

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

PARALLEL NETWORKS LICENSING, LLC,
Patent Owner.

Case IPR2015-00483
Patent 5,894,554

Before KEVIN F. TURNER, JEREMY M. PLENZLER, and
CHRISTOPHER L. CRUMBLEY, *Administrative Patent Judges*.

CRUMBLEY, *Administrative Patent Judge*.

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

I. INTRODUCTION

Microsoft Corporation filed a Petition seeking *inter partes* review of claims 12–19, 32, 34, 46, and 48 of U.S. Patent No. 5,894,554 (Ex. 1001, “the ’554 patent”). Paper 1, “Pet.” The owner of the ’554 patent, Parallel Networks Licensing, LLC (“Parallel”), filed a Patent Owner’s Preliminary Response. Paper 7,¹ “Prelim. Resp.”

Pursuant to 35 U.S.C. § 314(a), we may not institute an *inter partes* review “unless the Director^[2] determines that the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Upon consideration of the briefing and supporting evidence, we determine that the information presented establishes that there is a reasonable likelihood that Microsoft would prevail with respect to claims 12–19, 32, 34, 46, and 48 of the ’554 patent. Accordingly, we institute an *inter partes* review of these claims.

A. The ’554 Patent

The ’554 patent relates to a system and method for managing dynamic Web page generation requests, and providing Web pages in response to those requests. Ex. 1001, 2:20–32. According to the patent, prior art systems were unable to handle large numbers of simultaneous incoming

¹ The Preliminary Response was filed as “Parties and Board Only” pursuant to a Motion to Seal (Paper 8); a redacted version was filed as Paper 9. Citations herein apply to both the redacted and unredacted versions.

² “The Board institutes the trial on behalf of the Director.” 37 C.F.R. § 42.4(a).

Web page requests, because a single server was responsible for both receiving the requests and providing HTML data in response to the requests. *Id.* at 3:64–4:53 (describing prior art Web server environments). The '554 patent addresses this problem by distributing processing responsibility across a plurality of servers, as illustrated in Figure 4 below:

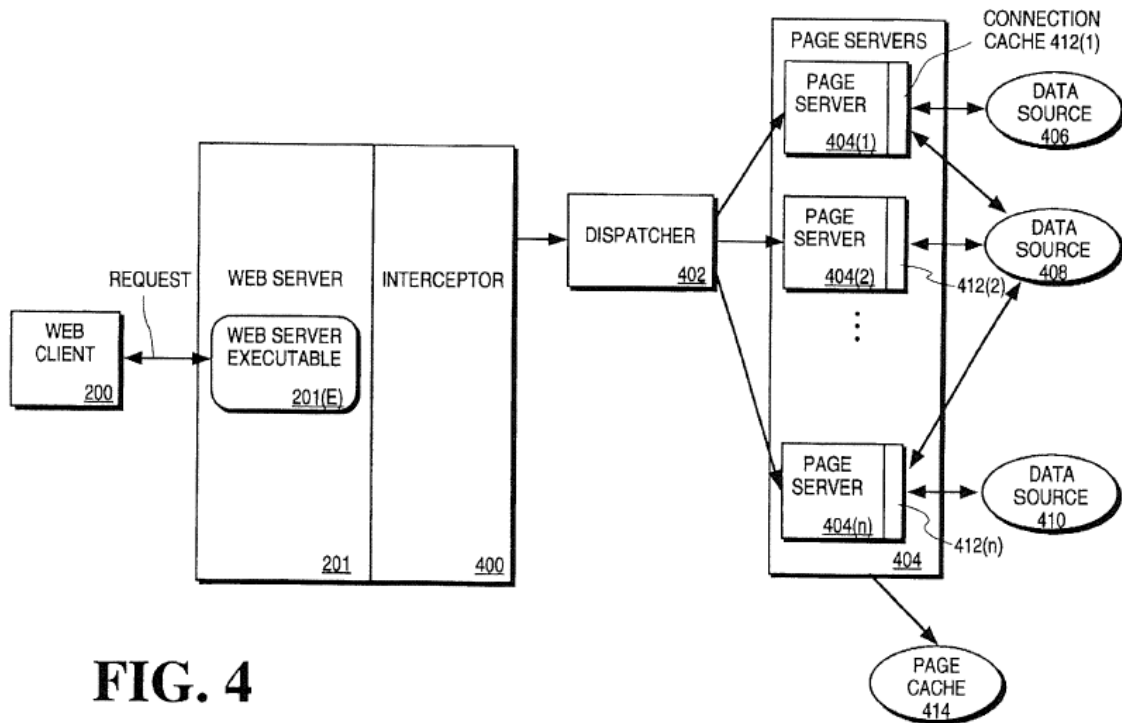


FIG. 4

Figure 4 depicts a request from Web client 200 received by Web server 201, which is then intercepted by interceptor 400 and routed by dispatcher 402 to one of a plurality of page servers 404.

In contrast to the described prior art systems, instead of Web server executable 201(E) processing the incoming Web page request, Interceptor 400 intercepts the request and routes it to Dispatcher 402, which may reside on the same machine as the Web server or on a different machine. *Id.* at 4:58–60; 5:8–36. The Dispatcher then dispatches the request to one of a

plurality of page servers, which retrieves the data necessary for processing the Web page request from one or more data sources. *Id.* at 5:37–48. The Dispatcher may take into account various criteria in selecting the appropriate page server, including whether the page server is connected to the appropriate data source, as well as the number of requests already being processed by the server (“load balancing”). *Id.* at 5:60–6:19.

1. *Illustrative Claim*

Each of the challenged claims is set forth in a Certificate of Correction which corrects the listing of claims in a Reexamination Certificate issued July 24, 2012. Ex. 1001, Certificate of Correction. Claims 12, 32, 34, 46, and 48 are independent and generally similar in format and substance.

Claim 12 is illustrative of the challenged claims and recites:

12. A computer-implemented method for managing a dynamic Web page generation request to a Web server, said computer-implemented method comprising the steps of:

routing said request from said Web server to a selected page server, said selected page server receiving said request and releasing said Web server to process other requests, wherein said routing step further includes the steps of intercepting said request at said Web server, routing said request from said Web server to a dispatcher, and dispatching, by said dispatcher, said request to said selected page server;

processing said request, said processing being performed by said selected page server while said Web server concurrently processes said other requests; and

dynamically generating a Web page by said selected page server in response to said request, said Web page including data dynamically retrieved from one or more data sources; and

wherein dispatching includes:

examining said request to make a selection of which page server should process said request from among a plurality of page servers that can each generate said Web page requested by said request;

selecting one of said plurality of page servers to dynamically generate said Web page;

wherein said selection is based on examining dynamic information regarding a load associated with each of said plurality of page servers; and

sending said request to said selected page server based on said examination.

Id.

2. *Related Proceedings*

The parties agree that Parallel has asserted the '554 Patent against Microsoft in the District of Delaware in an action captioned *Parallel Networks Licensing LLC v. Microsoft Corp.*, Civ. No. 1:13-cv-2073. Pet. 5; Paper 5, 1.

Microsoft has filed an *inter partes* review petition seeking review of additional claims of the '554 patent, in proceeding IPR2015-00484. Microsoft has also filed petitions for *inter partes* review of U.S. Patent No. 6,415,335, a divisional of the '554 patent, in proceedings IPR2015-00485 and IPR2015-00486.

B. The Asserted Grounds

Microsoft asserts the following grounds of unpatentability:

1. Whether claims 12–17, 32, 34, 46, and 48 are unpatentable under 35 U.S.C. § 102 as anticipated by SWEB 95.³
2. Whether claims 12–19, 32, 34, 46, and 48 are unpatentable under 35 U.S.C. § 103 as having been obvious over SWEB 95.
3. Whether claims 14, 15, 18, and 19 are unpatentable under 35 U.S.C. § 103 as having been obvious over SWEB 95 and Leaf.⁴
4. Whether claim 17 is unpatentable under 35 U.S.C. § 103 as having been obvious over SWEB 95 and Bradley.⁵

Pet. 4.

