

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RPX CORPORATION,
Petitioner,

v.

PUBLISHING TECHNOLOGIES, LLC,
Patent Owner.

IPR2018-01131
Patent 7,908,342 B2

Before DENISE M. POTHIER, JESSICA C. KAISER, and
KAMRAN JIVANI, *Administrative Patent Judges*.

JIVANI, *Administrative Patent Judge*.

JUDGMENT

Final Written Decision

Determining All Challenged Claims Unpatentable

35 U.S.C. § 318(a)

ORDER

Granting Petitioner's and Patent Owner's Motions to Seal

Denying Patent Owner's Motion to Exclude

37 C.F.R. §§ 42.5, 42.14, 42.54(a), 42.64

I. INTRODUCTION AND BACKGROUND

Petitioner RPX Corporation requested an *inter partes* review of claims 1, 4, 5, 9–11, and 16–20 of U.S. Patent No. 7,908,342 B2 (Ex. 1001, “the ’342 patent”). Paper 2 (“Petition” or “Pet.”). Patent Owner Publishing Technologies, LLC filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). With prior authorization (Paper 8), Petitioner filed a Reply to Patent Owner’s Preliminary Response with respect to Petitioner’s disclosure of the real party-in-interest and the application of the time bar provision of 35 U.S.C. § 315(b). Paper 9. After considering the parties’ arguments and evidence of record, we instituted this review of all challenged claims on all grounds set forth in the Petition. Paper 10 (“Inst. Dec.”).

During trial, the parties engaged in discovery related to Petitioner’s real party-in-interest disclosure. *See* Papers 13–15. The parties agreed to bifurcate Patent Owner’s Response in this proceeding in light of this discovery practice. Paper 15. Patent Owner, therefore, filed a Response (Paper 16, “PO Resp.”) addressing the merits of the Petition and subsequently filed a Supplemental Response (Paper 17, “Supp. Resp.”) addressing the real party-in-interest disclosure. Petitioner filed a single Reply addressing both the Response and Supplemental Response. Paper 25 (“Reply”). Patent Owner filed a Sur-Reply. Paper 27 (“Sur-Reply”).

In addition to the foregoing filings, Petitioner and Patent Owner each moved to seal certain papers and information of record in this proceeding. Papers 19, 24. Patent Owner also moved to exclude certain testimony of record. Paper 29. Petitioner filed an opposition to the motion (Paper 34) and Patent Owner filed a reply in support of its motion. Paper 35.

Both parties requested an oral hearing, and a hearing was held on September 4, 2019. Papers 33, 36. A transcript of the oral hearing has been entered into the record. Paper 42 (“Tr.”).

A. Related Matters

According to Petitioner, the ’342 patent is not involved in any “active litigation.” Pet. 64. Patent Owner asserts that the ’342 patent has been asserted in or is at issue in approximately ten actions for patent infringement or related appeals. Paper 4, 2–3.

Regarding proceedings before the Patent and Trademark Office, Petitioner states, “[a] patent application claiming the benefit of an earlier filing date through the ’342 patent was filed on February 6, 2018 and was given application number 15/889,781.” Pet. 64. Additionally, the ’342 patent is the subject of IPR2018-01132, addressing claims 1–4, 6–8, and 12–15. IPR2018-01132, Paper 2, 1, 32.

B. Real Party-in-Interest

Petitioner identifies only itself, RPX Corporation, as “the sole real party-in-interest in this proceeding.” Pet. 63. Patent Owner contends that Petitioner failed to identify real parties-in-interest or privies Google, [REDACTED]. Supp. Resp. 5, n.1.

We address the parties’ dispute on this issue below. *See infra* Section III.

Patent Owner identifies Publishing Technologies, LLC and Engagelogic Corporation as real parties-in-interest. Paper 4, 2. Patent Owner represents that “Publishing Technologies, LLC is a wholly owned subsidiary of Engagelogic Corporation.” *Id.*

C. The ’342 Patent

The ’342 patent is titled “Method, Apparatus and Sytem for Management of Information Content for Enhanced Accessibility Over

Wireless Communication Networks.” Ex. 1001, 1, code (54). The ’342 patent is a continuation of U.S. Patent No. 7,599,983. *Id.* at 1, code (63). The ’342 patent discloses “techniques 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 1:66–2:3. One aspect of the invention provides a content management web site (“CMS”) accessible to a system user in a network-based communication system. *Id.* at 2:7–9. The user utilizes the CMS to designate at least one data source that is external to the CMS. *Id.* Furthermore, “[a] mobile web site is generated that is accessible independently of the content management web site via one or more mobile devices over a wireless network of the communication system, with the mobile web site being configured to receive data automatically from the external data source designated by the user at the content management web site.” *Id.* at 2:9–15.

D. Illustrative Claim

Petitioner challenges claims 1, 4, 5, 9–11, and 16–20 of the ’342 patent, of which claims 1, 17, and 20 are the only independent claims. Claim 1 is illustrative of the claimed subject matter and is reproduced below:

1. A method for managing information content in a network-based communication system, the method comprising the steps of:

providing a content management web site identified by a first uniform resource locator and accessible to a user of the communication system, the content management web site being configured to permit the user to designate at least one data source that is external to the content management web site; and

generating a mobile web site identified by a second uniform resource locator different than the first uniform resource

locator, the mobile web site being accessible independently of the content management web site via one or more mobile devices, the mobile web site being configured to receive data automatically from the external data source designated by the user at the content management web site.

Ex. 1001, 18:26–42.

E. Prior Art and Asserted Grounds

Petitioner asserts the following grounds of unpatentability:

Claim(s) Challenged	35 U.S.C. §	Reference(s)
1, 5, 9–11, 16–18, and 20	102(e) or 103(a)	Underwood ¹
19	103(a)	Underwood and Tsakiris ²
1, 4, 5, 9–11, and 16–20	103(a)	Austin ³
1, 4, 5, 9–11, 16–18, and 20	103(a)	Austin and Chang ⁴
19	103(a)	Austin, Chang, and Tsakiris

F. Testimony

Petitioner supports its challenges with a declaration of Mark Crovella, Ph.D. Ex. 1002 (“Crovella Declaration”). Dr. Crovella testified by deposition on January 29, 2019, and a transcript of his testimony has been entered into evidence. Ex. 2016. With respect to its real party-in-interest disclosure, Petitioner proffers two declarations of Mr. William W. Chung. Exs. 1033, 2018.

¹ U.S. Patent No. 7,668,913 B1; Feb. 23, 2010 (Ex. 1006) (“Underwood”).

² U.S. Patent Application Publication No. 2001/0034746; Oct. 25, 2001 (Ex. 1016) (“Tsakiris”).

³ International Publication No. WO 02/03243 A1; Jan. 10, 2002 (Ex. 1004) (“Austin”).

⁴ U.S. Patent No. 7,590,681 B1; Sept. 15, 2009 (Ex. 1005) (“Chang”).

II. CONSTITUTIONAL CHALLENGES

Patent Owner requests that we find *inter partes* review of the '342 patent to be unconstitutional because this review constitutes (1) a taking prohibited by the Fifth Amendment and (2) an application of an *ex post facto* law impermissible under Article I. PO Resp. 8, 29–31. More specifically, Patent Owner contends that the findings in our decision on institution “should be reversed” because the “retroactive application of *inter partes* review to [the '342 patent] is an unconstitutional taking without just compensation.” *Id.* at 29. Furthermore, Patent Owner asserts that *inter partes* review is unconstitutional because “Congress is prohibited from passing ex post facto laws by clause 3 of Article I, Section 9 of the United States Constitution, which states that ‘[n]o Bill of Attainder or ex post facto Law shall be passed.’” *Id.* at 31.

The United States Court of Appeals for the Federal Circuit recently rejected Patent Owner’s takings argument in *Celgene Corp. v. Peter*, 931 F.3d 1342 (Fed. Cir. 2019), holding that that the retroactive application of *inter partes* review proceedings to patents issued before the Leahy-Smith America Invents Act went into effect is not an unconstitutional taking under the Fifth Amendment. *Celgene Corp. v. Peter*, 931 F.3d at 1358.

With respect to Patent Owner’s Article I argument, Petitioner correctly counters that “[n]o *ex post facto* law is at issue here” because “[an] *ex post facto* law is one that relates to criminal law.” Reply 25 (citing *Calder v. Bull*, 3 U.S. 386, 391 (1798); *Beazell v. Ohio*, 269 U.S. 167, 169–70 (1925)). According to Patent Owner, however, “*Calder* was principally justified because a contrary interpretation would render the Takings Clause unnecessary and should be reconsidered by the Supreme Court.” Sur-Reply 16–17. Despite Patent Owner’s argument that *Calder* “should be

reconsidered by the Supreme Court,” *Calder* remains binding precedent of the Supreme Court of the United States and we follow it. We, therefore, are not persuaded by Patent Owner’s *ex post facto* law argument.⁵

For the foregoing reasons, we decline Patent Owner’s request to find *inter partes* review of the ’342 patent to be unconstitutional.

III. TIME BAR OF 35 U.S.C. § 315(B)

Patent Owner contends the Petition is time barred under 35 U.S.C. § 315(b) because each of Google, [REDACTED] [REDACTED] “is in privity with the Petitioner and is also a real party-in-interest,” and each was served with a lawsuit alleging infringement of the ’342 patent more than one year prior to the filing of the Petition. Supp. Resp. 4–5, n. 1. Petitioner maintains that the Petition is not time barred because it is the sole real party-in-interest in this proceeding, and it is not in privity with any unnamed party. Reply 2–7.

Although Patent Owner identifies each of Google, [REDACTED] [REDACTED] as unnamed parties whose inclusion would trigger the Section 315(b) time bar, Patent Owner’s argument addresses only Google. Supp. Resp. 4–5, n. 1. Additionally, it is undisputed in the record before us that Google is subject to the Section 315(b) time bar because it was served with a lawsuit alleging infringement of the ’342 patent more than one year prior to the filing of the Petition. *See generally* Supp. Resp.; *see also* Reply. Accordingly, we focus our analysis of the parties’ Section 315(b) arguments on whether Google is a real party-in-interest or privy of Petitioner.

⁵ In apparent recognition of the fact that we will not contravene Supreme Court precedent as Patent Owner’s request seems to imply, Patent Owner clarifies that it brings its *ex post facto* law argument before us only so that “this argument is preserved for appeal.” Sur-Reply 17.

A. *Principles of Law*

Section 315(b) provides that “[a]n inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party-in-interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.” 35 U.S.C. § 315(b).

“Whether a party who is not a named participant in a given proceeding nonetheless constitutes a ‘real party-in-interest’ . . . to that proceeding is a highly fact-dependent question” with no “bright line test,” and is assessed “on a case-by-case basis.” Patent Office Trial Practice Guide (“TPG”), 77 Fed. Reg. 48,756, 48,759 (Aug. 14, 2012) (citing *Taylor v. Sturgell*, 553 U.S. 880, 893–95 (2008); 18A Charles Alan Wright, Arthur R. Miller & Edward H. Cooper, *Federal Practice & Procedure* §§ 4449, 4451). As the United States Court of Appeals for the Federal Circuit recently explained, determining whether a party is a real party-in-interest “demands a flexible approach that takes into account both equitable and practical considerations, with an eye toward determining whether the nonparty is a clear beneficiary that has a preexisting, established relationship with the petitioner.” *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1351 (Fed. Cir. 2018) (“AIT”).

“To decide whether a party other than the petitioner is the real party-in-interest, the Board seeks to determine whether some party other than the petitioner is the party or parties at whose behest the petition has been filed.” *Wi-Fi One, LLC v. Broadcom Corp.*, 887 F.3d 1329, 1336 (Fed. Cir. 2018) (internal citations omitted). Several relevant factors determine whether a party is a real party-in-interest, including the party’s relationship with the

petitioner, the party's relationship to the petition, and the nature of the entity filing the petition. *AIT*, 897 F.3d at 1351.

Though closely related in the context of Section 315(b), our inquiries regarding whether an unnamed party is a privy of a petitioner or a real party-in-interest are distinct. *See AIT*, 897 F.3d at 1350. For instance, “[a] party that funds and directs and controls an IPR or post-grant review proceeding constitutes a ‘real party-in-interest,’ even if that party is not a ‘privy’ of the petitioner.” *Wi-Fi One*, 887 F.3d at 1336 (quoting TPG, 77 Fed. Reg. at 48,760). Similarly, the concept of “privity” is more expansive and encompasses parties that do not necessarily need to be identified in the petition as real parties in interest. TPG, 77 Fed. Reg. at 48,759.

Petitioner “bears the ultimate burden of persuasion to show that its petitions are not time-barred under § 315(b) based on a complaint served on an alleged real party-in-interest [or privy] more than a year earlier.” *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242 (Fed. Cir. 2018).

