

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLACKBERRY CORP., and BLACKBERRY LTD.,
Petitioner,

v.

ZIPIT WIRELESS, INC.,
Patent Owner.

Case IPR2014-01508
Patent 8,086,678 B2

Before TREVOR M. JEFFERSON, NEIL T. POWELL, and
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

IPPOLITO, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner Blackberry Corp. and Blackberry LTD. filed a Petition on September 16, 2014, requesting an *inter partes* review of claims 1, 2, 5, and 7 of U.S. Patent No. 8,086,678 B2 (Ex. 1001, “the ’678 patent”). Paper 1 (“Pet.”). Patent Owner Zipit Wireless, Inc. did not file a Preliminary Response to the Petition.

Based on these submissions, we instituted trial as to claims 1, 2, 5, and 7 of the ’678 patent as anticipated by Adams.¹ Paper 6, 19 (“Dec. to Inst.”).

After institution, Patent Owner filed a Patent Owner’s Response (Paper 10, “PO Resp.”), and Petitioner filed a Reply (Paper 13, “Reply”). Additionally, we authorized a Patent Owner Sur-Reply, which Patent Owner filed on November 6, 2015 (Paper 24, “Sur-Reply”). Petitioner further filed a notice withdrawing portions of its Reply.² Paper 36.

Petitioner also filed a Motion to Exclude. Paper 32 (“Pet. Mot. Exclude”). Patent Owner filed an Opposition to Petitioner’s Motion to Exclude (Paper 39, “PO Exclude Opp.”), and Petitioner filed a Reply (Paper 43, “Pet. Exclude Reply”).

Additionally, Patent Owner filed a Motion to Exclude. Paper 35 (“PO Mot. Exclude”). Petitioner filed an Opposition to Patent Owner’s Motion to Exclude (Paper 40, “Pet. Exclude Opp.”), and Patent Owner filed a Reply (Paper 45, “PO Exclude Reply”).

An oral hearing was conducted on December 7, 2015. A transcript of

¹ U.S. Patent Publication No. 2005/0257209 A1, published Nov. 17, 2005 (Ex. 1004, “Adams”).

² Petitioner’s Exhibit 1028 is a red-lined version of its Reply showing withdrawn portions.

the oral hearing is included in the record. Paper 47 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6(c). This decision is a Final Written Decision under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73 as to the patentability of claims 1, 2, 5, and 7. For the reasons discussed below, Petitioner has demonstrated by a preponderance of the evidence that claims 1, 2, 5, and 7 are unpatentable.

A. Related Proceedings

The '678 patent is involved in a district court proceeding in the U.S. District Court for the District of South Carolina captioned *Zipit Wireless Inc. v. BlackBerry Ltd.*, No. 6:13-cv-2959-JMC (D.S.C. 2013). Pet. 1. Additionally, Petitioner has filed Petitions challenging the patentability of certain claims of Patent Owner's U.S. Patent Nos. 7,292,870 (IPR2014-01507); 7,894,837 (IPR2014-01506); and 8,190,694 (IPR2014-01509).

B. The '678 Patent

The '678 patent is directed to controls for network communication devices such as parental controls for mobile instant messaging terminals. Ex. 1001, 1:7–9. Figure 1 of the '678 patent is reproduced below.

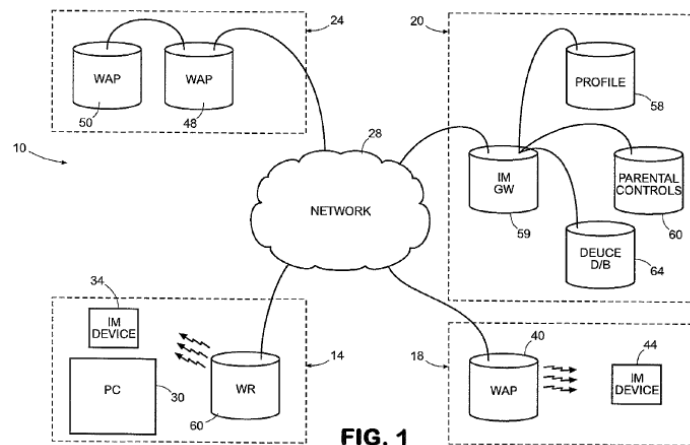


FIG. 1

Figure 1 shows system 10 that regulates usage of a mobile computer network communication device. *Id.* at 3:7–9. System 10 includes home location 14, remote site location 18, device regulation/support site 20, and internet service provider (“ISP”) site 24. *Id.* at 3:32–34. As shown, these sites and locations are coupled to one another through a computer network 28. *Id.* at 3:34–36. Home location 14 has a local area network (“LAN”) that includes personal computer (“PC”) 30 and a mobile computer communication device, such as instant messaging terminal 34. *Id.* at 3:38–41. As shown, these devices communicate with ISP site 24 or device regulation/support site 20 through wireless router 38. *Id.* at 3:41–43.

Figure 1 further shows device regulation/support site 20 includes mobile device communication gateway 54 that communicates with device database 58, profile server 60, and regulation database 64. Ex. 1001, 4:60–63. Regulation database 64 stores the controls and rules selected or generated by an administrative user for a device registered with regulation/support site 20. *Id.* at 5:13–16. These are the rules and controls applied to communications made with a particular mobile device registered with the site 20. *Id.* at 5:16–18. Regulation site 20 may include identification data unique for each mobile computer network communication device registered with site 20. *Id.* at 4:65–5:6. The unique identifier enables the regulation of the device to be implemented without recourse to a user or account identification. *Id.* at 6:25–27. The ’678 patent indicates regulation database 64 may store the controls and rules selected or generated by an administrative user for a device registered with regulation/support site 20 that apply to communications made with a particular mobile device registered with site 20. *Id.* at 5:13–16.

Figure 3 is reproduced below.

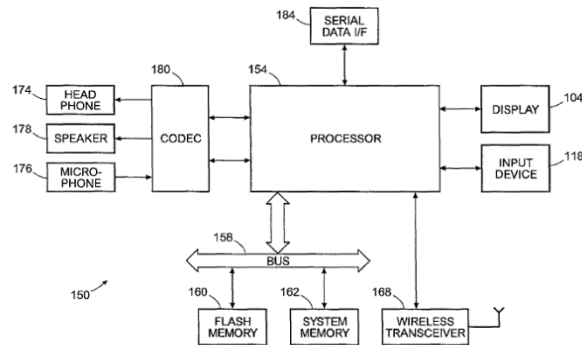


FIG. 3

Figure 3 shows components of mobile communication device 34 (e.g., instant messaging terminal) having a unique terminal identifier for enabling parental regulation of the terminal's use. Ex. 1001, 3:13–15, 6:4–5. As shown, device 34 includes system 150 with processor 154 coupled through system bus 158 to memory components 160 and 162. *Id.* at 6:5–7. The '678 patent discloses that memory 160 or 162 may be used to store a unique identifier that is installed by the manufacturer of device 34. *Id.* at 6:20–21. The '678 patent further indicates memories 160 and 162 may be non-volatile so the unique identifier remains the same during the life of the device. *Id.* at 6:23–25.

The '678 patent further discloses that mobile communication device 34 includes a support communication module configured to communicate with regulation/support site 20 in response. Ex. 1001, 6:52–55, 6:62–65. For registration of device 34, communication module sends a registration message to regulation/support site gateway 54 that includes the unique identifier for device 34. *Id.* at 7:60–64. Gateway 54 determines if the unique identifier is in the device database 58. *Id.* at 7:64–67. The communication module also monitors a user's command input to device 34. *Id.* at 9:7–10; Fig. 6. This process determines whether the entered command

requires evaluation by control site 20. *Id.* at 9:10–11. For example, a user command may prompt the communication module to generate a monitor message that includes the unique device identifier and data from the command required for control processing at control site 20. *Id.* at 9:14–18. Control site 20 receives the monitor message and may determine whether it is from a device having a unique identifier in device database 58 and whether the device is registered. *Id.* at 9:42–45. Once authenticated, the monitor message is parsed and the data compared to rules and control parameters stored in association with the device. *Id.* at 9:52–54. If the data violates a rule/parameter, a command message is generated and sent to the device for execution. *Id.* at 9:54–57; Fig. 7.

