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Paper No. 52
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.,
Petitioner,

v.

WINDY CITY INNOVATIONS, LLC,
Patent Owner.

Case IPR2016-01159[1]
Patent 8,694,657 B1

Before KARL D. EASTHOM, DAVID C. MCKONE, and
MELISSA A. HAAPALA, *Administrative Patent Judges*.

MCKONE, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

[1] Case No. IPR2017-00659 has been joined with this proceeding.

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I. INTRODUCTION

A. Background

Facebook, Inc. ("Petitioner") filed a Petition (Paper 1, "Pet.") to institute an *inter partes* review of claims 189, 334, 342, 348, 465, 580, 584, and 592 of U.S. Patent No. 8,694,657 B1 (Ex. 1001, "the '657 patent"). Windy City Innovations, LLC ("Patent Owner") filed a Preliminary Response (Paper 6, "Prelim. Resp.").

Pursuant to 35 U.S.C. § 314, in our Institution Decision (Paper 7, "Dec."), we instituted this proceeding as to claims 189, 334, 342, 348, 465, 580, 584, and 592.

Patent Owner filed a Patent Owner's Response (Paper 22, "PO Resp."), and Petitioner filed a Reply to the Patent Owner's Response (Paper 31, "Reply").

Petitioner relies on the Declarations of Tal Lavian, Ph.D. (Ex. 1002, "Lavian Decl."; Ex. 1021, "2nd Lavian Decl."). Patent Owner relies on the Declaration of Jaime G. Carbonell, Ph.D. (Ex. 2005, "Carbonell Decl.").

On January 12, 2017, Petitioner filed a petition seeking *inter partes* review of claims 203, 209, 215, 221, 477, 482, 487, and 492 of the '657 patent and sought to join that proceeding to this proceeding. IPR2017-00659, Paper 2 ("the '659 Pet."), Paper 3 (Mot. for Joinder). We instituted a trial in that proceeding for all challenged claims and joined it to this proceeding. Paper 34 (the "'659 Dec."). Petitioner relies on the Declaration of Dr. Lavian in the '659 proceeding (IPR2017-00659, Ex. 1002 ("Lavian '659 Decl.")).

As to the additional claims challenged in the '659 Petition, Patent Owner filed a Supplemental Patent Owner's Response (Paper 45, "Supp. PO

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Resp.") and Petitioner filed a Supplemental Reply (Paper 46, "Supp. Reply").

An oral argument was held on October 19, 2017 (Paper 51, "Tr.").

We have jurisdiction under 35 U.S.C. § 6. This Decision is a final written decision under 35 U.S.C. § 318(a) as to the patentability of claims 189, 203, 209, 215, 221, 334, 342, 348, 465, 477, 482, 487, 492, 580, 584, and 592. Based on the record before us, Petitioner has proved, by a preponderance of the evidence, that claims 189, 334, 342, 348, 465, 477, 482, 487, 492, 580, 584, and 592 are unpatentable, but has not proved that claims 203, 209, 215, and 221 are unpatentable.

B. Related Matters

The parties indicate that the '657 patent has been asserted in *Windy City Innovations, LLC v. Microsoft Corp.*, Civ. A. No. 15-cv-00103-GM (W.D.N.C.) (transferred to 16-cv-1729 (N.D. Cal.)), and *Windy City Innovations, LLC v. Facebook, Inc.*, Civ. A. No. 15-cv-00102-GM (W.D.N.C.) (transferred to 16-cv-1730 (N.D. Cal.)). Pet. 1; Paper 4, 1. The '657 patent is the subject of an *inter partes* review petition in IPR2016-01155. Paper 4, 1. IPR2017-00622, also challenging the '657 patent, has been joined to IPR2016-01155. The '657 patent also was the subject of IPR2017-00606 and IPR2017-00656, which Microsoft Corp. filed and sought to join with IPR2016-01155 and this proceeding, respectively, prior to settling with Patent Owner. Patents related to the '657 patent are subjects of additional *inter partes* review petitions.

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C. Asserted Prior Art References

Petitioner relies on the following prior art:

U.S. Patent No. 6,608,636 B1, issued Aug. 19, 2003, filed May 13, 1992 (Ex. 1003, "Roseman");

Published European Pat. App. No. 0 621 532 A1, published Oct. 26, 1994 (Ex. 1004, "Rissanen");

Ronald J. Vetter, *Videoconferencing on the Internet*, IEEE COMPUTER SOCIETY 77–79 (Jan. 1995) (Ex. 1005, "Vetter");

MARY ANN PIKE ET AL., USING MOSAIC (1994) (Ex. 1006, "Pike"); and

TOM LICHTY, THE OFFICIAL AMERICA ONLINE FOR MACINTOSH MEMBERSHIP KIT & TOUR GUIDE (2nd ed. 1994) (Ex. 1007, "Lichty").

