

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.,
Petitioner,

v.

BRUCE ZAK,
Patent Owner.

Case IPR2017-00002
Case IPR2017-00003
Patent 9,141,720 B2

Before KALYAN K. DESHPANDE, TREVOR M. JEFFERSON, and
JOHN F. HORVATH, *Administrative Patent Judges*.

Opinion of the Board filed by Administrative Patent Judge DESHPANDE.

Opinion Dissenting filed by Administrative Patent Judge HORVATH.

DECISION
Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Facebook, Inc. (“Petitioner”) filed requests for rehearing in IPR2017-00002 (Paper 9, “002 Req. Reh’g”¹) and IPR2017-00003 (Paper 9, “003 Req. Reh’g”) of the Board’s decision in IPR2017-00002 (002 Paper 8, “002 Dec.”) and IPR2017-00003 (003 Paper 8, “003 Dec.”) dated April 4, 2017, which together denied institution of *inter partes* review of claims 1–31 of U.S. Patent No. 9,141,720 B2 (Ex. 1001, “the ’720 patent”). Petitioner contends that we “overlooked critical portions of the Petition and misapplied its constructions of the terms ‘link’ and ‘configurable link’” and “application link.” 002 Req. Reh’g 1; 003 Req. Reh’g 1. For the reasons stated below, Petitioner’s requests are denied.

II. STANDARD OF REVIEW

Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” An abuse of discretion occurs when a “decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus., Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988). The request must identify, specifically, all matters the party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d).

¹ IPR2017-00002 and IPR2017-00003 include papers and exhibits that are substantially similar; therefore, unless otherwise indicated, citations to papers and exhibits are made to IPR2017-00002. Papers and Exhibits that are preceded by “002” are from IPR2017-00002, and papers and exhibits that are preceded by “003” are from IPR2017-00003.

III. DISCUSSION

We determined in our Decision Denying Institution that “Petitioner has failed to demonstrate that Boyce teaches or suggests ‘generat[ing] at least one configurable link that points to at least one of the configurable applications’” and “Petitioner has failed to demonstrate that Boyce teaches or suggests ‘at least one application link . . . that points to at least one of the plurality of configurable applications so as to enable the users to selectively activate the configurable application to which the application link points.’” 002 Dec. 19; 003 Dec. 19.

Petitioner argues that the “Board’s analysis and conclusion erred by overlooking the Petitioner’s obviousness analyses and misapplying its construction of the terms ‘link’ and ‘configurable [and application] link.’” 002 Req. Reh’g 6; 0003 Req. Reh’g 6. Petitioner specifically argues that (1) “the Board’s conclusion that it would not have been obvious to incorporate delegation functionality into Outlook Web Access as described by Boyce was clearly erroneous,” and (2) “the Board erred when it found that Petitioner had not established that the ‘clickable icons’ of Boyce are not configurable or modifiable based on ‘delegation’ functionality.” Req. Reh’g 6–15. For the reasons discussed below, we are not persuaded by Petitioner’s arguments.

1. Incorporation of Delegation Functionality in to Outlook Web Access

Petitioner asserts that “the Board rejected Petitioner’s assertion that it would have been obvious to combine features of a desktop-based embodiment and a web-based embodiment (‘OWA’) disclosed in the Boyce reference,” and argues that “[t]he Decision offers no rationale for this finding, and Petitioner respectfully submits that the Board erred.” 002 Req. Reh’g 6–7; 003 Req. Reh’g 7. Petitioner

argues that the “Federal Circuit has repeatedly stated that combining embodiments in a prior art reference ‘does not require a leap of inventiveness.’” Req. Reh’g 7 (citing *Boston Sci. Scimed, Inc. v. Cordis Corp.*, 554 F.3d 982, 991 (Fed. Cir. 2009); *Paice LLC v. Ford Motor Co.*, No. 2016-1412, 2017 WL 900062, at *8 (Fed. Cir. Mar. 7, 2017)). Petitioner argues that “combining delegation and OWA from the Boyce reference similarly would not have required a leap of inventiveness.” *Id.*

We are not persuaded by Petitioner’s argument. Petitioner’s Request for Rehearing must identify, specifically, all matters the party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d). Petitioner’s argument that the combination of different embodiments of Boyce “does not require a leap of inventiveness” is not presented in the Petition. Petitioner does not provide any citation to the Petition for this argument in its Request for Rehearing. Accordingly, we could not have misapprehended or overlooked this argument in the Petition because Petitioner presents it for the first time in its Request for Rehearing.

