

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.,
Petitioner,

v.

EVERYMD LLC,
Patent Owner.

Case IPR2014-00242
Patent 8,499,047 B2

Before KRISTEN L. DROESCH, MICHAEL R. ZECHER, and
PETER P. CHEN, *Administrative Patent Judges*.

CHEN, *Administrative Patent Judge*.

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

I. INTRODUCTION

Facebook, Inc. (“Petitioner”) filed a Corrected Petition requesting an *inter partes* review of claims 1–3, 5, and 6 of U.S. Patent No. 8,499,047 B2 (Ex. 1001, “the ’047 patent”). Paper 6 (“Pet.”). EveryMD LLC (“Patent Owner”) timely filed a Patent Owner Preliminary Response. Paper 14 (“Prelim. Resp.”). In a Decision to Institute (Paper 15, “Dec. to Inst.”) issued May 21, 2014, we instituted an *inter partes* review of claims 1–3, 5, and 6 of the ’047 patent.

Patent Owner did not file a Patent Owner Response, and instead filed a Motion to Amend (Paper 21, “Mot.”). Petitioner filed an Opposition to the Motion to Amend (Paper 22, “Opp.”), and Patent Owner filed a Reply (Paper 24, “PO Reply”). We held an oral hearing on January 6, 2015, and a transcript of the oral hearing (Paper 30, “Tr.”) is included in the record.

Both Petitioner and Patent Owner presented declaration testimony in support of their respective positions. With its Petition, Petitioner provided a declaration from Edward R. Tittel (Ex. 1002, “Tittel Decl.”). With its Motion to Amend, Patent Owner provided a declaration from Frank Weyer, one of the named inventors of the ’047 patent (Ex. 1019, “Weyer Decl.”).¹ With its Opposition, Petitioner provided a second declaration from Mr. Tittel

¹ Both parties have filed their exhibits under the 1000 number range. Exhibits must be uniquely numbered sequentially in the appropriate range (1001–1999 for Petitioner, and 2001–2999 for Patent Owner). 37 C.F.R. § 42.63 (c). In this case, however, Patent Owner filed its exhibits in the range reserved for Petitioner. We exercise our discretion to waive this rule because, based on the papers filed by each party, we are able to differentiate the exhibits filed and relied upon by Petitioner from those filed and relied upon by Patent Owner. *See* 37 C.F.R. § 42.5(b).

(Ex. 1020), and with its Reply, Patent Owner provided a second declaration from Mr. Weyer (Ex. 1025).

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73, and addresses issues raised during trial.

In its Motion to Amend, Patent Owner requests cancellation of claims 1–3, 5, and 6, and substitution of those claims with proposed claims 7–11. Mot. 1. Patent Owner’s request to cancel challenged claims 1–3, 5, and 6 is granted and we need not address these claims further. Instead, we analyze proposed substitute claims 7–11 set forth in the Motion to Amend. For the reasons discussed below, we determine that Patent Owner has not met its burden of proving by a preponderance of the evidence that the proposed substitute claims are patentable. Accordingly, Patent Owner’s Motion to Amend is granted with respect to the cancellation of claims 1–3, 5, and 6, and denied with respect to the proposed substitution of claims 7–11.

A. Related Proceedings

Both Petitioner and Patent Owner state that the ’047 patent is involved in two pending cases in the United States District Court for the Central District of California: (1) *EveryMD LLC v. Facebook, Inc.* (13-cv-04202); and (2) *EveryMD LLC v. eBay Inc.* (13-cv-08017-gw). Pet. 1; Paper 8, 2.

B. The ’047 Patent

The ’047 patent, titled “Method, Apparatus and Business System for Online Communication with Online and Offline Recipients,” generally relates to online communications over a network among members of a group

of recipients. Ex. 1001, Abstract. The challenged claims of the '047 patent describe a method for facilitating e-mail communications between a sender and recipient and, in particular, modifying e-mail return addresses to route e-mails through an intermediate ("interface") server. *Id.* at 3:35–4:22.

Figure 1 of the '047 patent is reproduced below.

