

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,  
Petitioner,

v.

UNILOC 2017 LLC,  
Patent Owner.

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IPR2020-00463  
Patent 8,194,632 B2

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Before DAVID C. McKONE, JESSICA C. KAISER, and  
SHARON FENICK, *Administrative Patent Judges*.

FENICK, *Administrative Patent Judge*.

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

## I. INTRODUCTION

### A. *Background and Summary*

Google LLC (“Petitioner”), filed a Petition for *inter partes* review of claims 1, 8, and 15 (“the challenged claims”) of U.S. Patent No. 8,194,632 B2 (Ex. 1001, “the ’632 patent”). Paper 1 (“Pet.”). Uniloc 2017 LLC (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Pursuant to 35 U.S.C. § 314, we instituted this proceeding. Paper 13 (“Inst. Dec.”).

Patent Owner filed a Patent Owner’s Response (Paper 17, “PO Resp.”), Petitioner filed a Reply to the Patent Owner’s Response (Paper 19, “Reply”), and Patent Owner filed a Sur-Reply to the Reply (Paper 21, “Sur-reply”). An oral argument was held on May 13, 2021 (Paper 28, “Tr.”).

We have jurisdiction under 35 U.S.C. § 6(b)(4). This Decision is a final written decision under 35 U.S.C. § 318(a) as to the patentability of claims 1, 8, and 15. Based on the record before us, Petitioner has proved, by a preponderance of the evidence, that claims 1, 8, and 15 are unpatentable.

### B. *Real Parties in Interest and Related Matters*

Petitioner identifies only itself as the real party in interest. Pet. 60. Patent Owner identifies only itself as the real party in interest. Paper 3, 1.

Petitioner and Patent Owner identify *Uniloc 2017 LLC v. Google LLC*, No. 2:18-cv-00499 (E.D. Tex.) (“related district court action”) as a related matter. Pet. 60; Paper 3, 2. Petitioner and Patent Owner each note that this case has been transferred to the Northern District of California. Paper 7, 1–2; Paper 12, 1; Ex. 1023. Petitioner in an updated mandatory notice states that the Northern District of California dismissed the litigation for lack of subject matter jurisdiction, and that a notice of appeal has been filed. Paper 18.

*C. The '632 Patent*

The '632 patent is directed to establishing network connections between a stationary terminal (such as a laptop, desktop, or workstation) and a remote device (a remote stationary terminal or a mobile device, such as a smart phone or PDA) through intermediary mobile devices. Ex. 1001, code (54), 1:25–31, 2:51–56. Figure 1 of the '632 patent is reproduced below:

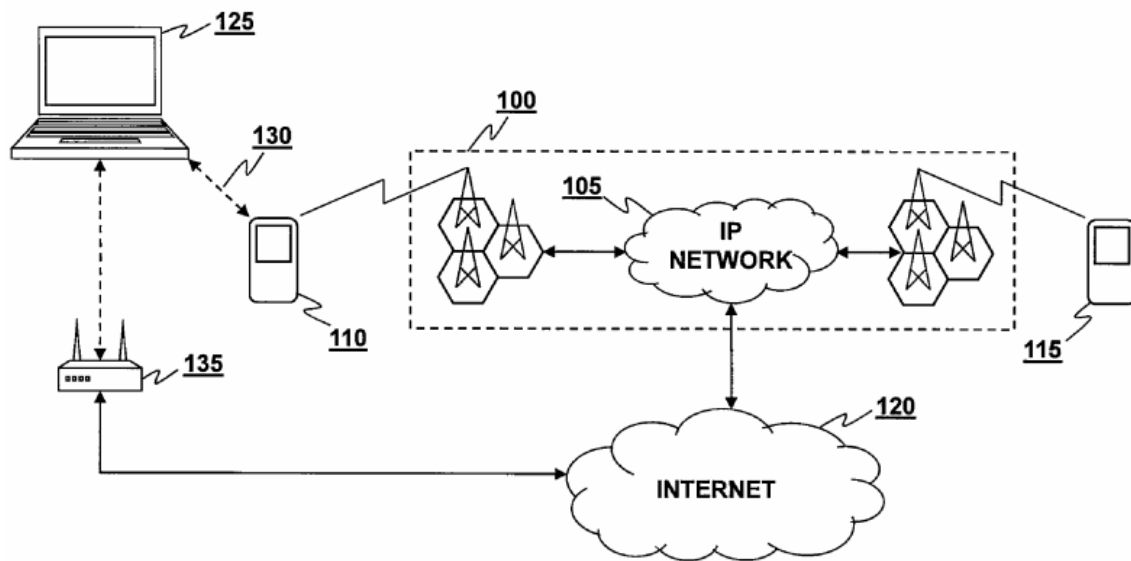


FIG. 1

Figure 1 is a diagram of an environment in which the invention may be deployed. *Id.* at 2:29–30, 2:40–41.

