

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2018-00282
Patent 7,092,671 B2

Before MIRIAM L. QUINN, CHARLES J. BOUDREAU, and
GARTH D. BAER, *Administrative Patent Judges*.

Opinion of the Board filed by Administrative Patent Judge BAER.

Opinion Concurring filed by Administrative Patent Judge QUINN.

FINAL WRITTEN DECISION

35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

Petitioner, Apple Inc., filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–7 and 9–15 of U.S. Patent No. 7,092,671 B2 (Ex. 1001, “the ’671 patent”). Pursuant to 35 U.S.C. § 314(a), we determined Petitioner showed a reasonable likelihood that it would prevail in establishing the unpatentability of all challenged claims and instituted an *inter partes* review. Paper 7, 12–13. Patent Owner Uniloc Luxembourg, S.A. filed a Response (Paper 11, “Resp.”), and Petitioner filed a Reply to Patent Owner’s Response (Paper 14, “Reply”). An oral hearing was held before the Board. Paper 29.

We issue this Final Written Decision pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. Having considered the record before us and as explained below, we determine Petitioner has shown by a preponderance of the evidence that claims 1–7 and 9–15 of the ’671 patent are unpatentable. *See* 35 U.S.C. § 316(e).

A. RELATED PROCEEDINGS

Petitioner and Patent Owner identify several related litigations in the Eastern District of Texas involving the ’671 patent. Pet. 1; Paper 4, 2. Another petitioner has also requested *inter partes* review of the ’671 patent in IPR2018-00199.

B. THE ’671 PATENT

The ’671 patent is directed to a “method and system for wirelessly autodialing a telephone number from a record stored on a personal information device.” Ex. 1001, [54]. According to the ’671 patent, at the time of filing, personal information devices (“PIDs”) and electronic organizers were in widespread use. *Id.* at 1:35–37. The ’671 patent describes these devices as “physically smaller,” having “more limited

hardware and data processing capabilities” than conventional computers, and including “a screen and data processor,” “substantial electronic memory,” and “a substantial variety of applications,” relating to, for example, contact information made up of addresses and telephone numbers. *Id.* at 1:14–33. In addition to PIDs, the ’671 patent describes cellphones as widely used handheld digital devices similar to PIDs, but with substantially fewer applications, less available memory for storage, and a limited capacity for data entry. *Id.* at 1:38–53.

Because of these differences between PIDs and cellphones, the ’671 patent observes that PIDs, and not cellphones, are used to store contact information. *Id.* at 1:54–63. This leads to a requirement for users to find contact numbers on their PID and then manually dial those numbers on the cellphone. *Id.* at 1:58–2:10. Thus, the ’671 patent identifies a need for “a method whereby a user’s handheld PID can automatically dial a telephone number stored in its memory” such that the user need not access controls of a telephone. *Id.* at 2:11–22.

To solve this problem, the ’671 patent describes using the wireless ports of the telephone and the PID to link the two devices using a standard communication protocol, such as short-range radio frequency (“RF”) over Bluetooth or infrared signals (“IR”) over the Infrared Data Association (“IrDA”) specification. *Id.* at 4:40–5:27, 6:35–57. The ’671 patent describes a method in which the user chooses a phone number from the memory of the PID, using the appropriate application, and indicates to the PID that the chosen number should be dialed by a cellphone. *Id.* at 8:10–17. In response, the PID application accesses the cellphone, transmits the desired telephone number, and “control[s] [the cellphone] to dial the number

and establish[] the telephone call” in a manner that is seamless and “without requiring any intervening steps or actions by the user” or involving direct interaction with the cellphone. *Id.* at 8:17–25. Figure 8, reproduced below, shows a flowchart of the steps in one embodiment of this autodialing process. *Id.* at 9:39–41.

