Trials@uspto.gov
571-272-7822

Paper 30
Date: December 20, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

ZIPIT WIRELESS, INC.,
Patent Owner.

IPR2021-01131
Patent 7,894,837 C1

Before TREVOR M. JEFFERSON, NEIL T. POWELL, and JOHN D. HAMANN, *Administrative Patent Judges.*

JEFFERSON, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
Denying Patent Owner's Motion to Exclude
35 U.S.C. § 318(a); 42 C.F.R. §§ 42.64, 42.71

Microsoft Corporation ("Microsoft") and Apple Inc. ("Apple") jointly filed a Petition ("Pet.," Paper 3) pursuant to 35 U.S.C. § 311 to institute an *inter partes* review of claims 13 and 17–19[1] of U.S. Patent No. 7,894,837 C1[2] ("the '837 patent," Ex. 1001) owned by Zipit Wireless, Inc. ("Patent Owner" or "Zipit"). The Petition is supported by the Declaration of Dr. Patrick Traynor (Ex. 1003, "Traynor Decl."), Dr. Gregory Abowd (Ex. 1050), and Duncan Hall (Ex. 1021). Zipit did not file a Preliminary Response.

We determined that the information presented in the Petition established that there was a reasonable likelihood that Apple and Microsoft would prevail with respect to its unpatentability challenges. Pursuant to 35 U.S.C. § 314, we instituted this proceeding on December 21, 2021, as to all challenged claims and all grounds of unpatentability. Paper 7 ("Dec. on Inst.").

During the course of trial, Patent Owner filed a Patent Owner Response (Paper 10, "PO Resp."), and Microsoft and Apple filed a Reply to the Patent Owner Response (Paper 13, "Reply"). Patent Owner also filed a

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[1] Claims 11 and 12 of the '837 patent were determined to be unpatentable in *Google LLC et al. v. Zipit Wireless, Inc.*, IPR2019-01568, Paper 39 at 49–51 (PTAB Mar. 9, 2021) (Final Written Decision) ("*Google '837 IPR*") (finding that claims 11, 12, 14–16, and 20 of the '837 patent were unpatentable). Because the challenged dependent claims 13 and 17–19 of the '837 patent depend from claims 11 and 12, Petitioner addresses claims 11 and 12 as a part of addressing the challenged claims.

[2] An *Ex Parte* Reexamination Certificate issued for the '837 patent on November 23, 2020 with amendments to independent claim 1 and newly added claims 21–50, each of which depend directly or indirectly from claim 1. *See* Ex. 1043, 151–152. The Reexamination did not amend the challenged claims (i.e., claims 13 and 17–19) in the present Petition. *Compare* Ex. 1001, claims 13, 17–19, *with* Ex. 1043, 151–152.

Corrected Sur-reply. Paper 21 ("Sur-reply"). The parties requested an oral hearing. Papers 16, 17.

Prior to the oral hearing, Microsoft and Zipit filed a Joint Motion to terminate the proceeding as to Microsoft (Paper 26), which we granted. Paper 28. Thus, the trial proceeded to an oral hearing with Apple as sole Petitioner. An oral hearing was held on September 21, 2022, and a transcript of the hearing is included in the record. Paper 29 ("Tr.").

Petitioner bears the burden of proving unpatentability of the challenged claims, and the burden of persuasion never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). To prevail, Petitioner must prove unpatentability by a preponderance of the evidence. *See* 35 U.S.C. § 316(e) (2018); 37 C.F.R. § 42.1(d) (2019).

We have jurisdiction under 35 U.S.C. § 6. This Decision is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of the claims on which we instituted trial. Based on the record before us, Petitioner has shown, by a preponderance of the evidence, that claims 13 and 17–19 are unpatentable.

I. BACKGROUND

A. Real Parties-in-Interest

The Petition asserts that Apple is the real party-in-interest. Pet. 82. Patent Owner asserts that Zipit is the real party-in-interest. Paper 6, 2.

B. Related Matters

Petitioner filed three concurrent Petitions for *inter partes* review of the '837 patent, the instant petition IPR2021-01131 (challenging claims 13 and 17–19); *Apple Inc. v. Zipit Wireless, Inc.*, IPR2021-01129 (challenging

claims 1, 3–7, 10, 11, 17, 21, 22, 28, 33–39, and 43–45); and *Apple Inc. v. Zipit Wireless, Inc.*, IPR2021-01130 (challenging claims 1, 2, 11–13, 19, 23, 24, 27, 29–31, 40–42, 46, and 48–50). Paper 2, 1–5; Paper 6, 2–3. Adverse judgment against Patent Owner was entered in IPR2021-01129. IPR2021-01129 Paper 30. In addition, Petitioner filed three concurrent Petitions for *inter partes* review of related U.S. Patent No. 7,292,870: *Apple Inc. v. Zipit Wireless, Inc.*, IPR2021-01124; *Apple Inc. v. Zipit Wireless, Inc.*, IPR2021-01125; and *Apple Inc. v. Zipit Wireless, Inc.*, IPR2021-01126. *Id*. Adverse judgment against Patent Owner was entered in each of these three cases. *See* IPR2021-01124 Paper 13; IPR2021-01125 Paper 14; IPR2021-01126 Paper 13.

The Petition provides that the '837 patent was the subject of Final Written Decisions in IPR2014-01506[3] and in *Google LLC et al. v. Zipit Wireless, Inc.*, IPR2019-01568, Paper 39 (PTAB Mar. 9, 2021) (Final Written Decision) (finding that claims 11, 12, 14–16, and 20 of the '837 patent were unpatentable). Pet. 98. In addition, related U.S. Patent No. 7,292,870 was the subject of *Google LLC et al. v. Zipit Wireless, Inc.*, IPR2019-01567, Paper 38 (PTAB Mar. 9, 2021) (Final Written Decision) (finding the challenged claims unpatentable). *Id*. Finally, Petitioner states that the '837 patent is involved in *Zipit Wireless, Inc. v. LG Electronics Inc.*, Case No. 6-18-cv-02016 (D.S.C.). Pet. 82–83.

Patent Owner indicates that the *inter partes* review of the '837 patent may also affect the following matters: *Ex Parte Zipit Wireless, Inc*., Reexamination No. 90/014,722; *Apple Inc. v. Zipit Wireless, Inc.*, Case

[3] *Blackberry Corp. v. Zipit Wireless, Inc.*, IPR2014-01506, Paper 50 (PTAB March 29, 2016) (Final Written Decision) ("*Blackberry IPR*") (finding that the challenged claims were not shown to be unpatentable).

No. 5:20-cv-04448-EJD (N.D. Cal.); *Apple Inc. v. Zipit Wireless, Inc.*, Appeal No. 21-1760 (Court of Appeals for the Federal Circuit); *Zipit Wireless, Inc. v. LG Electronics Inc.*, Case No. 6-18-cv-02016 (D.S.C.) (case currently stayed); and *Zipit Wireless, Inc. v. LG Electronics U.S.A., Inc.*, No. 2:20-cv-01494-KM-JBC (D.N.J.). Paper 6, 3–4.

C. The '837 Patent

The '837 patent relates to a handheld instant messaging ("IM") device. Ex. 1001, 1:16–18. The '837 patent discloses an IM terminal that includes a display and a data entry device integrated in a housing for the IM terminal. *Id*. at 4:25–28. The data entry device allows entry of graphical symbols (such as emoticons supported by an IM service provider) or textual characters via dedicated or programmable keys, a Wi-Fi communications module for communicating messages with a Wi-Fi access point, and a control module for coordinating authorization to coupling the IM terminal to a local network using a wireless access point and for controlling the IM conversation session. *Id*. at 4:28–35, 4:36–55, Figs. 12a and 12b.

