

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PLATFORM SCIENCE, INC.,
Petitioner,

v.

OMNITRACS, LLC,
Patent Owner.

IPR2020-01613
Patent 6,925,308 B2

Before BART A. GERSTENBLITH, JAMES J. MAYBERRY, and
FREDERICK C. LANEY, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background

Platform Science, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting institution of *inter partes* review of claims 1–3 and 5–15 (“the Challenged Claims”) of U.S. Patent No. 6,925,308 B2 (Ex. 1001, “the ’308 patent”). Omnitrac, LLC (“Patent Owner”) filed a Preliminary Response (Paper 9, “Prelim. Resp.”). With authorization, Petitioner filed a Reply to Patent Owner’s Preliminary Response (Paper 11, “Prelim. Reply”), limited to the issue of discretionary denial pursuant to 35 U.S.C. § 325(d), and Patent Owner filed a Preliminary Sur-reply in response (Paper 12).

An *inter partes* review may be instituted only if “the information presented in the petition . . . and any [preliminary] response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (2018). For the reasons given below, Petitioner has not established a reasonable likelihood that it would prevail in showing the unpatentability of at least one of the challenged claims of the ’308 patent. Accordingly, we do not institute an *inter partes* review.

B. Related Proceedings

Petitioner and Patent Owner identify the following related matter: *Omnitrac, LLC and XRS Corp. v. Platform Science, Inc.*, 20-cv-0958 (S.D. Cal.). Pet. 81; Paper 5 (Patent Owner Omnitrac, LLC’s Mandatory Notices Pursuant to 37 C.F.R. § 42.8), 2. In addition, Petitioner challenges several claims of the ’308 patent in IPR2020-01612. Paper 5, 2.

C. Real Parties in Interest

Petitioner identifies Platform Science, Inc. as the real party in interest. Pet. 81. Patent Owner identifies Omnitrac, LLC and XRS Corporation as the real parties in interest. Paper 5, 2.

D. The Asserted Grounds of Unpatentability and Declaration Evidence

Petitioner challenges the patentability of claims 1–3 and 5–15 of the '308 patent on the following grounds:

Claim(s) Challenged	35 U.S.C. § ¹	Reference(s)/Basis
1–3, 5–15	102(b), 103(a)	Milewski ²
1–4, 7–9, 12	103(a)	Milewski, Heijden ³

Pet. 2. Petitioner supports its challenge with a Declaration by Scott Andrews (Ex. 1003, “the Andrews Declaration”).

E. The '308 Patent

The '308 patent is directed to “text-based communications” and more particularly to “providing a method and apparatus for automatically entering information into pre-formatted messages in a communication terminal.” Ex. 1001, 1:7–11. The '308 patent explains that traditional text-based communications between a dispatch station and a vehicle operator have several disadvantages, particularly when considering response messages

¹ The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. §§ 102 and 103 that became effective on March 16, 2013. Because the '308 patent has an effective filing date before March 16, 2013, we apply the pre-AIA versions of the statutory bases for unpatentability.

² U.S. Patent No. 5,930,471, issued July 27, 1999 (Ex. 1007, “Milewski”).

³ U.S. Patent No. 6,880,016 B1, issued April 12, 2005 (Ex. 1006, “Heijden”).

(i.e., messages sent by a vehicle operator in response to messages from a dispatch station). *Id.* at 2:21–29. In particular, the '308 patent indicates that manually entering information (a) may lead to errors in the entries and (b) is a slow process, which can delay the vehicle operator from transporting goods as quickly as possible. *Id.* The '308 patent states that “[w]hat is needed is a method and apparatus for allowing information to be entered quickly into such response messages to minimize the chances of error and to reduce the vehicle operator’s time spent sending response messages.” *Id.* at 30–33.

Figure 1 is reproduced below:

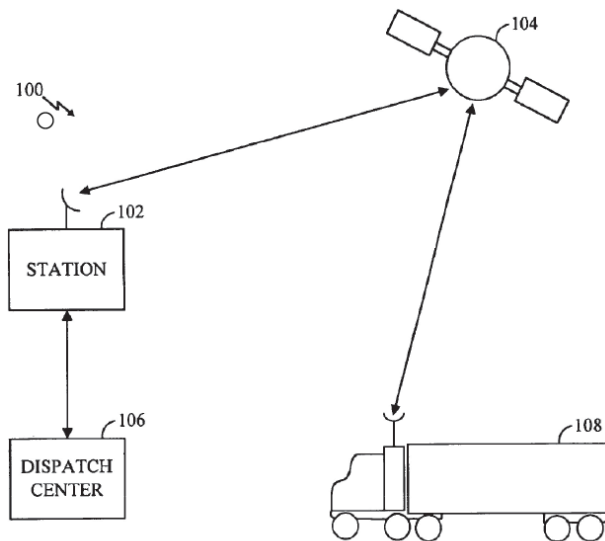


FIG. 1

Figure 1 of the '308 patent “illustrates a communication system 100 in which the method and apparatus for automatically entering information into formatted messages is used.” Ex. 1001, 3:36–38; *see id.* at 3:1–3. The '308 patent explains that “[d]ispatch center 106 and vehicle 108 are capable of communication with each other via central station 102 and satellite 104.” *Id.* at 3:38–40. “In one embodiment, vehicle 108 is a commercial trucking vehicle having a mobile communications terminal (MCT) mounted in a

tractor or cab of the vehicle, not shown [in Figure 1].” *Id.* at 3:50–52. The ’308 patent states, “[t]he MCT is capable of respectively transmitting and receiving communication signals to and from central station 102 via data satellite 104.” *Id.* at 3:52–55.

The ’308 patent explains the following regarding messages transmitted between the MCT and the central station:

Information transmitted between the MCT and central station 102 is accomplished using formatted messages, otherwise known as “macro” messages, or pre-formatted messages. Formatted messages are useful because they minimize the amount of information being transmitted, thus reducing communication costs. Cost savings are achieved by transmitted only pertinent data, without sending “overhead” information.

Ex. 1001, 3:59–66. Figure 2 is reproduced below:

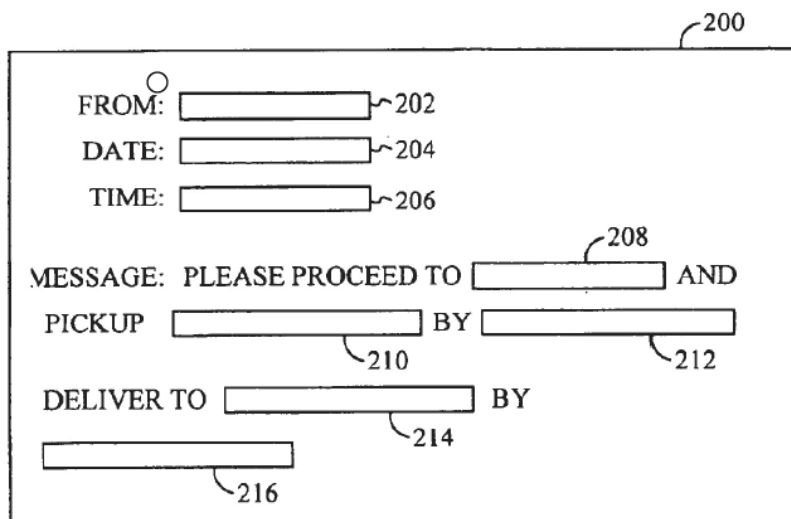


FIG. 2

Figure 2 of the ’308 patent “illustrates one embodiment of a formatted message 200 which instructs vehicle 108 to pick up goods at one location and deliver the goods to a second location within given time constraints.” *Id.* at 4:1–4; *see id.* at 3:4–6. The ’308 patent states that the type of message

shown in Figure 2 is “typically known in the transportation industry as a ‘load assignment’ message.” *Id.* at 4:4–5.

