

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FKA DISTRIBUTING CO., LLC,
Petitioner,

v.

DOK SOLUTION, LLC,
Patent Owner.

Case IPR2015-01745
Patent 7,742,293 B2

Before JENNIFER S. BISK, NEIL T. POWELL, and
SHEILA F. McSHANE, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

INTRODUCTION

E. Background

Petitioner, FKA Distributing Co., LLC, filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1, 2, 5, 7, 8, 11–13, 17, 19, and 20 (the “challenged claims”) of U.S. Patent No. 7,742,293 B2 (Ex. 1001, “the ’293 patent”). Patent Owner, DOK Solution, LLC, filed a Preliminary Response. Paper 8 (“Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314(b); 37 C.F.R. § 42.4(a). The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless the Director determines . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

After considering the Petition and Preliminary Response, we determine that Petitioner has not established a reasonable likelihood of prevailing in showing the unpatentability of at least one of the challenged claims. Accordingly, we do not institute *inter partes* review.

F. Related Matters

The parties indicate that the ’293 patent is the subject of a concurrent proceeding in the United States District Court for the Middle District of Florida. Pet. 1; Paper 5, 1–2.

G. The Asserted Grounds of Unpatentability

Petitioner contends that claims 1, 2, 5, 7, 8, 11–13, 17, 19, and 20 of the ’293 patent are unpatentable under 35 U.S.C. § 103 based on the following grounds (Pet. 2):

Statutory Ground	Basis	Challenged Claims
§ 103	JP '125 ¹	1, 2, 5, 7, 8, 11–13, 17, 19, and 20
§ 103	Struthers ² and iPort Brochure and Manual ³	1, 2, 5, 7, 8, 11–13, 17, 19, and 20

H. The '293 Patent

The '293 patent describes a cradle for supporting and holding one of a selection of digital music players. Ex. 1001, 1:7–9. Figures 5, 7, and 8 of the '293 patent are reproduced below.

¹ Japanese Patent Publication 10-023125, published January 23, 1998 (Ex. 1003); English translation (Ex. 1004) (“JP '125”). Petitioner does not point to “an affidavit attesting to the accuracy of the translation” as required by 37 C.F.R. § 42.63(b). Patent Owner does not mention this issue in its Preliminary Response. Because we decline to institute a review, any failure to comply with § 42.63(b) does not affect our determination set forth below.

² U.S. Patent No. 7,155,214 B2, issued December 26, 2006 (Ex. 1008) (“Struthers”).

³ Petitioner refers to several exhibits together as “iPort™ Brochure and Manual,” including: Ex. 1009 titled “Instruction Manual, Sonance iPort™ In-Wall Docking System for iPod™”; Ex. 1010 titled “iPort™ Instruction Manual (ver. IW)”; and Ex. 1011, which appears to be a 10-page color brochure titled “iPort™.” Pet. 3.