In Figure 1, mobile devices 110 and 115 are connected via cellular wireless network system 100, and mobile device 110 is connected via a short-range wireless technology, such as Bluetooth, with stationary terminal 125. *Id.* at 1:40–50, 1:61–67, 3:20–40, 5:1–20. Stationary terminal 125 also can access the Internet 120. *Id.* at 3:9–16.

The '632 patent describes one embodiment of the invention in which a network connection is established between an initiating stationary terminal

(such as stationary terminal 125 in Fig. 1) and a remote device (such as mobile device 115 in Fig. 1), and describes this embodiment with reference to Figure 3, reproduced below. *Id.* at 2:34–36, 4:29–67.

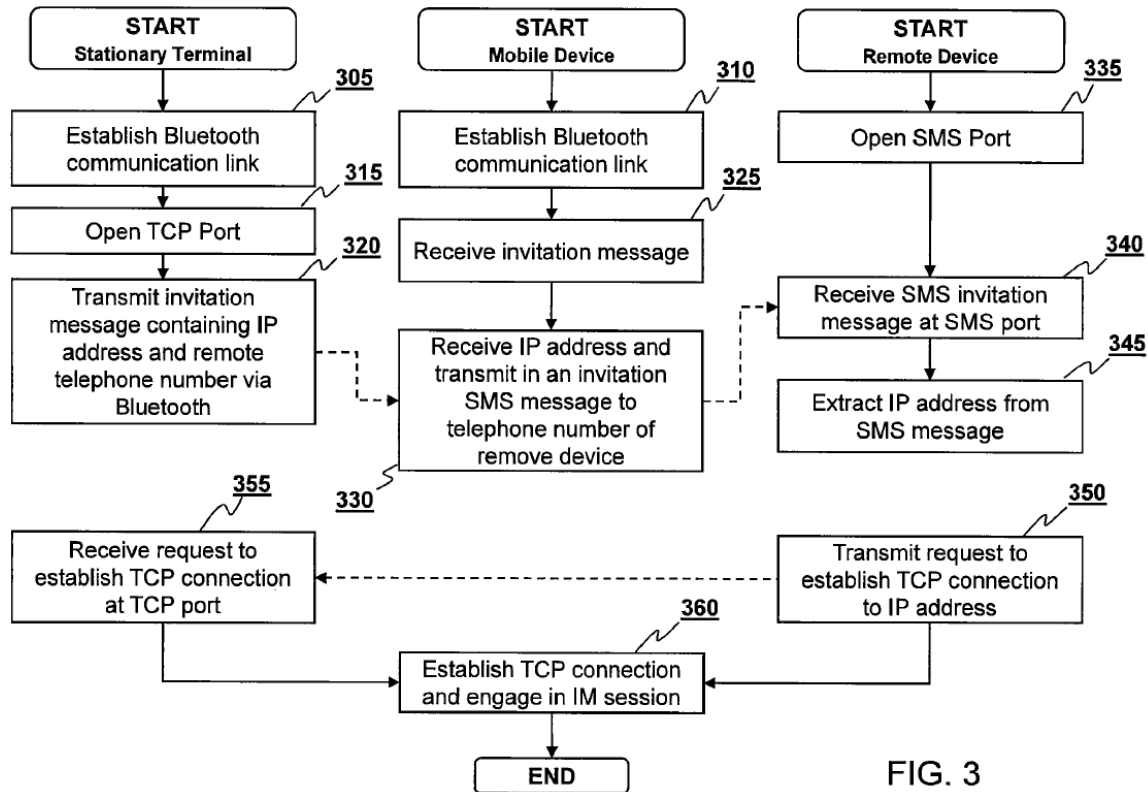


Figure 3 is a flow chart that depicts steps performed by a stationary terminal, a mobile device proximate to the stationary terminal, and a remote device. *Id.* at 4:29–67. The stationary terminal and proximate mobile device establish a Bluetooth (or other short-range wireless technology) communication link with each other. *Id.* at 4:36–44, Fig. 3 (elements 305, 310). The stationary terminal transmits an invitation message to the proximate mobile device. *Id.* at 4:47–51, Fig. 3 (element 320). This message includes information necessary for the remote device to establish a connection with the stationary terminal (such as an IP address and TCP port information) and the remote device’s cellular telephone number. *Id.* at 4:47–51. The proximate mobile device transmits an SMS message to the remote

device, using the provided cellular telephone number and including the provided connection information, and the remote device extracts and utilizes the included information to establish a connection to the stationary terminal. *Id.* at 4:51–67, Fig. 3 (elements 330, 340, 345, 350, 355, 360).

*D. Illustrative Claim*

Claim 1 of the '632 patent is illustrative and is reproduced below.

