UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORP.,
Petitioner,

v.

WINDY CITY INNOVATIONS LLC,
Patent Owner.

Case No. IPR2017-00606
U.S. Patent No. 8,694,657 B1

PETITIONER'S PRELIMINARY REPLY

Petitioner submits the following per the Board's March 21 Order (Paper 10). Patent Owner argues that the presently challenged claims include the limitation at issue in IPR2016-01137, where institution was denied against a related patent, and urges the Board to deny institution on the same basis. Paper 8 at 2-7. Patent Owner is incorrect. The claim language challenged here is materially broader than the language at issue in the 1137 proceeding, and encompasses the prior art.

In the 1137 proceeding, the Board denied institution after concluding that the prior art, Brown (Ex. 1012), did not disclose the following limitation:

> wherein both of the **two client software alternatives** … allow at least some of the participator computers **to form <u>at least one group</u>** in which members can send communications and receive communications from another of the members, **wherein at least some of <u>the</u> communications are received in real time** ….

IPR2016-01137, Paper 8 at 8-10 (emphasis added). The Board determined this language required that "the communications in a group pursuant to each of the client software alternatives must include real-time communications." *Id.* at 9. In other words, the Board ruled that the claim language at issue in the 1137 proceeding explicitly connected the "two client software alternatives" to the same "group" where communications are "received in real time." *See id.*

Here, there is no such connection between any claimed "two client software alternatives" and "real time" communications. Patent Owner points to certain

limitations from claims 189 and 203 (which depends on claim 189 via claim 202), but the plain language of those claims demonstrates the argument's error:

> 189. A method of communication via an Internet network … the method including: … 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**; …
>
> 202. The method of claim 189, wherein the determining whether the first user identity is censored includes determining that the first user identity is censored from the sending of the data presenting the video.
>
> 203. The method of claim 202, 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.**

IPR2017-00606, Paper 8 at 3-4 (emphasis added); Ex. 1001 at 36:51-38:26.

In the 1137 proceeding, the antecedent basis for "the communications [] received in real time" was the previously recited "group" comprising the "two client software alternatives." Here, however, claim 189 introduces a first "group" formed "to receive real-time communications," and claim 203 introduces a second "group" comprising "both of the client software alternatives" to "send communications and receive communications." The two claimed "groups" and

"communications" are introduced without any antecedent basis or other language that requires them to be connected. The basis for the Board's finding in the 1137 proceeding—the antecedent basis connecting two claim phrases—is simply not present in the claims at issue here.

Patent Owner's argument incorrectly presumes that these two claimed groups must be the same. *See* Paper 8 at 4-5 (referring to "the group"). But claims 189 and 203 introduce ***two*** separate claimed groups, neither of which includes "both client software alternatives" ***and*** requires "real time" communication. The 657 patent expressly contemplates multiple groups with different memberships, *see, e.g.*, Ex. 1001 at 2:18-24, 4:61-67, different client embodiments with distinct capabilities, *id.* at 4:32-35, 7:39-41, 8:37-38, 10:54-56, and that "various different modifications are possible and are within the true spirit of the invention," *id.* at 20:52-59. The challenged claims merely require "both client software alternatives" participate in "communications," not "*real-time* communications."

Finally, the claim language at issue here is *identical* to the language recited by claims instituted upon in IPR2016-01155. For example, claim 203 (at issue here) and 334 (at issue there) both ultimately depend on claim 189 and recite the same functionality, and Patent Owner offers no rationale rooted in the language of the claims for why review should be instituted on one but not the other.

For the foregoing reasons, the challenged claims should be cancelled.

Dated: March 29, 2017

Respectfully Submitted,

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