

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

IRON OAK TECHNOLOGIES, LLC,
Patent Owner.

IPR2019-00107
Patent 5,966,658

Before PATRICK R. SCANLON, KEVIN W. CHERRY, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

PESLAK, *Administrative Patent Judge*

JUDGMENT
Final Written Decision
Determining the Sole Challenged Claim Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

Petitioner, Microsoft Corporation (“Petitioner”), filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claim 1 (the “challenged claim”) of U.S. Patent No. 5,966,658 (Ex. 1001, “the ’658 patent”). Petitioner submitted a Declaration of Dr. Steve R. White (Ex. 1003, “White Decl.”) in support of the Petition. Patent Owner, Iron Oak Technologies, LLC (“Patent Owner”), timely filed a Preliminary Response (Paper 6, “Prelim. Resp.”). Taking into account the arguments presented in Patent Owner’s Preliminary Response, we determined that the information presented in the Petition established that there was a reasonable likelihood that Petitioner would prevail in challenging claim 1 of the ’658 patent as unpatentable under 35 U.S.C. § 102.¹ On May 15, 2019, we instituted this *inter partes* review, as to the challenged claim and all grounds presented in the Petition. Paper 8 (“Dec.”).

During the course of trial, Patent Owner timely filed a Patent Owner Response (Paper 10, “PO Resp.”). Petitioner timely filed a Reply to Patent Owner’s Response (Paper 14, “Pet. Reply”). Patent Owner timely filed a Sur-reply (Paper 15, “Sur-reply”). An oral hearing was held on February 13, 2020 and a transcript of the hearing has been entered into the record (Paper 22, “Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of claim 1 of the

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 102. Because the ’658 patent was filed before March 16, 2013 (the effective date of the relevant amendment), the pre-AIA version of § 102 applies.

'658 patent. For the reasons discussed below, we determine that Petitioner has demonstrated by a preponderance of the evidence that claim 1 is unpatentable under 35 U.S.C. § 102 and/or § 103(a).

A. Related Matters

The parties state that the '658 patent is the subject of the following civil actions:

- 1) *Iron Oak Techs. LLC v. Dell Inc.*, No. 3:18-cv-1542 (N.D. Tex.);
- 2) *Iron Oak Techs. LLC v. Sharp Elecs. Corp. and Sharp Corp.*, No. 3:17-cv-02699 (N.D. Tex.);
- 3) *Iron Oak Techs. LLC v. Lenovo (United States) Inc. and Lenovo Holding Co., Inc.*, No. 3:18-cv-1539 (N.D. Tex.);
- 4) *Iron Oak Techs. LLC v. Acer Am. Corp.*, No. 3:18-cv-1543 (N.D. Tex.);
- 5) *Iron Oak Techs. LLC v. Fujitsu Am. Inc.*, No. 3:16-cv-03319 (N.D. Tex.);
- 6) *Iron Oak Techs. LLC v. Toshiba Am. Info. Sys. Inc. and Toshiba Corp.*, No. 3:16-cv-03320 (N.D. Tex.);
- 7) *Iron Oak Techs. LLC v. Asustek Computer Inc.*, No. 3:16-cv-03322 (N.D. Tex.);
- 8) *Iron Oak Techs. LLC v. Samsung Elecs. America, Inc.*, 3:16-cv-3319 (N.D. Tex.); and
- 9) *Iron Oaks Techs. LLC v. Microsoft Corp.*, No. 3:18-cv-0222 (N.D. Tex.).

Pet. 3–4; Paper 7, 3–4.

The '658 patent is subject to review in:

- 1) *Unified Patents Inc. v. Iron Oak Techs., LLC*, IPR2018-00486. Pet. 3, Paper 7, 4; and
- 2) *Samsung Elecs. Co., Ltd. v. Iron Oak Techs. LLC*, IPR2018-01554. Pet. 3, Paper 7, 4.

B. The '658 Patent (Ex. 1001)

The '658 patent issued on October 12, 1999, and is entitled “Automated Selection of a Communication Path.” Ex. 1001, codes (45),

(54). The '658 patent issued from U.S. Patent Application 08/718,951, filed on September 26, 1996. *Id.* at codes (21), (22).

The '658 patent generally “relates to mobile communications, and more particularly to the automated selection of a communication path.” Ex. 1001, 1:6–8. The '658 patent describes that “a plurality of alternate communication paths may be available to a mobile communications device.” *Id.* at 1:18–19. Among the types of communication paths disclosed are “a network of satellite-based or land-based transceivers, a public switched telephone network (PSTN), a mobile telecommunications switching office (MTSO), or any other suitable element for communications.” *Id.* at 1:21–25, 2:44–63, Fig. 1.

Figure 1, reproduced below, illustrates a system for selecting an alternate communication path for transmitting a message between vehicle 12 and remote location 14 over alternate communication paths. *Id.* at 3:23–25.

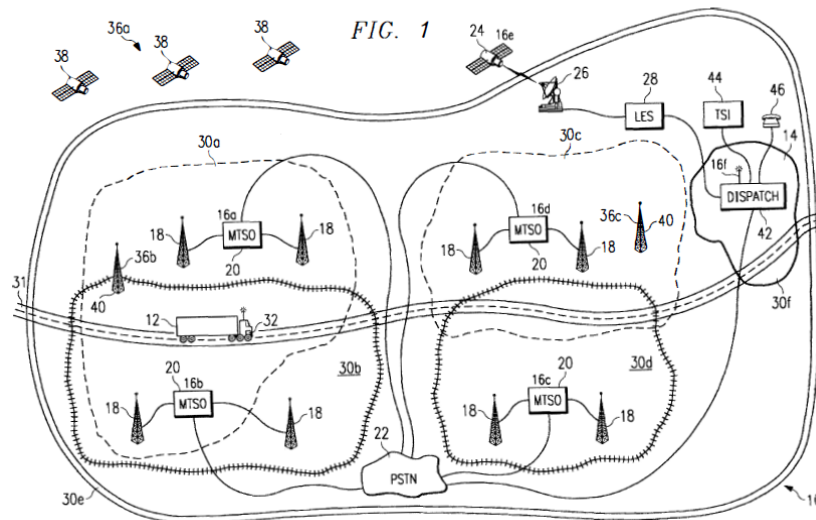


Figure 1 illustrates a system 10 for selecting one of a plurality of communication paths.

The '658 patent provides that “[c]ommunication over a communication path 16 may be implemented in a voice channel, control channel, paging channel, part of a seized voice or data channel.” *Id.* at 4:28–31.

The '658 patent describes that

[w]hen selecting a communication path 16, processor 72 may consider the functional characteristics of each communication path 16 (e.g., cost of communication, ability to deliver voice and/or data, ability to confirm receipt, propagation delay, speed, current load, or capacity). Processor 72 may also consider the various parameters for the communication (e.g., priority, preferred cost, preferred transmission time, amount of information to be communicated, type of communication, or confirmation of receipt).

Id. at 5:55–64.

The functional characteristics of the communication path and the various parameters for the communication are deemed “communication attributes.” *Id.* at 5:65. In one disclosed embodiment, processor 72 selects a communication path based on “the geographical position of the vehicle 12 and the priority of the communication” as the communication attribute. *Id.* at 5:66–6:3, Figs. 4, 5. In a second disclosed embodiment, “each communication attribute corresponds to a characteristic of a communication path 16.” *Id.* at 6:4–6, Figs. 6, 7.

