

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA MOBILITY LLC
Petitioner

v.

ARNOUSE DIGITAL DEVICES CORPORATION and
MICHAEL ARNOUSE
Exclusive Licensee and Patent Owner

Case IPR2013-00010
Patent 7,516,484

Before MICHAEL P. TIERNEY, JONI Y. CHANG and
WILLIAM V. SAINDON, *Administrative Patent Judges*.

CHANG, *Administrative Patent Judge*.

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

INTRODUCTION

On October 2, 2012, Motorola Mobility LLC (“Motorola”) filed a petition requesting an *inter partes* review of U.S. Patent No. 7,516,484 (“the ’484 patent”). Paper 2 (“Pet.”). Arnouse Digital Devices Corporation and Michael Arnouse (collectively “ADDC”) filed a patent owner preliminary response. Paper 14 (“Prelim. Resp.”). Taking into account ADDC’s preliminary response, the Board determined that the information presented in Motorola’s petition demonstrated that there was a reasonable likelihood that Motorola would prevail with respect to at least one challenged claim. Pursuant to 35 U.S.C. § 314, the Board instituted this trial on February 12, 2013, as to claims 1, 3, 7, 15, 16, 18, and 20 of the ’484 patent. Paper 21 (“Dec.”).

During the trial, ADDC filed a patent owner response (Paper 33, “PO Resp.”), and Motorola filed a reply (Paper 39, “Reply”). No oral hearing was held. Paper 43.

The Board has jurisdiction under 35 U.S.C. § 6(c). This decision is a final written decision under 35 U.S.C. § 318(a) as to the patentability of the involved claims. We hold that claims 1, 3, 7, 15, 16, 18, and 20 of the ’484 patent are unpatentable under 35 U.S.C. § 102.

A. Related Proceedings

Motorola indicates that the ’484 patent is the subject of litigation styled *Arnouse Digital Devices Corp. v. Motorola Mobility, Inc.*, No. 5:11-cv-00155-cr (D. Vt.). Pet. 2.

B. The '484 Patent

The '484 patent describes a reader adapted for a portable computer. Ex. 1001, Abs. According to the '484 patent, when the reader and portable computer are connected together, the combined system becomes a fully functional personal computer. *Id.* By itself, without connecting to the portable computer, the reader is a non-functioning “shell” that includes at least one input device and at least one output device, such as a keyboard and a display. *Id.* A user cannot interact with the portable computer without the reader. *Id.*

Figure 4, reproduced below, shows an embodiment of the '484 patent.

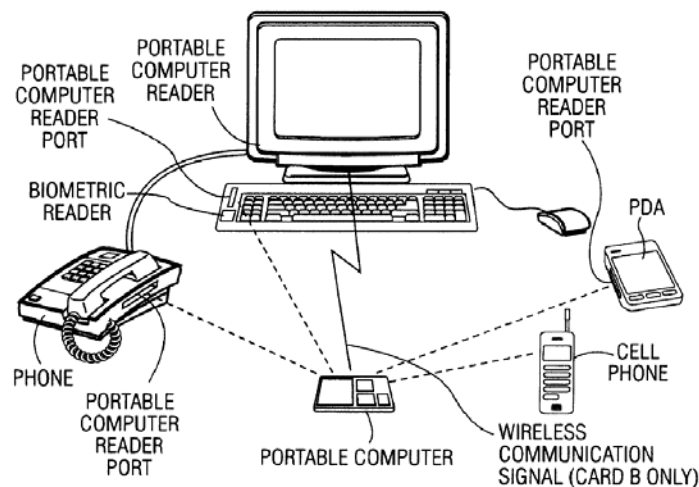


FIG. 4

Figure 4 illustrates a portable computer and a plurality of readers.

As shown in Figure 4, a plurality of readers may be located at various locations so that a user may use the portable computer in those remote locations. *Id.* at 6:59-7:6. The main function of the readers is to allow a user to interact with the portable computer. *Id.*

C. Exemplary Claim

Of the involved claims, claims 1 and 15 are the only independent claims. Claims 3 and 7 depend from claim 1, and claims 16, 18, and 20 depend from claim 15. Claim 15 is exemplary of the claimed subject matter of the '484 patent, and is reproduced below (emphasis added):

15. A computing system comprising:
 at least one *portable computer*, each comprising:
 storage; and
 at least one connector for connecting to at least one reader;
 at least one *reader*, each comprising:
 an input device;
 an output device; and
 a connector for connecting to the at least one portable computer,
 wherein the portable computer excludes means for a user to interact directly with the portable computer,
 wherein the reader and portable computer are configured to become a fully functioning computer when connected,
 wherein the readers are configured so that they will not operate with a computer other than a portable computer of the system, and
 wherein the reader is configured to be a non-functioning shell when not connected to the portable computer.