1. A method for establishing a data communications session between a stationary terminal and a remote device, the method comprising:

establishing a communication link through a short-range wireless technology between the stationary terminal and a proximate mobile device wherein the proximate mobile device operates within a cellular wireless network system;

transmitting, by the stationary terminal, an invitation message comprising a network address relating to the stationary terminal and a remote device identifier to the proximate mobile device through the established communication link, whereupon the proximate mobile device establishes communication with the remote device using the remote device identifier and provides the network address of the stationary terminal to the remote device; and

establishing a connection between the stationary terminal and the remote device for data communications based upon an initial communication by the remote device through use of the network address of the stationary terminal provided to the remote device by the proximate mobile device.

Ex. 1001, 6:26–48.

The remaining two challenged claims refer explicitly to the steps of claim 1. Claim 8 recites “[a] non-transitory computer-readable medium including instructions that, when executed by a processor of a stationary terminal, causes the processor to establish a data communications session between the stationary terminal and a remote mobile device, by performing all the steps of claim 1,” and claim 15 recites “[a] computer system configured to initiate a data communications session with a remote device, the computer system comprising a processor configured to perform all the steps of claim 1.” *Id.* at 6:63–67, 8:1–4.

*E. Evidence Relied Upon*

| Reference                                                                                                           |                    | Date          | Exhibit |
|---------------------------------------------------------------------------------------------------------------------|--------------------|---------------|---------|
| Conley et al.<br>(“Conley”)                                                                                         | US 2004/0215974 A1 | Oct. 28, 2004 | 1002    |
| J. Rosenberg et al., SIP: SESSION INITIATION PROTOCOL, NETWORK WORKING GROUP REQUEST FOR COMMENTS 3261 (“RFC 3261”) |                    | 2002          | 1003    |

Petitioner also relies upon the Declaration of Brian Von Herzen, Ph.D. (Ex. 1012). Patent Owner does not rely on expert testimony.

*F. The Instituted Grounds of Unpatentability*

| Claim(s) Challenged | 35 U.S.C. § | Reference(s)/Basis |
|---------------------|-------------|--------------------|
| 1, 8, 15            | 103         | Conley             |
| 1, 8, 15            | 103         | Conley, RFC 3261   |

II. ANALYSIS

*A. Claim Construction*

We apply the same claim construction standard that is applied in civil actions under 35 U.S.C. § 282(b), which is articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). *See* 37 C.F.R § 42.100(b) (2019). Under *Phillips*, claim terms are afforded “their ordinary and

customary meaning.” *Phillips*, 415 F.3d at 1312 (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)). “[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention . . . .” *Id.* at 1313. Only claim terms that are in controversy need to be construed and only to the extent necessary to resolve the controversy. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017).

In our Decision on Institution, we found that, while a claim construction order was issued in the related district court action construing certain terms in the challenged claims, with the exception of the term “short-range wireless technology,” no term required construction to resolve the controversy. Inst. Dec. 19–20. With respect to the term “short-range wireless technology,” we determined that the correct construction of the term encompasses Bluetooth technology, and that no further construction was necessary. *Id.* at 20.

Patent Owner argues that the term “short-range wireless technology” should not be interpreted as not encompassing “Wi-Fi technology” or as directed exclusively to such technology. PO Resp. 10–13. Patent Owner argues that a claim construction would allow us to evaluate an alternative argument made in the Petition. *Id.* at 13 (citing Pet. 22). Patent Owner agrees that the Specification discloses Bluetooth as an exemplary short-range wireless technology. *Id.* at 12 (citing Ex. 1001, 3:25–26, 4:42, 6:49–50); *see* Reply 18. Patent Owner argues, however, that claim construction is appropriate because, if we did adopt a construction that exclusively requires Wi-Fi, Petitioner’s “alternative obviousness theory” would need to be considered. PO Resp. 28 (citing Pet. 22). However, this theory relies again

on the prior art disclosure of Bluetooth, which the parties each agree is properly included in “short-range wireless technology” according to the language of the claims. *Id.* at 11–12; Reply 18.

No specific construction for “short-range wireless technology” is argued by either party, and none is necessary to resolve the controversy before us. We agree with the parties that the ’632 patent describes Bluetooth as one possible short-range wireless technology, and that the correct construction of “short-range wireless technology” encompasses Bluetooth technology. *See* Pet. 11; Reply 12; Ex. 1001, 2:61–62 (“Mobile device 110 also supports a short-range wireless technology such as Bluetooth.”), 2:1–6, 3:20–28, 4:36–44, 5:1–3, 6:6–9, claim 2. We do not find it necessary to provide express claim constructions for any other terms. *See Nidec*, 868 F.3d at 1017.

### *B. Legal Standards*

It is a petitioner’s burden to demonstrate unpatentability. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)).