The '658 patent describes

In operation, mobile unit 32 may receive a request for communication from either a user . . . or a sensor 82. Such a request for communication may specify various parameters for the communication, including priority, preferred cost, preferred transmission time, amount of information to be communicated, type of communication (e.g., data and/or voice), confirmation of receipt, and the like. This information may be conveyed in the form of one or more communication attributes. . . .

Furthermore, processor 72 may retrieve data, such as table 104 [Fig. 4] or table 120 [Fig. 6], relating to various alternate communication paths 16 from memory 74. Using this information, processor 72 selects the most appropriate communication path 16 for communication.

Id. at 9:52–66, 10:1.

C. Challenged Claim

Petitioner challenges independent claim 1, reproduced below.

1. An apparatus for automatically selecting one of a plurality of communication paths, the apparatus comprising:
 - a memory operable to store a plurality of ordered lists of communication paths, each ordered list associated with one of a plurality of communication attributes, each communication attribute representing a separate priority for communication; and
 - a processor operable to receive a request for communication, the request indicating a communication attribute, the processor further operable to automatically select a communication path from an ordered list associated with the indicated communication attribute.

Ex. 1001, 16:31–43.

D. Asserted Grounds of Unpatentability

Petitioner challenges claim 1 of the '658 patent based on the asserted grounds of unpatentability set forth in the following table (Pet. 5–6, 14–81):

Claim Challenged	35 U.S.C. §	Reference(s)/Basis
1	102	Oberlander ²
1	103	Oberlander
1	103	Oberlander Bamburak ³
1	103	Oberlander Eriksson ⁴
1	103	Oberlander, Burke ⁵ with or without Bamburak or Eriksson
1	103	Dutta ⁶ , Oberlander
1	103	Dutta, Oberlander, Eriksson

II. ANALYSIS

A. Overview

Petitioner bears the burden of establishing the unpatentability of any claim by a preponderance of the evidence. 35 U.S.C. § 316 (e) (2012); 37 C.F.R. § 42.1(d) (2018). This burden of persuasion never shifts to the patent

² U.S. Patent No. 5,509,000, issued April 16, 1996 (Ex. 1005, “Oberlander”).

³ U.S. Patent No. 5,832,367, issued Nov. 3, 1998 (Ex. 1006, “Bamburak”).

⁴ U.S. Patent No. 5,448,750, issued Sept. 5, 1995 (Ex. 1009, “Eriksson”).

⁵ U.S. Patent No. 5,406,642, issued April 11, 1995 (Ex. 1008, “Burke”).

⁶ U.S. Patent No. 5,953,319, issued Sept., 14, 1999 (Ex. 1007, “Dutta”).

owner. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

A claim is anticipated under 35 U.S.C. § 102 “only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). However, this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *See In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

A claim is unpatentable under § 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 skill in the art; and (4) when in evidence, objective indicia of non-obviousness (i.e., secondary considerations).⁷ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

We analyze the asserted grounds based on anticipation or obviousness with these principles in mind.

B. Level of Ordinary Skill in the Art

Petitioner contends that a person of ordinary skill in the art in the field of the '658 patent would have a “Bachelor’s degree in computer

⁷ No evidence of objective indicia of non-obviousness is in the record.

engineering, computer science, electrical engineering, physics or a similar discipline” and “at least two years of relevant experience including, for example, work related to computer and telecommunications networking.” Pet. 8 (citing Ex. 1003 ¶ 32). Patent Owner does not address the level of ordinary skill in the art. *See generally* PO Resp. Based on the foregoing, we adopt Petitioner’s definition of the level of ordinary skill in the art because it appears reasonable and consistent with the disclosure of the ’658 patent and the prior art of record.

C. Claim Construction

The ’658 patent expired on September 26, 2016. *See* Pet. 12. Thus, we construe the claims in accordance with the standard set forth in *Phillips v. AWH Corp.*, 415 F.3d 1309 (Fed. Cir. 2005) (en banc). *See* 37 C.F.R. § 42.5(b) (2018); *see also Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, 1279 (Fed. Cir. 2017) (“The Board construes claims of an expired patent in accordance with *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).”).

Petitioner requests that we construe the limitation “plurality of ordered lists of communication paths” as “multiple lists, each list containing multiple communication paths stored in a specified order.” Pet. 12–13. Petitioner contends that Patent Owner does not dispute this interpretation. *Id.* (citing Ex. 1010, 19).

Petitioner next requests that the limitation “communication path” be given its plain and ordinary meaning. *Id.* at 13. According to Petitioner, in co-pending District Court litigation, Patent Owner proposed that communication path be construed as “a path for communication uniquely

identified by the elements over which communications are transmitted or received.” *Id.* (citing Ex. 1010, 19).

Petitioner next requests that we construe “communication attribute” as a “parameter included with the communication request that represents a priority for communication.” *Id.* According to Petitioner, in co-pending District Court litigation, Patent Owner alternately proposed that this term be given its plain and ordinary meaning or be construed as “a characteristic indicated by a communication request.” *Id.* at 14 (citing Ex. 1010, 22).

Patent Owner submits that no claim terms require construction. PO Resp. 2–3.

Based on all the evidence of record and the parties’ respective arguments, we determine that express construction of these claim terms is not necessary for the purposes of this Decision. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Matal*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (noting that “we need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’”). To the extent necessary, claim terms will be construed below when addressing the parties’ arguments.

D. Anticipation by Oberlander

Petitioner contends that claim 1 is anticipated by Oberlander. Pet. 25–42. In support thereof, Petitioner identifies the disclosures in Oberlander alleged to describe the subject matter in the challenged claim. *Id.* Additionally, Petitioner offers declaration testimony from Dr. Steve R. White in support of its position. Ex. 1003 ¶¶ 71–92.

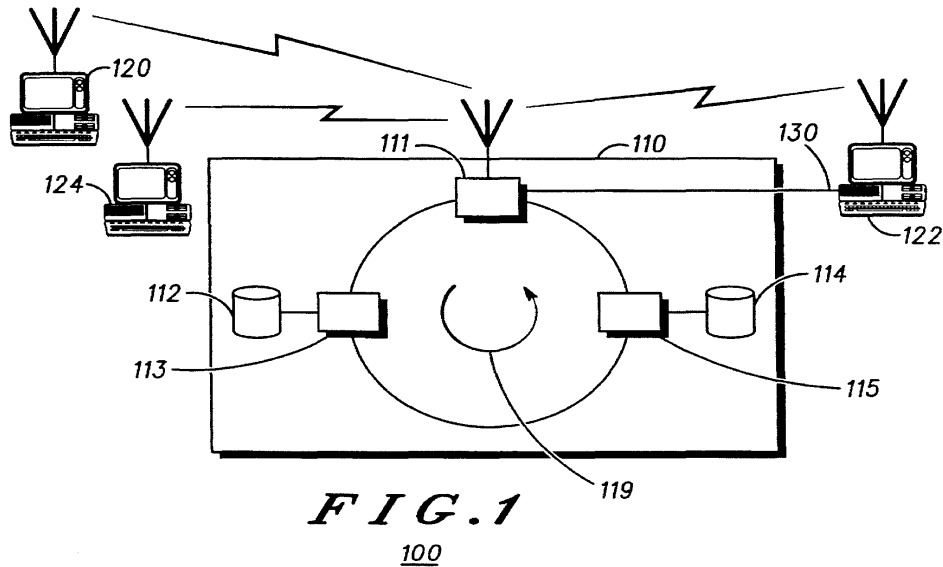
In the Patent Owner Response, Patent Owner contends that that Oberlander does not disclose a plurality of ordered lists of communication

paths “where ‘*each ordered list is associated with one of a plurality of communication attributes*’ where each communication attribute ‘represent[s] a separate priority for communication.’” PO Resp. 4.