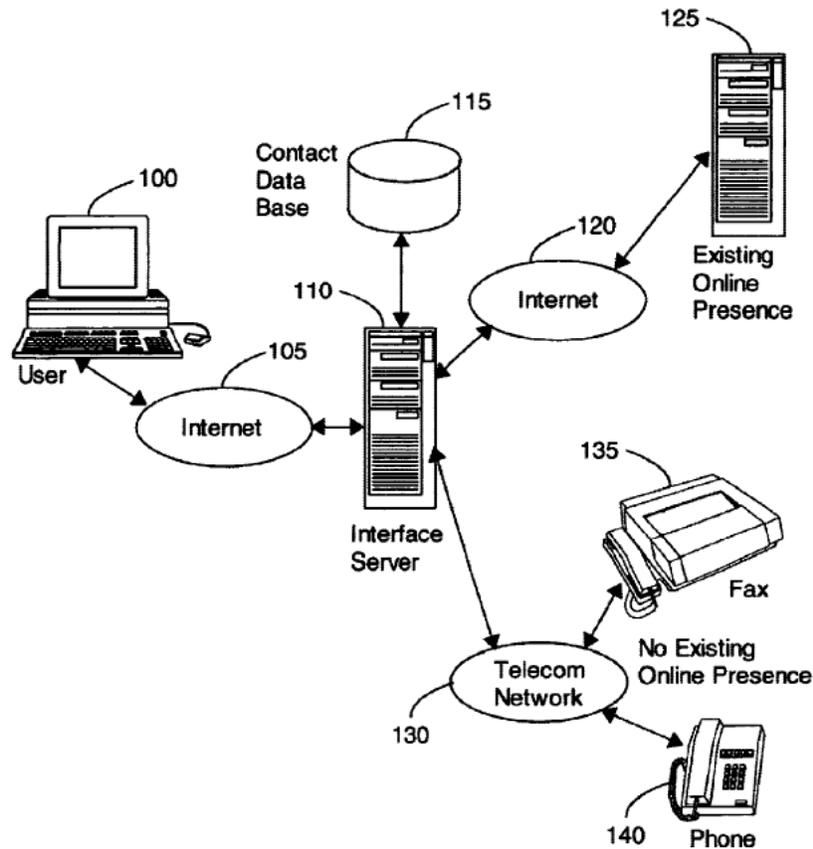


Figure 1

Figure 1 depicts user's computer 100 that communicates via Internet connection 105 with interface server 110 connected to contact database 115, which contains contact information for one or more groups of recipients. Ex. 1001, 3:35–39, 53–55. A recipient at computer 125 with an existing online presence, i.e., an existing e-mail address or website known and

accessible to interface server 110, may receive e-mail communications from the sender. *Id.* at 4:3–18.

Figure 8A of the '047 patent is reproduced below.

Figure 8A

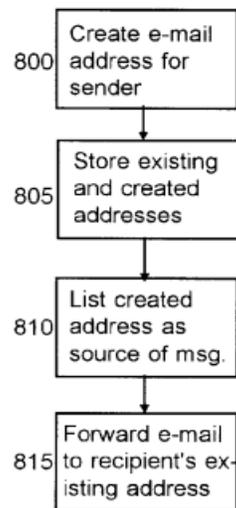


Figure 8A depicts the process of delivering e-mail messages from a sender to a recipient with an existing e-mail address. The sender composes an e-mail and selects a desired recipient. Ex. 1001, 6:67–7:2. At step 800, an e-mail address using the naming convention of the interface server is created for the sender. *Id.* at 7:8–12. At step 805, the newly created address and the sender’s existing e-mail address are stored in a contact information database. *Id.* at 7:22–30. At step 810, the sender’s created e-mail address is added to the sender’s e-mail message as the “reply to” address, and replaces any pre-existing “reply to” address. *Id.* at 7:30–35. At step 815, the e-mail is sent to the recipient’s existing e-mail address. *Id.* at 7:51–54.

Figure 8B of the '047 patent is reproduced below.

Figure 8B

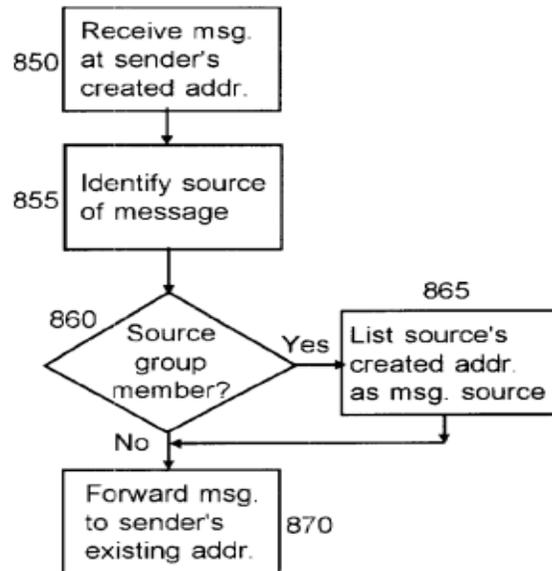


Figure 8B depicts the corresponding process of delivering a reply message from the original recipient to the original sender. At step 850, the interface server receives a reply e-mail message addressed to the sender, at an address created by the server for the original sender. Ex. 1001, 7:60–63. At steps 855 and 860, the server identifies the source of the e-mail message (the original recipient, who sent the reply) and determines whether the server previously created an e-mail address for that person. *Id.* at 7:63–8:6. If so, at step 865, the server modifies the reply message, replacing the existing address for the original recipient with the address created by the server. *Id.* at 8:7–11. At step 870, the server forwards the message to the sender at its pre-existing address. *Id.* at 8:23–29.

C. Illustrative Proposed Substitute Claim

In its Motion to Amend, Patent Owner proposes to add substitute claims 7–11. Proposed substitute claim 7 is the only independent claim. Proposed substitute claims 8–11 directly or indirectly depend from proposed substitute claim 7. Proposed substitute claim 7 is illustrative of the proposed substitute claims and is reproduced below, with bracketed subject matter indicative of subject matter deleted from challenged claim 1 and underlined subject matter indicative of subject matter added to challenged claim 1:

7. A method for providing e-mail communications between a sender and a recipient member of a group comprising a plurality of members and for providing information about said members of said group by a first computer system comprising the steps of:

- said first computer system storing information about said plurality of members in a database;
- said first computer system creating a webpage for said recipient member comprising information about said recipient member from said database;
- said first computer system creating a first created e-mail address for [a] said recipient member;
- said first computer system providing said webpage to a first sender;
- said first computer system receiving an incoming first e-mail message from a sending entity other than said first computer system comprising a first existing e-mail address of [a] said first sender addressed to said first created e-mail address of said recipient member;
- said first computer system determining that said first sender is a member of said group;
- said first computer system creating a second created e-mail address for said first sender different from said first existing e-mail address and from said first created e-mail address;

said first computer system creating a first modified e-mail message by replacing said first existing e-mail address in said incoming first e-mail message with said second created e-mail address;

said first computer system delivering said first modified e-mail message to said recipient member;

wherein said step of said first computer system delivering said first modified e-mail message to said recipient member comprises said first computer system sending said first modified e-mail message to a second existing e-mail address of said recipient member different from said first created e-mail address of said recipient member.

