

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

FENDGO, LLC,
Patent Owner.

IPR2024-00113
Patent 11,265,404 B2

Before JON M. JURGOVAN, JAMES J. MAYBERRY, and
AARON W. MOORE, *Administrative Patent Judges*.

JURGOVAN, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. *Background and Summary*

Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, “Petitioner”) filed a Petition requesting *inter partes* review of claims 9–15 of U.S. Patent No. 11,265,404 B2 (Ex. 1001, the “’404 patent”). Paper 2 (“Petition” or “Pet.”). The Petition was accorded a filing date of November 1, 2023. Paper 8 (Notice of Filing Date Accorded November 22, 2023). Patent Owner, Fendgo, LLC, filed a Preliminary Response to the Petition on February 22, 2024. Paper 10 (“Prelim. Resp.”).

Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless the information presented in a petition and the preliminary response “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Upon consideration of the Petition and Preliminary Response, and accompanying exhibits and evidence, we determine Petitioner has established a reasonable likelihood that it would prevail with respect to at least one challenged claim in the *inter partes* review. Therefore, we grant institution of an *inter partes* review as to all of the challenged claims of the ’404 patent on all challenges in the Petition.

B. *Real Parties in Interest*

Petitioner identifies Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. as the real parties in interest. Pet. 71 (Petitioner’s Mandatory Notices).

Patent Owner identifies itself as the real party in interest. Paper 6, 2 (Patent Owner’s Mandatory Notices).

C. Related Matters

Petitioner and Patent Owner (“the parties”) identify the following as matters related to this proceeding:

- *Samsung Electronics Co., Ltd. v. Fendgo, LLC*, IPR2024-00114 (concerning claims 1–8 of the ’404 patent); and
- *Fendgo, LLC v. Samsung Electronics Co., Ltd. et al.*, 2:23-cv-00221-JRG (E.D. Tex.), filed May 19, 2023 (“the District Court litigation”).

Pet. 71; Paper 6, 2; Ex. 1032.

Petitioner contends that the ’404 patent is related to the following patents and applications:

- US Provisional Application No. 60/643,865, filed January 14, 2005;
- US Application No. 11/333,809, filed January 17, 2006, and issued as US Patent No. 8,472,915 on June 25, 2013;
- US Application No. 13/897,353, filed May 17, 2013, and issued as US Patent No. 10,230,827 on March 12, 2019;
- US Application No. 17/566,597 filed December 30, 2021 (pending); and
- US Application No. 13/897,359 filed May 18, 2013 (abandoned).

Pet. 71; Ex. 1032.

D. The ’404 Patent

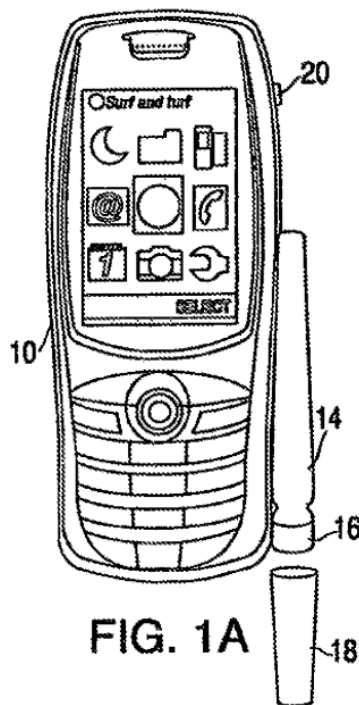
The ’404 patent is titled “Emergency Personal Protection System Integrated with Mobile Devices.” Ex. 1001, code (54). The ’404 patent integrates a self-defense device with a mobile phone/device to protect

against violent crime. *Id.* at 1:21–31. The ’404 patent asserts that integrating the self-defense device with the mobile phone/device means that “a person may be less likely to forget [the self-defense device] when traveling.” *Id.* at 2:36–38.

The ’404 patent provides that the self-defense device may include a self-defense mechanism that, when activated, causes a camera built into the mobile phone/device to take a still or moving image of the attacker and send image data and audio data to the authorities along with specific information such as the name and description of the owner of the self-defense device, location information, a time and date stamp, etc. *Id.* at 3:4–16. A separate panic button located on the device may be used to activate these processes. *Id.* at 3:16–19.

To provide this functionality, the mobile device has a camera to obtain image and audio data; a location unit to obtain location data; a transmitting unit to transmit the image, audio, and location data; and a panic button to activate the camera, location unit, and transmitting unit. *Id.* at 3:51–58.

Figure 1A of the ’404 patent is reproduced below.



As shown in Figure 1A, mobile device 10 includes an attached vial 14 containing pepper spray or mace. Ex. 1001, 7:63–67. “Nozzle 16 releases the pepper spray or mace once protective cap 18 is removed.” *Id.* at 8:1–2.

Figure 1A also shows panic button 20. *Id.* at 8:2–3. The panic button may be activated by a series of presses to automatically contact 911. *Id.* at 6:54–59. The series of presses of the panic button safeguards against falsely triggering the device. *Id.* at 7:51–57.

E. Challenged Claims

Claims 9, 13, and 15 are independent. Claims 10–12 depend directly from claim 9, and claim 14 depends from claim 13. Claim 9 is set forth below, with limitation identifiers indicated in brackets.

9. [pre] A mobile device, comprising:
- [a] a camera unit, adapted to obtain at least one of image data and audio data;
 - [b] a location unit, adapted to obtain location data;

[c] a transmitting unit, adapted to transmit as emergency information the image data, the audio data, and the location data along with specific information including owner identification information; and

[d] a panic button, adapted to activate the camera unit, the location unit, and the transmitting unit, and send the emergency information and the specific information to a specified location when the panic button is activated,

[e] wherein the panic button is activated by a series of depressings of the panic button.

Id. at 9:34–50.

F. Evidence of Record

Petitioner relies upon the following prior art references¹:

Walker	GB 2 401 752 A	Published Nov. 17, 2004	Ex. 1007
Zellner	US 6,807,564 B1	Issued Oct. 19, 2004	Ex. 1008
Martin	US 6,839,552 B1	Issued Jan. 4, 2005	Ex. 1009
Kim	WO 2004/056000 A1	Published July 1, 2004	Ex. 1010
Dixit	US 6,449,472 B1	Published Sept. 10, 2002	Ex. 1011

¹ Petitioner alleges that all of the prior art references were filed, issued or published before the '404 patent's earliest alleged priority date of January 14, 2005. Pet. 2–3. Petitioner contends that all of these prior art references are prior art under 35 U.S.C. §§ 102(a), (b), and (e) (pre-Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”)).

Id. at 3. Patent Owner does not refute these assertions at this time.

Because we determine in the Institution Decision for IPR2024-00114 that there is a reasonable likelihood that claims 1–8 of the '404 patent do not have a priority date earlier than its filing date of January 30, 2019, which is after the effective date of March 13, 2014 for the AIA, we apply the AIA versions of §§102 and 103 herein. *See, e.g.*, § 3(n); MPEP §§ 2152.01, 2159.02, 2159.03. Accordingly, we will treat these references as prior art under the AIA versions of §§ 102 and 103 for purposes of this Decision.

Petitioner also supports its challenges with a declaration from William R. Michalson, Ph.D. Ex. 1002. Patent Owner does not rely on any declarant to support its contentions at this time.

G. The Asserted Challenges to Patentability

Petitioner asserts the following challenges to patentability:

Ground	Challenged Claims	35 U.S.C. §	Reference(s)/Basis
1A	9, 10, 12–14	103	Walker, Kim
1B	14	103	Walker, Kim, Dixit
2	15	103	Walker
3A	9–14	103	Zellner, Kim
3B	14	103	Zellner, Kim, Dixit
4A	9, 10, 12–14	103	Martin, Kim
4B	14	103	Martin, Kim, Dixit

II. PRELIMINARY MATTER

A. Analysis of Discretionary Denial Under 35 U.S.C. § 314(a)

Institution of *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.108(a). When determining whether to exercise discretion to deny institution due to an earlier trial date in a parallel proceeding, we consider the factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (March 20, 2020) (precedential) (“*Fintiv*”).

