

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VTECH COMMUNICATIONS, INC., and
UNIDEN AMERICA CORPORATION,
Petitioner,

v.

SHPERIX INCORPORATED,
Patent Owner.

Case IPR2014-01432
Patent 6,614,899 B1

Before HOWARD B. BLANKENSHIP, JONI Y. CHANG, and
BEVERLY M. BUNTING, *Administrative Patent Judges*.

CHANG, *Administrative Patent Judge*.

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

I. INTRODUCTION

VTech Communications, Inc. and Uniden America Corporation (collectively, “VTech”) filed a Petition requesting an *inter partes* review of claims 1–5 and 8–23 of U.S. Patent No. 6,614,899 (Ex. 1001, “the ’899 patent”). Paper 2 (“Pet.”). Patent Owner Spherix Incorporated (“Spherix”) filed a Preliminary Response. Paper 11 (“Prelim. Resp.”). Upon consideration of the Petition and Preliminary Response, we instituted this trial as to claims 1–5 and 8–23, pursuant to 35 U.S.C. § 314, on March 3, 2015. Paper 14 (“Dec.”).

Subsequent to institution, Spherix filed a Patent Owner Response (Paper 24, “PO Resp.”), and VTech filed a Reply to the Patent Owner Response (Paper 27, “Reply”). An oral hearing¹ was held on September 28, 2015.²

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a). For the reasons discussed herein, we determine that VTech has shown by a preponderance of the evidence that claims 1–5 and 8–23 of the ’899 patent are unpatentable.

A. Related Matter

VTech indicates that the ’899 patent has been asserted in *Spherix Inc. v. VTech Telecomm., Ltd.*, No. 3:13-cv-3494-M (N.D.Tex.) and *Spherix Inc. v. Uniden Corp.*, No. 3:13-cv-3496-M. (N.D.Tex.). Pet. 1.

¹ The oral hearings for this trial and IPR2014-01431 were consolidated.

² A transcript of the oral hearing is entered in the record as Paper 44 (“Tr.”).

B. The '899 Patent

The '899 patent relates generally to a method and apparatus for providing Internet Protocol ("IP") telephony services. Ex. 1001, 1:7–9. In particular, the disclosed embodiments are directed to IP telephony intelligent devices that are said to be capable of updating local IP telephony directories from an IP network server, performing click-to-dial services using the local IP telephony directories, and performing advanced IP telephony services on incoming IP telephony communications. *Id.* at 1:9–15. According to the '899 patent, IP telephony was known generally in the art at the time of the invention. *Id.* at 1:18–19. One of the advantages of IP telephony devices was to provide users the capability of making telephone calls over the Internet, eliminating long distance charges. *Id.* at 1:22–28.

Figure 1 of the '899 patent is reproduced below.

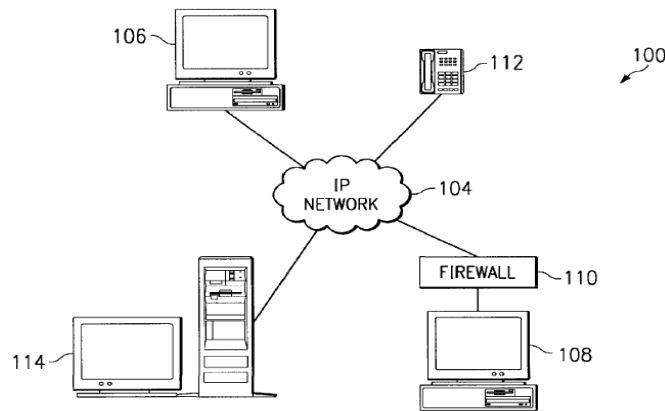


FIG. 1

As shown in Figure 1, communication system 100 is a network of computers, including IP network 104, intelligent IP telephony device 106, computing device 108, IP telephony apparatus 112, and directory server 114. *Id.* at 3:3–17, 4:7–9.

C. Illustrative Claim

Claims 1, 13, 14, 18, and 20 are independent. Claims 2–5 and 8–12 depend, either directly or indirectly, from claim 1; claims 15–17 depend ultimately from claim 14; claim 19 depends directly from claim 18; and claims 21–23 depend directly from claim 20.

Claim 1 is illustrative of the claimed subject matter of the '899 patent, and is reproduced below:

1. A method in a communications system for updating, from a network directory server, a *local telephony directory on a telephony device*, comprising:

establishing a communication connection between the telephony device and the network directory server;

sending an update request to the network directory server through the communication connection;

receiving updated telephony directory information from the network directory server through the communication connection;
and

updating the local telephony directory based on the updated telephony directory information.

Ex. 1001, 12:49–61 (emphases added).

D. Prior Art Relied Upon

VTech relies upon the following prior art references:

Wood	US 6,091,808	Jul. 18, 2000	(Ex. 1008)
Pickering	US 6,076,093	Jun. 13, 2000	(Ex. 1009)
Gerszberg	US 6,570,974 B1	May 27, 2003	(Ex. 1010)

Huiwei Guan, et al., *Java-Based Approaches for Accessing Databases on the Internet and a JDBC-ODBC Implementation*, 9(2) COMPUTING AND CONTROL ENGINEERING JOURNAL 71–78, IEE Xplor (Apr. 1998) (Ex. 1011, “Guan”)

E. Instituted Grounds of Unpatentability

We instituted the instant trial based on the following grounds of unpatentability (Dec. 26):

Claims	Basis	References
1–5 and 8–23	§ 103(a)	Pickering in view of Wood
2, 3, 9, 10, 11, 15, and 16	§ 103(a)	Pickering in view of Guan

II. 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); *see also In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1277–79 (Fed. Cir. 2015) (“Congress implicitly approved the broadest reasonable interpretation standard in enacting the AIA,”³ and “the standard was properly adopted by PTO regulation.”), *cert. granted sub nom. Cuozzo Speed Techs. LLC v. Lee*, 84 U.S.L.W. 3218 (Jan. 15, 2016) (No. 15-446). Under this 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). An inventor may rebut that presumption by providing a definition of

³ Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”).

the term in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). In the absence of such a definition, limitations are not to be read from the specification into the claims. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993). Furthermore, only those terms, which are in controversy, need to be construed, and only to the extent necessary to resolve the controversy. *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

Preambles of Claims 1, 13, 18, and 20

“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.” *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002) (citations omitted). “Conversely, a preamble is not limiting ‘where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention.’” *Id.* In other words, the preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305–06 (Fed Cir. 2005). When the limitations in the body of the claim “rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention.” *Eaton Corp. v. Rockwell Int’l Corp.*, 323 F.3d 1332, 1339 (Fed. Cir. 2003).

Here, the preambles of independent claims 1, 13, and 18 recite “for updating, from a network directory server, a local telephony directory on a telephony device.” *See, e.g.*, Ex. 1001, 12:49–50. The preamble of claim 20

recites “that initiates a telephony call, over a network having a network directory server, to a receiving telephony device.” *Id.* at 14:36–38.

