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

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.
Requester and Appellant

v.

LEADER TECHNOLOGIES, INC.
Patent Owner and Respondent

Appeal 2012-009270
Reexamination Control 95/001,261
Patent 7,139,761 B2
Technology Center 3900

Before ALLEN R. MACDONALD, STEPHEN C. SIU, and MEREDITH C. PETRAVICK, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*

DECISION ON APPEAL

Third Party Requester and Appellant Facebook, Inc. appeals under 35 U.S.C. §§ 134(c) and 315(b) the Examiner's decision not to reject claims 2, 3, 5, 6, 8, 10, 12-15, 24, 26, 29, 33, and 34 over various prior art references.[1] We have jurisdiction under 35 U.S.C. §§ 134(c) and 315(b).

STATEMENT OF THE CASE

This proceeding (Reexamination Proceeding 95/001,261) arose from a request by Facebook, Inc. for an inter partes reexamination of U.S. Patent 7,139,761 B2, titled "Dynamic Association of Electronically Stored Information with Iterative Workflow Changes," and issued to Michael T. McKibben and Jeffrey R. Lamb on November 21, 2006 (the '761 patent). Claims 1-16, 21, 23-26, 29, and 31-34 were subject to inter partes reexamination (see, e.g., Request for *Inter Partes* Reexamination, dated November 13, 2009, pp. 5-6).

Appellant and Requester Facebook, Inc. also filed a separate request for ex parte reexamination of claims 1, 2, 4-16, 21-29, and 31-35 of the '761 patent (Reexamination Proceeding 90/010,591) (see, e.g., Request for *Ex Parte* Reexamination, dated July 2, 2009, pp. 9-10), which was subsequently merged with inter partes reexamination proceeding 95/001,261 (see Decision, *Sua Sponte*, to Merge Reexamination Proceedings, dated April 26, 2010).

In a Decision Dissolving Merger of Reexamination Proceedings dated May 15, 2012, the merger of ex parte reexamination proceeding 90/010,591

[1] As described below, claims 1, 4, 7, 9, 11, 16, 21-23, 25, 27, 28, 31, 32, and 35 are not subject to appeal in this inter partes reexamination proceeding.

and inter partes reexamination proceeding 95/001,261 was dissolved and each of the proceedings was reconstituted as a separate proceeding.

In view of the dissolution of ex parte reexamination proceeding 90/010,591 and inter partes reexamination proceeding 95/001,261, the current appeal is directed solely to claims subject to reexamination in inter partes reexamination proceeding 95/001,261 (i.e., claims 1-16, 21, 23-26, 29, and 31-34) and does not include issues pertaining to claims reexamined in ex parte reexamination proceeding 90/010,591 (e.g., issues pertaining to claims 22, 27, 28, and 35).

The '761 patent describes a data management tool (col. 3, l. 17). Claim 2 (which depends from Claim 1) on appeal reads as follows:

1. A computer-implemented network-based system that facilitates management of data, comprising:

a computer-implemented context component of the network-based system for capturing context information associated with user-defined data created by user interaction of a user in a first context of the network-based system, the context component dynamically storing the context information in metadata associated with the user-defined data, the user-defined data and metadata stored on a storage component of the network-based system; and

a computer implemented tracking component of the network-based system for tracking a change of the user from the first context to a second context of the network-based system and dynamically updating the stored metadata based on the change, wherein the user accesses the data from the second context.

2. The system of claim 1, the context component is associated with a workspace, which is a collection of data and application functionality related to the user-defined data.

The Examiner confirms patentability of the claims over the following proposed rejections:

Claims 1-13, 16, 21, 23-26, 29, and 31-34 under § 102(b) as anticipated by Christopher K. Hess and Roy H. Campbell, "A Context File System for Ubiquitous Computing Environments," July 2002 ("Hess").

Claims 1-15, 21, 23-26, 29, and 31-34 under § 102(b) as anticipated by EP 1087306A2, March 28, 2001 ("Hubert").

Claims 1, 2, 4-15, 21, 23-26, 29, and 32-34 under § 102(b) as anticipated by iManage DeskSite 6.0, User Reference Manual, 1999 ("iManage").

Claims 1-16, 21, 23-26, 29, and 31-34 under § 103(a) as unpatentable over Hess and U.S. Patent 6,430,575 B1, August 6, 2002 ("Dourish").