Having considered all of the evidence of record and each of the parties’ arguments and for the reasons discussed below, we determine that Petitioner has demonstrated by a preponderance of the evidence that claim 1 of the ’658 Patent is anticipated by Oberlander. We begin our analysis with a brief overview of Oberlander. We then address the parties’ respective contentions with respect to the challenged claim.

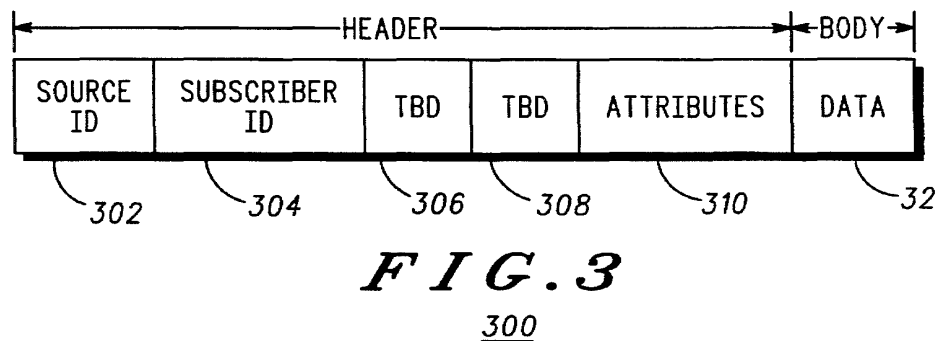
Overview of Oberlander

Oberlander is a United States Patent issued from an application filed June 10, 1994. Ex. 1005, code (22). Oberlander is directed “to a method and apparatus for routing information to a particular person (i.e., subscriber) via a particular destination device and over a particular network within a communication system.” *Id.* at 1:8–11. Oberlander notes that “the typical business individual may . . . prefer to receive a particular type of information at a particular one of her communicating devices.” *Id.* at 1:27–30. Figure 1 of Oberlander is reproduced below:



“Figure 1 illustrates in block diagram form a communication system.” *Id.* at 1:55–56.

Communication system 100, shown in Figure 1, “employs both wireless and wireline communication networks comprising a server 110 and a plurality of subscriber devices.” *Id.* at 2:30–32. Figure 3 of Oberlander is reproduced below:



“Figure 3 depicts the structure of a message for use within the communication system of Figure 1.” *Id.* at 1:59–60.

Message 300 includes attributes field 310. *Id.* at 3:48–53. The attributes field 310 “maintains information specific to the message 300” such as “message originator, message priority, message data format,

message logical size, message security requirements, message transmitted size, and message compressed size.” *Id.* at 3:66–4:5.

Figure 5 of Oberlander is reproduced below:

SUBSCRIBER ID	DEVICE ID	LIST NETWORK ID	FUNCTION LOGIC
1			
"			
"			
SUBSCRIBER ID			
2			
"			
"			

FIG. 5
500

Figure 5 of Oberlander shown above depicts an embodiment of Oberlander’s data base. *Id.* at 1:64–65.

Oberlander’s data base 500 shown in Figure 5 “comprises a plurality of records 510, each record comprises a subscriber ID field 502, a device ID field 504, a network ID list field 505 and a logic function field 506.” *Id.* at 4:43–46. Each record 510 represents “a rule that conditionally maps a subscriber and a selected device 120-124 to a prioritized list of communication networks.” *Id.* at 4:46–49. Oberlander discloses generating a key “to determine which network to use for transmission of the message . . . by applying the set of attribute 310 values of the message in

question to the logic function within field 506 of each data base 500 record.”
Id. at 4:64–5:1.

Analysis of Claim 1

a. Preamble

Petitioner contends that Oberlander discloses “an apparatus for automatically selecting one of a plurality of communication paths.” Pet. 25–27 (citing Ex. 1003 ¶¶ 73–75; Ex. 1005, 2:23–39, 2:55–62, 3:12–15, 3:62–66, 8:35–38). Specifically, Petitioner contends, *inter alia*, that Oberlander discloses “subscriber devices 120-124” each of which Petitioner contends is an apparatus. *Id.* at 25. According to Petitioner, each of Oberlander’s subscription devices “uses a network mobility manager (NMM) . . . that ‘selects one of a plurality of communication networks for transmission of the message.’” *Id.* at 26–27 (citing Ex. 1005, 3:12–15, 8:35–38). Petitioner further contends that because Oberlander discloses that its communication system may be wireless or wireline, Oberlander’s communication networks correspond to “communication paths” as recited in claim 1. *Id.* at 27 (citing Ex. 1003 ¶ 75; Ex. 1005, 2:29–32). Petitioner further contends that “[b]y automatically selecting a communication network from several networks, Oberlander’s subscriber device automatically selects a respective communication path from several paths” and therefore discloses “an apparatus for automatically selecting one of a plurality of communication paths.” *Id.* (citing Ex. 1003 ¶ 75).

Patent Owner does not dispute Petitioner’s contention that the subject matter of the preamble of claim 1 is disclosed by Oberlander. *See generally* PO Resp. 4–15.

Based on the arguments and evidence presented by Petitioner, Petitioner establishes that Oberlander discloses “[a]n apparatus for automatically selecting one of a plurality of communication paths.” Patent Owner does not argue that the preamble is not limiting. *See generally* PO Resp. We do not address whether the preamble is limiting because there is no dispute that Oberlander discloses the subject matter of the preamble.

b. a memory operable to store

Petitioner contends that Oberlander discloses this claim limitation. Pet. 28–29 (citing Ex. 1003 ¶¶ 79–82; Ex. 1005, 3:11–18, 3:25–26, 3:37–41, 4:49–51, Figs. 2, 5). Petitioner contends that “Oberlander’s server and subscriber device each include a RAM 240 . . . used ‘to control inbound and outbound data traffic.’” *Id.* at 28 (citing Ex. 1005, 3:25–26, 3:38–40, Fig. 2). Petitioner further contends that Oberlander’s “RAM maintains a network mobility manager (NMM) database used to select ‘one of a plurality of communication networks for transmission of a message,’” and thus, “Oberlander’s RAM is a memory that stores the NMM database and thereby stores network lists.” *Id.* (citing Ex. 1003 ¶ 79; Ex. 1005, 3:11–18, Fig. 1). Based on the foregoing, Petitioner concludes that Oberlander discloses a memory operable to store.

Patent Owner does not dispute Petitioner’s contention that Oberlander discloses this limitation. PO Resp. 4–15.

