

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ONE WORLD TECHNOLOGIES, INC.
d/b/a TECHTRONIC INDUSTRIES POWER EQUIPMENT,
Petitioner,

v.

THE CHAMBERLAIN GROUP, INC.,
Patent Owner.

Case IPR2017-01132
Patent 6,998,977 B2

Before JONI Y. CHANG, JUSTIN T. ARBES, and
JON M. JURGOVAN, *Administrative Patent Judges*.

CHANG, *Administrative Patent Judge*.

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

I. INTRODUCTION

One World Technologies, Inc. d/b/a Techtronic Industries Power Equipment (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 12–21 (“the challenged claims”) of U.S. Patent No. 6,998,977 B2 (Ex. 1001, “the ’977 patent”) and a Declaration of Stuart Lipoff (Ex. 1008). Paper 2 (“Pet.”). The Chamberlain Group, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Upon consideration of the Petition and Preliminary Response, we instituted the instant *inter partes* review as to all of the challenged claims for all of the grounds of unpatentability presented in the Petition. Paper 7 (“Dec.”).

Subsequent to institution, Patent Owner filed a Response (Paper 10, “PO Resp.”) and a Declaration of Nathaniel J. Davis IV, Ph.D. (Ex. 2001). Petitioner filed a Reply (Paper 16, “Reply”) and a second Declaration of Mr. Lipoff (Ex. 1014). A combined oral hearing with Case IPR2017-01137 was held on June 14, 2018, and a transcript has been entered into the record as Paper 27 (“Tr.”).

This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a). For the reasons that follow, Petitioner has demonstrated by a preponderance of the evidence that claims 12–21 of the ’977 patent are unpatentable.

A. Related Matters

Petitioner also challenges claims 1–11 and 22–25 of the ’977 patent in Case IPR2017-01137. Petitioner indicates that the ’977 patent has not been asserted against Petitioner. Pet. 1. Petitioner also identifies other related proceedings—e.g., U.S. Patent Nos. 7,224,275 and 7,635,966 are involved in

The Chamberlain Group, Inc. v. Techtronic Industries Co. Ltd., Case No. 1:16-cv-06097 (N.D. Ill.). *Id.* at 1–2.

B. The '977 Patent

The '977 patent describes a method and an apparatus for monitoring a movable barrier (e.g., a garage door) over a network. Ex. 1001, 1:12–15.

Figure 3 of the '977 patent is reproduced below with color highlighting added by Petitioner (Pet. 5).

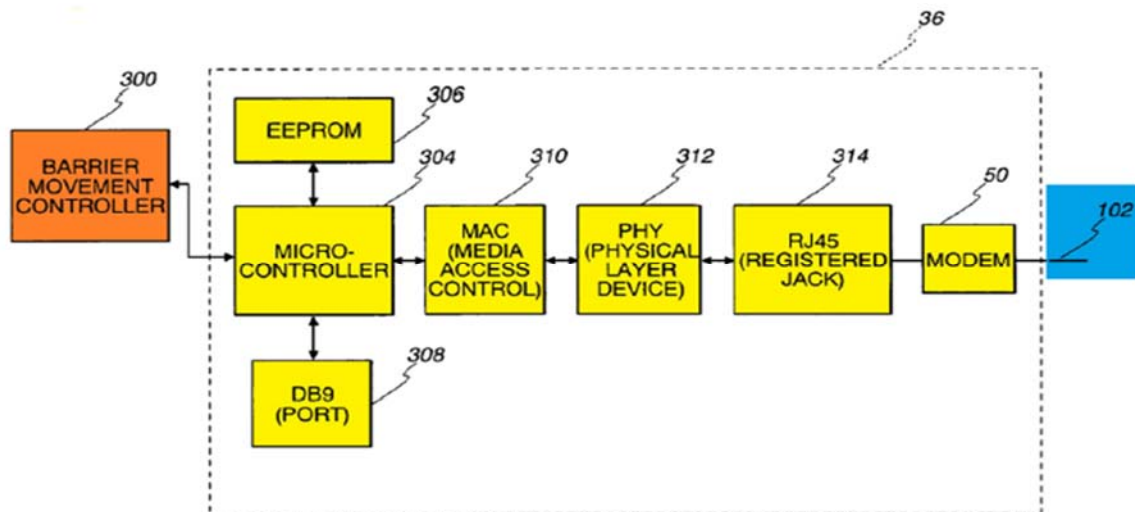


Figure 3 above illustrates a block diagram of a garage door operator connected to network 102. Ex. 1001, 3:36–43. Barrier movement controller 300 (in orange) controls the movement and/or position of the barrier (e.g., garage door). *Id.* at 3:9–12. Network interface 36 is connected to network 102 and coupled to controller 300, which provides network interface 36 with information regarding the status of the garage door operator, allowing an individual to receive the status of the garage door through network 102. *Id.* at 3:20–35. Network interface 36 includes micro-controller 304, electrically

erasable programmable read-only memory (EEPROM) 306, port 308, media access control layer 310, physical layer device 312, jack 314, and modem 50. *Id.* at 3:48–51, Fig. 3.

C. Illustrative Claim

Of the challenged claims, claim 12 is independent. Claims 13–21 depend, indirectly or directly, from claim 12. Claim 12 is illustrative:

12. A method for checking the status of a movable barrier comprising the steps of:

receiving from a network client over a network, a status request for a movable barrier;

determining a status of the movable barrier;

sending a status of the movable barrier over the network to the network client in response to the status request and;

wherein the movable barrier comprises a barrier movement operator for controlling the movement of the barrier and the method comprises receiving a status change request from the network client and controlling movement of the barrier in response to the status change request.

Ex. 1001, 5:38–6:4.

D. Prior Art Relied Upon

Petitioner relies upon the references listed below.

Menard	US 2002/0183008 A1	Dec. 5, 2002	(Ex. 1003)
Lee	US 5,475,377	Dec. 12, 1995	(Ex. 1007)

E. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability (Pet. 2–3)¹:

Claims	Basis	Reference(s)
12–21	§§ 102(a), 102(e)(1)	Menard
13 and 21	§ 103(a)	Menard and Lee

II. DISCUSSION

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b). “Under a broadest reasonable interpretation, words of the claim must be given their plain meaning, unless such meaning is inconsistent with the specification and prosecution history.” *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1062 (Fed. Cir. 2016).

The parties propose constructions for several claim terms. Pet. 6–14; Prelim. Resp. 2–3. Upon review of the parties’ contentions, we addressed two claim terms identified by the parties in our Institution Decision. Dec.

¹ Because the claims at issue have a filing date prior to March 16, 2013, the effective date of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), we apply the pre-AIA versions of 35 U.S.C. §§ 102 and 103 in this Decision.

5–7. After institution, neither party challenges any aspect of our claim constructions. Based on the entire record presented during trial, we discern no reason to modify our analysis or claim constructions of those claim terms in this Final Written Decision. Our claim construction analysis from the Institution Decision is reproduced in substance below in Sections II.A.1–2.

1. “*status of the movable barrier*”

Claim 12 recites “determining a status of the movable barrier.” Ex. 1001, 5:42. Petitioner asserts that the term “status of the movable barrier” should be construed as the state of the moveable barrier (e.g., whether a door is open or closed). Pet. 7. Petitioner argues that the Specification supports this construction as it discloses that, “[i]n order to check the status of the movable barrier[,] the user would go look at the movable barrier to see if it was open or closed.” *Id.* (citing Ex. 1001, 1:26–28) (emphasis omitted). Petitioner further notes claims 15 and 16 recite “wherein the status of the movable barrier is open,” and “wherein the status of the movable barrier is closed,” respectively. *Id.* at 7–8; Ex. 1001, 6:11–14.

Patent Owner does not dispute Petitioner’s proposed claim construction as to this term. *See* Prelim. Resp. 2–3; PO Resp. 2. In light of the Specification including the dependent claims, we agree with and adopt Petitioner’s claim construction, construing “status of the movable barrier” as “the state of the moveable barrier (e.g., whether a door is open or closed).”

2. “*barrier movement operator for controlling movement of a movable barrier*”

Claim 12 recites “a barrier movement operator for controlling the movement of the barrier.” Ex. 1001, 5:45–6:1. Petitioner asserts that, apart from the claim, the Specification does not use the claim term “barrier movement operator,” but rather “movable barrier operator,” which is described as a garage door operator. Pet. 9–10. Petitioner also alleges that the claim term “barrier movement operator” should be construed as a “device that moves a barrier, such as a garage door.” *Id.*

Patent Owner argues that the claim term does not require construction. *See* Prelim. Resp. 2–3; PO Resp. 2. The parties also agree that the term is *not* a means-plus-function limitation under 35 U.S.C. § 112, sixth paragraph. *See* Pet. 9; Prelim. Resp. 2–3; PO Resp. 2. In light of the Specification, we adopt Petitioner’s proposed claim construction, construing “barrier movement operator” as a “device that moves a barrier, such as a garage door.”

3. “*network*”

Claim 12 recites “receiving from a network client *over a network*, a status request for a movable barrier,” and “sending a status of the movable barrier *over the network* to the network client in response to the status request.” Ex. 1001, 5:40–45 (emphases added).

Although Patent Owner, in its Response discussing the construction of the terms, “submits that no construction is necessary for any claim term, and asks that the plain language of the claims be given its broadest reasonable

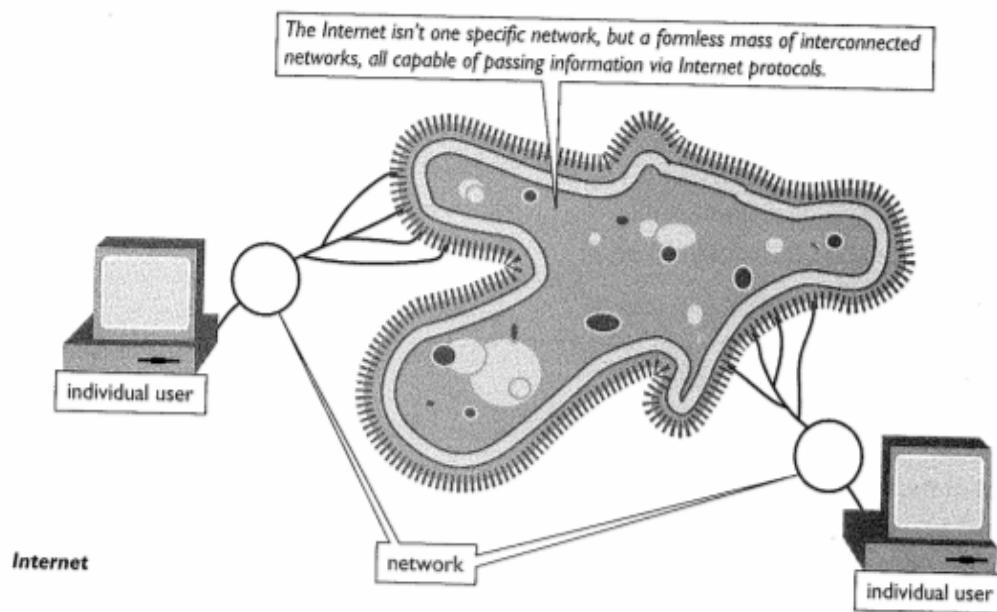
interpretation,” Patent Owner nevertheless argues, in its Response discussing the prior art, that claim 12 “requires that the status request be received *over a network from a network client*, and the status be sent *over the same network to the network client* in response to the status request.” *Compare* PO Resp. 2, 4–5, with *id.* at 14–15 (emphases in original).

