Trials@uspto.gov
571-272-7822

Paper 38
Date: July 22, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UNIFIED PATENTS LLC,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

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IPR2019-00453
Patent 7,020,252 B2

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Before JEFFREY S. SMITH, BARBARA A. PARVIS, and CHRISTA P. ZADO, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge.*

JUDGMENT
Final Written Decision
Determining All Claims Unpatentable
*35 U.S.C. § 318(a)*

# I. INTRODUCTION

Unified Patents LLC[1] ("Petitioner") filed a Petition requesting *inter partes* review of claims 1–5 of U.S. Patent No. 7,020,252 B2 ("the '252 patent," Ex. 1001). Paper 2 ("Pet."). On July 26, 2019, we instituted an *inter partes* review of all the challenged claims. Paper 9 ("Inst. Dec."). Patent Owner filed a Response ("PO Resp.") Paper 12. Petitioner filed a Reply ("Pet. Reply"). Paper 21. Patent Owner filed a Sur-Reply ("Sur-Reply"). Paper 27. A hearing was held on May 12, 2020, and a transcript has been entered into the record ("Tr."). Paper 37.

This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a). We determine that claims 1–5 are unpatentable.

## *A. Related Matters*

The parties state that the '252 patent is the subject of the following pending proceedings: *Uniloc 2017 LLC v. Hike Ltd.*, Case No. 2:18-cv-00515 (E.D. Tex. 2018); *Uniloc 2017 LLC v. Microsoft Corp.*, Case No. 8-18-cv-02054 (C.D. Cal. 2018); *Uniloc 2017 LLC v. Apple Inc.*, Case No. 1-18-cv-00991 (W.D. Tex. 2018); *Uniloc 2017 LLC et al v. Hike Ltd.,* Case No. 2-18-cv-00417 (E.D. Tex. 2018). Pet. 70; Paper 3, 2.

## *B. Real Parties in Interest*

Petitioner identifies itself as the real party in interest. Pet. 70. Patent Owner identifies itself as the real party in interest. Paper 3, 1.

## *C. The '252 Patent*

The '252 patent relates to a group audio message board. Ex. 1001, code (54). A communal audio message recordal apparatus enables multiple

[1] Petitioner changed its name from Unified Patents, Inc., to Unified Patents, LLC. Paper 16.

users to record and access recorded messages. *Id.* at code (57). Each message includes at least one qualifying parameter for access to the recordal apparatus. *Id.* The qualifying parameter may be an indication of time or date for a user recording a message and for a user requesting playback of a message, or the qualifying parameter may indicate a personal characteristic of a user, such as a pastime. *Id.* at 3:10–16. The recordal apparatus permits a user to access a previously recorded message if the user has a matching qualifying parameter. *Id.* at 3:52–57.

*D. Illustrative Claim*

Challenged independent claim 1 is reproduced below.

> 1. A method for enabling communal audio message recordal including a provision of audio data recorder coupled with a communications system configured to enable multiple users to access the audio data recorder and to record respective audio messages thereby, wherein a recordal of each message comprises:
>
> generating and storing by said system at least one qualifying parameter pertaining to the access to the audio data recorder;
>
> determining a qualifying parameter for a subsequent access to the audio data recorder by a user; and
>
> enabling access by said subsequently accessing user to previously recorded messages having a matching qualifying parameter, otherwise the denial of such access, wherein the qualifying parameter includes an indication of time and/or date for a user recording a message and for a user requesting playback of a message.

*E. Asserted Grounds of Unpatentability*

Petitioner asserts the following grounds of unpatentability:

| **Reference** | **Basis**[2] | **Claim(s)** |
|---|---|---|
| Nabkel[3] | § 102 | 1 |
| Nabkel | § 103 | 1 |
| Nabkel, Hidary[4] | § 103 | 2–5 |
| Ala-Laurila[5], Hidary | § 103 | 2–5 |
| Ala-Laurila, Nabkel | § 103 | 1 |

## II. ANALYSIS

*A. Claim Construction*

The Petition was accorded a filing date of December 31, 2018. Paper 5. In an *inter partes* review for a petition filed on or after November 13, 2018, a claim "shall be construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b)." *See* Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340, 51,340, 51,358 (Oct. 11, 2018) (amending 37 C.F.R. § 42.100(b) effective November 13, 2018) (now codified at 37 C.F.R. § 42.100(b) (2019)).

[2] The relevant sections of the Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112–29, 125 Stat. 284 (Sept. 16, 2011), took effect on March 16, 2013. Because the application from which the '252 patent issued was filed before that date, our citations to Title 35 are to its pre-AIA version. *See* Ex. 1001, code (22).
[3] U.S. Patent No. 5,963,626, issued Oct. 5, 1999, Ex, 1005.
[4] U.S. Patent No. 5,852,775, issued Dec. 22, 1998, Ex. 1007.
[5] U.S. Patent No. 6,246,871 B1, issued June 12, 2001, Ex. 1006.

*1. "generating and storing by said system at least one qualifying parameter pertaining to access of the audio data recorder"*

With regard to the limitation "generating and storing by *said system* at least one qualifying parameter pertaining to the access to the audio data recorder," as recited in claim 1,[6] the parties dispute the antecedent basis of "said system." The preamble of claim 1 recites

> [a] method for enabling communal audio recordal including provision of audio data recorder coupled with a communications system configured to enable multiple users to access the audio data recorder and to record respective audio messages thereby, wherein a recordal of each message comprises.

Patent Owner contends "said system" finds antecedent basis in the preamble recitation of "communications system," and that we should construe this limitation as "generating and storing by [a communications system] at least one qualifying parameter pertaining to the audio access to the audio data recorder." PO Response 4–5; PO Sur-Reply 2–3. Petitioner contends "said system" finds antecedent basis in the preamble recitation of "a provision of audio data recorder coupled with a communications system," and that we should construe this limitation as "generating and storing by [a provision of audio data recorder coupled with a communications system] at least one qualifying parameter pertaining to the audio access to the audio data recorder." Pet. Reply 5.

In arguing their respective constructions, the parties agree that the "communications system" recited in the preamble may *generate* a qualifying

[6] Our discussion in this section regarding claim 1 also pertains to the same or similar recitations in the other challenged claims.

parameter. PO Sur-Reply 4–5; Pet. Reply 2–3. However, the parties dispute whether the "communications system" may also *store* the qualifying parameter, or whether it is the "audio data recorder" that stores the qualifying parameter. PO Sur-Reply 4–5; Pet. Reply 2–3. Specifically, the parties agree the group audio message board (GAMB) 10 disclosed in the Specification *stores* a qualifying parameter. PO Sur-Reply 4; Pet. Reply 3–4. However, the parties dispute whether GAMB 10 discloses a "communications system," or whether it discloses an "audio data recorder."

For the reasons that follow, we construe "generating and storing by *said system* at least one qualifying parameter pertaining to the access to the audio data recorder" to encompass "generating and storing by a provision of audio data recorder coupled with a communications system at least one qualifying parameter pertaining to the audio access to the audio data recorder."

Beginning with the claim itself, the limitation at issue recites "said system," leaving out the term "communications." Nonetheless, Patent Owner urges that because the only prior appearance of "system" in the claim is the "communications system" recited in the preamble, we should construe "said system" to mean "communications system." PO Sur-Reply 2. "Said system" must not be construed in a vacuum, devoid of the context of the claim as a whole. *See Hockerson-Halberstadt, Inc. v. Converse Inc.*, 183 F.3d 1369, 1374 (Fed. Cir. 1999) ("proper claim construction . . . demands interpretation of the entire claim in context, not a single element in isolation.'); *ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1088 (Fed. Cir. 2003) ("While certain terms may be at the center of the claim construction debate, the context of the surrounding words of the claim also must be

considered"). Indeed, "the context in which a term is used in the asserted claim can be highly instructive." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005). The term "system" as used in claim 1 is not surrounded by uniform language that requires a single interpretation of the term. *Microprocessor Enhancement Corp. v. Texas Instruments Inc.*, 520 F.3d 1367, 1376 (Fed. Cir. 2008). Rather, the appropriate meaning of "system" is readily apparent from each occurrence in the context of the claim as read in light of the Specification. *Id.*; *Phillips*, 415 F.3d at 1315 ("Claims must always be read in light of the specification.").

The preamble recites a "communications system" that is coupled with an audio data recorder and configured to enable multiple users to access the audio data recorder. The claim limitation at issue recites *both* "generating and storing" at least one qualifying parameter by "said system."

For reasons discussed below, we find no support in the '252 Patent Specification for a construction of the "communications system" that (1) is "configured to enable multiple users to access the audio data recorder," as recited in the preamble, and (2) perform *both* "generating and storing*"* a qualifying parameter. Rather, the Specification indicates that the combination of the "audio data recorder" coupled with the "communications system" generates and stores a qualifying parameter. Therefore, in light of the context in which "communications system" and "said system" appear in the claim when read in light of the Specification, the interpretation that is most consistent with the intrinsic evidence is one in which the provision of the complete system—i.e., the audio data recorder coupled with the communications system—perform the steps of "generating and storing." *See Phillips*, 415 F.3d at 1313 ("the person of ordinary skill in the art is

deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.").

*a. "system"*

The term "system" has more than one meaning in the '252 patent, and to ascertain its meaning in any given instance we must look to the context in which it appears. Above we discussed the context in which the term "system" appears in the claim. We turn next to the Specification. *Phillips,* 415 F.3d at 1315 (holding "[t]he descriptive part of the specification aids in ascertaining the scope and meaning of the claims inasmuch as the words of the claims must be based on the description. The specification is, thus, the primary basis for construing the claims.").

The Summary of the Invention discloses "in accordance with the present invention," language that nearly identically recites the preamble of claim 1:

> a method for enabling communal audio recordal comprising the provision of audio data recordal means coupled with a communications system configured to enable multiple users to access the recordal means and to record respective audio messages thereby.

Ex. 1001, 2:63–3:1.

The Summary of the Invention discloses the invention also as an apparatus, again using language nearly identical to that in the preamble of claim 1, disclosing "[i]n accordance with a first aspect of the present invention":

> Provid[ing] a communications system comprising communal audio message recordal apparatus comprising audio data recordal means coupled with a communications system

> configured to enable multiple users to access the recordal means and to record respective audio messages thereby.

*Id.* at 1:64–2:3.

Accordingly, the Specification uses the term "communications system" in two different senses. In the narrower sense, "communications system" refers to a system that is coupled to an audio data recorder and configured to enable multiple users to access the recorder. In the broader sense, "communications system" refers to a system including: 1) an audio data recorder, coupled with 2) a "communications system" as that term is used in the narrower sense.

