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Paper 12
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.

IPR2024-00246
Patent 8,793,336 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, 6–11, 13–18, and 20–27 ("the challenged claims") of U.S. Patent No 8,793,336 B2 (Ex. 1001, "the '336 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).

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.

The parties also identify the following Office proceeding in which the '336 patent is involved: Reexam Control No. 90/019,221.[2] Pet. 1; Paper 5, 2.

D. The '336 Patent

The '336 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), 1:23–25.

The '336 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

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

[2] We take Official Notice that the Office issued a Notice of Intent to Issue a Reexamination Certificate that will confirm that patentability of claim 1, 11, 15, and 17, the only claims subject to reexamination. Ex. 3001.

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 '336 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 '336 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.

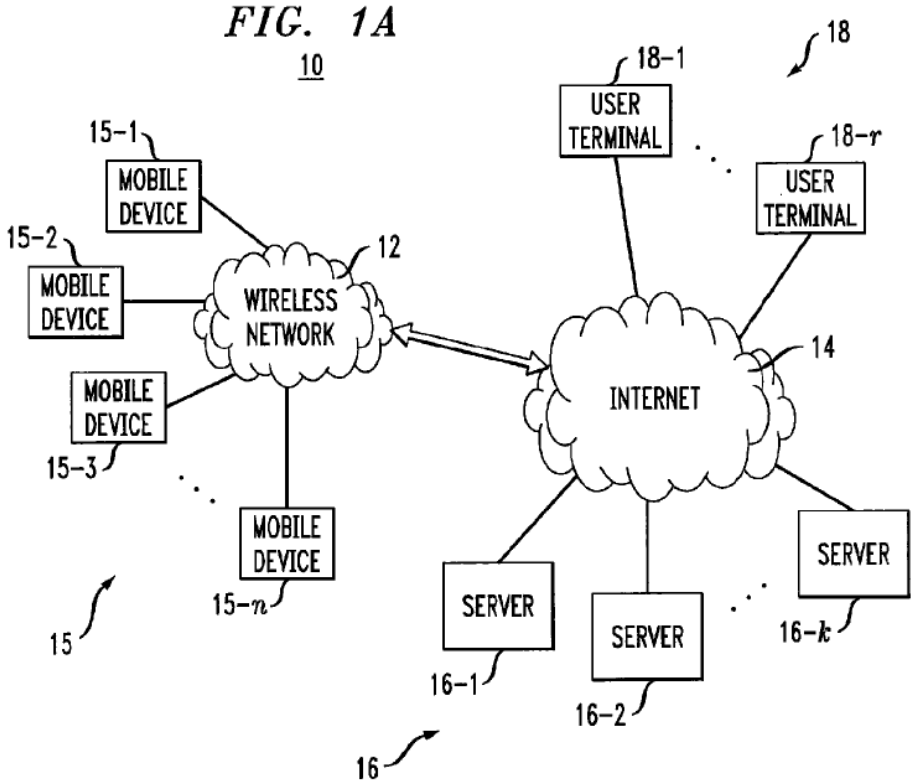


Figure 1A "is a block diagram of an example network-based communication system." Ex. 1001, 2:62–64. As shown in in Figure 1A, network-based communication system 10 includes wireless network 12 and Internet 14.

Ex. 1001, 4:5–6. 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 3:48–53, 3:62–63. In system 10, one of servers 16 may support a content management site accessible by mobile devices 15 or user terminals 18. *Id.* at 5:10–27. 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 "mobile information channels are . . . referred to as 'M-channels.'" *Id.* at 5:18–22.

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, 5:31–34, 5:56–59. 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 5:60–6:1. "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 8:7–14. 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 8:22–26.

Figure 8 is reproduced below.

