

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC, MICROSOFT CORPORATION,
Petitioner,

v.

CAROLYN W. HAFEMAN,
Patent Owner.

IPR2022-01192
IPR2022-01193
Patent 9,892,287 B2

Before JEFFREY S. SMITH, DANIEL J. GALLIGAN, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

ORDER
Granting Petitioner's Request for Consolidation
37 C.F.R. § 42.122(a)

I. INTRODUCTION

In these *inter partes* reviews, Google LLC and Microsoft Corporation (collectively “Petitioner”) challenge the patentability of claims 1–7 of U.S. Patent 9,892,287 B2 (Ex. 1001 (“’287 patent”)), which is owned by Carolyn W. Hafeman (“Patent Owner”). Petitioner requests that we consolidate these cases. IPR2022-01192, Paper 24 at 1. Patent Owner opposes. IPR2022-01192, Paper 28 at 1. Because these cases address the same claims, we grant Petitioner’s request to consolidate them pursuant to 37 C.F.R. § 42.122(a). *See also* 35 U.S.C. § 315(d) (giving Director discretion to consolidate proceedings).

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision, issued pursuant to 35 U.S.C. § 318(a), addresses issues and arguments raised during the trials in these *inter partes* reviews. For the reasons discussed below, we determine that Petitioner has proven by a preponderance of the evidence that claims 1–7 of the ’287 patent are unpatentable. *See* 35 U.S.C. § 316(e) (2018) (“In an *inter partes* review instituted under this chapter, the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.”).

A. Procedural History

Petitioner filed two petitions, each of which challenges claims 1–7 of the ’287 patent on the grounds set forth in the tables below.

IPR2022-01192

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

IPR2022-01192, Paper 4 (“Pet.”) at 2–3.⁶

IPR2022-01193

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–7	102(a)(1)	Hafeman 670 ⁷
1–7	103	Hafeman 298, ⁸ Chiu ⁹

IPR2022-01193, Paper 4 at 2–3.

Patent Owner filed Preliminary Responses in both proceedings.

Paper 8 in each proceeding. With Board authorization, Petitioner filed a Reply in each case (Paper 11 in each proceeding), and Patent Owner filed a

¹ The ’287 patent claims priority through a chain of continuations to an application that was filed before the effective date of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”) amendments to 35 U.S.C. §§ 102 and 103. In IPR2022-01192, Petitioner asserts that the references are prior art under the pre-AIA versions of these sections. Pet. 2–3. In IPR2022-01193, however, Petitioner argues that the effective filing date of the claims of the ’287 patent is after the AIA effective dates, and Petitioner applies the AIA version of sections 102 and 103 in that case. IPR2022-01193, Paper 4 at 2–3 n.2. For purposes of this Decision, we need not resolve the priority dispute because, as discussed below, the claims are unpatentable over the combination of Jenne and Cohen, the pre-AIA prior art.

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

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

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

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

⁶ Unless otherwise noted, we refer to the papers in IPR2022-01192.

⁷ US 2005/0071670 A1, published Mar. 31, 2005 (Ex. 1011).

⁸ US 2004/0103298 A1, published May 27, 2004 (Ex. 1009).

⁹ US 2003/0088633 A1, published May 8, 2003 (Ex. 1010).

Sur-reply (Paper 14 in each proceeding). Trial was instituted on the asserted grounds of unpatentability in each proceeding. Paper 16 (“Inst. Dec.”) at 39; IPR2022-01193, Paper 16 at 20.

In each proceeding, Patent Owner filed a Response (Paper 20 (“PO Resp.”); IPR2022-01193, Paper 20), Petitioner filed a Reply (Paper 24 (“Pet. Reply”); IPR2022-01193, Paper 24), and Patent Owner filed a Sur-reply (Paper 28 (“PO Sur-reply”); IPR2022-01193, Paper 28).

An oral hearing was held on November 2, 2023, a transcript of which appears in the record in each case. Paper 31 in each proceeding.

Petitioner relies on testimony from Erez Zadok, Ph.D. Exs. 1003, 1048 (same Declarations filed in both proceedings). Patent Owner relies on testimony from Scott Schaefer, Ph.D. Ex. 2040 in each proceeding. Patent Owner has entered in the record a transcript of the deposition of Dr. Zadok. Ex. 2048 in each proceeding.

B. Real Parties in Interest

Petitioner identifies the following real parties in interest: Google LLC, Microsoft Corporation, LG Electronics Inc., and LG Electronics U.S.A., Inc. Pet. 78; IPR2022-01193, Paper 4 at 79.

Patent Owner identifies herself as the real party in interest. Paper 5 (in each proceeding) at 1.

C. Related Matters

As required by 37 C.F.R. § 42.8(b)(2), the parties identify various related matters. Pet. 78–79; IPR2022-01193, Paper 4 at 79–80; Paper 5 (in each proceeding) at 1.

D. The '287 Patent and Illustrative Claim

The '287 patent relates to the “return of lost or stolen computers using a recovery screen that appears during or after boot-up of the computer.”

Ex. 1001, 1:24–26. Claims 1, 4, and 7 are independent, and claim 1 is reproduced below.

1. A method for displaying information to assist with returning a computer comprising the steps of:
 - activating a processor to display on a display screen on the computer which displays information concerning return information for returning the computer to an owner from data stored in a memory of the computer, the screen displaying 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.

II. ANALYSIS

A. Principles of Law

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

subject matter pertains. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) any secondary considerations, if in evidence. *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 17–18 (1966).

B. Level of Ordinary Skill in the Art

Citing the testimony of Dr. Zadok, Petitioner contends that a person of ordinary skill in the art

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

Pet. 12–13 (citing Ex. 1003 ¶ 96). Patent Owner does not dispute this assessment or offer her own assessment. *See* PO Resp.

To the extent necessary, 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.

C. Claim Construction

Petitioner presents two issues for claim construction. Pet. 9–12. First, Petitioner argues that certain language in each independent claim should be

interpreted to require the automatic display of certain information “during or after every boot-up.” Pet. 9–11. Second, Petitioner argues that the return and recovery information recited in the claims is merely printed matter that is not entitled to patentable weight. Pet. 11–12. Patent Owner disagrees with Petitioner’s claim construction arguments. PO Resp. 9–21.

