

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC, MICROSOFT CORPORATION,
Petitioner,

v.

CAROLYN W. HAFEMAN,
Patent Owner.

IPR2022-01191
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. 80. Patent Owner identifies Carolyn W. Hafeman 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. 80; 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 IPR2022-01190 (“the 1190 IPR”), filed by Petitioner. Pet. 80; 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. 80; 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 3:46–51.

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	
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 Retriever Logo <u>www.worldsecuritycorp.com/lostandfound.html</u> Email : <u>lostandfound@worldsecuritycorp.com</u> Phone : 1-800-xxx-xxxx 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	102(a)(1) ¹	Hafeman 670 ²
1–7	103	Hafeman 298, ³ Chiu ⁴

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

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, 125 Stat. 284 (2011), revised 35 U.S.C. §§ 102 and 103 effective March 16, 2013. Petitioner argues that the effective filing date of the claims of the ’393 patent is after the effective amendment date of the AIA, thereby subjecting them to the AIA versions of §§ 102 and 103. Pet. 2–3 n.2.

² Hafeman, US 2005/0071670 A1, published Mar. 31, 2005 (Ex. 1011).

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

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

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. Intri-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 Memorandum⁵ 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.*).

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*,

⁵ Available at:

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

Inc., No. 6:21-cv-00696-ADA (W.D. Tex.) (“LG Litigation”). Prelim. Resp. 12–26. Google and Microsoft are not named defendants in the LG Litigation, and neither has been sued for infringement of the ’393 patent. Pet. 78–79; 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. 80.

Petitioner asserts 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 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. 22. 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. 17. 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 first, and the 1190 IPR ranked second. 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. 24.

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 Guide⁶ (Nov. 2019), 59 (“[T]he Board recognizes that there may be circumstances in which more than one petition

⁶ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>

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. 27 (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. 23–27. 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.” *Id.* at 23–26. Second, Petitioner argues that the return and recovery information recited in the claims is merely printed matter that is not entitled to patentable weight. *Id.* at 26–27. Patent Owner “takes no position” on Petitioner’s first claim construction argument, and disputes Petitioner’s second argument. Prelim. Resp. 8–12.

We determine that no claim term requires express construction for purposes of this Decision.

E. Earliest Effective Filing Date

The ’393 patent issued from U.S. Patent Application No. 16/377,768 (“the ’768 application”), which was filed on April 8, 2019. Ex. 1001, codes (21), (22). The application claims the benefit, through a series of continuation applications, of Application No. 10/945,332 (“the ’332 application”), filed on Sept. 20, 2004, now Pat. No. 8,601,606 (“the ’606

patent”), which is a continuation-in-part of Application No. 10/304,827 (“the ’827 application”), filed on Nov. 25, 2002 (now abandoned). *Id.* at code (63). The ’332 application was published as Hafeman 670 on March 31, 2005. Ex. 1011, codes (10), (21), (43). The ’827 application was published as Hafeman 298 on May 27, 2004. Ex. 1009, codes (10), (21), (43).

Petitioner contends that the challenged claims are not entitled to the benefit of the filing date of either the ’827 application or the ’332 application because neither “provide[s] adequate written description support for at least the limitation: ‘initiating or changing [the] [return]/[recovery] information [which appears on the display] through remote communication without assistance by a user with the computer’” recited in each independent claim. Pet. 12 (first alteration added; emphasis omitted; citing Ex. 1003 ¶ 65). As a result, Petitioner contends, the claims of the ’393 patent are not entitled to claim the benefit of either the November 25, 2002 filing date of the ’827 application or the September 20, 2004 filing date of the ’332 application. *Id.* at 11.

“It is elementary patent law that a patent application is entitled to the benefit of the filing date of an earlier filed application only if the disclosure of the earlier application provides support for the claims of the later application, as required by 35 U.S.C. § 112.” *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306 (Fed. Cir. 2008) (citations omitted); *see also Research Corps. Techs. v. Microsoft Corp.*, 627 F.3d 859, 871–72 (Fed. Cir. 2010) (holding that claims of the later-filed application, which were not limited to a “blue noise mask,” were “not entitled to claim the benefit of their parent applications’ filing dates”); *ICU Med., Inc. v. Alaris Med. Sys.*, 558 F.3d 1368, 1377–78 (Fed. Cir. 2009) (holding that

