

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC, MICROSOFT CORPORATION,
Petitioner,

v.

CAROLYN W. HAFEMAN,
Patent Owner.

IPR2022-01188
Patent 10,325,122 B2

Before JEFFREY S. SMITH, JO-ANNE M. KOKOSKI, and
DANIEL J. GALLIGAN, *Administrative Patent Judges*.

GALLIGAN, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Google LLC and Microsoft Corporation (collectively “Petitioner”) filed a petition for *inter partes* review (Paper 4 (“Pet.” or “Petition”)) challenging claims 1–7 of U.S. Patent 10,325,122 B2 (Ex. 1001 (“’122 patent”)). Carolyn W. Hafeman (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). With our authorization, Petitioner filed a Reply to Patent Owner’s Preliminary Response (Paper 11), and Patent Owner filed a Sur-reply to Petitioner’s Preliminary Reply (Paper 14).

Under 37 C.F.R. § 42.4(a), we have authority to determine whether to institute review. The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted unless the information presented in the Petition and the Preliminary Response shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

For the reasons explained below, we institute an *inter partes* review of all challenged claims on all grounds raised in the Petition.

B. Related Matters

As required by 37 C.F.R. § 42.8(b)(2), the parties identify various related matters, including IPR2022-01189, which also involves the ’122 patent. Pet. 78; Paper 5 at 1.

C. Real Parties in Interest

Petitioner identifies the following real parties in interest: Google LLC, Microsoft Corporation, LG Electronics Inc., and LG Electronics U.S.A., Inc. Pet. 78.

Patent Owner identifies herself as the real party in interest. Paper 5 at 1.

D. The '122 Patent and Illustrative Claim

The '122 patent relates to the “return of lost or stolen computers using a recovery screen that appears during or after boot-up of the computer.” Ex. 1001, 1:24–27. Claims 1, 4, and 7 are independent, and claim 1 is reproduced below.

1. A method for displaying information to assist with returning a computer comprising the steps of:

activating a processor to display on a display screen on the computer which displays information concerning return information for returning the computer to an owner from data stored in a memory of the computer, the screen displaying return information before or with a lock screen, to facilitate return of the computer and which is maintained on or before or with the lock screen so the return information is visible to anyone viewing the display screen, the lock screen locks the display screen and protects the computer;

initiating or changing return information which appears on the display through remote communication without assistance by a user with the computer, wherein the changing of the return information is done through an interactive program stored in the memory of the computer which is remotely accessed only by the owner of the computer or the party authorized by the owner to enable the initiating or changing of the display screen;

displaying the screen before or with a security prompt which prevents the user from accessing operatively the computer;
and

activating the processor to allow a message to the user.

E. Asserted Grounds of Unpatentability

Petitioner presents the following grounds:

Claims Challenged	35 U.S.C. §	References/Basis
1–7	103(a) ¹	Jenne, ² Cohen ³
1, 4, 7	103(a)	Angelo, ⁴ Helle ⁵

II. ANALYSIS

A. Discretionary Denial

1. 35 U.S.C. § 314(a) (Fintiv)

Patent Owner argues that we should exercise discretion to deny institution under 35 U.S.C. § 314(a) because the factors identified in *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv* Order”), weigh in favor of denying institution in view of the proceedings in *Hafeman v. LG Electronics, Inc.*, No. 6:21-cv-00696-ADA (W.D.Tex.) (“district court litigation”). Prelim. Resp. 13–26; Paper 14. Petitioner argues we should not discretionarily deny institution.

¹ The ’122 patent claims priority through a chain of continuations to an application that was filed before the effective date of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”) amendments to 35 U.S.C. §§ 102 and 103. Petitioner asserts that the references are prior art under the pre-AIA versions of these sections. Pet. 2–3. In IPR2022-01189, however, Petitioner argues that the effective filing date of the claims of the ’122 patent is after the AIA effective dates. For purposes of this Decision, we need not resolve the priority dispute because the differences between the pre-AIA and AIA versions of §§ 102 and 103 have no bearing on the outcome here.

² US 2003/0122864 A1, published July 3, 2003 (Ex. 1005).