For registration of the mobile communication device, the '678 patent discloses in Figure 5 that a device logs in with a user's account for ISP access to enable computer network communication. Ex. 1001, 7:67–8:2. The communication module, in response to detection of communication on the network 28, sends a registration message to gateway 54 that includes a unique identifier. *Id.* at 8:6–7. Gateway 58 accesses device database 58 to verify the unique identifier is in database 58. *Id.* at 8: 7–9. If not, the registration process is aborted. *Id.* at 8:9–11.

C. Illustrative Claim

Of the challenged claims, claim 1 is independent. Claim 1 is illustrative of the subject matter of the '678 patent, and is reproduced below:

1. A system for controlling computer network communication devices that communicate over a computer network comprising:
 - a computer network communication device having a non-volatile memory containing a unique device identifier;
 - a controller operatively connected to a memory in which programmed instructions are stored within the computer network communication device, the controller being configured to

execute the programmed instructions to implement a communication module that generates a data message for use with a service provided by an Internet Service Provider in response to a command entered by a user, to generate a monitor message containing the unique device identifier and data corresponding to the command entered by the user, and to parse command messages received by the computer network communication device; and

a control site comprising a server operatively connected to a device database and a control database, the server being configured to compare data in the monitor message received from the communication module in the computer network communications device to control data stored in the control database in response to the monitor message received from the communication module in the computer network communications device having the unique device identifier that is also stored in the device database and to establish an administrative account for a device in response to the unique device identifier corresponding to a device identifier stored in the device database.

II. ANALYSIS

A. Weight Given to Patent Owner's Declarant

1. Dr. Konchitsky's Ph.D.

Petitioner asserts that Patent Owner's declarant, Dr. Alon Konchitsky, did not receive a genuine Ph.D. from Bournemouth University and, as a result, Dr. Konchitsky's testimony is entitled to no weight. Reply 1. Patent Owner responds that Dr. Konchitsky received an electrical engineering Ph.D. degree from Bournemouth University Extension in Israel, Campus of Ramat Gan College, and submits that several documents, including Dr. Konchitsky's Ph.D. diploma and Ph.D. payment receipts, corroborate Dr. Konchitsky's Ph.D. Sur-Reply 1–3; Exs. 1059–1060. In his declaration, Dr. Konchitsky provides that he “unequivocally state[s] – *under penalty of perjury* – that I did in fact receive my Ph.D. in electrical engineering

from the Bournemouth University Extension in Israel, Campus of Ramat Gan College.” Ex. 2082 ¶ 17.

We note first that the parties do not dispute that Dr. Konchitsky is qualified to provide his expert opinion on the subject matter of the ’678 patent even without considering his Ph.D. from Bournemouth University. Sur-Reply 13–15; Tr. 4:14–22, 21:1–15. Petitioner concedes that Dr. Konchitsky “worked at Nokia. He worked at a company that was purchased by Intel. To be able to testify about emoticons and parental controls on devices he meets the low threshold under the federal rules for providing expert testimony.” Tr. 4:21–24. Accordingly, the circumstances surrounding Dr. Konchitsky’s Ph.D. go to the weight of his testimony rather than admissibility.

Further, we do not find that Petitioner has demonstrated that Dr. Konchitsky’s testimony should be afforded diminished weight because *Dr. Konchitsky* falsified his Ph.D. from Bournemouth University Extension through Ramat Gan College in Israel. Petitioner concedes that

[t]he sur-reply shows that it’s possible that Konchitsky did receive a degree from either Ramat Gan or the extension at Ramat Gan. That was not an authorized diploma, had nothing to do with the Bournemouth University. And whether or not he knew that or was unwittingly duped into believing that he was getting a genuine Bournemouth University diploma, in the time allotted in IPR and our resources, there’s just not enough time and money available to prove that circumstantial case whether he knew that his diploma was not genuine.

Tr. 5:14–22. Additionally, Petitioner has withdrawn all its allegations that Dr. Konchitsky himself engaged in any act of forgery or perjury with respect to his Ph.D. Ex. 2106; Tr. 4:11–23, 6:13–8:2. This is not to say that there is sufficient evidence to establish whether Dr. Konchitsky’s Ph.D. is genuine.

However, as Petitioner argues, the issue is one of Dr. Konchitsky's veracity and credibility. Tr. 7:7–17. Thus, while it may be possible Dr.

Konchitsky's Ph.D. is not genuine, Petitioner has not shown that Dr.

Konchitsky engaged in any wrongdoing in obtaining his Ph.D. or representing that he obtained a Ph.D. from Bournemouth University

Extension in Israel. Thus, we do not diminish the weight of Dr.

Konchitsky's on this basis.

2. Dr. Konchitsky's Master's Degree in Tourism and Hospitality Management

Petitioner further argues that Dr. Konchitsky's mischaracterization of his Master's degree from Bournemouth University (Tr. 6:15–23)

demonstrates Dr. Konchitsky's lack of credibility and diminishes the weight of his testimony (*see id.* at 9:7–14). Petitioner does not dispute Dr.

Konchitsky received a Master's degree from Bournemouth University. Tr. 13:9–15. Rather, Petitioner asserts that Dr. Konchitsky has embellished his Master's degree in tourism and hospitality management by describing it as a degree in “management and business.” *Id.* at 5:23–25.

Dr. Konchitsky and Patent Owner do not dispute that Dr. Konchitsky's curriculum vitae **does not** state that his Master's degree was issued in “Tourism and Hospitality Management.” Ex. 2082 ¶ 94; *see* Tr. 21:5–7. Dr. Konchitsky asserts that he believes his CV is accurate because his

Master's thesis was focused on computers and computer science, and how personal computers could best be integrated into a hotel's business. This field, where I was forecasting the trend in a particular vertical industry, is part of Information Technology in graduate business studies, which is a subcategory of the school of management.

Ex. 2082 ¶ 94. While the argument may be made that Dr. Konchitsky's description of his Master's degree is merely harmless embellishment or an artful rewording having the same effective meaning, we find that Dr. Konchitsky, nevertheless, incorrectly described his Master's degree and misrepresented his credentials to the Board. Further, that Dr. Konchitsky may be qualified to testify based on his undergraduate degrees and experience, as asserted by Patent Owner (Tr. 21:16–5), does not mitigate Dr. Konchitsky's misrepresentation of his credentials nor preclude us from appropriately weighing his testimony in light of such misrepresentation. We expect all parties and individuals involved in proceedings before the Board to "have a duty of candor and good faith to the Office during the course of a proceeding." 37 C.F.R. § 42.11. Moreover, we agree with the sentiment that "[e]ven the slightest accommodation of deceit or a lack of candor in any material respect quickly erodes the validity of the process. As soon as the process falters in that respect, the people are then justified in abandoning support for the system in favor of one where honesty is preeminent." *United States v. Shaffer Equip. Co.*, 11 F.3d 450, 457–59 (4th Cir. 1993). Therefore, we will consider Dr. Konchitsky's statements regarding his Master's degree in affording his testimony the appropriate weight.

3. *Dr. Konchitsky's Translation of Mr. Cohen's Statement*

Petitioner further argues that the circumstances of Dr. Konchitsky's incorrect translation of Mr. Cohen's Statement (Ex. 2092), submitted to support his Ph.D. from Bournemouth University Extension through Ramat Gan College in Israel, demonstrate a lack of credibility and reliability. Pet. Mot. Exclude 4; Ex. 1061. In particular, Petitioner argues that the incorrect English translation of Mr. Cohen's Statement includes the phrase "[d]uring the time period 1999-2002, the Extension offered a doctoral program in

communication systems in electrical engineering,” for which the Hebrew counterpart does not appear in the original Hebrew version. Ex. 2092, 2.

