

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

AGIS SOFTWARE DEVELOPMENT, LLC,
Patent Owner.

Case IPR2018–01083
Patent 9,445,251 B2

Before TREVOR M. JEFFERSON, CHRISTA P. ZADO, and
FREDERICK C. LANEY, *Administrative Patent Judges*.

LANEY, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner Google LLC (“Google”) filed a request for *inter partes* review of claims 1, 2, 4–6, 8, 10, 12, 22–24, 27, 29, 31, 32, and 35 (the “challenged claims”) of U.S. Patent No. 9,445,251 B2 (Ex. 1001, “the ’251 patent”). Paper 2 (“Pet.”). Patent Owner AGIS Software Development, LLC (“AGIS”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). Google filed a Reply. Paper 9.

Under 35 U.S.C. § 314, an *inter partes* review must not be instituted “unless . . . the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Upon considering the evidence presented and the arguments made, we determine that Google has not demonstrated a reasonable likelihood that it would prevail in showing the unpatentability of at least one of the challenged claims. Accordingly, we do not institute an *inter partes* review.

A. RELATED PROCEEDINGS

As required by 37 C.F.R. § 42.8(b)(2), each party identifies various judicial or administrative matters that would affect or be affected by a decision in this proceeding. Pet. 2–4; Paper 4, 2–4 (“AGIS’s Mandatory Notices”).

B. THE ’251 PATENT

The ’251 patent specification (“Specification”) generally discloses a method and communication system to quickly set up and provide ad hoc, password protected, digital and voice communication networks among users of integrated handheld cellular/PDA/GPS phones (“integrated device” or “device”). Ex. 1001, 1:33–46. The Specification discloses that there is a

need to be able to set up ad hoc digital and voice networks easily and rapidly across different groups of users such as military, first responder, and other public and private emergency groups. Ex. 1001, 2:8–19. According to the Specification, users’ integrated devices need “to be able to rapidly coordinate their activities eliminating the need for pre-entry of data into a web and or identifying others by name, phone numbers or email addresses so that all intended participants that enter the agreed ad hoc network name and password are both digitally and voice interconnected.” *Id.* at 2:8–17; *see also id.* at 3:48–51 (same). Although previous systems may have allowed for voice and data communications among separate first-response entities (e.g., police and fire departments), they did not have the ability to cross communicate “without a substantial degree of immediate coordination.” *Id.* at 2:20–37. The invention, therefore, endeavors “to quickly establish user specific password protected private ad hoc voice and data networks to enable both data and voice communications up and down [first responders’] chain of command and simultaneously with different, not pre-known, organizations responding to a disaster.” *Id.* at 2:37–44.

The disclosed system includes a plurality of Internet Protocol (“IP”) capable integrated devices each having an Advanced Communication Software (“ACS”) application program. *Id.* at 2:57–59. The plurality of integrated devices, in conjunction with a remote Server, provides the ability to establish an ad hoc network of devices so that the devices can either broadcast to a group or selectively transmit to each other. *Id.* at 2:57–3:1. “The Server is used to establish an ad hoc network within certain groups using an ad hoc event name and password.” *Id.* at 3:43–45, 5:13–24. A user of an integrated device establishes the ad hoc communication network or

joins an existing ad hoc communication network by entering the remote Server's IP address, an ad hoc event name such as "Katrina," and a password in an appropriate prompt on the user's device. *Id.* at 3:52–55, 10:46–60. The user may also enter the user's name and phone number. *Id.*

Upon establishing or joining an existing communication network, the user's device commences reporting information to the remote server, including the user's IP address and GPS derived location. Ex. 1001, 10:61–11:2. Initially, when only one device has joined the network, the remote server retains the information reported by the device. *Id.* at 11:2–4. When additional devices join the network by using the same ad hoc event name and password and report their information to the remote server, the remote server can use the network participant devices' IP addresses to pass location information automatically between the devices. *Id.* at 11:4–10. "This can occur even though the ad hoc network participants have not entered other network participant's names, telephone number or Email addresses and do not have the other network participants' IP addresses, phone numbers or Email addresses." *Id.* at 11:10–14. Once a user or users leave the network, "no data concerning the network participants need be retained." Ex. 1001, 2:17–19.

According to the Specification, the ACS application program also provides for a geographical map that displays georeferenced entities on a user's device display. *Id.* at 6:17–23. The map is displayed on a touch screen that the device user may interact with using his/her finger or a stylus. *Id.* at 5:34–44. The map may display symbols depicting permanent geographical locations and buildings. *Id.* at 6:43–45. The map may also display symbols, such as a triangle or square, that represent participants of

the communication network. Ex. 1001, 6:59–62. The latitude and longitude of the device corresponding to a particular symbol displayed on the map are related by software to x and y coordinates on the map. *Id.* at 7:4–8.

Accordingly, the location of the symbol on the map corresponds to the device’s physical location provided by the device’s GPS location data. *Id.* at 5:48–58, 7:2–8. In addition, a database may associate the latitude and longitude of a particular symbol displayed on the map with a specific cell phone number, IP address, and email address. *Id.* at 6:66–7:2.

