

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 IPR2016-01156<sup>1</sup>  
Patent 8,458,245 B1

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Before KARL D. EASTHOM, DAVID C. McKONE, and  
MELISSA A. HAAPALA, *Administrative Patent Judges*.

McKONE, *Administrative Patent Judge*.

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

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<sup>1</sup> Case IPR2017-00709 has been joined with this proceeding.

## I. INTRODUCTION

### A. Background

Facebook, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) seeking *inter partes* review of claims 1–15, 17, and 18 of U.S. Patent No. 8,458,245 B1 (Ex. 1001, “the ’245 Patent”). Windy City Innovations, LLC (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”).

Pursuant to 35 U.S.C. § 314, in our Institution Decision (Paper 7, “Dec.”), we instituted this proceeding as to claims 1–15, 17, and 18.

Patent Owner filed a Patent Owner’s Response (Paper 22, “PO Resp.”), and Petitioner filed a Reply to the Patent Owner’s Response (Paper 31, “Reply”).

Petitioner relies on the Declarations of Tal Lavian, Ph.D. (Ex. 1002, “Lavian Decl.”; Ex. 1021, “2nd Lavian Decl.”). Patent Owner relies on the Declaration of Jaime G. Carbonell, Ph.D. (Ex. 2005, “Carbonell Decl.”).

On January 17, 2017, Petitioner filed a petition seeking *inter partes* review of claims 19 and 22–25 of the ’245 patent and sought to join that proceeding to this proceeding. IPR2017-00709, Paper 2 (“the ’709 Pet.”), Paper 3 (Mot. for Joinder). We instituted a trial in that proceeding and joined it to this proceeding. Paper 34 (“the ’709 Dec.”). Petitioner relies on the Declaration of Dr. Lavian in the ’709 proceeding (IPR2017-00709, Ex. 1002 (“Lavian ’709 Decl.”)).

As to the additional claims challenged in the ’709 Petition, Patent Owner filed a Supplemental Patent Owner’s Response (Paper 45, “Supp. PO Resp.”) and Petitioner filed a Supplemental Reply (Paper 46, “Supp. Reply”).

An oral argument was held on October 19, 2017 (Paper 51, “Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This Decision is a final written decision under 35 U.S.C. § 318(a) as to the patentability of claims 1–15, 17–19, and 22–25. Based on the record before us, Petitioner has not proved, by a preponderance of the evidence, that any claim of the '245 patent is unpatentable.

*B. Related Matters*

The parties indicate that the '245 patent has been asserted in *Windy City Innovations, LLC v. Microsoft Corp.*, Civ. A. No. 15-cv-00103-GM (W.D.N.C.) (transferred to 16-cv-1729 (N.D. Cal.)), and *Windy City Innovations, LLC v. Facebook, Inc.*, Civ. A. No. 15-cv-00102-GM (W.D.N.C.) (transferred to 16-cv-1730 (N.D. Cal.)). Pet. 1; Paper 4, 1. The '245 patent also is the subject of *inter partes* review petitions in IPR2016-01141, Paper 4, 1, and IPR2017-00655, which was joined to IPR2016-01141. The '245 patent was the subject of IPR2017-00669 (now terminated), which Microsoft Corp. filed and sought to join with this proceeding prior to settling with Patent Owner. Patents related to the '245 patent are subjects of additional *inter partes* review petitions.

*C. Asserted Prior Art References*

Petitioner relies on the following prior art:

U.S. Patent No. 6,608,636 B1, issued Aug. 19, 2003, filed May 13, 1992 (Ex. 1003, "Roseman");

Published European Pat. App. No. 0 621 532 A1, published Oct. 26, 1994 (Ex. 1004, "Rissanen");

Ronald J. Vetter, *Videoconferencing on the Internet*, IEEE COMPUTER SOCIETY 77–79 (Jan. 1995) (Ex. 1005, “Vetter”);  
MARY ANN PIKE ET AL., USING MOSAIC (1994) (Ex. 1006, “Pike”);  
U.S. Patent No. 5,226,176, issued July 6, 1993 (Ex. 1007,  
“Westaway”); and  
TOM LICHTY, THE OFFICIAL AMERICA ONLINE FOR MACINTOSH  
MEMBERSHIP KIT & TOUR GUIDE (2nd ed. 1994) (Ex. 1008,  
“Lichty”).

*D. The Instituted Grounds*

We instituted a trial on the following grounds of unpatentability.

Dec. 30; '709 Dec. 6–7.

References	Basis	Claims Challenged
Roseman, Rissanen, Vetter, Pike, and Westaway	§ 103(a)	1–5, 7, 9–14, 19, and 22–25
Roseman, Rissanen, Vetter, Pike, Westaway, and Lichty	§ 103(a)	6, 8, 15, 17, and 18

*E. The '245 Patent*

The '245 patent describes an Internet “chat room.” According to the '245 patent, it was known to link computers together to form chat rooms in which users communicated by text, graphics, and multimedia, giving the example of the Internet service provider “America On Line.” Ex. 1001, 1:40–46. The '245 patent acknowledges that chat rooms have been implemented on the Internet, albeit with “limited chat capability,” but contends that the complex chat room communications capable with Internet service providers had not been developed on the Internet “at least in part

because [the] Internet was structured for one-way communications analogous to electronic mail, rather than for real time group chat room communications” and because “there is no particular control over the platform that would be encountered on the Internet.” *Id.* at 1:47–54, 1:60–62.

Figure 1, reproduced below, illustrates an embodiment of the invention:

**FIG. 1**

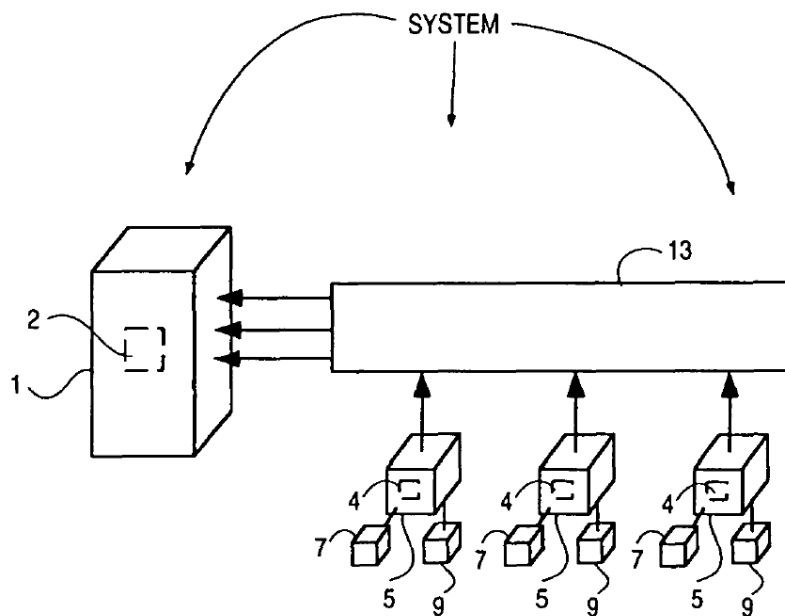


Figure 1 is a block diagram showing the components and data flow of a computerized human communication arbitrating and distributing system. *Id.* at 4:60–64. The system includes a controller computer (shown as 1 in Figure 1 but described as 3 in the written description) in communication with several participator computers 5 (e.g., IBM-compatible personal

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