Based on the arguments and evidence presented by Petitioner discussed above, Petitioner establishes that Oberlander discloses “a memory operable to store.”

c. a plurality of ordered lists of communication paths

Petitioner contends that Oberlander discloses this claim limitation. Pet. 29–33 (citing Ex. 1003 ¶¶ 86, 88, 90, 91; Ex. 1005, 3:64–66; 4:38–51, 4:49–61, 5:6–11, 5:26–31, Figs. 5, 6). Petitioner contends that Oberlander discloses “‘a list of network ID’s identifying those communication networks which may be used to communicate the message in question to the selected destination device.’” *Id.* at 29 (citing Ex. 1005, 3:64–66). Petitioner further contends that Oberlander discloses “communication paths” under its plain and ordinary meaning because the “network ID lists have different communication paths and each path has individual network elements that comprise the path when in use.” *Id.* at 29–30 (citing Ex. 1003 ¶ 86). Petitioner further contends that Oberlander’s Figure 5 discloses a database with a plurality of records 510 “where ‘each record comprises . . . a network ID list field 505’” and the “network ID lists 505 contain multiple networks that each have their own assigned network ID.” *Id.* at 30–31 (citing Ex. 1005, 4:43–44, 5:6–11, Figs. 5, 6). Petitioner further contends that Oberlander’s “Figure 6 shows a network list stored in field 505 for the corresponding record 510 (*i.e.*, one subscriber ID to one selected device).” *Id.* at 31 (citing Ex. 1005, Fig. 6). Petitioner further contends that one of ordinary skill in the art would understand that “each record of Figure 5 identifies a list of network IDs shown in Figure 6.” *Id.* at 32 (citing Ex. 1003 ¶ 90). According to Petitioner, because “[e]ach network ID identifies a different communication network, it is thereby identifying a different communication path” and consequently “Figures 5 and 6 show ‘a plurality of . . . lists of communication paths.’” *Id.*

Petitioner next contends that in Oberlander’s Figure 5, “each record 510 represents a rule that conditionally maps a subscriber and a selected device 120-124 to a prioritized list of communication networks,” “each network ID list 505 is organized such that the most favored network appears in the first network identified field” and “[t]here are multiple lists for each subscriber ID.” *Id.* at 33 (citing Ex. 1003 ¶ 91; Ex. 1005, 4:44–49, 5:26–29, Fig. 5). Petitioner further contends that because Oberlander “discloses ‘multiple lists’ for a subscriber ID, and each of which is organized . . . in a specified order,” Oberlander “discloses ‘*a memory operable to store a plurality of ordered lists of communication paths.*’” *Id.* (citing Ex. 1003 ¶ 91).

Patent Owner does not dispute that Oberlander discloses “a plurality of ordered lists of communication paths.” *See* PO Resp. 7 (stating that Petitioner’s “contention could support a finding that each of Oberlander’s network ID lists is an ordered list”); *id.* at 10 (“assuming that Oberlander’s network ID lists are ordered lists of communication paths”); *id.* at 14 (“it is not disputed that each network ID list 505 is organized such that the most favored network appears first”).

Based on the arguments and evidence presented by Petitioner discussed above, Petitioner establishes that Oberlander discloses “a plurality of ordered lists of communication paths.”

d. each ordered list associated with one of a plurality of communication attributes

Petitioner contends that Oberlander discloses this claim limitation. Pet. 33–37 (citing Ex. 1003 ¶¶ 120–122, 124, 125; Ex. 1005, 2:28–31, 3:51–55, 3:47–4:9, 5:26–39, 4:56–5:1, 6:1–14, Fig. 3). Petitioner contends that the structure of Oberlander’s messages “include[s] an ‘attributes field’ which

‘maintains information specific to the message’ such as priority (“*a communication attribute*”) needed for transmission on a communication network.” *Id.* at 34 (citing Ex. 1003 ¶ 120; Ex. 1005, 3:66–4:6, Fig. 3). Petitioner further contends that Oberlander’s “message priority attribute would indicate that some messages require a higher message priority” and “some messages require a lower priority.” *Id.* at 35 (citing Ex. 1005, 6:1–14). Based on this, Petitioner contends that the organized network lists in Oberlander are “arranged according to these message attributes (*i.e.*, priority).” *Id.* (citing Ex. 1003 ¶ 121). Petitioner further contends “that messages with different priority values have different communication attributes” and thus, the varying priority levels disclosed in Oberlander correspond to the recited “plurality of communication attributes” as well as the priority attributes disclosed in the ’658 patent. *Id.* at 35–36 (citing Ex. 1001, 11:40–46; Ex. 1003 ¶ 124). Petitioner further contends that Oberlander’s “priority attributes with a network message are ‘*associated with*’ Oblerlander’s network ID lists” and that the “message represents a ‘communication request’ because Oberlander discloses that it includes ‘information to be communicated.’” *Id.* at 36 (citing Ex. 1003 ¶ 125; Ex. 1005, 2:28–31, 3:47–4:9, Fig. 3). Petitioner also contends that Oberlander’s “‘organized’ network lists rank the networks contained in the list from ‘most favored network’ to ‘a lower priority . . . network.’” *Id.* (citing Ex. 1005, 4:46–61, 5:26–31). Petitioner further contends that Oberlander’s priority attribute “is a ‘parameter’ that ‘represents the priority for communication’ and is ‘included in the communication request’” and thus discloses the limitation, “each ordered list associated with one of a plurality of communication attributes.” *Id.* at 37 (citing Ex. 1003 ¶ 125).

Patent Owner contends that Oberlander does not disclose this limitation. PO Resp. 4–15. The crux of Patent Owner’s contention is that Oberlander’s Network ID lists 505 are *not associated* with one of a plurality of communication attributes as required by claim 1. *See* PO Resp. 5–6 (“[E]ven presuming that Oberlander’s network ID lists constitute the ‘plurality of ordered lists of communication’, the Petition fails to establish that each of Oberlander’s network ID lists is associated with one of a plurality of communication attributes.”). In support of this contention, Patent Owner argues that the Networks ID lists 505 shown in Figure 5 of Oberlander do not meet this claim limitation because neither the Subscriber ID parameter 502 nor the Device ID parameter 504 represent a priority of communication and thus do not “constitute the one or more communication attributes.” *Id.* at 11. Patent Owner further argues that the conditioning logic functions 506 are not communication attributes because they are not communication parameters, “exist independently of Oberlander’s request for communication,” and “are not included in, or indicated by, Oberlander’s request for communication and cannot be determined or derived from those requests.” *Id.* at 11–12. Patent Owner submits that “Oberlander’s logic equations 506 are functions to which attributes contained in a request for communication can be applied.” *Id.* at 13; *see also* Sur-reply 5 (explaining that “attributes contained in *Oberlander’s* request for communication are applied [to logic functions 506] for evaluation”).

Petitioner replies that Patent Owner does not dispute that Oberlander’s message priority attribute in Oberlander’s attributes field 310 corresponds to the claimed “communication attribute.” Pet. Reply 5 (citing PO Resp. 7–8). Petitioner argues that Patent Owner “only contests whether such attribute is

associated with each of the ‘*ordered list[s]*’ disclosed in Oberlander.” *Id.* at 6. Petitioner argues that Patent Owner fails to address Petitioner’s arguments regarding Figure 3 of Oberlander by restricting “its analysis to the disclosures in Figure 5” based on an implicit claim construction “that an association of the claimed ‘*communication attributes*’ with the ‘*order[ed] lists*’ within the context of the 658 patent can only be achieved if such ‘*attributes*’ **reside in the same database as the ordered lists.**” *Id.* at 8 (citing PO Resp. 11). Petitioner then argues that “the claims only require the communication attribute to be ‘*associated with*’ an ordered list; there is no requirement that such attributes need to be confined to a specific structure.” *Id.* at 9. Petitioner further contends that Patent Owner does not argue that “associated with” in claim 1 “should be given any special meaning within the context of the 658 patent, nor does it sufficiently explain or support that implicit construction with evidence from the intrinsic record.” *Id.* Petitioner further argues that the Petition showed how the communication attributes are used with Oberlander’s logic functions for message routing. *Id.* at 9–10 (citing Pet. 36; Ex. 1005, 5:34–39). Petitioner further cites to Dr. White’s Declaration testimony and contends that “the communication attributes 310 — Oberlander’s message priority attribute (*i.e.*, ‘*communication attribute*’) — are applied to the logic functions in field 506 to determine which network . . . from the network ID list . . . the message will be routed on.” *Id.* at 10 (citing Ex. 1003 ¶ 125).