A claim is unpatentable under 35 U.S.C. § 103 if the differences between the claimed subject matter and the prior art are “such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.” We resolve the question of obviousness on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and

(4) objective evidence of nonobviousness, i.e., secondary considerations.<sup>1</sup>  
*See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

*C. Level of Ordinary Skill in the Art*

Petitioner, relying on the testimony of Dr. Von Herzen, identifies a person of ordinary skill in the art as someone who “would have held at least a bachelor’s degree in electrical engineering, computer science, or an equivalent field, and approximately two years of industrial or academic experiences working in the fields of mobile and/or computer networking.” Pet. 7; Ex. 1012 ¶ 28. Patent Owner does not offer an opinion on Petitioner’s definition, either agreeing or disagreeing, and does not offer a counter definition of a person of ordinary skill in the art. PO Resp. 6.

We find Petitioner’s definition to be consistent with the problems and solutions disclosed in the patent and prior art of record, and adopt it as our own. *See, e.g., In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995).

*D. Obviousness of Claims 1, 8, and 15 over Conley*

Petitioner argues that claims 1, 8, and 15 are unpatentable as obvious over Conley. *See* Pet. 18–36. Patent Owner raises several specific substantive arguments regarding the step of “transmitting, by the stationary terminal, an invitation message . . .” as discussed in detail below. PO Resp. 14–26. For the reasons given below, Petitioner has shown obviousness by a preponderance of the evidence for the challenged claims.

*1. Overview of Conley*

Conley discloses a method for establishing a secondary communication channel between at least two computing devices through use

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<sup>1</sup> The record does not include allegations or evidence of objective indicia of nonobviousness.

of a primary channel. Ex. 1002 ¶ 10. Figure 1 of Conley, reproduced below, “illustrates one exemplary situation” in which this may occur. *Id.* ¶¶ 14, 21.

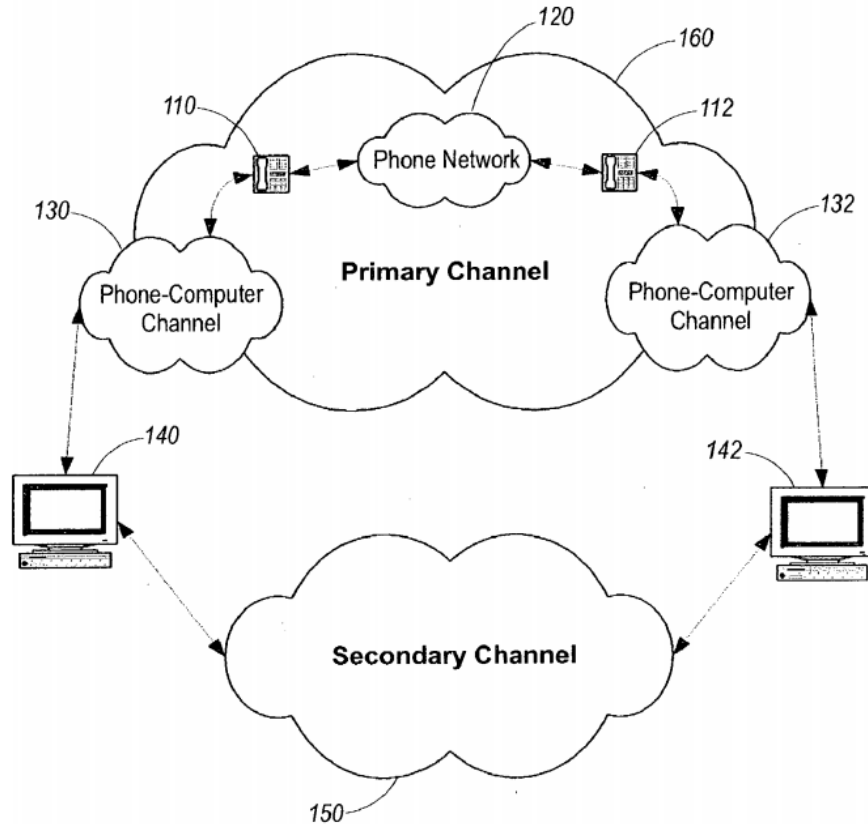


**FIG. 1**

Figure 1 depicts two telephones, 110 and 112, each connected to the other via telephone network 120. *Id.* ¶ 21. Telephone network 120 provides communication channel 160 between the telephones, which could be an audio channel or, alternatively, a data channel such as Short Messaging Service (SMS), among other data channel possibilities. *Id.* ¶¶ 21, 22. Telephone 110 is connected to device 140 via secure link 130 (labelled “Phone-Computer Channel”), and similarly telephone 112 is connected to device 142 via secure link 132 (labelled “Phone-Computer Channel”). *Id.*

Conley describes that the secure link may be a Bluetooth link, or that, alternatively, a telephone and a device could be “a single, integrated unit” where “the secure link may be accomplished by a direct connection.” *Id.* ¶¶ 21, 24, 26, 27. If the secure link between a device and a telephone is a Bluetooth link, Conley discloses that “the device could use the Bluetooth Serial Port Profile to send an SMS message containing the data [to be transmitted to another telephone].” *Id.* ¶ 26.