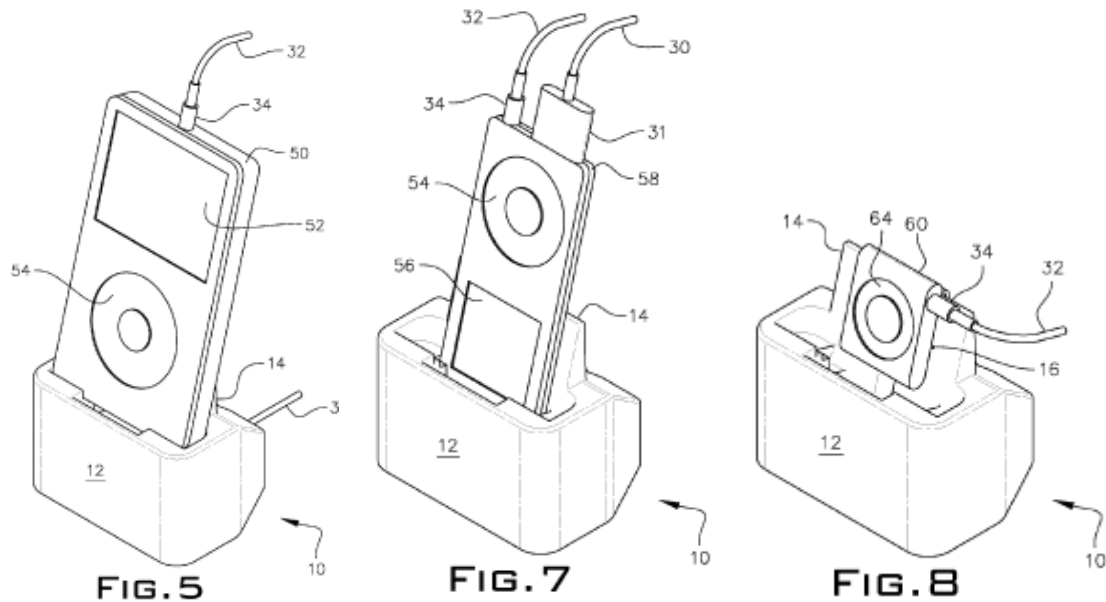


Figure 5, on the left above, illustrates the cradle of the '293 patent holding a large-sized digital music player. *Id.* at 3:23–25. Figure 7, in the middle above, illustrates the cradle of the '293 patent holding a small-sized digital music player. *Id.* at 3:29–31. Figure 8, on the right above, illustrates the cradle of the '293 patent holding a micro-sized digital music player. *Id.* at 3:32–34. Each Figure shows cradle 10 that “accommodates a variety of digital music players of various widths and thicknesses, thereby eliminating the need for multiple cradles or adapter inserts as provided in the past.” *Id.* at 3:52–56. Cradle 10 includes base 12, a cavity for containing an end of the digital music player, and support wall 14 “for supporting the digital music player on a slight slant towards the rear.” *Id.* at 3:56–59.

Figure 4 of the '293 patent is reproduced below.

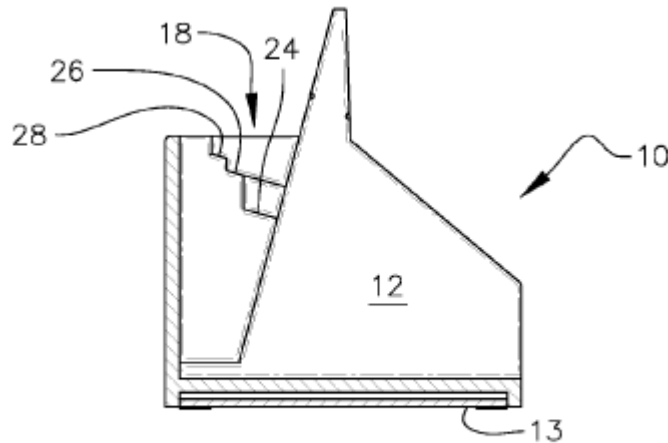


FIG. 4

Figure 4 illustrates a cross-sectional view of a cradle from the back. *Id.* at 3:21–22. Cavity 18 is shaped to hold the ends of three different music players. *Id.* at 4:22–25. An outer cavity formed by ledge 28 is shaped to hold an end of a large music player, a middle cavity formed by ledge 26 is shaped to hold an end of a medium-sized digital music player, and an inner cavity formed by ledge 24 is shaped to hold an end of a smaller-sized digital music player. *Id.* at 4:25–34.

Figure 2 of the '293 patent is reproduced below.

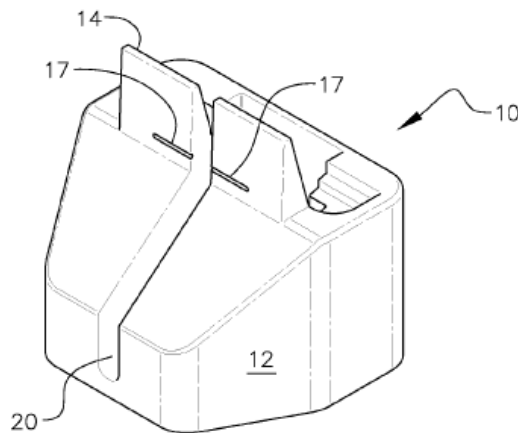


FIG. 2

Figure 2 illustrates the back of a cradle. *Id.* at 3:17–18. Cable trough 20 is provided to route a data cable from the digital music player. *Id.* at 4:8–9.