Comparing the preamble of claim 1 with the Summary of the Invention shows that the preamble expressly and unambiguously uses "communications system" in the narrower sense, i.e., as a "communications system" that is coupled to an audio data recorder and configured to enable multiple users to access the recorder:

| **Claim 1 (preamble)** | **Specification (Ex. 1001, 2:63–3:1)** | **Specification (Ex. 1001, 1:64–2:3)** |
|---|---|---|
| [a] method for enabling communal audio recordal including provision of | a method for enabling communal audio recordal comprising the provision of | Provid[ing] a communications system comprising communal audio message recordal apparatus comprising |
| audio data recorder | audio data recordal means | audio data recordal means |
| coupled with | coupled with | coupled with |
| a communications system configured to enable multiple users to access the audio data recorder and to record respective audio messages thereby | a communications system configured to enable multiple users to access the recordal means and to record respective audio messages thereby | a communications system configured to enable multiple users to access the recordal means and to record respective audio messages thereby |

Like the Specification's disclosure of a "communications system" in the narrower sense, the preamble recites that the "communications system" is coupled with the audio data recorder and is configured to allow multiple users to access the audio data recorder. In contrast, as discussed further below (*see infra* § II.A.d), claim 1's recitation of "generating and storing by *said system* at least one qualifying parameter" uses the term "system" in the broader sense, referring to an audio data recorder coupled with a communications system (as the term is used in the narrower sense).

*b. "audio data recorder" and "communications system"*

The Specification does not expressly define the terms "audio data recorder" and "communications system." Accordingly, we look to the plain and ordinary meaning as of these terms as would be understood by a person of ordinary skill in the art at the time of the invention and in the context of

the entire patent disclosure. *Phillips*, 415 F.3d 1313. For the reasons discussed below, we conclude that GAMB 10 in the Specification discloses the "audio data recorder" and that the plain and ordinary meaning of "audio data recorder" would have been understood to encompass a device that stores recorded audio messages, such as that disclosed by GAMB 10. We conclude further that telecommunications network 14, with or without beacons, such as beacons 22, 24, discloses a "communications system" and that the plain and ordinary meaning of "communications system" encompasses a telecommunications system, such as that disclosed by telecommunications network 14 (with or without beacons 22, 24).

The Specification makes plain that the term "audio data recorder" includes devices such as a message board that stores audio message recordings (e.g., GAMB 10 comprising storage device 16). Ex. 1001, 3:39–57, Fig. 1. As noted above, the Summary of the Invention and claim 1 disclose and recite an "audio recordal means" and an "audio data recorder," respectively, that "record audio data messages." Although the preferred embodiment does not use the term "audio data recorder," we find that GAMB 10 discloses an "audio data recorder," because GAMB 10 comprises storage device 16 that records and stores audio messages. Ex. 1001, 3:43–46.

The Specification also makes plain that the term "communications system" includes telecommunications networks such as telecommunications network 14 linked to beacons 22, 24. *Id.* at 4:10–16. As noted above, the Summary of the Invention and claim 1 disclose and recite a "communications system." Although the preferred embodiment does not use this term, we find that telecommunications network 14 (with or without

beacons 22, 24) discloses a "communications system" coupled with the audio data recorder and configured to enable multiple users to access the recorder, as recited in claim 1, because network 14 (with or without beacons 22, 24) is a telecommunications network, is connected (i.e., coupled) with GAMB 10 (i.e., the audio data recorder), and allows (i.e., is configured to enable) users on mobile telephones to access GAMB 10. *Id.* at 3:39–46; *see also id.* at 2:39–44 (disclosing that the communications system may comprise a plurality of networked beacons).

The file history of the '252 patent supports our finding that GAMB 10 discloses an "audio data recorder" and telecommunications network 14 (with our without beacons 22, 24) discloses a "communications system," as these terms are used in the preamble of claim 1. Throughout prosecution, the Examiner consistently mapped telecommunications networks to the claimed "communications system" and message boards/and or message storage that store recorded audio messages to the claimed "audio data recorder." Ex. 1013, 3; Ex. 3001, 101. For example, in the First Office Acction, dated May 9, 2003, the Examiner mapped Kanevsky's "telephone system" (i.e., a telecommunications network) to the claimed "communications system." Ex. 3001, 101. The Examiner mapped Kanevsky's phone message store 103 that stores recorded audio messages to the claimed "audio data recordal means." *Id.*; Ex. 3002, Fig. 1 ("Kanevsky"). In the Office Action dated November 3, 2004, the Examiner mapped Creswell's Switch 130 to a "communications system." Ex. 1013, 3. In pertinent part, Creswell discloses communications network 100 that may be a public switched telephone network that provides long distance telephone services to subscribers, wherein network 100 includes switching offices, such as

switch 130. Ex. 3003, 2:54–65. The Examiner mapped "audio recordal means" to Creswell's adjunct 150 (Ex. 1013, 3), which Creswell discloses as storing messages and their associated headers in an available bulletin board memory location, Ex. 3003, 13:3–6.

During prosecution, Applicant disagreed that the prior art rendered the pending claims unpatentable and/or cancelled the claims. *See generally* Ex. 3001, 11, 58–62. However, Applicant did not correct the Examiner or disagree that the "communications system" and "audio data recordal means" were properly mapped. *See generally id.* Although Applicant's silence regarding the Examiner's mappings is not determinative, the Examiner's mappings and Applicant's acceptance of those mappings may be informative as to the plain and ordinary meaning of the terms "communications system" and "audio data recorder" as used in the '252 patent. Indeed, the claim's "ordinary meaning must be considered in the context of all the intrinsic evidence, including the claims, the specification, and prosecution history." *Biogen Idec, Inc., v. GlaxoSmithKline LLC*, 713 F.3d 1090, 1094 (Fed. Cir. 2013). Here, the Examiner's mappings are consistent with, and therefore support, our determination that the plain and ordinary meaning of "audio data recorder" encompasses "a device that stores recorded audio messages," such as that disclosed by GAMB 10, and that the plain and ordinary meaning of "communications system" encompasses a "telecommunications system," such as that disclosed by telecommunications network 14 (with or without beacons 22, 24).

Patent Owner is vague as to which embodiments in the Specification disclose a "communications system," arguing that the claimed "communications system" includes "multiple components, such as storage

device 16, parameter index stage 18 and clock 30," but leaving open what else it might include. PO Sur-Reply 4. However, what is clear is Patent Owner's attempt to map GAMB 10's storage device 16 to the claimed "communications system," in order to support its contention that the "communications system" stores a qualifying parameter. *Id.* For reasons discussed immediately above regarding the Specification's disclosure and the prosecution history, nothing in the intrinsic record indicates storage device 16 would have been understood as comprising part of the "communications system." To the contrary, the intrinsic evidence indicates storage device 16 is part of the "audio data recorder." For example, as discussed above, the prosecution history treats telecommunications networks as "communications systems," and treats message boards/and or message storage that store audio recorded messages—i.e., systems like GAMB 10—as "audio data recorders." Patent Owner does not address this. Moreover, Patent Owner does not explain what embodiment(s) in the Specification disclose(s) the "audio data recorder." If storage device 16 (part of GAMB 10) were part of the "communications system" rather than the "audio data recorder," as asserted by Patent Owner, there would be no disclosure in the Specification's embodiments of an "audio data recorder."

As noted above, GAMB 10 including storage device 16 records and stores audio recorded messages, and therefore embodies an "audio data recorder." Ex. 1001, 3:43–46. Patent Owner does not identify, nor do we discern, any disclosure in the Specification that embodies the "audio data recorder . . . to record audio messages" other than GAMB 10 including storage device 16. In addition, Patent Owner does not address the recited language in the preamble that the "communications system" is *coupled with*

an "audio data recorder." If GAMB 10 including storage device 16 were part of the "communications system," then the "communications system" would not be "coupled with" the "audio data recorder" as required by the claim, because no other component disclosed in the Specification records audio messages. For the foregoing reasons, we disagree with Patent Owner that storage device 16 would have been understood as embodying part of the "communications system," rather than part of the "audio data recorder."

Having found that GAMB 10 discloses an "audio data recorder" and network 14 (with or without beacons 22, 24) discloses a "communications system," as these terms are used in the preamble of claim 1, next we turn to the disclosure in the Specification of "generating and storing a qualifying parameter."

*c. "generating and storing a qualifying parameter"*

As to generating a qualifying parameter, the parties agree that the "communications system" may generate a qualifying parameter. Pet. Reply 3; PO Sur-reply 4–5. Moreover, although the parties dispute what disclosure in the Specification corresponds to the claimed "communications system," they do not dispute that the Specification discloses networked beacons, such as beacons 22, 24, may generate a qualifying parameter. PO Sur-reply 4–5 (citing Ex. 1001, 2:39–44); *see also* Ex. 1001 at 4:10–20 (describing beacons 22, 24 appending geographical information to audio recorded messages as a qualifying parameter); *see also id.* at 4:37–61 (describing a user mobile phone appending date/time information to an audio recorded message as a qualifying parameter). As we discussed above, we determine that telecommunications system 14 with networked beacons discloses a "communications system."

With regard to the file history of the '252 patent, in the Notice of Allowance the Examiner amended the limitation "*capturing and storing at least one qualifying parameter pertaining to access of the audio data recorder"* in what issued as claim 1 by replacing the word "capturing" with "generating" and inserting "by said system" after "storing." Ex. 1004, 2. The Examiner's reasons for allowance states that "the prior art of record fails to teach a communications system generates a matching qualifying parameter including additional information (e. g. time and/or date for [claim 1]) for a user. The claimed parameter is not an ordinary password because it is automatically generated by the system and the parameter includes additional information." *Id.* at 4. The Examiner's reasons for allowance do not include a statement about "storing by said system." Also, Applicant did not comment on the Examiner's reasons for allowance.

"[A]n applicant's silence regarding statements made by the examiner during prosecution, without more, cannot amount to a clear and unmistakable disavowal of claim scope. After all, the applicant has disavowed nothing." *Salazar v. Proctor & Gamble Co.,* 414 F.3d 1342, 1345 (Fed. Cir. 2005) (internal citations omitted). Here, the reasons for allowance were made by the Examiner, not by the Applicant, and do not amount to clear and unmistakable acquiescence by the Applicant to the Examiner's unrebutted characterization of the claims. We determine that the reasons for allowance "made by the examiner during prosecution, without more, cannot amount to a clear and unmistakable disavowal of claim scope" and therefore do not limit the claims. *Salazar*, 414 F.3d at 1345.

As to storing the qualifying parameter, the parties agree GAMB 10 stores the qualifying parameter. Pet. Reply 3–4 (arguing that only the audio

data recorder GAMB 10 is capable of storing a qualifying parameter); PO Sur-Reply 4 (arguing GAMB 10's storage device 16 stores the qualifying parameter). Moreover, the parties do not dispute that the Specification nowhere discloses network 14 (with or without beacons 22, 24) storing the qualifying parameter. Pet. Reply 3–4 (arguing network 14 is merely a telecommunications network, with no disclosure or indication that it can store a qualifying parameter); PO Sur-Reply 4 (arguing storage device 16 stores the qualifying parameter, but providing no argument or evidence that network 14 stores a qualifying parameter).

