

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC, MICROSOFT CORPORATION,  
Petitioner,

v.

CAROLYN W. HAFEMAN,  
Patent Owner.

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IPR2022-01192  
Patent 9,892,287 B2

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

SMITH, *Administrative Patent Judge*.

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

## I. INTRODUCTION

### A. Background and Summary

Petitioner filed a Petition (Paper 4, “Pet.”) requesting *inter partes* review of claims 1–7 of U.S. Patent No. 9,892,287 B2 (Ex. 1001, “the ’287 patent”) pursuant to 35 U.S.C. § 311(a). Patent Owner filed a Preliminary Response (Paper 8, “Prelim. Resp.”) pursuant to 35 U.S.C. § 313. With Board authorization, Petitioner filed a Reply to the Preliminary Response (Paper 11), and Patent Owner filed a Sur-reply to Petitioner’s Reply (Paper 14). Petitioner also filed an explanation for filing multiple petitions ranking this Petition in this proceeding behind its petition in IPR2022-01193 (Paper 3).

Pursuant to 35 U.S.C. § 314(a), the Director may not authorize an *inter partes* review unless the information in the petition and preliminary 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.” For the reasons that follow, we institute an *inter partes* review as to claims 1–7 of the ’287 patent on all grounds of unpatentability asserted in the Petition.

### 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 parties also identify five Petitions for *inter partes* review related to the ’287 patent, between the same parties as this Petition:

IPR2022-01188, IPR2022-01189, IPR2022-01190, IPR2022-01191, and IPR2022-01193.

*C. The '287 Patent*

The '287 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, 1:22–26. The '287 patent teaches a “displaying automatically a return screen on a display of the computer during or after boot-up 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 a memory of the computer.” *Id.* at 4:9–16.

The '287 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 1:30–3:32. The '287 patent seeks to improve on the prior methods. *Id.*

Figure 2 is reproduced below.

| Workstation Locked                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                             |                                                                                                                                                                                                                                                                                                                                                                                                                                                                                 |
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| <div style="display: flex; align-items: center;"> <div style="text-align: center; width: 30px;"> <div style="border: 1px solid black; width: 15px; height: 15px; margin: 0 auto;"></div> <div style="font-size: 8px; line-height: 1;">Red Stop<br/>Sign w/white<br/>word STOP</div> </div> <div style="margin-left: 10px;"> <p><u>The Retriever by WorldsecurityCorp.com</u></p> <p>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.</p> <hr style="width: 50%; margin: 10px auto;"/> <p>To Identify Rightful Owner &amp; <u>Avoid Prosecution</u> CALL NOW :</p> <p>[Recovery Name/(input from database / required)]<br/> [Organization Name / ABC Corp/ input/ not required]<br/> [Address 1 / input from database / not required]<br/> [Address 2 / input from database / not required]<br/> [City] [State] [Zip / all of these input from database / not required]<br/> [Phone 1 / input from database / required][Phone 2 / not required]<br/> [Email / input from database / required][Fax / not required]</p> <p>OR VISIT</p> <div style="display: flex; align-items: center;"> <div style="text-align: center; width: 30px;"> <div style="border: 1px solid black; width: 15px; height: 15px; margin: 0 auto;"></div> <div style="font-size: 8px; line-height: 1;">Retriever Logo</div> </div> <div style="margin-left: 10px;"> <p><u>www.worldsecuritycorp.com/lostandfound.html</u></p> <p>Email : <u>lostandfound@worldsecuritycorp.com</u></p> <p>Phone : 1-800-xxx-xxxx</p> </div> </div> <p>Registration # : xxxxxxxxxxxxxxxx (sequential number unique to each software license)</p> </div> </div> | <div style="text-align: center; margin-top: 20px;"> User :      [ _____ ]<br/><br/> Password : [ _____ ] </div> <div style="display: flex; justify-content: space-around; margin-top: 20px;"> <div style="text-align: center;"> <p>[OK]</p> <p style="font-size: 8px;">(moves user to operating system with correct password)</p> </div> <div style="text-align: center;"> <p>[SHUTDOWN]</p> <p style="font-size: 8px;">(initiates operating system shutdown)</p> </div> </div> |

Figure 2 above illustrates 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 4:25–26; 6:53–65. The screen is displayed before, or during, a password or security prompt screen. *Id.* at 7:13–18; 10:56–58.

The program of the '287 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 8:48–51. “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 9:43–49. The information can be changed by a user through “remote communication.” *Id.* at 11:13–15.

The ’287 patent 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 down-load of changes to the protected equipment, control the entire recovery screen displayed, and even override the ‘assigned to’ person’s input.” *Id.* at 14:4–9; *see also id.* at 11:53–60 (defining “Owner” and “Assigned To” person). This “allows the ‘owner’ of the protected equipment to ultimately control the recovery information displayed on the protected equipment, not the user.” *Id.* at 12:1–3.

#### *D. Illustrative Claim*

Challenged claim 1 of the ’287 patent recites:

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 recovery information, to facilitate return of the computer so the return information is visible to anyone viewing the display screen;

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 warning message to the user.

Ex. 1001, 17:13–34.

*E. Evidence*

Petitioner relies on the following prior art:

U.S. Patent Appl. Publ. No. 2003/0122864 A1, published July 3, 2003, filed Dec. 31, 2001 (Ex. 1005, “Jenne”);

EP 0687968 A2, published Dec. 20, 1995 (Ex. 1006, “Cohen”);

U.S. Patent Appl. Publ. No. 2003/0065934 A1, published Apr. 3, 2003, filed Sept. 28, 2001 (Ex. 1007, “Angelo”);

U.S. Patent No. 6,662,023 B1, issued Dec. 9, 2003, filed July 6, 2000 (Ex. 1008, “Helle”).

