

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

BILLJCO LLC,
Patent Owner.

IPR2022-00426
Patent 8,761,804 B2

Before THU A. DANG, LYNNE H. BROWNE, and GARTH D. BAER,
Administrative Patent Judges.

BAER, *Administrative Patent Judge.*

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

I. INTRODUCTION

A. BACKGROUND

Apple Inc. (“Petitioner”)¹ filed a Petition (Paper 4, “Pet.”) requesting an *inter partes* review of claims 1 and 10–12 (“the challenged claims”) of U.S. Patent No. 8,761,804 B2 (Ex. 1001, “the ’804 patent”). BillJCo, LLC (“Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.”) to the Petition. Pursuant to 35 U.S.C. § 314, we instituted this *inter partes* review as to all of the challenged claims and all grounds raised in the Petition. Paper 16 (“Institution Dec.”).

Following institution, Patent Owner filed a Response. Paper 28 (“PO Resp.”). Petitioner filed a Reply to Patent Owner’s Response (Paper 34, “Pet. Reply”), and Patent Owner filed a Sur-reply (Paper 36, “PO Sur-reply”). On April 14, 2023, we held an oral hearing. A transcript of the hearing is included in the record. Paper 40.

We have jurisdiction under 35 U.S.C. § 6. This decision is a Final Written Decision issued pursuant to 35 U.S.C. § 318(a). For the reasons we discuss below, we determine that Petitioner has proven by a preponderance of the evidence that claims 1 and 10–12 are unpatentable.

B. RELATED PROCEEDINGS

The parties indicate that the ’804 patent is the subject of the following district court cases: *BillJCo, LLC v. Apple Inc.*, No. 6:21-cv-00528 (W.D. Tex.); *BillJCo, LLC v. Cisco Systems, Inc.*, No. 2:21-cv-00181 (E.D. Tex.)

¹ Cisco Systems, Inc., Hewlett Packard Enterprise Co., and Aruba Networks, LLC were originally parties to this proceeding, but have now been terminated. Paper 14; Paper 25.

(“ED Litigation”); and *BillJCo, LLC v. Hewlett Packard Enterprise Company*, No. 2:21-cv-00183 (E.D. Tex.). Pet. 1; Paper 6, 2.

C. REAL PARTY IN INTEREST

The parties identify themselves as the real parties in interest. Pet. 1; Paper 6, 2.

D. THE ’804 PATENT

The ’804 patent “relates generally to location based services for mobile data processing systems, and more particularly to location based exchanges of data between distributed mobile data processing systems for locational applications.” Ex. 1001, 1:20–24. The ’804 patent’s claims recite a “sending data processing system,” that accesses four types of information associated with the sending data processing system: “identity information,” “application information,” “location information,” and “reference information.” *Id.* at 117:60–118:7. The four types of accessed information are combined into a “broadcast unidirectional wireless data record” that the sending data processing system transmits to “receiving mobile data processing systems in a wireless vicinity of the sending data processing system.” *Id.* at 118:24–52.

E. CHALLENGED CLAIMS

Of the challenged claims, claim 1 is independent. Claim 1 is reproduced below.

1. A method by a sending data processing system, the method comprising:

accessing, by the sending data processing system, identity information for describing an originator identity associated with the sending data processing system;

accessing, by the sending data processing system, application information for an application in use at the sending data processing system;

accessing, by the sending data processing system, location information associated with the sending data processing system;

accessing, by the sending data processing system, reference information for further describing the location information associated with the sending data processing system;

preparing, by the sending data processing system, a broadcast unidirectional wireless data record including:

the identity information for describing the originator identity associated with the sending data processing system,

the application information for the application in use at the sending data processing system,

the location information associated with the sending data processing system, and

the reference information for further describing the location information associated with the sending data processing system;

maintaining, by the sending data processing system, a configuration for when to perform beaconing of the broadcast unidirectional wireless data record; and

