

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 IPR2015-01899
Patent 8,713,476 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 4 of U.S. Patent No. 8,713,476 B2 (Ex. 1001, “the ’476 patent”) is unpatentable as obvious over the combination of Schnarel (U.S. Patent No. 7,225,409 B1 (Ex. 1004)), Aberg (U.S. Patent No. 6,993,362 B1 (Ex. 1005)), and Smith (U.S. Patent No. 6,333,973 B1 (Ex. 1006)). Final Dec. 43–47.

Patent Owner requests rehearing (Paper 43, “Req. Reh’g” or “Request”) of our Final Decision with respect to claim 4, arguing that we failed to address its argument that Smith only teaches customizing data types within the underlying application itself and not within the application summary, as recited in claim 4. Req. Reh’g 1.

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.*

In our Final Decision, we determined that Petitioner had shown that Schnarel teaches the claimed application summary window and list of data, and that Smith generally teaches allowing a user to specify the displayed data types in a summary window. Final Dec. 46. We further found that

Petitioner had shown that a person of ordinary skill would have been motivated to incorporate Smith's customization of what data are displayed into Schnarel's application summary window, which includes a list of various data. *Id.*

In its Request, Patent Owner argues that we failed to address Patent Owner's argument that Smith does not disclose data customization *in an application summary*, and that we "did not identify any evidentiary basis to support finding that a [person of ordinary skill in the art] would have been motivated by Smith to modify the purported application summary of Schnarel, much less the purported application summary resulting from a combination of Schnarel and Aberg." Req. Reh'g. 1. Patent Owner's entire argument in its Patent Owner Response regarding the combination of Schnarel, Aberg, and Smith is:

Further, Smith is not a remedy to Schnarel's insufficient disclosure. Pet. at 33. According to Petitioner, Smith discloses adding a date/time stamp "to indicate when the message was received." *Id.* But these stamps are included in Smith's "message center 6100" and not in an "application summary" while the message center is in an unlaunched state, as required by claims 1 and 4. Smith's use of indicators within the message center 6100 itself offers no teaching that would influence or motivate a POSITA to modify an application summary, rather than the application itself.

PO Resp. 37.

As we explained in our Final Decision, Petitioner relies on Smith for its teaching of data customization and Schnarel for its teaching of an "application summary window." Final Dec. 46. Thus, Patent Owner's arguments that Smith fails to teach an customization in an "application

summary window,” as claimed in claim 4, were not persuasive, in part, because it argues the references separately when the Petitioner is relying on the combined teachings of the two references. *See In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986); *see also In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971) (“It should be too well settled now to require citation or discussion that the test for combining references is not what the individual references themselves suggest but rather what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art.”).

Patent Owner’s argument also fails because the argument requires that we limit Smith’s teachings regarding data customization to only the precise software configuration that Smith describes. However, “[a] reference may be read for all that it teaches, including uses beyond its primary purpose.” *In re Mouttet*, 686 F.3d 1322, 1331 (Fed. Cir. 2012) (citing *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418–21 (2007)). Yet, Patent Owner cites no evidence or testimony in its Patent Owner Response that would allow us to draw the conclusion that Smith’s teachings are limited to a precise configuration. In contrast, the Petition provided evidence and testimony that support a broader understanding of Smith. *See* Pet. 19–20, 30–33; Ex. 1003 ¶¶ 43, 81, 82 (discussing the teachings of Smith). Relying on this evidence and testimony, we found in the Final Decision that the evidence showed that Smith teaches customization of displayed data. Final Dec. 46 (citing Ex. 1006, 8:36–51, Fig. 7A). Indeed, there is no dispute that Smith teaches the concept of data customization. *See* Req. Reh’g 4 (“Smith only teaches customization of the contents of a specific **application**, the ‘message center 6100’ application.”). Thus, the argument that the “stamps are included in

Smith's 'message center 6100' and not in an 'application summary' while the message center is in an unlaunched state, as required by claims 1 and 4" is not persuasive because we found a person of ordinary skill would understand that Smith's teachings were broader than that. *See* Final Dec. 46.