One feature of the disclosed system is that a user may initiate contact with another user by selecting with a stylus the symbol on the user’s map corresponding to the user to be contacted. Ex. 1001, 8:64–9:8. The device of the initiator detects the x and y coordinates of where the stylus touched the display screen, and software translates the x and y coordinates to latitude and longitude. *Id.* The software then searches the device database of the initiator device for information corresponding to the latitude and longitude, such as an associated phone number or IP address. *Id.* The software then initiates appropriate contact, for example, by initiating a phone or Voice over IP (“VoIP”) call to the device of the user to be contacted. *Id.*

C. CHALLENGED CLAIMS

Google challenges claims 1, 2, 4–6, 8, 10, 12, 22–24, 27, 29, 31, 32, and 35 of the ’251 patent. Claims 1 and 24 are independent and are substantially similar. Claim 1 is illustrative.

1. A computer-implemented method comprising:

[1a] with a first device, receiving a message from a second device, wherein the message relates to joining a group;

[1b] based on receiving the message from the second device, participating in the group, wherein participating in the

group includes sending first location information to a server and receiving second location information from the server, the first location information comprising a location of the first device, the second location information comprising a plurality of locations of a respective plurality of second devices included in the group;

- [1c] presenting, via an interactive display of the first device, a first interactive, georeferenced map and a plurality of user-selectable symbols corresponding to the plurality of second devices, wherein the symbols are positioned on the first georeferenced map at respective positions corresponding to the locations of the second devices, and wherein the first georeferenced map data includes data relating positions on the first georeferenced map to spatial coordinates;
- [1d] sending, from the first device to the server, a request for a second georeferenced map different from the first georeferenced map, wherein the request specifies a map location;
- [1e] receiving, from the server, the second georeferenced map, wherein the second georeferenced map includes the requested location and data relating positions on the second georeferenced map to spatial coordinates;
- [1f] presenting, via the interactive display of the first device, the second georeferenced map and the plurality of user-selectable symbols corresponding to the plurality of second devices, wherein the symbols are positioned on the second georeferenced map at respective positions corresponding to the locations of the second devices; and
- [1g] identifying user interaction with the interactive display selecting one or more of the user-selectable symbols corresponding to one or more of the second devices and positioned on the second georeferenced map and user interaction with the display specifying an action and, based thereon, using an Internet Protocol to send data to the one or more second devices via the server,

[1h] wherein the first device does not have access to respective Internet Protocol addresses of the second devices.

Ex. 1001, 14:59–15:35 (reference annotations [1a]–[1h] added).

D. REFERENCES AND MATERIALS RELIED UPON

Google relies on the following references and materials in support of the asserted ground of unpatentability:

References and Materials	Exhibit No.
U.S. Patent No. 6,366,782 B1, issued Apr. 2, 2002 (“Fumarolo–782”)	1005
U.S. Patent No. 6,204,844 B1, issued Mar. 20, 2001 (“Fumarolo–844”)	1006
U.S. Application Pub. No. 2002/0173906 A1, published Nov. 21, 2002 (“Muramatsu”)	1007
U.S. Application Pub. No. 2002/0027901 A1, published Mar. 7, 2002 (“Liu”)	1008
Declaration of David Hilliard Williams (“Williams Decl.”)	1003

E. ASSERTED GROUND OF UNPATENTABILITY

Challenged Claims	Statutory Basis	Reference(s)
1, 2, 4–6, 8, 10, 12, 22–24, 27, 29, 31, 32, and 35	35 U.S.C. § 103	Fumarolo–782, Fumarolo–844, Muramatsu, and Liu

II. DISCUSSION

In the Petition, Google challenges the patentability of the challenged claims based on their alleged obviousness in view of the prior art. Pet. 5. A

claim is unpatentable under 35 U.S.C. § 103(a) if “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (internal quotation marks and citation omitted). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the level of skill in the art; (2) the scope and content of the prior art; (3) any differences between the claimed subject matter and the prior art; and, when in evidence, (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). In this case, only the first three factors are relevant because AGIS does not introduce any objective evidence of nonobviousness into the record.

In an *inter partes* review, “the petitioner has the burden from the onset to show with particularity” why the claims it challenges are unpatentable. *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016). It is incumbent upon Google to identify, in the Petition, “in writing and with particularity each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3); *see also Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (“It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’ 35 U.S.C. § 312(a)(3).”). Although the burden of production may shift, the burden of persuasion on the issue of patentability remains with Google

always and never shifts to AGIS. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). We analyze the challenges presented in the Petition in accordance with the above-stated principles.