*F. Prior Art and Asserted Grounds*

Petitioner asserts that claims 1–7 of the ’287 patent are unpatentable on the following grounds:

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

## II. ANALYSIS

### A. Discretionary Denial

#### 1. 35 U.S.C. § 314(a) (Fintiv)

Patent Owner argues that we should exercise discretion to deny institution under 35 U.S.C. § 314(a) because the factors identified in *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv* Order”), weigh in favor of denying institution in view of the proceedings in *Hafeman v. LG Electronics, Inc.*, No. 6:21-cv-00696-ADA (W.D. Tex.) (“district court litigation”). Prelim. Resp. 13–26; Paper 14. Petitioner argues we should not discretionarily deny institution. Pet. 75–77; Paper 11. For the reasons discussed below, we do not exercise discretion to deny institution.

Under § 314(a), the Director has discretion to deny institution of an *inter partes* review (see *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”)<sup>1</sup> 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 ’287 patent and, therefore, is not a defendant in the district court litigation. Paper 11 at 1. 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).

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<sup>1</sup> Available at [https://www.uspto.gov/sites/default/files/documents/interim\\_proc\\_discretionary\\_denials\\_aia\\_parallel\\_district\\_court\\_litigation\\_emo\\_20220621.pdf](https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_emo_20220621.pdf).

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

We agree with Petitioner. Our binding guidance states that “the PTAB will not discretionarily deny institution of an IPR or PGR in view of parallel district court litigation where a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition.” Interim Procedure 7. Petitioner could not make such a stipulation in district court litigation to which it is not a party. The defendant in that litigation, LG Electronics Inc., which is a real party in interest in this proceeding (Pet. 78), made such a stipulation. Thus, this stipulation “mitigates concerns of potentially conflicting decisions and duplicative efforts between the district court and the PTAB.” *See* Interim Procedure 7. Indeed, in advocating for discretionary denial in view of the district court litigation, Patent Owner argues that “Google and Microsoft are [s]tanding in LG’s [s]hoes.” Prelim. Resp. 21 (emphasis omitted); *see also id.* at 23 (asserting that, “for all intents and purposes, Google and Microsoft *are* ‘the same party’ as LG in the litigation”). Thus, Patent Owner effectively treats Petitioner and LG as the same entity in arguing 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 ’287 patent in IPR2022-01193, 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 ’287 patent’s priority date justifies two petitions. Paper 3 at 2.

Patent Owner does not directly address Petitioner’s reasons for filing multiple petitions, but, in arguing for discretionary denial based on the *Fintiv* factors, Patent Owner argues that the filing of two petitions will not streamline issues with respect to the district court litigation. Prelim. Resp. 24–25.

We find that two petitions are justified here due to the priority date issue that Petitioner addresses in IPR2022-01193. *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. Legal Standards*

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)); *see also* 37 C.F.R. § 42.104(b) (requiring a petition for *inter partes* review to identify how the challenged claim is to be construed and where each element of the claim is found in the prior art patents or printed publications relied upon).

A claim is unpatentable under 35 U.S.C. § 103(a) if “the differences between the subject matter sought to be patented 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 skill in the art; and (4) when in evidence, objective evidence of obviousness or nonobviousness, i.e., secondary considerations. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). An obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR*, 550 U.S. at 418.

Additionally, the obviousness inquiry typically requires an analysis of “whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2016) (requiring “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)). Furthermore, Petitioner does not satisfy its burden of proving obviousness by employing “mere conclusory statements,” but “must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

#### *C. Effective Filing Date*

Petitioner contends that the ’287 patent is not entitled to the benefit of the filing date of parent application 10/304,827 (“the ’827 application”), which is November 25, 2002. Paper 3, 1–2. Petitioner, however, relies on references that have filing dates no later than 2001. Therefore, the references relied on by Petitioner qualify as prior art, even if the ’287 patent is entitled to the benefit of the November 25, 2002 filing date of the ’827 application.

#### *D. 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 (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 13. Patent Owner does not address the level of ordinary skill at this stage of the proceeding. *See* Prelim. Resp.

The level of ordinary skill in the art usually is evidenced by the references themselves. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978). As Petitioner’s description of a person of ordinary skill appears commensurate with the subject matter before us, we apply Petitioner’s definition for purposes of this Decision, with the exception of the open-ended language “at least.”

#### *E. Claim Interpretation*

We interpret the challenged claims

using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b), including construing the 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) (2022). “In determining the meaning of [a] disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006). Claim terms are given their plain and ordinary meaning as would be 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). “There are only two exceptions to this general rule: 1) when a patentee sets out a definition and acts as his own

lexicographer, or 2) when the patentee disavows the full scope of a claim term either in the specification or during prosecution.” *Thorner v. Sony Comput. Entm’t Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012).

Petitioner contends that “displays information concerning return information,” as recited in claim 1,<sup>2</sup> should be construed to mean “automatically displaying return/recovery information during or after **every** boot-up” because Patent Owner disavowed any broader scope through clear and unequivocal statements in the specification. Pet. 9. Patent Owner “takes no position on the proper construction of the ‘return/recovery display’ terms.” Prelim. Resp. 10. The District Court has indicated in a preliminary claim construction that it will apply the plain and ordinary meaning to this term. Ex. 1018. Under either construction, Petitioner sufficiently shows a likelihood of success as explained below in our patentability analysis.

