

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TREND MICRO INC.,
Petitioner,

v.

CUPP COMPUTING AS,
Patent Owner.

IPR2021-01237
Patent 10,951,632 B2

Before THOMAS L. GIANNETTI, GARTH D. BAER, and
SHARON FENICK, *Administrative Patent Judges*.

BAER, *Administrative Patent Judge*.

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

I. INTRODUCTION

Trend Micro Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”), requesting an *inter partes* review of claims 1, 7, 9, 16, 22, and 24 (the “challenged claims”) of U.S. Patent No. 10,951,632 B2 (Ex. 1101, “the ’632 patent”). CUPP Computing AS (“Patent Owner”) filed a Preliminary Response to the Petition (Paper 9, “Prelim. Resp.”). In addition, Petitioner filed an Explanation for Filing Multiple Petitions (Paper 13) and Patent Owner filed a Response to Petitioner’s Explanation (Paper 14).

We have authority under 35 U.S.C. § 314 to determine whether to institute *inter partes* review. For the reasons discussed below, we institute *inter partes* review.

II. BACKGROUND

A. RELATED MATTERS

The ’632 patent is at issue in *CUPP Cybersecurity LLC v. Trend Micro, Inc.*, No. 3:20-cv-03206 (N.D. Tex.). The ’632 patent is also the challenged patent in IPR2021-01236, IPR2021-01237, and PGR2021-00100. A related patent, U.S. Patent No. 9,843,595 (the “’595 patent”), was before the Board in IPR2019-00765 (the “’765 IPR”). A Final Written Decision in the ’765 IPR, finding all challenged claims of the ’595 patent unpatentable, was entered on August 25, 2020. Ex. 1103.

B. THE ’632 PATENT

The ’632 patent describes a system and method for providing data and device security between external and host devices. Ex. 1101, 1:30–33. According to the patent, mobile devices are more vulnerable to attacks by malicious code when traveling outside an enterprise network. *Id.* at 1:61–65. The patent thus describes “a small piece of hardware [a ‘mobile security

system’] that connects to a mobile device and filters out attacks and malicious code.” *Id.* at 5:45–47. The patent explains that “[u]sing the mobile security system, a mobile device can be protected by greater security and possibly by the same level of security offered by its associated corporation/enterprise.” *Id.* at 5:49–52.

This system is illustrated in Figure 3 of the ’632 patent, which follows:

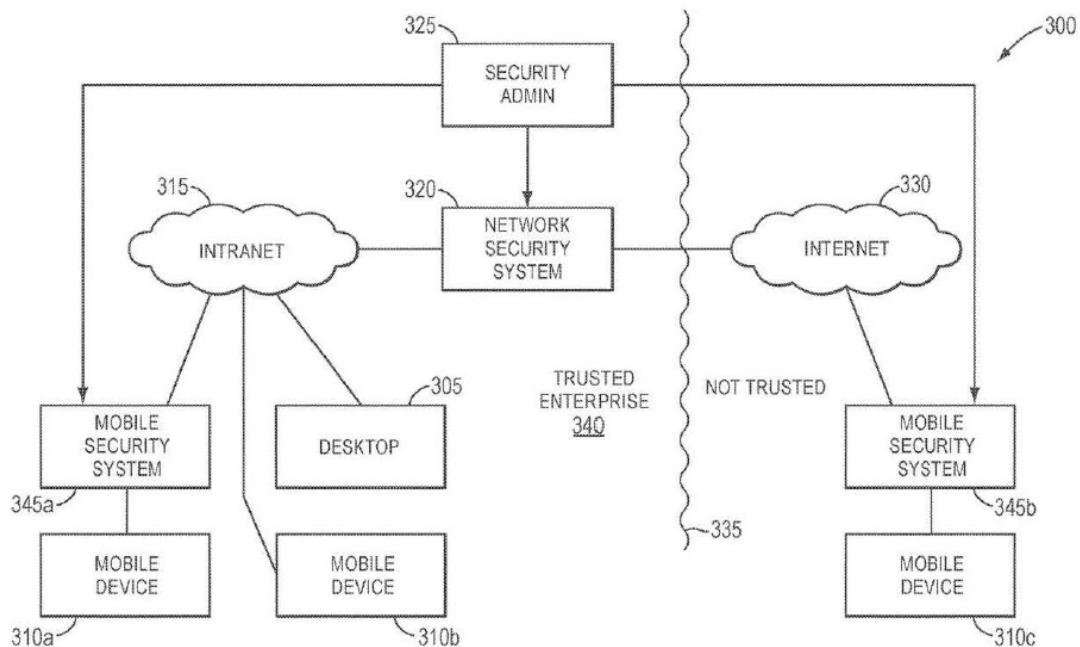


FIG. 3

Figure 3 of the ’632 patent is a block diagram of a network system. Ex. 1101, 5:53–54. Network system 300 includes desktop 305, first mobile device 310a, and second mobile device 310b. *Id.* at 5:54–56. First mobile device 310a is within trusted enterprise network 340 and is coupled to the enterprise’s intranet 315 via mobile security system 345a. *Id.* at 5:56–59. Figure 3 further shows mobile device 310c that has travelled outside trusted enterprise network 340 and is coupled to untrusted internet 330 via mobile