The preambles of these claims recite essential structural elements of the claimed method and apparatus pertaining to the network directory server, local telephony directory, and telephony device, rather than merely stating the purpose or intended use of the claimed method or apparatus. For instance, in claims 1, 13, and 18, the recitation of “a local telephony directory on a telephony device” describes a fundamental characteristic of the claimed method and apparatus—namely, the local telephony directory resides on a telephony device. The Specification states that “[t]he present invention provides methods and apparatus for providing advanced IP telephony services *using an intelligent endpoint device*,” and “[t]he apparatus is capable of performing *updates to a local directory* by retrieving directory information from a directory server using an Internet connection.” Ex. 1001, 1:46–53 (emphases added). Essentially, the preambles of these claims recite structural elements that are important to the claimed invention. *See Vizio, Inc. v. ITC*, 605 F.3d 1330, 1340 (Fed. Cir. 2010) (“[T]he ‘for decoding’ language . . . is properly construed as a claim limitation, and not merely a statement of purpose or intended use for the invention, because ‘decoding’ is the essence or a fundamental characteristic of the claimed invention.”); *Poly-America, L.P. v. GSE Lining Tech., Inc.*, 383 F.3d 1303, 1309–10 (Fed. Cir. 2004) (“blown-film” in the preamble was limiting where the specification was “replete with references to the invention as a ‘blown-film’ liner” and described it as a fundamental characteristic of the invention).

Moreover, the bodies of the claims do not recite the complete invention, but refer back to the structural features in the preamble, so that the references to the network directory server, local telephony directory, and telephony device in the bodies of the claims derive their antecedent basis from the preamble. For example, claims 1 and 13 recite, in the body, “updating the local telephony directory based on the updated telephony directory information.” *Id.* at 12:59–60, 13:53–55. Claim 18 recites a similar limitation. *Id.* at 14:31–32.

In consideration of the foregoing, we determine that the preambles of claims 1, 13, 18, and 20 are entitled to patentable weight.

local telephony directory

Prior to institution, Spherix submitted its proposed claim construction for the claim term “local telephone directory.” Prelim. Resp. 19. In the Decision on Institution, we addressed Spherix’s contentions, and noted that the Specification indicates that the graphical user interface of a directory listing includes fields for personal contact information, including the person’s name, address, Internet address, telephone number. Dec. 8–9; Ex. 1001, 7:4–23, Fig. 4. We did not adopt Spherix’s proposed construction, but rather, in light of the Specification, we construed the claim term a “local telephony directory” broadly, but reasonably, as a “listing of telephone contact information that resides on a user’s device, rather than on a remote system or server on the network.” Dec. 8–9. After institution, the parties do not challenge any aspect of our claim construction as to this term. PO Resp. 21; *see generally* Reply. Upon review of the present record, we discern no

reason to change our claim construction as to the preamble of claims 1, 13, and 18, and “a local telephony directory” for this Final Written Decision.

updating, updates, and to update

Each of claims 1 and 13 recites “*updating* the local telephony directory based on the updated telephone directory information”; claim 14 recites “*updates* a local telephony directory based on the updated telephony directory information”; and claim 18 recites “the updated telephony directory information being used by the telephony device *to update* the local telephony directory.” Ex. 1001, 12:59–60, 13:53–55, 14:30–32 (emphases added). In that regard, the parties’ dispute centers on whether these claim phrases require a comparison step, as construed by the District Court in a related proceeding. PO Resp. 21–25; Reply 5–11; Ex. 2004, 81–90, 105. For instance, the District Court construed the “updating” phrase recited in claims 1 and 13 to mean “*comparing an entry in the local telephony directory with an entry in the updated telephony directory information and executing instructions to overwrite an entry in the local telephony directory, add an entry to the local telephony directory, or delete the updated telephony directory information.*” Ex. 2004, 89 (emphasis added).

In its Petition, VTech contends that all of the aforementioned “updating” claim phrases essentially have the same meaning in the context of the ’899 patent. Pet. 7. For the claim term “updating,” VTech urges us to adopt Spherix’s proposed claim construction previously submitted with the District Court as the broadest reasonable construction. *Id.* at 7–8. In its brief filed with the District Court, Spherix indicated that the ordinary and

customary meaning of the term “updating” is simply “to change something to reflect the most recent, up-to-date, information.” Ex. 1013, 24–25.

In its Patent Owner Response, Spherix urges us to adopt the District Court’s claim constructions for the “updating” claim phrases to require a comparison step, because “there is no meaningful distinction between the ‘broadest reasonable construction’ standard applied by the Board and the *Phillips*-based claim construction applied in federal court litigation.” PO Resp. 20–25 (citing Ex. 2004, 81–90, 105).

Although a district court’s interpretation of a claim term recited in the involved patent is instructive, we nevertheless are not bound by that construction. *See Power Integrations, Inc. v. Lee*, 797 F.3d 1318, 1326 (Fed. Cir. 2015) (“There is no dispute that the board is not generally bound by a prior judicial construction of a claim term.”). We note that patent claims have a presumption of validity in a district court proceeding. In contrast, there is no presumption of validity in an *inter partes* review, and, therefore, we will not be applying a rule of construction with an aim to preserve the validity of claims. Further, we observe that the parties’ arguments and supporting evidence submitted here are different than those presented in the district court proceeding. In any event, we have reviewed and considered the District Court’s Claim Construction Order insofar as its reasoned analysis is relevant to the issues before us regarding the patentability of claims 1–5 and 8–23 of the ’899 patent and the claim terms in dispute here. *See Power Integrations*, 797 F.3d at 1326 (“The fact that the board is not generally bound by a previous judicial interpretation of a disputed claim term does not mean, however, that it has no obligation to

acknowledge that interpretation or to assess whether it is consistent with the broadest reasonable construction of the term.”).

In its Reply, VTech argues that the broadest reasonable interpretation of the claim term “updating” does not require a comparison step because Dr. Paul D. Franzon testified that *updating* a local directory may involve a simple *overwrite* of the directory without a comparison step. Reply 8–11; Ex. 1017 ¶¶ 79–80.

The District Court considered Dr. Franzon’s testimony but, in the context of the claims and Specification of the ’899 patent, the District Court found that the claim term “updating” requires a comparison step because the “updating” step is not simply overwriting or replacing the *entire* local directory with the updated telephony directory, as Dr. Franzon suggested. Ex. 2004, 86; Ex. 1017 ¶ 80. Apart from the claim language itself, the specification is “the single best guide to the meaning of a disputed term.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (en banc). Indeed, the Summary of the Invention section of the ’899 patent states that “[t]he apparatus further *compares* the directory update[d] information against local directory information to determine *if corresponding directory listings are present.*” Ex. 1001, 1:59–61 (emphases added).

In addition, Dr. Franzon also testified that “‘update’ does not have to mean an update of the *entire* telephone directory,” and that “[n]ormal usage could imply a *partial* update, for example requesting information about one *specific entry.*” Ex. 1017 ¶ 80 (emphases added). As such, one of ordinary skill in the art would have appreciated that, in a partial update or an update of a specific entry, the system must determine whether the local directory contains a corresponding entry for that specific entry, and where the

corresponding entry is located, before the system can update or make changes to the corresponding entry in the local directory.