Petitioner argues that the *Fintiv* factors as applied to this case weigh against exercising discretion to deny institution of *inter partes* review. Pet. 67–71. Patent Owner argues that we should deny institution. Prelim. Resp. 19–26. In this section, we consider the parties’ arguments and

evidence in relation to the *Fintiv* factors, and determine not to exercise our discretion to deny institution for the following reasons.

1. *Fintiv Factor 1: Stay*

Factor 1 addresses whether the District Court granted a stay or evidence exists that one may be granted if an *inter partes* review proceeding is instituted. *Fintiv* at 6.

Petitioner and Patent Owner agree that this factor is neutral since no stay has been sought, let alone granted, in the District Court litigation. Pet. 68; Prelim. Resp. 19. The evidence here does not establish one way or the other that a stay may be granted by the District Court if an *inter partes* review proceeding is instituted. We agree with the parties that this factor is neutral under these circumstances.

2. *Fintiv Factor 2: Timing*

Factor 2 concerns the proximity of the District Court’s trial date to the Board’s projected statutory deadline for a final written decision. *Fintiv* at 6.

Petitioner and Patent Owner agree that jury selection for the District Court litigation is currently scheduled for March 3, 2025, and the projected statutory deadline for a final written decision in this case is May 2025, approximately two months after the start of the District Court trial. Pet. 68–69; Prelim. Resp. 19–20.

Petitioner contends that “this factor should be neutral or at most minimally weigh in favor of denial,” noting that the Board has instituted with even more time between trial and final written decision. Pet. 68–69. Patent Owner argues that this factor “weighs heavily against institution because trial is set to occur approximately 2 months before the projected statutory deadline for a final written decision,” and states that the Board has

denied institution on similar or smaller gaps between the final written decision and trial of district court litigation. Prelim. Resp. 19–20.

We determine that this factor is neutral in this case given the relatively small two-month difference between the current expected dates for a final written decision and trial of the parallel District Court litigation.

3. *Fintiv Factor 3: Investment*

Factor 3 concerns the investment in the District Court litigation by the District Court and parties. *Fintiv* at 6.

Petitioner contends that this factor weighs strongly against discretionary denial. Pet. 69. According to Petitioner, no substantive orders have been issued by the District Court, and “investment in the parallel litigation will have remained low at the time of institution.” *Id.* (citing Ex. 1035). Petitioner contends much work in the District Court remains and the opening claim construction brief is due July 25, 2024, the Markman hearing is scheduled for September 5, 2024, and opening expert reports are due October 15, 2024. *Id.*

Patent Owner contends that this factor, “which considers the resources invested in the parallel district court proceeding, weighs in favor of the Board’s exercising discretionary denial authority.” Prelim. Resp. 20–21. Patent Owner argues that Petitioner “wrongly limits [its] analysis of the parties’ investment in the district court proceedings to the stage of those proceedings at the time the petition was filed” and that the “proper timeframe for this factor is the investment in the parallel proceeding at the time of the institution decision” that is “expected by May 22, 2024.” *Id.* at 21 (citing *Fintiv* at 9–10).

Patent Owner argues that the parties will have expended significant resources by May 2024. *Id.* Patent Owner asserts that the parties have exchanged infringement and invalidity contentions for the '404 patent. *Id.* In addition, Patent Owner contends that the parties have engaged in fact discovery, which is to conclude October 1, 2024, approximately 3.5 months after the institution decision is projected to issue in this case. *Id.* Patent Owner further argues that the parties will have to begin the claim construction process and exchange preliminary claim constructions by May 2024. *Id.*

We do not agree with Patent Owner's argument that Petitioner wrongly considered the parties' investment in the parallel litigation as of when the Petition was filed as opposed to when the institution decision is made. Prelim. Resp. 21. Petitioner indicated that "investment in the parallel litigation will have remained low *at the time of institution*," thus indicating the proper timeframe for consideration of this factor. Pet. 69.

Although the parties have expended some resources in the District Court litigation, the evidence shows that the District Court has not issued any substantive orders, a *Markman* hearing has not yet been conducted, and expert reports have not been exchanged. *Id.* (citing Ex. 1035). Accordingly, this factor weighs against exercising our discretion to deny institution. *Fintiv* at 10; *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019) (determining that "the advanced state of the district court proceeding is an additional factor that weighs in favor of denying the Petition," where the district court proceeding was "nearing its final stages, with expert discovery ending" soon).

4. *Fintiv Factor 4: Overlap*

Factor 4 addresses the overlap between issues raised in the Petition and the District Court litigation. *Fintiv* at 6.

Petitioner contends that factor 4 weighs against discretionary denial. Pet. 69–70. Specifically, Petitioner challenged claims 9–15 in this proceeding, and claims 1–8 in IPR2024-00114, whereas Patent Owner has only alleged infringement of claims 9 and 12 in the District Court litigation. Pet. 69 (citing Ex. 1033). Accordingly, Petitioner asserts, a material number of the challenged claims will not be addressed by the District Court. *Id.* at 69–70.

Petitioner further stipulates that “unless the Board denies or later vacates institution of this Petition, Petitioners will not seek resolution of invalidity in the copending litigation based on the specific grounds asserted in this Petition or any grounds including *Walker*, *Kim*, *Dixit*, *Zellner*, or *Martin*.” *Id.* at 70 (citing Ex. 1036).

Patent Owner argues that the issues raised in the Petition and the District Court litigation overlap, and Petitioner has provided only a limited *Sand-Revolution*-style stipulation, not a *Sotera*-style one. Prelim. Resp. 22; *see also Sotera Wireless, Inc. v. Masimo Corporation*, IPR2020-01019, Paper 12 at 18–19 (PTAB Dec. 1, 2020) (precedential as to § II.A). Patent Owner argues that the Board has held that Petitioner’s *Sand-Revolution*-style stipulation weighs only marginally in favor of not exercising discretion to deny institution. Prelim. Resp. 22 (citing *Sand Revolution II, LLC v. Continental Intermodal Group–Trucking LLC*, IPR2019-01393, Paper 24 at 9–10 (PTAB June 16, 2020) (informative) (“*Sand Revolution*”)).

Although there is some overlap because the validity of claims 9 and 12 is at issue in this proceeding as well as the District Court litigation, the validity of claims 10, 11, and 13–15 is not addressed in the District Court litigation. Petitioner’s stipulation, which is neither a *Sotera*- nor *Sand-Revolution*-type, provides that the prior art references asserted here (Walker, Kim, Dixit, Zellner, and Martin) will not be asserted again in the District Court litigation assuming this proceeding is instituted and not vacated. Ex. 1036. Petitioner’s stipulation mitigates to some degree concerns of duplicative efforts or conflicting decisions. *See Sand Revolution*, Paper 24 at 12. Because of the limited overlap and stipulation, we determine that this factor weighs against discretionary denial.

5. *Fintiv Factor 5: Same Party*

Factor 5 addresses whether the Petitioner is the defendant in the District Court litigation. *Fintiv* at 6. The parties agree this is the case. Pet. 70; Prelim. Resp. 22–23.

Petitioner argues that when the Board’s deadline for the final written decision is estimated to be close in time to the district court trial date and the parties are the same in both proceedings, factor 5 weighs as neutral. Pet. 70.

Patent Owner argues that Petitioner is the defendant in District Court litigation, so factor 5 weighs in favor of discretionary denial. Prelim. Resp. 22–23. Patent Owner asserts that Petitioner’s argument concerning timing is contrary to numerous Board decisions, and that Petitioner’s argument would mean that factor 5 would never weigh in favor of denial, contrary to the nature of a factor. *Id.* at 23. Patent Owner further argues that any determination based on Petitioner’s argument would be “bad public policy” and “likely only a power available to the Director.” *Id.*

As the Petitioner is the defendant in the District Court litigation, we find that this factor weighs in favor of discretionary denial.

6. *Fintiv Factor 6: Other Circumstances*

Factor 6 addresses other circumstances that impact the Board's exercise of discretion, including the merits. *Fintiv* at 6.

Petitioner argues that the Petition's "merits are compelling" and that "there is a wealth of prior art that the Office did not consider during prosecution that discloses and/or renders obvious the alleged invention." Pet. 70.