Patent Owner in the Sur-reply reiterates its contention that Oberlander’s logic functions 506 shown in Oberlander’s Figure 5 “are functions to which attributes contained in a request for communication can be applied, they are not themselves communication attributes and they are

not each associated with any particular communications attributes.” Sur-reply 7; *see also id.* at 5 (“[A] conditioning logic function 506 that is a function to which attributes contained in *Oberlander’s* request for communication are applied for evaluation.”) (citing Ex. 1005, 4:52–5:5). For the following reasons, we are not persuaded by Patent Owner’s contention.

Patent Owner’s contention is based on an implicit construction of “associated with” which requires that communication attributes be present in the structure of the data base shown in *Oberlander’s* Figure 5. However, Patent Owner does not provide any arguments or intrinsic evidence in support of such a construction. *See* PO Resp. 2–3. Further, a plain and ordinary meaning of the word “associated” is “related, connected, or combined together.” *See* <https://www.merriam-webster.com/dictionary/associated>. Consequently, the relevant inquiry is not whether communication attributes are present in the same table as the *Oberlander’s* network lists but rather whether the network lists are related to, connected to, or combined with communication attributes.

Oberlander’s message 300 contains attributes field 310 that includes various attributes of a message including “message priority,” as noted by Petitioner, and “message logical size.” Ex. 1005, 3:66–4:9; *see also* Ex. 1003 ¶ 125 (“attributes help determine which network . . . the message will be routed on.”) (citing Ex. 1005 4:62–5:1). Figure 7b of *Oberlander*, discloses “a graphical representation of a logic function that delimits messages based upon size.” *Id.* at 5:58–59, Fig. 7b. *Oberlander* further discloses in connection with Figure 9 that “the attribute 310 values of the received message 300 are applied to the logic function of the retrieved

record at block 912 by NMM 115. At block 914 a check is performed by NMM 115 to determine whether the logic function is true or false” based on the message attribute value. *Id.* at 8:47–51, Fig. 9. If the logic function is true at step 914, “flow proceeds to block 918, where the network ID list stored in field 505 of the retrieved record is written by NMM 115 into Null field 308 of the message 300.” *Id.* at 8:61–64, Fig. 9. As discussed above, message 300 includes attributes field 310. *Id.* at Fig. 9. Patent Owner confirms that this is the process by which Oberlander’s logic functions are used. *See* Sur-reply 6, 8–10. As a result, in the case of the logic function shown in Figure 7b, the network ID list stored in field 505 is related to (i.e., “associated with”) the communication attribute of message size. *See also* Ex. 1003 ¶ 125.

Based on the arguments and evidence presented by Petitioner discussed above and after considering Patent Owner’s arguments, we determine that Petitioner establishes that Oberlander discloses the limitation “each ordered list associated with one of a plurality of communication attributes.”

e. each communication attribute representing a separate priority for communication

Petitioner contends that Oberlander discloses this limitation. Pet. 37–38 (citing Ex. 1003 ¶ 139). Petitioner contends that Oberlander “organizes network lists based on factors (such as message priority) used in the ‘selection of one of . . . potential communication networks’” and “messages may contain a higher or lower priority requirement indicated by a message attribute (*e.g.*, a numerical value).” *Id.* at 37 (citing Ex. 1003 ¶ 139; Ex. 1005, 2:23–25, 6:1–14). Petitioner further contends that Oberlander discloses “two networks with different priority levels: a ‘most favored

network’ and a ‘lower priority . . . network.’” *Id.* (citing Ex. 1005, 5:26–31). Based on this, Petitioner contends that one of ordinary skill in the art would “recognize that Oberlander’s message priority attribute needs different parameters (*e.g.*, numerical values) . . . to request separate communication networks with different priority rankings.” *Id.* at 37–38 (citing Ex. 1003 ¶ 139).

Patent Owner does not dispute Petitioner’s contention that Oberlander discloses this limitation. PO Resp. 4–15.

Based on the arguments and evidence presented by Petitioner discussed above, Petitioner establishes that Oberlander discloses the limitation “each attribute representing a separate priority of communication.”

f. a processor operable to receive a request for communication

Petitioner contends that Oberlander discloses this limitation. Pet. 38–39 (citing Ex. 1003 ¶¶ 144–145). Petitioner contends that Oberlander’s “device has a processing unit that controls inbound and outbound data . . . and may be ‘for example, a microprocessor.’” *Id.* at 38 (citing Ex. 1005, 3:36–41, Fig. 2). Petitioner further contends that, in Oberlander, a “subscriber will transmit messages ‘locally within the individual’s subscriber device’” and discloses that a “routing procedure begins ‘upon receipt of a message 300 by NMM 115 [of the] subscriber device.’” *Id.* (citing Ex. 1005, 5:49–55, 8:26–28). Petitioner further contends that Oberlander discloses “that the user may define the priority of information by specifying a certain destination device.” *Id.* (citing Ex. 1005, 1:34–40). Based on the foregoing, Petitioner contends that the subscriber device in Oberlander “along with its processor, receives a request from a user to send

a message along with its priority (*‘receive a request for communication’*).”
Id. at 39 (citing Ex. 1004 ¶ 145).

Patent Owner does not dispute Petitioner’s contention that Oberlander discloses this limitation. PO Resp. 4–15.

Based on the arguments and evidence presented by Petitioner discussed above, Petitioner establishes that Oberlander discloses “a processor operable to receive a request for communication.”

g. the request indicating a communication attribute

Petitioner contends that Oberlander discloses this limitation. Pet. 39–40 (citing Ex. 1003 ¶ 154). Petitioner contends that the attributes field in Oberlander is specific to each message and includes a priority value of the message. *Id.* at 39 (citing Ex. 1005, 3:66–4:9, 6:9–15). Petitioner further contends that “a priority value attribute is a communication attribute because it represents the urgency with which a message is to be treated” and that “‘urgency’ is factored in the ‘selection of one of a plurality of potential communication networks.’” *Id.* (citing Ex. 1003 ¶ 154; Ex. 1005, 2:23–25). Petitioner further contends that, “Oberlander’s messages have communication attributes representing certain priorities (*‘a request indicating a communication attribute’*) needed in the selection of a network depending on the urgency of the message.” *Id.* at 39–40 (citing Ex. 1003 ¶ 154).

Patent Owner does not dispute Petitioner’s contention that Oberlander discloses this limitation. PO Resp. 4–15.

Based on the arguments and evidence presented by Petitioner discussed above, Petitioner establishes that Oberlander discloses the limitation “the request indicating a communication attribute.”

h. the processor further operable to automatically select a communication path from an ordered list associated with the indicated communication attribute

Petitioner contends that Oberlander discloses this claim limitation. Pet. 40–42 (citing Ex. 1003 ¶¶ 164–165). Petitioner contends that Oberlander discloses a processor that, “automatically selects a communication path because Oberlander discloses that the database structure is used to select a communication network from a prioritized list corresponding to a subscriber ID.” *Id.* at 41 (citing Ex. 1003 ¶ 165).

Patent Owner does not dispute Petitioner’s contention that Oberlander discloses this limitation. PO Resp. 4–15.