D. Prior Art Relied Upon

Motorola relies upon the following prior art references:

Kobayashi	US 5,463,742	Oct. 31, 1995	(Ex. 1003)
Nelson	US 5,436,857	July 25, 1995	(Ex. 1004)
Jenkins	US 6,029,183	Feb. 22, 2000	(Ex. 1005)
Warren	US 6,999,792 B2	Feb. 14, 2006	(Ex. 1006)

E. Grounds of Unpatentability

The Board instituted the instant trial based on the following grounds of unpatentability:

Claims	Basis	References
1, 3, 7, 15, 16, 18, and 20	§ 102(b)	Kobayashi
1, 3, 7, 15, 16, 18, and 20	§ 102(b)	Nelson

ANALYSIS

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b). Under the broadest reasonable construction standard, claim terms are given their ordinary and customary meaning as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech. Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

1. “*connector for connecting*”

The phrase “connector for connecting” appears in claims 1 and 15. For example, claim 15 recites “at least one portable computer, each comprising . . . at least one connector for connecting to at least one reader” and “at least one reader, each comprising . . . a connector for connecting to the at least one portable computer.” Essentially, the claim phrase “connector for connection” is recited in two claim limitations: (1) a *portable computer*

connector for connecting a portable computer to a reader; and (2) a *reader connector* for connecting a reader to a portable computer.

Through its arguments concerning the instituted grounds of unpatentability, ADDC attempts to import improperly a limitation—a *reader slot or hole*—from an embodiment described in the specification into the claims. PO Resp. 15. For the reasons stated below, we decline to import that limitation into the claim phrase “connector for connecting.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (We must be careful not to read limitations from a particular embodiment appearing in the written description into the claim if the claim language is broader than the embodiment.)

In support of its contentions, ADDC directs our attention to the following portions of the specification of the ’484 patent (PO Resp. 14-15):

The readers also comprise at least one connector for attaching the portable computer to the reader. In one embodiment, the connector is attached to the housing of the portable computer readers. *In the embodiments shown in FIGS. 4-7, the connector is within a slot or hole for receiving the portable computer.* The slot may be located anywhere on the reader, for example, on the keyboard, as shown in FIG. 4 or on the monitor, as shown in FIG. 5.

Ex. 1001, 7:59-66 (emphasis added by ADDC).

“Connecting” refers to being attached or in communication with the portable computer reader by being affixed to, stored within or in operable communication with the portable computer reader.

Id. at 6:35-38.

ADDC argues that the broadest reasonable interpretation of the claim phrase “a connector for connecting” includes *the embodiment of a reader having a slot or hole* with a connector therein, as shown in Figures 4 through 7. PO Resp. 15. According to ADDC, “this configuration is clearly contemplated by the patentee as a desirable place for the connector.” *Id.* In particular, ADDC alleges (*id.* n.3):

It should be readily apparent that, if the connector is designed to be inside the slot, the portable computer and reader are necessarily designed to accommodate this feature. Unremarkably, in order for . . . any two devices to be connected, the devices each must have conforming designs to allow for the connection.

We are not persuaded by ADDC’s arguments, as they fail to recognize that the specification discloses other embodiments in which a reader is connected to a portable computer without using *a reader slot or hole*. For example, in one embodiment, the portable computer connector is attached merely to the housing of the readers. Ex. 1001, 7:60-62. The reader connector is configured to mate with a universal connector on the portable computer. *Id.* at 6:37-42; 7:66-8:2. In another example, as shown in Figures 4 through 6, the connector includes a *wireless* connection between the portable computer and reader—the portable computer has a wireless transmitter, and the reader has a receiver, or vice versa. *Id.* at 6:42-46. As described in the specification, the connection between a portable computer and a reader does not include necessarily *a reader slot or hole*. Therefore, we do not import the limitation of *a reader slot or hole*, as urged by ADDC, from the specification into the claims.

Even in cases where the specification describes only a single embodiment, we do not construe necessarily the claims as being limited to that embodiment. *Thorner v. Sony Computer Entm't Am. L.L.C.*, 669 F.3d 1362, 1365 (Fed. Cir. 2012) (It is not enough that the only embodiment, or all of the embodiments, contain a particular limitation.). Moreover, we decline to add limitations into the claims in absence of a special definition set forth in the specification. An inventor may set out a definition and act as its own lexicographer by 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). Here, ADDC has not alleged that the inventor of the '484 patent acted as his own lexicographer and provided a special definition in the specification for the claim term “connector” or the claim phrase “connector for connecting” that is different from its recognized meaning to one with ordinary skill in the art.

In light of the specification and in the context of the claims, we construe the claim phrase “connector for connecting” broadly, but reasonably, as a device or configuration that establishes a wireless or physical communication connection between a reader and a portable computer.