B. Evidence of Record

During trial, the parties heavily negotiated the scope of document requests to Petitioner and testimony from a fact witness for Petitioner. Papers 13–15 (addressing the parties' disputes regarding the scope of discovery requests, declarations, and a related briefing schedule). This discovery resulted in a two declarations of Mr. William Chuang, an Executive Vice President at RPX Corporation. Ex. 1033 (“First Chuang

Declaration”)⁶; Ex. 2018 (“Second Chuang Declaration”)⁷. The parties also agreed that Petitioner would produce all non-confidential documents exchanged between the parties in *AIT*. Tr. 53:21–54:2.⁸

In his declarations, Mr. Chuang testifies that “Google has been a member of RPX from [REDACTED] to present.” Ex. 1033 ¶ 4. Mr. Chuang further states: a membership agreement exists between Petitioner and Google; he reviewed this agreement; and no part of this agreement “impose[s] on RPX any obligation to file any IPR petition” or “discuss[es] IPR proceedings.” *Id.* ¶ 8. Mr. Chuang continues, “[t]here is nothing in these agreements, nor am I otherwise aware of any obligation or agreement under which RPX was obligated to file the [instant Petition] on behalf of Google.” *Id.* ¶ 9.

Regarding documents beyond the membership agreement, Mr. Chuang attests that Petitioner conducted “a reasonable search of its files for indications of communications” between Petitioner and Google “concerning the ’342 patent after 2013,” but found no such communications.” *Id.* ¶¶ 10–11. Mr. Chuang’s search also revealed no documents regarding any references related to “any IPR that had been or was to be filed by RPX,” but for a single reference dated [REDACTED] [REDACTED] regarding a patent unrelated to the ’342 patent or Patent Owner. *Id.* ¶¶ 12–13.

⁶ The First Chuang Declaration is subject to Patent Owner’s motion to exclude (Paper 29) and Petitioner’s motion to seal (Paper 24). We address each motion below. *See infra* Sections VI and VII.

⁷ The Second Chuang Declaration is subject to Patent Owner’s motion to seal (Paper 19), which we address below. *See infra* Section VII.

⁸ We note these documents do not appear in the record before us because neither party has entered them into the record of this proceeding. *Id.*

Mr. Chuang testifies that “RPX has received no consideration, monetary or otherwise, from any unnamed entity for the purpose of funding or filing the [instant Petition].” *Id.* ¶ 15. He further states that [REDACTED]

[REDACTED]
[REDACTED] Ex. 2018 ¶ 4.

In addition to Mr. Chuang’s declarations, the parties have entered into evidence a 2014 Memorandum and Order of the United States District Court for the Southern District of New York granting Google’s motion for summary judgment of non-infringement of the ’342 patent and denying as moot Google’s motion for summary judgment of invalidity of the ’342 patent. Ex. 1029, 1–2; Ex. 2009, 1–2 (same). Petitioner further proffers the District Court’s Judgment entered in that case and the United States Court of Appeals for the Federal Circuit’s affirmance thereof. Exs. 1029, 1030.

Finally, Patent Owner has entered into evidence what appears to be a portion of Petitioner’s website describing its *inter partes* review activities. Ex. 2019.

C. Whether Google is a Real Party-in-Interest

Petitioner contends it has demonstrated that Google is not a real party-in-interest to this proceeding. Reply 2–6. As a threshold matter, Petitioner asserts that “under *Worlds*, the RPI designation is taken as true unless the Patent Owner comes forward with sufficient evidence suggesting its [sic] incorrect.” *Id.* at 4 (citing *Worlds, Inc.*, 903 F.3d at 1242). Petitioner asserts that Patent Owner’s “factually-unsupported speculation about any alleged interest in the ’342 patent” is insufficient evidence to put Petitioner’s real party-in-interest disclosure into dispute. *Id.* Even if the disclosure is in fact in dispute, Petitioner argues that it has proffered sufficient evidence to carry

its burden through the First and Second Chuang Declarations and the District Court's Order finding non-infringement. *Id.* at 3.

Also relying on *Worlds*, Patent Owner asserts that a petitioner's real party-in-interest disclosure is placed into dispute, "[o]nce the Patent Owner has identified a real party-in-interest or privy of the petitioner that has not been identified." Supp. Resp. 4 (citing *Worlds, Inc.*, 903 F.3d at 1248).

The Federal Circuit directs in *Worlds*:

[A]n IPR petitioner's initial identification of the real parties-in-interest should be accepted unless and until disputed by a patent owner. And although we disagree with treating this initial acceptance as a 'rebuttable presumption' that formally shifts a burden of production to the patent owner, we agree that a patent owner must produce some evidence to support its argument that a particular third party should be named a real party-in-interest.

Worlds, Inc., 903 F.3d at 1242. We do not opine here on the amount of evidence sufficient under *Worlds* to support Patent Owner's argument that Google should be named a real party-in-interest. Rather, assuming *arguendo* that Patent Owner has made that threshold showing by identifying a preexisting relationship between Petitioner and Google, the latter party of which undisputedly is subject to the Section 315(b) time bar with respect to the '342 patent, we determine for the following reasons that Petitioner has adduced sufficient record evidence to show that Google is not a real party-in-interest to this proceeding.

We are mindful of the Federal Circuit's guidance that our inquiry must take "a flexible approach that takes into account both equitable and practical considerations." *AIT*, 897 F.3d at 1351. In light thereof, we frame our analysis in terms of the nature of Petitioner, Google's relationship with Petitioner, and Google's relationship to the Petition. *See id.*

1. *Nature of Petitioner*

Patent Owner contends that Petitioner files petitions for *inter partes* review on its clients' behalf because it "publicly touts the number of IPRs it files," "advertises its IPR filing acumen," and publicizes its ability to "move quickly to seek a cost-effective resolution when available." Supp. Resp. 12 (citing Ex. 2019). Patent Owner makes a number of additional assertions regarding Petitioner's stated mission, work, and client relations, all relying on the Federal Circuit's decision in *AIT*. *Id.* at 13–14.

The evidence of record shows Petitioner is a membership organization. *See* Ex. 1033 ¶ 4 (stating Google is a member of Petitioner); *see also id.* at ¶¶ 8–9 (describing the membership agreement between Google and Petitioner). A party, however, does not become a real party-in-interest simply based on membership in an association. Reply 5–6; *TPG*, 77 Fed. Reg. at 48,760; *AIT*, 897 F.3d. at 1351. The evidence further shows that "RPX files validity challenges, such as *inter partes* review[s]" and that Petitioner filed "57 IPR petitions . . . on 36 patents in 26 campaigns" as of March 31, 2018. Ex. 2019. Contrary to Patent Owner's argument, the evidence does not show that RPX files petitions on behalf of its clients. Ex. 2019 ("We act alone, fund the petitions unilaterally, and expressly discourage input from clients and other third parties, unless they commit to co-filing."). Finally, with regard to Patent Owner's assertions based on evidentiary findings in *AIT* (Supp. Resp. 13–14), we decline to import those findings into this proceeding and lack evidence of record sufficient to make similar findings here.

Accordingly, based on the complete evidentiary record before us, we determine that Petitioner is a membership organization that files

patentability challenges, such as *inter partes* reviews, but not that it regularly files these challenges on behalf of its members.

2. *Google's Relationship with Petitioner*

Turning to Google's specific relationship, the evidence of record shows that Google has a preexisting, established relationship with Petitioner. Google is a member of Petitioner and has been since [REDACTED]. Ex. 1033 ¶¶ 4, 8–9.

Although the parties do not dispute the existence of this relationship, they do dispute the nature of the relationship. Supp. Resp. 6–8; Reply 2–6. In particular, Patent Owner contends that “Google may have the right to control or at least influence the decisions of RPX.” Supp. Resp. 7. According to Patent Owner, this control or influence arises because, “[a]lthough the second Chuang declaration states that Google accounts for [REDACTED], Google is still admitted to be a [REDACTED] client.” *Id.* Patent Owner also contends that Petitioner “should be considered the agent of its [REDACTED] clients” such as Google because Petitioner “has made it clear that filing IPRs is part of the services it provides to its clients.” Supp. Resp. 16–17.

Petitioner replies that even if Patent Owner's control or influence argument were true, “it does not indicate that [Google has] any interest in this proceeding.” Reply 4 (citing *AIT*, 897 F.3d at 1351 (evaluating whether a nonparty is a “clear beneficiary” of the proceeding)). Petitioner further contends that Patent Owner's agency argument fails because “RPX (1) made all decisions concerning this proceeding without considering [Google], (2) received no funding from [Google] for this proceeding, and (3) had not corresponded with [Google] about the '342 patent since 2013.” *Id.* at 5 (citing Ex. 1033 ¶¶ 10, 13, 15). Petitioner continues, “RPX has no

contractual or implicit obligation with [Google] to pursue this IPR.” *Id.* (citing Ex. 1033, ¶ 8).

Patent Owner’s control or influence argument is unpersuasive because it is speculative on its face. *E.g.*, Supp. Resp. 7 (“Several *possibilities may be inferred*, one of which is that Google *may* have the right to control or at least influence the decisions of RPX.”) (emphasis added). Further, Patent Owner’s reliance on outside counsel’s email stating that Google is a [REDACTED] of Petitioner is misplaced. *Id.* at 6 (citing Ex. 2020). Outside counsel’s email describing contents of a potential declaration is not evidence sufficient to substitute for sworn testimony of a fact witness. Even if this statement were evidence, it lacks sufficient specificity (e.g., what makes a client [REDACTED]) to demonstrate control or influence. *See generally* Ex. 2020.

Moreover, Patent Owner’s control or influence argument is contrary to the evidence of record showing that no part of the membership agreement between Petitioner and Patent Owner “impose[s] on RPX any obligation to file any IPR petition” or “discuss[s] IPR proceedings.” Ex. 1033 ¶ 8. The evidence further shows that Petitioner’s search for documents revealed no documents referring to “any IPR that had been or was to be filed by RPX,” but for a single reference dated [REDACTED] regarding a patent unrelated to the ’342 patent or Patent Owner. *Id.* ¶¶ 12–13. Finally, Patent Owner’s control or influence argument is undermined by the evidence showing that [REDACTED]. Ex. 2018 ¶ 4.

With regard to Patent Owner’s argument regarding agency, we disagree with this argument because it is unsupported by the record evidence. Patent Owner cites to no evidence in support of its agency

argument. *See* Supp. Resp. 16–17. To the extent Patent Owner relies on evidentiary findings in *AIT* (*see id.* at 16), we decline to import those findings into this proceeding and lack evidence of record sufficient to make similar findings here. Finally, we determined above that Petitioner is a membership organization that files validity challenges, such as *inter partes* reviews, but not that it regularly files these challenges on behalf of its members. *See supra* Section III.C.1.

Accordingly, based on the complete evidentiary record before us, we determine that Google maintains a relationship with Petitioner, but not that Google controls or influences Petitioner’s filings of petitions or that Petitioner acts as an agent of Google.

3. *Google’s Relationship to the Petition*

Petitioner asserts that “the evidence shows a *lack* of interest” by Google in the Petition such that “RPX is the sole RPI in this proceeding.” Reply 2–5. Patent Owner contends that Google is interested in the Petition and would benefit from its success because Google “can still be sued for infringement occurring after the judgment in 2013.” Supp. Resp. 10–12.

We agree with Petitioner. The record does not support that Google stands to benefit from the Petition because the record evidence shows that Google is adjudged a non-infringer. Ex. 1029, 1–2 (Order granting Google’s motion for summary judgment of non-infringement of the ’342 patent); Ex. 2009, 1–2 (same); Ex. 1030 (Judgment); Ex. 1031 (affirming Judgment of the District Court). Patent Owner’s assertion to the contrary that Google “can still be sued for infringement occurring after the judgment in 2013” (Supp. Resp. 10) asks us to infer a benefit on the mere possibility of a suit. There is no record evidence of a subsequent assertion of the ’342 patent against Google. Indeed, Patent Owner acknowledges, “there was no pending

litigation on the '342 patent against any company [when] RPX filed [the Petition].” Supp. Resp. 19. In the absence of supporting evidence, we decline to make the inference Patent Owner requests.

Further, the evidence shows that the Petition was not filed at Google’s behest. Google did not fund the Petition. Ex. 1033 ¶ 15 (attesting that “RPX has received no consideration, monetary or otherwise, from any unnamed entity for the purpose of funding or filing the [instant Petition]”). Google did not communicate with Petitioner regarding the Petition, the Patent Owner, or the '342 patent. *Id.* at ¶¶ 10–13. And Petitioner was not obligated to file the Petition by any agreement with Google. *Id.* at ¶¶ 8–9.