FIG. 8

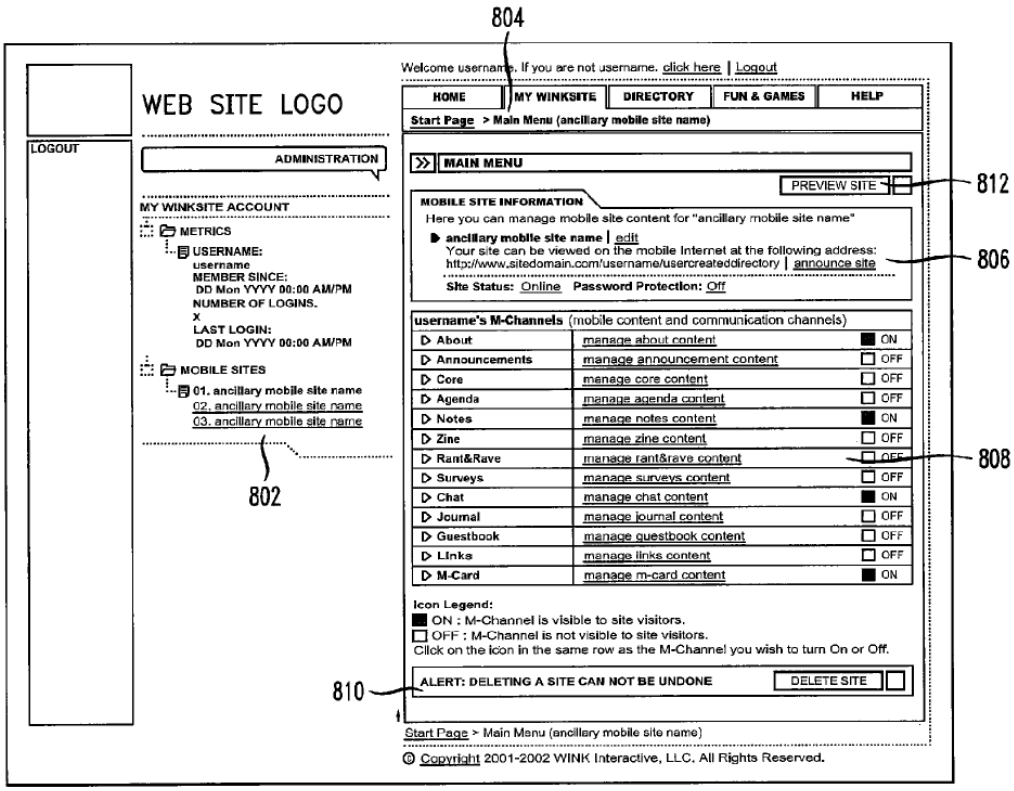


Figure 8 illustrates a "main menu page of the content management site for managing a given mobile site associated with a system user." Ex. 1001, 13:40–42; *see also id.* at 3:11–13 (Figure 8 is a "screenshot[] of [an] illustrative site page[] associated with a content management site in the system of 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 13:44–50. "[A] user selects a particular M-channel by activating the

corresponding link 808," and authors content through a subordinate user interface. *Id.* at 14:10–17; *see also id.* at 13:51–14:6.

E. Illustrative Claim

Claims 1, 11, 15, and 27 of the '336 patent are independent claims. Claim 1 is illustrative, and is reproduced below.

> 1. A method for managing information content in a network-based communication system, the method comprising the steps of:
>
> [1a] providing a first web-based interface accessible to a first user, the first web-based interface being configured to permit the first user to activate a given mobile information channel for sharing content between the first user and one or more additional users;
>
> [1b] generating a second web-based interface different than the first web-based interface, wherein the second web-based interface provides each of the one or more additional users access to at least a portion of the shared content via the given mobile information channel to thereby facilitate interaction between the first user and the one or more additional users;
>
> [1c] wherein the given mobile information channel supports messaging between the first user and the one or more additional users over a wireless network; and
>
> [1d] wherein the mobile information channel is configured to permit the first user to send messaging content to the one or more additional users and to receive messaging content from the one or more additional users.

Ex. 1001, 18:53–19:7; *see also* Pet. i–ii (adding limitation identifiers).