Petitioner counters that the claims do not require a single network, but rather permit multiple networks to be used. Reply 17–21. Petitioner also argues that, in any event, Menard discloses an example of a single network client on a single network requesting and receiving a garage door position status, and controlling the door. *Id.*

We agree with Petitioner that claim 12 does not require a single network. As the Federal Circuit has explained, “an indefinite article ‘a’ or ‘an’ in patent parlance carries the meaning of ‘one or more’ in open-ended claims containing the transitional phrase ‘comprising.’” *Baldwin Graphic Systems, Inc. v. Siebert*, 512 F.3d 1338, 1342 (Fed. Cir. 2008) (internal quotation marks and citations omitted). “The subsequent use of definite articles ‘the’ or ‘said’ in a claim to refer back to the same claim term does not change the general plural rule, but simply reinvokes that non-singular meaning.” *Id.* An exception to this general rule “only arises where the language of the claims themselves, the specification, or the prosecution history necessitate[s] a departure from the rule.” *Id.* at 1342–43.

Here, the Specification of the ’977 patent discloses that “[t]he network interface 36 is connected to *a network 102, e.g., the internet*, which allows an individual to connect to the network interface 36 over the network 102

and receive the status of the garage door 12.” Ex. 1001, 3:26–30 (emphasis added). Petitioner notes that, as of the priority date of the ’977 patent, the term “Internet” encompassed a plurality of networks, citing to several dictionary definitions for support. Reply 19 n.12 (citing Ex. 1014 ¶¶ 50–51; Ex. 1021, 354; Ex. 1022, 579; Ex. 1026, 97²). For example, The Internet Dictionary (1995) defines the “Internet” as “[a]n international network of well over ten thousand networks linked using the TCP/IP protocols (see illustration, next page).” Ex. 1026, 97. The Illustration is reproduced below (*id.* at 98).



The Illustration shows that “[t]he Internet isn’t one specific network, but a formless mass of interconnected networks, all capable of passing

² The citations are referring to the original page numbers, not the page numbers added by Petitioner.

information via Internet protocols.” *Id.* As another example, the Webster’s II New College Dictionary (1995) defines the “Internet” as “[a]n interconnected system of networks that connects computers around the world via the TCP/IP protocol.” Ex. 1022, 579.

At the oral hearing, both parties agreed that the claimed “network” can comprise multiple networks because, as disclosed in the ’977 patent, at the time of the invention, the Internet included many networks connected together. Tr. 26:3–12 (Petitioner noted “the ’977 patent . . . shows that the network interface is connected to multiple networks, not to a single network,” and “that it’s connected to a cable or DSL line which then in turn is connected to the internet”), 48:15–25 (Patent Owner explained “you could use multiple networks in a bridging context, so one network bridges to another network that bridges to another network . . . [and] they collectively act as a network”). Patent Owner further clarified that the claimed “network” can comprise multiple networks connected together acting collectively as a single network, such as a cellular phone network connected to the Internet to establish a communication channel between a cellular phone and the system for the garage door opener. *Id.* at 49:8–51:6.

Upon consideration, in light of the Specification of the ’977 patent, we interpret a “network” as recited in claim 12 to mean “a single network or a plurality of networks connected together acting individually or collectively to allow communication between a communication device and a system.” We also agree with Patent Owner that claim 12 “requires that the status request be received *over a network from a network client*, and the status be

sent over the same network(s) to the network client in response to the status request,” because the subsequent usages of definite article “the” refer back to the same “network client” and “network.” See PO Resp. 2, 4–5, 14–15 (emphases in original). To illustrate, as just one example, if “a network” were the Internet, “the network” would also refer to the Internet.

4. “computer”

Claim 17 recites “wherein the network client is a computer.” Ex. 1001, 6:15–16. Patent Owner asserts that the term “computer” should be interpreted as a “personal computer” because the ’977 patent consistently describes and refers to a “computer” as a device distinct from other devices, such as a PDA or cellular telephone. PO Resp. 21–22.

However, Patent Owner’s proposed claim construction, interpreting “computer” as “personal computer,” would improperly import a limitation from a preferred embodiment or specific example into the claims. See *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (limitations are not to be read from the specification into the claims). Our reviewing court “has repeatedly cautioned against limiting the claimed invention to preferred embodiments or specific examples in the specification.” *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1346–47 (Fed. Cir. 2015) (citations and quotation marks omitted); *SuperGuide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004) (noting that “it is important not to import into claim limitations that are not a part of the claim”). Moreover, Dr. Davis conceded during his cross-examination that the term “computer” as used in the ’977 patent is broader than the term “personal computer.” Ex. 1015,

87:3–7 (stating that “if you look at all of the devices back in column 2 [of the ’977 patent], a cellular phone, a personal computer, a PDA, at some level, they’re all a computer”). Thus, we decline to adopt Patent Owner’s narrow construction, and conclude that no further construction of “computer” is necessary.

B. Principles of Law

To establish anticipation, each and every element in a claim, arranged as recited in the claim, must be found in a single prior art reference. *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008). There is no requirement that the prior art must use the same words to describe a claim element in order to be deemed as teaching or disclosing that claim element. Identity of terminology is not required, for a claim element to be met directly by the prior art, without resort to obviousness. *See In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009); *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990). Even in a non-obviousness setting, it is proper to take into account not only the literal and specific teachings of the reference, but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826 (CCPA 1968). For anticipation, the dispositive question is whether one skilled in the art would reasonably understand or infer from a prior art reference that every claim element is disclosed in that reference. *Eli Lilly v. Los Angeles Biomedical Res. Inst.*, 849 F.3d 1073, 1074–75 (Fed. Cir. 2017).

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness.³ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

C. Level of Ordinary Skill in the Art

In determining the level of ordinary skill in the art, various factors may be considered, including the “type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.” *In re GPAC, Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (citation omitted). Mr. Lipoff testifies that a person with ordinary skill in the art “would have had at least an undergraduate degree in electrical engineering, or equivalent education, and one to two years of work experience in the fields of: (i) network communication systems; (ii) systems for access control or automated door systems; or (iii) equivalent work

³ Neither party presents objective evidence of nonobviousness in this trial.

experience or training.” Ex. 1008 ¶ 30. Patent Owner does not dispute Mr. Lipoff’s assessment regarding the level of ordinary skill in the art. *See generally* PO Resp. Based on the record before us, we agree with and apply Mr. Lipoff’s assessment regarding the general knowledge of a person with ordinary skill in the art. We further note that the prior art of record in the instant proceeding reflects the appropriate level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1354–55 (Fed. Cir. 2001) (“the prior art itself reflects an appropriate level” of ordinary skill in the art).

D. Anticipation by Menard

Petitioner asserts that claims 12–21 are unpatentable under 35 U.S.C. §§ 102(a) and (e) as anticipated by Menard. Pet. 2–3, 15–53. To support its contentions, Petitioner directs our attention to Mr. Lipoff’s Declaration. Ex. 1008. Citing Dr. Davis’ Declaration for support, Patent Owner counters that Menard does not describe certain claim limitations. PO Resp. 2–29.

For the reasons provided below, we determine that Petitioner has demonstrated by a preponderance of the evidence that claims 12–21 are anticipated by Menard. We begin our discussion with a brief summary of Menard, and then we address the relevant contentions advanced by the parties in turn.

Menard

Menard describes a wireless system for controlling and monitoring a power door. Ex. 1003 ¶ 1. Figure 1 of Menard illustrates a garage door opener, and is reproduced below.

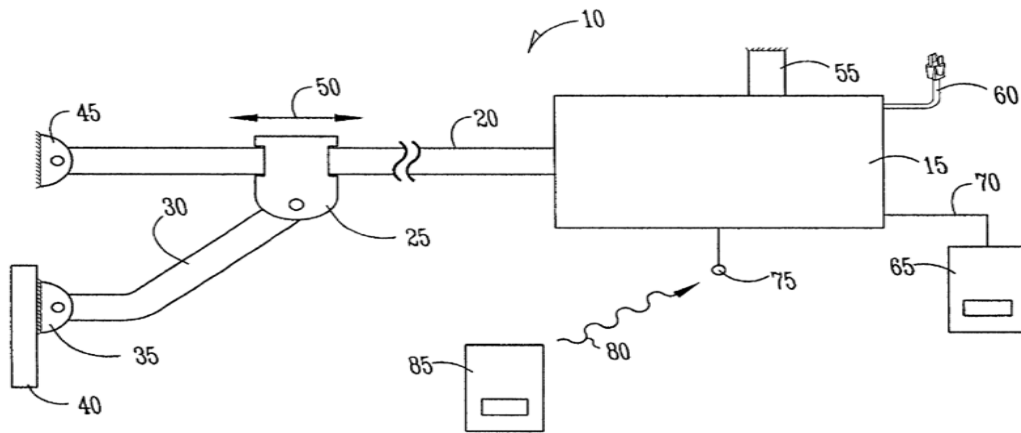


Fig. 1

Figure 1 of Menard shows garage door opener system 10 that includes power unit 15 that has an electric motor to open and close garage door 40. Ex. 1003 ¶¶ 4, 5. Power unit 15 can be operated by using switch 65 or remote control 85. *Id.* ¶¶ 6–7.

Menard discloses a system and a method that allow remote control and management of a single door opener or multiple door openers using a wired or wireless communication device, including a cellular telephone, a pager, a personal digital assistant, a computer, or other device that communicates using a network. *Id.* ¶ 9. The door opener system includes a processor executing programming, a position sensor, and a wireless transceiver that communicates using both a long range communication protocol and a short range communication protocol, allowing a user to control and manage the door opener remotely. *Id.* ¶ 10. The door opener receives commands and transmits status information using either or both of the long range and short range protocols. *Id.* The communication link provides a channel for communicating information from the door opener to

the device and for communicating instructions from the device to the door opener. *Id.* For example, the long distance network may include a two-way pager network, “enabling bidirectional communication” with a user controlled pager. *Id.* ¶ 44.

Figure 2 of Menard is reproduced below.