2. “*wherein the readers are configured so that they will not operate with a computer other than a portable computer of the system*”

Claims 1 and 15 each recite this “reader configuration” limitation. ADDC, through its arguments concerning the grounds of unpatentability, alleges that the “reader configuration” limitation requires that “the portable

computers and readers are *matched via security protocols* so as to eliminate the possibility of access to the portable computers by just any reader.” PO Resp. 22 (emphasis added). We disagree with ADDC, as such a construction would import improperly a limitation from the specification into the claims. *Van Geuns*, 988 F.2d at 1184. We do not find any special definition of the claim terms, set forth in the specification, that would require *matching security protocols*, and ADDC has not identified one.

Motorola points out that the claim construction urged by ADDC in the instant proceeding is *narrower* than the one advocated by ADDC in the related district court litigation. Reply 3-4, 8. The chart below compares ADDC’s proposed claim construction submitted in the instant *inter partes* review (“IPR”), with ADDC’s claim construction submitted in the related district court litigation (PO Resp. 22; Ex. 1013 at 4, col. 3, row 2 (emphases added)):

Claim Limitation	ADDC’s proposed construction in the instant IPR proceeding	ADDC’s construction submitted in the related district court litigation
“wherein the readers are configured so that they will not operate with a computer other than a portable computer of the system”	“the portable computers and readers are <i>matched via security protocols</i> so as to eliminate the possibility of access to the portable computers by just any reader.”	“the reader has a non-universal design that limits <i>the types of portable computers</i> that may be used with the reader.”

We observe that ADDC’s claim construction for the “reader configuration” limitation submitted in the instant proceeding is overly narrow. In fact, ADDC’s claim construction submitted in the related district court litigation is broader and does not require *matching security protocols*. Ex. 1013 at 4, col. 3, row 2. The “reader configuration” limitation is concerned with *the types of portable computers* being used with the reader, as opposed to the reader’s *security protocol*.

In support of its position, ADDC argues that the patentee invented the computer system to overcome problems in the prior art regarding information security breaches and virus transmission. PO Resp. 20. ADDC also cites portions of the specification for support. *Id.* at 17-18. We have reviewed those portions of the specification cited by ADDC, and observe that they do not support ADDC’s contention that the “reader configuration” limitation requires *matching security protocols*. The cited portions of the specification are directed to an *exemplary* embodiment. *See, e.g.*, Ex. 1001, 5:19-31 (“The portable computer *may* also comprise a GPS chip, *a specialized reader contact*, a logic element, a smart card device, and RFID crypto memory” (emphasis added).); 5:45-59 (“[T]he portable computer *may* include security information in the software. . . . *Preferably*, the portable computer reader or computer would comprise means for reading the biometric information . . .” (emphases added).).

ADDC’s arguments also fail to take into account other embodiments—the design of the interface, communication protocols, and software configuration—that do not include matching security protocols. *Id.* at 6:16-

21; 6:50-58; 7:62-64, 7:66-8:1; Figs. 4-7. Moreover, the specification explicitly warns that the invention disclosed in the '484 patent is not limited to any specific exemplary embodiment described in the specification. *Id.* at 13:1-6 (“Although the invention has been described in terms of exemplary embodiments, *it is not limited* thereto. Rather, the appended claims should be construed broadly to include other variants and embodiments of the invention” (emphasis added).).

The claim language itself—“not operate with a computer other than a portable computer of the system”—is broad, and is not limited to a specific reader configuration. We decline to construe the “reader configuration” limitation to require *matching security protocols*, as urged ADDC, which would limit improperly the claims to a preferred embodiment described in the specification. *Gemstar-TV Guide Int’l, Inc. v. Int’l Trade Comm’n*, 383 F.3d 1352, 1366 (Fed. Cir. 2004) (expressly rejecting the contention that claims must be construed as being limited to an embodiment disclosed in the patent).

For the foregoing reasons, we construe the “reader configuration” limitation as the readers each having a non-universal design that limits the types of portable computers that may be used with the reader.

3. “*means for a user to interact directly with the portable computer*”

The “means for interacting” limitation appears in claims 1, 15, and 18. For example, claim 15 recites “wherein the portable computer excludes *means for a user to interact directly with the portable computer.*”

We determine that the “means for interacting” claim limitation is a means-

plus-function claim limitation that invokes 35 U.S.C. § 112, ¶ 6.¹

We observe that: (1) the limitation uses the term “means for”; (2) the term “means for” is modified by functional language; and (3) the term “means for” is not modified by any structure recited in the claim to perform the claimed function. *Personalized Media Commc’ns LLC v. Int’l Trade Comm’n*, 161 F.3d 696, 703-04 (Fed. Cir. 1998) (A limitation that uses the term “means for” which creates a rebuttable presumption that the drafter intended to invoke 35 U.S.C. § 112, ¶ 6.); *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1427-28 (Fed. Cir. 1997) (The presumption is not rebutted if the term “means for” is modified by functional language, and it is not modified by any structure recited in the claim to perform the claimed function.).