transmitting, by the sending data processing system, the broadcast unidirectional wireless data record for receipt by a plurality of receiving mobile data processing systems in a wireless vicinity of the sending data processing system wherein the broadcast unidirectional wireless data record is beaconed by the sending data processing system in accordance with the configuration for when to perform beaconing, and wherein the broadcast unidirectional wireless data record includes at least:

the identity information for describing the originator identity associated with the sending data processing system wherein the identity information is for an alert determined by each receiving mobile data processing system of the plurality of receiving mobile data processing systems that the each receiving mobile data processing system is in the wireless vicinity of the sending data processing system,

the application information for the application in use at the sending data processing system,

the location information associated with the sending data processing system to be used by the each receiving mobile data processing system for determining their own location relative to the location information, and

the reference information for further describing the location information associated with the sending data processing system for describing to the each receiving mobile data processing system useful information associated with the sending data processing system.

Ex. 1001, 117:60–118:52.

F. ASSERTED GROUNDS OF UNPATENTABILITY

Petitioner asserts the following grounds of unpatentability. Pet. 15.

Claims Challenged	35 U.S.C. § ²	References/Basis
1, 10–12	103	Himmelstein ³ , Myr ⁴
1, 10–12	103	Himmelstein, Myr, Evans ⁵

II. PRELIMINARY MATTERS

A. LEVEL OF ORDINARY SKILL

Petitioner argues that a person of ordinary skill in the art would have had “a bachelor’s degree in computer science, computer engineering, or an equivalent, as well as two years of professional experience, and a POSITA would have had a working knowledge of hardware and software for location

² Because the challenged claims of the challenged patent have an effective filing date before March 16, 2013, we apply the pre-AIA (“America Invents Act”) version of § 103. Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011).

³ U.S. 7,123,926 B2, Oct. 17, 2006 (Ex. 1005, “Himmelstein”).

⁴ U.S. 2003/0014181 A1, published Jan. 16, 2003 (Ex. 1006, “Myr”).

⁵ U.S. 6,327,535 B1, Dec. 4, 2001 (Ex. 1007, “Evans”).

tracking of mobile devices,” and that “[l]ack of work experience can be remedied by additional education and vice versa.” Pet. 8 (citing Ex. 1004 ¶ 34). Patent Owner does not contest Petitioner’s description. PO Resp. 13. We adopt Petitioner’s description as it is consistent with the prior art and patent specification before us and 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).

B. CLAIM CONSTRUCTION

In an *inter partes* review, the claims of a patent shall be construed using the same claim construction standard that would be used to construe the claims in a civil action under 35 U.S.C. § 282(b), 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). Under that standard, and absent any special definitions, we give claim terms their ordinary and customary meaning, as would be understood by one of ordinary skill in the art at the time of the invention. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). We construe claim terms only as relevant to the parties’ contentions and only to the extent necessary to resolve the 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.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017).

1. Beacon

This term appears in several forms (i.e., “beaconing” and “beaconed”) in claim 1. Citing several extrinsic dictionary definitions, Patent Owner

contends beaconing means more than just simply transmitting, but rather transmitting with the intent of locating the transmitter. PO Resp. 15–17. Petitioner argues the term’s ordinary meaning is not limited to locating, and no further express construction is needed. Pet. Reply 2–5.

We agree with Petitioner. The ’804 patent’s specification equates beaconing with a simple periodic broadcast. *See* Ex. 1001, 113:35–56 (explaining that “[s]ervice(s) associated with antennas periodically broadcast (beacon) their reference whereabouts . . . for being received by MSs in the vicinity”); *id.* at 29:66–67 (describing “a continuous, or pulsed, broadcast or beaconing by the antenna”). Moreover, Patent Owner’s construction is problematic because claim 1 already has language that accounts for the location-related features that Patent Owner seeks to add through its claim construction. Specifically, claim 1 requires that the beacons broadcast includes “location information associated with the sending data processing system to be used by the each receiving mobile data processing system for determining their own location relative to the location information and the reference information for further describing the location information associated with the sending data processing system.” Ex. 1001, 118:43–49. To the extent Patent Owner seeks to change the location-related features to something different from what the claim expressly recites, we decline to do so. We agree with Petitioner that no additional express construction is necessary to determine patentability.