I. Illustrative Claim

Of the challenged claims in the '293 patent, claims 1, 7, and 12 are independent. Claim 1 recites:

1. A digital music player cradle for sequentially supporting multiple digital music players, the digital music player cradle comprising:
 - a base;
 - a cavity in an upper surface of the base, the cavity adapted to accept an end portion of a largest digital music player of the multiple digital music players;
 - a support wall extending from the upper surface of the base for supporting one of the digital music players;
 - a trough in a back side of the base extending through the support wall and interfacing with the cavity, the trough adapted to route a data cable connected to the one of the multiple digital music players; and
 - a plurality of ledges within the cavity, the ledges of decreasing size towards a bottom of the cavity, whereas each ledge is sized to hold a different one of the multiple digital music players.

Ex. 1001, 6:8–24.

ANALYSIS

A. Claim Construction

In an *inter partes* review, claim terms are given their broadest reasonable interpretation in light of the specification in which they appear and the understanding of others skilled in the relevant art. *See* 37 C.F.R. § 42.100(b). Applying that standard, we interpret the claim terms of the '556 patent according to their ordinary and customary meaning in the context of the patent's written description. *See In re Translogic Tech., Inc.*,

504 F.3d 1249, 1257 (Fed. Cir. 2007). For purposes of this decision, we need not explicitly construe any terms except those addressed below.

1. Sequentially supporting multiple digital music players

Neither party addresses the construction of the term “sequentially supporting multiple digital music players” found in the preamble of claims 1 and 12. “[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.” *Catalina Marketing Int’l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002) (internal quotation marks and citation omitted). A preamble, however, “limits the invention if it recites essential structure or steps, or if it is necessary to give life, meaning, and vitality to the claim.” For example, “dependence on a particular disputed preamble phrase for antecedent basis may limit claim scope because it indicates a reliance on both the preamble and claim body to define the claimed invention.” *Id.* (internal quotation marks and citation omitted).

For purposes of this decision, we are persuaded that, although it is part of the preamble, the term “sequentially supporting multiple digital music players” limits the scope of the challenged claims. The body of claim 1 refers several times to “the multiple digital music players.” Thus, on this record, we are persuaded that this language “indicates a reliance on both the preamble and claim body to define the claimed invention” and is not merely a statement of intended purpose or intended use. *Catalina Marketing*, 289 F.3d at 808 (citing *Bell Comm’s Research, Inc. v. Vitalink Comm’s Corp.*, 55 F.3d 615, 620 (Fed. Cir. 1995)). Moreover, we are persuaded that this term

means that the claimed cradle is designed to support any one of the multiple digital music players, one at a time in succession, in any particular order.

2. Ledges of decreasing size towards a bottom of the cavity

Petitioner proposes a construction for the limitation “a plurality of ledges within the cavity, the ledges of decreasing size towards a bottom of the cavity, whereas each ledge is sized to hold a different one of the multiple digital music players”⁴ (“the ledges of decreasing size limitation”). Pet. 7. Petitioner explains that the district court construed this limitation as “steps or ledges to the bottom of the cavity, where each subsequent step downward creates a decreasing sized sub-opening to hold a different sized digital music player.” *Id.* (quoting Ex. 1006, 5). According to Petitioner, however, this is not the broadest reasonable construction of the term. *Id.* Instead, Petitioner, urges us to construe the term as argued by Patent Owner in the district court—“steps or ledges of decreasing size toward the bottom of the cavity to hold a digital music player.” *Id.* (quoting Ex. 1005, 1). Patent Owner argues that we should adopt the district court’s construction of this term. Prelim. Resp. 5–9.

As explained below, we need not resolve this dispute between the parties regarding the proper construction of this term because, under either interpretation, our analysis results in the same outcome.

⁴ This is the language recited by claims 1 and 7. Ex. 1001, 6:21–24, 6:61–64. Claim 12 recites similar language: “stepped means for supporting the multiple digital music players including ledges of decreasing size towards a bottom of the means for supporting the digital music player, whereas each ledge is sized to hold a different one of the multiple digital music players.” *Id.* at 8:1–5.

B. Obviousness over JP '125

1. Overview of JP '125

JP '125 discloses a mobile phone holder for a computer. Ex. 1004, Title, Abs. JP '125's holder was created to hold a mobile phone in an upright position to solve problems associated with the phone being placed flat on a desk or held by hand, including failure of data communication. *Id.* ¶ 3–5. Figure 1 of JP '125 is reproduced below.