At the Oral Hearing, counsel for Patent Owner indicated that it relied on Dr. Konchitsky for the translation of all documents in his supplemental declaration (Ex. 2082). Tr. 13:22–14:11. Counsel for Patent Owner further represented that there was a “mismatching problem between the drafts” that resulted in the submission of an English version that did not match the statement in Hebrew. *Id.* at 14:16–21. Patent Owner’s counsel stated that

we have now obtained a declaration from Dr. Konchitsky that explains how the error occurred. And we also have a certified translation and have obtained a corrected, if you will, Exhibit 2092 from Mr. Cohen that matches the English version. And in short, just like I said Friday during the call, Dr. Konchitsky says it was a mismatching problem between the drafts that were discussed and exchanged with Mr. Cohen. He apparently mixed up the English translation with the Hebrew version. We don’t, of course, speak Hebrew, so we couldn’t catch the mistake ourselves.

Id. at 14:12–21. Patent Owner did not provide a certified translation of Exhibit 2092 at the time of filing as it was required to do per 37 C.F.R. § 42.63(b).

We find that this “mismatching” situation could have been avoided if a proper certified translation of Exhibit 2092 had been completed and submitted as required by Rule 42.63. Although we do not dismiss Dr. Konchitsky’s testimony on this basis,³ the misleading translation proffered

³ Petitioner has requested authorization to file a motion for sanctions based on Dr. Konchitsky’s translation of Exhibit 2092. Specifically, at the Oral Hearing, Petitioner requested reimbursement for the cost of obtaining certified translations of Exhibits 2087, 2091, and 2092. Tr. 9:13–16. On February 12, 2016, by email correspondence, the parties informed us that Patent Owner “has fully reimbursed Petitioner for the cost of obtaining

by Patent Owner erodes the foundation of Dr. Konchitsky's declaration and the weight we grant his testimony, and undermines the foundation of our trial process.

With these considerations in mind, we now turn to the construction of certain claim terms.

B. 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, 1277–79 (Fed. Cir. 2015) (“We conclude that Congress implicitly approved the broadest reasonable interpretation standard in enacting the AIA” and “the standard was properly adopted by PTO regulation.”), *cert. granted sub nom. Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 890 (mem.) (2016). There is a 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); *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

“Control database” and “device database” (claim 1)

For purposes of our Decision to Institute, we determined that no claim terms needed express construction. Dec. to Inst. 7.

In the Patent Owner's Response, Patent Owner proposes a construction for the claim term “database” as meaning “a collection of information or data that is structured or organized to allow quick access and retrieval of the information by a computer.” PO Resp. 18. Patent Owner

certified translations of Exhibits 2087, 2091, and 2092.” Ex. 3001. Accordingly, we treat Petitioner's request to file a motion for sanctions as moot.

further urges that a database excludes “any file or list,” and includes data organized in records with each record having one or more fields. *Id.* at 19. Patent Owner asserts additionally that the claim phrases “control database” and “device database” require two separate and distinct databases under the broadest reasonable construction. Patent Owner asserts that Petitioner’s declarant, Dr. Arthur Brody testified in his “Litigation Declaration” that the “plain language of the asserted claims require that the ‘device database’ and ‘control database’ are two distinct databases.” *Id.* at 13–14 (citing Ex. 2001 ¶ 190).

Petitioner responds that Patent Owner’s proposed definition is essentially the same definition proposed previously by Petitioner. Reply 4. In the Petition, Petitioner proposes that “database” means “a collection of information stored for retrieval and use by a computer system.” Pet. 8; Reply 4. Petitioner further asserts that “a collection of information with absolutely no structure or organization could not be retrieved and used by a computer system. Accordingly, any collection of information with even the simplest structure or organization satisfies both experts’ definition of ‘database.’” Reply 4. Petitioner, however, disagrees with Patent Owner’s position that the terms “control database” and “device database” require separate databases because the plain meaning of the claim language and the disclosure of the ’678 patent do not require separate databases. *Id.* at 5–6.

Based on the complete record before us, we agree with the parties that the broadest reasonable interpretation of the term “database” is “a collection of information or data that is structured or organized to allow access and retrieval of the information by a computer.” This interpretation is consistent with the Specification, which, for example, describes device database 58 as storing identification data and allowing access of stored identification data

by gateway 54. Ex. 1001, 4:60–63, 7:65–67. Therefore, we adopt this construction. Moreover, we agree with Petitioner’s position that a “database” as claimed does not require specific type of structure and even the “simplest” structure or organization of information would satisfy the element. The literal language of the claim language does not require fields, records, etc., and does not exclude the use of files or lists.

Additionally, we determine that the literal language of the claim terms “control database” and “regulation database” do not require separate and distinct databases. Further, we have considered both parties’ arguments regarding the respective position each has taken in the related district court proceeding. These arguments are instructive, but not binding on our construction of the claim term “database” in our review. For example, Dr. Brody’s testimony in the district court proceeding that the Specification describes individual control and regulation databases (Ex. 2001 ¶ 191) does not persuade us that the claim terms require separate and distinct databases. It is well-settled that even “the fact that the specification describes only a single embodiment, standing alone, is insufficient to limit otherwise broad claim language.” *Howmedica Osteonics Corp. v. Wright Med. Tech., Inc.*, 540 F.3d 1337, 1345 (Fed. Cir. 2008); *see also Phillips v. AWH Corp.*, 415 F.3d 1301, 1323 (Fed. Cir. 2005) (en banc) (“Although the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments.”).

Accordingly, we construe the term “database” as “a collection of information or data that is structured or organized to allow access and retrieval of the information by a computer,” and do not limit “control database” and device database” to separate and distinct databases.

C. Claims 1, 2, 5, and 7 – Anticipated by Adams (Ex. 1004)

Petitioner argues claims 1, 2, 5, and 7 are anticipated under 35 U.S.C. § 102 by Adams. Pet. 29–56. Patent Owner contests Petitioner’s position. PO Resp.17–46. As explained below, we have considered the arguments and evidence presented by both parties, and we determine Petitioner has shown by a preponderance of the evidence that claims 1, 2, 5, and 7 are anticipated by Adams.

To establish anticipation under 35 U.S.C. § 102, each and every element in a claim, arranged as recited in the claim, must be found in a single prior art reference. *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008); *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001). To anticipate, a prior art reference must disclose more than “multiple, distinct teachings that the artisan might somehow combine to achieve the claimed invention.” *Net MoneyIN*, 545 F.3d at 1371; *see also In re Arkley*, 455 F.2d 586, 587 (CCPA 1972) (“The [prior art] reference must clearly and unequivocally disclose the claimed [invention] or direct those skilled in the art to the [invention] without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference.”). Although the elements must be arranged or combined in the same way as in the claim, “the reference need not satisfy an *ipsissimis verbis test*,” i.e., identity of terminology is not required. *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009); *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990). Moreover, the prior art reference is read from the perspective of one with ordinary skill in the art. *In re Graves*, 69 F.3d 1147, 1152 (Fed. Cir. 1995) (“A reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings in combination with his own knowledge of the particular

art and be in possession of the invention.”); *In re Preda*, 401 F.2d 825, 826 (CCPA 1968) (“[I]t is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.”).

1. Summary of Adams (*Ex. 1004*)

Adams is directed to systems and methods of controlling an electronic device through “owner application control.” *Ex. 1004*, Abstract. Adams explains that “[o]wner application control information is stored on the electronic device and/or one or more remote servers” and “is consulted to determine if one or more required applications are available for execution on the electronic device.” *Id.* Figure 1 is reproduced below.

