

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC, MICROSOFT CORPORATION,
Petitioner,

v.

CAROLYN W. HAFEMAN,
Patent Owner.

IPR2022-01190
Patent 10,789,393 B2

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

KOKOSKI, *Administrative Patent Judge*.

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

I. INTRODUCTION

Google LLC (“Google”) and Microsoft Corporation (“Microsoft”) (collectively, “Petitioner”) filed a Petition to institute an *inter partes* review of claims 1–7 (the “challenged claims”) of U.S. Patent No. 10,789,393 B2 (“the ’393 patent,” Ex. 1001). Paper 4 (“Pet.”). Carolyn Hafeman (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). With Board authorization, Petitioner filed a Reply to the Preliminary Response (“Prelim. Reply,” Paper 11) and Patent Owner filed a Sur-reply to Petitioner’s Reply (“Prelim. Sur-reply,” Paper 14).

Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314 (2018); *see also* 37 C.F.R. § 42.4 (2021). Upon consideration of the Petition, Preliminary Response, Preliminary Reply, and Preliminary Sur-reply, and the evidence of record, we determine that Petitioner establishes a reasonable likelihood of prevailing with respect to the unpatentability of at least one claim of the ’393 patent, and we do not exercise discretion to deny the Petition. Accordingly, for the reasons that follow, we institute an *inter partes* review of claims 1–7 of the ’393 patent.

A. *Real Parties in Interest*

Petitioner identifies Google, Microsoft, LG Electronics Inc., and LG Electronics U.S.A., Inc as the real parties in interest. Pet. 78. Patent Owner identifies herself as the real party in interest. Paper 5, 1.

B. *Related Matters*

The parties identify *Hafeman v. LG Electronics, Inc.*, No. 6:21-cv-00696-ADA (W.D. Tex.) as a related matter. Pet. 78; Paper 5, 1. Patent

Owner additionally identifies *Absolute Software, Inc. et al. v. World Computer Security Corp. et al.*, No. 1:09-cv-00142-LY (W.D. Tex.).

Paper 5, 1. The '393 patent is also the subject of IPR2022-01191 (“the 1191 IPR”), filed by Petitioner. Pet. 78; Paper 5, 1. The parties further identify four *inter partes* reviews directed to patents related to the '393 patent, also filed by Petitioner: IPR2022-01188, IPR2022-01189, IPR2022-01192, and IPR2022-01193. Pet. 78; Paper 5, 1.

C. The '393 Patent

The '393 patent “is related to the return of lost or stolen computers using a recovery screen that appears during or after boot-up of the computer.” Ex. 1001, 1:26–30. The '393 patent teaches a “step of displaying automatically a return screen on a display of the computer during or after boot-up of the computer, which displays information concerning owner information about who owns the computer and return information for returning the computer to the owner from data stored in the memory of the computer.” *Id.* at 3:36–42.

The '393 patent describes three prior methods for return or recovery of products, which includes physical labels attached to the outside of the computer, software programs that attempt recovery through the use of a modem, and BIOS-based password identification systems. *Id.* at 1:34–3:21. The '393 patent seeks to improve on the prior methods. *Id.*

Figure 2 is reproduced below.

Workstation Locked	
[Picture] Red Stop Sign w/white word STOP	<u>The Retriever by WorldsecurityCorp.com</u> The workstation has been locked. This equipment is protected against theft by the World Security Corp. International Registration and Recovery System. The Retriever Program has been installed to help stop theft, protect information and recover lost or stolen equipment. To Identify Rightful Owner & <u>Avoid Prosecution</u> CALL NOW : [Recovery Name/(input from database / required)] [Organization Name / ABC Corp/ input/ not required] [Address 1 / input from database / not required] [Address 2 / input from database / not required] [City] [State] [Zip / all of these input from database / not required] [Phone 1 / input from database / required][Phone 2 / not required] [Email / input from database / required][Fax / not required] OR VISIT [Picture] Retriever Logo
	<u>www.worldsecuritycorp.com/lostandfound.html</u> <u>Email : lostandfound@worldsecuritycorp.com</u> <u>Phone : 1-800-xxx-xxxx</u> Registration # : xxxxxxxxxxxxxxxx (sequential number unique to each software license)
 User : [_____] Password : [_____] [OK] (moves user to operating system with correct password) [SHUTDOWN] (initiates operating system shutdown)	

Figure 2 illustrates a representation of a dialog box on a computer screen, which shows information the owner of the computer would like to be displayed to enable recovery of the computer.