The ’308 patent describes the following regarding “formatted message 200”:

Formatted message 200 comprises information fields 202 through 216. When a formatted message is transmitted, only the information contained in the information fields, plus some overhead information, is transmitted. The other information in the formatted message 200 is not transmitted, for example, the words “From”, “Date:”, “Time:”, “Message: Please proceed to”, “and pick up”, “by”, . . . “Deliver to”, . . . [and] “by” When formatted message 200 is created at, for example, central station 102, an operator first chooses which formatted message to send to vehicle 108 from the total number of formatted messages which are already defined. In this example, the operator chooses to send a load assignment message, which has been predefined as having a message identification code of “1”. After choosing formatted message 200, the operator then enters information into the information fields 202 through 216.

Ex. 1001, 4:11–26. The ’308 patent explains that a variety of formatted messages can be defined that allow vehicle 108 to transmit status and operational information to central station 102, including “message acknowledgments, vehicle location, speed, and direction, engine characteristics, arrival and departure notifications, and so on.” *Id.* at 4:46–51. Each predefined, formatted message is assigned “a unique message identification code for identifying the type of formatted message. For example, formatted message 200 could be given a message identification code of ‘1’, while another formatted message instructing vehicle 108 to report its present location could be given a message identification code of ‘2’.” *Id.* at 4:53–60.

The '308 patent explains the following regarding the message identification code:

The message identification code is used by central station 102 and vehicle 108 to determine which type of formatted message is being received so that it can be “decoded” correctly. For example, when a formatted message having a message identification code of “1” is transmitted to vehicle 108, only the message identification code and the information fields are sent. This information is received by a processor onboard vehicle 108 that determines that it is a load assignment message based on the message identification code, and that the received information is in a format in accordance with a predefined “template” stored locally to vehicle 108 (or central station 102, as the case may be). The template comprises information relating to overhead information that is not transmitted, i.e., the words “Message: Please proceed to” and other non-fielded information which comprises a formatted message. The template also contains information relating to each information field. For example, a received message having a message identification code of “1” is defined as a message having 8 information fields 202 through 216, and in one embodiment, a definition of how much information is contained in each field, for example, the number of bits or characters which represent each information field. In another embodiment, the template does not define how much information is contained within each information field.

Using the template information, the received information can then be used to reconstruct the original formatted message and presented to a user at either vehicle 108 or at central station 102.

Ex. 1001, 4:61–5:22.

Figure 3 is reproduced below:

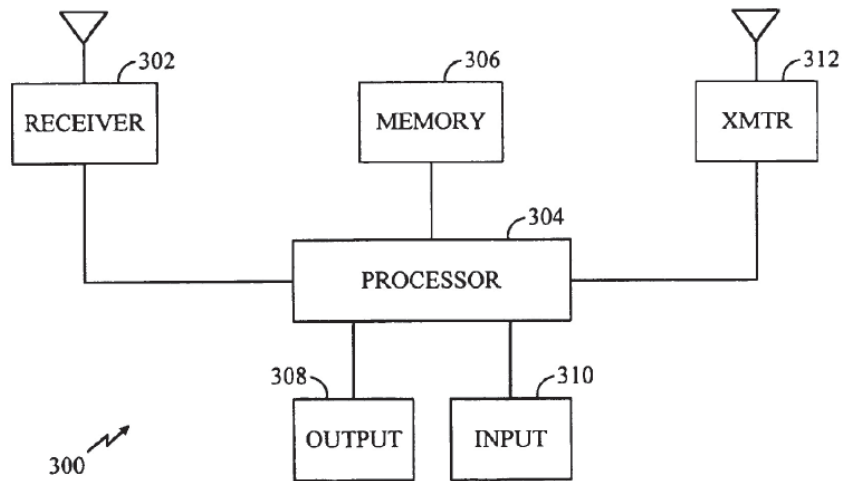


FIG. 3

Figure 3 of the '308 patent “illustrates a functional block diagram of communication terminal 300 used to transmit and receive information relating to formatted messages.” Ex. 1001, 5:23–25; *see id.* at 3:7–9. The functional blocks shown in Figure 3 can be used onboard vehicle 108 or at central station 102. *Id.* at 5:25–28.

The '308 patent explains that “[c]ommunication terminal 300 comprises receiver 302 for receiving information relating to formatted messages.” Ex. 1001, 5:32–33. “The received information, comprising a message identification code and one or more information fields, is provided to processor 304, where it is decoded for presentation to a user of communication terminal 300.” *Id.* at 5:45–48. According to the '308 patent, “[p]rocessor 304 determines the message identification code of the received information and uses a predefined template stored in memory 306 corresponding to the message identification code to reconstruct the formatted message, using information stored in memory 306 and the information fields of the received information.” *Id.* at 5:50–55. “The

reconstructed message may then be stored within memory 306 as a formatted message and/or presented to the user via output device 308.” *Id.* at 5:55–58. And, output device 308 may be a display device, such as a computer screen or monitor. *Id.* at 6:12–13.

Figure 5 is reproduced below:

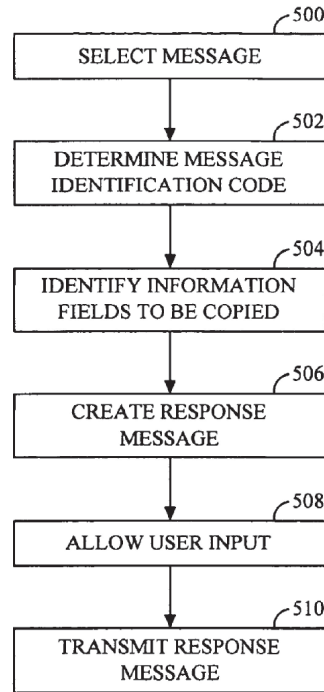


FIG. 5

Figure 5 of the '308 patent “illustrates a flow diagram of one embodiment of a method for automatically entering information into formatted messages in a communication terminal.” Ex. 1001, 7:48–50; *see id.* at 3:15–17. The '308 patent explains the following regarding Figure 5:

In step 500, a formatted message is selected to respond to. The formatted message comprises a message identification code and a number of information fields, the information fields filled in by a sender of the formatted message. The message may be chosen as a message which is currently-displayed by output device 308, or it may be selected from a number of messages stored within a memory of the communication terminal.