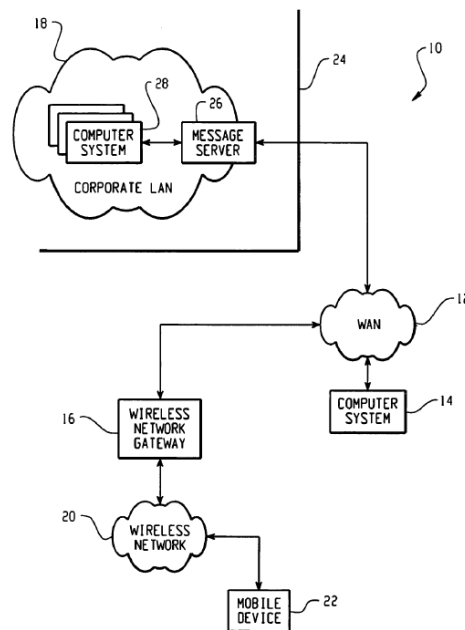


Fig. 1

Figure 1 shows communication system 10 in which electronic devices such as computer system 28 and mobile device 22 are used. *Id.* ¶ 15. Adams teaches that in order to maintain control over the use of computer system 28 or mobile device 22, an owner may establish local settings directly on the

device. *Id.* ¶ 24. In other instances, owner control information such as owner application control information can reside on a remote server rather than on the electronic device. *Id.* ¶ 133.

As an example, Adams describes in Figure 2 a system for inserting owner information and owner control information onto an electronic device. Figure 2 is reproduced below.

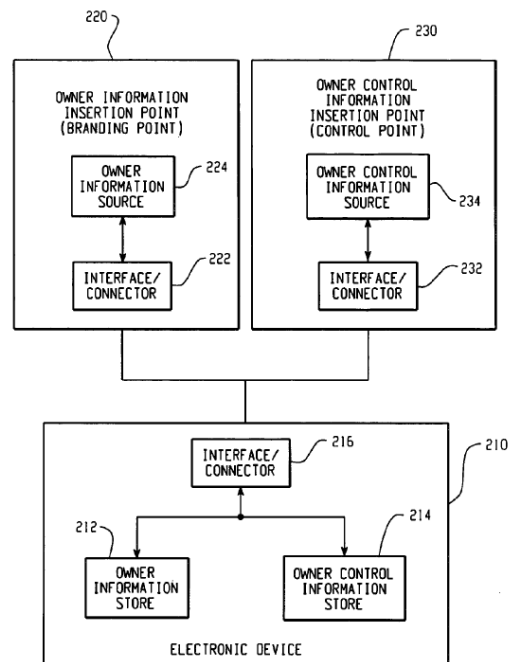


Fig. 2

The system in Figure 2 includes electronic device 210, owner information store 212, and owner control information store 220. *Id.* Owner information store 212 stores information such as an owner name or other identification information, which identifies an owner of electronic device 210. *Id.* Owner control information store 214 stores information that is used to control the operation of electronic device 210. *Id.*

In Figure 7, reproduced below, Adams shows mobile device 500 as a two-way communication device having at least voice and data communication capabilities. Ex. 1004 ¶ 135.

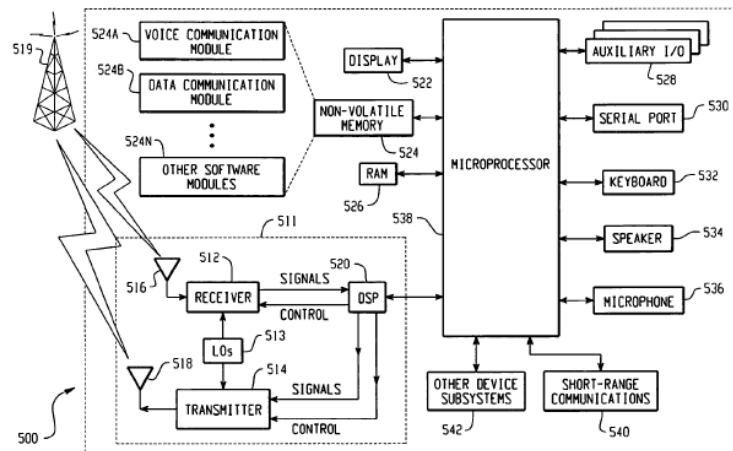


Fig. 7

Adams teaches mobile device 500 may communicate with other computer systems on the Internet as a data messaging device, a two-way pager, a cellular telephone with data messaging capabilities, a wireless Internet appliance, or a data communication device (with or without telephony capabilities). *Id.* Mobile device 500 includes transceiver 511, microprocessor 538, display 522, and non-volatile memory 524. *Id.* ¶ 136. Within non-volatile memory 524, the mobile device 500 includes a plurality of software modules 524A–524N that can be executed by the microprocessor 538 (and/or the DSP 520), including a voice communication module 524A, a data communication module 524B, and a plurality of other operational modules 524N for carrying out a plurality of other functions. *Id.* ¶ 136. Operating system software used by the microprocessor 538 preferably is stored in a persistent store such as the non-volatile memory 524. *Id.* ¶ 146. The non-volatile memory 524 may also include data stores for owner information and owner control information. *Id.*

2. Analysis

Below we discuss independent claim 1, which is illustrative of challenged claims 2, 5, and 7.

Claim 1 is directed to a system for controlling computer network communication devices that communicate over a computer network that includes “a computer network communication device having a non-volatile memory containing a unique device identifier.” To satisfy this limitation, Petitioner asserts Adams discloses mobile device 500 that includes non-volatile memory 524. Pet. 32 (citing Ex. 1004 ¶ 136). Petitioner argues non-volatile memory 524 contains a “unique device identifier” in the form of “owner information and owner control information.” *Id.* at 32–33 (citing Ex. 1004 ¶¶ 45, 146).

In its Reply, Petitioner asserts that Adams refers to “owner information” broadly as source authentication information, and a person having ordinary skill in the art would have understood that source authentication information would include information that uniquely identifies a device. Reply 7. Petitioner further explains that in paragraph 122, Adams discloses an “individual device identifier” that is used by a server to determine appropriate updates for the specific device. Reply 7–8; Tr. 46:12–23. Petitioner argues that Adams expressly provides the example of “control data being stored remotely and in association with a particular electronic device by means of an individual device identifier.” Tr. 47:3–7. Petitioner further explains that Adams teaches both associating control data with a “particular electronic device” and/or “device type,” and that Petitioner relies on the disclosure of the former for a “unique device identifier.” Tr. 43:17–44:2 (citing Adams ¶¶ 102, 118, 122).

Patent Owner argues that Adams’s owner information is not a unique

device identifier because a skilled artisan would have understood that identifying the owner of a device is different from identifying the device. PO Resp. 29. Specifically, Patent Owner asserts paragraph 45 of Adams discloses that the “owner information store 36” stores information about the owner of the device and different “owner control information” specifies information for the mobile device. *Id.* at 30. Patent Owner further challenges Petitioner’s reliance on paragraph 122 of Adams, arguing that paragraph 122 describes an “individual device identifier” that is not taught by Adams to be “owner information.” *Id.* at 31–32. Patent Owner contends that the “owner information” and “individual device identifier” are separate features in Adams that Petitioner cannot rely upon to each teach a “unique device identifier” as claimed. *Id.* at 32.

Upon review of the complete record, we agree with Petitioner’s argument that Adams’s “owner information,” described in paragraph 45 of Adams, includes the “individual device identifier,” disclosed in paragraph 122 of Adams. Paragraph 45 teaches broadly that “owner information store 36” stores information such as owner name or *other identification . . . and source authentication information*. Emphasis added. Although paragraph 122 does not expressly refer to “owner information,” paragraph 122 teaches that the server determines the “list appropriate for the requested device based upon device type and/or an individual device identifier.” In other words, the server *identifies* the querying device based on (1) device type or (2) an individual device identifier. Thus, we find Petitioner’s position persuasive that “other identification” or “source authentication information,” described in paragraph 45 as “owner information,” would include the “individual device identifier” taught in paragraph 122. This reading is consistent with Dr. Konchitsky’s testimony in which he agrees that paragraph 122 discloses

associating policy information with a particular electronic device. Ex. 1019, 83:22–84:2. Accordingly, we are not persuaded by Patent Owner’s argument that Adams’s owner information does not include Adams’s individual device identifier.

Patent Owner further asserts that Petitioner’s arguments regarding the “unique device identifier” improperly combine two different embodiments in Adams where one embodiment locally maintains and applies controls to device requests (as described in paragraph 122) and the other utilizes a remote server to determine whether to allow requests received by the device. PO Resp. 32–33. Patent Owner asserts that “Petitioner takes paragraph 122 – directed to the mobile device providing the application control – and speculates that these teachings could be applied to a different embodiment, and that Adams could operate in this manner.” *Id.* at 33. Patent Owner adds “[t]here is no disclosure in Adams how such other possible remote servers would actually operate, or that such operation would meet the elements of claim 1.” *Id.* at 33.