Id. at 4:14–15; 6:39–51. The screen is displayed before, or during, a password or security prompt screen, though a security prompt is an option.

Id. at 7:3–8; 10:15–17.

The program of the '393 patent “is essentially a recovery/return information screen that is displayed, and does not attempt to duplicate or replace more sophisticated access security programs already on the system.” *Id.* at 8:30–33. “The Return/Recovery owner information display screen is displayed before the main operating system. The Return/Recovery owner information screen has been customized by the owner (and can be interactively changed using an administrative program that can be accessed when the user gets to the operating system).” *Id.* at 9:24–29. The information can be changed by a user through “remote communication.” *Id.* at 10:61–64.

The '393 patent also distinguishes between an “owner” and a “user” of a computer in some situations and “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.” *Id.* at 13:19–23; *see also id.* at 11:8–14 (defining “Owner” and “Assigned To” person). Thus, the program disclosed in the '393 patent “allows the ‘owner’ of the protected equipment to ultimately control the recovery information displayed on the protected equipment, not the user.” *Id.* at 11:27–29.

D. Challenged Claims

Petitioner challenges claims 1–7 of the '393 patent, of which claims 1, 4, and 7 are independent. Independent claim 1 is illustrative of the claimed subject matter, and 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;

initiating or changing return information which appears on the display through remote communication without assistance by a user with the computer, wherein the initiating or 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.

Ex. 1001, 16:26–44.

E. Asserted Grounds

Petitioner asserts that claims 1–7 would have been unpatentable based on the following grounds:

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

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, 125 Stat. 284 (2011), revised 35 U.S.C. § 103 effective March 16, 2013. Petitioner asserts that the references are prior art under the pre-AIA versions of these sections. Pet. 2–3. In IPR2022-01191, however, Petitioner argues that the effective filing date of the claims of the ’393 patent is after the effective date of the AIA. 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.

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

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

⁴ Angelo, US 2003/065934 A1, published Apr. 3, 2003 (Ex. 1007).

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

Pet. 3. Petitioner relies on the Declaration of Dr. Erez Zadok (Ex. 1003) in support of its contentions.

II. ANALYSIS

A. 35 U.S.C. § 314(a)

Under 35 U.S.C. § 314(a), the Director has discretion to deny institution of an *inter partes* review. *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *SAS Inst. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (“[Section] 314(a) invests the Director with discretion on the question *whether* to institute review.”); *Harmonic 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.”).

In determining whether to exercise discretion to deny institution under 35 U.S.C. § 314(a), the Board considers the trial date in related litigation as part of an assessment of all relevant circumstances of the case, including the merits, in an effort to balance considerations such as system efficiency, fairness, and patent quality. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv* Order”); *see also NHK Spring Co. v. Intrix-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 19–20 (PTAB Sept. 12, 2018) (precedential) (denying institution relying, in part, on § 314(a) because the parallel district court proceeding was scheduled to finish before the Board reached a final decision). In particular, the Board evaluates the following factors (“*Fintiv* factors”):

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

- parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
 5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
 6. other circumstances that impact the Board's exercise of discretion, including the merits.

Fintiv Order, 5–6. In evaluating these factors, “the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.* at 6.

On June 21, 2022, the Director of the United States Patent and Trademark Office (“USPTO”) issued a Memorandum⁶ to clarify “the PTAB’s current application of *Fintiv* to discretionary institutions when there is parallel litigation” and “confirm[] that the precedential import of *Fintiv* is limited to the facts of that case.” Memorandum, 2. In particular, the Memorandum sets forth that: (1) the PTAB will not rely on the *Fintiv* factors to discretionarily deny institution “where a petition presents compelling evidence of unpatentability” (*id.* at 2); (2) the *Fintiv* factors do not apply to parallel U.S. International Trade Commission proceedings (*id.* at 2–3); (3) the PTAB will not discretionarily deny institution “where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB” (*id.* at 3); and (4) “the PTAB will consider the median time from filing to disposition of the civil trial for the district in which the parallel litigation resides” (*id.*).

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

Patent Owner argues that we should exercise our discretion under 35 U.S.C. § 314(a) to deny institution in view of *Hafeman v. LG Electronics, Inc.*, No. 6:21-cv-00696-ADA (W.D. Tex.) (“LG Litigation”). Prelim. Resp. 13–26. Google and Microsoft are not named defendants in the LG Litigation, and neither has been sued for infringement of the ’393 patent. Pet. 78; Prelim. Resp. 21; Prelim. Reply 1. LG Electronics, Inc. (“LG”), the defendant in the LG Litigation, however, is identified as a real party in interest in this proceeding. Pet. 78.

