UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/013,677	01/19/2016	5790793	2038695-0558	5557

20995 7590 02/28/2018		EXAMINER
KNOBBE MARTENS OLSON & BEAR LLP		DESAI, RACHNA SINGH
2040 MAIN STREET		
FOURTEENTH FLOOR	ART UNIT	PAPER NUMBER
IRVINE, CA 92614	3992	

MAIL DATE	DELIVERY MODE
02/28/2018	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE
_____

BEFORE THE PATENT TRIAL AND APPEAL BOARD
_____

Ex parte INTELLECTUAL VENTURES I, LLC,
Appellant and Patent Owner.
_____

Appeal 2017-011415
Reexamination Control 90/013,677
Patent 5,790,793 B2
Technology Center 3900
_____

Before STEPHEN C. SIU, JENNIFER L. McKEOWN, and KRISTINA M. KALAN *Administrative Patent Judges*.

McKEOWN, *Administrative Patent Judge*.

DECISION ON APPEAL

Intellectual Ventures I, LLC ("Patent Owner") appeals from the decision in the Examiner's Final Action, mailed September 14, 2016, rejecting claims 19, 20, and 41 of U.S. Patent No. 5,790,793 B2 (the "'739 patent"). App. Br. 1.[1]

---

[1] Throughout this opinion, we refer to (1) the Final Action, mailed September 14, 2016 ("Final Act."); (2) Patent Owner's Appeal Brief, filed April 13, 2017 ("App. Br."); (3) the Examiner's Answer, mailed June 22, 2017 ("Ans."), and (4) Patent Owner's Reply Brief, filed August 22, 2017 ("Reply Br.").

I. STATEMENT OF CASE

This proceeding arose from an *ex parte* reexamination request (the "Request") of the '739 patent, issued to Thomas Higley on August 4, 1998.

The '739 was the subject of *inter partes* review proceeding, IPR2014-00500 (the "IPR"). The Final Written Decision, issued on September 9, 2015, found claims 1, 4–6, 8, 10, 13–15, 17, 21, 24–26, 28, 30, 33–35, 37, 39, and 40 unpatentable. *Motorola Mobility, LLC v. Intellectual Ventures I, LLC*, IPR 2014–00500, Final Written Decision (PTAB Sept. 10, 2014). The Federal Circuit affirmed that Decision. *See Intellectual Ventures I LLC v. Motorola Mobility LLC*, 671 Fed.Appx. 787 (Fed. Cir. Dec. 9, 2016) (affirming under Fed. Cir. R. 36).

We have also been informed that the '739 patent was the subject of a district court proceedings *Intellectual Ventures I LLC v. AT&T Mobility LLC*, No. 12-cv-00193 (D. Del.); *Intellectual Ventures I LLC v. T-Mobile USA Inc.*, No. 13-cv-01632-LPS (D. Del.); *Intellectual Ventures I LLC v. Nextel Operations Inc.,* No. 13-cv-01636-LPS (D. Del.); and *Intellectual Ventures I LLC v. Motorola Mobility LLC*, No. 13-cv-61358-DMM (S.D. Fla.). *See* App. Br. 6.

An oral hearing was conducted on January 24, 2018. The transcript of the oral hearing will be made of record.

We have jurisdiction under 35 U.S.C. §§ 134(b) and 315 (pre-AIA).
We affirm.

