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Paper No. 7
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTERNATIONAL BUSINESS MACHINES CORPORATION,
Petitioner,

v.

ENVISIONIT, LLC,
Patent Owner.

Case IPR2017-01248
Patent 7,693,938 B2

Before LYNNE E. PETTIGREW, DAVID C. MCKONE, and TERRENCE W. MCMILLIN, *Administrative Patent Judges*.

McMILLIN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

A. Background

International Business Machines Corporation ("Petitioner") filed a Petition (Paper 1, "Pet.") to institute an *inter partes* review of claims 1, 11–13, 42, 47, and 57 of U.S. Patent No. 7,693,938 B2 (Ex. 1001, "the '938 patent"). EnvisionIT, LLC ("Patent Owner") filed a Preliminary Response (Paper 6, "Prelim. Resp."). We have statutory authority under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." *See also* 37 C.F.R § 42.4(a) (delegating authority to the Board).

Upon consideration of the Petition and Preliminary Response, we conclude Petitioner has not established a reasonable likelihood that it would prevail with respect to any of the challenged claims. Accordingly, we decline to institute an *inter partes* review of claims 1, 11–13, 42, 47, and 57 of the '938 patent.

B. Related Matters

The parties indicate that the '938 patent has been asserted in *CellCast Technologies, LLC v. United States*, Case No. 1:15-cv-01307 (Fed. Cl.) ("*CellCast* Litigation"). Pet. 4; Paper 4, 2. The '938 patent also was the subject of *Department of Justice v. EnvisionIT, LLC*, Case IPR2017-00183 (PTAB). Pet. 4.

C. The '938 Patent

The '938 patent relates to admission control for message broadcast systems. Ex. 1001, 1:18–20. Figure 1, reproduced below, illustrates an example:

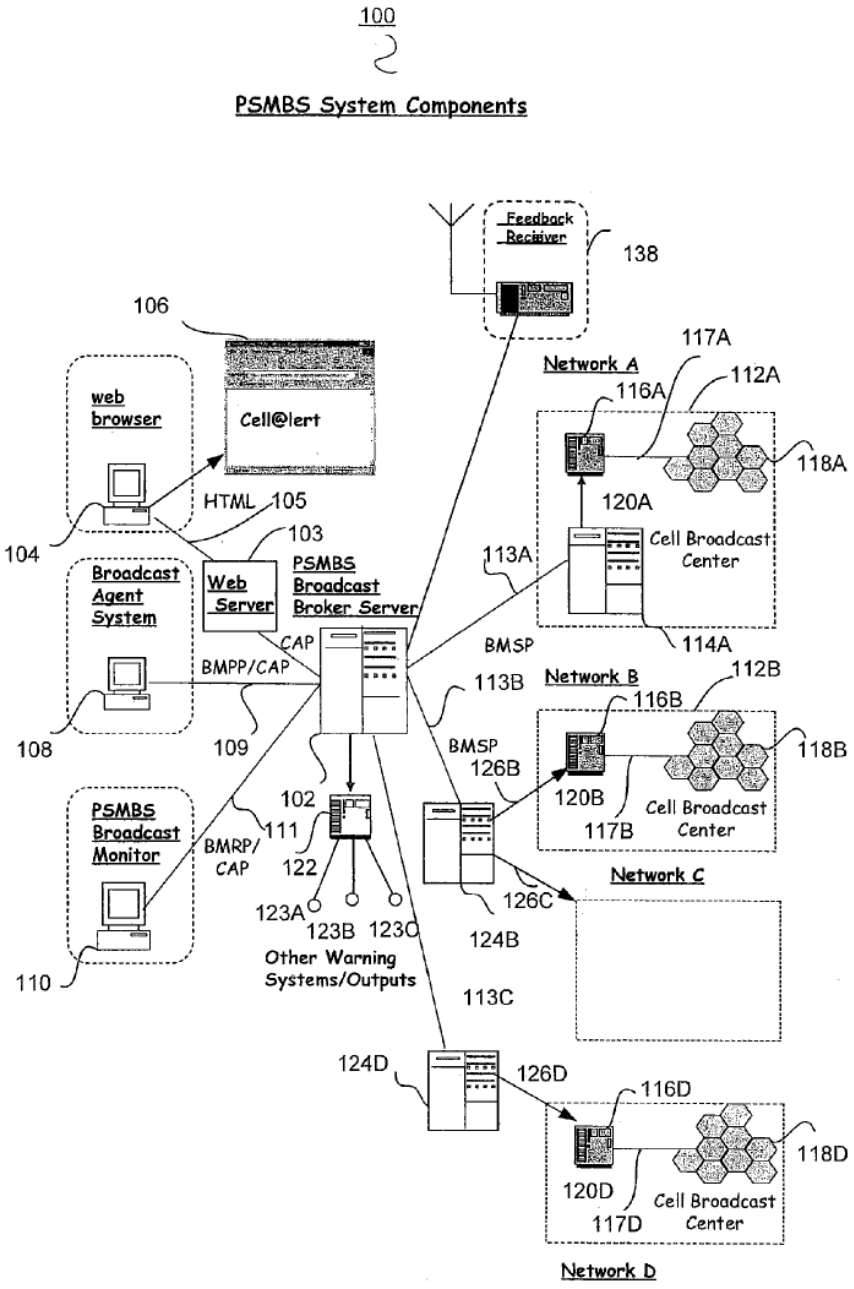

FIG. 1

Figure 1 is a functional block diagram of public service message location broadcast system ("PLBS") 100. *Id.* at 3:9–11, 5:29–30.

One or more broadcast agent devices 104 are connected to public service location broadcast service bureau ("service bureau" or "PLBS-SB")

102. *Id.* at 5:37–39. Broadcast agent device 104 provides cell@lert display 106 to a broadcast agent, who inputs a message and defines a geographic target area for delivery of the message. *Id.* at 5:39–43. Service bureau 102 also is connected to one or more local carrier networks 112A, 112B, which can include cellular carrier networks, wireline networks, satellite networks, and cable television networks. *Id.* at 6:17–25. Local carrier network 112A can include Cell Broadcast Center ("CBC") 114A that receives broadcast messages and local delivery instructions from service bureau 102. *Id*. at 6:25–29.

Service bureau 102 ensures the authenticity of the broadcast messages and the authority of the senders to create the messages. *Id*. at 6:50–52. "The signal from the Broadcast Agent Terminal 104, for example, at a police station, to the PLBS-SB 102, would only indicate the geographical area to be covered, plus the message. PLBS-SB 102 then sends the broadcast request signal to the Carrier Broadcast Center 114 at the office of each local carrier concerned." *Id.* at 6:54–59.

The '938 patent contains 59 claims. Ex. 1001, 39:21–46:17. As noted above, Petitioner challenges claims 1, 11–13, 42, 47, and 57. Pet. 1. Challenged, independent claim 1 is directed to a message broadcasting system. Ex. 1001, 39:21–43.

Claim 1, reproduced below, is illustrative of the invention:

> 1. A message broadcasting system providing a broadcast message to a broadcast target area, the system comprising:
>
> a broadcast request interface configured for receiving a broadcast message record having a broadcast message, a defined broadcast target area, and a broadcast message originator identifier;

> a broadcast admission control module configured for receiving the broadcast message record, validating the broadcast message record as a function [sic] one or more of the broadcast message originator identifier, the broadcast target area, and a broadcast message transmission network parameter associated with a broadcast transmission network adapted for broadcasting the message to at least a portion of the broadcast target area, said broadcast admission control module configured for generating a validated broadcast message record as a function of the validating; and;
>
> a broadcast message distributor module configured for receiving the validated broadcast message record and transmitting the broadcast message and the broadcast target area, or a part thereof, to an output interface configured for distributing the broadcast message to at least a portion of the broadcast target area.

D. Evidence Relied Upon

Petitioner relies on the following references:

Common Alerting Protocol Technical Working Group, *Common Alerting Protocol (v 0.5a) – Alert Message Data Dictionary, Draft 6/20/2002* (Ex. 1007, "CAP 0.5");

U.S. Patent Application Publication 2002/0103892 A1, published Aug. 1, 2002 (Ex. 1009, "Rieger"); [1]

In re Amendment of Part 73, Subpart G, of the Commission's Rules Regarding the Emergency Broadcast System, Report and Order and Further

[1] R***ie***ger is consistently misspelled "R***ei***ger" in the Petition. We have corrected these misspellings in our quotations of the Petition.

Notice of Proposed Rule Making, FCC Report No. 94-288 (Dec. 9, 1994) (Ex. 1010, "FCC 1994"); and

National Science and Technology Council, Committee on Environment and Natural Resources, Working Group on Natural Disaster Information Systems, Subcommittee on Natural Disaster Reduction, *Effective Disaster Warnings*, November, 2000 (Ex. 1013, "NSTC");

Petitioner also relies on the Declaration of Art Botterell (Ex. 1003, "Botterell Decl.") and the Declaration of Rajeev Surati, Ph.D. (Ex. 1005, "Surati Decl.").