Having considered the relevant portions of the District Court’s Claim Construction Order and the evidence in this record, we are persuaded that each of the “updating” claim phrases requires a comparison step.

That being said, we nevertheless are not persuaded that the comparison step must include “*comparing an entry* in the local telephony directory *with an entry* in the updated telephony directory information,” as construed by the District Court. Ex. 2004, 89–90, 105 (emphases added). Notably, the Specification of the ’899 patent makes clear that the comparison step does not necessarily include such an *entry-by-entry* comparison. Ex. 1001, 6:34–42. As explained in the Specification, the directory update device determines whether a corresponding listing is present in the local directory by, “*for example*, using a simple *filename* comparison” or, alternatively, “a more complex comparison taking into account actual data values within the files.” *Id.* (emphases added). The District Court’s claim construction is based on the exemplary embodiments shown in Figures 5 and 12 of the ’899 patent. Ex. 2004, 86–88; Ex. 1001, 2:24–30, 2:42–44 (“FIG. 5 is an exemplary diagram of a graphical user interface for comparing a local directory listing and a directory server listing according to the present invention”), 2:62–63 (“FIG. 12 is a flowchart outlining an exemplary operation of the directory update device of FIG. 3”), 3:1–2, 12:35–47. Our reviewing court “has repeatedly cautioned against limiting the claimed invention to preferred embodiments or specific examples in the specification.” *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1346–47 (Fed. Cir. 2015). “[I]t is the *claims*, not the written

description, which define the scope of the patent right.” *Laitram Corp. v. NEC Corp.*, 163 F.3d 1342, 1347 (Fed. Cir. 1998); *see also id.* (“[A] court may not import limitations from the written description into the claims.”). Therefore, we decline to adopt the District Court’s claim construction that requires an *entry-by-entry* comparison because such a construction would import improperly a limitation from a preferred embodiment or specific example into the claims. Rather, in light of the Specification, we conclude that each of the “updating” claim phrases requires no more than a comparison step for determining whether there is a corresponding listing or entry in the local directory. The comparison step may encompass a filename comparison or other comparison methods for such a determination.

We also decline to adopt the District Court’s claim construction that requires “executing instructions to overwrite an entry in the local telephony directory, add an entry to the local telephony directory, or *delete the updated telephony directory information.*” Ex. 2004, 89–90. Although overwriting or adding an entry in the local telephony directory would make changes to the local telephony directory, deleting the *updated* telephony directory information would not make any changes to the *local* telephony directory. As noted by Spherix, the ordinary and customary meaning of the term “updating” is *to change something* to reflect the most recent, up-to-date information or make it more current. Ex. 1013, 24–25; *see also* MICROSOFT COMPUTER DICTIONARY at 486 (3rd ed. 1997) (defining “update” as “[t]o change a system or a data file to make it more current”) (Ex. 3001). There is a “heavy presumption” that a claim term carries its ordinary and customary meaning. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002). Here, nothing in this record requires us to interpret the claim

term “updating the local telephony directory” contrary to its ordinary and customary meaning. We decline to treat a step for “deleting the updated telephony directory information,” which *makes no changes* to the local telephony directory, as “updating the local telephony directory.” We, therefore, construe each of the “updating” claim phrases to require the system to make at least a *change* to the local telephone directory to reflect the most recent, up-to-date information or make it more current.

network browser application

Claim 9 recites “wherein the establishing, sending, and receiving steps are performed using a network browser application.” Ex. 1001, 13:27–30. The Specification states that the “IP network interface 230 may further make use of an *IP network browser application*, such as Netscape™ or Microsoft Internet Explorer™, to log onto an IP network 104 server in order to gain access to the IP network 104.” Ex. 1001, 4:48–52 (emphasis added).

In its Claim Construction Order, the District Court found that the claims are not limited to *IP* networks, and that the use of the term “web browser” in exemplary embodiments of the ’899 patent does not amount to a special definition of the term “network browser application.” Ex. 2004, 79–80. The District Court also found that one of ordinary skill in the art would have understood that a “network browser application” can be used to *browse a network*. *Id.* In that light, the District Court declined to construe the claim term “network browser application” as “web browser,” but rather construed it to mean “an application used to browse a network.” *Id.* at 79–81. In this *inter partes* review, the parties do not object to the District Court’s claim construction. Reply 15; Ex. 2005 ¶ 79; *see generally* PO Resp.

That being said, Spherix’s expert, Dr. Franzon, testifies that *browsing a network* “includes supporting accessing any compatible web page, as well as web-connected directories, ftp sites, etc.” Ex. 2005 ¶ 79. The District Court, however, already rejected a claim construction that requires a web browser, and its claim construction does not require these additional functions identified by Dr. Franzon. Ex. 2004, 79–81. Further, one of ordinary skill in the art would have understood that *browsing a network* means “to scan a [network] either for a particular item or for anything that seems to be of interest.” See MICROSOFT COMPUTER DICTIONARY at 64 (3rd ed. 1997) (Ex. 3001) (defining “browse” as “to scan a database, a list of files, or the Internet, either for a particular item or for anything that seems to be of interest.”). Dr. Franzon’s implicit interpretation would redefine the term “browse” to import improperly extraneous features into the claims—namely, “supporting accessing any compatible web page, as well as web-connected directories, ftp sites, etc.” Ex. 2005 ¶ 79. It is well-settled that if a feature is not necessary to give meaning to what the inventor means by a claim term, it would be “extraneous” and should not be read into the claim. *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998); *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1433 (Fed. Cir. 1988).

Accordingly, we adopt the District Court’s claim construction for the claim term “network browser application,” as the broadest reasonable interpretation—“an application used to browse a network.” We, however, decline to further define *browsing a network* to require the extraneous features identified by Dr. Franzon.

applet

Claim 9 recites “an applet for downloading updated telephony directory information.” Ex. 1001, 13:27–30. The Specification clearly sets forth a definition for the term “applet”—“An applet is a small application program having limited utility.” Ex. 1001, 5:30–45. The District Court adopted that definition, and rejected the additional limitation that would require the recited “applet” to run within a web browser. Ex. 2004, 74–76. Here, we also adopt that definition, without the additional limitation, as the broadest reasonable interpretation for the claim term “applet” because the term has been defined in the Specification with reasonable clarity, deliberateness, and precision. *See Paulsen*, 30 F.3d at 1480.

B. Principles of Law

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

In that regard, an obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of

ordinary skill in the art would employ.” *KSR*, 550 U.S. at 418; *see also Translogic*, 504 F.3d at 1259. A prima facie case of obviousness is established when the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976).

The level of ordinary skill in the art is reflected by the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978).

We analyze the instituted grounds of unpatentability in accordance with the above-stated principles.

C. Obviousness over Pickering in view of Wood or Guan

VTech asserts, in its Petition, that claims 1–5 and 8–23 are unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Pickering and Wood. Pet. 44–51. VTech also asserts that claims 2, 3, 9, 10, 11, 15, and 16 are unpatentable over the combination of Pickering and Guan. *Id.* at 54–57. As support, VTech provides detailed explanations as to how each combination of prior art meets each claim limitation and proffers a Declaration of Dr. Robert Akl. *Id.* at 21–33, 44–51, 54–57; Ex. 1007.

