UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.,
Petitioner,

v.

WINDY CITY INNOVATIONS LLC,
Patent Owner.

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

SUPPLEMENTAL PATENT OWNER'S RESPONSE

Case No. IPR2016-01159[1]

[1] IPR2017-00659 has been joined with this proceeding.

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I. INTRODUCTION

Windy City Innovations LLC ("Patent Owner") submits this supplemental response to the newly-added ground in IPR2016-01159 (the "1159 IPR") which has been joined from IPR2017-00659 (the "659 IPR").[2] Particularly, Patent Owner responds to Facebook Inc.'s ("Petitioner") ground presented in its petition ('659 IPR, Paper 2) regarding claims 203, 209, 215, 221, 477, 482, 487 and 492 (the "Joined Claims") of U.S. Patent No. 8,458,245 (Ex. 1001, the "'245 Patent"). This supplemental response is timely pursuant to the Board's Amended Scheduling Order (Original IPR, Paper No. 40).

Patent Owner respectfully submits that this supplemental response demonstrates that the Joined Claims are not obvious over combinations based on U.S. Patent No. 6,608,636 to Roseman (Ex. 1003, "Roseman") for a number of reasons. The Board should find that Petitioner has failed to establish by a preponderance of the evidence the invalidity of each of the Joined Claims.

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[2] This response is intended to address Petitioner's substantive arguments regarding the grounds authorized for trial and is not intended to be any form of acquiescence regarding the propriety of the Board's joinder and institution decisions on these grounds.

II. SUMMARY OF THE '657 PATENT AND THE ALLEGED PRIOR ART

Summaries of the '657 Patent and each alleged prior-art reference have been submitted in Patent Owner's Response (Paper 22 at 5-8).

III. PROPER CONSTRUCTION OF DISPUTED TERMS

A. Token

Petitioner and the Board in its institution decision have both adopted a construction of "token" as "piece of information associated with user identity." For the purpose of this Petition only, Patent Owner also adopts a similar construction.

B. Database

For the reasons set forth in Patent Owner's Response (Paper 22 at 8-12), a database should be construed as "a collection of logically-related data which is stored with persistence and associated tools for interacting with the data, such as a DBMS."

IV. THE JOINED CLAIMS ARE VALID AND NON-OBVIOUS

In arriving at an obviousness determination, the Board must sufficiently explain and support the conclusions that the prior-art references disclose all the elements recited in the Challenged Claims and a relevant skilled artisan not only could have made, but would have been motivated to combine all the prior-art references in the way the patent claims, and reasonably expected success. *Pers.*

Web Techs., LLC v. Apple, Inc., 848 F.3d 987, 994 (Fed. Cir. 2017).

The obviousness inquiry must exclude hindsight and avoid reading into the prior art the patent's teachings. *Graham v. John Deere Co.*, 383 U.S. 1, 36 (1966).

A. Claims 189 and 465 Are Valid and Non-Obvious

The Joined Claims depend from independent claims 189 and 465. On March 31, 2017, Patent Owner submitted its Patent Owner's Response regarding the validity and non-obviousness of claims 189 and 465. (Paper 22) Accordingly, the Joined Claims are valid and non-obvious for at least the reasons submitted in its Patent Owner's Response.

B. Claims 203, 209, 215, 221, 477, 482, 487 and 492 Are Not Unpatentable

Claims 203, 209, 215, 221, 477, 482, 487 and 492 each require the limitation "wherein the computer system provides access via any of two client software alternatives, wherein both of the client software alternatives allow respective user identities to be recognized and allow at least some of the participator computers to form at least one group in which members can send communications and receive communications." The prior art of record fails to disclose and/or suggest this

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