

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.,
Petitioner,

v.

SOUND VIEW INNOVATIONS, LLC,
Patent Owner.

Case IPR2017-01006
Patent 6,732,181 B2

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 5–9 of U.S. Patent No. 6,732,181 B2 (“the ’181 patent,” Ex. 1001). Paper 2. Sound View Innovations, LLC (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). 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 ’181 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 7,366,786. IPR2017-01004.

B. *The ’181 Patent and Illustrative Claims*

The ’181 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, 1:10–13.

Challenged claim 5 is independent, and claims 6–9 depend from claim 5. Claim 5 is illustrative and is reproduced below.

5. A system for providing a user of an Internet-based communication system selective access to information relating to other users comprising:

a server having means to store a list of users including user access type, identification, password and name;

a user client having means for a user to input identification and password information; and

means at said server to compare said user input information with stored information and based on user verification and user access type provide said user with a list of other users for which said user has access.

C. References

Petitioner relies upon the following references:

Parker	US 5,729,734	Mar. 17, 1998	Ex. 1004
Smith	US 5,835,724	Nov. 10, 1998 (filed July 3, 1996)	Ex. 1007
Shi	US 5,875,296	Feb. 23, 1999 (filed Jan. 28, 1997)	Ex. 1003
Abraham	US 5,983,270	Nov. 9, 1999 (filed Apr. 2, 1997)	Ex. 1008
Jon Orwant, <i>Perl 5 Interactive Course</i> , 1996 (“Orwant”).			Ex. 1006
Mike Morgan et al., <i>Webmaster Expert Solutions</i> , 1996 (“Morgan”).			Ex. 1005

D. Asserted Grounds of Unpatentability

Petitioner challenges claims 5–9 of the ’181 patent based on the asserted grounds of unpatentability set forth in the table below. Pet. 3.

References	Basis	Claim(s) Challenged
Shi, Parker, Morgan, Orwant, and Smith	§ 103(a) ¹	5
Shi, Parker, Morgan, Orwant, Smith, and Abraham	§ 103(a)	6–9

II. ANALYSIS

A. *Claim Construction*

Patent Owner requested district court-type claim construction pursuant to 37 C.F.R. § 42.100(b), certifying that the '181 patent will expire within 18 months from the entry of the Notice of Filing Date Accorded to Petition. Paper 6, 1. We granted Patent Owner's motion, which Petitioner did not oppose. *See* Paper 8.

Petitioner argues that “independent claim [5] recites several limitations explicitly in ‘means-plus-function’ format.” Pet. 3. These limitations recite: “means to store a list of users including user access type, identification, password and name,” “means for a user to input identification and password information,” and “means at said server to compare said user input information with stored information and based on user verification and user access type provide said user with a list of other users for which said user has access.” 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.

¹ The application from which the '181 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.

§ 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).

Petitioner states that the parties “have, in the concurrent litigation, taken differing positions as to how these terms should be construed.” Pet. 3–4. In particular, in that litigation, Petitioner contends that these means-plus-functions limitations are indefinite for alleged lack of corresponding structure in the Specification of the ’181 patent. *See* Ex. 1013, 5–6. Petitioner, however, states that “[i]n order to simplify the review of the ’181 patent for the Board, the Petitioner is willing to accept, for purposes of this IPR petition only, the proposed constructions adopted by the patent holder in the concurrent litigation.” Pet. 4. Petitioner provides a table, reproduced below, outlining its proposed constructions.

Element of Claim 5	Function and Structure
[a] means to store a list of users including user access type, identification, password and name;	<p>Function: storing a list of users including user access type, identification, password and name</p> <p>Structure: shared memory in RAM, a hard drive</p>
[b] means for a user to input identification and password information;	<p>Function: enabling a user to input identification and password information</p> <p>Structure: a composed page within a WWW browser</p>
[c] means at said server to compare said user input information with stored information and based on user verification and user access type provide said user with a list of other users for which said user has access.	<p>Function: comparing said user input information with stored information and based on user verification and user access type provide said user with a list of other users for which said user has access</p> <p>Structure: a login CGI, the system shared memory's simple user database, Web API, System API, and a drop box selection menu as described in col. 9:34–36 or depicted in Figure 13</p>
"user"	No construction necessary
"user access type"	No construction necessary

Pet. 5 (brackets in original).

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. For purposes of this Decision, we discuss the second and third means-plus-function limitations identified above.

With respect to the “means for a user to input identification and password information,” Petitioner identifies the function as “enabling a user to input identification and password information.” 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 ’181 patent for this alleged structure.

Based on our review, we note the Specification of the ’181 patent mentions “composed” web pages in a few instances. *See* Ex. 1001, 4:23–27, 5:18–28, 5:34–36. These passages, however, do not mention the input of 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 ’181 patent links “a composed page within a WWW browser” to the function of enabling a user to input identification and password information.