Lastly, Patent Owner summarily argues that Petitioner should be precluded from re-litigating validity on behalf of Google through the Petition. Supp. Resp. 18–19. Even assuming that previously litigating validity would, itself, provide a basis for a time bar under § 315(b), Patent Owner’s argument is refuted by the record evidence showing Google has not previously litigated validity of the '342 patent. Ex. 1029, 1–2 (Order denying as moot Google’s motion for summary judgment of invalidity of the '342 patent); Ex. 2009, 1–2 (same); Ex. 1030 (Judgment); Ex. 1031 (affirming Judgment of the District Court).

Accordingly, based on the complete evidentiary record before us, we determine that Google does not have relationship to the Petition.

In sum, we find based on the evidentiary record in this proceeding that Petitioner is a membership organization that challenges patentability and unnamed party Google maintains a relationship with Petitioner. Even so, we further find that the evidence does not support finding that Petitioner files challenges on behalf of its members or that Google controls or influences Petitioner’s filings of petitions. There also is insufficient evidence to show

that Petitioner acts as Google's agent. Finally, the evidence supports finding that Google does not have a relationship to the Petition. We, therefore, determine that Google is not a real party-in-interest to this proceeding.

D. Whether Google is a Privy of Petitioner

Patent Owner argues, "even if Google were not an RPI, it is a privy of RPX." Supp. Resp. 14. Patent Owner's sole factual assertion in support of this argument reads as follows: "Here, Google is a [REDACTED] that obviously stands to benefit from RPX's advertised IPR services, and indeed is likely in the business relationship in part to gain the benefit of such services." *Id.* at 15. As discussed above, Patent Owner's reliance on the [REDACTED] statement is misplaced and the evidence does not show any benefit to Google from the Petition. *See supra* Sections III.C.2–3. Accordingly, we are not persuaded by Patent Owner's argument that Google is a privy of Petitioner.

E. Conclusion

For the foregoing reasons, we determine that Google is not a real party-in-interest to this proceeding nor a privy of Petitioner. Accordingly, we find the Petition is not subject to the time bar provision of 35 U.S.C. § 315(b).

IV. CLAIM CONSTRUCTION

A. Principles of Law

We interpret claims of an unexpired patent using the broadest reasonable interpretation in light of the specification. *See* 37 C.F.R. § 42.100(b) (2017)⁹; *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131,

⁹ Our recently changed version of this Rule, which requires that we interpret claims in the same manner used in a civil action under 35 U.S.C. § 282(b), does not apply here because the Petition was filed before the effective date

2144–46 (2016). Under that standard, and absent any special definitions, we generally give claim terms their ordinary and customary meaning, as would be understood by one of ordinary skill in the art at the time of the invention. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Any special definitions for claim terms must be set forth with reasonable clarity, deliberateness, and precision. *See In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

B. Construction of Disputed Claim Limitations

Petitioner seeks our construction of the limitation “the mobile web site being accessible independently of the content management web site,” recited in independent claims 1, 17, and 20. Pet. 4. Petitioner contends, “all other terms should have their plain and ordinary meaning as understood by a [person of ordinary skill in the art].” *Id.*

Patent Owner seeks our construction of the limitations “mobile web site,” “content management web site,” and “configured to receive data automatically from the external data source designated by the user at the content management website.” PO Resp. 12–14. Patent Owner seeks construction of each of these limitations because each relates to its arguments in opposition to Petitioner’s theories of unpatentability. *See, e.g., id.* at 13–14 (asserting that “[e]ven if the prior art were construed as a ‘content management web site,’ there is no teaching in the prior art cited that the ‘mobile website’ [sic] is ‘programmed to receive data without further

of the new Rule, November 13, 2018. *See Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board*, 83 Fed. Reg. 51,340, 51,344 (Oct. 11, 2018).

action required by the user from the same sources specified by the user in the preceding step’’).

We address below the parties’ positions regarding the aforementioned claim limitations. We further determine in light of our analysis of Petitioner’s asserted unpatentability grounds (*see infra* Section V) that construction of additional limitations is not necessary, and, therefore, we do not construe any additional claim terms. *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (explaining that only claim terms in controversy need to be construed, and only to the extent necessary to resolve the controversy).

1. “mobile web site”

Patent Owner asks in its Response that we construe this term as “a web site designed to be accessed by a mobile device.” PO Resp. 10. The United States District Court for the Southern District of New York adopted this construction during a claim construction hearing regarding U.S. Patent No. 7,599,983, of which the ’342 patent is a continuation. Ex. 2001, 57–58. Petitioner does not dispute the Patent Owner’s construction. Tr. 18:10–15 (stating Petitioner does not dispute application of the District Court’s constructions in this proceeding), 18:23–24 (addressing the District Court’s construction of the term “mobile web site”).

Having reviewed the Specification of the ’342 patent, we find the District Court’s construction to be supported by the Specification. Based on the full record developed during this trial, we find no need to depart from the District Court’s construction, and therefore, adopt it as our own.

Accordingly, we construe the term “mobile web site” as a web site designed to be accessed by a mobile device.

2. *“content management web site”*

Patent Owner asks in its Response that we construe this term as “a website that allows a user without programming to create and manage content at a mobile website.” PO Resp. 10. This construction was proposed by the United States District Court for the Southern District of New York during a claim construction hearing regarding the ’342 patent. Ex. 2002, 43.

Petitioner does not dispute the Patent Owner’s construction. Tr. 18, 7–15 (stating Petitioner does not dispute application of the District Court’s construction of the term “content management web site” in this proceeding).

Having reviewed the Specification of the ’342 patent, we find the District Court’s construction to be supported by the Specification. Based on the full record developed during this trial, we find no need to depart from the District Court’s construction, and therefore, adopt it as our own.

Accordingly, we construe the term “content management web set” as a website that allows a user without programming to create and manage content at a mobile website.

3. *“the mobile web site being accessible independently of the content management web site”*

In our Decision on Institution, we preliminarily construed this limitation as “the mobile website is capable of being reached without visiting the content management website.” Dec. on Inst. 18. In so doing, we adopted the District Court’s construction of this limitation. *Id.* Neither party contests our preliminary construction of this term. PO Resp. 11; *see* Reply 7–9. Based on the full record developed during this trial, we find no need to depart from our preliminary construction.

Accordingly, we construe the limitation “the mobile web site being accessible independently of the content management web site” as the mobile

website is capable of being reached without visiting the content management website.

4. *“configured to receive data automatically from the external data source designated by the user at the content management website”*

Patent Owner asks in its Response that we construe this limitation as “programmed to receive data without further action required by the user from the same sources specified by the user in the preceding step.” PO Resp. 11. This construction was adopted by the United States District Court for the Southern District of New York during a claim construction hearing regarding the ’342 patent. Ex. 2002, 103. Petitioner does not dispute the Patent Owner’s construction. Tr. 18, 10–15 (stating Petitioner does not dispute application of the District Court’s constructions in this proceeding).

Having reviewed the Specification of the ’342 patent, we find the District Court’s construction to be supported by the Specification. Based on the full record developed during this trial, we find no need to depart from the District Court’s construction, and therefore, adopt it as our own.

Accordingly, we construe the limitation “configured to receive data automatically from the external data source designated by the user at the content management website” as programmed to receive data without further action required by the user from the same sources specified by the user in the preceding step.

5. *Additional Terms*

In addition to the limitations discussed above, Patent Owner requests in its Response that we construe the following limitations: “web site;” “generating a mobile web site;” and “designate at least one data source as external to the content management website.” PO Resp. 10–11. Patent

Owner, however, does not demonstrate how construction of these limitations is necessary for us to resolve Petitioner's patentability challenges. *See generally* PO Resp.; Sur-Reply. Because our analysis of Petitioner's asserted unpatentability grounds (*see infra* Section V) is not impacted by construction of these terms, we determine that construction of these terms is not necessary, and, therefore, we do not construe them. *Vivid Techs., Inc.*, 200 F.3d at 803 (Fed. Cir. 1999).

C. Alleged Administrative Procedures Act Violation

As discussed above, the Petition in this proceeding proposes a construction of the limitation "the mobile web site being accessible independently of the content management web site," recited in independent claims 1, 17, and 20, and further states that "all other terms should have their plain and ordinary meaning as understood by a [person of ordinary skill in the art]." Pet. 4.

Patent Owner contends that the Petition is deficient because "[t]he petition does not, nor does the Board's Institution decision, explain how [the terms addressed in District Court claim construction hearings] should be construed and applied." PO Resp. 14; *see also* Sur-Reply 13 (arguing that Petitioner's alleged failure to satisfy 37 C.F.R. § 42.104(b) "should have barred institution of trial in the matter"). In particular, Patent Owner asserts that prior District Court claim construction hearings addressed the terms: "mobile web site," "content management web site," "configured to receive data automatically from the external data source designated by the user at the content management website," "the mobile web site being accessible independently of the content management web site," "web site," "generating a mobile web site," and "designate at least one data source as external to the content management website." PO Resp. 10–11. According to Patent

Owner, “[f]ailing to require the Petitioner to provide claim constructions and simply stating adoption of the ‘plain and ordinary meaning’ for all but one of the terms in the ‘342 patent, is improper.” *Id.* at 15. Patent Owner continues, “[r]equiring the Patent Owner to make these arguments and decisions in the dark about the Board’s view of the constructions of the claims in the case is a fundamental violation of the APA.” *Id.* at 16. Patent Owner elaborates:

Here, Patent Owner has no notice at all of the Board’s claim construction positions on various critical claims construction issues. Simply informing Patent Owner of those decisions after the hearing does not comply with the APA, and gives the Patent Owner no meaningful chance to amend the claims in order to amend them for patentability, in violation of the process set forth for IPRs by Congress.

Id. We disagree for the following reasons.

First, contrary to Patent Owner’s argument, the Petition sets forth Petitioner’s claim interpretation position. As stated in our Decision on Institution, “Patent Owner itself has acknowledged, Petitioner has stated its claim construction position(s), *i.e.*, that the claim terms should be construed according to their plain and ordinary meaning, except for one claim term.” Dec. on Inst. 6. We reiterate that the mere fact “[t]hat Patent Owner disagrees with Petitioner’s claim construction position(s) does not mean that Petitioner has failed to meet its burden under Sections 42.104(b)(3)–(4).” *Id.* Moreover, Patent Owner does not dispute Petitioner’s positions on the terms “web site,” “generating a mobile web site,” and “designate at least one data source as external to the content management website” as demonstrated by Petitioner’s application of these terms to the asserted prior art because Patent Owner does not contend in the record before us that the applied art fails to meet these limitations. *See* PO Resp. 13–14 (asserting only that the

applied art fails to meet the terms “content management web site,” “mobile web site,” and “the mobile web site being accessible independently of the content management web site”); *see also generally* PO Resp.; Sur–Reply.

Second, our Decision on Institution resolved the claim construction dispute before us at that time. Patent Owner filed a Preliminary Response to the Petition and chose not to place into dispute the construction of any specific claim term and its impact on Petitioner’s unpatentability theories, instead stating merely that Petitioner does not address “the many claim construction issues raised in the previous litigation.” Prelim. Resp. 6–7. Thus, the only claim term in dispute at the time of our Decision on Institution was raised by Petitioner, and our Decision set forth our preliminary construction of that term. Dec. on Inst. 18. Patent Owner’s contention that it proceeded to trial “in the dark about the Board’s view of the constructions of the claims in the case” is unavailing because Patent Owner chose not to seek construction of any specific terms prior to trial. To the extent Patent Owner contends it was not required to place terms into dispute in order to seek our construction, we agree with Petitioner that “claim construction is not an obligatory exercise in redundancy” (Reply 7 (citing *U.S. Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554, 1568 (Fed. Cir. 1997))) and that the Board is “not (and should not be) required to construe every limitation present in a patent’s asserted claims.” *Id.* (citing *O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co., Ltd.*, 521 F.3d 1351, 1362 (Fed. Cir. 2008)).

Third, we provided Patent Owner with ample opportunity to submit facts and arguments. Although Patent Owner correctly recognizes that the Administrative Procedures Act requires us to “give the parties an opportunity to submit facts and arguments for consideration” (PO Resp. 16),

Patent Owner fails to recognize that we satisfied this obligation by providing for a Response and Sur-Reply. Patent Owner availed itself of the opportunity we afforded by addressing in its Response construction of the terms “mobile web site,” “content management web site,” “configured to receive data automatically from the external data source designated by the user at the content management website,” and “the mobile web site being accessible independently of the content management web site.” PO Resp. 10–14. Patent Owner chose not to further address construction of these terms in its Sur-Reply. *See generally* Sur-Reply; *see also supra* Sections IV.B.1–4 (construing each term, taking into account Patent Owner’s and Petitioner’s positions on each term). With regard to the terms “web site,” “generating a mobile web site,” and “designate at least one data source as external to the content management website,” Patent Owner availed itself of the opportunity we afforded by identifying prior constructions of these terms (PO Resp. 11–12), but did not demonstrate why construction of these terms would be necessary to resolve the dispute before us. For instance, Patent Owner does not dispute Petitioner’s positions on these terms as demonstrated by Petitioner’s application of the terms to the asserted prior art. *See id.* at 13–14 (asserting only that the applied art fails to meet the terms “content management web site,” “mobile web site,” and “the mobile web site being accessible independently of the content management web site”); *see also generally* PO Resp.; Sur-Reply.