Based on the arguments and evidence presented by Petitioner discussed above, Petitioner establishes that Oberlander discloses the limitation “the processor further operable to automatically select a communication path from an ordered list associated with the indicated communication attribute.”

i. Conclusion

Based on the present record and after considering all of Patent Owner’s arguments, we determine Petitioner has established by a preponderance of the evidence that claim 1 is anticipated by Oberlander.

E. Obviousness over Oberlander

Petitioner alternatively contends that claim 1 is unpatentable under 35 U.S.C. § 103(a) in light of Oberlander. Pet. 42–43. Petitioner contends that to the extent Oberlander does not disclose “that the NMM database is included in ‘a memory operable to store,’ it would have been obvious to store the database in such a memory, such as the RAM memory 240 of Oberlander . . . in order to be accessed by, and therefore useful to, the

system.” *Id.* at 42 (citing Ex. 1003 ¶ 83). Petitioner contends that one of ordinary skill in the art “would have been motivated to store the NMM database in the RAM memory 240 . . . because it was an available resource already existing in the design of the system, and therefore provided a convenient place to store the database without altering the design of the system.” *Id.* (citing Ex. 1003 ¶ 83). Petitioner also contends that one of ordinary skill in the art “would have been motivated to include in the device of Oberlander a memory sufficient to store the databases of Oberlander so that the functionality of Oberlander could be implemented and the benefits of the invention obtained.” *Id.* at 43 (citing Ex. 1003 ¶ 84).

Patent Owner contends that claim 1 is not obvious in light of Oberlander for the same reasons as stated in connection with the anticipation ground based on Oberlander. *See* PO Resp. 15. Patent Owner further contends that Petitioner’s “arguments concerning . . . the use of a memory do not address this deficiency.” *Id.* This contention is not persuasive for the same reasons discussed above.

Based on the arguments and evidence presented by Petitioner and after considering all of Patent Owner’s arguments, we determine that Petitioner has demonstrated by a preponderance of the evidence that claim 1 would have been obvious to one of ordinary skill in the art in light of Oberlander if it were to be determined that the NMM database is not included in a memory operable to store. In any event, we determine that Oberlander anticipates claim 1 and it is well settled that “anticipation is the epitome of obviousness.” *In re McDaniel*, 293 F.3d 1379, 1385 (Fed. Cir. 2002) (quoting *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)).

F. Obviousness over Dutta and Oberlander

Petitioner contends that claim 1 is unpatentable in light of Dutta and Oberlander. Pet. 64–78. In support thereof, Petitioner identifies the disclosures in Dutta and Oberlander alleged to disclose the subject matter in the challenged claim. *Id.* Additionally, Petitioner offers declaration testimony from Dr. Steve R. White in support of its position. Ex. 1003 ¶¶ 172, 173, 177–184, 196, 199, 200, 203–206, 209, 212.

Patent Owner’s sole contention with respect to this challenge is that Oberlander does not disclose “the storage of a plurality of ordered lists of communication paths *where each ordered list is associated with one of a plurality of communication attributes representing a separate priority for communication.*” PO Resp. 25. Patent Owner relies on the arguments discussed above in connection with the anticipation ground based on Oberlander. *Id.*

Overview of Dutta

Dutta is a U.S. Patent issued from an application filed September 29, 1995. Ex. 1007, code (22). Dutta is directed to “Wide Area Mobile Communication Networks with Multiple Routing Mode Options.” *Id.* at code (54). Figure 1 of Dutta is reproduced below:

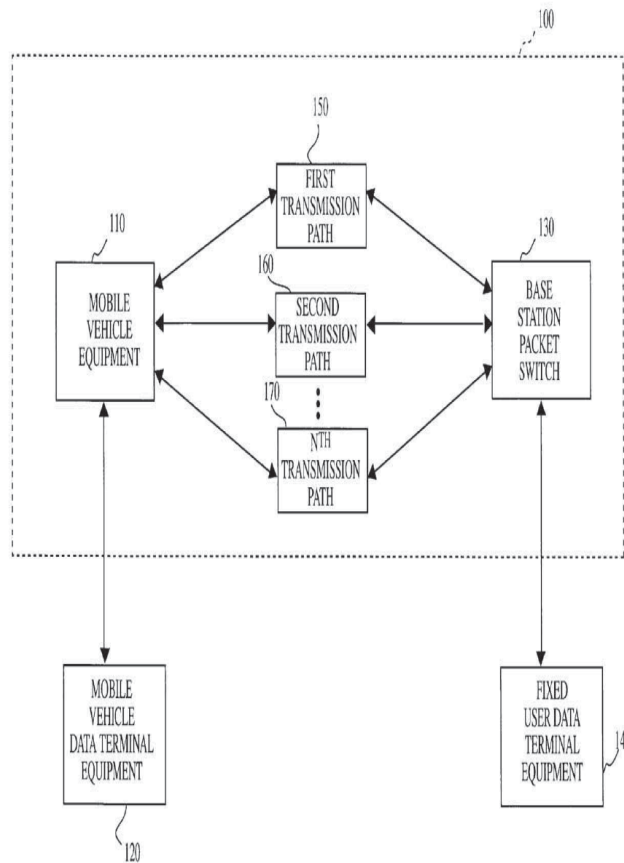


FIG. 1

Figure 1 of Dutta, “is a block diagram illustrating a wireless packet data transmission network for communicating with mobile terrestrial vehicles.”
Id. at 3:21–23.

As shown in Figure 1, “[m]obile vehicle equipment 110 is a terrestrial vehicle based device or system which facilitates communication between mobile vehicle data terminal equipment 120 . . . and fixed user data terminal equipment 140 through base station packet switch 130.” *Id.* at 4:50–55. Dutta discloses that “[m]obile vehicle equipment 110 incorporates ‘intelligent’ routing and control mechanisms to determine which of the radio frequency transmission paths a particular message data packet will be delivered through.” *Id.* at 4:58–62.

Analysis of Claim 1

a. Preamble

Petitioner contends that Dutta discloses an apparatus for automatically selecting one of a plurality of communication paths. Pet. 65–67. In particular, Petitioner contends that Dutta discloses “a data communication network that has the mobile vehicle equipment 110 and data terminal equipment 120 (together being ‘*an apparatus*’) to ‘determine which of the radio frequency transmission paths a particular message data packet will be delivered through.’” *Id.* at 65–66 (citing Ex. 1007, 4:55–63, Fig. 1). Petitioner contends that the radio frequency transmission paths shown in Figure 1 of Dutta correspond to the “communication paths” in claim 1. *Id.* at 66 (citing Ex. 1003 ¶ 173). Petitioner further contends that Dutta’s “communication paths may be part of two types of networks: a ‘terrestrial based sub-network[s]’ . . . or ‘satellite-based subnetwork’” and that “[e]ach network type has varying ‘advantages’ over the other network type.” *Id.* (citing Ex. 1007, 5:33–34, 5:51–6:9). Petitioner further contends that Dutta discloses “[a]n intelligent switching control node” that “select[s] the transmission path as a function of the message characteristics of the packet data message and as a function of the transmission path characteristics.” *Id.* (citing Ex. 1007, 3:6–14, 3:49–55). Dutta’s “message characteristics include ‘coverage [area], signal strength, data rates, message delivery times, and data costs.’” *Id.* (citing Ex. 1007, 6:9–16). According to Petitioner, one of ordinary skill in the art “would recognize that the intelligent switching node selects a path (‘*automatically selecting one of a plurality of communication paths*’) for use in communicating the data message to the mobile vehicle equipment.” *Id.* (citing Ex. 1003 ¶ 172).