³ EP 0687968 A2, published Dec. 20, 1995 (Ex. 1006).

⁴ US 2003/0065934 A1, published Apr. 3, 2003 (Ex. 1007).

⁵ US 6,662,023 B1, issued Dec. 9, 2003 (Ex. 1008).

Pet. 75–77; Paper 11. For the reasons discussed below, we do not exercise discretion to deny institution.

Under § 314(a), the Director has discretion to deny institution of an *inter partes* review. *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”); *see also* 37 C.F.R. § 42.4(a) (“The Board institutes the trial on behalf of the Director.” In determining whether to exercise discretion to deny institution under 35 U.S.C. § 314(a), the Board considers whether the circumstances of a parallel district court proceeding are a basis for exercising such discretion. *Fintiv* Order 5–6.

A Memorandum from Director Vidal titled *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (USPTO June 21, 2022) (“Interim Procedure”)⁶ sets forth the following:

the PTAB will not deny institution of an IPR or PGR under *Fintiv* (i) when a petition presents compelling evidence of unpatentability; (ii) when a request for denial under *Fintiv* is based on a parallel ITC proceeding; or (iii) where a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition.

Interim Procedure 9.

Petitioner has not been sued for infringement of the ’122 patent and, therefore, is not a defendant in the district court litigation. Paper 11 at 1.

⁶ Available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf.

The defendant in the district court litigation, LG Electronics Inc., stipulated the following:

Google and Microsoft have filed petitions for *inter partes* review against the three Hafeman patents asserted in this case and identified LG Electronics Inc. as a real party-in-interest.

As you know, LG Electronics Inc. is the only defendant in *Hafeman v. LG Electronics, Inc.* (Case No. 6:21-cv-00696-ADA-DTG), and the deadline to add parties was on June 8, 2022. In accordance with the Board's precedential decision in *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (PTAB Dec. 1, 2020), LG Electronics Inc. agrees that if any of IPR Nos. IPR2022-01188, IPR2022-01189, IPR2022-01190, IPR2022-01191, IPR2022-01192, and IPR2022-01193 is instituted, LG Electronics Inc. will not pursue in the related district court proceeding "any ground that [Google or Microsoft] raised or reasonably could have raised" during the instituted IPRs. 35 U.S.C. § 315(e).

Ex. 1029 (alteration in original). Petitioner argues that, because no other parties can be added to the litigation, this stipulation is effective as a *Sotera* stipulation even though made by a different party. Paper 11 at 2 (citing Interim Procedure 7); *see Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18–19 (PTAB Dec. 1, 2020) (precedential as to § II.A) ("*Sotera*").

We agree with Petitioner. Our binding guidance states that the PTAB will not discretionarily deny institution of an IPR or PGR in view of parallel district court litigation where a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition.

Interim Procedure 7. Petitioner could not make such a stipulation in district court litigation to which it is not a party. The defendant in that litigation, LG Electronics Inc., which is a real party in interest in this proceeding (Pet. 78),

made such a stipulation. Thus, this stipulation “mitigates concerns of potentially conflicting decisions and duplicative efforts between the district court and the PTAB.” *See* Interim Procedure 7. Indeed, in advocating for discretionary denial in view of the district court litigation, Patent Owner argues that “for all intents and purposes, Google and Microsoft *are* ‘the same party’ as LG in the litigation.” Prelim. Resp. 23; *see also* Prelim. Resp. 21 (“Google and Microsoft are [s]tanding in LG’s [s]hoes.” (emphasis omitted)). Thus, Patent Owner effectively treats Petitioner and LG as the same entity to argue for discretionary denial.

Patent Owner also argues that the stipulation is ineffective because it is conditional on institution. Paper 14 at 2. We disagree because the stipulation in *Sotera* was conditional on institution. *Sotera*, Paper 12 at 18 (stipulation stating “if IPR is instituted”).

Thus, in light of LG’s stipulation regarding the district court litigation, we do *not* exercise discretion to deny institution under 35 U.S.C. § 314(a).