Petitioner asserts (Pet. Reply 1) that LG provided Patent Owner with the following stipulation in the LG Litigation:

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. Petitioner argues that “[b]ecause no other defendant may be added to the sole litigation involving the ’393 patent,” LG’s stipulation “achieves the Director’s stated policy goals under *Sotera* of ‘mitigat[ing] concerns of potentially conflicting decisions and duplicative efforts between the district court and the PTAB,’ and ensuring that ‘the grounds the PTAB resolves will differ from those present in’ the LG Litigation. Prelim.

Reply 2 (alteration in original; citing Memorandum, 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 Board “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.”

Memorandum, 7. Petitioner could not make such a stipulation in a district court litigation to which it is not a party. Instead, LG, as the defendant in the LG Litigation and a real party in interest in this proceeding, made such a stipulation, and LG’s stipulation “mitigates concerns of potentially conflicting decisions and duplicative efforts between the district court and the PTAB.” *Id.* Indeed, in advocating for discretionary denial in view of the LG 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. Patent Owner, therefore, effectively treats Petitioner and LG as the same entity to argue for discretionary denial.

Patent Owner also contends that “LG’s stipulation came far too late” because LG already served an invalidity expert report in the LG Litigation that includes the IPR grounds, and, as a result, the parties are “forced to continue to litigate the IPR grounds in district court, including as part of rebuttal expert reports due in late January.” Prelim. Sur-reply 1; Prelim. Resp. 17–20. Patent Owner contends “the time to [offer a stipulation] was in the Petition.” Prelim. Resp. 18. We disagree that the stipulation is untimely. “[T]he only appropriate time for a petitioner to offer” such a stipulation “is prior to the Board’s decision of whether to institute review,” and LG offered

its stipulation prior to institution. *NXP USA, Inc. v. Impinj, Inc.*, IPR2021-01556, Paper 13 at 4 (PTAB Sept. 7, 2022) (precedential). Patent Owner also argues that LG’s stipulation is ineffective because “it will only take effect ‘if the above-captioned IPR is instituted.’” Prelim. Sur-reply 2 (citing Ex. 1029). Because the stipulation in *Sotera* was conditioned on institution, we disagree that LG’s similar stipulation is ineffective. *See Sotera*, Paper 12 at 18 (“Petitioner has filed in the District Court ‘a stipulation that, if IPR is instituted, they will not pursue in the District Court Litigation any ground raised or that could have been reasonably raised in an IPR.’”).

In view of LG’s *Sotera*-type stipulation, we decline to exercise our discretion under § 314(a) to deny institution of *inter partes* review.

B. Multiple Petitions

Petitioner filed two petitions challenging claims 1–7 of the ’393 patent, with this Petition ranked behind the 1191 IPR. Paper 3, 4. Petitioner argues that two petitions are justified here because there is a priority dispute that requires arguments under “completely distinct prior art combinations” to “address the different effective filing dates for the Challenged Claims.” *Id.* at 2–3. Although Patent Owner does not directly address Petitioner’s reasons for filing two petitions, in arguing in favor of discretionary denial based on the *Fintiv* factors, Patent Owner argues that the multiple petitions “would only magnify the costs of litigation, produce redundancy, and lead to inconsistent outcomes.” Prelim. Resp. 25.

In light of the priority dispute with respect to the challenged claims, we determine that two petitions are justified. *See* Patent Trial and Appeal Board Consolidated Trial Practice Guide⁷ (Nov. 2019), 59 (“[T]he Board

⁷ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>

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.”). We also note that two petitions together present a total of four grounds, and addressing the grounds in the two petitions does not create a substantial burden on the Board or the parties under these circumstances.

C. Level of Ordinary Skill in the Art

Petitioner contends that a person having ordinary skill in the art (“POSITA”) 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.” Pet. 12–13 (citing Ex. 1003 ¶¶ 95–97). Petitioner also contends that “[s]ignificantly 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.” *Id.* At this stage of the proceeding, Patent Owner neither addresses Petitioner’s proposed definition nor proposes a different level of skill in the art.

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 construe each claim “in accordance with the ordinary and customary meaning of such claim 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) (2021). Under this standard, claim terms are generally given their plain and ordinary meaning as would have been understood by a person of ordinary skill in the art at the time of the invention and in the context of the entire patent disclosure. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc). Only those terms in controversy need to be construed, and only to the extent necessary to resolve the controversy. *Realtime Data LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019).