Claims 9-15, 21, 23-26, and 31-34 under § 103(a) as unpatentable over Hess and Microsoft Corporation, "Computer Dictionary," 3rd Edition, 1997 ("Microsoft").

Claim 16 under § 103(a) as unpatentable over Hubert and U.S. Patent No. 6,434,403 B1, August 13, 2002 ("Ausems").

Claims 1-15, 21, 23-26, 29, and 31-34 under § 103(a) as unpatentable over Hubert and U.S. Patent Publication No. 2003/0120660 A1, June, 26, 2003 ("Maritzen").

Claim 3 under § 102(b) as anticipated by U.S. Patent No. 6,236,994 B1, May 22, 2001 ("Swartz").

Claims 1, 2, 4-16, 21, 23-26, 29, 31, and 33 under § 103(a) as unpatentable over Hess and Maritzen.

Judicial Proceedings

We are informed that the '761 Patent was the subject of litigation styled "*LEADER TECHNOLOGIES, INC. v. FACEBOOK, INC.,* Case No. 1:08-CV-00862 LPS, filed in the U.S. District Court for the District of Delaware (App. Br. 1), in which the jury found each asserted claim (i.e., claims 1, 4, 7, 9, 11, 16, 21, 23, 25, 31, and 32) invalid under 35 U.S.C. §102(b) as being on sale and in public use more than one year before the priority date to which it was entitled.

A Decision affirming the District Court's final judgment of the invalidity of claims 1, 4, 7, 9, 11, 16, 21, 23, 25, 31, and 32 under 35 U.S.C. § 102(b) was issued by the United States Court of Appeals for the Federal Circuit on May 8, 2012 (No. 2011-1366).[2]

ISSUE

Did the Examiner err in refusing to reject claims 2, 3, 5, 6, 8, 10, 12-15, 24, 26, 29, 33, and 34?

[2] In view of the final judgment of invalidity of claims 1, 4, 7, 9, 11, 16, 21, 23, 25, 31, and 32 by the United States Court of Appeals for the Federal Circuit, we will not consider issues of invalidity in this appeal pertaining to these claims. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1429 (Fed. Cir. 1988)("if a court finds a patent invalid, and that decision is either upheld on appeal or not appealed, the PTO may discontinue its reexamination"). Claims subject to this appeal are therefore claims 2, 3, 5, 6, 8, 10, 12-15, 24, 26, 29, 33, and 34.

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.,* 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

"The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).

ANALYSIS

Ex parte reexamination proceeding 90/010,591

Appellant argues that "[t]he Examiner did not address the four SNQs and several prior art references that were presented in the *Ex Parte* Request" (App. Br. 8). This issue is moot because, as indicated above, the merger of ex parte reexamination proceeding 90/010,591 and inter partes reexamination proceeding 95/001,261 was dissolved (see Decision Dissolving Merger of Reexamination Proceedings dated May 15, 2012).

Hess Reference

The Examiner refuses to adopt the proposed rejection of claims 2, 3, 5, 6, and 8 as anticipated by Hess. The Examiner states that Hess "does not disclose computer implemented tracking of this physical movement of the user" (Action Closing Prosecution 46-47) because, according to the Examiner, Hess merely discloses that "the context is set manually (*pg. 10, 2nd ¶*)" (Action Closing Prosecution 47). Claim 2, which depends from claim 1, recites a component "for tracking a change of the user from the first context to a second context." Hence, the Examiner appears to take the following position:

1) Claim 2 requires setting the context in a *non-manual* fashion.
2) Hess fails to disclose setting the context in a non-manual fashion (in contradistinction with this "requirement" of claim 2).
3) Therefore (and as a consequence of Hess failing to disclose setting a context non-manually), Hess fails to disclose tracking movement of the user.

We do not agree with the Examiner. First, the Examiner does not indicate how claim 2 requires setting the context in a "non-manual" fashion (point 1 above). Instead, claim 2 appears to merely recite "capturing context information," storing context information in metadata," and "updating the stored metadata" but does not appear to require that any of these activities are performed "non-manually" (or, presumably, "automatically"). Since the Examiner has not demonstrated that claim 2 requires setting the context non-manually (or "automatically"), we cannot agree with the Examiner of the relevance to claim 2 of whether Hess fails to disclose setting the context non-manually/automatically or not (point 2 above).