We identify the claimed function for this limitation to be “for a user to interact directly with the portable computer.” Based on the specification of the ’484 patent, the corresponding structure that performs the recited function is a component that allows a user to provide information to, or receive information from, the portable computer, directly—e.g., a keyboard, keypad, display, or voice input device, on the portable computer. *See, e.g.*, Ex. 1001, 5:63-6:31.

¹ Section 4(c) of the AIA re-designated 35 U.S.C. § 112, ¶ 6, as 35 U.S.C. § 112(f). We refer to the pre-AIA version of 35 U.S.C. § 112, because the ’484 patent has a filing date before September 16, 2012 (effective date).

4. “*the portable computer excludes means for a user to interact directly with the portable computer*”

Motorola seeks the claim construction of this “excluding” limitation, which appears in claim 15. Pet. 39-42. In the related district court proceeding, ADDC construed this “excluding” limitation as:

By itself the portable computer cannot provide information to a user or receive information from a user. In other words, the portable computer needs the reader for the user to interact with the programs, hardware, and user information of the portable computer.

Ex. 1013 at 6, col. 3, row 2 (emphasis added).

Motorola submitted the same construction—“[b]y itself the portable computer cannot provide information to a user or receive information from a user.” Ex. 1013 at 6, col. 2, row 2. As that construction also is consistent with the specification of the ’484 patent and the plain meaning of the claim terms, we adopt it as the broadest reasonable construction for the “excluding” limitation. See, e.g., Ex. 1001, 5:63-6:31.

5. *Preamble of claim 1*

The claim language “*the portable computer excludes means for a user to interact directly with the portable computer*” similarly is recited in the preamble of claim 1— “*a portable computer without input and output means for interacting directly therewith.*” In general, a preamble limits the invention if it recites essential structure or steps, or if it is “necessary to give life, meaning, and vitality” to the claim. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999). Here, the preamble of

claim 1 is entitled to patentable weight as it recites additional structure that is not included in the claim body. As the claim construction chart submitted by the parties in the related district court litigation shows, the parties agree that the preamble of claim 1 is limiting. Ex. 1013 at 1, col. 1-3, row 1.

B. Anticipated by Kobayashi

Motorola asserts that the challenged claims are unpatentable under 35 U.S.C. § 102(b) as anticipated by Kobayashi. Pet. 6. Motorola provides explanations as to how each limitation is met by Kobayashi. *Id.* at 6-13. Upon review of Motorola's analysis and ADDC's patent owner response, we determine that Motorola has demonstrated, by a preponderance of the evidence, that claims 1, 3, 7, 15, 16, 18, and 20 are anticipated by Kobayashi.

To establish anticipation, each and every element in a claim, arranged as is recited in the claim, must be found in a single prior art reference. *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008).

1. Overview of Kobayashi

Kobayashi discloses a single user computer system that can be separated into two parts: (1) a personal processor module (PPM) that can be easily transported, which Motorola equates to as a "portable computer" (Pet. 7); and (2) a docking station that includes input and output devices such as a keyboard and a display, which Motorola equates to as a "reader" (*id.*). Ex. 1003, 3:9-17. The user gains access to the computer system by connecting the PPM to the docking station. *Id.* at 3:24-31. Each PPM has a

processor with related logic, memory (RAM/ROM/CACHE MEMORY), and a mass storage device. *Id.* at 3:40-47. The PPM accommodates the hardware and software related to personal processing capability, the customized operating system, the graphic user interface, and the application software. *Id.* at 3:18-23.

Figure 1 of Kobayashi is reproduced below:

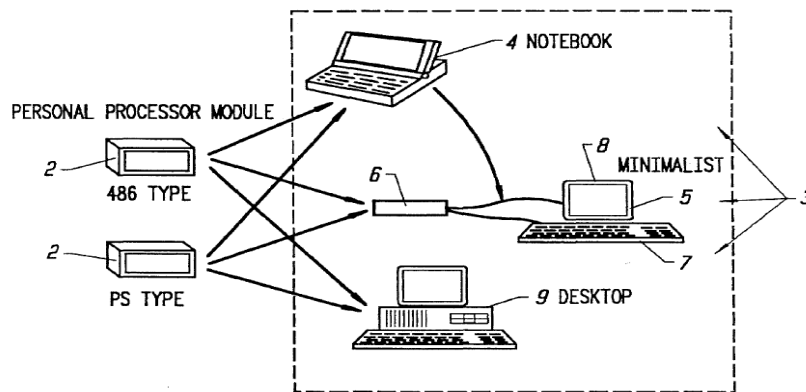


FIG. 1

Figure 1 of Kobayashi illustrates several PPMs and docking stations.

As shown in Figure 1 of Kobayashi, PPM 2 does not contain user interface input or output devices. *Id.* at 3:53-55. Therefore, PPM 2 always needs a docking station to allow user interaction. *Id.* at 6:37-39.

According to Kobayashi, the PPM works once it is connected to a docking station through a multi-connector. *Id.* at 3:54-60. The docking station has physical connector 24 that interfaces with PPM connector 22. *Id.* at 5:64 to 6:1. The docking station is configured specifically to interact with the PPM. *Id.* at Fig. 2.