security system 345b. *Id.* at 6:3–5. This mobile device may be in use by an employee of trusted enterprise network 340 who is currently on travel. *Id.* at 6:6–7. Security administrator 325 manages mobile security systems 345a and 345b and network security system 320 to assure that they include the most current security protection. *Id.* at 6:7–11.

The '632 patent also describes a wake module configured to wake a mobile device from a power management mode. *Id.* at Fig. 18, 21:63–64. According to the patent, a power management mode “is a mode wherein the mobile device conserves power, usually after a predetermined period of inactivity (e.g., no input from a mouse and keyboard).” *Id.* at 21:64–67. “During power management mode, the mobile device may reduce or eliminate power to one or more mobile device components such as a display and/or hard drive.” *Id.* at 21:67–22:3.

C. CHALLENGED CLAIMS

Petitioner challenges claims 1, 7, 9, 16, 22, and 24. Of the challenged claims, claims 1 and 16 are independent. Independent claim 1 is representative and is reproduced below:

1. A security system, comprising:
security system memory;
a communication interface configured to communicate with a mobile device and configured to communicate over a network with a security administrator device, the mobile device including a mobile device processor and including a security agent configured to cooperate with the security system, the security administrator device having a security administrator processor different than the mobile device processor, the mobile device being remote from the security administrator device, the mobile device being a first computer system, the security system being a second computer system, the security

administrator device being a third computer system, the first computer system, the second computer system and the third computer system being separate computer systems; and

a security system processor being different than the mobile device processor and different than the security administrator processor, the security system processor being configured to:

store in the security system memory at least a portion of wake code, the wake code being configured to detect a wake event and to send a wake signal to the mobile device in response to detecting the wake event, the security agent of the mobile device being configured to receive the wake signal, the security agent of the mobile device being configured to wake at least a portion of the mobile device from a power management mode in response to receiving the wake signal, the security agent of the mobile device being configured to perform security services after the at least a portion of the mobile device has been woken;

detect a particular wake event;

prepare a particular wake signal in response to detecting the particular wake event; and

send the particular wake signal to the mobile device in response to detecting the particular wake event, the security agent of the mobile device being configured to wake the at least a portion of the mobile device in response to receiving the particular wake signal and being configured to perform particular security services after the at least a portion of the mobile device has been woken.

Ex. 1101, 31:15–59.

D. ASSERTED GROUNDS OF UNPATENTABILITY

Petitioner asserts the following grounds of unpatentability. Pet. 4.

Reference(s)	Basis	Challenged Claims
Gordon, ¹ Gardner, ²	§ 103	1, 7, 9, 16, 22, 24
Gordon, Gardner, Chang ³	§ 103	7, 22
Gordon, Gardner, Meenan ⁴	§ 103	9, 24

III. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 325(d)

Patent Owner argues we should deny institution under 35 U.S.C.

§ 325(d) “because the Petition relies on the same art or substantially similar art that was previously presented to the Patent Office.” Prelim. Resp. 20. In evaluating arguments under § 325(d), we use a two-part framework: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of the first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential). We must also consider the non-exclusive factors set forth in *Becton, Dickinson and Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential in relevant

¹ U.S. 7,818,803 B2, Oct. 19, 2010 (Ex. 1107, “Gordon”).

² U.S. 2006/0272020 A1, Pub. Nov. 30, 2006 (Ex. 1108, “Gardner”).

³ U.S. 2011/0264931 A1, Pub. Oct. 27, 2011 (Ex. 1109, “Chang”).

⁴ U.S. 2006/0101277 A1, Pub. May 11, 2006 (Ex. 1111, “Meenan”).

part), which “provide useful insight into how to apply the framework” under § 325(d). *Advanced Bionics*, Paper 6 at 9. Those non-exclusive factors include:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;
- (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson, Paper 8 at 17–18. “If, after review of factors (a), (b), and (d), it is determined that the same or substantially the same art or arguments previously were presented to the Office, then factors (c), (e), and (f) relate to whether the petitioner has demonstrated a material error by the Office.”

