

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EMC CORPORATION, EMC INTERNATIONAL U.S. HOLDINGS, INC.,
and VMWARE, INC.,
Petitioner,

v.

CLOUDING CORP.,
Patent Owner.

Case IPR2014-01217
Patent 6,925,481 B2

Before JAMESON LEE, MICHAEL W. KIM, and KRISTINA M. KALAN,
Administrative Patent Judges.

KIM, *Administrative Patent Judge.*

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

I. INTRODUCTION

A. *Background*

EMC Corporation, EMC International U.S. Holdings, Inc., and VMware, Inc., (collectively, “Petitioner”) filed a Petition requesting *inter partes* review of claims 1–5, 25, 28, 30, 40, 48, 49, 52, and 53 of U.S. Patent 6,925,481 B2 (“the ’481 patent”) pursuant to 35 U.S.C. §§ 311–319. Paper 1 (“Pet.”). Clouding Corp. (“Patent Owner”) filed a Preliminary Response. Paper 7, 2; Paper 9. On January 26, 2015, we instituted an *inter partes* review of claims 1–5, 25, 28, 30, 40, 48, 49, 52, and 53 on one ground of unpatentability alleged in the Petition. Paper 10 (“Dec.”). After institution of trial, Patent Owner filed a Patent Owner Response (Paper 23, “PO Resp.”) and Petitioner filed a Reply (Paper 27, “Reply”). An oral hearing was held on August 17, 2015. Paper 36 (“Tr.”).

The Board has jurisdiction under 35 U.S.C. § 6(c). In this Final Written Decision, issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73, we determine that Petitioner has shown by a preponderance of the evidence that all claims for which trial is instituted, namely, claims 1–5, 25, 28, 30, 40, 48, 49, 52, and 53, are unpatentable.

B. *The ’481 Patent*

The ’481 patent sets forth:

The present invention relates to pervasive computing, and more particularly to methods, systems, and computer program instructions for enabling users of **pervasive devices** (such as limited-function mobile devices, smart appliances, etc.) to remotely access and manipulate information in ways that might otherwise be impossible or impractical because of inherent limitations of the device.

Ex. 1001, 1:7–13 (emphasis added).

As explained in the ’481 patent, pervasive devices have become popular in recent years as users increasingly seek “anywhere, anytime” access to services

such as voice and data communications. Ex. 1001, 1:17–20. However, pervasive devices have inherent drawbacks. Ex. 1001, 1:46–47. Pervasive devices typically do not have sufficient memory to store all information that the user requires. Ex. 1001, 1:61–63. Pervasive devices also may not have sufficient software to access all of data that the user might wish to use. Ex. 1001, 2:3–5. Pervasive devices further may not have necessary drivers installed with which to support all data manipulation operations the user might wish to perform. Ex. 1001, 2:12–14. Accordingly, the '481 patent discloses a technique for enabling pervasive devices to access and manipulate data that avoids these drawbacks. Ex. 1001, 3:27–29.

C. *Related Matters*

Patent Owner identifies the following related district court proceeding between Petitioner and Patent Owner that involves the '481 patent: *Clouding Corp. v. EMC Corp.*, Case No. 1:14-cv-01178 (D. Del.). Paper 7, 2. Petitioner and Patent Owner identify also the following *inter partes* reviews, involving different petitioners than the present proceeding, that were before the Board involving the '481 patent, but are now terminated: IPR2013-00075 (Ex. 1003); IPR2014-00299 (Ex. 1004). Paper 5, 2; Paper 7, 2.

D. *Illustrative Claim*

Independent claim 1 is reproduced below:

1. A method of enabling data access and manipulation from a pervasive device, comprising steps of:
 - receiving a data access request from a pervasive device;
 - obtaining the requested data;
 - determining what data manipulation operations are available for the obtained data, as well as a location of each available data manipulation operation; and

returning the determined data manipulation operations and locations to the pervasive device, in addition to the obtained data.

E. Prior Art Reference Applied by Petitioner and Alleged Ground of Unpatentability

Petitioner challenges the patentability of claims 1–5, 25, 28, 30, 40, 48, 49, 52, and 53 based on anticipation in view of the following item of prior art:

US 6,670,968 B1 (“Schilit”) Dec. 30, 2003 Ex. 1005

II. ANALYSIS

A. 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 patent in which it appears. 37 C.F.R. § 42.100(b); *see also In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1275–79 (Fed. Cir. 2015) (“We conclude that Congress implicitly approved the broadest reasonable interpretation standard in enacting the AIA.”) 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). Any special definition for a claim term must be set forth in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). We must be careful not to read a particular embodiment appearing in the written description into the claim if the claim language is broader than the embodiment. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993). We construe the terms below in accordance with these principles.