Patent Owner argues that the merits of the Petition are "weak and include numerous deficiencies, which cannot meet the high compelling merits standard needed to overcome *Fintiv* factors 1–5 strongly favoring denial of institution." Prelim. Resp. 24–25.

We determine below that *Fintiv* factors 1–5 do not favor discretionary denial. Thus, we do not reach the issue of whether the merits are compelling. *CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 4–5 (PTAB Feb. 27, 2023) (precedential) (holding that the Board must first address *Fintiv* factors 1–5, and should engage the compelling merits question only if that analysis favors discretionary denial) ("*CommScope*").

7. *Balancing the Fintiv Factors*

Weighing against discretionary denial is factor 3 involving the parties' limited investment and lack of substantive orders in the District Court litigation. Factor 4 concerning the limited overlap of the issues in the two cases also weighs against discretionary denial. Only factor 5, that Petitioner and the defendant in the District Court litigation are the same party, weighs

in favor of discretionary denial. Factor 1 concerning the absence of a stay in the District Court litigation, and factor 2 concerning the close proximity between the start of trial in the District Court litigation and the estimated deadline for the final written decision, are neutral on the facts of this case. We therefore determine that the balance of factors 1–5 weighs against discretionary denial. Accordingly, we do not consider the issue of whether compelling merits have been shown under factor 6. *See CommScope*, Paper 23 at 4–5.²

III. ANALYSIS AND DISCUSSION

In this section, we discuss Petitioner’s challenges to claims 9–15 of the ’404 patent and Patent Owner’s arguments for patentability. For the reasons that follow, we determine that Petitioner has presented a reasonable likelihood that at least 1 claim of the ’404 patent is unpatentable.

A. Legal Standards for Obviousness

A patent claim is unpatentable under 35 U.S.C. § 103 if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention 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

² Having decided against discretionary denial, we do not reach Petitioner’s argument that the *Fintiv* framework is legally invalid. *See* Pet. 67–68 n.5.

(4) where present, objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

B. Level of Ordinary Skill in the Art

Petitioner contends as follows:

A person of ordinary skill in the art (“POSITA”) at the time of the ’404 patent’s priority date would have had at least a Bachelor’s of Science Degree (or equivalent) in an academic area emphasizing electrical engineering, computer engineering, computer science, or a related technical field, and about 1-2 years of experience working with telematics systems (e.g. familiarity with wireless communications, geolocation systems, and human-computer interfaces). A greater amount of education in an academic area emphasizing electrical engineering, computer engineering, computer science, or a related technical field, would compensate for fewer years of work experience, and more years of work experience would compensate for less education. This is the appropriate level of skill, whether the claims are entitled to priority as of January 2005 or January 2019.

Pet. 7–8 (citing Ex. 1002 ¶¶ 14–16).

At this stage of the proceeding, Patent Owner does not dispute Petitioner’s proposed level of skill in the art, which is consistent with the prior art references asserted by Petitioner. *Okajima v. Bourdeau*, 261 F.3d 1350, 1354–55 (Fed. Cir. 2001) (the applied prior art may reflect an appropriate level of skill). Accordingly, we will use Petitioner’s proposed level for purposes of this Decision.

C. Claim Construction

We construe the challenged claims under the same standard used by a federal court in a civil action under 35 U.S.C. § 282(b). 37 C.F.R. § 42.100(b). This standard is articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc) and its progeny, and includes “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).

Only claim terms in controversy need to be construed, and only to the extent necessary to resolve the controversy. *See Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

Petitioner contends that “no express constructions of the claims are necessary to assess whether the prior art reads on the [challenged claims]” and that “the claims should be given their plain and ordinary meaning.” Pet. 8. Patent Owner states that “at this stage in the proceeding, Patent Owner will apply the ordinary and customary meaning to the ’404 patent’s claim terms.” Prelim. Resp. 4.

As Petitioner and Patent Owner do not dispute the meaning of any claim term at this time, we decline to expressly construe any claim term, and instead apply the ordinary and customary meanings consistent with 37 C.F.R. § 42.100(b). We address claim interpretation to the extent necessary in our obviousness analysis below.

D. Ground 1A: Obviousness over Walker and Kim

We now address Petitioner’s contention that claims 9, 10, and 12–14 would have been obvious over the combination of Walker and Kim, and Patent Owner’s arguments for patentability for this ground. Pet. 9–28; Prelim. Resp. 4–8.

1. Walker (Ex. 1007)

Walker is titled “Mobile Personal Security Eyewitness Device.” Ex. 1007, code (54). Walker discloses

a cellular handheld mobile communications device and external data storage system, and is intended to enhance personal safety and security, acting as an electronic eyewitness, helping to deter criminal activity and to reduce the incidence of crime. Where crime is committed, the invention assists authorities and security services in obtaining evidence linking the identities of criminals to their crimes.

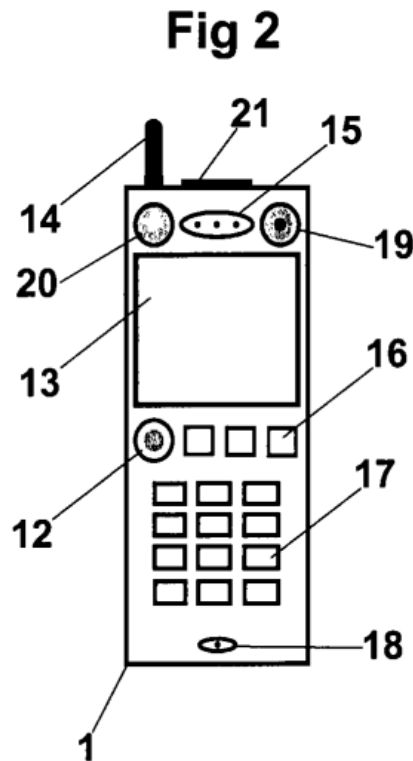
Id. ¶ 1.

Walker further discloses

a mobile communications handheld device and remote data recording and storage system which, in a single action, enables a user of the mobile communications handheld device to press a recessed eyewitness button or shout a voice command, which instantly initiates a series of actions, immediately capturing and transmitting streaming video and sound and environmental data detected by various sensors to a remote data storage facility, providing evidence of another individual's physical appearance, dress, behaviour, utterances and surroundings in real time and without any dial-up delay, together with precise geographical coordinates of the location and the precise time of the event, where the recorded data cannot be destroyed by an attacker even in the event that the handheld device is destroyed following such transmission.

Id. ¶ 38.

Figure 2 of Walker is reproduced below.



Walker's Figure 2 shows handheld mobile communications device 1 incorporating eye witness button 12, LCD colour screen 13, aerial 14, loud speaker or earpiece 15, navigation buttons 16, keypad buttons 17, microphone 18, digital camera with night vision sensitivity 19, and infrared illumination 20. *Id.* ¶¶ 63, 65.

Pressing eyewitness button 12 initiates a series of automatic actions, including transmitting streaming video and sound data, geographic location coordinates, timestamp, and other data, to data storage facility 7. *Id.* at ¶¶ 92, 99, 101, 105. The identities and behaviours of the recorded individuals are thus linked to particular locations at particular times, and to the physical presence of the user of handheld device 1. *Id.* ¶ 102. The data storage facility stores and organizes the received data against handheld device or user identities or accounts. *Id.* ¶¶ 55, 97.

Eyewitness button 12 is recessed and operates at a higher finger pressure than other buttons on the device to help prevent accidental activation of the button. *Id.* ¶ 83.