In any case, a request to respond to the selected message is entered using input device 310. Processor 304 receives the user's request to respond to the selected formatted message. The request indicates which formatted message the user wishes to respond, either explicitly with an indication of which formatted message to respond, or implicitly by processor 304 knowing which formatted message the user is viewing when the response request is entered.

Processor 304 then determines the message identification code of the formatted message to which a response is desired, as shown in step 502. The message identification code is either provided explicitly along with the request to respond, or it is determined by processor 304 identifying the selected formatted message and determining the message identification code by accessing memory 306. Memory 306 contains information linking each received formatted message with a corresponding message identification code. In step 504, processor 304 identifies information fields from the formatted message to be copied into the response message using field-mapping information stored in memory 306. The field-mapping information comprises a number of stored message identification codes and corresponding field identification information for each stored identification code. The field identification information identifies which information fields from each type of formatted message is copied into information fields of corresponding response messages. . . .

After processor 304 has identified the field-mapping information corresponding to the identified message identification code, a response message is created and provided to output device 308, shown as step 506. Processor 304 copies information fields from the message being responded to into the response message information fields as directed by the field-mapping information corresponding to the message identification code of the formatted message.

In step 508, the user enters information into any information fields that were not filled in automatically by processor 304. Some response messages may not need any user input, while other response messages may rely heavily on user

input. Generally, the user will be able to alter certain information fields, as allowed by the field-mapping information. . . .

After the user has entered information into the response message, the response message is provided to processor 304, where it is then transmitted to central station 102 in step 510. Of course, the entire response message is not transmitted. Processor 304 transmits a message identification code corresponding to the response message type, and each information field. Generally, some kind of formatting information is transmitted as well, such as an indication of stop/start bits between information fields, error correction coding, and so on.

Id. at 7:49–8:57.

F. Illustrative Claim

Claims 1, 7, and 12 are the independent claims challenged in this proceeding. Claim 1 is illustrative of the claimed subject matter and is reproduced below with Petitioner's bracketing added for reference:

1. [pre] A communication terminal, comprising:

[1a] a receiver for receiving a formatted message out of a number of pre-defined formatted messages, comprising a message identification code and a plurality of information fields;

[1b] an output device for presenting said formatted message to a user of said communication terminal;

[1c] an input device for responding to said formatted message;

[1d] a memory for storing said formatted message and for storing field-mapping information, said field-mapping information for indicating information to be copied from said formatted message to a response message based on which one of said pre-defined formatted messages was received;

[1e1] a processor for creating said response message in response to an indication from said input device of a request to

respond to said formatted message, [1e2] said response message comprising at least one response message information field, [1e3] wherein information from at least one of said plurality of information fields of said formatted message is copied into at least one of said response message information fields based on said field-mapping information; and

[1f] a transmitter for transmitting said information relating to said response message.

Ex. 1001, 9:2–24.

G. Level of Ordinary Skill in the Art

Petitioner, supported by Mr. Andrews’s testimony, proposes that a person of ordinary skill in the art at the time of the invention

would have had at least a Bachelor of Science degree (or equivalent) in electrical engineering, computer engineering, computer science, or a related technical field, and at least 2–3 years of experience in the fields of messaging systems, and wireless communication devices, or an equivalent advanced education in the field of messaging systems, including wireless communication devices.

Pet. 12 (citing Ex. 1003 ¶ 28).

Patent Owner “does not dispute Petitioner’s offered level of ordinary skill in the art” for purposes of this proceeding. Prelim. Resp. 8.

At this stage of the proceeding, we find Petitioner’s proposal consistent with the level of ordinary skill in the art reflected by the ’308 patent and the prior art of record, *see Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978), and, therefore, we adopt Petitioner’s unopposed position as to the level of ordinary skill in the art for purposes of this Decision.

II. CLAIM CONSTRUCTION

In this *inter partes* review, claims are construed using the same claim construction standard that would be used to construe the claims in a civil action under 35 U.S.C. § 282(b). *See* 37 C.F.R. § 42.100(b) (2019). The claim construction standard includes construing claims in accordance with the ordinary and customary meaning of such claims as understood by one of ordinary skill in the art at the time of the invention. *See id.*; *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–14 (Fed. Cir. 2005) (en banc). In construing claims in accordance with their ordinary and customary meaning, we take into account the specification and prosecution history. *Phillips*, 415 F.3d at 1315–17.

Additionally, only terms that are in controversy need to be construed, and these need be construed only to the extent necessary to resolve the controversy. *See Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (holding that “only those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy”); *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (citing *Vivid Techs.* in the context of an *inter partes* review).

The only dispute pertaining to claim construction at this stage of the proceeding is whether the phrase “a process for creating said response message,” recited in claim 1, is governed by 35 U.S.C. § 112 ¶ 6. Petitioner contends that the phrase should be interpreted as a means-plus-function limitation, whereas Patent Owner contends that it should not. *Compare* Pet. 3–7 (advocating for a means-plus-function construction), *with* Prelim. Resp. 9–11 (advocating for an ordinary and customary meaning). At this

stage of the proceeding, the dispute between the parties regarding the construction of this claim phrase does not impact our Decision. Accordingly, we need not construe expressly any claim terms for the purpose of this Decision.

III. ANALYSIS

A. *Legal Standards – Anticipation*

“[A] claim is anticipated ‘if each and every limitation is found expressly or inherently in a single prior art reference.’” *King Pharm., Inc. v. Eon Labs., Inc.*, 616 F.3d 1267, 1274 (Fed. Cir. 2010) (quoting *Celeritas Techs., Ltd. v. Rockwell Int’l Corp.*, 150 F.3d 1354, 1361 (Fed. Cir. 1998)). Anticipation is a question of fact, *In re Gleave*, 560 F.3d 1331, 1334–35 (Fed. Cir. 2009), assessed from the perspective of one of ordinary skill in the art, *see Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368 (Fed. Cir. 2003) (“the dispositive question regarding anticipation [i]s whether *one skilled in the art* would reasonably understand or infer from the [prior art reference’s] teaching that every claim element was disclosed in that single reference” (alteration in original) (quotation omitted)).

B. *Legal Standards – Obviousness*

The U.S. Supreme Court set forth the framework for applying the statutory language of 35 U.S.C. § 103(a) in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966):

Under § 103[(a)], the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc.,

might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

As explained by the Supreme Court in *KSR International Co. v. Teleflex Inc.*:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit.

550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”)).

“Whether an ordinarily skilled artisan would have been motivated to modify the teachings of a reference is a question of fact.” *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1327 (Fed. Cir. 2016) (citations omitted).

“[W]here a party argues a skilled artisan would have been motivated to combine references, it must show the artisan ‘would have had a reasonable expectation of success from doing so.’” *Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.*, 876 F.3d 1350, 1360–61 (Fed. Cir. 2017) (quoting *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litig.*, 676 F.3d 1063, 1068–69 (Fed. Cir. 2012)).

C. Anticipation by and/or Obviousness over Milewski

Petitioner contends that Milewski discloses each and every element of claims 1–3 and 5–15 and/or Milewski would have rendered the subject

matter of claims 1–3 and 5–15 obvious to one of ordinary skill in the art at the time of the invention. Pet. 27–72. We address Petitioner’s contentions as to anticipation together with Petitioner’s contentions as to obviousness with specific delineation of each.

