

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC.,
Petitioner,

v.

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

Case IPR2015-01983
Patent 8,498,671 B2

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

LEE, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

LG Electronics, Inc. (“Petitioner”) filed a Petition (“Pet.”) for *inter partes* review of U.S. Patent No. 8,498,671 B2 (Ex. 1001, “the ’671 patent”). Paper 1. The Petition challenges the patentability of claims 1–5, 7–12, 15, and 16 of the ’671 patent. In an initial decision, we instituted *inter partes* review of each of these challenged claims. Paper 7 (“Dec. Inst.”).

Core Wireless Licensing S.A.R.L. (“Patent Owner”) filed a Patent Owner Response (Paper 16, “PO Resp.”), and Petitioner filed a Reply (Paper 17, “Reply”). Oral argument was held on November 30, 2016. A transcript of the oral hearing is included in the record. Paper 23 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a). We determine that Petitioner has shown by a preponderance of the evidence that claims 1, 3–5, 7–12, 15, and 16 of the ’671 patent are unpatentable. We also determine that Petitioner has not shown by a preponderance of the evidence that claim 2 of the ’671 patent is unpatentable.

B. Related Matters

The parties indicate that the ’671 patent was asserted in *Core Wireless Licensing S.A.R.L. v. LG Electronics, Inc.*, No. 2:14-cv-00911 (E.D. Tex.); *Core Wireless Licensing S.A.R.L. v. Apple, Inc.*, No. 6:14-cv-00751 (E.D. Tex.); and *Core Wireless Licensing S.A.R.L. v. Apple, Inc.*, No. 6:14-cv-00752 (E.D. Tex.). Paper 1, 1; Paper 5, 2. Petitioner indicates that the last two actions are “pending transfer” to the Northern District of California. Pet. 1, 1.

C. The ’671 Patent

The ’671 patent discloses displaying certain information on the idle screen of a mobile telephone device. Ex. 1001, Abstr. That information is of a kind or from a source “selected by a user.” *Id.* The information can be financial information, news, traffic information, etc. *Id.* The ’671 patent explains that previously the idle screen had been used to display the name of the network operator and certain alert messages such as the number of missed calls. *Id.* The ’671 patent further explains that placing such selected

information of interest to the user in the idle screen makes that information instantly accessible to the user without having to navigate to the required “function” (e.g., a micro-browser) and select it. *Id.*

The '671 patent describes that the information may be from a resource selected by a user, such as a particular internet portal which the user selects. *Id.* at 3:12–14. With regard to “remote information resource,” the '671 patent states: “A ‘remote information resource’ contains information of interest to a potentially large number of users and is remotely accessible over a wireless connection. Web and WAP sites are examples of remote information resources.” *Id.* at 3:15–19. Regarding user selection of a “remote information resource,” the '671 patent explains:

The user may directly select the remote information resource by, for example, navigating to an internet site and defining elements of that site to appear in the idle screen. The user may also indirectly select the remote information resource by setting or agreeing to certain kinds of default profiles; for example, if a user selects a “shopping” profile, then location specific information relating to nearby shops (e.g. special offers etc.) or links to nearby taxi firms or indeed nearby taxis could be pushed to the user’s device to appear automatically in the idle screen of the user’s mobile telephone device.

Id. at 3:44–54 (emphasis added). Figure 3 is reproduced below:

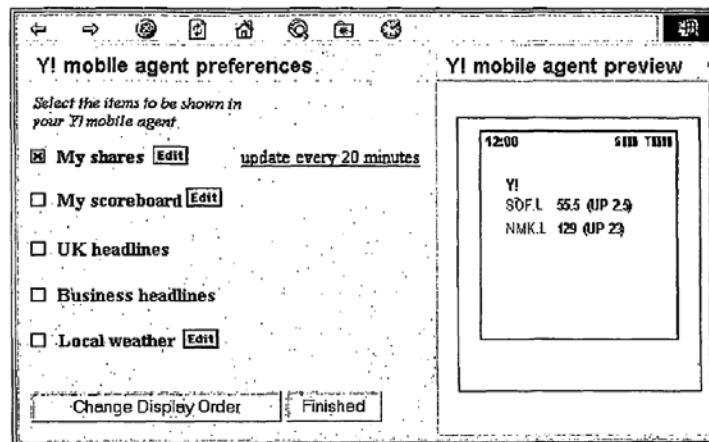


Figure 3, reproduced above, shows a screen shot of how a web site may be accessed to set up an idle screen display according to an embodiment of the '671 patent. *Id.* at 4:31–34. In the circumstance of Figure 3, a user has logged into “My Yahoo!” and navigated to a place for setting up “Yahoo! mobile agent.” *Id.* at 5:27–32.¹ The setup screen allows the user to specify what is visible on the idle screen of the user’s mobile device. *Id.* at 5:33–35. In this example, the user selects “My shares” and “My scoreboard,” sets the update schedules, and presses “Finished.” *Id.* at 5:36–38.

The '671 patent explains that a user can either select an existing Web or WAP page, or alternatively generate a Web/Wap page “according to the user’s specified preferences for different sorts of information (e.g.,] sports results, cookery, news headlines).” *Id.* at 6:53–60. In that regard, the '671 patent also states: “While the user could select an existing WAP page as the idle screen, formatting problems, ad-junk, and the fact that the user might want information from disparate sources means that a customized page would typically be better.” *Id.* at 5:4–7.

Claims 1, 12, 15, and 16 are the only independent claims of all challenged claims and are reproduced below:

1. A mobile communication device capable of supplying information to an end-user, the mobile communication device being adapted to receive and display the information from a remote information resource;

wherein the mobile communication device is adapted to enable the end-user to select the remote information resource prior to

¹ According to the '671 patent, “[t]he illustrated implementation is hypothetical only and should not be construed as implying that any such service is in fact available from or otherwise supported by Yahoo!.” Ex. 1001, 5:23–26.

the mobile communication device entering an idle screen state, enable the end-user to customize the idle screen to display the information according to the end-user's specified preferences, the information is for display on an idle screen of the mobile communication device, and the information is updated while the mobile communication device is in the idle screen state.

12. A method of displaying information on a mobile communication device, comprising:

- (a) enabling an end-user to select a remote information resource prior to the mobile communication device entering an idle screen state, wherein information content retrieved from the remote information resource is customized according to the end-user's specified preferences and displayed on an idle screen of the mobile communication device during the idle screen state; and
- (b) retrieving updated information content from the remote information resource during the idle screen state.

15. A mobile device configured to:

- (a) retrieve or receive, from a remote information resource, updated information during an idle screen state; and
- (b) display that updated information on the mobile device during the idle screen state;

wherein (i) the kind of updated information which is to be retrieved or received is determined prior to the mobile device entering the idle screen state based on a user input, and (ii) the updated information is displayed as part or all of an idle screen on the mobile device according to an end-user's specified preferences.

16. A method of displaying information on a mobile device, comprising:

- (a) retrieving or receiving, by the mobile device, updated information from a remote information resource during an idle screen state; and

(b) displaying that updated information on the mobile device during the idle screen state;

wherein (i) the kind of updated information which is to be retrieved or received is determined prior to the mobile device entering the idle screen state based on a user input, and (ii) the updated information is displayed as part or all of an idle screen on the mobile device according to an end-user's specified preferences.

D. Evidence Relied Upon by Petitioner

Reference		Date	Exhibit
Farber	U.S. Patent No. 5,819,284	Oct. 6, 1998	Ex. 1002
Martin	U.S. Patent No. 6,363,419 B1	Mar. 26, 2002 (filed Apr. 5, 1999)	Ex. 1003
APA	Admitted Prior Art ²	Not Applicable	Not Applicable

Petitioner also relies on the Declaration of Dr. V. Thomas Rhyne, III. Ex. 1004. Patent Owner has not submitted the declaration of any declarant to rebut the testimony of Dr. Rhyne.