The docking station includes a housing, the input and output devices (e.g., keyboard and display), and the interfaces to those devices. *Id.* at 4:2-5. For example, Figure 1 of Kobayashi shows computer notebook 4 where the input device of the docking station comprises a keyboard and the connector is contained on the keyboard. *Id.* at Fig. 1. The docking station does not include a processor, the application software, and operating system, but rather these components are supplied by the PPM. *Id.* at 5:55-63; 6:14-26.

2. Discussion

The explanations provided by Motorola as to how each claim limitation of the challenged claims is met by Kobayashi have merit. Pet. 6-14. ADDC counters that Kobayashi fails to describe the “reader configuration” claim limitation—“wherein the readers are configured so that they will not operate with a computer other than a portable computer of the system”—as required by claims 1, 3, 7, 15, 16, 18, and 20. PO Resp. 23-24. In particular, ADDC alleges that the “reader configuration” limitation requires that “the portable computers and readers are *matched via security protocols* so as to eliminate the possibility of access to the portable computers by just any reader.” *Id.* at 22 (emphasis added). ADDC contends that Kobayashi does not describe *matching security protocols*. *Id.* at 22-23.

ADDC’s arguments are unavailing, as they are not commensurate with the scope of the claims. Specifically, they are premised on an overly narrow claim construction of the “reader configuration” limitation, requiring *matching security protocols* (*id.* at 22). As discussed above, we decline to adopt such an overly narrow construction, because it would import

limitations from the specification into the claims, improperly limiting the claims to a preferred embodiment. Rather, we construe the “reader configuration” limitation as the readers each having a non-universal design that limits the types of portable computers that may be used with the reader.

In its petition, Motorola asserts that Kobayashi meets the “reader configuration” claim limitation. Pet. 10. Motorola points out that Kobayashi discloses that “[t]he PPM works after being connected to the docking stations through a multi-connector and is capable of being connected to several types of docking stations such as desktop, desk side or portable depending on the task to be undertaken by the user.” *Id.* (citing Ex. 1003, 3:55-60).

We agree with Motorola, as its assertion is supported by a preponderance of the evidence. Indeed, Kobayashi describes a docking station that limits the types of computers that may be used with the docking station. *See, e.g.*, Ex. 1003, 3:55-60. For instance, Kobayashi describes that the PPM and docking station are connected together by a processor independent of connection, such as the PC Peripheral Component Independent (PCI) Bus. *Id.* at 3:12-15.

Figure 2 of Kobayashi is reproduced below (emphasis added):

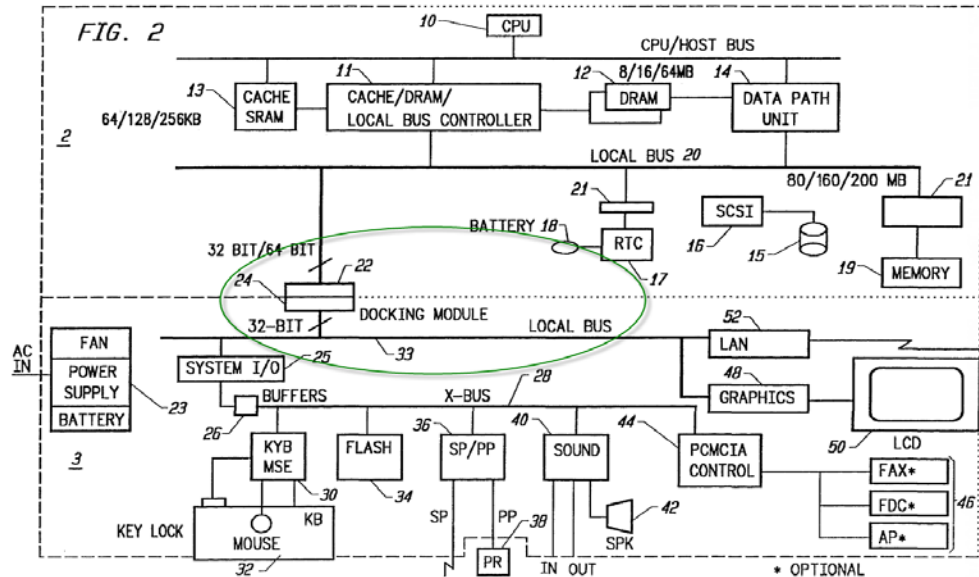
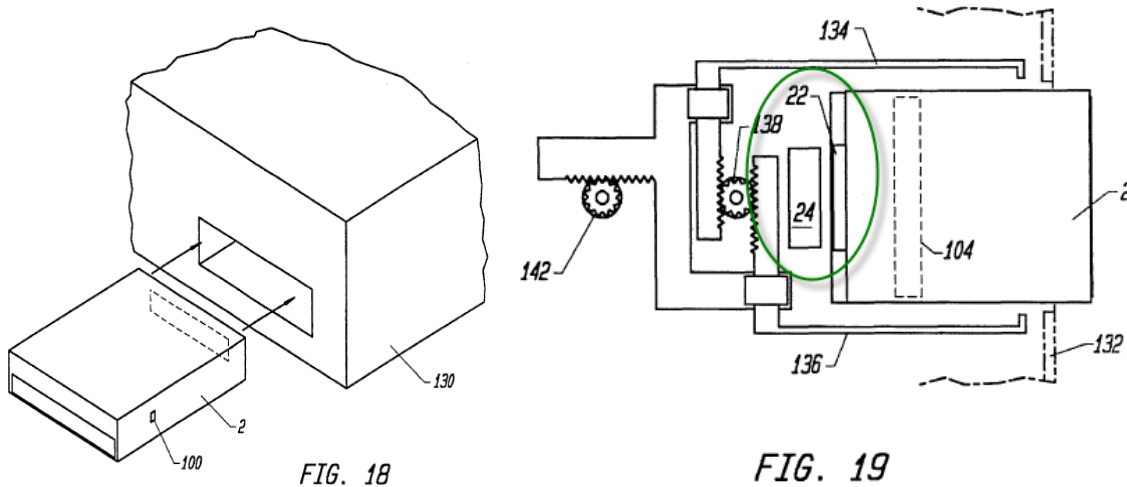