Spherix counters that the prior art combinations do not disclose all of the claim limitations. PO Resp. 28–36. Spherix also argues that VTech does not provide a sufficient rationale to combine Pickering with Wood or Guan. *Id.* at 25–28, 36–41.

We have considered the parties’ contentions and supporting evidence. In our discussion below, we begin with a brief overview of Pickering, Wood,

and Guan, and then we turn to the contentions presented by the parties, focusing on the deficiencies alleged by Spherix.

Pickering

Pickering describes a real-time interactive directory application implemented in a computer-telephony integration environment. Ex. 1009, Abs. Figure 1 of Pickering, reproduced below, illustrates an exemplary computer-telephony integration environment.

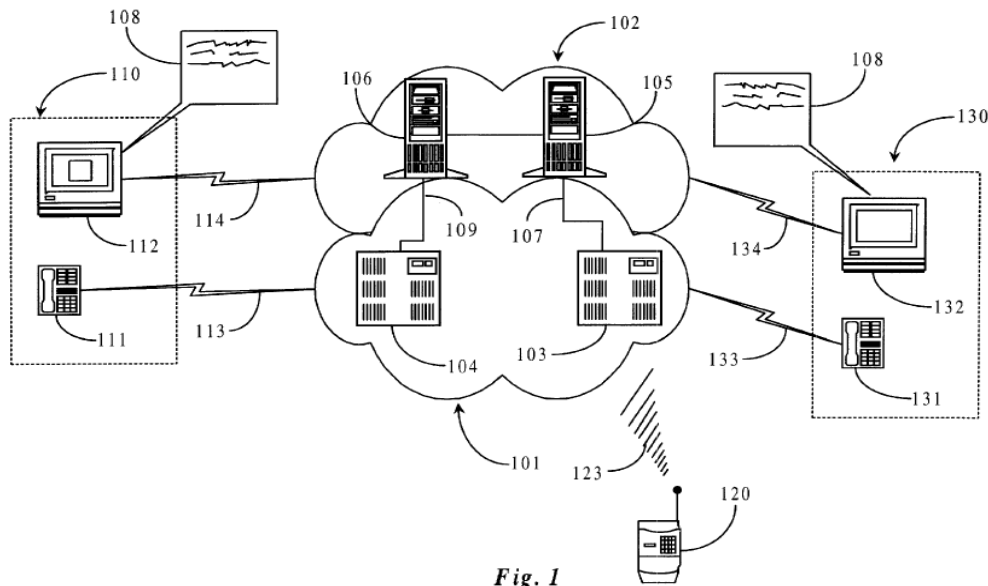


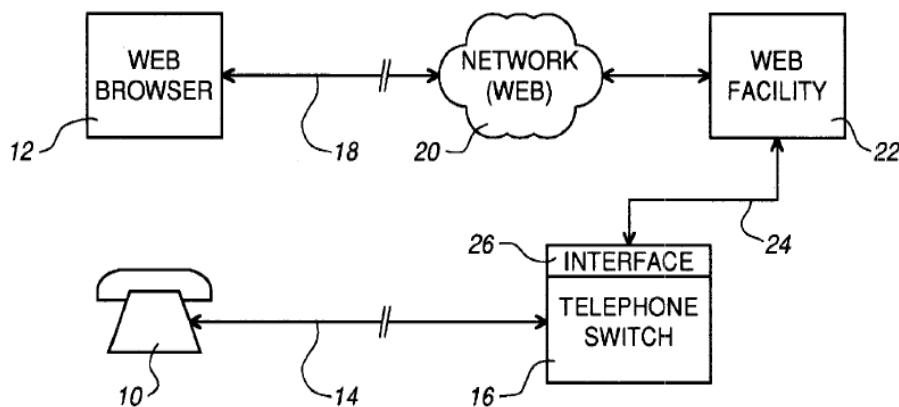
Fig. 1

As shown in Figure 1 of Pickering, the computer-telephony integration environment includes: (1) publicly switched telephone network or Internet Protocol Telephony Networks (“IPTN”) 101, which includes telephony switches 103, 104; (2) Internet 102; (3) workstations 110, 130, which are connected to PSTN 101 and Internet 102; and (4) cellular telephone 120. *Id.* at 3:37–55, 4:3–15, 5:51–53. Workstation 110 includes personal computer 112 and telephone 111 (a telephony device). *Id.* at 4:5–15. Real-time interactive directory application 108 is executed on workstation 110, to provide an interactive telephone directory of contact

names, telephone numbers, and status information (a local telephony directory). *Id.* at 4:61–67. The real-time interactive directory application also has an interactive function for placing calls, sending electronic mails, and accessing a forwarded telephone number. *Id.* at 6:35–40. A user may place a call using the input function of the real-time interactive directory application, by clicking on one of the telephone numbers listed in the directory. *Id.* at 6:40–46, 6:61–66.

Wood

Wood describes a telephone management system, which enables subscribers to control telephone connections and obtain information from telephone directories and call logs, using a web browser. Ex. 1008, Abs., 2:31–35. Figure 1 of Wood is reproduced below.



As shown in Figure 1 of Wood, a subscriber has telephone 10 and web browser 12. *Id.* at 3:20–22. Telephone 10 is coupled via path 14 to telephone switch 16, and web browser 12 is coupled via path 18 to Internet 20. *Id.* at 3:22–3:25. The functions of web browser 12 and telephone 10 can be integrated into a single unit, such as an integrated mobile unit, combining voice communication and network browsing functions by using wireless communication paths to Internet 20. *Id.* at 3:55–

67. Web facility 22 provides a user interface, having web pages for subscribers to manage telephone functions. *Id.* at 4:32–36.

Figure 2 of Wood illustrates an exemplary web facility, and is reproduced below.