Mot. 1–3.

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, we interpret claim terms in unexpired patents according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). There is a “heavy presumption” that a claim term carries its ordinary and customary meaning. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002). However, a “claim term will not receive its ordinary meaning if the patentee acted as his own lexicographer and clearly set forth a definition of the disputed claim term in either the specification or prosecution history.” *Id.*

In the Decision to Institute, we determined that no explicit construction was necessary for any of the claim terms beyond their ordinary and customary meanings. Dec. to Inst. 8–9. Neither party has challenged

that determination, and based on the record adduced during trial, we see no reason to provide an express construction for any term.

For the proposed substitute claims, Patent Owner states that:

Like the terms in the original claims, all of [the newly added claim terms in the proposed substitute claims] are simple [claim terms] whose ordinary meaning applies and for which no construction is required, with the possible exception of “member” and “group.” As explained in the specification (Ex. 1) at 3:2–4, “The present invention comprises a method . . . for allowing on-line communications with members of a group of recipients for whom the invention has been implemented.” In the context of proposed independent claim [7], the claimed invention requires that “said first computer system storing information about said plurality of members in a database.” Thus, in the context of the proposed amended claims[,] a “group” is a group of a plurality of members for whom the first computer system has stored information in a database.

Mot. 7. Petitioner does not propose alternative constructions for the claim terms “member” or “group.” We cannot discern how the constructions proffered by Patent Owner add any clarity to the terms “member” and “group,” which are simple and commonly understood terms. We decline to provide an express construction for either “member” or “group.”

B. Motion to Amend

As noted above, Patent Owner did not file a Patent Owner Response to the Petition. In its Motion to Amend, Patent Owner requests that challenged claims 1–3, 5, and 6 be canceled and replaced with proposed substitute claims 7–11.” Mot. 1; *see* 35 U.S.C. § 316(d)(1); 37 C.F.R. § 42.121(a)(3) (“A motion to amend may cancel a challenged claim or propose a reasonable number of substitute claims.”). Patent Owner’s request

to cancel challenged claims 1–3, 5, and 6 is not contingent on the claims being determined to be unpatentable. Patent Owner’s request to cancel challenged claims 1–3, 5, and 6 is granted, and we need not address these claims further. Instead, we analyze proposed substitute claims 7–11 set forth in the Motion to Amend.

C. Level of Ordinary Skill in the Art

The parties agree that a person of ordinary skill in the art would have the equivalent of either a Bachelor’s degree in information technology or computer science, with two years of practical experience in computer programming and network communications, or, in the absence of such a Bachelor’s degree, four such years of experience. Ex. 1002 ¶ 14; Ex. 1019 ¶ 20. We determine that the parties’ description of the level of ordinary skill is acceptable.

D. Proposed Substitute Claims

An *inter partes* review is more adjudicatory than examinational. Unlike examination, entry of the proposed substitute claims in an *inter partes* review is not automatic. As the moving party, Patent Owner must establish that it is entitled to the requested relief. *See* 37 C.F.R. § 42.20(c). In its Motion to Amend, Patent Owner bears the burden to show, *inter alia*, that a reasonable number of substitute claims is proposed, there is no broadening of scope, the proposed claims are supported adequately by the written description of the application as filed originally, and the proposed claims are patentable over the prior art. *See* 37 C.F.R. § 42.121; *Idle Free Sys. Inc. v. Bergstrom, Inc.*, Case IPR2012-00027, slip op. at 5–6 (PTAB June 11, 2013) (Paper 26) (“*Idle Free*”). We address each of these requirements in turn.

1. Reasonable Number of Substitute Claims

A patent owner may propose a reasonable number of substitute claims for each challenged claim. 35 U.S.C. § 316(d)(1)(B). Absent special circumstances, it is presumed that only one substitute claim is needed to replace each challenged claim. 37 C.F.R. § 42.121(a)(3). This presumption may be rebutted by showing that the substitute claims are patentably distinct from each other. *Idle Free*, Paper 26, 8–9. To the extent that no patentable distinction is shown, we may deny entry of the excess claims, or group them together for purposes of considering patentability over the prior art. *See id.* In its Motion to Amend, Patent Owner proposes to add five claims 7–11 as substitutes for the five challenged claims 1–3, 5, and 6, respectively. Given this one-to-one correspondence, we determine the number of proposed substitute claims to be reasonable.

