

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

R.N NEHUSHTAN TRUST LTD.,
Patent Owner.

IPR2023-00231
Patent 9,642,002 B2

Before JAMES P. CALVE, AARON W. MOORE, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

DOUGAL, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. *Background and Summary*

Petitioner, Apple Inc., requests that we institute an *inter partes* review challenging the patentability of claims 1–29 (the “challenged claims”) of U.S. Patent 9,642,002 B2 (Ex. 1001, “the ’002 patent”). Paper 2 (“Pet.”). Patent Owner, R.N Nehushtan Trust Ltd., argues that Petitioner’s request is deficient and should not be granted. Paper 6 (“Preliminary Response” or “Prelim. Resp.”).

Applying the standard set forth in 35 U.S.C. § 314(a), which requires demonstration of a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim, we deny the Petition and decline to institute an *inter partes* review.

B. *Related Matters*

The parties identify the following related district court litigation: *R.N Nehushtan Trust Ltd. v. Apple Inc.*, 3-22-cv-01832 (N.D. Cal.). Pet. 84; Paper 3, 2. Patent Owner also identifies the following related *inter partes* review: IPR2023-00230. Paper 3, 2.

C. *The ’002 Patent*

The ’002 patent is titled “Cellular Device Security Apparatus and Method” and relates to “a security system for protection of data,” including protection of “read and write access to configuration data, in a cellular telephony device.” Ex. 1001, code (54), 1:21–24. According to the ’002 patent, “[a] security vulnerability exists in cellular device[s]” where “it is [] possible to read sensitive information” and “write it into a new cellular device[,]. . . making the destination device identical to the source device with regards to the cellular network.” *Id.* at 1:25–35. This “enables the destination device to make calls, which are then billed to the source device.”

Id. The '002 patent describes solving security vulnerabilities associated with sensitive information stored on a cellular device by limiting device access.

The system uses a “data mode for allowing reading and writing of data to change the settings and generally to allow reprogramming.” *Id.* at 9:4–8. Device 20 is “configured to restrict use of the data mode” using a “unique security setting belonging to the device.” *Id.* at 9:8–10. This ensures “the data mode cannot be used unless the device unique security setting is provided” and “it is no longer possible to obtain a single password and thereby compromise a large number of devices.” *Id.* at 9:10–15.

The system includes reprogramming client device 24 and server 26 to support data mode operations on device 20. Device 24 supports connection 22 to device 20 and carries out reprogramming or data configuration operations, such as “replacing or updating of the operating system” and “changing of the telephone number.” *Id.* at 9:1–15. Server 26 supports device 24 and in some instances where “the device unique security settings are dynamic and change rapidly[,]” provides additional security by enabling “a live connection.” *Id.* at 10:14–21. The device unique security setting is “an encoding configuration for the data mode read and write instructions, and the data mode entry command,” “reprogramming client device 24 does not know... what the read and write command codes are for the given device.” *Id.* at 9:28–40. Server 26 “knows or generates the settings” such that the live connection permits data mode operation on device 20. *Id.* at 10:14–21.

D. Illustrative Claim(s)

Of the challenged claims, claims 1, 5, and 24 are independent. Claim 1 is illustrative:

A cellular communication device comprising

a processor, a memory, and a data mode allowing reading and writing of data into said memory and changing of settings on said cellular communication device,

said settings comprising personal data, device configuration data and technical data relating to the specific device; wherein:

said cellular communication device further comprising an access restrictor to restrict use of said data mode in accordance with a device unique security setting,

the device unique security setting provided remotely to said cellular communication device using a predetermined security protocol; and

wherein said device unique security setting is obtained remotely by the cellular communication device before the data mode is used by said cellular communication device,

said data mode being usable over a cellular network using an active connection;

the device being configured to perform one member of the group consisting of:

enabling said cellular communication device to use said data mode when said cellular communication device determines that said device unique security setting is correct; and

disabling said data mode when said active connection is not active.