A. CLAIM CONSTRUCTION

In this *inter partes* review, claim terms in the unexpired patent are given their broadest reasonable interpretation in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b) (2016)¹; *Cuozzo Speed Tech., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016). Under the broadest reasonable interpretation standard, and absent any special definition, we generally give claim terms their ordinary and customary meaning, as understood by a person of ordinary skill in the art in the context of the entire patent disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

1. “second georeferenced map”

Google proposes a construction for only “second georeferenced map” in this Petition. Pet. 10–12. AGIS does not dispute Google’s proposed construction of this term. See Prelim. Resp. 5–15. Our decision in this case does not depend on the meaning of “second georeferenced map.” Therefore, in this Decision, we do not reach Google’s contentions about the proper construction for this term. See *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (citing *Vivid Techs.*,

¹ A recent amendment to this rule does not apply here because the Petition was filed before November 13, 2018. See *Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board*, 83 Fed. Reg. 51,340 (Oct. 11, 2018) (to be codified at 37 C.F.R. pt. 42).

Inc. v. Am. Sci. & Eng’g, Inc., 200 F.3d 795, 803 (Fed. Cir. 1999)) (explaining that only those claim terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy).

2. *Sufficiency of the Petition*

AGIS argues that Google’s reliance on the plain and ordinary meaning of the term “device” recited in independent claim 24, and the challenged claims depending therefrom, is contrary to the positions that identified real parties-in-interest to this proceeding, Huawei and LG (“Defendants”), have taken in district court. *Id.* Specifically, AGIS asserts Google’s reliance on the plain meaning of “device” is inconsistent with Defendants’ assertion before the district court that the claim elements reciting a device are properly construed as means-plus-function limitations. *Id.* at 6–10. AGIS argues that this inconsistency demonstrates a failure by Google to comply with its obligations under 37 C.F.R. § 42.104(b)(3) to disclose how the challenged claims are to be construed. *Id.* at 10–13. In addition, AGIS contends Google has violated its duty of candor under 37 C.F.R. §§ 42.11 and 11.18(b)(2) by knowingly advancing conflicting positions. *Id.* at 13–15. According to AGIS, we should deny this Petition because of Google’s alleged inconsistent position. *Id.* at 12–13, 15.

We do not agree that the Petition fails to satisfy the requirements of 37 C.F.R. § 42.104(b)(3). This Rule requires a petition to set forth “how the challenged claim is to be construed.” 37 C.F.R. § 42.104(b)(3). This language does not refer to belief in the correctness of the construction, the determination of which would involve a subjective inquiry into the belief of, in this case, a corporate entity. As recently noted in *General Electric Co. v. Vestas Wind Systems, A/S*, the Office stated that the claim construction

requirement in the Rule 104(b)(3) gives the patent owner a more complete understanding about the basis for the unpatentability challenge in the Petition and assists the Board in analyzing how the cited prior art meets a claim limitation. IPR2018-00928, Paper 9, 14–15 (PTAB Nov. 5, 2018) (citing *Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents*, 77 Fed. Reg. 48,680, 48,688–700 (Aug. 14, 2012)). In fact, in response to a public comment raising this very point, the Office made clear that “[t]he rules do not preclude providing alternative claim constructions in a petition.” 77 Fed. Reg. at 48,700. Here, we find that the Petition sets forth with sufficiency Google’s assertions as to how the claims are to be construed in this proceeding. Therefore, for the foregoing reasons, we do not agree with AGIS’s contention that Google failed to satisfy the requirements of 37 C.F.R. § 42.104(b)(3).

As to AGIS’s contentions regarding the duty of candor, we are not persuaded, on this record, that Google has violated its duty of candor by presenting claim constructions to the Board that differ from those Defendants have presented to the district court. The standards used for claim construction and the burdens of proof are different in the district court than they are in this AIA proceeding, such that different constructions may be appropriate depending on the context. In district court proceedings, claims in issued patents are construed using the framework set forth in *Phillips v. AWH Corp.*, which emphasizes considering the plain meaning of the claim terms in light of the intrinsic record. *In re CSB-Sys. Int’l, Inc.*, 832 F.3d 1335, 1341 (Fed. Cir. 2016) (citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–15 (Fed. Cir. 2005) (en banc)). In this AIA proceeding,

however, we must apply the broadest reasonable construction consistent with the specification, otherwise known as “BRI.” *See Cuozzo Speed Tech., LLC v. Lee*, 136 S. Ct. 2131 (2016) (affirming the use of broadest reasonable construction standard in AIA proceedings despite the possibility of inconsistent results in district court litigation).

Under the circumstances presented here, we do not find that Google acted contrary to its duty of candor under 37 C.F.R. §§ 42.11 and 11.18(b)(2). Therefore, we decline to deny the Petition for failure to comply with 37 C.F.R. §§ 104(b)(3), 42.11, and 11.18(b)(2) on the grounds requested by AGIS.

B. LEVEL OF ORDINARY SKILL IN THE ART

Google asserts that a person of ordinary skill in the art in the field of the ’251 patent would have had either: 1) a bachelor of science degree in electrical engineering, computer science or an equivalent field, with three to five years of academic or industry experience in the wireless/mobile location industry or comparable industry experience; or 2) a master of science degree in electrical engineering, computer science, or an equivalent field, with two to four years of academic or industry experience in the same field. Pet. 9. Google further asserts that experience could take the place of some formal training, as relevant knowledge and skills could be learned on the job, and that a higher level of education or skill might make up for less experience, and vice versa. *Id.* (citing Ex. 1003 ¶ 29). AGIS does not provide an assessment of the appropriate level of skill in the art; nor does AGIS suggest Google’s characterization of the ordinary skill level would lead to an improper understanding of the claimed technology or about what the prior art demonstrates was known. *See generally* Prelim. Resp.

