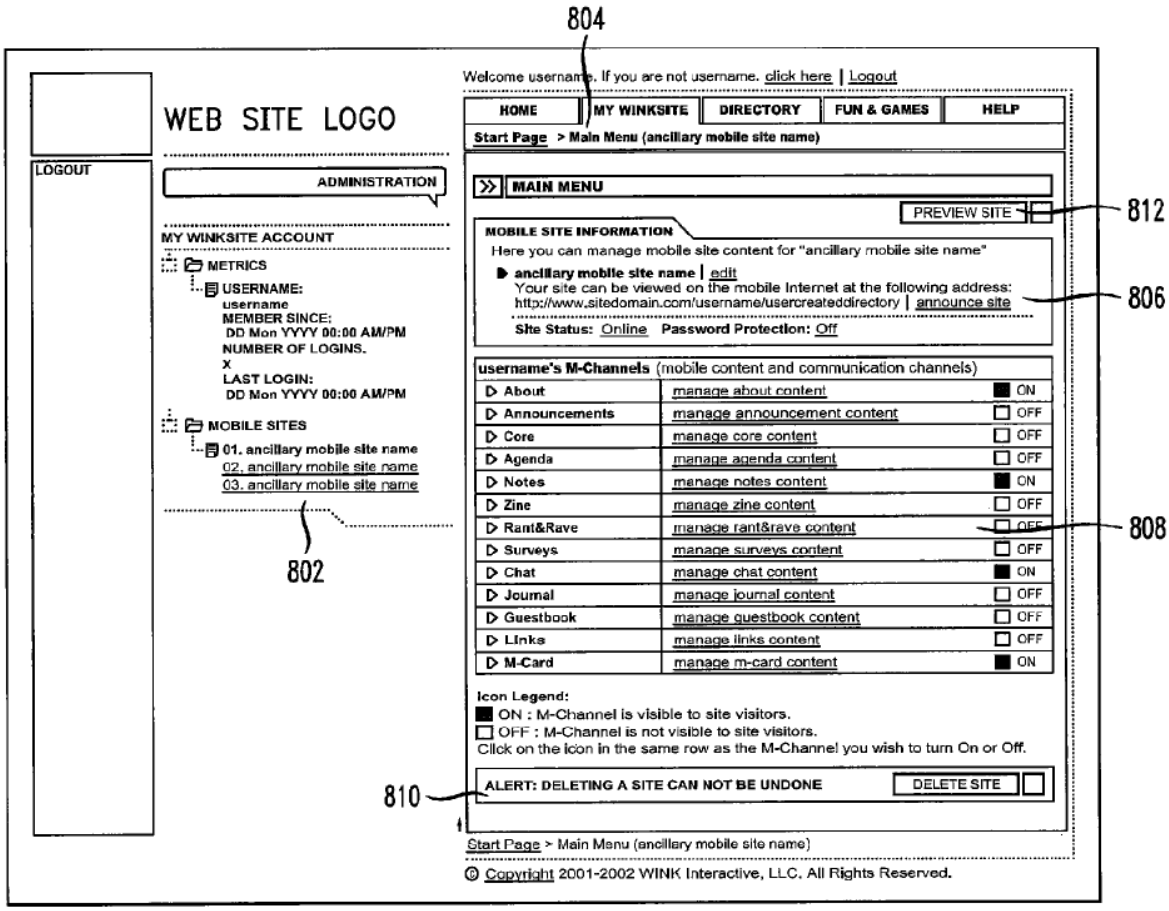

Figure 8 illustrates a "main menu page of the content management site for managing a given mobile site associated with a system user." Ex. 1001, 13:42–44; *see also id.* at 3:19–21 (Figure 8 is a "screenshot[] of [an] illustrative site page[] associated with a content management site in the system of Fig[ure] 1A."). As shown in Figure 8, the main menu page "includes information 802 identifying user account information and the particular mobile sites associated with that user, page navigational links 804, mobile site information 806 associated with a selected one of the mobile sites associated with the user, [and] M-channel information 808." *Id.* at 13:46–52. "[A] user selects a particular M-channel by activating the

corresponding link 808," and authors content through a subordinate user interface. *Id.* at 14:12–20; *see also id.* at 13:53–14:8.

E. Illustrative Claim

Claims 1, 23, and 25 of the '801 patent are independent claims. Claim 1 is illustrative and is reproduced below.

> 1. A method comprising:
>
> [1a] providing an interface permitting a first user to control activation of a mobile information channel through which the first user can share access to content with a plurality of additional users;
>
> [1b] activating the mobile information channel responsive to input received from the first user via the interface;
>
> [1c] inserting content provided by the first user into the mobile information channel;
>
> [1d] receiving additional content relating to the mobile information channel from one or more of said additional users via one or more respective mobile devices associated with at least one wireless network;
>
> [1e] inserting at least a portion of the additional content into the mobile information channel; and
>
> [1f] integrating into the mobile information channel information associated with at least one wireless networking functionality of said at least one wireless network.

Ex. 1001, 18:57–19:7; *see also* Pet. i-ii (adding limitation identifiers).

F. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–25 would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §[2]	Reference(s)/Basis
1–25	103(a)	Neibauer,[3] Miller,[4] Cheng,[5] Squibbs[6]
1–25	103(a)	Neibauer, Miller, Cheng, Squibbs, Harvey[7]

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

II. ANALYSIS

A. Legal Standards

In *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), the Supreme Court set out a framework for assessing obviousness under 35 U.S.C. § 103 that requires consideration of four factors: (1) the "level of ordinary skill in the pertinent art," (2) the "scope and content of the prior art," (3) the "differences between the prior art and the claims at issue," and (4) if in evidence, "secondary considerations" of non-obviousness, such as "commercial success, long-felt but unsolved needs, failure of others, etc." *Id.* at 17–18. "While the sequence of these questions might be reordered in

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[2] The Leahy-Smith America Invents Act ("AIA") included revisions to 35 U.S.C. § 103 that became effective on March 16, 2013. Petitioner applies the pre-AIA version. *See* Pet. 10 ("Pre-AIA law applies to the challenged claims, and each reference cited in the grounds listed in **Part III.B** qualifies as prior art.").

[3] Neibauer, A. R. (2000). *How to do everything with yahoo!* Osborne/McGraw-Hill (Ex. 1003). (Ex. 1003).

[4] WO 00/17775 A2, published Mar. 30, 2000 (Ex. 1004).

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

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

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

any particular case," *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 407 (2007), the U.S. Court of Appeals for the Federal Circuit has repeatedly emphasized that "it is error to reach a conclusion of obviousness until all those factors are considered," *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1328 (Fed. Cir. 2016). Because Patent Owner does not address objective evidence of non-obviousness, we focus solely on the first three *Graham* factors.

B. Level of Ordinary Skill in the Art

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

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

Dr. Madisetti argues that a person having ordinary skill in the art would have had "a bachelor's degree in electrical engineering, computer science, or similar field, with two years of experience in developing and implementing network-based computer systems that interact with mobile

devices, such as systems for storing and retrieving information over the Internet or communicating using the Web using wireless mobile devices." Pet. 5–6 (citing Ex. 1002 ¶¶ 14–18).

At this stage of the proceeding, Patent Owner "applies Petitioner's characterization of a [person having ordinary skill in the art]." Prelim. Resp. 19 (citing Ex. 2001 ¶¶ 42–44).

For purposes of this Decision, we adopt Petitioner's formulation of a person having ordinary skill in the art, which is consistent with the invention claimed in the '801 patent.[8]

C. Claim Construction

We apply the same claim construction standard used in the federal courts, in other words, the claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b), which is articulated in *Phillips*. *See* 37 C.F.R. § 42.100(b). Under the *Phillips* standard, the "words of a claim 'are generally given their ordinary and customary meaning,'" which "is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Phillips*, 415 F.3d at 1312–13.

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

"Petitioner does not believe express claim construction is necessary at this time." Pet. 8. Petitioner also discusses various claim construction arguments made in the district court proceeding. *See id.* at 27–28, 67.

At this stage, Patent Owner agrees with Petitioner that "no express constructions are required," and further agrees "that the ordinary and customary meanings of the claim terms apply." Prelim. Resp. 19.

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

D. Discretionary Denial — 325(d)

1. Legal Standard

Patent Owner argues that we should exercise our discretion to deny institution of trial under 35 U.S.C. § 325(d). Prelim. Resp. 3–17. Under § 325(d), we have discretion to deny a petition that presents the same or substantially the same prior art or arguments as previously presented to the Office. In evaluating whether the factual predicate under § 325(d) is met,

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

we consider a number of non-exclusive factors, as set forth in *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (Institution Decision) (precedential as to Section III.C.5, first paragraph) ("*Becton Dickinson* factors"):

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

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

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

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

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

2. Part One of the Advanced Bionics *Analysis*

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

Patent Owner argues that "Petitioner correctly acknowledges that [Neibauer and Cheng] were considered and made of record by the Examiner." Prelim. Resp. 6. Patent Owner further argues that Squibbs, Miller, and Harvey are "substantially similar to art previously before the Examiner." *Id.* at 8. In particular, Patent Owner argues that the pertinent functionality of Miller relied on by Petitioner, namely, "creat[ing] a web-based community and specify[ing] the specific features (e.g. message board, etc.) to include," is disclosed in Agboatwalla,[10] "which was before the Examiner." *Id.* at 8. Patent Owner further argues that the other references

[10] US 7,802,207 B2, issued September 21, 2010 (Ex. 2003).

the Petitioner relies on were substantially the same as prior art the Office previously considered. *Id.* at 9–11.

Petitioner argues that although Neibauer and Cheng were considered during prosecution, they were only mentioned in an Information Disclosure Statement and were "among hundreds of prior art references cited during prosecution." Pet. 4. Petitioner further argues that the Office "cited and relied on both Neibauer and Cheng in the successful reexamination of [U.S. Patent No. 8,135,801] patent (to which the present '801 patent was terminally disclaimed) which resulted in cancellation of all claims." Pet. 5; *see also* Pet. Prelim. Reply 1–2.

Petitioner further argues that neither Squibbs, Miller, nor Harvey were presented during prosecution. Pet. 3. Petitioner further argues that those references are not substantially the same as prior art considered by the Office. Pet. Prelim. Reply 2–3.