D. The Instituted Ground

We instituted a trial on the ground of unpatentability of claims 189, 203, 209, 215, 221, 334, 342, 348, 465, 477, 482, 487, 492, 580, 584, and 592 as obvious, under 35 U.S.C. § 103(a), over Roseman, Rissanen, Vetter, Pike, and Lichty. Dec. 36; '659 Dec. 15.

E. The '657 Patent

The '657 patent describes an Internet "chat room." According to the '657 patent, it was known to link computers together to form chat rooms in which users communicated by text, graphics, and multimedia, giving the example of "America On Line." Ex. 1001, 1:33–37. The '657 patent acknowledges that chat rooms have been implemented on the Internet, albeit

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with "limited chat capability," but contends that the complex chat room communications capable with Internet service providers had not been developed on the Internet because "[t]he Internet was structured for one-way communications analogous to electronic mail, rather than for real time group chat room communications" and because "there is no particular control over the platform that would be encountered on the Internet." *Id.* at 1:38–44, 1:50–52.

Figure 1, reproduced below, illustrates an embodiment of the invention:

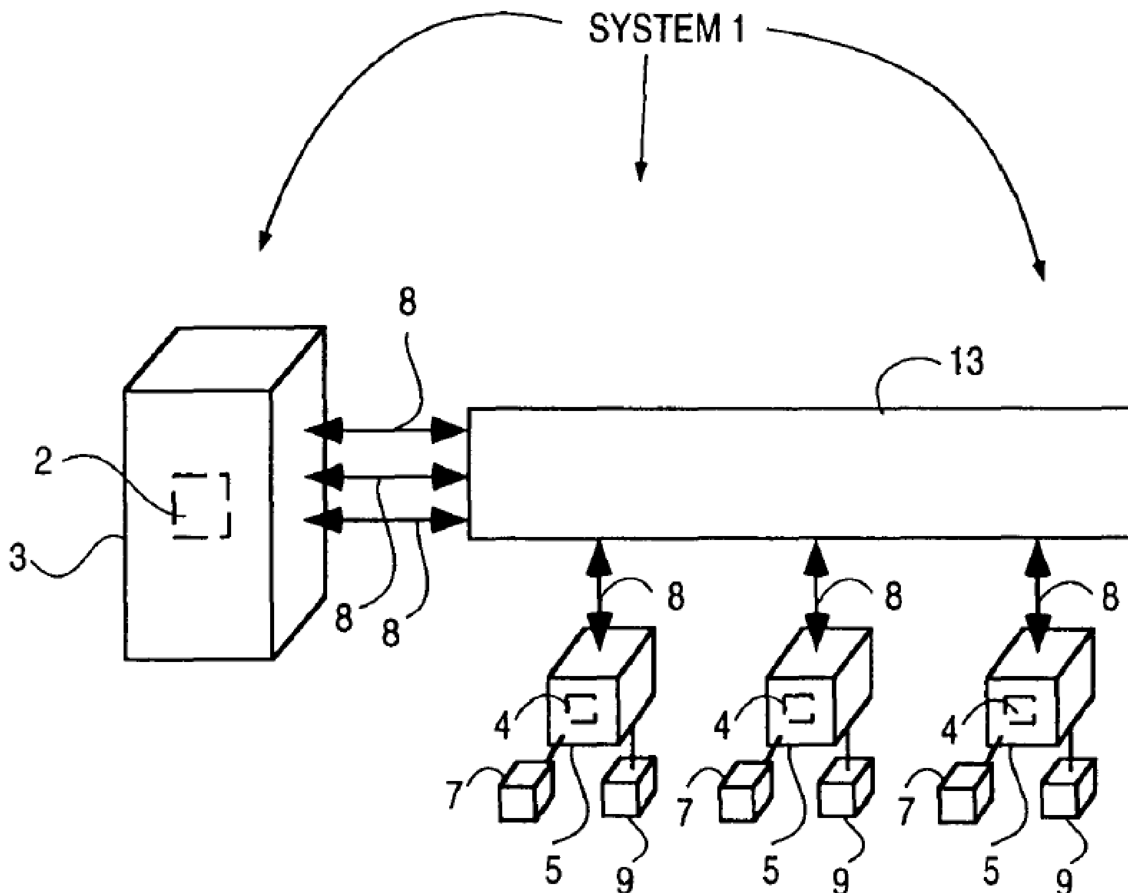

Figure 1 is a block diagram showing the components and data flow of a computerized human communication arbitrating and distributing system.

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