For her part, Patent Owner argues that the terms “computer recovery information,” “recovery information,” and “return information” mean “information provided by the owner so that the device can be returned to the owner,” and she argues that “owner” means “the person or entity that owns, rents, or licenses the recovery application or program, and/or the person or entity who controls the recovery service.” PO Resp. 21 (citing Ex. 1001, 3:42–43, 4:14–15, 4:60–63, 11:53–55; Ex. 2035, 6–7, 18–20).

As explained below, the combination of Jenne and Cohen teaches the content of the return/recovery information under Patent Owner’s construction, and, therefore, we need not resolve whether such information is entitled to patentable weight. Furthermore, as explained below, the combination of Jenne and Cohen teaches displaying the return/recovery information during or after every boot-up and teaches “owner” under Patent Owner’s construction. Therefore, because there are no claim construction disputes between the parties that affect the analysis of unpatentability based on the combination of Jenne and Cohen, we need not resolve these claim construction issues. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

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

Petitioner asserts that claims 1–7 are unpatentable as obvious over the combined teachings of Jenne and Cohen. Pet. 3, 13–44. Patent Owner opposes. PO Resp. 26–43, 55–57; PO Sur-reply 5–18, 24–26.

1. Overview of the Prior Art

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

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

We discuss additional pertinent details of Jenne and Cohen in our analysis below.

2. Claim 1

a) Petitioner’s Contentions

Petitioner relies on Jenne for its teachings of displaying messages during boot-up of a computer and updating those messages remotely. Pet. 13–15 (overview of Jenne), 22–41 (detailed analysis of independent claims). For example, Jenne discloses that, “[d]uring a computer boot-up time or a wake-up time from a low-power mode, the computer user is forced to sit and wait,” and Jenne discloses displaying messages during that time. Ex. 1005 ¶¶ 12–13. Jenne explains that such messages may be advertisements but that “other information could be displayed such as announcements, useful productivity tips, utility enhancements and computer upgrades.” Ex. 1005 ¶ 22. Jenne discloses that the content of the

information displayed can be remotely updated: “The computer manufacturer may also check for updates and downloads in block 65 via a manufacturer password that only the manufacturer or its authorized agent possesses.” Ex. 1005 ¶ 25; *see also* Ex. 1005 ¶ 13 (“The commercial messages in the non-volatile memory may be securely updated through the Internet using a password.”).

Petitioner relies on Cohen to teach the automatic display of ownership information with a lock screen each time the computer is powered on. Pet. 16–18 (overview of Cohen), 22–41 (detailed analysis of independent claims). Cohen discloses that a “textual indicia of personal ownership is entered by the owner of the system during set-up or during a configuration change and electronically stored within non-volatile memory” and that this information is displayed during the POST process. Ex. 1006, code (57). With reference to Figure 4, Cohen discloses that, when power is turned on to the computer, the POST process retrieves and displays the owner’s information and prompts for a password to allow use of the computer. Ex. 1006, 5:5–42, Fig. 4. This is shown in Cohen’s Figure 1 below.

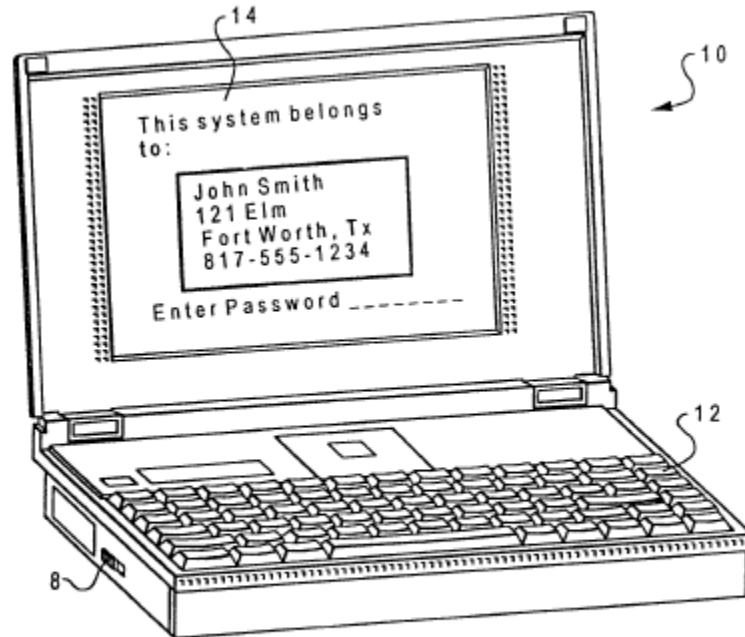


Fig. 1

Cohen's Figure 1, reproduced above, "display[s] an indication of ownership of portable computer device 10." Ex. 1006, 3:15–18. The display on computer 10 shows the following:

This system belongs to:
John Smith
121 Elm
Fort Worth, Tx
817-555-1234
Enter Password _____

Ex. 1006, Fig. 1.

Petitioner argues that it would have been "obvious to combine Jenne's teaching of automatic display of remotely updateable messages during the boot process with Cohen's teaching of displaying ownership indicia messages with a security (lock) screen on every bootup to prohibit a user from accessing the device until proper security credentials (e.g., password)

are entered.” Pet. 18–19 (citing Ex. 1003 ¶¶ 288–296). Petitioner provides several reasons that a person of ordinary skill in the art would have made this combination, including that Cohen expressly teaches that its display of ownership information during boot-up increases the likelihood of returning a lost computer. Pet. 18–22 (citing, *inter alia*, Ex. 1003 ¶ 289; Ex. 1006, 5:43–58¹⁰).

Petitioner provides a detailed analysis explaining how the combination of Jenne and Cohen teaches the subject matter of claim 1. Pet. 22–41. Petitioner argues that Jenne’s disclosure of displaying information in combination with Cohen’s disclosure of owner information teaches the preamble of claim 1. Pet. 22–24.

Petitioner argues that the combination of Jenne and Cohen teaches “automatically displaying return/recovery information during or after every boot-up of the computer” and, therefore, teaches “activating a processor to display on a display screen on the computer which displays information concerning return information for returning the computer to an owner from data stored in a memory of the computer,” as recited in claim 1. Pet. 26–28. Petitioner argues that, in the asserted combination, the owner information is displayed with a password prompt as described in Cohen such that the combination teaches “the screen displaying recovery information, to facilitate return of the computer so the return information is visible to anyone viewing the display screen,” as recited in claim 1. Pet. 30–32.