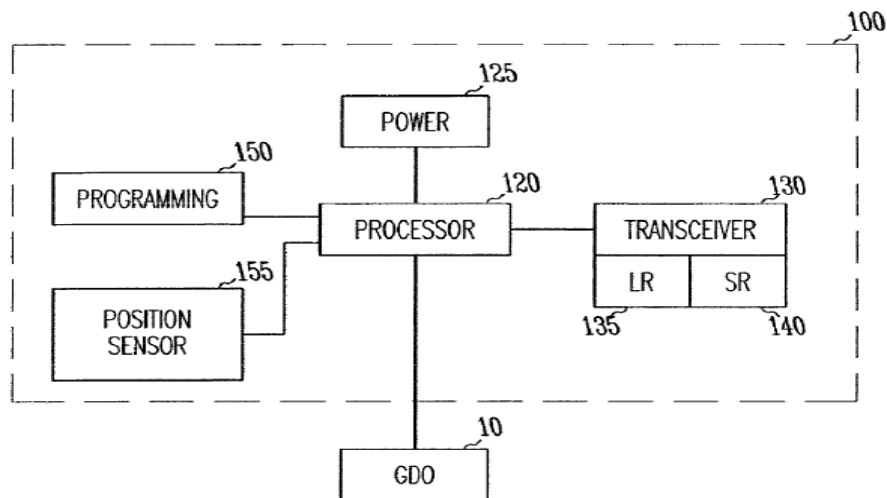


Figure 2 of Menard “illustrates a block diagram of one embodiment of the present system.” *Id.* ¶ 13. As shown in Figure 2 of Menard, system 100 is connected to garage door opener (“GDO”) 10. System 100 includes processor 120, programming 150, position sensor 155, and transceiver 130. *Id.* ¶¶ 21–26. Processor 120 may include a microprocessor and memory to perform the programmed functions and to retain settings and configuration information. *Id.* ¶ 23. Position sensor 155 is coupled to processor 120, and provides an electrical signal corresponding to the position of the door. *Id.* ¶¶ 30, 69 (disclosing that “sensor 155 provides the position information to processor 120”).

Transceiver 130 may be compatible with more than two communication protocols. *Id.* ¶ 47. For example, transceiver 130 may be compatible with three protocols, such as a cellular telephone communication protocol, a two-way pager communication protocol, and Bluetooth protocol. *Id.* In such a case, the garage door opener may be operable using a cellular telephone, a two-way pager, or a device compatible with Bluetooth. *Id.*

Figure 7 of Menard “illustrates one embodiment of programming in accordance with one embodiment of the present system” and is reproduced below. *Id.* ¶ 18.

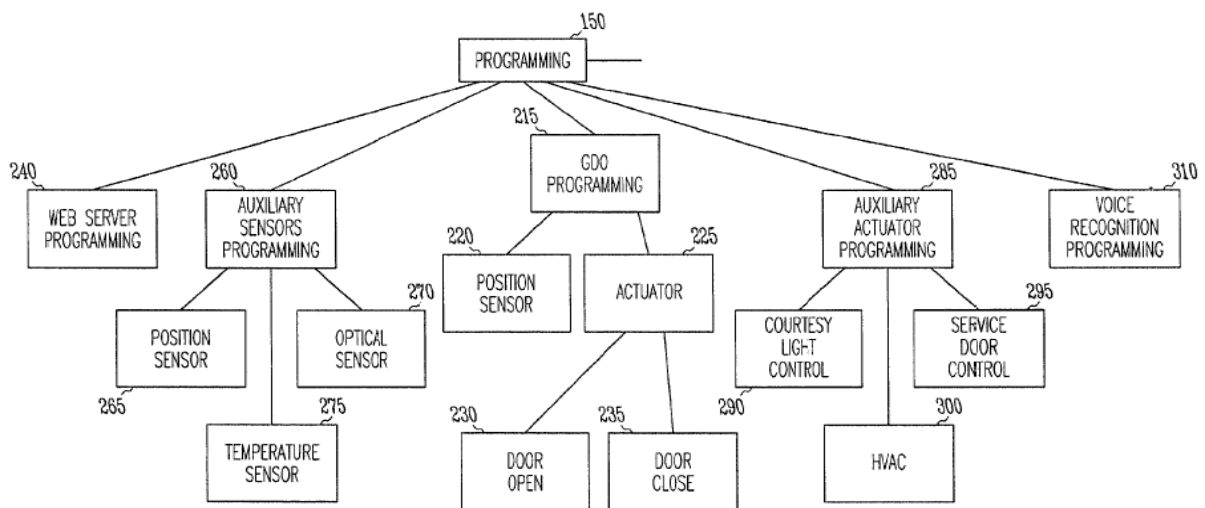


Fig. 7

As shown in Figure 7 of Menard, programming 150 has various features: web server programming 240, auxiliary sensors programming 260, GDO programming 215, auxiliary actuator programming 285, and voice recognition programming 310. *Id.* ¶ 58. For example, web server programming 240 provides an interface to allow remote control of system 100. *Id.* ¶ 59. The wireless application protocol (WAP) server of web

server programming 240 is coupled to a communication network to allow a user to operate, program, and monitor system 100. *Id.* The WAP server generates data that can be accessed using an Internet browser. *Id.*

Auxiliary sensors programming 260 includes position sensor programming 265 that receives and interprets position information derived from door position sensor 165. *Id.* ¶ 60. GDO programming 215 includes position sensor programming 220 and actuator programming 225 that includes door open programming 230 and door close programming 235 for opening or closing garage door 40 in response to commands received by processor 120. *Id.* ¶ 61.

Claims 12, 15, and 16

1. Checking the status of a movable barrier (e.g., the position of a door)

The preamble of claim 12 recites “[a] method for checking the status of a movable barrier.”⁴ Ex. 1001, 5:38–39. In addition, claim 15 further recites “wherein the status of the movable barrier is *open*,” and claim 16 further recites “wherein the status of the movable barrier is *closed*.” *Id.* at 6:11–14 (emphases added).

Petitioner explains in detail how Menard describes each of these limitations, citing to Mr. Lipoff’s Declaration for support. Pet. 15–16,

⁴ The parties do not dispute that the language appearing in the preamble is a claim limitation. Pet. 15–16; see *generally* PO Resp. We proceed on the assumption that the preamble of claim 12 is a limitation.

35–37 (citing Ex. 1008). Specifically, Petitioner notes Menard discloses a method that “allows remote control and management of single or multiple *door openers* using a wired or wireless communication device.” *Id.* at 15–16 (citing Ex. 1003 ¶ 9) (emphasis added by Petitioner). Petitioner explains Menard describes a method for checking the status (the position of a door) of a movable barrier (a door). *Id.* at 16 (citing Ex. 1003 ¶ 69). As shown in step 365 of Figure 8 of Menard, “door position information is received by the user,” who has a wireless device capable of communicating with transceiver 130 of system 100. Ex. 1003 ¶ 69, Fig. 8.

Based on the evidence of record, we determine Petitioner has established that Menard discloses a “method for checking the status of a movable barrier,” as recited in the preamble of claim 12. Patent Owner does not dispute Petitioner’s showing as to this limitation. *See generally* PO Resp.

As to the limitations expressly recited in claims 15 and 16, Petitioner notes “power unit 15 drives door 40 to an open position if door 40 [is] *closed*, and to a closed position if *open*” in Menard. Pet. 35–37 (citing Ex. 1003 ¶ 6) (emphases added by Petitioner). Menard discloses that position “sensor 155 includes a first magnetic switch to detect door 40 in an *open* position and second magnetic switch to detect door 40 in a *closed* position.” Ex. 1003 ¶ 30 (emphases added). At step 370 of Figure 8 in Menard, “the user receives notification of the door position information.” *Id.* ¶ 69, Fig. 8. Menard explains that “[t]he door position may be indicated by a pair of lights on a pager (one light labeled ‘open’ and another ‘close’),

by a graphical image on a screen, a recognizable audio tone, a recognizable vibration, or any other means of indicating position to a user.” *Id.*

Upon consideration of Petitioner’s contentions and supporting evidence, we determine Petitioner has demonstrated that Menard discloses “wherein the status of the movable barrier is open,” as recited in claim 15, and “wherein the status of the movable barrier is closed,” as recited in claim 16. Patent Owner does not dispute Petitioner’s assertions and supporting evidence as to these limitations. *See generally* PO Resp.

2. Status request from a network client over a network

Claim 12 recites (1) “receiving from a network client over a network, a status request for a movable barrier”; (2) “determining a status of the movable barrier”; and (3) “sending a status of the movable barrier over the network to the network client in response to the status request.” Ex. 1001, 5:38–45.

Petitioner’s contentions

Petitioner explains in detail how Menard describes each of these limitations. Pet. 16–24, 37–39. As to the limitation “receiving from a network client over a network, a status request for a movable barrier,” Petitioner first points out that transceiver 130 of system 100, as shown in Figure 2 of Menard, is coupled to a short range network via short-range transceiver 140 and a long range network via long range transceiver 135. *Id.* at 17–18 (citing Ex. 1003 ¶ 21, 26–28, Figs. 2–4). For example, “the long distance network may include a telephone network . . . [that] may include

communicating using an intranet or the Internet.” Ex. 1003 ¶ 44. Mr. Lipoff testifies an ordinarily skilled artisan would have understood that Menard thus discloses connecting to a “network,” as recited in claim 12. Ex. 1008 ¶¶ 74–75.

Petitioner also explains that Menard discloses various types of network client, including a pager, a computer, a personal digital assistant, and a cellular telephone. Pet. 18–19. Petitioner notes Menard discloses a method that “allows remote control and management of single or multiple door openers using a wired or wireless communication device,” including “a cellular telephone, a pager, a personal digital assistant, a computer or other device that communicates using a network.” *Id.* at 16–19, 23, 37–39 (emphasis omitted); Ex. 1003 ¶ 9; Ex. 1008 ¶¶ 77, 145–162. Menard further discloses that “a user may communicate with system 100 using a telephone coupled to the public switched telephone network (PSTN), a cellular telephone, a pager (either one way or two way), a personal communication device (such as a personal digital assistant, PDA), a computer, or other wired or wireless communication device.” Ex. 1003 ¶ 29. Having reviewed the evidence in the entire trial record, we are persuaded that Menard discloses a “network client,” as recited in claim 12.

Furthermore, Petitioner argues that Menard discloses receiving status requests from the network clients. Pet. 19–20. Petitioner notes Menard discloses, for example, “system 100 provides a pager signal to indicate the position of the door or any other information relative to the garage or the door opener.” Ex. 1003 ¶ 50. Menard explains “[u]sing a two way pager,

the user may operate the door opener, or operate an actuator, using the reply communication channel of the pager,” and “[t]he outbound signal (e.g., indicating the door position) may be transmitted to the pager on a predetermined schedule, or *upon inquiry*, or upon a change of position of the door (or actuator) at any time.” *Id.* (emphasis added). Mr. Lipoff explains that an ordinarily skilled artisan would have understood from this disclosure that an “inquiry” is another word for a “status request,” i.e., a request from the user of the device for the status of the garage door. Ex. 1008 ¶ 78. Mr. Lipoff testifies such an artisan would have recognized that Menard discloses receiving the status request from the network client, and responding to this request by sending the door position status (e.g., open or closed) to the network client. *Id.* ¶¶ 78–79.

Having considered the evidence in this entire trial record, we credit Mr. Lipoff’s testimony as it is consistent with Menard’s disclosure (e.g., Ex. 1003 ¶¶ 9–11, 29, 50, 69). We determine Petitioner has shown sufficiently that Menard discloses “receiving from a network client over a network, a status request for a movable barrier,” as recited in claim 12. We address Patent Owner’s arguments regarding this limitation in the next subsection under “Patent Owner’s contentions.”