Petitioner further argues that the Petition “explained at length why it would have been obvious to a person of ordinary skill in the art to combine delegation functionality from the desktop-based embodiment with OWA.” Req. Reh’g 8–9 (citing Paper 1 (“Pet.”), 44–45). Pages 44 and 45 of the Petition discuss the limitation of “generat[ing] an administrator portal through which users of the system are permitted to act in the role of an administrator of certain web pages,” and assert that the delegation interface allows a user to act as an administrator of certain pages. Pet. 40–46.

We are not persuaded by this argument. First, the Petition does not discuss the combination of the delegation functionality with OWA in order to “generate at least one configurable link that points to at least one of the configurable applications.” Rather, pages 44 and 45 of the Petition discuss an entirely different limitation. The Petition’s discussion of the limitation “generat[ing] at least one configurable link that points to at least one of the configurable applications” does not include this discussion, nor does it reference the discussion on pages 44 and 45 of the Petition, and discuss its application to the limitation of “generat[ing] at least one configurable link that points to at least one of the configurable applications.” It is not the Board’s burden to mix and match Petitioner’s arguments in order to unearth a cogent analysis of each of the challenged claim limitations. Rather, it is the Petitioner’s burden under 35 U.S.C. § 314(a) to demonstrate a reasonable likelihood it will prevail.

Furthermore, even if we were to consider it our burden to mix and match Petitioner’s arguments in order to fill in gaps in Petitioner’s analysis, Petitioner’s analysis is still deficient in demonstrating that the desktop “clickable icons” represented in Figure 36-23 of Boyce, are configurable based on the delegation functionality.² Rather, “we are left speculating as to what the user will see, and

² We specifically note that pages 44 and 45 of the Petition provides several arguments that are not supported by the evidence. For example, the Petition asserts that “Boyce discloses express motivations for having delegation functionality in OWA,” and cites a passage that discusses providing access to mailboxes to roaming users. Pet. 45 (citing Ex. 1003, 872). However, merely providing access to a user’s mailbox through OWA does not support Petitioner’s position that Boyce expresses a motivation to provide a user with delegation functionality.

Similarly, Petitioner’s arguments in its Request for Rehearing are not supported by evidence. For example, Petitioner asserts that “it would have been obvious to

whether the user will see ‘clickable icons’ that are selectively displayed based on their configuration.” Dec. 20. That is, Petitioner has not established a reasonable likelihood it will prevail in showing that the multiple embodiments of Boyce teach or suggest “generat[ing] at least one configurable link that points to at least one of the configurable applications.” It is the link itself that needs to be configurable, not the result of selecting the link or the rendered information after selection of the link.

2. The “clickable icons” of Boyce are not configurable or modifiable based on “delegation” functionality

We found in our Decision Denying Institution that

[W]e are left speculating as to what the user will see, and whether the user will see “clickable icons” that are selectively displayed based on their configuration. *See* Prelim. Resp. 22. Although Boyce discloses that the folders shown in Figure 36-21 represent “configurable applications,” Petitioner has not established a reasonable likelihood that the “clickable icons” or folders are “configuration links” that are configurable or modifiable based on the “delegation” functionality. Figure 36-21 of Boyce demonstrates that “configurable applications” are represented by folders, but Petitioner does not provide persuasive evidence to show that the “clickable icons” or links pointing to the folders can be modified or configured based on some “delegation” authority. As such, on this record, we are not persuaded that Petitioner has demonstrated a reasonable likelihood in showing that

check the delegation rights of the accessing user before presenting the OWA pages.” Req. Reh’g 8 (citing Pet. 10, 44–45). However, neither in the Petition nor in its Request for Rehearing does Petitioner provide any evidence to support this determination of obviousness.

Accordingly, such arguments are merely attorney arguments not based on the evidence, and, therefore, are not persuasive.

Boyce’s “delegation” functionality meets the claimed “configurable link.”

Dec. 20.

Petitioner argues that “[t]he Board identifies no disclosure or suggestion in Boyce that a user with access permission but who is not the mailbox owner will *not* be presented with OWA pages having a left pane of clickable icons and a right pane of folder content for a particular mailbox being accessed.” Req. Reh’g 10. We are not persuaded by this argument. As discussed above, it is Petitioner’s burden under 35 U.S.C. § 314(a) to demonstrate a reasonable likelihood it will prevail. We had determined that Petitioner had not met this burden. Dec. 20–21. Petitioner’s argument that the Board has failed to prove certain facts improperly shifts the burden to the Board to demonstrate that Petitioner’s challenges and arguments are false. Accordingly, we are not persuaded that we overlooked or misapprehended the law.