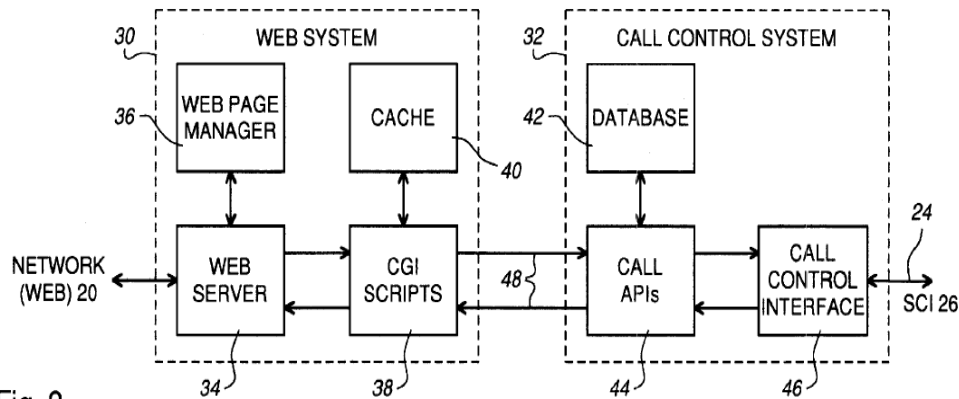
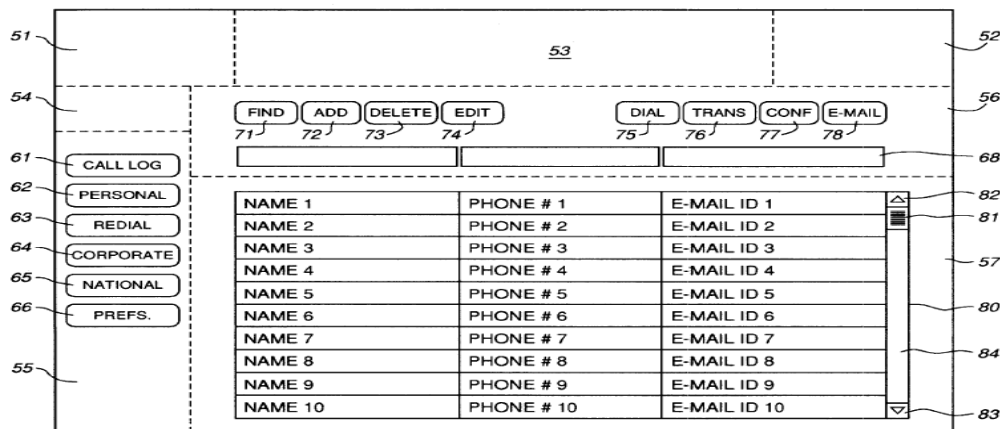


Fig. 2

As shown in Figure 2 of Wood, the web facility includes web system 30 and call control system 32. *Id.* at 4:57–63. Web system 30 supports web server 34, web page manager 36, Communications Gateway Interface scripts 38, and cache 40. *Id.* at 4:64–66. Call control system 32 supports database 42, Application Program Interfaces 44, and call control interface 46. *Id.* at 5:15–32.

Figure 3 of Wood, reproduced below, illustrates an exemplary call management web page provided by the web facility.



As shown in Figure 3 of Wood, the web page is divided into a plurality of frames, including: (1) frame 55, which provides a number of function buttons 61–66; (2) frame 56, which provides editing windows 68, directory function buttons 71–74 and communication function buttons 75–78; and (3) frame 57, which provides a directory of contact names, telephone numbers and e-mail addresses. *Id.* at 5:37–67, 6:17–24. To initiate a call, the user clicks on any record, causing the fields of that record to be reproduced in editing windows 68, and then clicks on DIAL button 75, triggering the telephone switch to set up a connection between the subscriber’s telephony device and receiving device. *Id.* at 6:26–28, 47–50.

Guan

Guan discloses a method of using a Java applet on a local device for accessing information in databases on the Internet. Ex. 1011, 73–74. According to Guan, the advantage of using Java applets is that Java supports platform-independent access to a wide range of information resources, so that applications can easily access databases from multiple vendors. *Id.* at 71, 74. Java programs also could provide an interactive and user-friendly interface and other capabilities. *Id.*

Updating a local telephony directory

Claims 1 and 13 recite “updating the local telephony directory based on the updated telephone directory information”; claim 14 recites “updates a local telephony directory based on the updated telephony directory information”; and claim 18 recites “the updated telephony directory information being used by the telephony device to update the local telephony directory.” Ex. 1001, 12:59–60, 13:53–55, 14:30–32. As discussed above, we construe a “local telephony directory” as a listing of telephone contact

information that resides on a user's device, rather than on a remote system or server on the network.

VTech asserts that Pickering in view of Wood or Guan discloses or suggests these aforementioned "updating" limitations. Pet. 21–33, 44–51, 54–57. Based on the evidence before us, we are persuaded by VTech's explanations and supporting evidence.

Notably, Pickering discloses a real-time interactive directory application executing on a local workstation that maintains and displays a telephony directory. Ex. 1009, 4:61–67, Fig. 2. The local workstation includes a personal computer and telephone (a telephony device). *Id.* at 4:5–15. The telephony directory, residing on the local workstation, provides a listing of telephone contact information (a local telephony directory). *Id.* at 5:4–6:20. The real-time interactive directory application receives the most recent, up-to-date information from the server, and updates the local telephony directory. *Id.* Figure 2 of Pickering is reproduced below.

	1	2	3	4	5	6	7	8
	Interactive Directory							
A	Name	First Name	Primary #	Second #	Home #	Mobile 1 #	Mobile 2 #	Status
B	Doe	John	780-5432	765-4321	723-4567	878-1234	777-1234	Busy
C	Doe	Jane	555-1234	555-4321	800-8888	888-7654	777-9876	Vacation
								Return 8/18/97
D	Duck	Duff	666-1234	666-4321	555-1234	888-9876	777-7654	Unavailable
								011-65-555-1234
	XXXX	XXX	XXX-XXXX	XXX-XXXX	XXX-XXXX	XXX-XXXX	XXX-XXXX	XXXXXX

As depicted in Figure 2 of Pickering, the local telephony directory contains a plurality of contact names, telephone numbers, and status information. *Id.* at 5:4–14. The directory may be accessed at the local

workstation statically when it is not connected to the Internet, or interactively when it is connected to the Internet. *Id.* at 5:14–21.

Pickering’s system also allows a user to update selectively a specific entry or field in real-time. *Id.* at 5:22–6:20. For instance, a user at the local workstation may request the most recent, up-to-date, status information of a particular person (e.g., John Doe) by selecting the name among the list displayed. *Id.* at 5:23–25. In response, the real-time interactive directory application establishes a communication connection with the network directory server over the Internet, negotiates for access to the up-to-date, status information of John Doe, and immediately updates the local telephony directory after receiving the information. *Id.* at 5:25–34.

In its Patent Owner Response, Spherix argues that Pickering does not disclose the comparison requirement under the District Court’s claim construction. PO Resp. 29–32. In particular, Spherix argues that Pickering does not disclose *comparing* the downloaded status information to the existing status information because the downloaded status information immediately *overwrites* and *replaces* the existing status information residing on the local workstation. *Id.* Spherix acknowledges the existing status information is immediately updated, but alleges that the language “immediately update” strongly indicates that “there is no comparison step.” *Id.* at 29–30 (citing Ex. 1009, 5:30–34, 5:66–6:1). Spherix also maintains that the failure to teaching a comparison step is significant because keeping data synchronized across multiple locations is challenging. *Id.* at 32.

We are not persuaded by Spherix’s arguments. The claims do not require an *entry-by-entry* comparison step, much less a *time delay* between the receiving step and the updating step, as suggested by Spherix. We are

cognizant that the preferred embodiment illustrated in Figure 5 of the '899 patent allows the user to *compare entry by entry manually*. Ex. 1001, 7:24–37, Fig. 5. Nothing in the claims or Specification, however, requires us to import a preferred or exemplary embodiment from the Specification into the claims. *See Van Geuns*, 988 F.2d at 1184. Spherix does not submit, nor do we discern, that the Specification sets forth a special definition that requires those extraneous features. *See Paulsen*, 30 F.3d at 1480.