Based on the complete record, we find that Petitioner has explained by a preponderance of the evidence how Adams describes the “unique device identifier” as arranged in the same manner as recited in claim 1. In the Petition, Petitioner relies on Adams’s paragraphs 91 and 118 as disclosing a remote server or site that stores control information and determines whether a request is allowed. Pet. 39. Paragraph 91 teaches that an “excluded application list can be maintained remotely on remote server or on an external memory device rather than in a memory area local to the device,” and in such cases, the “remote server consults the excluded list . . . to determine whether the to-be installed application has been designated as excluded.” Adams ¶ 91. Paragraph 118 further provides that policy

information can be stored on a remote server, *associated with a particular electronic device, and queried remotely upon request from the device.*

This disclosure is consistent with paragraph 122, which teaches that Adams's remote server determines an appropriate list for the device based upon "an individual device identifier." In other words, in describing how the remote server operates, Adams teaches that the remote server may associate policy information (e.g., lists) with a particular device via an individual device identifier. Petitioner further explains that it relies on paragraph 122 to demonstrate that "when a request is sent to a remote server, there's two methods of organizing the control data based on the device type or an individual device identifier." Tr. 46:17–19. Thus, we are not persuaded by Patent Owner that Petitioner's arguments improperly combine separate embodiments described in Adams. Petitioner has demonstrated by a preponderance of the evidence that Adams's "owner information" and "individual device identifier" teaches a "unique device identifier" as recited in claim 1.

Claim 1 further recites

a controller operatively connected to a memory in which programmed instructions are stored within the computer network communication device, the controller being configured to execute the programmed instructions to implement a communication module that generates a data message for use with a service provided by an Internet Service Provider in response to a command entered by a user, to generate a monitor message containing the unique device identifier and data corresponding to the command entered by the user, and to parse command messages received by the computer network communication device.

Petitioner asserts Adams discloses that mobile device 500 contains microprocessor 538 (e.g., controller) that manages and operates device 500

via an operative connection to non-volatile memory, which enables the controller to execute a plurality of software modules 524A–524N located within non-volatile memory 524 of mobile device 500. Pet. 32–33 (citing Ex. 1004 ¶¶ 136, 143). Petitioner adds that Adams’s data communication application 524B, which is executed by microprocessor 538, teaches the recited “communication module.” *Id.* at 36 (citing Ex. 1004 ¶ 143). Further, Petitioner argues Adams discloses that data communication application 524B generates and sends data messages in response to a user hitting a send command. *Id.* (citing Ex. 1004 ¶ 143; Ex. 1003 ¶ 56). Petitioner also asserts that Adams teaches “electronic devices ‘normally access the Internet through an Internet Service Provider (ISP).’” *Id.* at 37 (citing Ex. 1004 ¶ 16).

Patent Owner argues that Adams does not teach a controller configured to execute the programmed instructions to implement a communication module that generates a data message for use with a service provided by an Internet Service Provider in response to a command entered by a user. PO Resp. 55. Patent Owner asserts Adams discloses a LAN that implements a messaging client, and any messages directed to a mobile device are “accessed by a user through a messaging client operating on a computer system 28” that is part of the LAN 18, not the mobile communication device. *Id.* at 56 (referring to Ex. 1004 ¶ 17).

In its Reply, Petitioner responds that Adams teaches that, “[w]ithin the LAN 18, a message server 26, operating on a computer behind the firewall 24, acts as the primary **interface** for the corporation to exchange messages ... with other external messaging clients via the WAN 12.” Reply 24 (citing Ex. 1004 ¶ 17). The message server 26 does not generate data messages and operates as an interface that “distribute[s]” data messages that it receives. Ex. 1004 ¶ 17.

We agree with Petitioner’s position. Adams teaches that computers “normally access the Internet through an Internet Service Provider (ISP)” (Ex. 1004 ¶ 16) and that network computers implement messaging clients such as “a messaging client, such as Microsoft Outlook™, Lotus Notes™, Yahoo!™ Messenger, AOL Instant Messenger, or other client-server or peer-to-peer, or similar messaging clients with various architectures” (*id.* ¶ 17). Further, Adams provides that microprocessor 538 manages the overall operation of mobile device 500, including the use of data module 524B that provides a high-level user interface for sending and receiving data, such as email messages, files, etc. Ex. 1004 ¶ 143. Thus, we find Adams discloses a controller (i.e., microprocessor 538) that is configured to implement a communication module (e.g., data module 524) that generates a data message for use with a service provided by an Internet Service Provider (*see* Ex. 1004 ¶ 16) in response to an entered user command.

Additionally, Petitioner asserts that Adams discloses a controller configured “to generate a monitor message containing the unique device identifier and data corresponding to the command entered by the user” as recited in the limitation above. Petitioner argues Adams teaches a mobile device with an application loader that transmits a request to install new software application to a remote server “where the remote server verifies the request against the owner control information database.” Pet. 39–40 (citing Ex. 1004 ¶¶ 91, 101, 118). Petitioner further relies on the testimony of its declarant, Dr. Arthur T. Brody, who testifies that one of skill in the art would have understood that in order to determine if the requested operation is allowed, the request sent to the remote server must contain information that uniquely identifies the device and information corresponding to the requested operation. *Id.* at 39 (citing Ex. 1003 ¶ 58).

Patent Owner argues Adams does not disclose a “monitor message” because Adams’s request to a remote server does not contain a “unique device identifier” and “data corresponding to the command entered by the user.” PO Resp. 34.⁴ Patent Owner argues that paragraph 101 of Adams teaches “owner control information” may be stored in a remote database for owned devices, but does not disclose a “unique device identifier” or owner information. *Id.* at 35–36. Patent Owner adds that paragraph 118 does not require a unique identifier associated with owner control information and merely discloses that policy information may be stored remotely for delivery to a particular device. *Id.* at 36.

Patent Owner further asserts that paragraph 119 and Figure 9 provide the only teaching in Adams of the user interface where “owner control information” is placed into the “control database.” PO Resp. 37. Patent Owner argues Figure 9 and paragraph 119 only describe the configuration of policy information for “groups of electronic device by device type,” and that a person having ordinary skill in the art would not understand this same disclosure as teaching the configuration of policy information for a particular device with a unique device identifier. *Id.* at 37–39.

Petitioner responds that Adams explicitly teaches policy information can be stored remotely in a server and queried by the server upon request from the device. Reply 9; *see* Ex. 1004 ¶¶ 91, 118. Petitioner asserts both parties’ experts agree that a skilled artisan would understand that such a

⁴ Patent Owner does not present specific arguments directed to the “data corresponding to the command entered by the user” recited in claim 1. Nonetheless, we note that upon review of the complete record, we find Petitioner’s arguments persuasive for this limitation for the reasons set forth in the Petition. *See* Pet. 39–41.

query would include information identifying the requesting device. *Id.* at 10. With respect to Figure 9, Petitioner further asserts that Adams teaches “FIG. 9 depicts one possible user interface” and that the absence of an exemplary figure for a different interface “does not negate Adams’ express teachings that the remote server can determine the appropriate policy information for a ‘particular electronic device’ based upon an ‘individual device identifier.’” *Id.*

Based on the entire record, we agree with Petitioner’s position. As discussed above, Adams discloses that policy information stored at a remote server can be associated with a particular device using an “individual device identifier.” Ex. 1004 ¶¶ 118, 122. Paragraph 91 further teaches that the remote server can consult a stored excluded list to determine whether the “to-be installed application has been designated as excluded . . . [and] the remote server would transmit to the device either an approval or a denial as appropriate.” In discussing this disclosure, Petitioner’s declarant, Dr. Brody testified that a “PHOSITA would have understood that in order for the monitor message to determine if the requested operation is allowed for ‘a particular electronic device,’ the monitor message must contain information that uniquely identifies the device, i.e., the owner information.” Ex. 1003 ¶ 58. The cross-examination testimony of Dr. Konchitsky is consistent with Dr. Brody’s reading of Adams. In particular, as Petitioner notes, Dr. Konchitsky agrees that “[i]f the policy information is stored on a remote server in association with a particular electronic device, the query *would have to include some information to identify the particular electronic device.*” Ex. 1019, 81:22–82:3 (emphasis added). Thus, we find Petitioner’s position persuasive that “some information to identify the particular electronic device” includes owner information such as an individual device

identifier described in Adams. Further, we agree with Petitioner that the disclosure in paragraph 119 and Figure 9 of Adams describes a non-exhaustive example of a user interface, which does not in itself detract from Adams's disclosure of associating policy information with a particular device instead of device type.