2. *Multiple Petitions*

Petitioner filed another petition challenging the claims of the ’122 patent in IPR2022-01189, and Petitioner submitted a separate paper explaining why it filed two petitions. Paper 3; *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), 59–60 & n.3, *available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated> (“Trial Practice Guide”) (permitting a petitioner to file a separate paper explaining why additional petitions should be instituted). Petitioner argues that a dispute about the ’122 patent’s priority date justifies two petitions. Paper 3 at 2.

Patent Owner does not directly address Petitioner’s reasons for filing multiple petitions, but, in arguing for discretionary denial based on the *Fintiv*

factors, Patent Owner argues that the filing of two petitions will not streamline issues with respect to the district court litigation. Prelim. Resp. 24–25.

We find that two petitions are justified here due to the priority date issue that Petitioner addresses in IPR2022-01189. *See* Trial Practice Guide 59 (“[T]he Board recognizes that there may be circumstances in which more than one petition may be necessary, including, for example, when the patent owner has asserted a large number of claims in litigation or when there is a dispute about priority date requiring arguments under multiple prior art references.”).

B. Principles of Law

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) any secondary considerations, if in evidence.⁷ *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 17–18 (1966).

⁷ At this stage, Patent Owner does not present any objective evidence of nonobviousness (i.e., secondary considerations) as to any of the challenged claims.

C. Level of Ordinary Skill in the Art

Citing the testimony of its declarant, Erez Zadok, Ph.D., Petitioner contends that a person of ordinary skill in the art

would have had a bachelor's degree in computer science, computer engineering, electrical engineering, or the equivalent and at least two years of experience in the relevant field, e.g., electronic communications systems. Significantly more practical experience could also qualify one not having the aforementioned education as a person of ordinary skill in the art while, conversely, a higher level of education could offset a lesser amount of experience.

Pet. 12–13 (citing Ex. 1003 ¶ 96).

Patent Owner does not dispute this assessment or offer her own assessment. *See* Prelim. Resp.

To the extent necessary, and for purposes of this Decision, we accept the uncontested assessment offered by Petitioner, except that we delete the qualifier “at least” to eliminate vagueness as to the amount of experience. The qualifier expands the range indefinitely without an upper bound, and thus precludes a meaningful indication of the level of ordinary skill in the art.

D. Claim Construction

We interpret claim terms using “the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b).” 37 C.F.R. § 42.100(b) (2021).

Petitioner presents two issues for claim construction. Pet. 9–12. First, Petitioner argues that certain language in each independent claim should be interpreted to require the automatic display of certain information “during or after every boot-up.” Pet. 9–11. Second, Petitioner argues that the return

and recovery information recited in the claims is merely printed matter that is not entitled to patentable weight. Pet. 12.

Patent Owner “takes no position” on Petitioner’s first claim construction argument, but Patent Owner disputes Petitioner’s second argument. Prelim. Resp. 9–13.

As discussed further below, Petitioner’s contentions that it would have been obvious to display certain information after every boot-up are sufficiently persuasive, and the prior art teaches the recited content of information. Thus, we need not resolve these claim construction issues at this time. *See 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))).

Nevertheless, to provide guidance to the parties during the trial, we briefly address each issue. As to the first issue, it is not entirely clear how Petitioner’s proposed construction fits into the method of claim 1, which presumably is met with a single iteration. Thus, requiring performance “during or after every boot-up” suggests that the claim requires multiple iterations that are not recited. As to the second issue, it is not entirely clear, on this record, what functionality is imparted by the content of the displayed information, as Patent Owner argues. *See* Prelim. Resp. 9–13.

The parties are free to address these issues further during the trial.

*E. Alleged Obviousness over Jenne and Cohen
(Claims 1–7)*

Petitioner asserts that claims 1–7 are unpatentable as obvious over the combined teachings of Jenne and Cohen. Pet. 3, 13–44. Patent Owner opposes. Prelim. Resp. 27–37.

1. Overview of the Prior Art

Jenne discloses a computer system that displays messages during a user wait time, such as during system boot-up, and it discloses the ability to remotely update the messages. Ex. 1005, code (57), ¶¶ 21, 25.

Cohen discloses modifying the Power-On Self Test (POST) mode of a computer to display information about the owner of the computer while prompting for a password. Ex. 1006, code (57), 3:57–4:4, Figs. 1, 3.

