

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.
Petitioner

v.

WINDY CITY INNOVATIONS, LLC
Patent Owner.

Case IPR2016-01159
Patent 8,694,657¹

PETITIONER'S SUPPLEMENTAL REPLY

¹ IPR2017-00659 has been joined with this proceeding.

Patent Owner's Supplemental Response (Paper 45 ("Supp. Resp.)) is little more than a rehash of the arguments it previously made in IPR2016-01159, with which this proceeding was joined. In its Order Granting Petitioner's Motion for Joinder in IPR2017-00659, the Board correctly observed that "although the newly challenged claims are not identical to those challenged in the -1159 Petition, the substance is very similar such that the addition of claims 203, 209, 215, 221, 477, 482, 487, and 492 is not likely to affect the scope of the trial significantly." (Paper 11 in IPR2017-00659, at 9.) The Board also correctly observed that "the substance of Petitioner's claim construction arguments and summaries of the prior art references is essentially the same in the instant Petition as in the -1159 Petition." (*Id.*) Accordingly, it should come as no surprise that Patent Owner's Supplemental Response adds little, if anything, to its previous arguments. Patent Owner did not submit a new expert declaration or any additional evidence to support its defense of claims 203, 209, 215, 221, 477, 482, 487, and 492.

Nevertheless, in the interest of completeness, Petitioner will address each of Patent Owner's arguments below. For convenience and ease of reference for the Board, and to avoid the need to consider identical issues multiple times, Petitioner will also identify when an argument addressed herein was already covered (in more detail) by the previous submissions by the parties. For the reasons stated below, the

Board should find that claims 203, 209, 215, 221, 477, 482, 487, and 492 are unpatentable based on the instituted grounds.

I. CLAIM CONSTRUCTION

Patent Owner proposes the same construction for “database” that it proposed in its -1159 Response. As explained in detail in Petitioner's Reply (Paper 31 (“Reply”)), Patent Owner's proposed construction for “database” lacks intrinsic support, and its extrinsic support (the unsupported testimony of its expert) overlooks the facts that a “database” and a “database management system” (“DBMS”) are two different things and that a database does not require a DBMS. (Reply at 3-7; Lavian Second Decl., Ex. 1021, ¶¶ 10-17.) The Board should therefore reject Patent Owner's unsupported definition of “database.”²

II. CLAIMS 203, 209, 215, 221, 477, 482, 487 AND 492 ARE UNPATENTABLE

A. Reassertion of Patent Owner's Arguments for Claims 189 and 465

Patent Owner first argues that claims 203, 209, 215, 221, 477, 482, 487 and 492 are not unpatentable for the same reasons as the arguments it made with respect to claims 189 and 465. (Supp. Resp. at 3.) Patent Owner does not offer new

² As explained in the Reply, even if the Board were to adopt Patent Owner's “database” construction, it would not distinguish the prior art. (Reply at 14-15.)

arguments regarding claims 189 and 465. The unpatentability of claims 189 and 465 was fully addressed in the Petition and Reply.

B. “software alternatives”

Patent Owner next argues that Roseman does not disclose “two client software alternatives” by repeating nearly verbatim its arguments from its -1159 Response. (*Compare* Supp. Resp. at 4-8 with Paper 22 (“Resp.”) at 31-35.) These arguments were fully addressed in the Reply. (Reply at 20-21.)

Petitioner explained that the claimed two client software alternatives were obvious, among other reasons, because it would have been obvious to adapt the participator software in Roseman to run on multiple computing platforms, such as Windows and Macintosh. (Reply at 20; Ex. 1021, ¶ 54; -659 Petition at 53.) Patent Owner argues that “‘Windows and Macintosh’ are not client software, but are instead operating systems.” (Supp. Resp. at 6.) Petitioner already explained that it did not point to the Windows and Macintosh operating systems *themselves* as the two client software alternatives, but rather, to versions of the participator software in Roseman adapted to run on those platforms. (Reply at 20; Ex. 1021, ¶ 54; -659 Petition at 53.) Patent Owner does not dispute that a person of ordinary skill in the art would have been motivated to adapt the participator computer software in Roseman to run on multiple platforms, among other reasons, to increase the number of people who could use it. (-659 Petition at 53; Ex. 1021, ¶ 54.)

Patent Owner next argues in conclusory fashion that “even if one were to create Windows and Macintosh embodiments of the Roseman system, it would not meet this claim limitation.” (Supp. Resp. at 7.) Patent Owner does not provide any reasoning to support this assertion. Patent Owner appears to rely on statements in the '657 specification identifying “Tellnet” and “JAVA” as exemplary embodiments of client software alternatives, but the claims are not limited to those embodiments.

Patent Owner also asserts that, instead of creating Windows or Macintosh versions of the client software, a person of ordinary skill in the art would have been motivated to use a cross-platform or platform-independent implementation. (Supp. Resp. at 7-8.) But the plain language of the claim does not exclude platform-specific client software alternatives. In fact, the specification makes clear that although a platform-independent implementation such as Java bytecode may be advantageous, the claims also cover platform-specific (platform-controlled) embodiments. ('657, 4:32-35 (“While platform controlled embodiments are within the scope of the invention, it is particularly advantageous to have a platform independent embodiment, i.e., an embodiment that is byte code compiled.”) (underlining added).)

C. “wherein both of the client software alternatives . . . allow at least some of the participator computers to form at least one group”

Patent Owner next argues that Roseman fails to disclose/suggest “wherein both of the client software alternatives . . . allow at least some of the participator

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