

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.

Petitioner,

v.

HAILO TECHNOLOGIES, LLC, d/b/a BRING, LLC

Patent Owner.

Case IPR2017-01865

Patent 5,973,619

Before JOSEPH L. DIXON, MICHAEL R. ZECHER, and
PATRICK M. BOUCHER, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

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

In response to a Petition (Paper 1, “Pet.”) filed by United Patents Inc. (“Petitioner”), we instituted an *inter partes* review of claims 1–7 of U.S. Patent No. 5,973,619 (Ex. 1001, “the ’619 patent”) only as to two of the five grounds of unpatentability (“grounds”) raised in the Petition. Papers 6 (“Dec. on Inst.”), 8. Patent Owner timely filed a Patent Owner Response

(Paper 10, “PO Resp.”), and Petitioner timely filed a Reply to the Patent Owner Response (Paper 14, “Reply”). An oral hearing was held on October 10, 2018, and a copy of the transcript was entered into the record for this proceeding. Paper 20 (“Tr.”).

Although we modified our original Decision on Institution in response to *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018), to include all five grounds raised in the Petition (Paper 8), the parties agreed to remove the previously non-instituted grounds from the trial. See Paper 9, 2 (“the Parties have agreed and intend to dismiss the re-instituted grounds under which the claims of the ‘619 Patent are challenged, with prejudice”); Tr. 3:18–22 (parties waiving additional grounds at oral hearing); see *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1363 (Fed. Cir. 2018) (“Nor will we exercise any discretion to revive the non-instituted claims and grounds. Finality and expedition interests strongly counsel against such action. And so does the Court’s emphasis in *SAS* on the petitioner’s control of the contours of the proceeding.”).

We have jurisdiction under 35 U.S.C. § 6. This Decision is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of the claims for which trial was instituted. Based on the record before us, Petitioner has not shown, by a preponderance of the evidence, that claims 1–7 are unpatentable under 35 U.S.C. § 103(a).

I. BACKGROUND

A. The '619 Patent

The '619 patent was filed on June 10, 1997, and it relates to “[a]n automated vehicle dispatch and payment honoring system” and method. Ex. 1001, [22], [54]. Figure 1 of the '619 patent is reproduced below.

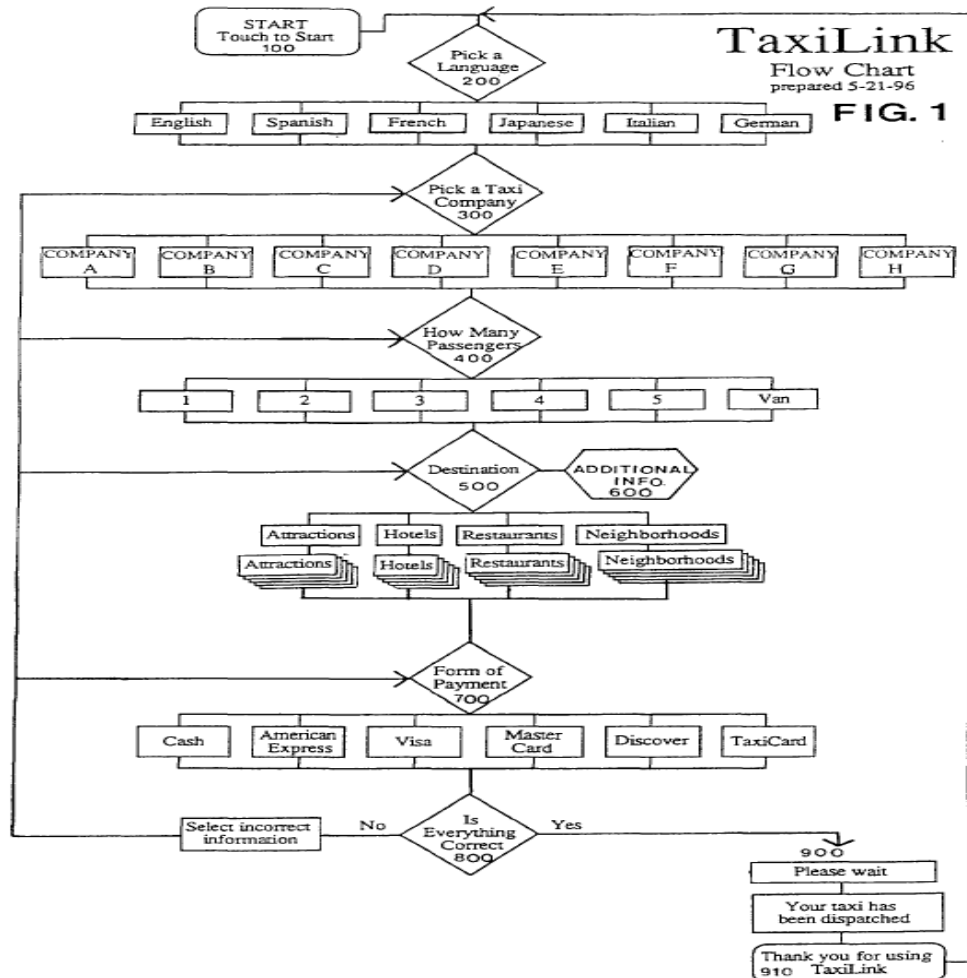


Figure 1 of the '619 patent depicts a schematic view of the flowchart of the vehicle request, or “Taxilink” software, as executed by the computer and hardware components of the vehicle dispatch and payment honoring system. *Id.* at 2:60–63. Within the system, “a computerized system which enables customers to select a transportation company, in this example a taxi

company, from a menu of all permitted and participating companies.” *Id.* at 2:26–29. “The user can choose a desired destination and enter the number of passengers travelling.” *Id.* at 2:29–30. “The system will then display the approximate fare along with forms of payment honored by the taxi company selected.” *Id.* at 2:31–33. “Specialized software enables a customer to make any changes prior to the selection being dispatched as a request for service.” *Id.* at 2:33–35. “The system uses a telecommunication or satellite link to relay the request to the dispatcher while a receipt for the operation is printed.” *Id.* at 2:35–37. “The system improves foreign customer service by offering multi-lingual instructions along with provisions for advertising.” *Id.* at 2:37–40.