2. Overview of Petitioner’s Contentions for Claim 1

Petitioner relies on Jenne for its teachings of displaying messages during boot-up of a computer and updating those messages remotely. Pet. 13–16 (overview of Jenne), 23–40 (detailed analysis of independent claims). For example, Jenne discloses that, “[d]uring a computer boot-up time or a wake-up time from a low-power mode, the computer user is forced to sit and wait,” and Jenne discloses displaying messages during that time. Ex. 1005 ¶¶ 12–13. Jenne explains that such messages may be advertisements but that “other information could be displayed such as announcements, useful productivity tips, utility enhancements and computer upgrades.” Ex. 1005 ¶ 22. Jenne discloses that the content of the information displayed can be remotely updated such as in the following passage: “The computer manufacturer may also check for updates and downloads in block 65 via a manufacturer password that only the manufacturer or its authorized agent possesses.” Ex. 1005 ¶ 25.

Petitioner relies on Cohen to teach the automatic display of ownership information each time the computer is powered on. Pet. 16–18 (overview of Cohen), 23–40 (detailed analysis of independent claims). Cohen discloses that a “textual indicia of personal ownership is entered by the owner of the system during set-up or during a configuration change and electronically stored within non-volatile memory” and that this information is displayed during the POST process. Ex. 1006, code (57). With reference to Figure 4 (not shown), Cohen discloses that, when power is turned on to the computer, the POST process retrieves and displays the owner’s information and prompts for a password to allow use of the computer. Ex. 1006, 5:5–42, Fig. 4.

Petitioner argues that it would have been “obvious to combine Jenne’s teaching of automatic display of remotely updateable messages during the boot process with Cohen’s teaching of displaying ownership indicia messages with a security (lock) screen on every bootup to prohibit a user from accessing the device until proper security credentials (e.g., password) are entered.” Pet. 19 (citing Ex. 1003 ¶¶ 300–308). Petitioner provides several reasons that a person of ordinary skill in the art would have made this combination, including that Cohen expressly teaches that its display of ownership information during start-up increases the likelihood of returning a lost computer. Pet. 19–22 (citing, *inter alia*, Ex. 1003 ¶ 301; Ex. 1006, 5:43–58⁸).

Petitioner provides a details analysis explaining how the combination of Jenne and Cohen teaches the subject matter of claim 1. Pet. 23–40.

⁸ Although Petitioner cites column 5, lines 43–48 of Cohen, the relevant disclosure appears through line 58, as cited by Dr. Zadok. Ex. 1003 ¶ 302.

Petitioner argues that Jenne’s disclosure of displaying information in combination with Cohen’s disclosure of owner information teaches the preamble of claim 1. Pet. 23–24. Petitioner argues that the “combination of Jenne and Cohen discloses automatically displaying return/recovery information during or after every boot-up of the computer” and, therefore, teaches “activating a processor to display on a display screen on the computer which displays information concerning return information for returning the computer to an owner from data stored in a memory of the computer,” as recited in claim 1. Pet. 26–30.

Petitioner argues that, in the asserted combination, the owner information is displayed with a password prompt as described in Cohen such that the combination teaches “the screen displaying return information before or with a lock screen, to facilitate return of the computer and which is maintained on or before or with the lock screen so the return information is visible to anyone viewing the display screen, the lock screen locks the display screen and protects the computer,” as recited in claim 1. Pet. 30–32.

Claim 1 recites “initiating or changing return information which appears on the display through remote communication without assistance by a user with the computer.” Petitioner addresses “changing” rather than “initiating,” noting that only one of these needs to be met by the prior art. Pet. 32–33; *see also* Prelim. Resp. 27 (“As Petitioner notes, ‘initiating or changing’ is disjunctive: thus, Petitioner only needs to establish that one of the two is satisfied.”). Petitioner relies on Jenne’s disclosures of remotely updating the message content and argues that a person of ordinary skill in the art “would have been motivated to incorporate the capability to change the stored ownership information using Jenne’s ‘remote communication’ (EX-1005, Abstract, ¶¶13, 21, 25) so that the most up-to-date ownership

information is displayed when a device is lost or stolen.” Pet. 33–34 (citing Ex. 1003, ¶¶ 303, 334).