¹⁰ Although Petitioner cites column 5, lines 43–48 of Cohen, the relevant disclosure appears through line 58, as cited by Dr. Zadok. Ex. 1003 ¶ 302.

Claim 1 recites “initiating or changing return information which appears on the display through remote communication without assistance by a user with the computer.” Petitioner addresses “changing” rather than “initiating,” noting that only one of these needs to be met by the prior art. Pet. 32; *see also* PO Resp. 28 (“As Petitioner notes, ‘initiating or changing’ is disjunctive: thus, Petitioner only needs to establish that one of the two is satisfied.”). Petitioner relies on Jenne’s disclosures of remotely updating the message content and argues that a person of ordinary skill in the art “would have been motivated to incorporate the capability to change the stored ownership information using Jenne’s ‘*remote communication*’ (EX-1005, Abstract, ¶¶ 13, 21, 25) so that the most up-to-date ownership information is displayed when a device is lost or stolen.” Pet. 32–34 (citing Ex. 1003 ¶¶ 291, 321).

Claim 1 further recites “wherein the changing of the return information is done through an interactive program stored in the memory of the computer which is remotely accessed only by the owner of the computer or the party authorized by the owner to enable the initiating or changing of the display screen.” Petitioner argues that Jenne’s disclosures of remotely updating the message content by the “computer manufacturer or its authorized agent” (Ex. 1005 ¶ 25) teaches an interactive program, which, in combination with Cohen’s disclosure of an owner changing owner information, teaches this subject matter. Pet. 34–37.

Claim 1 also recites “displaying the screen before or with a security prompt which prevents the user from accessing operatively the computer.” Petitioner relies on Cohen’s disclosure of displaying owner information on the screen with a password prompt as teaching this limitation. Pet. 37–39.

Claim 1 further recites “activating the processor to allow a warning message to the user.” Petitioner relies on Cohen’s screen showing the message “This system belongs to:” as teaching allowing a warning message. Pet. 39–41 (Ex. 1006, Fig. 1).

b) Patent Owner’s Arguments and Our Analysis

(1) Reason to Combine

Patent Owner argues that “Petitioner has not articulated any plausible reason why a [person of ordinary skill in the art], in 2002, would have been led to convert Jenne’s *advertising* system and Cohen’s permanent ownership indicia into a system for *remote changing of ownership information*.” PO Resp. 32. Referring to Petitioner’s argument based on Jenne’s disclosure that “[b]esides advertisements, other information could be displayed” (Ex. 1005 ¶ 22, *cited in* Pet. 19), Patent Owner argues that “there is no reason why the word ‘other’ would have led a [person of ordinary skill in the art] specifically to display *ownership* information in Jenne.” PO Resp. 29–30. According to Patent Owner, “Petitioner’s argument is essentially that the word ‘other’ would have motivated a [person of ordinary skill in the art] to display *any conceivable type of information*—sports betting information, Babylonian epics, astronomical charts, or anything else, in Jenne. This stretches obviousness beyond its breaking point.” PO Resp. 30.

But as noted above, Petitioner relies on Cohen’s disclosure that displaying ownership information during boot-up increases the likelihood of returning a lost computer. *See* Pet. 19 (arguing that a person of ordinary skill in the art would have “been motivated to display ownership information to this captive audience because as taught by Cohen, displaying such information during this time period between boot-up and before entry to the

operating system increases the likelihood that a lost or misplaced computer will be returned to its owner”). Patent Owner, however, contends that, “from the perspective of Cohen, *updating* the ownership indicia would not be a ‘benefit’ – it would be a detriment to security” because, according to Patent Owner, “Cohen ensures security by keeping ownership indicia constant after the initial set-up or configuration change.” PO Resp. 32 (citing Ex. 2040 ¶ 54(b)). Patent Owner cites the following testimony from Dr. Schaefer to support this assertion:

Cohen discloses a method where the owner enters “a textual indicia of personal ownership” “during set-up or during a configuration change.” Cohen is specifically designed to keep ownership indicia constant. Although Cohen states that ownership indicia can be stored in RAM or nonvolatile memory, Cohen makes clear that nonvolatile memory is preferred because it cannot be altered, whereas ownership information stored in the RAM could be “easily defeated” by removing the battery. Thus, Cohen’s objective is to keep its local ownership indicia constant after an initial set-up or configuration change.

Ex. 2040 ¶ 54(b) (citing Ex. 1006, 2:31–35, 4:50–5:4); *see* PO Resp. 29 (quoting this testimony), 32 (citing this testimony).

We do not credit Dr. Schaefer’s testimony because it is inconsistent with Cohen’s disclosure. In particular, Cohen discloses “storing of the personal ownership indicia and password data within nonvolatile memory, such as ROM 26,” which Cohen states “is preferably implemented utilizing so-called ‘flash’ ROM or serial EEPROM, which may be electrically altered upon application of suitable control signals.” Ex. 1006, 3:44–47, 4:47–50. Thus, contrary to Dr. Schaefer’s testimony that Cohen states a preference for nonvolatile memory because it cannot be altered, Cohen expressly discloses using nonvolatile memory that can be altered, so that the system may not “be

easily defeated by opening the case of portable computer device 10 and temporarily removing the battery, rendering this information erased.”

Ex. 1006, 4:54–57. In further contrast to Dr. Schaefer’s testimony, Dr. Zadok testifies that Jenne also discloses storing information in nonvolatile memory, such as nonvolatile random access memory (NVRAM) or a flash ROM. Ex 1003 ¶ 319 (citing Ex. 1005 ¶¶ 23, 27, Fig. 3). Dr. Zadok persuasively testifies that Cohen’s disclosure of storing information in nonvolatile memory is consistent with Jenne’s disclosure. Ex. 1003 ¶ 308.