F. Prior Art and Asserted Grounds

Petitioner asserts that claims 1, 6–11, 13–18, and 20–27 would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §[3]	Reference(s)/Basis
1, 6–11, 13–18, 20, 21, 23–27	103(a)	Neibauer,[4] Miller,[5] Cheng[6]
7	103(a)	Neibauer, Miller, Cheng, Ausems[7]
21, 22	103(a)	Neibauer, Miller, Cheng, Fransioli[8]
1, 6–11, 13–18, 20, 21, 23–27	103(a)	Neibauer, Miller, Cheng, Harvey[9]
7	103(a)	Neibauer, Miller, Cheng, Ausems, Harvey
21, 22	103(a)	Neibauer, Miller, Cheng, Fransioli, Harvey

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

[3] The Leahy-Smith America Invents Act ("AIA") included revisions to 35 U.S.C. § 103 that became effective on March 16, 2013. Because the '336 patent was filed before March 16, 2013, we apply the pre-AIA version of the statutory basis for unpatentability. *See* Ex. 1001, code (22).

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

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

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

[7] US 6,434,403 B1, issued Aug. 13, 2002 (Ex. 1006).

[8] US 2004/0198396 A1, published Oct. 7, 2004 (Ex. 1007).

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

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 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. 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 '336 patent.[10]

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*

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

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

"Petitioner does not believe express claim construction is necessary at this time." Pet. 8. Petitioner also discusses various claim construction arguments made in the district court proceeding. *See id*. at 28–29, 65.

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.[11] *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))).

[11] 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.

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, 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 Miller, Ausems, Fransioli, 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,[12] "which was before the Examiner." *Id.* at 8–9. Patent Owner further argues that the other references the Petitioner relies on were substantially the same as prior art the Office previously considered. *Id.* at 9–12.

Petitioner argues that although Neibauer and Cheng were considered during prosecution, they were only mentioned in an Information Disclosure Statement and were "cited along with hundreds of other prior art references." Pet. 4–5. 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 '336 patent was terminally disclaimed) which resulted in cancellation of all claims." Pet. 6; *see also* Pet. Prelim. Reply 1–2.

Petitioner also argues that neither Miller, Ausems, Fransioli, nor Harvey were presented during prosecution. Pet. 4. 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

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

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, ¶104.)

Pet. 19 (emphasis added).[13] 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.

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

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).

E. Neibauer, Miller, and Cheng

Petitioner argues that claims 1, 6–11, 13–18, 20, 21, and 23–27 would have been obvious over Neibauer, Miller, and Cheng. Pet. 3, 11–59. 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.[14] 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,

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

delete members, control the contents of photo albums, and customize the photo and messages on the club's home page." *Id.* at 480.

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

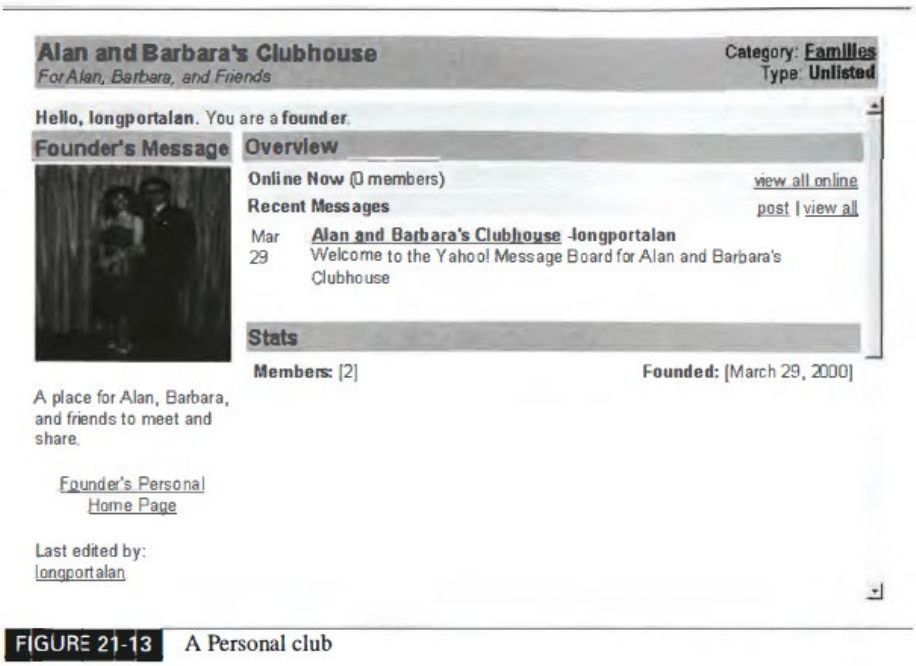


FIGURE 21-13 A Personal club

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.