Advanced Bionics, Paper 6 at 10. For the reasons given below, we are not persuaded to exercise our discretion to deny the Petition based on § 325(d).

Patent Owner contends “[t]he first prong of *Advanced Bionics* is satisfied here” because “[t]he Patent Office considered *Gordon* as well as the ’595 [patent] FWD.” Prelim. Resp. 21 (citing Ex. 1102, 39, 49, 187, 258). Patent Owner points to an information disclosure statement (IDS) citing both *Gordon* and the ’765 IPR Final Written Decision, and bearing the Examiner’s initials. *Id.* at 22. Patent Owner contends that “[since] *Gordon*,

and arguments from the related IPR proceeding concerning *Gordon*, were previously considered by the Office, the first prong of *Advanced Bionics* is satisfied.” *Id.* at 22.

Anticipating Patent Owner’s argument, Petitioner asserts that “although Patent Owner cited the *Gordon* prior art reference in an IDS (buried among over 220 other references) in the ’632 patent file history, the examiner made no rejection based on *Gordon*.” Pet. 61 (citation omitted). Petitioner continues, “[i]n fact, the examiner made no substantive claim rejection whatsoever, even after being provided with the Board’s Institution Decision and Final Written Decision from IPR2019-00765 (regarding the ’595 patent).” *Id.* at 61–62. Petitioner further asserts that “although Patent Owner provided the ’632 patent examiner with the Final Written Decision from the ’595 patent IPR, Patent Owner did so only after the examiner had issued four different notices of allowance for the ’632 patent claims.” *Id.* at 62 (citing Ex. 1102, 149–151, 121–122, 88–89, 76–77, 48–49). Petitioner remarks that in response to this citation, “the examiner merely cited his comments from the first notice of allowance.” *Id.* (citing Ex. 1102, 13–18). Finally, Petitioner argues that “[r]egardless of what Patent Owner disclosed to the examiner, the examiner clearly erred in issuing the ’632 patent claims.” *Id.*

We agree with Patent Owner (and Petitioner does not dispute) that *Gordon* was cited to the Examiner of the ’632 patent in an IDS. Pet. 61; Prelim. Resp. 21. Because *Gordon* was cited to the Examiner, and in view of Patent Owner’s argument that it was “considered,” we now turn to the second part of the *Advanced Bionics* framework and evaluate *Becton*, *Dickinson* factors (c), (e), and (f), to determine whether Petitioner has

demonstrated that the Office erred in a manner material to the challenged claims' patentability. *Advanced Bionics*, Paper 6 at 7–11.

As stated above, under factor (c) we consider “the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection.” We find this factor does not favor exercising our discretion to deny the Petition. There is no dispute that the examiner did not apply Gordon in rejecting any claims of the '632 patent or discuss Gordon in the examiner's comments or reasons for allowance.

Nor are we persuaded to deny institution because our Final Written Decision in the '765 IPR, involving the '595 patent and citing Gordon, was cited to the examiner in an IDS. The IDS citing the Final Written Decision for the '765 IPR was submitted by the applicant (without any discussion or explanation) *after* the examiner had allowed the application for the '632 patent, and was neither discussed nor cited by the examiner in the subsequent reasons for allowance. There is nothing in the prosecution history to suggest that the Board's reasoning was ever applied by the examiner, and the record is silent on the extent to which the '765 IPR Final Written Decision was actually evaluated by the examiner.

Factor (e) asks “whether Petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art.” Petitioner's argument is that “the examiner clearly erred in issuing the '632 patent claims” over Gordon. Pet. 62. We agree. Our own analysis of the challenged claims of the '632 patent in light of Gordon persuades us that the examiner erred in not appreciating the significance of that reference. Specifically, despite the citations to Gordon and the '765 Final Written

Decision, the examiner's reason for allowance⁵ adopts the reasoning of the examiner of the '595 patent, recites several claim elements, and concludes that "the closest prior art still fails to teach" those elements. Ex. 2101, 154–155. This conclusion by the examiner is erroneous, as demonstrated by our findings to the contrary in the '765 IPR based on Gordon, and our analysis of Gordon *infra*.

Becton, Dickinson factor (f) considers "the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments." Patent Owner emphasizes that Petitioner's positions in this case concerning Gordon's architecture are "inconsistent" with the positions Petitioner took in earlier '765 IPR in which it relied on Gordon to challenge the '595 patent. Prelim. Resp. 32–34. We see no reason, however, to fault Petitioner for reading the two different sets of claims differently on the same prior art reference, so long as the claims' language and the reference's disclosures support those readings. For the reasons identified in the '765 IPR and as explained below, that is the case here. Thus, we conclude that *Becton, Dickinson* factor (f) does not favor exercising our discretion to deny the Petition.