Microsoft presents the Declaration of Daniel Andresen (Ex. 1040), one of the authors of SWEB 95, and contends that SWEB 95 was publicly available as of September 1995, qualifying it as prior art under 35 U.S.C. § 102(a). Pet. 20. Microsoft further contends that Leaf is prior art to the '554 patent under 35 U.S.C. § 102(e), while Bradley qualifies under 35 U.S.C. § 102(a). Ex. 1007 ¶¶ 188, 194. At this stage of the proceeding, Parallel has not disputed the prior art status of the references.

C. Claim Construction

In an *inter partes* review, “[a] claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the

³ Daniel Andresen et al., *SWEB: Towards a Scalable World Wide Web Server on Multicomputers*, Dept. of Computer Sci. Tech. Report TRCS95-17, U.C. Santa Barbara, 1–25 (Sept. 1995) (Ex. 1009).

⁴ U.S. Patent No. 5,754,772 (May 19, 1998) (Ex. 1060).

⁵ S.W. Bradley et al., *Web-based Access to an Online Atlas of Anatomy: The Digital Anatomist Common Gateway Interface*, 512–16 (1995) (Ex. 1048).

patent in which it appears.” 37 C.F.R. § 42.100(b); *see also In re Cuozzo Speed Tech., LLC*, No. 2014-1301, 2015 WL 4097949, at *7–*8 (Fed. Cir. July 8, 2015) (“Congress implicitly approved the broadest reasonable interpretation standard in enacting the [America Invents Act (“AIA”)],” and “the standard was properly adopted by PTO regulation”), *reh ’g en banc denied*. Under this standard, we construe claim terms using “the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.” *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). We presume that claim terms have their ordinary and customary meaning. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) (“The ordinary and customary meaning is the meaning that the term would have to a person of ordinary skill in the art in question.”) (internal citation and quotation marks omitted). A patentee may rebut this presumption, however, by acting as his own lexicographer, providing a definition of the term in the specification with “reasonable clarity, deliberateness, and precision.” *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

Microsoft proffers claim constructions for thirteen claim terms (Pet. 10–19); Parallel does not set forth an explicit construction for any term. Upon review of the record and the parties’ positions, we determine that only the terms *Web server* and *page server* require a construction⁶ at this stage of

⁶ We note that the ’554 patent is scheduled to expire on April 23, 2016, potentially during the pendency of the instituted *inter partes* review. In such

the proceeding. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (“only those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.”).

1. *Web server*

Microsoft contends that the broadest reasonable interpretation of *Web server* is “software, or a machine having software, with the capability to receive and process, in whole or at least in part, Web page requests.” Pet. 10. Parallel does not provide an explicit construction for this term, and cites Microsoft’s proposed construction without disagreement. Prelim. Resp. 22.

We note that, after Microsoft filed its Petition, the District Court in the copending patent infringement action between the parties construed various terms in the ’554 patent, including *Web server*. Ex. 3001, 2. Judge Robinson, applying the claim construction standard of *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), adopted the construction “[s]oftware, or a machine having software, that receives Web page requests and returns Web pages in response to the requests.” *Id.*

Microsoft argues that the final phrase of the District Court’s construction, “returns Web pages in response to the requests,” should instead be “process, in whole or at least in part, Web page requests.” Pet. 10.

situations, upon expiration of the patent, the Board has considered previously construed terms in light of the District Court claim construction standard. *See Google Inc. v. Createads LLC*, Case IPR2014-00200, slip op. at 2 (PTAB July 16, 2014) (Paper 19) (applying *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc)). If necessary, we will revisit the constructions set forth herein upon the expiration of the ’554 patent.

Microsoft’s expert, Michael D. Mitzenmacher, testifies that under the broadest reasonable interpretation standard, the additional limitation of “returns Web pages” is inappropriate, because the ’554 patent discloses embodiments in which Web servers do not return Web pages. Ex. 1007 ¶¶ 96–97.

On this record, we agree with Petitioner’s argument that requiring a *Web server* to return Web pages in response to requests would be inconsistent with the broadest reasonable interpretation standard. The specification of the ’554 patent does not define *Web server*, but provides the following summary of the invention:

[T]he present invention claims a computer-implemented method for managing a dynamic *Web page generation request to a Web server*, the computer-implemented method comprising the steps of routing the request from the Web server to a page server, the page server receiving the request and *releasing the Web server to process other requests*, processing the request, the processing being performed by the page server concurrently with the Web server, *as the Web server processes the other requests*, and dynamically generating a Web page in response to the request, the Web page including data dynamically retrieved from one or more data sources.