As to the limitation “determining a status of the movable barrier,” Petitioner notes that Menard discloses “a processor executing programming and coupled to a door opener, a position sensor, and a wireless transceiver that communicates using both a long range communication protocol and a short range communication protocol.” Pet. 20–22 (citing Ex. 1003 ¶ 10)

(emphasis omitted). Petitioner explains that, to determine the status of a movable barrier (a door), position sensor 155 in Menard “includes a first magnetic switch to detect door 40 in an open position and second magnetic switch to detect door 40 in a closed position.” *Id.* (citing Ex. 1003 ¶ 30, Fig. 2) (emphases omitted). Position sensor 155 “provides an electrical signal corresponding to the position of door 40.” Ex. 1003 ¶ 30. Based on the evidence of record, we are persuaded that Menard discloses “determining a status of the movable barrier,” as expressly recited in claim 12, and as required by its dependent claims. Patent Owner does not dispute Petitioner’s assertions and supporting evidence as to this limitation. *See generally* PO Resp.

With respect to the limitation “sending a status of the movable barrier over the network to the network client in response to the status request,” Petitioner argues that Menard discloses sending a door position status over the network to a user’s communication device in response to the status inquiry. Pet. 22–24 (citing Ex. 1003 ¶¶ 9, 10, 50; Ex. 1008 ¶¶ 87–93). As support, Petitioner notes that Menard discloses, for example, “system 100 provides a pager signal to indicate the position of the door or any other information relative to the garage or the door opener.” Ex. 1003 ¶ 50. Menard explains “[u]sing a two way pager, the user may operate the door opener, or operate an actuator, using the reply communication channel of the pager,” and “[t]he outbound signal (e.g., indicating the door position) may be transmitted to the pager on a predetermined schedule, or *upon inquiry*, or

upon a change of position of the door (or actuator) at any time.” *Id.* (emphasis added).

Mr. Lipoff testifies that “in response to an inquiry, Menard transmits a signal indicating the door position (e.g., open or closed) to a user (e.g., via a pager network).” Ex. 1008 ¶ 89. Mr. Lipoff explains that Menard’s “outbound signal (e.g., indicating the door position)” providing the door position status is sent in response to the status inquiry received from the network device. *Id.* ¶¶ 90–93 (citing Ex. 1003 ¶¶ 9, 10, 50). Mr. Lipoff also testifies that “Menard teaches multiple types of network clients [that] may be used to send the inquiries requesting the status of the movable barriers.” *Id.* ¶ 90. We credit Mr. Lipoff’s testimony (*id.* ¶¶ 89–93), as it is consistent with Menard’s disclosure (e.g., Ex. 1003 ¶¶ 9–11, 29, 44, 50, 69).

Having reviewed Petitioner’s contentions and supporting evidence, we determine Petitioner has demonstrated sufficiently that Menard discloses “sending a status of the movable barrier over the network to the network client in response to the status request,” as recited in claim 12.

Patent Owner’s contentions

Patent Owner counters that Menard does not disclose expressly or inherently “a status request received from a network client over a network,” as recited in claim 12. PO Resp. 2–15 (citing Ex. 2001 ¶¶ 25–35). To support its position, Patent Owner advances several arguments. We address below each of Patent Owner’s arguments in turn.

At the outset, as discussed in our claim construction analysis above, we interpret a “network,” in light of the Specification of the ’977 patent, to

mean “a single network or a plurality of networks connected together acting individually or collectively to allow communication between a communication device and a system.”

There is no dispute that Menard discloses a network interface sending the door position status over a network. Patent Owner’s main dispute centers on whether the user uses *the same network client* to request and receive the door position status over *the same network(s)*.

Although we agree with Patent Owner that claim 12 “requires that the status request be received over a network from a network client, and the status be sent over the same network to the network client in response to the status request,” see PO Resp. 4–5 (emphases omitted), we are not persuaded by Patent Owner’s arguments and supporting evidence that Menard fails to disclose the limitation. Rather, we determine Petitioner has established that an ordinarily skilled artisan would have understood Menard to disclose a user using the same communication device (network client) to request and receive the door position status over the same network(s). Ex. 1008 ¶¶ 78–79, 89–93; Ex. 1014 ¶ 26.

First, Patent Owner opposes Petitioner’s assertion that Menard’s signal indicating the door position status sent “upon inquiry” discloses “the status request is received over a network from a network client.” PO Resp. 5. Patent Owner argues that Menard does not disclose the source of the status inquiry, and that the status inquiry is not received over a network. *Id.* at 4–10. In Patent Owner’s view, the status inquiry could be sent from the system itself to the door position sensor, not from the user’s

communication device over a network. *Id.* at 7–10. Patent Owner contends that Figure 8 of Menard supports its argument that the status inquiry is not a request over the network because the flowchart in Figure 8 does not show the communication device transmitting any type of “inquiry” over the network. *Id.* at 5–7.

Patent Owner’s argument and Dr. Davis’ supporting testimony (Ex. 2001 ¶¶ 25–35), however, are based on an unduly narrow interpretation of Menard’s teachings. Anticipation is not an *ipsissimis verbis* test. *See Gleave*, 560 F.3d at 1334; *Bond*, 910 F.2d at 832. It is well established that “‘the dispositive question regarding anticipation [i]s whether one skilled in the art would reasonably understand or infer from [the prior art reference’s] teaching’ that every claim element was disclosed in that single reference.” *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368 (Fed. Cir. 2003) (citation and emphasis omitted).

Significantly, Patent Owner conflates Menard’s disclosures regarding a *one-way pager*, which can only receive messages, not transmit them, with a *two-way pager*, which can receive and transmit messages. Menard explains that the user, using a *one-way pager*, “may operate the door opener . . . using *another communication channel*, including for example, a cellular telephone or a personal communication device.” Ex. 1003 ¶ 50 (emphasis added). In contrast, Menard discloses “[u]sing a two way pager, the user may operate the door opener, or operate an actuator, using *the reply communication channel of the pager*.” *Id.* (emphasis added). In the very next sentence, Menard states that “[t]he outbound signal (e.g., indicating the

door position) may be transmitted to *the pager . . . upon inquiry.*” *Id.* (emphases added). As Mr. Lipoff explains, “the” before “pager” refers to the two-way pager from the immediately preceding sentence, which uses a communication channel and “reply” communication channel. Ex. 1014 ¶ 26. The “upon inquiry” wording in paragraph 50 cannot be read in isolation; rather, a person of ordinary skill in the art would have read it in context with the surrounding disclosure in Menard. Mr. Lipoff testifies that such an artisan would have understood from Menard’s full disclosure that the user uses the same two-way pager to request and receive the door position status over the same network. Ex. 1008 ¶¶ 78–79, 89–93; Ex. 1014 ¶¶ 24–26. Again, we credit Mr. Lipoff’s testimony, as it is consistent with Menard’s disclosure (Ex. 1003 ¶¶ 9–11, 29, 41, 44, 50, 69).

Patent Owner also conflates a two-way pager with a one-way pager by assuming erroneously that the status inquiry is not sent from the two-way pager, but is sent from another communication channel. PO Resp. 3–15; Ex. 2001 ¶¶ 25–35. An ordinarily skilled artisan would have appreciated that there is no need for the user to use another communication channel when using a two-way pager because, unlike a one-way pager, a two-way pager can request and receive the status over the same network, as disclosed in Menard. Ex. 1014 ¶¶ 24–26; Ex. 1003 ¶¶ 10, 44 (disclosing “the pager network is a two-way pager network enabling *bidirectional communication* between a BLUETOOTH®-enabled sensor, or device, and a user controlled pager” (emphasis added)).

In addition, we do not agree with Patent Owner's characterization that the status inquiry is not sent from the user's communication device over a network (PO Resp. 3–15; Ex. 2001 ¶¶ 25–35). Such a characterization is not consistent with Menard's disclosure. *See, e.g.*, Ex. 1003 ¶¶ 9–11, 29, 44, 49, 50, 69. As Mr. Lipoff testifies, “Menard teaches multiple types of network clients [that] may be used to send the inquiries requesting the status of the movable barriers.” Ex. 1008 ¶¶ 90–92. Indeed, Menard makes clear that its system “allows remote control and management of single or multiple door openers using a wired or wireless communication device,” including “a cellular telephone, a pager, a personal digital assistant, a computer or other device that *communicates using a network*.” Ex. 1003 ¶ 9 (emphasis added).

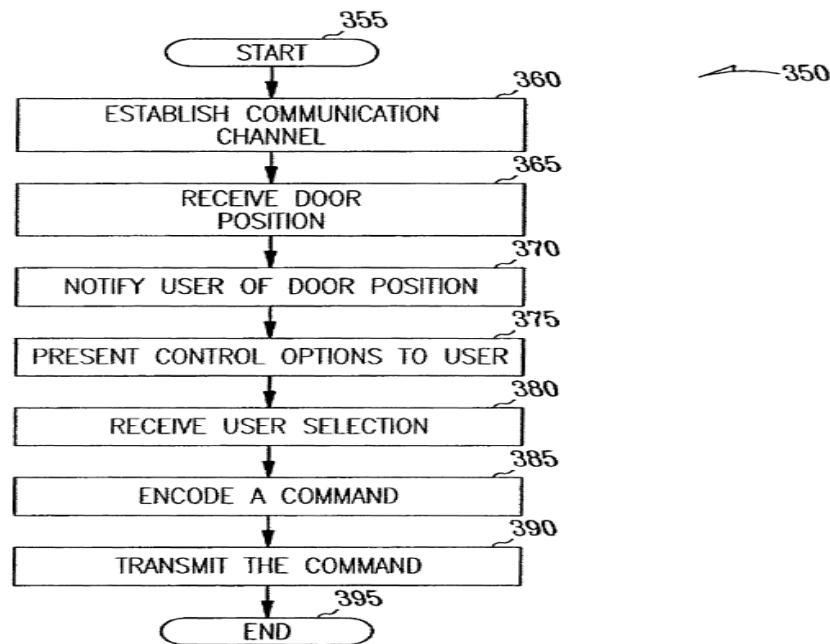
More importantly, as Menard describes, its “invention includes a processor executing programming and coupled to a door opener, a position sensor, and a wireless transceiver that communicates using both a long range communication protocol and a short range communication protocol.” *Id.* ¶ 10. “A user need not specify the communication protocol to be used in *controlling or managing the opener*” because the “opener *receives commands and transmits status information* using either or both of the long range and short range protocols.” *Id.* (emphases added).

As discussed above, we interpret a “network” as recited in claim 12 to mean “a single network or a plurality of networks connected together acting individually or collectively to allow communication between a communication device and a system.” Menard discloses both a single network and a plurality of networks connected together acting individually

or collectively to allow communications between the user's communication device and a door opener. *Id.* ¶¶ 9–11. For example, Menard explains that the “communication link, whether long range or short range, provides a channel . . . for *communicating instructions from the device to the door opener*,” and “[p]osition *information is transmitted to the device* by a transceiver coupled to the processor.” *Id.* ¶¶ 10–11, 29, 44 (emphases added). Therefore, Patent Owner's characterization that the status inquiry is not sent from the user's communication device over a network is not consistent with Menard's disclosure.