“spikeless” claims “added years later during prosecution” were not supported by the specification which “describe[d] only medical valves with spikes”); *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1158–60 (Fed. Cir. 1998) (holding the generic shaped cup claims of the later-filed child application were not entitled to the filing date of the parent application that “disclosed only a trapezoidal cup and nothing more”). “To satisfy the written description requirement the disclosure of the prior application must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, [the inventor] was in possession of the invention.” *PowerOasis*, 522 F.3d at 1306 (emphasis omitted; alteration in original; citations and quotations omitted). The sufficiency of written description support is based on “an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

“In an *inter partes* review, the burden of persuasion is on the petitioner to prove ‘unpatentability by a preponderance of the evidence,’ . . . and that burden never shifts to the patentee.” *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (quoting 35 U.S.C. § 316(e)). The burden of production can shift to the patent owner, however. *See id.* at 1379. This shift happens where it is “warranted because the patentee affirmatively seeks to establish a proposition not relied on by the patent challenger and not a necessary predicate for the unpatentability claim asserted—effectively an affirmative defense.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1376 (Fed. Cir. 2016).

1. The ’827 Application

Patent Owner agrees with Petitioner that the ’827 application “does not disclose **anything** relating to ‘initiating or changing return information

which appears on the display ***through remote communication*** without assistance by a user with the computer’—as is required by all challenged claims.” Prelim. Resp. 6–7 (citing Pet. 12–15). Accordingly, based on the record before us, we determine that Petitioner adequately establishes that the challenged claims of the ’393 patent are not entitled to the benefit of the November 11, 2002 filing date of the ’827 application.

2. *The ’332 Application*

Petitioner asserts that the ’332 application “fails to provide adequate written description support within the four corners of the specification for at least the following limitation included in all the independent claims of the ’393 patent: ‘***initiating . . . [return/recovery] [...] information through remote communication***’ (‘remote initiating’ limitation).” Pet. 15 (alterations in original). In particular, Petitioner contends that, “[t]o the extent that the [’332 application’s] specification discusses ‘initiating return/recovery information,’ it teaches that such initiating is performed locally at the device (*i.e.*, computer 12) and **not remotely** (*i.e.*, remote station).” *Id.* at 16.

Patent Owner responds that, “[b]ecause the ’393 patent is a straight continuation of Hafeman ’670, and Petitioner concedes that they have the same specification, the ’393 patent is entitled to the priority date of Hafeman ’670, as a matter of black letter law.” Prelim. Resp. 34. According to Patent Owner, Petitioner’s arguments to the contrary are “an argument for invalidity under 35 U.S.C. § 112(a)” that the Board cannot consider during an *inter partes* review. *Id.* at 35. We disagree. Patent Owner’s argument is based on Petitioner’s assertion that “Hafeman 670 contains the identical specification to the ’393 patent.” Prelim. Resp. 34 (quoting Pet. 28). Because an application’s claims are part of the

specification (35 U.S.C. § 112(b)), we understand Petitioner’s statement that the ’393 patent and Hafeman 670 have the “identical specification” to exclude the claims of both the ’393 patent and Hafeman 670, which are plainly not identical. *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))).

This distinction is important because the original claims that were filed as part of the application for the ’393 patent include the remote initiating limitation. Ex. 1012, 31–33.⁷ Thus, the remote initiating limitation could have adequate written description support in the specification of the ’393 patent 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 remote initiating limitation in its original claims, provides adequate written description support for the claims of the ’393 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 remote initiating limitation in the ’393 patent claims.

The “initiating” language was first added during the prosecution of the ’332 application in an amendment filed in July 2006. Ex. 1012, 114–22; *see* Pet. 15–16 (discussing this amendment). Specifically, pending claim 1

⁷ We refer to the page numbers added by Petitioner on the bottom left-hand corner of the page.

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 other pending independent claims were similarly amended 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 (*id.* at 123), which is encompassed in the following sentence: “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.” *Id.* at 37 (31:1–5)⁸; *see* Ex. 1001, 13:19–23 (same).