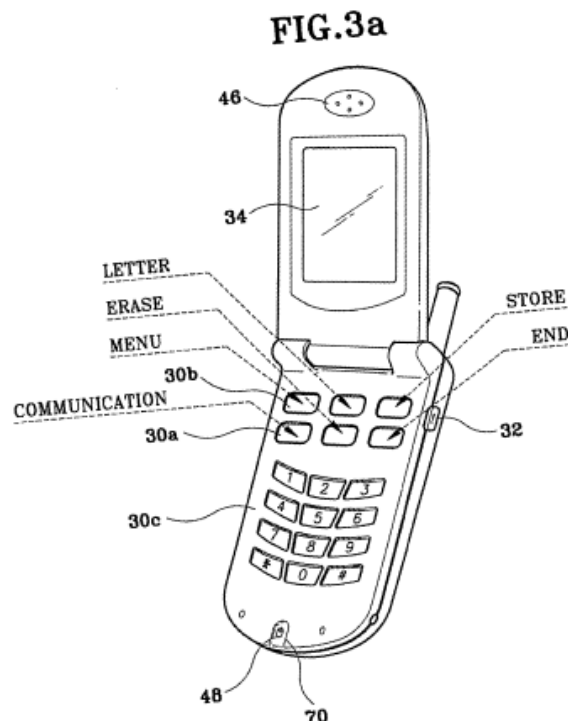
2. *Kim (Ex. 1010)*

Kim is titled “Apparatus for Processing Emergency Call Using Mobile Communication Network and Method Thereof.” Ex. 1010, code (54). Kim discloses

When a user of a mobile phone handset 2 is being assailed by a robber, is confined in a bounded area against his or her will, is being chased, is being attacked in a house by a burglar, or is distressed in a mountainous area, the user may simply manipulate an emergency key button disposed on the handset which transmits emergency information intrinsically stored therein to an emergency contact such as a police station, fire station or dispatcher via a mobile communication network.

Id. at 5:16–22.

Kim’s Figure 3a is reproduced below.



Kim's Figure 3a discloses a mobile phone with an emergency key button 32 to execute an emergency mode for notifying an emergency state by button manipulation. *Id.* at 8:22–25. The emergency mode may “be executed if the related emergency key button 32 is manipulated a plurality of times, e.g., three times, within a set period of time.” *Id.* at 13:3–6.

3. *Motivation to Combine Walker and Kim with a Reasonable Expectation of Success*

Petitioner contends that a POSITA would have been motivated to combine Walker and Kim. Pet. 18–19 (citing Ex. 1002 ¶¶ 117–126). Petitioner asserts that a “POSITA would have appreciated that *Kim*'s emergency key button serves the same purpose as *Walker*'s eyewitness button because they are both used to trigger transmission of information from a mobile device related to an emergency.” *Id.* at 18 (citing Ex. 1002 ¶ 118). Petitioner further states that a “POSITA would have understood that *Kim*'s technique of requiring the emergency key button to be pressed a plurality of times (e.g., three times) serves the same purpose to minimize accidental activation as implementing *Walker*'s eyewitness button in a recessed fashion and setting it to operate at a higher finger pressure because the prior art discloses that requiring a series of presses minimizes the occurrence of accidental/false activation.” *Id.* at 18–19. Petitioner argues that “implementing *Kim*'s emergency key button into *Walker* would have been consistent with and retained *Walker*'s goal to minimize the risk of accidental activation.” *Id.* at 19 (citing Ex. 1002 ¶ 125). Petitioner asserts that

a POSITA would have understood that modifying *Walker* to use *Kim*'s emergency key button that is pressed a plurality of times would have amounted to the simple substitution of one known

element (*Kim*'s emergency key button 32 that must be pressed a plurality of times (e.g., three times)) for another (eyewitness button 12 that is recessed and set to operate at a higher finger pressure) to obtain predictable results (*Walker*'s mobile device with an emergency key button that, when pressed a plurality of times (e.g., three times), triggers collection and transmission of data).

Pet. 19 (citing Ex. 1002 ¶ 126; *Agrizap, Inc. v. Woodstream Corp.*, 520 F.3d 1337, 1344 (Fed. Cir. 2008)).

Petitioner further contends that a “POSITA would have had a reasonable expectation of success in making the substitution at least because *Walker* itself states that any ‘input feature’ ‘may be set to act as the eyewitness button’ and that any ‘series’ of inputs can initiate the collecting and transmitting of data.” *Id.* at 19–20 (citing Ex. 1002 ¶¶ 127–132, 151). Petitioner states that “a POSITA would have understood that the substitution would have involved a tradeoff, as a recessed button set to operate at higher finger pressure has different advantages than a non-recessed button that must be pressed a plurality of times.” *Id.* at 20. Petitioner states that “the former may be more difficult for some people (such as the elderly) to locate and press than the latter, while the latter may be more susceptible to being falsely activated by, for example, other items (e.g., by a book or other clutter if stored in a bag) than the former.” *Id.* According to Petitioner, a “POSITA would have appreciated such tradeoffs and would have nevertheless considered the substitution obvious.” *Id.* (citing Ex. 1002 ¶ 131; *Allied Erecting & Dismantling Co. v. Genesis Attachments, LLC*, 825 F.3d 1373, 1381 (Fed. Cir. 2016)). Petitioner further asserts that using *Kim*'s dedicated button rather than *Walker*'s “nominated button” “provides a simpler design

and a lower risk of user-confusion in emergency situations.” *Id.* at 20–21 (citing Ex. 1002 ¶ 132).

At this time, Patent Owner does not dispute Petitioner’s proposed motivation to combine Walker and Kim, or its assertion that a POSITA would have had a reasonable expectation of success in making the combination.

We determine that Petitioner has shown sufficiently that a POSITA would have had reason to combine Walker and Kim with a reasonable expectation of success.

4. *Claim 9*

We proceed to consider the limitations of claim 9 in relation to the disclosures of Walker and Kim.

a) *Limitation 9[pre]: Mobile Device*

The preamble of claim 9 recites “A mobile device, comprising:”

Petitioner contends that Walker discloses or suggests this feature. Pet. 9 (citing Ex. 1002 ¶¶ 56–58). For example, Petitioner asserts, Walker discloses a “mobile communications handheld device.” *Id.* (citing Ex. 1007 ¶¶ 38, 58, 63–64, Figs. 1–3).

Patent Owner does not dispute Petitioner’s contention at this time.

Petitioner shows sufficiently that Walker discloses claim 9’s preamble.³

³ Because Petitioner has shown sufficiently that Walker discloses the preamble, we do not decide whether the preamble is limiting. *See Catalina Mrkt’g Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801 (Fed. Cir. 2002) (preamble may constitute a claim limitation under some circumstances).

b) Limitation 9[a]: Camera Unit

Limitation 9[a] recites “a camera unit, adapted to obtain at least one of image data and audio data.”

Petitioner contends that Walker discloses or suggests this feature. *Id.* at 9–10 (citing Ex. 1002 ¶¶ 59–65). For example, Petitioner asserts, “*Walker* discloses that the mobile device includes a digital camera and captures video and sound.” *Id.* at 9 (citing Ex. 1007 ¶¶ 38, 43–44, 63–64, 81–82, 91–92, 98–99; Ex. 1002 ¶¶ 60–62). Petitioner asserts this is consistent with how the ’404 patent describes the feature. *Id.* at 10 (citing Ex. 1007, 3:4–15 (built-in camera takes still or moving images of the attacker and sends the image and/or audio data to the authorities)). Accordingly, Petitioner asserts that “*Walker* discloses or suggests a handheld mobile communications device with a camera (‘camera unit’) that captures pictures, videos, and/or sound (‘adapted to obtain at least one of image data and audio data’).” *Id.* (citing Ex. 1002 ¶ 65).

At this time, Patent Owner does not dispute Petitioner’s contention that Walker discloses or suggests the “camera unit” of claim 9.

Petitioner shows sufficiently that Walker discloses or suggests the “camera unit” of claim 9.

c) Limitation 9[b]: Location Unit

Limitation 9[b] recites “a location unit, adapted to obtain location data.”

Petitioner contends Walker discloses or suggests this feature. Pet. 10–11 (citing Ex. 1002 ¶¶ 66–73). For example, Petitioner asserts, Walker discloses that its mobile device uses “A-GPS circuitry” and that the mobile device calculates “location coordinates” from data obtained by the

A-GPS circuitry. *Id.* at 10 (citing Ex. 1007 ¶¶ 77–79, 81–82, 92, 96, 101; Ex. 1002 ¶¶ 67–68). Petitioner contends that a POSITA would have understood that “location coordinates” are expressed in a latitude and longitude pair, such as in x-y format. *Id.* (citing Ex. 1002 ¶¶ 68–70).