Claim 1 further recites “wherein the changing of the return information is done through an interactive program stored in the memory of the computer which is remotely accessed only by the owner of the computer or the party authorized by the owner to enable the initiating or changing of the display screen.” Petitioner argues that Jenne’s disclosures of remotely updating the message content by the “computer manufacturer or its authorized agent” (Ex. 1005 ¶ 25) teaches an interactive program, which, in combination with Cohen’s disclosure of an owner changing owner display information, teach this subject matter. Pet. 35–37.

Claim 1 also recites “displaying the screen before or with a security prompt which prevents the user from accessing operatively the computer.” Petitioner relies on Cohen’s disclosure of displaying owner information on the screen with a password prompt. Pet. 37–38.

Claim 1 further recites “activating the processor to allow a message to the user.” Petitioner relies on Cohen’s screen showing the message “This system belongs to:” as teaching a message that is in addition to the return information. Pet. 39–40.

3. Patent Owner’s Arguments and Our Preliminary Analysis

Patent Owner argues that allowing an owner to remotely change return information (i.e., indicia of ownership) was “was unique and unconventional” at the relevant time and that Petitioner has not sufficiently explained why a person of ordinary skill in the art would have changed Jenne’s display from updating advertising information to updating owner information. Prelim. Resp. 27–31 (emphasis omitted).

On this record, we disagree with Patent Owner’s argument, and we determine that Petitioner provides sufficient articulated reasoning to support its obviousness contentions. As Petitioner correctly points out (Pet. 19), Cohen expressly teaches that the benefits of displaying owner information with a password prompt when the computer is started are that “the likelihood that a lost or misplaced personal computer device will be returned to its owner [is] greatly enhanced and [that] ownership of otherwise fungible devices may be easily determined.” Ex. 1006, 5:52–58; *see* Ex. 1003 ¶ 301 (Dr. Zadok testifying that Cohen’s disclosure shows that a person of ordinary skill in the art would have been motivated to display owner information during boot-up). Jenne teaches a system for displaying information in which the information can be remotely updated. To the extent the particular content of the information matters in this obviousness inquiry (*see* § II.D above), Cohen’s disclosures show the benefits of displaying ownership information as the updatable information in Jenne.

Patent Owner also argues that the asserted combination does not teach changing the displayed information “without assistance by a user with the computer” because Jenne discloses that user feedback is used in updating the information displayed. Prelim. Resp. 31–35 (citing Ex. 1005 ¶¶ 20, 25, Fig. 1; Ex. 1001, 7:18–35, 8:24–33, 10:1–7, Fig. 3; Ex. 1012 at 143, 151–53, 2017, 2075, 2093). We agree with Patent Owner that Jenne discloses a system that has the ability to take user feedback and update displayed content, such as advertisements, based on that feedback. Ex. 1005 ¶ 25 (“[T]he user may occasionally request to provide advertisement preferences as shown in block 70.”; “As an alternative to block 70, the control from block 55 may transfer to block 60 where the commercial message application 540 tracks the user Internet information, like the user preferences

and update the user profile.”). Petitioner, however, relies on Jenne’s disclosure of remotely updating displayed information by an authorized party in combination with Cohen’s disclosure of an owner entering ownership information for display. Pet. 32–34. The arguments Patent Owner made during prosecution of a related patent (U.S. Patent 8,601,606) show that the language “without assistance by a user” was added to distinguish over prior art that allegedly required a user at the computer “to push an interrupt key to allow the owner to change the display from remote.” Ex. 1012 at 2093; *see* Prelim. Resp. 33–35 (discussing prosecution history of U.S. Patent 8,601,606). Jenne discloses remotely updating using a password without requiring the user at the computer to press a particular key to start the process. For example, Jenne explains that the “computer manufacturer may also check for updates and downloads in block 65 via a manufacturer password that only the manufacturer or its authorized agent possesses.” Ex. 1005 ¶ 25; *see also* Ex. 1005 ¶ 13 (“The commercial messages in the non-volatile memory may be securely updated through the Internet using a password.”). Thus, on this record, Petitioner’s contentions for this subject matter are sufficiently persuasive. *See* Pet. 32–34.