Figure 1

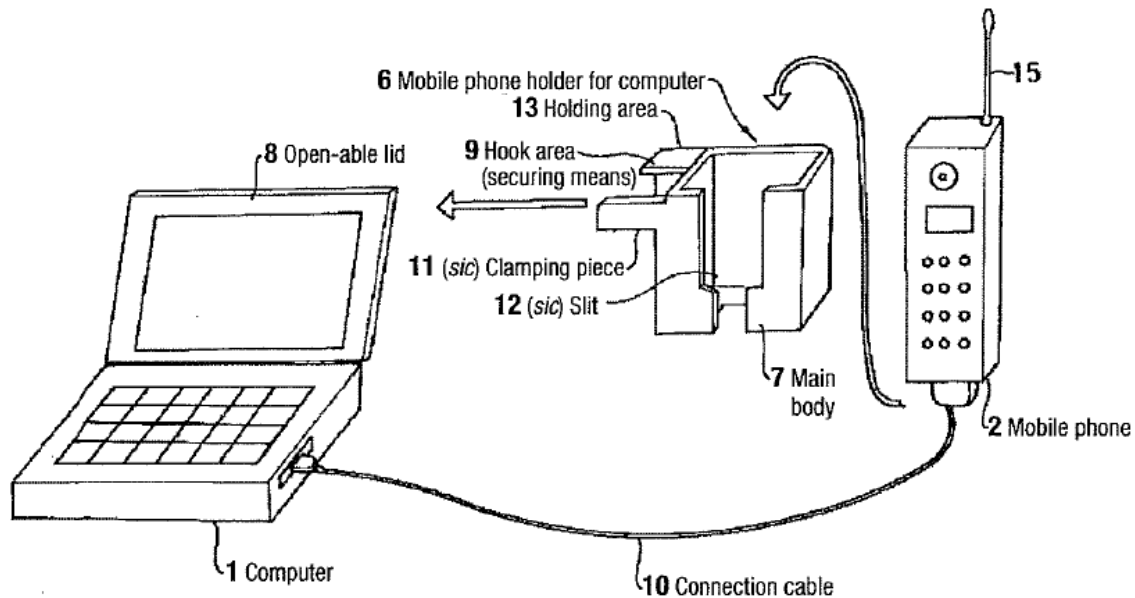


Figure 1, above, shows mobile phone holder 6 with box-shaped main body 7. *Id.* ¶ 11. Body 7 has an opening in the upper area for holding mobile phone 2 and hook area 9 for securing main body 7 to corner area of lid 8 of computer 1. *Id.* Figure 2 of JP '125 is reproduced below.

Figure 2

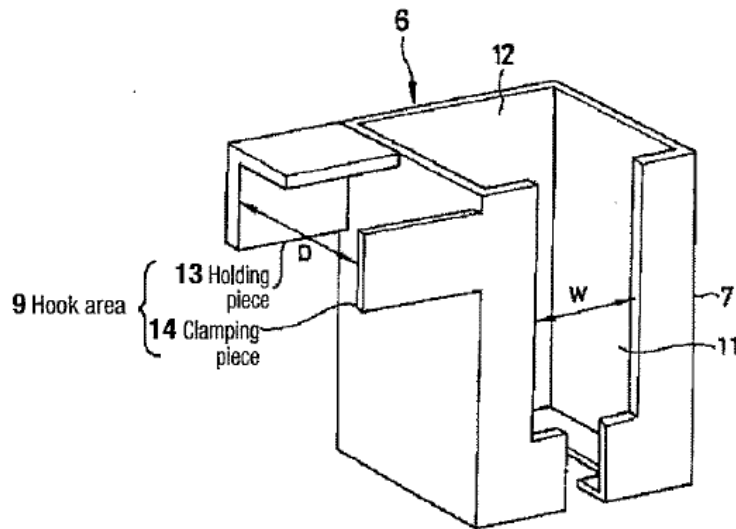
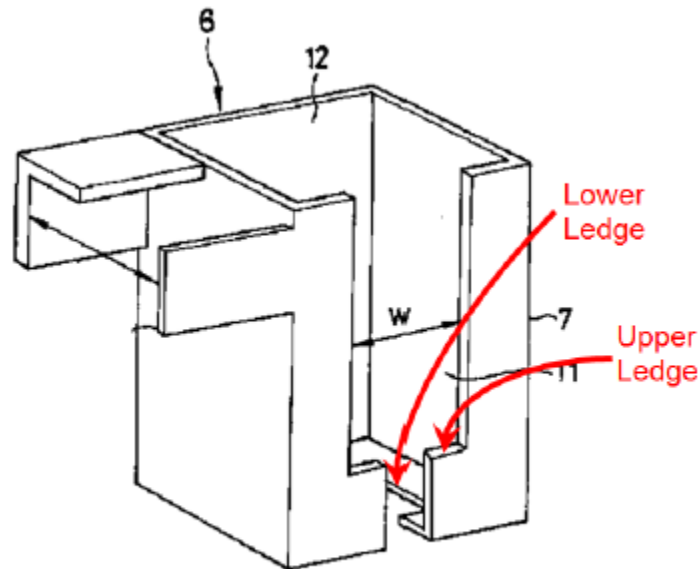