Petitioner further argues that the “only reasonable reading of Boyce is that any user who has permission to access a particular mailbox will see OWA web pages similar to those shown in Figures 36-1 and 36-23 of Boyce when accessing the mailbox’s URL.” Req. Reh’g 10. We are not persuaded by this argument. Figures 36-21 and 36-23 illustrate the “clickable icons” in OWA. Pet. 51, 53. Neither Figure 36-21 nor 36-23 illustrate “clickable icons” that have been delegated to a user. Petitioner does not provide any evidence illustrating a delegated folder in Boyce’s desktop. Petitioner’s assertion that the “only reasonable reading” of Boyce is according to Petitioner’s argument is not persuasive because Petitioner does not support such an allegation with evidence. Accordingly, as we had determined, “we are left speculating as to what the user

will see, and whether the user will see ‘clickable icons’ that are selectively displayed based on their configuration.”

Petitioner additionally argues that the Board determined that “Petitioner does not provide persuasive evidence to show that the ‘clickable icons’ or links pointing to the folders can be modified or configured.” Req. Reh’g 11 (citing Dec. 20). Accordingly, Petitioner argues that the Board erred if (1) “the Board separated the visual icon from its underlying functionality” and (2) the Board “drew a distinction between a displayed linking mechanism (such as the icon in Boyce) and an underlying link functionality.” Req. Reh’g 12–13. Petitioner argues that both acts would be contrary to the Board’s construction of the term “link.” *Id.* We are not persuaded by Petitioner’s argument. As discussed above, we determined that Petitioner failed to demonstrate that Boyce discloses “‘clickable icons’ that are selectively displayed based on their configuration.” Dec. 20. That is, we determined that Petitioner fails to demonstrate that Boyce discloses “configurable links” or “application links.”

3. The “clickable icons” of Boyce are not “configurable links”

Petitioner asserts that it demonstrated that a link is configurable by “(1) controlling the circumstances under which a clickable icon was presented to a user; and (2) visually modifying a clickable icon in accordance with a user’s access permissions.” Req. Reh’g 13. Petitioner argues that the “Decision does not provide a clear explanation as to why this was insufficient to show the claimed ‘configurable’ link.” *Id.* at 14. Petitioner argues that “visually modifying the clickable icons of an OWA page in accordance with the accessing user’s permissions would have been obvious in view of Parker.” *Id.* at 15.

We are not persuaded by Petitioner’s argument. Petitioner has not identified any evidence or argument that we overlooked or misapprehended. Rather, we explained that Figures 36-21 and 36-23 illustrate, for example, a “clickable icon” for “Options,” but Petitioner has failed to provide any evidence that the “clickable icon” for the “Options” application can be configured. Dec. 20–21. That is, there is no evidence on record that demonstrates that (1) the “Options” icon, under certain circumstances, is not presented to the user and (2) the “Options” icon may be visually modified based on the user’s access permissions. Accordingly, we determined that we were not persuaded that Petitioner has demonstrated a reasonable likelihood it will prevail in showing that Boyce discloses “configurable link” or “application link.” *Id.* at 21; 003 Dec. 21.

IV. CONCLUSION

The Board denies the relief requested in the request for rehearing.

V. ORDER

Accordingly, it is hereby

ORDERED that Petitioner’s request for rehearing is *denied*.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.,
Petitioner,

v.

BRUCE ZAK,
Patent Owner.

Case IPR2017-00002
Case IPR2017-00003
Patent 9,141,720 B2

HORVATH, *Administrative Patent Judge, dissenting.*

I respectfully dissent from the majority's decision to deny Petitioner's Requests for Rehearing of the Decisions denying institution in IPR2017-00002 and IPR2017-00003, and would grant Petitioner's Requests to reconsider the Decisions issued in both cases.³

³ As noted by the majority, the papers and exhibits filed in IPR2017-00002 and IPR2017-00003 are substantially similar. Petitioner's Requests for Rehearing in the two cases are likewise substantially similar. Accordingly, all citations to papers and exhibits are to the papers and exhibits filed in IPR2017-00002, and all citations to Petitioner's Request for Rehearing are to the Request filed in IPR2017-00002. A similar analysis, however, equally applies to IPR2017-00003.

For the reasons explained below, I find Petitioner's Requests for Rehearing demonstrates how the Board clearly erred in finding Petitioner had failed to reasonably demonstrate: (1) Boyce's "delegation" functionality is included in Outlook Web Access ("OWA"), and (2) Boyce's "delegation" functionality results in OWA generating "configurable links" as recited in claim 7 of the '720 patent and "application links" as recited in claim 11 of the '720 patent.