Ex. 1001, 22:13–37 (some paragraphing added).

E. Evidence and Asserted Grounds

Petitioner’s grounds of unpatentability rely on the following evidence:

Name	Patent Document	Exhibit
Shahbazi	U.S. Patent 8,635,661 B2 (Jan. 21, 2014)	1004
Fam	U.S. Patent 7,181,726 B2 (Feb. 20, 2007)	1005
Geiger	U.S. Patent 6,463,534 B1 (Oct. 8, 2002)	1006
Shirai	U.S. Patent Pub. 2001/0051519 A1 (Dec. 13, 2001)	1007

Petitioner asserts the following grounds of unpatentability (Pet. 1), supported by the declaration of Dr. Patrick G. Traynor (Ex. 1003):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–29	103(a) ¹	Shahbazi
1–10, 13–19, 21–25, 27–29	103(a)	Fam, Geiger
11, 12, 20, 26	103(a)	Fam, Geiger, Shirai

II. ANALYSIS

A. Legal Standards

Petitioner bears the burden to demonstrate unpatentability. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). At this preliminary stage, we determine whether the information presented in the Petition shows a reasonable likelihood that Petitioner would prevail in establishing that at least one of the challenged claims would have been obvious over the proposed combinations of prior art. *See* 35 U.S.C. § 314(a).

¹ Because the challenged claims appear to have an effective filing date before March 16, 2013, we apply the version of 35 U.S.C. § 103 in effect before the adoption of the Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011).

A claim is unpatentable as obvious 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) (quoting 35 U.S.C. § 103(a)). We resolve the question of obviousness based on underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the prior art and the claims; (3) the level of skill in the art; and (4) when in evidence, objective indicia of nonobviousness. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

We apply these principles to the Petition’s challenges.

B. Level of Ordinary Skill in the Art

We review the grounds of unpatentability in view of the understanding of a person of ordinary skill in the art [POSITA] at the time of the invention. *Id.* at 13, 17.

Petitioner does not identify a level of skill for a person of ordinary skill in the art. *See generally* Pet. Petitioner’s declarant asserts that a person of ordinary skill in the art

would have had at least a Bachelor’s Degree in an academic area emphasizing electrical engineering, computer science, or a similar discipline, and at least one year of experience in wireless communication systems. Superior education could compensate for a deficiency in work experience, and vice-versa.

Ex. 1003 ¶ 20.

Patent Owner accepts this level of skill at this stage. Prelim. Resp. 6. Patent Owner also argues that “with just a college degree and one year of work experience, the level of ordinary skill is essentially entry-level and a POSITA would thus not consider non-routine modifications of prior art to be

obvious.” *Id.* at 6–7 (citing *Innovention Toys, LLC v. MGA Ent., Inc.*, 637 F.3d 1314, 1323 (Fed. Cir. 2011) (“A less sophisticated level of skill generally favors a determination of nonobviousness, and thus the patentee, while a higher level of skill favors the reverse.”)).

We are persuaded, on the present record, that this level of skill proposal is consistent with the problems and solutions in the ’002 patent and prior art of record. We adopt the noted definition of the level of skill for the purposes of this Decision.

C. Claim Construction

In *inter partes* review, we construe 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).

Petitioner asserts that no terms require express construction. Pet. 7–8. Patent Owner does not propose any claim constructions, but argues that Petitioner’s arguments assume various claim constructions. PO Resp. 7–8.

We determine that no terms need to be construed at this time. *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. 35 U.S.C. § 103(a) – Shahbazi

Petitioner argues that Shahbazi renders obvious claims 1–29. Pet. 8–47. Patent Owner argues that Shahbazi is not prior art to the ’002 patent and that Petitioner’s ground suffers from other shortcomings. Prelim. Resp. 8–

28. We first provide a brief summary of Shahbazi and then discuss Shahbazi's prior art status. For the reasons expressed below, we determine that Petitioner has not established a reasonable likelihood of succeeding in showing that at least one claim is unpatentable.