II. THE '739 PATENT

The '739 patent relates generally to a method and system for sending and receiving Uniform Resource Locators (URLs) in electronic mail over the Internet. '739 patent, Abstract. Figure 4, reproduced below, depicts one embodiment.
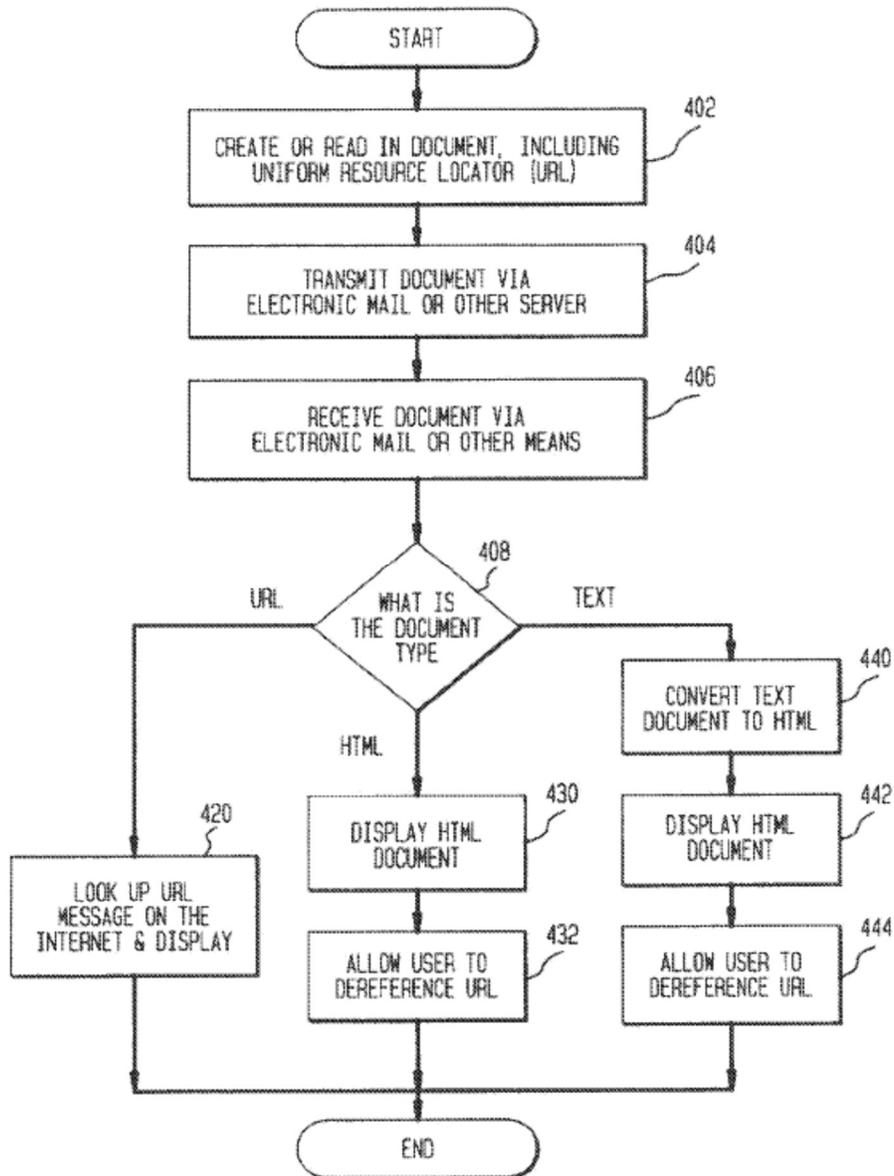
FIG. 4

START

CREATE OR READ IN DOCUMENT, INCLUDING
UNIFORM RESOURCE LOCATOR (URL)   402

TRANSMIT DOCUMENT VIA
ELECTRONIC MAIL OR OTHER SERVER   404

RECEIVE DOCUMENT VIA
ELECTRONIC MAIL OR OTHER MEANS   406

WHAT IS
THE DOCUMENT
TYPE   408

URL   TEXT   HTML

CONVERT TEXT
DOCUMENT TO HTML   440

LOOK UP URL
MESSAGE ON THE
INTERNET & DISPLAY   420

DISPLAY HTML
DOCUMENT   430

DISPLAY HTML
DOCUMENT   442

ALLOW USER TO
DEREFERENCE URL   432

ALLOW USER TO
DEREFERENCE URL   444

END

Figure 4 Depicting an Exemplary Embodiment of the Claimed Invention

3

Claims 19 and 41 are illustrative and read as follows:

19. A computer implemented method for transmitting a message to a receiving computer which examines a type of the message and looks up an address to a predetermined location contained within the message if the message is determined to be of a type which indicates that the message contains an address, comprising the steps of:

encoding a message into a format which indicates that a type of the message is of a format which contains an address to a predetermined location and contains the address to the predetermined location without including data corresponding to the predetermined location; and

transmitting the encoded message over a network to the receiving computer.

41. A method of communicating between computers, comprising the steps of:

sending a message over a network, said message includes at least one reference to a predetermined location at a first computer system;

receiving said message at a second computer system; and decoding said message by retrieving data from said predetermined location automatically, without requiring user interaction.

App. Br., Claims App'x.