In fact, as discussed above, we decline to adopt the District Court's claim construction to require an *entry-by-entry* comparison. Ex. 2004, 89–90. Rather, we determine that the comparison step may encompass a simple file name comparison or other comparison methods for determining whether there is a corresponding listing or entry in the local telephony directory.

Spherix confirms that, in the context of a directory update, the term “update” appears multiple times in Pickering. PO Resp. 29–30 (citing Ex. 1009, 2:23–26, 3:16–22, 5:30–53, 5:66–6:5, 6:15–18, 6:49–51). Yet, Spherix assumes that Pickering *only teaches overwriting or replacing* the individual's status information. *Id.* at 29. Spherix's assumption is incorrect because Pickering in fact uses the term “update” in the context of updating a specific entry or field in a local directory, and does not use “overwrite” or “replace.” *See generally* Ex. 1009.

The language “immediately update” in Pickering does not support Spherix's interpretation of Pickering that “there is no comparison step” at all (PO Resp. 30) because that language refers to the real-time feature of Pickering's invention. Ex. 1009, 5:15–6:21. Spherix fails to appreciate that Pickering's local directory is updated in real time automatically, rather than manually.

We also are not persuaded by Spherix’s contention that the “failure of Pickering to teach comparing is significant from a technical perspective because keeping data synchronized across multiple locations is a challenging task.” PO Resp. 32. The Specification of the ’899 patent states that *updating* the local directory also is referred to as *synchronizing* the local directory. Ex. 1001, 6:13–13. As we discussed above, Pickering teaches updating a local directory based on the most recent, up-to-date information downloaded from the network server. Ex. 1009, 5:4–6:20. In fact, Pickering allows a user to selectively update a specific entry or field. *Id.* Pickering also discloses that the real-time interactive directory application can *synchronize* a directory over the Internet. *Id.* at 7:3–6. Moreover, a person of ordinary skill in the art would have understood that, in the context of application or database files (e.g., a telephone directory), “synchronization” means “*version comparisons* of copies of the files to ensure they contain the same data.” See MICROSOFT COMPUTER DICTIONARY 456 (3rd ed. 1997) (emphasis added) (Ex. 3001). Therefore, Spherix’s assumption that Pickering’s updating process does not include a comparison step is incorrect. Spherix’s interpretation of Pickering does not take into account the knowledge of an ordinarily skilled artisan. It is well-settled that prior art disclosure must be viewed in light of the knowledge of one of ordinary skill in the art. *In re Antor Media Corp*, 689 F.3d 1282, 1291 (Fed. Cir. 2012); *DeGeorge v. Bernier*, 768 F.2d 1318, 1323 (Fed. Cir. 1985) (a reference “need not, however, explain every detail since [it] is speaking to those skilled in the art”). When considering whether a claimed invention would have been obvious, “the knowledge of such an artisan is part of the store of public knowledge that must be consulted.” *Randall Mfg. v. Rea*, 733 F.3d

1355, 1362 (Fed. Cir. 2013); *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1365 (Fed. Cir. 2015).

We are not persuaded by Spherix’s arguments that Wood does not disclose “a local telephony directory” and the “updating” limitations. PO Resp. 33–36. Nonobviousness cannot be established by attacking references individually where, as here, the ground of unpatentability is based upon the teachings of a combination of references. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). As discussed above, Pickering discloses a local telephony directory as well as the “updating” limitations.

In view of the foregoing, we determine that VTech has demonstrated by a preponderance of the evidence that Pickering in view of Wood or Guan discloses or suggests “updating the local telephony directory based on the updated telephone directory information,” as recited in claims 1 and 13, and similarly, other “updating” limitations recited in claims 14 and 18.

Network browser application

Claims 9–11 require “wherein the establishing, sending, and receiving steps are performed using a *network browser application*.” Ex. 1001, 13:27–30 (emphasis added). VTech asserts that Pickering in view of Wood or Guan discloses or suggests a network browser application, as required by the claims. Pet. 21–29, 44–51.

Spherix, based on Dr. Franzon’s testimony, counters that Pickering in view of Wood or Guan does not disclose “a network browser application.” PO Resp. 41. Dr. Franzon testifies that *browsing a network* “includes supporting accessing any compatible web page, as well as web-connected directories, ftp sites, etc.” and that “Pickering only discloses specific functions for the RTID, with examples given above,” but it “never mentions

any of the other functions that a ‘network browser application’ can perform.” Ex. 2005 ¶ 79.

We are not persuaded by Spherix’s argument and supporting expert testimony. As discussed above, we adopt the District Court’s claim construction for a “network browser application,” as the broadest reasonable interpretation, and construe it as “an application used to browse a network.” Ex. 2004, 79–81. We also decline to define “browse a network” in our claim construction to import improperly the additional functions identified by Dr. Franzon into the claims. Ex. 2005 ¶ 79. The District Court already rejected a claim construction that requires a web browser, and its construction does not include these additional functions identified by Dr. Franzon. Ex. 2004, 79–81. Moreover, one of ordinary skill in the art would have understood that *browsing* a network means “to scan a [network] either for a particular item or for anything that seems to be of interest.” See MICROSOFT COMPUTER DICTIONARY at 64 (3rd ed. 1997) (Ex. 3001).

As discussed above, Pickering’s system allows a user to update selectively a specific entry or field in real-time. *Id.* at 5:22–6:20. For instance, a user at the local workstation may request the most recent, up-to-date, status information of a particular person (e.g., John Doe) by selecting the name among the list displayed. *Id.* at 5:23–25. In response, the real-time interactive directory application establishes a communication connection with the network directory server over the Internet, request for access to the up-to-date, status information of John Doe, and immediately updates the local telephony directory after receiving the information from the network directory server. *Id.* at 5:25–34.

In sum, Pickering’s real-time interactive directory application establishes a communication connection between the telephony device on the local workstation and the network directory server, sends an update request to the network server, and receives the updated telephony directory information from the network server. As Dr. Akl testifies, one of ordinary skill in the art would have recognized that Pickering’s real-time interactive directory application is an application for browsing a network—a network browser application. Ex. 1007 ¶¶ 62–64; Ex. 1019 ¶ 10.

For the foregoing reasons, we determine that VTech has demonstrated by a preponderance of the evidence that Pickering in view of Wood or Guan discloses that “the establishing, sending, and receiving steps are performed using a network browser application,” as required by claims 9–11.

Applet

Claims 2–3, 15, and 16 require “initiating an applet to facilitate communication with the network directory server and with the telephony device.” Ex. 1001, 12:61–13:2, 14:9–16. Claims 9–11 also require “an applet for downloading updated telephony directory information.” Ex. 1001, 13:27–36. As discussed above, consistent with the definition set forth in the Specification, we construe the claim term “applet” as “a small application program having limited utility.”

