UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FACEBOOK, INC.,
Petitioner,

v.

SOUND VIEW INNOVATIONS, LLC,
Patent Owner.

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Case IPR2017-01004
Patent 7,366,786 B2

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Before DEBRA K. STEPHENS, JAMES B. ARPIN, and
DANIEL J. GALLIGAN, *Administrative Patent Judges*.

GALLIGAN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a) and 37 C.F.R. § 42.108

I. INTRODUCTION

Facebook, Inc. ("Petitioner") filed a Petition ("Pet.") requesting *inter partes* review of claims 1–4 and 7 of U.S. Patent No. 7,366,786 B2 ("the '786 patent," Ex. 1001). Paper 2. Sound View Innovations, LLC ("Patent Owner") filed a Preliminary Response. Paper 6 ("Prelim. Resp."). Petitioner filed a Reply to Patent Owner's Preliminary Response. Paper 11 ("Pet. Reply"); *see also* Paper 10 (Decision authorizing Petitioner to file a reply of limited scope). Pursuant to 37 C.F.R. § 42.4(a), we have authority to determine whether to institute review.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted unless the information presented in the Petition shows "there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition."

For the reasons that follow, we deny institution of an *inter partes* review.

A. *Related Matters*

The parties indicate the '786 patent is at issue in *Sound View Innovations, LLC v. Facebook, Inc.*, No. 16-116-RGA (D. Del.). Pet. 1; Paper 4, 1. In addition, Petitioner concurrently filed a petition for *inter partes* review of related Patent 6,732,181 B2. IPR2017-01006.

B. *The '786 Patent and Illustrative Claims*

The '786 patent "relates to service management of digital communications networks and, in particular, to the management of communications services from a service provider by a customer of the provider." Ex. 1001, 1:19–22.

Claim 1 is illustrative and is reproduced below, and claims 2–4 and 7 depend from claim 1.

1.   A system for authorizing a user of a client to have access to a server via the Internet comprising:

means in said client for inputting a user identification (ID) and user password;

means in said client for storing a unique client address;

communication means at said client for passing said ID, password and address to said server via said Internet in response to a request therefrom;

means at said server to store information respecting said client and to compare said stored information with said user ID and user password;

means at said server to store dynamic status information respecting said user, said dynamic status information being one of enabled, disabled or active; and

means to authorize log in of said user if said ID and password agree with said stored information and if said user status is enabled.

C.   References

Petitioner relies upon the following references:

Shi	US 5,875,296	Feb. 23, 1999 (filed Jan. 28, 1997)	Ex. 1003
Bachman	US 5,907,621	May 25, 1999 (filed Nov. 15, 1996)	Ex. 1009
W. Richard Stevens, *TCP/IP Illustrated, Volume 1*, 1994 ("Stevens").			Ex. 1005
Mike Morgan et al., *Webmaster Expert Solutions*, 1996 ("Morgan").			Ex. 1004
Jon Orwant, *Perl 5 Interactive Course*, 1996 ("Orwant").			Ex. 1006
Ted Coombs et al., *The Netscape LiveWire Sourcebook*, 1996 ("Coombs").			Ex. 1007

Mark Richer et al., *Official Netscape LiveWire Book*, 1997   Ex. 1008
("Richer").

D.   Asserted Grounds of Unpatentability

Petitioner challenges claims 1–4 and 7 of the '786 patent based on the

asserted grounds of unpatentability set forth in the table below. Pet. 3.

References	Basis	Claim(s) Challenged
Shi, Morgan, Stevens, Orwant, Coombs, and Richer	§ 103(a)[1]	1–3 and 7
Shi, Morgan, Stevens, Orwant, Coombs, Richer, and Bachman	§ 103(a)	4

II. ANALYSIS

A.   Claim Construction

In an *inter partes* review, "[a] claim in an unexpired patent that will

not expire before a final written decision is issued shall be given its broadest

reasonable construction in light of the specification of the patent in which it

appears." 37 C.F.R. § 42.100(b). In determining the broadest reasonable

construction, we presume that claim terms carry their ordinary and

customary meaning. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257

(Fed. Cir. 2007). This presumption may be rebutted when a patentee, acting

as a lexicographer, sets forth an alternate definition of a term in the

specification with reasonable clarity, deliberateness, and precision. *In re

Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

Petitioner argues that "independent claim [1] recites numerous

limitations explicitly in 'means-plus-function' format," and Petitioner lists

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[1] The application from which the '786 patent issued was filed before the date
on which the Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112-
29, took effect. Therefore, our citations to 35 U.S.C. §§ 103 and 112 are to
their pre-AIA version.

its proposed constructions for these terms in the table reproduced below.
Pet. 4–6. Petitioner states its proposed constructions below are also Patent
Owner's proposed constructions in the related district court litigation.
Pet. 4.