Patent Owner does not dispute Petitioner's contention that the subject matter of the preamble of claim 1 is disclosed by Oberlander. *See generally* PO Resp. 25.

Based on the arguments and evidence presented by Petitioner, Petitioner establishes that Dutta discloses “[a]n apparatus for automatically selecting one of a plurality of communication paths.” Patent Owner does not argue that the preamble is not limiting. *See generally* PO Resp. We do not address whether the preamble is limiting because there is no dispute that Dutta discloses the subject matter of the preamble.

b. a memory operable to store

Petitioner contends that Dutta in combination with Oberlander teaches or suggests the limitation, “a memory operable to store a plurality of ordered lists of communication paths.” Pet. 67–71. Petitioner contends that Dutta’s “mobile vehicle unit has a message storage device (*‘memory operable’*) which is capable of ‘storing received or transmitted message data packets’ and “that this memory can be for example, a dynamic random access memory (DRAM) device.” *Id.* at 68 (citing Ex. 1003 ¶ 177; Ex. 1007, 7:16–23, 6:21–30, Fig. 2). Petitioner concedes that Dutta does not disclose storing a plurality of ordered lists of communication paths in its memory but contends that “it would have been obvious to include that limitation in the system of Dutta in view of Oberlander.” *Id.* (citing Ex. 1003 ¶ 178). Petitioner relies on the disclosure in Oberlander discussed above in Section II.C. of a plurality of ordered lists of communication paths. *Id.* at 68–69. According to Petitioner, “[i]n the combination of Oberlander’s prioritized lists of communication networks with the mobile vehicle equipment of Dutta, Dutta’s mobile vehicle would maintain ‘organized’ lists of

communication networks and paths for use in selecting the appropriate communication link,” thus, allowing the “mobile vehicle memory to aide [sic] in the selection of the appropriate path.” *Id.* at 69 (citing Ex. 1003 ¶ 180).

Petitioner further contends that one of ordinary skill in the art would have been motivated to combine the teachings of Oberlander and Dutta in this way for two reasons. *Id.* at 70. First, Petitioner contends that Dutta discloses “an express reasoning to do so” because it discloses that “it is ‘preferable for a packet data network to take advantage of the best features of multiple transmission paths.’” *Id.* (citing Ex. 1003 ¶ 183; Ex. 1007, 1:61–63). Further, according to Petitioner, Dutta discloses “that there are ‘differentiating characteristic features of coverage, signal strength, data rates, message delivery times, and data costs’ which are factors in selecting the appropriate transmission path” which one of ordinary skill in the art would recognize “are represented in Oberlander’s organized network lists.” *Id.* (citing Ex. 1003 ¶ 183; Ex. 1007, 6:10–16). Petitioner further contends that the combination allows Dutta’s mobile device to create distinguished lists of communication paths to select the best one for each message. *Id.* Petitioner also contends that because Oberlander discloses “that ‘urgency’ should be a factor in selecting the way a subscriber device selects a network path,” one of ordinary skill in the art would have made “the modification to Dutta’s mobile vehicle and messages . . . to include message priority in the communication path selection as taught by Oberlander.” *Id.* at 71 (citing Ex. 1003 ¶ 184; Ex. 1005, 2:22–25).

Patent Owner does not dispute Petitioner’s contention that the combination of Dutta and Oberlander discloses this limitation nor does

Patent Owner challenge Petitioner's stated reasons for combining the teachings of Dutta and Oberlander. PO Resp. 25.

Based on the arguments and evidence presented by Petitioner discussed above, Petitioner establishes that the combination of Dutta and Oberlander teaches or suggests "a memory operable to store."

c. a plurality of ordered lists of communication paths

Petitioner contends that Dutta in combination with Oberlander teaches or suggests the limitation "each ordered list associated with one of a plurality of communication attributes." Pet. 71–73. Petitioner specifically contends that Dutta's system in combination with Oberlander "would use Oberlander's priority attribute in Dutta's packet messages to select the appropriate transmission path based on priorities." *Id.* at 72 (citing Ex. 1003 ¶ 196). Petitioner contends that Oberlander's messages include an attributes field "specific to each message" and the "attribute field represent[s] 'message priority' that may require a higher or lower priority ('communication attribute[s]') over other messages." *Id.* (citing Ex. 1003 ¶ 196; Ex. 1005, 3:66–4:9, 6:1–14). According to Petitioner, one of ordinary skill in the art "would recognize that Oberlander's messages have communication attributes representing certain priorities . . . needed in the selection of a network depending on the urgency of the message" and consequently, "these message priority attributes and corresponding organized lists teach 'each ordered list associated with one of a plurality of communication attributes.'" *Id.* at 72–73 (citing Ex. 1003 ¶ 196).

Patent Owner does not dispute Petitioner's contention that the combination of Dutta and Oberlander discloses this limitation nor does

Patent Owner challenge Petitioner's stated reasons for combining the teachings of Dutta and Oberlander. PO Resp. 25.

Based on the arguments and evidence presented by Petitioner discussed above, Petitioner establishes that the combination of Dutta and Oberlander teaches or suggests "a plurality of ordered lists of communication paths."

d. each ordered list associated with one of a plurality of communication attributes

Petitioner contends that Dutta in combination with Oberlander teaches or suggests the limitation "each communication attribute representing a separate priority for communication." Pet. 73–74. Petitioner specifically contends that "Dutta's messages would include Oberlander's priority message attribute . . . that would aide [sic] in selecting the appropriate transmission path." *Id.* at 73 (citing Ex. 1003 ¶ 200; Ex. 1005, 4:38–51, 5:26–61, Fig. 5, 6). Petitioner further contends that Dutta's system combined with Oberlander "would maintain this prioritized list of transmission paths as well as includes Oberlander's message priority attribute in Dutta'a messages." *Id.* at 74 (citing Ex. 1003 ¶ 200). According to Petitioner, one of ordinary skill in the art "would recognize that Dutta's separate transmission paths would necessarily belong to different priority lists, as shown in Oberlander." *Id.* (citing Ex. 1003 ¶ 200).

Patent Owner disputes that Oberlander discloses this limitation for the same reasons discussed above in connection with the anticipation ground based on Oberlander. *See* PO Resp. 25. For the reasons discussed above, we are not persuaded by this contention.

Based on the arguments and evidence presented by Petitioner discussed above, Petitioner establishes that the combination of Dutta and

Oberlander teaches or suggests the limitation “each ordered list associated with one of a plurality of communication attributes.”

e. each communication attribute representing a separate priority for communication

Petitioner contends that Dutta in combination with Oberlander teaches or suggests this limitation. Pet. 73–74. Petitioner contends that Dutta “selects a path based on message characteristics. ‘such as designation of preferred transmission path, criticality of delivery timing, or other constraints regarding the method of information delivery.’”

Id. at 73 (citing Ex. 1007, 6:58–62). Petitioner further contends that in the combination of Dutta and Oberlander, Oberlander’s priority message attributes would be included in Dutta’s messages and “that would aid[e] in selecting the appropriate transmission path.” *Id.* (citing Ex. 1003 ¶ 199). Petitioner also contends that when combined as proposed, Dutta would maintain prioritized lists of transmission paths and that one of ordinary skill in the art “would recognize that Dutta’s separate transmission paths would necessarily belong to different priority lists” as in Oberlander. *Id.* at 74 (citing Ex. 1003 ¶ 200).