1. Shahbazi

Shahbazi is titled "System and Method for Enforcing a Security Policy on Mobile Device Using Dynamically Generated Security Profiles." Ex. 1004, code (54). Shahbazi is directed to generating an identity status for the mobile device and then applying a security profile to the mobile device based on the identity status. *Id.* at Abstr. "The identity status . . . can be determined when the mobile device connects to a computing node source or when the mobile device accesses a resource within the network. *Id.* (reference numerals omitted).

2. Prior Art Status of Shahbazi

Shahbazi was filed² after the earliest priority date claimed by the '002 patent³. However, Petitioner argues that Shahbazi is entitled to the December 23, 2003 priority date of the Shahbazi Provisional (Ex. 1011). Pet. at 2.

In order for Shahbazi to be entitled to the filing date of the Shahbazi Provisional, Petitioner is required to show written description support in the

² Shahbazi was filed on *December 22, 2004*. Ex. 1004, code (22).

³ The '002 patent claims priority to a provisional application filed *March 8, 2004* and is a continuation in a line of other continuations, where the earliest application was filed *May 6, 2004*. Ex. 1001, codes (60), (63). Thus, based on the chain of priority, Shahbazi itself is not prior art to the '002 patent unless Shahbazi is entitled to the benefit of its provisional. Whether or not the '002 patent is entitled to its claim of priority to its provisional does not impact this analysis.

Shahbazi Provisional for the invention disclosed in Shahbazi. *In re Wertheim*, 646 F.2d 527, 537 (CCPA 1981); *see also Dynamic Drinkware, LLC v. National Graphics, Inc.*, 800 F.3d 1375, 1378, 1381–82 (Fed. Cir.) (2015) (“A reference patent is only entitled to claim the benefit of the filing date of its provisional application if the disclosure of the provisional application provides support for the claims in the reference patent in compliance with [35 U.S.C.] § 112, ¶ 1.”).⁴ In addition, Shahbazi only receives the benefit of the earlier priority date of the Shahbazi Provisional for that which is disclosed in the Shahbazi Provisional. *See* 35 U.S.C. § 119(e) (An application for patent is entitled to the filing date of a provisional application for the invention disclosed in the provisional application); *see also* Prelim. Resp. 12. In other words, Petitioner also needs to show that the portions of Shahbazi relied on as teaching aspects of the ’002 patent claims find support in the Shahbazi Provisional.

Concerning written description support of the Shahbazi invention in the Shahbazi Provisional, Petitioner states that:

Shahbazi claims priority to U.S. Provisional Pat. No. 60/531,668 (“Shahbazi Provisional”)(APPLE-1011), filed 12/23/2003. As Dr. Traynor explains, “Shahbazi is entitled to the benefit of its provisional filing date i.e., the December 23, 2003 filing date” since the Shahbazi Provisional disclosure “provides sufficient detail that would have led a POSITA to conclude that the inventor of the Shahbazi Provisional had possession of the invention claimed in Shahbazi...” APPLE-1003, ¶63.

⁴ In *Dynamic Drinkware* the court stated that petitioner did not need to address priority in the petition until after the patent owner made an argument about reduction to practice. *Dynamic Drinkware, LLC*, 800 F.3d at 1381. Here, in contrast, Petitioner is attempting to establish, and thus bears the burden to establish, that Shahbazi is prior art that can be used against the ’002 patent based on its earlier priority claim. *See* Pet. 2–3.

Shahbazi, Claim 1 (APPLE-1004, 17:65-18:33)	Shahbazi Provisional
[1a] ⁵	APPLE-1011, 4-5
[1b]	<i>Id.</i> , 6-8
[1c]	<i>Id.</i> , 6-8, 14-15
[1d]	<i>Id.</i> , 10-11
[1e]	<i>Id.</i> , 10-11
[1f]	<i>Id.</i> , 15-17

Pet. 2–3.