B. Illustrative Claim 1

Claim 1, the only independent claim of the ’619 patent, is illustrative of the claims at issue:

1. A method as implemented on a computer system for use by a consumer, said method for delivering instructional messages to said consumer regarding private transportation companies and estimated costs for hiring said transportation company for transporting said consumer to listed destinations and further providing an automated taxi dispatch and payment honoring system, said method comprising the steps of:

(1) displaying a list of authorized transportation companies for selection by the operator of the computer;

2) prompting the consumer to insert the amount of passengers to be traveling in the transportation vehicle;

(3) graphically illustrating destination locations;

(4) displaying the approximate fare for the number of passengers promoted [sic, prompted] to a selected destination and types of payment options honored by said selected company;

(5) initiating a dispatch call for an available taxi from said selected taxi company;

(6) estimate the approximate arrival time for said dispatched taxi.

Ex. 1001, 6:20–40.

C. References Relied Upon

Petitioner relies on the following references.

Penzias	US 5,604,676	Feb. 18, 1997	Ex. 1003
Clagett	US 5,218,633	June 8, 1993	Ex. 1004
Nimura	US 5,231,584	July 27, 1993	Ex. 1005
Behr	US 5,543,789	Aug. 6, 1996	Ex. 1006

D. Instituted Grounds of Unpatentability

We instituted this trial as to claims 1–7 of the '619 patent on the following grounds. Dec. on Inst. 19–20.

References	Basis	Claims Challenged
Penzias, Clagett, and Nimura	§ 103(a)	1 and 7
Penzias, Clagett, Nimura, and Behr	§ 103(a)	2–6

E. Related Proceedings

The parties indicate that the '619 patent was the subject of patent-infringement lawsuits brought by Patent Owner: *Hailo Technologies, LLC d/b/a Bring v. Uber Technologies, Inc.*, 2-17-cv-03028 (C.D. Cal. Apr. 21, 2017) (*see* Ex. 1014) and *Hailo Technologies, LLC d/b/a Bring v. Lyft, Inc.*, 2-17-cv-03031 (C.D. Cal. Apr. 21, 2017). Pet. 2; Paper 4, 1.

II. ANALYSIS

A. Claim Construction

The '619 patent expired on June 10, 2017. Ex. 1001, [22]; Pet. 3, 7. “[T]he Board’s review of the claims of an expired patent is similar to that of a district court’s review.” *In re Rambus Inc.*, 694 F.3d 42, 46 (Fed. Cir. 2012) (internal citations omitted). Thus, we construe the claims in accordance with their ordinary and customary meanings, as would have been understood by a person of ordinary skill in the art, in the context of the specification, prosecution history, and any extrinsic evidence, if in evidence. *See generally Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc).

In the Decision on Institution, we made certain preliminary constructions. *See* Dec. 5–6. We consider the claim construction issues anew in light of the full record developed during the trial. We note that only those claim terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

Petitioner contends that “the plain and ordinary meaning is sufficient for transportation companies.” Tr. 11–12. Petitioner further contends: “Transportation companies is any vehicle for hire.” Tr. 12. Further, Petitioner proffers discussions on the interpretation of claim term “transportation companies” regarding its plain and ordinary meaning as the

term relates to Penzias based upon preliminary interpretations in the complaints filed against the “Uber” or “Lyft” companies.¹ Tr. 12.

We make no specific findings with respect to whether the drivers for either the “Uber” or “Lyft” companies are each individually within a single company or multiple companies based upon their companies’ umbrella structures and because Petitioner has not set forth any ground which requires any factual findings on this matter.

With regard to the appropriate interpretation of the claim term “transportation companies,” we find that Figure 1 of the ’619 patent shows a

¹ Dialogue at oral hearing regarding ordinary meaning of “transportation companies”:

JUDGE BOUCHER: So, under that construction then, is a taxi company multiple transportation companies because it has multiple vehicles for hire?

MR. BOWSER: Yes; according to -- one taxi company includes multiple different cars, and they would correspond to transportation companies; and what we’re going to do is also address how the term, transportation companies is used in the claim, also how it was used in the prosecution history. And what I can tell you here --

JUDGE BOUCHER: It seems unlikely to me that someone would ascribe a plain and ordinary meaning to transportation company such that a taxi company would be equivalent to multiple transportation companies.

MR. BOWSER: Well, a transportation company -- one taxi company -- is conceivably one private company that has multiple different drivers; and what we’re going to discuss with respect to Penzias is multi-passenger vehicles like that; and also how the Clagett reference teaches multiple taxi companies, so that the user can select from one taxi company from a number of different taxi companies.

Tr. 12.

flowchart in which a user selects one of the plural companies at step 300. The corresponding disclosure states, “all authorized taxi companies would appear along with other information and/or advertisements.” On the following screen, the user will “Select a Company” 300 which will service the request. *See* Ex. 1001, 3:58–62. Additionally, the ’619 patent discloses that “[t]he present invention embodies a computerized system which enables customers to select a transportation company, in this example a taxi company, from a menu of all permitted and participating companies.” *Id.* at 2:26–29.

Based on our review of the Specification of the ’619 patent, we determine that the claim term “transportation companies” should be accorded its plain and ordinary meaning. That is, we construe “company” as a “commercial business.” THE OXFORD DESK DICTIONARY AND THESAURUS, 146 (American ed. 1997) Ex. 3001. For a “transportation company,” the commercial business would be transportation services. We further clarify that “transportation companies” requires plural companies.

We also find the plain and ordinary meaning of “taxi: ... also taxicab” is an “automobile licensed for hire and usu. with a meter.” THE OXFORD DESK DICTIONARY AND THESAURUS, 822 (American ed. 1997) Ex. 3001.