Figure 2, above, illustrates details of holder 6. *Id.* ¶ 13. “[S]lit 11 [shown in Figure 1 as “12 (*sic*) Slit”] is continuously cut from one side (front surface in the illustration) of main body 7 to the bottom surface” and is “widely open from the front surface upper area toward the lower area, and is narrow at the lower area continuing to the bottom surface.” *Id.* ¶ 14. Slit 11 has at least a width sufficient, at any point, for wiring the connection cable, the front surface opening area (shown in Figure 2 by W) is smaller than the width of the mobile phone, and the area from the narrow lower area to the bottom surface is narrower than the thickness of the mobile phone. *Id.* In the center of the bottom surface of the holder, slit 11 is limited to a size sufficient to hold the mobile phone. *Id.*

2. Petitioner’s Arguments

Petitioner argues that all the challenged claims would have been obvious based on JP ’125. Pet. 12–33. Petitioner equates JP ’125’s disclosed slit 11 to the claimed “trough” and opening 12 to the claimed “cavity.” *Id.* at 12. For disclosure of “a plurality of ledges within the cavity,

the ledges of decreasing size towards a bottom of the cavity, whereas each ledge is sized to hold a different one of the multiple digital music players,” Petitioner points to an “upper” and “lower” ledge in JP ’125’s holder. *Id.* at 19–22. Petitioner illustrates the two ledges by providing an “annotated Figure 2,” reproduced below.

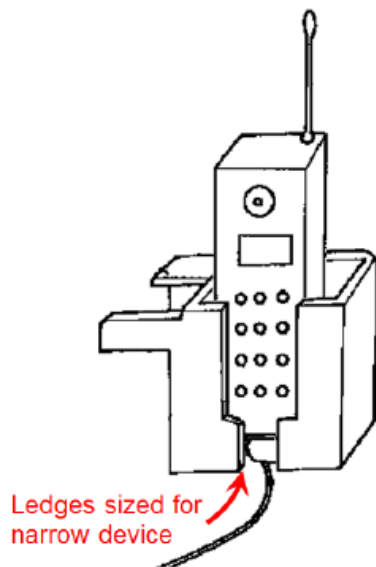


Ex. 1004 Figure 2

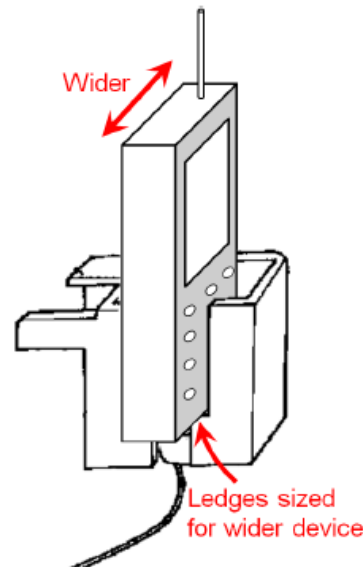
In Petitioner’s annotated Figure 2, above, the upper ledge is shown as the horizontal portion of slit 11 separating the wider top front surface opening area (shown in Figure 2 by W) from the narrower area from lower area to the bottom. The lower ledge is shown as the edge abutting slit 11 in the bottom of holder 6.