E. The Asserted Grounds of Unpatentability

Trial was instituted on the following grounds of unpatentability:

Reference(s)	Basis	Claims Challenged
Farber and APA	§ 103(a)	1–5, 7–12, 15, and 16
Martin, Farber, and APA	§ 103(a)	1–5, 7–12, 15, and 16

² According to Petitioner, the '671 patent states that it was known (1) for a mobile telephone device to retrieve information from a remote source for displaying on an idle screen (Ex. 1001, 3:20–24), and (2) to use the idle screen of a mobile telephone to display advertisement and other information selected and sent by the network provider (Ex. 1001, 2:41–47). Pet. 9. By “Admitted Prior Art,” we refer to those statements. Patent Owner does not dispute that those statements constitute admitted prior art.

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the specification of the patent in which they appear. *See* 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2142–46 (2016).

Consistent with that standard, we assign claim terms their ordinary and customary meaning, as would be understood by one of ordinary skill in the art at the time of the invention, in the context of the entire patent disclosure.

See In re Translogic Tech., Inc., 504 F.3d 1249, 1257 (Fed. Cir. 2007).

There are, however, two exceptions: “1) when a patentee sets out a definition and acts as his own lexicographer,” and “2) when the patentee disavows the full scope of a claim term either in the specification or during prosecution.” *Thorner v. Sony Comp. Entm’t Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012). It is inappropriate to limit a claim to a preferred embodiment without a clear intent in the specification to redefine a claim term or a clear disavowal of claim scope. *See id.* Limitations that are not a part of the claim should not be imported into the claim. *See SuperGuide Corp. v. DirecTV Enters., Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004).

If an inventor acts as his or her own lexicographer, the definition must be set forth in the specification with reasonable clarity, deliberateness, and precision. *See Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998). It is improper to add into a claim an extraneous limitation, i.e., one that is added wholly apart from any need for the addition to interpret what is meant by the words or phrases in the claim. *See Hoganas AB v. Dresser Indus., Inc.*, 9 F.3d 948, 950 (Fed. Cir. 1993); *E.I.*

Du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1433 (Fed. Cir. 1988).

Only terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *See Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011); *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

1. “remote information resource”

Each of independent claims 1, 12, 15, and 16 recites the term “remote information resource.” Petitioner does not propose any construction for the term. According to Patent Owner, the term is expressly defined in the specification as follows:

A ‘remote information resource’ contains information of interest to a potentially large number of users and is remotely accessible over a wireless connection. Web and WAP sites are examples of remote information resources.

PO Resp. 11 (citing Ex. 1001, 3:15–19). The above-quoted text first provides a definition, and then identifies examples. Petitioner’s witness, Dr. Rhyne, agrees that the above-quoted text in the specification functionally defines a remote information resource and provides examples. Ex. 2004, 21:15–22:12. In accordance with the definition given in the specification, we construe “remote information resource” as: a remotely wirelessly accessible location or object that contains information of interest to a potentially large number of users.³

³ Patent Owner correctly notes that a remote information resource is a container of information and is not the information itself. PO Resp. 13.

2. “select [a/the] remote information resource”

Claim 1 recites “select the remote information resource.” Claim 12 recites “select a remote information resource.” The ’671 patent does not specially define either phrase or the term “select.” Thus, both phrases and the term “select” take on their ordinary and customary meanings as would be understood by one with ordinary skill in the art in light of the specification.

Petitioner asserts that both phrases should be construed to mean “select a remote information resource either directly or indirectly.” Pet. 14. Petitioner’s assertion is fully supported by this description in the ’671 patent: “The user may directly select the remote information resource by, for example, navigating to an [I]nternet site and defining elements of that site to appear in the idle screen. The user may also indirectly select the remote information resource by setting or agreeing to certain kinds of default profiles.” Ex. 1001, 3:44–49.

A specific example of indirect selection is also provided in the specification. The ’671 patent states:

[F]or example, if a user selects a ‘shopping’ profile, then location specific information relating to nearby shops (e.g., special offers etc.) or links to nearby taxi firms or indeed nearby taxis could be pushed to the user’s device to appear automatically in the idle screen of the user’s mobile telephone device.

Id. at 3:44–54.

Patent Owner argues that in the context of claims 1 and 12, which add the language “an end-user is enabled to” just prior to the phrase “select the remote information resource” (claim 1) and the phrase “select a remote information resource” (claim 12), claims 1 and 12 should be construed to be limited to “direct” selection of the remote information resource. PO Resp. 13–15. The argument is unpersuasive. The presence of the phrase “an end-

user is enabled to” in claims 1 and 12 does not restrict the selection by the end-user to the direct approach. The end-user still can make its selection indirectly, such as by selecting a default profile, as is described in the specification and discussed above.

We construe “select [a/the] remote information resource” broadly, but reasonably, to mean “select a remote information resource either directly or indirectly.” We also clarify that indirect selection, in that context, means a selection made on the basis of information provided by the user that does not itself identify the remote information resource.

3. “idle screen”

Each independent claim refers to an “idle screen.” With respect to an “idle screen,” the specification of the ’671 patent states:

The term ‘idle screen’ refers to the default screen displayed when the mobile telephone device is switched on and therefore capable of receiving a voice call. The idle screen is the screen which is displayed when the user is not navigating to a particular function, nor actively using a particular application, such as contacts application, or a messaging application. Personal computers have no equivalent to an idle screen.

Ex. 1001, 1:28–36. Citing to the first two sentences in the above-quoted text, and without explanation, Petitioner proposes a construction for “idle screen” that is differently worded from that stated above. Pet. 12. It is inappropriate to rephrase the first two sentences in the above-quoted definition provided in the specification. The meaning of “idle screen” is

provided in the specification by the entirety of the above-quoted text and needs no further construction.⁴

4. “mobile communication device” and “mobile device”

Independent claims 1 and 12 each recite the term “mobile communication device,” and independent claims 15 and 16 each recite the term “mobile device.” Petitioner asserts that both terms should be construed to include *a portable electronic device with communications capabilities*.

Pet. 11. Patent Owner asserts that the term “mobile communication device” should be construed as *wireless mobile communication device*, and the term “mobile device” should be construed as *wireless mobile device*. PO Resp. 12–13. Because the prior art in the involved grounds of unpatentability accounts for a wireless communication capability of a portable device, we discern no need to specify any express construction for either “mobile communication device” or “mobile device.”

5. “a source selected by a user”

Claim 2 depends from claim 1 and further recites: “in which the information is from a source selected by the user.” According to Patent Owner, the phrase requires “**direct**” selection of a source of information. PO Resp. 19. We will address Patent Owner’s position in the context of analysis

⁴ The last sentence, “Personal computers have no equivalent to an idle screen,” indicates only that the ’671 patent defines “idle screen” to exclude anything on a personal computer, such as a screen saver. It acts as a disclaimer, and does not mean a screen saver on a personal computer is not reasonably pertinent to what the ’671 patent regards as an idle screen. By adopting the definition in the specification, we are not finding that teachings about screen savers on a personal computer may not be relied on to render the claimed invention obvious.

of claim 2 below. It is not necessary, however, to provide an express construction of the phrase. Note, however, a “source” is not the same as a “remote information resource.” A “remote information resource” is specially defined in the specification and construed above.