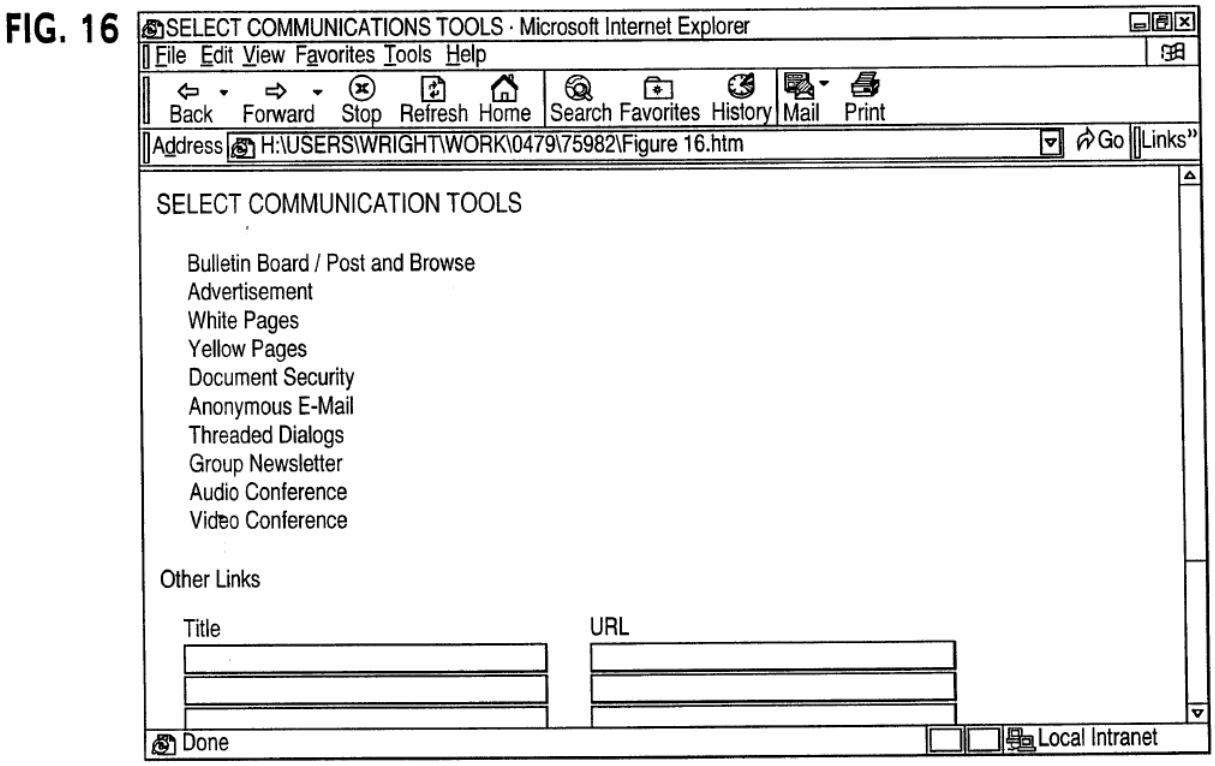
Neibauer further describes a product called Yahoo! Mobile that "lets you get many Yahoo! Services on mobile devices." Ex. 1003, 166. Within the Yahoo Mobile! product, a "Yahoo! To Go option lets you set up your mobile device and Yahoo! so that they work together, as well as specify the content that will 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.