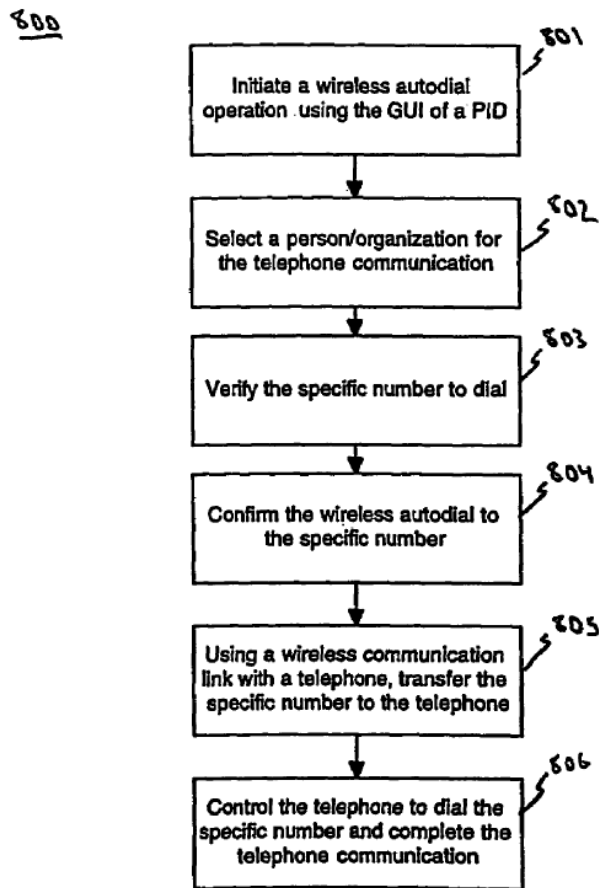


FIG. 8

The flow chart of Figure 8, above, begins with step 801—the user accessing the graphical user interface (“GUI”) of a PID to initiate wireless autodialing of a cellphone. *Id.* at 9:46–47. The user chooses the desired contact from a list displayed by the PID in step 802, verifies the correct

phone number in step 803, and confirms that the number should be autodialed by the cellphone in step 804. *Id.* at 9:55–59. The PID, in step 805, transfers the chosen number to the cellphone over the wireless communication link. *Id.* at 9:62–64. Finally, in step 806, the PID “controls telephone 14 to dial the specific number and complete the telephone communication.” *Id.* at 9:65–67.

C. ILLUSTRATIVE CLAIM

Of the challenged claims, claims 1 and 9 are independent. Claim 1 is illustrative of the claims at issue and is reproduced below with added indentations and spacing for clarity.

1. An automated telephone dialing system, comprising:
 - a telephone having a wireless port for short range wireless data transfer; and
 - a handheld computer system having a wireless port for communication with the wireless port on the telephone, wherein a specific telephone number is selectable from a list displayed on the handheld computer system and
 - wherein the handheld computer system is operable to transfer the specific telephone number to the telephone using a wireless communication, and
 - wherein the handheld computer system is configured to control the telephone via the wireless communication such that the telephone dials the specific telephone number.

Ex. 1001, 10:55–67.

D. ASSERTED GROUNDS OF UNPATENTABILITY

Petitioner asserts the following grounds of unpatentability:

References	Basis	Challenged Claims
Yun ¹ and Kikinis ²	§ 103	1–6 and 9–14
Yun, Kikinis, and Inoue ³	§ 103	7 and 15
Harris ⁴ and Kikinis	§ 103	1–7 and 9–15

Pet. 7.

II. ANALYSIS

A. REAL PARTIES IN INTEREST

A petition must identify all real parties in interest (“RPIs”). 35 U.S.C. § 312(a)(2). The petitioner bears the burden of persuasion to show that it accurately names all RPIs. *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1343 (Fed. Cir. 2018) (“AIT”) (citing *Zerto, Inc. v. EMC Corp.*, Case IPR2014-01295, slip op. at 6–7 (PTAB Mar. 3, 2015) (Paper 34)). We generally accept a petitioner’s initial identification of its RPIs unless the patent owner presents some evidence to support its argument that an unnamed party should be included as an RPI. *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242 (Fed. Cir. 2018).

Whether a particular entity is an RPI is a “highly fact-dependent question” that is assessed “on a case-by-case basis.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,759 (Aug. 14, 2012) (“TPG”). We

¹ U.S. Patent No. 6,084,949 (issued July 4, 2000). Ex. 1005 (“Yun”).

² U.S. Patent No. 5,790,644 (issued Aug. 4, 1998). Ex. 1006 (“Kikinis”).

³ U.S. Patent No. 7,080,154 B1 (issued July 18, 2006). Ex. 1007 (“Inoue”).

⁴ U.S. Patent No. 6,738,643 B1 (issued May 18, 2004). Ex. 1012 (“Harris”).

consider multiple factors, including the following: whether a non-party is funding, directing, or controlling the IPR; whether the non-party had the ability to exercise control; the non-party's relationship with the petitioner and with the petition, including any involvement in the filing; and the nature of the entity filing the petition. TPG, 77 Fed. Reg. at 48759–60.

The Petition identifies Apple Inc. as the sole RPI in this proceeding. Pet. 1. Patent Owner contends that Petitioner should have named Unified Patents, Inc. (“Unified”) as an RPI and that, therefore, we should dismiss the Petition. Resp. 22. Specifically, Patent Owner notes its “suspicion of collaboration” between Petitioner and Unified because Unified filed its own petition asserting the same two primary references against the ’671 within days of Petitioner filing its Petition in this case. Resp. 24. Patent Owner also asserts Petitioner and Unified have a preexisting relationship based on Petitioner’s subscription agreement with Unified. Resp. 25.

On the other side, Petitioner asserts Unified is not an RPI because Petitioner’s business model—selling iPhones, iPads and Mac computers—in no way suggests Petitioner filed the Petition to benefit Unified or at Unified’s behest. Reply 19. Petitioner further points to record evidence that it neither “solicit[ed] any input from Unified Patents with respect to [this] IPR,” nor “receive[d] any contributions, financial or otherwise, from Unified with respect to the preparation or filing of [this] IPR.” *Id.* at 21 (citing Ex. 1018 ¶ 5). Petitioner further asserts that it “received no instructions from Unified,” and “received no information from Unified Patents with respect to [this] IPR.” *Id.* (citing Ex. 1018 ¶ 5). We are not aware of any evidence that contradicts Petitioner’s assertions.