Concerning support for the relied upon portions of Shahbazi in the Shahbazi Provisional, the Petition discusses Shahbazi and then typically cites to Shahbazi and the Shahbazi Provisional. *See id.* at 8–47. The Petition does not discuss the similarities or differences between Shahbazi and the Shahbazi Provisional, except to state that “Figures 1 and 2” are the same in both. *Id.* at 10 n.5. Other than in this one footnote, the Petition does not expressly discuss or describe the Shahbazi Provisional.

Shahbazi and the Shahbazi Provisional do not share identical disclosures. *Compare* Ex. 1004 *with* Ex. 1011. For example, Patent Owner correctly notes that “Figures 7 and 8 of Shahbazi do not appear in the Shahbazi Provisional,” and that “Figures 7-10 of the Shahbazi Provisional do not appear in Shahbazi.” Prelim. Resp. 13–14. Even more than this, a

⁵ The Petition does not identify which claim elements this short hand refers to. Pet. 2–3. However, we can compare this with Petitioner’s declarant testimony which includes an almost identical statement with claim language instead of the bracketed short hand. Ex. 1003 ¶ 63. Similar to the Petition, Petitioner’s declarant merely includes the chart, but does not provide any discussion, such as an analysis of the claim language with reference to the Shahbazi Provisional.

brief review of the two documents reveals that Shahbazi, though it may be based-in-part on the Shahbazi Provisional, appears to have been rewritten, with additional content added. For example, the Summary of the Invention sections, though they start with the same phrase, include different summaries of different inventions. *Compare* Ex. 1004, 3:40–59 (discussing a security profile based on an identity status of a mobile device) *with* Ex. 1011, 4–5 (discussing a node security program at a computer node).

As correctly noted by Patent Owner, the Petition does not include any parenthetical discussions, or clarifying statements concerning the Shahbazi Provisional. Prelim. Resp. 12 (“The only potential support in the Petition is unexplained citations to the Shahbazi Provisional throughout the Ground 1 argument section”). Patent Owner argues that some of these citations are to as many as nine pages of the Shahbazi Provisional, again without any explanation. *Id.* at 13 (citing e.g., Pet. 16, 17, 23, 33, 34). We agree with Patent Owner that Petitioner has not satisfied its burden to show support for its positions with regard to the Shahbazi Provisional.

By providing no discussion of the Shahbazi Provisional, the Petition essentially requires Patent Owner and the Board to guess which teachings in the Shahbazi Provisional the Petition is relying on. This does not satisfy our rules that require the Petition to “state the relevance of the evidence to the issues raised” and “identify how the . . . claim is unpatentable over the relevant evidence.” *See* Consolidated Trial Practice Guide⁶ at 42 (citing 37 C.F.R. § 42.104); *see also* 84 Fed. Reg. 64,280 (Nov. 21, 2019).

This applies equally to the requirement 1) to show written description support in the Shahbazi Provisional for the invention disclosed in Shahbazi

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

and 2) to show that the portions of Shahbazi relied on as teaching aspects of the '002 patent claims also find support in the Shahbazi Provisional.

As a more specific example of the issues created by the Petition, a review of the first two pages in the general description of Shahbazi in the Petition reveal that the quotes are all in Shahbazi (APPLE-1004), but that only some of the quotes are in the Shahbazi Provisional (APPLE-1011). For example, the Petition includes the following paragraph:

Shahbazi recognizes “a need for an efficient and flexible system and method for securing data in mobile devices used in varying operating environments.” APPLE-1004, 3:5-17; APPLE-1011, 4-5. This involves an identity status that is “akin to DNA information of an organism” and includes “information [that] characterizes or identifies different mobile devices.” APPLE-1004, 9:16-46; APPLE-1011, 7-9. The identity status enables a “security profile” used for device protection and includes parameters “relating to protection of the mobile device, restriction on use of an internal resource and external resource, and configuration of a resource.” APPLE-1004, 3:60-4:6; APPLE-1011, 7-9. This enables the Shahbazi system to “intelligently create and enforce security and data protection policies across [a] dynamic set of mobile devices and end points in a timeless, network, and device independent manner, with low maintenance requirement.” APPLE-1004, 5:26-31; APPLE-1011, 7-9; APPLE-1003, ¶60.