Petitioner contends that Walker is consistent with the ’404 patent’s description of this feature, which describes “obtain[ing] location information through a form of GPS . . . on the device” including “GPS or AGPS,” and that “[l]ocation information . . . can be an x-y coordinate or close to it that the phone obtains.” *Id.* at 11 (citing Ex. 1001, 6:64–7:6). Petitioner asserts that “a POSITA would have understood that data obtained by *Walker*’s A-GPS circuitry and the calculated coordinates constitute ‘location data.’” *Id.* (citing Ex. 1002 ¶¶ 71–72).

Petitioner asserts that “*Walker* discloses or suggests that the mobile device includes A-GPS circuitry (‘a location unit’) to obtain data used by the device to calculate location coordinates (‘adapted to obtain location data’).” *Id.* ¶ 73.

At this time, Patent Owner does not contest that Walker discloses or suggests the “location unit” of claim 9.

Petitioner shows sufficiently that Walker discloses or suggests the “location unit” of claim 9.

d) Limitation 9[c]: Transmitting Unit

Limitation 9[c] recites “a transmitting unit, adapted to transmit as emergency information the image data, the audio data, and the location data along with specific information including owner identification information.”

Petitioner contends that Walker discloses or suggests this feature. Pet. 11 (citing Ex. 1002 ¶¶ 74–103). For example, Petitioner contends,

“*Walker* discloses that the mobile device includes ‘cellular communications equipment enabling all relevant data to be transmitted in real time’ according to the CDMA2000 1xEV-DV protocol, which provides wireless access to the Internet and is based on ‘standard Internet Protocols (IP).” *Id.* (citing Ex. 1007 ¶¶ 54, 65, 66–74; Ex. 1002 ¶¶ 75–76). Petitioner further asserts that Walker discloses “related or alternative technologies for transmitting data, such as an aerial 14, Bluetooth, and dial-up networking.” *Id.* (citing Ex. 1007 ¶¶ 63, 81–82, 103, 107, 109, 134, 140, 159; Ex. 1002 ¶¶ 78–80). Petitioner states that “*Walker* also discloses using email or other electronic messaging services to transmit recorded data.” *Id.* at 12 (citing Ex. 1007 ¶ 134; Ex. 1002 ¶ 80).

Petitioner asserts that Walker’s disclosures are consistent with how the ’404 patent describes that the alleged invention may be used with cellular telephones, and describes transmitting information via TCP/IP or MMS, or other protocols, including “regular email” or a “picture-based e-mail type system.” *Id.* (citing Ex. 1007, 6:20–53, 8:29–31). Petitioner contends that “a POSITA would have understood that cellular telephones have cellular communications equipment, and that TCP/IP is a standard Internet protocol.” *Id.* (citing Ex. 1002 ¶¶ 82–83). Petitioner contends that “a POSITA would have understood *Walker* to disclose or suggest a ‘transmitting unit.’” *Id.* (citing Ex. 1002 ¶ 84).

Petitioner contends that “*Walker* also discloses transmitting “‘streaming video and sound data and other data’” and that, once calculated, the location coordinates of the device are “‘immediately transmitted to the data storage facility 7, integrated with the continuing video stream, sound data, and other data.’” Pet. 12 (citing Ex. 1007 ¶¶ 92, 99, 101, 103;

Ex. 1002 ¶ 85). Petitioner asserts that the “audio, video, and location data is used to inform others of a crime or when the user is being attacked” and that the data was therefore related to an ongoing emergency, consistent with how the ’404 patent describes “emergency information.” *Id.* at 12–13 (citing Ex. 1007, code (54), ¶¶ 21, 43–49; Ex. 1001, 5:34–59, 6:20–23; Ex. 1002 ¶¶ 86–87). Petitioner contends that “a POSITA would have understood *Walker* to disclose or suggest that the mobile device transmitting unit is ‘adapted to transmit as emergency information the image data, the audio data, and the location data.’” *Id.* at 13 (citing Ex. 1002 ¶ 88).

Petitioner further contends that “*Walker* further discloses that the remote data storage facility creates a file linked with the ‘device owner’s identity’ to record the data transmitted from the mobile device.” *Id.* (citing Ex. 1007 ¶¶ 92, 97, 106; Ex. 1002 ¶ 89). Petitioner asserts that “[a]ccordingly, a POSITA would have understood *Walker* to disclose the mobile device transmitting information to identify the device owner (‘owner identification information’).” Pet. 13 (citing Ex. 1002 ¶ 90).

Additionally, Petitioner argues that if the Board were to decide that *Walker* does not disclose transmitting owner identification information, then a POSITA would have found it obvious to do so. *Id.* (citing Ex. 1002 ¶¶ 91–97). Petitioner asserts that “*Walker* discloses that the remote data storage facility creates a file linked with the ‘device owner’s identity’ to record the data transmitted from the mobile device,” that *Walker* is concerned with identifying individuals at the scene of a crime or other event, and that these disclosures express a suggestion to transmit information to identify the mobile device’s owner. *Id.* (citing Ex. 1007 ¶¶ 1, 40–41, 43, 48–49; Ex. 1002 ¶ 93). Petitioner asserts that “a POSITA would have

understood that transmitting the owner identification information would have allowed the remote storage facility to link the recorded information with the device owner's identity and would have advanced *Walker*'s objective to identify individuals present at the scene of the emergency described by the image, audio, and location data.” *Id.* at 13–14 (citing Ex. 1002 ¶ 94).

Petitioner further argues that a “POSITA would have had a reasonable expectation of success in modifying *Walker* to transmit information to identify the owner to accomplish *Walker*'s objectives because techniques for doing so were well-known.” *Id.* at 14 (citing Ex. 1002 ¶¶ 95–97; Ex. 1012, code (54), 3:6–22, 11:1–7, 12:13–18, Figs. 3A–3B).

Petitioner contends that a “POSITA would have further understood *Walker* to disclose or suggest that the owner identification information is transmitted in a manner that associates it with the transmitted image, audio, and location data because that is how a POSITA would have understood the storage facility could link the transmitted data to the owner's identity and appropriately notify emergency services.” Pet. 14 (citing Ex. 1002 ¶ 98). Petitioner asserts that “*Walker* discloses that the steps of creating the linked file and transmitting the data are initiated automatically and in parallel in response to the press of the eyewitness button.” *Id.* (citing Ex. 1007 ¶¶ 92–105, 109; Ex. 1002 ¶ 99). Petitioner argues that “a POSITA would have understood that, at a minimum, the device owner identity information was transmitted in parallel or close in time to the video, sound, and location data.” *Id.* (citing Ex. 1002 ¶ 100). Petitioner contends that Walker “is consistent with how the '404 patent describes transmitting emergency information ‘along with’ owner identification information ‘so that help can

be dispatched right away.” *Id.* at 14–15 (citing Ex. 1001, 5:24–57; Ex. 1002 ¶ 91). Petitioner thus contends that “a POSITA would have understood *Walker* to disclose or suggest transmitting image, audio, and location data ‘along with’ owner identification information.” *Id.* at 15 (citing Ex. 1002 ¶¶ 101–102).

Petitioner contends that

Accordingly, *Walker* discloses or suggests a mobile device with cellular communications equipment and various additional or alternative transmission technologies (a “transmitting unit”) to transmit image, audio, and location data in emergencies (“adapted to transmit as emergency information the image data, the audio data, and the location data”) in addition to information to identify the owner of the device so that it could be linked at the storage facility and provided to emergency services (“along with specific information including owner identification information”).

Pet. 15 (citing Ex. 1002 ¶ 103).

Patent Owner argues that claim limitation 9[c] requires transmitting emergency information along with specific information including “owner identification information.” Prelim. Resp. 6. Patent Owner asserts that, even assuming Walker’s “device owner’s identity” is equivalent to the ’404 patent’s owner identification information, “the Petition does not establish that Walker discloses transmitting the device owner’s identity as required by the claim limitations.” *Id.* at 6–7 (citing Pet. 13; Ex. 1007 ¶ 97). According to Patent Owner, “*Walker* merely acknowledges that ‘[a] database link between each file and the device owner’s identity or account is made’ with no disclosure stating if and how any information identifying the device owner is transmitted in the first place.” *Id.* at 7.