On this record, we adopt Google’s uncontested representation of the level of ordinary skill in the art. We further note that the prior art itself demonstrates a level of skill in the art at the time of the invention, which is consistent with Google’s position. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (explaining that specific findings regarding ordinary skill level are not required “where the prior art itself reflects an appropriate level and a need for testimony is not shown”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

C. THE SCOPE AND CONTENT OF THE PRIOR ART

1. *Scope of the Prior Art*

Google contends that the publication dates of Fumarolo–782, Fumarolo–844, Muramatsu, and Liu qualify them under 35 U.S.C. § 102 as prior art references available against the ’251 patent. Pet. 5–6. AGIS does not dispute these contentions in its Preliminary Response.

AGIS does contend, however, that the Fumarolo references are “not directed to the same technological field as the ’251 Patent or the secondary references, *i.e.*, Muramatsu, and Liu.” Prelim. Resp. 18. To the extent AGIS is contending that the Fumarolo references are outside the scope of available prior art because they are non-analogous art, we do not agree.

The ’251 patent describes “related art” as encompassing communication systems that enable the transmission of messages from a source, located at one point, to user destination(s), located at other point(s) some distance away. Ex. 1001, 1:53–55. A particular problem the ’251 patent seeks to address is the coordination of communications between different organizations at the scene of a disaster, such as police and firefighters responding to a disaster. *Id.* at 2:20–44. The Fumarolo

references relate to a communication system that would allow for the coordination of communications between different organizations at the scene of a disaster, such as police and firefighters responding to a disaster. *See e.g.*, Ex. 1005, 6:28–39; Ex. 1006, 2:1–16. Therefore, the Fumarolo references are analogous art and within the scope of available prior art because they are at least reasonably pertinent to the problem with which the inventors of the '251 patent were concerned. *See Sci. Plastic Prods., Inc. v. Biotage AB*, 766 F.3d 1355, 1359–60 (Fed. Cir. 2014).

2. *Content of the Prior Art*

The following are general descriptions of Fumarolo–782, Fumarolo–844, Muramatsu, and Liu.

a. *Fumarolo–782*

Fumarolo–782, titled “Method And Apparatus For Allowing A User Of A Display-Based Terminal To Communicate With Communication Units In A Communication System,” describes a dispatch system with a display-based terminal, such as a CAD (Computer Aided Dispatch) terminal, having an integrated mapping program to communicate directly with communication units from a single map environment. Ex. 1005, [54], [57], 1:18–22, 2:52–56. Fumarolo–782 explains that when such a system receives incident information from a 911 system that is coupled to the CAD system, a dispatcher “can quickly determine which communication unit users (e.g., policemen, firemen, paramedics, and so forth) would be in the best situation to respond to the incident.” *Id.* at 1:43–45.

Figure 1 of Fumarolo–782 is shown below.