Element of Claim 1	Function and Structure
[a] means in said client for inputting a user identification (ID) and user password;	**Function:** inputting a user identification (ID) and user password **Structure:** a composed page within a WWW browser
[b] means in said client for storing a unique client address;	**Function:** storing a unique client address **Structure:** address field of a TCP/IP message
[c] communication means at said client for passing said ID, password and address to said server via said Internet in response to a request therefrom;	**Function:** passing said ID, password and address to said server via said Internet in response to a request therefrom **Structure:** TCP/IP message
[d] means at said server to store information respecting said client and to compare said stored information with said user ID and user password	**Function:** store information respecting said client and to compare said stored information with said user ID and user password **Structure:** a login CGI, and the system shared memory's simple user database
[e] means at said server to store dynamic status information respecting said user, said dynamic status information being one of enabled, disabled or active; and	**Function:** store dynamic status information respecting said user, said dynamic status information being one of enabled, disabled or active

	Structure: shared memory in RAM, or a hard drive
[f] means to authorize log in of said user if said ID and password agree with said stored information and if said user status is enabled.	**Function:** authorize log in of said user if said ID and password agree with said stored information and if said user status is enabled **Structure:** a JavaScript cookie

Pet. 5–6 (brackets in original). Patent Owner also argues these are means-plus-function limitations. Prelim. Resp. 3–4.

Each of the limitations reproduced above recites "means" and further recites one or more functions, thus creating a presumption that 35 U.S.C. § 112 ¶ 6 applies. *See* 35 U.S.C. § 112, ¶ 6 ("An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."); *see also Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1349 (Fed. Cir. 2015) (quoting *Personalized Media Communications, LLC v. International Trade Commission*, 161 F.3d 696, 703 (Fed. Cir. 1998)) (holding that "use of the word 'means' creates a presumption that § 112, ¶ 6 applies.").

We agree with the parties that these limitations are means-plus-function limitations subject to 35 U.S.C. § 112 ¶ 6. Construing a means-plus-function limitation includes two steps: (1) identifying the claimed function, and (2) identifying the corresponding structure in the specification of the patent that performs the function. *IPCom GmbH v. HTC Corp.*, 861 F.3d 1362, 1370 (Fed. Cir. 2017).

A petition for *inter partes* review must

[p]rovide a statement of the precise relief requested for each claim challenged. The statement must identify . . . [h]ow the challenged claim is to be construed. Where the claim to be construed contains a means-plus-function or step-plus-function limitation as permitted under 35 U.S.C. 112(f), the construction of the claim must identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function . . . .

37 C.F.R. § 42.104(b). The Petition does not provide the requisite claim construction analysis for the means-plus-function limitations. Petitioner includes no citation to the Specification of the '786 patent for any alleged structure and, therefore, has not "identif[ied] *the specific portions of the specification* that describe the structure, material, or acts corresponding to each claimed function," as required by our Rules. 37 C.F.R. § 42.104(b) (emphasis added).

As just one example, with respect to the "means in said client for inputting a user identification (ID) and user password," Petitioner identifies the function as "inputting a user identification (ID) and user password." Pet. 5. We agree with Petitioner's statement of the claimed function. As purported structure, Petitioner identifies "a composed page within a WWW [(World Wide Web)] browser." Pet. 5. Petitioner, however, does not "identify *the specific portions of the specification* that describe the structure, material, or acts corresponding to each claimed function," as required by our Rules. 37 C.F.R. 42.104(b) (emphasis added). Petitioner includes no citation to the Specification of the '786 patent for this alleged structure.

Based on our review, we note the Specification of the '786 patent mentions "composed" web pages in a few instances. *See* Ex. 1001, 4:31–35, 5:26–36, 5:44–46. These passages, however, do not mention the input of

user identification and password information. As the Federal Circuit has stated, "structure corresponding to the claimed function must be disclosed in the specification with clear linkage between the structure and the claimed function." *Medical Instrumentation & Diagnostics Corp. v. ElektaAB*, 344 F.3d 1205, 1220 (Fed. Cir. 2003). Petitioner has not provided any argument in support of its proposed construction explaining how the Specification of the '786 patent links "a composed page within a WWW browser" to the function of inputting a user identification (ID) and user password. Therefore, we are not persuaded by Petitioner's assertion that "a composed page within a WWW browser" is structure that corresponds to the function of "inputting a user identification (ID) and user password." Pet. 5.

Petitioner argues that, because its proposed constructions in this proceeding are the same as Patent Owner's proposed constructions in the related district court litigation, "the Board has no obligation to decide the issue on its own, and the stipulated construction will not be a basis for reversal on appeal." Pet. 4; *see also* Pet. Reply 1 ("The Board should adopt the agreed constructions, and neither party will be able to challenge those constructions thereafter"). That Patent Owner has proposed these constructions in related district court litigation, however, does not relieve Petitioner of its burden to comply with our Rules for *inter partes* reviews.