Petitioner also contends that “the recited ‘*recovery*’ and ‘*return* information’ claim **only** the content of the information,” in claims 1, 4, and 7, and should not be entitled to patentable weight under the printed matter doctrine. Pet. 12 (citing *In re Distefano*, 808 F.3d 845, 848 (Fed. Cir. 2015); *In re Bryan*, 323 F. App’x 898, 901 (Fed. Cir. 2009)). Patent Owner argues “[b]ecause the displayed return/recovery information interacts with the claims’ other elements to create a new functionality, these terms are entitled to patentable weight.” Prelim. Resp. 10. Under either construction, Petitioner sufficiently shows a likelihood of success as explained in our patentability analysis.

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<sup>2</sup> Similar limitations are recited in independent claims 4 and 7, and Petitioner advances the same proposed construction as for claim 1.

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

To the extent necessary to address the parties’ unpatentability arguments, construction of additional claim terms is addressed below in the context of the unpatentability analysis. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“Because we need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy,’ we need not construe [a particular claim limitation] where the construction is not ‘material to the . . . dispute.’” (Citation omitted)).

*F. Obviousness Ground based on Jenne and Cohen*

Petitioner contends that claims 1–7 would have been obvious over the combined teachings of Jenne and Cohen. Pet. 13–44.

*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, Abstract. 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 made by the system's 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.

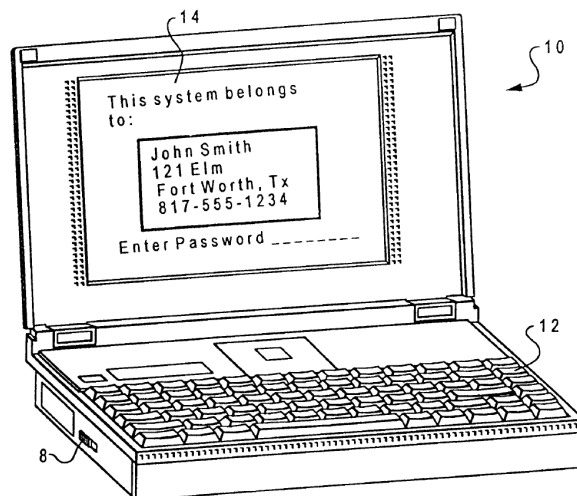


Figure 1 illustrates portable computer device 10, video display device 14, and keyboard 12. *Id.* at 3:4–12. Referring to Figure 1, “video display

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 requesting entry of 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

#### *Preamble*

The preamble of claim 1 recites a “method for displaying information to assist with returning a computer.” The preambles of independent claims 4 and 7 recite similar features. Petitioner contends that the combination of Jenne and Cohen teaches the features recited in the preamble of claim 1. Pet. 23. Petitioner contends that Jenne discloses displaying advertisements on a computer display during a boot-up period. *Id.* at 23 (citing Ex. 1005 ¶ 23). Petitioner contends that Cohen discloses automatically retrieving and displaying textual indicia of personal ownership during the boot-up process to greatly enhance the likelihood that a misplaced computer device will be returned to its owner. *Id.* (citing Ex. 1005, Abstr., 3:57–4:4; Ex. 1003 ¶¶ 298, 341–344). Based on the evidence and arguments currently of record, for purposes of institution, we determine that Petitioner has demonstrated that the combination of Jenne and Cohen teaches the features recited in the preambles of claims 1, 4, and 7. Because we determine that

the combination teaches the preamble, we need not decide whether the preamble is limiting at this stage.

*Activating a processor to display . . . .*

Claim 1 recites “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.” Claims 4 and 7 recite a similar limitation. Petitioner contends that the combination of Jenne and Cohen teaches this limitation. Pet. 26–29. Petitioner contends that Figure 3 of Jenne discloses a personal computer-based system including a microprocessor, a memory, and a display. *Id.* at 24–25 (citing Ex. 1005, Fig. 3; Ex. 1003 ¶¶ 300, 345–46, 363). Petitioner contends that Jenne discloses displaying commercial messages or other information on a computer display during booting. *Id.* at 26–27 (citing Ex. 1005 ¶¶ 7–8, 22–23, 27). Petitioner contends that Cohen discloses automatically displaying indicia of personal ownership during or after every power on. *Id.* at 27–29 (citing Ex. 1006, 2:10–13, Fig. 1). Petitioner contends that a person of ordinary skill would have used Cohen’s indicia of personal ownership as the other information of Jenne to yield the benefit of enhancing the likelihood that a misplaced computer will be returned to its owner as taught by Cohen. *Id.* at 28–29 (citing Ex. 1003 ¶¶ 301–304, 347–348, 378). Based on the evidence and arguments currently of record, for purposes of institution, we determine that Petitioner has demonstrated that the combination of Jenne and Cohen teaches the features recited in these limitations of claims 1, 4, and 7, and that a person of ordinary skill would have had a reason to combine the references as Petitioner proposes.

*Displaying return information . . . .*

Claim 1 recites “the screen displaying recovery information, to facilitate return of the computer so the return information is visible to anyone viewing the display screen.” Claims 4 and 7 recite a similar limitation. Petitioner contends that the combination of Jenne and Cohen teaches this limitation. Pet. 30–32. Petitioner contends that Jenne discloses displaying messages on a display during user waiting times such as boot-up time and that Cohen discloses displaying return information on the same screen as the password prompt. *Id.* at 31 (citing Ex. 1005, Abstract, ¶¶ 18, 21; Ex. 1006, Figs. 1 and 4; Ex. 1003 ¶¶ 314–316, 347, 349, 362, 365). Petitioner contends that a person of ordinary skill in the art would have modified Jenne to include the ownership information displayed along with a password prompt on a locked screen as taught by Cohen to yield the benefit of preventing access to files and applications stored within the computer in case of a lost or stolen computer as taught by Cohen. *Id.* at 37–38 (citing Ex. 1003 ¶¶ 293–294; Ex. 1006, Abstract, 5:28–37, Fig. 4); *see* Ex. 1006, 1:32–37. Based on the evidence and arguments currently of record, for purposes of institution, we determine that Petitioner has demonstrated that the combination of Jenne and Cohen teaches the features recited in these limitations of claims 1, 4, and 7, and that a person of ordinary skill would have had a reason to combine the references as Petitioner proposes.