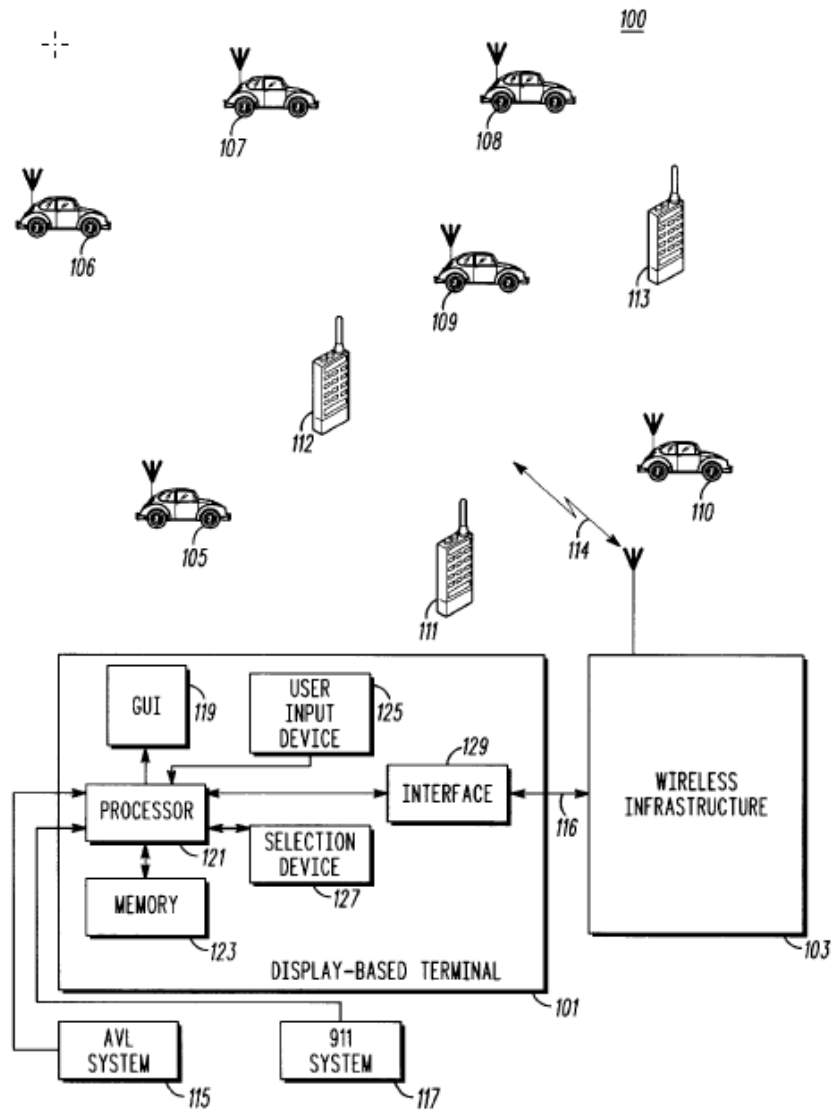


FIG. 1

Figure 1 above depicts a block diagram of a communication system 100, which “may be either a conventional system or trunked system and each communication resource 114 may comprise a frequency carrier, one or more time slots of a frequency carrier, or an orthogonal code implemented by a respective frequency hopping pattern or by a pseudo-random noise sequence spread over a wide bandwidth (e.g., 3 MHZ).” Ex. 1005, 2:59–61, 3:66–4:5. As the above diagram shows, a display-based terminal 101, which controls

communications with the communication units 105–113 in the communication system, is connected by a communication link 116 to a wireless infrastructure 103 through an interface 129. *See id.* at 3:21–43, 4:23–38. The wireless infrastructure 103 permits communication 114 with a plurality of mobile wireless units 105–113. *Id.* at 4:6–22.

Fumarolo–782 explains that, prior to making any communication control determinations, terminal 101’s processor 121 “receives location coordinates of the communication units 105–113 on a periodic basis from the AVL [automated vehicle location] system 115, from the communication units 105–113 themselves, or from the wireless infrastructure 103 in accordance with known techniques.” *Id.* at 8:37–43. Processor 121 then instructs GUI 119 to “display the locations of the communication units 105–113 on the map . . . or a pulldown menu identifying the types of communications and/or the modes of transmission supported by the system 100.” *Id.* at 8:43–48.

Terminal 101 “displays a map to the user indicating locations of communication units in at least a portion of the communication system.” *Id.* at 3:23–26. Terminal 101 then “receives a selection from the map [from the user] . . . of at least one communication unit and an indication of the user’s desire to communicate with the selected communication unit or units.” *Ex.* 1005, 3:26–31. Based on the selection, terminal 101 can further control the type of communication to have with the selected communication units via the communication system 100, the different types of communications being “individual or private communication,” “group communication,” “voice communication,” “data communication,” or some combination thereof. *Id.* at 5:53–60. “Responsive to receipt of the user’s selection of the

communication unit and indication of a desire to communicate, the terminal automatically initiates a communication with the selected communication unit.” *Id.* at [57], 3:39–43, 10:10–14.

b. Fumarolo–844

Fumarolo–844, titled “Method And Apparatus For Dynamically Grouping Communication Units In A Communication System,” was filed on the same day and by the same inventors as Fumarolo–782. Ex. 1006, [54], [75], [22]; *see also* Ex. 1005, [75], [22]. Also similarly to Fumarolo–782, Fumarolo–844 describes a dispatch system with a display-based terminal, such as a CAD (Computer Aided Dispatch) terminal, having an integrated mapping program to communicate directly with communication units from a single map environment. Ex. 1006, [57], 3:29–32, 4:43–46. Moreover, Fumarolo–844 includes the same Figure 1 (shown above) as Fumarolo–782 and provides a similar explanation about what the illustration shows and how components of the display-based terminal 101 operate within the communication system 100. *See, e.g., id.* at 4:9–5:16, 8:53–9:4, Fig. 1.

Fumarolo–844, however, addresses more specifically the need for a user of the display-based terminal to be able “to dynamically group and ungroup communication units from a single map environment.” *Id.* at 2:37–42. Previous dispatch systems required “the user to first determine from the map which communication units to regroup or ungroup and then use a separate regrouping program to actually select the units to be grouped or ungrouped and perform the regrouping.” *Id.* at 2:37–42, 3:60–4:1. To overcome this drawback, Fumarolo–844 discloses “link[ing] the regrouping functionality directly into the map display to enable the terminal user to simply ‘point and click’, ‘click and drag’, or the equivalent to quickly

regroup communication units being monitored by the terminal user as such regrouping may be necessary to accomplish system-related tasks, such as responding to emergency incidents.” *Id.* at 4:1–8.