1. Level of Ordinary Skill in the Art

As noted above, and for the reasons discussed therein, we adopt Petitioner’s proposed definition for the level of ordinary skill in the art. *See supra* § I.G.

2. Scope and Content of the Prior Art

a. Milewski

Milewski is directed to “computer software for a computer controlled electronic messaging system using structured response objects and virtual mailboxes.” Ex. 1007, 1:10–13. In explaining the purpose of the invention disclosed, Milewski provides the following regarding “structured response objects or action message[s] as replies in a transaction to increase efficiency”:

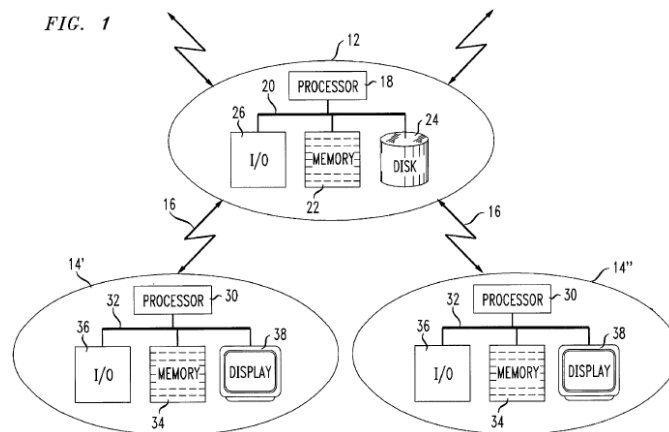
As part of increasing transaction efficiency, structured response objects are made available by a sender to a recipient to make [it] more simple and faster for a recipient to respond to a message as part of a transaction. Structured response objects are pre-delineated forms specified by a sender to lower the barrier to a response by the recipient to a message. No programming is required by the recipient to respond to the message, the recipient simply completes the form. In return, the sender can realize increased efficiency through automatic selection and analysis of the structured object responses. . . . For purposes of the present invention, structured response objects include buttons, menus, and formatted fields that a message sender can specify in a message to elicit predetermined responses from recipients, again without requiring any programming effort by the recipients. There are several

advantages to structured response objects. First, they reduce the amount of time and effort spent by the recipient in responding to a message. In many structured response object replies, the recipient can simply click the mouse and the message is responded to in a meaningful way. Second, because structured responding can enforce more consistency in the reply content, these objects can help the sender and the recipient to organize, filter and potentially perform processing automatically on the replies.

Summarizing, the efficiency of transactions in a communication system is improved using structured response objects as a basis for replying to events. Throughout the description, structured responses may also be classified as an “action message” as more descriptive of the reply sought by a sender.

Id. at 5:27–59.

Figure 1 is reproduced below:



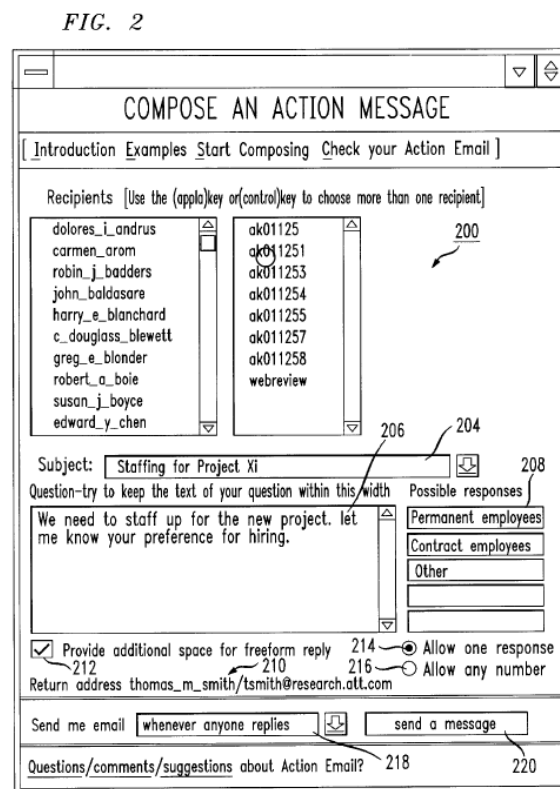
Milewski’s Figure 1 “is a representation of a communication system which facilitates transactions between a sender and at least one recipient.”

Ex. 1007, 4:35–38. Communication system 10 includes communications controller 12 coupled to a plurality of communications stations 14’ through 14ⁿ via conventional wired line or wireless links 16. *Id.* at 5:60–63.

Controller 12 includes processor 18 for management and controlling electronic messages among stations 14’ through 14ⁿ. *Id.* at 5:63–65.

Processor 18 is coupled through system bus 20 to conventional system memory 22, magnetic storage Direct Access Storage Device (DASD) 24, and interface 26. *Id.* at 6:2–7. Memory 22 and disk 26 “store electronic templates of structured object responses prepared by senders at the communications stations 14’ as part of a transaction with one or more recipients.” *Id.* at 6:16–19. Milewski explains that “[t]he templates . . . provide structure response objects to simplify the response by recipients of an electronic message as part of such a transaction.” *Id.* at 6:20–22. And, memory 22 provides the sender with “a virtual mailbox for the structured object responses sent as part of a transaction.” *Id.* at 6:23–25.

Figure 2 is reproduced below:



Milewski’s Figure 2 is “a representation of an electronic template for forming and sending a structured response object or action message to a recipient in the system of FIG. 1.” Ex. 1007, 4:39–41. Milewski explains

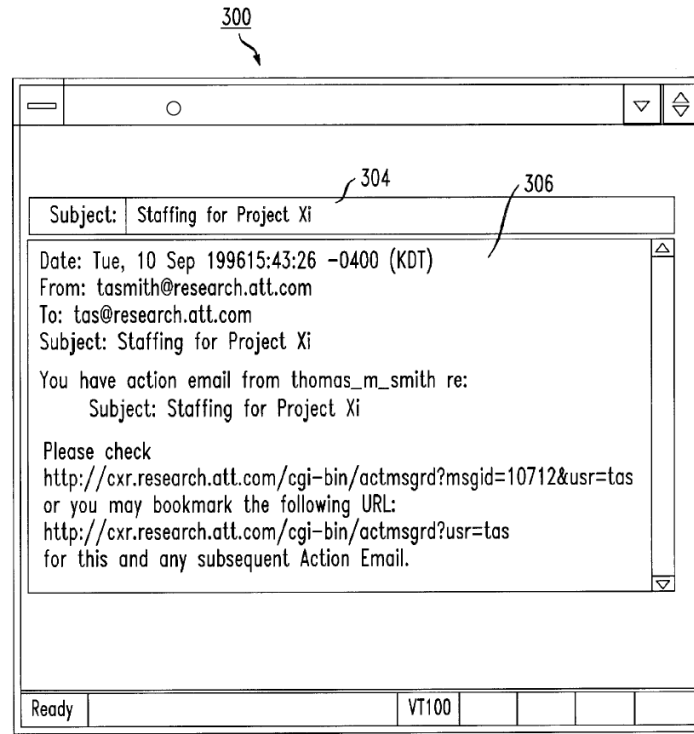
that electronic template 200, which can be formed and stored at station 14, “enables a sender to compose a structured response object or action message to a recipient at another communications station 14.” *Id.* at 6:52–56.

