

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.
Petitioner

v.

BRUCE ZAK
Patent Owner

Case IPR2017-00003
Patent 9,141,720 B2

PETITIONER'S REQUEST FOR REHEARING
(37 C.F.R. § 42.71(d))

I. INTRODUCTION

Petitioner Facebook, Inc. (“Petitioner”) respectfully submits this request for rehearing under 37 C.F.R. § 42.71(d) of the April 4, 2017 Decision denying institution of *inter partes* review (IPR). (Paper 8.) As explained in detail below, it appears that the Board overlooked critical portions of the Petition and misapplied its constructions of the terms “link” and “application link.”

II. ARGUMENT

A. The Petition demonstrated that Boyce and Parker render obvious the claimed “application link”

The Decision focuses solely on whether Boyce and Parker disclose an “application link” recited in independent claim 11. (Decision at 21.) Petitioner respectfully submits that the Petition presented a reasonable likelihood that Boyce and Parker render the “application link” obvious.

The Petition explained that the “link” in the claims of the ’720 patent is disclosed by Boyce’s description of a clickable folder icon and associated functionality in Outlook Web Access (“OWA”) that a user clicks in order to access corresponding content of the folder. (Petition at 11, 37-38.) For example, Boyce provides the figure below from OWA and explains that “[t]o manage your schedule, click the Calendar icon on the Outlook Bar. OWA updates the right pane to display your Calendar folder.” (*Id.* at 37-38 (quoting Boyce, p.897).)

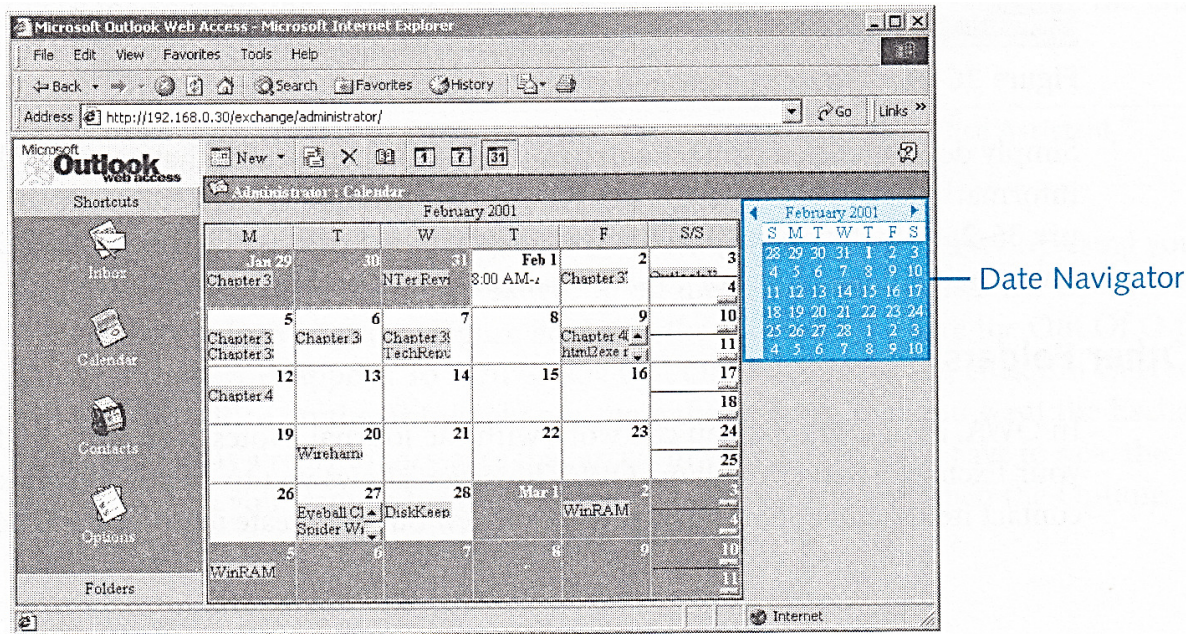


Figure 36-23. You can view and modify your schedule in OWA.

(*Id.* at 37.)

The Petition further explained that it would have been obvious that the clickable folder icon and its associated functionality is a link that “can be modified or configured.” (Petition at 22-23, 38-46.) The Petition explained that the clickable folder icons were 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. (*Id.* at 38-46.)

