

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC, MICROSOFT CORPORATION,
Petitioner,

v.

CAROLYN W. HAFEMAN,
Patent Owner.

IPR2022-01189
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 IPR2022-01188, which also involves the ’122 patent. Pet. 81; 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. 81.

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	102(a)(1)	Hafeman 670 ¹
1–7	103 ²	Hafeman 298, ³ Chiu ⁴

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. 12–26; Paper 14. Petitioner argues we should not discretionarily deny institution.

¹ US 2005/0071670 A1, published Mar. 31, 2005 (Ex. 1011).

² The ’122 patent claims the benefit, through a chain of continuations, to an application that was filed before the effective date of the amendments made by the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”) to 35 U.S.C. §§ 102 and 103. Petitioner argues that the effective filing date of the claims of the ’122 patent is after the effective date of the AIA amendments, thereby subjecting them to the AIA versions of §§ 102 and 103. Pet. 2–3 n.2.

³ US 2004/0103298 A1, published May 27, 2004 (Ex. 1009).

⁴ US 2003/0088633 A1, published May 8, 2003 (Ex. 1010).

Pet. 78–81; 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”)⁵ 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.

⁵ 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. 81),

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. 22; *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 IPR2022-01188, 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.

We find that two petitions are justified here due to the priority date issue that this Petition raises. *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

To establish anticipation, each and every element in a claim, arranged as recited in the claim, must be found in a single prior art reference. *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008). Although the elements must be arranged or combined in the same way as in the claim, “the reference need not satisfy an *ipsissimis verbis* test,” i.e., identity of terminology is not required. *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009) (citing *In re Bond*, 910 F.2d 831, 832–33 (Fed. Cir. 1990)).

A patent claim is unpatentable under 35 U.S.C. § 103 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.⁶ *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 17–18 (1966).

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. 27 (citing Ex. 1003 ¶¶ 95–97).

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 need not expressly construe any terms to determine whether to institute. *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

⁶ At this stage, Patent Owner does not present any objective evidence of nonobviousness (*i.e.*, secondary considerations) as to any of the challenged claims.

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))).

*E. Alleged Anticipation by Hafeman 670
(Claims 1–7)*

Petitioner asserts that claims 1–7 are unpatentable as anticipated by
Hafeman 670. Pet. 3, 10–23, 30–77. Patent Owner opposes. Prelim.
Resp. 34–42.

1. Overview of Challenge

As background, the ’122 patent claims the benefit, through a series of
continuation applications, of the filing date of U.S. Patent Application No.
10/945,332 (“’332 application”), which issued as U.S. Patent No. 8,601,606
(“’606 patent”). Ex. 1001, code (63). The publication of the ’332
application is Hafeman 670. Ex. 1011, codes (10), (21). The ’332
application is a continuation-in-part of U.S. Patent Application No.
10/304,827, which published as Hafeman 298. Ex. 1001, code (63);
Ex. 1009, codes (10), (21).

Petitioner asserts that Hafeman 670 does not provide adequate written
description support for the subject matter claimed in the ’122 patent but
nevertheless anticipated that subject matter. Pet. 15–16, 73–74. The
situation arises because of the following language in claim 1 of the
’122 patent: “initiating *or* changing return information which appears on the
display through remote communication without assistance by a user with the
computer” (emphasis added). Claims 4 and 7 have similar disjunctive
language. Petitioner argues that “the challenged claims do not require both
remotely initiating and remotely changing the return/recovery information[;]
rather they require only one or the other.” Pet. 73. Patent Owner agrees

with this interpretation. *See* IPR2022-01188, Paper 8 at 27 (“As Petitioner notes, ‘initiating or changing’ is disjunctive: thus, Petitioner only needs to establish that one of the two is satisfied.”). Petitioner argues that Hafeman 670 discloses the “changing” alternative but not the “initiating.” Pet. 73–74. Petitioner contends that the earliest date for which written description support for both alternatives can be found is November 22, 2013, the date of filing the application for U.S. Patent No. 9,021,610. Pet. 2. As such, according to Petitioner, Hafeman 670, published March 31, 2005, is prior art to the claims of the ’122 patent under 35 U.S.C. § 102(a)(1).

The sole dispositive dispute between the parties is whether the ’332 application (Hafeman 670) provides written description support for the “initiating” alternative. Petitioner relies on Hafeman 670 to describe the remaining subject matter of the claims of the ’122 patent. Pet. 70–77. Thus, if Hafeman 670 has adequate written description support for the “initiating” limitation, then the claims of the ’122 are entitled to the benefit of Hafeman 670’s filing date, removing Hafeman 670 as prior art.