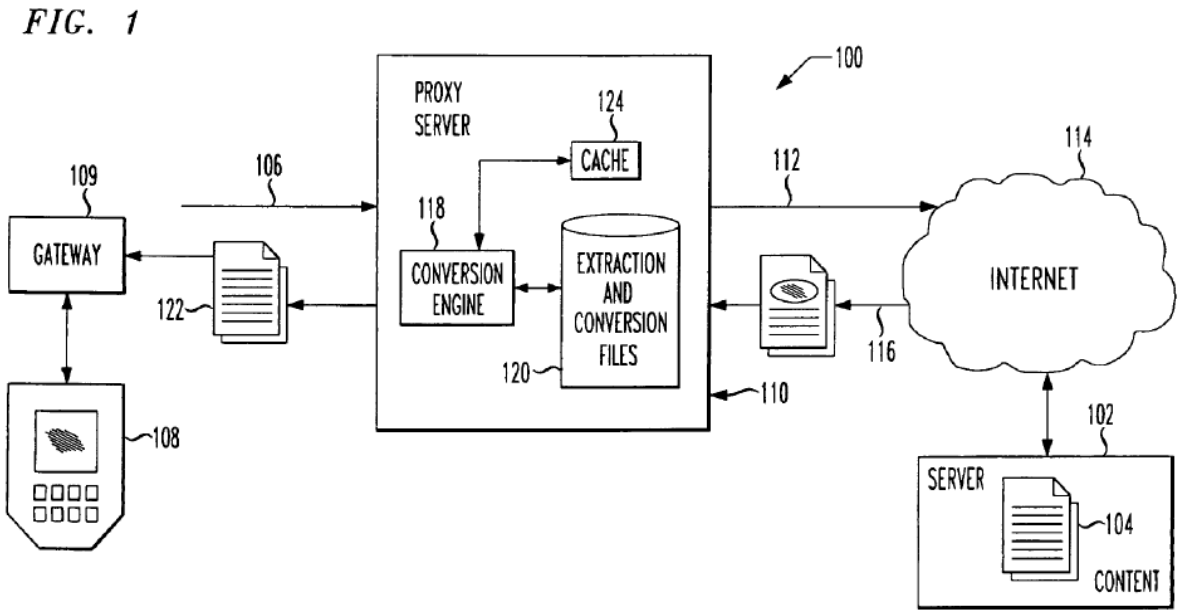


Figure 1 illustrates "a representative simplified block diagram of a mobile device, a proxy server, and a content server." Ex. 1005, 2:57–60. Specifically, architecture 100 includes proxy server 110, which "reformats/converts web content 104 on an origin web server 102 into a format 122 readable on any 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. Analysis of Claim 1

a) The Undisputed Preamble

The preamble of claim 1 recites "[a] method for managing information content in a network-based communication system." Ex. 1001, 18:53–55. Petitioner argues that Neibauer teaches the preamble of claim 1. *See* Pet. 12–13.

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.[15]

b) Limitations 1a and 1b

Claim 1 recites "[1a] providing a first web-based interface accessible to a first user, the first web-based interface being configured to permit the first user to activate a given mobile information channel for sharing content

[15] 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.

between the first user and one or more additional users." Ex. 1001, 18:56–60. Claim 1 further recites "[1b] generating a second web-based interface different than the first web-based interface, wherein the second web-based interface provides each of the one or more additional users access to at least a portion of the shared content via the given mobile information channel to thereby facilitate interaction between the first user and the one or more additional users." *Id.* at 18:61–67. For the reasons set forth below, we are sufficiently persuaded by Petitioner's argument and evidence that the combination of Neibauer and Miller teach limitations 1a and 1b. *See* Pet. 13–21, 30–34.[16]

Neibauer teaches a web-based interface (first 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, 89, 94–95. Figure 21-12 is reproduced below.

[16] Petitioner also presents alternative theories as to how the combination of Neibauer, Cheng, and Miller teaches limitations 1a and 1b. *See* Pet. 21–30, 33–34. For example, relies on the features of Yahoo! Mobile "to the extent mobile device were construed as requiring a handheld device." *Id.* at 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. 28–30. Because we are sufficiently persuaded that the combination of Neibauer (without Yahoo! Mobile) and Miller teaches limitations 1a and 1b, we do not address Petitioner's alternative arguments that further rely upon Cheng.

YAHOO! CLUBS Help?

Yahoo! Clubs: Create a Club

Step 1: Name Your Club

Keep the name short, as it will be in your Web address.

Name: (ex: Joe's Sports Dugout)

Step 2: Your Club's Location (optional)

Is your Club located in a specific neighborhood, city, state or country? Fill it in below.
(Zip codes and countries are used to help categorize the them based on location, allowing users to find Club(s) in their region.)