Petitioner further asserts Adams discloses a controller configured to “parse command messages received by the computer network communication device,” as recited in the same limitation of claim 1, because Adams teaches the remote server, upon verifying whether or not the requested operation is allowed, transmits a command message back to the electronic device. Pet. 42 (citing Ex. 1004 ¶¶ 91, 125). Petitioner asserts an inherent characteristic of electronic devices is that “once the electronic device receives the command message, it must analyze the message and determine whether remote server has returned an ‘allow’ or ‘deny’ command.” *Id.* (citing Ex. 1004 ¶ 151; Ex. 1003 ¶ 59). Based on the complete record, we are persuaded that Petitioner's arguments demonstrate by a preponderance of the evidence how Adams discloses the controller limitation recited in claim 1.

Claim 1 also recites “a control site comprising a server operatively connected to a device database and a control database.” Petitioner asserts Adams discloses that a remote server can “store owner control information associated with one or more electronic devices, or groups of devices,” and “maintain a device data store, that may be in the form of a database, that stores the control information, including application control information, associated with owned devices.” Pet. 44–45 (citing Ex. 1004 ¶¶ 101, 120). Petitioner further argues that Adams's owner control information database is both a control database and a device database. Pet. 44 (citing Ex. 1003

¶ 60).

Patent Owner asserts that neither Adams's owner information store nor owner control information store discloses a "device database" and a "control database" as recited in claim 1. With respect to the owner information store, Patent Owner argues that Adams does not disclose its owner information store 36 has the structure of a database. PO Resp. 41. Patent Owner further asserts that owner information store 60 is only disclosed to insert owner information onto the mobile device before the mobile device is operable. *Id.* at 43. Patent Owner argues that "[s]uch operation only before the device is operable cannot disclose the 'device database.'" *Id.* Patent Owner adds that Adams does not disclose the remote server is operatively connected to owner information store databases 36 and 60 to perform the steps of figure 6. *Id.* at 44. In addition, Patent Owner asserts that Adams's owner control information store does not teach a "device database" and a "control database" because this claim language requires two separate databases, and excludes a list of devices. *Id.* at 45–46, 48–50.

Based on the complete record, we are persuaded that Petitioner has explained by a preponderance of the evidence how Adams discloses a "device database" and a "control database." To start, we find that Adams's owner information "store" and owner control information "store" disclose databases because Adams teaches that each store allows access and retrieval of information. Ex. 1004 ¶ 45 ("a user of the mobile device 30 may be able to retrieve data from the stores 34, 36"); *id.* ¶ 54 ("owner information is retrieved from the owner information store 60"); *id.* ¶ 101 ("remote server can maintain a device data store, that may be in the form of a database, that stores the information, including application control information, associated

with owned devices.”); see Reply 13–14. As discussed, we find the term “database” means “a collection of information or data that is structured or organized to allow access and retrieval of the information by a computer.” *Supra* Claim Construction.

We are further not persuaded by Patent Owner’s argument that the owner information store is located on the mobile device for use before the mobile device is operation. See PO Resp. 42–43. The language of claim 1 requires the control site server to be “operatively connected” to the “device database” and “control database,” but does not dictate where the “device database” or “control database” is located. Furthermore, as Petitioner observes, claim 1 does not require that the remote server “compare[] information received from the mobile device during operation of the mobile device” to the device database.” Reply 16.

We also agree with Petitioner that Adams’s owner control information store discloses a “device database” and “control database.” First, we have not construed these terms to require separate “device” and “control” databases. *Supra* Claim Construction. As such, a single owner control information store can disclose a “device database” and “control database.” Second, the owner control information store includes a database of devices as Adams expressly teaches that the “remote server can maintain a *device data store*, that may be in the form of a database, that *stores the information, including application control information*, associated with owned devices.” Adams ¶ 101 (emphases added). Accordingly, we conclude that Petitioner has explained by a preponderance of the evidence how Adams teaches “a control site comprising a server operatively connected to a device database and a control database.”

Claim 1 further recites

the server being configured to compare data in the monitor message received from the communication module in the computer network communications device to control data stored in the control database in response to the monitor message received from the communication module in the computer network communications device having the unique device identifier that is also stored in the device database.

For this limitation, Petitioner asserts that Adams discloses an excluded application list can be maintained on a remote server, and an application loader can transmit a request to the remote server for the remote server to consult the excluded list to determine whether a to-be installed application has been designated as excluded. Pet. 47 (citing Ex. 1004 ¶ 91). Petitioner adds Adams teaches policy information stored on a remote server “can be associated with a particular electronic device or a particular group of electronic devices.” *Id.* at 48–49 (citing Ex. 1004 ¶ 118).

Additionally, Petitioner also relies on Dr. Brody’s testimony that a comparison of the unique owner information . . . that is also stored in the owner control database’s list of devices . . . necessarily must be performed prior to the comparison because “the control information, including application control information, [is] associated with owned devices,” *i.e.*, “associated with a particular electronic device.”

Ex. 1003 ¶ 61 (citing Ex. 1004 ¶¶ 101, 118, Fig. 6); *see* Pet. 50. Dr. Brody further testifies that Figure 6 of Adams teaches that when a request to install a new software application is received (step 110), a “comparison is accomplished in response to the monitor message containing the unique owner information (unique device identifier) that is also stored in the owner information store (the device database)” (step 112). Ex. 1003 ¶ 61 (citing Ex. 1004 ¶¶ 123–125).

Patent Owner argues claim 1 requires a remote server that performs

(1) an initial *verification* that the unique device identifier is also stored in the device database; and (2) comparison of stored control data with data in the monitor message “in response to” the verification. PO Resp. 50. Patent Owner asserts Adams does not disclose a remote server that performs this verification step where the remote server *verifies* the unique device identifier is also stored in the device database. *Id.* at 46. Patent Owner further asserts Figure 6 of Adams discloses application control by the mobile device, not the remote server, and that Petitioner’s reliance on Figure 6 improperly combines functions performed by the mobile device with functions performed by the remote server. *Id.* at 44, 47, 50–51. Additionally, Patent Owner argues that Petitioner has not shown how Adams’s owner control information store performs both the verification and comparison elements of claim 1 because a control database finding and retrieving control data does not satisfy the separate verification comparison with a device database. *Id.* at 51. Third, Patent Owner argues Petitioner has not explained how the disclosure of claims 32, 40, and 42 in Adams teaches this element. *Id.* at 51–53.

In response, Petitioner explains that the language of claim 1 does not include a “verification” step, and only requires a comparison between the monitor message and the control database that is performed “in response to” or after the monitor message having a unique device identifier that is also stored in the device database. Reply 18–19. Petitioner adds that Adams teaches Figure 6 presents a general flow diagram showing a method of owner control of an electronic device that is applicable to the operation of the remote server. *Id.* at 19–20.

