

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC., SAP AMERICA, INC., EBAY INC., EXPEDIA, INC.,
HOMEAWAY.COM, INC., SQUARESPACE, INC., WIX.COM, LTD.,
WIX.COM, INC., and GOOGLE LLC,¹
Petitioner,

v.

EXPRESS MOBILE, INC.,
Patent Owner.

IPR2021-01226
Patent 7,594,168 B2

Before JEFFREY W. ABRAHAM, STACEY G. WHITE, and
CHARLES J. BOUDREAU, *Acting Vice Chief Administrative Patent
Judges*.

ABRAHAM, *Acting Vice Chief Administrative Patent Judge*.

DECISION

Delegated Director Review of Final Written Decision on Remand
37 C.F.R. § 42.75(f)

¹ SAP America, Inc. filed a motion for joinder and a petition in IPR2022-00518. Expedia, Inc., eBay Inc., Homeaway.com, Inc., Squarespace, Inc., Wix.com, Ltd., and Wix.com, Inc. collectively filed a motion for joinder and a petition in IPR2022-00572. Google LLC filed a motion for joinder and a petition in IPR2022-00597. The Board joined all of these parties as petitioners in IPR2021-01226. This Decision refers to all petitioners collectively as Petitioner.

I. BACKGROUND

Facebook, Inc. filed a Petition requesting *inter partes* review (“IPR”) of claims 1–4 and 6 (“the challenged claims”) of U.S. Patent No. 7,594,168 B2 (Ex. 1001, “the ’168 patent”). Paper 1. On January 14, 2022, the Board instituted *inter partes* review as to all challenged claims and all asserted grounds of unpatentability. Paper 8, 2. At the conclusion of trial, the Board issued a Final Written Decision determining that Petitioner had met its burden of showing, by a preponderance of the evidence, that claims 1–4 and 6 are unpatentable. Paper 42, 2 (“Decision”). Patent Owner appealed to the United States Court of Appeals for the Federal Circuit. Paper 43. On June 17, 2025, the Federal Circuit vacated the Decision and remanded the proceeding to the Board to review whether the asserted prior art combinations teach certain limitations of claim 1 under the proper construction of the recited claim term “style.” *Express Mobile, Inc. v. Meta Platforms, Inc.*, No. 2023-1646, 2025 WL 1693494, at *6 (Fed. Cir. June 17, 2025).

On remand, the Board applied the Federal Circuit’s construction of “style” and again found that Petitioner established by a preponderance of the evidence that claims 1–4 and 6 of the ’168 patent are unpatentable. Paper 60, 19 (“Remand Decision”). The Board acknowledged an intervening jury verdict finding claim 1 of the challenged patent not invalid based on the same prior art grounds asserted in this IPR and applying substantially the same construction of “style” as articulated by the Federal Circuit but concluded that the jury verdict did not change the Board’s

patentability determination. *Id.* at 2–3, 15–19 (citing Ex. 2023).² The Board reasoned that it was bound by the Federal Circuit’s mandate to review only whether the asserted prior art combinations teach certain limitations of claim 1 under the proper construction of “style” and that testimony provided to the jury by Petitioner during the district court trial supported its conclusion that the recited prior art references disclose the disputed limitations under the correct claim construction. *Id.* at 17–18.

On Director Review, the Director determined that the Federal Circuit’s mandate did not require the Board to ignore intervening adjudications from other tribunals or to limit its analysis of prior adjudications to only the “style” issue. Paper 65, 3–4 (“Delegation Order”). The Director further determined that the Board did not give due consideration to the district court’s findings or explain why the evidence or arguments in this IPR dictate a different outcome than that reached by the jury. *Id.* at 4. Accordingly, the Director delegated review to this panel to determine (1) “whether, in view of the district court’s adjudication, Petitioner has presented meaningfully different evidence and arguments to the Board to warrant a different outcome under the preponderance of the evidence standard, or provided other reasons that require a different outcome here” and (2) “whether the Board correctly determined that Petitioner’s claim mapping on remand was timely.” *Id.*

² The jury verdict was handed down in *Express Mobile Inc. v. GoDaddy.com, LLC*, No. 1:19-cv-01937-MFK (D. Del. Nov. 7, 2025).

For the reasons explained below, we determine that Petitioner has not sufficiently explained why a different outcome from the jury verdict is warranted.³

II. ANALYSIS

Binding guidance, issued September 16, 2025, instructs that if the Board reaches an initial or final decision on a finding of fact or conclusion of law that is different than the prior finding or conclusion of the Office, district court, or the ITC, the Board shall explain in the institution or final written decision why a different outcome is warranted. A more detailed explanation is required from the Board when the same or substantially the same evidence and/or arguments that were previously presented to the Office, the district court, or the ITC are being relied upon in the subsequent AIA trial proceeding.