1. Whether OWA includes "delegation" functionality

Petitioner argues the Board clearly erred by failing to consider the Petition's lengthy explanation, supported by the testimony of Mr. Klausner, that it would have been obvious to a person of ordinary skill in the art to include Outlook's delegation functionality in OWA. Req. Reh'g 8–9 (citing Pet. 44–45). I agree.

The Petition demonstrated that Boyce discloses a user can "access a mailbox *you don't own* but for which you have access permission." Pet. 44 (quoting Boyce, 878) (emphasis added). Relying on the testimony of Mr. Klausner, Petitioner argued this disclosure "refers to a delegate, who is a person who can access a mailbox that they do not own." *Id.* (citing Klausner ¶ 61). I agree, and find this section of the Petition, alone, which the Board failed to consider in its Decision denying institution, clearly discloses the actual incorporation of Outlook "delegation" functionality in OWA.

Moreover, in the Petition, Petitioner argued that to the extent Boyce does not expressly disclose incorporating "delegation" authority in OWA, a person of ordinary skill in the art would have found it obvious to do so because the rules applicable to delegate access "should apply regardless of the manner of access of the mailbox," that is, "the rules of delegate access should be consistently enforced regardless of whether a user's mailbox is accessed through a client application or

through OWA.” Pet. 44 (citing Klausner ¶ 116). Petitioner argued it would have been obvious to include the “delegation” functionality of Outlook in OWA because doing so “would have involved the combination of existing elements according to their established functionality with the predictable result of a user’s delegates being able to access the user’s mailbox, in accordance with the restrictions established by the mailbox owner.” *Id.* at 45. Thus, to the extent OWA does not expressly disclose including “delegation” functionality, Petitioner has reasonably demonstrated that it would have been obvious to a person of ordinary skill in the art to modify OWA to include such functionality. I, therefore, agree with Petitioner that the Board clearly erred in issuing its Decisions denying institution by failing to consider and give weight to the arguments and evidence cited in the Petition regarding the obviousness of incorporating Outlook’s “delegation” functionality in OWA.

The majority indicates it is not persuaded by Petitioner’s arguments because “[p]ages 44 and 45 of the Petition discuss the limitation of “generat[ing] an administrator portal,” which is an entirely different limitation from the limitation of “generat[ing] at least one configurable link” that the Decision denying institution found Petitioner had failed to demonstrate. Maj. Op. 5. The majority finds the Petition’s discussion of the “generat[ing] at least one configurable link” limitation fails to reference the discussion on pages 44 and 45, and fails to demonstrate how that discussion applies to the “generat[ing] at least one configurable link” limitation. *Id.* I respectfully disagree.

In discussing the “generat[ing] at least one configurable link” limitation, the Petition explicitly states: “As explained above for claim 7[a][2], Boyce discloses and makes obvious that delegation functionality is incorporated into OWA.” Pet.

52; *see also* Pet. 50–58. The Petition’s reference to claim 7[a][2] is a reference to the “generat[ing] an administrator portal” limitation, discussed on pages 40–46 of the Petition. Thus, in discussing the “generat[ing] at least one configurable link” limitation, the Petition relied on and cited to the same evidence to demonstrate the obviousness of including “delegation” functionality in OWA that the Petition relied on in discussing the “generat[ing] an administrator portal” limitation. *Id.* at 52. Thus, I find Petitioner had reasonably demonstrated the obviousness of incorporating the “delegation” functionality of Outlook in OWA, and the Board clearly erred in finding it had not.

2. *Whether Boyce’s “clickable icons” are “configurable links” based on OWA “delegation” functionality*

Petitioner argues the Board clearly erred in finding Petitioner had not demonstrated the “clickable icons” of Boyce are “configurable links” because they can be modified based on the “delegation” functionality of OWA. Req. Reh’g 10–15. In particular, Petitioner argues:

[T]he Petition explained that the clickable folder icon is “configurable” in at least two ways: (1) controlling the circumstances under which a clickable icon was presented to a user; and (2) visually modifying a clickable icon in accordance with a user’s access permissions. Because the configurability is performed by the mailbox owner as permitted by the OWA software, the clickable folder icon qualifies as a “configurable link.”

Req. Reh’g 13 (internal citations omitted) (citing Pet. 52–58.). Petitioner argues “the Petition explained that accessing a mailbox via OWA, *whether by the mailbox owner or a delegate*, will result in a display such as the ones shown in Figures 36-1 and 36-23 of Boyce.” Req. Reh’g 10 (citing Pet. 50–51) (emphasis added).