Based on the complete record, we find Petitioner has explained by a preponderance of the evidence how Adams discloses this limitation. Adams

teaches that the remote server can maintain a “device data store . . . in the form of a database, that stores the control information.” Ex. 1004 ¶ 101. This control information “can be associated with a particular electronic device.” *Id.* ¶ 118. Additionally, Adams discloses that the remote server can consult an “excluded list” (i.e., control information) to determine whether a request for application installation should be allowed. *Id.* ¶¶ 91, 133 (“an operation request such as application installation or device initialization can generate a query to the remote server where such lists reside. The proper list can be consulted and an appropriate response returned to the inquiring device.”). Additionally, we find that Figure 6 supports Petitioner’s position that prior to consulting control information in step 114, the system determines whether owner information (e.g., individual device identifier) exists in step 112. Ex. 1004, Fig. 6. Thus, where a remote server stores control information associated with a particular device, and, further, consults the control information upon receiving a request from a device, we are persuaded that one having ordinary skill in the art would understand Adams to teach that the remote server compares control information to data in a monitor message in response to a unique device identifier (e.g., individual device identifier) also stored in a device database. *See* Ex. 1003 ¶ 61 (“As seen in Figure 6, step 112, the comparison is accomplished in response to the monitor message containing the unique owner information (unique device identifier) that is also stored in the owner information store (the device database).”) (citing Ex. 1004 ¶¶ 123–125.).

Moreover, based on the disclosure of Figure 6 and Adams in its entirety, we are not persuaded that Petitioner has improperly combined the functions of the mobile device with that of the remote server. In the paragraph following the section describing Figure 6, Adams expressly states

that there are “[m]any variations on the systems and methods” and explicitly includes, “[a]s an example, a system of owner application control of an electronic device . . . where] [t]he owner control information store can reside on the controlled device or on one or more remote servers” Ex. 1004

¶ 126. Thus, we view Figure 6 as a general flow diagram showing how Adams’s system operates. Ex. 1004 ¶ 123.

This is consistent with the overall disclosure in Adams, which provides, for example, that

[a] remote server can be used to store owner control information associated with one or more electronic devices, or groups of devices. The remote server can communicate with the one or more devices via any suitable communication channel (e.g. wired or wireless connection). The remote server can use owner control information insertion tools as described herein.

Id. ¶ 120. Further, as disclosed in paragraph 133:

[O]wner control information such as owner application control information can reside on a remote server rather than on the electronic device. For instance, one or more of a required, authorized and/or excluded application list can reside on a remote server. In such instances, an operation request such as application installation or device initialization can generate a query to the remote server where such lists reside. The proper list can be consulted and an appropriate response returned to the inquiring device.

Claim 1 further requires that the recited server is configured “to establish an administrative account for a device in response to the unique device identifier corresponding to a device identifier stored in the device database.”

For this limitation, Petitioner refers to claims 40–42 in Adams, which discloses in claim 42, an interface through which “an administrator can designate one or more electronic devices subject to owner control and a

correspondence between the designated one or more electronic devices and one or more stored authorization records.” Based on this disclosure, Petitioner argues that an administrative account in Adams is established in response to the administrator designating one or more electronic devices subject to owner control. Reply 22. At the Oral Hearing, Petitioner further explained that claim 42 of Adams “designates one or more electronic devices subject to owner control and then designates control data associated with that designated electronic device by the administrator. That process in general, as Adams understands, establishing that administrative account, that is what claim 42 is used for.” Tr. 53:1–10.

Patent Owner argues that Adams’s claims 40–42 are directed to creating “owner control information” for a device, not creating and “branding” the mobile device with “owner information.” PO Resp. 54. Patent Owner takes the position that “branding” a mobile device with owner information establishes an administrative account before any entry of information about the device in the owner control information database. *Id.* Thus, we understand Patent Owner’s argument to be that Adams does not teach creating an administrative account *in response to* “the unique device identifier corresponding to a device identifier stored in the device database.”

Upon review of the complete record, Petitioner’s arguments are persuasive. Adams discloses that system administrators can change owner control information. Ex. 1004 ¶¶ 72–73. Claim 42 of Adams further provides an interface through which an administrator can designate one or more electronic devices subject to owner control and a correspondence between the designated one or more electronic devices and stored authorization records. Thus, this administrator “interface” or account is established after (i.e., “in response to”) the completion of the process

described in claim 42, which is the designation of devices and correspondence between devices and control data. This reading of Adams is consistent with the understanding of a person having ordinary skill in the art as evidenced by both Dr. Brody and Dr. Konchitsky. Dr. Brody testifies that “[t]he purpose of the administrative account is to control particular electronic devices and, therefore, is established in response to an administrator ‘designat[ing] one or more electronic devices [that will be] subject to owner control.’” Ex. 1003 ¶ 62 (citing Ex. 1004, Claim 42). Likewise, during cross-examination, Dr. Konchitsky agreed that a “PHOSITA [would] understand that an administrative account is established *after* the completion of the step described in Claim 42 of Adams.” Ex. 1019, 105:7–11 (emphasis added). Accordingly, we are persuaded that Petitioner has explained by a preponderance of the evidence how Adams discloses this limitation.

Upon review of Petitioner’s evidence and analysis, and taking into account Patent Owner’s arguments and evidence, we determine that Petitioner has shown by a preponderance of the evidence that claim 1 is anticipated under 35 U.S.C. § 102 by Adams. Further, Petitioner provides detailed explanations of how each limitation of dependent claims 2, 5, and 7 is anticipated Adams. Pet. 51–56. For dependent claims 2, 5, and 7, Patent Owner relies on the arguments presented previously for claim 1 that are discussed above. PO Resp. 57–58. For the reasons set forth in the Petition (see Pet. 51–56), we conclude that Petitioner has established by a preponderance of the evidence that claims 2, 5, and 7 are anticipated by Adams. For example, Petitioner argues Adams’s messaging client (e.g., AOL Instant Messenger) teaches the “instant messaging device” recited in claim 2. Pet. 51–52. Accordingly, based on the complete record, Petitioner

IPR2014-01508

Patent 8,086,678 B2

has established by a preponderance of the evidence that claims 2, 5, and 7 are anticipated by Adams.

D. Petitioner's Motion to Exclude

Petitioner filed a Motion to Exclude certain evidence. Paper 32 (“Pet. Mot. Exclude”). Patent Owner filed an Opposition to Petitioner’s Motion to Exclude (Paper 39, “PO Exclude Opp.”), and Petitioner filed a Reply to Patent Owner’s Opposition (Paper 43, “Pet. Exclude Reply”). In particular, Petitioner moves to exclude Patent Owner’s exhibits, as discussed below.

1. Secondary Consideration Charts (Exhibits 2080–2081)

Petitioner argues that the charts pertaining to secondary considerations are not relevant to this proceeding because each deal with a patent that is not at issue in this proceeding. Exhibit 2080 is related to U.S. Patent No. 7,292,870 B2, which is the subject matter of IPR2015-001507, and Exhibit 2081 is U.S. Patent No. 7,894,837 B2, which is the subject matter of IPR2015-01506. Patent Owner states that it does not rely upon Exhibits 2080 and 2081 for this proceeding, and does not oppose Petitioner’s request to exclude Exhibits 2080 and 2081 in the instant case. PO Exclude Opp. 2. Accordingly, the evidence presented regarding secondary considerations related to patents involved in IPR2015-01505 and IPR2015-01506 do not have any tendency to make a fact more or less probable than it would be without the evidence in determining patentability of claims 1, 2, 5, and 7 of the ’678 patent. We grant Petitioner’s Motion to Exclude Exhibits 2080 and 2081.

2. Dr. Konchitsky's Bournemouth University Ph.D. Dissertation (Exhibit 2084) and Dr. Konchitsky's Bournemouth University Master's Thesis (Exhibit 2090)

Petitioner argues that Exhibit 2084 and Exhibit 2090 are inadmissible

because Patent Owner failed to file an English translation with an affidavit attesting to the accuracy of the translation pursuant to 37 C.F.R. § 42.63(b).⁵ Pet. Mot. Exclude 1–2, 4. Rule 42.63(b) provides that “[w]hen a party relies on a document or is required to produce a document in a language other than English, a translation of the document into English and an affidavit attesting to the accuracy of the translation must be filed with the document.”