Patent Owner does not dispute Petitioner’s contention that the combination of Dutta and Oberlander suggests this limitation nor does Patent Owner challenge Petitioner’s stated reasons for combining the teachings of Dutta and Oberlander. PO Resp. 25.

Based on the arguments and evidence presented by Petitioner discussed above, Petitioner establishes that the combination of Dutta and Oberlander teaches or suggests “each communication attribute representing a separate priority for communication.”

f. a processor operable to receive a request for communication

Petitioner contends that Dutta in combination with Oberlander teaches or suggests the limitation “a processor operable to receive a request for communication.” Pet. 74–76. Petitioner contends that Dutta discloses a processor operable to receive because it discloses an intelligent switching node that “is preferably a microprocessor based device” that “routes messages to the desired transmission path . . . by ‘[determining] which transmission path to utilize for transmitting a particular message data packet in order to obtain some desired result.’” *Id.* at 74 (citing Ex. 1003 ¶ 203, Ex. 1007, 8:24–35, Fig. 3). Petitioner further contends that “[b]oth Dutta’s message processor and intelligent switching node processor together satisfy the claimed ‘*request for communication*.’” *Id.* at 75 (citing Ex. 1003 ¶ 205). Petitioner further contends that Dutta’s message processor “is capable of receiving information by a terminal equipment interface,” “acts upon information sent and received by fixed data terminal equipment interface 310’ . . . which includes information about the messages,” and “passes information to be transmitted together with control information . . . to intelligent switching node 230.” *Id.* citing (Ex. 1003 ¶ 205; Ex. 1007, 6:52–62, 8:7–14, Figs. 2, 3). According to Petitioner, one of ordinary skill in the art “would understand the combination of the message processor and the intelligent switching node work together by having the two processors together extract information from the message in order to determine its destination and transmission requirements” and “recognize that both of Dutta’s processors receive communication message requests from a user and selects the appropriate path depending on the message’s transmission requirements.” *Id.* at 75–76 (citing Ex. 1003 ¶ 206).

Patent Owner does not dispute Petitioner's contention that the combination of Dutta and Oberlander discloses this limitation nor does Patent Owner challenge Petitioner's stated reasons for combining the teachings of Dutta and Oberlander. PO Resp. 15.

Based on the arguments and evidence presented by Petitioner discussed above, Petitioner establishes that Dutta in combination with Oberlander teaches or suggests "a processor operable to receive a request for communication."

g. the request indicating a communication attribute

Petitioner contends that Dutta in combination with Oberlander teaches or suggests the limitation "the request indicating a communication attribute." Pet. 76–77. Petitioner specifically contends that Dutta as combined with Oberlander discloses that Dutta's messages include the priority message attribute" disclosed in Oberlander and "[a] priority value attribute . . . represents the urgency with which a message is to be treated." *Id.* at 76 (citing Ex. 1003 ¶ 209). According to Petitioner, one of ordinary skill in the art "would recognize that Dutta's messages, as modified by the Oberlander's priority attribute, have communication attributes representing certain priorities . . . needed in the selection of a network depending on the urgency of the message." *Id.* at 77 (citing Ex. 1003 ¶ 209).

Patent Owner does not dispute Petitioner's contention that the combination of Dutta and Oberlander discloses this limitation nor does Patent Owner challenge Petitioner's stated reasons for combining the teachings of Dutta and Oberlander. PO Resp. 25.

Based on the arguments and evidence presented by Petitioner discussed above, Petitioner establishes that Dutta in combination with

Oberlander teaches or suggests the limitation “the request indicating a communication attribute.”

h. the processor further operable to automatically select a communication path from an ordered list associated with the indicated communication attribute

Petitioner contends that Dutta in combination with Oberlander teaches or suggests the limitation “automatically select a communication path from an ordered list associated with the indicated communication attribute.”

Pet. 77–78. Petitioner specifically contends that “the combined system of Dutta and Oberlander would use Oberlander’s ordered list of transmission paths . . . as stored in Dutta’s apparatus, to select a communication path from a list corresponding to those characteristics’ which “include the message priority attribute” disclosed by Oberlander. *Id.* at 78 (citing Ex. 1003 ¶ 212). According to Petitioner, one of ordinary skill in the art “would recognize that these message priority attributes would be used to select the list . . . based on a specific priority attribute” and thus, “Dutta’s apparatus necessarily automatically selects a communication network and corresponding network path (*‘communication path’*).” *Id.* (citing Ex. 1003 ¶ 212).

Patent Owner does not dispute Petitioner’s contention that the combination of Dutta and Oberlander discloses this limitation nor does Patent Owner challenge Petitioner’s stated reasons for combining the teachings of Dutta and Oberlander. PO Resp. 25.

Based on the arguments and evidence presented by Petitioner discussed above, Petitioner establishes that Dutta in combination with Oberlander teaches or suggests the limitation “the processor further operable

to automatically select a communication path from an ordered list associated with the indicated communication attribute.”

i. Conclusion

Based on the present record and after considering all of Patent Owner’s arguments, we determine Petitioner has established by a preponderance of the evidence that claim 1 would have been obvious in light of Dutta and Oberlander.

G. Remaining Grounds

Petitioner’s challenges based on Oberlander and Bamburak, Oberlander and Eriksson, and Oberlander and Burke with or without Bamburak or Eriksson are presented as alternative grounds in the event we were to determine that one or more elements of the challenged claim were not disclosed or suggested by Oberlander alone. *See* Pet. 43, 55, 58. Likewise, the challenge based on Dutta, Oberlander, and Eriksson is also an alternative ground to the challenge based on Dutta and Oberlander. *See id.* at 79. Because we determine that Petitioner has shown by a preponderance of the evidence that claim 1 is unpatentable as anticipated and/or obvious over Oberlander alone and unpatentable as obvious over Dutta and Oberlander, we need not and do not decide these additional grounds. *See SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1359 (2108) (holding that a petitioner “is entitled to a final written decision addressing all of the claims it has challenged”); *see also* 35 U.S.C. § 318(a); *In re Gleave*, 560 F.3d at 1338 (Fed. Cir. 2009) (not reaching other grounds of unpatentability after affirming the anticipation ground); *Beloit Corp. v. Valmet Oy*, 742 F.2d 1421, 1423 (Fed. Cir. 1984) (holding that once a dispositive issue is decided, there is no need to decide other issues).

III. CONCLUSION

Based on the record before us, we determine that Petitioner demonstrates by a preponderance of the evidence that claim 1 of the '658 patent is anticipated under 35 U.S.C. § 102 or unpatentable under 35 U.S.C. § 103.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that,

In summary:

Claim(s)	35 U.S.C. §	Reference(s)/Basis	Claim(s) Shown Unpatentable	Claim(s) Not shown Unpatentable
1	102	Oberlander	1	
1	103	Oberlander	1	
1	103	Dutta, Oberlander	1	
1	103 ⁸	Oberlander, Bamburak,		
1	103 ⁹	Oberlander, Eriksson		
1	103 ¹⁰	Oberlander, Burke with or without Bamburak or Eriksson		
1	103 ¹¹	Dutta, Oberlander, Eriksson		
Overall Outcome			1	

⁸ For the reasons discussed above, this ground was not reached.

⁹ For the reasons discussed above, this ground was not reached.

¹⁰ For the reasons discussed above, this ground was not reached.

¹¹ For the reasons discussed above, this ground was not reached.

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Patent 5,966,658

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