B. Level of Ordinary Skill in the Art

With regard to the level of ordinary skill in the art, Petitioner asserts: “A person of ordinary skill in the art in the field of the [']671 patent is a person who has, through formal education or extensive practical experience, the equivalent of a Bachelor’s Degree in Computer Science or Electrical Engineering and 2–3 years of experience in graphical user interfaces.” Pet. 10–11. Patent Owner does not explicitly take a position on the level of ordinary skill and does not dispute Petitioner’s articulation. Petitioner’s assertion is supported by the testimony of Dr. Rhyne. We accept and adopt Petitioner’s statement of the level of ordinary skill in the art.

C. Claims 1–5, 7–12, 15, and 16,
as Obvious over Farber and APA

We have reviewed the arguments and evidence presented by Petitioner, and determine that, notwithstanding the arguments of Patent Owner, Petitioner has established by a preponderance of the evidence that claims 1, 3–5, 7–12, 15, and 16 are unpatentable as obviousness over Farber and APA. Petitioner, however, has not established by a preponderance of the evidence that claim 2 is unpatentable as obvious over Farber and APA.

1. APA

APA refers to admitted prior art. As noted above, by “admitted prior art,” we refer to (1) the statement in the specification of the ’671 patent, in column 3, lines 20–24, indicating that it was known for a mobile telephone device to retrieve information from a remote source for displaying on an idle screen (Ex. 1001, 3:20–24), and (2) the statement in the specification of the ’671 patent, in column 2, lines 41–47, indicating that it was known to use the idle screen of a mobile telephone to display advertisement and other information selected and sent by the network provider (Ex. 1001, 2:41–47). Patent Owner does not dispute that those statements constitute admitted prior art.

2. Farber

Farber discloses a screen saver for a personal computer or other similar display devices. Ex. 1002, Abstr. The screen saver displays personalized up-to-date information that is of interest to that particular user. *Id.* Each user has a personalized user profile indicating (a) the categories or types of information that the user desires to receive, such as sports information, weather, investment advisories, and (b) parameters that specify, for that user, the exact information desired to be received in that category. *Id.* The personal profile is stored in a database at a service node away from the personal computer. *Id.* at 4:32–47.

When the screen saver is activated, such as when the personal computer display has remained inactive for a predetermined period of time, the personal computer accesses the service node to retrieve information for display, based on the user’s individual profile, without interrupting the screen saver function. *Id.* at Abstr., 1:47–60. The displayed personalized

data is thereafter updated periodically such that the information displayed as a screen saver is always current. *Id.* at 1:60–64.

Figure 1 of Farber is reproduced below:

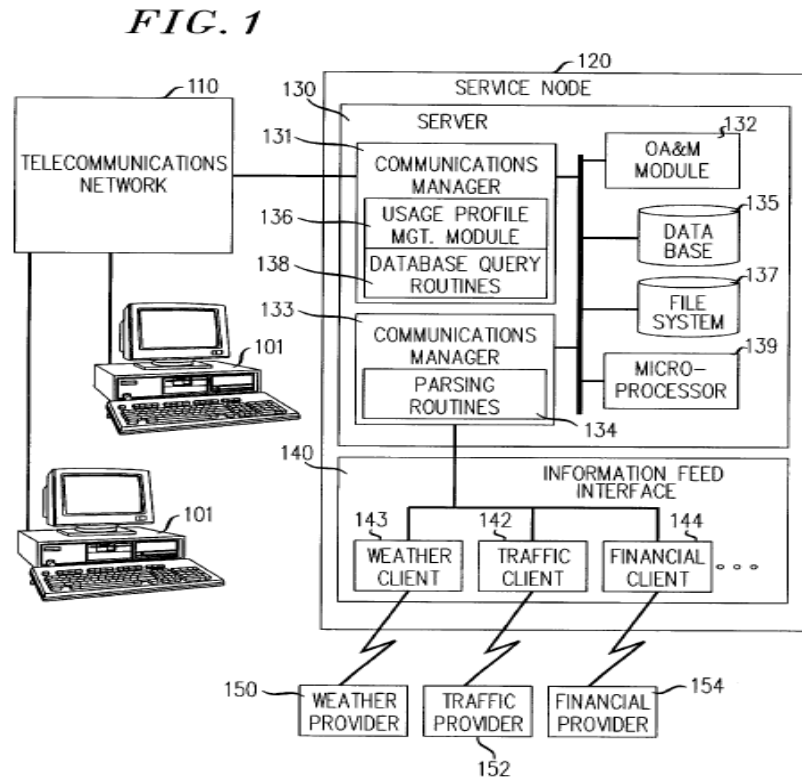


Figure 1, reproduced above, is a block diagram of a described embodiment of Farber. *Id.* at 2:24–26. Personal computers 101 are connected to service node 120 through telecommunications network 110. *Id.* at 2:57–58. Service node 120 includes server 130 and information feed interface 140. *Id.* at 2:65–66. Information feed interface 140 is connected to server 130 and also a plurality of information providers that may be at different locations, such as weather provider 150, traffic provider 152, and financial information provider 154. *Id.* at 3:3–11. Information feed interface 140 includes a plurality of clients, such as traffic client 142, weather client 143, and financial client 144, which provide an interface to a

corresponding one of the providers, to download or receive information from the providers. *Id.* at 3:61–4:5.

Server 130 in service node 120 includes database 135. *Id.* at 4:32–34. Database 135 includes traffic database 171, weather database 172, and financial database 173, which store information obtained from the various information providers. *Id.* at 4:34–38. Database 135 also includes user profile database 174 which contains profile information of each user in the system. *Id.* at 4:41–44. Database 135 is illustrated in Figure 2, reproduced below:

FIG. 2

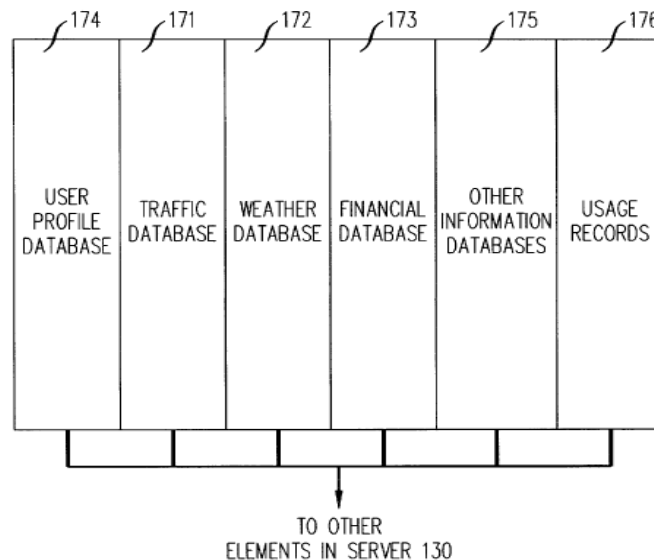


Figure 2, reproduced above, illustrates the components within database 135 of server 130 shown in Fig. 1. *Id.* at 2:27–28.

Farber describes that the information displayed by the screen saver is up-to-date because it was recently obtained from service node 120, and is customized because it was selected by the user and set forth in his or her profile. *Id.* at 6:59–60.

3. Independent Claims 1 and 12

Claim 1 is drawn to an apparatus and claim 12 is drawn to a method. The steps recited in method claim 12 correspond to the respective functions the mobile communication device is adapted to perform. Petitioner relies on the same analysis and evidence to address both claims 1 and 12, and Patent Owner does not have arguments that apply to one of claims 1 and 12 but not the other. Accordingly, claim 1 is representative. Although we specifically discuss only claim 1, the analysis applies to claim 12 as well.