1. *Whether No More Than One Data
Access Request Is Permitted*

Independent claims 1 and 52 each recite “receiving a data access request.”

Petitioner asserts the following:

For purposes of this *inter partes* review, Petitioners submit that the broadest reasonable construction of “receiving a data access request” is the construction adopted by the Board in the Oracle and SAP proceedings. Specifically, the term “receiving a data access request” as used in claims 1 and 52 of the ’481 Patent does not preclude receiving additional data access requests, or having steps performed also in response to another request. (Ex. 1003 at 7–9; Ex. 1004 at 6–8).

As the Board twice noted, this construction is consistent with the open-ended transition “comprising” in the independent claims. (Ex. 1003 at 7–8; Ex. 1004 at 6–7). It is also consistent with the specification, which explicitly notes that the embodiments in which only one request was disclosed were not to be construed as limiting. (Ex. 1001 at 18:43–45; Ex. 1003 at 8; Ex. 1004 at 8–9).

Pet. 12–13 (citing Exs. 1001, 1003, 1004).

Patent Owner asserts that elements within claim 1 could be obtained in response to additional data access requests not recited in claim 1, because that would run contrary to the plain meaning and internal consistency of the claim’s terms, as well as the disclosure in the specification as viewed by a person of ordinary skill in the art. PO Resp. 6–11 (citing Ex. 1001, 2001). We disagree, and agree with Petitioner in construing independent claim 1 such that elements within claim 1 could be obtained in response to additional data access requests not recited in claim 1.

Patent Owner asserts that the “requested data” is synonymous with the “obtained data,” and is indeed the only data found in the claims. We agree. Patent Owner’s assertion is misplaced, however, because giving the term that meaning does not conflict with the above-stated claim construction of Petitioner. For

example, independent claim 1 recites “obtaining the requested data,” where that “requested data” is in response to a “data access request” received in “receiving a data access request from a pervasive device.”

To clarify our construction, we provide the following illustrative scenario. Assume a user makes a data access request, “we want the Elvis song ‘Jailhouse Rock’.” This request for “Jailhouse Rock” is sent from the pervasive device to a server. The server may find “Jailhouse Rock”, but then may wonder “what music format for ‘Jailhouse Rock’ would the pervasive device prefer?” The server may then send such a query back to the pervasive device, and the pervasive device can respond “we request .wav files.” Based on the two requests from the pervasive device, the server then sends “Jailhouse Rock” as a .wav file. “Jailhouse Rock” in a .wav file format received by the pervasive device corresponds properly to the “requested data” recited in “obtaining the requested data,” because it is clearly the “Jailhouse Rock” song initially requested by the pervasive device. Of course, “Jailhouse Rock” in the .wav file format is *also responsive* to the additional data access request of “we request .wav files.” Indeed, Patent Owner does not appear to dispute the applicability of this scenario. *See* Tr. 48:17–50:4.

What Patent Owner attempts to assert in distinguishing the prior art, however, is that the recited obtained data (e.g., “Jailhouse Rock” in the .wav file format) cannot be obtained based on *both* the recited data access request (e.g., “we want the Elvis song ‘Jailhouse Rock’”) *and an additional data access request* (e.g., “we request .wav files”). Clearly, the recited obtained data (e.g., “Jailhouse Rock” in the .wav file format) may be responsive to both. We are unpersuaded that independent claims 1 and 52 require that the recited obtained data (e.g., “Jailhouse Rock” in the .wav file format) be obtained *only* from the recited data access request

(e.g., “we want the Elvis song ‘Jailhouse Rock’”) **and** *to the exclusion of any other additional data access request* (e.g., “we request .wav files”) for several reasons.

First, independent claim 1, for example, recites the open-ended transitional phrase “comprising” in conjunction with all of the recited steps, including “receiving a data access request.” See *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368 (Fed. Cir. 2003) (“The transition ‘comprising’ in a method claim indicates that the claim is open-ended and allows for additional steps.”). Thus, the recitation of “receiving a data access request” (e.g., “we want the Elvis song ‘Jailhouse Rock’”) does not preclude receiving additional data access requests (e.g., “we request .wav files”) or having steps performed in response to both requests (e.g., returning “Jailhouse Rock” in the .wav file format).

Second, other language in each independent claim is consistent with our claim construction set forth above. For example, a subsequent step recited in independent claim 1 and also subject to the open-ended transitional phrase “comprising” is “obtaining the requested data.” While the requested data must be obtained in response to the previously recited “data access request,” it does not follow that the requested data must be obtained only in response to the same recited “data access request,” and cannot also be obtained in response to other, additional data access requests. Obtaining data in response to other data access requests, in addition to the one particular data access request, is not excluded by the claim language at issue.