According to Petitioner “[t]o the extent that JP ’125 does not expressly disclose ‘*sequentially supporting multiple digital music players*,’ the description provides for the use of the cradle with different devices.” Pet. 14. To support this assertion, Petitioner points to JP ’125’s statement that “[o]ther data handling type mobile radio terminals are included as mobile phones in this invention.” *Id.* (quoting Ex. 1004 ¶ 25). In addition,

Petitioner provides several modified figures to show that “it would have been obvious to a person of ordinary skill to sequentially accommodate multiple ‘other’ devices as disclosed in the cradle.” *Id.* at 14, 20–23. For example, two of Petitioner’s “modified Figure 1[s]” is reproduced below.



Ex. 1004 Figure 1 (Modified)



Ex. 1004 Figure 1 (Modified)

Pet. 13, 21. Petitioner explains that in the modified Figure 1 on the left, “the narrow device depicted in Figure 1 fits within the opening and rests at the bottom of the cavity on lower ledges sized to hold a smaller device.” *Id.* at 20. Further, Petitioner asserts that in the modified Figure 1 on the right, “a wider device would reside on the wider ledges that are higher in the cavity.” *Id.*

According to Petitioner, a person of ordinary skill would have known that electronic devices are commonly wider than they are thick. Pet. 21. Therefore, based on the teachings of JP ’125 that the upper ledges were “sized to hold a wider device” and the “lower ledges that decrease in size toward the bottom of the cavity were sized [to] hold a different, smaller mobile device that is not as wide,” a person of ordinary skill “would be

motivated to place a wider device on the higher ledges for the express benefit described in JP '125 of positioning the wider device upright in the holder to eliminate 'data communication failure' by securing the device in an upright position.” *Id.* at 21–22.

3. Ledges of Decreasing Size Limitation

We are not persuaded that Petitioner has shown sufficiently that JP '125 discloses the recited ledges of decreasing size limitation. As discussed above, Petitioner asserts that JP '125 discloses an upper ledge by showing the horizontal portion of slit 11 separating the wider top front surface opening area (shown in Figure 2 by W) from the narrower area from lower area to the bottom and discloses a lower ledge by showing an edge abutting slit 11 in the bottom of holder 6. Pet. 19–20. Petitioner also states that “[o]ne can step from the upper ledge to the lower ledge” and “one may step from the lower ledge out through the bottom of the cradle.” *Id.* at 20.

Petitioner, however, never explains how JP '125's lower ledge is “of decreasing size” from the upper ledge. *Id.* at 19–22. This requirement must be satisfied no matter which construction of the ledges of decreasing size limitation we adopt (the district court's construction requires “steps or ledges of decreasing size toward the bottom . . .” and Petitioner's proposed construction requires “steps or ledges of decreasing size toward the bottom . . .”). Thus, we are not persuaded that Petitioner has shown sufficiently that JP '125 discloses the recited ledges of decreasing size limitation.

4. Rationale to Modify

We are also not persuaded that Petitioner has shown sufficiently a suggestion or motivation to modify the teachings of JP '125 as proposed. In appropriate circumstances, a single prior art reference can render a claim

obvious as long as there is a showing of a suggestion or motivation to modify the teachings of that reference. *SIBIA Neurosciences, Inc. v. Cadus Pharm. Corp.*, 225 F.3d 1349, 1356 (Fed. Cir. 2000). “This suggestion or motivation may be derived from the prior art reference itself, from the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved.” *Id.* (internal citations omitted). Here, Petitioner’s stated suggestion or motivation for “sequentially supporting multiple digital music players” is a combination of the knowledge a person of ordinary skill in the art would have of the dimensions of common mobile phones and the “benefit described in JP ’125 of positioning the wider device upright in the holder to eliminate ‘data communication failure’ by securing the device in an upright position.” Pet. 22.

It does not follow logically, however, either from the knowledge of common phone dimensions, or the desire to position a phone upright, that a person of ordinary skill would understand the holder in JP ’125 to sequentially support multiple digital music players.⁵ Petitioner does not point to any disclosure in JP ’125 showing its holder being used in the manner shown in the right-most version of modified Figure 1, above, such that the phone is placed sideways into the holder. In fact, Petitioner acknowledges that JP ’125 shows supporting one device at a time. *Id.* at 14.

⁵ Although claim 7 does not recite “sequentially supporting multiple digital music players,” this analysis applies equally to claim 7 because claim 7 recites the same concept using different language. Specifically, claim 7 recites “a digital music player cradle for supporting any one digital music player of the multiple digital music players” and includes steps of inserting a first digital music player into the cavity, removing that player, and then inserting a second digital music player into the cavity. Ex. 1001, 6:45–7:11.