Petitioner presents two issues for claim construction. Pet. 9–12. First, Petitioner argues that the limitations in the independent claims that require the display of recovery/return information, such as the “display on a display screen on the computer which displays return information” limitation in claim 1, should be interpreted to require the automatic display of return/recovery information “during or after **every** boot-up.” *Id.* at 9. Second, Petitioner argues that the return and recovery information recited in the claims is printed matter that is not entitled to patentable weight. *Id.* at 12. Patent Owner “takes no position” on Petitioner’s first claim construction argument, and disputes Petitioner’s second argument. Prelim. Resp. 9–13.

As discussed below, we determine that Petitioner demonstrates a reasonable likelihood of establishing that it would have been obvious to display return/recovery information after boot-up and that the asserted prior art meets the relevant claim limitations. *See infra* Section II.E. Accordingly we need not resolve any claim construction issues for purposes of this Decision. Nevertheless, to provide guidance to the parties during the trial,

we provide the following comments. As to the first issue, it is not entirely clear how Petitioner’s proposed construction of the display of return/recovery information limitation fits into the method of claim 1, which presumably is met with a single iteration. Requiring performance “during or after every boot-up” at least 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. 10–13. The parties are free to address these issues further during trial.

E. Asserted Obviousness over Jenne and Cohen

Petitioner contends that claims 1–7 would have been obvious over the combined teachings of Jenne and Cohen. Pet. 13–45.

1. Overview of Jenne

Jenne is directed to displaying “commercial messages during a user waiting time,” which may include time during software installation, screen saver operation, file download, virus scanning, low-power mode, and wake-up from low-power mode. Ex. 1005, code (57). Commercial messages, stored in non-volatile memory, are selected and displayed during the user waiting time. *Id.* ¶ 13. The commercial messages may be updated through the Internet, using a password. *Id.* According to Jenne, this advertising could generate additional revenue for the computer manufacturer. *Id.* ¶ 19.

Jenne discloses that the display of messages may be by the systems Basic Input/Output System (BIOS) during boot-up, or by the operating system after boot-up. *Id.* ¶ 23. Jenne also discloses that “[a]fter receiving user advertisement preferences, the application in block 65 checks for advertisement updates and downloads advertisements according to those user preferences from the Internet.” *Id.* ¶ 25. Alternatively, 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” and can “securely access the memory 520 through the Internet . . . for securely updating the memory 520.” *Id.*

2. Overview of Cohen

Cohen is directed to “personalizing a portable computer device.”

Ex. 1006, 1:55–57. Figure 1 of Cohen is reproduced below.

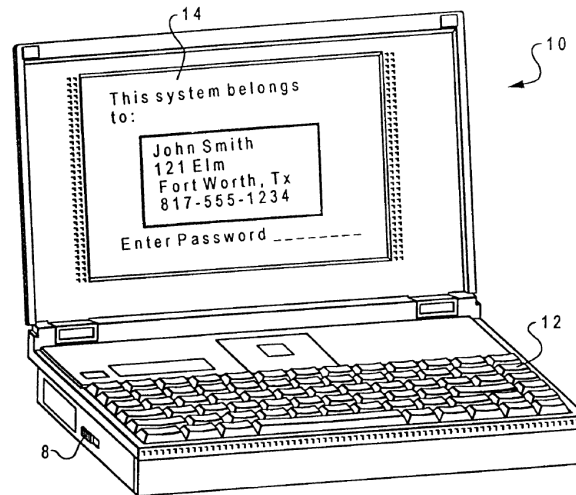


Figure 1 illustrates portable computer device 10, video display device 14, and keyboard 12.

Id. at 3:4–12. Referring to Figure 1, video display device 14 may be utilized to display an indication of ownership of portable computer device 10.” *Id.* at 3:15–17.

A user is prompted to set up the personal ownership information, which is stored. *Id.* at 3:57–4:4. Cohen’s system modifies the Power-On System Test (POST) so that after power is applied to the computer, and POST has run, the personal ownership information is displayed. *Id.* at 5:14–27. At the time of the display, a prompt for a password is displayed. *Id.* at 5:28–29. If the appropriate password has been entered, normal processing of the computer occurs. *Id.* at 5:34–41.

3. *Claims 1, 4, and 7*

Petitioner asserts, with supporting testimony from Dr. Zadok, that the combination of Jenne and Cohen teaches all of the limitations of independent claims 1, 4, and 7. Pet. 23–41. In particular, Petitioner relies on Jenne for its teachings of displaying messages during boot-up of a computer and updating those messages remotely, and on Cohen to teach automatic display of ownership information each time the computer is powered on. Pet. 13–18, 23–41.