Figure 2, provided below, "shows an embodiment of an instant messaging terminal that operates in accordance with the principles of the present invention." *Id*. at 8:62–65.

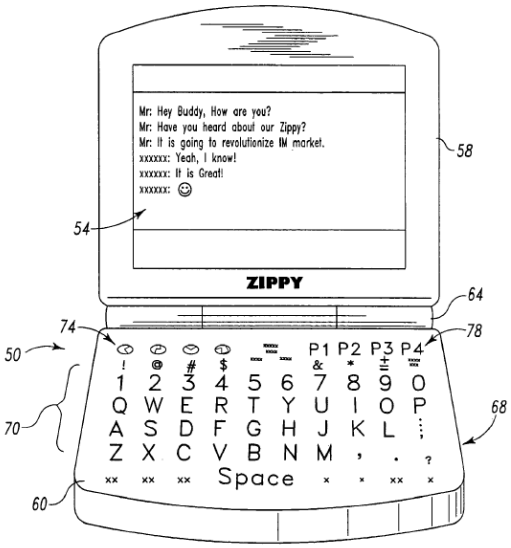

Fig. 2

Figure 2 shows terminal 50, display 54, and located on the bottom of the clamshell configuration 60 is data entry device 68, with QWERTY keyboard section 70, pre-programmed emoticon keys 74, and programmable emoticon keys 78. *Id*. at 11:10–23.

Figures 12a and 12b, provided below, show user interface screens that associate emoticon pictorial images with programmable keys. *Id*. at 9:27–28.

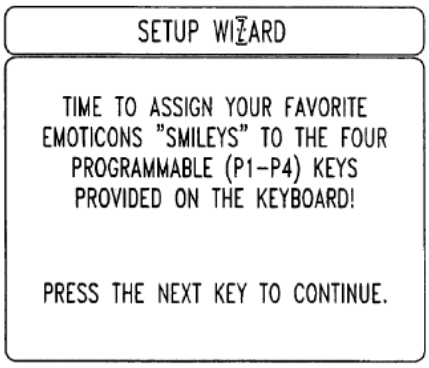

Fig. 12A

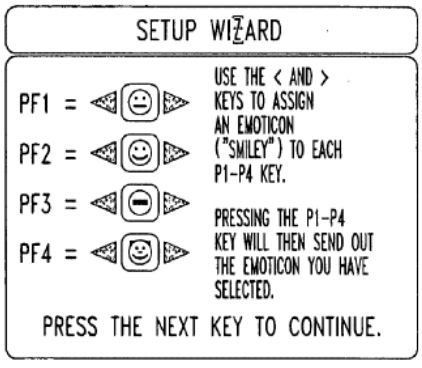

Fig. 12B

Figures 12a and 12b show screens used in the emoticon selection procedure. *Id.* at 9:27–28. Figure 12a identifies keys of keyboard 68 (not shown) that are associated with selected emoticons. Figure 12b shows a screen that instructs the user to use the "<" and ">" keys on either side of the displayed symbol to change the graphical symbol that is associated with a programmable key, e.g., PF2. *Id*. at 16:1–8.

The handheld terminal of the '837 patent manages multiple IM conversations over Internet Protocol ("IP") through different IM service providers. *Id*. at 5:16–63, code (57). The device generates a buddy list of contacts associated with each IM service provider and displays conversation windows for each buddy with whom the user is engaged in active conversation. *Id*. The device detects signals from local wireless access points, prioritizes the access points according to their signal strength, and selects the one having the strongest signal for local network access. *Id*. at 4:56–62.

D. Illustrative Claims

For purposes of this decision, claims 11 and 19 are illustrative of the challenged claims.

> 11. A method for managing wireless network access and instant messaging through a wireless access point with a handheld instant messaging terminal comprising:
>
> generating textual characters and graphical symbols in response to manipulation of keys on a data entry device of a handheld instant messaging terminal;
>
> displaying the generated textual characters and graphical symbols on a display of the handheld instant messaging terminal;
>
> generating data messages with the generated textual characters and graphical symbols in accordance with at least one instant messaging protocol that is compatible with an instant messaging service;

wirelessly transmitting the generated data messages to a wireless network access point through an Internet protocol communications module and wireless transceiver in the handheld instant messaging terminal; and

controlling a conversation session in accordance with the at least one instant messaging protocol being implemented with a control module located within the handheld instant messaging terminal.

19. The method of claim 11, the conversation session control further comprising:

parsing textual characters and graphical symbols generated with the data entry device; and

confirming the entered characters are compatible with the instant messaging service associated with the buddy to whom the message is being sent.

Ex. 1001, 24:55–25:20, 26:22–28.

E. Instituted Grounds

Petitioner relies on the following references. Pet. 2–3.

Name	Reference	Exhibit
Van Dok	Van Dok, U.S. Patent App. Pub. No. 2004/0162877, filed Feb. 19, 2003, published Aug. 19, 2004	1060
Sinivaara	Sinivaara, U.S. Patent App. Pub. No. 2004/0202141, filed Jan. 9, 2003, published Oct. 14, 2004	1062
Werndorfer	Werndorfer et al., U.S. Patent App. Pub. No. 2004/0024822, filed Aug. 1, 2002, published Feb. 5, 2004	1013
Sidekick-I	T-Mobile Sidekick Owner's Manual, Release 1.01, March 11, 2003	1005
Sidekick-II	T-Mobile Sidekick Owner's Manual, https://web.archive.org/web/20030202154930/http://help.sidekick.dngr.com/OwnersManual.Html	1006
Saric	Saric, et al., Canadian Patent App. No. 2,363,978, filed Nov. 26, 2001, published May 26, 2003	1065
Canfield	Canfield, et al., U.S. Patent No. 7,281,215 B1, filed Jul. 31, 2002, issued Oct. 9, 2007	1045
Rucinski	Rucinski, U.S. Patent App. Pub. No. 2003/0130014, filed Aug. 20, 2002, published July 10, 2003	1040

We instituted *inter partes* review of claims 13 and 17–19 of the '837 patent on the following grounds (Dec. on Inst. 8–9, 19), which are all the grounds presented in the Petition (Pet. 1–2):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
17	103(a)	Van Dok, Sinivaara, Werndorfer, (Sidekick I or Sidekick II), or Van Dok, Sinivaara, Werndorfer, (Sidekick I or Sidekick II), Rucinski
18	103(a)	Van Dok, Sinivaara, Werndorfer, (Sidekick I or Sidekick II), Canfield

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
19	103(a)	Van Dok, Sinivaara, Werndorfer
13	103(a)	Van Dok, Sinivaara, Werndorfer, or Van Dok, Sinivaara, Werndorfer, Saric

Pet. 1–2. Petitioner also relies on the declarations of Patrick Traynor, Ph.D. (Ex. 1003), Dr. Gregory Abowd (Ex. 1050) (asserted in the *Google '837 IPR*), and Duncan Hall (Ex. 1021).

II. ANALYSIS

A. Level of Ordinary Skill in the Art

Petitioner asserts the level of skill adopted in the Final Written Decision in IPR2019-01568, *Google '837 IPR* at 8–9. *See* Pet. 5 n.2; Ex. 1003 ¶¶ 37. Our prior decision in IPR2019-01568 found that

> [a person of ordinary skill in the art] has an accredited bachelor's degree in computer science, electrical engineering, or a related discipline that included coverage of wireless communications and the use of communication protocols used for real-time communications, and also at least two years of industry experience. In lieu of specific academic training, a [person of ordinary skill in the art] may draw upon appropriate industry experience to meet the foregoing requirements.