In sum, we are persuaded of material error by the examiner in overlooking Gordon's significance. Based on our consideration of the record in light of the *Becton, Dickinson* factors, we decline to exercise our discretion to deny institution under section 325(d).⁶

⁵ The examiner's final notice of allowance refers back to the prior notice of allowability dated December 27, 2019, for "full" reasons of allowance. Ex. 1002, 17.

⁶ Because of our conclusion regarding Gordon, we determine that section 325(d) is not sufficiently implicated, and we do not address Patent Owner's

IV. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 314(a)

A. DENIAL BASED ON MULTIPLE PETITIONS

Petitioner filed two IPRs and two PGRs challenging the '632 patent. In this case and in PGR2021-00101, Petitioner challenges claims 1, 7, 9, 16, 22, and 24. In IPR2021-01236 and PGR2021-00100, Petitioner challenges claims 1, 9, 16, and 24. Patent Owner contends that the Board should exercise its discretion under 35 U.S.C. § 314(a) to deny the Petition “because two PGR and two IPR petitions are not necessary nor proper.” Prelim. Resp. 10.

For its part, Petitioner maintains that there are material differences between the two IPR petitions that warrant granting both. Paper 13, 1–4. For example, Petitioner points out that the two IPR petitions “use different prior art references . . . that present different material issues.” *Id.* at 2. Also, “the various prior art references disclose certain claim limitations in materially different ways.” *Id.* Petitioner asserts also that it could not have adequately addresses the two petition’s three principal references (Joseph,⁷ Hall,⁸ and Gordon) in just one petition. *Id.* at 5. As to the two PGRs, which Petitioner admits are “substantively duplicative of the IPR petitions” (Paper 13, 2), Petitioner explains that they were filed “out of an abundance of caution,” in case the Board were to decide that the '632 patent is an “AIA patent.” *Id.* at 1–2.

Concurrently with this Decision, the Board is issuing decisions in PGR2021-00100 and PGR2021-00101, denying the petitions in those cases

argument that Gardner is “substantially the same and cumulative to *Gordon*.” Prelim. Resp. 22.

⁷ U.S. Patent App. Pub. No. 2010/0218012 (Ex. 1009, “Joseph”).

⁸ U.S. Patent App. Pub. No. 2008/0120423 (Ex. 1007, “Hall”).

because the '632 patent is a pre-AIA patent and thus not eligible for post-grant review. As to the two remaining IPRs, we find Petitioner's approach—using two different petitions to present substantively distinct challenges—is not unreasonable. In particular, two petitions is enough for Petitioner to clearly lay out three substantively distinct challenges based on three different primary prior-art references, while not overly burdening the Board. We therefore decline to exercise our discretion to deny institution.

B. DENIAL BASED ON FINTIV

In addition to its argument for discretionary denial based on multiple petitions, Patent Owner contends the Board should deny the Petition under § 314(a) “given the advanced state of the parallel district court litigation” in the Northern District of Texas. Prelim. Resp. 13. For the reasons that follow, we decline to exercise our discretion to deny the Petition on that basis.

The Board's precedential decision in *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”), identifies a non-exclusive list of factors parties may consider addressing where there is a related, parallel district court action to determine whether such action provides any basis for discretionary denial. *Fintiv*, Paper 11 at 5–16. Those factors include:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;

5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Id. at 5–6.

In evaluating the factors, we take “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.* at 6.

1. Factors 1 and 2

As Patent Owner acknowledges, the projected trial date of November 7, 2022, in the Northern District of Texas litigation involving the '632 patent is approximately two months before the statutory deadline for the final written decision. Prelim. Resp. 15. Neither party has requested a stay of the Texas litigation. However, Petitioner asserts that after institution the district court “likely will enter a stay.” Pet. 63 (citing Ex. 1112). We do not speculate about the likelihood of a stay, but we find that given the close proximity of the projected trial date to the final written decision due date, and the uncertainties of projected trial dates in general, on balance these factors at most weigh only slightly in favor of exercising our discretion to deny the Petition.

2. Factors 3 and 4

Patent Owner argues that “[t]he parallel litigation proceeding is already at an advanced state and has seen significant investment by the parties and the court.” Prelim. Resp. 17. Patent Owner advises us that the Northern District of Texas case involving the '632 patent has been consolidated with an earlier-filed case. *Id.* In that earlier case there have been “numerous” discovery requests and responses and invalidity and

infringement contentions have been served. *Id.* Finally, Patent Owner advises us that the district court has issued claim construction orders. Paper 15, 1.