In USA, enter 5-digit ZIP code: (example: 90210)

Outside USA, select country: Canada
Afghanistan
Albania

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 ¶ 94. In other words, Neibauer teaches providing a first interface shown in Figure 21-12 (a first web-based interface) that is accessible to a person who wishes to create a Yahoo! Club (accessible to a first user). *See* Ex. 1002 ¶ 94.

Neibauer also teaches various ways that users of a Yahoo! Club can share content. *See* Ex. 1002 ¶¶ 97–100. 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 ¶ 97. Another example is a chat feature, club chat, which allows Yahoo Club members to engage in real-time communications. Ex. 1003, 479; Ex. 1002 ¶ 98. A third example is the ability the share photographs with other Yahoo Club members. Ex. 1003, 477–78; Ex. 1002 ¶ 99. Each of the Yahoo! Club

features above allow users to share content, such as messages or photographs, with other club members. *See* Ex. 1002 ¶ 100. Stated differently, Neibauer teaches "sharing content between the first user and one or more 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 '336 patent. *See* Ex. 1002 ¶ 101. According to the '336 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, 8:11–17. Examples of M-channels includes a "discussion forum," "chat," and "photo blog." *Id.* at 8:27–38. Those features are the same or substantially the same as Yahoo! Club message board, chat, and photo sharing features, described in Neibauer. Ex. 1002 ¶ 101.

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 ¶ 109. 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 '336 patent describes a laptop computer as a "mobile device," (Ex. 1001, 4:30–34), 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 ¶ 109).

Based on the current record, the combination of Neibauer and Miller teaches "activat[ing] a given 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 ¶ 104. 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 ¶¶ 103–108.

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 ¶¶ 105–108. 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.* ¶ 107. 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.* ¶ 108.

With regard to limitation 1b, Neibauer teaches a web page (the second web-based interface), such as Figure 21-13, for the Yahoo! Club that is different than the one used to create the Yahoo! Club (the first web-based interface). Figure 21-13 is reproduced below.