B. Asserted Grounds of Unpatentability

1. Legal Principles

To prevail in challenging Patent Owner’s claims, Petitioner must demonstrate by a preponderance of the evidence that the claims are unpatentable. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). “In an [*inter partes*

review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). This burden of persuasion remains with Petitioner, except in limited circumstances not present here. See *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof in *inter partes* review).

A 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 of the invention to a person having ordinary skill in the art. *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 non-obviousness, if in evidence. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

Additionally, the obviousness inquiry typically requires an analysis of “whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (requiring “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)); see *In re Warsaw Orthopedic, Inc.*, 832 F.3d 1327, 1333

(Fed. Cir. 2016) (citing *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006)).

We analyze the challenges presented in the Petition in accordance with the above-stated principles weighing the totality of the evidence and arguments presented in the proceeding.

2. *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) (quoting *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986)). “[O]ne or more factors may predominate.” *Id.*

Petitioner asserts a person of ordinary skill in the art (“POSA”) at the time of the alleged invention of the ’619 patent would have had at least a Bachelor of Science degree in electrical engineering, or equivalent thereof, with a good working knowledge of computer programming. Pet. 7.

Patent Owner proffers a different level of ordinary skill in the art than Petitioner has proffered. PO Resp. 20. Patent Owner proffers

[i]nstead, a [person having ordinary skill in the art] would be someone having a similar background and body of experience as Mr. Paredes did in 1997, and thus have years of experience in user experience (UX) design and optimization, with enough computer programming experience and exposure to the business of taxi cab dispatching to understand the challenges needed to integrate disparate and unstandardized systems between VFH marketplace competitors. See [Ex. 2001], ¶¶ 17-19.

Id. at 21.

Although there are slight differences between the definitions proffered by Petitioner and Patent Owner, the parties agreed that there is no meaningful distinction between them that would change the analysis in this proceeding. *See* Tr. 26–27. We agree and also find that both definitions are consistent with the level of ordinary skill in the art reflected by the prior art of record—namely, Penzias. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *GPAC*, 57 F.3d at 1579; *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978).

We adopt Petitioner’s articulation of the level of ordinary skill in the art for purposes of this Decision, but our conclusion would not differ if we were to accept Patent Owner’s articulation. *See* Pet. 7.

3. Scope and Content of the Prior Art

a. Penzias

Penzias relates to “transportation systems generally, and, more specifically, to a door-to-door transportation system for coordinating the provision of rides to people in lieu of their using their own personal cars or other individual means of transportation.” Ex. 1003, 1:6–10.

Figures 1 and 2 of Penzias are reproduced below.

FIG. 1

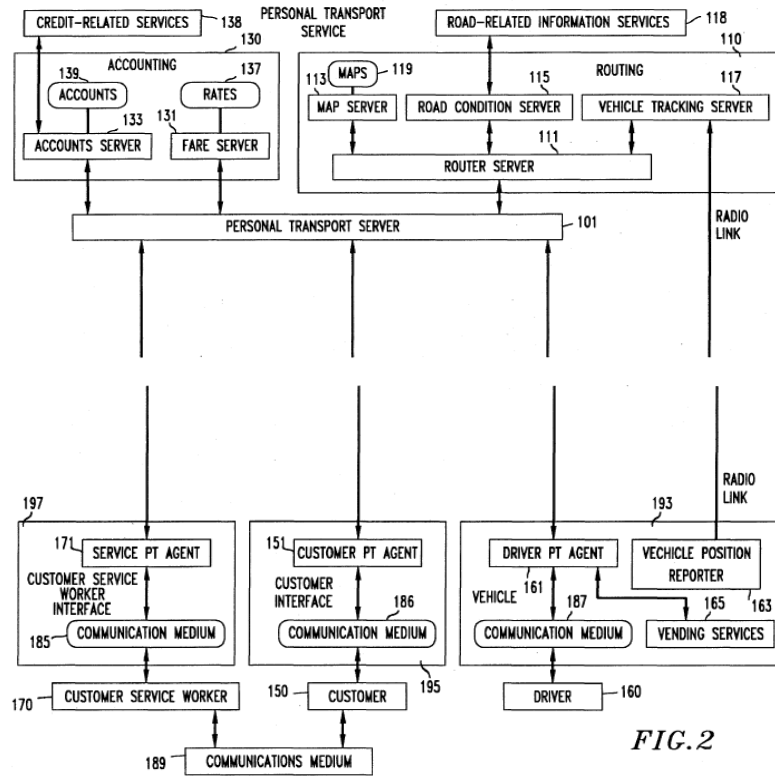


FIG. 2

Figures 1 and 2 together show an exemplary architecture of the overall system of Penzias. Ex. 1003, 2:36–41. Penzias uses multi-passenger vehicles, such as vans that are monitored and rerouted as passengers are added. A consumer requests a ride by specifying a) a pick-up location and b) the destination and, optionally, c) a desired time of arrival and d) the number of people. *Id.* at 1:45–50. Then, a suitable “path” to the destination is determined. *Id.* As shown above, the request of customer 150 is communicated to customer PT agent 151 using a conventionally available communication medium 186, e.g., telephone lines, or data networks, via a customer interface. *Id.* at 5:56–59. Customer PT agent 151 is a logical process that interfaces with customer 150 to receive the customer’s ride

request and relay that ride request in a form compatible with personal transport server 101. *Id.* at 5:52–56; *see* Pet. 9.

Personal transport server 101 controls overall operation of the personal transport service. Ex. 1003, 3:44–46. Personal transport server dispatches vehicles in response to customer requests for rides and coordinates communication among the other units of the personal transport service. *Id.* at 3:46–49. Routing unit 110 has router server 111, which receives a layout of the roads in the area from map server 113 by accessing information stored in maps database 119. *Id.* at 2:60–62. Router server 111 also receives from vehicle tracking server 117 the position, and optionally the direction, of each of the vehicles. *Id.* at 3:7–9; *see* Pet. 9.