We disagree with Patent Owner that all of the references Petitioner is relying on are the same or substantially the same as references that were before the Office. In particular, there is no dispute that Miller was not considered by the Office. *See* Prelim. Resp. 6–13; Ex. 1001, code (56). Further, we do not agree with Patent Owner that Miller is substantially the same as Agboatwalla. Specifically, Petitioner relies on Miller for being able to select different types of communication tools for a group:

> Miller discloses a number of web-based forms that allow the user to (among other things) specify a name and description for the environment (Fig. 13B) identify the members of the environment (Fig. 13C, 14A-C), and select the various communication features (e.g. bulletin board, etc.) that will be available for members (Fig. 16). (Miller, 0045:12-0046:27.) *With respect to the selection of communications features, Miller discloses a user interface for allowing the user to select (from a list) the*

> *particular features that will be included in the collaborative environment.* (Miller, Fig. 16, 0047:31-0048:9, 0042:29-32 ("The group creator selects from among these functions, preferably by way of an easy-to-use web browser interface, and these choices are stored in a database and associated with the group members.").) These selections are then used in creating the environment or group. (Miller, 0043:3-6 ("In step 1104, the environment is created… to permit the group members to activate the functions selected for the group."); EX1002, ¶96.)

Pet. 18–19 (emphasis added).[11] We have reviewed the section of Agboatwalla to which Patent Owner directs us (Ex. 2003, 2:32–50) and do not see substantially the same functionality. Although Agboatwalla describes a user being able to select what content may be viewed (*see id.*), Patent Owner does not direct us to, and we do not see, Miller's teaching of selecting different types of communication pathways that may be selected for a group. Accordingly, Miller is not substantially the same as Agboatwalla.

3. Conclusion

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

[11] References to Miller are to Petitioner's pagination in the exhibit, for consistency with the Petition.

E. Neibauer, Miller, Cheng, and Squibbs

Petitioner argues that claims 1–25 would have been obvious over Neibauer, Miller, Cheng, and Squibbs. Pet. 3, 11–44. Based on the current record, we are sufficiently persuaded that Petitioner has established a reasonable likelihood of prevailing on this asserted obviousness ground with respect to at least claim 1.

1. Overview of Neibauer

Neibauer describes a feature of the Yahoo! Web site called Yahoo! Clubs, which is "a group of Yahoo! members who share a common interest," and which "has its own message board and chat room, as well as places to share photographs, news, addresses, and links." Ex. 1003, 473.[12] According to Neibauer, there are official, listed, and unlisted clubs hosted by Yahoo!. *Id.* Official clubs are created by Yahoo!, listed clubs are open to all Yahoo! members, and unlisted clubs are private clubs, and only "members who were invited to join may join the club and be able to access it." *Id.* A founder can create a club "to share information privately," and "can invite others to join, delete members, control the contents of photo albums, and customize the photo and messages on the club's home page." *Id.* at 480.