Google '837 IPR at 8. Patent Owner does not challenge Petitioner's statement. *See* PO Resp. We apply this level of skill in the present case.

B. Claim Construction

In *inter partes* review proceedings based on petitions filed on or after November 13, 2018, such as this one, we construe claims using the same claim construction standard that would be used in a civil action under 35 U.S.C. § 282(b), as articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), and its progeny. *See* 37 C.F.R. § 42.100(b) (2020). "There are only two exceptions to this general rule: 1) when a

patentee sets out a definition and acts as his own lexicographer, or 2) when the patentee disavows the full scope of a claim term either in the specification or during prosecution." *Thorner v. Sony Comput. Entm't Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012).

We now consider claim construction issues only to the extent necessary to dispose of the instant unpatentability grounds. *See, e.g., Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) ("The Board is required to construe 'only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.'" (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

Petitioner offers no proposed claim constructions and apply the constructions determined by the Board in the IPR2019-01568 Final Written Decision. Pet. 5. Petitioner asserts that the remaining terms are given their "ordinary and customary meaning as understood by a Person of Ordinary Skill in the Art as of the Critical Date . . . and the prosecution history." *Id*. at 5 (citing Ex. 1003 ¶¶ 73–74; 37 C.F.R. §42.100(b)). Patent Owner does not challenge Petitioner's construction. PO Resp. 10–11

We adopt the claim constructions determinations in IPR2019-01568 provided in the table below.

Claim Term	IPR2019-01568 Construction
"generating textual characters and graphical symbols in response to manipulation of keys on a data entry device"	"graphical symbols" refers to "graphical emoticons;" phrase is given its "ordinary meaning in the context of the claims"
"a data entry device of a handheld terminal"	"a handheld terminal capable of data entry"

Google '837 IPR at 9–12.

C. Obviousness of Claim 17: Van Dok, Sinivaara, Werndorfer, Sidekick (Sidekick I or Sidekick II), or Van Dok, Sinivaara, Werndorfer, Sidekick (Sidekick I or Sidekick II), Rucinski

Petitioner asserts that claim 17 is unpatentable under 35 U.S.C. § 103(a) as obvious over Van Dok, Sinivaara, Werndorfer, and Sidekick (Sidekick I or Sidekick II), or Van Dok, Sinivaara, Werndorfer, Sidekick (Sidekick I or Sidekick II), and Rucinski. Pet. 5–38. In the *Google '837 IPR* we found Van Dok, Sinivaara, and Werndorfer teach the limitations of claim 11, from which claim 17 depends. *See Google '837 IPR* at 20, 49–51. Petitioner provides support with evidence and argument regarding the motivations to combine the prior art teachings as to how the asserted art discloses each limitation with citations to the Traynor and Abowd declarations in support of their contentions. Pet. 5–38; Ex. 1003 ¶¶ 639–695; Ex. 1050 ¶¶ 105–180. The prior art is summarized below.

1. Van Dok (Ex. 1060)

Van Dok discloses a system providing "enhancements to a real-time communications user interface" that "add functionality and personality" in "instant messaging." Ex. 1060, code (57), ¶ 3. Van Dok addresses shortcomings of traditional instant messaging through "automatic emoticon replacement." *Id.* ¶¶ 7, 9, 56. Van Dok discloses that "[k]nown instant messaging implementations . . . fail to show a graphical representation [e.g., ☺] for a textually entered emoticon [e.g., ':)'] . . . until after a message is sent." *Id*. ¶ 14. Van Dok teaches that when the user types a text sequence for an emoticon (e.g., ":)" for a smiley face emoticon), the system automatically interprets the text sequence and displays its graphical representation (e.g., ☺) in the "input box" of a "conversation window" before the message is sent, "allow[ing] the user composing the message to

preview how the message will appear when received." *Id.* ¶ 56. Figure 5A depicts the automatic emoticon replacement disclosed in Van Dok. *Id.* ¶ 26.

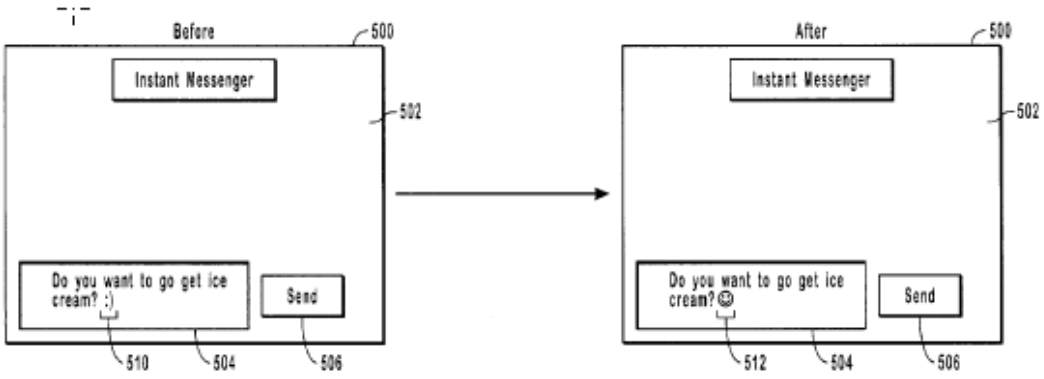

FIG. 5A

Van Dok states that Figure 5A illustrates

> instant messaging user interface 500, having conversation window 502, input box 504, and send button 506, both "Before" and "After" automatic emoticon replacement in accordance with the present invention. The user interface interprets, for example, the text sequence ":)" 510 automatically as the smiley face character ☺ 512, before a user selects the send button 506 for the instant message in input box 504. Among other things, replacement before sending the real-time message allows the user composing the message to preview how the message will appear when received. Of course, text sequence 510 is merely one example of many possible text sequences for potentially many different emoticons that may be available. Which text sequences correspond to which emoticons may be user configurable, including the ability to specify user defined emoticons. . . .

Id. ¶ 56.

Van Dok also discusses use of "hand-held devices" and network computing environments and handheld device markup language (HDML) operating in wireless network environments. *Id.* ¶¶ 16, 66–69.

2. Sinivaara (Ex. 1062)

Sinivaara discloses a method for a "mobile terminal" to select an "access point in a wireless communication system." Ex. 1062, code (57). Sinivaara teaches that

> a group of mobile terminals in a cell utilize predetermined attributes which give an indication of the quality of service (QoS) currently experienced by the terminal, by collecting a set of such attributes and sending the set to the serving access point. The serving access point processes the attribute sets received from the mobile terminals and compiles a cell report on the basis of the sets. The cell report indicates the current overall quality of service in the cell. . . .
>
> The service report is then transmitted so that each mobile terminal in the neighborhood, which is about to select an access point, may receive it.

Id. ¶¶ 16–17. Sinivaara describes WLAN in "infrastructure mode" is "preferably based on the IEEE 802.11 [Wi-Fi] standard for wireless local area networking" for a mobile terminal to use "beacon" information to select an access point to use. *Id*. ¶¶ 1–5, 15, 55, 56.