We agree with Petitioner that Unified is not an unnamed RPI. The record contains no evidence of specific communications between Petitioner and Unified regarding this proceeding or the preparation of the Petition filed in this proceeding. Instead, Petitioner offers undisputed evidence that it alone directed, controlled, and funded this IPR, and that Petitioner did not communicate or coordinate with Unified in any way regarding the challenged patent or the asserted prior art in this proceeding. *See Id.* at 21–22 (citing Ex. 1018 ¶¶ 4, 5). There is also no specific evidence that the Petition was filed at Unified’s behest or to benefit Unified. To the contrary, as Petitioner notes, Petitioner has its own, independent reason for filing its Petition—Patent Owner has sued Petitioner for allegedly infringing the ’671 patent. *Id.* at 21. Last, that Unified filed its own somewhat similar petition around the same time as Petitioner does not suggest Unified is an unnamed RPI, as Patent Owner suggests. Instead, it shows that to the extent that Unified wanted to challenge the ’671 patent, Unified did not need Petitioner to file an IPR because Unified could (and did) file its own petition. The evidence and arguments advanced by Petitioner lead us to determine that Unified is not an unnamed RPI to this proceeding.

B. LEVEL OF ORDINARY SKILL IN THE ART

Patent Owner contends “the Petition does not set forth the requisite analysis necessary to prove obviousness at least because . . . it fails to provide or expressly rely upon any definition for the level of ordinary skill in the pertinent art.” Resp. 3. We disagree.

The Petition consistently cites to Dr. Medvidović’s Declaration, which both defines a person of ordinary skill in the art and explains that all of the opinions expressed are consistent with that person’s perspective. Ex. 1003

¶¶ 26, 27. The Petition also explains that its prior art analysis is from a skilled artisan’s prospective. *See* Pet. 7 (noting that the Petition “explains . . . why the claims would have been obvious *to a person of ordinary skill in the art*”) (emphasis added). We see no need to require more, and Patent Owner cites no authority for its contention that we should reject the Petition based solely on Petitioner’s failure to expressly define the level of ordinary skill in the art in the Petition itself, as opposed to in an expert’s supporting declaration.

C. CLAIM CONSTRUCTION

The ’671 patent has not expired, and the Petition was filed before November 13, 2018. Therefore, we interpret terms of the challenged claims according to their broadest reasonable interpretation in light of the specification. *See* 37 C.F.R. § 42.100(b) (2017).⁵ Unless the record shows otherwise, we presume a claim term carries its “ordinary and customary meaning,” which is “the meaning that the term would have to a person of ordinary skill in the art in question” at the time of the invention. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

Independent claim 1 requires a handheld computer system that “is operable to transfer the specific telephone number to the telephone using a wireless communication, and wherein the handheld computer system is configured to control the telephone via the wireless communication such that

⁵ *See also* Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340, 51,344 (Oct. 11, 2018) (“The Office will continue to apply the BRI standard for construing unexpired patent claims . . . in AIA proceedings where a petition was filed before the [November 13, 2018] effective date of the rule.”).

the telephone dials the specific telephone number.” Ex. 1001, 10:62–67. The other challenged independent claim, claim 9, includes similar transfer and control limitations: “transferring the specific telephone number from the handheld computer system to the telephone using a wireless communication” and “controlling the telephone using the handheld computer system to cause the telephone to dial the specific telephone number.” *Id.* at 12:1–6.

Patent Owner asserts that these limitations “require[] the handheld computer to issue a control command that is separate and apart from ‘transferring the specific telephone number’ itself.” Resp. 6. According to Patent Owner, both the Specification and the prosecution history support its “separate and apart” construction. *Id.* at 6–9. Petitioner disagrees that the claims require a control command separate and apart from transferring the telephone number. Reply 7–9. According to Petitioner, the transferring and control limitations “simply require a configuration in which the telephone is controlled by the handheld computer system to dial the specific telephone number, even if the transfer of the telephone number accomplishes as much.” *Id.* at 7.

We agree with Petitioner. First, the claim’s plain language does not support Patent Owner’s narrow construction. The transferring and control limitations at issue recite separate and distinct *steps*, not separate and distinct *commands*. The claim language does not reference “commands” at all and does not preclude the same command from accomplishing the two distinct steps. *See Powell v. Home Depot U.S.A., Inc.*, 663 F.3d 1221, 1231–32 (Fed. Cir. 2011) (holding that the same physical structure can serve two distinct claim limitations). The Specification and prosecution history also do

not support Patent Owner's narrow construction. Patent Owner alleges two Specification references and three prosecution history passages support its construction. *See* Resp. 7–10 (citing Ex. 1001, 8:17–21, 9:7–21; Ex. 1002, 243–244). At most, however, the cited passages describe transferring a number and controlling a telephone to dial the number as separate steps, not separate commands. The cited passages are ambiguous as to whether the transfer and control steps can be accomplished with just one command. *See, e.g.*, Ex. 1001, 8:17–21 (Specification passage describing that “[t]he wireless link 20 enables an application executing on PID 12 to access telephone 14, communicate the desired telephone number, and control telephone 14 to dial the number”); Ex. 2001, 243 (prosecution history passage asserting that “the mere exchange of data as described in [a prior art reference] is separate and distinct from the claim limitation of one wireless station controlling another”).