2. No Broadening of Scope

Proposed substitute claims in an *inter partes* review “may not enlarge the scope of the claims of the patent.” 35 U.S.C. § 316(d)(3); *see* 37 C.F.R. § 42.121(a)(2)(ii). In its Motion to Amend, Patent Owner proposes claim 7 as a substitute for claim 1, claim 8 as a substitute for claim 2, claim 9 as a substitute for claim 3, claim 10 as a substitute for claim 5, and claim 11 as a substitute for claim 6. Mot. 1–5. Each claim includes all of the limitations of the corresponding challenged claim for which it is a substitute, and adds additional limitations. *Id.* No limitations from the challenged claims were deleted in the proposed substitute claims. Patent Owner asserts that the proposed substitute claims do not enlarge the scope of the claims of the ’047 patent. *See* Mot. 1. Petitioner does not dispute this assertion (“patent owner’s proposed substitute claims . . . add ancillary features”). Opp. 1. We

are persuaded that each of the proposed substitute claims does not enlarge the scope of each of the challenged patent claims it intends to replace.

3. *Written Description Support*

Pursuant to 37 C.F.R. § 42.121(b), Patent Owner bears the burden in its Motion to Amend to set forth “[t]he support in the original disclosure of the patent for each claim that is added or amended,” and “[t]he support in an earlier-filed disclosure for each claim for which benefit of the filing date of the earlier filed disclosure is sought.” The test for written description support is “whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010). The purpose of the written description requirement is to convey with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991).

Petitioner argues that only proposed substitute claim 10 lacks written description support, particularly the limitation of “said first computer system forwarding said third incoming e-mail message to said recipient member without replacing said third existing e-mail address of said second sender.” Opp. 12–13. Patent Owner’s Motion to Amend contains a table stating that support for the entirety of proposed substitute claim 10 is found in the following disclosure of the ’047 patent: “[i]f it is determined at step 860 that the source of the reply message is not a member of the group, the message is forwarded to the recipient at step 870 without any changes being made to the ‘from’ and ‘reply to’ e-mail addresses listed in the e-mail.” Mot. 6 (citing

Ex. 1011, 17:9–12); *see* Ex. 1001, 8:25–29. Patent Owner makes no additional arguments for written description support as to proposed substitute claims 7–11 other than its table of citations. *See* Mot. 5–6.

Petitioner argues that the one sentence of the specification cited by Patent Owner “relates to an advanced step (860) of processing a ‘reply’ to an earlier message. . . . The newly recited ‘third incoming e-mail message’ however, has no connection to any other recited message and is not limited to a reply message.” Opp. 12–13. We agree with Petitioner that the single sentence cited by Patent Owner does not provide sufficient written description support for proposed substitute claim 10’s limitation regarding the forwarding of the third incoming e-mail message without replacing the third address of the second sender.

In addition, in this case, the Patent Owner’s mere citation in a table to various portions of the original disclosure, without any explanation why a person of ordinary skill in the art would have recognized that the inventor possessed the claimed subject matter as a whole, is inadequate to satisfy the written description requirement, not only for proposed substitute claim 10, but also for claims 7–9 and 11. *See also Nichia Corp. v. Emcore Corp.*, Case IPR2012-00005, slip op. at 4 (PTAB June 3, 2013) (Paper 27) (“However, [if] the claim language does not appear *in ipsius verbis* in the original disclosure, a mere citation to the original disclosure without any explanation as to why a person of ordinary skill in the art would have recognized that the inventor possessed the claimed subject matter as a whole may be similarly inadequate.”).

Petitioner, however, contends in its Opposition and at the oral hearing that it viewed only proposed substitute claim 10 as lacking sufficient written

description support. Opp. 12–13; Tr. 28:3–10. Accordingly, because Patent Owner has failed to demonstrate sufficient written description support only as to proposed substitute claim 10, we proceed to address the parties’ arguments on whether the proposed substitute claims are patentable over the prior art.

4. Patentability Over the Prior Art

In a motion to amend, the patent owner bears the burden to demonstrate patentability of its proposed substitute claims over the prior art, and, thus, entitlement to the claims. *Idle Free* at 7. This does not mean that the patent owner is assumed to be aware of every item of prior art known to a person of ordinary skill in the art. The patent owner, however, should explain in its motion why the proposed substitute claims are patentable over the prior art of record, as well as prior art known to the patent owner:

A patent owner should identify specifically the feature or features added to each substitute claim, as compared to the challenged claim it replaces, and come forward with technical facts and reasoning about those feature(s), including construction of new claim terms, sufficient to persuade the Board that the proposed substitute claim is patentable over the prior art of record, and over prior art not of record but known to the patent owner. The burden is not on the petitioner to show unpatentability, but on the patent owner to show patentable distinction over the prior art of record and also prior art known to the patent owner. Some representation should be made about the specific technical disclosure of the closest prior art known to the patent owner, and not just a conclusory remark that no prior art known to the patent owner renders obvious the proposed substitute claims.

Id. This includes addressing the basic knowledge and skill set possessed by a person of ordinary skill in the art even without reliance on any particular

item of prior art. *Id.* at 7–8. The petitioner then has the opportunity, in its opposition, to argue any deficiency in the patent owner’s motion and “come forward with specific evidence and reasoning, including citation and submission of any applicable prior art,” to rebut the patent owner’s position on patentability. *Id.* at 8.