Electronic template 200 includes several fields for supplying information by either the sender or recipient, including field 208 “for the sender to specify a menu of responses available to the recipients” and field 210, which “provide[s] space for free-form reply by a recipient.” *Id.* at 6:56–67; *see also id.* at 7:1–10 (describing other fields of template 200). Once completed, template 200 is forwarded to communications controller 12 for handling. *Id.* at 7:11–13.

Milewski explains that “[t]he completed template containing an action message in the form of a structured object response as part of a transaction is stored in a virtual mailbox at an address located in memory 22 or the DASD device 24.” Ex. 1007, 7:14–17. Once the template is stored, “the controller initiates a ‘personalized pointer message’ to each recipient named in the action message in lieu of the message stored at the virtual mailbox address.” *Id.* at 7:17–21.

Figure 3 is reproduced below:

FIG. 3



Milewski's Figure 3 is "a representation of an electronic pointer message to a recipient referring the recipient back to a controller in the system of FIG. 1 which maintains the current state of the action message in FIG. 2."

Ex. 1007, 4:43–46. Milewski explains that the screen representation of pointer message 300 includes field 304 for entering the subject of the meeting and field 306, which is completed by the controller from data contained in screen 200. *Id.* at 7:22–27. "The controller provides a notice to the recipient of the message and instruction to respond to the message stored at the controller." *Id.* at 7:29–31. Milewski states that "[i]n responding to a reply pointer message, the controller transmits a portion of the original message contained in the template 200." *Id.* at 7:36–38.

Figure 4 is reproduced below:

FIG. 4

400

Message from thomas_m_smith

Subject: Staffing for Project Xi

Original mail

We need to staff up for the new project. Let me know your preference for hiring.

Additional comments ?

Your responses ?
Choose one response

☐ Permanent employees

☐ Contract employees

☒ Other

Transfer from project Wa

send

thomas_m_smith/tsmith@research.att.com

Questions/comments/suggestions about Action Email?

Milewski's Figure 4 is "a representation of a response provided by a recipient to the structured object response of FIG. 2." Ex. 1007, 4:47–48.

Milewski explains the following regarding Figure 4:

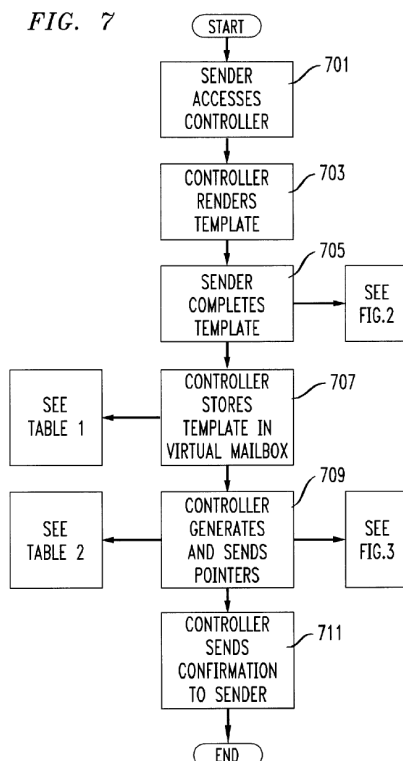
FIG. 4 is a screen of the action message 400 displayed by the controller at the recipient's station. The message 400 includes a field 402 which includes the text displayed in field 206. Field 404 is based upon the sender marking the bullet 214 in the template 200 (see FIG. 2). A field 406 corresponds to the menu of responses listed in field 208 of template 200. Upon marking the selected response, the recipient completes the response to the action message. In the present instance, the recipient has marked the "other" response and provides text in a field 408 as a response to the text in field 402. A field 410 is available for additional comments which the sender authorized to be entered by checking the field 212 in template 200. . . . The addressee of the response message is contained in a field 412 and a message is transmitted by the recipient actuating a send button 14

Id. at 7:38–58.

Milewski illustrates two additional screen images—(1) a status template 500 and (2) a transaction summary form 600. Ex. 1007, 7:59, 8:9.

Milewski explains that the controller provides status template 500 to the sender, which “indicat[es] the status of messages sent and received by the sender as contained in the virtual mailbox at the controller.” *Id.* at 7:59–62. Status template 500 includes several fields providing information, including which recipients have and have not answered the message. *Id.* at 7:62–8:2. The controller also prepares transaction summary form 600, which “indicat[es] the status of the message distributed to the recipients in template 200.” *Id.* at 8:9–11. Transaction summary form 600 includes several fields providing information, including a field for a “response count and type of response provided by the recipients of the message.” *Id.* at 8:15–17.

Figure 7 is reproduced below:

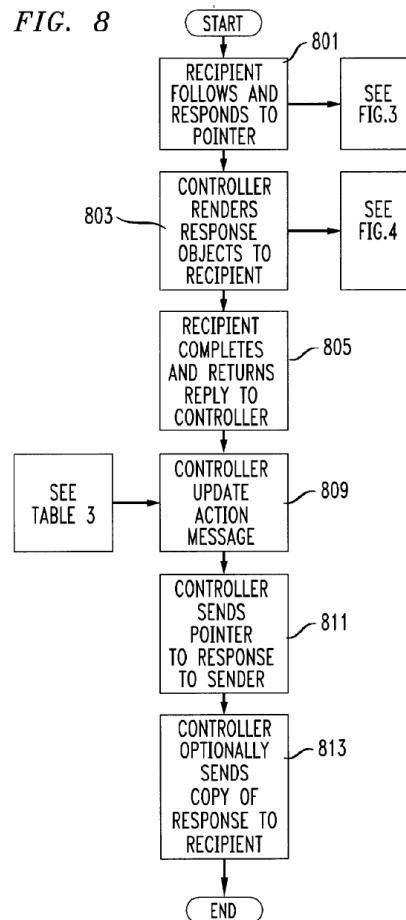


Milewski’s Figure 7 is “a flow diagram for message origination in a transaction between a sender and a controller in the system of FIG. 1.”

Ex. 1007, 4:55–57. Milewski explains that a message transaction is started in operation 701 where a sender uses processor 30 to access controller 12 and the sender identifies a structured object response template previously prepared by the sender and stored in the controller. *Id.* at 8:29–36.

Controller 12 obtains the selected structured response object from disk 26 and returns the template to the sender in operation 703. *Id.* at 8:37–39. In operation 705, the sender completes the template shown in Figure 2 and returns the completed template containing the structured object response to the controller for distribution to the addressee. *Id.* at 8:41–44. In operation 707, controller 12 stores the template at an address in memory 22 assigned to the sender as a virtual mailbox. *Id.* at 8:45–48. In operation 709, controller 12 sends notification to recipients of the action message in “a personalized pointer message to each recipient” as shown in Figure 3. *Id.* at 8:53–55. The pointer message directs the recipient to a reply form, which was previously prepared by the sender and stored in disk 26. *Id.* at 8:55–58. In operation 711, controller 12 confirms the dispatch of the pointer message to the recipients and provides the sender with a pointer to status information regarding the content of the virtual mailbox. *Id.* at 8:61–64.