Claim 1 recites: “A mobile communication device capable of supplying information to an end-user, the mobile communication device being adapted to receive and display the information from a remote information resource.” Petitioner points out that Farber describes a system and method for personalizing a screen saver display on a personal computer or other visual display devices. Pet. 15. Petitioner also points out that the content for the screen saver is obtained by request to a service node accessed through a telecommunication network. *Id.*

The various “other visual display devices” described in Farber, as identified by Petitioner, are “a Picturephone™ 2500 available from AT&T™ Corp.,” “a personal digital assistant, such as a MagicLink™ personal digital assistan[t] available from [SONY],” a “screen telephone” and a “display device” similar to a personal computer. *Id.* Petitioner fails to explain, however, why any of the identified devices necessarily constitutes a mobile communication device.

Petitioner does, however, provide obviousness reasoning to account for the requirement of the idle screen of a mobile communication device. Petitioner explains that in light of Farber and APA, it would have been

obvious for one with ordinary skill in the art to put information of special interest to an end-user on the idle screen of a mobile telephone in the same way that Farber describes such information would be applied as a screen saver to a screen phone or a personal digital assistant. Pet. 16–17. The reasoning has rational underpinnings and is persuasive. APA refers to admitted facts that it was known (1) for a mobile telephone device to retrieve information from a remote source for displaying on an idle screen, and (2) to use the idle screen of a mobile telephone to display an advertisement and other information selected and sent by the network provider. The benefit of having desirable information on the screen saver of a screen phone or a personal digital assistant similarly applies to an idle screen on a mobile telephone. As is persuasively explained by Petitioner, combining the teachings of Farber and APA in the manner proposed by Petitioner would have been obvious “because it is the straightforward result of using the user-customization techniques Farber describes to improve a similar device in the same way.” Pet. 16. In the Patent Owner’s Response, Patent Owner does not dispute Petitioner’s reasoning for combining the teachings of Farber and APA.

We determine that this element of claim 1 is rendered obvious by the combined teachings of Farber and APA as applied by Petitioner. In essence, what Farber describes for selection, customization, and display on a screen saver would have been recognized by one with ordinary skill in the art to apply to the selection, customization, and display of information in the idle screen state of a mobile telephone.

Claim 1 further recites: “wherein the mobile communication device is adapted to enable the end-user to select the remote information resource

prior to the mobile communication device entering an idle screen state.” Petitioner persuasively explains how this limitation is met by the combined teachings of Farber and APA. Pet. 17–19. Specifically, as discussed above, APA is relied on to extend Farber’s teachings to a mobile communication device. The rest of this limitation is accounted for by Farber’s disclosure.

Petitioner explains that in Farber the selection of remote information resource is done by the user’s creation of “a personalized user profile” that indicates “(a) the categories or types of information that the user desires to receive, such as sports information, weather, investment advisories, and so on, and (b) parameters that specify, for that user, the exact information desired to be received in each category.” Pet. 17 (citing Ex. 1002, 1:41–47, 6:56–60). Petitioner explains that in Farber the personalized user profile is created when a user initially arranges to use the display system. *Id.* (citing Ex. 1002, 1:41–47, 6:56–60). Petitioner further explains that, subsequently, when the user’s device enters an idle or inactive state, the process for retrieving current up-to-date data is initiated by establishing a communication session with the service node. *Id.* (citing Ex. 1002, 5:15–22, 5:47–50, 2:45–49). And Petitioner explains that based on the customized profile, the service node obtains the specific information desired by the user and sends it to the mobile device for display. *Id.* (citing Ex. 1002, 5:44–6:17). The explanations are supported by evidence and persuasive, notwithstanding the arguments of Patent Owner, which are discussed below.

Because “to select the remote information resource” is construed to encompass indirect selection, in the sense of relying on a default profile containing certain information such as a broader class of information, to make the selection, Petitioner has adequately accounted for how Farber

satisfies the limitation *enable the end-user to select the remote information resource* (the “to-select limitation”).

Claim 1 specifically requires that the user selection be enabled by the mobile communication device. We are persuaded by Petitioner (Pet. 18–19) that in light of Farber’s disclosing that the customized profile may be created by using an “interactive voice platform,” it would have been obvious to one with ordinary skill to use the mobile telephone in the combined teachings of Farber and APA to create the personalized user profile at the service node. A mobile telephone provides the interactive voice platform. Petitioner’s position is supported by the testimony of Dr. Rhyne. Ex. 1004 ¶ 49.

Patent Owner asserts that the Petition is unclear as to what Petitioner regards, in Farber, as the remote information resource. PO Resp. 41 n.15. We explained in the initial decision, however, that, in light of Dr. Rhyne’s testimony, it is evident that Petitioner identifies providers 150, 152, and 154 as the remote information resource. Dec. Inst. 21–22. Patent Owner acknowledges that the initial decision understood the Petition as equating Farber’s information providers as the remote information resources. PO Resp. 41 (citing Dec. Inst. 21–22). Patent Owner has had clear notice of how Farber is applied to the claims.

Patent Owner argues that the limitation of enabling an end-user to select a remote information resource is restricted to the “direct” selection embodiment which is not met by a user’s setting or agreeing to a certain profile as is the case in the disclosure of Farber. PO Resp. 14–15. Patent Owner further notes that “direct” selection is not disclosed by Farber, because Farber’s system is arranged to insulate information providers from direct connection to users. PO Resp. 41 (citing Ex. 1002, 1:66–2:1, 4:14–

16). Patent Owner further notes that direct selection is akin to a user's navigating to the remote information resource to make the selection. PO Resp. 40–41.

As discussed above, however, we have rejected Patent Owner's proposed construction of the phrase "select [a/the] remote information resource" to require direct selection by the user.⁵ Instead, we have construed the phrase to cover the case of indirect selection, i.e., selection made on the basis of information provided by the user that does not itself identify the remote information resource. Patent Owner further states: "The user profile is only used by the service node to retrieve information from the data base 135 within the service node, and does not lead to or facilitate any subsequent selection or access to the information providers 150, 152, and 154." *Id.* at 41 n.16. Even if true, that would not undermine Petitioner's position. Nothing in the claim precludes first obtaining information from a plurality of remote information resources and then determining which remote information resource is the one to be selected based on the contents of a user's personalized profile and then supplying information from a

⁵ On pages 37–39 of the Patent Owner's Response, Patent Owner adds that the fact that claim 1 separately requires enabling the end-user to customize the idle screen to display information according to the end-user's specified preferences makes clear that claim 1 is limited to "direct" selection. PO Resp. 37–39. The assertion is without merit. There is no conflict between an end-user's customizing the idle screen to display information the end-user prefers and indirectly selecting the remote information resource. In Farber, the screen is customized because the personalized profile includes parameters that indicate in more specificity the particular or exact information desired by the corresponding user. Ex. 1002, 1:41–47, 4:51–59, 6:56–60.

corresponding specific database 171, 172, 173, or 175 within general database 135.

For these reasons, Farber's use of a personalized user profile, as discussed by Petitioner, satisfies the requirement of an indirect selection of the remote information resource, and the limitation of "wherein the mobile communication device is adapted to enable the end-user to select the remote information resource prior to the mobile communication device entering an idle screen state" is met by the combined teachings of Farber and APA.

Claim 1 further recites: "enable the end-user to customize the idle screen to display the information according to the end-user's specified preferences." Petitioner persuasively explains how this limitation is met by the combined teachings of Farber and APA. Pet. 19–20. As discussed above, APA is relied on to extend Farber's teachings to a mobile communication device. The rest of this limitation is accounted for by Farber's disclosure.