In its Petition, VTech asserts that Pickering describes the claim elements “establishing a communication connection between the telephony device and the network directory server” and “downloading updated telephony directory information.” Pet. 21–29. As discussed above, Pickering’s real-time interactive directory application establishes a communication connection between a local telephony workstation and a

network directory server, via an Internet communication link, for accessing updated directory information from the server. *See, e.g.*, Ex. 1009, 4:55–60, 5:4–6:20, 7:3–6, Figs. 1–2. When access is granted, the real-time interactive directory application receives the updated information downloaded from the server and updates the local telephony directory. *Id.*

Although Pickering does not disclose explicitly an applet, VTech nevertheless alleges that Pickering’s real-time interactive directory application qualifies as an applet because, as Dr. Akl testifies, the application provides an interactive user interface and obtains updated information from a network directory server. Pet. 24; Ex. 1007 ¶¶ 61–62. VTech also maintains that, in view of Wood or Guan, it would have been obvious to use an applet to facilitate the communication between Pickering’s local workstation and server, and to download the updated directory information. Pet. 44–47, 54–57. VTech explains that Wood discloses the use of an applet to facilitate the communication between a telephony device and a web server, and to access caller information from the web server. Pet. 47; Ex. 1008, 8:14–25.

VTech also submits that Guan describes the use of an applet to facilitate communication between a local device and a network server, for retrieving and displaying information obtained from the server. Pet. 54–56 (citing Ex. 1011, 71, 76, Figs. 5–7). Specifically, Guan describes using a Java applet on a local device for accessing information from databases on the Internet. Ex. 1011, 71, 76, Figs. 5–7. Guan also discloses several benefits of using Java applets, including “reduced maintenance and support of application software.” *Id.* at 71.

VTech contends that, in view of Wood or Guan, one of ordinary skill in the art would have used an applet in conjunction with Pickering's system to improve the communication between the local workstation and network directory server. Pet. 46–47, 56–57. Based on the prior art of record and for the reasons discussed below, we are persuaded by VTech's contentions.

Spherix counters that VTech fails to provide a rationale to combine Pickering with Wood and a rationale to combine Pickering with Guan. PO Resp. 25–28, 36–41. To that end, Spherix advances several arguments.

First, Spherix argues that VTech “does not address or even acknowledge the general problem faced by the '899 inventors.” *Id.* at 27–28. This argument is misplaced because “the problem motivating the patentee may be only one of many addressed by the patent's subject matter.” *KSR*, 550 U.S. at 420. “Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *Id.* In short, VTech's reasons to combine “are not limited to the same motivation that may have motivated the inventors.” *See PAR Pharm., Inc., v. TWI Pharms., Inc.*, 773 F.3d 1186, 1197 (Fed. Cir. 2014); *Alcon Research, Ltd. v. Apotex Inc.*, 687 F.3d 1362, 1368 (Fed. Cir. 2012) (noting that the courts “have repeatedly held that the motivation to modify a prior art reference to arrive at the claimed invention need not be the same motivation that the patentee had”). “Motivation to combine may be found in many different places and forms.” *Allergan, Inc. v. Sandoz, Inc.*, 726 F.3d 1286, 1292 (Fed. Cir. 2013); *see also Alza Corp. v. Mylan Labs., Inc.*, 464 F.3d 1286, 1294 (Fed. Cir. 2006) (stating that the motivation to combine does not have to be explicitly stated in the prior art, and can be supported by

testimony of an expert witness regarding knowledge of a person of skill in the art at the time of invention).

Second, Spherix argues that “the teachings and solutions of Pickering and Wood are distinct and not amenable to combination merely because Petitioners characterize them as being in the same art generally.” PO Resp. 26–27. Spherix contends that Pickering teaches an independent application real-time interactive directory, whereas Wood discloses a web page-based interface that views, but does not download, information at a web facility. *Id.* at 26–27, 37. Spherix also alleges that VTech fails to discuss how Pickering and Wood could be combined. *Id.* at 36–37.

Spherix’s arguments, however, are premised on bodily incorporating Wood’s system into Pickering’s system. “It is well-established that a determination of obviousness based on teachings from multiple references does not require an actual, physical substitution of elements.” *In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012); *In re Etter*, 756 F.2d 852, 859 (Fed. Cir. 1985) (en banc) (noting that the criterion for obviousness is not whether the references can be combined physically, but whether the claimed invention is rendered obvious by the teachings of the prior art as a whole). In that regard, one with ordinary skill in the art is not compelled to follow blindly the teaching of one prior art reference over the other without the exercise of independent judgment. *Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 889 (Fed. Cir. 1984); *see also KSR*, 550 U.S. at 420–21 (stating that a person with ordinary skill in the art is “a person of ordinary creativity, not an automaton,” and “in many cases . . . will be able to fit the teachings of multiple patents together like pieces of a puzzle”).

As evidenced by Wood, using an applet in a computer-telephony integrated system to facilitate the communication between a telephony device and network directory server, downloading updated information from the server, was well known in the art at the time of the invention. Ex. 1008, Abs, 2:28–30, 8:14–25, 8:45–65. Spherix does not provide sufficient or credible evidence that using an applet in Pickering’s computer-telephony integrated system would have been “uniquely challenging” or otherwise beyond the level of an ordinary skilled artisan. *See Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418).

We also are not persuaded by Spherix’s argument that Wood discloses a webpage-based interface that views, but does not download, information at a web facility. PO Resp. 26–27, 37. Spherix’s interpretation of Wood is too narrow. As VTech points out, Wood discloses that the software manages all of the functions of the telephony device, which includes establishing communication with a network directory server, and requesting and receiving directory information from the server. Pet. 47; Ex. 1008, 4:33–37 (“The web facility 22 provides an interface to the subscriber, . . . that enable the subscriber to manage at least some and preferably all telephone functions for the telephone 10.”); 8:45–65 (“the subscriber can scroll through the directory information, click on any record to reproduce it in the windows 68, click on the ADD button 72 to add a corresponding record to the subscriber’s personal directory, click on the DIAL button 75 to establish a call to the selected number, etc.”); Ex. 1007 ¶ 87.

Further, we are not persuaded by Spherix’s argument that VTech fails to discuss how Pickering and Wood could be combined. PO Resp. 36–37.

As noted above, VTech specifically explains that Pickering discloses the use of a real-time interactive directory application for establishing a communication connection between the local telephony device and the network directory server, and for downloading updated directory information from the server. Pet. 21–25; Ex. 1009, 5:4–6:20. VTech asserts that Pickering’s real-time interactive directory application qualifies as an applet. Pet. 24; Ex. 1007 ¶¶ 61–62. VTech further submits that, although Pickering does not use the term “applet” explicitly, it would have been obvious to use an applet, in light of Wood or Guan, to perform those functions in Pickering’s computer-telephony integrated system. Pet. 46–47. Therefore, VTech has explained explicitly how Pickering and Wood could be combined, and articulated reasoning with underpinnings as to why an ordinarily skilled artisan would have combined Pickering with Wood.

Third, Spherix alleges Wood teaches away from the ’899 patent because Wood teaches centralizing functions at a network server to decrease telephone complexity and cost, while the ’899 patent teaches decentralizing functions. PO Resp. 38–39.