Other than citing the claim construction orders by the district court and service of preliminary discovery requests and responses, Patent Owner does not support its contention that “[t]he parallel litigation proceeding is already at an advanced state.” Prelim. Resp. 17. Moreover, Petitioner has been reasonably diligent, filing the Petition “less than three months after Patent Owner filed the amended complaint asserting the ’632 patent.” Pet. 63. We conclude that this factor does not favor exercising our discretion to deny institution.

Furthermore, citing *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18–19 (PTAB Dec. 1, 2020) (precedential in relevant part), Petitioner stipulates that “if the Board institutes IPR, Petitioner will not pursue in the district court litigation any ground of invalidity of the ’632 patent that was raised or that could have been reasonably raised in an IPR.” Pet. 65. Patent Owner criticizes this as stipulation as “not sufficient when weighed against the other factors.” Prelim. Resp. 19. Patent Owner tries to distinguish *Sotera* on the basis that in *Sotera*, there was “a relatively limited investment in the parallel proceeding and the district court trial was scheduled to begin around the time of the projected final written decision.” *Id.*

We do not agree with Patent Owner’s argument regarding these facts supposedly distinguishing *Sotera*. In *Sotera*, as here, “much other work remain[ed] in the parallel proceeding as it relates to invalidity.” *Sotera*, Paper 12 at 16. Specifically, here, as in *Sotera*, “fact discovery is

ongoing, expert reports are not yet due, and substantive motion practice is yet to come.” *Id.* Thus, we conclude, as did the Board in *Sotera*, that “although the parties and the District Court have invested some effort in the parallel proceeding to date, further effort remains to be expended in this case before trial.” *Id.*

We are persuaded that the *Sotera* stipulation here is sufficient to mitigate any overlap in the proceedings and weighs strongly in favor of institution. Overall, we conclude that these factors weigh in favor of not exercising our discretion to deny institution.

3. Factor 5

Neither party disputes that Petitioner and Patent Owner are parties to the district court proceeding. To the extent that the district court trial proceeds as scheduled, this factor favors exercising our discretion to deny institution

4. Factor 6

Patent Owner contends “Petitioner’s case lacks substantive merit.” Prelim Resp. 20. We disagree. We have considered the merits of the Petition and determined that they more than meet the standards for institution of *inter partes* review. We have previously decided, in the ’765 IPR, that similar claims are unpatentable in light of Gordon. At this stage, we regard the changes Patent Owner has made in the claims we previously reviewed to be insufficient to avoid obviousness over Gordon. Thus, the merits of this case appear to be strong and therefore, we find that this factor does not favor denying institution.

5. Summary and Conclusion

We have considered the circumstances and facts before us in view of the *Fintiv* factors. For the reasons given, we are not persuaded to exercise our discretion to deny institution.

V. ANALYSIS

A. LEVEL OF SKILL IN THE ART

Petitioner contends “[a] person of ordinary skill in the art at the time of the alleged invention of the ’632 patent (i.e., August 4, 2008) . . . would have had a bachelor’s degree in computer science, electrical engineering, or a comparable field of study, plus at least two years of professional experience with computer security systems, or the equivalent.” Pet. 13.

At this stage, Patent Owner does not provide a description of the person of ordinary skill.

Petitioner’s description is consistent with the prior art and patent specification before us and is supported by credible expert testimony. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (prior art itself may reflect an appropriate level of skill). For the purpose of our decision, we adopt Petitioner’s description.

B. CLAIM CONSTRUCTION

In an *inter partes* review, we construe patent claims using the same claim construction standard that as in a civil action under 35 U.S.C. § 282(b), including construing the claims in accordance with the ordinary and customary meaning of such claims as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. 37 C.F.R. § 42.100(b); *see also Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–14 (Fed. Cir. 2005). We construe claim terms only as relevant to the parties’

contentions and only to the extent necessary to resolve issues in dispute. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999); *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Matal*, 868 F.3d 1013, 1017 (Fed. Cir. 2017).

1. “power management mode”

This term has been construed in the '765 IPR and in district court litigation involving the '595 patent as “a mode where the mobile device conserves power.” Pet. 13–14; Prelim. Resp. 26–27. There is no dispute over this construction. *Id.* The construction is supported by the '632 patent specification. *See* Ex. 1101, 21:62–64 (“A power management mode is a mode wherein the mobile device conserves power.”). We agree with this construction and adopt it for this decision.