Petitioner further argues the Petition demonstrated that “visually modifying the clickable icons of an OWA page in accordance with the accessing user’s permissions would have been obvious in view of Parker.” Req. Reh’g 11 (citing (Pet. 54–58.)). I agree.

Having agreed with Petitioner’s argument that the Petition reasonably demonstrated OWA either expressly incorporates “delegation” functionality or that it would have been obvious to modify it to do so, I agree with Petitioner that the Petition reasonably demonstrates the “clickable links” of Boyce’s OWA mailbox (e.g., links to an owner’s Inbox, Contacts, or Calendar) are configurable by the owner to allow a delegate to see or not see the links when the delegate accesses the owner’s mailbox, or to see modified versions of the links.

The Petition reasonably demonstrates that when a user clicks on a link in the mailbox displayed by OWA (e.g., a link to an Inbox, Calendar, or Contacts application), OWA displays the contents of the corresponding application. Pet. 50–52 (citing Boyce 896–897, Fig. 36-23; Klausner ¶¶ 130–131). Petitioner also reasonably demonstrates that these mailbox links are configurable by the mailbox owner because “their display to a delegate depends on the delegate’s privileges, which are configurable by the mailbox owner.” *Id.* at 52. For example, the Petition demonstrated that the mailbox links point to folders stored on an exchange server, and the owner can grant or withhold “folder visible” privileges to allow the delegate to see or prohibit the delegate from seeing the corresponding folders. *Id.* at 53–54 (citing Boyce 684, 687–688, 894–895, Fig. 36-21; Klausner ¶¶ 133–134). Thus, for example, a delegate viewing an owner’s mailbox for which “folder visible” privileges were not granted to see the owner’s calendar, would not see the corresponding link in OWA to the owner’s calendar folder on the exchange server.

Finally, the Petition demonstrated that, to the extent Figures 36-21 and 36-23 of Boyce do not visually indicate that an owner had configured the mailbox links to grant or deny privileges to a delegate viewing the owner's mailbox, providing such visual indicators would have been obvious in view of the teachings of Parker, which discloses visually displaying the permissions granted to a user to access and edit shared folders. Pet. 54–56 (citing Parker 2:24–26, 11:32–35, 11:40–49, Fig. 7). Such permissions can be visually indicated using icons such as an 'eye glass' to show read privileges, a 'lock and key' to indicate a lack of privileges, and a 'writing instrument' to indicate write privileges. *Id.* at 56 (citing Parker 11:60–64). The Petition, therefore, reasonably demonstrated that combining the teachings of Boyce and Parker would have allowed Boyce's OWA mailbox icons (i.e., links to Inbox, Calendar, and Contacts applications) to be visually adapted to display different "clickable icons for each delegate, based on the permissions granted to the delegate." *Id.* at 56; *see also* Klausner ¶¶ 139–141. Thus, for example, a delegate denied access privileges to an owner's Calendar application would see a link to the owner's calendar when accessing the owner's mailbox through OWA, but the link would have been modified to include a "lock and key" to indicate the delegate had not been granted privileges to access the owner's calendar.

3. Conclusion

For the reasons expressed above, I find Petitioner has shown the Board clearly erred in its Decision denying institution in IPR2017-0002 ("the '002 Dec.") by failing to consider the evidence and argument presented in the Petition that shows Petitioner had reasonably demonstrated the combination of Boyce and Parker teaches the "generat[ing] at least one configurable link" limitation recited in claim 7. *See* '002 Dec. 16–21. For the same reasons, I find Petitioner has shown

Case IPR2017-00002
Case IPR2017-00003
Patent 9,141,720 B2

the Board clearly erred in its Decision denying institution in IPR2017-0003 (“the ’003 Dec.”) by failing to consider the evidence and argument presented in the Petition that shows Petitioner had reasonably demonstrated the combination of Boyce and Parker teaches the “at least one application link” limitation recited in claim 11. *See* ’003 Dec. 16–21.

Accordingly, I would grant Petitioner’s Requests for Rehearing, and reconsider the Decisions denying institution in both IPR2017-00002 and IPR2017-00003.

Case IPR2017-00002
Case IPR2017-00003
Patent 9,141,720 B2

For PETITIONER:

Heidi Keefe
Phillip Morton
Andrew Mace
COOLEY LLP
hkeefe@cooley.com
pmorton@cooley.com
amace@cooley.com

For PATENT OWNER:

Glenn Forbis
David Utykanski
Matthew Cutler
James Luchsinger
HARNESS, DICKEY & PIERCE, P.L.C.
gforbis@hdp.com
davidu@hdp.com
mcutler@hdp.com
bluchsinger@hdp.com