3. Sidekick-I (Ex. 1005) and Sidekick II (Ex. 1006)

Sidekick-I (a PDF manual) and Sidekick II (an internet based publication of a user manual) are the user manuals for a handheld mobile communication device that uses IM and wireless networking. Ex. 1005, 1, 9, 14; Ex. 1006 5, 9. Petitioner cites to the two Sidekick manuals in parallel asserting that "Sidekick-II is the earliest publically accessible portions of a user manual relied upon" and "Sidekick-I has a slightly later known public accessibility date than Sidekick-II." Pet. 3. Petitioner relies primarily on Sidekick-I, but to the extent that Sidekick-I is challenged, Petitioner also relies independently on Sidekick-II. *Id*.

The Sidekick manuals disclose a device, with display keyboard and control buttons that also has wireless network connectivity to connect to IM functions such as AOL Messenger (AIM). Ex. 1005, 14, 19–22, 43, 46, 73, 75; Ex. 1006, 9–12, 24–26, 52–55. The Sidekick manuals disclose that "[w]ith AIM, you can have up to 10 online [IM] conversations going at the same time." Ex. 1005, 81–82; Ex. 1006, 47–48. The Sidekick manuals state that the display screen provides indications for when a message has been sent successfully or queued for delivery when a connection is lost when a device was out of radio range. Ex. 1006, 48, 72; Ex. 1005, 81.

4. Werndorfer (Ex. 1013)

Werndorfer discloses a "unified instant messaging client platform" designed to address the "lack of interoperability between the different instant messaging services" in conventional IM systems. Ex. 1013 ¶¶ 47, 48. Werndorfer explains that a "basic principle[]" of IM is that "proprietary instant messaging client software" is required "to communicate with the specified instant messaging service." *Id.* ¶¶ 8–9. For example, AOL's Instant Messenger ("AIM®") software "allows the client computers . . . to communicate with the AIM server using AOL's proprietary instant messaging protocol." *Id*. "Moreover, the client IM software and associated IM protocols required by each service . . . are not compatible." *Id.* ¶ 10.

Figure 2, below, depicts an instant messaging client architecture. *Id*. ¶ 18.

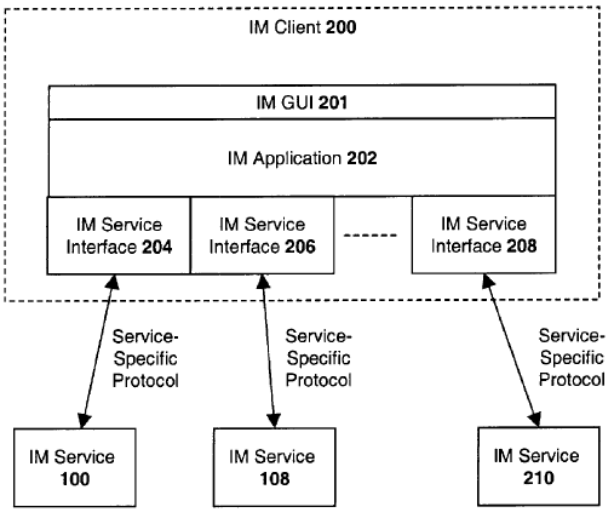

Fig. 2

Figure 2 shows IM client platform 200 comprised of IM application portion 202, which contains standard IM functions used by each IM service 100, 108, 210 (e.g., a buddy list, user-defined online/offline parameters, and other universal IM features described below). *Id*. ¶ 48. "Users interact with the IM application 202 via IM graphical user interface 201." *Id*. Werndorfer teaches "interoperability with the different, normally incompatible, IM services, [using] IM service interface module 204, 206, 208, [which] is provided for each IM service 100, 108, and 210, respectively." *Id*. "The IM service interface modules 204, 206, 208 provide service-specific features and communicate with the respective IM services 100, 108, 210 using the IM protocol required by that service." *Id*.

5. Rucinski (Ex. 1040)

Rucinski discloses a user interface for use in an instant messaging service application. Ex. 1040, code (57). Rucinski teaches a dedicated button to launch a buddy list. Ex. 1040 ¶ 50. Specifically, Rucinski teaches a "WHO's ON" which upon activation displays a screen "identify[ing] those

subscribers that are online and within, for example, a buddy list or chat group associated with the user." *Id*.

6. Motivation to Combine

Petitioner argues that the *Google '837 IPR* found that a person of ordinary skill in the art would have had reasons to combine Van Dok, Sinivaara, and Werndorfer to implement Van Dok's device as set forth in IPR2019-01568. Pet. 9 (citing *Google '837 IPR* at 16–17). Petitioner reasserts the arguments presented in the *Google '837 IPR* supporting the motivation to combine Van Dok, Sinivaara, and Werndorfer. Pet. 9–15; Ex. 1003 ¶¶ 648–650; Ex. 1050 ¶¶ 81–103. Petitioner provides persuasive argument and evidence supporting the combination of Van Dok's instant messaging device with features from the Sidekick (Pet. 26–30; Ex. 1003 ¶¶ 657–671) and in the alternative with Sidekick and Rucinski (Pet. 36–38; Ex. 1003 ¶¶ 688–695; Ex. 1040 ¶ 50).

7. Claim 17

In view of the *Google '837 IPR* which canceled claim 11 based on Van Dok, Sinivaara, and Werndorfer**,** Petitioner asserts that Van Dok, Sinivaara, Werndorfer in combination with the teachings of Sidekick (Sidekick-I and Sidekick-II) discloses the limitations of claim 17, which requires generating and displaying an active buddy list for an instant messaging service. Pet. 30–36; Ex. 1003 ¶¶ 672–687. In the alternative, Petitioner argues that Rucinski in combination with Van Dok, Sinivaara, Werndorfer, and Sidekick provides a dedicated button to launch a buddy list for an instant messaging service. Pet. 36–38; Ex. 1003 ¶¶ 688–695.

Patent Owner does not challenge Petitioner's contentions and "takes no position" with respect to the cited evidence. PO Resp. 12. *See* 37 C.F.R. § 42.23(a) ("Any material fact not specifically denied may be considered

admitted."); *In re Nuvasive, Inc*., 842 F.3d 1376, 1379–82 (Fed. Cir. 2016) (holding that patent owner waived arguments on an issue that were not raised in its response after institution).

Based on the full record, we find that Petitioner's evidence and argument establish by a preponderance of the evidence that the combination of Van Dok, Sinivaara, Werndorfer, and Sidekick (Sidekick I or Sidekick II), or Van Dok, Sinivaara, Werndorfer, Sidekick (Sidekick I or Sidekick II), and Rucinski discloses the limitations of claim 17.

D. Obviousness of Claim 18: Van Dok, Sinivaara, Werndorfer, Sidekick (Sidekick I or Sidekick II), Canfield

Petitioner asserts that claim 18, which depends from claim 11, is unpatentable under 35 U.S.C. § 103(a) as obvious over Van Dok, Sinivaara, Werndorfer, Sidekick (Sidekick I or Sidekick II), and Canfield. Pet. 38–64. As stated above, claim 11 was found unpatentable over Van Dok, Sinivaara, Werndorfer. *Google '837 IPR* at 20, 49–51. To support its contentions, Petitioner provides persuasive explanations as to how the prior art discloses each claim limitation and the motivations to combine the prior art teachings of Van Dok, Sinivaara, Werndorfer, and Sidekick (Sidekick I or Sidekick II) with Canfield. *Id.*; Ex. 1003 ¶¶ 704–714.

Canfield discloses an "IM conversation counter and indicator" that "provides . . . statistics regarding concurrent instant messaging sessions." Ex. 1045, codes (54), (57). Canfield teaches a system that "determine[s]" "statistics," such as "a total number of concurrent instant messaging sessions; a number of instant messaging sessions with new messages; a number of new instant messaging sessions; and a number of new instant messages." *Id*. at 1:45-62.