Patent Owner's other argument in its Patent Owner Response was that "Smith's use of indicators within the message center 6100 itself offers no teaching that would influence or motivate a POSITA to modify an application summary, rather than the application itself." PO Resp. 37. This argument suffers from two flaws. First, there is no requirement that the references contain the motivation to combine or modify. *See KSR*, 550 U.S. at 420 (holding "any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed"); *see also Alza Corp. v. Mylan Labs., Inc.*, 464 F.3d 1286, 1294 (Fed. Cir. 2006) (stating that the motivation to combine does not have to be explicitly stated in the prior art, and can be supported by testimony of an expert witness regarding knowledge of a person of skill in the art at the time of invention). Second, there is no requirement for bodily incorporation of Smith's features into Schnarel and Aberg. *See Allied Erecting & Dismantling Co. v. Genesis Attachments, LLC*, 825 F.3d 1373, 1381 (Fed. Cir. 2016) ("The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference. . . ."). Instead, the question is "whether 'a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention[.]'" *Id.* (quoting *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d

1348, 1361 (Fed. Cir. 2007)). Thus, Patent Owner's conclusory argument that Smith alone fails to provide a motivation is not persuasive.

Moreover, Patent Owner's motivation argument also fails because, in our Final Decision, we further determined that it would have been obvious to apply the data customization teachings of Smith to the application summary of Schnarel. Final Dec. 46. In particular, we found, based on the testimony of Petitioner's Declarant, Dr. Myers, that a person of ordinary skill would have been motivated to incorporate this into Schnarel's phone as modified. *Id.* (citing Ex. 1003 ¶ 83). As the cited portion of Dr. Myers's testimony explains, Smith's customization feature "advantageously allow[s] a user to quickly view types of information (data) in the summary window that a particular user is most interested in seeing." Ex. 1003 ¶ 83. As Dr. Myers further explains, it would be beneficial to allow different users to change the setting according to their own preferences. *Id.* Indeed, Dr. Myers testified that it "would have been routine and straightforward for a [person of ordinary skill in the art] to do so, and it would have been clear to a [person of ordinary skill in the art] that such a combination would have worked and provided the expected functionality to yield predictable results." *Id.* Dr. Myers also testified that "[s]uch a combination would have merely applied the known techniques of Smith to improve a similar device (the phone taught by Schnarel) in the same way." *Id.* This testimony was well-reasoned and explained, and we found it persuasive and entitled to substantial weight. Thus, we were persuaded by Petitioner had shown sufficiently that there was a motivation to combine the references.

Despite the reiteration of these arguments in the Request, we remain persuaded by Petitioner's evidence. Dr. Myers is the only expert who has

testified on Smith. We have found his testimony to be reasoned and persuasive, and have given it substantial weight.

In addition, as for Patent Owner's complaint that we omitted a discussion of Aberg, Req. Reh'g 9, Aberg is only relied on to teach a modification of the placement of the menu of Schnarel. *See* Final Dec. 23–35 (discussing the use of Aberg in the combination). The device at issue in the combination remains the device of Schnarel. Thus, Patent Owner's contention that there must further be a showing that the modification must be made to Schnarel and Aberg is simply elevating form over substance, because the teachings being modified by Smith are merely the teachings of the Schnarel reference. *See* Final Dec. 45–47.

In its Request, Patent Owner takes the two sentences of arguments regarding Smith in its Patent Owner Response that we discussed above, and goes into great detail for more than nine pages regarding the alleged differences between Smith and the claimed application summary window and deficiencies in Dr. Myers's motivation testimony. Besides the arguments considered above, none of the other arguments were argued in its Patent Owner Response or even presented at the oral hearing. Patent Owner's expert Mr. Denning offered no testimony about Smith or the deficiencies of the combination of Schnarel, Aberg, and Smith beyond the deficiencies of Schanrel. *See* Ex. 2003 ¶ 63. Also, Patent Owner has not identified any cross examination testimony of Dr. Myers regarding the disclosure of Smith.

We do not mention these omissions to say that Patent Owner had to offer testimony on this point or cross examine Dr. Myers about Smith, but rather, it shows that these arguments are entirely absent from the record

before this point. 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 Smith. 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 not shown that we misapprehended or overlooked its arguments regarding the combination of Schnarel, Aberg, and Smith. Accordingly, Patent Owner’s request for rehearing is *denied*.

IV. ORDER

Patent Owner’s Request for Rehearing is DENIED.

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