Figure 2 of Kobayashi illustrates the relationship between a PPM and a docking station.

As shown in Figure 2 of Kobayashi, docking station 3 includes local bus 33 for communicating across the interface. Ex. 1003, 5:64-6:1. Local bus 33 includes physical connector 24 for connecting docking station 3 with PPM 2. *Id.* Similarly, PPM 2 includes connector 22 for connecting PPM 2 with docking station 3. *Id.* at Fig. 2.

Figures 18 and 19 of Kobayashi are reproduced below (emphasis added):



Figures 18 and 19 of Kobayashi depict a docking station and the physical mechanisms that are used to move and lock the PPM in the docking station.

As shown in Figures 18 and 19, PPM 2 is inserted into docking station 130. *Id.* at 10:7-8. More specifically, PPM 2 is inserted inside front wall 132 of docking station 130 and between arms 134 and 136, which will be moved laterally by motor 138 to grasp the sides of PPM 2 and hold it in docking station 130 while the PPM is activated. *Id.* at 10:8-13. PPM connector 22 extends slightly beyond the end of PPM 2 so that it may interface with connector 24 in the docking station. *Id.* at 10:18-20. Clearly, Kobayashi's docking station is configured physically so that it will not operate with a computer other than a PPM that has the appropriate configuration.

ADDC also alleges that Kobayashi's connectors do not meet the "reader configuration" limitation, because they are the same features relied upon by Motorola for meeting the "connector for connecting" claim limitations—(1) a *portable computer connector* for connecting the portable computer to a reader; and (2) a *reader connector* for connecting the reader to a portable computer (claims 1 and 15). PO Resp. 23-24. According to ADDC, when the claim phrase "connector for connecting" is construed to require a reader having *a slot or hole*, Kobayashi's connectors merely meet the "connector for connecting" limitations, and not the "reader configuration" limitation. *Id.* at 22-24.

ADDC's arguments are inapposite because they are premised on an overly narrow claim construction of the claim phrase "connector for connecting," requiring *a reader slot or hole* (*id.* at 15). As we discussed above in the claim construction section, we decline to adopt such an overly narrow construction, because it would import limitations improperly from the specification into the claims. Rather, we construe the claim phrase "connector for connecting" as a device or configuration that establishes a wireless or physical communication connection between a reader and a portable computer.

Although Kobayashi discloses a docking station having a slot (*see, e.g.,* Ex. 1003, Fig. 18), that feature is not needed to meet the "connector for connecting" limitations. According to Motorola, Kobayashi meets the "connector for connecting" limitations because Kobayashi discloses a docking station that has a *multi-connector* that connects to a PPM with a

mating multi-connector. Pet. 8, 10 (citing Ex. 1003, 3:55-58). We agree with Motorola. As noted above, Figures 2 and 19 of Kobayashi illustrate that docking station 3 includes *connector 24 for connecting* docking station 3 with PPM 2, and PPM 2 includes *connector 22 for connecting* PPM 2 with docking station 3. Ex. 1003, 5:64-6:1, Figs. 2, 19.

For the reasons stated above, we agree with Motorola that Kobayashi discloses all of the limitations of claims 1 and 15, including the “reader configuration” limitation and the “connector for connecting” limitations.