Petitioner provides persuasive evidence to support the motivation to combine Van Dok, Sinivaara, Werndorfer, and Sidekick (Sidekick I or Sidekick II) with Canfield to implement Canfield's teachings of providing statistics and information about concurrent sessions within the displayed conversation session window provided by Van Dok, Sinivaara, Werndorfer, and Sidekick device. Pet. 43–44; Ex. 1003 ¶ 712. Petitioner cites persuasive evidence and argument that the combination of Van Dok, Sinivaara, Werndorfer, and Sidekick (Sidekick I or Sidekick II) with Canfield teaches the buddy list and display window data limitations of dependent claim 18. Pet. 45–64; Ex. 1003 ¶¶ 715–768.

Patent Owner does not challenge Petitioner's contentions and "takes no position" with respect to the cited evidence. PO Resp. 12; *see* 37 C.F.R. § 42.23(a).

Based on the full record, we find that Petitioner's evidence and argument establish by a preponderance of the evidence that the combination of Van Dok, Sinivaara, Werndorfer, and Sidekick (Sidekick I or Sidekick II), and Canfield discloses the limitations of claim 18.

E. Obviousness of Claim 13: Van Dok, Sinivaara, Werndorfer, or Van Dok, Sinivaara, Werndorfer, Saric

Petitioner asserts that claim 13, which depends from claims 11 and 12, is unpatentable under 35 U.S.C. § 103(a) as obvious over Van Dok, Sinivaara, and Werndorfer, or Van Dok, Sinivaara, Werndorfer, and Saric. We determined in the *Google '837 IPR* that both Van Dok, Sinivaara, and Werndorfer, and Van Dok, Sinivaara, Werndorfer, and Saric rendered claim 12 obvious. *Google '837 IPR* at 20–21, 34–46; Ex. 1006, 31–32, 37–40; Ex. 1050 ¶¶ 174–1890, 191–211; *see also* Ex. 1003 ¶¶ 792–796. Claim 12 includes further limits the control of claim 11 adding a "correlating a key on

the data entry device with a graphical symbol in response to the key on the data entry device being depressed." Claim 13 further limits claim 12 and requires "generating in accordance with the at least one instant messaging protocol being used to control a conversation session, a character sequence that represents the graphical symbol."

In the present case, Petitioner asserts that either combination—Van Dok, Sinivaara, and Werndorfer, or Van Dok, Sinivaara, Werndorfer, and Saric—teaches "determining and generating the correct graphical symbol (e.g., emoticon) in response to the user depressing a key already assigned to that symbol" with Saric further teaching assigning an emoticon to a key. Pet. 75–76 (citing Ex. 1063, 12; Ex. 1003 ¶¶ 797–807; Ex. 1042, 34–36). Petitioner argues that Van Dok's combined system would have assigned a key to an emoticon by assigning the character sequence to the special key, such that when pressed it sequence is generated and converted into the corresponding graphical emoticon in an IM application. Pet. 77–78 (citing Ex. 1003 ¶¶ 812–814; Ex. 1010, 90; Ex. 1060 ¶¶ 14, 56; Ex. 1013 ¶ 82).

In view of our prior determinations, Petitioner provides persuasive argument and evidence that either Van Dok, Sinivaara, and Werndorfer, or Van Dok, Sinivaara, Werndorfer, and Saric teach the additional limitations of claim 13. Pet. 73–79; Ex. 1003 ¶¶ 792–819.

Patent Owner does not challenge Petitioner's contentions and "takes no position" with respect to the cited evidence. PO Resp. 37; *see* 37 C.F.R. § 42.23(a) ("Any material fact not specifically denied may be considered admitted.").

Based on the full record, we find that Petitioner's evidence and argument establish by a preponderance of the evidence that Van Dok,

Sinivaara, and Werndorfer, or Van Dok, Sinivaara, Werndorfer, and Saric, disclose the limitations of claim 13.

F. Obviousness of Claim 19: Van Dok, Sinivaara, Werndorfer

Petitioner asserts that claim 19, which depends from claim 11 is unpatentable under 35 U.S.C. § 103(a) as obvious over Van Dok, Sinivaara, and Werndorfer. In view of the *Google '837 IPR* which canceled claim 11 based on Van Dok, Sinivaara, and Werndorfer**,** Petitioner asserts that the cited art further teaches the limitations of dependent claim 19. Claim 19 recites two disputed limitations, "parsing textual characters and graphical symbols generated with the data entry device" and "confirming the entered characters are compatible with the instant messaging service associated with the buddy to whom the message is being sent." We address the parties' contentions below.

Petitioner's Contentions

Petitioner argues that claim 19 does not require the parsing or confirming limitations are performed in a multiple IM service environment, asserting that claim 19 only requires confirming that the characters are compatible with the IM service recited in claim 11. Pet. 65. Thus, Petitioner asserts that the Van Dok, Sinivaara, Werndorfer combination teaches automatically converting a test sequence into a graphical emoticon character, such as a smiley face. Pet. 67–68; Ex. 1060 ¶¶ 6–7, 14, 38–41, 45, 56, 69, 72; Figs. 2A–2B, 5A; Ex. 1003 ¶ 777. Petitioner argues that the when data entry in the Van Dok combination includes a character string recognized by the IM application as corresponding to a graphical emoticon, the IM application evaluates the characters and converts the character sequence into the graphical emoticon. Pet. 68 (citing Ex. 1003 ¶ 778; Ex. 1060 ¶ 56, Fig. 5A). Petitioner argues this teaches the parsing limitation

of claim 19. Pet. 68—69; Ex. 1001, 5:49–56, 7:61–8:2, 18:35–19:23; Ex. 1003 ¶ 778). Petitioner alleges that this parsing is part of the VD combination's conversation session control previously found in claim 11. Pet. 69 (citing Ex. 1060 ¶¶ 6–8, 38–48, 56–63m 68–74; Ex. 1033 ¶ 779).

> With respect to the confirming limitation, Petitioner argues that
>
> [a] POSITA would have thus understood, or found obvious, that when VD's user keys in a character sequence that is automatically converted and displayed as a graphical emoticon in the IM application window, the entered character sequence corresponds to a graphical emoticon supported by the particular IM service used by VD's device.

Id.at 72 (citing Ex. 1003 ¶ 787). Thus, when the character string or sequence is determined to correspond to a graphical emoticon by the IM client and supported by the IM service, the corresponding graphical emoticon symbol is displayed. Pet. 72; Ex. 1003 ¶¶ 788–789. Conversely, when a character string is not recognized as a supported by the IM service in the VD combination, it is displayed as-is (e.g. displayed as a character string). Pet. 72; Ex. 1003 ¶¶ 788–789. Petitioner asserts that this is consistent with the '837 patent description of entered character sequences and their compatibility when describing a single IM service. Pet 72; Ex. 1003 ¶ 790; Ex. 1001, 5:49–56, 7:61–8:2, 18:35–19:23.

Patent Owner's Contentions

Patent Owner argues that Petitioner fails to understand the programmable keys as described in the '837 patent. PO Resp. 17–21; Ex. 2001 ¶¶ 116–122. Because the programmable keys of the '837 patent could only be programmed with graphical emoticons that were supported or adopted by the IM service there was no need for an application in the '837

patent to evaluate whether the character sequence was supported by the IM service. PO Resp. 21; Ex. 2001 ¶ 122.