As Dr. Akl testifies, however, the ’899 patent does not disclose a decentralized system exclusively, and, in fact, the Specification of the ’899 patent specifically describes a centralized network directory server. Ex. 1019 ¶¶ 7–8; Ex. 1001, 5:30–46. Spherix’s argument once again is premised improperly on bodily incorporating Wood’s entire system into Pickering’s system. Spherix’s argument also lacks sufficient specificity as to how Wood teaches away from the *claimed* subject matter. In fact, Wood does not teach away using an applet for facilitating a communication connection between a telephony device and a network directory server, let

alone for downloading updated information from the server. A reference does not teach away, if it merely expresses a general preference for an alternative invention but does not “criticize, discredit, or otherwise discourage” investigation into the invention claimed. *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). Just because “better alternatives” may exist in the prior art “does not mean that an inferior combination is inapt for obviousness purposes.” *In re Mouttet*, 686 F.3d 1322, 1334 (Fed. Cir. 2012) (citing *Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)). More importantly, using an applet in Pickering’s system would not take away any functionality, but instead improving the method for the local workstation to access the network directory or database file. Based on the evidence in this record, we do not discern that Wood’s teaching criticizes, discredits or otherwise discourages the use of an applet in a computer-telephony integration system for facilitating communication between a telephony device and a network directory server, or downloading updated directory information.

Fourth, Spherix argues that VTech fails to articulate a reason to combine Pickering with Guan, and there would be no reason for a person of ordinary skill in the art to combine Pickering with Guan because Guan does not disclose telephony or telephone directories. PO Resp. 40–41.

A prior art reference is considered to be analogous if it is reasonably pertinent to the particular problem with which the inventor is concerned, regardless of the field of endeavor. *See In re Clay*, 966 F.2d 656, 658–59 (Fed. Cir. 1992). “A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” *Id.* at 659. In

that regard, “[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one.” *KSR*, 550 U.S. at 417.

Here, Guan is reasonably pertinent to the problem addressed by the ’899 patent, at least with respect to using an applet to facilitating the communication with a network server and local device, and downloading information from a database file that resides on the server. Pickering discloses databases and directories, and, significantly, the functionality of accessing updated telephony directory information from a server over the Internet. Ex. 1009, 2:16–38, 5:4–6:20. As discussed above, Guan describes using a Java applet on a local device for accessing information from databases on the Internet. Ex. 1011, 71, 76, Figs. 5–7. Guan discloses several advantages of using Java applets, including “reduced maintenance and support of application software.” *Id.* at 71. According to Guan, Java supports platform-independent access to a wide range of information resources, so that applications can access easily databases from multiple vendors. *Id.* at 71, 74. Guan further describes that Java programs could provide an interactive and user-friendly interface and other capabilities. *Id.* Therefore, in light of the advantages of using an applet, we agree with VTech’s position that an ordinarily skilled artisan would have combined Pickering with Guan.

Fifth, Spherix argues that Pickering could not have used Guan’s Java applet because Guan states that “[o]ur prototype software can be run on a platform with Netscape Communicator 4.0 browser and any browsers for supporting the Java JDK1.1 or over” and Pickering’s real-time interactive directory application is not a network browser application. PO Resp. 41;

Ex. 1011, 78; Ex. 2005 ¶¶ 82–83. As discussed above, however, Pickering’s real-time interactive directory application is a network browser application. Spherix also interprets Guan too narrowly, limiting Guan’s teaching to an exemplary embodiment, and assumes Guan’s Java applets can *only* be executed on a web browser. A prior art reference must be considered for everything it teaches by way of technology and is not limited to the particular invention it is describing and attempting to protect. *EWP Corp. v. Reliance Universal Inc.*, 755 F.2d 898, 907 (Fed. Cir. 1985).

In addition, we also are not persuaded by Spherix’s argument that Guan does not disclose the “updating” limitation. PO Resp. 41. As discussed above, Pickering discloses the “updating” limitations. The ground of unpatentability here is based on Pickering in view of Guan or Wood. Pet. 54–57. Attacking Guan individually does not undermine VTech’s showing of obviousness. *See Keller*, 642 F.2d at 426.

Based on the evidence in this record, we are persuaded by VTech’s explanation and supporting evidence because one with ordinary skill in the art would have appreciated the aforementioned advantages recognized in the prior art for using an applet to facilitate the communication between a local device and a server on the Internet, and to download updated directory information from the server. We also note that “if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *See KSR*, 550 U.S. at 417. Accordingly, we determine that VTech has articulated reasoning with rational underpinnings as to why a person of

ordinary skill in the art would have combined Pickering with Wood and combined Pickering with Guan.

Conclusion on Obviousness

For the foregoing reasons, we determine that VTech has demonstrated by a preponderance of the evidence that claims 1–5 and 8–23 are unpatentable over Pickering in view of Wood, and that claims 2, 3, 9, 10, 11, 15, and 16 are unpatentable over Pickering in view of Guan.

D. Motion to Exclude Evidence

Spherix filed a Motion to Exclude, seeking to exclude the deposition transcript of Dr. Franzon (Ex. 1020) and two paragraphs of the Declaration of Dr. Akl (Ex. 1019 ¶¶ 4, 5), because the evidence purportedly exceeds the proper scope of a reply under 37 C.F.R. § 42.23(b). Paper 31 (“Mot.”), 1–2.

Notwithstanding that Spherix acknowledges that a motion to exclude evidence is not an appropriate mechanism for presenting arguments that a reply or reply evidence exceeds the proper scope of reply under 37 C.F.R. § 42.23(b), Spherix ignores our Order (Paper 17, 3), as well as the Board’s trial rules and practice, by presenting such arguments in its Motion to Exclude Evidence. Mot. 3, n. 1. Spherix could have sought relief under 37 C.F.R. § 42.20 during this trial, but did not do so. *See Belden Inc. v. Berk-Teck LLC*, 805 F.3d 1064, 1081–82 (Fed. Cir. 2015) (noting that “if the petitioner submits a new expert declaration with its Reply, the patent owner can respond in multiple ways”); *see also id.* (“The tribunal has broad discretion to regulate the presentation of evidence under Fed. R. Evid. 611(a).”). We remind counsel of Spherix that they are required to comply

with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials, as set forth in Part 42 of Title 37, Code of Federal Regulations.

In any event, we did not rely upon the evidence that Spherix seeks to exclude, and, therefore, it is not necessary for us to assess the merits of Spherix's Motion to Exclude Evidence. Accordingly, Spherix's Motion to Exclude Evidence is *dismissed* as moot.

III. CONCLUSION

For the foregoing reasons, we determine that VTech has demonstrated by a preponderance of the evidence that claims 1–5 and 8–23 of the '899 patent are unpatentable under § 103(a) over Pickering in view of Wood, and that claims 2, 3, 9, 10, 11, 15, and 16 of the '899 patent are unpatentable under § 103(a) over Pickering in view of Guan.

IV. ORDER

In consideration of the foregoing, it is:

ORDERED that claims 1–5 and 8–23 of the '899 patent are held *unpatentable*;

FURTHER ORDERED that Spherix's Motion to Exclude Evidence is *dismissed* as moot; 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.

IPR2014-01432
Patent 6,614,899 B1

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