*Initiating or changing return information . . . .*

Claim 1 recites “initiating or changing return information which appears on the display through remote communication without the assistance by a user with the computer.” Claims 4 and 7 recite a similar limitation. Petitioner contends that the combination of Jenne and Cohen teaches this

limitation. Pet. 32–34. Petitioner contends that Jenne discloses that a remote agent may remotely access the computer to update and download messages from the Internet, which occurs without the assistance by a user with the computer. *Id.* at 33 (citing Ex. 1005, Abstract, ¶¶ 23, 25; Ex. 1003 ¶¶ 317–321, 350–355, 366). Petitioner contends that Cohen teaches that the stored ownership information may be changed using an additional level of security, such as a secondary password. *Id.* at 33–34 (citing Ex. 1006, 4:23–26). Petitioner contends that a person of ordinary skill would have combined the capability to change the ownership information as taught by Cohen with remote communication as taught by Jenne to yield the benefit of displaying the most up-to-date ownership information when the computer is lost or stolen. *Id.* at 34 (citing Ex. 1005 ¶¶ 13, 21, 25; Ex. 1003 ¶¶ 291, 321).

Patent Owner contends that Jenne does not disclose anything about the display of return information, but rather, simply discloses display of advertisements and other information. Prelim. Resp. 27–28. Patent Owner contends that Jenne’s disclosure of displaying other information would not have led a person of ordinary skill to display ownership information. *Id.* at 28. Patent Owner further contends that Cohen discloses displaying return information during boot-up but does not disclose changing the return information remotely. *Id.* at 27–28. According to Patent Owner, Petitioner has not shown that a person of ordinary skill, when remotely changing the other information of Jenne, would have had a reason to use the ownership information of Cohen as the other information. *Id.* at 28–29.

We disagree. “The presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact.” *In re*

*Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000). Evidence of a motivation to combine prior art references “may flow from the prior art references themselves.” *See Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1125 (Fed. Cir. 2000). Petitioner contends that a person of ordinary skill would have been motivated to use the ownership information of Cohen as the other information of Jenne because displaying ownership information increases the likelihood that a lost or misplaced computer will be returned to its owner. Pet. 19. Cohen teaches displaying “personal ownership indicia automatically upon each application of electrical power to the portable computer device. This simple expedient provides a technique whereby the likelihood that a lost or misplaced personal computer will be returned to its owner has been greatly enhanced . . . .” Ex. 1006, 5:49–56. Based on the current record, we find that evidence of Petitioner’s motivation to use the ownership information of Cohen as the other information of Jenne, namely, to yield the benefit of increasing the likelihood that a lost or misplaced computer will be returned to its owner, flows from the prior art references themselves.

Patent Owner contends that the claim recites changing return information “without assistance by a user with the computer” but that Jenne’s disclosure of updating and downloading advertisements requires input from the user. Prelim. Resp. 31–35. According to Patent Owner, Jenne either tracks user Internet information, or requests and receives user advertisement preferences, before checking for updates and downloading advertisements from the Internet. *Id.* at 31–32.

Patent Owner, however, does not address the combination made by Petitioner. Petitioner contends that other information, rather than advertising

information, would be updated and downloaded by the system of Jenne, where the other information is the ownership information taught by Cohen. Pet. 19. Petitioner contends that the ownership information would be changed by the owner of the computer and would be downloaded using Jenne's remote communication. *Id.* at 33–34, 36–37. We are sufficiently persuaded that an owner of a computer, when remotely changing ownership information, would not require assistance of the user of the computer, and in particular, would not require user Internet information nor user advertisement preferences. Based on the evidence and arguments currently of record, for purposes of institution, we determine that Petitioner has demonstrated that the combination of Jenne and Cohen teaches the features recited in these limitations of claims 1, 4, and 7, and that a person of ordinary skill would have had a reason to combine the references as Petitioner proposes.

*Through an interactive program . . . .*

Claim 1 recites “wherein the changing of the return information is done through an interactive program stored in the memory of the computer which is remotely accessed only by the owner of the computer or the party authorized by the owner to enable the initiating or changing of the display screen.” Each of claims 4 and 7 recites a similar limitation. Petitioner contends that Jenne's commercial message application on the computer interacts with a remote server to check for updates and to download messages, and permits a remote manufacturer or authorized agent to initiate the download of updated messages. Pet. 36 (citing Ex. 1005 ¶¶ 25, 27). Petitioner contends that Jenne discloses that remotely changing the stored messages requires entering a password. *Id.* (citing Ex. 1005 ¶ 25).

Petitioner contends that a person of ordinary skill would have understood that only the owner of the computer, or a party authorized by the owner, would have access to the password needed to remotely change the recovery information. *Id.* at 36–37 (citing Ex. 1003 ¶¶ 326–329, 356–357, 367).