In that regard, Jenne teaches 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.” *Id.* ¶ 22. Jenne teaches that “the non-volatile memory containing the displayed messages ‘may be updated securely through the Internet.’” *Id.* at code (57); *see also id.* ¶ 25 (“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.”). Cohen teaches 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 teaches 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. *Id.* at 5:5–42, Fig. 4.

Petitioner contends that

[a] POSITA would have found it obvious to combine Jenne's teachings of remotely updateable automatic display of messages during the boot process with Cohen's teaching of displaying ownership indicia messages with a security (lock) screen on every boot of the device to prohibit a user from accessing the device until the proper security credentials (e.g., password) are entered.

Pet. 19 (citing Ex. 1003 ¶¶ 291–99). Petitioner provides several reasons why a POSITA would have been motivated to make the proposed combination. *Id.* at 19–22. For example, Petitioner contends that “Jenne provides a motivation to display information to a computer user during and after boot-up because ‘the user is a captive audience.’” *Id.* at 19 (citing Ex. 1005 ¶ 20; Ex. 1003 ¶ 292). Petitioner contends that, because Jenne teaches that information other than commercial messages can be displayed during boot-up, a POSITA would have “been motivated to display ownership information to this captive audience” to increase “the likelihood that a lost or misplaced computer will be returned to its owner,” as taught by Cohen. *Id.* (citing Ex. 1005 ¶ 22; Ex. 1003 ¶ 292 (citing Ex. 1006, 5:43–48)).

Petitioner provides a detailed analysis explaining how the combination of Jenne and Cohen teaches the subject matter of claims 1, 4, and 7. Pet. 23–41. For example, claim 1 recites “initiating or changing return information which appears on the display through remote communication without assistance by a user with the computer.” Ex. 1001, 16:32–34. Claims 4 and 7 include similar limitations. *Id.* at 16:66–17:2, 18:12–14. Petitioner addresses “changing” rather than “initiating,” noting that only one of these needs to be met by the prior art. Pet. 33–35; *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 contends that “[t]he combination of Jenne and Cohen teach remotely changing return/recovery information.” *Id.*

Specifically, Petitioner relies on Jenne’s disclosures of remotely updating the message content and on Cohen’s teachings that the owner of the system enters “textual indicia of personal ownership” during set-up or a configuration change and “that the owner may thereafter change the indicia information.” Pet. 33–34 (citing Ex. 1005, code (57), ¶ 25; Ex. 1006, 4:31–34, 6:23–26). Petitioner argues that, based on the teachings in Cohen, “a POSITA would have been motivated to incorporate the capability to change the stored ownership information using Jenne’s ‘*remote communication*’ so that the most up to date ownership information is displayed when a device is lost or stolen.” *Id.* at 34–35 (citing Ex. 1005, code (57), ¶¶ 13, 21, 25; Ex. 1006, 4:31–34, 6:23–26; Ex. 1003 ¶¶ 313–317, 349–354, 372) (parenthetical omitted).

Claim 1 also recites “wherein the initiating or changing of the return information is done through an interactive program . . . 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.” Ex. 1001, 16:34–41. Claims 4 and 7 include similar limitations. *Id.* at 17:2–8, 18:14–19. Petitioner identifies Jenne’s commercial message application 540 as the claimed “interactive program” and contends that the combination of Jenne and Cohen demonstrates “the capability for the device owner to remotely change the displayed return/recovery information including ownership indicia.” Pet. 36 (citing Ex. 1005 ¶¶ 25, 27). Petitioner also contends that “Jenne discloses that remotely ‘*changing*’ stored messages requires entry of a password” and that “[a] POSITA would have understood that in the

combination of Jenne and Cohen in which the displayed message includes ownership indicia, only the ‘*owner of the computer or the party authorized by the owner*’ has access to the password and therefore the ability to change the remote/recovery information.” *Id.* at 37 (citing Ex. 1005 ¶ 25; Ex. 1003 ¶¶ 322, 325, 355–356).