Fourth, Patent Owner was afforded, and continues to enjoy, a “meaningful chance to amend the claims” challenged in this proceeding. Patent Owner withdrew its request to confer with us regarding a potential motion to amend the claims, as provided for in our Scheduling Order, one day after requesting the conference. Ex. 1034. Moreover, Patent Owner

may yet pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this Decision. *See Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*, 84 Fed. Reg. 16,654 (Apr. 22, 2019).

Accordingly, for the foregoing reasons, we disagree with Patent Owner's arguments regarding an alleged violation of the Administrative Procedures Act.

V. ANALYSIS OF ASSERTED GROUNDS

A. *Principles of Law*

Petitioner bears the burden of proving unpatentability of the challenged claims, and the burden of persuasion never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). To prevail in its challenges, Petitioner must demonstrate by a preponderance of the evidence that the challenged claims are unpatentable. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d).

A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros., Inc. v. Union Oil. Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). The elements must be arranged as recited in the challenged claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

A claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The

question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) when in evidence, objective evidence of non-obviousness such as commercial success, long-felt but unsolved needs, failure of others, and unexpected results. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966) (“the Graham factors”). The obviousness inquiry further requires an analysis of “whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (requiring “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)).

Neither party presents evidence on the fourth *Graham* factor. We, therefore, do not consider that factor in this decision.

B. Level of Ordinary Skill in the Art

The level of skill in the art is a factual determination that provides a primary guarantee of objectivity in an obviousness analysis. *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 1324 (Fed. Cir. 1999) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966); *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991)).

Petitioner asserts that a person of ordinary skill in the art (“skilled artisan”) at the time of the invention would have attained “a bachelor’s degree in computer science, computer engineering, or a related field and two years of experience working in development of web-based content and/or applications.” Pet. 3–4 (citing Ex. 1002 ¶ 17). Petitioner adds that “[i]ndividuals with additional education or additional industry experience could be a [person of ordinary skill in the art] if the additional aspect

compensates for a deficit in one of the other aspects.” *Id.* at 4. Patent Owner does not address the level of ordinary skill of a skilled artisan. *See generally* PO Resp.

We regard Petitioner’s formulation of the level of skill as consistent with the prior art before us. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (prior art itself may reflect an appropriate level of skill). Thus, we adopt Petitioner’s proposal.

C. Overview of Asserted Prior Art

1. Underwood

Underwood “provide[s] an improved method . . . for web site generation that harnesses and coordinates all the resources required for creating, updating and maintaining a quality web site,” and provides an “improved method . . . for web site generation that allows for the collection of various information from an external database” Ex. 1006, 3:51–54, 61–65; *id.* at 10:13–15; Fig. 1.

2. Tsakiris

Tsakiris describes “creating a set of user-defined personal web cards thereby facilitating access to resources on the Internet while using a mobile device, particularly a mobile phone.” Ex. 1016, Abst. “The invention enables a user to enter or provide configuration information, which defines one or more personal web cards.” *Id.* Tsakiris uses this configuration information to generate personal web cards. *Id.*

3. Austin

Austin discloses “a web site structure and a method of building a web site for an internet shopping mall in which a number of different and independent retailers are represented on web pages produced on the

shopping mall site but under each retailers individual control.” Ex. 1004, Abst.

4. *Chang*

Chang discloses “[a] method and a system [that] allow presentation of web pages to an internet appliance (e.g., a hand-held computer, a mobile telephone, or a digital personal assistant) according to user preferences.” Ex. 1005, Abst. Chang’s “user preferences are captured by a management server, which provides a web page customization service in conjunction with a document manager, which parses the web pages to identify information units.” *Id.*

D. *Asserted Anticipation of Claims 1, 5, 9–11, 16–18, and 20 by Underwood*

1. *Claim 1*

Petitioner and Dr. Crovella demonstrate persuasively where each element of independent claim 1 is disclosed in Underwood, as follows. Pet. 10–18; Reply 12–22. Claim 1 recites, “providing a content management web site identified by a first uniform resource locator and accessible to a user of the communication system.” Ex. 1001, 18:29–31. Petitioner notes that “Underwood teaches a ‘Universal Content Manager’ or ‘UCM’ that ‘integrat[es], within one Internet navigation interface: a complete business web site solution.’” and that “[t]he UCM includes “Definer software for generating a complete quality web site by communicating with server 105,” “[t]he Definer includ[ing] modules like a ‘Site Definer’ and “Web Definer.” Pet. 10 (citing Ex. 1006, 4:38–47; 4:59–5:25; 11:43–50). Relying on its declarant, Dr. Crovella, Petitioner asserts that “[t]he Definer is accessible by a URL that provides a top-level page into the site including the Definer modules.” *Id.* at 10–11 (citing Ex. 1002 ¶ 113; Ex. 1006, Fig. 5, 13:15–18,

29:1–12). Petitioner asserts that the Definer constitutes a content management website that is identified by a first URL and is accessible to a user. *Id.* at 11 (citing Ex. 1002 ¶ 113).

Claim 1 further recites “the content management website being configured to permit the user to designate at least one data source that is external to the content management website.” Ex. 1001, 18:31–34. Petitioner points out that “Underwood’s method includes ‘retrieving web site data according to’ a description of the website, where the ‘web site data includes dynamic content data from an external data source and the data entry may include a designation of such an external data source.’” Pet. 11 (citing Ex. 1006, Abst.). Petitioner further notes that “[i]n addition to providing static webpages, these ‘external web-server hosted applications’ can be used to provide ‘custom content for inclusion within a page of a Definer web site.’” *Id.* at 12 (citing Ex. 1006, 45:23–27). According to Petitioner, a user designates an external data source by inserting, during the editing process, a “DXC instance” that is associated with the external data source (via the DXC registry). *Id.* Petitioner concludes that “Underwood teaches that the external components are a data source that is external to the content management website (i.e., the Definer).” *Id.*

Claim 1 further recites “generating a mobile website identified by a second uniform resource locator different than the first uniform resource locator.” Ex. 1001, 18:35–37. For this limitation, Petitioner refers to the following disclosure from Underwood (Pet. 12): “The user portion of the system includes a web site provider (hereinafter Definer) which acts as an assembly line for an end user to generate a customized web site” (Ex. 1006, 4:59–61); Definer “publishes the web site created by the end user onto the World Wide Web” (*id.* at 12:20–26); and, “When a user . . . publish[es] a

site, the publish method . . . generates the HTML for the web page . . . and loads it onto a web server for hosting the published site” (*id.* at 41:54–57). Petitioner further refers to the disclosure that “[b]efore the website is published, the user specifies ‘a preferred domain name in a space 6410 for publishing the template web site.’” Pet. 13 (citing Ex. 1006, 37:44–46, Fig. 64A). Petitioner concludes that “[b]ased on these teachings, including the disclosure of publishing a website at a specific domain, generating HTML for webpages when publishing content, having visitors to websites with dynamic content such as by having DXC generate data dynamically at runtime, a [person of ordinary skill in the art or “POSA”] would have understood that Underwood discloses that the resulting site is at a second URL.” *Id.* at 14 (citing Ex. 1002 ¶ 119). In addition, Petitioner contends that “[t]he domain name selected by the user is part of a URL that is different from the URL for the Definer as would have been apparent to a [skilled artisan] because the selected domain name is dedicated to the website audience whereas the URL identifying the Definer is directed to the web site creator/Definer user.” *Id.*

With respect to the claimed “mobile web site,” Petitioner asserts that “Underwood’s published websites include mobile websites because the sites can be specifically formatted for viewing on [reduced capacity] mobile devices.” *Id.* (citing Ex. 1006, 8:51–9:13; Ex. 1002 ¶¶ 120–121).

Claim 1 further recites “the mobile website being accessible independently of the content management website via one or more mobile devices.” Ex. 1001, 18:37–39. With respect to this limitation, Petitioner asserts that “because different URLs are used to access the different pages of these distinct sites, pages of Underwood’s mobile website are accessible without accessing the pages of the content management website, thus

making the mobile website ‘accessible independently’ of the content management website.” Pet. 15 (citing Ex. 1002 ¶ 124). Petitioner also contends that a skilled artisan “would have understood that Underwood teaches that the mobile website is accessed ‘via one or more mobile devices’ based on the teaching that the website may be formatted specifically for display on ‘a palm computer, cellular telephone or the like.’” *Id.* at 16 (citing Ex. 1006, 9:9–13; Ex. 1002 ¶¶ 120–121, 125).

Claim 1 further recites “the mobile website being configured to receive data automatically from the external data source designated by the user at the content management website.” Ex. 1001, 18:39–42. For this limitation, Petitioner asserts that “Underwood teaches that the content management website allows a user to designate a data source external to the content management website” and “[o]nce published, the mobile website can [automatically] receive data from external data sources called by DXC instances inserted into pages by the user.” Pet. 16–17 (citing Ex. 1006, Fig. 78). According to Petitioner, a skilled artisan “would have understood Underwood to disclose that the mobile website receives data from an external source because a visitor’s page request calls the Runtime Event interface which in turn calls a remote (server) application to automatically generate HTML code for inclusion in the website page.” *Id.* at 17 (citing Ex. 1006, Abst.; Ex. 1002 ¶ 128).

We are persuaded by Petitioner’s showing that Underwood discloses all of the limitations of claim 1, and we adopt Petitioner’s analysis as our own.

Patent Owner asserts that Underwood does not describe a “content management web site” because in Underwood, “the designer creates web sites, which may not be designed for access by a mobile user at all.” PO

Resp. 22. According to Patent Owner, “[t]he designer controls the appearance of the web site, and thus there is no teaching of a content management web site for use with a mobile web site, as required by the properly construed claims.” *Id.* at 22–23.

Furthermore, Patent Owner asserts that Underwood does not disclose “generating a mobile web site configured to receive data automatically from the external data source designated by the user at the content management website” because the system of Underwood requires a user to design its web site. *Id.* at 24. Patent Owner states:

Both Austin and Underwood require all sorts of required actions by the user to get any designated data into a web site. If the web site is to be mobile, it is up to the user to design the web site accordingly. This is in stark contrast to the claims of the ‘342 patent, which require that the process be ‘automatic.’

Id. Patent Owner elaborates that “Petitioner admits that mobile web sites are not generated ‘automatically’ in either the Underwood or Austin disclosures.” Sur-Reply 8. Patent Owner contends that, unlike the system of Underwood, the ’342 patent describes “an automatically generated mobile website, which requires no design on the part of the user in accordance with the ordinary meaning of the term.” *Id.* at 7.

We disagree with Patent Owner’s arguments for the following reasons. First, contrary to Patent Owner’s argument that in Underwood “the designer creates web sites, which may not be designed for access by a mobile user at all” (PO Resp. 22), Underwood discloses generating a mobile web site. We construed above the term “mobile web site” as a web site designed to be accessed by a mobile device. Underwood discloses creating websites designed to be accessed by a mobile device, as follows. Underwood states that a web site designed using its system “*may be*

formatted so that it presents a different appearance depending on a number of factors including: . . . *the capabilities of the device used to access the web site.*” Ex. 1006, 8:51–55 (emphasis added). Underwood continues, “[t]he web site can be configured so that it recognizes the format of the accessing device and presents a format that can be transmitted and used by the accessing device.” *Id.* at 8:65–67. Specifically with regard to accessing the web site via a mobile device such as a “Palm Pilot” or “a cellular telephone,” Underwood discloses presenting “the web site in a format useable by the accessing device.” *Id.* at 8:59–65. Underwood discloses, “[t]he site can also be formatted during editing to depict the look of the site on a reduced capacity device, such as a palm computer, cellular telephone or the like. Thus, a user can design and view a web site for a variety of preview devices of differing capabilities.” *Id.* at 9:9–13. In light of the foregoing disclosure, we disagree with Patent Owner that in Underwood “there is no teaching of a content management web site for use with a mobile web site.” PO Resp. 22–23.