Fumarolo–844 explains the operation of a preferred embodiment that provides this solution as follows. While the locations of the communication units 105–113 are displayed on the map, the user of the terminal 101 may desire to dynamically regroup communication units 105–113 to handle an incident. Ex. 1006, 9:5–8. In such a case, the terminal user uses a selection device 127 to select the communication units to be regrouped and the talkgroup associated with the regrouping. *Id.* at 9:14–17. For example, the user may use a computer mouse to “point and click” on the communication units 105, 107–109, and 113 to identify to terminal processor 121 that these are the selected units and then “point and click” on a displayed “talkgroup button” to indicate to processor 121 the user’s intent to regroup the selected units. *Id.* at 9:17–20, 9:27–30. The GUI may then provide a list of available talkgroups from which a user may select. *Id.* at 9:42–47, Fig. 3. Once the desired talkgroup is selected, processor 121 automatically accesses a communication resource 114 and sends a group command to the selected communication units 105, 107–109, and 113 in accordance with the access scheme and communication protocols of communication system 100. *Id.* at 9:53–65. “The group command preferably includes grouping information, such as the identification of the target talkgroup.” *Id.* at 9:65–67. Once regrouping has been completed, the regrouped communication units 105, 107–109, and 113 can communicate quickly and simply via communication system 100 in accordance with known techniques. *Id.* at 10:8–11. “Thus, the terminal user, upon making his or her selections, need only continue

monitoring the map . . . to determine if any other action is necessary to handle the incident” *Id.* at 10:51–54.

c. Muramatsu

Muramatsu, titled “Portable Navigation Device And System, And Online Navigation Service In Wireless Communication Network,” states the object is to “to provide a portable communication device that is easy to operate for users of all ages and that can display a clear and recognizable navigation image on the screen without using ‘expensive’ graphic processing.” Ex. 1007, [54], ¶ 11. Muramatsu asserts the problem with the prior art devices was that they required complicated and expensive graphic processing in order to electronically ensure rotation of the map displayed on the screen by the prescribed image processing and/or complicated and expensive mechanisms in order to ensure mechanical rotation of the display. *Id.* ¶ 10.

In Muramatsu, a portable communication device, such as a cellular phone, has a GPS module to determine the current position, and an electronic compass module for detecting an azimuth, a display, and a wireless communicator. *Id.* [57]. This device is in communication, via the Internet, with a navigation server, which has access to various databases including a customer verification database, a map database, and a destination database. *Id.* ¶¶ 35, 39–41. The navigation server receives the customer data, present position data, and GPS data provided by the cellular phone (*id.* ¶ 43) and performs the following functions: it uses the customer data to determine whether the device is registered (*id.* ¶ 44); it uses the position data to create a map including the present position of the phone (*id.* ¶ 45); and it uses the GPS data to perform measurement calculations (*id.* ¶ 46). The

navigation server sends the new information generated to the customer's phone, which then displays the map including the phone's location thereon. *Id.* ¶¶ 76–77. The phone then activates the electronic compass module to detect the azimuth and a symbol is generated on the map to represent the detected azimuth. *Id.* ¶¶ 78–80. Thus, the phone creates images for navigation that are appropriately displayed on the screen and are recognizable in viewing without using expensive graphic processing. *Id.* [57].

d. Liu

Liu, titled “Apparatus, Methods And Systems For Anonymous Communication,” states the object of the invention is to address “privacy concerns through the establishment, maintenance and control of anonymity in the context of voice communication.” Ex. 1008 ¶ 136. Liu describes a method of facilitating anonymous voice communication between a first station and a second station wherein at least one of stations has an address for voice communication. *Id.* [57]. The method comprises providing an interface that allows input of a transaction specification from at least one of the first and second stations. *Id.* ¶ 33. A transaction specification includes parameters associated with and describing a proposed transaction. *Id.* ¶ 66. In response to the submission of a transaction specification, a reference code associated with the transaction is generated and has a defined relationship with a user's address. *Id.* [57]. A controller unit generates the reference code in association with an applicable transaction between users. *Id.* ¶¶ 83, 86. The controller unit preferably generates the reference code based on and/or responsive to a connection instruction. *Id.* Preferably, the reference code corresponds uniquely to a connection instruction. *Id.*

The controller unit supplies the reference code to one or more of the users in an applicable transaction. *Id.* ¶ 89. The user may subsequently request a voice communication and provide the reference code, which is used to recover the address of another party. *Id.* ¶¶ 34, 95–96. In response, the system opens a channel for voice communication between first and second user stations, whereby voice communication can be established without providing said address to the first station. *Id.* ¶ 33.

D. THE DIFFERENCES BETWEEN THE CLAIMED SUBJECT MATTER
AND THE PRIOR ART

Google contends independent claims 1 and 24 are unpatentable because they recite an obvious combination of known elements, as evidenced by the combination of Fumarolo–782, Fumarolo–844, Muramatsu, and Liu. Pet. 23–49. Independent claims 1 and 24 recite substantially the same combination of elements (e.g., [1a]–[1h]), except claim 1 is for a method and claim 24 is for an apparatus. Ex. 1001, 14:59–15:35, 17:59–18:41. To show both of these claims are unpatentable, Google relies on the same evidence and argument. *See* Pet. 23–49. We, therefore, select claim 1 as representative of both independent claims.