2. "transmitting . . . the broadcast unidirectional wireless data record for receipt by a plurality of receiving mobile data processing systems in a wireless vicinity of the sending data processing system"

This language appears in claim 1. Patent Owner asserts we should construe this term to preclude a defined network of devices, and to require transmission *directly* to the wireless devices in the vicinity of the sending data processing system. PO Resp. 19. Petitioner argues the term's ordinary meaning does not preclude a defined network of devices, and no further express construction is needed. Pet. Reply 2, 5–6. We agree with Petitioner. As Petitioner notes, nothing in the disputed claim language precludes a defined network of devices and the '804 patent's specification expressly describes "locating as many MSs as possible *in a wireless network*." Pet. Reply 6 (quoting Ex. 1001, 4:42–44 (emphasis added)). Likewise, neither the at-issue claim language nor the specification precludes a transmission to the receiving system through an intermediary. Thus, we decline to limit this term to direct transmissions, as Patent Owner suggests. We agree with Petitioner that no additional express construction is necessary to determine patentability.

C. SUMMARY OF PRIMARY ASSERTED PRIOR ART REFERENCES

1. Himmelstein (Ex. 1005)

Himmelstein discloses "a system and method for providing information to users based on the user's location." Ex. 1005, code (54). Figure 1 is reproduced below.

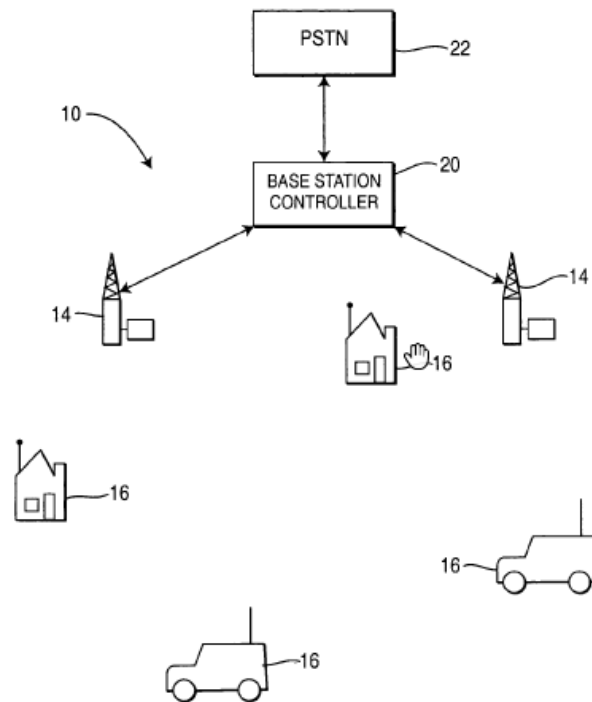


FIG. 1

Figure 1 depicts “a vehicle communication system.” *Id.* at 2:26.

Himmelstein’s “vehicle communication system 10 generally includes one or more base stations 14, each of which is in wireless communication with a plurality of remote units 16.” *Id.* at 2:60–63. “Each mobile unit 16 can communicate with another mobile unit 16, the closest base station 14, or the base station 14 which provides the strongest communication signal.” *Id.* at 2:65–3:1. According to Himmelstein, “[c]ommunications between mobile units 16 . . . are accomplished through a stream of transmitted communication packets.” *Id.* at 4:31–33. These packets include “a plurality of information fields which can be generally categorized by three different functional groups: 1) transmission administrative information 55; 2) sender information 56; and 3) receiver information 57.” *Id.* at 4:52–56.

2. Myr (Ex. 1006)

Myr teaches “[t]he process of collecting and transmitting cell phone position data is well known” and “it is time and cost effective if the data are received in the form of periodic data packets in real time, such as, 1 to 3 minutes.” Ex. 1006 ¶¶ 91–92.