E. The Asserted Grounds

Petitioner asserts the following grounds of unpatentability (Pet. 31, 37):

References	Basis	Claims Challenged
FCC 1994, NSTC, and CAP 0.5	§ 103(a)	1, 11–13, 42, 47, and 57
Rieger and NSTC	§ 103(a)	1, 11–13, 42, 47, and 57

II. ANALYSIS

A. Obviousness Challenge Based on FCC 1994, NSTC, and CAP 0.5

Petitioner relies on FCC 1994, NSTC, and CAP 0.5 in asserting claims 1, 11–13, 42, 47, and 57 would have been obvious. Pet. 31. With regard to CAP 0.5, Petitioner relies on CAP 0.5 as teaching or suggesting "a broadcast request interface configured for receiving a broadcast message record having a broadcast message, a defined broadcast target area, and a broadcast message originator identifier" as recited in independent claim 1.

Pet. 44–46. Petitioner also relies on CAP 0.5 in asserting independent method claim 42 is unpatentable. Pet. 50–51 ("The claimed method includes a receiving element ('receiving a broadcast message…'), similar to the receiving element of claim 1 . . . These elements are obvious over FCC 1994, NSTC, and CAP 0.5 for the same reasons that these elements are obvious in claim 1, discussed above."). The remaining challenged claims depend from claims 1 and 42. Patent Owner argues that CAP 0.5 has not been shown to have been publicly accessible and does not qualify as prior art. Prelim. Resp. 16–23. If CAP 0.5 is not shown to qualify as prior art, there is a not a reasonable likelihood that the Petitioner will prevail in the challenge to claims 1, 11–13, 42, 47, and 57 based on FCC 1994, NSTC, and CAP 0.5.

According to the Federal Circuit, "[b]ecause there are many ways in which a reference may be disseminated to the interested public, 'public accessibility' has been called the touchstone in determining whether a reference constitutes a 'printed publication'" under Section 102. *Kyocera Wireless Corp. v. Int'l Trade Comm'n*, 545 F.3d 1340, 1350 (Fed. Cir. 2008) (quoting *In re Hall*, 781 F.2d 897, 898–99 (Fed. Cir. 1986)). A reference is publicly accessible "upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it." *SRI Int'l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1194 (Fed. Cir. 2008). We assess public accessibility on a case-by-case basis. *See Kyocera*, 545 F.3d at 1350.

In *SRI International*, in the context of a motion for summary judgment, a document on an FTP server was not shown to have been

sufficiently publicly available, in part, because "the FTP server did not contain an index or catalogue or other tools for customary and meaningful research." 511 F.3d at 1196. In another example, theses deposited at a library "were not accessible to the public because they had not been either cataloged or indexed in a meaningful way." *In re Cronyn*, 890 F.2d 1158, 1161 (Fed. Cir. 1989).

In addition to CAP 0.5 (Ex. 1007) itself, Petitioner relies on the following evidence to establish CAP 0.5 qualifies as prior art: (1) paragraphs 46 and 47 of the Botterell Declaration (Ex. 1003); (2) a printout of a page from the Internet Archive (Ex. 1008); (3) a printout of comments posted to the website incident.com (Ex. 1015); and (4) a document published by the Partnership for Public Warning (Ex. 1021). Pet. 35–37. We do not find this evidence sufficient to establish the public accessibility of CAP 0.5.

With regard to the Botterell Declaration (Ex. 1003), paragraph 46 states:

> In or near June 2002 I published CAP 0.5 on www.incident.com, a website which I owned in the early 2000s and which was visited by a variety of interested parties from government (nationally and internationally), academia, and technology developers and providers. The internet archive capture at Ex. 1021 confirms my recollection that I uploaded CAP 0.5 in or near June 2002. This website had chat capabilities, which allowed viewers to comment on my posts. I found a record of comments posted to a page of incident.com on the internet archive database, "Wayback Machine," and that record is attached as Exhibit 1015.

This statement is insufficient to establish that CAP 0.5 was publicly accessible. First and foremost, Mr. Botterell does not assert, and his

statement does not contain, any facts which establish that CAP 0.5 was publicly accessible. Mr. Botterell does not state that the website was publicly accessible or that the materials, such as CAP 0.5, "published" on the website were publicly accessible or catalogued or indexed or searchable.

With regard to Exhibits 1015 and 1021, these documents are alleged to be printouts from the Internet Archive, "Wayback Machine."[2] Exhibits 1015 and 1021 fail to support the public accessibility of CAP 0.5. With regard to Exhibit 1015, the Petition states, "[m]any readers of the information posted on incident.com also contributed comments to the posts that were posted on the website, in addition of the original post by Mr. Botterell." Pet. 36. Patent Owner argues, "Petitioner has not pointed to any comments that even purport to evidence user access or downloading of the CAP 0.5 document presented in Ex. 1007, let alone user access or downloading of the CAP 0.5 document prior to the relevant priority date." Prelim. Resp. 20. We agree with Patent Owner that Exhibit 1015 does not support the public accessibility of CAP 0.5. (Ex. 1007).