With that background, we turn to the parties’ dispute about the written description support for the “initiating” claim language.

2. Alleged Lack of Written Description Support for “Initiating”

As noted above, the ’122 patent claims the benefit, through a series of applications, of the filing date of the application for Hafeman 670.

Ex. 1001, code (63). “[T]o gain the benefit of the filing date of an earlier application under 35 U.S.C. § 120, each application in the chain leading back to the earlier application must comply with the written description requirement of 35 U.S.C. § 112.” *Zenon Envtl., Inc. v. U.S. Filter Corp.*, 506 F.3d 1370, 1378 (Fed. Cir. 2007) (quoting *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1571 (Fed. Cir. 1997)); *see also In re Hogan*, 559 F.2d

595, 609 (CCPA 1977) (“[T]here has to be a continuous chain of copending applications each of which satisfies the requirements of § 112 with respect to the subject matter presently claimed.” (quoting *In re Schneider*, 481 F.2d 1350, 1356 (CCPA 1973)) (alteration in original). Thus, if any application in the continuity chain fails to make the requisite disclosure of subject matter, the later-filed application is not entitled to the benefit of the filing date of applications preceding the break in the chain.

At the outset, we reject Patent Owner’s argument that Petitioner’s challenge based on Hafeman 670 should be denied because it is merely “an argument for invalidity under 35 U.S.C. § 112(a), which the Board may not consider in an *Inter Partes* Review.” Prelim. Resp. 35. Before us, Petitioner is not asserting that the application for the ’122 patent does not provide written description support for the challenged claims. Patent Owner’s argument is based on Petitioner’s assertion that “Hafeman 670 contains the identical specification to the ’122 patent.” Pet. 28, *quoted in* Prelim. Resp. 34. Petitioner’s language here is imprecise because, according to § 112(b)’s provision that the “specification shall conclude with one or more claims,” the claims of the filed application are part of the specification. *See Ariad Pharms. v. Eli Lilly and Co.*, 598 F.3d 1336, 1349 (Fed. Cir. 2010) (en banc) (stating that “original claims are part of the original specification” (citing *In re Gardner*, 480 F.2d 879, 879 (CCPA 1973))). We understand Petitioner’s reference to the “identical specification” to be to the written description in the ’122 patent except for the original claims, which are not found in the specification of Hafeman 670.

This distinction is important here because the original claims that were filed as part of the application for the ’122 patent include the “initiating or changing” limitation. Ex. 1002, 31–33. Thus, the “initiating” recitation

in the issued claims of the '122 patent may have adequate written description support in the specification based on the original claims. *See Ariad*, 598 F.3d at 1349 (“Although many original claims will satisfy the written description requirement, certain claims may not.”). That issue is not before us. Rather, we must determine if the '332 application, which does not include the “initiating or changing” language in its original claims, provides adequate written description support for the claims of the '122 patent. *See* Ex. 1012, 44–46 (original claims of the '332 application). On this record, we preliminarily determine that the '332 application does not provide written description support for the “initiating or changing” limitation in the '122 patent claims.

The “initiating” language was first introduced into claims in the continuity chain in a July 2006 amendment during prosecution of the '332 application. Ex. 1012, 114–22; *see* Pet. 15–16 (discussing this amendment). Claim 1 of that application was amended, in relevant part, to recite “initiating and changing recovery information by the owner of the computer and additional computers owned by the owner through remote communication by the owner with the computer and additional computers.” Ex. 1012, 115. The applicant similarly amended other independent claims to recite “initiating and changing.” Ex. 1012, 117–20. The applicant stated that support for the “initiating” language was at page 31, line 2 of the application. Ex. 1012, 123. The full cited sentence states the following: “The program design feature allows the ‘owner’ to access the recovery center administration program, initiate a download of changes to the protected equipment, control the entire recovery screen displayed, and even

override the ‘assigned to’ person’s input.” Ex. 1012, 37 (31:1–5)⁷; *see* Ex. 1001, 13:43–47 (same subject matter).