Patent Owner contends that Jenne does not disclose “changing of the return information . . . through an interactive program . . . which is remotely accessed only by the owner of the computer or the party authorized by the owner.” Prelim. Resp. 30 (second alteration in original; emphasis omitted). Patent Owner contends that Jenne discloses that the computer manufacturer, or its authorized agent, can remotely send information to the device but does not disclose allowing the device owner to send any type of message to the device over the Internet, such as a message to change ownership information. *Id.* Patent Owner also contends that Petitioner does not show that a person of ordinary skill would have been motivated to modify Jenne to do so. *Id.* at 30–31.

We disagree. Jenne discloses that remotely changing stored information requires entry of a password, and Cohen discloses that changing ownership information also requires entry of a password. Ex. 1005 ¶ 25; Ex. 1006, 4:23–26. 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 ¶¶ 291 (citing Ex. 1006, 4:23–26), 320–321, 328. We are sufficiently persuaded that a person of ordinary skill, when modifying the system of Jenne to use the

ownership information of Cohen as other information, would have caused Jenne's system to remotely change the ownership information using a password accessible only by the owner of the computer or a party authorized by the owner as taught by Cohen.

Patent Owner contends that Jenne teaches that a computer user could uninstall or delete the commercial message application and that a premium user could enable, disable, or save the advertisement displayed by the commercial message application. Prelim. Resp. 35–37. According to Patent Owner, the uninstalling, deleting, enabling, disabling, and saving functions that may be performed by the user do not teach that the interactive program “is remotely accessed only by the owner of the computer or the party authorized by the owner.” *Id.*

We disagree. Claim 1 recites that “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 . . . changing the display screen.” The language of claim 1 thus limits who can remotely access the interactive program, but does not limit who has local access. On this record, we determine that the scope of this limitation requires allowing remote access “only by the owner . . . or the party authorized by the owner to enable . . . changing the display screen,” but does not exclude allowing local access by a user of the computer. Our construction of this term is not final, and we invite the parties to present arguments and evidence in support of or in opposition to our construction.

Jenne teaches that only an authorized party can remotely access the interactive program to enable changing the stored information that is displayed on the screen. Ex. 1005 ¶ 25. Cohen teaches that when the stored

information is ownership information, only the owner or an authorized party would be able to change the information. Ex. 1006, 4:23–26; Ex. 1003 ¶¶ 291, 320–321. Although Jenne teaches that a local user may perform certain functions with the interactive program, Jenne does not disclose that a local user, without authorization, would be able to remotely access the interactive program to change the stored information. We are sufficiently persuaded that the combination of Jenne and Cohen teaches changing the return information through an interactive program which is remotely accessed only by the owner of the computer or an authorized party to enable changing the display screen. Based on the evidence and arguments currently of record, for purposes of institution, we determine that Petitioner has demonstrated that the combination of Jenne and Cohen teaches the features recited in these limitations of claims 1, 4, and 7, and that a person of ordinary skill would have had a reason to combine the references as Petitioner proposes.

*Displaying the screen . . . .*

Claim 1 recites “displaying the screen before or with a security prompt which prevents the user from accessing operatively the computer.” Petitioner contends that the combination of Jenne and Cohen teaches this limitation. Pet. 37–39. Petitioner contends that the lock screen shown in Figure 1 of Cohen includes return information and a password prompt for entry by a user of the appropriate password in order to access files. *Id.* at 37 (citing Ex. 1006, Abstract). Petitioner contends that a person of ordinary skill would have included the information content displayed on a lock screen as taught by Cohen on the display of Jenne to increase the likelihood that a lost or misplaced computer will be returned to its owner. Pet. 19. Based on

the evidence and arguments currently of record, for purposes of institution, we determine that Petitioner has demonstrated that the combination of Jenne and Cohen teaches the features recited in this limitation of claim 1, and that a person of ordinary skill would have had a reason to combine the references as Petitioner proposes.

*Activating the processor to allow . . .*

Claim 1 recites “activating the processor to allow a warning message to the user.” Petitioner contends that Cohen discloses displaying the message “this system belongs to” in addition to displaying return information and a security prompt. Pet. 39–40 (citing Ex. 1003 ¶¶ 337–349). Based on the evidence and arguments currently of record, for purposes of institution, we determine that Petitioner has demonstrated that the combination of Jenne and Cohen teaches the features recited in this limitation of claim 1, and that a person of ordinary skill would have had a reason to combine the references as Petitioner proposes.

Based on the evidence and arguments currently of record, for purposes of institution, we determine that Petitioner has demonstrated that a person of ordinary skill would have had reason to combine the teachings of Jenne and Cohen and that their combined teachings would have taught or suggested the features recited in claims 1, 4, and 7 to an ordinarily skilled artisan.

*4. Dependent Claims 2, 3, 5, and 6*

Petitioner contends that the combined teachings of Jenne and Cohen teach or suggest all of the limitations of dependent claims 2 and 3 (which depend from claim 1) and 5 and 6 (which depend from claim 4). Pet. 41–44; Ex. 1003 ¶¶ 369–382. At this stage of the proceeding, Patent Owner does

not offer any specific arguments with respect to claims 2, 3, 5, and 6. *See* Prelim. Resp. 27–37. Based on the record before us, we are persuaded that Petitioner’s discussion of the particular structures, systems, methods, and operations in Jenne and Cohen, and the explanations in the Petition and Dr. Zadok’s Declaration, sufficiently show that the combined teachings of Jenne and Cohen teach or suggest all of the limitations of claims 2, 3, 5, and 6. Pet. 41–45; Ex. 1003 ¶¶ 369–382.

### 5. *Conclusion*

On this record, we are persuaded that Petitioner has shown a reasonable likelihood of prevailing on its assertion that claims 1–7 are unpatentable over Jenne and Cohen.

#### *G. Obviousness Ground Based on Angelo and Helle*

Petitioner contends that the subject matter of claims 1, 4, and 7 would have been obvious over the combined teachings of Angelo and Helle. Pet. 44–74.