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

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

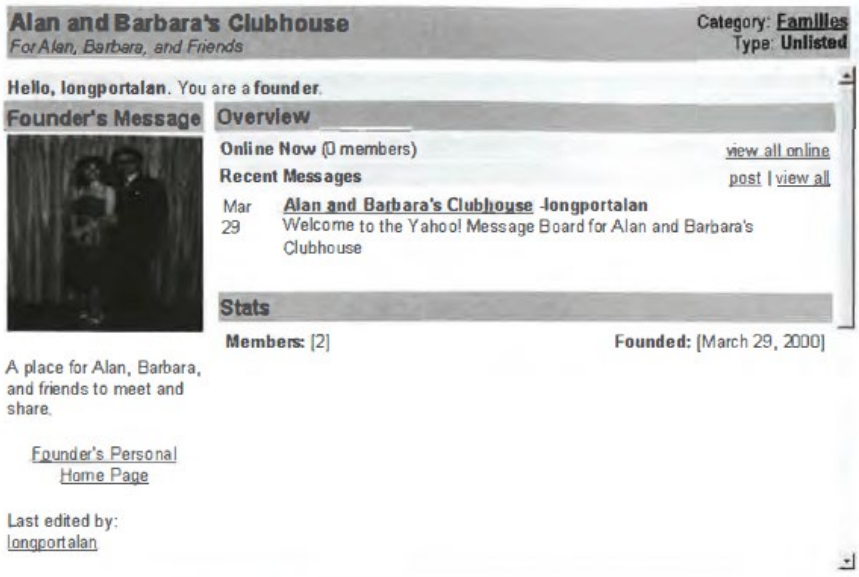


FIGURE 21-13 A Personal club

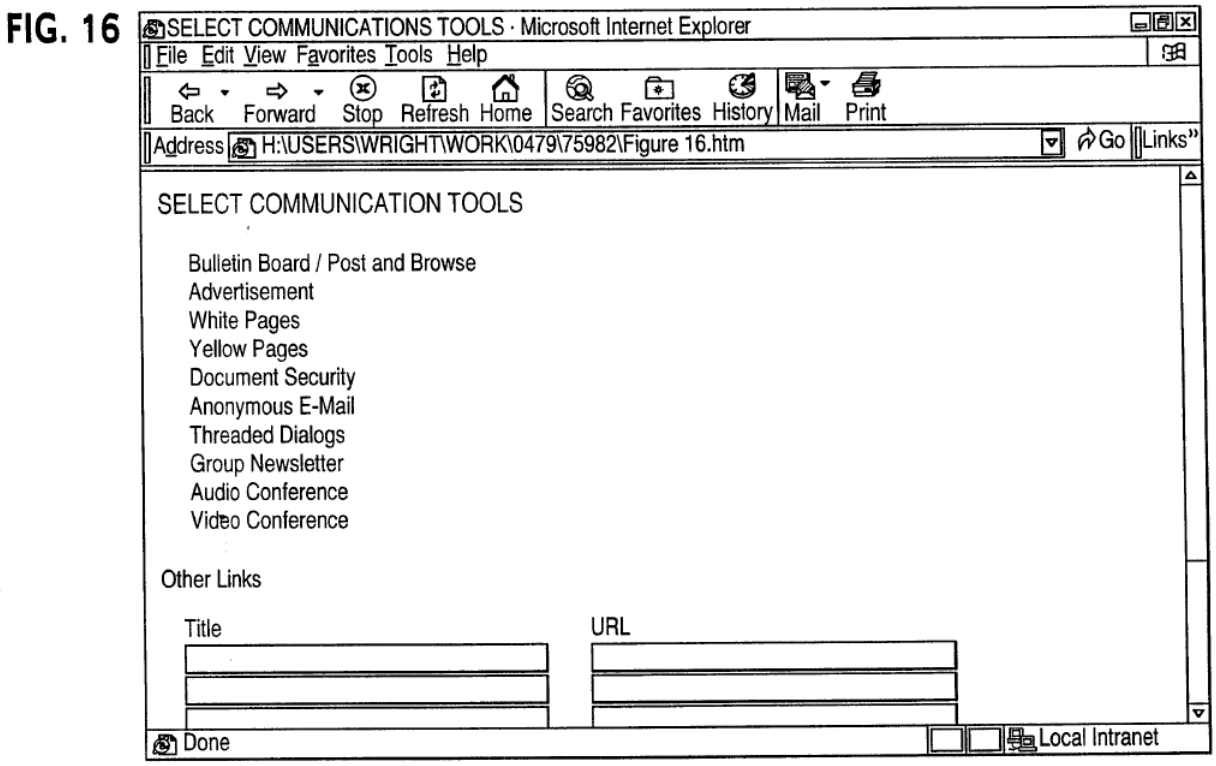
Figure 21-13 is an illustration of a personal club page. Ex. 1003, 482–83. According to Neibauer, it "contains all of the elements found on other club pages." *Id.* Club members may use a private message board to post messages or comment on other messages, as well as access a private chat area that provides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

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

2. Overview of Miller

Miller is titled "User-Defined Dynamic Collaboration Environments" and relates to "[a] collaborative system and method [that] allows members of a group to collaborate on a project such as a bid or proposal." Ex. 1004, codes (54), (57). In an embodiment concerning "a dynamic collaborative environment, a user can define a group and a virtual private network environment including user-selected tools that facilitate communication, research, analysis, and electronic transactions within the group." *Id.* at code (57). In particular, a group creator selects group members either by selecting from a list, by invitation, or by solicitation through advertising, and selects functions available to the group "preferably by way of an easy-to-use web browser interface." *Id.* at 41:12–42:32. In addition to the selected functions, a "group creator can specify links to other web-based or network-based applications that are not included in the list by specifying a web site address, executable file location, or the like" or "define shared data libraries that will be accessible to group members." *Id.* at 42:32–43:2. Once the environment is created, "group members collaborate and communicate with one another using the facilities and resources (e.g., shared data) available to group members." *Id.* at 43:13–14.

Miller Figure 16 is reproduced below.



Miller Figure 16 shows an exemplary "user interface for selecting communication tools to be made available to group members." Ex. 1004, 47:31–32. A screen that is "presented to the user creating the environment after the group has been identified and its members selected" may include communication tools such as:

> a bulletin board service; advertisements; white pages (e.g., a listing of members, their e-mail addresses, telephone numbers, and the like); yellow pages (e.g., a listing of services or companies represented by group members, with promotional and contact information); document security (e.g., shared access secure document storage services); anonymous e-mail (described above with respect to the first embodiment); threaded dialogs; a group newsletter creation tool; videoconferencing; and even other user-provided applications that can be specified by name and location (e.g., URL).

Id. at 47:32–48:9.

3. Overview of Cheng

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

Cheng Figure 1 is reproduced below.