After the filing of the Petition, in related litigation involving the '786 patent, the district court issued a claim construction opinion and orders addressing the "means to authorize log in of said user if said ID and password agree with said stored information and if said user status is enabled" limitation of claim 1. *Sound View Innovations, LLC v. Facebook, Inc.*, No. 16-116-RGA (D. Del.), Dkt. Nos. 100 (Memorandum Opinion,

entered May 19, 2017) (excerpt at Ex. 2001[2]), 113 (Claim Construction Order, entered May 30, 2017), and 162 (Memorandum Order, entered August 10, 2017) (Ex. 2009).[3] Initially, the district court determined this limitation was indefinite for lack of corresponding structure in the Specification of the '786 patent. Ex. 3001, 16–20. On reconsideration, however, the district court determined this limitation is not indefinite, and it construed the function to be "authorizing log in and verifying user status as enabled" and identified the corresponding structure as "'a JavaScript cookie' and 'System API.'" Ex. 2009, 1–3.

In the context of claim construction under the broadest reasonable interpretation standard, the Federal Circuit has stated that "[t]here is no dispute that the [Patent Trial and Appeal Board (board)] is not generally bound by a prior judicial construction of a claim term" but has advised further that "the fact that the board is not generally bound by a previous judicial interpretation of a disputed claim term does not mean, however, that it has no obligation to acknowledge that interpretation or to assess whether it is consistent with the broadest reasonable construction of the term." *Power Integrations, Inc. v. Lee*, 797 F.3d 1318, 1326 (Fed. Cir. 2015). The Federal Circuit, however, also has stated that section 112, "'paragraph six applies regardless of the context in which the interpretation of means-plus-function language arises, i.e., whether as part of a patentability determination in the PTO or as part of a validity or infringement determination in a court.'" *IPCom*, 861 F.3d at 1369 (quoting *In re Donaldson Co.*, 16 F.3d 1189, 1193

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[2] A complete copy of this Opinion is entered as Exhibit 3001.
[3] The Opinion and Orders from the district court do not set forth constructions for the other means-plus-function limitations of claim 1.

(Fed. Cir. 1994) (en banc)). Therefore, under either standard of interpretation, "the construction of a means-plus-function limitation under § 112 ¶ 6 'must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure.'" *Id.*

In its Petition, Petitioner identifies as alleged structure for the "means to authorize" limitation "a JavaScript cookie," but Petitioner includes no citation to the Specification of the '786 patent in support. Pet. 5. The district court's issuance of a claim construction opinion construing this means-plus-function limitation did not relieve Petitioner retroactively of its obligation in the Petition to "identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function," as required by our Rules. 37 C.F.R. § 42.104(b)(3). Nevertheless, consistent with the Federal Circuit's guidance in *Power Integrations*, we have considered the district court's claim construction analysis with respect to this means-plus-function limitation and the portions of the Specification cited therein. *See* Exs. 2001, 2009 (citing Ex. 1001, 10:21–27, 13:4–27, 13:34–36, 13:51–53, 13:57–58). We determine, however, that the cited portions of the '786 patent Specification do not provide identification of sufficient structure corresponding to the recited functions, as required for our proceedings under our Rules and in view of the guidance of the Federal Circuit on this issue. *See* 37 C.F.R. § 42.104(b)(3); *IPCom*, 861 F.3d at 1370; *see also Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371, 1383 (Fed. Cir. 2009) ("The ACM is essentially a black box that performs a recited function. But how it does so is left undisclosed.");

ePlus, Inc. v. Lawson Software, Inc., 700 F.3d 509, 518 (Fed. Cir.2012)
(holding that "black box" labeled "Purchase Orders" was insufficient
structure to perform the "generate purchase orders" function); *Noah Sys.,
Inc. v. Intuit Inc.*, 675 F.3d 1302, 1317 (Fed. Cir. 2012) ("[T]he *disclosure*
must identify the method for performing the function, whether or not a
skilled artisan might otherwise be able to glean such a method from other
sources or from his own understanding.").

In sum, Petitioner does not "identify the specific portions of the
specification that describe the structure, material, or acts corresponding to
each claimed function," as required by our Rules (37 C.F.R. § 42.104(b)), to
enable us to determine if the asserted prior art teaches such structure. Thus,
Petitioner fails to demonstrate a reasonable likelihood of prevailing in its
challenge to independent claim 1 as well as its challenges to claims 2–4
and 7, which depend from claim 1 and do not recite structure for the means-
plus-function limitations of claim 1.

III. ORDER

Based on the foregoing, it is hereby:

ORDERED that the Petition is *denied*, and no trial is instituted.

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