Ex. 1001, 2:20–32 (emphases added). In other words, a *Web server* must: 1) receive a page generation request; and 2) “process” requests that are not routed to a page server. *See id.* at 6:21–28 (“While Page server is processing the request, Web server executable can concurrently process other Web client requests. This partitioned architecture thus allows both Page server and Web server executable to simultaneously process different requests.”) (internal numbering omitted).

The '554 patent does not, however, state that the *Web server* must return a Web page. Rather, it notes that the dynamic Web pages generated by the page server are “either transmitted back to [the] requesting Web client or stored on a machine that is accessible to [the] Web server, for later retrieval.” *Id.* at 6:28–32 (internal numbering omitted). Left unspecified is *what* is responsible for the transmission. While we note that Figure 5 of the '554 patent shows an example in which the *Web server*, in block 522, “sends new HTML document to client,” the specification describes this as “one embodiment of the presently claimed invention.” *Id.* at Fig. 5; 8:26–28. We decline to limit the claims to this exemplary embodiment.

We, therefore, construe *Web server* as “software, or a machine having software, that receives Web page requests and may process said requests.”

2. *page server*

Microsoft contends that the broadest reasonable interpretation of *page server* is “software, or a machine having software, that locates or generates a Web page.” Pet. 10. Parallel does not provide an explicit construction for this term, but cites Microsoft’s proposed construction without disagreement. Prelim. Resp. 22. In the copending District Court action, the parties agreed to construe the term as “page-generating software that generates a dynamic Web page.” Ex. 1021, 6.

Microsoft argues, however, that limiting *page server* to only software that generates dynamic Web pages ignores the '554 patent’s disclosure that systems according to the invention may also utilize page caching, in which previously generated pages that are frequently accessed are cached for later retrieval, rather than re-generated. Pet. 10–11; Ex. 1001, 6:66–7:7. We

agree, and determine on this record that the broadest reasonable interpretation of *page server* should encompass both generating, and locating previously generated, Web pages. We, therefore, adopt Microsoft's proposed construction of "software, or a machine having software, that locates or generates a Web page."

II. PROCEDURAL MATTERS

Prior to addressing the merits of Microsoft's Petition, we address two procedural matters raised by Parallel in its Preliminary Response. Prelim. Resp. 7–16. First, Parallel contends that the statutory bars of 35 U.S.C. § 315(a)(1) and (b) bar Microsoft's Petition. Second, Parallel asks that we deny institution under 35 U.S.C. § 325(d), because the art and arguments in the Petition are substantially the same as those previously presented to the Office. We address these issues in turn.

A. 35 U.S.C. § 315(a)(1) and (b)

The copending District Court action is not the first between the parties involving the '554 patent. In November of 2008, Microsoft filed an action for declaratory judgment of invalidity of the '554 patent in the District of Delaware. Ex. 1050. Parallel also sued Microsoft in May of 2009 for infringement of the '554 patent in the Eastern District of Texas. Ex. 1053.

Normally, the filing of a declaratory judgment action challenging the validity of the patent bars a Petitioner from later seeking review of the patent in an *inter partes* review proceeding. 35 U.S.C. § 315(a)(1). Similarly, an *inter partes* review petition must be filed within one year of the petitioner being served with a complaint alleging infringement of a patent. 35 U.S.C.

§ 315(b). Absent other facts, under either of these provisions the present Petition would be barred, as it was filed on December 23, 2014, after the declaratory judgment action was filed and over a year after the infringement complaint was served.

The parties, however, settled both their cases on June 29, 2012, entering into a Dismissal Agreement signed August 2, 2012. Ex. 2001. As a result, both the declaratory judgment action and the infringement action were voluntarily dismissed without prejudice. We have noted that the “Federal Circuit has consistently interpreted the effect of such dismissals as leaving the parties as though the action had never been brought.” *Macauto U.S.A. v. Bos GmbH & KG*, Case IPR2012-00004, slip op. at 15 (PTAB Jan. 24, 2013) (Paper 18) (*citing Graves v. Principi*, 294 F.3d 1350, 1356 (Fed. Cir. 2002); *Bonneville Assocs., Ltd. P’ship v. Baram*, 165 F.3d 1360, 1364 (Fed. Cir. 1999)). Because the effect of a voluntary dismissal without prejudice is to render the prior action a nullity, the Board has held that such actions cannot give rise to statutory bars under 35 U.S.C. §§ 315(a)(1) or (b).