We instituted an *inter partes* review of claims 1–3, 5, and 6 of the ’047 patent because Petitioner had demonstrated a reasonable likelihood of showing that these claims were rendered obvious by Bacard (Ex. 1003)², Gabber (Ex. 1004)³, and Wayner (Ex. 1009).⁴ Paper 15. Patent Owner did not file a Patent Owner Response, and we accept Petitioner’s un rebutted contention that the combination of Bacard, Gabber, and Wayner teaches or suggests all of the limitations of challenged claims 1–3, 5, and 6. In its Motion to Amend, Patent Owner states that in addition to these references, the closest “prior art of which the [Patent Owner] is aware” are a user manual for the 1990s webhosting service GeoCities, entitled, “Creating GeoCities Websites,”⁵ and U.S. Patent No. 5,796,395 to deHond.⁶ Mot. 7–8. Patent Owner provides explanations why Bacard, Gabber, Wayner, GeoCities and deHond, either alone or in combination, do not disclose,

² A. Bacard, *The Computer Privacy Handbook* (1995), ISBN #1-56609-171-3, Ex. 1003 (“Bacard”).

³ U.S. Patent No. 6,591,291 B1, issued July 8, 2003, Ex. 1004 (“Gabber”).

⁴ P. Wayner, *Disappearing Cryptography* (1996), ISBN #0-12-738671-8, Ex. 1009 (“Wayner”).

⁵ B. Sawyer and D. Greely, *Creating GeoCities Websites* (1999), Exs. 1013–17 (“GeoCities”).

⁶ U.S. Patent No. 5,796,395, issued Aug. 18, 1998, Ex. 1018 (“deHond”).

teach, or suggest the newly added limitations in proposed substitute claims 7–11. Mot. 10–15.

In its Opposition to the Motion to Amend, Petitioner first contends the proposed substitute claims would be obvious over the combination of Bacard, Gabber, Wayner, and GeoCities. *See* Opp. 2. Petitioner argues that “GeoCities was cited in [an appeal of] a reexamination of a parent [application] to the ’047 patent [Control No. 95/001,411] in which the Board found all claims in that patent anticipated by or obvious over GeoCities.” *Id.* at 2–3 (citing Ex. 1023, 70). Petitioner further states that, in appealing the outcome of the reexamination proceeding, the Patent Owner did not challenge “the Board’s finding that GeoCities renders obvious a member webpage being created by a computer system, without assistance from the member.” *Id.* at 3, fn.1. Patent Owner’s Reply, however, correctly states that the reexamination proceeding cited by Petitioner involved the parent application of the application for the ’047 patent, and consequently includes “claims different from the proposed claims,” PO Reply 1, fn.1. *See* Tr. 10:21–11:20. As a result, we are not persuaded by Petitioner’s argument that the proposed substitute claims are unpatentable over Bacard, Gabber, Wayner, and GeoCities simply by virtue of the outcome of the prior reexamination appeal before the Board involving the parent application to the ’047 patent.

Petitioner next contends that proposed claims 7–9 and 11 would be obvious over Bacard, Gabber, and Wayner, in view of the additional teachings of U.S. Patent No. 5,913,212 to Sutcliffe (Ex. 1021),⁷ a reference

⁷ U.S. Patent No. 5,913,212, issued June 5, 1999, Ex. 1021 (“Sutcliffe”).

not cited by Patent Owner. Opp. 4–11; Ex. 1020 ¶¶ 5, 17–18. Therefore, we consider whether Sutcliffe teaches or suggests the limitations added in proposed substitute claims 7–9 and 11, and whether Petitioner has presented an articulated reasoning supported by a rational underpinning for combining the teachings of Sutcliffe with those of Bacard, Gabber, and Wayner.

Bacard (Exhibit 1003)

Bacard is titled, “The Computer Privacy Handbook.” Ex. 1003, Title. Bacard discloses anonymous e-mail re-mailer systems and, in particular, the anon.penet.fi re-mailer that was based in Finland and operated by Johan Helsingius. *Id.* at 66. Bacard describes a “way to privatize your e-mail is to use an anonymous re-mailer.” *Id.* at 65.⁸ Bacard further describes the anon.penet.fi re-mailer and its Penet server, and discloses an example of responding to an e-mail from a victim of domestic abuse who wishes to remain anonymous.

Suppose you want to respond to the (fictitious) battered woman calling out for help. You can write her a message and e-mail it to <an 123@anon.penet.fi>. Helsingius’ computer will strip away your real return address (the header at the top of your e-mail), replace it with a dummy address like <an345@anon.penet.fi>, and forward your message to Victim. Also, Helsingius’ computer will notify you that <an345@anon.penet.fi> is your new anonymous address.

Ex. 1003, 66.

⁸ The page numbers in Bacard refer to the original page numbers located in either the top, right-hand corner or top, left-hand corner of each page.

Gabber (Exhibit 1004)

Gabber is titled, “*System and Method for Providing Anonymous Re-mailing and Filtering of Electronic Mail.*” Ex. 1004, Title. Gabber discloses systems for, and methods of, anonymous re-mailing and filtering of e-mail messages by generating an alias source e-mail address for a message being sent over a computer network, such as the Internet. *Id.* at 2:53–3:22. Gabber describes prior art anonymous re-mailing systems, such as the anon.penet.fi re-mailer, and discloses that bidirectional e-mailing in a re-mailing system replaces the sender’s real source address with a corresponding alias source address and re-mails the message to the intended recipient. The recipient can reply to the message, but only by using the anonymous sender’s alias source address. Upon receipt of a reply from the original recipient, the re-mailer substitutes the anonymous sender’s real source address for the alias source address and re-mails the reply to the anonymous sender. *Id.* at 1:66–2:23.