In particular, the Petition explained that Boyce describes a “delegation” feature in which a user may control which other users may access the user’s mailbox. (*E.g., id.* at 11-13.) The Petition explained that delegation allows a user to specify access permissions (such as read-only, editor, and folder visible) for other users to

access the folders of the user's mailbox. (*Id.* at 11-13.) The Petition further discussed how Boyce explains that, using OWA, a user who has been given access to another user's mailbox can access that other user's mailbox by including that user's account name in the URL, which Boyce calls "explicit logon." (*Id.* at 22 ("[e]xplicit logon is useful when you need to access a mailbox you don't own but for which you have access permission.' (Boyce, e.g., p.878.)"), 10-11 ("[C]lients add their account name [to the URL], such as *http://mail.proseware.tld/jboyce.*") (citing Boyce, p.878) (underlining added).) Thus, for example, a user other than "jboyce" who has permission to access the mailbox of "jboyce" can access that mailbox using OWA by navigating to the URL *http://192.168.0.30/exchange/jboyce/*, which is shown in the figure below:

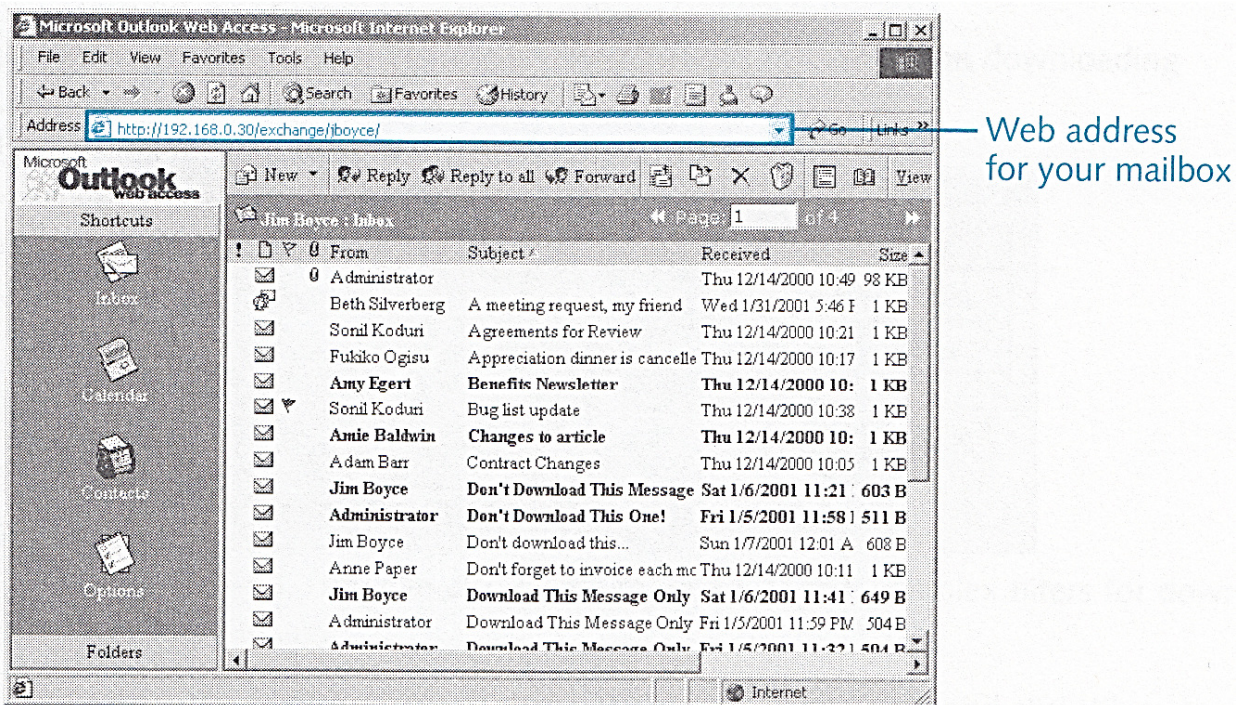


Figure 36-1. Using OWA, you can access your Inbox through a Web browser.

(*E.g., id.* at 10 (citing Boyce, p.872).)