Upon receipt of paths from routing unit 110, personal transport server 101 submits the paths to accounting unit 130. Ex. 1003, 4:11–13. “Accounting unit 130 returns to personal transport server 101 a price for each path.” *Id.* at 4:13–14. “Personal transport server 101 relays the paths and their corresponding prices back to the customer over the same connection over which it had received the request from the customer.” *Id.* at 4:14–17. “The customer then chooses a desired path which is relayed to personal transport server 101.” *Id.* at 4:18–19. Personal transport server 101 adds the selected path to its representation of the scheduled paths. *Id.* at 4:19–21. Confirmation of the selected path may be supplied to the customer. *Id.* at 4:20–21, 6:62–63; *see* Pet. 9–10.

Accounting unit 130 includes fare server 131 connected to rates database 137. Ex. 1003, 4:62–63. Fare server 131 computes the fares for each path supplied by personal transport server 101. *Id.* at 4:62–64.

Accounting unit 130 also includes account server 133 connected to accounts database 139. *Id.* at 5:3–5. Account server 133 is responsible for billing a passenger after completing a ride. *Id.* at 5:3–4. Account server 133 may be connected to credit services 138, e.g., commercial credit card databases or telephone customer databases. *Id.* at 5:9–6:1 (not including Table 1); *see* Pet. 9–10.

The functions of personal transport server 101, routing unit 110, and accounting unit 130 are implemented by various computers as shown in Figure 4. Ex. 1003, 9:29–40. As shown in Figure 5, each of these computers has communication interface 307 and display 309. *See* Pet.10.

The display of each computer enables a customer to enter the relevant data and see the paths and their corresponding prices over the same connection from which the request of the customer was received. Ex. 1003, 4:11–17. The display also enables a customer to select a desired path. *Id.* at 4:18–19. The consumer then pays for the selected path and receives confirmation of the selected path via the display. *Id.* at 6:63–67; Pet. 11.

b. Clagett

Clagett discloses a public pay telephone station. Ex. 1004, [57]. The station may be used by a traveler or business person desiring taxi service in a strange city. *Id.* at 7:19–21. The traveler may “call up the directory information from the telephone network directory store 72” or insert a disk containing geographic data relating to listed taxi services, which permits the user to select a taxi company from those listed in the yellow page directory information. *Id.* at 7:21–26, 47–50. The user may select a destination using map information from the disk including nearby hotels, restaurants, fast food establishments, etc. *Id.* at 7:40–42; *see* Pet. 11.

Figure 1 of Clagett is reproduced below.

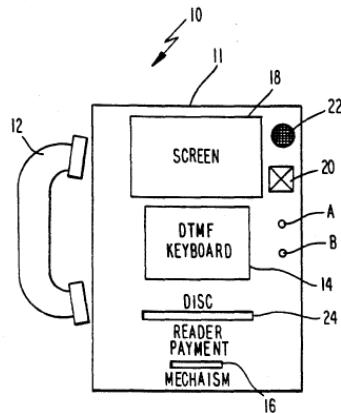


FIG. 1

Figure 1 of Clagett shows a diagrammatic illustration of a public pay telephone station constructed according to a preferred embodiment of the Clagett invention. Ex. 1004, 3:26–28. Figure 1 shows exemplary public pay station 10 with keyboard 14, a payment mechanism illustrated as coin or card slot (or both) 16, display screen 18, and cursor control switches or buttons 20. *Id.* at 3:46–53. The cursor buttons may be provided in the conventional x-y or up-down, left-right form. *Id.* at 3:54–55. “The cursor switch 20 allows the user to control the position of the screen graphics cursor.” *Id.* at 5:27–28; *see* Pet. 12. By actuating the payment mechanism of the public telephone station and inserting his/her disk containing directory information, which includes the geography of a particular city, the user can call up yellow page directory information for taxi service. Ex. 1004, 7:21–26. “The display screen 18 and the cursor control switches or button 20 enable a traveler to select a taxi company from those displayed and listed from an electronic database.” *See* Pet. 12–13; Ex. 1004, 7:19–42.

c. Nimura

Figure 1 of Nimura is reproduced below.

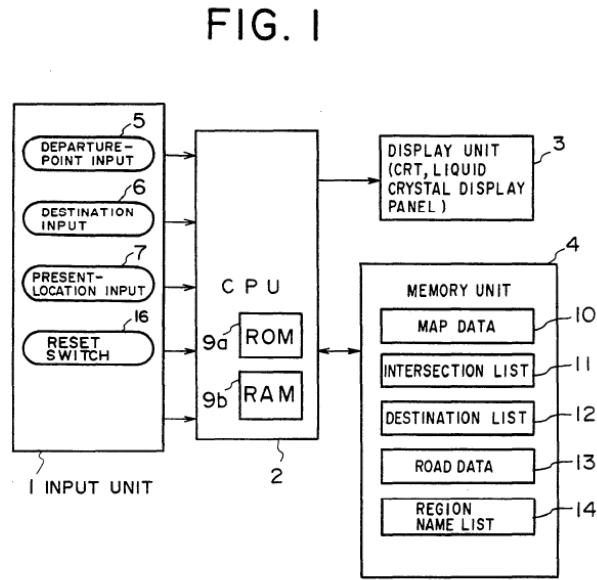


FIG. 1 of Nimura is a diagram of a navigation apparatus according to one embodiment of the Nimura invention. Ex. 1005, 4:18–19. Figure 1 of Nimura depicts input unit 1 with input means for departure point input 5 and destination input 6. *Id.* at 5:33–39. Destination list 12 is stored in memory unit 4, which is in communication with central processing unit (“CPU”) 2 and display unit 3. *Id.* at 5:33–62; see Pet. 14.

Figure 11c of Nimura is reproduced below.