2. “security administrator device”

Petitioner contends “[t]he plain and ordinary meaning of this term includes a device that performs security administration.” Pet. 14 (citing Ex. 1101 (“Jakobsson Decl.”) ¶ 65). Petitioner asserts that “[t]his is consistent with the '632 patent’s disclosure that the security administrator device 325 may perform various security administration tasks.” *Id.* Patent Owner responds that “[t]he plain and ordinary meaning of the term in light of the '632 Patent Specification is a device that manages security of a security system.” Prelim. Resp. 27. Patent Owner continues, “the specification describes that the security administration device ‘manages the mobile security system 345(a), the mobile security system 345(b), and the network security system 320.’” *Id.* (citing Ex. 1101, 6:8–10).

At this stage we are more persuaded by Petitioner’s construction. Petitioner’s construction is consistent with the term’s plain language as well

as the specification and is supported by expert testimony. *See* Jakobsson Decl. ¶ 65 (“The plain and ordinary meaning of this term includes a device that performs security administration. This is consistent with the ’632 patent’s disclosure that the security administrator device 325 may perform various security administration tasks.”) *See, e.g.*, Ex. 1101, 24:55–57 (describing security administrator 325 as an “administrator device”).

C. DESCRIPTION OF PRINCIPAL PRIOR ART REFERENCE (GORDON, EX. 1107)

Gordon is a patent titled “Security Module Having a Secondary Agent in Coordination with a Host Agent.” Ex. 1107, code (54). Figure 1 of Gordon, annotated by Petitioner, is reproduced below.

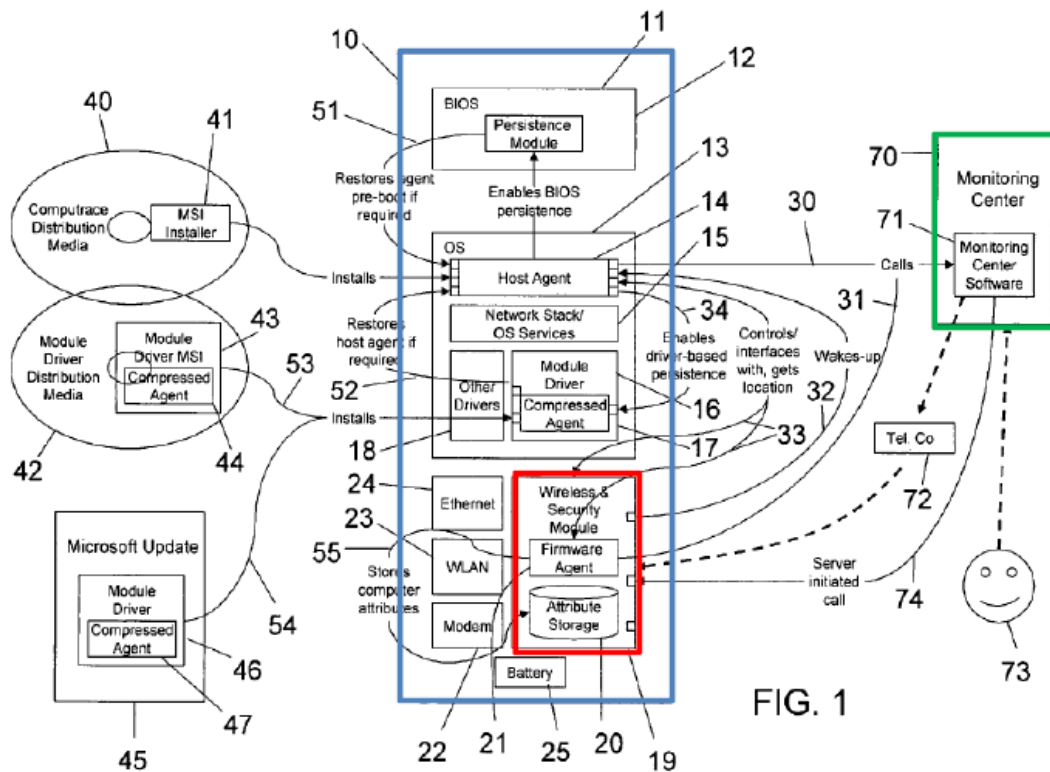


Figure 1 of Gordon (annotated by Petitioner) is a schematic functional block diagram showing protected host device 10 (e.g., a laptop computer) with security module 19 (outlined in red). Ex. 1107, 6:14–16, 14:1. The security

module includes firmware agent 21 connected to the host. *Id.* at 14:45–46. The laptop and wireless security module also communicate with monitoring center 70 via a wireless connection. *Id.* at Fig. 2, 5:7–12, 15:12–15.