We agree with the parties that in the Specification, GAMB 10 stores the qualifying parameter. The Specification provides that GAMB 10 comprises storage device 16 in which recorded messages are stored by category in distinct areas A–F. Ex. 1001, 3:39–46. The Specification explains, "[t]he categories are determined by at least one qualifying parameter appended to each incoming message" and that the messages are stored in storage device 16. *Id.* at 3:46–51. Categories include, for example: 1) "date/time" a message is recorded, or 2) geographical location of the user. *Id.* at 3:63–4:2, 4:37–38. As disclosed in the Specification, the qualifying parameter that is appended to the recorded message may be the geographical location, or the date/time (e.g., time stamp) a message is recorded. *Id.* at 4:2–16, 4:37–48. Because the qualifying parameter is appended to the message, and the message is stored in storage device 16 of GAMB 10, we find that the Specification discloses storing the qualifying parameter in GAMB 10.

Further support for this understanding is that in a subsequent step, when a user seeks to access a message stored in GAMB 10's storage

device 16, the Specification states that the requesting user is granted access to messages "having a matching qualifying parameter." *Id.* at 3:52–57. Making a determination as to whether the stored message's qualifying parameter matches the qualifying parameter provided in the access request further indicates the qualifying parameter is stored with the message in storage device 16 of GAMB 10.

In contrast with the disclosure of GAMB 10 storing a qualifying parameter, the parties do not identify, nor do we discern, any disclosure in the Specification of network 14 (with or without beacons 22, 24) or a similar telecommunications network storing a qualifying parameter. Nor do the parties provide any evidence or argument showing a skilled artisan would have understood network 14 (with or without beacons 22, 24) to store the qualifying parameter—on the contrary, the parties agree the qualifying parameter is stored in GAMB 10's storage device 16, as discussed above.

*d."generating and storing by said system at least one qualifying parameter pertaining to access of the audio data recorder"*

Based on the intrinsic evidence discussed above, we agree with Petitioner that one of ordinary skill in the art would have understood "said system" in claim 1 to refer to the system described in the preamble including the "communication system" and the "audio data recorder."

Patent Owner's construction of "said system" as "said communications system" is inconsistent with the claim language when read in the context in which "communications system" and "said system" appear in the claim, the Specification as a whole, and the file history. Moreover, Patent Owner's construction excludes the disclosed embodiment of "storing by [the GAMB] at least one qualifying parameter," which "is rarely, if ever, correct and would require highly persuasive evidentiary support." *Adams*

*Respiratory Therapeutics, Inc. v. Perrigo Co.*, 616 F.3d 1283, 1290 (Fed. Cir. 2010). As we discussed above, the only disclosed system that stores the qualifying parameter is GAMB 10. Ex. 1001, 3:39–57, 3:66–4:1, 4:38–47, Fig. 1. Moreover, also discussed above, GAMB 10 discloses an "audio data recorder," not a "communications system." Construing "said system" to mean "said communications system" would exclude the only disclosed embodiment of "storing by said system at least one qualifying parameter." *See Johns Hopkins Univ. v. CellPro, Inc.*, 152 F.3d 1342, 1355 (Fed. Cir. 1998) ("A patent should be construed to encompass at least one disclosed embodiment").

For the foregoing reasons, we construe "generating and storing by *said system* at least one qualifying parameter pertaining to the access to the audio data recorder" to encompass "generating and storing by a provision of audio data recorder coupled with a communications system at least one qualifying parameter pertaining to the audio access to the audio data recorder."

*2. "pertaining to the access of the audio data recorder"*

Patent Owner contends that "pertaining to the access of the audio data recorder" should be construed as access that pertains to the audio data recorder itself. PO Resp. 4–5; PO Sur-Reply 3. Petitioner contends that Patent Owner's construction attempts to insert the word "itself" into the claim, but the claim should not be so limited. Pet. Reply 5. Petitioner further contends that Patent Owner's construction is inconsistent with the Specification of the '252 patent. *Id.* Petitioner contends that the '252 patent discloses two types of access, (1) password access control for accessing the audio data recorder, and (2) qualifying parameters for accessing messages

within the audio data recorder. *Id.* at 6 (citing Ex. 1001, 3:52–57, 4:62–67, 5:44–48). Petitioner contends that the '252 patent does not disclose using qualifying parameters to access the audio data recorder itself. *Id.* (citing Ex. 1001, 5:44–48).

The '252 patent discloses that the qualifying parameter identifies where a message should be stored on the GAMB and who should have access to the stored message, and that the qualifying parameter "is distinct from the password access control . . . which simply enables or disables access to the GAMB." Ex. 1001, 5:44–48; *see id.* at 3:52–57, 4:62–67. We agree with Petitioner, that Patent Owner's construction is too narrow, because it excludes the disclosed embodiment of a qualifying parameter pertaining to identifying who should have access to a message stored on the audio data recorder. We determine that a "qualifying parameter pertaining to the access to the audio data recorder," read in light of the specification, encompasses at least a qualifying parameter pertaining to identifying who has access to a message stored on the audio data recorder.

*3. "qualifying parameter"*

Patent Owner, relying on the Examiner's reasons for allowance, contends that the term "qualifying parameter" should be construed as (1) being automatically generated by the system, (2) including additional information such as date/time or a personal characteristic, and (3) being distinguishable from a mere user-generated password or user identification. PO Reply 5–6 (citing Ex. 1004, 4). Petitioner contends that the reasons for allowance were made by the Examiner, not the Applicant, and do not amount to clear and unmistakable acquiescence by the Applicant to the Examiner's unrebutted characterization of the claims. Pet. Reply 9–10.

We agree with Petitioner. As discussed above, we determine that the reasons for allowance "made by the examiner during prosecution, without more, cannot amount to a clear and unmistakable disavowal of claim scope," and therefore do not limit the claims. *See Salazar*, 414 F.3d at 1345.

Petitioner further contends that express construction of "qualifying parameter" is not necessary, because this term is not in controversy. Pet. Reply 7. We agree with Petitioner, and do not find it necessary to construe "qualifying parameter." *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (only terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy).

*4. "personal characteristic"*

Petitioner proposes that the claimed "personal characteristic" recited in each of claims 2–5 should be construed to mean "a feature that helps distinguish a person or thing." Pet. 7. Patent Owner contends that Petitioner's proposed construction is unreasonably broad. PO Resp. 6–7. In Reply, Petitioner contends that a construction of "personal characteristic" is not necessary to resolve a controversy. Pet. Reply 11. We agree with Petitioner, and do not find it necessary to construe "personal characteristic."

*C. Asserted Anticipation of Claim 1 by Nabkel*

Petitioner contends claim 1 is anticipated by Nabkel. Pet. 11–19. To support this contention, Petitioner relies on the declaration testimony of Mr. Scott Andrews. *Id.*; Ex. 1002.

*1. Nabkel*

Nabkel discloses a system for posting a message to callers based on a caller's identity. Ex. 1005, at code (57). A subscriber accesses the system

and identifies calling parties authorized to receive a prerecorded message on a caller list. *Id.* at 2:25–3:4, Figs. 1, 2. The subscriber records a message, may enter an expiration time or date for the message, and may also specify security parameters for the message, such as a personal identification number (PIN). *Id.* at 3:12–58, Fig. 3 (steps 132, 136, 141).

When a call from telephony device 22 is routed to communication station 14, the communication station queries adjunct processor 12 for call processing functions. *Id.* at 6:1–4, Fig. 6. Adjunct processor 12 receives call identification (ID) information of subscriber 20 and incoming caller 22, and compares the ID number of the calling party with ID numbers stored in the subscriber's profile in the database associated with adjunct processor 12. *Id.* at 6:10–14, Fig. 6. If the ID number of the calling party indicates that the calling party is authorized to receive the message, the adjunct processor instructs intelligent processor (IP) 18 to generate prompts if a PIN is required. *Id.* at 6:14–19. After determining the calling party is authorized to receive the message posted by the subscriber, the adjunct processor instructs the IP to present the message to the calling party. *Id.* at 6:20–23.

*2. Analysis*

Petitioner has not shown Nabkel discloses an "indication of time and/or date for a user recording a message," as recited in claim 1. Claim 1 recites "wherein the qualifying parameter includes an indication of time and/or date for a user recording a message and for a user requesting playback of a message." Petitioner contends that Nabkel describes this limitation in disclosing that a subscriber can enter a time or date for automatic expiration of the communication, such as seven days. Pet. 18 (citing Ex. 1005, 3:28–36, Fig. 3). Petitioner, relying on the testimony of

Mr. Andrews, contends that "to execute the seven-day expiration restriction, Nabkel's system manages one or more qualifying parameters including both the time and date the user recorded the audio message and the time and date a user is requesting playback of the message." *Id.* at 18–19 (citing Ex. 1002 ¶¶ 64–65).

However, Petitioner has not shown that the system of Nabkel necessarily includes the time and/or date that a user records a message in the qualifying parameter when a user enters a date of expiration of the message. The date of expiration, as disclosed in Nabkel, provides the system with the information necessary to expire the message, and thus the system does not need the time and date that the message was recorded. Accordingly, based on the arguments and evidence presented in the Petition and Mr. Andrews's declaration (Ex. 1002), we are not persuaded that the system in Nabkel necessarily stores the time and/or date the message was recorded.

We pointed out this deficiency in the Institution Decision. Inst. Dec. 8–9. In the Reply, Petitioner has not provided persuasive evidence or argument to the contrary.

For the foregoing reasons, we determine Petitioner has not shown by a preponderance of the evidence that claim 1 is anticipated by Nabkel.

*D. Asserted Obviousness of Claim 1 Over Nabkel*

Petitioner, relying on the testimony of Mr. Andrews, contends that Nabkel renders claim 1 obvious. Pet. 19–20.

The preamble of claim 1 recites a "method for enabling communal audio message recordal including a provision of audio data recorder coupled with a communications system configured to enable multiple users to access the audio data recorder and to record respective audio messages thereby,

wherein a recordal of each message comprises." We are persuaded that Nabkel teaches "enabling communal audio message recordal including a provision of audio data recorder coupled with a communications system configured to enable . . . users . . . to record respective audio messages," because, as argued by Petitioner, Nabkel discloses a system including an adjunct processor with a database for storage and a communication station to allow users to record audio messages on the system. Pet. 11 (citing Ex. 1005, 2:34–37, 3:12–28, 5:30–6:9, Fig. 6; Ex. 1002 ¶¶ 44–47). We are persuaded that Nabkel teaches "enabl[ing] multiple users to access the audio data recorder and access the audio data recorder and to record respective audio messages," because, as argued by Petitioner, Nabkel discloses a system that enables a user to post a message to callers based on each caller's identity, and that multiple users can record audio messages on the system. *Id.* at 11–12 (citing Ex. 1005, Abstract, 1:40–45, 2:25–57; Ex. 1002 ¶¶ 44–47). We are persuaded that Nabkel teaches the "audio data recorder" in disclosing an adjunct processor with a database, and teaches the "communications system," because, as argued by Petitioner, Nabkel discloses a communication station. *Id.* at 12 (citing Ex. 1002 ¶¶ 44–47). We are persuaded that Nabkel teaches the preamble of claim 1.