Petitioner explains that in Farber the customizing of the idle screen to display the information according to the end user's specified preferences is done by creating the personalized user profile, which includes parameters that specify, for that specific user, the exact information desired to be received. Pet. 19 (citing Ex. 1002, 1:41–47, 6:56–60). Petitioner further explains that the profile is then used to obtain the personalized information for display. *Id.* at 20 (citing Ex. 1002, 1:28–40, 4:32–63, 1:41–63). For instance, parameters in user A's profile that specify the exact information desired by user A can be news and weather for City A, and parameters in User B's profile that specify the exact information desired by user B can be news and weather for City B. Ex. 1002, 4:55–59. Farber further describes

that different users may specify individualized preferences, such as traffic information for different roadways, financial information for different securities, and sports information for different teams. *Id.* at 4:51–55.

Petitioner’s explanations are supported by evidence and are persuasive. For the reasons given by Petitioner, Farber’s use of personalized parameters in the user profile, as discussed by Petitioner in the combined teachings of Farber and APA, satisfies the requirement of “enable the end-user to customize the idle screen to display the information according to the end-user’s specified preferences.”

Claim 1 additionally recites: “the information is for display on an idle screen of the mobile communication device.” As we discussed above, Petitioner has shown that it would have been obvious for one with ordinary skill in the art to put information of special interest to an end-user on the idle screen of a mobile telephone in the same way that Farber describes that such information would be applied as a screen saver to a screen phone or a personal digital assistant. Accordingly, this limitation is satisfied by Petitioner’s proposed combination of Farber and APA.

Claim 1 finally recites: “the information is updated while the mobile communication device is in the idle screen state.”

Petitioner explains:

Farber teaches that “the process for retrieving current up-to-date data is initiated by proceeding to step 301” after “a user-specified period of PC inactivity has elapsed” and the “screen saver” is activated.” (Ex. 1002 at Fig. 3, 5:12–22). Thus, the information is updated while the user’s device is in the idle screen state (*i.e.*, after a period of inactivity while the screen-saver is active). (Ex. 1004 at ¶ 55; *see also* Ex. 1002 at 1:7–14, Fig. 4, 6:56–62.)

Pet. 22. The explanation is supported by evidence and is persuasive. The device according to Petitioner's combination of Farber and APA satisfies this claim limitation.

For the foregoing reasons, we determine that Petitioner has shown by a preponderance of the evidence that each of claims 1 and 12 is unpatentable as obvious Farber and APA.

4. Independent Claims 15 and 16

Petitioner states that claim 15 contains the same substantive limitations as claim 1 and is unpatentable for the same reasons explained for claim 1. Pet. 28. Petitioner also states that claim 16 is essentially identical to claim 15, except that it is a method claim. Pet. 29. Petitioner further states that claim 16 contains the same substantive limitations as claim 1 and is unpatentable for the same reasons explained for claim 1. *Id.*

The only argument Patent Owner advances for claims 15 and 16 is that Petitioner "assumes that claims 15 and 16 contain the same substantive limitations as claim 1, and merely refer[s] back to the analysis of claim 1." PO Resp. 44. Patent Owner asserts that "all of the independent claims of the '671 patent do not contain the same substantive limitations." *Id.* at 45.

Petitioner bears the burden of proof with respect to its Petition. *See* 37 C.F.R. § 42.20(c). That does not mean, however, that the Petitioner must reiterate its analysis, separately, each time it addresses an additional claim. Some claims are sufficiently similar that it is manifestly evident why the analysis already provided for a first claim also applies for the same reasons given for the first claim. That is the case with respect to claim 1, as the claim for which the substantive analysis is provided by Petitioner, and

claims 15 and 16 as claims for which the analysis provided for claim 1 also applies, without reiteration.

Whether the claims share identical language is not the appropriate test for determining whether a Petitioner properly may rely on analysis previously given in the Petition for another claim. Whether the claims are literally of identical scope also is not the test. What matters is whether an accounting for one claim also accounts for the other. That is the case here, with respect to claim 1 on the one hand, and claims 15 and 16 on the other. For instance, claim 1 recites that the information for display on the idle screen “is updated while the mobile communication device is in the idle screen state.” Satisfaction of that limitation, as discussed in the context of claim 1, also means satisfaction of the requirements of claims 15 and 16 that information is retrieved from a remote information resource during an idle screen state and displayed during the idle screen state.

Also, claim 1 recites that the end-user is enabled “to select the remote information resource prior to the mobile communication device entering an idle screen state,” and “to customize the idle screen to display the information according to the end-user’s specified preferences.” Satisfaction of those limitations, as discussed in the context of claim 1, also means satisfaction of the requirements of claims 15 and 16 that the kind of updated information to be retrieved is determined prior to the mobile device entering the idle screen state based on user input, and that the updated information is displayed as part or all of an idle screen on the mobile device according to an end-user’s specified preferences.

We are persuaded by Petitioner that claims 15 and 16 are each of essentially the same scope as claim 1 in the sense that the subject matter of

claim 1 is encompassed by the subject matter of each of claims 15 and 16. Consequently, the analysis Petitioner provided for claim 1 also applies to claims 15 and 16, with persuasion, and need not be expressly reiterated. We are persuaded by Petitioner's analysis, by a preponderance of the evidence.

Patent Owner provides no further explanation as to why establishing end-user's selecting of a remote information resource prior to the mobile communication device's entering of the idle screen state, as required by claim 1, does not also establish determining based on user input, prior to the mobile device entering the idle screen state, the information that is to be retrieved. We have considered Patent Owner's assertion that the analysis of the similar element found in claim 1 does not apply, but for the reasons set forth above, we disagree. Patent Owner also provides no further explanation as to why establishing end-user's customizing the idle screen to display the information according to the end-user's specified preferences, as required by claim 1, does not also establish displaying that information as part or all of an idle screen according to an end-user's specified preferences. Again, we have considered this assertion, but we find the reasoning above that the analysis of claim 1 does meet this limitation to be more persuasive for the reasons given above.

For the foregoing reasons, Petitioner has shown by a preponderance of the evidence, based on its analysis of claim 1, made applicable to claims 15 and 16 by reference, that claims 15 and 16 are unpatentable as obvious over Farber and APA.

5. Claims 3–5, 7, 8, and 10

Claims 3–5, 7, 8, and 10 each depend, directly or indirectly, from claim 1. Relying on the testimony of Dr. Rhyne, Petitioner explains why

these claims would have been obvious over Farber and APA. Pet. 22–26. Patent Owner submits no argument specifically for any of these claims. As for the arguments Patent Owner made for claim 1, the base claim on which these claims depend, we have discussed and rejected them above in the discussion and analysis of claim 1. We have considered Petitioner’s explanations and credit the supporting testimony of Dr. Rhyne. Petitioner’s arguments are persuasive and are supported by the record evidence. Pet. 22–26. The limitations of each of claims 3–5, 7, 8, and 10 are met by Petitioner’s proposed combination of Farber and APA and the teachings of Farber and APA have been properly combined. We determine that Petitioner has shown by a preponderance of the evidence that each of claims 3–5, 7, 8, and 10 is unpatentable as obvious over Farber and APA.

6. Claim 9

Claim 9 reads: “The mobile communication device of claim 1 in which multiple information resources are used with different priority settings.” Petitioner argues:

Farber discloses, in Figure 4 under the “Traffic” heading, three different geographical areas. Two of these have a traffic “alert” and one of them has “no alert.” (Ex. 1002 at Figure 4.) A person of ordinary skill in the art would have understood from this that at least two different priority settings (“alert” and “no alert”) are disclosed. (Ex. 1004 at ¶ 63.) Farber also discloses, in claim 32, maintaining a user profile which includes a preference for weather information. (Ex. 1002 at claim 32.)