Google contends independent claim 1 is unpatentable because it recites an obvious combination of known elements, as evidenced by the combination of Fumarolo–782, Fumarolo–844, Muramatsu, and Liu. Pet. 13–49. Google contends the combination of Fumarolo–782, Fumarolo–844, and Muramatsu disclose elements [1a]–[1g] of claim 1. Pet. 23–46. As to element 1[h], Google argues that a skilled artisan would have found it obvious to incorporate Muramatsu’s navigation server into the combined system of Fumarolo–782 and Fumarolo–844 to carry out data communication using an Internet protocol. *Id.* However, Google provides no evidence or

argument that these references, alone or combined, disclose that the terminal “*does not have access have access to respective Internet Protocol addresses of the second devices,*” as recited in element 1[h]. *Id.* at 46 (emphasis added). Google states, to the extent we determine that these references do not disclose this recited feature, Liu discloses this feature. *See id.* at 46. Because Google fails to provide evidence or argument that Fumarolo–782, Fumarolo–844, and Muramatsu disclose element 1[h], Petitioner has not made a sufficient showing that these references disclose this element. As a result, we need not determine whether Fumarolo–782, Fumarolo–844, and Muramatsu actually disclose this element. *See id.* at 46–49.

We nonetheless consider Google’s contention that Liu’s anonymous communication method through an internet-based system renders obvious the recitation that “the first device does not have access to respective Internet Protocol addresses of the second devices.” *Id.* at 46–47. Google asserts the following disclosures from Liu shows this element [1h] was known by a skilled artisan. Liu discloses an internet-based system, which includes servers, that allows a first and second station to communicate both voice and data information. Pet. 46–47 (citing Ex. 1008 ¶¶ 54, 56, 57, 60). The first station in Liu “merely has access to a ‘reference code’ associated with the second station, and does not have access to the second station’s address.” *Id.* at 47 (citing Ex. 1008 ¶ 33). “So to engage in an anonymous communication with the second station, the first station sends a communication request and the second station’s ‘reference code’ to a server,” which then uses the reference code to recover the second station’s address to open a channel for communication. *Id.* (citing Ex. 1008 ¶ 33). As a result, Liu’s communication method allows the first station to initiate

communications with the second stations without ever receiving the address of the second station. *Id.* (citing Ex. 1008 ¶ 33).

Google contends a skilled artisan would have sought to modify the combined system of Fumarolo–782, Fumarolo–844, and Muramatsu with the anonymous communication method of Liu because Liu provides a technique that enables a user of Fumarolo–782’s display-based terminal 101 to communicate directly with communication units 105–113 through a single map environment displayed on terminal 101. Pet. 21 (citing Ex. 1003, ¶¶ 88–93; Ex. 1005, 2:52–56). Google contends a skilled artisan would have understood Liu to teach such a technique because it describes a communication method that allows anonymous voice communications to occur without having to obtain or enter address information for other communication units. *Id.* (citing Ex. 1003, ¶ 93). Google explains,

A [skilled artisan] would have understood that time would be of the essence during such an emergency event, and as such, taking the time to acquire address information for the selected communications, store the address information, and then retrieve and transmit the address information before being able to communicate with the communication units may not be desirable. That person would have therefore looked to the prior art for techniques for facilitating communications between the terminal and select communication units while also obviating the aforementioned time consuming tasks. This would have led that person to Liu, which describes such a technique.

Pet. 48 (citing Ex. 1003 ¶¶ 146–148). Google contends also that modifying the emergency system of Fumarolo–782 with Liu’s anonymous communication functionality would have been recognized by a skilled artisan to be “particularly beneficial” because it would allow first responders to communicate amongst themselves without having to first know each other’s direct contact information. *Id.* at 21–22, 48 (citing Ex. 1003 ¶¶ 94–

95, 149).

There are several factual deficiencies with Google’s rationale. First, Google is missing evidentiary support for the contention that a skilled artisan would have recognized Liu’s anonymous communication method as a technique for facilitating direct communication through a single displayed-map environment. As support, Google relies on a *resulting* byproduct (i.e., a user being able to initiate an anonymous voice communication to occur without having to obtain or enter the specific address for other party) from using a reference code in Liu’s communication method. But this fact does little, if anything, to establish that Liu’s method itself enables communications to be initiated within a single displayed-map environment. To the contrary, we note Liu discloses that the anonymous communication method may require a user to input a transaction specification into an interface provided, which is used to generate a reference code associated with the transaction before an anonymous communication may be initiated. Ex. 1008 ¶ 33. Thus, simply because Liu’s method may result in an anonymous communication between parties that do not have their counterpart’s actual address, it does not follow that the communication may be initiated within a single displayed-map environment.