D. OBVIOUSNESS ANALYSIS

1. Obviousness of Claims 1, 7, 9, 16, 22, and 24 based on Gordon and Gardner

Petitioner contends claims 1, 7, 9, 11, 16, 22, and 24, would have been obvious over Gordon and Gardner. Pet. 18–49. Based on Petitioner’s analysis and for the reasons explained below, we find Petitioner has, at this stage, demonstrated a reasonable likelihood of prevailing on this challenge.

a. Petitioner’s Proffered Combination

Petitioner identifies Gordon’s host monitoring system C and monitoring center 70 as the claimed “security system.” *Id.* at 19–22. For the claimed “security system memory,” Petitioner asserts Gordon’s monitoring system includes a monitoring server 3 that is a physical computer, which “inherently and necessarily has a memory.” *Id.* at 22–23. Petitioner identifies Gordon’s laptop computer A3 as the claimed “mobile device.” *Id.* at 24. Petitioner explains further that Gordon refers to Gardner, and that Gardner discloses additional detail about host monitoring system C, including a “‘web-based or network based console’ . . . that remotely accesses the host monitoring system C.” *Id.* at 25 (quoting Jakobsson Decl. ¶ 84). Petitioner corresponds Gardner’s network-based console to the claimed “security administrator device.” *Id.* According to Petitioner, it would have been obvious to combine the Gardner’s administrator consoles with Gordon’s system “such that ‘authorized administrators’ could use the consoles to access data in ‘host monitoring system C’ over a network, as Gardner discloses.” *Id.* Moreover, Petitioner asserts, “[m]otivation to do so

arises from the fact that Gardner describes the administrator consoles as an extension of the same ‘host monitoring system C’ that is in Gardner.” *Id.* at 26 (citing Ex. 1108 ¶ 57, Fig. 1; Ex. 1107, Fig. 5).

Petitioner contends that together, Gordon’s security module 19 and host agent 14 are the claimed “security agent.” *Id.* at 29–32. Petitioner explains that Gordon’s monitoring center 70 (the claimed security system) includes the claimed “wake code” that “detect[s] a wake event” because Gardner describes that “the monitoring center may . . . indicate that the firmware agent should wake-up the host.” *Id.* at 35–36 (quoting Ex. 1107, 4:58–63). Gordon discloses that the monitoring center 70 sends wake signals in response to detected wake events (as the challenged claims require) because “the monitoring center may send a wake signal if it receives a response to a call from the laptop’s firmware agent 21 instead of the host agent 14.” *Id.* at 36 (citing Ex. 1107, 16:23–17:9, Fig. 4). “In this scenario,” Petitioner explains, “the receipt of the return call from the firmware agent would be a detected wake event because it triggered the monitoring center to send a wake-up signal.” *Id.* at 36–37.

Patent Owner raises several arguments contesting Petitioner’s challenge. We discuss those arguments below.

b. Petitioner’s Alleged Inconsistencies

Patent Owner’s principal argument is that Petitioner utilizes Gordon’s teachings differently in this Petition than it did in the ’595 IPR. *See* Prelim. Resp. 32–34, 38–39, 41–42. We disagree that Petitioner’s approach is problematic. Patent Owner offers no reason why Petitioner must apply the same analysis to these claims as it did when applying the same reference to different claims of the ’595 patent. We see nothing untoward in Petitioner

presenting a different analysis here, so long as the different claim language and the reference's disclosures support that analysis.

c. Security System's Wake Signal and Wake Event

Independent claim 1 requires “the security system processor being configured to: store in the security system memory at least a portion of wake code, the wake code being configured to detect a wake event and to send a wake signal to the mobile device in response to detecting the wake event.” Claim 16 recites a similar limitation. As noted above, Petitioner asserts that Gordon's monitoring center 70 (the claimed security system) includes the claimed wake code that detects a wake event and wakes up the host in response. *See* Pet. 19–21. Patent Owner contends that Petitioner argument fails because Gordon's firmware agent of security module 19—which is located on the mobile device and not in the monitoring center as the claims require—sends wake-up signals in response to wake events. *See* Prelim. Resp. 35–37. According to Patent Owner, “the monitoring device does not send a wake signal to the host, rather it sends a message to the firmware agent that, operating independently of the now inactive host, detects the message and sends wake-up commands to the host.” *Id.* at 38 (emphasis omitted).

We disagree with Patent Owner's argument because nothing in the wake-signal/wake-event limitations require the security system (here, Gordon's monitoring device) to act alone, without employing Gordon's firmware agent. As Petitioner explains, Gordon discloses that “the monitoring center may, for example, indicate that the firmware agent should wake-up the host.” Ex. 1107, 4:58–63. Thus, the monitoring center sends a

wake signal to the host as claimed, even if it ultimately relies on an outside entity (the firmware agent) to implement the wake signal.