Third, the specification is consistent also with the construction proposed by Petitioner, which we agree with and adopt. For example, the Summary of the Invention section of the specification mentions accommodating multiple data access requests. Ex. 1001, 4:5–8 (“In preferred embodiments, the proxies, agents, and DMS are not located within the WID, but instead are accessed by sending one

or more request messages from the WID.”). In another example, the embodiments in the specification, such as Figure 3 cited by Patent Owner, disclose performing the obtaining, determining, and returning steps in response to one data access request. There is no indication, however, that other embodiments are excluded, and, indeed, the specification nowhere disclaims other embodiments. Moreover, the specification actually indicates the contrary of Patent Owner’s position by stating, “[t]he foregoing description of a preferred embodiment is for purposes of illustrating the present invention, and is not to be construed as limiting thereof.” Ex. 1001, 18:36–38; *see also* Ex. 1001, 4:49–56 (“As will be obvious to one of ordinary skill in the art, these flowcharts are merely illustrative of the manner in which the associated aspects of the present invention may be implemented, and changes may be made to the logic that is illustrated therein (for example, by altering the order of operations shown in some cases, by combining operations, etc.) without deviating from the inventive concepts disclosed herein.”).

At oral argument, Patent Owner asserted that the aforementioned portions of the specification are boilerplate language, and, thus, should be given minimal weight as compared to the balance of the specification. Tr. 32:16–33:6. As an initial matter, we note that column 4, lines 5–8 are cited above, and those portions of the specification are directed to preferred embodiments. Moreover, we are unable to discern, and Patent Owner does not cite, any authority on characterizing, and, thus, disregarding certain prior art disclosure as boilerplate language. Accordingly, we decline to disregard what Petitioner characterizes as “boilerplate” language.

Patent Owner asserts also that any additional data access requests would be undefined, for none are shown in Figure 3 or elsewhere described in the specification. Patent Owner’s assertions are misplaced. While we agree that the

'481 patent does not disclose explicitly additional data access requests, such an absence does not support affirmatively precluding obtaining data responsive to *both* the recited data access request *and additional data access requests*, for the reasons set forth above.

Patent Owner asserts also that any additional data access requests would be superfluous, for the requested data has already been obtained, and, therefore, without meaning. Here, too, Patent Owner's assertions are misplaced, for the additional data access request is not superfluous in the above construction where the obtained data (e.g., "Jailhouse Rock" in the .wav file format) is responsive to *both* the recited data access request (e.g., "we want the Elvis song 'Jailhouse Rock'") *and an additional data access request* (e.g., "we request .wav files").

Patent Owner asserts further that the independent claims do not permit the data that is operated upon in the balance of the claim to be obtained by the additional, unrecited data request, because this would run contrary to the plain meaning of the terms as well as the purpose and mechanics of the method as disclosed in the specification. To the extent that Patent Owner is asserting that the operating steps set forth in the balance of the claim should operate *only* on the additional, unrecited data request *to the exclusion of* the recited data access request, Patent Owner's assertion is misplaced for the reasons set forth above.

Patent Owner cites *In re Abbott Diabetes Care Inc.*, 696 F.3d 1142, 1149 (Fed. Cir. 2012), in support of several of its positions. Patent Owner asserts that any additional data access requests would be superfluous, and that *In re Abbott Diabetes Care Inc.* instructs that superfluous language is disfavored. We are unpersuaded that the additional data access requests are superfluous, for the reasons set forth above.

Patent Owner asserts further that the specification as a whole is directed to compensating for the limitations of a pervasive device—e.g., “access to limited-bandwidth networks,” and “the need to maximize the device’s relatively short battery life” (Ex. 1001 at 1:35–56), thus teaching a person of ordinary skill that adding data access requests, where the specification teaches a method can be accomplished using only one, would be undesirable. Patent Owner asserts that the above-quoted language from the specification amounts to sufficient disparagement of additional data access requests under *In re Abbott Diabetes Care Inc.* to warrant exclusion from a proper claim construction. In effect, Patent Owner is asserting that the specification indicates a disclaimer of additional data access requests. We disagree. Unlike the explicit references to and disparagement of the disputed subject matter in the background section of the patent at issue in *In re Abbott Diabetes Care Inc.*, the above-quoted language from the specification does not even mention additional data access requests, a fact confirmed repeatedly by Patent Owner. Such explicit references are necessary, because any special definition for a claim term must be set forth in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d at 1480. It can be difficult to show the necessary clarity, deliberateness, and precision without there being any explicit discussion of the subject, and we are unpersuaded that Patent Owner has made a sufficient showing. *See also Hill-Rom Servs., Inc. v. Stryker Corp.*, 755 F.3d 1367, 1372–73 (Fed. Cir. 2014) (*quoting Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1327 (Fed.Cir.2002)) (“[e]ven when the specification describes only a single embodiment, the claims of the patent will not be read restrictively unless the patentee has demonstrated a clear intention to limit the claim scope using ‘words or expressions of manifest exclusion or restriction’”). Indeed, Patent Owner’s assertion appears to be a hindsight attempt to

impermissibly read a particular embodiment appearing in the written description into the claim, where the claim language would support a broader embodiment. *See In re Van Geuns*, 988 F.2d 1184.