While the Petition acknowledged that Boyce does not explicitly tie the ability to access another user's mailbox via OWA to delegation functionality, the Petition explained at length that it would have been obvious to use delegation access controls to control OWA mailbox access by another user:

Although Boyce does not appear to expressly state that the “delegate” functionality is incorporated into OWA, it would have been obvious to a person of ordinary skill in the art that the rules applicable to delegates should apply regardless of the manner of access of the mailbox. (Klausner ¶116.) A person of ordinary skill in the art would have understood that the rules governing access for delegates should be consistently enforced regardless of whether a user's mailbox is accessed through a client application or through OWA. Boyce explains that the ability to access another user's mailbox was already present in OWA. Providing that ability in accordance with delegation information 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. Moreover, Boyce discloses express motivations for having delegation functionality in OWA. Boyce explains that OWA “is useful for roaming users who want to access the most common mailbox features when they don't have access to their personal Outlook installation.” (Boyce, p.872.) A person of ordinary skill in the art would have been motivated to include delegation functionality in OWA so that a delegate who was a “roaming

user” could perform their assigned responsibilities. Boyce further states that “OWA can save the administrative overhead, support, and licensing costs associated with Outlook to users who don’t need all that Outlook has to offer.” (Boyce, p.872.) Therefore, a person of ordinary skill in the art would have also been motivated to include delegation functionality in OWA so that a delegate who did not need all of the features of Outlook could still perform their assigned delegation duties. (Klausner ¶116.)

(*Id.* at 22-23.)

The Petition also acknowledged potential ambiguity in how delegation functionality would be reflected visually in the presentation of a user’s mailbox accessed via OWA. (*Id.* at 41.) For example, while Boyce makes clear that accessing the URL for the mailbox of user “jboyce” results in the web page shown above (with clickable folder icons in the left pane and content of the selected folder in the right pane), Boyce does not say explicitly whether that page is modified visually in accordance with the user’s access permissions.

As a result, the Petition pointed to the Parker reference for its teachings regarding visually modifying icons in accordance with the permissions of the accessing user. (*Id.* at 41-46.) Thus, for example, when a user other than “jboyce” with permission to access the mailbox of “jboyce” navigated to the URL <http://192.168.0.30/exchange/jboyce/>, it would have been obvious in view of Parker to modify the visual presentation of the clickable icons to reflect the user’s access

permissions. (*Id.* at 44-46.) Accordingly, Boyce and Parker render obvious the claimed “application link.”

The Board concluded that the Petition failed to show that the combination of Boyce and Parker discloses the claimed “application link” for three reasons. (Decision at 19, 21.) First, the Board found that “Petitioner has not demonstrated that the ‘delegation’ functionality of Boyce is included in the OWA functionality disclosed by Boyce or that such functionality would have been obvious to include in the OWA.” (*Id.* at 19, 20.) Second, the Board was “not persuaded that even if the ‘delegation’ functionality of Boyce is available in OWA, that Petitioner has demonstrated the ‘delegation’ functionality meets the claimed ‘application links’ as Petitioner contends.” (*Id.*) Third, the Board found that “Petitioner has failed to show that Boyce’s ‘clickable icons’ are ‘application links’ that are configurable.” (*Id.* at 19, 20-21.)

While the specific bases for the Board’s findings are not completely clear, Petitioner respectfully submits that the Board’s analysis and conclusion erred by overlooking the Petition’s obviousness analyses and misapplying its construction of the terms “link” and “application link.”

B. 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

As noted above, 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. (Decision at 19-20 (“Petitioner provides insufficient evidence as to . . . whether modifying Boyce’s OWA to include ‘delegation’ functionality would have been obvious to a person of ordinary skill in the art.”).) The Decision offers no rationale for this finding, and Petitioner respectfully submits that the Board erred.

The Federal Circuit has repeatedly stated that combining embodiments in a prior art reference “does not require a leap of inventiveness.” *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.) In *Boston Scientific Scimed*, the Federal Circuit reversed the district court’s judgment of nonobviousness, finding that it would have been obvious to combine features of different embodiments that were disclosed adjacent to each other. *Boston Sci. Scimed*, 554 F.3d 982, 991-92. In *Paice*, decided in March of this year, the Federal Circuit affirmed the Board’s finding that combining portions of an “optimal” embodiment and a “sub-optimal” embodiment disclosed in a series of related references by the same author similarly did not “require a leap of inventiveness.”

Paice, 2017 WL 900062, at *8. Instead, “as long as a POSA ‘can implement a predictable variation, § 103 likely bars its patentability.’” *Id.* (quoting *Boston Sci. Scimed*, 554 F.3d at 991). Here, combining delegation and OWA from the Boyce reference similarly would not have required a leap of inventiveness.

