

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK INC.
Petitioner
v.

WINDY CITY INNOVATIONS, LLC
Patent Owner

U.S. Pat. No. 8,694,657
Issue Date: April 8, 2014
Title: REAL TIME COMMUNICATIONS SYSTEM

**PATENT OWNER'S MOTION FOR OBSERVATIONS
ON CROSS-EXAMINATION**

Case No. IPR2016-01155¹

¹ Case IPR2017-00622 has been joined to this proceeding.

Exhibit List

Exhibit #	Exhibit Name
2001	Declaration of Chandrajit Bajaj, Ph.D.
2002	Merriam-Webster's Collegiate Dictionary, Tenth Edition (1994)
2003	Microsoft Press Computer Dictionary, Third Edition (1997)
2004	Macmillan Encyclopedia of Computers (Gary G. Bitter ed., Macmillan Publ. Co. 1992)
2005	Excerpt from David W. South, <i>The Computer and Information Science and Technology Abbreviations and Acronyms Dictionary</i> , CRC Press, May 6, 1994
2006	Declaration of Jaime G. Carbonell, Ph.D.
2007	Deposition Transcript of Christopher M. Schmandt, dated February 22, 2017
2008	Deposition Transcript of Robert Stein, dated March 1, 2017
2009	Deposition Transcript of Judith S. Donath, dated February 23, 2017
2010	IDS filed Jan. 14, 2017 for U.S. Patent Application No. 14/246,965
2011	Bob Metcalfe, <i>Predicting the Internet's catastrophic collapse and ghost sites galore in 1996</i> , InfoWorld, p.61 (Dec. 4, 1995)
2012	<i>AOL could strike gold with IM patent</i> , CNN.com. (Dec. 19, 2002)
2013	U.S. Patent No. 6,449,344 to Yair Goldfiner et al.
2014	Decision Denying Institution in IPR2016-01137
2015	157 Cong. Rec. S1360-02, Proceedings and Debates of the 112th Congress, First Session (March 8, 2011)
2016	Deposition Transcript of Christopher Schmandt, dated July 25, 2017

Pursuant to the Board's scheduling order² (Paper 13), Patent Owner Windy City Innovations LLC respectfully submits this motion for observations on cross-examination of Mr. Christopher Schmandt, whose deposition was taken on July 25, 2017.

(1) **In exhibit 2015, on page 12, line 12 through page 13, line 15**, Mr. Schmandt testifies there is no copyright or publication date on the face of the Sociable Web document (Ex. 1019), that the face of the Sociable Web document included the date January 11, 1998, and that Mr. Schmandt understood that January 11, 1998 represented the date of the Sociable Web document's the earliest archived version. This testimony is relevant to Petitioner's assertion that the Sociable Web reference was publicly available before April 1, 1996 (Petition, Paper 1 at 17-18). The testimony is relevant because it contradicts Petitioner's assertion that the Sociable Web is prior art.

(2) **In exhibit 2015, on page 18, line 16 through page 22, line 24**, Mr. Schmandt testifies that Exhibit 1021 indicates that the Sociable Web document (Ex. 1019) was not printed and distributed at the conference. This testimony is relevant to (a) Mr. Schmandt's prior testimony in the same deposition (Exhibit 2015, page 12, line 12 through page 16, line 15) that he based his prior-art opinions on the Sociable Web document itself being printed and published at a 1994

² Due Date 4 remains unaffected by the filing of the parties' scheduling stipulations and the Board's revised scheduling order in this case.

conference, (b) the Board's institution decision (Paper 12 at 20-21) where the Board states that the "Sociable Web paper that was presented to conference attendees...in 1994," and (c) Petitioner's Reply (Paper 44 at 7-8) in which Petitioner states that copies of the paper were distributed at the conference. The testimony is relevant because it contradicts Mr. Schmandt and Petitioner's assertions that the Sociable Web paper is prior art, i.e. a "printed publication" having a publication date prior to April 1, 1996. The testimony is also relevant because it contradicts the Board's understanding that the Sociable Web document itself, not the project or work as a system, was made available to the conference attendees and should be considered prior art.

(3) **In exhibit 2015, on page 15, line 10 through page 16, line 15**, Mr. Schmandt testifies that his opinions on the Sociable Web document's (Exhibit 1019) prior-art status and relevance to this case are based on the advice of legal counsel for Facebook Inc., and that he relied on the opinions of legal counsel. This testimony is relevant to the Petition (Petition, Paper 1 at 17-18) because it contradicts Petitioner's assertion that the Sociable Web document itself is prior art.

(4) **In exhibit 2015, on page 65, line 24 through 66 line 12**, Mr. Schmandt testifies he has no opinion as to whether the prior art would disclose censorship if the Board adopted Dr. Carbonell's construction of the censor terms. This testimony is relevant to the Petition (Paper 1 at pp. 27 and 32), Mr.

Schmandt's original declaration (Ex. 1003 at pp. 144), where Petitioner and Mr. Schmandt allege disclosure of the censor limitations only in view of their own construction. The testimony is relevant because, if the Board adopts Patent Owner's constructions, Mr. Schmandt's testimony would contradict Petitioner's assertions that Petitioner disputes whether the prior art discloses the censor limitations.

(5) **In exhibit 2015, on page 131, line 20 through page 131, line 10, Mr. Schmandt testifies the claimed determination needs to be made as to multiple user identities, *i.e.* both a first user identity and a second user identity. This testimony is relevant to Mr. Schmandt's reply declaration (Ex. 1100 at paragraph 26) and Petitioner's Reply Brief (Paper 44 at 12), in which Mr. Schmandt and Petitioner state that the limitation does not require that this determining step must make a determination of multiple user identities. The testimony is relevant because it contradicts Mr. Schmandt's testimony and Petitioner's arguments regarding the limitation "determining whether the first user identity and the second user identity are able to form a group to send and receive real-time communication."**

(6) **In exhibit 2015, on page 132, line 20 through page 135, line 11, Mr. Schmandt testifies that the determining step is met by whether a note exists and that the only determination made in column 15, lines 27-37 of the Brown reference is whether a user can know that a note exists. This testimony is relevant to Mr.**

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