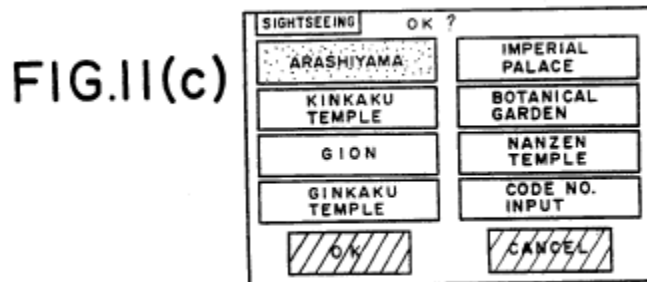


Figure 11c of Nimura shows the confirmation provided to a user after selecting an option from the sightseeing genre. Ex. 1005, 8:29–34; see Pet. 15.

Figures 11a–c of Nimura depict a touch panel for selecting a destination genre, reviewing listed destinations, selecting a particular destination, and viewing confirmation of the selection. Ex. 1005, 3:64–4:15. The listed destination genres in Figure 11a include sightseeing, lodgings, dining, and souvenirs. *Id.* at 3:64–4:15. These destinations are displayed in a color indicating that they are selectable items, and a desired genre is selected by touch-panel input. *Id.*; see Pet. 14.

4. Obviousness over Penzias, Clagett, and Nimura

Petitioner challenges claims 1 and 7 as unpatentable under 35 U.S.C. § 103(a) over the combination of Penzias, Clagett, and Nimura. Pet. 8–32.

Patent Owner and Petitioner have both argued that we should apply the plain and ordinary meaning to the claim terminology “transportation companies” based upon how a person of ordinary skill in the art would have understood that term in light of the Specification and prosecution history.

As we held in our claim construction section above, a transportation company should be defined as a “commercial business” for transportation services, but most important is that the claim term “transportation companies” refers to plural companies.

That is, there must be more than one transportation company in the claimed “method for delivering instructional messages to said customer regarding private transportation *companies* and estimated costs for hiring said transportation company.” Ex. 1001, 6:21–24 (emphases added). Claim 1 further requires “displaying a list of authorized transportation *companies* for selection by the operator of the computer;” and a selection by a user where the method requires “displaying the approximate fare for the number of passengers promoted [*sic*: prompted] to a selected destination and types of payment options honored *by said selected company*.” *Id.* at 6:28–29, 6:34–36 (emphases added).²

Petitioner contends that, during the prosecution history of the ’619 patent, the term “taxi company” in the originally filed claims was replaced by “transportation company” and “private transportation companies” and, therefore, a broader interpretation is reasonable. Pet. 17; Ex. 1002, 48–49; Andrews (Ex. 1012) ¶ 44; Reply 9–10.

Petitioner provides examples of transportation companies offering vehicles for hire or such as taxi companies, individual contractors, and drivers. Pet. 17; Andrews (Ex. 1012) ¶¶ 50–51; Reply 9–10.

² The claim language was amended to be “for the number of passengers *prompted* to a selected destination” rather than as printed “promoted.” (Emphasis added.) Exhibit 1002 Prosecution History; the amendment dated, May 10, 1999, page 1.

During the oral hearing, Petitioner clarified that Petitioner has two alternative interpretations regarding the combination of the three prior art references. Tr. 16–18. Petitioner presents two alternative interpretations of the asserted ground of unpatentability based on the combination of Penzias, Clagett, and Nimura. Tr. 16; Pet. 8–11, 16–18, 21–28.

First, Petitioner relies upon Penzias alone to teach the multiple “transportation companies” limitation. (First Alternative). Petitioner contends that the paths in Penzias are equivalent to plural transportation companies. Tr. 16–18; Pet. 9–10, 16–17; Ex. 1003, 1:7–10, 1:54–60; Reply 17–20.

Second, Petitioner relies upon Penzias together with the display of a list of “transportation companies” in Clagett to teach the multiple “transportation companies” limitation. (Second Alternative). Pet. 17–18; Reply 21–22. With regard to this second alternative, Petitioner argues that Clagett teaches a selection of a taxi company from the yellow page directory information. Pet. 11. Petitioner contends that, if the separate paths in Penzias are not considered as individual transportation companies, then Clagett teaches that a user may select from a list of taxi companies a specific taxi company from those listed in the yellow page directory with a program actuated cursor and, upon making a selection, the user presses a button to actuate an auto-dialer to initiate a call to the designated taxi company for dispatch of a taxi to the telephone station. Pet. 17; Ex. 1004, 7:19–38. We address each of these two alternatives in turn prior to addressing the parties’ remaining arguments.

a. First Alternative

We find that Penzias does not teach or suggest multiple transportation entities/companies, but merely teaches and suggests a user interface for a single transportation company with multiple multi-passenger vans having multiple paths, which we find provides a user interface for only this single transportation company.

Petitioner contends that the phrase “private transportation companies” is only used in the preamble and does not appear anywhere else in the claims or Specification. Pet. 17. Petitioner further contends that, in the prosecution history, the phrase “private transportation companies” was added to the preamble in a Response filed on May 13, 1999 (“1999 Response”). *Id.* (citing Ex. 1002, 49). Petitioner argues that, in the remarks of the 1999 Response, it was stated that “Applicant’s invention is directed, to a computer system for [selection] of private transportation companies such as taxis.” *Id.* (quoting Ex. 1002, 50). Petitioner further argues that, based on this assertion, the phrase “private transportation companies” in the challenged claims includes taxis. Pet. 17. We find Petitioner’s assertion unavailing because it does not address the plural “[transportation] companies.”

In the First Alternative, Petitioner’s expert, Mr. Andrews, proffers that the vehicles in the system of Penzias “may” represent different transportation companies such that the paths in Penzias are offered by more than one transportation company to provide competition and quicker response times. Pet. 17; Ex. 1012, ¶¶ 47–51.

We find that Penzias is limited to a single company based on the disclosed level of control of the routes and the control of drivers of the multi-passenger vehicles. Moreover, Petitioner has provided insufficient

evidence to the contrary. As we explained in our claim construction section above, the plain and ordinary meaning of the claim term “transportation companies” requires multiple companies, and Petitioner has provided insufficient evidence that Penzias discloses, teaches, or suggests an interface for selection from multiple transportation companies in a list.