Patent Owner makes three arguments in response. First, Patent Owner argues that Jenne “does not disclose **anything** about display of ‘return information.’ It simply discloses display of advertisements in an effort to maximize user entertainment and revenue.” Prelim. Resp. 27. Patent Owner also argues that Cohen discloses displaying return information during boot-up, but “only discloses that such information is input **locally** on the device, during ‘set-up,’” and does not disclose that a user can change the information, locally or otherwise. *Id.* at 27–28 (citing Ex. 1006, 4:27–44). Patent Owner further argues “there is no reason why” Jenne’s teaching that “other information could be displayed” “would have led a POSITA specifically to display **ownership** information in Jenne.” *Id.* at 28. According to Patent Owner, Petitioner does not articulate “any plausible reason why a POSITA, in 2002, would have been led to convert Jenne’s **advertising** system into a system for **remote changing of ownership information**.” *Id.* at 29.

Based on the record before us, we disagree. Petitioner contends that a POSITA would have been motivated to display ownership information to the captive audience described in Jenne because displaying this information increases the likelihood that a lost or misplaced computer will be returned to its owner. Pet. 19 (citing Ex. 1003 ¶ 292). And, as Petitioner points out, Cohen expressly teaches that displaying ownership indicia automatically upon boot-up of the device “provides a technique whereby the likelihood

that a lost or misplaced personal computer device will be returned to its owner has been greatly enhanced and whereby ownership of otherwise fungible devices may be easily determined.” Ex. 1006, 5:49–56; Pet. 19 (citing Ex. 1003 ¶ 292 (citing Ex. 1003, 5:43–58)). Accordingly, we determine that Petitioner adequately establishes, for purposes of institution, that a POSITA would have been motivated to combine Jenne and Cohen as proposed.

Second, Patent Owner argues that Jenne does not teach “initiating or changing return information . . . through remote communication without assistance by a user with the computer.” Prelim. Resp. 31–35. In particular, Patent Owner argues that “Jenne teaches that its update and download process relies on feedback from the user to provide advertisements that are ‘tailored to the users’ interest.’” *Id.* at 31 (citing Ex. 1005 ¶ 20). According to Patent Owner, “[w]ithout such input, Jenne would never update or download advertisements.” *Id.* at 32.

Although Patent Owner is correct that Jenne teaches that its system has the ability to update advertisements based on user feedback, Petitioner’s contentions do not rely on Jenne’s display of advertisements. Instead, Petitioner relies on Jenne’s teachings regarding remotely updating other displayed information, along with Cohen’s teachings regarding entering ownership information for display. Pet. 33–35. Moreover, Jenne teaches that updates can occur automatically during execution of the application and that “[t]he computer manufacturer may also check for updates and downloads . . . via a manufacturer password that only the manufacturer or its authorized agent possesses.” Ex. 1005 ¶ 25. On this record, we are persuaded that Petitioner sufficiently establishes that the proposed combination of Jenne and Cohen teaches changing return information

through remote communication without assistance by a user with the computer as claims 1, 4, and 7 require.

Finally, Patent Owner argues that Petitioner does not establish that the combination of Jenne and Cohen teaches 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. Patent Owner argues that “Jenne teaches that ‘the computer user could uninstall or delete the commercial message application’” and “Jenne’s ‘computer user’ is not the owner or authorized party.” *Id.* at 35 (citing Ex. 1005 ¶ 21). Patent Owner also argues that Jenne teaches that “a premium user can disable, enable, and save the displayed advertisements.” *Id.* at 36–37. Thus, Patent Owner argues, “Jenne does not teach that its ‘commercial message application’ ‘is remotely accessed *only* by the owner’ or the owner’s ‘authorized’ party, as Petitioner must show.” *Id.* at 36.

The claims, however, only limit *remote* access to “the owner of the computer or the party authorized by the owner.” Ex. 1001, 16:36–40, 17:4–8, 18:15–19. Jenne teaches that remote updating requires 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.”). Cohen similarly teaches a password “may be required to alter the ownership indicia which will be entered as part of the process.” Ex. 1006, 4:23–26. In addition, Dr. Zadok testifies that Cohen teaches that the owner may change the ownership information using a password, and that a person of ordinary skill would have understood that only the owner of the computer or the party authorized by the owner would have had access to the password and therefore the ability to

change the ownership information, so that the most up-to-date ownership information is displayed. Ex. 1003 ¶¶ 294 (citing Ex. 1006, 4:23–26), 322–325, 329. We are persuaded that Petitioner sufficiently establishes, for purposes of institution, that the proposed combination of Jenne and Cohen teaches an “interactive program . . . which is remotely accessed only by the owner of the computer or the party authorized by the owner” as required by claims 1, 4, and 7.

Having reviewed Petitioner’s contentions for all of the elements of independent claims 1, 4, and 7, and Petitioner’s contentions regarding reasons to combine the teachings of Jenne and Cohen, and based on the record before us, we determine that Petitioner establishes a reasonable likelihood that they would prevail in showing that claims 1, 4, and 7 would have been obvious over the combined teachings of Jenne and Cohen. Pet. 19–41.