Patent Owner argues that Petitioner appears “to recognize the deficiency in *Walker* and attempt[s] to argue that, even if *Walker* does not disclose transmitting owner identification information, a POSITA would have found it obvious to modify *Walker* to do so.” Prelim. Resp. 7 (citing Pet. 13). Patent Owner argues that Petitioner’s contentions of a reasonable expectation of success for transmitting owner information because it was well-known, and that this information would have been transmitted in parallel or close in time with video, sound, and location data, are not supported by *Walker* and are conclusory in nature, supported only by Petitioner’s declarant parroting Petitioner’s flawed logic. *Id.* at 7–8 (citing Pet. 14; Ex. 1002 ¶¶ 95–97). Patent Owner asserts that Petitioner has “failed to establish that *Walker* discloses transmitting owner identification information as required by the claim limitations,” and that Petitioner has failed to show unpatentability of claim 9 for this reason. *Id.* at 8.

To address the parties’ contentions, we note that, although Patent Owner does not concede that *Walker*’s “device owner’s identity” is equivalent to the ’404 patent’s “owner identification information,” neither does it argue at this time that these terms have different meanings. Prelim. Resp. 7. Based on *Walker*’s disclosure, and the ordinary and customary meaning of the terms, we are persuaded on the current record that *Walker*’s “device owner’s identity” is equivalent to “owner identification information” as recited in claim 9. Ex. 1007 ¶¶ 92, 97, 106; Ex. 1002 ¶¶ 89–90.

The fact that *Walker*’s data storage facility links the electronic file containing the transmitted information with the “device owner’s identity” suggests on this record that the mobile device transmits the “device owner’s identity” to the data storage facility along with the video, sound, and

location data. Ex. 1007 ¶¶ 105–106. Without this information, the data storage facility could not associate the transmitted data with the electronic file linked to the “device owner’s identity.”

Furthermore, Petitioner’s declarant, Dr. Michalson, explains that a POSITA would have had a reasonable expectation of modifying Walker to transmit information to identify the owner to accomplish Walker’s objectives because techniques for doing so were well-known, as exemplified by Chang. Ex. 1002 ¶¶ 96–97. Chang discloses that a “user-identification device” may comprise a “wireless-communication device” or “smart card” that communicates with a security office, and that Chang includes “user-identification information with the transmitted video signal” and that a “subscriber identify module” in the device may be used to store user-specific information. *Id.* ¶¶ 96–97. Although Chang is not part of any of the challenged grounds here, the general knowledge of a person of ordinary skill in the art is relevant to the obviousness inquiry. *Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330 (Fed. Cir. 2020) (general knowledge of skill artisan may supply missing claim limitation).

For the foregoing reasons, Petitioner has shown sufficiently that the combination of Walker and Kim, in light of the general knowledge of a POSITA, at least suggests that owner information is transmitted along with emergency information including image, audio, and location data, as recited in claim 9. Patent Owner does not argue Petitioner’s contentions regarding the remainder of limitation 9[c].

Accordingly, Petitioner shows sufficiently that Walker discloses or suggests the “transmitting unit” of claim 9.

e) Limitation 9[d]: Panic Button

Limitation 9[d] recites “a panic button, adapted to activate the camera unit, the location unit, and the transmitting unit, and send the emergency information and the specific information to a specified location when the panic button is activated.”

Petitioner contends that “*Walker* in combination with *Kim* discloses or suggests this feature.” Pet. 15–21 (citing Ex. 1002 ¶¶ 104–133). Petitioner asserts that “*Walker* discloses an ‘eyewitness button 12’ that, when pressed once (for example, during an attack), initiates various operations related to collecting and transmitting information about the attack.” *Id.* at 15–16 (citing Ex. 1007 ¶¶ 92–105; Ex. 1002 ¶ 105). Petitioner asserts that a “POSITA would have understood that Walker’s eyewitness button 12 is akin to the ’404 patent’s ‘panic button.’” *Id.* at 16 (citing Ex. 1001, 3:16–21, 5:37–42, 8:2–3, Fig. 2A; Ex. 1002 ¶ 106). Petitioner argues that Walker’s eyewitness button is dedicated to a panic function. *Id.* (citing Ex. 1002 ¶ 107).

Petitioner further contends that Kim is similar to Walker and the ’404 patent, and discloses a device and method “to transmit emergency information to an emergency contact with a simple manipulation of a button on a mobile phone.” *Id.* at 16–17 (citing Ex. 1010, code (54); Ex. 1002 ¶ 110). Petitioner asserts that Kim’s “emergency key button 32 is mounted on an external lateral surface of the phone” and “executes an emergency mode for notifying an emergency state by way of button manipulation.” Pet. 17 (citing Ex. 1010, 4:24–26, 5:16–22, 8:22–9:11, 12:22–13:6, Fig. 3a; Ex. 1002 ¶¶ 111–112). Petitioner argues that Kim’s emergency key button,

like Walker’s eyewitness button, is dedicated to panic or emergency operations. *Id.* (citing Ex. 1002 ¶ 113).

Patent Owner argues that Petitioner fails to establish that Walker and/or Kim actually disclose transmitting information “to a specified location” as required by the claim limitations. Prelim. Resp. 8–9 (citing Pet. 21–23). Patent Owner asserts that the “’404 patent discloses that the invention can choose the specified location to send data to using a variety of communication protocols.” *Id.* at 9 (citing Ex. 1001, 6:20–53). Patent Owner states, for example, that “the ’404 patent discloses that the user can choose to send the emergency information and specific information via e-mail directly to a single e-mail address, or multiple e-mail addresses.” *Id.* (citing Ex. 1001, 6:28–35, 6:46–47). Patent Owner also contends that “[a]lternatively, the user could choose to send the emergency information and specific information to a web service using TCP/IP connections on the mobile device.” *Id.* (citing Ex. 1001, 6:20–25). Patent Owner further contends that “the ’404 patent discloses that the user could choose to transmit the emergency information and specific information directly to an emergency responder via the e-911 protocol.” *Id.* (citing Ex. 1001, 6:54–7:7). In other words, according to Patent Owner, “the ’404 patent discloses that the user can choose the specific location that the emergency information and specific information is sent to, and that different protocols can be used to transmit the data to that specified location.” *Id.*

Patent Owner argues, “[b]y contrast, the cited portions of *Walker* do not allow the user of a mobile device to specify a location to transmit data.” Prelim. Resp. at 9–10. Patent Owner asserts that while Petitioner relies on Walker’s claim 86 and paragraphs 84, 85, and 134 as disclosing this feature,

these disclosures do not allow flexibility to choose an alternate location. *Id.* at 10–11 (citing Pet. 22; Ex. 1007 ¶¶ 84–85, 134, claim 86). Patent Owner also disputes Petitioner’s contention that Walker discloses transmitting to a specified location because it does not broadcast data. *Id.* at 11. According to Patent Owner, Walker can only transmit data to its data storage facility and there is no option to specify or select other locations. *Id.*

On the current record, we do not agree with Patent Owner’s argument. Although Patent Owner argues that the user must be able to select a “specified location” in claim 9, there is no language to this effect in the claim. *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) (stating that limitations not appearing in the claims cannot be relied upon for patentability). In other words, claim 9 does not recite that the mobile device’s user specifies the location to which the recorded data is to be sent.

Moreover, we agree with Petitioner based on the current record that Walker’s data storage facility is a “specified location” because its corresponding IP address, email address, or telephone number must be specified in order for the mobile device to transmit the recorded data over a network to the data storage facility. Pet. 22 (citing Ex. 1007 ¶¶ 84–85, 134, claim 86).

Patent Owner does not otherwise contest that Walker discloses the “panic button” of claim 9.