During oral argument, Petitioner contended Penzias teaches or suggests plural transportation companies. Tr. 17–18.

When questioned regarding the interpretation of multiple paths as equating to multiple transportation companies, Petitioner’s representative identified the end of paragraph 119 of Mr. Andrews’ declaration. Tr. 19; see Ex. 1012.

The relevant part of Mr. Andrews’ declaration states:

The set of multipassenger vehicles in Penzias *could include* some drivers representing the same transportation companies or *some could operate* a company as the sole owner such as “Joe’s taxi company LLC.” One of ordinary skill in the art designing a system such as that disclosed in Penzias would be motivated to provide options from different transportation companies, at least because Penzias provides the cost for each route, and competition between various transportation companies enhances the offerings based on cost, allows comparison shopping, and generally gives greater freedom to consumers interfacing with taxi services. Based on at least these factors, one of ordinary skill in the art would have been motivated to *enable the paths in Penzias to be associated with multiple transportation companies*.

Ex. 1012, ¶ 119 (emphases added). Additionally, Mr. Andrews states:

A path in Penzias may also involve transfers with multiple rides in different multi-passenger vehicles such that a path is not necessarily provided by a single specific transportation company, but *could represent several*.

Id. ¶ 120 (emphasis added).

We find Mr. Andrew’s supporting testimony to be based upon speculation and conjecture. While Mr. Andrews speculates that the multiple paths “could represent” several transportation companies, Mr. Andrews provides no evidence to support a finding that Penzias teaches or suggests a user interface for the multiple transportation companies. Consequently, we do not credit Mr. Andrews’ testimony in this regard because it is not supported by the disclosure in Penzias. *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.”).

We have reviewed Petitioner’s analysis, which is rebutted by Patent Owner, and we conclude that the First Alternative based upon the teachings of Penzias alone for the claimed multiple “transportation companies” is deficient because Petitioner has not shown that Penzias teaches or suggests multiple “transportation companies,” but merely shows multiple routes by different drivers of multi-passenger vans all controlled by a single transportation company. As a result, Penzias does not teach or suggest “displaying a list of authorized transportation companies for selection by the operator of the computer,” where the user selects a desired company, followed by displaying the proximate fare for the selected location and payment options honored by the selected company, and then initiating a dispatch call for available taxi from the selected company, as required by the method of independent claim 1. We find that Penzias only provides a process for a single “transportation company” and does not provide any teaching or suggestion to expand the user interface and process for multiple “transportation companies.”

b. Second Alternative

In the Petitioner's Second Alternative, Petitioner relies upon Clagett to teach and suggest multiple transportation companies and a user interface thereto.

In the Second Alternative, Petitioner's expert, Mr. Andrews, contends that, to the extent Penzias is not considered to disclose private transportation companies, Clagett discloses a system permitting "a traveler or business person desiring taxi service in a strange city" to select an option from the taxi companies in a city as listed in a yellow page directory. Pet. 17; *see* Ex. 1004, 7:20–25; Ex. 1012, ¶ 79.

In Clagett, a microprocessor may identify a taxi company capable of rendering prompt service to the location of the particular telephone station. Ex. 1004, 7:30–33. However, Clagett indicates a user selects a taxi company from those listed in a yellow page directory with a program actuated cursor and then presses a button to actuate an auto-dialer to initiate a call to the designated taxi company for dispatch of a taxi to the telephone station. *Id.* at 7:33–38.

Petitioner contends a POSA would have been motivated to enable the paths in Penzias to be associated with various taxi companies, as taught by Clagett, because the taxi companies provide security and the resulting competition yields better prices and response times. Pet. 17–18; *see* Ex. 1012, ¶¶ 160–162.

Additionally, Petitioner contends a POSA would have been further motivated to modify the combination of Penzias and Clagett with the teachings of Nimura to enable a consumer to select from listed destinations

and to receive messages about the listed destinations, such as confirmation of the selected destination as shown in Figure 11c of Nimura. Pet. 18, 32; see Ex. 1012, ¶¶ 125–127, 161. Figures 11a–b of Nimura depict a touch panel enabling a user to select a genre and then a particular destination from listed destinations. Pet. 18; see Ex. 1012, ¶¶ 125–127.

In the Patent Owner Response, Patent Owner proffers:

A caller using the *Clagett* phone can automatically dial the number of a locally-selected taxi company – from a digital list of companies listed on the phone’s display to arrange for a pickup at that phone’s recorded location. See EX1004 7:19-40. There is no way to digitally specify number of riders, destination locations, or receive approximate fares for a trip between that phone and the destination location. See *id.* Where *Clagett* discloses that “[t]his same methodology may be utilized for the purpose for selecting nearby hotels, restaurants, fast food establishments, etc.”, the specification is referring to the caller’s ability to select from a list of local establishments, and call them to discuss matters related to their business. The specification does not disclose conveying the system allowing for the selection of hotels or restaurants to a particular taxi dispatcher. Finally, using the “payment mechanism” does not result in a payment to the contacted taxi service, but instead is a required prerequisite for using the phone at all, much like the payment of a nick[el], dime, or quarter for using a standard pay phone for a telephone call. See EX1004, 7:22-25.

PO Resp. 15–16.

Although we agree with Petitioner that information for telephonically calling multiple companies is displayed in a list to the user on the telephone, Petitioner has not identified how *Clagett* provides further disclosure of additional user interaction steps beyond verbal communications with a selected company that is “auto-dialed.” Petitioner has not identified any

additional user interface steps taught by Clagett that would permit a user to obtain transportation services by a means other than via traditional voice-based telephone communication. Consequently, the combination of Penzias and Clagett would not teach or suggest the additional computer interface functionality required by independent claim 1. As a result, Petitioner has not explained sufficiently how the combination of Penzias and Clagett (in view of Nimura) would teach or suggest the claimed:

[a] method as implemented on a computer system for use by a consumer, said method for delivering instructional messages to said consumer regarding private transportation companies and estimated costs for hiring said transportation company for transporting said consumer to listed destinations and further providing an automated taxi dispatch and payment honoring system.