##### *1. Overview of Angelo*

Angelo is directed to a system “which permits a user or owner of a portable electronic device to report the device missing to a security station. In response, the security station wirelessly transmits a security message or command to the portable electronic device which, in turn, responds by causing a ‘destructive’ security action to occur.” Ex. 1007, Abstract. The Angelo disclosure involves “broadcasting an authenticated security message to a remote computer device upon its theft to cause the computer device to protect its data.” *Id.* ¶ 4. “The destructive action may include erasing memory in the portable device, disabling certain functions (e.g., transmitting

data, receiving data, accessing memory, etc.) or other types of actions such as reporting location information to the security station.” *Id.* ¶ 11.

## 2. *Overview of Helle*

Helle is directed to “controlling a mobile phone when it has been lost or stolen in order to prevent its use except to help the owner find it.”

Ex. 1008, Abstract.

Helle discloses three security features, including displaying contact information for the owner of a phone, setting the phone into a secure mode, and instructing the phone to “send information about its location and usage via SMS” text message to a pre-set number. *Id.* at 1:47–58. Helle describes that the security mode can be set “by remote control after it has actually been lost.” *Id.* at 1:63–65.

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. But 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 discloses 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.

## 3. *Independent Claims 1, 4, and 7*

### *Preamble*

The preamble of claim 1 recites a “method for displaying information to assist with returning a computer.” The preambles of claims 4 and 7 recite similar features. Petitioner contends that Angelo discloses receiving a report

that a device is lost or stolen and then locking down the device while displaying a predefined message with a return address or telephone number. Pet. 53–54 (citing Ex. 1007 ¶¶ 21, 23). Petitioner contends that Helle discloses a technique that displays contact information of the owner on a screen when a device has been lost or stolen. *Id.* at 54 (citing Ex. 1008, Abstract). Based on the evidence and arguments currently of record, for purposes of institution, we determine that Petitioner has demonstrated that the combination of Angelo and Helle teaches the features recited in the preambles of claims 1, 4, and 7. Because we determine that the combination teaches the preamble, we need not decide whether the preamble is limiting at this stage.

*Activating a processor to display . . . .*

Claim 1 recites “activating a processor 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.” Claims 4 and 7 recite a similar limitation. Petitioner contends that Figure 2 of Angelo shows a portable device that includes a processor, memory, and a display. Pet. 55–56. Petitioner contends that Angelo discloses locking a device and displaying a predefined message with a return address or telephone number when the device is lost or stolen. *Id.* at 57–58 (citing Ex. 1007 ¶¶ 23, 33). Petitioner contends that Helle provides exemplary messages to be displayed on a locked device when the device is lost or stolen. *Id.* at 58 (citing Ex. 1008, 3:10–14, 4:7–10, Figs. 3 and 5). Based on the evidence and arguments currently of record, for purposes of institution, we determine that Petitioner has demonstrated that the combination of Angelo and Helle teaches the features recited in these

limitations of claims 1, 4, and 7, and that a person of ordinary skill would have had a reason to combine the references as Petitioner proposes.

*Displaying return information . . . .*

Claim 1 recites “the screen displaying recovery information, to facilitate return of the computer so the return information is visible to anyone viewing the display screen.” Claims 4 and 7 recite a similar limitation. Petitioner contends that Angelo discloses a screen on a locked device displaying a return address or telephone number. Pet. 62 (citing Ex. 1007 ¶ 23). Petitioner contends that Helle discloses examples of locked screens of a device with security prompts such as instructions to call the owner when the device is lost or stolen. *Id.* at 62–63 (citing Ex. 1008, 2:19–20, 3:20–24, 4:5–7, 4:24–26, Figs. 4–6). Based on the evidence and arguments currently of record, for purposes of institution, we determine that Petitioner has demonstrated that the combination of Angelo and Helle teaches the features recited in these limitations of claims 1, 4, and 7.

*Initiating or changing return information . . . .*

Claim 1 recites “initiating or changing return information which appears on the display through remote communication without assistance by a user with the computer.” Claims 4 and 7 recite a similar limitation. Petitioner contends that Angelo discloses transmitting a security command to a portable device over a communication link. Pet. 64–65 (citing Ex. 1007 ¶¶ 19, 21, 23). Petitioner contends that, in response to receiving the security message, the portable device becomes locked and displays a predefined message with a return address or a telephone number. *Id.* at 65–66 (citing Ex. 1007 ¶ 23, Fig. 2). Petitioner contends that Helle discloses sending a security command to a lost mobile phone, where the control message

includes a phone number to be displayed. *Id.* at 67 (citing Ex. 1008, 4:10–13). Petitioner contends that a person of ordinary skill would have modified the security command of Angelo to include a telephone number as taught by Helle to yield the benefit of allowing the owner to change the return information to any number that the owner finds convenient at the moment as taught by Helle. *Id.* at 50 (citing Ex. 1008, 4:10–14; Ex. 1003 ¶¶ 415–416), 67 (citing Pet. 50).

Patent Owner contends that Angelo does not teach this limitation because Angelo does not disclose displaying return information during or after every boot-up. Prelim. Resp. 38. Patent Owner cites to destructive actions performed after a device interprets Angelo’s security message, such as erasing memory or shorting circuitry, and contends that performing such actions after every boot-up would not make sense, because the memory would be erased once, and the circuit would be shorted once. *Id.* at 39. However, the destructive action of Angelo that Petitioner relies on is “lock[ing] the machine down while displaying a pre-defined message with a return address for the device or a telephone number to call.” Pet. 57 (quoting Ex. 1007 ¶ 23). When the device only performs the destructive action of locking the machine down and displaying a return address, other destructive actions such as erasing memory or shorting circuitry are not performed. *See* Ex. 1007 ¶ 21 (suggesting that the device would perform only one destructive action, as follows: “[P]ortable device 100 preferably interprets the security message and performs a destructive action that has been predetermined or specified in the security message itself.”).