Claim 1 recites "generating and storing by said system at least one qualifying parameter pertaining to the access to the audio data recorder." Petitioner contends Nabkel teaches this limitation in disclosing generating and storing an expiration date or time. *Id.* at 12–14 (citing Ex. 1005, 3:13–4:20, 4:40–48, 5:20–29, 5:42–60, 6:10–26, Fig. 3; Ex. 1002 ¶¶ 48–53). Petitioner contends that Nabkel teaches the "qualifying parameter" in disclosing one or more variables associated with an audio message, such as

the time/date, where the values of the variables determine whether a user is eligible to access a particular audio message. *Id.* at 13 (citing Ex. 1005, 3:13–4:20; Ex. 1002 ¶ 51). Petitioner contends that Nabkel teaches "generating . . . by said system at least one qualifying parameter" in disclosing that the communication system takes a user input of an expiration time/date, such as seven days, and generates the qualifying parameter based on the user input, so that the audio message is only available for access for seven days. *Id.* at 13–14 (citing Ex. 3:28–58, 4:40–48, 5:42–60; Ex. 1002 ¶ 52). Petitioner contends that Nabkel teaches "storing . . . by said system at least one qualifying parameter" in disclosing a system including an adjunct processor with a database to store the qualifying parameter so that the qualifying parameter can be retrieved and evaluated when other users attempt to access the message. Pet. 14 (citing Ex. 1005, 3:29–58, 4:40–48, 5:20–29, 6:10–26; Ex. 1002 ¶ 53).

Patent Owner contends that Nabkel does not teach "storing . . . by said system at least one qualifying parameter," because "said system" refers only to the "communications system," and Nabkel's communication system does not store the qualifying parameter. PO Resp. 7–10. According to Patent Owner, the claimed "communications system" is taught by Nabkel's communication station, and the claimed "audio data recorder" is taught by Nabkel's adjunct processor with a database. *Id.* at 8. Patent Owner contends that storing the qualifying parameter by the adjunct processor with a database (corresponding to the claimed "audio data recorder") does not teach storing the qualifying parameter by the "communications system" as required by claim 1. *Id.* at 10.

Petitioner contends that Patent Owner's contention is based on an erroneous claim construction. Pet. Reply 12. We agree. As discussed in Section II.A above on claim construction, we agree with Petitioner's interpretation of claim 1, namely that "said system" refers to "a provision of an audio data recorder coupled with a communications system." Accordingly, contrary to Patent Owner's contention, claim 1 does not require the claimed "communications system" to store the qualifying parameter. Rather, claim 1 is met if the qualifying parameter is stored by the "system" comprising "a provision of audio data recorder coupled with a communications system." Consequently, Nabkel's disclosure of storing a qualifying parameter by an adjunct processor with a database (the "audio data recorder") teaches "storing *by said system* at least one qualifying parameter" as claimed. *See* Pet. 14 (citing Ex. 1005, 3:29–58, 4:40–48, 5:20–29, 6:10–26; Ex. 1002 ¶ 53).

For the foregoing reasons, we are persuaded that Nabkel teaches "generating and storing by said system at least one qualifying parameter pertaining to the access to the audio data recorder."

Claim 1 recites, "determining a qualifying parameter for a subsequent access to the audio data recorder by a user." We are persuaded that Nabkel teaches this limitation by disclosing that a user can be denied access to a recorded audio message after a certain date/time because the audio message will be expired, as argued by Petitioner. *Id.* at 15–16 (citing Ex. 1005, 1:49–51, 3:28–42, 3:53–58, 4:41–57, Figs. 3, 5; Ex. 1002 ¶¶ 54–55). Patent Owner does not raise any arguments as to this limitation. *See generally* PO Response. We are persuaded that Nabkel teaches this limitation.

Claim 1 recites, "enabling access by said subsequently accessing user to previously recorded messages having a matching qualifying parameter, otherwise the denial of such access." We are persuaded that Nabkel teaches this limitation by disclosing that the system determines if the user is attempting to access a message that has reached its expiration date/time and, if so, denying access, as argued by Petitioner. Pet. 16–18 (citing Ex. 1005, 1:49–51, 3:28–42, 4:41–47, 6:45–7:11, Figs. 3, 5; Ex. 1002 ¶¶58–60). Patent Owner does not raise any arguments as to this limitation. *See generally* PO Response. We are persuaded that Nabkel teaches this limitation.

Claim 1 recites, "wherein the qualifying parameter includes an indication of time and/or date for a user recording a message and for a user requesting playback of a message." Petitioner contends that Nabkel discloses that a user can set a message to expire in seven days. Pet. 19–20 (citing Ex. 1005, 3:32–34). Petitioner, relying on testimony of Mr. Andrews, contends that Nabkel would have rendered obvious using an indication of time and/or date as claimed, because a person of ordinary skill would have understood that there were a "finite number of identified, predictable solutions" to the time and date expiration embodiment disclosed in Nabkel, and would have had "good reason to pursue the known options within his or her technical grasp," including providing both indications of time and date in the qualifying parameter. *Id.* at 20 (citing *KSR Int'l Co. v. Teleflex Inc*., 550 U.S. 398, 402 (2007); Ex. 1002 ¶ 69). Specifically, Petitioner contends that a person of ordinary skill in the art, in implementing the time or date expiration feature of Nabkel, would have found it obvious to include both "an indication of time and/or date for a user recording a

message and an indication of time and/or date for a user requesting playback of a message" as claimed. *Id.*

We find Petitioner's arguments to be persuasive. Nabkel discloses that the user is prompted to enter "a time or date for automatic expiration of the communique," such as "a social group leader . . . set[ting] that message to expire in seven days." Ex. 1005, 3:28–32, Fig. 3. We rely on the testimony of Mr. Andrews, which we find credible, to determine that Nabkel's distinction between entering an expiration time *or* entering an expiration date, along with Nabkel's example of setting a message to expire in seven days, teaches that a user may enter an expiration time, such as by noting the time of recording and that expiration will occur seven days later, instead of a precise date of expiration, such as August 10. *See* Ex. 1002 ¶¶ 63–66, 69; Ex. 1005, 3:28–32, Fig. 3 (step 136).

On this record, we find that a person of ordinary skill in the art would have understood that there were "a finite number of identified, predictable solutions" to implement Nabkel's feature of setting a time or date for automatic expiration of the message, namely, (1) by setting an expiration time, or (2) by setting an expiration date. *See* Pet. 19–20 (citing *KSR*, 550 U.S. at 421); Ex. 1005, 3:28–34, Fig. 3; Ex. 1002 ¶¶ 63–66, 69. We credit the testimony of Mr. Andrews in finding that a person of ordinary skill in the art, in order to implement Nabkel's teaching of setting an expiration time of seven days, would have noted "the time that the message was created and the expiry was defined, so that the expiration will occur *seven days from that time*" (Ex. 1002 ¶ 65) "by enabling the qualifying parameter disclosed in Nabkel to include both (a) an indication of time and/or date for a user

recording a message and (b) an indication of time and/or date for a user requesting playback of a message" (*id.* ¶ 69).

We are persuaded that a person of ordinary skill who wanted to set a time for a message to expire, such as seven days after recording the message, would have had "good reason to pursue the known options within his or her technical grasp," such as determining whether the elapsed time between the recording date and the playback request date was greater than the expiration time of seven days. *KSR*, 550 U.S. at 421. "If this leads to the anticipated success" of causing the message to expire seven days after recording it, then "it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103." *Id.* Petitioner "provided convincing evidence that" determining whether an elapsed time between a recording date and a playback request date was greater than an expiration time "was a design step well within the grasp of a person of ordinary skill in the relevant art." *Id.* at 427.

We determine that Petitioner shows, by a preponderance of the evidence, that claim 1 is unpatentable as obvious over Nabkel.

*E. Asserted Obviousness of Claims 2–5 Over Nabkel and Hidary*

Petitioner contends that the combination of Nabkel and Hidary renders claims 2–5 obvious. Pet. 21–40.

*1. Hidary*

Hidary pertains to a cellular telephone system with means for selective delivery of advertising or other promotional material to subscribers. Ex. 1007, 1:6–8. An ad server of the system includes a memory bank to store a table of subscribers, and a corresponding profile for

each subscriber. *Id.* at 2:33–34. The profile of the subscriber includes information provided by the subscriber, such as age, gender, income, hobbies, and profession. *Id.* at 3:18–23. The memory bank also holds various commercial messages, which may be generic, or tailored for specific subscribers or geographic cells. *Id.* at code (57), 2:28–34. For example, the memory bank includes a memory for messages correlated with specific subscriber profile items. *Id.* at 2:42–43.

The ad server identifies a subscriber using a subscriber identifier, and looks up the corresponding profile in the memory bank. *Id.* at 3:13–17. The ad server selects an appropriate message for the subscriber from the memory bank based on the profile, and sends the message to the subscriber. *Id.* at 3:24–28. For example, if the subscriber has indicated that he likes to go to the movies, the message selected by the ad server may be an advertisement for a movie. *Id.* at 3:41–45.

The subscriber may also actively seek messages from the memory bank. *Id.* at 4:26–28. For example, if the subscriber is located in an unfamiliar area, he may want information about nearby restaurants and gas stations. *Id.* at 4:28–30. The subscriber sends a code to the system to indicate that he wants to access messages in the memory bank. *Id.* at 4:30–32. The ad server identifies the subscriber, and provides the subscriber with a list of available messages for the subscriber to select. *Id.* at 32–36.

*2. Analysis*

*Claim 2*

Petitioner contends that the limitations of claim 2 are identical to those of claim 1, with the exception of the "wherein" clause, and relies upon the arguments set forth in the proposed ground of anticipation of claim 1 by

Nabkel to teach the limitations of claim 2 that are identical to those recited in claim 1. Pet. 24–25.

Claim 2 recites, "wherein the qualifying parameter includes a user-supplied indication of a personal characteristic." Petitioner, relying on testimony of Mr. Andrews, contends that this limitation is taught by the combination of Nabkel and Hidary. Pet. 22–27 (citing Ex. 1005, 1:15–20, 1:40–45, 3:28–36, 3:53–58, 4:40–47, Fig. 3; Ex. 1007, Abstract, 1:19–65, 2:23–58, 3:4–61, 4:3–36, Fig. 3; Ex. 1002 ¶¶ 70–91). We find Petitioner's argument persuasive. Hidary discloses that

> The ad server 24 first determines the identity of the subscriber using subscriber identifier 52 (step 106) . . . . The microprocessor 50 uses this information to look up in data bank 26 the profile of subscriber 16 (step 110). From the profile the ad server then has to select an appropriate message from the messages stored in memory bank 26.
>
> Previously the subscriber 16 has been requested to provide information about himself which may be useful to target specific advertising for him. This information may 20 include the age, sex, income, hobbies, preferences, profession and other similar information. All this subscriber specific information is stored in memory 58.
>
> In step 112 the ad server selects a message appropriate for the subscriber 16 based on the profile.