Patent Owner also asserts that Petitioner conflates the parsing requirement with displaying, rendering the terms redundant with independent claim 11's displaying limitation. PO Resp. 21–22, 27. Because "[t]he second limitation of independent claim 11, from which claim 19 depends, calls for 'displaying the generated textual characters and graphical symbols on a display of the handheld instant messaging terminal,'" the further parsing of claim 19's conversation session control limitation, requires more than simply displaying characters or symbols as recited in claim 11. PO Resp. 21; Ex. 2001 ¶ 124.

Patent Owner argues that this understanding of parsing is supported by the plain and ordinary meaning (PO Resp. 22 (citing Ex. 2001 ¶ 125)); and dictionary definitions (Ex. 2006, 585; Ex. 2005, 627), requiring more than simply analyzing a character string to determine if it compatible with a language or protocol. PO Resp. 22–23; Ex. 2001 ¶ 125.

In addition, Patent Owner argues that parsing is consistent with the '837 patent. PO Resp. 23; Ex. 2001 ¶ 126; Ex. 1001, 5:49–58, 7:61–8:2. Thus, Patent Owner argues that

> the ['837 patent] specification explains [to a POSITA] that parsing is used not for displaying emoticons but to confirm that "the sequence is compatible with the messaging service" of a buddy; and if it is not compatible, "the control module determines the corresponding sequence for the symbol in the messaging service and substitutes that sequence in the message before transmitting the message"

PO Resp. 23 (citing Ex. 2001 ¶ 126; Ex. 1001, 5:49–58, 7:61–8:2).

With respect to the confirming compatibility limitation of claim 19, Patent Owner argues that Petitioner ignored the confirming step (PO Resp.

26), and renders the confirming step redundant with the compatibility step in claim 19. PO Resp. 27–29. Patent Owner argues that Petitioner fails to show that the asserted combination confirms that the entered characters are compatible with the instant messaging service. PO Resp. 31 (citing Ex. 2001 ¶ 139; Pet. 72; Ex. 1003 ¶ 787). Patent Owner further argues that Petitioner fails to show that claim 19's further limitation on claim 11, is not met by a character string that is associated with a graphical emoticon, but "requires an affirmative step of approval to ensure, or double-check, the "compatibility" of the "entered characters" with a recipient buddy's instant messaging service. PO Resp. 32; Ex. 2001 ¶ 142.

1. Claim 19 Analysis

We are not persuaded by Patent Owner's arguments that the art cited in the Petitionfails to teach the limitation of claim 19. Specifically, Patent Owner's arguments are premised on the programmable keys in the '837 patent performing the same functions and limitations as Petitioner's asserted Van Dok combination. *Compare* PO Resp. 16–21 (describing the '837 patent programmable key embodiment) *with* Pet. 67–69 *and* Ex. 1103 ¶ 142 (describing a user typing in a character string and automatic emoticon replacement if the string is recognized as supported by the IM service). Petitioner argues and we agree that the '837 patent's programmable keys are not required in claim 19 or claim 11 from which it depends. Reply 3–4; Ex. 1103 ¶ 141. In addition, Petitioner is not relying on the programmable keys as disclosed in the '837 patent that are limited to IM service supported emoticons, but instead Petitioner asserts that a user inputs character strings that may not be recognized by the IM service. Pet. 67–69. Accordingly, we find Patent Owner's arguments unavailing as they do not address the

combination Petitioner asserts. We address Patent Owner's contentions below.

a) Parsing Limitation

With respect to "parsing," Patent Owner states that the "claimed 'parsing' means that the IM client application evaluates whether the characters were supported by the instant messaging service" Sur-reply 16 (citing PO Resp. 22–23; Ex. 2001 ¶ 60). However, the Patent Owner also argues that parsing requires more and "refers to analyzing characters as part of a string or text (in this case, an instant message) to ensure that they are compatible with a 'grammar,' i.e., the rules of a language or protocol." PO Resp. 22–23; Ex. 2001 ¶ 125.

Under either interpretation Patent Owner advances, we find that Petitioner provides persuasive evidence and argument that the cited art teaches the limitation. The Petition expressly argues that the combination evaluates characters to determine if they are supported by a particular IM supported emoticon. Pet. 67–70; Ex. 1003 ¶¶ 777–783. We credit Dr. Traynor's testimony that the combination's IM client evaluates entered characters to ensure compatibility with IM supported graphical emoticons. Ex. 1003 ¶¶ 777–783; Ex. 1103 ¶¶ 134–136. We find that Petitioner's argument is consistent with the '837 patent's description that the control module "parses the characters within a message generated by a user with the data entry device and confirms the sequence is compatible with the message service being used to conduct the conversation." Ex. 1001, 5:50–54.

We also do not find the Petitioner's argument regarding "parsing" redundant of claim 11's "displaying" limitation, as the Petition does not rely on the resulting display to support the parsing limitation. *See* Pet. 67–69; Ex. 1003 ¶¶ 777–779 (citing Ex. 1001, 5:49–57, 7:59–8:2, 18:1–42);

Ex. 1103 ¶¶ 143–144. We also do not agree that the Petition relies on automatic conversion of entered characters to establish parsing, that Petitioner's arguments encompass all applications, or that parsing in claim 19 "requires additional logic (computation) that goes beyond 'displaying' a character." PO Resp. 26–27; Ex. 2001 ¶¶ 66–68. Patent Owner's arguments regarding the parsing of other applications that display emoticons or symbols do not address Petitioner's proposed combination that relies on the IM application to determine if the generated or entered characters to ensure compatibility with the IM service. Pet. 66–69; Ex. 1003 ¶¶ 777–789. Further, Patent Owner's arguments that additional logic or computation is required (PO Resp. 15; Sur-reply 15) is not supported by the '837 patent or commensurate in scope with claim 19's parsing limitation. Instead, we are persuaded, as Petitioner argues, that an ordinarily skilled artisan would understand that the entered characters are evaluated or parsed to determine if they are recognized as corresponding to a graphical emoticon and displayed as such in the IM conversation window. *See* PO Resp. 67–68; Ex. 1060, Fig. 5A, ¶ 56; Ex. 1003 ¶¶ 774–778; Reply 1–2. Indeed, Patent Owner's declarant testified that parsing requires determining whether the generated character sequence corresponds to a graphical emoticon supported by or compatible with the IM service. Ex. 1107, 81:18–84:10 (stating that parsing example includes "character sequence corresponds to an emoticon that is supported by" the IM service/protocol); *see also* Ex. 1003 ¶¶ 777–779, 783–789; Ex. 1103 ¶¶ 145–146.

On the full record, we find that Petitioner establishes by a preponderance of the evidence that the cited combination teaches the "parsing" limitation of claim 19.

b) Confirming Compatibility Limitation

Petitioner and Patent Owner's dispute regarding claim 19's confirming compatibility rely on different views of the scope of claim 19's confirming compatibility limitation and the features of Petitioner's proposed combination. We do not agree with Patent Owner that the Petition conflates confirming and compatibility as recited in claim 19. PO Resp. 27–28; Ex. 2001 ¶ 134. Petitioner argues that in the proposed combination a character string that is recognized as corresponding to an IM service is displayed and an unrecognized character string is displayed as is. Pet. 71–72; Ex. 1003 ¶¶ 785–791; Ex. 1103 ¶¶ 55–68; Ex. 1107, 43:1–45:19, 59:5–60:16, 63:3–11 (describing confirmation that a character sequence is compatible in the '837 patent).