Wayner (Ex. 1009)

Wayner is a book, titled *Disappearing Cryptography -- Being and Nothingness on the Net.* Ex. 1009, Title. Wayner describes anonymous re-mailers, including the anon.penet.fi re-mailer system. *Id.* at 179–83.⁹ Wayner discloses that recipients of an e-mail can reply to the e-mail, and the anonymous re-mailer program “repackages the letter and sends it on.” *Id.* at 180.

⁹ The page numbers in Wayner refer to the original page numbers located in the top, right-hand corner or top, left-hand corner of each page.

Sutcliffe (Ex. 1021)

Sutcliffe is titled, “Personal Journal,” and discloses an online matchmaking website and, specifically, a “method for tracking personal contacts with other people over a computer network.” Ex. 1021, 1:12–13. Sutcliffe describes a Personals Online Network (“PON”) that enables users to “find activity partners, to make new friends, to make acquaintances or to find people with whom intimate relationships may be formed.” *Id.* at 1:18–25; *see id.* at Abstract, 6:22–44, 7:14–17. Each member has a personal profile that includes information such as gender, interests and user identification (or “handle”), all of which is stored in a database. *Id.* at 2:31–37, 7:40–9:44, 11:47–57. Each member also can search the database to identify others with whom the member may wish to initiate contact. *Id.* at 2:37–40, 11:58–12:12.

Members can retain information about other members with a “personal journal” that includes login-protected pages. Ex. 1021, 11:40–12:65. Personal journal web pages are created by a “Journal Generator” based on information stored in a database. *Id.* at 11:40–57, 12:21–32, 12:38–40, 12:52–55, Figs. 5, 6.

Figure 7 of Sutcliffe is reproduced below.

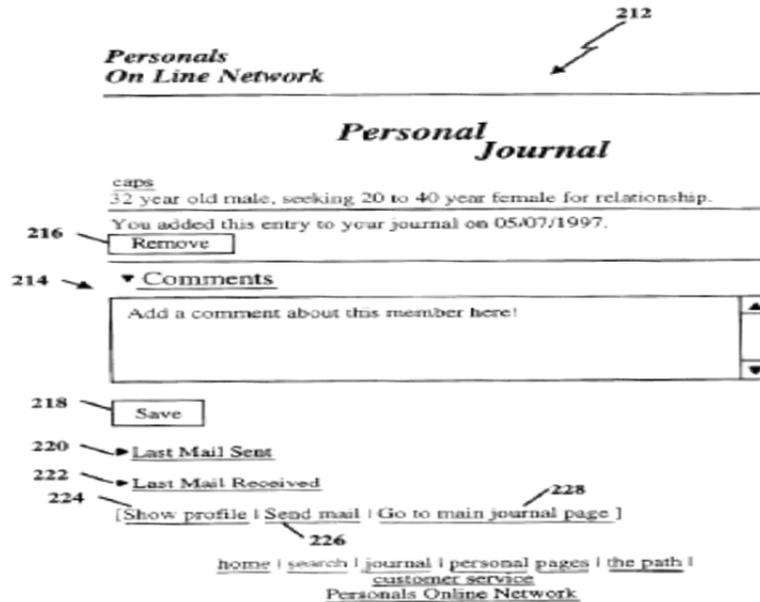


Figure 7

In Figure 7 of Sutcliffe, an exemplary web page for a member of the network named “caps” is depicted, with “Send mail” hyperlink 226 for sending email to that member. Ex. 1021, 12:58–65. A form allows a sending member to enter a message for the recipient member. *Id.* at 10:39–42, Fig. 3. In order to protect the privacy of members involved in e-mail exchanges, Sutcliffe discloses a remailer system that assigns each member an anonymous e-mail address, such as “username@anon.tpigroup.com.” *Id.* at 9:46–52. The PON system “stores the true email address of each user,” which allows the system to route all e-mail communications through the PON server and then to the recipient’s true e-mail address. *Id.* at 9:53–59, 10:42–44.

Proposed substitute claim 7

Proposed substitute independent claim 7 would replace challenged independent claim 1. Patent Owner does not attempt to rebut our preliminary determination that Petitioner presented sufficient evidence to support a finding that the combination of Bacard, Gabber, and Wayner taught or suggested all the limitations of challenged claim 1. Dec. to Inst. 9–13. We, therefore, agree with Petitioner that Patent Owner has not challenged that the limitations of proposed substitute claim 7 reproduced from challenged claim 1, are taught or suggested by the prior art references cited in the Petition – namely, the combination of Bacard, Gabber, and Wayner. Opp. 1. We adopt the preliminary determination from the Decision to Institute for purposes of this Final Written Decision.

Petitioner further argues that Sutcliffe discloses all of the added limitations in proposed substitute claim 7. *Id.* at 7–8. For the limitation, “said first computer system storing information about said plurality of members in a database,” Petitioner contends “Sutcliffe teaches a PON computer system that includes a database system that stores information about PON members.” *Id.* at 7 (citing Ex. 1021, 2:31–37, 7:40–9:44, 11:40–57, 12:21–32, Fig. 5). We agree with Petitioner that Sutcliffe’s database tables perform this storage function. *Id.*

For the limitations, “said first computer system creating a webpage for said recipient member comprising information about said recipient member from said database,” and “said first computer system providing said webpage to a first sender,” Petitioner contends:

Sutcliffe also teaches that each PON member has a “personal journal” that includes web pages—for example, the web page

for “caps” shown in Figure 7 above [citing Ex. 1021, 11:40–12:65, Figs. 6 and 7]. A member web page is created by the system’s “Journal Generator” 186 using information from the journal database 164 [citing Ex. 1021, 11:40–57, 12:21–32, Fig. 5]. . . . As noted previously, the member web page also includes a “Send mail” 226 link that allows the viewer to send a message to the member [citing Ex. 1021, 12:58–65, 10:39–42, Fig. 3 (item 160)].