III. UNPATENTABILITY ANALYSIS

A. OBVIOUSNESS OF CLAIM 1

Petitioner argues that claim 1 would have been obvious over Himmelstein and Myr. Pet. 19–49. For the reasons explained below, we find Petitioner has shown by a preponderance of evidence that claim 1 would have been obvious over Himmelstein and Myr.

1. Disputed Elements

Claim 1 requires

maintaining, by the sending data processing system, a configuration for when to perform beaconing of the broadcast unidirectional wireless data record; and transmitting, by the sending data processing system, the broadcast unidirectional wireless data record for receipt by a plurality of receiving mobile data processing systems in a wireless vicinity of the sending data processing system wherein the broadcast unidirectional wireless data record is beaconed by the sending data processing system in accordance with the configuration for when to perform beaconing.

Ex. 1001, 118:21–31. Petitioner relies on Himmelstein for teaching the claimed unidirectional wireless broadcast, and adds Myr for teaching periodic transmission as a time- and cost-effective method of transmission. *See* Pet. 20–21, 41–42.

Specifically, Petitioner explains, “Himmelstein discloses the preparation of communication packet 50, which corresponds to the claimed broadcast unidirectional wireless data record.” *Id.* at 41 (citing Ex. 1004 ¶ 97). Himmelstein further teaches transmitting the communication packet wirelessly from one mobile unit to other units within the sending unit’s wireless vicinity. *Id.* at 41–42 (citing Ex. 1005, 2:65–3:1, 7:16–19, 7:48–52). Although Himmelstein does not teach beaconing its wireless data record in accord with a maintained configuration for when to do so, Petitioner explains that Myr discloses that feature and a skilled artisan would have been motivated to employ Myr’s transmission strategy so that “the sending device [would] only provide the signal at advantageous times and thereby make the most efficient use of the power of the sending device.” *Id.* at 21; *see id.* at 42 (citing Ex. 1006, ¶¶ 92, 96). In contesting obviousness, Patent Owner raises several arguments related to this element. We address these arguments below.

a. “Transmitting . . . The Broadcast Unidirectional Wireless Data Record for Receipt by a Plurality of Receiving Mobile Data Processing Systems in a Wireless Vicinity of the Sending Data Processing System”

Patent Owner argues that Himmelstein does not teach claim 1’s “transmitting” to mobile units because in Himmelstein, all communications are processed through and controlled by a base station (in Himmelstein’s primary embodiment) or a master node (in Himmelstein’s piconet architecture). PO Resp. 26–27. According to Patent Owner, in both of Himmelstein’s embodiments there is no communication directly from one mobile unit to other mobile units “because transmission[s] must be processed

through a central base station controller or ‘master’ device.” *Id.* at 27. We disagree with Patent Owner’s argument for several reasons.

First, Patent Owner’s argument is premised on its construction of “transmitting . . . the broadcast unidirectional wireless data,” which we do not adopt for the reasons explained above in Section II.B.2. In addition, we agree with Petitioner that Himmelstein teaches claim 1’s “transmitting,” even under Patent Owner’s construction—i.e. “the wireless data record . . . is transmitted by the sending data processing system via a unidirectional beacon directly to the wireless devices in the vicinity of the sending data processing system.” PO Resp. 19; *see* Pet. Reply 9–11. Even though, as Patent Owner explains, in Himmelstein’s piconet architecture, “a ‘master’ device would take the place of the base station controller” (PO Resp. 26), nothing in claim 1 precludes using a master device as the sending system. Rather, as Petitioner explains, in Himmelstein’s piconet architecture, “the primary or master device is the ‘sending data processing system’” that can “talk directly to other mobile units,” without an intervening base station. Pet. Reply 11 (quoting Ex. 1005, 7:49–52).

In light of the Petition’s analysis and for the reasons explained above, we agree with Petitioner that Himmelstein’s piconet embodiment teaches “transmitting . . . the broadcast unidirectional wireless data record for receipt by a plurality of receiving mobile data processing system[s],” as claim 1 requires.

b. *Beaconing the Broadcast Unidirectional Wireless Data Record*

Patent Owner also argues that Petitioner’s obviousness challenge fails because Petitioner’s asserted combination does not teach the claimed

“beaconing.” PO Resp. 20–23. Specifically, according to Patent Owner, “[u]nlike a beacon, there is no disclosure in Myr of a signal that is designed to attract attention to a specific location or that is intended to indicate the position of something.” PO Resp. 22. We disagree with Patent Owner’s argument for several reasons.