In light of the lack of explicit reference to additional data access requests, Patent Owner can at best show only a tangential relationship between additional data access requests and the above-quoted language from the specification. Given the need in a disclaimer for clarity, deliberateness, and precision using “words or expressions of manifest exclusion or restriction,” in order to show that this tangential relationship rises to the level of a disclaimer, Patent Owner would need to show that the correlation between additional data access requests and bandwidth and battery life is so undisputedly negative, that one of ordinary skill could not have helped but come to the conclusion that any action that would negatively impact bandwidth and battery life, such as additional data access requests, are precluded by the claim. In support of this implication, Patent Owner cites the Declaration of Dr. Scott M. Nettles, which recites the following:

There is no method corresponding to claim 1 that is described in the '481 patent that involves or suggests more than one data access request. Indeed, such methods would run contrary to the goals of the patentee to reduce power consumption at the mobile device while also simplifying its operation. The method of claim 1 requires one send and one receive at the pervasive device. And in fact, those sends and receives would have been needed just to communicate. As discussed above, a person of ordinary skill would have understood that this minimal scheme was desirable to conserve resources.

Ex. 2001 ¶ 30. This paragraph constitutes the entirety of Patent Owner’s factual support for its position in this regard.

In response, Petitioner relies on the Declaration of Dr. Benjamin Goldberg to support its position that one of ordinary skill in the art would have understood that, in certain circumstances, using multiple data access requests is commensurate with

preserving bandwidth and battery life, for example, and, most notably, when obtained data is in response to multiple requests, but also when a request for a large data file is broken up into multiple smaller requests to preserve the possibility that the rest of the data won't be sent. Reply 3–4 (citing Ex. 1022 ¶¶ 22–28).¹ Accordingly, when we consider that Patent Owner's position is based on a tangential extrapolation from the specification supported by minimal factual support from Dr. Nettles, we are more persuaded by Petitioner's reasoning and response, which is supported by the more robust Declaration of Dr. Goldberg, the contents of which we have considered and determine are more credible than those of Dr. Nettles's Declaration.

Accordingly, although independent claims 1 and 52 do require that the steps recited therein, other than the receiving step and the requesting step, be responsive to the same data access request, they do not preclude receiving additional data access requests, or having steps performed also in response to another request.

2. *“Location of Each Available Data Manipulation Operation”*

Independent claims 1 and 52 each recite “location of each available data manipulation operation.” Petitioner asserts the following:

For purposes of this *inter partes* review, Petitioners submit that the broadest reasonable construction of the term “location of each available data manipulation operation” is the construction adopted by the Board in the Oracle and SAP proceedings. Specifically, the term “location of each available data manipulation operation” as used in claims 1 and 52 of the '481 Patent means “a location identified by an

¹ In reply to Patent Owner's assertions on this issue, Petitioner cites Schilit for disclosing that it, too, is directed to “minimiz[ing] transmissions over relatively low-bandwidth wireless communications.” Reply 17 (citing Ex. 1005, 11:11–13). Accordingly, as Schilit discloses additional data access requests, Schilit provides objective evidence that additional data access requests are not undisputedly correlated negatively with minimizing bandwidth and battery life.

address, such as a URL, an e-mail address, or a combination of an e-mail address and subject line, specifying where on a computer network a data manipulation operation or service may be invoked.” (Ex. 1003 at 9–10; Ex. 1004 at 8–9).

As the Board twice noted, this construction finds direct support in the specification, which discloses that the references to data manipulation operations “may employ address formats other than URLs, such as e-mail addresses, or perhaps a combination of an e-mail address and subject line, to designate a service to be invoked.” (Ex. 1001 at 9:15–19; Ex. 1003 at 9–10; Ex. 1004 at 8–9).

Pet. 13–14 (citing Exs. 1001, 1003, 1004). Patent Owner does not indicate any disagreement with Petitioner’s proposed construction.