Pet. 9. The above paragraph includes 6 quotes, all of which are in Shahbazi at the cited locations. However, only the first quote and the quoted term “security profile” could be found in a text search of the Shahbazi Provisional and a visual search of the cited portions. Even more concerning, unlike Shahbazi, a text search revealed that the Shahbazi Provisional does not use the term “identity status” and from a review of the cited portion of the Shahbazi Provisional it is not evident what Petitioner is referring to as

disclosing the concept of “identity status,” the specifics surrounding identity, or any relationship between an identity status and a security profile.

The Petition relies on Shahbazi’s teachings related to “identity status” for a number of features of claim 1 of the ’002 patent. *See e.g., id.* at 20–23. None of these portions discuss the Shahbazi Provisional or explain why one of skill in the art would understand the Shahbazi Provisional to teach the concept of “identity status,” the specifics surrounding identity status or any relationship between an identity status and a security profile.

The term “identity status” is also used five times in Shahbazi’s claim 1, and thus is relevant to whether the claims of Shahbazi have written description support in the Shahbazi Provisional. The Petition’s discussion of written description support in the Shahbazi Provisional for Shahbazi’s claim 1 does not cite directly to pages 7–9 of the Shahbazi Provisional. However, limitations that include the term “identity status” cite to pages 6–8, 14–15, and 15–17 in the Shahbazi Provisional. Pet. 2–3. Thus, presumably, Petitioner desires Patent Owner and the Board to fish through all of those pages to guess which teachings the Petition is relying on. We decline to guess which teachings the Petition is relying on for teaching “identity status” in the Shahbazi Provisional. We further decline to speculate about which teachings in the Shahbazi Provisional correspond with the rest of Shahbazi’s claim 1 which is over half a column long. *See Ex. 1004, 17:65–18:33.*

Still further, Patent Owner correctly identifies that “there are several instances where Petitioner provides a citation to Shahbazi without providing a corresponding citation to the Shahbazi Provisional.” Prelim. Resp. 12–13 (citing *e.g.*, Pet. 13). This is most relevant to the Petition’s explanation as to why 35 U.S.C. § 103 applies, rather than 35 U.S.C. § 102. Pet. 12–14. Petitioner admits that “Shahbazi’s disclosure of some relevant features

arguably span more than one embodiment.” *Id.* at 12. The Petition then alleges that it would be obvious to combine these disclosures in Shahbazi, citing support in Shahbazi and by Petitioner’s declarant. *Id.* at 13–14 (citing Ex. 1004, 2:12–41, 7:65–8:12; Ex. 1003 ¶¶ 76–77). Notably missing is any citations to or discussion of the Shahbazi Provisional. *Id.* (This also includes a discussion of “identity status” in Shahbazi).

For these reasons, we agree with Patent Owner that, without more (such as identifying with particularity how the Shahbazi Provisional supports Petitioner’s reliance on Shahbazi), we are left to speculate about what exactly Petitioner is relying on in the Shahbazi Provisional. In this instance, where the disclosures are not the same, mere citations without any discussion is inadequate. As the Petition fails to provide a reasonable basis for us to determine whether Shahbazi is prior art to the ’002 patent, Petitioner has not established a reasonable likelihood of succeeding in showing that any of the challenged claims are unpatentable.