First, Patent Owner’s argument is premised on its construction of beaconing, which we reject for the reasons explained above in Section II.B1. In addition, we agree with Petitioner that the asserted combination of Himmelstein and Myr teaches beaconing, even under Patent Owner’s construction—i.e. “send[ing] out a radio signal to show the position of something.” PO Resp. 16; *see* Pet. Reply 7–9. As Petitioner explains, Himmelstein teaches transmitting the sending station’s location information, which then “may be used by each receiving mobile data processing system for determining their own location relative to the location information.” Pet. 46; *see* Ex. 1005, 10:26–29. Thus, even if Patent Owner is correct in its characterization of Myr, that argument does not undermine obviousness because it is undisputed that Himmelstein teaches the alleged missing feature from Myr and the only feature Petitioner relies on Myr for is configured, periodic transmission. *See* Pet. 20–21 (explaining that in Himmelstein, “there is no discussion of whether the signal is continuously or periodically beacons out,” but that “Myr teaches a POSA that its system is configured to periodically beacon its signal”); *see also id.* at 42 (explaining Petitioner’s reliance on Myr for periodic transmission). In other words, Patent Owner’s argument is not persuasive because it attacks Myr individually, rather than the combined teachings of Himmelstein and Myr that are asserted in the Petition. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

In light of the Petition’s analysis and for the reasons explained above, we agree with Petitioner that together, Himmelstein and Myr teach claim 1’s “beaconing” a broadcast unidirectional wireless data record according to a maintained configuration for when to do so, as claim 1 requires.

c. Petitioner's Rationale for Combining Himmelstein and Myr

The Petition explains in detail why one skilled in the art would have been motivated to include Myr’s periodic transmission in Himmelstein’s system signal. *See* Pet. 26–30. Specifically, Petitioner explains, with relevant support from Dr. Long, that a skilled artisan “would have been motivated to use Myr’s teaching of periodic beaconing of its signals in order to provide accurate location information while using as little power as needed from the device.” Pet. 21 (citing Ex. 1004 ¶ 58). Petitioner goes on to explain that “[b]y adopting the beaconing aspect of Myr, the Himmelstein system would have been able to have the sending device only provide the signal at advantageous times and thereby make the most efficient use of the power of the sending device.” *Id.* Petitioner also asserts that its proposed combination of Himmelstein and Myr is an obvious combination of Himmelstein’s system with Myr’s periodic transmission, yielding only predictable results. Pet. Reply 12–13 (citing *KSR Intern. Co. v. Teleflex Inc.*, 550 U.S. 398, 416–422 (2007)).

Patent Owner raises several arguments in contesting whether a skilled artisan would have combined Himmelstein and Myr. First, Patent Owner argues that conserving power was not a concern in Himmelstein because Himmelstein’s mobile devices were “interfaced with the vehicle’s electromechanical system” and thus could run off the vehicle’s generator instead of batteries. PO Resp. 30. We disagree with this argument because

using power more efficiently is beneficial, regardless of the power source. *See Intel Corp. v. Qualcomm Inc.*, 21 F.4th 784, 797–99 (Fed. Cir. 2021) (determining that the Board’s rejection of “increasing energy efficiency,” as a motivation to combine lacked substantial evidence). Moreover, nothing in Patent Owner’s argument undermines that Petitioner’s proposed combination amounts to no more than using a known technique in a known device, yielding only predictable results, and therefore obvious under *KSR*’s framework. *See* PO Resp. 28–31; PO Sur-reply 12–14.