The '837 patent specification states that

> the control module parses the characters within a message generated by a user with the data entry device and confirms the sequence is compatible with the messaging service being used to conduct the conversation with the recipient buddy. If it is not compatible with the service, the control module determines the corresponding sequence for the symbol in the messaging service and substitutes that sequence in the message before transmitting the message to the access point for delivery to the messaging service. In this manner, the control module provides transparent support across multiple instant messaging services without requiring the terminal user to be knowledgeable of the different character sequences for graphical symbol generation in each of the instant messaging services with which the user has an account.

Ex. 1001, 5:50–63. Thus, the '837 patent discusses confirming that the entered characters are compatible with the IM message conversation in the same manner Petitioner cites for the cited combination.

Patent Owner argues that

> a POSITA would have understood that the "confirming" step additionally requires an affirmative step of approval to ensure, or double-check, the "compatibility" of the "entered characters" with a recipient buddy's instant messaging service. Exhibit 2001, Rouskas Declaration at ¶ 142. Thus, "confirming" "compatibility" is not met merely by "a character string that is automatically converted and displayed as a graphical emoticon in the IM application window." Exhibit 2001, Rouskas Declaration at ¶ 142.

PO Resp. 32. In sum, Patent Owner requires the "confirming" step of claim 19 to incorporate the additional step of approval, ensuring, and double-checking the compatibility of entered characters. *Id*. Patent Owner argues that Petitioner's combination fails because the Van Dok combination does not support a sending and receiving users on different IM services, and in fact requires the sending and receiving users to use the same IM service. PO Resp. 33; Ex. 2001 ¶¶ 143–144; Ex. 1060 ¶¶ 6–7. Thus, Patent Owner argues that no confirmation step was necessary. *Id*.

Patent Owner's arguments are not commensurate in scope with claim 19, which does not assert a double-check or approval, and fail to address the proposed combination asserted by Petitioner. The '837 patent specification and claim 19 do not describe any additional step above the recited "confirming the entered characters are compatible with the instant messaging service associated with the buddy to whom the message is being sent." Indeed, Patent Owner's declarant support that if the terminal determines that the entered sequence matches/corresponds to a character sequence for an emoticon supported by the IM service being used for the conversation, compatibility is confirmed and the supported emoticon is

generated and displayed in the conversation. Reply 6–7; Ex. 1103 ¶¶ 55–68; Ex. 1107, 43:1–45:19, 59:5–60:16, 63:3–11.

Patent Owner also asserts that because dependent claim 19 adds a confirming compatibility limitation, there must be an additional check performed in claim 19. PO Resp. 32; Ex. 2001 ¶ 142. The '837 patent does not describe an additional affirmative step beyond determining that the character sequence matches the character sequence that corresponds to an emoticon supported by the IM service that is then generated. Reply 16; Ex. 1103 ¶¶ 74–75, 159–160; Ex. 1107, 59:19–60:16 (Patent Owner declarant agreeing that "confirmation means . . . [the] particular sequence that the user types corresponds to an emoticon" supported by the IM service); *see id*. 62:5–16, 63:3–11. We are also not persuaded that the compatibility limitation of claim 19 requires a double check because claim 11, from which claim 19 depends, already determines if entered characters are compatible with an IM service. PO Resp. 31–32. We agree with Petitioner that claim 11 requires the instant messaging protocol of claim 11 is compatible with an IM service. Reply 17; Ex. 1103 ¶¶ 79–81. We agree that the specific character sequence or string compatibility is the plain reading of claim 11. Thus, we do not find that the '837 patent requires an additional affirmative step. In sum, we do not agree with Patent Owner's argument that determining that the character string is associated with a graphical emoticon of claim 11 encompasses evaluating the compatibility of the entered characters with the IM service. PO Resp. 31–32; Ex. 2001 ¶¶ 141–142.

Patent Owner's arguments are also premised on the compatibility and confirmation limitations applying to generated characters exchanged in across multiple IM services. PO Resp. 33–34; 36–37 (discussing

compatibility and confirming across IM services); Sur-reply 19–22. Patent Owner's arguments are not commensurate in scope with claim 19 or claim 11 from which it depends. Claims 11 and 19 do not recite or require compatibility between more than one IM service, but instead, require compatibility between an entered character sequence and the IM service used for the IM conversation session with at least one messaging service protocol. *See* Ex. 1001, 5:47–63 (stating that the entered characters are "compatible with the messaging service being used to conduct the conversation with the recipient"). Although the '837 patent addresses multiple IM service environments (Ex. 1001, 5:47–63, 7:59–65), the claims at issue here, claims 11 and 19, are not limited to these embodiments. In contrast to claim 11 and 19, the '837 patent includes claims that specifically require multiple IM services, such as claims 27 and 47, which recite communicating with different recipients across two IM services). *See* Ex. 1103 ¶ 164; Reply 21. Furthermore, we agree with Petitioner that the '837 patent also discloses an IM conversation between two users using a single IM service. Reply 20–21; Ex. 1001, 16:10–17:9, Fig. 14A; Ex. 1103 ¶¶ 86–88; *see also* Ex. 1107, 37:17–39:22, 23:7–30:18, 32:3–33:1 (supporting single IM service interpretation).

We also do not agree with Patent Owner that "Van Dok does not teach or suggest a step of 'confirming' 'compatibility' because the sending and receiving user were 'online with the same [IM] service provider at the same time.'" PO Resp. 33 (citing Ex. 1060, ¶ 1007); Ex. 2001 ¶ 144. Patent Owner contends that because compatibility already exists between users on the same IM service no confirmation of entered characters as recited in claim 19 is necessary. *Id*. We agree with Petitioner that the '837 patent supports character sequence messages that are deemed incompatible with an

IM service, including embodiments where either characters or graphical emoticons are substituted for the incompatible character sequences. Reply 26–28; Ex. 1001, 5:47–63, 7:59–65, 19:13–23; Ex. 1103 ¶¶ 60–64, 107, 111, 166–168. Thus, we credit Petitioner's evidence and argument that the Van Dok combination discloses displaying a corresponding graphical emoticon when the character string is supported, and when the character string is not supported or recognized, the IM client displays the character string as-is. Pet. 71–72; Ex. 1060 ¶¶ 56–57, Figs. 5A, 5B; Ex. 1003 ¶¶ 787–790; Ex. 1103 ¶¶ 148–153.[4]

Finally, Patent Owner argues that the Central Reexamination Unit (CRU) concluded that claim 19 was patentable over the submitted Petition and the cited art and the Decision on Institution. PO Resp. 15; Sur-reply 25–26. Patent Owner cites to no analysis or discussion of the cited prior art in the Reexamination in this proceeding as it applies to claim 19 or any other challenged claim.[5]

[4] Patent Owner argues that the Petition ignores the Certificate of Correction for claim 19 that deletes the words "the buddy" and replaced them with "a buddy," but Patent Owner fails to provide evidence that this antecedent correction renders the Petition's analysis and argument deficient. PO Resp. 14–15 (citing Ex. 2004; Ex. 2001 ¶ 112).

[5] With respect to the reexamination proceeding, our Order denying Petitioner leave to file a motion to stay the then pending reexamination (Paper 9) noted that the reexamination involved different prior art and could be made of record in this proceeding should it address issues relevant to the issues in this proceeding. Patent Owner raises no such issues apart from the bare assertion that the preliminary papers were submitted to the CRU. PO Resp. 14. Accordingly, we do not find that the Office addressed the patentability of claim 19 with respect to the art cited in this proceeding.

Based on the full record, we find that Petitioner's evidence and argument establish by a preponderance of the evidence that Van Dok, Sinivaara, and Werndorfer disclose the limitations of claim 19.