We find Petitioner’s reasoning to combine Jenne and Cohen to be persuasive. As Petitioner correctly points out (Pet. 19), Cohen expressly teaches that the benefits of displaying owner information with a password prompt when the computer is started are that “the likelihood that a lost or misplaced personal computer device will be returned to its owner [is] greatly enhanced and [that] ownership of otherwise fungible devices may be easily determined.” Ex. 1006, 5:52–58; *see* Ex. 1003 ¶ 289 (Dr. Zadok testifying that Cohen’s disclosure shows that a person of ordinary skill in the art would have been motivated to display owner information during boot-up). Thus, we find that Cohen’s express disclosure provides a rationale for a person of ordinary skill in the art to display a particular type of information, specifically owner information, in the system of Jenne. We agree with Petitioner, that “the combination would have involved a simple substitution of a known generic element (Jenne’s ‘other information’) with a specific type of information (Cohen’s ‘ownership indicia’) to obtain predictable results.” Pet. 20 (citing *KSR*, 550 U.S. at 415–16).

(2) *Owner*

Patent Owner argues that “[e]ach of the [challenged] [c]laims recites an ‘owner’ whose return/recovery information is displayed on the device,” that “Petitioner relies on Jenne’s ‘computer manufacturer’ for the ‘owner’ limitation,” and that Jenne’s manufacturer is not an owner. PO Resp. 26–28.

We disagree with this argument because Petitioner relies on Cohen to teach an owner and ownership indicia in combination with Jenne’s teachings. *See* Pet. 18–19 (asserting that it would have been obvious to combine “Jenne’s teaching of automatic display of remotely updateable messages during the boot process with Cohen’s teaching of displaying ownership indicia messages with a security (lock) screen on every bootup”), 20 (“A [person of ordinary skill in the art] would have therefore found it straightforward to modify the information stored for display during boot-up in Jenne to include Cohen’s indicia of ownership (e.g., address and phone number).”); *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (stating that each reference “must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole”); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (stating that, for obviousness, “the test is what the *combined teachings* of the references would have suggested to those of ordinary skill in the art” (emphasis added)).

Patent Owner argues that Petitioner “relied on Cohen’s ‘ownership indicia’ to show the return/recovery information” but did not rely on Cohen’s disclosure of an owner such as “John Smith” from Cohen’s Figure 1 “to show the ‘owner’ or authorized agent limitation.” PO Sur-reply 5–6 (citing Pet. 36). We disagree. Petitioner relies on Cohen to teach ownership information that is entered by the owner. *See* Pet. 16 (“In

Cohen, a ‘textual indicia of personal ownership is entered by the owner of the system during set-up or during a configuration change and electronically stored within non-volatile memory.’” (quoting Ex. 1006, code (57))).

Petitioner relies on Cohen’s Figure 1 throughout the Petition to show the “owner” of the computer. *See* Pet. 17, 29, 31, 38.

We find that Cohen’s disclosure teaches an “owner” under Patent Owner’s construction because John Smith (Figure 1) is the person who owns the computer and, therefore, owns the program on the computer and also because John Smith controls the recovery service by entering his information.

(3) Remotely Changing Return Information

Patent Owner argues that Jenne “does not disclose *anything* about the display of ‘return information.’” PO Resp. 28. Petitioner, however, relies on Cohen to teach the content of the information recited in the claims. *See, e.g.,* Pet. 19–20 (arguing that “it would have been trivial to modify Jenne to display Cohen’s ownership indicia in information because it would have involved merely substituting the content of the information to be displayed in Jenne”). We find that Cohen’s ownership indicia, which includes the name, address, and phone number of the owner (*see* Ex. 1006, Fig. 1), as discussed in the previous section, teaches “computer recovery information,” “recovery information,” and “return information” under Patent Owner’s proposed construction of “information provided by the owner so that the device can be returned to the owner.”

Patent Owner argues that Cohen discloses displaying return information but only discloses inputting the information locally. PO Resp. 28–29 (citing Ex. 1006, 4:27–44). According to Patent Owner,

“Cohen does not even disclose that the user can change that information *locally*—rather, it appears to be permanent.” PO Resp. 29. Patent Owner cites Dr. Schaefer’s testimony that “Cohen is specifically designed to keep ownership indicia constant” and that Cohen prefers nonvolatile memory “because it cannot be altered.” Ex. 2040 ¶ 54(b) (citing Ex. 1006, 2:31–35, 4:50–5:4), *quoted in* PO Resp. 29.

As discussed above in Section II.D.2.b.1, we do not credit this testimony from Dr. Schaefer because it is inconsistent with Cohen’s disclosure. In particular, Cohen discloses “storing of the personal ownership indicia and password data within nonvolatile memory, such as ROM 26,” which Cohen states “is preferably implemented utilizing so-called ‘flash’ ROM or serial EEPROM, which may be electrically altered upon application of suitable control signals.” Ex. 1006, 3:44–47, 4:47–50. Thus, Cohen discloses using alterable nonvolatile memory to store ownership indicia.

We also disagree with Patent Owner’s argument that Cohen discloses permanently setting the ownership information, which then cannot be altered. *See* PO Resp. 29; PO Sur-reply 10–11. Cohen discloses entering ownership information as part of a process depicted in Figure 3, and it states that “those skilled in the art will appreciate that an additional level of security, such as a secondary password, may be required to *alter* the ownership indicia which will be entered as part of this process.” Ex. 1006, 4:23–26 (emphasis added). Patent Owner argues that Cohen’s statement that “ownership indicia which will be entered” means that “ownership indicia *has not yet* been entered” and, therefore, that alteration here refers to the initial input of the ownership information. PO Sur-reply 10–11. We disagree with this reading of Cohen. Rather, we find that Cohen’s use of the

term “alter” means that ownership information entered as part of the process of Figure 3 can be changed, which is why “an additional level of security, such as a secondary password,” would be required over and above what is disclosed in Figure 3 with the entry of a password in block 36. Ex. 1006, 4:23–26.

Patent Owner argues that, “[a]t the time of invention (2002), it was wholly unconventional for a computer system to allow a device owner to remotely change return information over the Internet.” PO Resp. 31. According to Patent Owner, Petitioner’s assertion that it would have been obvious to combine Jenne’s teachings of delivering advertisements with Cohen’s teachings of locally inputting return information “is pure hindsight.” PO Resp. 31.

