

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

CORE WIRELESS LICENSING S.A.R.L.,
Patent Owner.

Case IPR2015-01898
Patent 8,434,020 B2

Before JAMESON LEE, DAVID C. McKONE, and
KEVIN W. CHERRY *Administrative Patent Judges.*

CHERRY, *Administrative Patent Judge.*

DECISION
ON REQUEST FOR REHEARING
37 C.F.R. § 42.71

I. INTRODUCTION

In our Final Written Decision (Paper 42, “Final Decision” or “Final Dec.”), we determined, *inter alia*, that Petitioner had shown by a preponderance of the evidence that claim 6 of U.S. Patent No. 8,434,020 B2 (Ex. 1001, “the ’020 patent”) is unpatentable as obvious over the following references or combinations: (1) Schnarel (U.S. Patent No. 7,225,409 B1 (Ex. 1004)) and Aberg (U.S. Patent No. 6,993,362 B1 (Ex. 1005)); (2) Schnarel, Aberg, and Yurkovic (U.S. Patent No. 6,668,353 B1 (Ex. 1018)); (3) Nason (U.S. Patent No. 6,593,945 B1 (Ex. 1007)); and (4) Nason and Yurkovic. Final Dec. 71.

Patent Owner requests rehearing (Paper 43, “Req. Reh’g” or “Request”) of our Final Decision with respect to claim 6, raising two main arguments. First, Patent Owner argues that we “disregarded or otherwise misinterpreted the intrinsic evidence and instead relied heavily on non-contemporaneous extrinsic evidence,” and as a result, we “wrongly rejected Patent Owner’s position that ‘environment of the device’ excludes the device’s hardware and software configuration.” Req. Reh’g 1. Second, Patent Owner argues that “claim 6 requires that ‘stored data **types**’ vary with the ‘environment of the device,’” but that our findings “merely rested on evidence of variations within the data provided for the **same** data **type(s)**.” *Id.*

II. ANALYSIS

A party dissatisfied with a decision of the Board may file a request for rehearing. 37 C.F.R. § 42.71(d). The party requesting rehearing has the burden of showing the decision should be modified, and “[t]he request must

specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.*

A. Construction of “Environment of the Device”

In the Final Decision, we construed the phrase “environment of the device,” which is recited in claim 6, as “includes device hardware, software, and location, and does not exclude the presence and type of accessory attached to the device or SIM card inserted in the mobile phone.” Final Dec. 15. Patent Owner argues that our construction was based on a “misreading of the specification and a dictionary definition that was not remotely contemporaneous with the filing of the ’020 patent.” Req. Reh’g 2. Patent Owner argues that the proper reading of one of the passages from the specification that we relied on (Ex. 1001, 4:47–52) is that “environment of the device” is tied to the “‘vicinity’ of the device or where the device ‘finds itself,’ *i.e.*, the *physical* environment *external* to the device itself.” *Id.* at 4. Patent Owner argues that the dictionary definition contradicts “the specification’s teaching as to the specific concept of ‘environment of the device,’” and so we cannot rely on the dictionary definition to support our construction. *Id.* at 4–5.

Patent Owner’s arguments suffer from a number of flaws. First, we disagree that these arguments are even the proper basis of rehearing request. Patent Owner never offered a formal construction for this term, identified any part of the specification as relevant to this term, or discussed the specification’s use of the term. Patent Owner also never asked for a sur-reply nor discussed this claim term at the oral hearing. Instead, Patent Owner’s arguments focused on the alleged failure of Petitioner to offer

adequate proof for its contentions that Schnarel, Aberg, and Yurkovic accounted for the limitations of claim 6. *See* PO Resp. 43–43 (e.g., “Petitioner offers no support for their allegation that the ‘caller log transport’ or ‘fax transport’ availability is dependent on the ‘environment of the device.’ This allegation finds no support in the record.”; “Once again, the Petitioner offers no support that these features are dependent upon the ‘environment of the device.’”). Thus, we were never presented the opportunity to misapprehend or overlook these new arguments. Second, Patent Owner’s arguments themselves provide evidence of the broad ordinary meaning of the term “environment.” Patent Owner argues that, as used in claim 6, the term environment means “physical” environment. *Req. Reh’g* 5. The mere fact that Patent Owner must distinguish between “physical” and other environments demonstrates that the term “environment” has a broader ordinary meaning than Patent Owner contends.

Third, we disagree that our construction is based on a “misreading of the specification.” *Req. Reh’g* 2, 6–9. The ’020 patent uses environment several times. Patent Owner focuses its attention on the following passage:

Another possible feature is that the constituency of the App Snapshot may vary with the environment in which the mobile telephone finds itself. For example, if the telephone is Bluetooth enabled, then there may be a Bluetooth application which has associated with it a summary window which lists the other Bluetooth devices in the vicinity.

Ex. 1001, 4:47–52.