And Petitioner notes that the holder of JP '125 includes both front and rear surfaces, with the front being the side containing slit 11. *Id.* at 17–18. On the other hand, Petitioner does not point to persuasive evidence, either within JP '125 or elsewhere, supporting its assertion that a person of ordinary skill would have found it obvious that a single implementation of JP '125 could support multiple sizes of phone by placing the phone in the holder sideways, such that the side of the phone faces the front of the holder when inserted.

Based on the present record, we are not persuaded that Petitioner has established a reasonable likelihood of prevailing in showing that claims 1, 2, 5, 7, 8, 11–13, 17, 19, and 20 would have been obvious over JP '125.

C. Obviousness over Struthers Combined with iPort Manual and Brochure

1. Overview of the Prior Art

Struthers discloses a “connecting dock for porting handheld audio devices to a multi-zone audio system.” Ex. 1008, 1:14–16. Struthers’ device includes a cradle with a “dock engaging well” that is “preferably formed to be of a size and shape to receive and support the handheld device” and which is “replaceable with alternate cradles defining different shapes of engaging wells, depending upon the shape and size of the particular handheld device to be placed within the connector dock.” *Id.* at 5:13–16.

Petitioner asserts that iPort Manual and Brochure are “materials pertaining to [Dana Innovations’] commercial embodiment of Struthers.”⁶

⁶ Patent Owner argues that Petitioner has not shown that Exhibits 1009, 1010, and 1011 are printed publications such that they are prior art under 35 U.S.C. § 311(b). Prelim. Resp. 20–22. We do not reach this issue because we decline to institute a review based on these references for other reasons.

Pet. 3. According to Petitioner, the first commercial embodiment, shown in Exhibit 1009, “included removable cradles having a cavity like those described in Struthers.” *Id.* at 34. Petitioner explains that “a second generation iPort,” shown in Exhibits 1010 and 1011, “included a universal cradle having multiple ledges arranged to receive differently-sized devices.” *Id.* at 35.

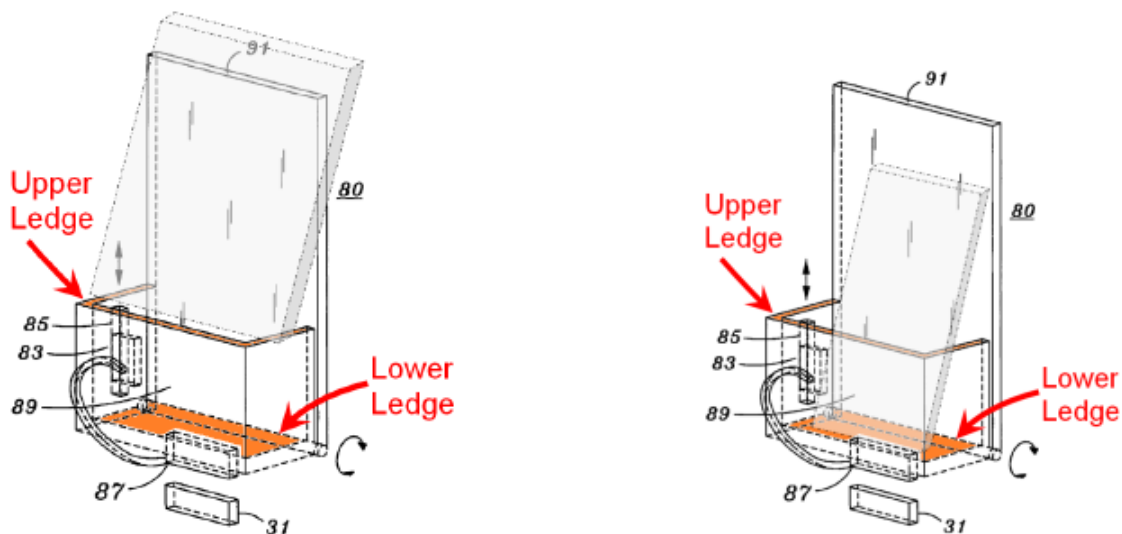
2. Ledges of Decreasing Size Limitation

We are not persuaded that Petitioner has shown sufficiently that the combination of Struthers and iPort Manual and Brochure discloses the recited ledges of decreasing size limitation. Petitioner asserts that iPort Manual and Brochure discloses this limitation. Pet. 41–45. Specifically, Petitioner points to a statement that “Spring-loaded clamps at the bottom of the iPod well will hold . . . smaller models in place.” *Id.* at 42 (quoting Ex. 1010, 10). In addition, Petitioner creates an “annotated” version of a photo from Exhibit 1011. Petitioner’s “Ex. 1011, p.8 (annotated)” Figure is reproduced below.