Ex. 1001, 6:20–26.

Additionally, we find the selection step in the combination of the Penzias and Clagett would merely teach or suggest providing a user interface for a single transportation company. But, we cannot agree with Petitioner that the combination would suggest to one of ordinary skill in the art at the time of the invention in 1997 to provide an interface to multiple transportation companies, thereby allowing the user to select between multiple companies and then provide corresponding further user interface for the selected company which would continue the process of initiating dispatch for the selected company and providing an estimate of approximate arrival time of the dispatched taxi for the selected company (vehicle for hire). Consequently, Petitioner has not shown that Clagett teaches or suggests any additional functionality for interfacing to the user. Petitioner

relies upon Clagett for the displaying of a list of authorized transportation companies for selection by an operator of computer, but Clagett merely teaches a telephone interface for multiple taxi companies, and Petitioner provides no teaching or suggestion in Clagett of subsequent underlying process steps beyond the traditional verbal dialogue with a telephone operator at any selected taxi company.

Although Penzias may teach or suggest some of the method steps of independent claim 1, Petitioner has not shown that Penzias teaches or suggests to one of ordinary skill in the art (either as identified by Patent Owner or Petitioner) how to combine the limited interface of Clagett with the single interface of Penzias.

Petitioner's proffered rationale for the motivation for the Second Alternative is summarized in the Reply as follows:

Second, Petitioner showed that, based on the teachings of the applied references, it would have been obvious to combine *Penzias*, *Clagett*, and *Nimura* according to known methods to yield predictable results. Pet., 31–32. The Petition provided adequate reasoning based on rational underpinnings for why one of ordinary skill in the art would have modified the asserted prior art. Pet., 31–32 (citing Ex. 1012, ¶¶ 160–162); *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006); *KSR*, 550 U.S. at 418. Accordingly, the Board should reject Patent Owner's erroneous problem-solution argument about why a POSA would have combined the asserted references.

Reply 25–26. Again, we disagree with the Petitioner and find that the proffered combination falls short of merely yielding predictable results.

Petitioner has provided insufficient evidence that, at the time of the invention in 1997, it would have been obvious to one of ordinary

skill in the art to provide a user interface for multiple transportation companies to deliver instructional messages to the consumer to allow the consumer to select a desired company and provide the relevant claimed information to ultimately dispatch a taxi/transportation vehicle/vehicle for hire from the selected company.

We may speculate that, although the Clagett teaches a directory of companies for a user to contact a single selected transportation company, Clagett is silent as to how the single selected transportation company would provide a user interface for any of the claimed steps 2–6 of independent claim 1. As a result, the combination of Penzias with Clagett would provide a useful user interface system only for one selectable transportation company. If the user selected any other transportation company beyond the single transportation company as taught by Penzias, there would be no computer implementable system for the user to perform the method steps 2–6, which effectively negates the plural selectable [private; authorized] transportation companies because the user interface would not perform steps 2–6 for plural companies.

Neither Petitioner nor Patent Owner address, in detail, Nimura and neither Petitioner nor Patent Owner has argued that Nimura would have remedied this deficiency in the combination of Penzias and Clagett identified above. Therefore, we need not address Petitioner's reliance on Nimura to teach certain aspects of independent claim 1 because Petitioner does not contend Nimura cures the deficiencies in Petitioner's reliance on Penzias and Clagett to teach discussed aspects of independent claim 1.

Therefore, we find that even if one of ordinary skill in the art would have combined the teachings of Penzias and Clagett as argued by Petitioner in the Petition, the combination would not have taught or suggested the multiple “transportation companies” limitation. At most, we find the combination of Clagett with Penzias would teach or suggest that, if a user selected the single transportation company that has a computer user interface, then the user could perform other than the plural companies limitations of independent claim 1, but not if the user selected any other transportation company. Additionally, Petitioner provides no persuasive evidence as to how the computer user interface of Penzias could be loaded to the pay telephone at the time of the invention beyond the memory disk, which stores the phone directory. Nor does Petitioner provide any persuasive evidence regarding the operating system and differences thereto of Penzias to load and operate a computer user interface at the pay telephone of Clagett, which Petitioner asserts teaches the additional method steps 2–6 required by independent claim 1. While one user may select a taxi company from the phone book of Clagett, neither Clagett, Penzias, nor a combination thereof teaches or suggests a user interface for multiple transportation companies for the six (6) separate steps/functions recited in the language of independent claim 1. Nor has Petitioner identified how POSA would have modified the teachings of Penzias regarding a single user interface such that it is applicable to a user interface for multiple “[transportation] companies.”

c. Prosecution History Argument

Petitioner proffers that the prosecution history of the ’619 patent mentions that multiple types of transportation services may be

summoned/ordered. Tr. 24–25; Pet. 17 (citing Ex. 1012, ¶ 47–51) (“[T]he invention could readily be used to summons any other type of transportation service, including but not limited to shuttlebuses, limousines, private cars for hire, city buses and other types of vehicles for hire.” (quoting Ex. 1001, 5:39–43)).

We determine the prosecution history provides no express information to change the claim interpretation beyond the plain and ordinary meaning of the claim limitations. As a result, irrespective of the level of skill in the art, as identified by either the Petitioner or Patent Owner, we find the combination of Penzias and Claggett does not account properly for the multiple “transportation companies” limitation, as advanced by Petitioner in the proffered ground based on obviousness.

Neither Petitioner nor Patent Owner have sufficiently addressed Nimura as it relates to the above-noted deficiency with regards to the multiple “transportation companies,” and, therefore, we need not address Nimura beyond finding that Nimura does not remedy the above-noted deficiency.

d. Unified Communications Arguments

Petitioner further argues:

For example, Patent Owner alleges the problem surmounted by Mr. Parades was “the need for a unified communication, dispatching, and payment honoring system.” *Id.* at 8 [PO Reply, 8–11]. But as laid out in the Petition, Penzias disclosed such a unified system before Mr. Parades, rendering such argument moot. Pet., 8–11.