III. REJECTIONS

A. Evidence Relied Upon

The Examiner relies on the following as evidence of unpatentability:

Payne	US 5,715,314	Feb. 3, 1998 ("Payne")

Steve Putz, *Interactive Information Services Using World-Wide Web Hypertext*, Xerox Palo Alto Research Center (April 20, 1994).

Steve Putz, *Interactive Information Services Using World-Wide Web Hypertext*, Computer Networks and ISDN Systems 27 (1994) 273–280 (collectively, "Putz").

Patent Owner additionally relies on the Declaration of Mark. T Jones, Ph.D, dated July 26, 2016 ("Jones Decl.").

B.   *The Adopted Rejections*

The Examiner maintains the following rejections:

1. Claims 19, 20, and 41 are rejected under 35 U.S.C. § 102 as anticipated by Putz.

2. Claims 19, 20, and 41 are rejected under 35 U.S.C. § 102 as anticipated by Payne.

IV. ANALYSIS

A. The Anticipation Rejections of Claim 19 and 20

Based on the record before us, we are not persuaded that the Examiner erred in rejecting claims 19 and 20 under 35 U.S.C. § 102 as anticipated by each of Payne and Putz.

Patent Owner contends that neither Payne nor Putz examine a type of message or encode a message into a format which indicates that a type of the message is of a format which contains an address to a predetermined location, as required by claim 19. According to the Patent Owner, claim 19 implicitly requires more than one message type because the claim recites *examining* a type of message. *See, e.g.*, App. Br. 27 ("The Examiner ostensibly interprets Payne and Putz to examine a 'type' of the message, even though they can only transmit and receive one type or format of message. This interpretation makes no sense."); App. Br. 28 ("[Payne's] HTTP message with the access URL sent from the payment computer to the buyer computer is always a response message following the HTTP

protocol, so it is always the same type and always has the same format."); App. Br. 30 ("[Putz's] web client does not examiner [sic], and has no need to examine, a type of the message because it is always the same type of message.").

Patent Owner further supports this argument by relying on the exemplary message types disclosed in the '793 patent. *See, e.g.*, App. Br. 24 ("In certain embodiments of the '793 patent, the type and format of the message can change. Figures 6-8 show some examples."). Patent Owner distinguishes the URL/pointer message type of figure 6 from the html/text and text/plain message types of figures 7 and 8, respectively. App. Br. 24–25. Patent Owner contends that the html/text and text/plain type messages may include a URL, but these message types do not reveal that the message contains a URL. App. Br. 25; *see also* App. Br. 30 (citing Jones Decl. ¶ 104) ("Like the examples of Figure 7 and 8 of the '793 patent, a response message may contain a URL or it may not, but the type of the message would not reveal that because all response messages are the same type of message, following the HTTP protocol.").

Patent Owner also argues that the Examiner failed to properly consider the Jones Declaration. App. Br. 26; Reply Br. 26–27.[2] In particular, Patent Owner asserts that the Jones Declaration

> even more fully explained why '[t]he type and format of a response message [in Payne and Putz] is ***always the same*** because it is defined by the HTTP standard.' Jones Decl. (Ex. 106) ¶ 62 (emphasis added); *see also id.* ¶¶ 65, 83, 86, 102. In other words, Payne's and Putz's computers ***absolutely*** do not include alternate types and formats.

---

[2] Patent Owner asserts that the Examiner instead considered the Jones Declaration from the IPR. There, Jones stated that Payne's computers "'need not and likely do not' include alternate types and formats." App. Br. 26.

App. Br. 26. As such, according to Patent Owner, "Payne and Putz have no need to examine-and there is no evidence they do examine-the type of the message." App. Br. 28.

We find Patent Owner's arguments unpersuasive. As explained in the Request, Payne at least describes that the URL message may be a HTTP request message or a redirection. Request 18 (quoting Payne, col. 9, ll. 51–63); Final Act. 5 (incorporating by reference Request pp. 11–35). Payne also describes sending a success HTTP response message with a requested document within the body of the message. Payne, col. 9, l. 64–col. 10, l. 1. Thus, contrary to Patent Owner's assertions, Payne describes and examines multiple message types. Similarly, as the Examiner finds, Putz "discloses multiple document types (i.e. images, SGML) that are examined / decoded." Final Act. 14; *see also* Final Act. 15 ("The MIME-type parameters used in Putz's HTTP response message can specify document types, such as images. Putz also discloses HTML, 'which is a .... SGML document type allowing structured text with links.' Thus, multiple document types are examined in Putz.").