E. 35 U.S.C. § 103(a) – Fam, Geiger

Petitioner argues that the combination of Fam and Geiger renders obvious claims 1–10, 13–19, 21–25, and 27–29. Pet. 47–77. Patent Owner argues that Petitioner’s ground suffers from multiple shortcomings. Prelim. Resp. 28–49. We first provide a brief summary of the asserted prior art and then discuss some of the parties’ arguments with respect to the independent claims. For the reasons expressed below, we determine that Petitioner has not established a reasonable likelihood of succeeding in showing that at least one claim is unpatentable.

1. Fam

Fam is titled “Method for Providing Active Protection to Programming Tools for Programmable Devices.” Ex. 1005, code (54). Fam teaches a

method where key data is sent “from the mobile phone to the computer system over a data connection” and then “authorized configuration data at the computer system [is authorized after] referencing the received key data, before finally, programming the mobile phone with the authorized configuration data through the data connection to enable a predetermined authorized operational mode.” *Id.* at Abstr.

2. *Geiger*

Geiger is titled “Secure Wireless Electronic-Commerce System with Wireless Network Domain.” E. 1006, code (54). *Geiger* teaches that “[e]ach phone in the factory has [] some unique characteristics built-in before the unit is shipped.” *Id.* at 5:59–65. When a phone (i.e., wireless device) is at the factory, “a Public Key Certificate is generated for the phone.” *Id.* at 4:59–5:10. The Public Key Certificate is generated by Software Server 17 and “[t]he phone is installed with its own Public Key Certificate.” *Id.*

3. *Independent Claims 1, 5, 24*

The Petition argues that the combination of *Fam* and *Geiger* renders obvious claim 1. Pet. 53–66. The Petition also relies on the same or similar teachings for most of the features of independent claims 5 and 24. *See id.* at 66–67. We focus on Patent Owner’s arguments with respect to two claim limitations below.

a) *Data Mode Allowing . . . Changing of Settings . . . Comprising Personal Data*

Claim 1 includes the following:

A cellular communication device comprising . . . a data mode allowing reading and writing of data into said memory and changing of settings on said cellular communication device, said settings comprising personal data . . .

Ex. 1001, 22:13–17. Claims 5 and 24 include similar limitations. *Id.* at 22:49–53, 24:25–29.

As will be discussed below, the Petition fails to address the claimed requirement that the data mode allows changing of settings comprising personal data. Rather, the Petition argues that Fam teaches a data mode including the changing of settings generally, but then only argues that the memory includes personal data, which are settings. The Petition does not argue that the references teach that the personal data is changeable in the data mode as required by the claim.

The Petition relies on Fam for teaching an operational mode that allows reading and writing of data and changing of settings on a mobile phone, including Fam’s Figure 1, reproduced below. Pet. 54–56.