Patent Owner argues that this and other disclosures in the ’332 application show that the owner can remotely control the displayed screen, which adequately supports the “initiating” language. Prelim. Resp. 38–40 (citing Ex. 1012, 10 (4:10–12) 18–19 (12:26–13:2), 19 (13:23–28), 20 (14:3–13), 21 (15:3–6), 37 (31:9–23), 38 (32:3–7)). We agree with Patent Owner that these passages show remote control capability. The issue is whether they are adequate written description support for “initiating . . . return information which appears on the display through remote communication without assistance by a user with the computer.” For example, the ’332 application discloses the ability to “control the entire recovery screen displayed” (Ex. 1012, 37 (31:1–5)), but it is not clear, on this record, that this supports the “initiating” alternative of the ’122 patent claims. During prosecution of the ’332 application, the applicant distinguished the “initiating and changing recovery information” language of the pending claims from the manner in which the prior art “initiates changes to the ownership tag.” Ex. 1012, 124. Thus, the conjunctive “initiating and changing recovery information” may have been supported by disclosures of changing information on the screen. The relevant limitation of the ’122 patent claims, however, recites the disjunctive language “initiating or changing.” Thus, the ’332 application must provide written description support for a remote “initiating” operation alone, and it is not clear that

⁷ In parentheses, we include the original specification page number with line citations.

controlling information that is already being displayed is the same as initiating that information.

Petitioner's argument is that initiating a display of return information did not refer to a remote operation in the original specification of the '332 application. Pet. 16–23. On this record, we agree with Petitioner. The '332 application uses the term “initiate” or derivations in several places. For example, it states that “[t]he present invention automatically initiates during the boot-up process of the equipment, in order to display the recovery/return information before a security prompt screen to always help protect the owner's confidential information on the hard drive.” Ex. 1012, 10 (4:10–15). The use of “initiating” here is for the initial display of the information done locally by the computer. The same is true for the following passage: “By automatically initiating this program during or before a user's security prompt, such as a password screen program, the recovery/return program will not only increase chances of recovery, but will also increase chances that the computer 12 information on the hard drive is protected while the computer 12 is not in the owner's possession.” Ex. 1012, 19 (13:23–28).

The following passage further illustrates the initiation on computer boot-up:

For example, the actual step by step operation of the program is as follows:

- (1) Someone finds a lost or stolen computer 12. The person who finds the computer 12, turns the computer 12 on. (The software program 24 could be provided with a warning sticker that will be placed on the outside of the equipment telling anyone finding the equipment, about the program and the display recovery screen.)
- (2) The computer 12 display 18 screen turns on. The computer 12 security software return/recovery program automatically initiates during the computer's 12 boot-up process.

Ex. 1012, 20 (14:1–14).

The '332 application further explains the following:

It is important to note only that the computer 12 security software recovery/return program be displayed on the computer 12 screen monitor before, or during a password or security prompt display screen, because the operating system password screen creates a 'wall' before taking the computer 12 user to the computer 12 operating system. (See FIG. 3). This helps not only protect the owner's information on the hard drive, but also ensures that the person finding the equipment will see the owner recovery/return information. If the program initiated after the password or security prompt screen, the person finding the lost or stolen equipment would have difficulty ever seeing the recovery/return display 20.

Ex. 1012, 21–22 (15:26–16:10). This passage counsels against initiating the display of the return information after the display of a password or security prompt screen.

The '332 patent, however, does contemplate initiating the display of return information at a time after the initial boot-up, but not through remote communication. It states the following:

The Retriever display not only appears during the initial boot-up, but the Retriever program security recovery display screen can also be manually initiated by the computer 12 user. This would be the Workstation Locked display. (FIG. 10). This allows the computer 12 user to manually lock the computer 12 screen and protect the computer 12 if they need to leave their computer 12 for a few minutes. This feature is handy for all types of situations, like emergency room laptops at hospitals, etc.

The Retriever display not only appears during the initial boot-up or with a manual activation by the computer 12 user; the Retriever workstation locked recovery screen can also be initiated automatically using a screen saver timer feature that can be changed by the Owner or the Assigned To person. For example, let's say the computer 12 screen saver time feature has

a 10 minute timer. If there is no activity on the computer 12, the Workstation Locked security Recovery screen will display and stay displayed until the password prompt is satisfied.

Ex. 1012, 42–43 (36:14–37:4). The first paragraph above explains that the user of the computer can manually initiate the display of recovery information locally, which goes against two requirements of the '122 patent claims—that the initiating be done through “remote communication” and “without assistance by a user with the computer.” The second paragraph discloses using a timer to initiate the display of return information, not initiating the display remotely.

Turning back to the prosecution of the '332 application, the applicant cited page 31, line 2 of the original application to support the “initiating” language. Ex. 1012, 123. This language discloses the ability to “initiate a download of changes to the protected equipment,” not “initiat[e] . . . return information which appears on the display,” as recited in claim 1.