Figure 4 of Conley is reproduced below:

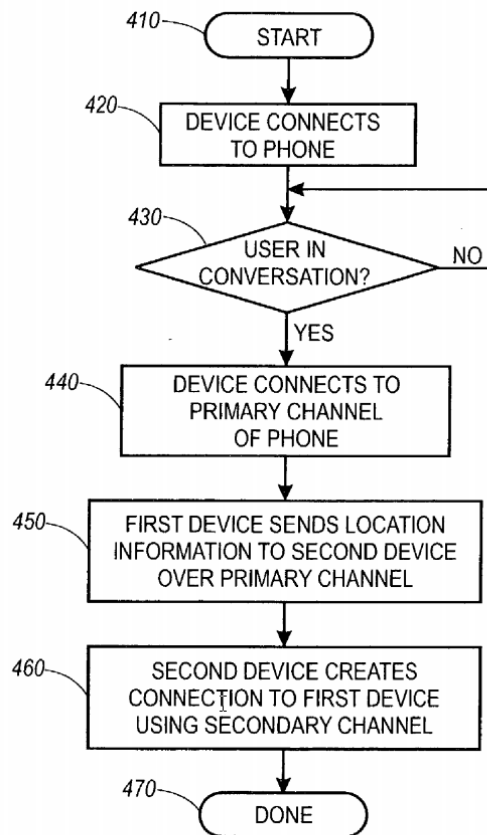


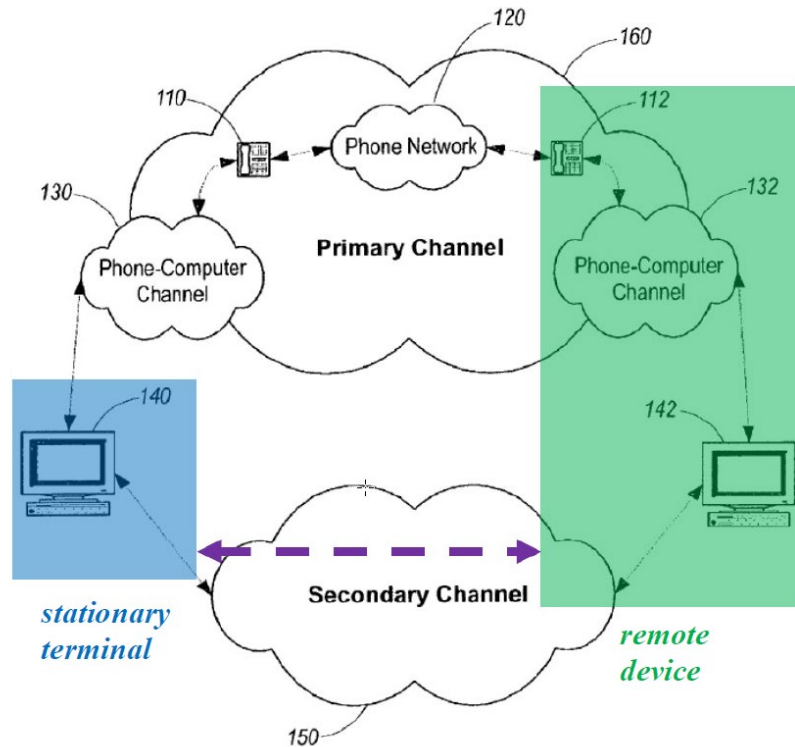
**FIG. 4**

Figure 4 is a flow chart depicting a method for establishing a secondary channel through use of a primary channel. *Id.* ¶¶ 17, 29.

The method depicted in Figure 4 begins with step 410, in which “a network link, for example via the Internet, is initiated . . . by a [first] device.” *Id.* ¶ 29. Next, in step 420, the first device connects to a telephonic unit. *Id.* Then, “[i]f the users of at least two telephonic units desire to transmit data or files between their devices, for example their computers,” they establish communication over a telephone network. *Id.* The first device determines whether this communication has been established in decision diamond 430, and if it has not, waits for such communication to be in process. *Id.* Next, in steps 440 and 450, the first device connects to the telephonic unit and sends a small amount of information, such as the location information of the first device, to the second device via the telephone network. *Id.* ¶¶ 23, 30. Upon receipt, the second device uses the information to establish a second channel connection with the first device, step 460, and when the process is finished, “both primary and secondary channels are operable simultaneously.” *Id.*

## *2. Claim 1 – Obviousness over Conley*

Petitioner argues that Conley’s telephonic device 112 and second device 142 together teach the claimed remote device, and that Conley’s device 140 teaches the claimed stationary terminal. Petitioner’s expert Dr. Von Herzen annotated Conley’s Figure 1, as reproduced below, to illustrate this argument.