The Specification interchangeably refers to a data manipulation operation and a data manipulation service. Ex. 1001, 4:17–29. A service invocation address specifies a location of a data manipulation service. Ex. 1001, 9:10–14. The service invocation address is specified for each data manipulation service and indicates an address at which the data manipulation service may be invoked. Ex. 1001, 8:57–60. These addresses are provided as Uniform Resource Locators (“URLs”). Ex. 1001, 8:60–62. The Specification discloses further that “[i]n alternative embodiments, service invocation addresses may employ address formats other than URLs, such as e-mail addresses, or a combination of an e-mail address and subject line, to designate a service to be invoked.” Ex. 1001, 9:15–19. Thus, we construe “location of each available data manipulation operation” as “a location identified by an address, such as a URL, an e-mail address, or a combination of an e-mail address and subject line, specifying where on a computer network a data manipulation operation or service may be invoked.”

3. *Whether the Data Manipulation Operations, their Locations, and the Obtained Data Must Be Returned Together*

Independent claim 1 recites “returning the determined data manipulation operations and locations to the pervasive device, in addition to the obtained data.” Independent claim 52 recites a similar limitation. Patent Owner asserts that this claim limitation requires that the data manipulation operations, their locations, and the obtained data are returned together. PO Resp. 11–12 (citing Exs. 1001, 2001). We disagree. To support its position, Patent Owner presents several assertions, each of which we will address in turn.

Patent Owner asserts that its position is a logical conclusion from the fact that “the claim language suggests that it is a single operation.” PO Resp. 11. We disagree. As an initial matter, we note that Patent Owner only asserts that such a construction is suggested. We are unclear as to the proper place of a suggestion in the context of claim construction. Furthermore, we determine that the aforementioned claim language does not indicate one way or the other whether or not all the aforementioned data is returned together. There are no temporal or delivery format limitations, as the only determination we are able to discern from the aforementioned claim limitation for the operations and locations data is that it is (1) returned and (2) additional to the obtained data, neither of which require the data manipulation operations, their locations, and the obtained data to be returned together.

Patent Owner asserts further that the specification supports their position, because the only embodiments in the specification show that the data manipulation operations, their locations, and the requested data are returned together. We disagree. As an initial matter, our reviewing court has cautioned against reading limitations into a claim from the preferred embodiment described in the specification, even if it is the only embodiment described, absent clear disclaimer

in the specification. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004). Furthermore, the first citation provided by Patent Owner reads as follows: “When requested information is delivered to a client application on the WID, a list of service invocation addresses for the available services is provided along with that information” Ex. 1001, 9:20–23. Presumably, Patent Owner asserts that the “along with” language supports their position. As an initial matter, we note that the aforementioned claim limitations do not recite “along with.” Moreover, we are unpersuaded that “along with,” as used in the specification, places such strict temporal and delivery format limitations on the data manipulation operations, their locations, and the obtained data. The same analysis is applicable to Patent Owner’s subsequent citation: “Continuing on with FIG. 3, at Block 360, the content, along with the annotated list of available services is returned to the WID.” Ex. 1001, 15:52–54.

Patent Owner asserts additionally that nowhere does the specification teach or suggest that the data and the data manipulation operations should be provided to the pervasive device separately. We disagree. The specification indicates a broad desire that the disclosed embodiments not be construed as limiting. *See, e.g.*, Ex. 1001, 18:36–38 (“[t]he foregoing description of a preferred embodiment is for purposes of illustrating the present invention, and is not to be construed as limiting thereof”); Ex. 1001, 4:49–56 (“As will be obvious to one of ordinary skill in the art, these flowcharts are merely illustrative of the manner in which the associated aspects of the present invention may be implemented, and changes may be made to the logic that is illustrated therein (for example, by altering the order of operations shown in some cases, by combining operations, etc.) without deviating from the inventive concepts disclosed herein.”). Accordingly, we determine that, particularly given such language in the specification, it is reasonable to construe

any reasonable ambiguity in the claim against importation of specific embodiments. *See In re Van Geuns*, 988 F.2d 1184.

Patent Owner asserts also that not returning the aforementioned data together would be waste of resources, an assertion similar to that set forth above for the additional data access request. Our analysis is the same as set forth above, and need not be repeated here.

Accordingly, we construe independent claims 1 and 52 as not requiring that the recited data manipulation operations, their locations, and the obtained data be returned together.

*B. Claims 1–5, 25, 28, 30, 40, 48, 49, 52, and 53 as
Anticipated by Schilit*

Petitioner contends that claims 1–5, 25, 28, 30, 40, 48, 49, 52, and 53 are anticipated by Schilit. Pet. 14–35; Reply 11–20. Patent Owner disagrees. PO Resp. 13–21.