Accordingly, Petitioner shows sufficiently on the current record that Walker discloses or suggests the “panic button” of claim 9.

f) Limitation 9[e]: Series of Depressings of Panic Button

As explained in § III.D.3, Petitioner contends that the “eyewitness button 12” is “recessed and set to operate at a higher finger pressure than other buttons on the device so as to [minimize] the occurrence of accidental activation.” Pet. 16 (citing Ex. 1007 ¶¶ 81, 83, Fig. 2). Kim, on the other hand, avoids accidental activation by providing that “emergency key button 32 is manipulated a plurality of times, e.g., three times, within a set period of time.” *Id.* at 17 (citing Ex. 1010, 13:1–6). Petitioner contends that Kim’s emergency key button would be used instead of Walker’s eyewitness button by simple substitution. *Id.* at 19.

Petitioner further argues that “Kim’s disclosure related to emergency key button 32 is consistent with how the ’404 patent describes a panic button that is activated by a series of presses” and that “a POSITA would have understood Kim to disclose that the emergency key button 32 is activated to trigger the emergency mode by being manipulated, i.e., pressed, a series of times (e.g., three times).” *Id.* at 17–18 (citing Ex. 1001, 3:60–62; Ex. 1023; Ex. 1002 ¶¶ 114–116).

Patent Owner does not argue against Petitioner’s assertion that Kim discloses depressing its emergency key button a series of times (e.g., three times) to activate the emergency mode.

Petitioner has shown sufficiently that the combination of Walker and Kim discloses “wherein the panic button is activated by a series of depressings of the panic button” in claim 9.

g) Conclusion for Claim 9

Petitioner has shown sufficiently that a POSITA would have been motivated to combine Walker and Kim with a reasonable expectation of success. Petitioner has also shown sufficiently that each limitation of claim 9 is taught or at least suggested by the combination of Walker and Kim. Accordingly, we determine that Petitioner has presented, on the current record, a reasonable likelihood that claim 9 is unpatentable as obvious over the combination of Walker and Kim notwithstanding Patent Owner's arguments.

5. Claim 10

Claim 10 depends from claim 9 and recites "wherein when the panic button is activated a public or private network for emergency purposes is dialed."

Petitioner contends that the Walker-Kim combination discloses this feature. Pet. 23–25 (citing § VIII.A.1.e; Ex. 1002 ¶¶ 144–153). Specifically, Petitioner contends that, when the panic button is depressed three times, the handheld mobile device dials a number to form a dial-up connection to the remote data storage facility on a PSTN to transmit recorded data. *Id.* at 23–24 (citing Ex. 1007 ¶¶ 60, 84–85, 134, claim 51; Ex. 1002 ¶¶ 103, 109, 145–150). Petitioner also contends that, similarly to the '404 patent, Walker discloses that the transmitted and recorded data is used to assist security and police in responding to crimes. *Id.* at 24–25 (citing Ex. 1007 ¶¶ 1, 40–41, 43, 48–49, 141; Ex. 1002 ¶¶ 151–152).

Patent Owner does not dispute Petitioner's contention concerning the specific limitation of claim 10 at this time.

Petitioner has shown a reasonable likelihood, on the current record, that claim 10 is unpatentable as obvious of the combination of Walker and Kim.

6. *Claim 12*

Claim 12 recites “wherein a number of depressings of the panic button to activate the panic button is three.”

Petitioner contends that the Walker-Kim combination discloses or suggests this feature. Pet. 25 (citing § VIII.A.1.e(i); Ex. 1002 ¶ 154).

Patent Owner does not dispute Petitioner’s assertion for the specific limitation of claim 12.

Petitioner presents a reasonable likelihood that claim 12 would have been obvious over the Walker-Kim combination.

7. *Claim 13*

Claim 13 is an independent claim that is similar to claim 9 but further recites that the panic button, when activated, performs the function of “dialing a public or private network for emergency purposes.”

For the reasons explained for claim 10 (*see* Pet. § III.D.5), Petitioner has shown sufficiently that the Walker-Kim combination discloses or at least suggests this limitation notwithstanding Patent Owner’s arguments discussed with respect to claim 9. Pet. 26–27 (citing *id.* at § VIII.A.1.e and § VIII.A.2; Ex. 1002 ¶¶ 158–159).

Other than the arguments addressed with respect to claim 9, Patent Owner does not submit any other argument for claim 13 at this time.

Petitioner presents a reasonable likelihood, on the current record, that claim 13 would have been obvious over the Walker-Kim combination.

8. *Claim 14*

Claim 14 recites “wherein a number of depressings of the panic button to activate the panic button is five.”

Petitioner contends that the Walker-Kim combination discloses or suggests claim 14. Pet. 27–28 (citing Ex. 1002 ¶¶ 160–163). Petitioner contends that a POSITA considering Kim would have understood that pressing a key a “plurality of times” is a range that does not have an upper bound, and overlaps and encompasses the claimed five presses. *Id.* at 27–28. Petitioner also argues that the ’404 patent does not disclose that there is something special or critical about five button presses. *Id.* at 28.

Patent Owner does not dispute Petitioner’s contentions specific to claim 14 at this time.

Petitioner demonstrates a reasonable likelihood, on the current record, that claim 14 would have been obvious over the Walker-Kim combination.

E. Ground 1B: Obviousness over Walker, Kim, and Dixit

We now address Petitioner’s contention that claim 14 would have been obvious over the combination of Walker, Kim, and Dixit, and Patent Owner’s argument for patentability for this ground. Pet. 29–31; Prelim. Resp. 18.

1. *Dixit (Ex. 1011)*

Dixit is titled “System and Method for Remote Convenience Function Control with At-Vehicle and Remote Assistance-Summoning Functions.” Ex. 1011, code (54). Dixit’s Figure 1 is reproduced below.

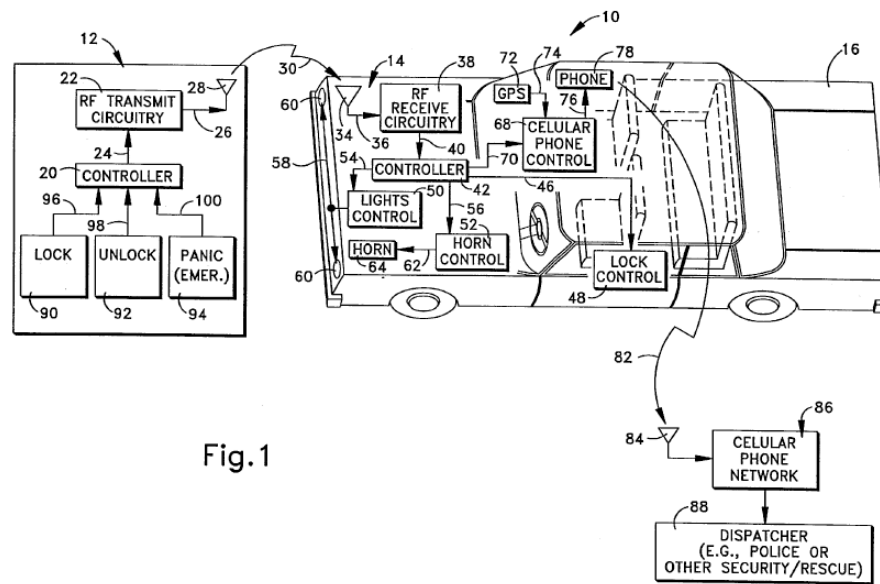


Fig.1

Figure 1 shows remote convenience system 10 which includes a portable hand-held transmitter 12, and a vehicle-based receiver/controller 14 located at vehicle 16. Ex. 1011, 2:54–60. The transmitter has a panic pushbutton switch 94 which, when actuated, causes a remote-assistance summoning function to convey an assistance-request message via a cellular phone network 86 to a dispatcher 88, e.g., the police or other security or rescue. *Id.* at 4:20–28, Fig. 1. Transmitter 12 outputs a broadcast signal 30 conveying a PANIC message when the emergency pushbutton switch 94 is actuated five times within five seconds. *Id.* at 4:47–53, Figs. 1, 3.