Pet. 25. The assertion based on Farber’s showing an alert or no alert status of the traffic conditions in different geographic areas does not support satisfying the limitation that multiple information resources are “used” with different priority settings. It is usage of the different remote information resources, i.e., the information containers, that must be prioritized, and that

is not met by having information content that happens to indicate that the information is important relative to some other information.

Petitioner's identification of claim 32 of Farber, however, sufficiently accounts for the limitation added by claim 9 of the '671 patent relative to base claim 1. Claim 32 of Farber reads: "The method of claim 26 wherein said maintained user profile includes a preference for weather information." Patent Owner argues that the language of claim 32 of Farber only identifies a preference for a type of information, and not for an information resource as is required by claim 9. PO Resp. 31. But no further explanation by Petitioner is necessary, because a "preference" naturally and logically translates to priority and because a user preference for weather information in the context of Farber leads to obtaining information from the weather provider. For example, Dr. Rhyne has regarded Farber's language about having a preference for weather information as prioritizing the weather provider over the other information providers. Ex. 1004 ¶ 63. Furthermore, as is explained by Petitioner in its Reply, "[w]hile it is certainly true that assigning a preference to 'financial information' can be thought of as prioritizing a type of information, it does not mean that it is not also a prioritization of information from the 'financial provider' over the information from the other providers." Reply 22.

Patent Owner refers to Figure 4 of Farber, and asserts that as shown in Figure 4, all information designated by the user within the user's profile are displayed on the screen saver all the time, and thus, Farber suggests that all such information are treated equally and that none is given priority over another. PO Resp. 31. Figure 4 of Farber is reproduced below:

FIG. 4

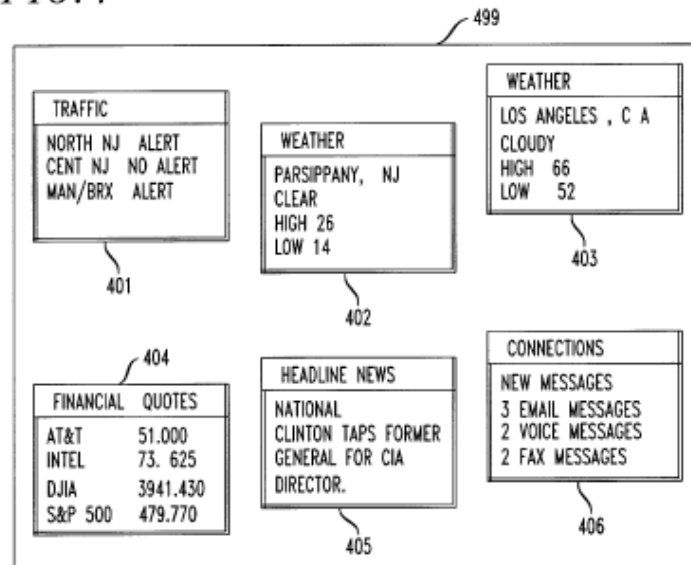


Figure 4, reproduced above, illustrates a sample look according to an embodiment of Farber's screen saver. Ex, 1002, 2:32–35. As is stated in Farber, Figure 4 provides only a sample illustration. To the extent that it conflicts with claim 32 of Farber, it may not be illustrating the embodiment covered by that claim. Patent Owner's argument is misplaced.

For the foregoing reasons, we determine that Petitioner has shown by a preponderance of the evidence that claim 9 is unpatentable as obvious over Farber and APA.

7. Claim 11

Claim 11 depends directly from claim 1 and further recites: “wherein the mobile communication device is adapted to enable the end-user to select, from the remote information resource, information to be displayed to the end-user such that updated versions of that information are sent automatically to the mobile communication device for display on said idle screen of the mobile communication device.” Petitioner explains how this limitation is met by the combined teachings of Farber and APA. Pet. 26–27.

Petitioner has explained, persuasively, in the context of claim 1 as discussed above, that the mobile communication device enables the end-user to select the remote information resource by way of generating the personalized profile for storage at the service node. Petitioner further explains how the mobile communication device enables the end-user to select the information to be displayed, also by way of generating the personalized profile. *Id.* at 26. Specifically, Petitioner explains that the personalized profile in Farber includes parameters that specify, for a particular user, the exact information desired to be received by and displayed. *Id.* at 19 (citing Ex. 1002, 1:41–47, 6:56–60). Petitioner’s arguments are supported by underlying evidence and are persuasive, notwithstanding the contrary arguments of Patent Owner discussed below.

Patent Owner argues that Farber cannot teach selecting information from any remote information resource because in Farber a user is insulated against any “direct” connection to an information provider. PO Resp. 34. This is essentially the same argument as that we rejected above in the context of claim 1, i.e., that an end-user cannot select a remote information resource because in Farber the end-user is insulated from any “direct” connection to a remote information resource. The argument is unpersuasive because, as discussed above in the context of claim 1, the specification of the ’671 patent expressly regards a user’s indirect selection of a remote information resource as user selection of the remote information resource. Moreover, the personalized user profile in Farber includes user supplied parameters that indicate the exact information desired by the user. Ex. 1002, 1:45–47.

Patent Owner also points to certain testimony of Dr. Rhyne, and asserts that according to that testimony, the limitation of claim 11 cannot be met unless the user profile in Farber is itself sent to the remote information resource. PO Resp. 35. That testimony is as follows:

I think if they defined a profile and sent it to the remote information resource and let the remote information resource know what they wanted, that would be an indirect way of accomplishing Claim 11, at least the first part of Claim 11.

Ex. 2004, 27:2–6. Patent Owner’s characterization of the above-quoted testimony is incorrect. Nothing in the above-quoted testimony indicates that unless the profile is sent to the remote information resource, no part of claim 11 can be met. The testimony indicates only that sending the personalized profile to the remote information resource is one way of meeting claim 11. It does not exclude other ways. Patent Owner’s argument is without merit.

For the foregoing reasons, we determine that Petitioner has established by a preponderance of the evidence that claim 11 is unpatentable as obvious over Farber and APA.

8. Claim 2

Claim 2 depends directly from claim 1 and recites: “The mobile communication device of claim 1 in which the information is from a source selected by the user.” For claim 2, the entirety of Petitioner’s argument is reproduced below:

As described above in the discussion of elements [1b] and [1c], Farber describes enabling the user to select the source of information to be displayed on the idle-screen. For example, Figure 4 of Farber provides an example of a “customized” idle screen displaying the information from the sources “selected by the user and set forth in his or her profile.” (*Id.* at 6:56-62, Fig. 4, Ex. 1004 at ¶ 56.)

Pet. 22. The argument is misplaced and unpersuasive.

As is evident from the above-quoted argument, Petitioner incorrectly regards “source” the same as “remote information resource” or the same as specific “information.” These terms are facially different and Petitioner presents no evidence that they are used interchangeably in the specification of the ’671 patent. There also is ample evidence indicating that remote information resource and source are different from each other. For instance, although different users may commonly select an existing WAP page (remote information resource), they still may want information from different sources.⁶ Ex. 1001, 5:4–7. Also, claim 1 already recites “enable the end-user to select the remote information resource.” It would be redundant for claim 2 to recite that “the information is from a source selected by the user” if remote information resource and source are the same. Thus, by incorrectly regarding “source” the same as “remote information resource,” or the same as specific “information,” Petitioner has not adequately explained how the limitation of claim 2 is met by the combined teachings of Farber and APA.