Patent Owner argues that this and other disclosures in the ’332 application adequately support the “initiating” language by showing that the owner can remotely control the displayed screen. Prelim. Resp. 37–40 (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 the cited passages show remote control capability. The issue here, however, is whether these disclosures are adequate written description support for the remote initiating limitation, namely, “initiating . . . [return/recovery] [...] information through remote communication.” 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 ’393 patent

⁸ In parentheses, we include the original specification page number with line citations.

claims. Even if the conjunctive “initiating *and* changing recovery information” limitation added to the pending claims in the ’332 application is supported by the description of changing information on the screen, the ’393 patent claims recite the disjunctive language “initiating *or* changing.” The ’332 application, therefore, must provide written description support for a remote “initiating” operation alone. It is not clear, on this record, that controlling information that is already being displayed is the same as initiating that information.

On this record, we are persuaded by Petitioner’s position that, in the ’332 application, disclosures regarding initiating a display of return information do not refer to a remote operation. Pet. 16–23. The ’332 application uses the term “initiate” or forms thereof several times, mostly within the context of the computer’s display during the start-up process. 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) (emphasis added). Similarly, the ’332 application states: “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) (emphasis added). Here, “initiates” and “initiating” refer to the initial display of the information done locally by the computer during start-up, before displaying a security or password prompt. *See also* Ex. 1012, 20 (14:1–14) (describing step by step operation of the program, including that

“[t]he computer 12 security software return/recovery program automatically initiates during the computer’s 12 boot-up process”).

The ’332 application also counsels against initiating the display of the return information *after* the display of a password or security prompt screen:

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 further supports the position that the ’332 application’s description of “initiating” does not refer to remote operation.

In addition, the ’332 application describes manually or automatically initiating the display of return information at a time after the initial boot-up, but does not refer to remote initiation:

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) (emphases added).

For all of these reasons, and on the present record, we agree with Petitioner's position that the remote initiating limitation recited in independent claims 1, 4, and 7 lacks written description support in the '332 application. Accordingly, we determine that Petitioner establishes a reasonable likelihood that it would prevail in showing that the challenged claims are not entitled to the benefit of the September 20, 2004 filing date of the '332 application.

3. *Conclusion*

We preliminarily determine, based on the record before us, that Petitioner adequately establishes that the '827 and '332 applications do not provide written description support for the challenged claims. Accordingly, at this stage of the proceeding, we agree with Petitioner's position that the earliest possible effective filing date of the '393 patent is November 22, 2013 (the filing date of the next continuation in the chain). Pet. 2–3; 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).

F. Asserted Anticipation by Hafeman 670

Petitioner contends that claims 1–7 are anticipated by Hafeman 670. Pet. 71–76. Hafeman 670 is the publication of the '332 application, which was filed on September 20, 2004 and published on March 31, 2005. Ex. 1011, codes (22), (43). Petitioner contends that Hafeman 670 “is prior

art under at least AIA § 102(a)(1).” Pet. 3. Patent Owner argues that Hafeman 670 provides written description support for the claims of the ’393 patent, and therefore is not prior art, as discussed in Section II.E. above. Prelim. Resp. 34–42. Having preliminarily determined that the earliest possible effective filing date of the ’393 patent is November 22, 2013, we are persuaded, on this record, that Petitioner adequately establishes that Hafeman 670 is prior art to the ’393 patent.

Petitioner asserts that “the challenged claims do not require both remotely initiating and remotely changing the return/recovery information, rather they require one or the other.” Pet. 72; *see also id.* at 51 (“The use of the disjunctive ‘or’ in *initiating or changing*’ in the Remotely Initiating or Changing Limitations means that only one these alternatives need be satisfied by the prior art.”). Petitioner contends that although Hafeman 670 does not disclose initiating the return/recovery information, it does disclose “the ability to **remotely change** the locally stored return/recovery information that is displayed on the device.” *Id.* at 72 (citing Ex. 1003 ¶¶ 232, 255–56, 267–68). Petitioner also contends that Hafeman 670 discloses the other limitations of the challenged claims. *Id.* at 71–76. Patent Owner does not offer any arguments addressing this ground beyond its arguments regarding the earliest effective filing date of the ’393 patent, discussed above.

Having reviewed Petitioner’s assertions regarding claims 1–7, as well as the supporting evidence, we determine on this record that Petitioner demonstrates a reasonable likelihood of establishing that claims 1–7 are anticipated by Hafeman 670, and we institute an *inter partes* review. Pet. 71–76.

G. Alleged Obviousness over Hafeman 298 and Chiu

Petitioner contends that claims 1–7 would have been obvious over the teachings of Hafeman 298 and Chiu. Pet. 30–69. 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 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 ’393 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 based on 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

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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