Patent Owner also argues that the asserted combination does not teach “an interactive program . . . which is remotely accessed only by the owner of the computer or the party authorized by the owner.” Prelim. Resp. 35–37. According to Patent Owner, “Jenne teaches that ‘the computer user could uninstall or delete the commercial message application.’” Prelim. Resp. 35 (citing Ex. 1005 ¶ 21). Patent Owner argues, therefore, that the owner is not the only one who has access to the application. Prelim. Resp. 35–36.

On this record, we disagree with this argument because the claim recites that *remote* access is “only by the owner of the computer or the party

authorized by the owner.” The claim does not limit all access. Jenne discloses that remote updating is done with a password. Ex. 1005 ¶¶ 13 (“The commercial messages in the non-volatile memory may be securely updated through the Internet using a password.”), 25 (“The password may be used by the computer manufacturer or its authorized agent for securely updating the memory 520.”). Thus, the entity having the password is the “party authorized by the owner.” From the computer’s perspective, authorization is determined by checking for the correct password. This is consistent with the ’122 patent’s disclosure that the software determines who “is in charge” based on who “uses the correct password.” Ex. 1001, 15:4–8. For purposes of teaching the claimed subject matter, therefore, it is sufficient for Petitioner to show that “interactive program . . . is remotely accessed only by the owner of the computer or the party authorized by the owner,” which Petitioner has done by explaining that a password is used for remotely updating the display. *See* Pet. 36–37.

Patent Owner argues that, “just because the computer manufacturer may have access to the ‘commercial message application’ does not mean that ‘only’ the manufacturer has such access” because, “[i]f you give a spare house key to your neighbor, they will have access to the house; but, of course, you still have access too.” Prelim. Resp. 37. In Patent Owner’s scenario, whoever has a key is “authorized by the owner,” as recited in the claim, so we see no patentable distinction between the claims and the asserted combination based on this analogy.

4. Preliminary Determination for Claim 1

For the reasons discussed above and based on Petitioner’s contentions and evidence, summarized above, we are persuaded, on this record, that Petitioner shows a reasonable likelihood of prevailing in demonstrating that

claim 1 is unpatentable as obvious over the combined teachings of Jenne and Cohen.

5. Claims 2–7

Petitioner also asserts that independent claims 4 and 7 and dependent claims 2, 3, 5, and 6 are unpatentable as obvious over the combined teachings of Jenne and Cohen. Pet. 13–44. Patent Owner relies on the arguments addressed above in § II.E.3 and does not set forth additional arguments for claims 2–7 at this stage of the proceeding. Prelim. Resp. 27–37. We have reviewed Petitioner’s contentions, and we are sufficiently persuaded, on this record, that Petitioner shows a reasonable likelihood of prevailing in demonstrating that claims 2–7 are unpatentable as obvious over the combined teachings of Jenne and Cohen.

*F. Alleged Obviousness over Angelo and Helle
(Claims 1, 4, 7)*

Petitioner asserts that claims 1, 4, and 7 are unpatentable as obvious over the combined teachings of Angelo and Helle. Pet. 3, 44–73. Patent Owner opposes. Prelim. Resp. 38–50. Having determined that the Petition meets the threshold for institution (reasonable likelihood of prevailing as to at least one of the challenged claims) based on the Jenne-Cohen obviousness ground, the remainder of this Decision focuses on the parties’ disputes to provide guidance to the parties for the trial.

Angelo discloses that devices have basic security mechanisms, such as a screen requiring a personal identification number (PIN), but it says that there is “room for improvement.” Ex. 1007 ¶¶ 9–10. Angelo discloses additional security mechanisms, including giving the owner of the device the ability to remotely lock it if stolen. Ex. 1007 ¶ 23.

Helle discloses security features for a phone that allow the owner to remotely control various messages that display on the phone. Ex. 1008, code (57), 6:5–42 (table of supported remote commands).