Next, Patent Owner contends Himmelstein teaches away from the proposed combination because it “expressly states that systems based on cell phones are not appropriate in its system.” PO Resp. 30 (citing Ex. 1005, 1:28–35). We disagree with this argument because, as Petitioner explains, the at-issue passage in Himmelstein’s background section addresses conventional communication environments, but does not extend to the improved communication environment in Himmelstein on which Petitioner relies. *See* Pet. Reply 13–14. To the contrary, right after Patent Owner’s asserted Himmelstein passage that disparages cell phones, Himmelstein states that “[t]he present invention . . . eliminates these pitfalls.” Ex. 1005, 1:54–55. Thus, we agree with Petitioner that Himmelstein does not teach away from Petitioner’s proposed combination.

Last, Patent Owner argues that a skilled artisan would not have combined Himmelstein’s seven-unit piconet embodiment with Myr because doing so would subvert Myr’s overall purpose of “gathering and aggregating traffic information from a large number of cell phones across a wide geographic area.” PO Resp. 31. We disagree with this argument because the intended purpose of Myr’s overall system is not relevant to Petitioner’s

combination, which uses only Myr's periodic transmission in Himmelstein's piconet-architecture system. *See* Pet. 20–21, 42. Patent Owner does not point to anything in Myr that undermines Petitioner's combination—i.e., using Myr's periodic transmission in Himmelstein's system of a small number of cell phones, across a narrow geographic area.

Given Petitioner's explanation that Myr's periodic transmission would be a time- and cost-effective method of transmission in Himmelstein's system, Petitioner has articulated sufficient reasoning with rational underpinning to support the legal conclusion that its proffered combination would have been obvious. *See KSR*, 550 U.S. at 418. In addition, we agree with Petitioner that its proposed combination would have been obvious because it amounts to no more than using a known technique (Myr's periodic transmission) in a known device (Himmelstein's mobile units), yielding the predictable result of a mobile unit that periodically transmits information. *See* Pet. Reply 13; *KSR*, 550 U.S. at 417.

2. *Additional Undisputed Elements in Claim 1*

Petitioner asserts that Himmelstein and Myr teach the additional, undisputed elements in claim 1. *See* Pet. 22–49. Specifically, Petitioner corresponds Himmelstein's identification number 70 to claim 1's "identity information" because it provides a unique identification for the sending mobile unit. Pet. 26. Petitioner corresponds Himmelstein's communication identifier field 65 to claim 1's "application information" because it identifies whether the communication is a voice or data transmission. *Id.* at 27–28. Petitioner corresponds Himmelstein's position 72 to claim 1's "location information" because it represents the sending mobile unit's position. *Id.* at 31. Petitioner corresponds Himmelstein's acceleration, deceleration, or

direction/heading to claim 1's "reference information" because it further describes location information associated with the sending data processing system. *Id.* at 34. Next, Petitioner explains that Myr teaches maintaining a configuration for when records are transmitted, as well as transmitting records in accord with the maintained configuration, as claim 1 requires. *Id.* at 38–40, 42. Other than the arguments addressed above, Patent Owner does not additionally challenge Petitioner's showing for claim 1. We have reviewed Petitioner's arguments and evidence and, based on Petitioner's analysis outlined above, we agree with Petitioner that Himmelstein and Myr teach each element in claim 1.

3. Objective Indicia of Nonobviousness

Patent Owner asserts that objective evidence of nonobviousness demonstrates that the challenged claims were not obvious. *See* PO Resp. 32–41. We address Patent Owner's arguments below.

a. Copying

Patent Owner suggests that evidence of copying supports that the challenged claims are not obvious. PO Resp. 33–38. According to Patent Owner, we should infer copying based on Petitioner's access to the '804 patent and Petitioner's release of products that embody the challenged claims. *Id.* (citing *Liqwd, Inc. v. L'Oreal USA, Inc.*, 941 F.3d 1133, 1138 (Fed. Cir. 2019)). As the court in *Liqwd* recognized, access to a patent coupled with circumstantial evidence showing changes to a competitor's design can be sufficient to support copying. *Liqwd, Inc. v. L'Oreal USA, Inc.*, 941 F.3d 1133, 1138 (Fed. Cir. 2019). This may happen when, for example, "the defendant's engineering design team had settled on one design and 'suddenly changed direction' to adopt a feature disclosed in the patent as

soon as it issued.” *Id.* (quoting *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1328 (Fed. Cir. 2009)).