Parallel attempts to distinguish the present case from the previous ones addressed by the Board, because the Dismissal Agreement between the parties contains various provisions that give “on-going legal effect” to the dismissed actions. Prelim. Resp. 9.⁷ This allegedly “reflects the parties’

⁷ Parallel filed a Motion to Seal this portion of its Preliminary Response, contending that the provisions of the Dismissal Agreement discussed therein are confidential settlement terms. Paper 8, 2. While we reserve ruling on the Motion to Seal at this time, we note that, even if the terms of the Dismissal Agreement are confidential, Parallel’s argument regarding “on-

express intention to recognize the existence and continuing import of the Previous Actions—even after the agreed-to dismissals ‘without prejudice.’” *Id.* at 10.

We need not discuss the particular terms of the Dismissal Agreement, because, even if we accept Parallel’s assertion that the parties intended to give “ongoing legal effect” to the dismissed actions, it does not change the fact that a voluntary dismissal without prejudice, from the point of view of the courts, renders the prior action a nullity. The fact that the parties to that action may, between themselves, contractually agree to terms that would never have been agreed to absent the action’s existence, does not change the *de jure* legal effect of the dismissal. Parallel directs us to no authority that holds that an agreement between private parties can alter the legal effect of a voluntary dismissal without prejudice.

Nor do we consider the Board’s decision in *Callidus Software Inc. v. Versata Software, Inc.*, Case CBM2013-00053 (PTAB Apr. 9, 2014) (Paper 22), cited by Parallel, to mandate a different outcome. Parallel directs us to the *Callidus Software* panel’s statement that “while Patent Owner envisions petitioners filing declaratory judgments, settling, and then filing institutable petitions, it would appear that a proper settlement could mitigate the problems outlined.” *Id.* at 6. According to Parallel, this is exactly what it did with Microsoft in the Dismissal Agreement, by agreeing to give the dismissed actions “on-going legal effect.” Prelim. Resp. 11.

going legal effect” of the dismissed actions, and the parties’ alleged intent in agreeing to the Dismissal Agreement, is not.

We disagree with Parallel's interpretation of *Callidus Software*. If parties to a settlement agreement wish to prevent filing of *inter partes* review petitions following the dismissal of their District Court actions, they may do so by including explicit prohibitions on such filings. We presume that such terms are the type contemplated by the *Callidus Software* panel's discussion of "a proper settlement." The Dismissal Agreement between Microsoft and Parallel, however, contains no prohibition on Microsoft filing *inter partes* review petitions, even though it was dated after the enactment of the America Invents Act, which created such reviews. If the parties had intended to give "on-going legal effect" to the actions such that *inter partes* reviews would be barred, they easily could have included such prohibitions.

In sum, we do not consider the Dismissal Agreement to give us any reason to depart from the Board's consistent position that a prior action that is voluntarily dismissed without prejudice does not give rise to 35 U.S.C. §§ 315 (a)(1) or (b) statutory bars. On the present record, Microsoft is not barred from bringing the instant Petition.

B. 35 U.S.C. § 325(d)

Parallel also contends that the Board should deny Microsoft's Petition because the primary reference relied upon for its invalidity grounds, SWEB 95, was previously presented to the Office. Under 35 U.S.C. § 325(d), we "may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office." We note, however, that while this provision gives the Board authority to decline to institute review if art or arguments have

been presented previously to the Office, the statute does not *require* any particular outcome.

Parallel first notes that, during the prosecution of U.S. Patent No. 6,415,335 (a divisional of the '554 patent) a reference referred to as "SWEB 96"⁸ was cited to the Office. Prelim. Resp. 13. According to Parallel, SWEB 96 contains all material content of SWEB 95 that is relied on in the Petition. *Id.* at 14. Additionally, Parallel notes that, during an *ex parte* reexamination of the '554 patent, it submitted SWEB 95 to the Office in an Information Disclosure Statement. *Id.* at 15 (citing Ex. 2006, 20).