Figure 8 is reproduced below:



Milewski's Figure 8 is "a flow diagram of message processing between a sender and a recipient(s) by a controller in the system of FIG. 1." Ex. 1007, 4:58–60. In operation 801, the recipient accesses controller 12 to obtain a list of messages sent to the recipient. *Id.* at 9:1–3. If the recipient chooses to reply to the action message, the recipient follows the instruction contained in the pointer message "to obtain the action message in structured response object form for completion." *Id.* at 9:6–10. In operation 803, controller 12 sends the action message body in a reply form shown in Figure 4 to the recipient, and the recipient completes and returns the reply form to the controller in operation 805. *Id.* at 9:11–17. Controller 12 updates the action message according to the responses or lack of responses received from the

recipients in operation 809. *Id.* at 9:17–19. In operation 811, controller 12 optionally sends notification of responses to the sender and in operation 813, the controller optionally sends recipients a copy of their responses to the action message. *Id.* at 9:26–27, 9:30–31.

3. *Differences Between the Prior Art and the Claims;
Motivation to Modify*

a. *Independent Claim 1 – Limitation 1d*

Our discussion herein focuses on limitation 1d because we find it dispositive.

Limitation 1d recites “a memory for storing said formatted message and for storing field-mapping information, said field-mapping information for indicating information to be copied from said formatted message to a response message based on which one of said pre-defined formatted messages was received.” Ex. 1001, 9:9–14. Petitioner asserts that Milewski “discloses and/or renders obvious” this limitation. Pet. 35 (citing Ex. 1003 ¶ 109). Petitioner contends, “[t]he communication stations of Milewski’s communication system include memory (34) that stores program instructions for an operating system and application programs for creating and responding to electronic messages.” *Id.* (citing Ex. 1003 ¶ 109; Ex. 1007, 6:37–45). Petitioner asserts, “[t]he recipient of an action message can choose to respond to the presented action message upon marking a selected response presented in field 406” *Id.* at 36 (citing Ex. 1003 ¶ 111; Ex. 1007, 7:44–58).

Petitioner argues that “[u]pon marking the selected response, a response form is generated at the receiver communication station that can be completed by the recipient and then sent back to the controller.” Pet. 37

(citing Ex. 1003 ¶ 112; Ex. 1007, 7:44–52, 9:16–17). Petitioner points to the following statement in Milewski in support—“In an operation 805, the recipient completes and returns the reply form to the controller.” *Id.* (citing Ex. 1007, 9:16–17). Petitioner contends that “[t]he generated completed reply form (response message) includes information that is copied from the action message, such as the subject of the message and fields 402, 404, 406, 408, 410, 414, and 418, including the titles thereof” *Id.* (citing Ex. 1003 ¶ 113; Ex. 1007, 7:44–52). Petitioner asserts that “[o]nce the response form is complete, the recipient can transmit the response form by actuating the send button (414)” and “[t]he completed response form, *i.e.*, the response message, is returned to the controller, which then updates the action message stored on the controller to reflect the recipient’s responses.” *Id.* at 38 (citing Ex. 1003 ¶ 114; Ex. 1007, 9:16–19).

Petitioner contends the communication stations include a memory for storing program instructions and application programs to create messages. Pet. 38 (citing Ex. 1003 ¶ 115; Ex. 1007, 6:37–45). Petitioner raises three alternative arguments regarding limitation 1d’s recitation of field-mapping information.

First, Petitioner contends one of ordinary skill in the art “would have understood that the incoming action message, including its information fields and field-mapping information would be required to be stored at least temporarily at the communication station.” Pet. 38 (citing Ex. 1003 ¶ 116). Petitioner asserts:

[S]ince at least a portion of this information is required to generate the response message, such as the message ID it responds to and information necessary to populate the response form (*i.e.*, field-mapping information) using information from

the received action message (*i.e.*, the formatted message), the communications station would use this memory for storing the field mapping information used to determine which fields in the action message are copied over to the corresponding fields in the response message.

Id. (citing Ex. 1007, 7:36–38). Petitioner states that “[b]ecause Milewski describes that at least some of the information from the action message (formatted message) is copied to the completed reply form (response message)” and “the communication station uses ‘program instructions’ and ‘application programs’ for creating electronic messages,” one of ordinary skill in the art would have understood “that the field mapping information used to copy these fields would be stored by the program instructions, at least while the completed reply form (response message) is being created.” *Id.* at 38–39 (citing Ex. 1003 ¶ 117).

Second, Petitioner asserts that, “[t]o the extent that Milewski does not explicitly discuss ‘field-mapping information,’ the described system must inherently use ‘field-mapping information’ to know which field from the action message is to be copied to which corresponding field in the response form.” Pet. 39 (citing Ex. 1003 ¶ 118). Petitioner explains that without such field-mapping information,

the system would not be able to copy over information from the action message into the correct fields of the response form to reconcile the questions to the answers, or for that matter would risk operator error in hunting down and correctly copying over the information fields so the information in the response form would be correctly matched with the information in the action message.

Id. (citing Ex. 1003 ¶ 118). Petitioner asserts that it is not practical to imagine that a person of ordinary skill in the art at the time of the invention “would have left such a tedious task, routinely performed on a computer, to

a human operator—it would defeat the whole purpose of Milewski, which was to aid in managing such structured, pre-formatted action messages and responses.” *Id.* (citing Ex. 1003 ¶ 118).

Third, Petitioner contends:

To the extent that Milewski is deemed not to expressly or inherently disclose that “field-mapping information” is stored on the communication station, it would have been obvious to a [person of ordinary skill in the art] to include “field-mapping information” with the action message and/or program instructions stored in the memory of the communication station for the operating system and application programs to create electronic messages and respond to electronic messages.

Pet. 40 (citing Ex. 1003 ¶ 119; Ex. 1007, 6:37–50). Additionally, Petitioner provides several reasons why one of ordinary skill in the art allegedly would have been motivated to modify Milewski as proposed. *Id.* (citing Ex. 1003 ¶ 120).

Patent Owner raises several arguments in response to Petitioner’s challenge based on Milewski, including that Petitioner fails to show Milewski “discloses or renders obvious ‘field-mapping information for indicating information to be copied from said formatted message to a response message based on which one of said pre-defined formatted messages was received’ and/or copying information from a formatted message into a response message ‘based on said field-mapping information.’” Prelim. Resp. 37 (citing Pet. 35–47, 68–70). In particular, Patent Owner asserts that “because Petitioner reads the claimed ‘formatted message’ and ‘response message’ on the same Figure 4 action message, there is no copying from one message into another and Milewski does not inherently disclose this element.” *Id.* at 37–38 (citing Ex. 1007, Fig. 4; Pet. 31–32). Additionally, Patent Owner contends it would not have been obvious to one

of ordinary skill in the art to modify Milewski as proposed by Petitioner because one “would have no need to include ‘*field-mapping information for indicating information to be copied*’ from said formatted message to a response message’ when no copying occurs.” *Id.* at 38 (citing Pet. 40).