D. OBVIOUSNESS GROUNDS BASED ON YUN

As outlined below, we conclude that Petitioner has shown by a preponderance of evidence that claims 1–6 and 9–14 would have been obvious over Yun and Kikinis, and that claims 7, and 15 would have been obvious over Yun, Kikinis, and Inoue.

1. Overview of Yun

Yun discloses a “telephone system with automatic dialing using infrared transmission from [an] electronic pocket book.” Ex. 1002, [54]. Yun’s electronic pocket book is a “conventional” device “organized to feature a visual display, computer linking and a host of communication options and expandability, including touch screen display, word processor, calendar, scheduler, telephone directory and the like.” *Id.* at 1:20–31. After

user selection of a phone number using the electronic pocketbook, Yun describes the telephone as “initially analyzing the telephone number contained in the infrared ray signal received from the electronic pocketbook after receipt of an electronic dial request in an off-hook state, and automatically dialing the analyzed telephone number contained in the infrared ray signal.” *Id.* at 4:24–31.

2. Combining Kikinis with Yun

Petitioner relies on Yun as disclosing all the limitations recited by the challenged independent claims, except Petitioner points to Kikinis as disclosing “wherein a specific telephone number is selectable from a list displayed on the handheld computer system.” Pet. 10–50. Specifically, Petitioner asserts that Yun discloses displaying the name and number of stored contacts, and that Kikinis discloses displaying, for user selection, a plurality of stored telephone numbers. *Id.* at 23 (citing Ex. 1005, 2:29–41; Ex. 1006, Fig. 2C; Ex. 1003, 43–44). In addition, Petitioner explains that a person of ordinary skill would have included Kikinis’s technique of displaying contacts in a selectable list with Yun’s display of contact information to improve efficiency and usability. *Id.* at 14–17. As support for this reasoning, Petitioner points to Kikinis’s own disclosure that “[a]n important feature of the embodiment shown by FIG. 1 is user *interface display* 16, which provides a *flexible interface to easily operate and edit variable information for the dialer.*” *Id.* at 16 (quoting Ex. 1006, 4:21–25; Ex. 1003 ¶ 78). Patent Owner does not challenge Petitioner’s assertions in this regard. We conclude Petitioner has articulated sufficient reasoning with some rational underpinning to support the legal conclusion that its proffered

combination of Yun and Kikinis would have been obvious to one of ordinary skill in the art. *See KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007).

3. Transfer/Control Limitations

For the transfer and control limitations, Petitioner relies on Yun's disclosure that its electronic pocketbook transmits a specific telephone number to its telephone system, which then automatically dials the number. Pet. 25–28 (citing Ex. 1005, 3:13–17, 3:45–51, 4:16–30, 5:7–15, Figs. 1, 2, 3; Ex. 1003, 46, 47–49); *id.* at 41 (citing Ex. 1003, 62). Based on its contentions and supporting evidence, we agree with Petitioner that Yun teaches the independent claims' transfer and control limitations.

Patent Owner argues that Petitioner does not sufficiently show that Yun discloses the control limitation because Yun describes control merely by transmitting a telephone number, rather than by a separate step apart from transferring the telephone number. *See* Resp. 13. We disagree with Patent Owner's argument for two reasons. First, it relies on Patent Owner's narrow construction of the control limitation, which we declined to adopt, as explained above. Second, we disagree with Patent Owner's characterization that in Yun "the only involvement of the electronic pocketbook is the transfer of a single infrared ray signal containing a telephone number." *Id.* Yun discloses a device sending an infrared ray signal "containing an electronic dial request *and* telephone number of an interested person selected for an automatic dialing function." Ex. 1005, 4:13–16 (emphasis added). Thus, Yun distinguishes between its dial request and transferred telephone

number. By doing so, Yun discloses the transfer and controlling limitations even under Patent Owner's narrow construction.⁶

Patent Owner next argues Yun is deficient because in Yun, the telephone's control unit, rather than the electronic pocketbook, controls dialing the telephone. Resp. 12. As evidence that Yun's telephone control unit is responsible for the controlling limitation, Patent Owner cites passages in Yun that describe the telephone's control unit "controlling the overall operation of the telephone system," including making calls. *Id.* (citing Ex. 1005, 3:18–20); *see id.* (citing Ex. 1005, 3:30–33, 4:36–38, 5:5–16). Patent Owner also notes that Yun's telephone control unit "is specifically designed to ignore a received 'dial request' while the handset unit 118 is not in an off-hook state." *Id.* at 16, 17 (citing Ex. 1005, Fig. 3, Step 310). We disagree with Patent Owner's argument because it assumes that the electronic pocketbook's dial request cannot control the telephone to automatically dial the transferred number by working in conjunction with telephone's control unit. Yet that is precisely what Yun discloses. *See* Ex. 1005, 4:54–59, 5:8–16 ("[I]f the infrared ray signal corresponding to the electronic dial request from the electronic pocketbook is received . . . the [telephone's] control unit 110 determines whether the infrared ray signal contains a telephone number" and "control[s] the [telephone's] dial unit 116