Even assuming that claim 2 requires that context information is captured "automatically" as the Examiner appears to assume, Hess discloses "the physical location of the user triggers the automatic configuration of the user's environment" (Request for Inter Partes Reexamination dated November 13, 2009, p. 14, citing Hess, § 1, page 4). Since a user's location or "context" is automatically configured (i.e., captured or updated) in Hess, we disagree with the Examiner's statement that Hess fails to disclose that context information is captured or updated "automatically" at least because Hess explicitly discloses that the context is configured automatically.

Second, still assuming that claim 2 requires setting the context in a non-manual or automatic fashion and further assuming that Hess fails to disclose the "automatic" feature as the Examiner appears to assume, the Examiner does not demonstrate how such a finding indicates that Hess also fails to disclose "tracking movement of the user" (point 3 above) since whether "capturing context information" is performed manually or automatically does not appear to impact the separate action of tracking a user.

As Appellant points out, Hess discloses that "[u]sers can move between spaces and their environment (i.e., applications, state, data, etc.) can move with them" (Request for Inter Partes Reexamination dated November 13, 2009, p. 31, citing Hess, § 1, page 3) and "personal mount points may be . . . automatically retrieved from a home server and merged into the current environment" (App. Br. 10; Hess, p. 5, § 2.1). The Examiner has not demonstrated a difference between these disclosures in Hess, for example, and "tracking a change of the user" as recited in claim 2. We do not

independently identify any differences because in both cases, the user's location is being tracked.

The Examiner also states that Hess fails to disclose a "component" for capturing context information and a "component" for tracking a user because "the mount server [of Hess] cannot be both the claimed context component and the claimed tracking component" (see, e.g., Action Closing Prosecution 47). However, as Appellant points out, "'components' can reside within a single computer or single program" (App. Br. 12, citing the '761 patent at col. 5, ll. 54-65). Hess discloses a server computer that one of ordinary skill in the art would have understood to execute computer algorithms with "components" for performing the disclosed functions of, for example, capturing context information (i.e., "the automatic configuration of the user's environment" (Hess, § 1, page 4)) and tracking a change of the user (e.g., "[u]sers can move between spaces and their environment (i.e., applications, state, data, etc.) can move with them" (Hess, § 1, page 3)).

We disagree with the Examiner that the "mount server" of Hess cannot contain a component for capturing context information and a component for tracking a user because, as described above, Hess discloses each of these functions being performed by a computer system. One of ordinary skill in the art would have understood that if the computer system of Hess performs specific functions, then the computer system of Hess contains "components" that perform the specified functions because otherwise, the specified functions would not be performed as disclosed by Hess.

The Examiner also refuses to adopt the rejection of claims 2, 3, 5, 6, and 8 as obvious over the combination of Hess and Dourish because, according to the Examiner, the proposed rejection "makes the conclusion [of obviousness] . . . without pointing to any specific teachings as to how this combination meets the claim limitations" (Action Closing Prosecution 47). With the exception of the issues already discussed above, the Examiner does not point to any additional specific elements that the combination of Hess and Dourish does not disclose or suggest. In addition, Appellant/Requester appears to provide sufficient reasons with supporting factual underpinnings to support the conclusion that the combination would have been obvious.[3] The Examiner does not point out any specific flaws in Appellant's/ Requester's rationale. In the absence of any specifically identified flaws in Appellant's rationale, we cannot agree with the Examiner.

The Examiner provides the same rationale(s) for refusing to adopt the rejection under 35 U.S.C. § 102(b) of claims 10, 12, and 13 as anticipated by

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[3] Appellant states, for example, that "[i]t would also have been obvious to one of ordinary skill in the art to combine Hess and Dourish to provide the systems and methods claimed in claims 1-16, 21, 23-26, 29, 31-34. Both Hess and Dourish provide solutions to the same problems purportedly addressed in the '761 patent, which would lead a skilled artisan to look to both references for possible solutions to the problem. Both Hess and Dourish describe techniques for managing and organizing a user's data (including through using stored metadata), and both references disclose the ability of a user to move to a new context, workspace, or user environment in which the user accesses that data. A person of ordinary skill in the art could easily have combined the elements of both systems by known methods, with no change in their respective functions and yielding nothing more than results which would have been predictable at the time the '761 patent was filed" (Request for *Inter Partes* Reexamination dated November 13, 2009, p. 138)

Hess and the rejection under 35 U.S.C. § 103(a) of claims 10, 12-15, 24, 26, 29, 33, and 34 as unpatentable over Hess and Dourish and does not provide additional reasons for not adopting the rejection of claims 10, 12-15, 24, 26, 33, and 34 as unpatentable over Hess and Microsoft. We disagree with the Examiner's refusal to adopt the rejection of claims 10, 12-15, 24, 26, 29, 33, and 34 for at least the reasons set forth above.