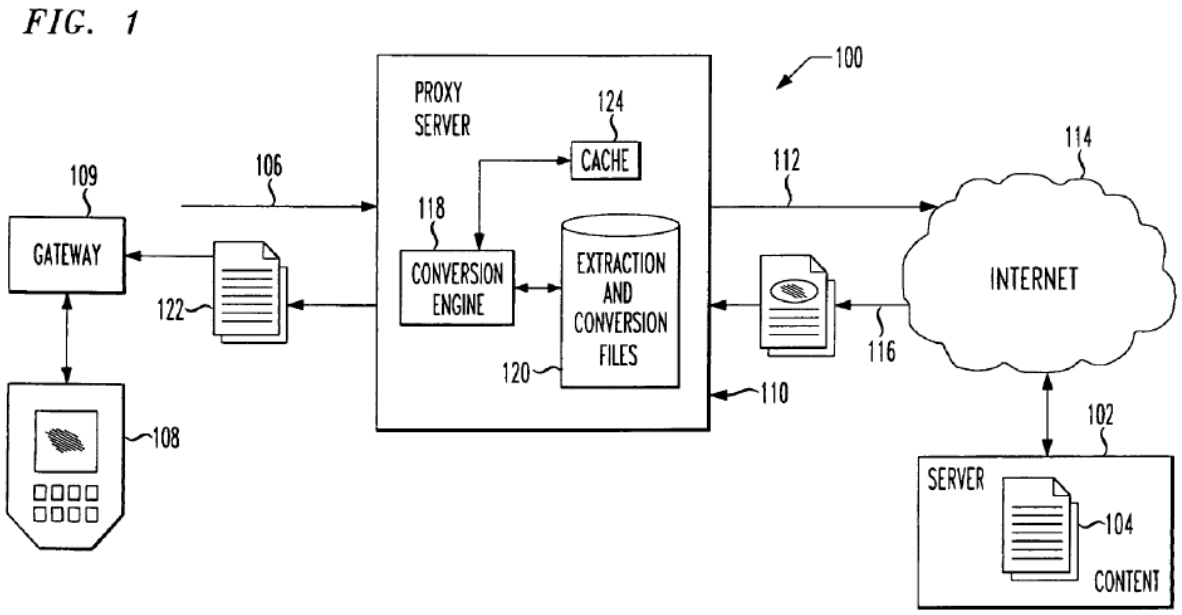


Figure 1 illustrates "a representative simplified block diagram of a mobile device, a proxy server, and a content server." Ex. 1005, 2:57–60. Specifically, architecture 100 includes proxy server 110, which "reformats/converts web content 104 on an origin web server 102 into a format 122 readable on any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

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

4. Overview of Squibbs

Squibbs is titled "Location-Informed Camera" and relates to "a camera which can obtain location data about its current location and associate it with image recordings." Ex. 1011, code (54), ¶ 1. Specifically, Squibbs describes a photo system with a digital camera that includes location determining means, such as a GPS receiver, for generating digital photos that are stamped with location data indicating the location where the photo was taken. *Id.* ¶ 31. "Other data may also be associated with each photo, such as a timestamp, a camera ID, and a user ID," which is referred to as photo metadata. *Id.* Photos and their metadata may be downloaded to a computer where an "album program enables user to catalogue, manage and view their photos through a map-based interface, the photos being represented on a displayed map by a marker indicating the location they were taken." *Id.* ¶¶ 31–32.

In an embodiment where a digital camera does not have location determining means, a cell phone that can ascertain its location may be used for obtaining location information. *See* Ex. 1011 ¶¶ 95–98. The digital camera may obtain location data from the cell phone and associate it with a last-taken photo (*id.* ¶ 99), or, alternatively, a photo may be associated with

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

5. Analysis of Claim 1

a) The Undisputed Preamble

The preamble of claim 1 recites "[a] method." Ex. 1001, 18:57. Petitioner argues that Neibauer teaches the preamble of claim 1. *See* Pet. 11–12.

After reviewing Petitioner's arguments and information regarding the preamble, including the Madisetti Declaration, which are not addressed by Patent Owner at this stage (*see* Prelim. Resp.), we are persuaded that Petitioner sufficiently demonstrates, for purposes of this Decision, that Neibauer teaches the preamble of claim 1.[13]

b) Limitation 1a

Claim 1 further recites "[1a] providing an interface permitting a first user to control activation of a mobile information channel through which the first user can share access to content with a plurality of additional users." Ex. 1001, 18: 58–61. For the reasons set forth below, we are sufficiently persuaded by Petitioner's argument and evidence that the combination of Neibauer and Miller teach limitation 1a. *See* Pet. 12–20.[14]

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[13] Because Petitioner has sufficiently shown that the prior art teaches the preamble, we need not determine at this time whether the preamble is limiting. *See Nidec*, 868 F.3d at 1017.

[14] Petitioner also presents alternative theories as to how the combination of Neibauer, Cheng, and Miller teaches limitation 1a. *See* Pet. 20–26. For example, Petitioner relies on the features of Yahoo! Mobile "to the extent

continued on the next page

Neibauer teaches a web-based interface, shown in Figure 21-12, that can be used by a founder (first user) to create a new Yahoo! Club. Ex. 1003, 480–81; Ex. 1002 ¶¶52, 86–88. Figure 21-12 is reproduced below.

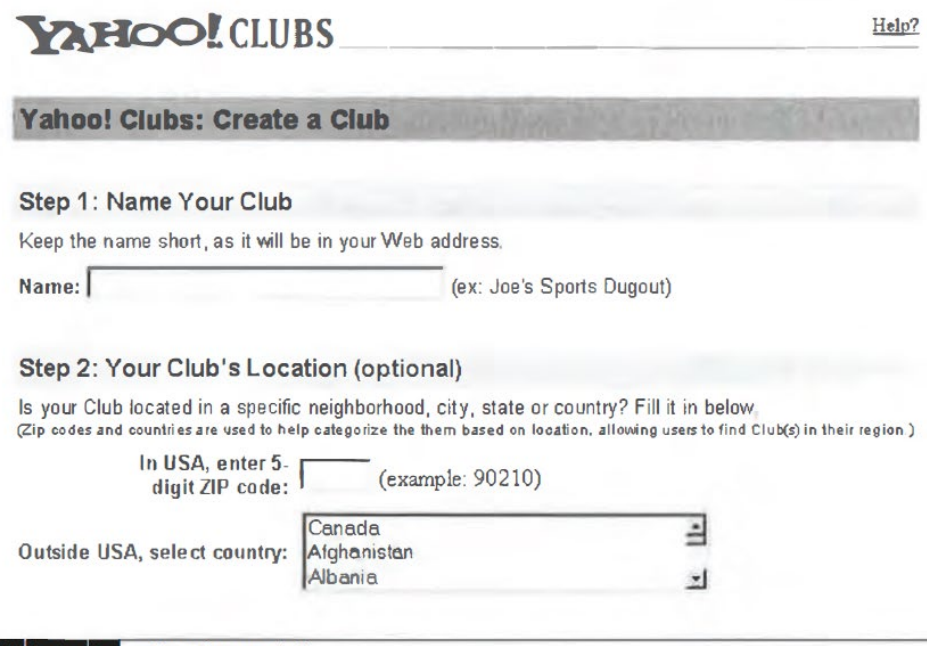

FIGURE 21-12 Creating a club

Ex. 1003, 481. Figure 21-12 shows the interface used to create a Yahoo! Club. *Id.* The Yahoo! Club is created when the user enters the necessary information and selects a "Yes! I accept." Ex. 1003, 481; Ex. 1002 ¶ 87. In other words, Neibauer teaches providing a first interface shown in Figure