For all of these reasons, we preliminarily determine that the '332 application does not provide adequate written description support for “initiating . . . return information which appears on the display through remote communication without assistance by a user with the computer,” as recited in claim 1 and similarly recited in independent claims 4 and 7.

3. Effective Filing Date for Claims of the '122 Patent

Petitioner argues that, because the '332 application does not provide adequate written description support for the claims of the '122 patent, the earliest possible effective filing date is November 22, 2013, which is the filing date of the next continuation in the chain. Pet. 22–23; *see* Ex. 1001, code (63) (U.S. Application No. 14/087,866, filed on November 22, 2013, issued as U.S. Patent No. 9,021,610). As a result, Petitioner contends that

the '122 patent is subject to AIA §§ 102 and 103, rendering Hafeman 670 prior art under 35 U.S.C. § 102(a)(1). Pet. 2–3 & n.2.

Having preliminarily determined that the '332 application does not provide written description support for the claims of the '122 patent, Petitioner's contention that Hafeman 670 is prior art under 35 U.S.C. § 102(a)(1) is sufficiently persuasive. If the earliest possible effective filing date is November 22, 2013, no exception under 35 U.S.C. § 102(b)(1) applies because Hafeman 670 was published more than one year before this date.

4. Alleged Anticipation by Hafeman 670

Petitioner asserts that Hafeman 670 describes all of the subject matter in the claims of the '122 patent except for the alternative “initiating” limitation. Pet. 72–77. Patent Owner argues that Hafeman 670 provides written description support for the claims of the '122 patent and is not prior art to the '122 patent. Prelim. Resp. 37–42. Thus, the parties agree that Hafeman 670 discloses sufficient subject matter to anticipate the claims of the '122 patent.

Having preliminarily determined, as explained above, that the claims of the '122 patent are not entitled to claim the benefit of the filing date of the '332 application (Hafeman 670) because it does not disclose “initiating . . . return information . . . through remote communication,” we are sufficiently persuaded that Petitioner establishes a reasonable likelihood of showing that Hafeman 670 anticipated the claims of the '122 patent, and we institute an *inter partes* review.

*F. Alleged Obviousness over Hafeman 298 and Chiu
(Claims 1–7)*

Petitioner also asserts that claims 1–7 are unpatentable as obvious over the combined teachings of Hafeman 298 and Chiu. Pet. 3, 30–70. As noted above, the ’332 application is a continuation-in-part of the application that published as Hafeman 298. Ex. 1001, code (63). Because we institute an *inter partes* review, this ground is included in the trial as well. 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.”).

We note, however, that it is unclear whether this ground will ever require substantive evaluation. If we determine that Hafeman 670 is prior art under 35 U.S.C. § 102(a)(1) and no exception applies, then the claims are likely to be found unpatentable as anticipated by Hafeman 670 for the reasons discussed above. If we determine that the claims of the ’122 patent are entitled to the benefit of the September 20, 2004, filing date of the ’332 application, the pre-AIA version of 35 U.S.C. §§ 102 and 103 would apply. See Pub. L. No. 112-29, 125 Stat. 284 (2011), §§ 3(b), 3(c) and 3(n). Hafeman 298 would not qualify as prior art under any category in pre-AIA § 102. Because Hafeman 298 is by the same inventor as the ’332 application, pre-AIA §§ 102(a), (e), and (g) would not apply. See *In re Katz*, 687 F.2d 450, 454–55 (CCPA 1982) (discussing pre-AIA § 102(a)); see also pre-AIA §§ 102(e) and (g) (“by another”). Because the ’332 application was filed within one year of Hafeman 298’s publication, pre-AIA § 102(b) would not apply.

Therefore, it is not clear, on the present record, that the ground of unpatentability over Hafeman 298 and Chiu will need to be decided. Nevertheless, under 37 C.F.R. § 42.108(a), it is part of the trial.

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 its challenge on 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.

IPR2022-01189
Patent 10,325,122 B2

FOR PETITIONER:

Matthew A. Smith
Andrew S. Baluch
SMITH BALUCH LLP
smith@smithbaluch.com
baluch@smithbaluch.com

Kirstin L. Stoll-DeBell
Carrie A. Beyer
FAEGRE DRINKER BIDDLE & REATH LLP
kirstin.stolldebelle@faegredrinker.com
carrie.beyer@faegredrinker.com

FOR PATENT OWNER:

Stephen E. Underwood
Jason C. Linger
GLASER WEIL FINK HOWARD AVCHEN & SHAPIRO LLP
sunderwood@glaserweil.com
jlinger@glaserweil.com