For these reasons, we are not persuaded by Patent Owner's argument that Menard does not disclose the source of the status inquiry, and that the status inquiry is not transmitted over a network. PO Resp. 3–15; Ex. 2001 ¶¶ 25–35. Instead, we agree with Petitioner and Mr. Lipoff that an ordinarily skilled artisan would have recognized that the same two-way communication device is used for sending the status inquiry and receiving the door position status over the same network. *See In re Baxter Travenol Labs.*, 952 F.2d 388, 390 (Fed. Cir. 1991) (holding that “the dispositive question regarding anticipation [is] whether one skilled in the art would reasonably understand or infer” from the prior art reference that the reference discloses all of the limitations of the claim).

Patent Owner's reliance on Figure 8 of Menard to support its argument that the “inquiry” is not a request over the network (PO Resp. 5–8) is misplaced. Figure 8 of Menard is reproduced below.



As shown in Figure 8 of Menard, method 350 describes the operation of system 100 for receiving door position information and for controlling the door from a remote location. Ex. 1003 ¶¶ 68–69. The method starts at step 355 in which “the user has a wireless device capable of communicating with transceiver 130” of system 100. *Id.* ¶ 69. At step 360, “the user and system 100 establish a link on a communication channel.” *Id.* At step 365, door position information is received by the user. *Id.* At step 370, “the user receives notification of the door position information.” *Id.* At step 375, “the user is presented with one or more options to control system 100.” *Id.* In the case that the door is open, options may include partially, or fully, closing the door. *Id.* At step 380, “the user indicates a selection using the portable wireless device.” *Id.* At step 385, “the wireless device encodes a message for transmission to system 100 including instructions to operate the door according to the user selection.” *Id.* At step 390, “the message is

transmitted to system 100.” *Id.* “The message may be routed to system 100 on wired or wireless communication networks.” *Id.*

Patent Owner concedes that Menard discloses at least three triggers, each of which results in sending the door position status to the user: (1) “on a predetermined schedule,” (2) “upon inquiry,” or (3) “upon a change of position of the door.” PO Resp. 7 (citing Ex. 1003 ¶ 50). During cross-examination, Dr. Davis conceded that, although none of these triggers is depicted in the flow chart shown in Menard’s Figure 8, “[t]hey would result in this flow chart being exercised.” Ex. 1015, 153:10–154:4. Moreover, Mr. Lipoff testifies that “[n]one of these triggers are discussed in relation to Figure 8,” but nevertheless “each of these triggers would result in the steps of Figure 8 being performed,” including the steps of notifying the user of door position and then presenting control options to the user. Ex. 1014 ¶¶ 28–30. As Mr. Lipoff explains, an ordinarily skilled artisan would not have expected the status “inquiry” to be shown in Figure 8 anymore than the other triggers to be shown. *Id.* Therefore, the mere fact that Figure 8 of Menard does not show a status inquiry does not support Patent Owner’s argument that the status “inquiry” referenced in paragraph 50 of Menard is not a request over the network.

Second, Patent Owner argues that it would not make sense for the user to prompt the system for the door position status since the status is sent on a predetermined schedule or upon a change of the door position. PO Resp. 8; Ex. 2001 ¶ 28. Patent Owner fails to appreciate that the triggers in Menard are alternative ways for a user to receive the status that are not necessarily

used altogether at the same time. Ex. 1003 ¶ 50 (“The outbound signal (e.g., indicating the door position) may be transmitted to the pager on a predetermined schedule, *or upon inquiry*, or upon a change of position of the door (or actuator) at any time.” (emphasis added)). For example, when an out-of-view user does not remember whether he or she had closed the garage door, the user can remotely send a status inquiry and receive the door position status immediately using a two-way communication device, without waiting for the predetermined schedule or a change of position of the door. Therefore, Patent Owner’s argument that it does not make sense for the user to prompt the system for the door position status is not consistent with Menard’s disclosure.

Third, Patent Owner argues that Menard merely addresses opening and closing the door, not making a status inquiry. PO Resp. 8–10 (citing Ex. 1003 ¶ 50); Ex. 2001 ¶¶ 29–30. Patent Owner’s reading of Menard’s disclosure is again unduly narrow. During cross-examination concerning the flow chart shown in Figure 8 of Menard, Dr. Davis conceded that each of the three triggers described in paragraph 50 of Menard, including the status inquiry, “would result in this flow chart being exercised.” Ex. 1015, 153:10–154:4. Mr. Lipoff also testifies that “each of these triggers would result in the steps of Figure 8 being performed.” Ex. 1014 ¶¶ 28–30. Figure 8 of Menard makes clear that the user, using a communication device, is notified of the door position status in step 370, *before* the user is presented with the options to control system 100 (close or open the door) in step 375. Ex. 1003 ¶ 69. An ordinarily skilled artisan would have

understood that requesting and receiving the door position status are basic initial steps for operating the door opener remotely. *Id.* ¶¶ 50, 69, Fig. 8; Ex. 1014 ¶¶ 28–30. Therefore, Patent Owner’s argument that Menard merely addresses opening and closing the door, not making a status inquiry, is unavailing.

In addition, Patent Owner’s reliance on the “automatic” example to support its argument is misplaced. PO Resp. 8–10 (citing Ex. 1003 ¶ 74). In Menard’s “automatic” example, there is no need for the user to send any commands to operate the door opener, much less requesting and receiving the door position status, because the system *automatically* opens the door if the door is closed, or closes the door if the door is open. Ex. 1003 ¶ 74. Accordingly, the “automatic” example does not support Patent Owner’s argument that Menard merely addresses opening and closing the door, not making a status inquiry.

Other portions of Menard (Ex. 1003 ¶¶ 7, 23, 65, 73) cited by Patent Owner also do not support its argument. PO Resp. 8–10. Notably, paragraph 7 of Menard in the Background section describes a basic residential garage door opener, not Menard’s disclosed system and method. Ex. 1003 ¶¶ 4–8. Other portions of Menard cited by Patent Owner teach different aspects of Menard’s invention. *Id.* ¶¶ 23 (“Processor 120 may also include a driver circuit to provide an electrical signal at a level sufficient to operate the garage door opener.”), 65 (“Programming 150 may also include software routines or modules to address prioritization matters.”), 73 (“it will be noted that other doors may be controlled and operated using a suitable

power opener”). Menard is not required to disclose repeatedly in every discussion the basic initial steps (e.g., requesting the door position status) for controlling and managing the door opener. For the reasons discussed above, Patent Owner’s argument that Menard merely addresses opening and closing the door, not making a status inquiry (PO Resp. 8–10; Ex. 2001 ¶¶ 29–30), is not supported by Menard’s disclosure.

Fourth, Patent Owner argues that Menard describes other ways of communicating with the garage door opener that do not involve communicating over a network, such as a user interacting with a physical interface of Menard’s system (using a “wired button”) or interacting with the system using their voice. PO Resp. 8–15; Ex. 2001 ¶¶ 33, 35. However, the mere fact that Menard additionally discloses other features does not undermine Petitioner’s anticipation showing that Menard discloses a system and a method that allow a user using a two-way communication device to request and receive a door position status over a network. *See Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1376 (Fed. Cir. 2005) (rejecting the notion that an ingredient “cannot anticipate because it appears without special emphasis in a longer list”); *Hewlett-Packard v. Mustek Sys., Inc.*, 340 F.3d 1314, 1324 n.6 (Fed. Cir. 2003) (“The anticipation analysis asks solely whether the prior art reference discloses and enables the claimed invention, and not how the prior art characterizes that disclosure or whether alternatives are also disclosed.”).

Furthermore, Patent Owner does not explain, nor can we discern, why a user would use the wired button or audio transducer to request the door

position status when the user can physically see whether the door is open or closed. Both the wired button and audio transducer are located near the garage. Ex. 1003 ¶¶ 2, 57. As Mr. Lipoff testifies, a user would not need to request the door position status if the user physically could see whether the door is open or closed. Ex. 1014 ¶¶ 35–37, 40. We credit Mr. Lipoff’s testimony, as it is consistent with one of Menard’s stated goals—solving the problem of the lack of feedback to indicate the position of the door to the user when the user has driven out of view. Ex. 1003 ¶ 3. Accordingly, we are not persuaded by Patent Owner’s argument that Menard describes other ways of communicating with the garage door opener that do not involve communicating over a network. PO Resp. 8–15; Ex. 2001 ¶¶ 33, 35.

For the foregoing reasons, we determine that Petitioner has established that Menard describes a method for checking the status of a movable barrier comprising the steps of: “receiving from a network client over a network, a status request for a movable barrier,” “determining a status of the movable barrier,” and “sending a status of the movable barrier over the network to the network client in response to the status request,” as recited in claim 12.

3. Controlling the movement of the barrier (e.g., opening or closing a door)

Claim 12 also recites “wherein the movable barrier comprises a barrier movement operator for controlling the movement of the barrier.” Ex. 1001, 5:46–6:1. Petitioner explains in detail how Menard describes this limitation, citing to Mr. Lipoff’s Declaration for support. Pet. 24–27 (citing Ex. 1008). Petitioner notes that garage door opener system 10 (barrier

movement operator), as illustrated in Figure 1 of Menard, includes power unit 15 that can be operated by remote control 85 “to drive door 40 to an open position if closed, and to a closed position if door 40 is open.” *Id.* (citing Ex. 1003 ¶ 7, Fig. 1) (emphasis omitted). Further, Figure 7 of Menard shows actuator programming 225 includes door open programming 230 and door close programming 235 for raising or lowering garage door 40, respectively, in response to commands received by processor 120 (controlling the movement of the barrier). *Id.* (citing Ex. 1003 ¶ 61, Fig. 7; Ex. 1008 ¶¶ 94–101).

Upon consideration of Petitioner’s contentions and supporting evidence, we are persuaded that Menard discloses “the movable barrier comprises a barrier movement operator for controlling the movement of the barrier,” as recited in claim 12. Patent Owner does not dispute Petitioner’s contentions and supporting evidence as to this limitation. *See generally* PO Resp.

4. *Change request*

Claim 12 also recites “the method comprises receiving a status change request from the network client and controlling movement of the barrier in response to the status change request.” Ex. 1001, 6:1–4.

Petitioner’s contentions

Petitioner explains in detail how Menard describes this limitation, citing Mr. Lipoff’s Declaration for support. Pet. 27–30 (citing Ex. 1008). Petitioner first directs our attention to Figure 8 of Menard, which shows a

method that describes the operation of system 100 for receiving door position information and for controlling the door from a remote location. *Id.* (citing Ex. 1003 ¶ 69, Fig. 8; Ex. 1008 ¶¶ 108–109). In particular, Menard discloses the following: at step 375, after the user receives notification of the door position status, “the user is presented with one or more options to control system 100” and “[i]n the case that door 40 is open, options may include partially, or fully, closing the door”; at step 380, “the user indicates a selection using the portable wireless device”; at step 385, “the wireless device encodes a message for transmission to system 100 including instructions to operate the door according to the user selection”; and at step 390, “the message is transmitted to system 100,” and “[t]he message may be routed to system 100 on wired or wireless communication networks.” Ex. 1003 ¶ 69, Fig. 8.

Mr. Lipoff testifies “Menard also teaches that when the status change instruction is received from the device on the network, the networked movable barrier operator (e.g., a garage door opener) will move the barrier.” Ex. 1008 ¶ 110. Petitioner further explains that, as shown in Figure 7 of Menard, programming 150 for system 100 includes door open programming 230 and door close programming 235 for raising or lowering garage door 40, respectively, in response to commands received by processor 120. Pet. 27–30 (citing Ex. 1003 ¶ 61; Ex. 1008 ¶¶ 110, 112–113).