We disagree with Patent Owner’s arguments, which focus on the content of the information. As discussed above in Section II.D.2.b.1, Cohen discloses that the benefits of displaying owner information with a password prompt when the computer is started are that ownership of the computer can be determined and that the likelihood of return is increased. Ex. 1006, 5:52–58. As discussed above in Section II.D.2.a, Jenne discloses that the content of the information displayed can be remotely updated: “The computer manufacturer may also check for updates and downloads in block 65 via a manufacturer password that only the manufacturer or its authorized agent possesses.” Ex. 1005 ¶ 25; *see also* Ex. 1005 ¶ 13 (“The commercial messages in the non-volatile memory may be securely updated through the Internet using a password.”). Jenne discloses that the displayed information can be advertising content but also recognizes that “other information could be displayed” and specifically identifies other content, “such as

announcements, useful productivity tips, utility enhancements and computer upgrades.” Ex. 1005 ¶ 22. Based on these disclosures, we agree with Petitioner’s argument that “it would have been trivial to modify Jenne to display Cohen’s ownership indicia information because it would have involved merely substituting the content of the information to be displayed in Jenne (e.g., commercial/other information/announcements) with the message content disclosed in Cohen (e.g., personal ownership indicia).” See Pet. 19–20. As Petitioner correctly asserts, “the combination would have involved a simple substitution of a known generic element (Jenne’s ‘other information’) with a specific type of information (Cohen’s ‘ownership indicia’) to obtain predictable results.” Pet. 20.

(4) Without Assistance by the User

Claim 1 recites “changing return information which appears on the display through remote communication without assistance by a user with the computer.” Patent Owner argues that Jenne does not teach remotely changing information without assistance of a user because the computer user must log in and establish an Internet connection so that communication can occur, which Patent Owner contends is user assistance. PO Resp. 33–37. Patent Owner argues that the ’287 patent allows an owner to push recovery information changes to the computer even when the user of the computer has not connected to the Internet, such as when a computer is found by someone who does not know the password and, therefore, cannot connect to the Internet. PO Resp. 34–35. According to Patent Owner,

Nothing, other than turning on the computer, is required from the user. Hence, there is no “assistance.” The owner may *push* return/recovery information to the device via the Internet, but the user does [not] need to establish that connection. This makes

sense because the user does not and cannot have the password to gain access to the system and establish the connection.

PO Resp. 35.

We disagree with this argument because, as Petitioner correctly asserts, “[t]he language ‘without assistance by a user’ refers to the specific recited action of ‘initiating or changing [return/recovery] information,’ rather than to an unrecited action of establishing the remote communication in the first instance.” *See* Pet. Reply 15 (second alteration in original). We do not view the claims as prohibiting all other user interactions.

Jenne’s disclosure of checking for an internet connection before downloading any updates to the displayed information (Ex. 1005 ¶ 25, Fig. 1) is consistent with the updating process described in the following passage of the ’287 patent:

Using this unique communication power, both ‘owner’ and “assigned to” information can be uploaded to the recovery center and/or downloaded to the protected equipment in order to synchronize the international recovery center information and the recovery information displayed on the initial display 18 screen. (This is a combination of the PDA type of synchronization between the main computer 12 and the PDA, and the McAfee anti-virus software Internet updating capability where *every time you go on-line, your computer 12 automatically checks to make sure that you have the most current anti-virus software and automatically updates your computer 12 with the latest changes.*) Nobody has ever before considered or designed a product combining this type of communication ability with this type of recovery security program that seizes control of the display 18 monitor until a security prompt is satisfied. The Retriever design allows an equipment recovery capability that just does not exist on today’s market, and is completely unique from all current products on the market[.]”

Ex. 1001, 14:47–15:7 (emphasis added). Thus, the '287 patent explains that downloads of new information occur automatically when the user goes online.

Patent Owner argues that, “as anyone who has turned on a cellphone can attest, a connection can be established *automatically* without any involvement by the user. The user simply turns on the device.” PO Sur-reply 15 (citing Ex. 2048, 44:5–13, 45:2–15, 61:25–62:1). According to Patent Owner, “in many cases, there is no assistance in connecting to the Internet in a cellphone. Similarly, the Claims prohibit any assistance as part of the ‘remote communication’ process (other than turning on the device).” PO Sur-reply 15–16. The cited testimony from Dr. Zadok was in response to questions about how iPhones and smartphones operate and log on to networks. *See* Ex. 2048, 44:5–13 (question and answer about “iPhone or other smartphone”), 45:2–15 (question and answer about iPhone), 61:25–62:1 (answer about iPhone). Patent Owner does not direct us to any evidence that iPhones or other smartphones, to the extent they even existed “[a]t the time of invention (2002)” (PO Resp. 31), had such capabilities in 2002. We see no reason that we should interpret the claim to exclude the automatic updating functionality described in the specification of the '287 patent. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996) (noting that interpreting a claim to exclude a preferred embodiment in the specification “is rarely, if ever, correct and would require highly persuasive evidentiary support, which is wholly absent in this case”).

Patent Owner also argues that the “prosecution history further demonstrates that no input or action by the user is needed to remotely initiate or change return/recovery information.” PO Resp. 35–36 (citing Ex. 1012

(prosecution history of related U.S. Patent 8,601,606), 143, 151–53, 2071, 2075, 2093). The arguments Patent Owner made during prosecution of related U.S. Patent 8,601,606 show that the language “without assistance by a user” was added to distinguish over prior art that allegedly required a user at the computer “to push an interrupt key to allow the owner to change the display from remote.” Ex. 1012, 2093. In contrast, Jenne discloses remotely updating using a password without requiring the user at the computer to press a particular key to start the process. For example, Jenne explains that the “computer manufacturer may also check for updates and downloads in block 65 via a manufacturer password that only the manufacturer or its authorized agent possesses.” Ex. 1005 ¶ 25; *see also* Ex. 1005 ¶ 13 (“The commercial messages in the non-volatile memory may be securely updated through the Internet using a password.”).