Petitioner argues that a person of ordinary skill in the art

would have been motivated to integrate Helle’s teachings regarding the content of messages to display to a device user and Helle’s teachings of changing the content of stored information to be displayed using a control message into Angelo’s computer security system having a basic security mechanism (password protection) and enhanced security features when a device is lost or stolen.

Pet. 48–49. Petitioner provides several rationales in support of its combination. Pet. 49–52.

Patent Owner argues that “[n]either Angelo nor Helle teaches displaying the alleged return/recovery information ‘during or after *every* boot-up,’” as in Petitioner’s proposed construction. Prelim. Resp. 38–44. Patent Owner’s argument here appears to be based on the premise that “Petitioner does not rely on the ‘basic security mechanism of a password or code screen’ as taught by Angelo or Helle for the return/recovery information limitations.” Prelim. Resp. 42. We disagree with Patent Owner’s reading of the Petition. Petitioner contends that the combination would have Angelo’s basic security mechanism and its enhanced security features and that it would have been obvious to display return information on the standard lock screen that is part of Angelo’s basic security mechanism. Pet. 48–49 (explaining the combination with “Angelo’s computer security system having a basic security mechanism (password protection) and enhanced security features”), 59 (explaining motivation “to display a predefined message including a return address, such as disclosed in the enhanced security feature displays of Angelo and Helle, on the standard

security password/code screens disclosed by Angelo and Helle”), 60–61 (“Because the basic security mechanism of a password or code screen occurs every time a device is activated, the combination of Angelo and Helle teaches these limitations under Petitioners’ proposed construction.”). Thus, Patent Owner’s argument does not appear to be responsive to Petitioner’s contentions.

Patent Owner also argues that Petitioner’s contentions do not show initiating or changing return information “without assistance by a user with the computer.” Prelim. Resp. 45–47. In particular, Patent Owner argues that “Angelo never teaches that this destructive action is performed without any input by the person in possession of the device.” Prelim. Resp. 46. On this record, we disagree with Patent Owner’s argument. As Petitioner correctly points out (Pet. 65–66), Angelo’s enhanced security features are for use when the phone is lost or stolen. For example, Angelo discloses remotely “lock[ing] the machine down while displaying a predefined message with a return address for the device or a telephone number to call.” Ex. 1007 ¶ 23. The signal to lock the device is sent from a remote security station over a communication link to the device, so the user at the device is not involved. Ex. 1007 ¶ 21, Fig. 1.

Patent Owner also argues that Petitioner has not specified what in the prior art teaches the “interactive program” recited in the claims. Prelim. Resp. 47–50. We disagree. Petitioner argues that Angelo’s CPU uses software to perform the security functions. Pet. 54. Petitioner further contends that “the combination of Angelo and Helle teaches a computer ‘*program*’ stored in memory and that executes on the CPU of the portable device when a security message is received triggering an action by the portable device.” Pet. 68. Thus, by pointing to the specific operations and

functionality that the CPU of Angelo (in combination with Helle) performs, Petitioner has sufficiently identified the recited “interactive program” for purposes of institution. Patent Owner argues that “Angelo’s user must be able to access the CPU, or else the software would serve no purpose” and, therefore, that the software running on the CPU is not remotely accessed “only by the owner.” Prelim. Resp. 49. As stated above in § II.E.3, the claim does not limit all access but only remote access.

We have reviewed Petitioner’s contentions based on the combination of Angelo and Helle and find them sufficiently persuasive on this record.

III. CONCLUSION

For the foregoing reasons, we determine that the information presented in the Petition establishes that there is a reasonable likelihood that Petitioner would prevail in challenging at least one claim of the ’122 patent, and we institute *inter partes* review of all challenged claims on all grounds raised in the Petition. See 37 C.F.R. 42.108(a) (“When instituting *inter partes* review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.”). At this stage of the proceeding, we have not made a final determination with respect to the patentability of any of the challenged claims or the construction of any claim term.

IV. ORDER

Accordingly, it is

ORDERED that, pursuant to 35 U.S.C. § 314(a) and 37 C.F.R. § 42.4, an *inter partes* review is hereby instituted as to claims 1–7 of the ’122 patent on all challenges raised in the Petition; and

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, which will commence on the entry date of this decision.

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Patent 10,325,122 B2

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