Second, Patent Owner’s argument regarding the claimed “generating a mobile web site configured to receive data automatically from the external data source” is unavailing because it is not commensurate with the scope of the claim. Patent Owner repeatedly asserts that the claimed mobile web site must be generated automatically. *See, e.g.,* PO Resp. 24; Sur-Reply 7–8. Claim 1, however, does not recite generating a mobile web site automatically. Rather, claim 1 recites simply, “generating a mobile web site.” Ex. 1001, 18:35. The only use of the term “automatically” in claim 1 describes how the mobile web site receives data. *Id.* at 18:39–40. Thus, Patent Owner’s argument is not supported by the claim language. *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) (The “arguments fail from the

outset because . . . they are not based on limitations appearing in the claims.”).

For the reasons discussed above, based on the complete trial record before us, we find Petitioner has shown by a preponderance of the evidence that claim 1 is anticipated by Underwood.

2. *Claims 5, 9–11*

Claim 5 recites, in relevant part, “the data source comprises a file source.” Ex. 1001, 18:50–51. Petitioner and Dr. Crovella demonstrate where this subject matter is disclosed in Underwood. Pet. 19. Having reviewed the disclosure of Underwood upon which Petitioner and Dr. Crovella rely, we agree with Petitioner that Underwood discloses a data source comprising a file source. More specifically, we agree with Petitioner and Dr. Crovella that DXCs of Underwood can refer to static webpages, leading those static webpages to be pulled into the mobile website at runtime, and that the static HTML webpages identified by the user for inclusion in a mobile website are files and therefore come from a file source. *Id.* (citing Ex 1002 ¶ 137; Ex. 1006, Fig. 78, 45:60–65, 48:51–49:5, 51:16–38).

Claim 9 recites, in relevant part, “the content management web site permits the user to upload at least one information item,” and “the mobile web site includes said at least one uploaded information item.” Ex. 1001, 18:58–61. Petitioner and Dr. Crovella demonstrate where this subject matter is disclosed in Underwood. Pet. 19–20. Petitioner points out that Underwood teaches an “Upload Image” button providing for uploading an image to be displayed on the online store for the product category,” and that “[i]mages are information items and may be uploaded by the user using the Definer.” Pet. 19 (citing Ex. 1002 ¶ 143; Ex. 1006, 19:54–56, 20:7–8; 35:40–51, 36:25–32; Fig. 59). Having reviewed the disclosure of

Underwood upon which Petitioner and Dr. Crovella rely, we agree with Petitioner that Underwood teaches this subject matter of claim 9.

Claim 10 recites, in relevant part, “the content management web site permits the user to select one or more information items from a listing of a plurality of information items,” and “the mobile web site includes said one or more selected information items but does not include other information items in the listing that were not selected by the user.” Ex. 1001, 18:62–67. Petitioner and Dr. Crovella demonstrate where this subject matter is disclosed in Underwood. Pet. 20–21. Specifically, Petitioner notes that Underwood teaches “a listing of information items such as whether the user wants to be able to sell products on its web site, have a staff directory, or list locations” and that “[b]ased on [a user] selection of certain information items, the mobile web site includes said one or more selected information items but does not include other information items in the listing that were not selected by the user.” Pet. 20–21 (citing Ex. 1006, Fig. 53, 34:26–43). Having reviewed the disclosure of Underwood upon which Petitioner and Dr. Crovella rely, we agree with Petitioner that Underwood teaches this subject matter of claim 10.

Claim 11 recites, in relevant part, “the content management web site permits the user to enter a message,” and “the mobile web site includes the entered message.” Ex. 1001, 19:1–3. Petitioner and Dr. Crovella demonstrate that this subject matter is disclosed in Underwood. Pet. 21–22. Specifically, petitioner points to “[t]he online store maintenance feature” of Underwood, which “includes a message text box 3320 . . . for entering a text message to be displayed when an order is placed by a customer using a web site containing the online store.” Pet. 21 (citing Ex. 1006, 19:34–37, Fig.

33). Having reviewed the evidence cited by Petitioner and Dr. Crovella, we agree with Petitioner that Underwood discloses the limitations of claim 11.

Patent Owner asserts that, as to dependent claims 5 and 9–11, “Petitioner simply cites a number of features in the art that are recited as potential ‘external data sources’ that can be designated by the user for automatic inclusion in a mobile web site.” PO Resp. 25–26. Patent Owner goes on to assert that “there is nothing in Underwood, Tsakiris, Austin or Chang references that has anything to do with content management or mobile web site generation,” and that therefore there is nothing that would render obvious automatically making such sources part of a mobile web site. *Id.* at 26 (citing Ex. 2016, 57:5–59:13).

As addressed above in the context of independent claim 1, we disagree with Patent Owner that Underwood fails to disclose the claimed content management web site or generating a mobile web site. *See supra* Section V.D.1. For the reasons discussed above, based on the complete trial record before us, we find Petitioner has shown by a preponderance of the evidence that claims 5 and 9–11 are anticipated by Underwood.

3. *Claim 16*

Claim 16 recites, “[a] non-transitory computer-readable storage medium having embodied therein executable code of one or more software programs for use in managing information content in a network-based communication system, wherein said executable program code when executed by a processing element of the communication system implements the steps of the method of claim 1.” Ex. 1001, 19:15–21. Petitioner and Dr. Crovella demonstrate where this subject matter is disclosed in Underwood. Pet. 23–24. Specifically, Petitioner notes that Underwood teaches software and hardware for carrying out the invention, . . .and thus discloses or renders

obvious a non-transitory computer-readable storage medium and software code that when executed carries out the method of claim 1.” *Id.* at 23 (citing Ex. 1002 ¶ 165; Ex. 1006, 6:20–44). Having reviewed the disclosure of Underwood upon which Petitioner and Dr. Crovella rely, we agree with Petitioner that Underwood discloses the subject matter of claim 16.

Patent Owner does not advance any arguments on claim 16 beyond those addressed in above in the context of claims 1, 5, and 9–11. *See* PO Resp. 25–26; *see also supra* Section V.D.1–2.

For the reasons discussed above, based on the complete trial record before us, we find Petitioner has shown by a preponderance of the evidence that claim 16 is anticipated by Underwood.

4. *Claims 17 and 20*

Petitioner’s analysis, as supported by the Crovella Declaration, demonstrates where Petitioner contends each element of independent claims 17 and 20 is disclosed in Underwood. Pet. 24–30. Patent Owner does not dispute Petitioner’s analysis of claims 17 and 20 separately from the arguments raised with respect to claim 1. *See* PO Resp. 22–25.

Claim 17 recites, in relevant part, “a processing element comprising a processor coupled to a memory” to perform steps similar or identical to those recited in claim 1. Ex. 1001, 19:25–26. Claim 20 recites, in relevant part, “a plurality of servers configured to communicate over a network,” in addition to subject matter similar to that of claim 1. Ex. 1001, 20:14–15. Having reviewed the evidence cited by Petitioner and Dr. Crovella, we agree with Petitioner that Underwood discloses the limitations of independent claims 17 and 20. More specifically, Petitioner correctly asserts that a skilled artisan would have understood that “Underwood’s server includes a processor coupled to a memory” and that “Underwood’s distributed servers

105 are configured to communicate over a network, such as the Internet.” *Id.* at 25 (citing Ex. 1002 ¶ 184; Ex. 1006, 38:11–12, 38:18–20, 38:24–27), 29 (citing Ex. 1002 ¶ 220; Ex. 1006, 55:22–24, 11:4–45).

Accordingly, based on the complete trial record before us, we find Petitioner has shown by a preponderance of the evidence that Underwood anticipates claims 17 and 20.

5. *Claim 18*

Claim 18 recites, in relevant part, “the processing element comprises at least one server.” Ex. 1001, 20:9–10. Petitioner demonstrates where this subject matter is disclosed in Underwood. Pet. 28. Specifically, Petitioner notes that Underwood teaches a “server 105.” *Id.* (citing Ex. 1006, 11:14–16, Fig. 1). Having reviewed the disclosure of Underwood upon which Petitioner relies, we agree with Petitioner that Underwood teaches this subject matter of claim 18. Patent Owner does not advance any arguments on claim 18 beyond those addressed in above in the context of claims 1, 5, and 9–11. *See* PO Resp. 25–26.; *see also supra* Section V.D.1–2.

Accordingly, based on the complete trial record before us, we find Petitioner has shown by a preponderance of the evidence that Underwood anticipates claim 18.

E. Asserted Obviousness of Claims 1, 5, 9–11, 16–18, and 20 by Underwood

1. *Claim 1*

Petitioner’s obviousness challenge on this claim relies on Underwood in the same manner as its anticipation challenged, discussed above. *See* Pet. 9–18. In addition, with respect to the claimed “mobile web site,” Petitioner asserts that it would have been obvious to generate a mobile website based on Underwood’s recognition that mobile devices have

reduced capacity and a skilled artisan's understanding that websites should be designed to be displayed on mobile devices to accommodate their "reduced capacity." *Id.* at 15 (citing Ex. 1006, 8:51–9:13; Ex. 1002, ¶¶ 122–23). Having reviewed the cited portions of Underwood and the testimony of Dr. Crovella, we agree with Petitioner.

Patent Owner does not address this challenge beyond its arguments discussed above in the context of anticipation. *See* PO Resp. 22–25.

For the reasons discussed above, based on the complete trial record before us, we find for the same reasons set forth above in the context of anticipation that Petitioner has shown by a preponderance of the evidence that Underwood renders obvious claim 1. *See supra* Section V.D.1; *see also In re McDaniel*, 293 F.3d 1379, 1385 (Fed. Cir. 2002) ("It is well settled that 'anticipation is the epitome of obviousness.'") (citations omitted).

2. *Claim 16*

Petitioner's obviousness challenge on this claim relies on Underwood in the same manner as its anticipation challenge, discussed above. *See* Pet. 23–24. In addition, Petitioner and Dr. Crovella assert that "even if [Underwood's] disclosure of software and servers did not convey non-transitory storage media, a POSA would have found it obvious to store Underwood's software on such storage media." *Id.* at 23 (citing Ex. 1002 ¶ 166). Having reviewed the disclosure of Underwood upon which Petitioner and Dr. Crovella rely, we agree with Petitioner.

Patent Owner does not address this challenge beyond its arguments discussed above in the context of anticipation. *See* PO Resp. 25–27.

For the reasons discussed above, based on the complete trial record before us, we find for the same reasons set forth above in the context of anticipation that Petitioner has shown by a preponderance of the evidence

that Underwood renders obvious claim 16. *See supra* Section V.D.3; *see also McDaniel*, 293 F.3d at 1385.

3. *Claims 5, 9–11, 17, 18, and 20*

Petitioner’s obviousness challenges to these claims relies on Underwood in the same manner as its anticipation challenges, discussed above. *See* Pet. 19–22, 24–28. Patent Owner does not address these challenges beyond its arguments discussed above in the context of anticipation. *See* PO Resp. 25–27.

Accordingly, based on the complete trial record before us, we find for the same reasons set forth above in the context of anticipation that Petitioner has shown by a preponderance of the evidence that Underwood renders obvious claims 5, 9–11, 17, 18, and 20. *See supra* Sections V.D.2, 4, 5; *see also McDaniel*, 293 F.3d at 1385.

F. Asserted Obviousness of Claim 19 by Underwood Alone or with Tsakiris

Claim 19 recites, in relevant part, “the server is accessible over the Internet via a network interface.” Ex. 1001, 20:11–12. Petitioner asserts dependent claim 19 would have been obvious in light of Underwood alone or in combination with Tsakiris. Pet. 30–31. Specifically, Petitioner asserts that Underwood’s server 105 is connected to clients 125 via “Internet” 120. *Id.* at 30. Relying on its declarant, Dr. Crovella, Petitioner asserts that “[a] POSA would have found obvious that devices on the Internet, such as Underwood’s ‘client terminal’ communicate through an interface that provides network connectivity via various protocols,” and that “[a] network interface is needed to interface the terminal with a network.” *Id.* (citing Ex. 1002 ¶¶ 80, 206; Ex. 1006, 11:10–12). Patent Owner relies on its claim 1 anticipation arguments for this claim. PO Resp. 27.

In light of Underwood’s teaching that server 105 is connected to clients 125 via “Internet” 120, we agree with Petitioner and Dr. Crovella that one of ordinary skill in the art “would have found it obvious, if not essential, to include network interfaces in the clients and the servers disclosed in Underwood so that those devices could communicate over the Internet.” Pet. 30–31 (citing Ex. 1002 ¶ 206). This finding is further supported by Tsakiris’ teaching “that the computer of a web server comprises ‘a network interface 708 that enables communication over a connection 718 between the network and the computer.’” *Id.* at 31 (citing Ex. 1016 ¶ 66).