ADDC’s arguments are directed to independent claims 1 and 15, and ADDC does not address dependent claims 3, 7, 16, 18, and 20 with separate, specific arguments. PO Resp. 24. As to dependent claims 3, 7, 16, 18, and 20, Motorola provides sufficient evidence to show that Kobayashi discloses the additional recited limitations in those claims. Pet. 10-14. For example, with respect to claim 3 (which requires a keyboard and display), Kobayashi’s docking stations each, as shown in Figure 1, have a keyboard and display. As another example, claim 18 recites “wherein the computer comprises substantially all of the components of a fully functional general purpose computer excluding means for a user to interact with the computer.” As illustrated in Figures 1 and 2 of Kobayashi, PPM 2 has all of the components of a fully functional, general purpose computer (e.g., CPU 10, Memory 19, and Battery 18), but it does not include input and output devices for a user to interact directly with PPM 2 (e.g., a keyboard and display). Ex. 1003, 3:53-55; 6:3-39.

For the foregoing reasons, we hold that Motorola has demonstrated, by a preponderance of the evidence, that claims 1, 3, 7, 15, 16, 18, and 20 are anticipated by Kobayashi.

C. Anticipated by Nelson

Motorola asserts that the challenged claims are unpatentable under 35 U.S.C. § 102(b) as anticipated by Nelson. Pet. 14. Motorola provides explanations as to how each limitation is met by Nelson. *Id.* at 14-23. Upon review of Motorola's analysis and ADDC's patent owner response, we determine that Motorola has demonstrated, by a preponderance of the evidence, that claims 1, 3, 7, 15, 16, 18, and 20 are anticipated by Nelson.

1. Overview of Nelson

Nelson describes a personal computer module system that has two separable parts: (1) the processor module, which Motorola equates to as the "portable computer" (Pet. at 14); and (2) a PC base unit, which Motorola equates to as the "reader" (*id.* at 14-15). Ex. 1004, 1:37-52.

Figure 2 of Nelson is reproduced below:

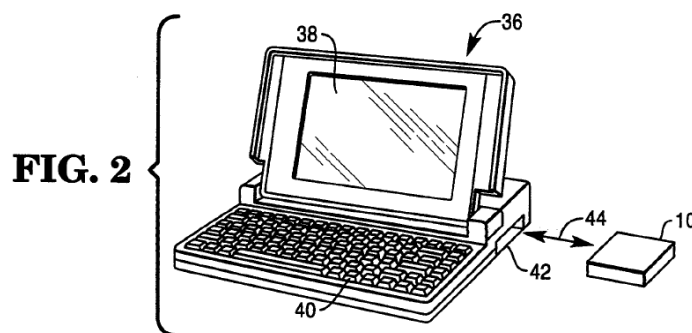


Figure 2 of Nelson illustrates a PC base unit and a processor module.

As depicted in Figure 2 of Nelson, PC base unit 36 includes a housing, display 38, keyboard 40, base unit 12, and receptacle 42 that is configured to receive processor module 10. Ex. 1004, 2:51-63. Processor module 10 may be inserted into PC base unit 36 to enable operations of the combined units as a complete data processing system. *Id.* Processor module 10 includes processor 14, memory 16, hard disk unit 18, system controller 20, and interface 22. *Id.* at 2:25-30.

Figure 1 of Nelson is reproduced below:

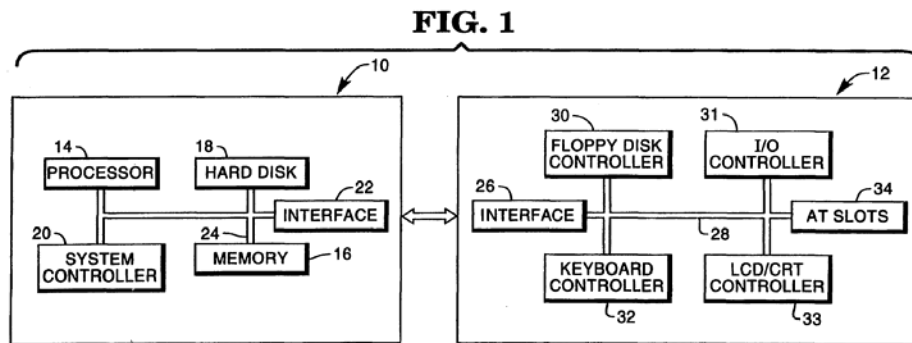


Figure 1 of Nelson depicts a processor module and a PC base unit.

As shown in Figure 1, processor module 10 does not include input and output devices for a user to interact directly with processor module 10. Further, PC base unit 12 does not include a processor, system controller, and memory, and therefore it could not function when it is not connected to processor module 10.