We have considered several factors in determining whether to deny institution on the basis of 35 U.S.C. § 325(d), including the following. First, we note that the presentation of SWEB 96 was during the prosecution of a child patent application, not the application that matured into the '554 patent, and therefore it has less relevance to the challenged claims. In addition, while SWEB 95 was listed on a lengthy Information Disclosure Statement initialed by the Examiner, the reference was not applied against the claims and there is no evidence that the Examiner considered the particular disclosures cited by Microsoft in the Petition. Finally, we note the *ex parte* nature of the reexaminations differs from the adversarial nature of an *inter partes* review. Though we recognize that SWEB 95 (and the related SWEB 96) were previously presented to the Office, on these facts we decline to deny the Petition on the basis of 35 U.S.C. § 325(d).

⁸ Daniel Andresen et al., *SWEB: Towards a Scalable World Wide Web Server on Multicomputers*, Proceedings of the IPSPS '96, 850–56 (Apr. 1996) (Ex. 1010).

III. ANALYSIS OF GROUNDS

A. Anticipation by SWEB 95

Microsoft contends that claims 12–17, 32, 34, 46, and 48 are unpatentable under 35 U.S.C. § 102 as anticipated by SWEB 95. Pet. 24–42. The Petition sets forth where each element of the challenged claims is said to be disclosed by SWEB 95. *Id.* Microsoft also submits the Declaration of Dr. Michael D. Mitzenmacher, who testifies regarding SWEB 95 and maps the disclosure of the reference to the elements of the challenged claims. Ex. 1007 ¶¶ 198–293, 405–24, 437–52, 486–99, 503–16.

SWEB 95 discloses a “Scalable Web server” (SWEB) built on a network of computers, which permits distributed processing of Web page requests. Ex. 1009, 1–2. A scheduler on the network monitors the usage of system resources, and routes requests to computers on the network accordingly. *Id.* at 8–9. The scheduler can be centralized on one processor such that all requests go through it, or it can be distributed across all the computers on the network. *Id.* Figure 6 of SWEB 95, reproduced below, shows the operation of one system having a distributed scheduler:

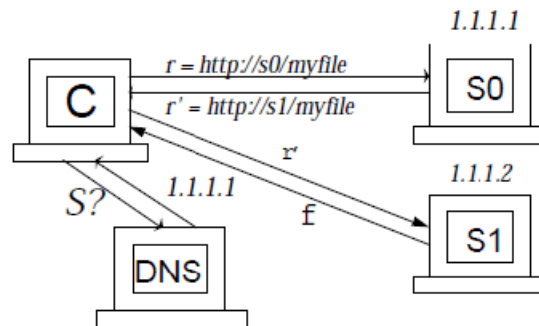


Figure 6: The URL redirection.

Figure 6 of SWEB 95 depicts a system comprising client computer C, a DNS server, and servers S0 and S1.

According to Figure 6, client computer C sends a request for a file located at URL r, that is routed by the DNS server to server S0. *Id.* at 10–11. If the distributed scheduler determines that the request is best processed by server S1, S0 returns a rewritten URL r' to the client directing the client to server S1. *Id.* S1 then processes the request and returns file f. *Id.* The reference states that “[m]ost Net browsers and clients automatically query the new location, so redirection is virtually transparent to the user.” *Id.*

Microsoft contends that the SWEB 95 system discloses all elements of claims 12–17, 32, 34, 46 and 48. For example, with respect to claim 12, Microsoft argues that the routing step is met by the routing of a request from a first server (S0 in Figure 6) to a second server (S1) which then fulfills the request, thereby releasing the first server to process other requests. Pet. 25–27. The “dispatcher” limitation of claim 12 is said to be met by the distributed scheduling algorithm, which intercepts the request and routes it to another server. *Id.* at 28–29. The processing server (S1 in Figure 6) then retrieves a file or invokes a CGI program in order to respond to the request, which Microsoft contends satisfies the step of “dynamically generating a Web page.” *Id.* at 29–30.