Moreover, as noted above, the Petition, supported by the declaration of David Klausner, 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, and why doing so would have at least been a predictable variation of OWA. (Petition at 22-23.) The Petition identified specific reasons why a person of ordinary skill in the art would have been motivated to allow delegate access via OWA. (*Id.*) Moreover, the Petition cited specific teachings in Boyce to show that *not* including delegate functionality in OWA would not make sense. In particular, as noted above, the Petition explains that the ability to access another user’s mailbox was already present in OWA. (*Id.* at 22.) The Board does not identify any means in Boyce other than delegation for a user to control mailbox access by another user. And as the Petition observed, it would not make sense for a delegate to have full access to another user’s mailbox through OWA while the delegate’s desktop-based access is restricted. (*Id.* at 22 (“rules governing access for delegates should be consistently enforced regardless of whether a user’s mailbox is accessed through a client application or through OWA”).) Accordingly, when a user other

than “jboyce” attempts to access jboyce’s mailbox via OWA using the URL <http://192.168.0.30/exchange/jboyce/> (*see, e.g., id.* at 10-11), for example, it would have been obvious to check the delegation rights of the accessing user before presenting the OWA pages for jboyce’s mailbox to that user. (*Id.* at 10, 22-23.)

The Petition’s lengthy obviousness discussion is not cited or addressed anywhere in the Decision, and Petitioner respectfully submits that the discussion amply demonstrates that it would have been obvious to combine delegation with OWA. In fact, Patent Owner did not even contest the combinability of delegation and OWA in its Preliminary Response. Instead, Patent Owner only argued about the “most logical” way to implement the combination:

Even if a person of ordinary skill in the art were motivated to incorporate the delegation features of Outlook/Exchange into OWA, the most logical approach would have been to utilize a dialog box and drop-down menu similar to the one used in Outlook/Exchange (shown above in Figure 27-4).

(Preliminary Response at 23.) Patent Owner’s argument is not relevant. *See PAR Pharm., Inc. v. TWI Pharm., Inc.*, 773 F.3d 1186, 1197–98 (Fed. Cir. 2014) (“Our precedent, however, does not require that the motivation be the best option, only that it be a suitable option from which the prior art did not teach away.”); *In re Fulton*, 391 F.3d 1195, 1200 (Fed. Cir. 2004) (“[O]ur case law does not require that a

particular combination must be the preferred, or the most desirable, combination described in the prior art in order to provide motivation for the current invention.”).

Petitioner accordingly respectfully submits that the Petition and supporting papers demonstrated a reasonable likelihood that it would have been obvious to a person of ordinary skill in the art to incorporate delegation functionality into OWA.

C. 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

As noted above, the Decision found that “Petitioner has not established that the ‘delegation’ functionality meets the claimed ‘application link.’” (Decision at 20.) The Board’s rationale for this finding is not clear. The Decision first states that “Petitioner has not pointed to sufficient evidence in Boyce that demonstrates exactly what a user granted delegate authority will be able to see.” (*Id.* at 20.) But as explained above, the Petition explains 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. (*E.g.*, Petition at 10-11, 22, 37-38.) The 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 the particular mailbox being accessed. Instead, Boyce makes clear that explicit logon is simply a second kind of logon functionality that can be used by mailbox owners and others

alike to access the OWA pages of the mailbox owner, and points out that it is particularly useful if the user is not the mailbox owner. (*Id.* at 10-11, 22 (quoting Boyce, p.878).) 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, with a left pane of clickable folder icons for accessing corresponding folder content, which is displayed in the right pane. Moreover, if there is any doubt that the Petition's obviousness discussion at pages 21-23 addresses whether it would have been obvious for a delegate to see such pages, the Petition also notes that "Boyce further discloses and *makes obvious* that multiple users of the system, including a mailbox owner and their delegates, may view *the mailbox owner's OWA web pages.*" (Petition at 19 (emphasis added).)

The Decision next states that "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." (Decision at 20.) The Board's rationale for this finding is not clear. As explained above, the Petition demonstrated that it would have been obvious to incorporate delegation functionality into OWA, and further, 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. (Petition at 21-23, 41-46.) To the extent that the Board has separated the visual icon from its underlying link functionality or has required that an application link must be configurable separate and apart from the configuration of other aspects of the system, the Board has erred, as explained below.