Ex. 1007, 3:4–5, 13–26; *see id.* at 1:57–65, 2:25–34, 3:39–50; Ex. 1002 ¶¶ 72, 79. We find that Hidary's disclosure of personal characteristics provided by a subscriber, stored in a profile, and used to select a message appropriate for the subscriber, teaches "wherein the qualifying parameter includes a user-supplied indication of a personal characteristic."

Mr. Andrews testifies that Nabkel teaches giving a user access to a recorded message based on a user's identity. Ex. 1002 ¶¶ 76, 77, 80–82

(citing Ex. 1005, 1:15–20, 1:40–45, 3:53–58, 6:10–33). Mr. Andrews's testimony is supported by the record. Nabkel discloses "generating messages associated with a subscriber for receipt by predetermined callers based on their identity." Ex. 1005, 1:42–45. Nabkel discloses "assign[ing] a message . . . a personal PIN (Personal Identification Number) associated with a specific individual." Ex. 1005, 3:53–58. Nabkel also discloses

> Adjunct processor 12 then compares the ID number of the calling party . . . with the ID numbers stored in the subscriber's profile in the database associated with the adjunct processor 12 [to determine if] the ID number of the calling party 22 indicates that the calling party is authorized to receive a personal communique.

Ex. 1005, 6:10–16. Accordingly, we credit the testimony of Mr. Andrews in finding that Nabkel teaches giving a user access to a recorded message based on the user's identity.

Mr. Andrews testifies that Nabkel does not expressly disclose associating audio messages with user-supplied characteristics of the user. Ex. 1002 ¶ 78. Mr. Andrews testifies that Hidary teaches a memory storing a subscriber profile and recorded messages, where a subscriber sends a code to the system to allow the system to look up the subscriber's profile and select an appropriate message based on a user–supplied personal characteristic in the subscriber's profile. Ex. 1002 ¶¶ 73, 79 (citing Ex. 1007, 3:4–28, 4:26–36). Mr. Andrews's testimony is supported by the record. Hidary discloses "subscriber 16 sends a code to central station 12 to indicate that he wants to access the memory bank 26. The ad server 24 again identifies the subscriber and his cell 11 provides the subscriber with a list of messages that are available from the memory 60." Ex. 1007, 4:30–36.

Hidary also discloses "ad server 24 first determines the identity of the subscriber using subscriber identifier 52," "uses this information to look up in data bank 26 the profile of subscriber 16," and "selects a message appropriate for the subscriber 16 based on the profile." Ex. 1007, 3:4–5, 13–15, 24–25. Accordingly, we credit the testimony of Mr. Andrews in finding that Hidary teaches selecting a message for a subscriber based on a subscriber-supplied personal characteristic of the subscriber.

Mr. Andrews testifies that adding the personal characteristics from the subscriber profiles of Hidary to the subscriber profiles stored in the database of Nabkel, and identifying a subscriber using the identifier of Hidary in place of the identifier in Nabkel, yields the benefit of providing a wider range of possible qualifying parameters, such as selecting a message for a subscriber based on the personal characteristic of the subscriber as taught by Hidary. Ex. 1002 ¶¶ 79–82. Mr. Andrews's testimony is supported by the record, because Hidary teaches that a benefit of its system is providing automatic selective messages to various subscribers by selecting the messages "based on information about the subscriber, such as age, sex, income, hobbies, [and] profession." Ex. 1007, 1:33–35, 1:61–65. Therefore, we are persuaded that adding information from the subscriber profile database of Hidary to the subscriber profile database of Nabkel, and identifying a subscriber profile using the subscriber identifier of Hidary, yields the predictable results of looking up the profile of the subscriber, and selecting a message appropriate for the subscriber based on a personal characteristic from the profile as taught by Hidary. Pet. 23; Ex. 1007, 3:24–28, 3:39–50; Ex. 1002 ¶¶ 79, 81. *See KSR*, 550 U.S. at 416 ("The

combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.").

Patent Owner contends that Petitioner does not address the claim language, arguing that claim 2 defines each previously recorded message as having a qualifying parameter, which must itself include the user supplied indication of a personal characteristic. PO Resp. 14–15. According to Patent Owner, Hidary does not teach this limitation. *Id.* We are not persuaded by Patent Owner's contention. Hidary discloses a message memory bank that includes "memory 64 for messages correlated with specific profile items." Ex. 1007, 2:38–43; *see id.* at Fig. 2 (showing memory 64 containing "messages coded for specific subscriber interests"), 3:24–26 (The "ad server selects a message appropriate for the subscriber 16 based on the profile. These messages are stored in memory 60 or 64."), 3:46–48 ("If the subscriber indicates that he is an avid sports fan, the message from memory 64 may indicate when the subscriber's favorite team plays in his area."). We find that Hidary's disclosure of recorded messages coded for specific subscriber interests and selected based on a subscriber's indication of interest in the subscriber's profile, teaches "previously recorded messages having a matching qualifying parameter . . . wherein the qualifying parameter includes a user-supplied indication of a personal characteristic" as recited in claim 2.

Patent Owner also contends that Hidary is directed to an entirely different endeavor, namely, advertising. PO Resp. 15. Even if we were to find Hidary is not in the same field of endeavor as the '252 patent, Petitioner argues, and we agree, that Hidary "is reasonably pertinent to the particular problem with which the inventor is involved," namely, using qualifying

parameters to select an appropriate message. Pet. Reply 15; *see In re Klein*, 647 F.3d 1343, 1348 (Fed. Cir. 2011) ("[a] reference qualifies as prior art for an obviousness determination under § 103 only when it is analogous to the claimed invention" and "[t]wo separate tests define the scope of analogous art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the invention is involved"). We find Petitioner's argument is persuasive because Hidary is pertinent to the problem of how to use qualifying parameters to "select an appropriate message from messages stored in a memory bank." Pet. Reply 15 (quoting Ex. 1007, 3:4–20); *see* Pet. 21; *see also* Ex. 1001, 1:46–56 ("if the message contents are to be meaningful or interesting . . . some form of restriction or segregation must be applied").

Patent Owner also contends that Hidary does not grant or deny user access to previously recorded messages using a user-supplied indication of a personal characteristic. However, the Petition relies on Nabkel to teach granting or denying user access to previously recorded messages using a qualifying parameter, and relies on Hidary to teach that the qualifying parameter includes a user-supplied indication of a personal characteristic. Pet. 19–20, 22–23. We find Patent Owner's contention against Hidary alone unpersuasive. *See In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) ("Non-obviousness cannot be established by attacking references individually, where the rejections are based on combinations of references."); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Patent Owner further contends that the code of Hidary is automatically supplied, not entered by a user, and also is not an indication of a personal characteristic. PO Resp. 15–16. Therefore, according to Patent Owner, the code of Hidary is not "a user-supplied indication of a personal characteristic" as claimed. *Id.* However, the Petition relies on Hidary's disclosure of subscriber-supplied information such as age, sex, income, hobbies, and profession, stored in the subscriber profile 58, to teach the claimed "user-supplied indication of a personal characteristic." Pet. 22–23; Ex. 1002 ¶ 79. The Petition relies on the code of Hidary to teach a subscriber identifier that allows the system to look up the profile of the subscriber, and to select a message appropriate for the subscriber based on a personal characteristic stored in the profile. Pet. 26; Ex. 1002 ¶¶ 87–89. As we discussed above, Hidary's description of a subscriber providing "information about himself . . . includ[ing] the age, sex, income, hobbies, preferences, profession, and other similar information" teaches "wherein the qualifying parameter includes a user-supplied indication of a personal characteristic." Ex. 1007, 3:13–28. As we also discussed above, identifying a subscriber profile using the code of Hidary yields the predictable results of using the code to look up the profile of the subscriber, and to select a message appropriate for the subscriber based on a user-supplied personal characteristic from the profile as taught by Hidary.

We determine that Petitioner shows, by a preponderance of the evidence, that claim 2 is unpatentable over the combination of Nabkel and Hidary.

*Claim 3*

Petitioner contends that the limitations of claim 3 are identical to those of claim 1, with the exception of the "wherein" clause, and relies upon the arguments set forth in the proposed ground of anticipation of claim 1 by Nabkel to teach the limitations of claim 3 that are identical to those recited in claim 1. Pet. 27–28.

Claim 3 recites "wherein the personal characteristic is a pastime of the user." On this record, we are persuaded that Hidary teaches "the personal characteristic is a pastime of the user." As argued by Petitioner, Hidary discloses that the user-supplied indication of a personal characteristic can include information about the user's hobbies, such as movies or sports. Pet. 28–29 (citing Ex. 1007, 1:60–65, 3:4–29, 3:39–50; Ex. 1002 ¶¶ 97–98).

Patent Owner does not raise arguments specific to claim 3.

We determine that Petitioner shows, by a preponderance of the evidence, that claim 3 is unpatentable over the combination of Nabkel and Hidary.

*Claim 4*

Petitioner contends that the limitations of claim 4 are identical to those of claim 1, with the exception of the limitations following the "wherein" clause, and relies upon the arguments set forth in the proposed ground of anticipation of claim 1 by Nabkel to teach the limitations of claim 4 that are identical to those recited in claim 1. Pet. 29–30.

Claim 4 recites, "wherein the qualifying parameter includes a user-supplied indication of a personal characteristic." Petitioner contends clam 2 recites an identical limitation, and relies upon the arguments set forth in the proposed ground of obviousness of claim 2 over Nabkel and Hidary to teach

this limitation. Pet 30. As discussed in our analysis of claim 2 above, on this record, we agree with Petitioner that the combination of Nabkel and Hidary teaches this limitation.

Claim 4 recites "providing a menu selection by operation of which a user is enabled to supply an indication of one from a plurality of menu-listed personal characteristics." Petitioner contends Hidary teaches this limitation in disclosing an ad server providing a list of messages that are available from memory for a subscriber to select, and in disclosing that messages can be selected based on a user-supplied personal characteristic. Pet. 30–31 (citing Ex. 1007, 1:44–56, 3:39–61, 4:26–37; Ex. 1002 ¶¶ 104–106). Petitioner, relying on testimony of Mr. Andrews, contends that a person of ordinary skill would have modified the list of available messages for the user to choose, into a list of personal characteristics for the user to choose, because it would have provided the benefit of allowing the user to select an entire personal characteristic category, such as movie fan, rather than a specific message about a particular movie. Pet. 31–33 (citing Ex. 1007, 1:44–56, 3:39–61, 4:26–37; Ex. 1005, 2:30–33, 3:28–30; Ex. 1002 ¶¶ 107–110). We credit the testimony of Mr. Andrews in determining that the combination of Nabkel and Hidary teaches "further comprising: providing a menu selection by operation of which a user is enabled to supply an indication of one from a plurality of menu-listed personal characteristics."

Patent Owner does not raise arguments specific to claim 4.

We determine Petitioner shows, by a preponderance of the evidence, that claim 4 is unpatentable over the combination of Nabkel and Hidary.