Having reviewed Petitioner’s explanations and supporting evidence, we are persuaded that Menard discloses “receiving a status change request

from the network client and controlling movement of the barrier in response to the status change request,” as recited in claim 12.

Patent Owner’s contentions

Patent Owner counters that Petitioner improperly combines features of different devices or mixes disclosure from multiple distinct embodiments in addressing the limitations of claim 12. PO Resp. 15–19, 27–29. In particular, Patent Owner argues that Petitioner relies upon a *pager* embodiment to teach a status request, and relies upon a *cellular telephone* embodiment to teach a status change request. *Id.* Patent Owner avers that “Menard does not teach that the functionality of each of these different devices are interchangeable across all devices” because Menard acknowledges the different capabilities of the different devices, specifically a *one-way pager* having “no provision for outgoing communications with which to operate the door opener.” *Id.* at 17–18. Patent Owner also contends that features from distinct embodiments cannot be combined to demonstrate anticipation of a claim merely because such a combination would have been “at once envisaged” by a person of ordinary skill in the art, citing *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Ltd.*, 851 F.3d 1270, 1274 (Fed. Cir. 2017). PO Resp. 27–29.

We are not persuaded by Patent Owner’s argument that Petitioner improperly combines features of different devices or mixes disclosure from multiple distinct embodiments in addressing claim 12. Patent Owner’s arguments erroneously rest upon the premise that each of the user communication devices disclosed in Menard (e.g., a two-way pager and a

cellular phone) constitutes a separate, distinct embodiment. See PO Resp. 15–19; Ex. 2001 ¶¶ 39, 40, 42.

As described in the Summary of the Invention section of Menard, a cellular telephone, pager, personal digital assistant, and computer are *examples* of communication devices that a user can use for controlling and managing a single door opener or multiple door openers remotely. Ex. 1003 ¶¶ 9–11; see PO Resp. 17 (acknowledging that “Menard describes multiple different devices that can interact with its garage door opener (e.g., the pager and cellular telephone)”). Menard makes clear that the system for controlling and managing *a single door opener* is one embodiment, whereas the “Other Embodiments” are directed to the system for controlling managing *multiple door openers*. Ex. 1003 ¶¶ 13, 18, 19, 70–72.

Notably, Menard discloses, in a single embodiment, a system and a method that allow remote control and management of a door opener using a wired or wireless communication device, which may be “a cellular telephone, a pager, a personal digital assistant, a computer or other device that communicates using a network.” *Id.* ¶¶ 9–11, 13 (“FIG. 2 illustrates a block diagram of one embodiment of the present system”), 18 (“FIG. 7 illustrates one embodiment of programming in accordance with one embodiment of the present system”), 19 (“FIG. 8 illustrates one embodiment of a method in accordance with one embodiment of the present system”).

Menard makes clear that a “user need not specify the communication protocol to be used in *controlling or managing the opener*” because the “opener receives commands and transmits status information using either or

both of the long range and short range protocols.” *Id.* ¶ 10 (emphases added). “The communication link, whether long range or short range, provides a channel . . . for communicating *instructions from the device to the door opener*,” and “[p]osition *information is transmitted to the device* by a transceiver coupled to the processor.” *Id.* ¶¶ 10–11 (emphases added). Menard thus discloses a number of exemplary communication devices, and then proceeds to describe the capabilities of the disclosed system with respect to such a “device.”

Menard also specifically discloses that transceiver 130 of system 100 is compatible with a plurality of communication protocols, such that system 100 communicates with a cellular telephone, a two-way pager, a PDA, a computer, or other wired or wireless communication device. *Id.* ¶¶ 29, 31, 44, 47. Significantly, Menard discloses that “[o]ther long range and short range communication protocols are also contemplated and *the foregoing examples* are not to be construed as limitations but *merely as examples*.” *Id.* ¶ 46 (emphases added); *see also id.* ¶ 66 (disclosing that processor 120 can transmit information “using all modes of communication”).

Paragraph 50 of Menard similarly describes *examples* of how a one-way pager (in connection with another device, such as a cellular telephone), and a two-way pager (like other two-way communication devices that can receive and transmit messages), request and receive the door position status and operate *a single door opener*. *Id.* ¶ 50. Menard’s “Other Embodiments,” by contrast, disclose how the communication devices

communicate with the system when “system 100 is coupled to *multiple door openers*.” *Id.* ¶¶ 70–71 (emphasis added).

To account for each limitation of claim 12, Petitioner likewise describes examples from Menard of two-way communication devices for controlling and managing a door opener remotely. Pet. 28–30. Petitioner did not combine features of different devices. Nor does Petitioner need to combine features of different devices to establish that the challenged claims are anticipated by Menard. For these reasons, we are not persuaded by Patent Owner’s argument that Petitioner improperly combines features of different devices or mixes disclosure from multiple distinct embodiments in addressing claim 12.

In addition, Patent Owner’s argument that Petitioner relies upon a *pager* to teach a status request and relies upon a *cellular telephone* to teach a status change request is inapposite. Petitioner correctly asserts that Menard discloses “communicating with *multiple network clients*,” not just the pager as Patent Owner argues, and “receiving status requests from the network clients,” including “a cellular telephone, a pager, a personal digital assistant, a computer or other device that communicates using a network.” Pet. 17–20 (citing Ex. 1003 ¶ 9) (emphasis added). Mr. Lipoff testifies that “Menard teaches multiple types of network clients [that] may be used to send the inquiries requesting the status of the movable barriers.” Ex. 1008 ¶¶ 90–92. We agree.

With respect to the “status change request” limitation, Petitioner relies upon Figure 8 of Menard, which teaches how *multiple types of*

communication “device[s]” can receive door position information and control the door remotely, not just the cellular telephone, as Patent Owner argues. Pet. 28–29 (citing Ex. 1003 ¶¶ 61, 69, Fig. 8). Indeed, Menard explains: “the user has a wireless device capable of communicating with transceiver 130”; “the user and system 100 establish a link on a communication channel”; “the user receives notification of the door position information”; and the “door position may be indicated by a pair of lights on a pager,” a “graphical image on a screen, a recognizable audio tone, a recognizable vibration, or any other means of indicating position to a user,” and the user indicates a control selection (e.g., closing the door) using the portable wireless device. Ex. 1003 ¶ 69.

According to Menard, Figure 8 “illustrates *one embodiment* of a method in accordance with *one embodiment* of the present system.” Ex. 1003 ¶ 19 (emphases added). Significantly, during cross-examination regarding the flow chart shown in Figure 8, Dr. Davis conceded that each of the three triggers disclosed in paragraph 50 of Menard, including the *status inquiry*, “would result in this flow chart being exercised.” Ex. 1015, 153:10–154:4. Mr. Lipoff also agrees, testifying that “each of these triggers would result in the steps of Figure 8 being performed.” Ex. 1014 ¶¶ 28–30. Thus, we do not agree with Patent Owner’s argument that Petitioner relies upon a *pager* to teach a status request, and relies upon a *cellular telephone* to teach a status change request.

Furthermore, we are not persuaded by Patent Owner’s argument that “Menard does not teach that the functionality of each of these different

devices are interchangeable across all devices” because Menard acknowledges the different capabilities of the different devices, specifically, a *one-way pager* having “no provision for outgoing communications with which to operate the door opener.” PO Resp. 17–18 (citing Ex. 1003 ¶ 50; Ex. 2001 ¶ 40). In paragraph 50, Menard merely points out the differences between a one-way pager and a two-way pager: a *one-way pager* can only receive messages, not transmit them, and thus requires “another communication channel,” such as a “cellular telephone,” to operate the door opener, whereas a *two-way pager* can both receive and transmit messages (similar to other two-way communication devices). Ex. 1003 ¶ 50. Patent Owner conflates a one-way pager with a two-way pager, improperly concluding that a two-way pager cannot send a status change request. See PO Resp. 17–18; Ex. 2001 ¶ 40.

An ordinarily skilled artisan reading Menard would have recognized that a two-way pager is similar to a cellular telephone, a computer, a PDA, and other two-way communication devices, for controlling and monitoring the garage door opener system. Ex. 1003 ¶¶ 9–11, 29, 44, 50, 69. Menard explains “a two-way pager network enabl[es] bidirectional communication” and “[u]sing a two way pager, the user may operate the door opener, or operate an actuator, using the reply communication channel of the pager.” *Id.* ¶¶ 44, 50. In fact, Patent Owner concedes that Menard “expressly addresses using the two way pager in opening/closing the door.” PO Resp. 8; Ex 2001 ¶ 29. Accordingly, we are not persuaded by Patent Owner’s argument that “Menard does not teach that the functionality of each of these

different devices are interchangeable across all devices” because a *one-way pager* “has no provision for outgoing communications with which to operate the door opener.” See PO Resp. 17–18.

Patent Owner’s reliance on *Nidec Motor* also is misplaced. PO Resp. 27–29 (citing *Nidec Motor*, 851 F.3d at 1274 (holding that *Kennametal, Inc. v. Ingersoll Cutting Tool Co.*, 780 F.3d 1376, 1381 (Fed. Cir. 2015) “does not stand for the proposition that a reference missing a limitation can anticipate a claim if a skilled artisan viewing the reference would ‘at once envisage’ the missing limitation”)). As discussed above, a person of ordinary skill in the art would have understood that Menard discloses every claim limitation recited in claim 12. We do not agree with Patent Owner’s argument that there is a “missing limitation.” Again, Menard discloses, in a single embodiment, a system that allows the user to make a status request and receive the status in response using a communication device, and provides multiple *examples* of types of such devices.

For the reasons discussed above, we also do not agree with Patent Owner that it is necessary to combine a two-way pager with a cellular telephone in order for Petitioner to show that Menard discloses each limitation recited in claim 12.

Even assuming such a combination were necessary, though, Menard expressly discloses that “it will be appreciated that each of the aforementioned devices, namely a cellular telephone, a two-way pager, and a device compatible with BLUETOOTH®, may be combined in a single portable housing.” Ex. 1003 ¶ 47. Similarly, transceiver 130 of system 100

may communicate with devices “on more than one protocol.” *Id.* ¶ 48. Patent Owner’s and Dr. Davis’ characterization that Menard’s disclosure is “much the same as carrying a pager and a cellular telephone inside *a backpack*” is speculative and conclusory. PO Resp. 18; Ex. 2001 ¶ 42 (emphasis added). Menard never mentions “a backpack,” but instead provides detailed explanations how transceiver 130 of system 100 supports long distance network and short distance network communication, with specific examples of network protocols and network devices, and clearly discloses that device functionality for communicating with the transceiver may be combined. *See, e.g.*, Ex. 1003 ¶ 47.

To the extent Patent Owner is arguing that Menard is non-enabling for such a device, we note that prior art publications and patents are presumed to be enabled. *See In re Antor Media Corp.*, 689 F.3d 1282, 1287–88 (Fed. Cir. 2012); *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1355 (Fed. Cir. 2003). Patent Owner does not proffer persuasive evidence to show why one of ordinary skill in the art could not have combined the functionalities of a cellular telephone and a two-way pager into “a single portable housing” for controlling the movement of a garage door, as taught by Menard. *See* Ex. 1003 ¶ 47. Nor does Patent Owner explain adequately the basis for such a non-enablement assertion.