Patent Owner argues that this passage equates “environment” with “vicinity.” *Req. Reh’g* 3. We disagree that the specification, even in this passage, equates the two. Instead, we understand the full passage as listing

several elements of environment—whether the telephone is Bluetooth enabled, whether there is Bluetooth application which was an associated summary window, and the location of the device. Ex. 1001, 4:47–52. In any case, the specification is clear that this is only an example. The specification teaches broadly that the application snapshot may vary with “the environment in which the mobile telephone finds itself,” and then provides an “example.” Thus, the specification is clear that the sentence beginning with “for example” is not intended to limit the term “environment.” See *Ancora Tech., Inc. v. Apple, Inc.*, 744 F.3d 732, 735 (Fed. Cir. 2014) (holding non-limiting examples insufficient to narrow a term’s plain and ordinary meaning); see also *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1373 (Fed. Cir. 2014) (noting “e.g.” in the specification does not limit a term). Thus, we disagree that this passage is inconsistent with our construction or limits the term “environment” in the way Patent Owner now proposes.

Our understanding of the broad use of the term “environment” is supported by the specification’s final passage, which states:

As explained above, the present invention is particularly useful for mobile telephones because of their user interface constraints. However, it may also be used in environments outside of mobile telephony. For example, desktop and laptop PCs may also benefit from the present invention. The present invention may therefore be used in any computing environment, including both keyboard and keyboard-less devices.

Ex. 1001, 5:25–31. As can be seen from this passage, the specification here uses “environment” in a much broader sense than Patent Owner contends. Patent Owner attempts to dismiss this passage as relating to “computing environment,” Req. Reh’g 4, but again, this shows that the term

“environment” has many facets and the specification does not limit this term to a single sense. Thus, we disagree that the specification is inconsistent with our construction.

As the intrinsic evidence demonstrates, under a broadest reasonable interpretation, Patent Owner’s efforts to limit the term “environment” to “physical” environment or the “location” of the device are not the only constructions consistent with the use of the term “environment” in the specification.

Patent Owner also argues that our reliance on the MCGRAW-HILL DICTIONARY OF SCIENTIFIC & TECHNICAL TERMS 686 (5th ed. 1994) (Exhibit 1033) was “misplaced,” because Exhibit 1033 is not “contemporaneous with the patent’s filing date.” Req. Reh’g 5. Again, Patent Owner did not raise this argument during the trial. Patent Owner did not file a motion to exclude Exhibit 1033, it did not seek to file a sur-reply, nor did it raise this argument at the oral hearing. Yet, even if we consider this untimely argument, it is without merit. Patent Owner cited *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1299 (Fed. Cir. 2003),¹ for the proposition that non-contemporaneous extrinsic evidence must be disregarded. Req. Reh’g 5–6. Patent Owner goes on to assert that it is irrelevant whether the evidence is from before or after the filing date; rather, the extrinsic evidence

¹ Patent Owner actually cites to *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 326 F.3d 1215, 1221–22 (Fed. Cir. 2003), but that opinion was withdrawn by the panel on rehearing. *Brook-Hill Wilk 1*, 334 F.3d at 1294. The modified opinion contains substantially the same statements that Patent Owner relies on, so we cite to the modified opinion instead.

must be from the same time as the patent's filing date. *Id.* at 6. However, *Brookhill-Wilk 1* does not stand for such a broad proposition.

In *Brookhill-Wilk 1*, the Federal Circuit declined to consider extrinsic evidence date 5 and 8 years *subsequent* to the filing date of the patent-in-suit for purposes of claim construction. *Brookhill-Wilk 1*, 334 F.3d at 1299. Patent Owner's efforts to argue this reasoning applies equally to evidence pre-dating the filing of the patent is not persuasive. As the Federal Circuit explained in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc), the purpose of consulting extrinsic evidence such as technical dictionaries like Exhibit 1033, is to ascertain the meaning understood by persons of skill in the art "at the time of the invention." In other words, *Brookhill-Wilk 1* applies the uncontroversial rationale that a dictionary or technical treatise from years *after* an invention was made is a poor source of understanding of what a person of ordinary skill in the art understood at the time of the invention. An after-arising dictionary or treatise may reflect additional information and knowledge that was not available to persons of ordinary skill at the time of the invention. The same problem is not necessarily true of a dictionary or treatise from before the invention. A pre-existing dictionary would have been available to persons of skill in the art, and would inform a person of ordinary skill's understanding of the word.

Moreover, Patent Owner also fails to persuade us that we erred by relying on Exhibit 1033 because Patent Owner fails to explain how a more contemporaneous dictionary would define the term any differently. See *Mass. Instit. Tech. v. Shire Pharm., Inc.*, 839 F.3d 1111, 1124 (Fed. Cir. 2016) (affirming district court's reliance general dictionary definitions from "the present day" where the party did "not explain how technical dictionaries

or dictionaries contemporaneous to the patent’s filing date would define the term any differently”). Indeed, Patent Owner even fails to explain why Exhibit 1033 is not sufficiently contemporaneous or what a “contemporaneous” dictionary would be. *See, e.g., Int’l Rectifier Corp v. ISYS Corp.*, 361 F.3d 1363, 1370–71 (Fed. Cir. 2004) (describing dictionaries from 1966 and 1993 as “contemporaneous” with patent filed in 1978 and issued in 1990). Exhibit 1033 is a technical dictionary from only seven years before the filing date of the ’020 patent and only six years before the July 28, 2000 foreign priority date. *See* Ex. 1001, 1:6–8. There is no evidence or argument in the record that suggests that the definition of “environment” changed over that brief time. Thus, we disagree with Patent Owner that we erred by our consideration of Exhibit 1033.