Accordingly, based on the complete trial record before us, we find Petitioner has shown by a preponderance of the evidence that Underwood alone or in view of Tsakiris renders obvious claim 19. *See supra* Sections V.D.4–5 (discussing claims 17 and 18, from which claim 19 depends).

G. Asserted Obviousness of Claims 1, 4, 5, 9–11, 16–18, and 20 over Austin Alone

1. Claim 1

Petitioner and Dr. Crovella demonstrate where each element of independent claim 1 is disclosed in Austin, as follows. Pet. 31–62. Claim 1 recites, “providing a content management web site identified by a first uniform resource locator and accessible to a user of the communication system.” Ex. 1001, 18:29–31. For this limitation, Petitioner refers to Austin’s disclosure of a CMS as “a service for both retailers and the Internet Shopping Mall to create and define content which is then dynamically ‘plugged’ into HTML pages prior to being sent to users.” Pet. 33 (citing Ex. 1004, 24:12–17). Petitioner concludes that Austin’s “CMS is thus accessible to a user of the communication system.” *Id.* at 34 (citing Ex. 1004, 24:15; Ex. 1002 ¶ 86).

Petitioner further contends that it would have obvious to a skilled artisan to make Austin's CMS "identif[iable] by a first uniform resource locator" for at least three reasons. *Id.* For example, according to Petitioner, a skilled artisan would have understood that Austin's CMS is provided via a website identified by a URL and accessible to a user of the system because Austin discloses that the retailer can interface with the CMS over the Internet. *Id.* (citing Ex. 1004, 2:2–3, Fig. 3, Fig. 5; Ex. 1002 ¶ 88). Petitioner further alleges that it would have been obvious to implement Austin's CMS as a website accessible via a first URL based on Chang's disclosure of "a method and system for customizing a structured document (e.g., a web page) for delivery to an internet appliance," such as a mobile device. Pet. 35 (citing Ex. 1005, 1:13–21, 1:58–60). Petitioner concludes that "[b]ased on these teachings, a POSA would have found it obvious to make Austin's CMS accessible as a website to users via different URLs than the content that is to be viewable by, for example, shoppers in Austin's Internet Shopping Mall." *Id.* at 36 (citing Ex. 1002 ¶ 91).

Claim 1 further recites "the content management website being configured to permit the user to designate at least one data source that is external to the content management website." Ex. 1001, 18:31–34. Petitioner asserts, *inter alia*, that Austin discloses a user can "identify a [retailer] stock database thus permitting data held in the CMS's website databases to be updated." *Id.* at 37 (citing Ex. 1004, 11:28–33, 13:13–18, 13:19–23). Figure 4 of Austin is reproduced below with Petitioner's annotation.

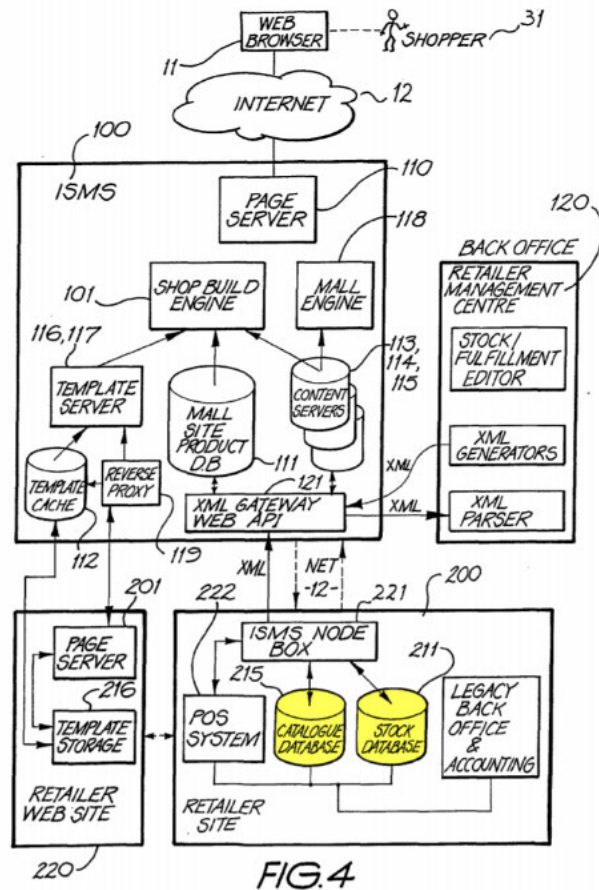


Figure 4 is a block diagram illustrating a shop building function within Austin's Internet Shopping mall. Ex. 1004, 8:24–25. Petitioner highlights the Catalogue and Stock Databases depicted in Figure 5 and asserts that “[t]hese retailer databases are external to the CMS.” Pet. 37–38 (citing Ex. 1004, Fig. 4). Petitioner explains, “[t]he XML gateway 121 ‘assist[s] in direct integration with a retailer’s legacy stock control or point of sale system’” *Id.* at 38 (citing Ex. 1004, 10:33–36, 25:35–26:2). “The API allows ‘retailers to update stock data, or integrate legacy systems into the ISMS stock database.’” *Id.* (citing Ex. 1004, 11:8–14). Petitioner further asserts that Austin “teaches that stock database 111 (the updated copy of the retailer’s external product database) is used to provide ‘page content’ for the retailer’s site.” *Id.* (citing Ex. 1004, 15:1–5).

Claim 1 further recites “generating a mobile website identified by a second uniform resource locator different than the first uniform resource locator.” Ex. 1001, 18:35–37. With respect to the “mobile web site” limitation, Petitioner refers to disclosure from Austin that “‘shoppers’ interactions with the [Internet Shopping Mall System] site ‘may be limited to a single point, the web server 13, and their connection method will usually be HTTP (or HTTP + SSL), plus SMTP’” and “‘[a]lternatives may include wireless protocols such as WAP.’” Pet. 40 (citing Ex. 1004, 11:21–23, Figs. 1 & 3). Petitioner explains that “‘WAP’ refers to the ‘wireless access protocol’ which was a standardized protocol for accessing webpages from a mobile device.” *Id.* (citing Ex. 1002 ¶ 96).

For the limitation “a mobile website identified by a second uniform resource locator different than the first uniform resource location,” Petitioner argues that a skilled artisan would have understood that each product category and product mobile web site generated by Austin’s CMS would have a URL that was different than the URL of the CMS. *Id.* at 42. Petitioner reasons that Austin discloses “‘a method of building a web page on a first internet site,’” accessible via first URL. *Id.* (citing Ex. 1004, 2:2–3; Ex. 1002 ¶ 88). Petitioner further contends that according to Austin, “a web developer for a particular retailer creates a web directory structure that will form the URL for each product.” *Id.* (citing Ex. 1004, 22:25–30; Ex. 1002 ¶ 99). According to Petitioner, “[t]he retailer would not have accessed the CMS from this URL associated with a particular [product], as this is the shopper-facing URL.” *Id.* (citing Ex. 1002 ¶ 99).

Petitioner, relying on its declarant Dr. Crovella, asserts that an ordinarily skilled artisan “would have found it obvious to use different URLs for Austin’s mobile shopping sites.” *Id.* at 43 (citing Ex. 1002 ¶ 100). This

is because “Austin’s Internet Shopping Mall server . . . ‘present(s) pages to shoppers, accept orders, and provide updates to shoppers of an order[’]s progress,’” whereas “the CMS ‘is a service for both retailers and the Internet Shopping Mall to create and define content.’” *Id.* at 43 (citing Ex. 1004, 9:17–20, 24:12–15; Ex. 1002 ¶ 101). Petitioner concludes that “[b]ecause of the different purposes of the [Internet Mall Shopping System] stores and the CMS, a POSA would have found it obvious to make each of those sites available at different URLs.” *Id.* at 44 (citing Ex. 1002 ¶ 101).

Claim 1 further recites “the mobile website being accessible independently of the content management website via one or more mobile devices.” Ex. 1001, 18:37–39. For this limitation, Petitioner argues that Austin’s CMS was accessible via a client terminal and a mobile web site is accessed through the “‘Shopper Web Interface’” “and is accessible from a mobile device using WAP.” *Id.* at 44–45 (citing Ex. 1004, 11:23, 18:10–14, 24:15–17; Ex. 1002 ¶ 103). Petitioner also argues that a skilled artisan “would have found it obvious to implement a mobile website such that it was accessible using a URL—and thus a webpage—that is different from the URL of the CMS website’s” because it would have allowed “customers of the mall to see only shopping-related site information while the retailers would have seen aspects of the site that would have assisted them in designing and building their retailer sites.” *Id.* at 45–46 (citing Ex. 1002 ¶¶ 86–91, 95–101, 104).

Claim 1 further recites “the mobile website being configured to receive data automatically from the external data source designated by the user at the content management website.” Ex. 1001, 18:39–42. With respect to this limitation, Petitioner asserts that “where the retailer’s databases [] are the external data sources, Austin explains that a ‘copy of the

retailer's products database is kept on the Internet Shopping Mall,' and '[u]pdates are maintained in real time, with retailer and web site updates being synchronized between databases,' or, in the alternative are 'batched' and processed 'at timed intervals (e.g., every hour).'" *Id.* at 47 (Ex. 1004, 13:13–20; Fig. 4, items 215, 211). According to Petitioner, "[d]ata from these external data sources is received automatically because it is either received in real-time as changes are made to the retailer's database or is received periodically (e.g., hourly) without user involvement in the data transfers." *Id.* (citing Ex. 1002 ¶ 106; Ex. 1004, 13:21–23).

We are persuaded by Petitioner's showing that Underwood discloses all of the limitations of claim 1, and we adopt Petitioner's analysis as our own.

Patent Owner asserts that Austin does not teach a "content management web site," because in Austin, the designer creates web sites, which may not be designed for access by a mobile user at all. PO Resp. 22. According to Patent Owner, "[t]he designer controls the appearance of the web site, and thus there is no teaching of a content management web site for use with a mobile web site, as required by the properly construed claims." *Id.* at 22–23.

Furthermore, Patent Owner asserts that Austin requires a user to design its web site, and therefore does not teach "generating a mobile web site configured to receive data automatically from the external data source designated by the user at the content management website" because the system of Austin requires a user to design its web site. *Id.* at 24. Patent Owner states:

Both Austin and Underwood require all sorts of required actions by the user to get any designated data into a web site. If

the web site is to be mobile, it is up to the user to design the web site accordingly. This is in stark contrast to the claims of the '342 patent, which require that the process be 'automatic.'

Id. Patent Owner elaborates that "Petitioner admits that mobile web sites are not generated 'automatically' in either the Underwood or Austin disclosures." Sur-Reply 8. Patent Owner contends that, unlike the system of Austin, the '342 patent describes "an automatically generated mobile website, which requires no design on the part of the user in accordance with the ordinary meaning of the term." *Id.* at 7.

We disagree with Patent Owner's arguments for the following reasons. Contrary to Patent Owner's argument that in Austin "the designer creates web sites, which may not be designed for access by a mobile user at all" (PO Resp. 22), Austin discloses that shoppers may connect to the Internet Shopping Mall System site using "wireless protocols such as WAP." Ex. 1004, 11:21–23. Dr. Crovella explains that "[a person of ordinary skill in the art] would have understood that WAP was a standardized protocol for accessing Internet content such as webpages from a mobile phone." Ex. 1002 ¶ 96. Dr. Crovella supports this testimony by referring to Chen,¹⁰ an essay describing WAP. *Id.* (citing Ex. 1018). According to Dr. Crovella, "Chen explains that 'WAP' refers to the 'Wireless Access Protocol,' and indicates that it is a 'major breakthrough that achieves universal Internet-based information access on wireless devices,' and 'make[s] it possible for developers to write once for all networks worldwide.'" *Id.* (citing Ex. 1018, 1). Dr. Crovella continues "WAP is aimed 'to bring advanced services and

¹⁰ Chen, et al., "WAP (Wireless Application Protocol) (Nov. 20, 1998) available at <http://www.tml.tkk.fi/Studies/Tik-110.300/1998/Essays/wap.html> (last visited May 13, 2018)

Internet content to digital cellular phones and terminals.”” *Id.* (citing Ex. 1018, Abst, 1.1). “WAP extends ‘the Web to handheld wireless devices’ and allows wireless devices ‘with a small display [to] render Web pages that are loaded with text.’” *Id.* Dr. Crovella further testifies that “WAP supports mobile devices such as smart phones, palmtops, and laptops.” *Id.* (citing Ex. 1018, 2). Dr. Crovella further directs our attention to Lee,¹¹ a published patent application, which states:

The Wireless Application Protocol (WAP) is being developed as an application environment and set of communication protocols for enabling wireless mobile devices to access the Internet and telephony services. WAP is being specified and developed by WAP Forum Ltd. (<http://www.wapforum.org/>), which is a consortium of Internet and telecom companies.