With regard to Exhibit 1021, the Petition states, "[t]he CAP 0.5 document at Ex. 1007 is the document at the link on this archived page titled 'Data Dictionary'" but there is no evidence cited to support this statement.

[2] "The Internet Archive is a website that provides access to a digital library of Internet sites . . . The Internet Archive has created a service known as the Wayback Machine. The Wayback Machine makes it possible to surf more than 400 billion pages stored in the Internet Archive's web archive. Visitors to the Wayback Machine can search archives by URL (i.e., a website address). If archived records for a URL are available, the visitor will be presented with a list of available dates. The visitor may select one of those dates, and then begin surfing on an archived version of the Web." https://archive.org/legal.faq.php (last visited Sept. 19, 2017).

There is no evidence that the alleged link was active or that the linked document was CAP 0.5 (Ex. 1007). Therefore, Exhibits 1015 and 1021 do not support the public accessibility of CAP 0.5.

With regard to Exhibit 1008, the Petition states, "[a] document published by the Partnership for Public Warning, a group having the purpose of advancing the goals set forth in NSTC, commented on CAP 0.5 and suggested actions that could be taken to improve CAP." Pet. 36. In support, Petitioner cites to Exhibit 1008 at 34, 41. *Id*. at 36–37. Patent Owner argues:

> [B]oth [cited] sections of the PPW Report reference a document tilted "Common Alerting Protocol (*v.0.5*) Alert Message *Format*," which is not the title of the CAP 0.5 reference relied upon by the Petitioner. The CAP 0.5 document of Ex. 1007 is tilted "Common Alerting Protocol (*v 0.5a*) Alert Message *Data Dictionary*." The CAP document referenced in the PPW Report is not only a different document, but it also appears to pertain to a *different version* (version 0.5) of CAP [rather] than the version referenced in the CAP 0.5 document (version 0.5a). Therefore, the comments regarding "CAP" in the PPW Report are not comments pertaining to the CAP 0.5 document upon which Petitioner relies for Ground I.

Prelim. Resp. 22–23. We agree with Patent Owner. Exhibit 1008 does not support the public accessibility of CAP 0.5.

Petitioner does not present any evidence of the indexing and cataloging of CAP 0.5 or download or search capabilities related to the website or server from which Petitioner argues CAP 0.5 was accessible. Thus, the evidence in the Petition is insufficient to show that CAP 0.5 was publicly accessible as of the priority date of the '938 patent. Petitioner, therefore, has not established that CAP 0.5 is prior art to the '938 patent.

As CAP 0.5 has not been established to have been publicly accessible prior art, Petitioner has not established a reasonable likelihood that it would prevail in its challenge to claims 1, 11–13, 42, 47, and 57 based on FCC 1994, NSTC, and CAP 0.5.

B. Obviousness Challenge Based on Rieger and NSTC

Petitioner asserts claims 1, 11–13, 42, 47, and 57 would have been obvious over Rieger and NSTC. Pet. 37–39, 54–62. Patent Owner argues Petitioner fails to show the cited art teaches or suggests the "validating" limitations of independent claims 1 and 42. Prelim. Resp. 48–57. We agree with Patent Owner.

Claim 1 recites (emphasis added):

> *validating the broadcast message record* as a function [sic] one or more of the broadcast message originator identifier, the broadcast target area, and a broadcast message transmission network parameter associated with a broadcast transmission network adapted for broadcasting the message to at least a portion of the broadcast target area, said broadcast admission control module configured for *generating a validated broadcast message record as a function of the validating*.

Petitioner's entire presentation with regard to this element is:

> Third, meeting the validating element of claim 1, Rieger discloses storing "broadcast target areas" for broadcast agents and using those stored areas to validate a broadcast message record. As illustrated by the following excerpts from Rieger, the system in Rieger uses passwords to direct each user to a page that allows the user to post to only specified target areas. Some areas are geographically restricted, such that only some users are allowed to post messages to those areas. By restricting the area's [sic] to which users are allowed to post, Rieger discloses the validating element of claim 1. (Ex. 1003 (Botterell Dec.) at ¶ 66; Ex. 1005 (Surati Dec.) at ¶¶ 70–71.)