Pet. 19; Ex. 1012 ¶ 47. In this annotated version of Conley’s Figure 1, a portion including Conley’s telephonic device 112 and second device 142 is shaded green to indicate Petitioner’s contention that together they teach the claimed remote device, as Conley teaches that a telephone and a device may be “a single, integrated unit.” *Id.* at 15, 18–21 (citing Ex. 1002 ¶¶ 21, 26, 27; Ex. 1012 ¶ 47). Petitioner argues that Conley describes that device 140 (shaded in blue) may be a laptop computer or table-top computer, and thus Conley teaches or suggests a device that is a “laptop, desktop, [or] workstation” and therefore a stationary terminal. *Id.* at 20 (quoting Ex. 1001, 1:28–29; citing Ex. 1002 ¶ 24; Ex. 1012 ¶ 49).

*a) Preamble and first limitation (“establishing a communication link . . .”)*

Petitioner argues that Conley teaches the preamble: “[a] method for establishing a data communications session between a stationary terminal and a remote device.” Ex. 1001, 6:26–27. As described above, Petitioner

argues that Conley teaches the stationary terminal and the proximate mobile device. Petitioner additionally argues that first device 140 establishes a secondary communications channel, as seen on the annotated version of Figure 1 above in purple. Pet. 14, 18–20 (citing Ex. 1002, code (57), ¶¶ 21, 24, 26, 27; Ex. 1012 ¶¶ 47–49).

The first limitation of the method of claim 1 is “establishing a communication link through a short-range wireless technology between the stationary terminal and a proximate mobile device wherein the proximate mobile device operates within a cellular wireless network system.” Ex. 1001, 6:29–33. Petitioner argues that the proximate mobile device is taught by Conley’s telephonic device 110, operating within a cellular network, and connected via a Bluetooth communication link to first device 140. Pet. 21–23 (citing Ex. 1002 ¶¶ 21, 22, 26, 27, 30; Ex. 1012 ¶¶ 51–53). As discussed above, Section II.A, we construe “short-range wireless technology” to encompass Bluetooth technology.

Patent Owner argues that “the Petitioner fails to explain why a person of ordinary skill would implement the system of Conley in a fashion where the first device is not an integrated unit while the second device is, except by using the ’632 patent as a roadmap.” Sur-reply 6 n.1.

We credit Dr. Von Herzen’s uncontroverted testimony that Conley discloses telephonic device 112 and that second device 142 “can be implemented as multiple devices or as a single device.” Ex. 1012 ¶ 47 (citing Ex. 1002 ¶¶ 21, 26, 27). The language of Conley describes that devices 140 and 142 are securely linked to respective telephones 110 and 112. Ex. 1002 ¶ 21. It describes that these secure links may be accomplished by one of five different exemplary means. *Id.* It then additionally discloses that, “[a]lternately, if the telephone and device are a

single, integrated unit . . . the secure link may be accomplished by a direct connection.” *Id.* Conley does not describe or imply that only one of these possibilities must apply to all telephone/device pairs.

Petitioner is not required to show that one of ordinary skill would have been motivated to select a configuration having different connections between each telephonic device and computing device pair over one having identical connections for each pair. *See Novartis Pharm. Corp. v. West-Ward Pharm. Int’l Ltd.*, 923 F.3d 1051, 1059 (Fed. Cir. 2019) (“Our case law does not require that a particular combination must be the preferred, or the most desirable, combination described in the prior art in order to provide motivation for the current invention.”) (quoting *In re Fulton*, 391 F.3d 1195, 1200 (Fed. Cir. 2004); *Infineum USA L.P. v. Chevron Oronite Co. LLC*, 844 Fed. Appx. 297, 305 (Fed. Circ. 2021) (unpublished)). Petitioner has shown that the configuration it relies on is encompassed in Conley’s disclosure and supported this showing with citations to Conley and expert testimony, and, thus, we do not agree that this showing is deficient.

Beyond this argument, Patent Owner does not dispute Petitioner’s arguments with respect to the preamble or the first limitation. *See* PO Resp. 14–26. Petitioner directs us to sufficient evidence to support the balance of its contentions. Therefore, we find Petitioner has met its burden of proof on this limitation.

- b) Second limitation (“transmitting . . . an invitation message comprising a network address . . . and a remote device identifier to the proximate mobile device through the established communication link, whereupon the proximate mobile device establishes communication with the remote device using the remote device identifier and provides the network address of the stationary terminal to the remote device”)*

The method of claim 1 further includes the step of “transmitting, by the stationary terminal, an invitation message comprising a network address relating to the stationary terminal and a remote device identifier to the proximate mobile device through the established communication link, whereupon the proximate mobile device establishes communication with the remote device using the remote device identifier and provides the network address of the stationary terminal to the remote device.” Ex. 1001, 6:34–42.