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mobile device were construed as requiring a handheld device." *Id.* at 20–21. As another example, Petitioner argues that "[i]nformation channels that are '**mobile**' would also have been obvious over Neibauer and in further view of Cheng." *Id.* at 22. As yet another alternative, Petitioner presents arguments based on claim constructions that were proposed in the pending district court litigation. *See* Pet. 26–29. Because we are sufficiently persuaded that the combination of Neibauer (without Yahoo! Mobile) and Miller teaches limitation 1a, we do not address Petitioner's alternative arguments that further rely on Cheng.

21-12 (an interface) that is a person to create a Yahoo! Club. *See* Ex. 1002 ¶ 87.

Neibauer also teaches various ways that users of a Yahoo! Club can share content. *See* Ex. 1002 ¶¶ 89–92. For example, a Yahoo! Club can include a message board which "can be compared to a bulletin board on an office wall. It's a place to leave messages to others and to read their replies." Ex. 1003, 468; *see also id.* 469–71, 477; Ex. 1002 ¶ 89. Another example is a chat feature, club chat, which allows Yahoo! Club members to engage in real-time communications. Ex. 1003, 479; Ex. 1002 ¶ 90. A third example is the ability the share photographs with other Yahoo! Club members. Ex. 1003, 477–78; Ex. 1002 ¶ 91. Each of the Yahoo! Club features above allow users to share content, such as messages or photographs, with other club members. *See* Ex. 1002 ¶ 92. Stated differently, Neibauer teaches various ways "through which the first user can share access to content with a plurality of additional users," as recited in claim 1. *See id.*

Additionally, based on the current record, a person having ordinary skill in the art would have understood that the various Yahoo! Club features described above are examples of "information channels" as recited in the '801 patent. *See* Ex. 1002 ¶ 93. According to the '801 patent, a mobile information channel or M-channel "allow unsophisticated users to easily and efficiently author message data or other types of information content to be made accessible via a collaborative workspace, a data mailbox, a collaborative community, or other type of mobile site or portion thereof generated or otherwise managed in the system 10." Ex. 1001, 8:11–23. Examples of M-channels includes a "discussion forum," "chat," and "photo blog." *Id.* at 8:33–44. Those features are the same or substantially the same

as Yahoo! Club message board, chat, and photo sharing features, described in Neibauer. Ex. 1002 ¶ 93.

Based on the current record, it would have been obvious to a person having ordinary skill in the art to use the features of the Yahoo! Club (information channels) with a mobile device, thus using a "mobile information channel" as recited in claim 1. *See* Ex. 1002 ¶ 101. A person having ordinary skill in the art would have known that a person could use a conventional computer, such as a laptop computer, to run a web browser to visit pages on the internet, such as Yahoo!, including Yahoo! Clubs. *Id.* Because the '801 patent describes a laptop computer as a "mobile device," (Ex. 1001, 4:38–42), the "information channels" described in the previous paragraph are "mobile information channels" as recited in claim 1 when used with a laptop computer (Ex. 1002 ¶ 101).

Based on the current record, the combination of Neibauer and Miller teaches "control[ling] activation of a mobile information channel," as recited in claim 1. As discussed above, the first user can create a Yahoo! Club by supplying the necessary information and selecting "Yes! I accept." Neibauer is silent on whether the user can select which specific mobile information channels are associated with the Yahoo! Club. However, Miller teaches a similar collaborative web-based system in which the group's creator can use an interface to choose specific communication pathways to allow:

> *FIG. 16 shows one possible user interface for selecting communication tools to be made available to group members.* This screen can be presented to the user creating the environment after the group has been identified and its members selected. It is contemplated that a variety of communication tools can be provided, including a bulletin board service; advertisements; white pages (e.g., a listing of members, their e-mail addresses, telephone numbers, and the like); yellow pages (e.g., a listing of

> services or companies represented by group members, with promotional and contact information); document security (e.g., shared access secure document storage services); anonymous e-mail (described above with respect to the first embodiment); threaded dialogs; a group newsletter creation tool; videoconferencing; and even other user-provided applications that can be specified by name an location (e.g., URL).

Ex. 1004, 47:31–48:10 (emphasis added); *see also id.* at 42:29–32 ("The group creator selects from among these functions, preferably by way of an easy-to-use web browser interface, and these choices are stored in a database and associated with the group members."); Ex. 1002 ¶ 96. The combination of Miller's teaching of selecting different methods of communication with Neibauer's teaching of Yahoo! Clubs would allow the founder to select specific mobile information channels for the group to use. *See* Ex. 1002 ¶¶ 95–100.