Patent Owner does not dispute that (1) Exhibit 2084 and Exhibit 2090 are written in Hebrew; and (2) no English translation has been provided. However, Patent Owner argues that Rule 42.63(b) should not apply in circumstances where the substance of the document in a foreign language is not relied upon. PO Exclude Opp. 3, 5–6. Alternatively, Patent Owner argues that we should waive the certified translation in these circumstances in the interest of a just, speedy and inexpensive resolution of this proceeding. *Id.*

Based on the complete record, we are not persuaded by Patent Owner’s arguments that we should set aside the requirements of Rule 42.63(b). For example, Patent Owner argues that the “substance” of Exhibit 2084 is not at issue because the “entire point of Exhibit 2084” is that it is a Ph.D. dissertation written in the Hebrew language. PO Exclude Opp. 3. However, without a certified translation, we cannot confirm that Exhibit 2084 contains Dr. Konchitsky’s Ph.D. dissertation in Hebrew, or, for example, that the substance of the document is not at issue. Moreover, we cannot agree with Patent Owner that Exhibit 2084 is “indisputably authenticated,” as we cannot ascertain the contents of the document to

⁵ Petitioner filed its objections to Exhibits 2084 and 2090 within the prescribed time limit provided under Rule 42.64(b)(1). Paper 29.

determine authenticity. *See id.*

Additionally, based on the facts of this case, Patent Owner has not explained how waiver of Rule 42.63(b) would promote a just, speedy and inexpensive resolution of the proceeding. Providing a certified translation of a document in a foreign language allows each party a fair opportunity to develop its respective positions based on a full understanding of the record. Generally, the development of a clear and complete record promotes the interests of a just, speedy and inexpensive resolution. In the instance of a missing translation, the record lacks clarity and completeness, which in itself incurs expenditure of resources on issues that could have been avoided altogether. Accordingly, based on the totality of the facts, we do not waive Rule 42.63(b) for Exhibit 2084 and Exhibit 2090. Petitioner's Motion to Exclude Exhibit 2084 and Exhibit 2090 is granted.

3. *Dr. Konchitsky's Bournemouth University Ph.D. Transcript*
(Exhibit 2085)

Petitioner argues that Patent Owner has not established the authenticity of Exhibit 2085 in order to demonstrate that Dr. Konchitsky obtained a genuine Ph.D. from Bournemouth University. Pet. Mot. to Exclude 2. Exhibit 2085 purportedly shows Dr. Konchitsky's Bournemouth University Ph.D. transcript.

Arguably, the Ph.D. transcript alleged shown in Exhibit 2085 may not be sufficient to establish that Dr. Konchitsky obtained a genuine Ph.D.; however, as discussed above, Dr. Konchitsky's education and experience qualify him to provide his opinion on the subject matter of this proceeding even without taking into consideration whether Dr. Konchitsky has a Ph.D. from Bournemouth University Extension through Ramat Gan College in Israel. Further, Petitioner has withdrawn any allegation that Dr. Konchitsky

himself engaged in forgery or perjury related to his Ph.D. Tr. 5:8–22. Thus, for purposes of this decision, the authenticity of Exhibit 2085 is moot.

4. *Dr. Konchitsky’s Bournemouth University Ph.D. Payment Receipts (Exhibit 2087) and Dr. Konchitsky’s Master’s Payment Receipts (Exhibit 2091)*

Petitioner has withdrawn its motion to exclude Exhibits 2087 and 2091. Pet. Exclude Reply 3; Tr. 11:1–4. We treat this request as moot.

5. *Statement of Mr. Cohen (Exhibit 2092); November 4, 2002 Letter from Marilyn Russell on Bournemouth University Letterhead (Exhibit 2093); December 26, 2002 Letter of Professor Meidan on Bournemouth University Letterhead (Exhibit 2094); October 18, 2015 Letter of Professor Meidan (Exhibit 2095); Statement of Gili Dror (Exhibit 2096); Statement of Simon Perez (Exhibit 2097); December 21, 2004 Letter of Recommendation by Stanford University Professor Lusignan (Exhibit 2102)*

Petitioner presents several arguments challenging the admissibility of Exhibits 2092–2097 and 2102. Pet. Mot. to Exclude 5–14. Petitioner’s Motion is dismissed as moot because this Decision does not rely on Exhibits 2092–2097 and 2102.

Further, we note that in evaluating the credibility of Dr. Konchitsky’s testimony, we considered the circumstances of how Patent Owner came to file an incorrect translation of Exhibit 2092, which is originally in a foreign language and purported to be a statement by Mr. Haim Cohen. *Supra* sect. II(A)(iii); see Ex. 1061 (certified translation of Exhibit 2092 filed by Petitioner). Our discussion of Exhibit 2092 does not rely on the substance of Ex. 2092 to determine Dr. Konchitsky’s credibility, but solely considers Dr. Konchitsky’s testimony in light of the circumstances Patent Owner asserts

led to a “mismatched” Exhibit 2092 with an incorrect translation.

Accordingly, we dismiss Petitioner’s Motion to Exclude Exhibits 2092–2097 and 2102 as moot.

E. Patent Owner’s Motion to Exclude

Patent Owner filed a Motion to Exclude. Paper 35 (“PO Mot. Exclude”). Petitioner filed an Opposition to Patent Owner’s Motion to Exclude (Paper 40, “Pet. Exclude Opp.”), and Patent Owner filed a Reply (Paper 45, “PO Exclude Reply”).

1. Exhibits 1009–1018, 1021–1023, and 1030

Patent Owner presents several arguments challenging the admissibility of Exhibits 1009–1018, 1021–1023, and 1030. Pet. Mot. to Exclude 5–14. Patent Owner’s Motion to Exclude these exhibits is dismissed as moot because this Decision does not rely on these exhibits.

2. Petitioner’s Arguments in its Reply

Patent Owner asserts that several arguments presented in Petitioner’s Reply are “new” and go beyond the scope of a Reply. PO Mot. to Exclude 10–12. Specifically, Patent Owner argues the Reply contains new unsupported attorney arguments regarding the teaching in Adams and several claim elements including the “monitor message,” “unique device identifier,” “device database,” “control database,” and “control site.” *Id.* at 10–12. Patent Owner adds that it is particularly prejudiced by the inability to cross-examine Petitioner’s expert regarding these arguments. *Id.* at 11–12.

As an initial matter, a motion to exclude is not a proper vehicle for a party to raise the issue of arguments exceeding the permissible scope of a reply. Whether a reply contains arguments or evidence that are outside of a proper reply under 37 C.F.R. § 42.23(b) is left to our determination.

Moreover, based on our review of the arguments presented by Patent Owner in its Patent Owner Response, we agree with Petitioner that the portions of the Reply at issue are responsive to Patent Owner's arguments. For example, Petitioner's arguments regarding the "monitor message" and "unique device identifier" presented on pages 8 through 11 of the Reply cite and respond to Patent Owner's arguments presented on pages 36 and 37 of the Patent Owner Response. Reply 8–11.

Accordingly, we deny Patent Owner's Motion to Exclude portions of Petitioner's Reply.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 1, 2, 5, and 7 of the '678 patent are held unpatentable;

FURTHER ORDERED that Petitioner's Motion to Exclude Exhibits 2080, 2081, 2084, and 2090 is *granted*;

FURTHER ORDERED that Petitioner's Motion to Exclude Exhibits 2085, 2087, 2091–2097, and 2102 is *dismissed as moot*;

FURTHER ORDERED that Patent Owner's Motion to Exclude Exhibits 1009–1018, 1021–1023, and 1030 is *dismissed as moot*;

FURTHER ORDERED that Patent Owner's Motion to Exclude portions of Petitioner's Reply is *denied*; and

FURTHER ORDERED that any party to the proceeding seeking judicial review of this Final Written Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2014-01508
Patent 8,086,678 B2
PETITIONER:

Robert C. Mattson
John S. Kern
Thomas C. Yebernetsky
OBLON SPIVAK

cpdocketmattson@oblon.com
cpdocketkern@oblon.com
cpdocketyebernetsky@oblon.com

PATENT OWNER:

Stephen R. Risley
Robert B. Dulaney III
SMITH RISLEY TEMPEL SANTOS LLC

srisley@srtslaw.com
rdulaney@srtslaw.com