*Claim 5*

Claim 5 recites a "group audio message board." Petitioner contends Nabkel teaches this limitation in disclosing a system that allows a user to record audio messages and allows authorized calling parties to hear the recorded audio messages. Pet. 33 (citing Ex. 1005, 1:54–65, 2:34–37, 3:5–28, 4:20–47; Ex. 1002 ¶¶ 111–112). We are persuaded that Nabkel teaches this limitation.

Claim 5 recites "a storage device." Petitioner contends Nabkel teaches this limitation in describing a database storage device associated with an adjunct processor that stores information provided by a user, including a user profile. Pet. 33 (citing Ex. 1005, 2:58–63, 3:5–10, 3:12–35, 3:52–61, 6:1–18, 6:27–33; Ex. 1002 ¶¶ 113–117). We are persuaded that Nabkel teaches this limitation.

Claim 5 recites

> a parameter index module wherein said parameter index module is operable to store a first message having a first at least one qualifying parameter by said board appended to the first message within said storage device in response to a first user of said group audio message board communicating the first message to said group audio message board.

Petitioner contends that Nabkel teaches the "parameter index module operable to store a first message . . . in response to a first user" communicating the message to the message board by describing an adjunct processor that interfaces with a first user to create and store an audio message in the database, and interfaces with a second user to retrieve the message from the database. Pet. 34–35 (citing Ex. 1005, 2:25–40, 3:12–27, 4:20–55, 5:60–6:40, Figs. 1, 3, 5, 6; Ex. 1002 ¶¶ 118–120). On this record,

we are persuaded that Nabkel teaches the "parameter index module operable to store a first message . . . in response to a first user" communicating the message to the message board.

Petitioner contends Nabkel teaches the "first message having at least one qualifying parameter by said board appended to the first message within said storage device" by describing a qualifying parameter associated with the message. Pet. 35 (citing Ex. 1005, 2:25–37, 5:60–6:40). Petitioner contends that although Nabkel does not expressly disclose appending the qualifying parameter to the message, Nabkel discloses that the database stores the message and information related to the message. Pet. 35–36 (citing Ex. 1005, 2:25–37, 5:60–6:40). Petitioner, relying on testimony of Mr. Andrews, contends that it would have been obvious to a person of ordinary skill in the art to store the qualifying parameter together with the message in the database for the benefit of easily locating the correct qualifying parameter for a particular audio message. Pet. 36 (citing Ex. 1002 ¶ 120).

Patent Owner contends that neither the Petitioner nor Mr. Andrews has shown that there would have been a finite number of identified, predictable solutions for associating a qualifying parameter with an audio message, including appending the qualifying parameter to the first message within the storage device. PO Resp. 12 (citing Ex. 1002 ¶ 120). Patent Owner also contends that various items of information can be stored separately within the same database, without appending one of those items to the other. *Id.* at 13; PO Sur-Reply 8–9.

The parties do not dispute that a skilled artisan would have known of the option of appending data to a file. *See* Pet. 36 (citing Ex. 1009); PO

Resp. 12–13 (citing Ex. 1009); Ex. 1007, Fig. 2 (showing memory 64 that contains messages coded for specific subscriber interests). Nabkel discloses storing the date/time qualifying parameter in the same database as the audio message. Ex. 1005, 2:25–37, 5:60–6:40; Ex. 1002 ¶¶ 119–120. We agree with Patent Owner's contention, that the qualifying parameter and the audio message of Nabkel could be stored within the same database (1) separately, or (2) with one item appended to the other item. *See* PO Resp. 12–13; Ex. 1002 ¶ 120. "As the Supreme Court explained, if trying such a limited number of solutions 'leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.'" *Perfect Web Technologies, Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1331 (Fed. Cir. 2009) (quoting *KSR*, 550 U.S. at 421).

Mr. Andrews testifies that a person of ordinary skill in this art would have appreciated the value of appending the qualifying parameter to the audio message. Ex. 1002 ¶ 120. We credit Mr. Andrews's testimony, which provides a clear reason for doing so, explaining that a person of ordinary skill would have understood that the benefits of appending the qualifying parameter to the audio message include making it easy to locate the correct qualifying parameter for a particular message, and ensuring that the qualifying parameter was processed along with the audio message. *Id.* "In these circumstances, there is a clear reason for a skilled artisan, knowing of the [appending] option, to try that option. And there is no . . . argument that success would be in doubt . . . or that unexpected results would be produced." *Google LLC v. Koninklijke Philips N.V.*, 795 F. Appx. 840, 845–46 (Fed. Cir. 2020).

"Here, the record reveals only two options for what happens" when the qualifying parameter and the audio message are stored in the database of Nabkel, (1) storing them separately, or (2) appending the qualifying parameter to the audio message. *Id.* at 846. "[S]imple logic suggests that [appending the qualifying parameter to the audio message] is a readily achievable option and . . . will serve the undisputed goal of" making it easy to locate the correct qualifying parameter for a particular message and ensuring that the qualifying parameter was processed along with the audio message. *Id.* Moreover, as discussed above, Mr. Andrews provides a clear reason for trying the option of appending the qualifying parameter to the audio message. We are persuaded that Nabkel teaches the "first message having at least one qualifying parameter by said board appended to the first message within said storage device."

Claim 5 recites "the first at least one qualifying parameter for enabling access to the first message by a second user of said group audio message board." Petitioner contends Nabkel teaches this limitation in describing an automatic expiration date set by the user recording the audio message. Pet. 37 (citing Ex. 3:28–58; 4:40–48; Ex. 1002 ¶ 121); *see* Ex. 1002 ¶¶ 48–53. We are persuaded that Nabkel teaches this limitation.

Claim 5 recites "wherein said parameter index module is further operable to enable access to the first message by the second user in response to the second user communicating the first at least one qualifying parameter to said group audio message board." Petitioner contends Nabkel teaches this limitation in disclosing that a second user is granted access to a recorded audio message only when the user communicates a qualifying parameter to the system that matches the qualifying parameter appended to the recorded

audio message. Pet. 37–38 (citing Ex. 1005, 6:10–26; Ex. 1002 ¶ 122); *see* Ex. 1002 ¶¶ 48–53. We are persuaded that Nabkel teaches this limitation.

Claim 5 recites "wherein the qualifying parameter includes a user-supplied indication of a personal characteristic." Petitioner contends this limitation is taught by the combination of Nabkel and Hidary. Pet. 38. We are persuaded that the combination of Nabkel and Hidary teaches this limitation for the reasons given in our analysis of claim 2 above.

Claim 5 recites "wherein said parameter index module is further operable to store a second message having a second at least one qualifying parameter appended to the second message within said storage device in response to the first user communicating the first message to said group audio message board." Petitioner contends Nabkel teaches this limitation in describing that the first user, after recording a first message, can create and store a second message with a second qualifying parameter. Pet. 39 (citing Ex. 1005, 3:53–64, 6:34–39, Figs. 2, 3; Ex. 1002 ¶ 124). We are persuaded that Nabkel teaches this limitation.

Claim 5 recites "the second at least one qualifying parameter for enabling an access to the second message by the second user." Petitioner contends Nabkel teaches this limitation in describing an expiration date/time to restrict access to the message by a second user. Pet. 39–40 (citing Ex. 1005, 3:28–58, 4:40–48, 5:42–60, 6:10–26; Ex. 1002 ¶ 125). We are persuaded that Nabkel teaches this limitation.

Claim 5 recites "wherein said parameter index module is further operable to enable access to the second message by the second user in response to the second user communicating the second at least one qualifying parameter to said group audio message board." Petitioner

contends Nabkel teaches this limitation in describing that after a second user is presented with a first audio message, the adjunct processor repeats the entire process to determine if the second user is authorized to access any other recorded audio messages. Pet. 40–41 (citing Ex. 1005, 6:33–38, Fig. 5; Ex. 1002 ¶ 126). We are persuaded that Nabkel teaches this limitation.

We determine Petitioner shows, by a preponderance of the evidence, that claim 5 is unpatentable over the combination of Nabkel and Hidary.

*F. Asserted Obviousness Over Ala-Laurila and Hidary*

Petitioner contends that the combination of Ala-Laurila and Hidary renders claims 2–5 obvious. Pet. 41–65.

*1. Ala-Laurila*

Ala-Laurila pertains to providing multiple recipients limited access to a network subscriber's mailbox in a cellular network for retrieving designated messages. Ex. 1006, 1:9–14. A network subscriber accesses a subscriber's mailbox which contains a message, by entering a voice messaging service address code and entering a personal access code. *Id.* at Abstract. A temporary access code is then assigned to the selected message and the messaging service address code and temporary access code are transmitted to the intended recipients of the voice message to allow the intended recipients to access the selected message by contacting the voice messaging service and entering the temporary access code. *Id.*

*2. Analysis*

*Claim 2*

Claim 2 recites, "generating and storing by said system at least one qualifying parameter pertaining to the access to the audio data recorder." Petitioner contends Ala-Laurila teaches this limitation in describing

generating and storing a temporary access code and assigning the code to a message stored in a voice mail server, such that subsequent users need the code to access the message. Pet. 47–49 (citing Ex. 1006, 2:6–24, 3:60–4:4, 4:32–47, 4:33–65, 5:1–20; Ex. 1002 ¶¶ 143–145).

Patent Owner contends that Ala-Laurila's wireless network, which corresponds to the claimed "communications system," does not teach "storing by said system at least one qualifying parameter" as claimed. PO Resp. 10–11. Petitioner argues that Patent Owner's contention that Ala-Laurila fails to teach this limitation is based on an erroneous construction of this limitation. Pet. Reply 12. We agree that Patent Owner's construction is erroneous, for the reasons discussed in our construction of "said system" and our previous analysis of claim 2 in Section II.E above. The Petition relies on the voice mail server of Ala-Laurila, corresponding to the claimed "audio data recorder," to teach "storing by said system at least one qualifying parameter" as claimed. Pet. 48–49 (citing Ex. 1006, 3:44–4:4, 4:33–65, Fig. 1; Ex. 1002 ¶ 145). We are persuaded that Ala-Laurila teaches this limitation.

Claim 2 recites, "determining a qualifying parameter for a subsequent access to the audio data recorder by a user." Petitioner contends Ala-Laurila teaches this limitation in describing that recipients of the temporary access code call the mail server and use the temporary access code to retrieve the temporary message. Pet. 49–50 (citing Ex. 1007, 3:60–4:4, 4:33–65; Ex. 1002 ¶¶ 146–147). We are persuaded that Ala-Laurila teaches this limitation.

Claim 2 recites, "enabling access by said subsequently accessing user to previously recorded messages having a matching qualifying parameter,

otherwise the denial of such access." Petitioner contends Ala-Laurila teaches this limitation in describing that the voice mail server allows a subsequent user to access the message only if the user communicates a temporary access code that matches the temporary access code assigned to the message. Pet. 50 (citing Ex. 1007, 2:6–24, 3:60–4:4, 4:33–65; Ex. 1002 ¶ 148). On this record, we are persuaded that Ala-Laurila teaches this limitation.