Even assuming that end-user selection of the remote information resource leads to a default selection of the source of the information, Petitioner still has not established that the limitation of claim 2 is met by the combined teachings of Farber and APA. That is because, as pointed out by Patent Owner, Petitioner’s own expert, Dr. Rhyne, testified that claim 2

⁶ We note that in the context of the ’671 patent, “source” means a place of origin. Ex. 1001, 5:4–7. Where source is used in connection with information contained in a remote information resource, it refers to a place of origin that provided the information to the remote information resource.

requires “direct” selection of a source of information. PO Resp. 21 (citing Ex. 2004, 25:11–18). We note also that the special definition in the specification of the ’671 patent that expressly allows “select” to be either direction selection or indirect selection is for selecting a “remote information resource” and not for selecting “a source.” Ex. 1001, 3:44–54. Petitioner has not pointed to any disclosure in Farber that indicates the end-user directly specifies the source of the desired information.

In its Reply, Petitioner additionally explains that Farber describes that information from multiple information sources are aggregated, reformatted, and stored in the service node, for later access by a user. Reply 17 (citing Ex. 1002, 4:26–29). That does not, however, mean or establish that in Farber the end-user selects the source of information. As is noted above, the broad reading of selecting remote information resource to cover indirect selection does not apply to selecting a “source.”

In its Reply, Petitioner asserts that it is misleading for Patent Owner to characterize Dr. Rhyne’s testimony as admitting that claim 2 requires direct selection. Reply 18. We have read the testimony at issue and note that to the question “And that’s a direct selection, correct?” Dr. Rhyne answered: “I think that’s what Claim 2 says, is that you’re going to pick a source where you’re going to get your information from, yes.” Ex. 2004, 25:11–18. We agree with Patent Owner’s characterization of Dr. Rhyne’s testimony as an admission that claim 2 requires a direct selection by the end-user.

In its Reply, Petitioner notes that in Farber’s Figure 4, the weather at particular cities are displayed. Reply 17–18. But that indicates only that the end-user has selected the specific information content, and not that the end-user has selected the source of the weather information, e.g., the place of

origin that generated the weather report. Similarly, Farber's allowing an end-user to specify in the personalized profile the specific information content desired does not meet the requirement of selecting the "source" for that information.

For reasons discussed above, we determine that Petitioner has not established by a preponderance of the evidence that claim 2 is unpatentable as obvious over Farber and APA.

D. Claims 1–5, 7–12, 15, and 16
as Obvious over Martin, Farber, and APA

We have reviewed the arguments and evidence presented by Petitioner, and determine that, notwithstanding the arguments of Patent Owner, Petitioner has established by a preponderance of the evidence that claims 1, 3–5, 7–12, 15, and 16 are unpatentable as obviousness over Martin, Farber and APA. Petitioner, however, has not established by a preponderance of the evidence that claim 2 is unpatentable as obvious over Martin, Farber, and APA.

Martin discloses a system for displaying content on wireless computing devices during idle times. Ex. 1003, Abstr. For instance, when the wireless device is idle, a browser program is used to display certain information. *Id.* at 1:53–56. That displayed content could be the customer support telephone number of the network operator or advertisements. *Id.* at 1:48–52. Martin states that its system is "[t]o more effectively use the display screen during idle time of wireless communication devices." *Id.* at 1:46–48. In a preferred embodiment, Martin's device is a mobile telephone. *Id.* at 5:1–5. Martin describes: "In one embodiment, each mobile device is given a defined 'idle content' address identifier (URI or URL). The idle

content address identifier provides a link to the content information that the wireless network provider wishes to have displayed on the mobile device during idle time.” *Id.* at 7:39–43. When an idle timer expires, the browser fetches the idle content information addressed by the idle content address identifier from the wireless network and displays that idle content information. *Id.* at 7:60–64. Martin describes that in a different embodiment, “the idle content information addressed by the idle content URL would be pre-fetched by the browser (in the background) during a time the user last operated the browser.” *Id.* at 7:67–8:3.

Although Martin’s idle content is determined by the network operator, that content still may be “user-oriented.” *Id.* at 11:41–47. In that regard, Martin discloses the display of “targeted advertising” based on the specific location of the user. *Id.* at 11:48–49. For example, Martin describes:

When a cellular hand-off occurs, the cellular wireless network will determine the mobile device’s approximate geographic location using the location of new cell area. In this manner, businesses within that cell area can advertise to the remote devices located within that cellular area.

Id. at 11:50–55.

Martin represents an example of the admitted prior art referred to as APA. That which is added by Martin, with respect to generally identified APA, is its discussion of the network operator’s selecting idle content that is user-oriented. Martin’s teaching of user-oriented idle content further strengthens the rationale for combining the teachings of Farber and Martin.

1. Independent Claims 1 and 12

For essentially the same reasons we discussed above in the context of the ground of unpatentability based on Farber and APA, Petitioner has

established by a preponderance of the evidence that claims 1 and 12 are unpatentable as obvious over Martin, Farber, and APA.

With respect to Martin, Patent Owner argues that the idle content address identifier provided by the network provider to the mobile communication device for the mobile communication device to use in fetching idle content information is determined by the network provider and not by the end-user. PO Resp. 42–44. The argument is ineffective in the circumstance here, where Martin represents an example of the admitted prior art and it is Farber’s methodology that is applied to a mobile telephone.

2. Independent claims 15 and 16

Petitioner states that claim 15 contains the same substantive limitations as claim 1 and is rendered obvious by Martin and Farber for the same reasons. Pet. 45. Petitioner also states that claim 16 is essentially identical to claim 15, except that it is a method claim. Pet. 46. Petitioner further states that claim 16 contains the same substantive limitations as claim 1 and is rendered obvious by Martin and Farber for the same reasons. *Id.*

The only argument Patent Owner advances for claims 15 and 16 is that Petitioner “assumes that claims 15 and 16 contain the same substantive limitations as claim 1, and merely refer[s] back to the analysis of claim 1.” PO Resp. 44. Patent Owner asserts that “all of the independent claims of the ’671 patent do not contain the same substantive limitations.” *Id.* at 45.

We already addressed above, in the context of the ground of unpatentability based on Farber and APA, whether claims 15 and 16 would have been rendered unpatentable by the same arguments and evidence Petitioner presented specifically for claim 1 and include only by reference for claims 15 and 16. We determined the issue affirmatively for Petitioner.

The same determination applies here in the context of the ground of unpatentability based on Martin, Farber, and APA.

We are persuaded by Petitioner that claims 15 and 16 are each of essentially the same scope as claim 1 in the sense that the subject matter of claim 1 is encompassed by the subject matter of each of claims 15 and 16. Consequently, the analysis Petitioner provided for claim 1 also applies to claims 15 and 16, with persuasion, and need not be expressly reiterated. We are persuaded by Petitioner's analysis, by a preponderance of the evidence.

Petitioner has shown by a preponderance of the evidence, based on its analysis of claim 1, made applicable to claims 15 and 16 by reference, that claims 15 and 16 are unpatentable as obvious over Martin, Farber and APA.

3. Dependent Claims 3–5, 7, 8, and 10

For essentially the same reasons we discussed above in the context of the ground of unpatentability based on Farber and APA, Petitioner has established by a preponderance of the evidence that claims 3–5, 7, 8, and 10 are unpatentable as obvious over Martin, Farber, and APA.

With respect to claim 5, Petitioner has strengthened its assertions of obviousness based on Farber and APA by noting additional disclosures in Martin. In that regard, we have considered Martin as a specific example of the APA. Claim 5 reads: “The mobile communication device of claim 4 in which there are hyperlinks in the updated information shown in the idle screen which are capable of being navigated to and selected by the user.” Petitioner identifies Martin's disclosure of providing the user a hyperlink on the idle screen to access the user's messages when the idle screen displays a notification that the user has email messages. Pet. 39 (citing Ex. 1003, 8:7–42, 9:60–10:32). Petitioner further identifies Martin's disclosure of

providing the user a hyperlink on the idle screen to respond to advertising information when the idle screen displays advertising. *Id.* We agree with Petitioner's reading of Martin's disclosure.