Patent Owner also argues that Jenne’s updating process relies on user feedback to tailor advertisements to a user’s interests, which means the user provides assistance in updating the information. PO Resp. 37–39 (citing Ex. 1005 ¶¶ 20, 25, Fig. 1; Ex. 2040 ¶ 56(a)). This argument, however, does not respond to the asserted combination in which Petitioner relies on Jenne’s disclosure of remotely updating displayed information by an authorized party in combination with Cohen’s disclosure of an owner entering ownership information for display. *See* Pet. 32–34. Because, in Petitioner’s proposed combination, the content of the information is ownership indicia entered by the owner, we disagree with Patent Owner’s argument that, “without the user preferences and advertisements, the commercial message application [of Jenne] would not be built and would have nothing to execute.” *See* PO Sur-reply 17.

In view of the foregoing, we find Jenne teaches changing the content of information through remote communication without assistance by a user with the computer, which in combination with Cohen’s disclosure of changing ownership indicia, discussed above in Section II.D.2.b.4, teaches “changing return information which appears on the display through remote communication without assistance by a user with the computer,” as recited in claim 1.

(5) Remote Access Only by the Owner or Authorized Party

Patent Owner argues that Jenne does not teach that the interactive program “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,” as recited in claim 1 and similarly recited in claims 4 and 7. PO Resp. 39–42. According to Patent Owner, Jenne fails to teach this subject matter because “Jenne’s user can ‘uninstall or delete’ the application” and thus has access to the application. PO Resp. 40 (citing Ex. 1005 ¶ 21; Ex. 2040 ¶ 57(a)). Patent Owner also argues that Jenne’s disclosure that a premium user can enable or disable an advertisement shows access by someone other than the owner. PO Resp. 40–41 (citing Ex. 1005 ¶ 24).

Addressing similar arguments, the Institution Decision states that the claim limits “remote access,” not all access. Inst. Dec. 24–25. Patent Owner disagrees and argues that claim 1’s “lock screen” keeps unauthorized users off the system, “not allow[ing] local access to the interactive program, unless the security prompt is satisfied.” PO Resp. 41–42. Petitioner, however, relies on Cohen to teach “a lock screen with password prompt displayed after the computer is powered on and before allowing a user to

access the operating system.” Pet. 21 (citing Ex. 1006, Fig. 4 (steps 58, 60, 62)), 31 (citing Ex. 1006, Fig. 1), 37–38 (citing Ex. 1006, 5:28–37, Figs. 1, 4). Cohen’s Figure 1 shows a screen that prompts the user for a password. *See* Ex. 1006, 5:28–37 (“Block 58 illustrates the prompting of the user for a password. . . . [I]n the event the appropriate password has been entered, the password passes to block 62. Block 62 illustrates the occurrence of normal processing in a manner well known to those having skill in this art.”). Thus, the combination of Jenne and Cohen teaches restricting local access unless a security prompt is satisfied.

The claims do not specify that the “interactive program” cannot be accessed locally; rather, they specify that *remote* access is “only by the owner of the computer or the party authorized by the owner.” Thus, Patent Owner’s arguments regarding local access, including by a premium user in Jenne, are unavailing.

We find Petitioner’s contentions for the remote access limitation persuasive. Jenne discloses that remote updating is done with a password. Ex. 1005 ¶¶ 13 (“The commercial messages in the non-volatile memory may be securely updated through the Internet using a password.”), 25 (“The password may be used by the computer manufacturer or its authorized agent for securely updating the memory 520.”). Thus, the entity having the password is the “party authorized by the owner.” From the computer’s perspective, authorization is determined by checking for the correct password. This is consistent with the ’287 patent’s disclosure that the software determines who “is in charge” based on who “uses the correct password.” Ex. 1001, 15:33–41. In Petitioner’s combination, Cohen’s owner has remote access to change the content of the information displayed

(i.e., Cohen’s ownership indicia). *See* Pet. 34 (arguing that Cohen’s ownership indicia are entered by the owner and can be changed subsequently and that a person of ordinary skill in the art “would have been motivated to incorporate the capability to change the stored ownership information using Jenne’s ‘remote communication’ so that the most up-to-date ownership information is displayed when a device is lost or stolen” (citing Ex. 1005, code (57), ¶¶ 13, 21, 25; Ex. 1006, 4:23–26, 4:31–34; Ex. 1003 ¶¶ 303, 334)).

(6) Summary of Findings

Based on Petitioner’s persuasive contentions and evidence discussed above, we find that the combination of Jenne and Cohen teaches the subject matter of claim 1. We find that Jenne’s disclosure of displaying information during boot-up in combination with Cohen’s disclosure of displaying owner information with a lock screen during boot-up teaches the preamble of claim 1 and the subject matter reciting

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

Ex. 1005 ¶ 13 (displaying messages during boot-up); Ex. 1006, Fig. 1 (lock screen with owner information and password prompt).

For the reasons discussed above in Sections II.D.2.b.2–5, we find that the combination of Jenne and Cohen teaches

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.

We find that the combination of Jenne and Cohen teaches “displaying the screen before or with a security prompt which prevents the user from accessing operatively the computer” because, as discussed above, Cohen teaches displaying the ownership indicia with a lock screen that has a password prompt. Ex. 1006, Fig. 1. We also find that Cohen’s disclosure of the screen in Figure 1 showing the message “This system belongs to:” teaches “activating the processor to allow a warning message to the user.”

We find that a person of ordinary skill in the art would have combined the teachings of Jenne and Cohen such that Cohen’s ownership information would be displayed and could be remotely updated per Jenne’s disclosure of remotely updating information that is displayed for the reasons discussed above. In particular, we find that Cohen’s disclosure of the benefits of displaying owner information with a password prompt when the computer is started provides a reason to display ownership information in Jenne, as discussed above in Section II.D.2.b.1. As discussed above in Section II.D.2.b.3, we agree with Petitioner that substituting the content of information in Jenne with Cohen’s ownership indicia would have been a trivial modification and a simple substitution of one type of information with another. *See* Pet. 19–20. We also find that it would have been obvious to employ a lock screen, as taught in Cohen, in the system of Jenne because it would have protected the computer, as taught in Cohen. *See* Ex. 1006, 1:32–

37 (“[T]he utilization of password protection schemes maintains the integrity of data and applications within such devices”), 5:28–37 (referring to Figure 4’s process in which access to the computer is denied until entry of the correct password). We agree with Petitioner that a person of ordinary skill in the art would have had a reasonable expectation of success in making the combination to arrive at the claimed subject matter. *See* Pet. 21–22; Ex. 1003 ¶ 306.