Patent Owner’s argument identifies a deficiency in Petitioner’s analysis. Petitioner maps the action message shown in Milewski’s Figure 4 to the recited “formatted message” (*see, e.g.*, Pet. 32 (“Figure 4 shows an exemplary screen display of an action message (the ‘formatted message’) presented to the recipient at the receiver communication station.”)), while also mapping Figure 4 to the recited “response message” (*see, e.g., id.* at 37 (identifying Figure 4 as the “completed reply form (response message)”). Milewski describes Figure 4 as both the action message and reply form. *Compare* Ex. 1007, 7:38–39 (“*FIG. 4 is a screen of the action message 400 displayed by the controller at the recipient’s station.*” (emphasis added)), *with id.* at 9:11–15 (“In an operation 803, the controller renders the action message body in a *reply form shown in FIG. 4* to the recipient using standard World Wide Web protocols and processes (HyperText Transaction Protocols-HTTP; HyperText Mark Up Language-HTML).” (emphasis added)). Milewski appears to explain the basis for its terminology by stating that “[t]hroughout the description, structured responses may also be classified as an ‘action message’ as more descriptive of the reply sought by a sender.” *See id.* at 5:56–59.

The problem Patent Owner identifies with Petitioner’s analysis, however, is that Petitioner fails to explain where Milewski indicates copying information from the action message to the reply form when the action message and reply form appear to be the same. In support of its argument

regarding copying, Petitioner cites to column 7, lines 44 through 52, of Milewski. That section states the following:

Upon marking the selected response, the recipient completes the response to the action message. In the present instance, the recipient has marked the “other” response and provides text in a field 408 as a response to the text in field 402. A field 410 is available for additional comments which the sender authorized to be entered by checking the field 212 in template 200. In this case, the recipient has chosen not to provide any additional comments.

Ex. 1007, 7:44–52. We find that there is nothing in this section that expressly supports Petitioner’s contention that information is copied from the action message to the reply form, especially in light of Milewski’s indication that the action message is the reply form. Furthermore, Petitioner fails to explain sufficiently why a skilled artisan would view this passage as describing the alleged copying.

Although Petitioner cites, as support, paragraph 113 of the Andrews Declaration, the testimony therein does not provide any explanation as to where Milewski discloses copying. *See* Pet. 37 (citing Ex. 1003 ¶ 113). Instead, Mr. Andrews merely states that the completed reply form includes copied information without any reasoning to support that conclusion. Specifically, Mr. Andrews testifies:

113. The generated completed reply form (response message) includes information that is copied from the action message, such as the subject of the message (e.g., “Subject: Staffing for Project Xi”) and fields 402 (sender comments to recipient), 404 (one or more of the responses sought by the sender and selected by the recipient), 406 (response options for the recipient), 408 (free form response field), 410 (free form comment field), 414 (send button), and 418 (addressee of the

response message), including the titles thereof (highlighted brown in Figure 4 above.)

Ex. 1003 ¶ 113. Aside from identifying Figure 4, which Milewski describes as both the action message and the reply form, Mr. Andrews does not cite to any particular portion of Milewski in support of his opinion that the reply form is generated by copying information from the action message.

Petitioner's arguments based on inherency and obviousness are focused on whether Milewski discloses or renders obvious field-mapping information stored on Milewski's communication stations, not whether copying is inherent or would have been obvious. *See, e.g.*, Pet. 39 (discussing inherency and stating that "without such field-mapping information, the system would not be able to copy over information from the action message into the correct fields of the response form"), 40 (arguing it would have been obvious to store field-mapping information on Milewski's communication stations). Thus, Petitioner's alternative arguments regarding inherency and obviousness fail to fill the gap identified above in Milewski's explicit disclosure.

Accordingly, based on the record before us, Petitioner has not shown sufficiently that Milewski discloses and/or renders obvious limitation 1d.

b. Independent Claims 7 and 12

Independent claim 7 is directed to "[a] signal-bearing medium tangibly embodying a digital processing apparatus to perform operations for automatically entering information into formatted messages in a communication terminal, said operations comprising," *inter alia*, "identifying which information fields, from said plurality of information fields, to be copied into said response message, based on said message

identification code.” Ex. 1001, 9:53–57, 10:1–3 (emphasis added).⁴ Independent claim 12 is directed to “[a] method for automatically entering information into formatted messages in a communication terminal, comprising,” *inter alia*, “*identifying one or more information fields of said formatted message to be copied into a response message based on field-mapping information stored in a memory, said field-mapping information for indicating information to be copied from said formatted message to a response message based on which one of said pre-defined formatted messages was received.*” *Id.* at 10:33–35, 40–46 (emphasis added).⁵ Each of these limitations recites language that is similar to limitation 1d. Petitioner relies upon the same arguments and portion of Milewski in addressing the above limitations of claims 7 and 12. *See* Pet. 59 (discussing limitation 7e and relying upon Petitioner’s discussion of limitation 1d), 68 (discussing limitation 12c and relying upon Petitioner’s discussion of limitation 1d). Thus, Petitioner’s challenge of claims 7 and 12 suffers from the same deficiency identified with respect to claim 1.

Accordingly, based on the record before us, Petitioner has not shown sufficiently that Milewski discloses and/or renders obvious limitations 7e or 12c.

c. Dependent Claims 2, 3, 5, 6, 8–11, and 13–15

Claims 2, 3, 5, and 6 depend from claim 1, claims 8–11 depend from claim 7, and claims 13–15 depend from claim 12. Petitioner relies upon its discussion of the independent claims in its analysis of these dependent claims. *See, e.g.*, Pet. 48 (addressing dependent claim 2 and incorporating

⁴ Petitioner refers to this clause of claim 7 as “element 7[e].” Pet. 59.

⁵ Petitioner refers to this clause of claim 12 as “element 12[c].” Pet. 68.

arguments from Petition §§ VI.A.1.(e)–(h)). Accordingly, the deficiencies identified with respect to the independent claims also apply to the dependent claims.

4. *Objective Considerations of Nonobviousness*

Neither party presents evidence of objective considerations of nonobviousness at this stage of the proceeding.

5. *Conclusion as to Anticipation*

For the reasons discussed above and based on the present record, Petitioner has not established a reasonable likelihood that it would prevail in showing that Milewski discloses each and every element of claims 1–3, and 5–15.

6. *Weighing the Graham Factors – Conclusion as to Obviousness*

“Once all relevant facts are found, the ultimate legal determination [of obviousness] involves the weighing of the fact findings to conclude whether the claimed combination would have been obvious to an ordinary artisan.” *Arctic Cat*, 876 F.3d at 1361. On balance, considering the record presently before us, Petitioner has not established a reasonable likelihood that it would prevail in showing that Milewski would have rendered the subject matter of claims 1–3 and 5–15 obvious to one of ordinary skill in the art at the time of the invention.

D. *Obviousness over Milewski and Heijden*

Petitioner contends the combined teachings of Milewski and Heijden would have rendered the subject matter of claims 1–3, 7–9, and 12 obvious to one of ordinary skill in the art at the time of the invention. Pet. 72–80.