At paragraph 93 in the Williams Declaration, Google’s declarant identifies Liu’s description of a “feature” of the anonymous communication method that “allows for users to simply click a button in order to be ‘automatically connected with the other party for voice communication.’” Ex. 1003 (citing Ex. 1008 ¶ 45). As one example of this feature, Mr. Williams states, “Liu describes a user interface that includes a selectable icon that can automatically initiate a communication with a desired device.”

Id. ¶ 93 (citing Ex. 1008 ¶ 134, Fig. 6). Thus, Mr. Williams concludes, Liu “is consistent with Fumarolo-782’s stated goal of streamlining the communication process by, for example, allowing users to simply click on an icon on a map representative of a communication unit to initiate a communication.” *Id.*

Mr. Williams’s testimony improperly picks and chooses teachings from Liu and fails to represent accurately what Liu fairly suggests to a skilled artisan. We are mindful that, when evaluating claims for obviousness, “the prior art as a whole must be considered.” *In re Hedges*, 783 F.2d 1038, 1041 (Fed. Cir. 1986); *see also In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (explaining that a reference “must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole”). “It is impermissible within the framework of section 103 to pick and choose [teachings] from any one reference . . . to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” *Hedges*, 783 F.2d at 1041 (quoting *In re Wesslau*, 353 F.2d 238, 241 (CCPA 1965)).

After considering Liu as a whole, it is evident that the above “feature” that Mr. Williams identifies is merely a back-end “reminder” option of the anonymous communication method and available only after the portion of the process that causes the generation of a reference code is performed. *See* Ex. 1008 ¶¶ 116–134, Figs. 4–6. Notably, Liu explains that the exemplary process that Mr. Williams references involves the parties first conducting an on-line transaction to define a transaction specification. *Id.* ¶¶ 116–117, Fig. 4A. Next, the parties submit the mutually agreeable transaction specification. *Id.* ¶ 118, Fig. 4A. If the transaction specification indicates

that an anonymous communication is requested, the process generates a reference code associated with the transaction. *Id.* ¶ 119, Fig. 4A. The process then delivers the reference code to one or both of the transacting users. *Id.* ¶ 120, Fig. 4A. Liu further describes that only after these steps of the anonymous communication process are performed is a user allowed to simply click a button in order to be automatically connected with the other party. *Id.* ¶¶ 127–135, Figs. 4–6. Thus, when the “feature” Mr. Williams relies upon from Liu’s communication method is viewed in context of the whole of what Liu fairly suggests about that method, it is insufficient to support a conclusion that a skilled artisan would have recognized Liu’s anonymous communication method as a technique for facilitating direct communication through a single displayed-map environment.

Second, Google is missing evidentiary support for the contention that a skilled artisan would have recognized Liu’s anonymous communication method is any less time consuming than a method that acquires address information for a selected communication, stores the address information, and then retrieves and transmits the address information to initiate a communication. Google’s sole support for this contention is paragraph 148 in the Williams Declaration. Pet. 48. At that paragraph, however, Google’s declarant fails to provide any meaningful support for this contention. Mr. Williams asserts Liu’s method “reduc[es] the amount of information that is needed to initiate communications.” Ex. 1003 ¶ 148. Mr. Williams asserts this reduction results from the fact that Liu’s anonymous communication method may initiate communications without having to obtain or enter address information for the other communications and it includes a feature

that allows a user to automatically connect to another person by simply clicking a button. *Id.*

The problem with Mr. Williams’s testimony is that it completely ignores the information that Liu’s method does need to initiate a communication. Mr. Williams gives us no basis to evaluate whether there is a *reduction* in the amount of information needed. We note, however, that Liu describes at least three categories of information needed to initiate a communication: a transaction specification, a connection instruction, and a reference code. Ex. 1008 ¶ 65. The transaction specification includes information associated with, and describing, a proposed transaction. *Id.* The connection instruction includes information about a proposed connection between users. *Id.* ¶ 76. Liu explains, “[t]he connection process typically includes, but is not limited to, receiving, storing, inputting and processing reference codes,” which evidences some of the tasks that are necessary for Liu’s method to initiate a communication. *Id.* ¶ 95. Because there is no indication of any consideration of the information and tasks Liu’s method does require to initiate a communication, Mr. Williams’s testimony about the *relative amount* of information associated with initiating communications has little evidentiary value.

In view of the foregoing, we are not persuaded there is a reasonable likelihood that Google would prevail in establishing it would have been obvious to combine the teachings of Fumarolo–782, Fumarolo–844, Muramatsu, and Liu in the manner claims 1 and 24 recite. Therefore, because claims 2, 4–6, 8, 10, 12, 22, 23, 27, 29, 31, 32, and 35 depend from either claim 1 or 24, Google has not demonstrated a reasonable likelihood that it would prevail in showing any of the challenged claims are

unpatentable.

III. CONCLUSION

For the foregoing reasons, we determine that Google has not demonstrated a reasonable likelihood that it would prevail in showing at least one of the challenged claims is unpatentable on the asserted grounds. Therefore, we do not institute an *inter partes* review.

IV. ORDER

Accordingly, it is

ORDERED that the Petition is *denied* as to all challenged claims of the '251 patent and no trial is instituted.

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