(7) Secondary Considerations

Patent Owner contends that objective evidence of non-obviousness includes “praise Patent Owner received for her inventions, the inventions’ commercial success, copying by others, and failure by others.” PO Resp. 55–56; *see also* PO Sur-reply 24–26. Petitioner argues that Patent Owner has not established a nexus between the merits of the claimed invention and the objective evidence. Pet. Reply 25–27. We agree with Petitioner.

As stated by the Federal Circuit,

For objective evidence of secondary considerations to be relevant, there must be a nexus between the merits of the claimed invention and the objective evidence. *See In re GPAC*, 57 F.3d 1573, 1580 (Fed. Cir. 1995). A showing of nexus can be made in two ways: (1) via a presumption of nexus, or (2) via a showing that the evidence is a direct result of the unique characteristics of the claimed invention.

A patent owner is entitled to a presumption of nexus when it shows that the asserted objective evidence is tied to a specific product that “embodies the claimed features, and is coextensive with them.” *Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 229 F.3d 1120, 1130 (Fed. Cir. 2000).

Volvo Penta of the Americas, LLC v. Brunswick Corp., 81 F.4th 1202, 1210 (Fed. Cir. 2023). Furthermore, “even absent a presumption of nexus, ‘the patent owner is still afforded an opportunity to prove nexus by showing that the evidence of secondary considerations is the ‘direct result of the unique characteristics of the claimed invention.’” *Id.* (quoting *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1373–74 (Fed. Cir. 2019)).

Patent Owner argues that her “invention was commercialized under the name of ‘The Retriever,’” which “practiced the ’287 patent.” PO Resp. 55 (citing Ex. 1001, 4:61). This is the extent of Patent Owner’s argument supporting a presumption of nexus. Indeed, Patent Owner does not address coextensiveness at all. This is insufficient to show a presumption of nexus. *See Volvo Penta*, 81 F.4th at 1211 (finding that a one sentence assertion that a product embodies the claimed features of the Patent and is coextensive with them is insufficient to show a presumption of nexus).

Patent Owner’s arguments also do not prove a nexus independently of a presumption. For example, Patent Owner argues that, “[i]n various news articles and television coverage, her products were praised for their ability to retrieve lost or stolen computers.” PO Resp. 55 (citing Exs. 2042, 2043). Exhibit 2043 is a 2009 article titled “Talking software goes global” and mentions that the Retriever software has a “verbal alarm” and has the ability to “let[] law enforcement pinpoint the physical location of a stolen computer.” Exhibit 2042, a 2009 Associated Press article titled “Stop thief! Software lets stolen laptops speak up,” also discusses an audio alert that a stolen laptop can play. These articles indicate that non-patented features were the object of any alleged praise. Indeed, Exhibit 2043 states that,

“[s]ince Front Door Software Inc. launched the verbal alarm with a software upgrade on Thursday, Feb. 26, the story about the talking laptop software has been published around the world.” This suggests that the verbal alarm upgrade to the Retriever software resulted in any alleged praise.

Patent Owner also argues that she “received multiple awards for her products” and that her company “placed first out of 175 companies as the top start-up at a pitch contest in San Francisco.” PO Resp. 55 (citing Ex. 2044). Patent Owner does not cite evidence to support the assertion regarding “multiple awards.” The pitch contest brochure introduces the Front Door Software product as follows:

A patent pending laptop tracking and recovery program combined with one of the most powerful targeted opt-in page view delivery capabilities ever! By moving delivery out to the computer ON button, every 15,000 users using our free version automatically generates over 1 million page views @ mo. and over 50 million page views @ user license lifetime! <http://vator.co/frontdoorsoftware>.

Ex. 2044 at 8. This summary appears to focus more on the potential for page views than on the claimed features and in that regard is similar to Jenne’s teachings of showing messages to a “captive audience” during boot-up. Ex. 1005 ¶ 21; *see* PO Resp. 6–7 (describing Jenne’s teachings of monetizing user wait times).

Patent Owner also argues the following:

Patent Owner’s products were downloaded and successfully used by thousands of people in over 100 countries. Ex. 2045. Patent Owner tracked how often her customers’ devices would display return/recovery information, and such information was displayed millions of times per year. Patent Owner’s customers included major universities. *Id.* Patent

Owner's company generated hundreds of thousands of dollars in revenue from the sale of its products. *Id.*

PO Resp. 55. Exhibit 2045 appears to be a printout of a Front Door Software website from 2013 that lists certain institutional customers and countries where the software is deployed. The printout states the following:

We cannot tell where the majority of our customers are coming from unless they list their organization. We do know that we have had over 6 million customer visits to our web site in the past year and customers from over 100 countries and nations around the world are creating accounts in record numbers every day.

Ex. 2045 at 1 (emphasis omitted). The only specific evidence here is that there were over six million visits to the website. This is insufficient evidence to show commercial success tied to the merits of the invention. *Cf. Kansas Jack, Inc. v. Kuhn*, 719 F.2d 1144, 1151 (Fed. Cir. 1983) (“The evidence of commercial success consisted solely of the number of units sold. There was no evidence of market share, of growth in market share, of replacing earlier units sold by others or of dollar amounts, and no evidence of a nexus between sales and the merits of the invention.”).

Patent Owner further argues that “Microsoft did not release its Find My Device product for laptops until 2015, and Google did not release its Find My Device product for smartphones and tablets until 2013. Ex. 2046, Ex. 2047.” PO Resp. 55. Patent Owner does not explain how Google's and Microsoft's Find My Device features are evidence of non-obviousness of the '287 patent claims. According to Exhibit 2046, “Find My Device in Windows 10 doesn't do a whole lot right now. There isn't a way to have your tablet make a sound, lock itself, erase data, or anything like that. Instead, you can only find out where its last known general location was.”

Ex. 2046 at 1. According to Exhibit 2047, the Android Device Manager “lets you locate your Android device on a map, see when it was last located and when it was last used, as well as ring, lock and wipe the device.”

Ex. 2047 at 1. Thus, it appears that the Microsoft and Google features are for finding a device by ascertaining the location of the device, which is not a feature of the claims.

