

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION

Petitioner

v.

WINDY CITY INNOVATIONS LLC

Patent Owner

Patent No. 8,694,657

Issue Date: April 8, 2014

Title: REAL TIME COMMUNICATIONS SYSTEM

**WINDY CITY INNOVATIONS LLC'S PRELIMINARY RESPONSE
TO PETITION FOR INTER PARTES REVIEW OF
U.S. PATENT NO. 8,694,657**

Case No. IPR2017-00606

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I. INTRODUCTION

On January 7, 2017, Microsoft Corporation (“Petitioner”) submitted a Petition (the “Petition”) to institute *inter partes* review (“IPR”) of U.S. Patent No. 8,694,657 (Ex. 1001, the “’657 Patent”), challenging dependent claims 203, 209, 215, 221, 477, 482, 487, and 492 (“the Challenged Claims”). Also on January 7, 2017, Microsoft filed a Petitioner’s Motion for Joinder to join this proceeding with IPR2016-01155 (the “Earlier IPR” or the “-01155 IPR”) on the basis that the Challenged Claims purportedly contain a single limitation which is identical to one found in claims for which trial is already instituted. Joinder Motion, Paper 3 at 1.

The Petition should be denied because the Board has already denied institution of claims containing the limitation “at least two software alternatives . . . wherein both of the client software alternatives allow at least some of the participator computers to form at least one group in which members can send communications and receive communications” in real time over the same reference asserted here, Brown. Specifically, in IPR 2016-01137 (the “-01137 IPR”), the Board denied institution of the challenged claims of U.S. Patent No. 8,473,552 (the “’552 Patent”), which is a continuation of the ’657 Patent, because the Brown reference did not disclose two client software applications that enable real-time

group member communications. IPR2016-01137, Termination Decision, Paper 8 at 9.

The Petition should also be denied because while claims with similar limitations were instituted in the Earlier IPR, the claims were never analyzed by the Board. Rather, the claims were instituted in the Board's discretion without any determination that the cited prior art discloses any of the limitations shared with the Challenged Claims.

The deficiencies of the Petition detailed herein demonstrate that Petitioner has not met its burden to demonstrate a reasonable likelihood that it would prevail in showing unpatentability of any of the Challenged Claims.

II. PETITIONER HAS NOT DEMONSTRATED A REASONABLE LIKELIHOOD OF SUCCESS FOR THE SINGLE GROUND ADVANCED IN THE PETITION AND THE PETITION SHOULD BE DENIED

A. Brown Does Not Disclose Two Client Software Alternatives that Provide Real-Time Communications

Petitioner contends that the Challenged Claims are unpatentable over Brown in view of Sociable Web because Brown allegedly discloses three examples of client applications—the “Sysop Tools” client applications, the chat application, and the BBS client applications—that allow users to form at least one group that can send and receive communications. (*See* Petition, Paper 2 at 38-39). Petitioner overlooks that the independent claims from which the Challenged Claims depend

require that these communications be real-time communications, and that Brown discloses, at most, only one client application for real-time communications.

Independent claim 189, which Petitioner asserts is representative, provides:

189. A method of communicating via an Internet network by using a computer system including a controller computer and a database which serves as a repository of tokens for other programs to access, thereby affording information to each of a plurality of participator computers which are otherwise independent of each other, the method including:

affording some of the information to a first of the participator computers via the Internet network, responsive to an authenticated first user identity;

affording some of the information to a second of the participator computers via the Internet network, responsive to an authenticated second user identity; and

determining whether the first user identity and the second user identity are able to form a group to send and to receive real-time communications; and

determining whether the first user identity is individually censored from sending data in the communications, the data presenting at least one of a pointer, video, audio, a graphic, and multimedia by determining whether a respective at least one parameter corresponding to the first user identity has been determined by an other of the user identities; and

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