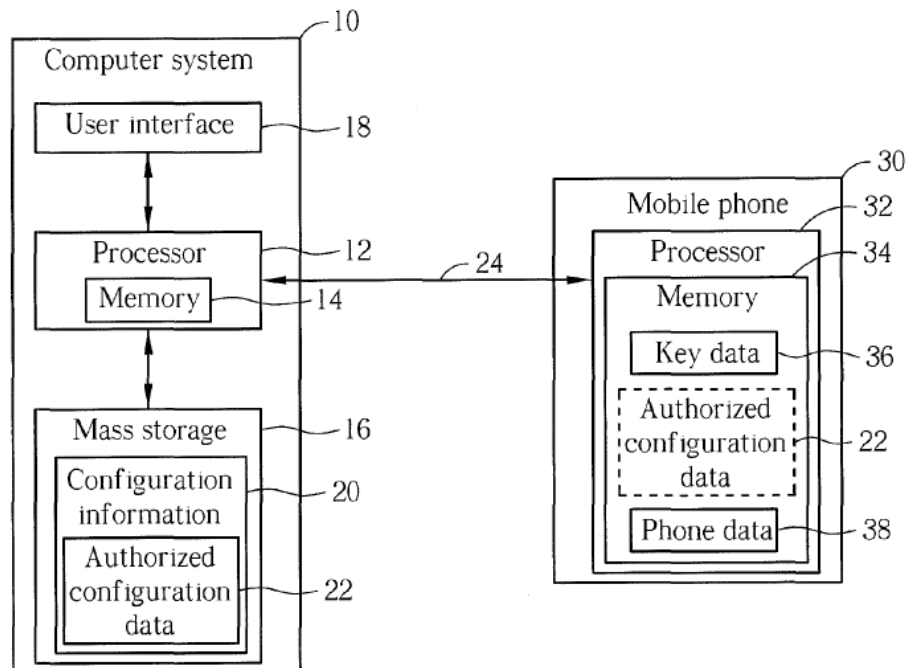


Fig. 1

Fam’s Figure 1 shows computer system 10 for programming a mobile phone 30, where the computer system is connected to the mobile phone over cable 24. Ex. 1005, 2:64–65, 3:3–6. Petitioner argues that when the

computer system and mobile phone are connected, the mobile phone is in a programming mode that reads on the claimed data mode. Pet. 55. Petitioner further argues that “[t]he programming mode involves ‘**allowing reading and writing of data**’ into memory 34 since, upon completion of the programming mode, the mobile phone 30 becomes operational and/or functional.” *Id.* Fam teaches that when the computer and mobile phone are connected, the computer can program the mobile phone with configuration information 20 (22 on the mobile phone) that includes “operating data and parameters required for the mobile phone [] to function such as mobile phone operating software, network information, service provider information, hardware settings, and other similar information for supporting a wide variety of mobile phones.” Ex. 1005, 3:8–29.

Turning to the claimed “data mode allowing . . . changing of settings on said cellular communication device,” Petitioner asserts that one of skill in the art would “have found obvious that the programming mode is an operational state of mobile phone 30 that permits the reading and writing of device data and the changing of device settings or a mode in which mobile phone 30 can change settings and read and write information.” Pet. 56 (citing Ex. 1003 ¶ 125).⁷

The Petition then argues that “Mobile phone 30 stores various types of data in memory 34 that a POSITA would have understood includes . . . “**personal data**.”” *Id.* However, as noted above, the claim requires more than just storing personal data in the mobile phone. The Petition does not argue that Fam alone, or in combination with Geiger, teaches a “data mode

⁷ The Petition also argues that when Fam changes key data this is also changing a setting, however, the Petition does not relate this to personal data and so it is not relevant to our discussion here. *See* Pet. 55–56.

allowing . . . changing of settings . . . said settings comprising personal data” as required by claim 1. Rather, the Petition merely asserts, without explanation, that one of skill in the art would understand that the programming mode includes changing of settings, and then argues that the memory includes personal data in the settings. The Petition does not address changing of personal data settings in the programming mode of Fam. Thus, the Petition does not sufficiently identify how the prior art teaches all of the limitations of the claims.

The Petition later states that Fam’s phone data 38 in view of the teachings of Geiger would be understood to be personal data. Pet. 58. However, reviewing Fam Figure 1, it can be seen that the phone data 38 is not part of configuration data 20/22 used to program the phone in the programming mode. The Petition does not address the fact that Fam does not appear to teach changing the phone data 38 during the programming mode, which is what the Petition relies on for the claimed data mode.

Still further, the Petition admits that Fam teaches that the phone data 38 is “generally non-configurable information.” *Id.* Thus, even if the Petition did assert that phone data 38 includes changeable settings, it would also need to address this admitted teaching to the contrary, which it does not. *See* Prelim. Resp. 36.

For these additional reasons, the Petition does not sufficiently show how all of the limitations of the independent claims are taught or suggested by the cited prior art.

b) Usable Over a Cellular Network

Claim 1 also requires “said data mode being usable over a cellular network using an active connection.” Ex. 1001, 22:28–29. Claims 5 and 24 include similar limitations.⁸ *Id.* at 22:65–23:1, 24:44–45.