Finally, Patent Owner does not provide evidentiary support for her assertion that “the subject matter claimed in the ’287 patent is now included or may be downloaded on virtually every smartphone, laptop, tablet, and personal computer today.” *See* PO Resp. 56.

For the reasons discussed above, we find that Patent Owner has not provided objective evidence of non-obviousness that has a nexus to the claimed invention.

c) Conclusion for Claim 1

We find that the combination of Jenne and Cohen teaches the subject matter recited in claim 1 and that a person of ordinary skill in the art would have combined the teachings of Jenne and Cohen in the manner asserted by Petitioner with a reasonable expectation of success in arriving at the subject matter recited in claim 1. Patent Owner’s asserted objective evidence of non-obviousness lacks nexus and does not undermine Petitioner’s showing. Therefore, we conclude that the subject matter of claim 1 would have been obvious based on the combined teachings of Jenne and Cohen.

3. Claims 2–7

Independent claim 4 is directed to an apparatus for displaying and remotely changing “computer recovery information,” “recovery information,” or “return information,” and independent claim 7 is directed to

a computer program for displaying and remotely changing “recovery information” or “return information.” These independent claims recite subject matter substantially similar to claim 1, and the parties’ arguments for claim 1 apply to claims 4 and 7. *See* Pet. 13–40; PO Resp. 26–43.

For the reasons explained above in Section II.D.2 and based on Petitioner’s persuasive contentions and evidence, we conclude that the subject matter of claims 4 and 7 would have been obvious based on the combined teachings of Jenne and Cohen.

Claim 2 depends from claim 1 and recites “selecting by the owner or user an Internet link on the screen, an Internet location associated with the Internet link stored in the memory of the computer, the owner or user is automatically able to access the computer and the Internet location associated with the Internet link.” Claim 5 depends from claim 4 and similarly recites “wherein the display includes an Internet link that can be selected by the owner or user, an Internet location associated with the Internet link stored in the memory of the computer, the owner or user is able to access the computer and the Internet location associated with the Internet link.”

Petitioner argues that, based on Jenne’s disclosure of an Internet browser connected to the Internet for a user to access a website, a person of ordinary skill in the art “would have been motivated to include an active, user-selectable, ‘*Internet link*’ on the displayed return/recovery screen” “to allow an individual finding a lost or stolen computer to immediately access information or resources to assist with the return, rather than making the user contact the owner later through a different mechanism (e.g., phone call or postal mail).” Pet. 41–42 (citing Ex. 1005 ¶¶ 18, 27; Ex. 1003 ¶¶ 369–373).

Claim 3 depends from claim 1 and recites “wherein the screen having an active link allowing remote communication to a remote server which provides return information to facilitate return of the computer.” Claim 6 depends from claim 4 and similarly recites “wherein the display having an active link to allow remote communication to the remote server which provides recovery information to facilitate return of the computer.”

Citing Jenne’s disclosure that a user “may be directed to other advertisements through links” (Ex. 1005 ¶ 18), Petitioner argues that such links are active links and that it would have been obvious that such links go to information hosted on a remote server. Pet. 42–44 (citing Ex. 1003 ¶¶ 379–381). Petitioner argues that it “would have been well within the ordinary creativity of a [person of ordinary skill in the art] to include an active Internet link on the display screen as taught by Jenne with more specific return/recovery information,” which a person of ordinary skill in the art would have done “to allow an individual finding a lost or stolen computer to immediately access information or resources to assist with the return, rather than making the user contact the owner later through a different mechanism (e.g., phone call or postal mail).” Pet. 44 (citing Ex. 1003 ¶¶ 374–382).

Patent Owner does not separately argue claims 2, 3, 5, and 6. *See* PO Resp.

We find Petitioner’s contentions and evidence, summarized above, persuasive, and we conclude that the subject matter of claims 2, 3, 5, and 6 would have been obvious based on the combined teachings of Jenne and Cohen.

E. Remaining Grounds

As noted above in Section I.A, Petitioner presents additional grounds of unpatentability. Because we determine that all challenged claims are unpatentable as discussed above, we need not separately assess the remaining grounds. 35 U.S.C. § 318(a) (“If an inter partes review is instituted and not dismissed under this chapter, the Patent Trial and Appeal Board shall issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner and any new claim added under section 316(d).”); *Bos. Sci. Scimed, Inc. v. Cook Grp. Inc.*, 809 F. App’x 984, 990 (Fed. Cir. 2020) (nonprecedential) (“We agree that the Board need not address issues that are not necessary to the resolution of the proceeding.”).

III. CONCLUSION

For the reasons discussed above, we determine that Petitioner has proven, by a preponderance of the evidence, that claims 1–7 of the ’287 patent are unpatentable, as summarized in the following tables:

IPR2022-01192

Claim(s)	35 U.S.C. §	Reference(s)/Basis	Claim(s) Shown Unpatentable	Claim(s) Not Shown Unpatentable
1–7	103(a)	Jenne, Cohen	1–7	
1, 4, 7	103(a)	Angelo, Helle ¹¹		
Overall Outcome			1–7	

¹¹ As explained above, because we determine that the challenged claims are unpatentable based on the combination of Jenne and Cohen, we decline to address this ground and the grounds raised in IPR2022-01193.

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Claim(s)	35 U.S.C. §	Reference(s)/Basis	Claim(s) Shown Unpatentable	Claim(s) Not Shown Unpatentable
1–7	102(a)(1)	Hafeman 670		
1, 4, 7	103(a)	Hafeman 298, Chiu		

IV. ORDER

Accordingly, it is

ORDERED that Petitioner’s request to consolidate these proceedings is granted;

FURTHER ORDERED that claims 1–7 of the ’287 patent have been shown to be unpatentable; and

FURTHER ORDERED that, because this is a Final Written Decision, parties to the proceeding seeking judicial review of the Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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IPR2022-01193
Patent 9,892,287 B2

FOR PETITIONER:

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

Kirstin Stoll-DeBell
Carrie Beyer
FAEGRE DRINKER BIDDLE & REATH LLP
Kirstin.stolldeb@faegredrinker.com
Carrie.beyer@faegredrinker.com

FOR PATENT OWNER:

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