Here, we find the circumstantial evidence is not sufficient to suggest that Petitioner copied the patented technology. As Petitioner notes, the only alleged access involves unsolicited communications between 2010 and 2014 sent to Petitioner’s agent seeking to monetize Patent Owner’s then-pending patent applications. *See* Pet. Reply 16–17; PO Resp. 34–35. Patent Owner further alleges that “[i]n or around June 2013,” Petitioner “publicly announced its rollout of [] iOS7,” which Patent Owner alleges embodies the challenged claims. PO Resp. 35–38. These general allegations are not sufficient to infer that Petitioner changed its design to incorporate the patented features based on its access to Patent Owner’s technology. *See Liqwd*, 941 F.3d at 1138 (noting the “primary concern . . . to avoid treating mere infringement as copying simply because the claims of a patent arguably read on a competitor product”).

b. Commercial Success

Patent Owner suggests that evidence of commercial success further supports that the challenged claims are not obvious. Specifically, according to Patent Owner, the claimed features were commercially successful because “Petitioner touted the claimed features of the invention in connection with products using the iBeacon technology covered by the ’804 Patent.” PO Resp. 38. In addition, Patent Owner asserts that several companies “have entered into licensing agreement[s] pertaining to the patented technology covered by the ’804 patent.” *Id.* at 39.

We find Patent Owner’s evidence unconvincing for several reasons. First, the alleged touting relates to the products’ functionality, not their

commercial success. *See* PO Resp. 38–39 (citing Ex. 2028). In addition, Patent Owner’s licensing is unconvincing because, as Petitioner notes, the asserted licenses address some 30+ patents, only one of which is the ’804 patent, and Patent Owner “failed to provide any evidence regarding the weight or importance of the ’804 Patent to these agreements.” Pet. Reply 21.

In sum, we have reviewed Patent Owner’s arguments and evidence regarding objective evidence of non-obviousness and, for the reasons outlined above, do not find them persuasive enough to outweigh Petitioner’s evidence that the challenged claims would have been obvious.

4. Claim 1 Conclusion

Other than the arguments addressed above, Patent Owner does not additionally challenge Petitioner’s showing for claim 1. We have reviewed Petitioner’s arguments and evidence and, based on Petitioner’s analysis outlined above, we find that Petitioner has shown by a preponderance of evidence that claim 1 would have been obvious over Himmelstein and Myr.

B. OBVIOUSNESS OF DEPENDENT CLAIMS 10–12

Petitioner presents evidence explaining how Himmelstein teaches the additional features recited in dependent claims 10–12. *See* Pet. 50–59. Other than the arguments discussed above for claim 1, Patent Owner does not additionally challenge Petitioner’s obviousness showing for claims 10–12. Having reviewed the arguments and weighed the evidence, we agree with Petitioner that Himmelstein teaches the additional features recited in claims 10–12. Thus, we find Petitioner has shown by a preponderance of evidence that claims 10–12 would have been obvious over Himmelstein and Myr.

C. ALTERNATIVE OBVIOUSNESS GROUND

Petitioner adds an additional reference, Evans, for an alternative ground challenging claims 1 and 10–12. Pet. 59–60. Because Petitioner has shown these same claims would have been obvious without adding Evans, we do not address these alternative grounds.

IV. CONCLUSION

For the foregoing reasons, we determine Petitioner has demonstrated by a preponderance of the evidence that claims 1 and 10–12 of the '804 patent are unpatentable.⁶ Our conclusions are summarized in the following table.

Claim(s)	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Not shown Unpatentable
1, 10–12	103	Himmelstein, Myr	1, 10–12	
1, 10–12	103	Himmelstein, Myr, Evans ⁷		
Overall Outcome			1, 10–12	

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).

⁷ We do not reach this ground because it would not change the outcome of this case.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 1 and 10–12 of the '804 patent are unpatentable; and

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.

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