Upon consideration of parties’ contentions and supporting evidence, we find that Petitioner has shown sufficiently that Menard discloses “the method comprises receiving a status change request from the network client

and controlling movement of the barrier in response to the status change request,” as recited by claim 12.

5. Conclusion on Anticipation Regarding Claims 12, 15, and 16

In light of the foregoing, we determine that Petitioner has demonstrated by a preponderance of the evidence that claims 12, 15, and 16 are anticipated by Menard.

Dependent Claims 17–20

The '977 patent also claims various types of network client. In particular, claim 17 recites “wherein the network client is a *computer*,” claim 19 recites “wherein the network client is a *personal digital assistant*,” and claim 20 recites “wherein the network client is a *cellular telephone*.” Ex. 1001, 6:15–22 (emphases added). Claim 18 depends from claim 17, which in turn depends from claim 12. Claim 18 further recites “wherein the status of the movable barrier is displayed on a *monitor of the computer*.” *Id.* at 6:17–18 (emphasis added).

Petitioner’s contentions

Incorporating its analysis with respect to claim 12, Petitioner explains in detail how Menard describes each of these limitations. Pet. 15–39. Petitioner relies upon Menard to disclose multiple types of network client, including a computer, a personal digital assistant, and a cellular telephone. *Id.* at 18–19, 37–39. Petitioner notes Menard discloses a method that “allows remote control and management of single or multiple door openers using a wired or wireless communication device” (network client), including

“a cellular telephone, a pager, a personal digital assistant, a computer or other device that communicates using a network.” *Id.* at 16–19 (emphasis omitted), 37–39; Ex. 1003 ¶ 9; Ex. 1008 ¶¶ 77, 145–162. Menard also discloses that “a user may communicate with system 100 using a telephone coupled to the public switched telephone network (PSTN), a cellular telephone, a pager (either one way or two way), a personal communication device (such as a personal digital assistant, PDA), a computer, or other wired or wireless communication device.” Ex. 1003 ¶ 29. Mr. Lipoff notes that these are the same network clients recited in claims 17, 19, and 20. Ex. 1008 ¶ 77. Given the evidence in the entirety of the record, we are persuaded that an ordinarily skilled artisan would have recognized that Menard discloses a system with network clients that can be various types of devices, including a computer, a personal digital assistant, and a cellular telephone, as recited in claims 17, 19, and 20.

In addition, as Petitioner points out, Menard discloses that “[t]he *door position may be indicated* by a pair of lights on a pager (one light labeled ‘open’ and another ‘close’), by a *graphical image on a screen*, a recognizable audio tone, a recognizable vibration, *or any other means of indicating position to a user*” in Menard. Ex. 1003 ¶ 69 (emphases added); see Pet. 38. Mr. Lipoff testifies that an ordinarily skilled artisan would have understood that “a screen” is another name for “a monitor,” given Menard’s disclosure of a “computer.” Ex. 1008 ¶¶ 152, 155.

Based on the evidence of record, we credit Mr. Lipoff’s testimony, as it is consistent with Menard’s disclosure (Ex. 1003 ¶¶ 9, 10, 29, 50, 69). We

agree that an ordinary skilled artisan would have recognized that Menard discloses “the status of the movable barrier is displayed on a monitor of the computer,” as recited in claim 18.

Patent Owner’s contentions

Patent Owner counters that Petitioner improperly combines features of different devices or mixes disclosure from multiple distinct embodiments in addressing these claims. PO Resp. 15–29 (citing Ex. 2001 ¶¶ 45–55). In particular, Patent Owner argues that, in Petitioner’s analysis of claim 12, Petitioner identifies Menard’s two-way pager as the “network client” that receives the status, but Petitioner identifies the network client as “a computer” for dependent claims 17 and 18, “a personal digital assistant” device for claim 19, and “cellular telephone” for claim 20. *Id.* Patent Owner avers that Menard does not teach that the pager device is a computer or that it includes the features of a computer (e.g., a screen capable of displaying graphics, a general purpose processor, and sufficient memory and storage resources to execute software programs). *Id.* According to Patent Owner, Menard makes clear that the pager device only includes “a pair of lights,” rather than a screen capable of displaying a graphical image as included in the computer. *Id.* Patent Owner also contends that features from distinct embodiments cannot be combined to demonstrate anticipation of a claim merely because such a combination would have been “at once envisaged” by a person of ordinary skill in the art, citing *Nidec Motor*. *Id.* at 27–29.

At the outset, as discussed above in our claim construction analysis, we decline to interpret “computer” as “personal computer” as suggested by Patent Owner because it would improperly import a limitation from a preferred embodiment or specific example into the claims. *See Van Geuns*, 988 F.2d at 1184.

Patent Owner essentially repeats its arguments in connection with claim 12, assuming erroneously that Petitioner relies upon Menard’s pager to teach a network client. PO Resp. 15–29 (citing Ex. 2001 ¶¶ 45–55). For the same reasons discussed above in our analysis for claim 12, we are not persuaded by Patent Owner’s arguments.

In addition, we do not agree with Patent Owner’s characterization that a two-way pager does not include a graphical screen or cannot function like a computer. PO Resp. 20–24. Patent Owner incorrectly assumes a two-way pager is like a one-way pager that merely includes a pair of lights.

The portion of Menard relied upon by Patent Owner (Ex. 1003 ¶ 69) is directed to different types of *output features* that notify the user of the door position status. Menard discloses that “[t]he door position may be indicated by a pair of lights on a pager (one light labeled ‘open’ and another ‘close’), by a *graphical image on a screen*, a recognizable audio tone, a recognizable vibration, or any other means of indicating position to a user.” *Id.* (emphasis added). Mr. Lipoff testifies that one of ordinary skill in the art at the time of the invention would have recognized that a *two-way* pager that controls and monitors a garage door opener system via the Motorola ReFLEX two-way pager protocol, as described in Menard (Ex. 1003 ¶¶ 44, 49, 50, 59, 61, 69),

would have had a graphical screen, a keyboard, a processor, and memory, citing supporting evidence in the record for his opinion. Ex. 1014 ¶¶ 52–60 (citing Exs. 1017, 1018). Dr. Davis also conceded during his cross-examination that “a cellular phone, a personal computer, a PDA, at some level,” are “all a computer.” Ex. 1015, 87:3–7.

Therefore, we do not agree with Patent Owner’s characterization that a two-way pager, as disclosed in Menard, would not have included a graphical screen or could not function like a computer. *See In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (holding that “a calculator may be a ‘limited function’ computer as opposed to a ‘full function’ computer does not change the fact that it is nonetheless a computer”).

Upon consideration of the parties’ contentions and supporting evidence, we find that Petitioner has shown sufficiently that Menard discloses that “wherein the network client is a computer,” as required by claim 17, “the status of the movable barrier is displayed on a monitor of the computer,” as recited in claim 18, “wherein the network client is a personal digital assistant,” as required by claim 19, and “wherein the network client is a cellular telephone,” as required by claim 20.

Dependent Claims 13 and 21

Claims 13 and 21 depend from claim 12. Claim 13 further recites “the step of receiving access authorizing information from the network client.” Ex. 1001, 6:5–7. Claim 21 further recites “receiving authorizing information from the network client before controlling movement of the barrier in response to the status change request.” *Id.* at 6:23–26.

Petitioner provides detailed explanations and supporting evidence to account for these additional limitations. Pet. 30–33, 40–42. In particular, Petitioner explains that Menard discloses receiving access authorizing information (indicating the authority of users and/or devices) from the network client before controlling movement of the barrier (exercising control) in response to the status change request (open or close command), as required by claims 13 and 21. *Id.* (citing Ex. 1003 ¶¶ 3, 72, 74; Ex. 1008 ¶¶ 116, 118, 119, 121, 122, 165–166). Petitioner notes that, similar to the ’977 patent (Ex. 1001, 4:1–9 (“the user who is checking the status of the garage door 12 may have to enter a *password* to be allowed access to the status information” (emphasis added))), Menard teaches that typical garage door openers utilize *access codes* to prevent operation of the door by an unauthorized person (Ex. 1003 ¶ 3). Pet. 32; Ex. 1008 ¶ 119. Petitioner further notes that Menard discloses that “typical garage door openers lack adequate security protection to prevent operation of the door by an unauthorized person.” Pet. 31 (citing Ex. 1003 ¶ 3). Petitioner explains that “[t]o address this issue, Menard describes that ‘*authorization systems* are included in system 100 to ensure that any detected compatible device is *authorized to exercise control* over system 100.’” *Id.* (citing Ex. 1003 ¶ 74) (emphases added by Petitioner).

Mr. Lipoff testifies that a person of ordinary skill in the art would have understood this disclosure in Menard to disclose receiving access authorizing information from the network client. Ex. 1008 ¶ 116. Mr. Lipoff explains that such an artisan would have understood that

Menard's authorization system "receives access authorizing information, as such information is necessary for it to establish whether a remote client is authorized to control (i.e., raise or lower) the garage door." *Id.* Mr. Lipoff further explains that "[i]n order for the garage door opener to only allow control by 'authorized' devices," Menard's system would receive access authorizing information because "[w]ithout that access authorizing information, Menard would not be capable of determining which network clients are authorized to access the system and which are not." *Id.* ¶ 117. Mr. Lipoff's testimony is un rebutted, and we credit Mr. Lipoff's testimony as it is consistent with Menard's disclosure. Ex. 1015, 91:14–92:21.

Upon review of Petitioner's explanations, which are supported by Menard's disclosures and Mr. Lipoff's un rebutted testimony, we find that Petitioner has shown adequately that a person of ordinary skill in the art would have reasonably understood from Menard's teachings that Menard discloses "receiving access authorizing information from the network client," as recited in claim 13 and similarly recited in claim 21.

As to the limitation "receiving authorizing information . . . before controlling movement of the barrier in response to the status change request" recited in claim 21, Petitioner asserts that Menard discloses this limitation because Menard discloses that "[s]ecurity systems or authorization systems are included in system 100 to ensure that any detected compatible device is *authorized to exercise control over system 100.*" Pet. 40 (citing Ex. 1003 ¶ 74) (emphases added by Petitioner). Mr. Lipoff testifies that by explaining that the authorization is "to" exercise control, a person of ordinary skill in

the art would have understood Menard to disclose that “the system receives the authorizing information and determines if the user is authorized prior to performing the requested action.” Ex. 1008 ¶ 166. Mr. Lipoff’s testimony is un rebutted. Ex. 1015, 91:14–92:21. We credit Mr. Lipoff’s un rebutted testimony (Ex. 1008 ¶¶ 116, 118, 119, 121, 122, 165–166) as Mr. Lipoff has provided reasoned explanations and citations to Menard that support his testimony (Ex. 1003 ¶¶ 3, 72, 74).

Upon consideration of Petitioner’s explanations and supporting evidence, we find Petitioner has established that a person of ordinary skill in the art would have understood from Menard’s teachings that Menard discloses “receiving access authorizing information from the network client,” as recited in claim 13, and “receiving authorizing information from the network client before controlling movement of the barrier in response to the status change request,” as recited in claim 21.