Based on the current record, a person having ordinary skill in the art would have combined those teachings in the manner described above. *See* Ex. 1002 ¶¶ 97–100. Specifically, a person having ordinary skill in the art would have combined Miller's ability to select communication channels with Neibauer's Yahoo! Club in order "to enhance the flexibility and customizability of clubs in Neibauer." *Id.* ¶ 99. This would allow the founder to eliminate certain features that "may not have been particularly useful or desirable for some clubs." *Id.* Additionally, a person having ordinary skill in the art would have had a reasonable expectation of success. *See id.* ¶ 100.

Accordingly, the combination of Neibauer and Miller teaches limitation 1a.

Patent Owner argues that aside from mapping the limitations identified above to disclosure in Neibauer, "Petitioner does not provide any

additional explanation for how the information is ***shared with a plurality of users*** as the limitations are arranged in the claim." Prelim. Resp. 28. Specifically, Patent Owner argues that "Neibauer is devoid of such functionality as it is focused only on the limited read-only functionality of mobile access to traditional websites," and that there is no evidence the Yahoo! Clubs functionality Petitioner relies upon "could have been supported by users accessing the services on a mobile device." *Id.* (citing Ex. 2001 ¶¶ 54–57). According to Patent Owner, Neibauer's disclosure of the Yahoo! Mobile and Yahoo! To Go functionalities do not cure this deficiency. *Id.* at 28–29. Importantly, Patent Owner argues, these functionalities are "limited to a user's one-way access and viewing of information originating with the Yahoo! Software platform," and there is no evidence they "would have allowed mobile users to actually post content" associated with Yahoo! Club features. *Id.* (citing Ex. 2001 ¶ 58); *see also id.* at 29 (citing Ex. 2001 ¶¶ 59–62, 65–66).

We do not agree with Patent Owner's argument. First, as discussed above, based on the current record, Neibauer discusses ways that members of Yahoo! Clubs can interact using the club message board, chat, and photo sharing features. For example, the club messages feature allows users to post and read messages posted by other members. Ex. 1003, 469–71, 477; Ex. 1002 ¶ 89. Similarly, the club chat feature allows users club members to send private messages to each other, another type of interaction. Ex. 1003, 479; Ex. 1002 ¶ 90. And the photo sharing feature allows users to post photographs and view the photographs posted by other users. Ex. 1003, 477; Ex. 1002 ¶ 91.

Second, although not explicitly stated in the Preliminary Response, based on the cited testimony of Dr. Almeroth, it appears that Patent Owner's

primary issue is the lack of a teaching in Neibauer that connects the features of Yahoo! Clubs with Yahoo! Mobile. *See* Ex. 2001 ¶¶ 54–66. However, as discussed above, we do not rely on Petitioner's alternative arguments directed to handheld devices using Yahoo! Mobile. Instead, as discussed above, we focus on the use of laptop computers and Yahoo! Clubs. Patent Owner does not address that combination. *See* Prelim. Resp. 25–30.

Patent Owner further argues that Cheng does not cure the deficiencies of Neibauer because "Cheng is explicitly designed for one-way data transfer in response to a request from a mobile client." Prelim. Resp. 29 (citing Ex. 2001 ¶¶ 75–76, 80). In particular, Patent Owner argues that Cheng fails to teach the persistent connections between a client and server typically present for uploading data to a server. *Id.* (citing Ex. 2001 ¶ 86).

Similarly, Patent Owner argues that Petitioner's combination of Neibauer and Cheng relies on a "basic fallacy" in which "mobile devices available at the time of the invention were capable of receiving and displaying complex websites such as those shown in Neibauer at all, much less capable of supporting the internal functionality needed for the interactive features of" Yahoo! Clubs. Prelim. Resp. 31. Patent Owner asserts that Petitioner fails to provide "evidence that a [person having ordinary skill in the art] actually ***could*** have achieved such a combination," and that "Petitioner's arguments that a [person having ordinary skill in the art] ***would*** have sought to do so amount to nothing more than anachronistic, impermissible hindsight." *Id.*; *see also id.* at 31–40 (detailed discussion).

Patent Owner's arguments relating to Cheng are inapposite. As discussed above, for limitation 1a, we rely on Petitioner's argument based on Neibauer and Miller and do not rely on the alternative argument based on the combination of Neibauer, Miller, and Cheng. *See* Pet. 21 (explaining that

Cheng is an alternative argument: "Information channels that are 'mobile' *would also have been* obvious over Neibauer and in further view of Cheng." (emphasis added) (emphasis in original omitted)). Even if we agreed with Patent Owner's arguments regarding Cheng, that agreement would have no impact on our preliminary determination based on Neibauer and Miller.[15]

c) Undisputed Limitation 1b

Claim 1 further recites "[1b] activating the mobile information channel responsive to input received from the first user via the interface." Ex. 1001, 18:62–63. Petitioner argues Neibauer teaches that limitation. *See* Pet. 29

After reviewing Petitioner's arguments and information regarding the limitations identified immediately above, including the Madisetti Declaration, which are not addressed by Patent Owner at this stage (*see* Prelim. Resp.), we are persuaded that Petitioner sufficiently demonstrates, for purposes of this Decision, that Neibauer teaches limitation 1b.

d) Limitation 1c and 1d

Claim 1 further recites "[1c] inserting content provided by the first user into the mobile information channel; [1d] receiving additional content relating to the mobile information channel from one or more of said additional users via one or more respective mobile devices associated with at least one wireless network." Ex. 1001, 18:64–19:2. Petitioner argues that the combination of Neibauer and Cheng teaches the limitations. *See* Pet. 30–34. For the reasons set forth below, we are sufficiently persuaded by Petitioner's arguments.