Patent Owner further contends that Angelo discloses using various security techniques, such as a digital signature, to prevent replays of the

message. Prelim. Resp. 40. Angelo discloses, however, that it wants to prevent unauthorized replays of messages such as those that cause the device to erase its memory. Ex. 1007 ¶ 38. Dr. Zadok testifies that a person of ordinary skill “would recognize that it makes sense for a locked device, once turned off and then back on, to remain locked and still display the same return information” so that honest finders would know where to return the device, and thieves would not be able to remove the lock simply by turning the device off. Ex. 1003 ¶ 452. On this record, we agree with Dr. Zadok. We are persuaded that the device of Angelo, after receiving the security message to lock the phone, would display the return information on the screen of the locked device (which occurs after boot-up) until the device is returned to the owner, who would then enter the correct password. *See* Ex. 1003 ¶ 454 (Dr. Zadok testifies that a person of ordinary skill “would have recognized that prompting the authorized user to enter the password or PIN code would have been one simple and well-known mechanism for allowing the reactivation of any disabled functions.”). We are persuaded that Angelo teaches “initiating . . . return information which appears on the display through remote communication” as claimed under the plain meaning of this term and under Petitioner’s narrower construction. *See also* Pet. 60–61 (“Because the basic security mechanism of a password or code screen occurs every time a device is activated, the combination of Angelo and Helle teaches these limitations under Petitioners’ proposed construction.”).

Patent Owner also contends that Helle does not disclose this limitation because the device of Helle does not display the return information after every boot-up. Prelim. Resp. 40–44. According to Patent Owner, the return information of Helle would not be displayed when a PIN code is

successfully entered. *Id.* at 42. The PIN code, however, would be successfully entered when the device is returned to the owner and the owner enters the correct code. After Helle's device receives a lost phone message, and before the device is returned to the owner, the device would display the return information and prevent use of the device "except to help the owner find it." Ex. 1008, 1:41–45, 4:5–21. We are persuaded that the device of Helle, after receiving a lost phone message, would display the return information on the screen of the locked device (which occurs after boot-up) until the device is returned to the owner. *See* Ex. 1003 ¶ 454. We are persuaded that Helle teaches "initiating . . . return information which appears on the display through remote communication" as claimed under the plain meaning of this term and under Petitioner's narrower construction.

Patent Owner contends that Helle does not teach "initiating or changing . . . without assistance by the user of the computer" as claimed, because "Helle teaches that the lock or lost display message is only shown after the PIN query is canceled by the user, or a wrong PIN is entered by the user." Prelim. Resp. 45–46. However, Helle discloses that "when the owner sends the control message with a phone lost instruction," a "remote-controlled secure mode module 54 locks the mobile phone and displays a phone lost display message." Ex. 1008, 4:5–15; *see* Pet. 66–67; Ex. 1003 ¶¶ 465–466, 504, 521. In this case, Helle teaches that no input from the user is required to initiate return information which appears on the display through remote communication. Further, Helle discloses that the mobile phone number to be displayed can be a number stored in memory, or can be changed when the owner sends a different phone number with the control message. Ex. 1008, 4:11–21; *see* Pet. 67; Ex. 1003 ¶¶ 469–470. Thus, Helle

teaches that no input from the user is required to change return information that appears on the display through remote communication. Further, Petitioner relies on the combination of Angelo and Helle to teach this limitation (Pet. 64–68), and the combination teaches this limitation as discussed in the following two paragraphs.

Patent Owner contends that Angelo does not teach “initiating . . . without assistance by the user with the computer” as claimed because Angelo “is simply silent on whether user assistance is required” to initiate. Prelim. Resp. 46. Dr. Zadok testifies that Angelo’s technique would be performed “without assistance by a user with the computer” as claimed, because a person of ordinary skill would have understood that “the user in physical possession of the portable device may be untrustworthy and thus cannot be a participant in the security message procedure.” Ex. 1003 ¶ 464 (citing Ex. 1007 ¶ 19). We are sufficiently persuaded that a person of ordinary skill would have understood that Angelo’s technique is performed “without assistance by a user with the computer” as claimed.

Patent Owner contends that Angelo does not disclose that the owner may remotely change the return information “as required by all challenged claims.” Prelim. Resp. 46–47. Petitioner contends that “use of the disjunctive ‘or’ in ‘initiating or changing’ . . . means that only one of these alternatives need be satisfied by the prior art.” Pet. 32; *see* Prelim. Resp. 27 (in response to the ground based on Jenne and Cohen, Patent Owner agrees with Petitioner that only one of “initiating or changing” need be shown). We agree that only one of “initiating or changing” as claimed need be shown. Patent Owner’s contention that the “changing” alternative is

“required by all challenged claims” is, therefore, based on an incorrect claim construction.

Further, Petitioner relies on the combination of Angelo and Helle, not Angelo alone, to teach “changing return information . . . through remote communication without assistance by a user with the computer” as claimed. Pet. 50–51 (The “combination of Angelo and Helle merely combines prior art elements (Angelo’s security commands to cause an action on the device with Helle’s security commands permitting changing of displayed information) according to known methods (altering content of a command) to yield predictable results.”). Based on the current record, we agree with Petitioner’s rationale for combining the teachings of Angelo and Helle. We are sufficiently persuaded that the combination of Angelo and Helle teaches “initiating or changing . . . without assistance by the user with the computer” as claimed. Based on the evidence and arguments currently of record, for purposes of institution, we determine that Petitioner has demonstrated that the combination of Angelo and Helle teaches the features recited in these limitations of claims 1, 4, and 7.