Claim 2 recites, "wherein the qualifying parameter includes a user-supplied indication of a personal characteristic." Petitioner contends that Ala-Laurila teaches the claimed "qualifying parameter" in describing a temporary access code needed to access a recorded message as discussed above, and that Hidary teaches the qualifying parameter including a user-supplied indication of a personal characteristic. Pet. 51 (citing Ex. 1002 ¶¶ 149–150). In particular, Petitioner contends that Hidary discloses associating an audio message with a user-supplied indication of a personal characteristic, such as the age, sex, income, hobbies, preferences, and profession of the user. Pet. 51 (citing Ex. 1007, 3:4–27, 4:26–36).

Hidary discloses an ad server with a memory bank that stores a profile for a subscriber, including information provided by the subscriber, such as age, sex, income, hobbies, preferences, and profession. *Id.* at 2:33–34, 2:39–40, 3:13–23. Hidary discloses that the memory bank also stores messages correlated with specific profile items. *Id.* at 2:42–43. Hidary discloses that the ad server selects a message appropriate for a subscriber based on the subscriber's profile, such as an advertisement for a recently released movie when the subscriber's profile indicates that the subscriber likes going to movies. *Id.* at 3:24–25, 3:42–50. We are persuaded that Hidary's

description of using a profile to select a message appropriate for the subscriber, where the profile includes information provided by the subscriber, such as hobbies, teaches "wherein the qualifying parameter includes a user-supplied indication of a personal characteristic."

Petitioner contends that a person of ordinary skill in the art would have modified Ala-Laurila's qualifying parameter to include a user-supplied indication of a personal characteristic as taught by Hidary for the benefit of allowing the system to send an appropriate and relevant audio message to that user as taught by Hidary. Pet. 52 (citing Ex. 1002 ¶¶ 149–150). Mr. Andrews testifies that a problem with using Ala-Laurila's temporary access code is that the network subscriber originating the message must manually determine which recipients receive the code, which is time consuming and requires the subscriber to remember types of messages for each recipient. Ex. 1002 ¶ 135. Mr. Andrews testifies that the user-supplied indication of a personal characteristic taught by Hidary would be an improvement to Ala-Laurila's temporary access code, because the subscriber can classify users according to their profile information, automatically cross-reference between the type of message and a database of user profiles, and send a temporary access code to numerous appropriate recipients. *Id.* Mr. Andrews testifies that, by using the method in Hidary, a user would enter a code for identification, and the system would determine the user's personal characteristics and present an appropriate audio message. *Id.* ¶ 150. Mr. Andrews testifies that the improvement of automatically determining to which recipients to send the access code for any particular type of message is predictable, and allows the message originator to assign access codes to

users for whom the message would be appropriate, without the need to do so manually. *Id.* ¶¶ 135, 150.

Patent Owner contends that the system of Ala-Laurila allows a subscriber who records an audio message to manually determine which recipients will receive the temporary access code, and that the subscriber would not benefit from replacing this manual process with the process of Hidary. PO Resp. 17–19. According to Patent Owner, neither the Petition, nor Mr. Andrews, nor the prior art, shows that Ala-Laurila's manual process of entering names is a deficiency. *Id.* Patent Owner contends that the manual process of Ala-Laurila is not a deficiency, but rather, a fundamental principle of operation. *Id.* (citing Ex. 1006, Abstract, 3:61–65).

Petitioner contends that substituting the personal characteristic of Hidary for the temporary code of Ala-Laurila does not destroy the functionality of Ala-Laurila's principle of operation, which is providing a user with access to a restricted message by matching data of the message with corresponding data of the user. Pet. Reply 17–18. In particular, Petitioner contends that both Hidary's personal characteristic, and Ala-Laurila's temporary code, provide a user with access to a restricted message by matching data of the message (the personal characteristic or the temporary code) with corresponding data of the user. *Id.* (citing Ex. 1007, 2:38–43, 3:15–17, 3:24–28; Ex. 1006, 3:61–4:3). Mr. Andrews testifies that using Hidary's approach to classify users according to profile information allows the system of Ala-Laurila to cross reference between types of messages and the database of user profiles, in order to send a temporary code to numerous appropriate recipients automatically rather than manually. Ex. 1002 ¶¶ 135, 150.

We agree with Petitioner and Mr. Andrews. Ala-Laurila discloses providing access of select messages by matching a temporary access code of a user to a temporary access code of a message. Ex. 1006, Abstract, 3:61–4:3. Hidary discloses providing access to select messages by matching a personal characteristic of a user to a personal characteristic of a message. Ex. 1007, 3:13–28. The Supreme Court has "recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result." *KSR,* 550 U.S. at 416. Here, substitution of the personal characteristic of Hidary for the temporary access code of Ala-Laurila yields the predictable result of automatically providing access to select messages as taught by Hidary. Ex. 1007, 1:33–43.

Further, we disagree with Patent Owner's contention that the prior art does not teach a benefit to modifying the manual selection process of Ala-Laurila. Hidary teaches that an advantage of its system is that it provides automatic selective messages to various subscribers. Ex. 1006, 1:33–35. Hidary teaches that its system "is easily integrated with the existing system so that there is a minimal amount of additional equipment, or modifications required." *Id.* at 1:36–38. Hidary teaches that its system provides messages to targeted audiences in an efficient and reliable manner, yet does not interfere with the normal operation of the telephone system. *Id.* at 1:39–43. Mr. Andrews testifies that using Hidary's approach to classify users according to profile information allows the system of Ala-Laurila to cross reference between types of messages and the database of user profiles, in order to send a temporary code to numerous appropriate recipients automatically rather than manually. Ex. 1002 ¶¶ 135, 150.

We find that the testimony of Mr. Andrews regarding the benefits of automatically selecting appropriate messages is supported by Hidary's teaching of automatically selecting and delivering an audio message to a user, where the content of that message is based on the user's profile. *See* Ex. 1007, Abstract, 1:33–43, 3:13–25, 3:39–50, 4:26–37. We are persuaded that the Petition and supporting evidence show that using the user-supplied indication of a personal characteristic of Hidary as the qualifying parameter of Ala-Laurila does no more than yield the predictable results of automatically selecting an audio message based on the content of the user profiles, and delivering the message to an appropriate user in an efficient and reliable manner, as taught by Hidary. *See* Pet. 44–45; Ex. 1007, Abstract, 1:33–43, 3:24–28, 3:39–50; Ex. 1002 ¶¶ 135, 150.

We determine that Petitioner shows, by a preponderance of the evidence, that claim 2 is unpatentable over the combination of Ala-Laurila and Hidary.

*Claim 3*

Petitioner contends that the limitations of claim 3 are identical to those of claim 2, with the exception of "wherein said personal characteristic is a pastime of the user," and relies upon the arguments set forth in the analysis of claim 2 to teach the identical limitations. Pet. 52–53.

Claim 3 recites, "wherein the personal characteristic is a pastime of the user." Petitioner contends that Hidary discloses that the user-supplied indication of a personal characteristic can include information about the user's hobbies, such as movies or sports. Pet. 53–54 (citing Ex. 1007, 3:4–29, 3:39–50; Ex. 1002 ¶¶ 156–157). Hidary discloses that the user can provide information about his hobbies, such as movies or sports, and that

this information is stored in a profile of the ad server's memory bank. Ex. 1007, 3:13–23, 3:42–50. We are persuaded that Hidary teaches "the personal characteristic is a pastime of the user."

We determine Petitioner shows, by a preponderance of the evidence, that claim 3 is unpatentable over the combination of Ala-Laurila and Hidary.

*Claim 4*

Petitioner contends that the limitations of claim 4 are identical to those of claim 2, with the exception of "further comprising: providing a menu selection by operation of which a user is enabled to supply an indication of one from a plurality of menu-listed personal characteristics," and relies upon the arguments set forth in the analysis of claim 2 to teach the identical limitations. Pet. 54–55.

Claim 4 recites, "further comprising: providing a menu selection by operation of which a user is enabled to supply an indication of one from a plurality of menu-listed personal characteristics." Petitioner contends that Hidary teaches this limitation in disclosing an ad server providing a list of messages that are available from memory for a subscriber to select, and in disclosing that messages can be selected based on a user-supplied personal characteristic. Pet. 56–58 (citing Ex. 1007, 1:44–56, 3:39–61, 4:26–37). Petitioner, relying on testimony of Mr. Andrews, contends that a person of ordinary skill would have modified the list of available messages for the user to choose, into a list of personal characteristics for the user to choose, for the benefit of allowing the user to select an entire personal characteristic category, such as movie fan, rather than a specific message about a particular movie. Pet. 57–58 (citing Ex. 1002 ¶¶ 163–166).

We are persuaded that the combination of Ala-Laurila and Hidary

teaches "further comprising: providing a menu selection by operation of which a user is enabled to supply an indication of one from a plurality of menu-listed personal characteristics."

We determine that Petitioner shows, by a preponderance of the evidence, that claim 4 is unpatentable over the combination of Ala-Laurila and Hidary.

*Claim 5*

Claim 5 recites a "group audio message board." Petitioner contends Ala-Laurila teaches this limitation in disclosing a system including a mail server with a message database selector and a message database, and a communication network that allows a user to record a message on the system and subsequent users to access the messages. Pet. 58 (citing Ex. 1006, 1:26–2:24, 2:45–3:30, 3:40–4:3, 4:33–65, Fig. 1; Ex. 1002 ¶¶ 167–169). We are persuaded that Ala-Laurila teaches this limitation.

Claim 5 recites "a storage device." Petitioner contends Ala-Laurila teaches this limitation in disclosing a network message database that stores audio messages and temporary access codes associated with those messages. Pet. 58–59 (citing Ex. 1006, 1:34–45, 2:6–24, 3:12–30, 3:47–4:3, 4:33–65, 5:1–20, Fig. 1; Ex. 1002 ¶¶ 170–172). We are persuaded that Ala-Laurila teaches this limitation.

Claim 5 recites a "parameter index module." Petitioner contends Ala-Laurila teaches this limitation in disclosing a message database selector that receives and stores temporary messages in a network message database. Pet. 59 (citing Ex. 1006, 1:34–45, 2:6–24, 3:12–30, 3:43–4:3, 4:33–65, Fig. 1;

Ex. 1002 ¶¶ 172–173). We are persuaded that Ala-Laurila teaches this limitation.

Claim 5 recites "wherein said parameter index module is operable to store a first message . . . in response to a first user of said group audio message board communicating the first message to said group audio message board." Petitioner contends Ala-Laurila teaches this limitation in disclosing a message database selector that interfaces with the first user to create a first audio message, and to store the first message in the network message database. Pet. 59–60 (citing Ex. 1006, 1:34–45, 2:6–24, 3:12–30, 3:47–4:3, 4:33–65, Fig. 1; Ex. 1002 ¶ 174). We are persuaded that Ala-Laurila teaches this limitation.