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[15] Patent Owner does not set forth any argument challenging Petitioner's rationale to combine Neibauer and Miller. *See* Prelim. Resp. 30-40.

Neibauer describes how a club member, which can include the founder (first user) can leave a message on the message board. *See* Ex. 1003, 470–72; Ex. 1002 ¶¶ 119–120, 123. Similarly, the club founder could add a photograph or send a private message using the chat feature. Ex. 1003, 477–79; Ex. 1002 ¶¶ 121–122. Based on the current record, a person having ordinary skill in the art would have understood that the message (content) would have been "'insert[ed] . . . into the mobile information channel,' as it would have been available through" the club message board, photo sharing feature, and chat. Ex. 1002 ¶ 120–123 (emphasis omitted).

Similarly, based on the current record, a person having ordinary skill in the art would also understand that a club member besides the founder (one or more of said additional users) would be able to add additional content (messages, photographs, or chats) that would be received by the club members. Ex. 1002 ¶ 124. It also would have been obvious to a person having ordinary skill in the art that an additional user using a mobile device, such as a laptop, would have used a well-known wireless network, such as GSM, to connect with the internet to add and receive the content. Ex. 1002 ¶ 125; *see also* Ex. 1003, 171 (describing how a mobile device could use a GSM phone modem); Ex. 1004, 2:4–7 ("[T]he present invention provides a system, method, and medium that extracts a portion of web page content and reformats the extracted content for delivery to one or more wireless devices."), 5:33 (mobile device 108 can include "a cellular telephone")).

Accordingly, the combination of Neibauer and Cheng teaches limitations 1b and 1c.

Patent Owner relies on the same arguments discussed above for limitation 1a. That is, Patent Owner's argument are focused on the specific

implementations of the references and an explanation as to what a person having ordinary skill in the art (1) would not have been able to use the feature of Yahoo! Clubs with Yahoo! Mobile and (2) how the specific implementation of Cheng could not be combined with Yahoo! Clubs. *See* Prelim. Resp.

As it relates to "inserting comments" in limitation 1c and "receiving additional comments," we do not agree with Patent Owner's arguments for the same reasons discussed above with regard to limitation 1a.

As it relates to "at least one wireless network," although Patent Owner raises arguments as to why a person having ordinary skill in the art would not have combined the Yahoo! Clubs of Neibauer with the specific implementations of Yahoo Mobile! and Cheng, Patent Owner does not rebut Petitioner's evidence regarding using a well-known cellular communication platform such a GSM with mobile devices such as a laptop, which we find persuasive. *See* Prelim Resp. 25–42.[16]

e) Undisputed Limitations 1e and 1f

Claim 1 also recites

> [1e] inserting at least a portion of the additional content into the mobile information channel; and
>
> [1f] integrating into the mobile information channel information associated with at least one wireless networking functionality of said at least one wireless network.

Ex. 1001, 19:3–7. Petitioner argues that the combination of Neibauer and Squibbs teaches these limitations and that a person having ordinary skill in

[16] To the extent Patent Owner argues that such a combination would not have been obvious to a person having ordinary skill in the art, Patent Owner must explicitly do so in the Response or forfeit the argument.

the art would have combined the references with a reasonable expectation of success. *See* Pet. 34–44.

After reviewing Petitioner's arguments and information regarding the limitations identified immediately above, including the Madisetti Declaration, which are not addressed by Patent Owner at this stage (*see* Prelim. Resp.), we are persuaded that Petitioner sufficiently demonstrates, for purposes of this Decision, that the combination of Neibauer and Squibbs teaches each of these limitations.

f) Conclusion Regarding Claim 1

Based on the current record, there is a reasonable likelihood that Petitioner will prevail in demonstrating that claim 1 is unpatentable as obvious in view of Neibauer, Miller, Cheng, and Squibbs.

6. Analysis of Claims 2–25

Because Petitioner demonstrates a reasonable likelihood of success in proving that at least one claim of the '801 patent is unpatentable, we institute on all grounds and all claims raised in the Petition. *See* 37 C.F.R. § 42.108(a). Therefore, at this stage of the proceeding, it is not necessary for us to provide an assessment of every challenge raised by Petitioner, especially, as in this case, when Patent Owner does not separately argue those claims. Those challenges, in our view, are best left for trial after full development of the record.

F. Remaining Ground

Petitioner also challenges the patentability of claims 1–25 based on the addition of Harvey to the combination discussed above. *See* Pet. 3, 67–70. Patent Owner does not separately address the merits of Petitioner's prior art challenge including Harvey. *See* Prelim. Resp. 40–41.

Because Petitioner meets the threshold for institution by demonstrating a reasonable likelihood that at least claim 1 is unpatentable as obvious, we need not decide whether Petitioner's other challenge demonstrates the same. This challenge, in our view, is best left for trial after full development of the record.

III. CONCLUSION

Following 35 U.S.C. § 314, we have determined that the totality of the information presented at this stage shows there is a reasonable likelihood that Petitioner would prevail with respect to at least one of the claims challenged in the Petition, and we institute on all grounds raised and all claims challenged in the Petition. Additionally, we decline to exercise our discretion under § 325(d) to deny institution.

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

IV. ORDER

In consideration of the foregoing, it is hereby

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review is instituted for claims 1–25 of the '801 patent on the unpatentability grounds asserted in the Petition; and

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

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