4. Dependent Claim 9

Claim 9 reads: "The mobile communication device of claim 1 in which multiple information resources are used with different priority settings." As discussed above, Farber and APA already render obvious claim 9. For essentially the same reasons discussed above in the context of the ground of unpatentability based on Farber and APA, Petitioner has established by a preponderance of the evidence that claim 9 is unpatentable as obvious over Martin, Farber, and APA. The addition of Martin does not add or take away from the analysis based solely on Farber and APA.

Petitioner further relies on Martin's displaying on an idle screen how many email messages the user has received and whether each message was marked urgent by the sender for satisfying the added limitation of claim 9. Pet. 41–42. However, it is usage of the different resources that must be prioritized, and that is not met by using one resource, i.e., email resource, and indicating whether some email messages are more or less important than others. Even if each email message is regarded as a remote information resource, the limitation still is not met, because Martin's email alert does not prioritize display of urgent email messages over non-urgent email messages.

Petitioner further relies on disclosure in Martin about a timer setting for "looping" idle content, i.e., setting the amount of time a particular idle content stays on the idle screen before displaying another idle content. Pet. 42 (citing Ex. 1003, 9:60–10:32). Dr. Rhyne testifies that in the disclosed embodiment, the timer setting is made the same for all types of

idle content. Ex. 1004 ¶ 98. Dr. Rhyne testifies, however, that it would have been obvious to one with ordinary skill in the art to use remote information resources with different priority settings. *Id.* The testimony is inadequately explained, and unpersuasive. First, as is noted by Patent Owner (PO Resp. 33), there is only a single remote information resource in Martin, the one selected by the network provider. Second, the disclosed timer setting in Martin is for particular idle content, and not for a remote information resource. Petitioner's argument has not accounted for that difference.

Nevertheless, no teaching from Martin is required to render claim 9 unpatentable over Martin, Farber, and APA, because claim 9 already is unpatentable over Farber and APA as discussed above. We determine that Petitioner has established by a preponderance of the evidence that claim 9 is unpatentable as obvious over Martin, Farber, and APA.

5. Dependent Claim 11

Claim 11 depends from claim 1 and further recites: “wherein the mobile communication device is adapted to enable the end-user to select, from the remote information resource, information to be displayed to the end-user such that updated versions of that information are sent automatically to the mobile communication device for display on said idle screen of the mobile communication device.” As applied by Petitioner, Martin adds nothing to the combination of Farber and APA as discussed above in the analysis of claim 11 over Farber and APA. Pet. 43–44.

Patent Owner argues that in Martin it is the network provider, not the end-user, who is selecting the information from the remote information resource. PO Resp. 36. The argument is misplaced, because Petitioner is

relying on the methodology described in Farber to meet this selecting limitation. *See* Pet. 43–44. For essentially the same reasons we discussed above in the alleged ground of unpatentability against claim 11 based on Farber and APA, Petitioner has established by a preponderance of the evidence that claim 11 is unpatentable as obvious over Martin, Farber, and APA.

6. Dependent Claim 2

Claim 2 depends directly from claim 1 and recites: “The mobile communication device of claim 1 in which the information is from a source selected by the user.” As in the case of alleged obviousness of claim 2 over Farber and APA discussed above, Petitioner incorrectly regards “source” the same as “remote information resource” or specific “information.” Pet. 31–35, 37. In Martin, the idle content address identifier (URL) supplied by the network provider to the end-user’s mobile device represents merely the remote information resource, and not the “source” of the information within the remote information resource. Also, as is noted by Patent Owner (PO Resp. 28), there is no explanation by the Petitioner how the end-user in Martin has any choice in selecting the URL, given that it is provided to the user’s mobile device by the network provider.

In its Reply, Petitioner identifies additional disclosure in Martin purportedly showing user selection of the “source” of information. PO Resp. 14–15, 19. Specifically, the additional disclosure identified by Petitioner from Martin pertains to an embodiment of Martin that allows interaction between the user and the idle content that is displayed. In that embodiment, the idle content being displayed includes links for the user to obtain more information about a particular product or service. Ex. 1003,

8:57–64. In that regard, Petitioner argues in the Reply: “Both when [further] selecting a link to obtain more information about a specific advertisement, and when selecting a link to obtain email messages, a user is directly selecting the source of the information.” Reply 19.

First, this additional argument was not presented in the Petition. Rather, it is belatedly presented in the Reply. *Cf. Dell Inc. v. Acceleron, LLC*, 818 F.3d 1293, 1297 (Fed. Cir. 2016) (addressing new argument presented at oral hearing). The argument is one Petitioner should have presented in the Petition, as it presents how the reference is applied to meet a claim limitation. Patent Owner did not have an opportunity to respond. *See* 37 C.F.R. § 42.23(b) (“A reply may only respond to arguments raised in the corresponding opposition or patent owner response”); Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions; Final Rule, 77 Fed. Reg. 48,612, 48,620 (Aug. 14, 2012) (“Oppositions and replies may rely upon appropriate evidence to support the positions asserted. Reply evidence, however, must be responsive and not merely new evidence that could have been presented earlier to support the movant’s motion.”). “Respond,” in the context of 37 C.F.R. § 42.23(b), does not mean embark in a new direction with a new approach as compared to the position originally taken in the Petition. Accepting such belatedly presented new arguments would be unjust to the Patent Owner and we decline to do so.

Second, the argument is ambiguous in that Petitioner does not articulate for that interactive embodiment of Martin what is the remote information resource, what is the information in the remote information resource, and what is the source of the information in the remote information

resource. Third, even if the focus is shifted to how Martin discloses user selection, Martin still does not disclose end-user selection of the remote information resource, which is a limitation incorporated into dependent claim 2 from base claim 1. Patent Owner is correct that in Martin the idle information content identifier URL is supplied to the user from the network provider. Specifically, Martin states: “[E]ach mobile device is given a defined ‘idle content’ address identifier (URI or URL). The idle content address identifier provides a link to the content information that the wireless network provider wishes to have displayed on the mobile device during idle time.” Ex. 1003, 7:39–43. In the context of the ’671 patent, it is unreasonable to regard Martin’s idle content address identifier as a remote information resource selected by the end-user.

For reasons essentially the same as that discussed above in the ground of unpatentability against claim 2 based on Farber and APA, Petitioner has not established by a preponderance of the evidence that claim 2 is unpatentable as obvious over Martin, Farber, and APA.

III. CONCLUSION

Petitioner has shown, by a preponderance of the evidence, that claims 1, 3–5, 7–12, 15, and 16 are unpatentable under 35 U.S.C. § 103 as obvious over Farber and APA.

Petitioner has not shown, by a preponderance of the evidence, that claim 2 is unpatentable under 35 U.S.C. § 103 as obvious over Farber and APA.

Petitioner has shown, by a preponderance of the evidence, that claims 1, 3–5, 7–12, 15, and 16 are unpatentable under 35 U.S.C. § 103 as obvious over Martin, Farber, and APA.

Petitioner has not shown, by a preponderance of the evidence, that claim 2 is unpatentable under 35 U.S.C. § 103 as obvious over Martin, Farber, and APA.

IV. ORDER

It is

ORDERED that claims 1, 3–5, 7–12, 15, and 16 of the '671 patent are unpatentable; and

FURTHER ORDERED that, because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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