**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.

WINDY CITY INNOVATIONS, LLC
Patent Owner

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Case No. IPR2016-01155[1]
Patent No. 8,694,657

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# PETITIONER'S RESPONSE TO PATENT OWNER'S MOTION FOR OBSERVATIONS ON CROSS-EXAMINATION

[1] Case IPR2017-00622 has been joined with this proceeding.

Patent Owner's Motion for Observations on the Cross-Examination of Christopher Schmandt (Paper 51) contains excessively long and argumentative observations in violation of the Office's Trial Practice Guide and should be expunged. (*See* 77 F.R. 48756 at 768 (Aug. 14, 2012).) Nevertheless, Petitioner respectfully submits the following responses, numbered to correspond to Patent Owner's observations.

**1.** The cited testimony does not contradict Petitioner's assertion that the Sociable Web is prior art as Patent Owner asserts in Observation 1. The 1998 date on the face of the Internet Archive document is not relevant to the date of public accessibility of the Sociable Web prior art disclosure. As discussed in the Petition, supported by the Donath declaration, and accepted for the purposes of institution, the Sociable Web article was publicly available no later than the date of the 2nd Int'l Web Conference of October 1994, where Dr. Donath presented the article and made it available on the conference's website. (*See* Pet. at 17-18; Ex. 1031 at ¶¶ 6-7, 12; Ex. 1021 at iii, ix.)

**2.** Patent Owner's Observation 2 mischaracterizes Mr. Schmandt's testimony and the express disclosures of Ex. 1021, the Oct. 1994 Web Conference proceeding. Although counsel for Patent Owner attempted to prevent Mr. Schmandt from reading these disclosures into the record, Mr. Schmandt testified that Ex. 1021 expressly states that "[a]ll conference papers are available in the electronic

proceedings which can be access via the conference home page at the URL listed below." (*See* Ex. 2015 at 17:7-19:13, referring to Ex. 1021 at iii.) Patent Owner's Observation 2 further ignores the unrebutted sworn testimony of Dr. Donath, who testified the article was distributed both through the conference website and her own MIT website. (*See* Ex. 1022, ¶¶ 9-13; Ex. 1020; Ex. 2009 at 13:17-14:21.)

**3.** Patent Owner's Observation 3 underscores the fact that questioning directed to Mr. Schmandt improperly went beyond the scope of Mr. Schmandt's reply declaration, which never discussed the legal status of the Sociable Web article as prior art. Indeed, Mr. Schmandt's opening declaration did not address this issue either, but instead is based on the assumption that the Sociable Web qualifies as a prior art document. Mr. Schmandt explained this in his deposition. (*See* Ex. 2015 at 15:21-16:10.) Mr. Schmandt further testified that, even though he did actually have personal knowledge (because he and Dr. Donath were both at MIT) that Dr. Donath was working on the subject matter described in the Sociable Web and that she presented that subject matter at a conference, he did not rely on that in forming the opinions expressed in his declaration. (*See id.* at 13:16-14:19.)

**4.** Mr. Schmandt's reply declaration provides his opinion on the proper claim construction of the term "censor." (*See* Ex. 1100, ¶¶ 11-12.) Mr. Schmandt's reply declaration contains no opinions on whether the prior art discloses the censorship limitations of the challenged claims under Patent Owner's proposed

construction, because the Patent Owner's Response and Dr. Carbonell's supporting declaration did not dispute that the claim limitations containing the term "censor" were disclosed in the prior art (under any construction). (*See* Reply (Paper 44) at 6, 8-9.) Mr. Schmandt's opinions that the prior art discloses the "censor" claim limitations are not implicated by this observation and were not disputed by Patent Owner's Response or Dr. Carbonell. (*See* Ex. 1003, ¶¶ 222-226, 232-237, 238-246, 257-262, 269-278, 281-285, 288-290, 310-313, 316-317.)

**5.** Observation 5 mischaracterizes Mr. Schmandt's opinions and the arguments advanced by Petitioner. The claim language expressly recites that the relevant claim step requires "determining whether the first user identity ***and*** the second user identity are able to form a group." Petitioner's reply responds to Patent Owner's apparent argument that this claim limitation requires that the determination be made as to both user identities *simultaneously*. (*See* Reply at 12; Ex. 1100 ¶¶ 26-30.) The testimony of Mr. Schmandt cited by Patent Owner is not to the contrary. (*See* Ex. 2015 at 131:20-132:10.)

**6.** Contrary to Patent Owner's Observation 6, Mr. Schmandt did not testify that the *only* determination being made in Brown at 15:27-37 is whether a user can know whether or not a note exists. Indeed, Mr. Schmandt testified specifically that this section of Brown teaches a determination of whether "the group is visible to other users." (*See* Ex. 2015, 133:4-18; *see also* Ex. 1100 ¶ 27.) And in

any case, the disclosures of Brown speak for themselves. The cited section of Brown teaches that "this feature may be used to hide from the view of regular users a BBS folder (and its contents) that has been created for private correspondence between members of a family, so that the only users who can see the folder (via the Explorer or other client application) are the designated family members…. [O]nly those authorized to access each node can see the node." (*See* Ex. 1012, 15:27-37; *see also* Ex. 1100, ¶¶ 27-29.)

**7.** Patent Owner's observation appears to be based on a mistake in the questioning directed to Mr. Schmandt. In deposition, Mr. Schmandt was asked about Column ***33***, lines 5-21 of the Brown reference, even though he did not refer to these lines in his reply declaration. (*See* Ex. 2015 at 135:12, 135:17, 136:19.) In his reply declaration, Mr. Schmandt referred to Column ***31***, lines 5-21 of Brown. (*See* Ex. 1100, ¶ 28.) Patent Owner's accusation of Mr. Schmandt of contradicting his own declaration thus makes no sense. Instead, it is clear that Patent Owner's counsel failed to properly direct Mr. Schmandt to the correct column of Brown during the deposition, accounting for the confusion underlying this observation.

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