Because Patent Owner has not shown that we erred in our construction of “environment of the device,” we do not see reason to modify our construction.

B. Unpatentability of Claim 6

1. Schnarel and Aberg

Patent Owner argues that we erred in our unpatentability analysis of claim 6 based on Schnarel and Aberg because we misconstrued “environment of the device.” *Req. Reh’g* 9–10. We have, however, rejected Patent Owner’s claim construction above. Thus, we are not persuaded that we erred in our unpatentability analysis of claim 6 based on Schnarel and Aberg.

2. Alleged Overlooking of Requirement that “Stored Data Types” must “Vary”

Patent Owner further argues that we erred in our findings that Yurkovic and Nason each taught the limitations of claim 6 because we “overlooked that claim 6 requires the ‘stored data *types*’ of a summary window vary, and not simply the data for a given type to vary.” Req. Reh’g 10–11. Patent Owner never identifies, however, where it argued that Yurkovic and Nason only disclose information varying, not *type* of information varying, which is fatal to its Request. *See* 37 C.F.R. § 42.71(d).

This failure is especially egregious with respect to the grounds based on Nason and Nason and Yurkovic. Patent Owner never separately argued that Nason failed to teach the limitations of claim 6. *See* PO Resp. 43–44. Moreover, Patent Owner also never separately argued that the combination of Nason and Yurkovic failed to account for the limitations of claim 6. With respect to Nason and Nason and Yurkovic, there is nothing that we could have misapprehended or overlooked with respect to our findings regarding the obviousness of claim 6 for these grounds. Thus, these new arguments regarding Nason and Nason and Yurkovic with respect to claim 6 were waived. *See* Paper 8, 3 (Scheduling Order) (“The patent owner is cautioned that any arguments for patentability not raised in the response will be deemed waived.”).

As for the combination of Schnarel, Aberg, and Yurkovic, although Patent Owner did argue claim 6 separately, Patent Owner never argued that Yurkovic failed to teach or suggest that the “stored data types” must “vary” as it now argues. Req. Reh’g 10–11. Instead, Patent Owner’s argument in its Patent Owner Response focused on the alleged lack of reasoning to

modify Schnarel's summary window to include Yurkovic's varying data types, as alleged by Petitioner. *See* PO Resp. 44. Indeed, a review of Patent Owner's entire argument demonstrates that this argument that Yurkovic fails to teach or suggest varying "types" of data was never raised:

Second, Petitioner alleges that it would have been obvious to vary Schnarel's alleged "summary window" based on Yurkovic's disclosure that "News or Weather Information" is based on "location and/or time changes." Pet. at 32. But Petitioner relies upon Schnarel's messages pane 206 to disclose the claimed "summary window" of claim 6, and Schnarel's messages pane 206 does not include "News or Weather Information." Further, Petitioner offers no proposed modification of Schnarel that would modify the content of messages pane 206. While Petitioner does argue that it would have been obvious to "vary the data types (such as date and time information) displayed in the summary window," Schnarel already includes a separate date and time pane 204 that is not included in messages pane 206. There is no reason to modify messages pane 206 to include date/time already provided by a separate pane 204 that Petitioner does not rely upon to disclose the alleged "summary window."

PO Resp. 44.

This paragraph is the only paragraph discussing the combination of Schnarel, Aberg, and Yurkovic with respect to claim 6. Because Patent Owner failed entirely to raise the argument that the types of data in Yurkovic do not vary in its Patent Owner Response, we decline to consider this argument for the first time in a request for rehearing. A request for rehearing is not the proper vehicle for raising these entirely new theories regarding the deficiencies in the combination of Schnarel, Aberg, and Yurkovic. A party seeking reconsideration "is not supposed to treat the [Board's] initial decision as the opening of a dialogue in which that party

may then use such a motion to advance new theories or adduce new evidence in response to the [Board's] rulings.” *Polsby v. St. Martin's Press, Inc.*, No. 97 Civ. 690 (MBM), 2000 WL 98057, at *1 (S.D.N.Y. Jan 18, 2000). Thus, we do not find Patent Owner's remaining arguments to be persuasive that we erred.

III. CONCLUSION

Patent Owner has failed to show that we misapprehended or overlooked its arguments regarding the patentability of claim 6 over the combinations of Schnarel and Aberg; Schnarel, Aberg, and Yurkovic; Nason; and Nason and Yurkovic. In any event, Patent Owner has not shown that we erred in our construction of “environment of the device.” Accordingly, Patent Owner's request for rehearing is *denied*.

IV. ORDER

Patent Owner's Request for Rehearing is DENIED.

IPR2015-01898
Patent 8,434,020 B2

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