1. Schilit (Ex. 1005)

Schilit relates to a Web Browser program, referred to as an “m-link,” which converts HTML documents for displaying on a mobile display. Ex. 1005, 5:30–32. The m-link program accesses a server to retrieve a document as identified by a user-selected URL. Ex. 1005, 5:32–34. The document received from the server is then parsed, and hyper-links contained in the document are separated from the content. Ex. 1005, 5:34–36. The hyper-links are processed, re-organized, and provided for display on the mobile device. Ex. 1005, 5:36–37. Once the links are displayed, the mobile-device keypad can be used to navigate to and select one of the displayed links. Ex. 1005, 5:46–48. As shown below in Figures 6A and 6B, Schilit discloses a menu tree of links that can be navigated by user selection so as

to allow a user to select the “Publications” link, and then the “Hypertext Interaction revisited” link.

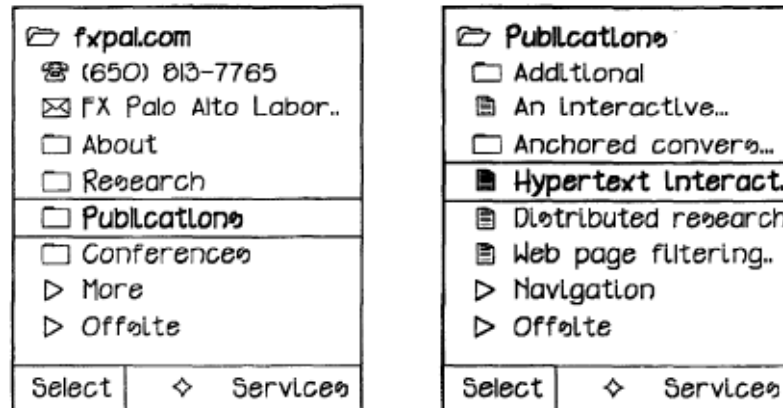


FIG. 6A

FIG. 6B

Figure 6A displays links from the FXPAL Web page with links reorganized for better viewer accessibility, and new links for a telephone number and an address are provided. Figure 6B shows links provided after selection of the publications link in Figure 6A.

As shown below in Figure 6C, a list of situations, or content-appropriate services, such as reading, printing, or faxing, is then provided to the mobile device display after the “Hypertext Interaction revisited” link is selected in Figure 6B.

Ex. 1005, 5:48–49.

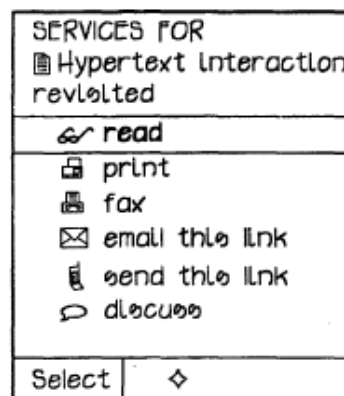


FIG. 6C

Figure 6C shows services available for the “Hypertext interact . . .” publication link from Figure 6B.

The services are hosted on a database. Ex. 1005, 10:1–2. The list of content-appropriate services, including printing and faxing, are provided dynamically by the database, for display on the mobile device display, based on the link owner or link type selected by the user. Ex. 1005, 10:1–4. Selecting one of the services from the list enables the service selected to be performed on the user-selected URL. Ex. 1005, 5:49–51. Schilit discloses other services including links for dialing telephone numbers identified in the content of the web page and map locations for similarly identified addresses. Ex. 1005, 8:4–36.

2. *Claims 1–5, 25, 28, 30, 40, 48, 49, 52, and 53*

After considering the Petition, Patent Owner Response, Reply, and all evidence relied on by Petitioner and Patent Owner, we are persuaded that Petitioner has shown, by a preponderance of the evidence, that claims 1–5, 25, 28, 30, 40, 48, 49, 52, and 53 are anticipated by Schilit. The Petition sufficiently accounts for each of the elements in these claims. For example, independent claim 1 recites “receiving a data access request from a pervasive device” and “obtaining the requested data.” Schilit discloses that an m-link program accesses a server to retrieve a document identified by a user-selected URL. Ex. 1005, 5:32–34. Independent claim 1 also recites “determining what data manipulation operations are available for the obtained data, as well as a location of each available data manipulation operation” and “returning the determined data manipulation operations and locations to the pervasive device.” Schilit discloses that, in response to receipt of a user-identified URL, a list of situations, or content-appropriate services, such as reading, printing, or faxing, for that user-identified URL, are located on a database (Ex. 1005, 10:1–4) and provided to a mobile device display. Ex. 1005, 5:48–49, Fig. 6C.