Parallel argues that SWEB 95 does not disclose *Web servers* or *page servers*, contending that Microsoft’s analysis of the reference uses the two terms interchangeably. Prelim. Resp. 22. According to Parallel, the *Web servers* and *page servers* of the ’554 patent are different things, and Microsoft identifies all the servers in the SWEB architecture as both. *Id.* In

Parallel's view, SWEB 95 only discloses *Web servers*, which then may, if the scheduler instructs, redirect requests to other *Web servers*. *Id.* at 19–20. Parallel distinguishes this from the architecture described in the '554 patent, in which all requests are passed through one *Web server* and then dispatched to one of a plurality of *page servers*. *Id.* at 20–21.

We are not persuaded by Parallel's arguments. As disclosed by SWEB 95, for a single request, there is a server which receives the request (S0) and a server which locates or generates a Web page (S1). These characteristics satisfy our construction of *Web server* and *page server*. Neither the language of the challenged claims, nor our constructions of *Web server* or *page server*, requires a server perform the same role for all incoming requests.

The challenged claims are directed to the management of *a* dynamic Web page generation request. In other words, the claims focus on the handling of a single request. In the context of one request, a server is designated as the *Web server*, while another is the *page server*. For the next request, however, it is within the scope of the claims that the servers could switch roles, or the *Web server* could route the request to a different *page server*. Indeed, the specification of the '554 patent recognizes that *Web servers* and *page servers* share the same capabilities, and may act in different manners in response to different requests. Ex. 1001, 6:21–28 (“While Page server is processing the request, Web server executable can concurrently process other Web client requests. This partitioned architecture thus allows both Page server and Web server executable to simultaneously process different requests.”) (internal numbering omitted).

Microsoft's analysis of how the elements of the challenged claims are disclosed by the SWEB 95 reference is reasonable and persuasive at this stage of the proceeding. We, therefore, conclude that there is a reasonable likelihood that Microsoft will prevail in showing that claims 12–17, 32, 34, 46, and 48 are anticipated by SWEB 95, and institute trial on this ground.

B. Obviousness over SWEB 95

Anticipating various potential counterarguments, Microsoft asserts that, even if claims 12–17, 32, 34, 46, and 48 are not anticipated by SWEB 95, it would have been obvious to modify SWEB 95 to meet the claims. Pet. 42–49. In addition, Microsoft alleges that claims 18 and 19 are obvious over SWEB 95. *Id.* at 52–53. Microsoft relies on the testimony of Mr. Mitzenmacher to provide the level of ordinary skill in the art and discuss the motivations of the person of ordinary skill to modify SWEB 95. *See, e.g.*, Ex. 1007 ¶¶ 161–63 (level of skill); ¶ 214 (obviousness of routing step). Parallel does not challenge any of Microsoft's obviousness contentions at this stage of the proceeding.

As an example, Microsoft argues that to the extent SWEB 95 does not disclose “said processing being performed by said selected page server while said Web server concurrently processes said other requests,” as required by the challenged claims, this element would have been obvious to a person of ordinary skill. Pet 46–47. According to Microsoft, SWEB 95's discussion of “load balancing” suggests that routing a request to another server frees the first server to concurrently process another request. *Id.*; *see* Ex. 1007 ¶ 235.

As an additional example, dependent claim 18 requires that the page server “includes custom HTML extension templates for configuring said

Web page.” Microsoft contends that this limitation would have been obvious from the disclosure of SWEB 95. Pet. 52–53. Mr. Mitzenmacher testifies that HTML templates were well known in the art at the time of the invention, had known advantages, and would have been within the level of skill of the ordinary artisan to incorporate in SWEB 95 given the reference’s disclosure of executing CGI scripts to return dynamic Web pages. Ex. 1007 ¶ 303.

We find Microsoft’s uncontested analysis of how the challenged claims would have been obvious over the disclosure of SWEB 95 to be persuasive at this stage of the proceeding. On this record, we are satisfied that there is a reasonable likelihood that Microsoft will prevail in showing claims 12–19, 32, 34, 46, and 48 are unpatentable under 35 U.S.C. § 103 as having been obvious over SWEB 95, and institute trial on this ground.