⁶ Patent Owner asserts Petitioner waived relying on Yun's electronic dial request for teaching the claimed control limitation by failing to raise that argument in the Petition. Resp. 13–15. We disagree. The Petition and Dr. Medvidović's Declaration cited the Specification's dial request passage. *See* Pet. 12; Ex. 1003 ¶ 66. In addition, Petitioner's reliance on Yun's dial request in its Reply (*see* Reply 10–13) is permissible because it is responsive to Patent Owner's claim construction argument. *See* 37 C.F.R. § 42.23(b).

to automatically dial the telephone number.”). In addition, Yun’s off-hook functionality (ignoring dial requests) is irrelevant because Yun’s on-hook functionality teaches the claimed control feature. *See Hewlett-Packard Co. v. Mustek Systems, Inc.*, 340 F.3d 1314, 1326 (Fed. Cir. 2003) (“[A] prior art product that sometimes, but not always, embodies a claimed method nonetheless teaches that aspect of the invention.”).

4. Combining Inoue with Yun and Kikinis

Petitioner relies on Inoue for teaching limitations requiring remote device control using a wireless communication that supports Bluetooth compatible protocols. *See* Pet. 45. Petitioner explains that “[a] POSITA seeking to implement the Yun/Kikinis system would have evaluated the available, known options for short-range wireless communication, as taught in Inoue, and considered which of these would be an appropriate design choice.” *Id.* at 47 (citing Ex. 1003 ¶ 86). Petitioner adds that Yun expressly recognizes “various changes and modifications may be made” to its system and that “a POSITA viewing Yun’s statement allowing for modifications to its system would be motivated to consider and use other options for wireless communication instead of infrared, such as Bluetooth, as taught by Inoue, depending on the needs of the design.” *Id.* at 46, 47 (citing Ex. 1005, 5:23–28; Ex. 1003 ¶ 87). Petitioner goes on to note, “[a] POSITA would understand that Bluetooth ‘may be specifically preferred since it is a short range, low-power, high noise immune protocol.’” *Id.* at 47 (citing Ex. 1012, 2:12–16). Patent Owner does not challenge Petitioner’s assertion in this regard. We conclude Petitioner has articulated sufficient reasoning with some rational underpinning to support the legal conclusion that its proffered

combination of Inoue with Yun and Kikinis would have been obvious to one of ordinary skill in the art.

5. Undisputed Elements

As outlined below, Petitioner has shown by a preponderance of the evidence that the combination of Yun and Kikinis teaches the remaining limitations of claims 1–6 and 9–14, and the combination of Yun, Kikinis, and Inoue teaches the remaining limitations of claims 7 and 15. Patent Owner does not contest Petitioner’s assertions in these regards.

a. Independent Claim 1

Petitioner has shown that Yun teaches “[a]n automated telephone dialing system” as claim 1 requires. *See* Pet. 17–18 (citing Ex. 1005, Abstract, 1:16–19, Figs 1, 2; Ex. 1003, 37–38). Petitioner has shown that Yun teaches “a telephone having a wireless port for short range wireless data transfer” as claim 1 requires. *See id.* at 19–20 (citing Ex. 1005, Abstract, 3:11–41, Fig. 1; Ex. 1003, 39–40). Petitioner has shown that Yun teaches “a handheld computer system having a wireless port for communication with the wireless port on the telephone” as claim 1 requires. *See id.* at 20–23 (citing Ex. 1005, Abstract, 1:20–43, 3:18–23, 3:42–46, 3:67–4:3, 4:10–20, Fig. 2; Ex. 1003, 41, 42–43). Petitioner also has shown that Kikinis teaches “wherein a specific telephone number is selectable from a list displayed on the handheld computer system” as claim 1 requires. *See id.* at 23–25 (citing Ex. 1006, 4:21–26, 5:10–12, Fig. 2C ; Ex. 1003, 45–46).

b. Independent Claim 9

Petitioner has shown that Yun teaches “[a]n automatic wireless telephone dialing method” as claim 9 requires. *See* Pet. 37–38 (citing Ex. 1005, Abstract, 3:6–7, 4:20–31, Fig. 3; Ex. 1003, 58–60). Petitioner has shown that Yun teaches “establishing a wireless communications link for a

short range data transfer between a telephone and a handheld computer system” as claim 9 requires. *See id.* at 39–40 (citing Ex. 1005, 3:36–41, 4:16–20; Ex. 1003, 60–61). Petitioner also has shown that the combination of Yun and Kikinis teaches “receiving a user input identifying a specific telephone number from a list displayed on the handheld computer system” as claim 9 requires. *See id.* at 40–41 (citing Ex. 1006, 5:11–13, 5:26–29, Fig. 2C; Ex. 1003, 61–62).