On the current record, for the reasons given, Petitioner demonstrates sufficiently that Gordon teaches the claimed security system's wake event and wake signal.

d. Security Agent

Independent claims 1 and 16 require a “security agent of the mobile device” configured to perform certain functions. As noted above, Petitioner contends that together, Gordon's security module 19 and host agent 14 are the claimed “security agent.” Pet. 29–32. Patent Owner argues that Gordon's security module 19 and host agent 14 cannot be the claimed security agent because each of those modules operates independently on its own processor. Prelim. Resp. 40–41. This, Patent Owner asserts, is in contrast to the '632 patent's Figure 19, which depicts multiple modules (agent module 1904 and component manager 1906) as part of a single security agent 1902 of mobile device 1900. *Id.* at 39. “In other words, the agent module's and component module's instructions are located within the security agent's program and are executed by the mobile device's processor.” *Id.* at 40.

We disagree with Patent Owner's argument because it imposes a limitation—requiring the security agent to operate on a single processor—that the claims do not recite. In addition, even if Patent Owner is correct that the '632 patent's Figure 19 depicts a single security agent on a mobile device, Patent Owner has not explained why such a configuration precludes multiple processors.

On the current record, for the reasons given, Petitioner demonstrates sufficiently that Gordon teaches the claimed security agent.

e. Security Administrator Device

Independent claims 1 and 16 require “a security administrator device” configured to perform certain functions. As noted above, Petitioner corresponds Gardner’s network-based consoles to the claimed security administrator device. Pet. 25. Patent Owner contends that Petitioner argument fails because “Gardner’s computer consoles do *not* manage the security of a security system,” but instead “merely provide access to information through inputs and outputs.” Prelim. Resp. 43.

We do not agree with Patent Owner’s argument because it is based on a construction of “security administrator device” that we did not adopt for this decision. We, instead, adopted Petitioner’s construction—i.e., a security administrator device “includes a device that performs security administration.” Pet. 11 (citing Jakobsson Decl. ¶ 65). As Petitioner explains, Gardner discloses that its console “is used by ‘authorized administrators’ for the administrative purposes of accessing ‘location and asset related data.’” *Id.* at 25 (quoting Ex. 1107). Under our construction, Gardner’s console is a security administrator device because it performs administrative tasks such secure asset tracking and securing devices in the event of theft, tampering, or loss. *See* Pet. 25; Ex. 1107 ¶¶ 59, 56, 60, 191.

We conclude that Petitioner sufficiently demonstrates that Gardner discloses the claimed security administrator device.

f. Uncontested Limitations

As for the remaining limitations of claims 1, 7, 9, 16, 22, and 24, Petitioner provides a detailed analysis of Gordon’s and Gardener’s

disclosures that teach every element of the challenged claims. Pet. 18–49. Other than as discussed above, Patent Owner does not additionally challenge Petitioner’s analysis in its Preliminary Response. We have reviewed Petitioner’s arguments and the underlying evidence cited in support and are persuaded that, at this stage, Petitioner sufficiently demonstrates that claims 1, 7, 9, 16, 22, and 24 would have been obvious over Gordon and Gardner.

2. Obviousness of Claims 7 and 22 based on Gordon, Gardner and Chang, and Claims 9 and 24 based on Gordon, Gardner, and Meenan

Petitioner contends claims 7 and 22 would have been obvious over Gordon, Gardner and Chang. Pet. 49–55. Petitioner further contends claims 9 and 24 would have been obvious over Gordon, Gardner and Meenan. *Id.* at 55–61. Other than as discussed above, Patent Owner does not additionally challenge Petitioner’s analysis in its Preliminary Response. We have reviewed Petitioner’s arguments and the underlying evidence cited in support and are persuaded that at this stage, Petitioner has made a sufficient showing for these two additional grounds.

VI. CONCLUSION

For the foregoing reasons, we have determined that there is a reasonable likelihood that the Petitioner would prevail with respect to at least one of the claims challenged in the Petition. We therefore institute trial as to all challenged claims on all grounds stated in the Petition. We decline also to exercise our discretion to deny institution under 35 U.S.C. § 314(a) or § 325(d).

VII. ORDER

Accordingly, it is:

ORDERED that *inter partes* review of claims 1, 7, 9, 16, 22, and 24 of the '632 patent is instituted on all grounds in the Petition;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; the trial will commence on the entry date of this decision.

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