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 "enabling a user to input identification and password information."

Pet. 5.

With respect to the "means at said server to compare said user input information with stored information and based on user verification and user access type provide said user with a list of other users for which said user has access" limitation, Petitioner identifies the function as "comparing said user input information with stored information and based on user verification and user access type provide said user with a list of other users for which said user has access." Pet. 5. This limitation actually recites two functions: comparing and providing. Therefore, a more precise statement of the claimed functions is: *comparing* said user input information with stored information and, based on user verification and user access type, *providing* said user with a list of other users for which said user has access.

As purported structure, Petitioner identifies "a login CGI, the system shared memory's simple user database, Web API, System API, and a drop box selection menu as described in col. 9:34-36 or depicted in Figure 13." Pet. 5. Petitioner's proposed construction identifies only two specific portions of the Specification of the '181 patent allegedly referring to a "drop box selection menu": column 9, lines 34-36 and Figure 13. Pet. 5. The cited passage states: "There is a drop box selection menu that allows the user to switch to another customer portfolio and act as a user from that customer." Ex. 1001, 9:34-36.

The second citation is to Figure 13, which is reproduced below.

The image shows a dashboard frame with a vertical label 'DASHBOARD FRAME' on the left. The main content area contains a 'WELCOME' header, followed by 'CUSTOMER CARE SERVICE MANAGEMENT'. Below this, it displays 'CURRENT CUSTOMER: CUSTOMER 15' and 'SELECT A CUSTOMER TO SWITCH TO'. A dropdown menu is shown with 'CUSTOMER 15' and a downward arrow. Further down, it shows 'LAST LOGIN WAS: 01/22/98 10:14:29' and 'HELP DESK PHONE NUMBER: 421-2643 N/A'. A 'NOTE PAD' section contains 'N/A' and a 'SAVE NOTE PAD' button.

FIG. 13

According to the '181 patent, Figure 13 “shows an internal user’s welcome frame. A pull down menu contains a list of all the customers that may be accessed by the internal user.” Ex. 1001, 19:32–34. Although these two passages appear to relate to the function of “provid[ing] said user with a list of other users for which said user has access,” it is not readily apparent that these passages correspond to both recited functions. At least for this reason, Petitioner fails 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) (emphasis added).

Petitioner also identifies “a login CGI, the system shared memory’s simple user database, Web API, [and] System API” as allegedly corresponding structure for the “means . . . to compare . . . and . . . provide” limitation. Pet. 5. However, Petitioner has not provided any citations to the Specification of the ’181 patent describing these alleged structures, nor has Petitioner provided any argument explaining how the Specification of the ’181 patent links these alleged structures to the recited functions of “compar[ing] said user input information with stored information” and “based on user verification and user access type provid[ing] said user with a list of other users for which said user has access.”

Based on our review, we note the term “login CGI” appears only twice in the Specification of the ’181 patent. In the first instance, the ’181 patent states:

Upon user login, a login CGI program is fired up. The Login [C]GI uses the system shared memory’s simple user database for user access authorization. If login is successful, the CGI program calls Web API, which again calls System API, to construct the users welcome screen. System then changes the status of the user account to active.

Ex. 1001, 9:60–65. In the second instance, the ’181 patent states: “If login failure is reported by the Login CGI process, an error notification screen is constructed with a specific reason, i.e., non-existent account, invalid password.” Ex. 1001, 10:2–5. The ’181 patent Specification characterizes the “login CGI” cited by Petitioner as a program, i.e., software. Petitioner, however, does not direct us to a description of structure for that software, i.e., an algorithm by which the software operates to perform the recited functions. Such an algorithm may be expressed “in any understandable terms including as a mathematical formula, in prose, . . . or as a flow chart,

or in any other manner that provides sufficient structure.” *FinisarCorp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1340 (Fed. Cir. 2008). However, merely disclosing “a black box that performs a recited function” without disclosing “how it does so” is not sufficient. *Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371, 1383 (Fed. Cir. 2009). Furthermore,

[a] patentee cannot avoid providing specificity as to structure simply because someone of ordinary skill in the art would be able to devise a means to perform the claimed function. To allow that form of claiming under section 112, paragraph 6, would allow the patentee to claim all possible means of achieving a function.

Id. at 1385.

Furthermore, Petitioner does not explain how Web API and System API provide structure for performing the recited functions of “compar[ing] said user input information with stored information” and “based on user verification and user access type provid[ing] said user with a list of other users for which said user has access.” Although Petitioner does not identify any specific portions of the ’181 patent Specification describing Web API and System API, we have reviewed the ’181 patent Specification and portions thereof mentioning Web API, Web Services API², and System API. *See, e.g.*, Ex. 1001, 4:55–5:33, 6:43–50, 9:60–10:2, 10:38–39, 10:42–43, 11:21–30, 11:45–46, 11:51–53, 11:65–66, Fig. 3. One passage of the ’181 patent states that, “[i]f login is successful, the CGI program calls Web API, which again calls System API, to construct the users welcome screen.”