2. Discussion

The explanations provided by Motorola as to how each claim limitation of the challenged claims is met by Nelson have merit. Pet. 14-23. ADDC counters that Nelson does not describe the “reader configuration”

limitation, as required by 1, 3, 7, 15, 16, 18, and 20 claims. PO Resp. 13-23. ADDC argues that the “reader configuration” limitation requires that “the portable computers and readers are *matched via security protocols* so as to eliminate the possibility of access to the portable computers by just any reader.” PO Resp. 22 (emphasis added). ADDC also argues that the claim phrase “connector for connecting” requires *a reader slot or hole*. *Id.* at 15. Applying its proposed claim constructions submitted in the instant proceeding, ADDC maintains that Nelson does not disclose *matching security protocols* to prevent unauthorized access to the data on the processor module. *Id.* at 22. According to ADDC, Motorola has rendered the disputed limitation “superfluous by construing it to have the exact same scope and meaning as the element ‘connectors for connecting.’” *Id.* at 13.

We are not persuaded by ADDC’s arguments, as they are not commensurate with the scope of the claims. Further, ADDC’s arguments are based on an unduly narrow construction of the “reader configuration” limitation, requiring *matching security protocols*, and based on an improper interpretation of the claim phrase “connector for connecting,” requiring *a reader slot or hole*. As discussed above, we decline to adopt those overly narrow claim constructions, because they would import limitations from the specification into the claims, improperly limiting the claims to a preferred embodiment.

In its petition, Motorola asserts that Nelson meets the “reader configuration” claim limitation. Pet. 17-18. Motorola notes that Nelson’s base unit is configured so that it will not operate with a computer other than

a portable module of the system. *Id.* (citing Ex. 1004, 2:30-34; 2:57-63; 2:27-29; Figs. 2-3). Specifically, Motorola notes that Nelson’s processor module is packaged in a case that enables it to be installed and locked into a PC base unit, a host device. Pet. 17 (citing Ex. 1004, 2:30-34). Motorola asserts that “for the module to include functionally to be ‘optionally locked into a host device,’ it would require a design that is specific to that host device, or . . . specific to that type of host device.” *Id.*

We agree with Motorola, as its assertions are supported by a preponderance of the evidence. Indeed, Nelson describes a PC base unit that limits the types of computers that may be used with the PC base unit. *See, e.g.,* Ex. 1004, 2:30-34 (“The module is packaged in a case which provides mechanical modularity which enables it to be installed and optionally locked into a host device.”); 2:54-63 (“The portable PC 36 includes . . . a receptacle 42 which is appropriately configured to receive the module 10. As represented by double-headed arrow 44 in FIG. 2, the module 10 may be readily moved into and out of the housing of portable PC 36 . . .”).

As to ADDC’s argument regarding the claim phrase “connector for connecting” (PO Resp. 13-16), we are not persuaded. Although Nelson discloses a PC base unit having a receptacle (i.e., a slot or hole) configured to receive a processor module (Ex. 1004, 2:56-57; Fig. 2), that feature is not needed to meet the “connector for connecting” limitations. As shown in Figure 1 of Nelson, processor module 10 has interface 22 that enables processor module 10 to be coupled with PC base unit 12 (i.e., a portable computer connector for connecting the portable computer to a reader). *Id.* at

2:27-29. Similarly, Nelson's PC base unit 12 has interface 26 that engages interface 22 to couple the PC base unit with processor module 10 (i.e., a reader having a connector for connecting to a computer). *Id.* at 2:35-37.

For the reasons provided above, we agree with Motorola that Nelson describes all of the limitations of claims 1 and 15, including the "reader configuration" limitation and the "connector for connecting" limitations.

ADDC's arguments are directed to independent claims 1 and 15, and ADDC does not address dependent claims 3, 7, 16, 18, and 20 with separate, specific arguments. PO Resp. 22-23. As to dependent claims 3, 7, 16, 18, and 20, Motorola provides sufficient evidence to show that Nelson discloses the additional recited limitation in those claims. Pet. 14-23. For example, as to claim 3 (which requires a keyboard and display), Nelson's PC base unit includes a keyboard and display (Ex. 1004, 2:54-55, Fig. 2). As another example, claim 18 recites "wherein the computer comprises substantially all of the components of a fully functional general purpose computer excluding means for a user to interact with the computer." As shown in Figures 1 and 2 of Nelson, processor module 10 includes all of the components of a fully functional general purpose computer (e.g., processor 14, system controller 20, and memory 16), but it does not include input and output devices for a user to interact directly with processor module 10 (e.g., a keyboard and display).

For the foregoing reasons, we hold that Motorola has demonstrated, by a preponderance of the evidence, that claims 1, 3, 7, 15, 16, 18, and 20 are anticipated by Nelson.

CONCLUSION

Motorola has met its burden of proof, by a preponderance of the evidence, in showing that claims 1, 3, 7, 15, 16, 18, and 20 of the '484 patent are unpatentable based on the following grounds of unpatentability:

- A. Claims 1, 3, 7, 15, 16, 18, and 20 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Kobayashi; and
- B. Claims 1, 3, 7, 15, 16, 18, and 20 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Nelson.

ORDER

In consideration of the foregoing, it is

ORDERED that claims 1, 3, 7, 15, 16, 18, and 20 of the '484 patent are CANCELLED.

Case IPR2013-00010
Patent 7,516,484

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