See Memorandum, “PTAB consideration of prior findings of fact and conclusions of law” (USPTO Sept. 16, 2025), available at https://www.uspto.gov/sites/default/files/documents/Memo_re_prior_findings_of_fact_and_conclusions_of_law_9_16_25.pdf (“Memorandum”).

The Board found that “the same or substantially the same issues of obviousness were presented during the district court trial, and that the jury found claim 1 of the [challenged patent] not invalid.” Remand Decision 17. Thus, pursuant to the Memorandum, the Board was required to provide a detailed explanation of why a different outcome is warranted in this proceeding. Memorandum 1; Delegation Order 4.

The Board provided Petitioner an opportunity to explain why the present IPR should proceed despite the jury’s intervening verdict. *See* Paper

³ Because we resolve the first delegated question in favor of Patent Owner, we do not address the second delegated question relating to the timeliness of Petitioner’s claim mapping on remand.

56. In its brief, Petitioner argues the jury verdict should not be given persuasive weight because Patent Owner did not contest before the jury that the prior art discloses a “style” under the correct construction of that term (which Petitioner contends is the sole issue on remand), the presentation to the jury in the district court did not “even remotely approach[] the thoroughness of the one the Board received,” and the jury’s black box verdict is a “result without reasoning” that “should be afforded no persuasive weight.” *Id.* at 1–6 (asserting that the defendant’s expert “discussed the Reynolds-Lemay combination for only five minutes at the end of the third day of trial”); Paper 63, 7.

With respect to the scope of analysis required by the Memorandum, the Director determined that the Federal Circuit’s mandate “did not require the Board to ignore intervening adjudications from other tribunals involving the same claims and prior art” or require the Board to limit its analysis of the Memorandum’s requirements to any particular issue. Delegation Order 3–4. Accordingly, contrary to Petitioner’s arguments, consideration of the entire jury verdict is required by the Memorandum, especially where the same prior art and arguments were presented in each proceeding. *Id.* at 4.⁴

Petitioner’s briefing does not identify any “meaningfully different evidence and arguments” that would “warrant a different outcome under the preponderance of the evidence standard.” Memorandum; Paper 56, 2; Paper 63, 9. Nor does Petitioner provide any “other reasons that require a

⁴ Petitioner appears to have assumed that only the “style” issue was relevant on remand. *See* Paper 56, 3; Paper 63, 1–4. Any such misapprehension is resolved by the Director’s Delegation Order, however, and despite having been put on notice thereby, Petitioner did not seek leave for any additional briefing following issuance of the Delegation Order.

different outcome here.” Delegation Order 4. For example, although Petitioner argues that the amount of time allocated to the defendant’s district court invalidity defense was minimal, Petitioner does not identify any material differences in the prior art embodiments applied in the asserted obviousness combinations, any material differences in the proffered reasons to combine those references, or any relevant, binding admissions that differ between the two proceedings. *See* Paper 56, 1–6.

As noted by Petitioner, the jury’s verdict form provides little guidance as to which disputed issues of fact the jury resolved in favor of Patent Owner. Paper 56, 6; Ex. 2023, 4 (jury verdict form). The record, however, provides guidance as to which issues the jury was tasked with resolving. In his direct testimony, Patent Owner’s expert opined that at least one limitation of claim 1 was not met by the asserted prior art combinations and that the proffered reasons to combine the references were deficient. Ex. 2030, 844:6–847:20; Paper 56, 3 (Petitioner detailing Patent Owner’s expert’s testimony regarding the proposed combinations). In view of the outcome, the jury resolved at least one of these disputed issues of fact, either of which is dispositive, in favor of Patent Owner. *See, e.g., Apple Inc. v. Samsung Elecs. Co.*, 839 F.3d 1034, 1047 (Fed. Cir. 2016). Petitioner does not explain why the arguments and evidence presented to the jury on these disputed issues of fact differ in any material way between the two proceedings, such that a different outcome is justified in this proceeding. *See* Memorandum; Paper 56, 3 (Petitioner assuming only the “style” issue was relevant on remand).

In view of the foregoing, we determine that Petitioner has neither presented meaningfully different evidence and arguments to the Board, in

view of the district court's adjudication, to warrant a different outcome under the preponderance of the evidence standard nor provided other reasons that require a different outcome. Accordingly, pursuant to the Delegation Order, we vacate the Board's Final Written Decision on Remand and issue this new Final Written Decision concluding that Petitioner has not demonstrated by a preponderance of the evidence that challenged claims 1–4 and 6 are unpatentable.

III. ORDER

For the foregoing reasons, it is:

ORDERED that the Board's Final Written Decision on Remand (Paper 60) is vacated;

FURTHER ORDERED that Petitioner has not demonstrated by a preponderance of the evidence that claims 1–4 and 6 of U.S. Patent No. 7,594,168 B2 are unpatentable; and

FURTHER ORDERED that, because this is a Final Written 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.

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