1. *Level of Ordinary Skill in the Art*

The level of ordinary skill in the art at the time of the invention is discussed above. *See supra* § I.G.

2. *Scope and Content of the Prior Art*

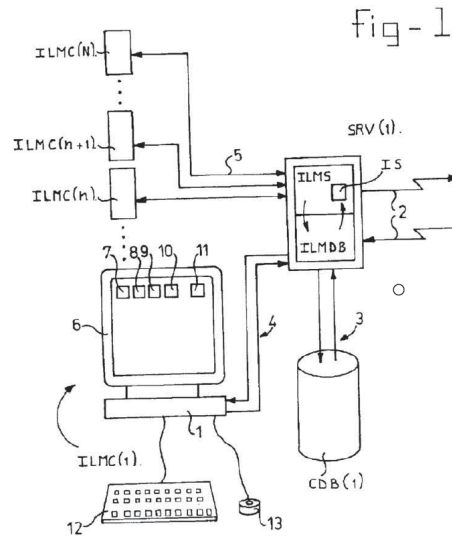
a. *Milewski*

The scope and content of Milewski is described above. *See supra* § III.C.2.a.

b. *Heijden*

Heijden is directed to a method and apparatus for point-to-point communication between a sender and a receiver by means of messages with flexible message formats. Ex. 1006, code (57). Heijden explains that “[t]he flexible message format contains information that allows a receiver to interpret, understand and display the contents of the message, even if it has previously never been received.” *Id.* at 9:66–10:2. Heijden states that a user can receive, view, and send messages on a terminal. *Id.* at 10:24–26. Heijden’s flexible message format consists of header information and a series of fields, objects, maps, and actions. *Id.* at Fig. 2a, 12:26–30, 12:45–13:14.

Figure 1 is reproduced below:



Heijden's Figure 1 shows a general overview in block diagram of the disclosed system. *Id.* at 11:15–16. In particular, Figure 1 shows a plurality of servers (SRV(m)) connected to a customer database (CDB(1)) and one or more terminals (e.g., ILMC(1)), which includes monitor screen 6, processing unit 1, keyboard 12, and mouse 13. *Id.* at 11:22–34.

Heijden explains that server SRV(1) “is provided with a processor called InterLingua™ message server ILMS for receiving, passing or sending messages.” Ex. 1006, 11:47–49. “Part of the ILMS processor is indicated with IS (=InterLingua™ Script).” *Id.* at 11:50–51. IS “is a small, but powerful set of calculation, execution and conditional logic statements that give application level functionality to a message,” including the ability to load and store mapped field data defined by a message. *Id.* at 17:34–38.

Server SRV(L) “also comprises a database ILMDB (=InterLingua™ Message Database) for storing several tables.” Ex. 1006, 11:53–55. Certain relational tables within the database ILMDB are “needed to define and control a message either received or to be sent.” *Id.* at 14:3–5. Heijden explains:

Preferably, the database of the communication apparatus is organized in several tables to which reference is made from the message definition table. Then, the predetermined message definition table comprises a message system identifier for use as a reference to further tables in the database.

One of such further tables may be a field definition table for holding primary definitions for any field of the messages.

Preferably, one of such further tables is a field mapping table comprising mapping information usable by predetermined fields, e.g. for mappings to hyper text markup language fields, database fields, flat file fields and other message fields, said database fields and flat file fields being stored in a customer database.

Id. at 8:36–48.

3. *Differences Between the Prior Art and the Claims;
Motivation to Modify*

With respect to claims 1, 7–9, and 12, Petitioner contends:

To the extent that Milewski does not explicitly disclose[] “field-mapping information” that is stored on the receiver communication station, it would have been obvious to a [person of ordinary skill in the art] to include “field-mapping information” with the action message and/or program instructions stored in the memory of the communication station for the operating system and application programs to create electronic messages and respond to electronic messages, as evidenced by Heijden.

Pet. 73 (citing Ex. 1003 ¶ 225). Patent Owner asserts that “Heijden does not disclose and Petitioner does not argue that Heijden discloses ‘field-mapping information for indicating information to be copied from said formatted message to a response message based on which one of said pre-defined formatted messages was received’” Prelim. Resp. 44.

Petitioner’s reliance upon Heijden does not cure the deficiencies noted above in our analysis of Petitioner’s first ground based on Milewski alone.

In particular, Petitioner does not rely upon Heijden as disclosing the limitations of claims 1, 7, and 12 that we found lacking in Petitioner's analysis based upon Milewski. *See, e.g.*, Pet. 72–80. Accordingly, based on the present record and for the same reasons discussed above in our analysis of Petitioner's first ground based on Milewski, Petitioner has not shown sufficiently that the combination of Milewski and Heijden teaches or suggests the subject matter of claims 1–3, 7–9, and 12.

4. *Objective Considerations of Nonobviousness*

As noted above, neither party presents evidence of objective considerations of nonobviousness at this stage of the proceeding.

5. *Weighing the Graham Factors*

“Once all relevant facts are found, the ultimate legal determination [of obviousness] involves the weighing of the fact findings to conclude whether the claimed combination would have been obvious to an ordinary artisan.” *Arctic Cat*, 876 F.3d at 1361. On balance, considering the record presently before us, Petitioner has not established a reasonable likelihood that it would prevail in showing that the combination of Milewski and Heijden would have rendered the subject matter of claims 1–3, 7–9, and 12 obvious to one of ordinary skill in the art at the time of the invention.

IV. CONCLUSION

For the foregoing reasons, Petitioner has not demonstrated a reasonable likelihood that it would prevail in showing that at least one claim of the '308 patent is unpatentable.

V. 35 U.S.C. §§ 314(a), 325(d)

Patent Owner contends that we should exercise our discretion to deny institution pursuant to 35 U.S.C. § 314(a) and 35 U.S.C. §325(d). Prelim. Resp. 11–25. Petitioner opposes Patent Owner's argument. *See generally* Paper 3 (Petitioner's Notice Ranking and Explaining Material Differences Between Petitions for *Inter Partes* Review of U.S. Patent 6,925,308); Prelim. Reply. Because we determine that Petitioner has not demonstrated a reasonable likelihood that it would prevail in showing that at least one claim of the '308 patent is unpatentable, we need not reach the issues of discretionary denial pursuant to §§ 314(a) or 325(d).

VI. ORDER

Accordingly, it is:

ORDERED that the Petition is *denied* as to the Challenged Claims of the '308 patent; and

FURTHER ORDERED that no *inter partes* review is instituted.

IPR2020-01613
Patent 6,925,308 B2

For PETITIONER:

John C. Phillips
Jason W. Wolff
Markus D. Weyde
John-Paul Fryckman
FISH & RICHARDSON P.C.
phillips@fr.com
wolff@fr.com
weyde@fr.com
fryckman@fr.com

For PATENT OWNER:

Gianni Cutri
Adam R. Alper
Michael W. De Vries
Akshay S. Deoras
KIRKLAND & ELLIS LLP
gianni.cutri@kirkland.com
adam.alper@kirkland.com
michael.devries@kirkland.com
akshay.deoras@kirkland.com