Petitioner argues that the transmission of an invitation message as in this limitation is taught in Conley, where a “small amount of information” is transmitted by first device 140 to the second device, via the Bluetooth connection to telephonic device 110 and then via primary channel 160. Pet. 23–26 (citing Ex. 1002 ¶¶ 21–23, 26, 30, 34, 36, 40; Ex. 1012 ¶¶ 54–55). Petitioner argues that inclusion of “a network address relating to the stationary terminal” in the invitation message sent to the proximate mobile device and then the provision of that network address to the remote device is taught by the inclusion of the IP address of the sender (the first device) in the “small amount of information” sent by first device 140 through primary channel 160 to the second device, as described in Conley. Pet. 26, 28–29 (citing Ex. 1002 ¶¶ 22, 23, 30, 36; Ex. 1012 ¶¶ 56, 58).

Petitioner additionally contends that Conley teaches or suggests the inclusion of a remote identifier in the invitation message transmitted by

Conley's first device 140 to the proximate mobile device (telephonic device 110), because Conley describes that primary channel 160 might be a data channel (e.g. SMS), and one of ordinary skill in the art would have understood that in order to send an SMS message, the address of the recipient must be included, and this would teach or suggest the "remote device identifier" of claim 1. Pet. 26–27, 29 (citing Ex. 1002 ¶¶ 21, 22, 23, 30, 34; Ex. 1012 ¶¶ 57, 58). Petitioner argues that one of ordinary skill "would have understood that when a computer sends an SMS message via a connected telephone, the computer provides the telephone with the SMS\_Submit Transfer Protocol Data Unit along with a command to send the message." *Id.* at 27, 29 (citing Ex. 1012 ¶ 57; Ex. 1019<sup>2</sup> at 21–23, 25–29). Petitioner additionally argues that the provision of the network address of the terminal to the remote device is also taught by the inclusion in the SMS message in Conley, which is transmitted to telephonic device 112, of the IP address of the first device 140. *Id.* at 28–29 (citing Ex. 1002 ¶¶ 23, 30, 36; Ex. 1012 ¶¶ 58, 59).

Patent Owner contends that Conley does not disclose this claim limitation because Conley does not disclose the inclusion of a remote device identifier for Conley's second device 142. Patent Owner argues that "the Petition and the Reply both point to **Conley's second device 142** as being the required 'remote device.'" Sur-reply 4, 5 ("As seen in Conley's Figure 1, Petitioner points to **Conley's second device 142** (desktop computer on the right-hand side) as being the required '**remote device**'."), 6 (arguing that the remote device identifier would be the identifier of Conley's second device

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<sup>2</sup> We refer for this exhibit to the internal page numbers rather than the page numbers added by Petitioner.

142); Reply 16, 21. Patent Owner argues that an SMS message would have had the address of telephone 112, and not second device 142. This argument rests in part on Patent Owner’s rejection of Petitioner’s mapping of the remote device as telephone 112 and device 142 as a single, integrated unit, which we have addressed above, Section I.D.2.a. With that mapping in mind (which we find supported in Conley’s teachings), we find persuasive Petitioner’s argument, backed with uncontroverted expert testimony and citations to supporting documentation, that the SMS messages sent over Conley’s primary channel 160 (if that channel was an SMS data channel (Ex. 1012 ¶¶ 21, 22)) would include the address of the recipient, that is, a single integrated unit incorporating telephone 112. Pet. 26–27 (citing Ex. 1002 ¶¶ 23, 30, 34; Ex. 1012 ¶ 57; Ex. 1019, 21–23, 25–29); Reply 2–4; Ex. 1012 ¶ 50.

Patent Owner additionally argues that “[n]othing in Conley discloses or even suggests that *any* communication of data over the *already established primary channel* would somehow require the inclusion of a ‘remote device identifier,’ much less that inclusion of a ‘remote device identifier’ *is somehow necessary to even allow* each and every communication of data over the established primary channel.” PO Resp. 18–19. Because the transmission to the remote device including the “small amount of information” in Conley occurs only after this channel is established, Patent Owner argues, there would be no need to use a remote device identifier:

Petitioner’s speculative and illogical rewrite of Conley is tantamount to arguing that once you and a friend have successfully started a telephone conversation over a traditional Public Switched Telephone Network or PSTN, every time you want to say something you have to hang up and redial, as

opposed to simply continue speaking and allowing *the established connection* to convey your voice.

*Id.* at 19. But we agree with Petitioner that Conley discloses the existing channel may be “a data channel such as Short Messaging Service (SMS).” Ex. 1002 ¶ 21; Pet. 23, 27, 29–30. It is uncontroverted that “an SMS message includes the address of the recipient, which in this case would be the remote device.” Pet. 27; Ex. 1012 ¶ 57. Thus, we determine that a person of ordinary skill in the art would have understood that even where prior SMS messages had been sent or a specific SMS channel established, the Conley invitation message, if sent via SMS, would have included a remote device identifier.

For these reasons, we determine that Petitioner has met its burden of proof on this limitation.

c) *Third limitation (“establishing a connection between the stationary terminal and the remote device . . . .”)*

The method of claim 1 further includes the limitation “establishing a connection between the stationary terminal and the remote device for data communications based upon an initial communication by the remote device through use of the network address of the stationary terminal provided to the remote device by the proximate mobile device.” Ex. 1001, 6:43–48.