Id. (citing Ex. 1019 ¶ 12). Thus, Dr. Crovella concludes, “[a person of ordinary skill in the art] would have understood that by disclosing WAP, Austin was disclosing a mobile website.” *Id.*

Having reviewed the testimony of Dr. Crovella and the cited portions of Chen and Lee, we agree with Petitioner that an ordinarily skilled artisan would have understood Austin’s disclosure of generating web sites to which users connect via WAP as meeting the claimed generating mobile web sites, and therefore, we disagree with Patent Owner’s argument that in Austin “the designer creates web sites, which may not be designed for access by a mobile user at all.” PO Resp. 22.

We also disagree with Patent Owner’s argument regarding the claimed “generating a mobile web site configured to receive data

¹¹ U.S. Patent Application Publication No. 2002/0101848; Aug. 1, 2002 (Ex. 1019) (“Lee”).

automatically from the external data source” because it is not commensurate with the scope of the claim. Patent Owner repeatedly asserts that the claimed mobile web site must be generated automatically. *See, e.g.*, PO Resp. 24; Sur-Reply 7–8. Claim 1, however, does not recite generating a mobile web site automatically. Rather, claim 1 recites simply, “generating a mobile web site.” Ex. 1001, 18:35. The only use of the term “automatically” in claim 1 describes how the mobile web site receives data. *Id.* at 18:39–40. Thus, Patent Owner’s argument is not supported by the claim language. *See In re Self*, 671 F.2d at 1348.

For the reasons discussed above, based on the complete trial record before us, we find Petitioner has shown by a preponderance of the evidence that Austin renders obvious claim 1.

2. *Claim 4, 5, 9–11*

Claim 4 recites, in relevant part, “the data source comprises a database source.” Ex. 1001, 18:48–49. Petitioner and Dr. Crovella demonstrate where this subject matter is disclosed in Austin. Pet. 48. Having reviewed the disclosure of Austin upon which Petitioner and Dr. Crovella rely, we agree with Petitioner that Austin discloses a data source comprising a database source. More specifically, we agree with Petitioner that the retailer stock integration of Austin allows legacy stock control databases to be synchronized between databases controlled by the retailer and those in Austin’s ISMS (Internet Shopping Mall System). Pet. 48 (citing Ex 1004, 11:28-33, 13:13–23, 14:19–23).

Claim 5 recites, in relevant part, “the data source comprises a file source.” Ex. 1001, 18:50–51. Petitioner and Dr. Crovella demonstrate where this subject matter is disclosed in Austin. Pet. 48–49. Having reviewed the disclosure of Austin upon which Petitioner and Dr. Crovella

rely, we agree with Petitioner that Austin discloses a data source comprising a file source. More specifically, we agree with Petitioner that Austin's page server retrieves retailer product catalog data held in the retailer's mall site stock database, which is updated from the retailer's non-mall stock database on a regular basis. *Id.* (citing Ex 1004, 14:19–21). As Petitioner and Dr. Crovella assert, since product catalog information including image files are stored in the mall site stock database which is updated from the non-mall stock database, the non-mall stock database includes image files too. *Id.* at 49 (citing Ex. 1002 ¶ 134). Thus, Austin teaches the data source comprising a file source.

Claim 9 recites, in relevant part, “the content management web site permits the user to upload at least one information item,” and “the mobile web site includes said at least one uploaded information item.” Ex. 1001, 18:58–61. Petitioner and Dr. Crovella demonstrate where this subject matter is disclosed in Austin. Pet. 49–50. Petitioner and Dr. Crovella point out that “Austin explains that to provide for the introduction of content on the Internet Shopping Mall site, the CMS allows uploading of richer content objects (Flash files, images, sounds, QuickTime movies, etc).” Pet. 49 (citing Ex. 1004, 24:24–25:2; Ex. 1002, ¶ 141). Petitioner and Dr. Crovella assert that Austin's retailer pages can be populated with additional content from a content database which is part of the mobile web site that is fetched by the page builder when serving pages calling for those items of information. Pet. 50 (citing Ex. 1004, 24:30–34; Ex. 1002 ¶ 141). Having reviewed the disclosure of Austin upon which Petitioner and Dr. Crovella rely, we agree with Petitioner that Austin teaches this subject matter of claim 9.

Claim 10 recites, in relevant part, “the content management web site permits the user to select one or more information items from a listing of a plurality of information items,” and “the mobile web site includes said one or more selected information items but does not include other information items in the listing that were not selected by the user.” Ex. 1001, 18:62–67. Petitioner and Dr. Crovella demonstrate where this subject matter is disclosed in Austin. Pet. 50–53. Specifically, Petitioner notes that Austin teaches a collection of DDS (Dynamic Data Stub) placeholders and a DDS toolbox available for the designer to quickly select and place the appropriate DDS placeholder prompting the designer for the DDS data source and presentation requirements. Pet. 50 (citing Ex. 1004, 23:29–32). Petitioner and Dr. Crovella assert that Austin’s disclosure of a collection of DDS placeholders provides a listing of a plurality of information items. *Id.* (citing Ex. 1002 ¶ 147). Petitioner and Dr. Crovella further assert that “a POSA would have understood that the non-selected DDS placeholders will not become a part of the mobile website, while selected DDS placeholders will be included in the mobile website to signal that dynamic content is inserted from a database into the location of the selected placeholder(s).” *Id.* at 51 (citing Ex. 1004, 23:16–21; Ex. 1002 ¶ 148). Having reviewed the disclosure of Austin upon which Petitioner and Dr. Crovella rely, we agree with Petitioner that Austin teaches this subject matter of claim 10.

Claim 11 recites, in relevant part, “the content management web site permits the user to enter a message,” and “the mobile web site includes the entered message.” Ex. 1001, 19:1–3. Petitioner and Dr. Crovella demonstrate that this subject matter is disclosed in Austin. Pet. 53–54. Specifically, Petitioner points to examples of messages disclosed by Austin including “respond[ing] to customer enquiries” and “up to date stock

information, including stock availability and expected shipping times,” which “must come from the retailer and must be updated as frequently as the data requires.” *Id.* at 54 (citing Ex. 1004, 11:1–3, 26:3–7; Ex. 1002 ¶ 157). Petitioner and Dr. Crovella assert that “[b]ecause these messages are intended for shoppers and appear on the shopper-facing webpages that are part of the mobile website, the messages are included in the mobile website.” *Id.* (citing Ex. 1002 ¶ 157). Having reviewed the evidence cited by Petitioner and Dr. Crovella, we agree with Petitioner that Austin discloses the limitations of claim 11.

Patent Owner asserts that, as to dependent claims 5 and 9–11, “Petitioner simply cites a number of features in the art that are recited as potential ‘external data sources’ that can be designated by the user for automatic inclusion in a mobile web site.” PO Resp. 25–26. Patent Owner goes on to assert that “there is nothing in Underwood, Tsakiris, Austin or Chang references that has anything to do with content management or mobile web site generation,” and that therefore there is nothing that would render obvious automatically making such sources part of a mobile web site. *Id.* at 26 (citing Ex. 2016, 57:5–59:13).

As addressed above in the context of independent claim 1, we disagree with Patent Owner that Austin fails to teach or suggest the claimed content management web site or generating a mobile web site. *See supra* Section V.G.1. Accordingly, based on the complete trial record before us, we find Petitioner has shown by a preponderance of the evidence Austin renders obvious claims 4, 5, and 9–11.

3. *Claim 16*

Claim 16 recites, “[a] non-transitory computer-readable storage medium having embodied therein executable code of one or more software

programs for use in managing information content in a network-based communication system, wherein said executable program code when executed by a processing element of the communication system implements the steps of the method of claim 1.” Ex. 1001, 19:15–21. Petitioner and Dr. Crovella demonstrate where this subject matter is taught or suggested in Austin. Pet. 54–55. Specifically, Petitioner notes that “Austin teaches that the methods of claim 1—i.e., the steps of ‘providing’ and ‘generating’—are performed by the ISMS (14), which is executed on application server 14,” and that “Austin’s ISMS is implemented on a server.” *Id.* at 55 (citing Ex. 1004, 9:17–23, 11:24–27, Figs. 1, 4). Furthermore, Petitioner and Dr. Crovella assert that “[a] POSA would have found the use of a server with memory to store and a processor execute software code stored in memory thus performing the ISMS functionality not only taught and rendered obvious by Austin, but would also have understood it to be the standard way to implement Austin’s ISMS.” *Id.* (citing Ex. 1002 ¶ 163).

Patent Owner does not advance any arguments on claim 16 beyond those addressed above in the context of claims 1, 4, 5, and 9–11. *See* PO Resp. 25–26; *see also supra* Section V.G.1–2.

Having reviewed the disclosure of Austin upon which Petitioner and Dr. Crovella rely, we agree with Petitioner that Austin meets the limitations of claim 16. Accordingly, based on the complete trial record before us, we find Petitioner has shown by a preponderance of the evidence that Austin renders obvious claim 16.

4. *Claims 17 and 20*

Petitioner’s analysis, as supported by the Crovella Declaration, demonstrates where Austin teaches or suggests each element of independent claims 17 and 20. Pet. 56–62. Patent Owner does not dispute Petitioner’s

analysis of claims 17 and 20 separately from the arguments raised with respect to claim 1. *See* PO Resp. 22–25.

Claim 17 recites, in relevant part, “a processing element comprising a processor coupled to a memory” to perform steps similar or identical to those recited in claim 1. Ex. 1001, 19:25–26. Claim 20 recites, in relevant part, “a plurality of servers configured to communicate over a network,” in addition to subject matter similar to that of claim 1. Ex. 1001, 20:14–15. Having reviewed the evidence cited by Petitioner and Dr. Crovella, we agree with Petitioner that Austin teaches or suggests the limitations of independent claims 17 and 20. Petitioner correctly asserts that a skilled artisan would have understood that Austin’s “ISMS server is a ‘processing element’ and includes both software and a processor to execute that software for performing the ISMS functions” and notes that Austin discloses servers such as a “Transaction and Fulfilment Server,” a “Retailer Enablement Sever,” and an “Internet Shopping Server (ISMS).” Pet. 60. Petitioner notes that “ISMS comprises ‘a web server 13 connected to a Java based application server 14.’” *Id.* at 61 (citing Ex. 1004, 9:9–13, 9:17–21, 10:8–11:14, 14:3–30, Figs. 1 & 4).

For the reasons discussed above, based on the complete trial record before us, we find Petitioner has shown by a preponderance of the evidence that Austin renders obvious claims 17 and 20.

5. *Claim 18*

Claim 18 recites, in relevant part, “the processing element comprises at least one server.” Ex. 1001, 20:9–10. Petitioner demonstrates where this subject matter is disclosed in Austin in its discussion of claim 17. Pet. 59; *see supra* Section V.G.4. Having reviewed the disclosure of Austin upon which Petitioner relies, we agree with Petitioner that Austin teaches this

subject matter of claim 18. For the reasons discussed above, based on the complete trial record before us, we find Petitioner has shown by a preponderance of the evidence that Austin renders obvious claim 18.

H. Asserted Obviousness of Claims 1, 4–5, 9–11, 16–18, and 20 by Austin in combination with Chang

We have considered Petitioner’s arguments and evidence in support of this ground; however, because we determine above that the claims challenged under this ground are rendered obvious by Austin alone, we decline to reach whether the claims are also rendered obvious by Austin in combination with Chang. *See supra* Section V.G.

I. Asserted Obviousness of Claim 19 by Austin Alone or with Chang and in Further View of Tsakiris

Claim 19 recites, in relevant part, “the server is accessible over the Internet via a network interface.” Ex. 1001, 20:11–12. Petitioner asserts dependent claim 19 would have been obvious in light of Austin alone or in combination with Chang and further in view of Tsakiris. Pet. 62–63. Specifically, Petitioner asserts that “Austin’s ISMS is implemented on an ‘application server’ and the ISMS is also called a web server.” *Id.* at 62 (citing Ex. 1004, 9:17–25, 11:24–27, 15:24). Relying on its declarant, Dr. Crovella, Petitioner asserts that “[t]his reference to servers conveys to a POSA a hardware ‘network interface.’” *Id.* (citing Ex. 1002 ¶ 203; Ex. 1004, Fig. 5).

In light of Austin’s description that it describes a “method of building a web site for an internet shopping mall” in addition to the teachings of Austin cited by Petitioner, we agree with Petitioner and Dr. Crovella that Austin’s references to an application server and web server on which ISMS is implemented would convey to an ordinarily skilled artisan the claimed

“network interface.” This finding is further supported by Tsakiris’ teaching “that the computer of a web server comprises ‘a network interface 708 that enables communication over a connection 718 between the network and the computer.’” *Id.* at 63 (citing Ex. 1016 ¶ 66).