*Through an interactive program . . .*

Claim 1 recites “wherein the changing of the return information is done through an interactive program stored in the memory of the computer which is remotely accessed only by the owner of the computer or the party authorized by the owner to enable the initiating or changing of the display screen.” Claims 4 and 7 recite a similar limitation. Petitioner contends that Angelo discloses that an authorized person identifies to a security station the identity of a device that has been lost or stolen, the security station sends a security message to the device, and the device receives and processes the

message using an interactive program. Pet. 68–70 (citing Ex. 1007 ¶¶ 21, 29–30, 36; Ex. 1003 ¶¶ 461–471, 473–481, 507–508, 511–514, 523–524).

Patent Owner contends that the “interactive program” of Angelo cited by Petitioner is accessed by the user, and therefore does not teach an “interactive program” that is “remotely accessed only by the owner of the computer or the party authorized by the owner” as claimed. Prelim. Resp. 48–49. We disagree for the reasons given in our analysis of Ground 1 above. In particular, we determine that the scope of this limitation does not exclude local access by a user of the computer. We are sufficiently persuaded that the only people who would “remotely access” the “interactive program” of Angelo are the owner of the device or a party authorized by the owner. Ex. 1007 ¶¶ 20–21. Further, Petitioner relies on the combination of Angelo and Helle to teach “changing of the return information” through the “interactive program” as claimed. Pet. 64–69. Petitioner contends that Helle discloses a remote-controlled secure mode module 54 that changes the return information. *Id.* at 66–67 (citing Ex. 1008, 4:8–11, 4:14–15). We are sufficiently persuaded that the remote-controlled secure mode module of Helle is an interactive program that changes the return information.

Patent Owner contends that the preamble of claim 7 recites a “computer program,” and the body of the claim recites the “interactive program.” Patent Owner contends that Petitioner improperly relies on the same teachings for these separate limitations. Prelim. Resp. 48. However, the specification of the ’287 patent discloses that “apparatus 10 includes means for causing the screen to appear on the display 18 with the owner and return information. . . . The causing means 22 preferably is a software program 24.” Ex. 1001, 5:1–5. The ’287 patent discloses that the “Retriever

is preferably a software program 24 . . . to allow an owner to communicate and control the computer 12” and that the “Retriever is designed to enable communication of the recovery display information . . . from the recovery administration center to the equipment being protected to control changes to the recovery display 18 screen.” *Id.* at 11:46–49, 13:45–50. On this record, we determine that both the “computer program” that performs “displaying . . . return information” and the “interactive program” that performs “changing the recovery information” of claim 7 find written description support in software program 24. We are sufficiently persuaded that, to the extent Petitioner relies on the same teachings of Angelo for the “computer program” and the “interactive program” of claim 7, such reliance is consistent with the scope of these terms as read in light of the Specification. Further, as discussed above, Petitioner relies on the combined teachings of Angelo and Helle, not Angelo alone, to show these limitations. Based on the evidence and arguments currently of record, for purposes of institution, we determine that Petitioner has demonstrated that the combination of Angelo and Helle teaches the features recited in these limitations of claims 1, 4, and 7, and that a person of ordinary skill would have had a reason to combine the references as Petitioner proposes.

*Displaying the screen . . .*

Claim 1 recites “displaying the screen before or with a security prompt which prevents the user from accessing operatively the computer.” Petitioner contends that the combination of Angelo and Helle teaches displaying return information on a screen which prompts a user for a password. Pet. 71–73 (citing Ex. 1007 ¶¶ 8–10, 23; Ex. 1008, 1:15–24, Fig. 4; Ex. 1003 ¶¶ 453–454, 484–486). Based on the evidence and arguments

currently of record, for purposes of institution, we determine that Petitioner has demonstrated that the combination of Angelo and Helle teaches the features recited in this limitation of claim 1, and that a person of ordinary skill would have had a reason to combine the references as Petitioner proposes.

*Activating the processor to allow . . . .*

Claim 1 recites “activating the processor to allow a warning message to the user.” Petitioner contends that the combination of Angelo and Helle teaches displaying a warning indicating, for example, that the phone is locked. Pet. 73–74 (citing Ex. 1003 ¶¶ 488–494). Based on the evidence and arguments currently of record, for purposes of institution, we determine that Petitioner has demonstrated that the combination of Angelo and Helle teaches the features recited in this limitation of claim 1, and that a person of ordinary skill would have had a reason to combine the references as Petitioner proposes.

Based on the evidence and arguments currently of record, for purposes of institution, we determine that Petitioner has demonstrated that a person of ordinary skill would have had reason to combine the teachings of Angelo and Helle and that their combined teachings would have taught or suggested the features recited in claims 1, 4, and 7 to an ordinarily skilled artisan.

### III. CONCLUSION

Based on the arguments presented in the Petition, we conclude that Petitioner has demonstrated a reasonable likelihood of prevailing with respect to at least one claim of the '287 patent challenged in the Petition. Accordingly, we institute a trial on all claims and all grounds asserted in the Petition. The Board has not made a final determination under 35 U.S.C. § 318(a) with respect to the patentability of the challenged claims.

### IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–7 of the '287 patent is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of the '287 patent shall commence on the entry date of this Decision, and notice is hereby given of the institution of a trial.

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Patent 9,892,287 B2

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