c. Claims 2 and 10

Petitioner has shown that Yun teaches the additional limitation in dependent claim 2 (and parallel limitation in claim 10): “wherein the dialing of the specific telephone number by the telephone is automatically effected in response to a user interacting with the information stored on the handheld computer system.” *See id.* at 29–30 (citing Ex. 1005, 2:29–34, 4:60–5:7, 5:16–22; Ex. 1003, 50–51); *id.* at 42 (citing Ex. 1003, 62–63).

d. Claims 3 and 11

Petitioner has shown that Yun teaches the additional limitation in dependent claim 3 (and parallel limitation in claim 11): “wherein the information stored in the handheld computer system includes contact information.” *See id.* at 31 (citing Ex. 1005, 2:1–3, 4:60–5:4; Ex. 1003, 51–52); *id.* at 42 (citing Ex. 1003, 63).

e. Claims 4 and 12

Petitioner has shown that Kikinis teaches the additional limitation in dependent claim 4 (and parallel limitation in claim 12): “wherein the list is presented as a list of contacts and the telephone number dialed by the telephone corresponds to one of the contacts selected by the user.” *See id.* at 32–33 (citing Ex. 1006, Abstract, 2:37–38, 5:10–13, 5:26–29, Fig. 2C; Ex. 1003, 52–53); *id.* at 43 (citing Ex. 1003, 63).

f. Claims 5, 6, 13, and 14

Petitioner has shown that the combination of Yun and Kikinis teaches the additional limitation in dependent claim 5 (and parallel limitation in claim 13): “wherein the information stored on the handheld computer system is maintained by a management program executing on the handheld computer system and the management program controls the telephone via the wireless communication,” as well as the additional limitation in claim 6 (and parallel limitation in claim 14): “wherein the management program is an address book program.” *See id.* at 33–37 (citing Ex. 1005, 3:67–4:20, 5:13–16; Ex. 1006, 3:14–17, 3:36–42, 3:52–54, 3:63–65, 5:11–13, 5:2–4, 5:34–63, 6:50–54, 7:30–35, 8:36–39; Ex. 1003, 54–58); *id.* at 43–44 (citing Ex. 1003, 64).

g. Claims 7 and 15

Petitioner has shown that Inoue discloses the additional limitation in dependent claims 7 and 15: “wherein the wireless communication is compatible with a version of the Bluetooth specification.” *See id.* at 48 (citing Ex. 1007, 6:14–19; Ex. 1003, 69–70); *id.* at 49–50 (citing Ex. 1003, 71).

E. OBVIOUSNESS GROUNDS BASED ON HARRIS

We conclude that Petitioner has shown by a preponderance of evidence that claims 1–7 and 9–15 would have been obvious over Harris, and Kikinis, as outlined below.

1. Overview of Harris

Harris discloses a personal digital assistant (PDA) that can automatically dial a telephone. Ex. 1012, Abstract, 1:41–46. Harris’s PDA “stores a plurality of contacts” and displays “the person’s name and phone number as conventional” with “an icon or spot on the screen 112, which

commands dialing the displayed number” when selected by a user. *Id.* at 1:47–53.

2. *Combining Harris with Kikinis*

Petitioner relies on Harris as disclosing all limitations recited by the challenged independent claims, except Petitioner again points to Kikinis as disclosing “wherein a specific telephone number is selectable from a list displayed on the handheld computer system.” Pet. 59–61. Specifically, Petitioner asserts that Harris discloses displaying the name and number of stored contacts and that Kikinis discloses a list of those numbers displayed on a handheld computer system. *Id.* at 59 (citing Ex. 1012, 1:46–49; Ex. 1006, Fig. 2C; Ex. 1003, 84–85). In addition, Petitioner explains that a person of ordinary skill would have included Kikinis’s technique of displaying contacts in a selectable list with Harris’s display of the contacts to improve efficiency and usability. *Id.* at 53–54. As support for this reasoning, Petitioner points to Kikinis’s own disclosure that “[a]n important feature of the embodiment shown by FIG. 1 is user *interface display 16*, which provides a *flexible interface to easily operate and edit variable information for the dialer.*” *Id.* at 53 (quoting Ex. 1006, 4:21–25; Ex. 1003, 97). Patent Owner does not challenge Petitioner’s assertion in this regard. We conclude Petitioner has articulated sufficient reasoning with some rational underpinning to support the legal conclusion that its proffered combination of Harris and Kikinis would have been obvious to one of ordinary skill in the art. *See KSR*, 550 U.S. at 418.

3. *Transfer/Control Limitations*

For the transfer and control limitations, Petitioner relies on Harris’s disclosure that when a user selects an icon, the telephone phone number

information associated with that contact information is sent wirelessly to a telephone, which then automatically dials the number. *See* Pet. 61–63 (citing Ex. 1012, Abstract, 1:49–50, 2:10–22, 2:32–34, 4:3–6, Fig. 2); *id.* at 74–75 (citing Ex. 1003, 98–99). Based on its contentions and supporting evidence, we agree with Petitioner that Harris teaches the transfer and control limitations.