C. Obviousness over SWEB 95 and Leaf

Microsoft contends that claims 14, 15, 18, and 19 are unpatentable under 35 U.S.C. § 103 as having been obvious over the combined disclosures of SWEB 95 and Leaf. Pet. 54–59. Microsoft identifies various limitations of the dependent claims that are arguably not disclosed by SWEB 95 alone, and sets forth how the limitations are disclosed by Leaf. *Id.* For example, with respect to claim 18’s recitation of “custom HTML extension templates for configuring said Web page” discussed above, Microsoft points out that Leaf discloses creation of an HTML document by inserting data into an HTML template. *Id.* at 57 (citing Ex. 1060, 8:51–59). Similarly, Microsoft notes that Leaf discloses a Transaction Gateway Client which retrieves information from data sources and transforms those data into a

Web page, thus meeting claim 14's requirement of "dynamically generating said Web page includ[ing] the step of dynamically retrieving said data from said one or more data sources." *Id.* at 55 (citing Ex. 1060, 6:27–34).

Microsoft argues that it would have been obvious to combine the disclosures of Leaf with SWEB 95, as both are concerned with the problem of efficiently accessing data sources over the World Wide Web, and cites Mr. Mitzenmacher's testimony on this point. *Id.* (citing Ex. 1007 ¶ 269).

We find that Microsoft's Petition and Mr. Mitzenmacher reasonably set forth how the elements of claims 14, 15, 18, and 19 are disclosed by the combination of SWEB 95 and Leaf, and that a person of ordinary skill would have had reason to combine the references. On this record, we are satisfied that there is a reasonable likelihood that Microsoft will prevail in showing claims 14, 15, 18, and 19 are unpatentable under 35 U.S.C. § 103 as having been obvious over the combined disclosures of SWEB 95 and Leaf, and institute trial on this ground.

D. Obviousness over SWEB 95 and Bradley

Claim 17 adds the additional limitation of "wherein said step of dynamically generating said Web page includes the step of maintaining a page cache containing said Web page." Microsoft argues that this limitation is disclosed by Bradley, which discusses maintaining a cache of GIF files that were previously converted from PICT format by a CGI program running on a Web server. Pet. 59–60 (citing Ex. 1048, 515). According to Microsoft, it would have been obvious to modify SWEB 95 to incorporate this feature of Bradley, because Bradley teaches that caching GIF files would reduce processing demand and therefore would improve the

performance of SWEB. *Id.* at 60; Ex. 1007 ¶ 298. Parallel does not address the disclosure of Bradley or its combination with SWEB 95 at this stage of the proceeding.

Upon review, Microsoft persuasively sets forth the disclosures of Bradley and why a person of ordinary skill in the art would have had reason to combine the disclosures of Bradley with SWEB 95. We, therefore, conclude that Microsoft has presented sufficient evidence to establish a reasonable likelihood that it would prevail in showing claim 17 is unpatentable under 35 U.S.C. § 103 as having been obvious over the combined disclosures of SWEB 95 and Bradley, and institute trial on this ground.

IV. CONCLUSION

For the forgoing reasons, we determine that the information presented in the Petition and Preliminary Response establishes that there is a reasonable likelihood that Microsoft would prevail with respect to claims 12–19, 32, 34, 46, and 48 of the '554 patent.

At this stage of the proceeding, the Board has not made a final determination as to the patentability of any challenged claim.

V. ORDER

Accordingly, it is

ORDERED that pursuant to 35 U.S.C. § 314, an *inter partes* review is hereby instituted as to claims 12–19, 32, 34, 46, and 48 of the '554 patent on the following grounds:

1. Whether claims 12–17, 32, 34, 46, and 48 are unpatentable under 35 U.S.C. § 102 as anticipated by SWEB 95.
2. Whether claims 12–19, 32, 34, 46, and 48 are unpatentable under 35 U.S.C. § 103 as having been obvious over SWEB 95.
3. Whether claims 14, 15, 18, and 19 are unpatentable under 35 U.S.C. § 103 as having been obvious over SWEB 95 and Leaf.
4. Whether claim 17 is unpatentable under 35 U.S.C. § 103 as having been obvious over SWEB 95 and Bradley.

FURTHER ORDERED that no other ground of unpatentability alleged in the Petition for any claim is authorized for this *inter partes* review;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(d) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial, the trial commencing on the entry date of this Decision.

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Patent 5,894,554

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