Opp. 7–8. We agree with Petitioner that Sutcliffe’s disclosure teaches these added limitations. Finally, for the limitation, “said first computer system determining that said first sender is a member of said group,” Petitioner contends Sutcliffe “teaches that PON members must ‘log in’ in order to access” their personal journal pages and send and receive emails with other members. Opp. 8; Ex. 1021, 12:33–37, 12:58–65, Fig. 7; *see* Tr. 24:8–21, 25:8–22. We also agree with Petitioner that Sutcliffe’s log in functionality teaches this limitation.

Patent Owner makes two arguments in its Reply. First, Patent Owner states that Sutcliffe does not disclose a limitation that is reproduced nearly verbatim from challenged claim 1, reciting, “said first computer system receiving an incoming first e-mail message from a sending entity other than said first computer system comprising a first existing e-mail address of [a] said first sender” PO Reply 2–3. Proposed substitute claim 7 replaces “a sender” in challenged claim 1 with “said first sender.” As we explained previously, we determined that Petitioner presented sufficient evidence to support our preliminary determination that the combination of Bacard, Gabber, and Wayner taught or suggested this limitation of challenged claim 1. *See* Dec. to Inst. 9–13. Because we adopt the preliminary determination

in this regard, we address only Patent Owner's argument directed to the added "said first sender" element.

Patent Owner argues that Sutcliffe does not disclose the "said first sender," PO Reply 2–3, but its isolated focus on Sutcliffe ignores the Petitioner's asserted combination of Sutcliffe with Bacard, Gabber, and Wayner. One cannot show nonobviousness by attacking references individually. *In re Keller*, 642 F.2d 413, 425-26 (CCPA 1981). Each reference must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole. *See In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). The Petition explained how Bacard disclosed an anonymous remailer system in which an incoming first email message has a first existing email address of the sender, Pet. 27–28, and Sutcliffe, in combination with the references cited in the Petition, teach or suggest an incoming first email message with a first existing email address of a first sender in a group, who has been provided a webpage with information about a recipient member of the group. *See* Opp. 4 ("all of the features of proposed claims 7–9 and 11 are fully disclosed by Sutcliffe and [Bacard, Gabber, and Wayner]"), 7–9.

Second, Patent Owner argues that the limitation, "said first computer system determining that said first sender is a member of said group," requires the step of "determining" to occur only after the first computer system receives the incoming email message. PO Reply 3–4; Tr. 5:24–6:22, 9:13–24, 12:25–13. We agree with Petitioner that the claim language does not recite explicitly when the determination step occurs. *See* Tr. 25:1–15. To the extent Patent Owner argues for importing such a temporal restriction into the claim language from the specification (*e.g.*, Tr. 6:4–22), such

importation is improper. *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1371 (Fed. Cir. 2003) (determining that it is improper to impose a sequence of steps from a patent's specification). We, thus, agree with Petitioner that Sutcliffe teaches a log in process for a member to use the system. Opp. 8; Ex. 1021, 12:33–37.

Petitioner also contends that combining the teachings of Sutcliffe with those of Bacard, Gabber, and Wayner would have been “predictable and proper” to one of ordinary skill in the art. Opp. 6 (citing Ex. 1020 ¶¶ 19–22). Bacard, Gabber, and Wayner all describe remailer systems for anonymous emailing. *See* Dec. to Inst. 9–11. Petitioner notes that Sutcliffe expressly discloses a remailer system for use with its web-based member web pages, where “the email system provides anonymous email . . . provided by assigning to each user an anonymous email address.” Opp. 6; Ex. 1021, 9:45–59. Petitioner also states that Wayner “provides an explicit motivation to combine by explaining that ‘[t]here is also a great need for anonymous dating services on the Net.’” Opp. 6 (emphasis omitted); Ex. 1009 at 196. Patent Owner argues that interaction with and information sharing with others (as disclosed by GeoCities and DeHond, and also by Sutcliffe) is “the opposite of the purpose” of anonymous remailers. Mot. 10. We agree with Petitioner’s argument, however, that such remailers can facilitate interaction and information sharing by promoting communications where users may keep their true email addresses private. Opp. 6–7; Ex. 1009 at 180; Ex. 1020 ¶¶ 19–20. Accordingly, we agree with Petitioner’s rationale for combining the teachings of Sutcliffe with those of Bacard, Gabber, and Wayner, and conclude that Patent Owner’s Motion to Amend

fails to demonstrate the patentability of proposed substitute claim 7 over the prior art.

Proposed Substitute Claim 8

Proposed substitute claim 8 would replace challenged claim 2, depends from proposed substitute claim 7, and adds a limitation that “the first created e-mail address for said recipient member comprises a name of said recipient member.” Mot. 3. Petitioner contends Sutcliffe discloses that each user is assigned an email address that “may consist of the user’s user identification name.” Opp. 8–9 (emphasis omitted); Ex. 1021, 9:50–59. In its Reply to the Opposition, Patent Owner makes no specific patentability arguments regarding proposed substitute claim 8. *See* PO Reply 4. We agree that Sutcliffe discloses the added limitation regarding the name of the recipient member, and conclude that Patent Owner’s Motion to Amend fails to demonstrate the patentability of proposed substitute claim 8 over the prior art.