Petitioner argues that, in Conley, the second device 142 uses the information received from telephone 110 to establish a secondary channel, and that one of ordinary skill would have understood this to teach or suggest the use of an initial communication by the remote device. Pet. 30–31 (citing Ex. 1002 ¶¶ 21, 23, 27, 30, Fig. 4; Ex. 1012 ¶¶ 60, 61). Petitioner contends that one of ordinary skill would have known how devices would connect to

each other over a secondary channel such as the Internet. *Id.* at 31–32 (citing Ex. 1012 ¶ 61; Ex. 1006, 524, 539–540).

Patent Owner does not dispute Petitioner’s arguments with respect to this third limitation. *See* PO Resp. 14–26. Petitioner directs us to sufficient evidence to support the balance of its contentions. Pet. 30–32. Therefore, we find Petitioner has met its burden of proof on this limitation.

*d) Conclusion*

In sum, on the complete record, we conclude that Petitioner has proved by a preponderance of the evidence that claim 1 would have been obvious over Conley.

*3. Analysis of Claims 8 and 15*

Petitioner argues that claim 8’s “non-transitory computer-readable medium including instructions that, when executed by a processor of a stationary terminal, causes the processor to establish a data communications session between the stationary terminal and a remote mobile device, by performing all the steps of claim 1,” is taught or suggested by the memory 220 of first device 140. Pet. 34–35 (citing Ex. 1002 ¶ 24, Fig. 2). Petitioner further argues that the processor of first device 140 teaches the “processor of [the] stationary terminal.” *Id.* (citing Ex. 1002 ¶ 24, Fig. 2). Petitioner additionally contends that the telephonic device 142 is a “remote mobile device” thus teaching “a remote mobile device” as in claim 8, as well as the “remote device” of claim 1. *Id.* at 34 (citing Ex. 1012 ¶ 64). We find that Petitioner has shown that Conley teaches these additional aspects of claim 8 based on those contentions.

Petitioner additionally argues that claim 15’s “computer system configured to initiate a data communications session with a remote device” and “comprising a processor configured to perform all the steps of claim 1”

are similarly taught by first device 140 and its processor. *Id.* at 36 (citing Ex. 1012 ¶ 67). We find that Petitioner has shown that Conley teaches these additional aspects of claim 15 based on those contentions.

Patent Owner does not present any arguments for claims 8 or 15 other than those presented for claim 1, addressed above.

For the reasons discussed above, we conclude that Petitioner has proved by a preponderance of the evidence that claims 8 and 15 would have been obvious over Conley.

#### *E. Remaining Grounds*

Having determined that Petitioner establishes by a preponderance of the evidence that the challenged claims would have been obvious over Conley, we do not address Petitioner's additional grounds challenging these claims. *See SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1359 (2018) (holding a petitioner “is entitled to a final written decision addressing all of the claims it has challenged”); *Boston Sci. Scimed, Inc. v. Cook Grp. Inc.*, 809 F. App’x 984, 990 (Fed. Cir. 2020) (nonprecedential) (“We agree that the Board need not address [alternative grounds] that are not necessary to the resolution of the proceeding.”).

### III. PATENT OWNER’S ARGUMENT UNDER *ARTHREX*

Patent Owner argues that the Federal Circuit determined in *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320 (Fed. Cir. 2019), that Administrative Patent Judges were appointed unconstitutionally, but that the Federal Circuit’s remedy was inappropriate and insufficient to cure the constitutional violation. PO Resp. 34–37.

We need not consider Patent Owner’s constitutional argument because the U.S. Supreme Court addressed this issue in *United States v. Arthrex, Inc.*, 141 S. Ct. 1970 (2021).

#### IV. CONCLUSION<sup>3</sup>

Petitioner has shown by a preponderance of the evidence that claims 1, 8, and 15 would have been obvious over Conley.

| <b>Claims</b>              | <b>35 U.S.C. §</b> | <b>Reference(s)/<br/>Basis</b>   | <b>Claims<br/>Shown<br/>Unpatentable</b> | <b>Claims<br/>Not shown<br/>Unpatentable</b> |
|----------------------------|--------------------|----------------------------------|------------------------------------------|----------------------------------------------|
| 1, 8, 15                   | 103                | Conley                           | 1, 8, 15                                 |                                              |
| 1, 8, 15                   | 103                | Conley, RFC<br>3261 <sup>4</sup> |                                          |                                              |
| <b>Overall<br/>Outcome</b> |                    |                                  | 1, 8, 15                                 |                                              |

#### V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED, based on a preponderance of the evidence, that claims 1, 8, and 15 are unpatentable; and

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

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<sup>3</sup> 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).

<sup>4</sup> As discussed above, Section II.E, having determined that the challenged claims would have been obvious over Conley, we do not address Petitioner's additional grounds challenging these claims.

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