The Petition relies on Fam for teaching a programming mode when there is an active connection between the computer system 10 and mobile phone 30 over cable 24 or “radio transmitters and receivers.” Pet. 62–63 (citing Ex. 1005, 2:64–3:7, Fig 1). Petitioner argues that a cellular service provider could “use[] Fam’s proposed software framework to program mobile phone 30 (e.g., to provision the device for cellular telecommunications services).” *Id.* at 64 (citing Ex. 1003 ¶ 135 (Petitioner’s declarant making the same assertion)). Petitioner states that Fam’s configuration information 20 used to program mobile phone 30 in the programming mode includes the programming necessary “so that ‘processor 32 can instruct related systems of the phone 30 to communicate with cellular base stations of the correct service provider.’” *Id.* (citing Ex. 1005, 3:8–29, 3:30–50). Petitioner then argues that “it would have been obvious to a POSITA that Fam indicates, in at least some implementations, the service provider is a telecommunications service provider that provides authorized configuration data 22 to program mobile phone 30 to communicate over its cellular network.” *Id.* at 65.

However, Petitioner’s argument does not correspond with the requirements of the claim. Petitioner is arguing that Fam’s configuration information sent during the programming mode, can relate to and be used to

⁸ The similar limitation in Claim 5 is significantly more detailed than what is required by claim 1. However, the Petition fails to address these additional details.

set up a connection with a cellular network, not the “data mode being usable *over a cellular network* using an active connection.” *See also* Prelim. Resp. 44–45.

Further, the Petition includes no discussion of a data mode after the mobile device has been programmed with the necessary cellular network connection information as taught by Fam, and relied on by Petitioner for teaching other elements of claim 1. Thus, if this is the intended meaning of Petitioner’s argument, it is also insufficient. The Petition cannot merely pick and choose embodiments from the prior art to use for different claim elements without consideration of the claim as a whole.

The Petition also includes a statement that “Dr. Traynor explains that ‘techniques for enabling remote configurations of mobile devices over a cellular network were well-known by the Critical Date.’” Pet. 65 (citing Ex. 1003 ¶ 125). However, this is also insufficient; the mere fact that something is known, outside of the reference being relied on, is not enough to establish obviousness. *See KSR*, 550 U.S. 415–18 (In general, obviousness entails an inquiry that is “expansive and flexible” and takes into account “the inferences and creative steps that a person of ordinary skill in the art would employ” when presented with the teachings of the prior art.). Petitioner provides no discussion of this “known” technology in the context of the teachings of Fam. *See* Prelim. Resp. 45. Thus, it is unclear what Petitioner’s position is as to how it relates to the teachings of Fam or how the combination reads on the limitations of claim 1.

For these additional reasons, the Petition does not sufficiently show how all of the limitations of independent claims 1, 5, and 24 are taught or suggested by the cited prior art.

4. *Claims 2–4, 6–10, 13–19, 21–23, 25, 27–29*

As the Petition does not sufficiently show how all of the limitations of the independent claims are taught or suggested by the cited prior art, it also does not sufficiently show how all of the limitations of the dependent claims are taught or suggested by the cited prior art.

F. 35 U.S.C. § 103(a) – Fam, Geiger, Shirai

Petitioner argues that the combination of Fam, Geiger, and Shirai renders obvious claims 11, 12, 20, and 26. Pet. 77–80. The Petition does not rely on Shirai to address any of the shortcomings discussed above.

As the Petition does not sufficiently show how all of the limitations of the independent claims are taught or suggested by the cited prior art, it also does not sufficiently show how all of the limitations of these dependent claims are taught or suggested by the cited prior art.

III. CONCLUSION

For the foregoing reasons, we do not institute trial.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), no *inter partes* review as to any claim of U.S. Patent 9,642,002 B2 is instituted.

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Patent 9,642,002 B2

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