Claim 5 recites "a first message having a first at least one qualifying parameter by said board appended to the first message within said storage device." Petitioner contends Ala-Laurila teaches this limitation in disclosing assigning a temporary access code to the first message stored in the database. Pet. 60 (citing Ex. 1006, 2:11–15, 3:47–4:3, 4:33–56, 4:57–51, Figs. 1, 2; Ex. 1002 ¶ 174). Petitioner, relying on testimony of Mr. Andrews, contends that a person of ordinary skill in the art would have understood that there were a finite number of identified, predictable ways of associating the qualifying parameter with the audio message, including appending the qualifying parameter to the audio message within the database. Pet. 60–61 (citing Ex. 1002 ¶ 174). Patent Owner contends that the Petition does not identify a finite number of practical solutions, nor explain any rational underpinning for such a conclusion. PO Resp. 13–14; PO Sur-Reply 8–9. We find Patent Owner's contentions unpersuasive for

the reasons given in our previous analysis of claim 5 above. We are persuaded that Ala-Laurila teaches this limitation.

Claim 5 recites "the first at least one qualifying parameter for enabling an access to the first message by a second user of said group audio message board." Petitioner contends Ala-Laurila teaches this limitation in disclosing a temporary access code that grants a user access to retrieve a first recorded audio message. Pet. 62 (citing Ex. 1006, 3:60–4:3, 4:33–65, Fig. 2; Ex. 1002 ¶ 175). We are persuaded that Ala-Laurila teaches this limitation.

Claim 5 recites "wherein said parameter index module is further operable to enable access to the first message by the second user in response to the second user communicating the first at least one qualifying parameter to said group audio message board." Petitioner contends Ala-Laurila teaches this limitation in disclosing that a second user will only gain access to the stored audio message by communicating a temporary access code that matches the temporary access code appended to the stored audio message. Pet. 62 (citing Ex. 1006, 3:60–4:3, 4:33–65, Fig. 2; Ex. 1002 ¶ 176).

Claim 5 recites "wherein the qualifying parameter includes a user-supplied indication of a personal characteristic." Petitioner contends that this limitation is taught by the combination of Ala-Laurila and Hidary. Pet. 62–63 (citing Ex. 1002 ¶ 177). We are persuaded that the combination of Ala-Laurila and Hidary teaches this limitation for the reasons given in our analysis of claim 2 above.

Claim 5 recites "wherein said parameter index module is further operable to store a second message having a second at least one qualifying parameter appended to the second message within said storage device in response to the first user communicating the first message to said group

audio message board." Petitioner contends Ala-Laurila teaches this limitation in disclosing a first user storing a second message having its own unique temporary access code. Pet. 63 (citing Ex. 1006, 1:9–14, 1:39–44, 1:65–2:1, 2:5–25, 3:1–4, 3:13–30, 3:47–4:65, 5:1–10, 5:16–35, Fig. 1; Ex. 1002 ¶ 178). We are persuaded that Ala-Laurila teaches this limitation.

Claim 5 recites "the second at least one qualifying parameter for enabling an access to the second message by the second user." Petitioner contends Ala-Laurila teaches this limitation in disclosing recording a second audio message with its own temporary access code, and granting access to a second user only after the second user enters the correct second temporary access code. Pet. 63–64 (citing Ex. 1006, 3:60–4:3, 4:33–68, Fig. 2; Ex. 1002 ¶ 179).

Claim 5 recites "wherein said parameter index module is further operable to enable access to the second message by the second user in response to the second user communicating the second at least one qualifying parameter to said group audio message board." Petitioner contends that Ala-Laurila teaches this limitation in disclosing that a second user will only gain access to a second stored message when the second user enters a temporary access code that matches the second temporary access code. Pet. 64–65 (citing Ex. 1006, 3:60–4:3, 4:33–65, Fig. 2; Ex. 1002 ¶ 180). We are persuaded that Ala-Laurila teaches this limitation.

We determine Petitioner shows, by a preponderance of the evidence, that claim 5 is unpatentable over the combination of Ala-Laurila and Hidary.

*G. Asserted Obviousness Over Ala-Laurila and Nabkel*

Petitioner contends that the combination of Ala-Laurila and Nabkel renders claim 1 obvious. Pet. 65–69. Petitioner relies upon Ala-Laurila to

teach the limitations of claim 1 as discussed in the analysis of claim 2 as obvious over Ala-Laurila and Hidary, with the exception of the "wherein" clause. *Id.* at 67–68 (citing *id.* at 47–50). Petitioner relies upon Nabkel to teach the "wherein" clause as discussed in the analysis of claim 1 as obviousness over Nabkel. *Id.* at 68–69 (citing *id.* at 19–20). Petitioner, relying on testimony of Mr. Andrews, contends that a person of ordinary skill in the art would have supplemented Ala-Laurila's user-supplied temporary code with a qualifying parameter that includes an indication of a date and/or time as taught by Nabkel for the benefit of providing an automatic means of removing messages that are no longer relevant as taught by Nabkel. *Id.* at 66; Ex. 1002 ¶¶ 187–188. We credit the testimony of Mr. Andrews in determining that the combination of Ala-Laurila and Nabkel teaches this limitation.

We determine Petitioner shows by a preponderance of the evidence that claim 1 is unpatentable over the combination of Ala-Laurila and Nabkel.

*H. Real Parties in Interest*

Patent Owner contends that the Petition fails to name all real parties in interest ("RPIs") as required by 35 U.S.C. § 312(a)(2). PO Resp. 19–35. Patent Owner's contention that the Petition fails under § 312(a)(2) is "a contention that the agency should have refused to institute an inter partes review," which "raises an ordinary dispute about the application of an institution-related statute." *ESIP Series 2, LLC v. Puzhen Life USA, LLC*, 958 F.3d 1378, 1386 (Fed. Cir. 2020) (citing *Thryv, Inc v. Click-To-Call Techs., LP*, 140 S. Ct. 1367, 1373–74 (2020)). The Petitioner bears the burden of persuasion to show that it accurately names all RPIs. *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1343, 1356 (Fed. Cir.

2018) ("*AIT*"). We generally accept Petitioner's initial identification of its RPIs unless Patent Owner presents some evidence to support its argument that an unnamed party should be included as an RPI. *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242 (Fed. Cir. 2018). Whether a particular entity is an RPI is a "highly fact-dependent question" that is assessed "on a case-by-case basis." Patent Trial and Appeal Board Consolidated Trial Practice Guide 13 (Nov. 2019), https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf. We consider multiple factors, including the following: whether a non-party is funding, directing, or controlling the IPR; whether the non-party had the ability to exercise control; the non-party's relationship with the petitioner and with the petition, including any involvement in the filing; and the nature of the entity filing the petition. *Id.* at 15–18.

Petitioner identifies Unified Patents, Inc. ("Unified") as the sole RPI in this proceeding. Pet. 70. Patent Owner, relying primarily on the Federal Circuit's decision in *AIT* and also on a concurring opinion from IPR2018-00199 (May 31, 2019) (Paper 33), contends that Petitioner also should have named Apple, Inc. ("Apple") as an RPI. PO Resp. 19–20. Patent Owner contends that because Apple was a paid member of Unified prior to Patent Owner filing a suit against Apple asserting infringement of the '252 patent, and remains a member, Apple has a preexisting, established relationship with Unified. *Id.* at 22–23. In addition, Patent Owner asserts that Apple is the beneficiary of the Petition because "as a client of Unified who was sued in district court litigation asserting the '252 patent, it is self-evident that Apple has an interest in and will benefit from Unified's actions in this trial." *Id.* at 27 (citing *AIT*, 897 F.3d at 1353).

Petitioner asserts that "[n]o other party exercised control or could exercise control over Unified's participation in this proceeding, the filing of this petition, or the conduct of any ensuing trial," and provides voluntary interrogatory responses in support of that certification. Pet. 70 (citing Ex. 1003); *see* Pet. Reply 19–29. Petitioner also contends that the concurring opinion from IPR2018-00199 should be unpersuasive, because every time the issue of whether Unified is the sole RPI has been considered by the Board, the Board has held that Unified is the sole RPI. Pet. Reply 26 (citing IPR2014-01252, Paper 37; IPR2016-00364, Paper 13; IPR2017-02148, Paper 9 (all pre-*AIT*); IPR2018-00199, Paper 33; IPR2018-00883, Paper 36; IPR2017-01430, Paper 30; IPR2018-01186, Paper 24, Paper 56; IPR2018-01150, Paper 9; IPR2018- 00952, Paper 31; IPR2019-00474, Paper 9; IPR2019-00482, Paper 36).

Here, the facts of this case are distinguishable from *AIT* where Salesforce—the alleged unnamed RPI—made a payment to petitioner RPX shortly before RPX filed its petition, discussed the patent and related litigation with RPX, and shared a board member with RPX, and RPX negotiated a license on behalf of Salesforce. *See AIT*, 897 F.3d at 1340–42. In contrast, we agree with Petitioner that the record here contains insufficient evidence of client-specific or pre-filing communications between Unified and Apple regarding this proceeding or the preparation of the Petition filed in this proceeding. *See* Pet. 70, Pet. Reply 19–20. There is also no specific evidence that the Petition was filed at Apple's behest. *See* Pet. Reply 20–26. We also agree with Petitioner, that the persuasiveness of the concurring opinion in IPR2018-00199 is outweighed by the fact that other decisions by the Board that have addressed whether Unified is the sole

IPR have held that Unified is the sole RPI absent a showing of control or involvement by the Unified member. Consequently, the evidence and arguments advanced by Patent Owner do not lead us to determine that Apple is an unnamed RPI to this proceeding.

## III. CONCLUSION[7]

In summary:

| Claims | 35 U.S.C. § | Reference(s)/Basis | Claims Shown Unpatentable | Claims Not shown Unpatentable |
|---|---|---|---|---|
| 1 | § 102(b) | Nabkel | | 1 |
| 1 | § 103(a) | Nabkel | 1 | |
| 2–5 | § 103(a) | Nabkel, Hidary | 2–5 | |
| 2–5 | § 103(a) | Ala-Laurila, Hidary | 2–5 | |
| 1 | § 103(a) | Ala-Laurila, Nabkel | 1 | |
| **Overall Outcome** | | | 1–5 | |

## IV. ORDER

[7] Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner's attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. *See* 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. *See* 37 C.F.R. §§ 42.8(a)(3), (b)(2).

Accordingly, it is

ORDERED that claims 1–5 are unpatentable under 35 U.S.C. § 103;

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

For PETITIONER:

Trenton Ward
Lionel Lavenue
Umber Aggarwal
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
trenton.ward@finnegan.com
lionel.lavenue@finnegan.com
umber.aggarwal@finnegan.com

Jessica Marks
Roshan Mansinghani
Jonathan Stroud
UNIFIED PATENTS INC.
jessica@unifiedpatents.com
roshan@unifiedpatents.com
jonathan@unifiedpatents.com

For PATENT OWNER:

Ryan Loveless
Brett Mangrum
James Etheridge
Jeffrey Huang
ETHERIDGE LAW GROUP PLLC
ryan@etheridgelaw.com
brett@etheridgelaw.com
jim@etheridgelaw.com
jeff@etheridgelaw.com