III. PATENT OWNER'S MOTION TO EXCLUDE

Patent Owner filed a Motion to Exclude Dr. Traynor's testimony, Exhibits 1003 and Exhibit 1103, certain of Patent Owner's evidence. Paper 18 ("Motion" or "Mot."). Petitioner opposed this motion (Paper 19 ("Opposition" or "Opp.")) and Patent Owner filed a Reply to Petitioner's Opposition (Paper 23("Opp. Reply")). For reasons discussed herein, the Motion is denied.

Patent Owner moves to exclude Dr. Traynor's testimony, Exhibit 1003 and Exhibit 1103, asserting that they are inadmissible based on FRE 702, 703, and 704, and improperly contain hearsay based on FRE 802, 803, 804, 805, 806, and 807. Mot. 2–3. Patent Owner's contentions regarding admissibility of Dr. Traynor's declarations and hearsay contained in the declarations all stem from Dr. Traynor's alleged lack of industry experience sufficient to establish ordinary skill in the art as of the critical date of the '837 patent. *See* Mot. 3–8; Opp. Reply 2–5. Petitioner opposes, arguing that (1) Dr. Traynor need not be a person of ordinary skill in the art as of the critical date (December 24, 2003); (2) Dr. Traynor is highly qualified in the pertinent art; and (3) Patent Owner's objections to the declarations were not timely filed and lacked particularity. Opp. 1–2.

We are not persuaded by Patent Owner's arguments that because Dr. Traynor obtained his undergraduate degree 1 year before the critical date he lacks the requisite 2 years of industry experience as of the critical date. Mot. 3–4. Our Consolidated Trial Practice Guide provides that "[a]n expert

witness must be qualified as an expert by knowledge, skill, experience, training, or education to testify in the form of an opinion." Consolidated Trial Practice Guide 74 (Nov. 2019), https://www.uspto.gov/TrialPracticeGuideConsolidated 34 (citing Fed. R. Evid. 702). Further, the Trial Practice Guide also provides that "[a] person may not need to be a person of ordinary skill in the art in order to testify as an expert under Rule 702, but rather must be 'qualified in the pertinent art.'" *Id*. (citing *Sundance, Inc. v. DeMonte Fabricating Ltd*., 550 F. 3d 1356, 1363–1364 (Fed. Cir. 2008)).

We find that Dr. Traynor is qualified in the pertinent art. Dr. Traynor received his Bachelor's degree in Computer Science in May 2002, his Masters' degree in Computer Science in May 2004, and his Ph.D. in Computer Science in 2008. Ex. 1003 ¶ 2; Ex. 1004, 5. He has served as a professor since 2008 and is currently a Professor in the Department of Computer and Information Science and Engineering at the University of Florida. *Id*. at ¶ 3. He has over 8 years of industry experience and has published 90 articles in the areas of information security, mobility, and networking. Ex. 1003 ¶¶ 6–7, 9–11, Ex. 1004 12–24, 31. We note that Patent Owner did not depose Dr. Traynor or ask him about his post undergraduate experience before the critical date.

Furthermore, Patent Owner provides no persuasive authority to support their contention that Dr. Traynor is required to be an ordinarily skilled artisan as of the critical date. *See, generally*, Mot. None of the cases cited by Patent Owner establish that Dr. Traynor must have two years of industry experience as of the critical date. *See* Mot. 5–6 (citing *Libas, Ltd. v. United States*, 193 F.3d 1361, 1366 (Fed. Cir. 1999); *Unified Patents, LLC v. Ideahub, Inc.*, IPR2020-01338, Paper No. 48, at 13 (PTAB Feb. 7, 2022);

Disney Enters., Inc. v. Kappos, 923 F. Supp. 2d 788, 798 (E.D. Va. 2013)). Although *Unified Patents, LLC v. Ideahub, Inc.* case finds that an expert must at a minimum possess ordinary skill in the art, it does not require it such possession as of the critical date. IPR2020-01338, Paper No. 48 at 13. Indeed, the Board in *Unified Patents, LLC v. Ideahub, Inc.*, found that the declarant exceeded the qualifications of an ordinarily skilled artisan. *Id*. at 13–14.

We find that whether Dr. Traynor was an ordinarily skilled artisan as of the critical date of the '837 patent is irrelevant because an expert does not have to be one of ordinary skill in the art during the relevant time frame to be qualified as an expert. *Bayerische Motoren Werke Aktiengesellschaft v. Paice LLC*, IPR2020-01386, Paper 37, at 73-74 (PTAB Jan. 31, 2022); *T. Rowe Price Inv. Servs., Inc. v. Secure Axcess, LLC*, CBM2015-00027, Paper 31, 22 (PTAB June 13, 2016) ("[T]he Federal Circuit has not placed temporal restrictions, such as requiring an expert be qualified in the pertinent art at the time of the invention."). Patent Owner's reliance on *Sundance*, (Mot. 7–8) is not availing, as that case involved an expert that lacked technical qualifications at any time. 550 F.3d at 1359–65. Here, there is no reasonable dispute that Dr. Traynor is highly qualified and presently exceeds the level of ordinary skill in the art. Accordingly, we find that Dr. Traynor is qualified to testify as an expert.

For all the foregoing reasons, we deny Patent Owner's motion to exclude Dr. Traynor's testimony.

IV. CONCLUSION[6]

For the reasons given, based on the arguments and evidence of record, Petitioner has met its burden to prove by a preponderance of the evidence that (1) claim 17 is unpatentable under 35 U.S.C. § 103(a) as obvious over Van Dok, Sinivaara, Werndorfer, and Sidekick (Sidekick I or Sidekick II), or Van Dok, Sinivaara, Werndorfer, Sidekick (Sidekick I or Sidekick II), and Rucinski; (2) claim 18 is unpatentable under 35 U.S.C. § 103(a) as obvious over Van Dok, Sinivaara, Werndorfer, and Sidekick (Sidekick I or Sidekick II), and Canfield; (3) claim 19 is unpatentable under 35 U.S.C. § 103(a) as obvious over Van Dok, Sinivaara, and Werndorfer; and (4) claim 13 is unpatentable under 35 U.S.C. § 103(a) as obvious over Van Dok, Sinivaara, and Werndorfer, or Van Dok, Sinivaara, Werndorfer, and Saric.

V. ORDER

Accordingly, it is:

ORDERED that claims 13 and 17–19 of the '837 patent are unpatentable;

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

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[6] 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).

FURTHER ORDERED that Patent Owner's Motion to Exclude is denied.

The table below summarizes our conclusions:

Claim(s)	35 U.S.C. §	Reference(s)/ Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
17	103(a)	Van Dok, Sinivaara, Werndorfer, (Sidekick I or Sidekick II), or Van Dok, Sinivaara, Werndorfer, (Sidekick I or Sidekick II), Rucinski	17	
18	103(a)	Van Dok, Sinivaara, Werndorfer, (Sidekick I or Sidekick II), Canfield	18	
19	103(a)	Van Dok, Sinivaara, Werndorfer	19	
13	103(a)	Van Dok, Sinivaara, Werndorfer, or Van Dok, Sinivaara, Werndorfer, Saric	13	
Overall Outcome			13, 17–19	

FOR PETITIONER:

W. Karl Renner
David Holt
Karan Jhurani
FISH & RICHARDSON P.C.
axf-ptab@fr.com
holt2@fr.com
jhurani@fr.com

FOR PATENT OWNER:

Stephen R. Risley
Cortney S. Alexander
KENT & RISLEY LLC
steverisley@kentrisley.com
cortneyalexander@kentrisley.com