With respect to the anticipation ground based on Menard, Patent Owner does not dispute Petitioner’s showing as to the limitations recited in claims 13 and 21, but relies on its arguments presented in connection with claim 12. *See generally* PO Resp. We already addressed those arguments in our analysis above for claim 12, and we find those arguments unavailing here for the reasons stated above.

For the reasons discussed above in our analysis for claim 12, we determine that Petitioner has shown sufficiently that Menard discloses every limitation recited in independent claim 12. Therefore, we determine that

Petitioner has demonstrated by a preponderance of the evidence that claims 13 and 21 are anticipated by Menard.

Dependent Claim 14

Claim 14 depends from claim 12, and further recites “retrieving from a memory a web page in response to the receiving step.” Ex. 1001, 6:8–10. Claim 12 recites two “receiving” steps: (1) “receiving from a network client over a network, a status request for a movable barrier”; and (2) “receiving a status change request from the network client.” *Id.* at 5:40–41, 6:1–4. Both parties take the position that claim 14 requires “retrieving a web page from memory in response to receiving the same status request that prompts ‘sending a status of the movable barrier over the network to the network client.’” PO Resp. 19; Pet. 34. We agree with and apply that interpretation in our anticipation analysis below.

For the limitation expressly recited in claim 14, Petitioner explains that Menard discloses that processor 120 includes a microprocessor and memory, and that programming 150 executing on processor 120 includes a wireless application protocol (WAP) server that generates data, which can be accessed using an Internet browser. Pet. 33–34 (citing Ex. 1003 ¶¶ 58, 59, Fig. 7). Petitioner asserts that Menard discloses retrieving from a memory a web page in response to receiving the inquiry to monitor the system, as required by claim 14. *Id.* We agree.

Patent Owner counters that Petitioner does not explain how the two-way pager would operate the described “Internet browser.” PO Resp. 19–20. Citing to the testimony of Dr. Davis, Patent Owner asserts that pager

devices as of the Critical Date “generally lacked various features necessary to allow the use of an ‘Internet browser,’ such as a screen capable of displaying graphical web pages, an input device to select links from such web pages, and memory and processor resources sufficient to retrieve and render such web pages.” *Id.* (citing Ex. 2001 ¶ 43).

However, Patent Owner’s arguments rest on the premise that Petitioner merely relies upon a pager to teach a network client. As discussed above in our analysis for claim 12, Petitioner relies upon Menard to disclose “communicating with *multiple [types of] network client[]*,” and “receiving status requests from the network clients,” including “a cellular telephone, a pager, a personal digital assistant, a computer or other device that communicates using a network.” Pet. 17–23 (emphasis added). With respect to the “status change request” limitation, Petitioner relies upon Figure 8 of Menard, which similarly teaches how *multiple types of communication devices* receive door position information and control the door remotely. Pet. 28–29 (citing Ex. 1003 ¶¶ 61, 69, Fig. 8).

In addition, we do not agree with Patent Owner’s characterization that a two-way pager would not have had features to operate an Internet browser. Notably, Menard discloses that web server programming 240 provides an interface to communicate with remote control system 100, so that a user can operate, program, and monitor system 100, as well as access data using an Internet browser. *Id.* ¶ 59, claim 13 (“the processor includes programming having instructions for generating a web page accessible from the Internet”). Patent Owner and Dr. Davis concede that Menard discloses that “[u]sing a

two way pager, the user may operate the door opener, or operate an actuator,” and Menard’s disclosure “expressly addresses using the two way pager in opening/closing the door.” PO Resp. 8; Ex 2001 ¶ 29; Ex. 1003 ¶ 50. Menard explains that a two-way pager network enables bidirectional communication with a user controlled pager. Ex. 1003 ¶ 44. Menard also makes clear that the transceiver of system 100 is compatible with various two-way pager protocols, such as ReFLEX (Motorola) format, InFLEXion (Motorola) format, NexNet format and others. *Id.* ¶¶ 44, 47, 49, 50.

As Mr. Lipoff testifies, one of ordinary skill in the art in 2001 would have recognized that a two-way pager that uses the Motorola ReFLEX two-way pager protocol, such as the Motorola Timeport ReFLEX two-way pager, would have had features (e.g., a keyboard, a graphical screen, and 4 MB of memory) for accessing to web pages on the Internet. Ex. 1014 ¶¶ 52–57, 59–60. A cropped picture of the Motorola Timeport ReFLEX two-way pager from the cover of the Motorola Timeport User’s Guide (Motorola, Inc. 2000) (Reply 23; Ex. 1017) is reproduced below.



The cropped picture above shows that the Motorola Timeport ReFLEX two-way pager has a keyboard and a graphical screen. Ex. 1017, 1.

Mr. Lipoff testifies that he had such a pager and the requisite documentation at that time, and he was a subscriber for many years (before the priority date of the '977 patent) to the ReFLEX two-way paging service and to an additional service supported by an application, "PocketGenie," downloaded over the Motorola ReFLEX two-way paging network to a Motorola ReFLEX two-way pager that provided access to web pages on the Internet. Ex. 1014 ¶¶ 52–57, 59–60. Mr. Lipoff further testifies that "[m]any web browsers prior to 2003 allowed for text-only web browsing" and, therefore, it was not even necessary to have a graphical screen to access a web page. *Id.* ¶ 57. We credit Mr. Lipoff's testimony, as it is consistent with Menard's disclosure regarding a two-way pager that uses, for example, the "ReFLEX™ (Motorola) format" (Ex. 1003 ¶¶ 44, 49, 50) and is

supported by contemporaneous documentation in the record, including the Motorola Timeport User's Guide (Motorola, Inc. 2000) (Ex. 1017) and Wolfetech PocketGenie 3.1 User's Guide, Motorola Timeport/PageWriter (WolfeTech Development Corp. 2001) (Ex. 1018).

Contrary to Patent Owner's assertion that "pager devices as of the Critical Date generally lacked various features necessary to allow the use of an 'Internet browser,' such as a screen capable of displaying graphical web pages, an input device to select links from such web pages, and memory and processor resources sufficient to retrieve and render such web pages" (PO Resp. 19–20), the evidence in this proceeding shows that a person with ordinary skill in the art at the time of the invention would have understood that a two-way pager using a two-way pager protocol such as the Motorola ReFLEX format, as taught by Menard, would have had features to allow the user to access a web page (Ex. 1014 ¶¶ 52–57, 59–60; Exs. 1017, 1018). *See Dayco Prods.*, 329 F.3d at 1368; *see also Sundance, Inc. v. DeMonte Fabricating Ltd.*, 550 F.3d 1356, 1361 n.3 (Fed. Cir. 2008) ("What a prior art reference discloses or teaches is determined from the perspective of one of ordinary skill in the art."); *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991) ("[Anticipation requires that there be] no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention."), *overruled in part on other grounds by Abbott Labs. v. Sandoz, Inc.*, 566 F.3d 1282, 1293 (Fed. Cir. 2009).

Furthermore, Dr. Davis’ testimony that merely repeats Patent Owner’s assertion is also conclusory. It cites to paragraph 69 of Menard (Ex. 1003 ¶ 69) without explanation or additional evidence. Ex. 2001 ¶ 43. It is unclear whether Dr. Davis’ testimony is based on one-way pagers or two-way pagers. As discussed above, one of ordinary skill in the art at the time of the invention would have recognized that a *two-way* pager using a two-way pager protocol (e.g., Motorola ReFLEX format), as described in Menard (Ex. 1003 ¶¶ 44, 49, 50), had a graphical screen, keyboard, processor, and memory. Ex. 1014 ¶¶ 52–60; Ex. 1017; Ex. 1018.

It is also unclear how the cited portion of Menard (Ex. 1003 ¶ 69) supports Dr. Davis’ testimony. That portion of Menard is directed to different types of *output features* to indicate the door position to a user. In particular, Menard states that “[t]he door position may be indicated by a pair of lights on a pager (one light labeled ‘open’ and another ‘close’), by a graphical image on a screen, a recognizable audio tone, a recognizable vibration, or any other means of indicating position to a user.” Ex. 1003 ¶ 69. Consistent with Menard’s *one-way* pager disclosure (*id.* ¶¶ 29, 50), Menard makes clear that a pager would have to have, *at a minimum*, a pair of lights to indicate the door position to the user. *Id.* ¶ 69. Menard does not teach that a *two-way* pager only has a pair of lights, as Dr. Davis implies.

For these reasons, we decline to credit Dr. Davis’ testimony (Ex. 2001 ¶ 43). See 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”).

Upon review of the parties' contentions and supporting evidence in this entire trial record, we determine that Petitioner has demonstrated sufficiently that Menard discloses "the step of retrieving from a memory a web page in response to the receiving step," as recited in claim 14. For the reasons stated in our analysis concerning claim 12 above, we find that Petitioner also has shown adequately that Menard discloses each limitation recited in independent claim 12. Thus, we conclude that Petitioner has demonstrated by a preponderance of the evidence that claim 14 is anticipated by Menard.

Summary of Anticipation

In light of the foregoing, we determine that Petitioner has demonstrated by a preponderance of the evidence that claims 12–21 are unpatentable under §§ 102(a) and (e) as anticipated by Menard.

E. Obviousness over Menard and Lee

Petitioner additionally asserts that claims 13 and 21 are unpatentable under § 103(a) as obvious over Menard and Lee. Pet. 2–3, 42–52. Petitioner incorporates all of its arguments presented in the anticipation ground. *Id.* at 42. Petitioner also states that "[i]n the unlikely event that the Board finds any claim element not explicitly or inherently disclosed by Menard, then it would have been obvious for one of skill in the art at the time of the invention to modify Menard to arrive at the claimed invention." *Id.* As we discussed above in our anticipation analysis, we determine that Petitioner has demonstrated sufficiently that Menard discloses all of the

limitations recited in claims 13 and 21, as well as those in independent claim 12. *See supra*, Section II.D. Consequently, we find that Petitioner has demonstrated by a preponderance of the evidence that claims 13 and 21 are unpatentable as anticipated by Menard. This finding is dispositive of Petitioner’s challenge to the patentability of these claims.

Therefore, we do not address Petitioner’s obviousness ground as to these claims based on the combination of Menard and Lee. *Cf. In re Gleave*, 560 F.3d at 1338 (not reaching other grounds of unpatentability after affirming the anticipation ground); *see also Beloit Corp. v. Valmet Oy*, 742 F.2d 1421, 1423 (Fed. Cir. 1984) (finding an administrative agency is at liberty to reach a decision based on a single dispositive issue because doing so “can not only save the parties, the [agency], and [the reviewing] court unnecessary cost and effort” but can “greatly ease the burden on [an agency] faced with a . . . proceeding involving numerous complex issues and required by statute to reach its conclusion within rigid time limits.”).

III. CONCLUSION

For the foregoing reasons, we determine that Petitioner has demonstrated by a preponderance of the evidence that claims 12–21 of the ’977 patent are unpatentable.

IV. ORDER

For the foregoing reasons, it is
ORDERED that claims 12–21 of the ’977 patent are unpatentable; and
FURTHER ORDERED that, because this is a Final Written Decision,

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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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