The correspondence of Schilit's disclosure to independent claim 1 is even clearer for the phone number and address functions of Figure 6A. For example, independent claim 1 recites "receiving a data access request from a pervasive device" and "obtaining the requested data." Schilit discloses that an m-link program accesses a server to retrieve a document identified by a user-selected URL. Ex. 1005, 5:32–34. Independent claim 1 also recites "determining what data manipulation operations are available for the obtained data, as well as a location of each available data manipulation operation" and "returning the determined data manipulation operations and locations to the pervasive device." Schilit discloses that in response to receipt of a user-identified URL, a link is provided for a telephone number identified in the user-identified URL (e.g., "(650) 813-7765" as shown in Figure 6A of Schilit), the link listed as the telephone number identified in the user-identified URL is displayed on a mobile device display, and the link is configured such that when the link is selected the telephone number displayed on the mobile device is dialed. Ex. 1005, 8:14–18, Fig. 6A. Thus, as distinguished from the embodiment of Figure 6C of Schilit, one request for a user-selected URL results in both obtained data from the user-selected URL (e.g., "(650) 813-7765" as shown in Figure 6A of Schilit) and data manipulation operations (e.g., the link is configured such that when the link is selected the telephone number displayed on the mobile device is dialed). The same analysis applies to the address link (e.g., "FX Palo Alto Laboratory"), the selection of which brings up a map of the address listed in identified in the user-identified URL. Ex. 1005, 8:22–35, Fig. 6A.

We are persuaded similarly that the Petition has set forth adequately how Schilit discloses each and every limitation of claims 2–5, 25, 28, 30, 40, 48, 49, 52, and 53. Pet. 26–35.

Patent Owner asserts that Schilit does not disclose “returning the determined data manipulation operations and locations to the pervasive device, in addition to the obtained data,” in response to the data access request, as recited in independent claims 1 and 52. Specifically, Patent Owner asserts that Schilit does not return content (i.e., the obtained data) in response to a requested URL (i.e., the data access request), but instead returns links parsed and separated from the content of the requested URL, and, thus, more properly corresponds to the recited “data manipulation operations” rather than the recited “obtained data.” As an initial matter, we are unpersuaded that the recited “obtained data” is limited to content. Moreover, Patent Owner has not articulated sufficiently the boundaries of what would or would not constitute “content.” For example, Schilit discloses a hyperlink listing a phone number identified on a webpage, and that selecting that hyperlink will dial that phone number. Ex. 1005, 8:4–21. The phone number would meet the definition of content from the webpage, even if the manner in which the phone number is listed is in the form of a hyperlink. The same goes for the address hyperlink. Ex. 1005, 8:4–36. In any case, even if we were to limit the recited “obtained data” to what could be considered most typically as the “content” of a webpage, we find that user selection of the “reading” operation in Schilit would return such content to the user. Ex. 1005, 5:48–49, Fig. 6C.

In that regard, Patent Owner asserts that Schilit describes a process in which a user of a mobile device must engage in a series of request-response operations with an m-link browser in order to obtain separately requested data and data manipulation operations available for that data. As an initial matter, we note that this assertion is inapplicable to the embodiment in Figure 6A of Schilit, as that embodiment does not engage in this series of request-response operations; the

telephone content and link functionality are returned in response to one data access request, without any intervening operations.

Even for the embodiment in Figure 6C of Schilit, however, when we focus on the recited obtained data individually, Patent Owner is asserting that because each request-response operation is a separate data access request, the obtained data (i.e., content) in Schilit is returned not in response to an original data access request (i.e., the URL request of Schilit), as required by the claims, but to a request subsequent to the original data access request (i.e., the user selection of the “read” option in Schilit). We disagree, because we find that the content in Schilit is returned in response to both the original URL request and the subsequent “read” selection of the original URL request. Specifically, the content in Schilit is not obtained from a “read” request disembodied from the previous URL request, but is instead information derived from the webpage associated with, and, thus, inexorably intertwined with, the original URL request. Insofar as Patent Owner is asserting that any returned data can only be responsive to one discrete, separate data access request, we determined above that the claims are not so limiting. With regards to the recited “data manipulation operations,” Patent Owner’s assertions are also unavailing, as we find that the original URL request in Schilit results in the return of the aforementioned hyperlinks, such as reading, printing, or faxing, which we determine corresponds properly to the recited “data manipulation operations.” Ex. 1005, 5:48–49, Figs. 6A–6C. Thus, unlike the supposed content of Schilit, there are no intervening request-response operations.

Patent Owner asserts further that because the data manipulation operations, their locations, and the requested data are not returned together in Schilit, Schilit does not disclose “returning the determined data manipulation operations and locations to the pervasive device, in addition to the obtained data,” in response to

the data access request, as recited in independent claims 1 and 52. As set forth above, however, the claims do not require that the data manipulation operations, their locations, and the requested data all be returned together. Accordingly, in that regard, Patent Owner's assertions are unpersuasive.