1. If the Board separated the visual icon from its underlying functionality, it erred

If the Board separated the visual icon from its underlying functionality, doing so would have been contrary to the Board’s claim construction of “link.” The Board construed the term “link” as “a mechanism by which a user of a network site activates an application.” (Decision at 10.) The Board also noted in its Decision that “the term ‘link’ *should be tied to activation by a user* based on the definition provided by the ’720 patent specification.” (*Id.* at 10 (emphasis added).)

The Petition clearly explained that the clickable folder icon in Boyce is a “link” because it enables the user to activate or access the linked-to OWA page and content. (Petition at 37-38.) The clickable folder icon clearly qualifies as a “mechanism by which a user of a network site activates an application,” the application in this case being the associated OWA pages and content. (*Id.*)

If the Board excluded the icon from its “link” analysis, doing so was contrary to the plain language of the Board’s claim construction, and clearly erroneous. A folder icon *itself* is a clickable link to the target page, a fact the Petition pointed out. (*Id.*, e.g., at 37 (“Boyce discloses that a user may navigate among OWA pages by

clicking these icons. ‘When you select a different folder on the Outlook Bar,’ Boyce explains, ‘OWA displays the contents of the selected folder in the right pane.’ (Boyce, p.896.)”).)

If the Decision drew a distinction between a displayed linking mechanism (such as the icon in Boyce) and an underlying link functionality, this distinction has no basis in the Board’s construction of “link” as “a mechanism by which a user of a network site activates an application.” In fact, the specification and claims of the ’720 patent demonstrate a link can have a visually-displayable component. (’720, 5:66-6:2 (“A links display page in the content interface 26 can be used to *display the generated link 32* for a specific application 30 selected by the content provider 22. The link 32 can include any necessary parameters and formatting.”), claim 1 (“at least one application link displayed on the web site”).) There is no meaningful difference between the “link” described in the ’720 patent and the one disclosed in Boyce. Like the ’720 patent, the link in Boyce has a clickable visual component (the folder icon) and underlying link functionality. Therefore, to the extent the Board excluded the visual icon from its “link” analysis, it clearly erred.

2. If the Board required an application link to be configurable separate and apart from other aspects of the system, it erred

As noted above, the 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. (*Id.* at 38-46.) Because the configurability is performed by the mailbox owner as permitted by the OWA software, the clickable folder icon qualifies as an "application link." (*Id.*)

The Decision does not provide a clear explanation as to why this was insufficient to show the claimed "application link." If the Board required that the link (in this case the folder icon) must be directly modifiable by the user, and not indirectly modifiable through other actions such as modifying delegation settings, there is nothing in the Board's construction, the claims, or the specification that requires that an application link be directly configurable or modifiable by a content provider separate and apart from configuration or modification of any other aspect of the system.

In fact, the specification of the '720 patent suggests that a link's configurability (under its broadest reasonable construction) can be based on a user's configuration of settings that only indirectly affect the link. For example, the patent states that an underlying application can be configured with specified start and end dates. ('720, 8:5-6 ("Applications 30 can be configured to begin on a particular date/time that is referred to as a start date 74."), 8:14-15 (end date).) The patent explains that configuring the start date and end date of the underlying application will result in the link appearing or disappearing based on that configuration. (*Id.*, 9:28-34.) In that embodiment, the user did not directly configure the link itself.

D. The Board erred when it found that Boyce and Parker do not render obvious an application link

As noted above, the Board further found that “Petitioner fails to identify any disclosure in Boyce that the ‘clickable icons’ . . . can themselves be modified or configured as ‘application links,’ regardless of the ‘delegation’ functionality.” (Decision at 20-21.) The Board’s rationale for this finding is not clear, but as explained above, the Petition demonstrated that it would have been obvious to incorporate delegation functionality into OWA, and further, 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. (Petition at 22-23, 41-46.) And, as explained above, if the Board has separated the visual icon from its underlying link functionality or has required that an application link must be directly configurable separate and apart from the configuration of other aspects of the system, it erred.

III. CONCLUSION

For the foregoing reasons, Petitioner requests rehearing and institution based on Ground set forth in the Petition.

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Dated: May 4, 2017

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CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. § 42.6, that a complete copy of the attached **PETITIONER'S REQUEST FOR REHEARING** is being served on the 4th day of May, 2017, the same day as the filing of the above-identified document in the United States Patent and Trademark Office/Patent Trial and Appeal Board, via electronic mail upon counsel of record for Patent Owner as follows:

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