Patent Owner's reliance on Figure 7 is also misplaced. The '793 patent identifies that the message using the HTML protocol is *a URL type message*. *See* '793 patent, col. 3, ll. 59-61 ("FIG. 7 illustrates another example of an electronic mail format in HTML used to transmit addresses (*URL typed mail*) by the present invention") (emphasis added); '793 patent, col. 8, ll. 11–13 ("FIGS. 6 and 7 are illustrative and should not be considered *the only possible formats or URL typed messages*....") (emphasis added). As such, a message in HTML format may also be a URL type message according to the '793 patent. This is further supported by the '793 patent's disclosure that the message type may be determined or assessed

from *the contents of the message itself.* '793 patent, col. 5, ll. 38–40. In other words, the URL type message need not be identified by a header but can be determined by the presence of a URL within the message. As such, a skilled artisan would not interpret use of HTML, or other protocols such as Payne's HTTP, to limit messages to a single message type.

We are not persuaded then that Payne and Putz are limited to a single message type. To the contrary, as discussed above, Payne at least discloses URL messages, redirect messages, and success response messages. See Payne, col. 9, l. 64–col. 10, l. 1. Moreover, Exhibit 105, submitted by Patent Owner, also explains that within the HTTP protocol there are request and response type messages, each of which are disclosed and examined in Payne. *See* Exhibit 105, Network Working Group, Request for Comments: 1945, p. 21. Putz likewise describes examining multiple message types within the HTML protocol. *See* Final Act. 14–15.

Patent Owner's argument with respect to the Jones Declaration is likewise unavailing. While the Examiner inaccurately quotes the Jones Declaration, Payne and Putz expressly describe multiple message types. For example, as discussed above, Payne discloses URL messages, redirect messages, and success response messages. *See* Payne, col. 9, l. 64–col. 10, l. 1; *see also* Final Act. 14–16 (finding that Putz discloses examining multiple message types). As such, Jones' statement that Payne and Putz *absolutely* disclose only a single message type is unconvincing.

Patent Owner also alleges that the Examiner identified the access URL and payment URL as both the message and the reference to a predetermined location. Reply Br. 22–26. We disagree. The Examiner finds that

> Payne discloses a first embodiment: a payment computer encodes *a message containing an access URL* (i.e.,,[sic] a message that

8

includes at least one reference to a predetermined location), and then transmits I sends to the receiving computer I a second computer system (buyer computer).

Payne discloses a second embodiment, a merchant computer encodes *a message containing a payment URL* (i.e., a message that includes at least one reference to a predetermined location at a first computer system); which is then transmitted I sent to the receiving computer I a second computer system (i. e. the buyer computer).

Final Act. 7–8 (emphasis added).

Therefore, we are not persuaded that the Examiner erred in finding that Payne and Putz each examine a type of message and encode a message into a format which indicates that a type of the message is of a format which contains an address to a predetermined location, as required by claim 19. *See also* IPR 18–19, 29–30 (rejecting Patent Owner's arguments and finding that Payne and Putz disclose the disputed limitations).

Accordingly, for the reasons discussed above and explained by the Examiner, we sustain the rejections of claim 19 as well as dependent claim 20, not argued with particularity, as anticipated by each of Payne and Putz.

B. *The Anticipation Rejections of Claims 41*

Based on the record before us, we are not persuaded that the Examiner erred in rejecting claims 41 under 35 U.S.C. § 102 as anticipated by each of Payne and Putz.

With respect to claim 41, Patent Owner alleges that the Specification and file history distinguish decoding that is triggered by user interaction from decoding that occurs without user interaction. App. Br. 18–19. Particularly, Patent Owner relies on the description of Figure 7,

> When the file of FIG. 7 is received by a machine operating according to the process of the present invention, the message is received and if a user "clicks" when a pointing device such as a mouse is pointing to the URL, the information relating to the URL would be retrieved via the Internet and displayed (e.g., dereferenced). Alternatively, the URL may automatically be displayed without user intervention.

'793 patent (Ex. 1) 8:5–12. Additionally, Patent Owner identifies that the file history distinguishes prior art on the basis of pushing information to the user rather than manually browsing with user interaction. App. Br. 18–19.