Proposed Substitute Claim 9

Proposed substitute claim 9 would replace challenged claim 3, depends from proposed substitute claim 7, and adds a limitation for “a control for activating a user interface for sending a message to said recipient member.” Mot. 3. Petitioner contends that the “send mail” hyperlink 226 in Figure 7 of Sutcliffe discloses the claimed “control.” Opp. 9–10. Proposed substitute claim 9 also adds a limitation that the recipient web page is “created by said first computer system without assistance from said recipient member.” Mot. 3. Petitioner contends that Sutcliffe teaches that the member web pages are generated by the “Journal Generator” of the PON system, rather than by the member. Opp. 10; Ex. 1021, 11:40–57, 12:21–32,

12: 52–65; Ex. 1020, ¶ 40.¹⁰ Patent Owner argues that Petitioner’s contention is not supported specifically by the testimony of Petitioner’s expert, Mr. Tittel. PO Reply 4. We disagree, as the Tittel declaration states, “[t]his limitation is also disclosed by Sutcliffe, which teaches that the member web pages are generated by the PON system.” Ex. 1020, ¶ 40. We agree with Petitioner that Sutcliffe discloses these added limitations, and conclude that Patent Owner’s Motion to Amend fails to demonstrate the patentability of proposed substitute claim 9 over the prior art.

Proposed Substitute Claim 11

Proposed substitute claim 11 would replace challenged claim 6, depends from proposed substitute claim 9, and adds limitations related to sending an email from the user interface recited in proposed substitute claim 9. Mot. 5. Petitioner’s Opposition and the second declaration of Mr. Tittel explain how Sutcliffe discloses the additional limitations in proposed substitute claim 11. Opp. 10–11; Ex. 1020, ¶¶ 38–42. Patent Owner argues only that proposed substitute claim 11, like proposed substitute claim 9, includes a limitation for the webpage being created “without assistance from said user member.” PO Reply 4. That limitation, however, appears only in proposed substitute claim 9, and does not appear in proposed substitute claim 11. *See* Mot. 5. We conclude that Patent Owner’s Motion to Amend

¹⁰ At the oral hearing, Petitioner’s counsel appeared to state that Sutcliffe did not disclose explicitly this limitation, and argued the recited creation of the webpage without member assistance would be obvious to one of ordinary skill in the art. Tr. 28:11–30:2. We rely only on the arguments made in Petitioner’s Opposition and supported by the accompanying second declaration of Mr. Tittel (Ex. 1020).

fails to demonstrate the patentability of proposed substitute claim 11 over the prior art.

Proposed Substitute Claim 10

Proposed substitute claim 10 would replace challenged claim 5 and depends from proposed substitute claim 7. As explained previously, Patent Owner has not met its burden to show sufficient written description support for the added limitation of “said first computer system forwarding said third incoming e-mail message to said recipient member without replacing said third existing e-mail address of said second sender.” *See supra* Section II. D. 3. Consequently, while Patent Owner asserts that “the added limitations of claim 10 are not disclosed in any of the prior art,”¹¹ we need not and, therefore, do not address in detail whether Patent Owner’s Motion to Amend demonstrates the patentability of proposed substitute claim 10 over the prior art.

5. Patent Eligible Subject Matter

Petitioner also argued in its Opposition that the proposed substitute claims fail to recite patent eligible subject matter under 35 U.S.C. § 101, citing *Alice Corp. Pty. Ltd. v. CLS Bank International*, 134 S. Ct. 2347 (2014). Opp. 14–15. In its Reply, Patent Owner argues the merits of why its proposed substitute claims comprise patentable subject matter. PO Reply 5; *see* Tr. 15:10–17:9. Because Patent Owner has not met its burden of demonstrating sufficient written description support for proposed substitute claim 10, or its burden of proving by a preponderance of the evidence that

¹¹ PO Reply 4; *cf.* Opp. 11–14 (explaining why Patent Owner’s Motion to Amend fails to demonstrate the patentability of proposed substitute claim 10 over the prior art).

proposed substitute claims 7–9 and 11 are patentable over the prior art of record, we need not and, therefore, do not reach the merits of Petitioner’s § 101 argument.

III. CONCLUSION

Patent Owner has not demonstrated by a preponderance of the evidence that proposed substitute claims 7–11 are patentable. Therefore, we grant Patent Owner’s Motion to Amend solely as to its non-contingent request to cancel challenged claims 1–3, 5, and 6 of the ’047 patent, and deny the Motion to Amend as to the proposed substitution of claims 7–11.

IV. ORDER

Accordingly, it is

ORDERED that Patent Owner’s Motion to Amend is *granted* as to its request to cancel claims 1–3, 5, and 6 of the ’047 patent; and

FURTHER ORDERED that Patent Owner’s Motion to Amend is *denied* as to its request to add proposed substitute claims 7–11.

Because this is a final decision, the parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2014-00242
Patent 8,499,047 B2

PETITIONER:

Heidi L. Keefe
Mark R. Weinstein
COOLEY LLP
hkeefe@cooley.com
mweinstein@cooley.com
zpatdcdocting@cooley.com

PATENT OWNER:

Frank Michael Weyer
TECHCOASTLAW
fweyer@techcoastlaw.com