Patent Owner challenges Petitioner’s showing for the transfer and control limitations with respect to Harris in much the same way it challenges Petitioner’s showing with respect to Yun. Specifically, Patent Owner argues that Petitioner does not sufficiently show “that Harris’ PDA provides the required control that is distinct from the transmission of the phone number itself.” Resp. 19. We disagree with this argument because it relies on Patent Owner’s narrow construction of the control limitation, which we decline to adopt for the reasons explained above. In addition, even if we were to accept Patent Owner’s construction, that construction does not distinguish over Harris because Harris teaches both transmitting a number and commanding a telephone to dial the number. *See, e.g.*, Ex. 1012, 1:52–53 (explaining that “information indicative of the displayed number is sent over the infrared link”), 1:50–51 (explaining that “[t]he device also includes an icon . . . which commands dialing the displayed number”), 4:4–6 (explaining that “said wireless communicating provides said telephone number to a telephone”), 4:45–47 (explaining that the “computer has a command that causes said telephone to dial a phone number associated with a specified contact”). Patent Owner asserts that Harris’s dial command is distinguishable from the claimed controlling step because Harris’s telephone “has multiple modes of operation,” including one in which “the telephone

(130/140) ‘will only dial the next time that the on hook or send button’ on *the telephone* is used.” Resp. 20 (quoting Ex. 1012, 1:61). Thus, Patent Owner concludes, “in the Harris system it is the telephone (and not the PDA) that controls if and when it will dial a phone number provided by the PDA.” *Id.* We disagree with Patent Owner’s argument because it relies on an optional feature in Harris, yet we do not limit a prior art reference’s disclosure to a preferred embodiment. *See Arthrocare Corp. v. Smith & Nephew, Inc.*, 406 F.3d 1365, 1372 (Fed. Cir. 2005).

4. Undisputed Elements

As outlined below, Petitioner has shown by a preponderance of the evidence that the combination of Harris and Kikinis teaches the remaining limitations of claims 1–7 and 9–15. Patent Owner does not contest Petitioner’s assertions in this regard.

a. Independent Claim 1

Petitioner has shown that Harris teaches “[a]n automated telephone dialing system” as claim 1 requires. *See* Pet. 54–55 (citing Ex. 1012, Abstract, 3:33–35, Fig. 2; Ex. 1003, 75, 76). Petitioner has shown that Harris teaches “a telephone having a wireless port for short range wireless data transfer” as claim 1 requires. *See id.* at 55–57 (citing Ex. 1012, Abstract, 1:29–32, 2:10–22, Fig. 2; Ex. 1003, 77, 78, 79). Petitioner has shown that Harris teaches “a handheld computer system having a wireless port for communication with the wireless port on the telephone” as claim 1 requires. *See id.* at 57–58 (citing Ex. 1012, 1:6, 1:29–32, 1:40–52, 2:9–21, Figs. 1, 2; Ex. 1003, 79–83). Petitioner also has shown that Kikinis teaches “wherein a specific telephone number is selectable from a list displayed on

the handheld computer system” as claim 1 requires. *See id.* at 59–61 (citing Ex. 1006, 1:46–49, 4:21–26, 5:10–13, 5:26–29, Fig. 2C; Ex. 1003, 84–86).

b. Independent Claim 9

Petitioner has shown that Harris teaches “[a]n automatic wireless telephone dialing method” as claim 9 requires. *See id.* at 71–72 (citing Ex. 1012, Abstract, 2:9–11, 2:19–21, 3:32–34, Fig. 2; Ex. 1003, 96, 97). Petitioner has shown that Harris teaches “establishing a wireless communications link for a short range data transfer between a telephone and a handheld computer system” as claim 9 requires. *See id.* at 72–73 (citing Ex. 1012, 1:31–32, 2:9–21, Fig. 2; Ex. 1003, 97–98). Petitioner also has shown that the combination of Harris and Kikinis teaches “receiving a user input identifying a specific telephone number from a list displayed on the handheld computer system” as claim 9 requires. *See id.* at 73–74 (citing Ex. 1006, 5:26–29, 5:11–13, Fig. 2C; Ex. 1003, 98).

c. Claims 2 and 10

Petitioner has shown that Harris teaches the additional limitation in dependent claim 2 (and parallel limitation in claim 10): “wherein the dialing of the specific telephone number by the telephone is automatically effected in response to a user interacting with the information stored on the handheld computer system.” *See id.* at 63–65 (citing Ex. 1012, Abstract, 1:46–47, 1:65–2:1, 3:32–34; Ex. 1003, 89–90); *id.* at 75 (citing Ex. 1003, 99).

d. Claims 3 and 11

Petitioner has shown that Harris teaches the additional limitation in dependent claim 3 (and parallel limitation in claim 11): “wherein the information stored in the handheld computer system includes contact information.” *See id.* at 65 (citing Ex. 1012, 1:46–47; Ex. 1003, 90); *id.* at 76 (citing Ex. 1003, 100).

