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Fed. Circ. Nixes More Claims Of Patents Fought By Facebook

By **Kelly Knaub**

Law360, New York (September 9, 2016, 5:15 PM EDT) -- The Federal Circuit concluded Friday that the U.S. Patent Trial and Appeal Board did not go far enough in invalidating claims of two database patents asserted against Facebook, Twitter and LinkedIn in two America Invents Act inter partes reviews, saying it should have invalidated even more.

In a per curiam opinion, the appeals court rejected arguments made by Software Rights Archive LLC that the PTAB erred in invalidating a handful of claims of each of its U.S. Patent Numbers 5,832,494 and 6,233,571 as obvious over prior art and further said the PTAB, in fact, wrongly confirmed the patentability of at least four more claims of the '494 patent as anticipated by prior art and at least one additional claim of the '571 patent as obvious over prior art.

Facebook Inc., LinkedIn Corp. and Twitter Inc. had cross-appealed the board's decision confirming the patentability of other claims.

"We affirm the determinations of the Patent Trial and Appeal Board that claims 18–20, 45, 48–49, 51, and 54 of the '494 patent and claims 12 and 22 of the '571 patent are unpatentable on the ground of obviousness, but reverse its determinations that claims 1, 5, 15, and 16 of the '494 patent and claim 21 of the '571 patent are patentable over the prior art," the Federal Circuit said.

The board noted in its decision that it recently affirmed the board's determination that seven claims of Software Rights Archive's U.S. Patent Number 5,544,352 are unpatentable as obvious.

The trio of patents, referred to in the suit as the "Egger patents," after Daniel Egger, are directed to using indirect citation relationships between records, court records show. For example, if Document A and Document B both cite Document C, the three would be grouped together to improve search and retrieval, as the social media companies explained in their filings.

Egger was a law student in 1993 when he allegedly discovered the value of these relationships for search, according to filings in the case.

Circuit Judge Raymond T. Chen partly dissented in Friday's decision on the part of the ruling backing Facebook and the other social media giants, saying he would have fully affirmed the PTAB's decision finding some claims invalid and confirming others.

Software Rights Archive asserted the patents against the companies in a July 2012 infringement suit in

Northern California federal court. In response to the lawsuit, Facebook, Twitter and LinkedIn petitioned PTAB to review the validity of the claims, proffering prior art references that allegedly rendered the patents-in-suit invalid.

Attorneys for the parties did not respond to a request for comment on Friday.

The patents in suit are U.S. Patent Nos. 5,544,352, 5,832,494 and 6,233,571.

U.S. Circuit Judges Pauline Newman, Haldane Robert Mayer and Raymond T. Chen sat on the panel.

Software Rights Archive is represented by Victor G. Hardy and Minghui Yang of DiNovo Price Ellwanger & Hardy LLP and Martin M. Zoltick and Soumya Panda of Rothwell Figg Ernst & Manbeck PC.

Facebook is represented by Heidi L. Keefe, Lowell D. Mead, Carrie J. Richey and Mark R. Weinstein of Cooley LLP.

LinkedIn and Twitter are represented by David Silbert, Sharif E. Jacob and Philip J. Tassin of Keker & Van Nest LLP.

The cases are Software Rights Archive LLC v. Facebook Inc. et al., case numbers 15-1648, 15-1649, and 15-1652, in the U.S. Court of Appeals for the Federal Circuit.

--Additional reporting by Kat Greene and Jimmy Hoover. Editing by Jill Coffey.