Patent Owner then argues that neither Payne nor Putz teaches the decoding limitation of claim 41. "To the extent Payne and Putz 'decode' anything, there is no dispute they need user interaction to trigger the decoding." App. Br. 22. According to Patent Owner,

> Payne discloses no mechanism for causing the fulfillment document to be sent to the buyer computer —and certainly not an automatic mechanism. Jones Decl. (Ex. 106) ¶ 74. Moreover, Payne requires significant user action at the buyer computer to retrieve the fulfillment document. *Id.* ¶ 75. The user at the buyer computer controls the purchase process and repeatedly requests the merchant computer send the fulfillment document to the buyer computer. First, the user enters "a user request for purchasing a product" at the buyer computer. Payne (Ex. 5) 1:55–59; *see id.*, 5:26–29. Then, the user confirms the purchase request by clicking the "continue" button in the confirmation document displayed on the buyer computer (as well as entering any required security information). *Id.*,

App. Br. 22. Patent Owner presents similar arguments regarding Putz. *See* App. Br. 23 ("In Putz, the user at the web client computer explicitly requests the retrieval of the map image associated with the image URL by clicking or selecting a web page URL.").

We are not persuaded that the Examiner erred in finding that Payne and Putz each disclose the decoding limitation. Rather, we agree with the Final Decision of the IPR that directly and extensively addresses this argument. Namely,

> With respect to the decoding step in the first embodiment [in Payne], we find that the buyer computer of Payne decodes the message without user interaction, sending the access URL to the merchant computer to retrieve the fulfillment document. Ex. 1007, 7:46–50 ("the merchant computer verifies that the buyer computer network address is the same as the buyer network address in the access URL (step 101), and if so, sends a fulfillment document to the buyer computer (step 102), which is displayed by the buyer computer (step 104)"), Figs. 2H, 10. With respect to the decoding step in the second embodiment, we find that the buyer computer sends the payment URL to the payment computer to automatically retrieve the confirmation document. *Id*. at 5:53–60 ("buyer computer then sends the payment URL A it has received from the merchant computer to the payment computer."), *id*. at 6:5–14 ("payment computer sends a payment confirmation document to the buyer computer,"), Fig. 6 (showing an example of the confirmation document), *id*. at 4:7–9.

IPR 15–16; *see also* IPR 28 (finding that "Putz fetches or retrieves and automatically decodes, without user interaction, the images identified by the <IMG> tag from the URL location.").

As explained by the Examiner, the user actions in Payne and Putz identified by Patent Owner are *not performed in decoding the message by retrieving data from the predetermined location*. Ans. 43. Nothing in claim 41 precludes user interaction outside of this step. While Patent Owner attempts to read in additional steps to decoding, the claim expressly recites "decoding said message by retrieving data from said predetermined location." As such, we find Patent Owner's arguments unpersuasive.

We also agree with the Examiner that Payne and Putz's decoding is automatic. Ans. 43–45. "Payne discloses 'automatic (without user

interaction) redirection of a web browser based on a standard HTTP request message that includes a URL (such as the access URL).'[] The redirection of a web browser based on a standard HTTP request message including a URL disclosed in Payne is automatic." Ans. 43. Similarly,

> Putz discloses, as an example, a "web browser" on the client computer automatically retrieves the map image from the image source without user interaction and thus anticipates retrieving automatically and without user interaction, notwithstanding any user interaction that may be taken in an earlier step.

Final Act. 18–19. Therefore, we are unpersuaded that the Examiner erred in finding that Payne and Putz each disclose the decoding limitation of claim 41.

Accordingly, for the reasons discussed above and by the Examiner, we sustain the rejections of claim 41 as anticipated by each of Payne and Putz.

V. CONCLUSION

We affirm the Examiner's decisions to reject claims 19, 20, and 41.

AFFIRMED

Appeal 2017-011415
Reexamination Control 90/013,677
Patent 5,790,793 B2

PATENT OWNER:

KNOBBE, MARTENS, OLSON & BEAR LLP
2040 Main Street
14TH Floor
Irvine, CA 92614

FOR THIRD-PARTY REQUESTER:

JAMES W. MILLER, ATTORNEY
527 MARQUETTE A VENUE
SUITE 1960, RAND TOWER
MINNEAPOLIS, MN 55402