Respondent agrees with the Examiner that "'the mount server [of Hess] cannot be both the claimed context component and the claimed tracking component'," that Hess fails to disclose "the '761 Patent's 'tracking component'," and that there is no discussion of "***how*** combining Hess and Dourish renders any claim obvious" (Respondent Br. 6). We disagree with Respondent for at least the reasons set forth above.

The Examiner erred in refusing to maintain the rejection of claims under 35 U.S.C. § 102(b) as anticipated by Hess; claims 2, 3, 5, 6, 8, 10, 12-15, 24, 26, 29, 33, and 34 under 35 U.S.C. § 103(a) as unpatentable over Hess and Dourish; and claims 10, 12-15, 24, 26, 33 and 34 under 35 U.S.C. § 103(a) as unpatentable over Hess and Microsoft.

Hubert, iManage, and Swartz references

Affirmance of the rejection for the above-referenced claims based on Hess renders it unnecessary to reach the propriety of the Examiner's decision to refuse to adopt the rejection of those claims on a different basis. *Cf. In re Gleave*, 560 F.3d 1331, 1338 (Fed. Cir. 2009). As such, we need not decide the propriety of the Examiner's refusal to adopt the additional proposed rejections of those claims over Hess, Hubert, iManage,

or Swartz, alone or in combination with any of Ausems, Maritzen, or Microsoft.

CONCLUSION

Issues pertaining to the propriety of proposed rejections in the corresponding ex parte reexamination proceeding are moot and not properly subject to appeal for review by the Board.

The Examiner erred in refusing to reject claims 2, 3, 5, 6, 8, 10, 12-15, 24, 26, 29, 33, and 34.

DECISION

We reverse the Examiner's decision not to maintain the rejection of claims 2, 3, 5, 6, 8, 10, 12, and 13 under 35 U.S.C. § 102(b) as anticipated by Hess; claims 2, 3, 5, 6, 8, 10, 12-15, 24, 26, 29, 33, and 34 under 35 U.S.C. § 103(a) as unpatentable over Hess and Dourish; and claims 10, 12-15, 24, 26, 33 and 34 under 35 U.S.C. § 103(a) as unpatentable over Hess and Microsoft.

Pursuant to 37 C.F.R. § 41.77(a), the above-noted reversal constitutes a new ground of rejection and is hereby designated as such. Section 41.77(b) provides that "[a] new ground of rejection . . . shall not be considered final for judicial review." That section also provides that Patent Owner, WITHIN ONE MONTH FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal proceeding as to the rejected claims:

> (1) *Reopen prosecution.* The owner may file a response requesting reopening of prosecution before the examiner. Such a response must be either an amendment of the claims so rejected or new evidence relating to the claims so rejected, or both.
>
> (2) *Request rehearing.* The owner may request that the proceeding be reheard under § 41.79 by the Board upon the same record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

In accordance with 37 C.F.R. § 41.79(a)(1), the "[p]arties to the appeal may file a request for rehearing of the decision within one month of the date of: . . . [t]he original decision of the Board under § 41.77(a)." A request for rehearing must be in compliance with 37 C.F.R. § 41.79(b). Comments in opposition to the request and additional requests for rehearing must be in accordance with 37 C.F.R. § 41.79(c) & (d), respectively. Under 37 C.F.R. § 41.79(e), the times for requesting rehearing under paragraph (a) of this section, for requesting further rehearing under paragraph (d) of this section, and for submitting comments under paragraph (c) of this section may not be extended.

An appeal to the United States Court of Appeals for the Federal Circuit under 35 U.S.C. §§ 141-144 and 315 and 37 C.F.R. § 1.983 for an *inter partes* reexamination proceeding "commenced" on or after November 2, 2002 may not be taken "until all parties' rights to request rehearing have been exhausted, at which time the decision of the Board is final and

appealable by any party to the appeal to the Board." 37 C.F.R. § 41.81. *See also* MPEP § 2682 (8th ed., Rev. 8, July 2010).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REVERSED
37 C.F.R. § 41.77(b)

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