4. Claims 2, 3, 5, and 6

Petitioner contends that the combined teachings of Jenne and Cohen teach all of the limitations of claims 2 and 3, which depend from claim 1, and claims 5 and 6, which depend from claim 4. Pet. 41–45. Patent Owner does not offer any arguments addressing dependent claims 2, 3, 5, and 6 at this stage of the proceeding. Having reviewed Petitioner’s assertions regarding claims 2, 3, 5, and 6, as well as the supporting evidence, we determine on this record that Petitioner demonstrates a reasonable likelihood of establishing that these claims would have been obvious as well.

5. Conclusion: Claims 1–7

For the reasons discussed above and based on the record before us, we are persuaded that Petitioner establishes a reasonable likelihood of prevailing in showing that claims 1–7 would have been obvious over the

combined teachings of Jenne and Cohen. Pet. 19–45. Accordingly, we institute an *inter partes* review of the challenged claims.

F. Asserted Obviousness over Angelo and Helle

Petitioner contends that claims 1, 4, and 7 would have been obvious over the combined teachings of Angelo and Helle. Pet. 45–73. Patent Owner disagrees. Prelim. Resp. 38–50. Having determined that Petitioner establishes a reasonable likelihood of showing that at least one of the challenged claims is unpatentable as set forth above, we institute an *inter partes* review based on this ground 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 the grounds of unpatentability asserted for each claim.”). We provide the following comments to provide guidance to the parties during trial.

Angelo describes a system that, upon its theft, broadcasts an authenticated security message to a remote computer device “to cause the computer device to protect its data.” Ex. 1007 ¶ 4. The remote computer device can respond in a number of ways, such as “lock[ing] the machine down while displaying a message with a return address for the device or a telephone number to call.” *Id.* ¶ 23.

Helle describes a system of controlling a mobile phone after it is lost or stolen to prevent its use except to help the owner find it. Ex. 1008, code (57). In Helle’s system, a phone asks for entry of a PIN code when turned on, and if the code is successfully entered, the phone can be used normally. *Id.* at 3:5–9. If the code is not successfully entered, an “owner information” display is shown, and the phone is locked. *Id.* at 3:10–14. Helle also teaches that the “secure mode” of the phone can be switched on “by remote control, using a control message, while the mobile phone 10 is

‘on’.” *Id.* at 3:47–51. Depending on which control message is sent to the phone, the phone may display, for example, either a “phone stolen display message” or a “phone lost display message.” *Id.* at 4:5–29.

Petitioner contends that

[a] POSITA 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. 49 (citing Ex. 1003 ¶¶ 415–442). Petitioner provides several reasons why a POSITA would be motivated to make the proposed combination. *Id.* at 49–53.

Claim 1 recites displaying “on a display screen on the computer which displays information concerning return information.” Ex. 1001, 16:28–30.

Claims 4 and 7 include similar limitations. *Id.* at 16:62–63, 18:5–6.

Petitioner contends that these limitations “should be construed as ‘automatically displaying return/recovery information during or after **every** boot-up.’” Pet. 9. Patent Owner argues that “[n]either Angelo nor Helle teaches displaying the alleged return/recovery information ‘during or after **every** boot-up.’” Prelim. Resp. 38. Patent Owner asserts that Angelo’s “‘security commands’ cause various ‘destructive actions’ to occur” and that “Angelo teaches that these actions are performed only after ‘the security stations 102 transmits a security message to the portable device 100.’” *Id.* at 38–39 (citing Ex. 1007 ¶¶ 11, 22–24). Patent Owner also argues that “Helle teaches that the phone or lost messages appear when the PIN is not entered correctly or the PIN query is cancelled” but that “the phone

‘operates normally if the SIM card is recognized’ and ‘the PIN code is successfully entered.’” *Id.* at 42 (citing Ex. 1008, claims 1, 2, 9).

Patent Owner’s arguments appear to be based on its contention that “Petitioner does not rely on the ‘basic security mechanism of a password or code screen’ as taught by Angelo or Helle” in order to meet this limitation of claims 1, 4, and 7. Prelim. Resp. 42. Petitioner’s proposed combination, however, is based on integrating Helle’s teachings regarding the content of the messages and stored information into “Angelo’s security system having a *basic security mechanism* (password protection) and enhanced security features when a device is lost or stolen.” Pet. 49 (emphasis added). And, before describing Angelo’s “additional security features,” Petitioner contends “both Angelo and Helle disclose a password/code screen displayed every time the device is activated (e.g., on boot or from sleep state).” *Id.* at 58 (citing Ex. 1003 ¶¶ 450–462, 500, 519). Accordingly, Patent Owner’s arguments do not appear to address Petitioner’s contentions.