Pet. 43. In the annotated Figure, above, Petitioner points to the rounded edges of a cavity as demonstrating “outer ledges.” *Id.* Petitioner points to what appears to be the edges of the data/power connector well as the “inner ledges.” *Id.* Even if we were persuaded by Petitioner’s annotated Figure, that this image discloses “inner” and “outer” ledges, as asserted, Petitioner never explains how inner and outer ledges, that appear to be at the same level within a cavity, show “steps or ledges of decreasing size toward the bottom” as required by any construction of the ledges of decreasing size limitation. Thus, we are not persuaded that Petitioner has shown sufficiently that iPort Manual and Brochure discloses the recited ledges of decreasing size limitation.

Petitioner adds that the disclosure of Struthers provides an “alternate embodiment depicting a plurality of ledges that can hold a digital music player.” Pet. 44. Again, Petitioner identifies “upper” and “lower” ledges by providing a “modified” Figure, reproduced below.



Ex. 1008 Fig. 8 (modified)

Id. In the annotated Figure above, Petitioner points to the seam where the back wall meets the bottom of the holder as disclosing a “lower ledge” and the horizontal surface at the top of the lower wall delineating the cavity as the “upper ledge.” *Id.* As with Petitioner’s other explanations of ledges, however, Petitioner fails to explain how the alleged upper and lower ledges shown by Struthers show “steps or ledges of decreasing size toward the bottom” as required by any construction of the ledges of decreasing size limitation. Moreover, the upper ledge in this particular example is not even within the cavity—even if this qualifies the structure as a ledge, we are not persuaded, without anything more than Petitioner’s conclusory statement on the matter, that a person of ordinary skill would have used it as such. *Id.* Thus, we are not persuaded that Petitioner has shown sufficiently that Struthers discloses the recited ledges of decreasing size limitation.

3. *Rationale to Combine*

We are also not persuaded that Petitioner has shown sufficiently a rationale for combining the teachings of Struthers and iPort Manual and Brochure. Petitioner’s rationale appears to be limited to its assertion that the three iPort related documents related to the sale of “a commercial embodiment of Struthers.” *Id.* at 34; *see also id.* at 36 (“One of ordinary skill in the art would have naturally considered materials describing commercial embodiments that correspond to [Struthers].”). Petitioner does not cite to evidence supporting this assertion. Pet. 3, 34.

Moreover, Petitioner assumes, with no explanation whatsoever, that the three exhibits, Exs. 1009, 1010, and 1011, would have been understood to be one document by a person of ordinary skill in the art. Pet. 3. We are not persuaded that this is so. For example, Exhibit 1009 was purportedly

written the year before Exhibits 1010 and 1011, and, even according to Petitioner, describes a different version of a product. See Pet. 3. Petitioner, therefore, has failed to meet its burden showing why a person of ordinary skill in the art would have combined the teachings of the three documents.

Petitioner's conclusory statements and unexplained assumptions do not qualify as rationale for combining the cited references and certainly does not provide a sufficiently "articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Accordingly, we are not persuaded that Petitioner has demonstrated a reasonable likelihood that it would prevail on the ground that claims 1, 2, 5, 7, 8, 11–13, 17, 19, and 20 would have been obvious over Struthers and iPort Manual and Brochure.

CONCLUSION

For the foregoing reasons, based on the information presented in the Petition and the Preliminary Response, we are not persuaded that there is a reasonable likelihood that Petitioner would prevail in showing the unpatentability of claims 1, 2, 5, 7, 8, 11–13, 17, 19, and 20 of the '293 patent. We, therefore, decline to institute *inter partes* review as to any of the challenged claims. 37 C.F.R. § 42.108.

ORDER

It is ordered that the Petition is *denied* as to all challenged claims, and no trial is instituted.

Case IPR2015-1745
Patent 7,742,293 B2

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