What’s more, Patent Owner attempts to discredit the testimony of Petitioner’s expert, Scott Andrews, via a newly

proposed definition of the POSA. POR, 20–21. Even putting aside that the Board considers relevant expert testimony regardless of the level of skill, Trial Practice Guide Update, 3, Patent Owner fails to provide a rational basis for excluding a highly qualified, experienced electrical engineer, such as Mr. Andrews. Those in glass houses should not throw stones: it is the testimony of Mr. Paredes that should be looked at askance in light of his financial interest in the ‘619 Patent.

(Reply 3).

We disagree with Petitioner’s conclusion and do not find the argument to be moot. Rather, we find that Penzias merely discloses a system for a single transportation company with all its corresponding processing and dispatching of vehicles for hire. Even in light of the proffered financial interests of Mr. Paredes, Petitioner has not shown any teaching or suggestion in Penzias, Clagett, and Nimura, either alone or in combination, to provide the claimed “method as implemented on a computer system for use by a consumer, said method for delivering instructional messages to said consumer regarding private transportation companies and estimated costs for hiring said transportation company for transporting said consumer to listed destinations and further providing an automated taxi dispatch and payment honoring system,” as recited in the language of independent claim 1.

At most, the combination of Clagett with Penzias, at the time of the invention in 1997, would provide a listing of plural contacts for a user to verbally discuss and verbally order dispatch of a taxi or vehicle for hire, but this combination does not suggest the single computer user interface system of Penzias is capable of providing multiple interfaces for separate transportation companies or providing a single universal user interface for multiple transportation companies.

e. Temporal limitation argument

With respect to the Petitioner's argument regarding the "payment honoring system," Petitioner contends that this limitation lacks a "temporal limitation requiring prebilling and merely refers to a system for a customer to pay a company providing a ride, such as by using a credit card." Reply 7–8 (citing Ex. 1001, 2:43, 4:39–40; Pet. 20).

Although we agree with Petitioner that independent claim 1 does not set forth specific express temporal limitations, the express sequence of steps of independent method claim 1 must be met by the combination of teachings. We find the sequence of steps in independent claim 1 referring to previous steps and system elements sets forth an inherent temporal sequence in the claimed method. Claim 1 requires displaying a list of authorized transportation companies for selection in step 1 and refers back to "said selected company" and "said selected taxi company." Consequently, the prior art combination must teach or suggest:

- (1) displaying a list of authorized transportation companies for selection by the operator of the computer;
- (2) prompting the consumer to insert the amount of passengers to be traveling in the transportation vehicle;
- (3) graphically illustrating destination locations;
- (4) displaying the approximate fare for the number of passengers promoted to a selected destination and types of payment options honored by said selected company;
- (5) initiating a dispatch call for an available taxi from said selected taxi company;
- (6) estimate the approximate arrival time for said dispatched taxi.

As a result, Penzias alone does not provide the display of a list of authorized transportation companies for selection and Clagett merely provides a display of transportation companies' contact information, but does not provide any of the other claimed method steps in the claimed sequence of steps. Therefore, the combination does not teach or suggest the claimed method steps in the claimed sequence of steps.

f. Long Felt Need Argument

With respect to Petitioner's Reply to the Patent Owner's long felt yet unmet need in the industry by providing a vehicle for hire service that enabled customers to "self serve," we need not reach the long felt need argument because we find the base combination to be insufficient to establish obviousness, as discussed above. Reply 26–27.

g. Financial Interest Argument

Finally, Petitioner proffers that Mr. Paredes admitted that he has a financial interest in the '619 patent and we should consider Mr. Paredes financial interest and accord his testimony appropriate weight. Reply 29.

We need not reach or evaluate the financial interest in the '619 Patent because we find the base combination of Penzias, Clagett, and Nimura to be insufficient to establish obviousness.

h. Conclusion

We have reviewed Petitioner’s analysis, which is now rebutted on this record, and conclude that Petitioner lacks teachings or suggestions for the recited limitations regarding the multiple “transportation companies” and selection of a single transportation company and the continuation of the method steps 2–6 recited in independent claim 1. Although Petitioner sets forth a line of reasoning for the proffered combination relying on the three prior art references and Mr. Andrews’s testimony, Petitioner has not shown, by a preponderance of the evidence, that the prior art references, individually or in combination, teach or suggest the subject matter of independent claim 1.

By virtue of its dependency, dependent claim 7 includes all the limitations of independent claim 1. As we explain above, we found Petitioner’s proffered combination to be insufficient to show unpatentability of independent claim 1. As a result, Petitioner’s same combination does not evidence the unpatentability of dependent claim 7.

Accordingly, we conclude that Petitioner has not demonstrated, by a preponderance of the evidence, that claims 1 and 7 are unpatentable under 35 U.S.C. § 103(a) over the combination of Penzias, Clagett, and Nimura.

5. Obviousness over Penzias, Clagett, Nimura, and Behr

Petitioner challenges dependent claims 2–6 as unpatentable under 35 U.S.C. § 103(a) over the combination of Penzias, Clagett, Nimura, and Behr. Pet. 32–44.

We find Petitioner has not identified how Behr remedies the deficiency in Petitioner’s arguments and evidence of obviousness in the base

combination of Penzias in view of Clagett and Nimura. For the same reasons discussed above, those arguments are not persuasive to dependent claims 2–6. Therefore, Petitioner has not demonstrated that the subject matter of claims 2–6 would have been obvious to one of ordinary skill in the art at the time of the invention based upon the combination of Penzias, Clagett, Nimura, and Behr.

Accordingly, we conclude that Petitioner has not demonstrated, by a preponderance of the evidence, that claims 2–6 are unpatentable under 35 U.S.C. § 103(a) over the combination of Penzias, Clagett, Nimura, and Behr.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, based on a preponderance of the evidence, claims 1–7 of the '619 patent have not been shown to be unpatentable;

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

IPR2017-01865
Patent 5,973,619

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