Additionally, even if we were to agree that independent claims 1 and 52 require that the data manipulation operations, their locations, and the requested data must be returned together, we are persuaded that Schilit discloses such an option. Specifically, in reply to Patent Owner's assertions on this issue, Petitioner cites Schilit for disclosing that "[t]o minimize transmissions over relatively low-bandwidth wireless communications, the mlink browser **typically** separates and transmits links to mobile-devices, as indicated above." Reply 17 (citing Ex. 1005, 11:11–13). Given this disclosure, we find that Schilit discloses the converse was known: links and content can be transmitted together.

Patent Owner asserts that such a finding is incorrect, because Schilit does not go into any details about transmitting links and content together; that the only disclosures in Schilit are embodiments in which links and content and transmitted separately. In support of its position, Patent Owner cites the Declaration of Dr. Nettles. PO Resp. 18–20 (citing Ex. 2001 ¶¶ 49, 51, 53, 54). We have reviewed Patent Owner's supporting evidence, and are unpersuaded that they support adequately Patent Owner's position. Specifically, none of the cited testimony addresses column 11, lines 11–13 of Schilit. Accordingly, we are unpersuaded by Patent Owner's contention.

Dependent claim 25 recites "determining what data manipulation operations are available for a content type of the obtained data." Petitioner cites portions of Schilit as disclosing this limitation. Pet. 29–30 (citing Ex. 1005, 4:15–25, 4:48–51, 9:41–48; Ex. 1011 ¶¶ 20–21). We have reviewed Petitioner's position, and

determine that it is supported by a preponderance of the evidence. Patent Owner asserts the following:

Schilit fails to disclose this feature of claim 25. Ex. 2001 at ¶ 36. Schilit discloses making the service links available for a file dependent on service links provided by the owner of the link and the format of the link. Ex. 1005 at 9:41–48. However, the format of a link does not indicate what types of content are associated with that link at least because a link format is not analogous to a content type of obtained data. For example, link of a particular format may be associated with various types of content (e.g., images, text, graphs, audio files, etc.).

PO Resp. 20 (citing Exs. 1005, 2001). We disagree, because Petitioner cites the telephone number link function of Schilit as corresponding to the aforementioned claim limitation. Pet. 29 (citing Ex. 1001, 1011). We are persuaded that Schilit discloses determining that a telephone number link function is available for a content type of the obtained telephone number data from the webpage.

Dependent claim 28 recites “determining what data manipulation operations are available for a user of the pervasive device.” Petitioner cites portions of Schilit as disclosing this limitation. Pet. 30 (citing Ex. 1005, 4:52–54, 10:22–25, 10:30–33; Ex. 1011 ¶ 21). We have reviewed Petitioner’s position, and determine that it is supported by a preponderance of the evidence. Patent Owner asserts the following:

While *Schilit* may describe services that may be dependent on user preferences or services typically executed by a specific user, such services dependent upon user preferences or behavior (i.e., services typically executed by a specific user) are not analogous to data manipulation operations that are available for a user of a pervasive device at least because user preferences and behavior do not dictate the availability of data manipulation operations on a pervasive device. For example, a user may have a preference for a particular data manipulation operation that is not available or, conversely, a data

manipulation operation may be available to the user even though it is not a user's preferred data manipulation operation.

PO Resp. 21. As an initial matter, we disagree Schilit does not disclose that user preferences and behavior do not dictate the availability of data manipulation operations on a pervasive device. We determine Schilit discloses that expressly, for example, when disclosing the following: "the services portal enables a dynamic contribution to the items in the services list dependent on the specific user." Ex. 1005, 4:52–54; *see also* Ex. 1005, 10:22–30. Furthermore, the last sentence of Patent Owner's assertion set forth above is immaterial, as the claim language does not require that either every user preference must be available or that every available data manipulation operation must be preferred by the user. So long as both user preference and availability are taken into account, as we find they are in the aforementioned portions of Schilit, we are persuaded that the claim limitation is disclosed.

3. *Conclusion*

For the foregoing reasons, after considering the Petition, Patent Owner Response, Reply, and all evidence relied on by Petitioner and Patent Owner, we are persuaded that Petitioner has shown, by a preponderance of the evidence that claims 1–5, 25, 28, 30, 40, 48, 49, 52, and 53 are anticipated by Schilit.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 1–5, 25, 28, 30, 40, 48, 49, 52, and 53 of the '481 patent are held unpatentable; and

FURTHER ORDERED that because this is a final written decision, 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.

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Patent 6,925,481 B2

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