e. Claims 4 and 12

Petitioner has shown that Kikinis teaches the additional limitation in dependent claim 4 (and parallel limitation in claim 12): “wherein the list is presented as a list of contacts and the telephone number dialed by the telephone corresponds to one of the contacts selected by the user.” *See id.* at 66–67 (citing Ex. 1006, 2:37–38, 5:10–13, 5:26–29, Fig. 2C; Ex. 1003, 91, 92); *id.* at 76 (citing Ex. 1003, 100).

f. Claims 5 and 13

Petitioner has shown that the combination of Harris and Kikinis teaches the additional limitation in dependent claim 5 (and parallel limitation in claim 13): “wherein the information stored on the handheld computer system is maintained by a management program executing on the handheld computer system and the management program controls the telephone via the wireless communication.” *See id.* at 67–70 (citing Ex. 1012, 1:42–45, 1:49–50, 2:10–22, 3:32–34, 4:3–6; Ex. 1006, 3:14–17, 3:36–42, 3:52–54, 3:63–65, 5:11–13, 5:34–63, 6:50–54, 7:30–35, 8:36–39; Ex. 1003, 92–94); *id.* at 76–77 (citing Ex. 1003, 100–01).

g. Claims 6 and 14

Petitioner has shown that Harris teaches the additional limitation in dependent claim 6 (and parallel limitation in claim 14): “wherein the management program is an address book program.” *See id.* at 70 (citing Ex. 1012, 3:1–3; Ex. 1003, 95); *id.* at 77–78 (citing Ex. 1003, 101).

h. Claims 7 and 15

Petitioner has shown that Harris teaches the additional limitation in dependent claims 7 and 15: “wherein the wireless communication is compatible with a version of the Bluetooth specification” *See id.* at 71

(citing Ex. 1012, 2:11–15, Fig. 2; Ex. 1003, 95); *id.* at 78 (citing Ex. 1003, 101).

III. CONSTITUTIONAL CHALLENGE TO *INTER PARTES* REVIEW

Patent Owner asserts that “the Board’s appointments of administrative patent judges violate the Appointments Clause of Article II, and that their decisions must be set aside, because administrative patent judges are ‘appointed by the Secretary of Commerce, in consultation with the Director’ of the USPTO, but without appointment by the President and confirmation by the Senate in violation of Article II, Section 2, Clause 2 of the Constitution.” Resp. 25–26. We decline to consider Patent Owner’s constitutional challenge.

IV. CONCLUSION

Petitioner has shown by a preponderance of the evidence that claims 1–6 and 9–14 would have been obvious over Yun and Kikinis and that claims 7 and 15 would have been obvious over Yun, Kikinis, and Inoue. Patent Owner has also shown by a preponderance of the evidence that claims 1–7 and 9–15 would have been obvious over Harris and Kikinis.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner has shown by a preponderance of the evidence that claims 1–7 and 9–15 of the ’671 patent are unpatentable; and

FURTHER ORDERED that, because this is a Final Written Decision, the parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2018-00282
Patent 7,092,671 B2

PETITIONER:

Andrew S. Ehmke
Philip W. Woo
HAYNES AND BOONE, LLP
andy.ehmke.ipr@haynesboone.com
philip.woo.ipr@haynesboone.com

PATENT OWNER:

Ryan Loveless
Sean Burdick
Brett Mangrum
James Etheridge
Jeffrey Huang
ETHERIDGE LAW GROUP
ryan@etheridgelaw.com
sean.burdick@unilocusa.com
brett@etheridgelaw.com
jim@etheridgelaw.com
jeff@etheridgelaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.,
Petitioner,

v.

UNILOC USA, INC. and UNILOC LUXEMBOURG, S.A.,
Patent Owner.

Case IPR2018-00199
Patent 7,092,671 B2

QUINN, *Administrative Patent Judge, concurring.*

I concur in the result of the majority's Decision and analysis that Petitioner has demonstrated by a preponderance of the evidence that the challenged claims are unpatentable. However, my analysis of the RPI issues in Section II.A would be different in light of the circumstances in this case and in the related IPR proceeding IPR2018-00199.

It is undisputed that Apple has been sued for infringement of the patent at issue. It is also undisputed that Apple is a client of Unified Patents. The majority's analysis notes that there is no evidence that Apple filed the Petition here on behalf of or at the behest of Unified. I agree. The only point of departure in my analysis is that consistent with my concurrence in IPR2018-00199, Unified has filed a petition requesting review of the '671 patent on behalf of certain of its members, including Apple. But Apple has not been shown to have a similar contractual obligation with respect to Unified. Thus, while I would hold that Apple is an RPI of Unified in IPR2018-00199, I would not hold that Unified is an RPI of Apple in this proceeding. The difference lies in Unified's business nature, which has a purpose of reducing NPE exposure for its members by filing IPRs. Apple's business nature, however, is to manufacture and sell its products. Accordingly, I agree with the majority's determination that Unified is not an RPI of Apple.