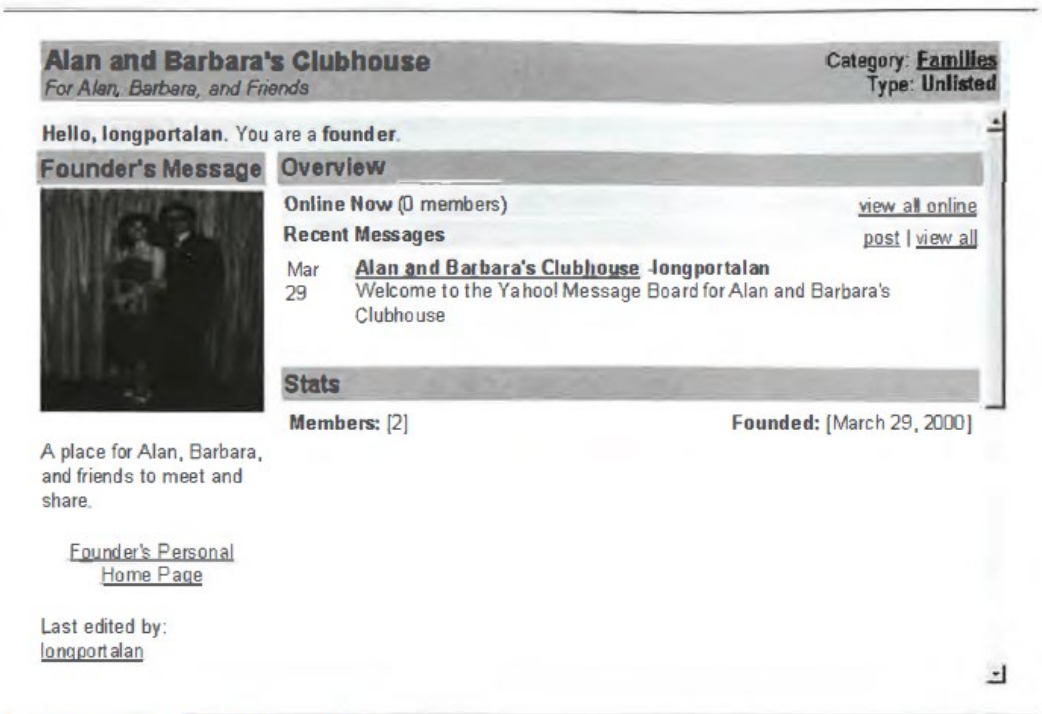


FIGURE 21-13 A Personal club

Ex. 1003, 483. Figure 21-13 "shows an example of a personal club page." *Id.* at 482. Although Figure 21-13 does not show the "Our Pages" section, which lists the features that are available to members, it appears to have been cut-off as Neibauer states that the personal club page in Figure 21-13 "contains all of the elements found on other club pages." *Id.* That would include the mobile information channels discussed above. *See* Ex. 1002 ¶ 126. Moreover, it would have been obvious to a person having ordinary skill in the art to have the Yahoo! Club page include "the Our Pages features, which allow access to the message board, chat, photo, and other features." *Id.* ¶¶ 126–127. Based on the current record, those features would give the users (both the founder and the additional club members) access to shared content through the various information channels such as the club message board, chat, or photo sharing features. *Id.* ¶ 129. A person having ordinary skill in the art would have understood that because those

features allow the exchange of information between the founder and additional club members, the Yahoo! Club page, such as Figure 21-13, would "facilitate interaction[s] between the first user and the one or more additional users." *Id.*

Additionally, the Yahoo! Club page (Figure 21-13) looks different than the web-page used to create the club (Figure 21-12). *See* Ex. 1002 ¶ 128. Stated differently, the second web-based interface is different than the first web-based interface. *Id.*

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

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 between users*** to ***facilitate an interaction*** 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 ¶97. 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 ¶98. And the photo sharing feature allows users to post photographs and view the photographs posted by other users. Ex. 1003, 477; Ex. 1002 ¶ 99.

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. 26–31.

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. 29–30 (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.* at 30 (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. 32. 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 31–42 (detailed discussion).

Patent Owner's arguments relating to Cheng are inapposite. As discussed above, for limitations 1a and 1b, 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. 22 (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.[17]

c) Undisputed Limitations 1c and 1d

Claim 1 also recites

> [1c] wherein the given mobile information channel supports messaging between the first user and the one or more additional users over a wireless network; and
>
> [1d] wherein the mobile information channel is configured to permit the first user to send messaging content to the one or

[17] Patent Owner does not set forth any argument challenging Petitioner's rationale to combine Neibauer and Miller. See Prelim. Resp. 31-42.

> more additional users and to receive messaging content from the one or more additional users.

Ex. 1001, 19:1–7. Petitioner argues that those additional limitations would have been obvious over Niebauer and Cheng. *See* Pet. 34–36.

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[18] (*see* Prelim. Resp.), we are persuaded that Petitioner sufficiently demonstrates, for purposes of this Decision, that limitation 1c and 1d would have been obvious to a person having ordinary skill in the art in light of Neibauer.

d) 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, and Cheng.

5. Analysis of Claims 6–11, 13–18, 20, 21, and 23–27

Because Petitioner demonstrates a reasonable likelihood of success in proving that at least one claim of the '336 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,

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[18] We note that although Patent Owner raises arguments as to why a person having ordinary skill in the art would not have combined the Yahoo! Clubs of Neibauer with the specific implementations of Yahoo Mobile! and Cheng, Patent Owner does not rebut Petitioner's evidence regarding using a well-known cellular communication platform such as GSM with mobile devices such as a laptop. *See* Prelim. Resp. 26–42. 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.

especially, as in this case, when Patent Owner does not separately argue those claims. Those challenges, in our view, are best left for trial after full development of the record.

F. Remaining Grounds

Petitioner also challenges the patentability of claims 1, 6–11, 13–18, and 20–27 based on the addition of Harvey to the combination discussed above, and challenges the patentability of claims 7, 21, and 22 by additionally relying on Ausems or Fransioli, with or without Harvey. *See* Pet. 3, 59–68. Patent Owner does not separately address the merits of Petitioner's other prior art challenges. *See* Prelim. Resp. 42.

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 challenges demonstrate the same. Those challenges, in our view, are best left for trial after full development of the record.

III. CONCLUSION

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

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

IV. ORDER

In consideration of the foregoing, it is hereby

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review is instituted for claims 1, 6–11, 13–18, and 20–27 of the '336 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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