

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.,
Petitioner,

v.

MYMAIL, LTD.,
Patent Owner.

Case IPR2017-00967
Patent 8,275,863 B2

Before KEVIN F. TURNER, KAMRAN JIVANI, and
MONICA S. ULLAGADDI Administrative Patent Judges.

ULLAGADDI, Administrative Patent Judge.

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

I. INTRODUCTION

A. Background

Unified Patents Inc. (“Petitioner”) filed a Petition pursuant to 35 U.S.C. §§ 311–319 requesting an *inter partes* review of claims 1, 2, 4, 5, 10, 11, 14–17, 20, and 23 of U.S. Patent No. 8,275,863 B2, issued on September 25, 2012 (Ex. 1001, “the ’863 patent”). Paper 2. As the original Petition lacked page numbers, we instructed Petitioner to file a Second Corrected Petition on September 6, 2017, which we cite herein.¹ Paper 9 (“Pet.”), Paper 8 (authorizing Second Corrected Petition). My Mail, Ltd. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

On September 13, 2017, we entered a Decision on Institution (“Inst. Dec.” Paper 10) instituting an *inter partes* review as to all of the challenged claims. Specifically, we instituted review as to claims 1, 2, 4, 5, 10, 11, 14–17, 20, and 23 over Filepp and Morten and claims 2 and 10 over Filepp, Morten, and Olsen.² Inst. Dec. 22. We did not institute review as to

¹ Petitioner indicated that the original Petition did not comply with the word count limit set forth in 37 C.F.R. § 42.24. *See* Paper 8; *see* Paper 9, 66 (stating that the word count for the Second Corrected Petition is 14,134 words). Due to the short time frame, we instructed Petitioner to file the Second Corrected Petition, which we refer to herein as “Petition” or “Pet.,” with no changes except to add page numbers, and we indicated that we would disregard any portion of the Petition in excess of the word count. Paper 8. Petitioner’s ground 6, based on Reilly and December, includes the portion of the Petition that is in excess of the word limit by 134 words. Pet. 66. In view of our disposition, we need not consider what, if any, effect our disregarding the 134 words (*see* Paper 8) would have had on a decision on the merits with respect to ground 6.

² In our Decision on Institution, we instituted review with respect to claims 2 and 10 over Filepp, Morten, and Olsen, instead of Filepp and Olsen as

challenges based on Filepp alone, Reilly alone, or Reilly in combination with other references.

After institution of trial, Patent Owner filed a Patent Owner Response (“PO Resp.” Paper 16), to which Petitioner filed a Reply (“Reply” Paper 20).

On May 1, 2018, a conference call was held among Judges Jivani, Turner, and Ullagaddi and counsel for the parties. During the call, we gave the parties an opportunity to discuss the impact of the Supreme Court’s holding in *SAS Institute Inc. v. Iancu*, 2018 WL 1914661, at *10 (U.S. Apr. 24, 2018) with respect to the instant proceeding. Following the call, we entered an Order (Paper 27) which modified the Decision on Institution to include review of all grounds of unpatentability of the challenged claims as presented in the Petition. In that Order, we authorized additional briefing to address the modification to the Decision on Institution.

Petitioner filed a Supplemental Reply (“Supp. Reply” Paper 32) and Patent Owner filed a Supplemental Response (“Supp. Resp.” Paper 30). Patent Owner also filed a Motion to Strike (“Motion” or “Mot.” Paper 29), to which Petitioner responded with an Opposition to Motion to Strike (“Opposition” or “Opp.” Paper 31).

A hearing for IPR2017-00967 was held on June 22, 2018. The transcript of the hearing has been entered into the record. Paper 35 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This final written decision is issued pursuant to 35 U.S.C. § 318(a).

originally set forth by Petitioner. Inst. Dec. 19. In view of our Order following *SAS*, we revert to Petitioner’s original challenge to claims 2 and 10 over Filepp and Olsen. Paper 27, 5.

Based on the complete record now before us, we conclude Petitioner has not shown, by a preponderance of the evidence, that any of challenged claims 1, 2, 4, 5, 10, 11, 14–17, 20, and 23 of the '863 patent are unpatentable.

B. Related Proceedings

The parties inform us that the '863 patent is or has been the subject of numerous lawsuits in district court. Pet. 7; Paper 4, 1–2.

In addition, the '863 patent was the subject of IPR2015-00269 (the “'269 IPR”), which, according to Petitioner, “was instituted and later settled.” Pet. 7; Paper 4, 2; Ex. 1021 (“'269 Institution Decision”).

Petitioner represents that the asserted grounds in the Petition are the same as those upon which trial was instituted in the '269 IPR and that the content of the Petition is substantially the same as the petition in that proceeding. Pet. 5.

The '863 patent was also the subject of the IPR2018-00118 proceeding (“'118 IPR”) in which we denied institution. *See* '118 IPR, Paper 5, 1–2 (discussing related litigations). A child of the '863 patent, U.S. Patent No. 9,021,070 (the “'070 patent”), was the subject of the IPR2018-00117 proceeding (“'117 IPR”) in which we also denied institution. *See* '117 IPR, Paper 5, 1–2 (discussing related litigations).

C. The '863 Patent

The '863 patent relates to methods for modifying the toolbar of an Internet device. Ex. 1001, 1:1. Specifically, the claims relate to updating the toolbar of a user Internet device over the Internet. *Id.* at 29:28–63.

Figure 16 is reproduced below:



FIG. 16

Figure 16 illustrates a toolbar.

According to the '863 patent, information related to updating the toolbar (also called a “button bar”), which may be provided as part of a browser, is obtained from button bar database 208. *Id.* at 10:7–15. Button bar database 208 stores “attributes” that define the toolbar’s buttons, including text, format, and function. *Id.* at 10:38–50 (alternately referring to button bar database with reference number 210). For example, a button can be configured to “go to the USA Today . . . web site,” or launch a script or a program. *Id.* at 10:38–11:4. The '863 patent discloses, “the Toolbar of the present invention has some unique properties as it can be dynamically changed or updated via a Pinger process or a MOT script.” *Id.* at 10:15–17. The '863 patent discloses that

[A] Pinger process comprises an entity that acts transparently as a services coordinator to provide and/or administer the following:

1. Heartbeat service to help maintain network connectivity with a client.
2. Authentication services that securely authenticate client access to email, commerce, and other public and private network servers and services.
3. Update services that can perform client software, database, and maintenance services during periods of inactivity.

The Pinger entity, as suggested above, has, as one of its functions, the responsibility of providing database updates to the client user.

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