² The ’181 patent Specification appears to use the terms Web API and Web Services API interchangeably. *See, e.g.*, Figure 3 (depicting “WEB API” as part of client UI module), 4:62–64 (“As shown in FIG. 3 the client UI module includes a CGI parser, a WEB services API and a WEB page formatting API.”).

Ex. 1001, 9:62–64. This passage, however, does not describe how the Web API and the System API construct the user welcome screen so as to “provide said user with a list of other users for which said user has access,” as recited in 5. Figure 13 may represent a web page or screen that results from some operation involving the Web API and the System API, but the manner in which that operation is carried out, i.e., the means for performing the recited function, is not specified. Indeed, the ’181 patent describes the Web API or Web Services API in largely functional terms, with those functions including “invok[ing] a WEB Page Formatting API to compose a HTML screen page for the returned object as necessary” and “return[ing] the composed HTML screen page.” Ex. 1001, 5:18–28. The ’181 patent Specification, however, does not describe the manner in which the Web Page Formatting API creates pages. *See* Ex. 1001, 5:29–36. *See Blackboard*, 574 F.3d at 1383 (“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.”).

After the filing of the Petition, in related litigation involving the ’181 patent, the district court issued a claim construction opinion and an order setting forth a construction for the “means . . . to compare . . . and . . . provide” limitation that identifies the identical structure as that proposed by Petitioner in this proceeding. *Sound View Innovations, LLC v. Facebook*,

Inc., No. 16-116-RGA (D. Del.), Dkt. Nos. 100 (Memorandum Opinion, entered May 19, 2017) (Ex. 3001) and 113 (Claim Construction Order, entered May 30, 2017).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)). Although we are applying the district court-type claim construction standard rather than the broadest reasonable interpretation in this proceeding (*see* Paper 8), the Federal Circuit 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 (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

³ The Memorandum Opinion and the Order from the district court do not set forth constructions for the other two means-plus-function limitations of claim 5.

acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure.” *Id.*

As an initial matter, we note that the district court’s issuance of a claim construction opinion identifying the identical structure as Petitioner’s proposed construction after the filing of the Petition 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). However, because in this proceeding Petitioner’s proposed structure for the “means . . . to compare . . . and . . . provide” limitation is identical to the structure identified by the district court, we also look to the district court’s claim construction opinion, consistent with the Federal Circuit’s guidance in *Power Integrations*. The district court states:

I read the patent as both clearly connecting the cited structures to the claimed function and to one another. At column 9, line 30, the specification begins its discussion of internal users, which are users with the ability to access multiple user profiles. It states that an internal user would be given a “modified welcome page.” (’181 Patent, col. 9, ll. 33–34). The modified welcome page includes a “drop box selection menu that allows the user to switch to another customer portfolio” (*Id.* at ll. 34–35). In that same discussion, the specification describes a “login CGI” that is “fired up” when a user enters login information. (*Id.* at l. 60). “The Login [C]GI uses the system shared memory’s simple user database for user access authorization.” (*Id.* at ll. 60–63). Once the user’s access has been authorized, “the CGI program calls Web API, which again calls System API, to construct the users welcome screen.” (*Id.* at ll. 63–64).

The compare function is performed by the “Login CGI” and the “system shared memory’s simple user database.” The “providing said user with a list of other users for which said user has access” function is performed by the “Web API” and the

“System API,” which construct the welcome screen that includes a “drop box selection menu.”

Ex. 3001, 14–15 (alterations in original) (footnote omitted).

We have considered the district court’s claim construction analysis and the portions of the Specification cited therein.⁴ We determine, however, that the cited portions of the ’181 patent Specification do not provide identification of sufficient structure corresponding to the recited function 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.

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. 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.

⁴ In addition to the citations to column 9 and Figure 13 of the ’181 patent, the district court notes that the plaintiff in litigation (Patent Owner) cites column 12, lines 49–51. This passage is directed to “a new logon system” directed to an alleged “multiple logon” problem. *See* Ex. 1001, 12:12, *et seq.* The “login CGI” is not mentioned in this passage. Rather, this portion of the Specification states that an “SD application[] performs user validation and prevents multiple logon of identical user Ids through the Internet.” Ex. 1001, 12:12–14. The Specification of the ’181 patent further states that, “[t]o enforce the user logon, functions defined using Netscape Server API *are to be created*,” including one to “service[] the logon process.” Ex. 1001, 13:1–7 (emphasis added). It is not readily apparent how this disclosure relates to the previously-mentioned “login CGI.”

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 5 as well as its challenge to claims 6–9, which depend from claim 5 and do not recite structure for the means-plus-function limitations of claim 5.

III. ORDER

Based on the foregoing, it is hereby:

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

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