For the reasons discussed above, based on the complete trial record before us, we find Petitioner has shown by a preponderance of the evidence that Austin alone or in view of Tsakiris renders obvious claim 19. *See supra* Sections V.G.4, 5 (discussing claims 17 and 18, from which claim 19 depends). Further, we have considered Petitioner’s arguments and evidence in support of its ground asserting Austin in combination with Chang; however, because we determine that the claim 19 is rendered obvious by Austin alone or in view of Tsakiris, we decline to reach whether claim 19 is also rendered obvious by Austin in combination with Chang.

VI. MOTION TO EXCLUDE

Patent Owner moves to exclude the First Chuang Declaration. Paper 29 (“Motion” or “Mtn.”). Petitioner opposes the Motion. Paper 34 (“Opposition” or “Opp.”). Patent Owner has filed a Reply in support of its Motion. Paper 35 (“Reply ISO”). Patent Owner seeks to exclude the First Chuang Declaration on the basis that it violates Federal Rules of Evidence 1002, 901, and 802. We address each Rule in turn below.

A. *Best Evidence Rule*

Federal Rule of Evidence 1002, sometimes referred to as the Best Evidence Rule, states, “[a]n original writing, recording, or photograph is required in order to prove its content unless these rules or a federal statute provides otherwise.” F.R.E. 1002. Patent Owner contends that the First Chuang Declaration “should be excluded as it relies on materials not produced or filed.” Mtn. 3 (objecting to testimony in the First Chuang

Declaration made “[w]ithout providing the underlying documents, including copies of the membership agreements or contracts with the barred members, or the documents uncovered during the reasonable search, and any documents relied upon to state that Petitioner ‘has received no consideration’”); *see also* Reply ISO 3 (“If Petitioner were not seeking to prove the content of the documents, they would not be part of the testimony.”). Regarding Mr. Chuang’s testimony about Petitioner’s search for documents, Patent Owner asserts that, “apart from belated attorney argument that such searches were ‘reasonable[,]’ there is nothing in the affidavit about the searches or why they should be considered reasonable.” Reply ISO 4.

Petitioner counters that “Mr. Chuang is not testifying as to the contents of a writing. Instead, Mr. Chuang’s testimony establishes that there are no documents and as such ‘[a]n original writing’ cannot possibly be required and Fed. R. Evid. 1002 is inapplicable.” Opp. 3. Petitioner continues, even if Mr. Chuang’s statement could be interpreted as one characterizing the contents of writings, Fed. R. Evid. 1002 is inapplicable” because “testimony about what writings *do not say* do not violate the best evidence rule.” *Id.* (citing *United States v. Diaz-Lopez*, 625 F.3d 1198, 1200-1201 (9th Cir. 2010) (“We must decide if testimony that a search of a computer database revealed no record of a matter violates the best evidence rule when it is offered without the production of an ‘original’ printout showing the search results. We hold that it does not.”)).

We disagree with Patent Owner’s arguments in light of the history of discovery in this proceeding. During trial, the parties heavily negotiated the scope of document requests to Petitioner and testimony from a fact witness for Petitioner. Papers 13–15 (addressing the parties’ disputes regarding the

scope of discovery requests, declarations, and a related briefing schedule). This discovery resulted in the First and Second Chuang Declarations, the scope of which Patent Owner agreed to during conferences with Petitioner and via subsequent email communication. *Id.*; *see also* Ex. 2002. Further, we observe that Patent Owner chose not seek our leave to compel the production of documents discussed in the First Chuang Declaration, such as the membership agreement between Google and Petitioner, or by deposing Mr. Chuang pursuant to 37 C.F.R. § 42.51(b)(1)(ii) on his statements regarding the scope and contents of Petitioner's search for documents. Because Patent Owner negotiated the scope of the declaration it chose to accept in lieu of document production, we decline to exclude now that declaration on the basis of the Best Evidence Rule.

B. Authenticity

Federal Rule of Evidence 901 addresses authenticating or identifying evidence and provides that, “[t]o satisfy the requirement of authenticating or identifying an item of evidence, the proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is.” F.R.E. 901(a). Patent Owner “moves to exclude Exhibit 1033 in violation of Federal Rule of Evidence 901” because “Petitioner has not filed or produced these documents [described in the First Chuang Declaration] and therefore has not filed or produced ‘evidence to support a finding that the item is what the proponent claims it is.’” Mtn. 4 (citing F.R.E. 901).

Patent Owner's argument fails because it is misdirected. Patent Owner seeks to exclude the First Chuang Declaration, but fails to address how the declaration is allegedly inauthentic. Rather, Patent Owner's arguments address the authenticity of the documents described by the First Chuang Declaration, not the declaration itself. *See, e.g., id.* (“Indeed, if one

could simply admit testimony about documents in lieu of the documents themselves, one could authenticate just about anything one wanted the documents to say at trial.”). Because Patent Owner does not address how the First Chuang Declaration allegedly might be inauthentic, i.e. not be the sworn testimony of Mr. Chuang as Petitioner asserts, we are not persuaded by Patent Owner’s argument and decline to exclude the First Chuang Declaration on this basis.

C. Inadmissible Hearsay

Federal Rule of Evidence 802 is the rule against hearsay. F.R.E. 802. Patent Owner “objects to Exhibit 1033 in violation of Federal Rule of Evidence 802 as inadmissible hearsay.” Mtn 5. According to Patent Owner,

Petitioner relies on Exhibit 1033 to introduce hearsay evidence, in paragraphs 2 – 7 of its Reply, of: (1) contents of the documents uncovered in the reasonable search (see Ex. 1033 ¶13); (2) the information contained in the membership agreements (see Ex. 1033 ¶ 8; and (3) a lack of funds or consideration provided to Petitioner (see Ex. 1033 ¶14, 15).

Id. Patent Owner summarily asserts, “[w]hile there are exceptions to the so-called hearsay rule, none of them apply here.” Reply ISO 5.

Petitioner contends that “Patent Owner makes no effort to show that any of the statements that it seeks to have excluded under Fed. R. Evid. 802 meet the definition of hearsay under Fed. R. Evid. 801.” Opp. 10. Petitioner further states that “[s]ince Mr. Chuang’s statements are made while testifying in this proceeding they are not hearsay.” *Id.* at 10–11 (citing 37 C.F.R. §§ 42.2, 42.53(a)).

We agree with Petitioner. Hearsay is defined in Federal Rule of Evidence 801, in relevant part, as a statement that “the declarant does not make while testifying at the current trial or hearing.” F.R.E. 801(c)(1).

Mr. Chuang's testimony in the First Chuang Declaration, however, was made during this trial. Our Rules require that "[u]ncompelled direct testimony must be submitted in the form of an affidavit." 37 C.F.R. § 42.53(a). Our Rules also define the term "affidavit" to include a declaration under 28 U.S.C. § 1746. *Id.* § 42.2. Here, it is undisputed that the First Chuang Declaration was submitted by Petitioner as Mr. Chuang's direct testimony in this proceeding, pursuant to our Rules. Patent Owner does not explain how Mr. Chuang's testimony in the First Chuang Declaration that is made during this proceeding comports with the definition of hearsay under Federal Rule of Evidence 801(c)(1) in light of our rules. Accordingly, we decline to exclude the First Chuang Declaration on this basis.

D. Conclusion

Patent Owner has not shown why the First Chuang Declaration should be excluded under Federal Rules of Evidence 1002, 901, or 802. Accordingly, Patent Owner's Motion is *denied*.

VII. MOTIONS TO SEAL

Petitioner moves to seal the First Chuang Declaration (Ex. 1033). Paper 24. Petitioner has filed a redacted non-confidential version of the First Chuang Declaration bearing the same exhibit number. Patent Owner has not filed an opposition to Petitioner's motion.

Patent Owner moves to seal the Second Chuang Declaration (Ex. 2018), outside counsel's email (Ex. 2020), and certain portions of its Supplemental Response (Paper 17). Paper 19. Patent Owner has filed a redacted non-confidential version of its Supplemental Response. Paper 18. Petitioner has not filed an opposition to Petitioner's motion.

A strong public policy exists for making information filed in an *inter partes* review publicly available. 37 C.F.R. § 42.14; *see also* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48760–61 (Aug. 14, 2012). The public’s interest in maintaining a complete and understandable file history is balanced with the party’s interest in protecting its truly sensitive, confidential information. 77 Fed. Reg. at 48760–61. A party moving to seal must show “good cause” for the relief requested. 37 C.F.R. § 42.54(a). To demonstrate “good cause,” the moving party must demonstrate that:

(1) the information sought to be sealed is truly confidential, (2) a concrete harm would result upon public disclosure, (3) there exists a genuine need to rely in the trial on the specific information sought to be sealed, and (4), on balance, an interest in maintaining confidentiality outweighs the strong public interest in having an open record.

Argentum Pharms. LLC v. Alcon Research, Ltd., IPR2017-01053, Paper 27 at 3–4 (PTAB Jan. 19, 2018) (informative); *see also Corning Optical Communications RF, LLC v. PPC Broadband, Inc.*, IPR2014-00440, Paper 46 at 2 (PTAB April 6, 2015) (requiring a demonstration that information is not “excessively redacted”).

Upon review of the parties’ motions and redactions, we determine that the parties have shown good cause to seal the limited set of requested information. Therefore, the motions to seal are *granted*.

There is an expectation that information will be made public where the information is identified in a final written decision, and that confidential information that is subject to a protective order ordinarily would become public 45 days after final judgment in a trial, unless a motion to expunge is granted. 37 C.F.R. § 42.56; Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,761 (Aug. 14, 2012). In rendering this Final Written Decision, it

was necessary to identify and discuss in detail certain sealed confidential information. Accordingly, the parties are directed to submit a joint proposed redacted version of this Final Written Decision within 14 days of its entry.

A party who is dissatisfied with this Final Written Decision may appeal the Decision pursuant to 35 U.S.C. § 141(c), and has 63 days after the date of this Decision to file a notice of appeal. 37 C.F.R. § 90.3(a). Thus, it remains necessary to maintain the record, as is, until resolution of an appeal, if any.

In view of the foregoing, the confidential documents filed in the instant proceeding will remain under seal, at least until the time period for filing a notice of appeal has expired or, if an appeal is taken, the appeal process has concluded. The record for the instant proceeding will be preserved in its entirety, and the confidential documents will not be expunged or made public, pending appeal. Notwithstanding 37 C.F.R. § 42.56 and the Office Patent Trial Practice Guide, neither a motion to expunge confidential documents nor a motion to maintain these documents under seal is necessary or authorized at this time. *See* 37 C.F.R. § 42.5(b).

VIII. CONCLUSION¹²

Petitioner has demonstrated that the Petition is not subject to the time bar provision of 35 U.S.C. § 315(b). Petitioner has further shown by a

¹² Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner's attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. *See* 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. *See* 37 C.F.R. § 42.8(a)(3), (b)(2).

preponderance of the evidence that: (i) claims 1, 5, 9–11, 16–18, and 20 are anticipated by Underwood; (ii) claims 1, 5, 9–11, 16–18, and 20 are rendered obvious by Underwood; (iii) claim 19 is rendered obvious by Underwood alone or in view of Tsakiris; (iv) claims 1, 5, 9–11, 16–18, and 20 are rendered obvious by Austin; and (v) claim 19 is rendered obvious by Austin alone or in view of Tsakiris.

Patent Owner has not shown that we violated the Administrative Procedures Act nor shown that this proceeding violates a provision of the Constitution of the United States.

In addition, Petitioner's motion to seal is *granted*, Patent Owner's motion to seal is *granted*, and Patent Owner's motion to exclude is *denied*.

IX. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 1, 5, 9–11, 16–20 of the '342 patent are unpatentable;

FURTHER ORDERED that Petitioner's Motion to Seal is *granted*;

FURTHER ORDERED that Patent Owner's Motion to Seal is *granted*;

FURTHER ORDERED that Patent Owner's Motion to Exclude is *denied*; and

FURTHER ORDERED that, because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

In summary:

Claims	35 U.S.C. §	Reference(s)/ Basis	Claims Shown Unpatentable
1, 5, 9–11, 16–18, 20	102(e)	Underwood	1, 5, 9–11, 16–18, 20
1, 5, 9–11, 16–18, 20	103(a)	Underwood	1, 5, 9–11, 16–18, 20
19	103(a)	Underwood alone or Underwood, Tsakiris	19
1, 4, 5, 9– 11, 16–18, 20	103(a)	Austin	1, 4, 5, 9–11, 16–18, 20
19	103(a)	Austin alone or Austin, Tsakiris	19
Overall Outcome			1, 4, 5, 9–11, 16–20

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