Patent Owner also argues that Angelo and Helle, either alone or in combination, do not disclose “initiating or changing return information . . . through remote communication *without assistance by a user* with the computer” as claims 1, 4, and 7 require. Prelim. Resp. 45. Specifically, Patent Owner argues that, because the lock or lost message is only displayed when a PIN query is cancelled or an incorrect PIN is entered, Helle does require assistance in order to display return/recovery information. *Id.* Patent Owner argues that Angelo “is simply silent on whether user assistance is required” and “does not disclose that the owner may remotely *change* the return information—as required by all challenged claims.” *Id.* at 46.

With respect to the “without assistance by the user with the computer” element, Petitioner relies on Angelo’s teaching that the enhanced security

features are used when the device is lost or stolen and that it is the authorized person (or owner) that initiates remote communication of the security action “without input from the device’s current user.” Pet. 66 (citing Ex. 1003 ¶¶ 464, 504–505, 521). With respect to Patent Owner’s contention that Angelo does not disclose remotely changing return information “as required by all challenged claims,” we agree with Petitioner, that the “use of the disjunctive ‘or’ in ‘*initiating or changing*’ . . . means that only one of these alternatives need be satisfied by the prior art.” Pet. 33. Thus, Patent Owner’s contention that the “changing” alternative is “required by all challenged claims” is based on an incorrect construction of the claim. See Prelim. Resp. 27 (agreeing with Petitioner, that “Petitioner only needs to establish that one of the two is satisfied.”). Petitioner contends that Angelo teaches the “initiating” alternative in disclosing that “the authorized person can contact the security station 102 to initiate a security procedure.” Pet. 64–65 (citing Ex. 1007 ¶ 27). Further, Petitioner relies on the combination of Angelo and Helle—not Angelo alone—to teach “initiating or changing return information . . . through remote communication” element of the claim. *Id.* at 50–51, 66–68.

Patent Owner further argues that Petitioner fails to identify “an interactive program stored in the memory of the computer” as required by claims 1, 4, and 7. Prelim. Resp. 47–50. But, on this record, we understand Petitioner to be arguing that Angelo’s portable device includes non-volatile memory and a CPU that requires software stored in non-volatile memory to perform any actions and that Helle teaches using software to control security and owner information display. Pet. 55 (citing Ex. 1007 ¶¶ 27, 33; Ex. 1008, 3:35–39, 4:35–39; Ex. 1003 ¶¶ 511–515); *see id.* at 69. We also understand Petitioner to be arguing that Angelo’s “remote security station interacts with

the portable device to both initiate the display of return/recovery information as well as to change the return/recovery information to be displayed on the screen.” *Id.* at 69; *see id.* at 64–65. On this record, we are persuaded that Petitioner’s discussion of the particular structures and operations in Angelo and Helle sufficiently identifies the evidence that supports Petitioner’s contention that the combined teachings of Angelo and Helle teach “an interactive program” as required by claims 1, 4, and 7. *See* 37 C.F.R. § 42.104(b)(4).

III. CONCLUSION

Based on the arguments in the Petition, the Preliminary Response, the Preliminary Reply, and the Preliminary Sur-reply, and the evidence of record, we determine that Petitioner establishes a reasonable likelihood that it will prevail on its challenge to at least one claim of the ’393 patent. Additionally, we decline to exercise our discretion under 35 U.S.C. § 314(a). Accordingly, we institute an *inter partes* review of all the challenged claims on all the grounds presented in the Petition.

The factual findings set forth in this Decision are preliminary and provided for the sole purpose of deciding whether to institute a review. Any final findings will be based on the full trial record, including any information presented in a timely filed response to the Petition. *See Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed. Cir. 2016) (noting that “there is a significant difference between a petitioner’s burden to establish a ‘reasonable likelihood of success’ at institution, and actually proving invalidity by a preponderance of the evidence at trial”) (quoting 35 U.S.C. § 314(a) and comparing *id.* with § 316(e)).

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that an *inter partes* review is instituted with respect to the grounds asserted 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 shall commence on the entry date of this Decision.

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FOR PETITIONER:

Matthew A. Smith
Andrew S. Baluch
SMITHBALUCH 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