- "Administrators of the communications system 100 can restrict the nature of posting created by any particular user by defining geographic regions into which the user is either authorized or unauthorized to post. Authorized regions can be assigned optional passwords and posting category restrictions that further narrow the user's posting privileges in those regions. These controls would, for example, permit system administrators to grant specific privileges to a regional authority to create posting of particular categories, e.g., Governmental/Traffic, Governmental/Weather, to particular regions, while excluding all other users from posting these categories to the regions." (*Id*. at ¶ 81.)
- "The MASTER server's 221 database contains global system information, such as the identities and addresses of the other servers, the master list of user names, passwords, and email addresses and so forth." (*Id*. at ¶ 102.)
- "Each entry in the UserMasterIndex table contains the critical information enabling the user to log on (log-on name and password), as well as the user's system-wide unique email address. When a user attempts to log on to the communications system 200, the client tier 205 passes the log-on name and password that have been entered to the system's MASTER server 211, which is also an HTTP server. The MASTER server 211 validates the information, and upon success, redirects the client tier to the USER server 215 that hosts the user, who has now been identified." (*Id*. at ¶¶ 176–77.)
- "'Restricted' system channels are assigned at the direction of system administrators, and are made available only to users who have positively identified themselves as relevant uses [sic] of the channel, e.g., the "McLean VA Police

> Emergency" channel. Restricted channels will generally have an associated broadcast region. . ." (*Id*. at ¶ 157.)

Pet. 56–58. We have reviewed the cited passages and do not discern any teaching or suggestion of "validating the broadcast message record" or "generating a validated broadcast message record as a function of the validating" as recited in this element of claim 1. We do not agree with Petitioner that "[b]y restricting the area's [sic] to which users are allowed to post, Rieger discloses the validating element of claim 1." Pet. 57. The claim recites, "validating the broadcast message record." The cited passages relate to validating the user's log-on information and restricting the nature of the user's posting by limiting the geographic areas into which the user can post. These passages do not relate to validating a broadcast message record.

The claim recites, "generating a validated broadcast message record as a function of the validating." The cited passages fail to teach or suggest this limitation and Petitioner provides no explanation or argument relating to this limitation.

Patent Owner argues:

> [W]hen validation of a user in Rieger is performed, there is no posting and no posting "originator" (since the posting has not yet been created). Additionally, there would be no need in the system of Rieger to perform any validation of a posting made from the restricted channel based on a posting originator identifier because the user has already established that it is a trusted source by virtue of being previously authenticated to access the restricted channel.

Prelim. Resp. 51–52. We agree with Patent Owner. Thus, Petitioner has not shown a reasonable likelihood that it will prevail in establishing claim 1 would have been obvious over Rieger and NSTC.

Independent method claim 42 contains two "validating" steps. With regard to the first, the Petition states, "[t]he claimed method includes . . . a validating element ('validating the authority of a broadcast message originator…') similar to the validating element of claim 1 . . . . These elements are disclosed by Rieger by the same excerpts discussed above with respect to claim 1." Pet. 60. The second validating step in claim 42 is, "validating the broadcast transmission network against a broadcast transmission network parameter." With regard to this second "validating" step of claim 42, the Petition states, "Rieger teaches this validating step as explained above with respect to claim 1." Pet. 61. Thus, Petitioner relies on its presentation with regard to the "validating" element of claim 1 as showing Rieger teaches or suggests the two "validating" steps of claim 42. As discussed above, we do not agree that Rieger teaches or suggests the "validating" element of claim 1. And, the two "validating" steps of claim 42 are of different scope than the "validating" element of claim 1. Petitioner has failed to establish that Rieger teaches or suggests the two "validating" steps of claim 42. Therefore, Petitioner has not shown a reasonable likelihood that it will prevail in establishing claim 42 would have been obvious over Rieger and NSTC.

Claims 1 and 42 are the only challenged independent claims. Challenged claims 11–13, 47, and 57 are dependent on claims 1 and 42. As a result of failing to establish that the cited art teaches or suggests all the limitations of claims 1 and 42, Petitioner has not shown a reasonable

likelihood that it will prevail in establishing claims 1, 11–13, 42, 47, and 57 would have been obvious over Rieger and NSTC.

III. CONCLUSION

We have considered the other contentions and arguments of the parties in the Petition and Preliminary Response but, as the issues discussed above establish that the asserted challenges to the claims are not likely to prevail, we do not address the other contentions and arguments of the parties in this Decision.

Petitioner has not established a reasonable likelihood it would prevail in showing that claims 1, 11–13, 42, 47, and 57 are unpatentable.

IV. ORDER

For the reasons given, it is:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review is not instituted for claims 1, 11–13, 42, 47, and 57 of U.S. Patent No. 7,693,938 B2.

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