2. Motivation to Combine Walker, Kim, and Dixit

Petitioner contends that Dixit is similar to the '404 patent, Walker, and Kim. Pet. 29 (citing Ex. 1002 ¶ 165). Petitioner argues that a plurality of button presses was a well-known technique for minimizing the risk of accidental activation. Pet. 30 (citing *id.* at § VIII.A.1.e.(i); Ex. 1002 ¶ 167). Petitioner asserts that “[t]he '404 patent does not disclose any special or critical results in terms of risk reduction from using five button presses compared to any other number of button presses more than one.” *Id.*

Petitioner argues that “a POSITA would have understood that requiring five button presses would predictably lead to fewer accidental activations compared to four, three, or two button presses with a corresponding tradeoff in terms of how easy it is to activate the panic button when needed.” *Id.* Petitioner contends that, considering the pros and cons, “a POSITA would have been motivated to use five button presses instead of three to, for example, further reduce the risk of accidental activation of the panic button.” *Id.* at 30–31 (citing Ex. 1002 ¶¶ 168–170).

Petitioner contends that a “POSITA would have understood the proposed combination to amount to the simple substitution of one known element (a panic button that must be pressed five times) for another (a panic button that must be pressed three times) to obtain predictable results (a panic button that is activated after five presses).” *Id.* at 31 (citing Ex. 1002 ¶ 170).

Other than as described for ground 1A, Patent Owner does not dispute Petitioner’s contentions regarding the combination of Walker, Kim, and Dixit.

Petitioner has shown sufficiently, on the current record, that a POSITA would have combined Walker, Kim, and Dixit with a reasonable expectation of success.

3. *Claim 14*

Claim 14 recites “wherein a number of depressings of the panic button to activate the panic button is five.”

Petitioner contends that Dixit is similar to the ’404 patent, Walker, and Kim, and discloses a portable transmitter that, when “actuated five times,” causes the vehicle to transmit a remote assistance-summoning request to the police, for example. Pet. 29–30 (citing Ex. 1011, 4:47–5:49,

Figs. 1, 3; Ex. 1002 ¶ 166). Petitioner thus asserts that “the *Walker-Kim-Dixit* combination discloses or suggests a mobile device with a dedicated emergency key button that must be pressed five times (‘wherein a number of depressings of the panic button to activate the panic button is five’).” *Id.* at 31 (citing Ex. 1002 ¶ 171).

Patent Owner relies on its arguments for ground 1A and does not present any further argument for this ground specific to claim 14. For the reasons explained, Patent Owner’s arguments do not undermine Petitioner’s showing for either ground 1A or this ground.

Consequently, Petitioner has presented, on the current record, a reasonable likelihood that claim 14 is unpatentable on this ground.

F. Ground 2: Obviousness over Walker

Claim 15 is similar to claim 9 but differs in that it recites “wherein the panic button is activated by a button sequence” rather than that the button is activated by a series of depressings.

Petitioner contends that claim 15 does not require that the button sequence be entered into the mobile device itself, but may instead be entered on a remote device according to Walker’s disclosure. Pet. 34–35 (citing Ex. 1007 ¶¶ 92–109, 130; Ex. 1001, 7:16–21; Ex. 1002 ¶¶ 188, 190–194).

Patent Owner relies on the same arguments presented for ground 1A, which do not undermine Petitioner’s showing for the reasons explained with respect to that ground.

Petitioner has presented, on the current record, a reasonable likelihood that claim 15 would have been obvious over Walker.

G. Ground 3A: Zellner and Kim

We now address the disclosure of Zellner, Petitioner’s contention that claims 9–14 would have been obvious over the combination of Zellner and Kim, and Patent Owner’s arguments for patentability for this ground. Pet. 36–53.

1. Zellner (Ex. 1008)

Zellner is titled “Panic Button IP Device.” Ex. 1008, code (54). Zellner’s Figure 3 is shown below.

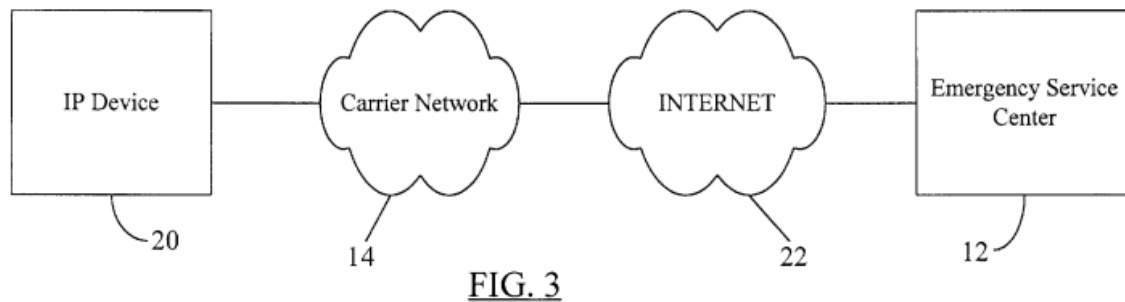
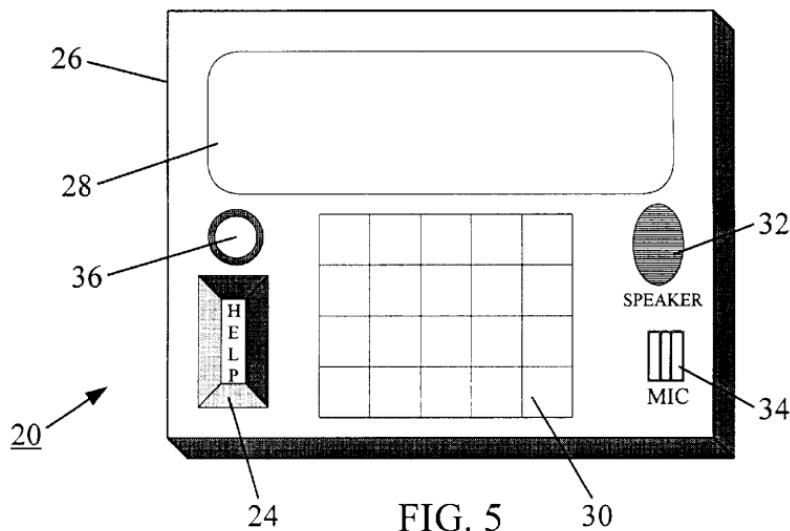


Figure 3 shows an IP device 20 connected to an emergency service center 12 via a carrier network and the Internet 22. *Id.* at 4:56–62, 5:15–33, 6:55–7:14.

Zellner’s Figure 5 is reproduced below.



Zellner’s Figure 5 shows an embodiment of the IP device 20 having a built-in camera 36. Ex. 1008, 7:65–67. Zellner discloses that panic button 24 may be provided on the housing of the IP device 20, and that pressing the panic button invokes emergency help functionality. *Id.* at 7:15–16, 7:46–50. Zellner discloses that the camera may be activated when the panic button 24 is pressed, and that video shot by the camera may be helpful in law enforcement in response to a burglary attempt or threat to the user’s physical safety. *Id.* at 8:3–14. Zellner further discloses that the video images captured by the camera may be transmitted to the emergency service center (ESC) 12 upon activation of the panic button. *Id.* at 8:15–17. Zellner also discloses a user location identifier that “ascertain[s] a location of the user activating said panic button.” *Id.* at claim 3, 3:34–39.

2. *Claims 9–14*

Petitioner contends that a POSITA would have been motivated to combine Zellner and Kim, and that the combination discloses each limitation of claims 9–14. Pet. 36–53. Patent Owner presents a similar argument as provided for ground 1A that the Zellner-Kim combination does not disclose sending the emergency information and specific information to a specified location when the panic button is activated (limitations 9[d], 13[d]). Prelim. Resp. 13–15.

Petitioner presents, on the current record, a reasonable likelihood that claims 9–14 would have been obvious over the Zellner-Kim combination.

H. Ground 3B: Zellner, Kim, and Dixit

Petitioner contends it would have been obvious to modify the Zellner-Kim combination to implement Dixit’s technique of five button presses. Pet. 53.

Apart from the arguments presented for ground 3A, Patent Owner does not separately argue against Petitioner's contentions with respect to this ground.

Petitioner has presented, on the current record, a reasonable likelihood that claim 14 would have been obvious over the Zellner-Kim-Dixit combination.

I. Ground 4A: Martin and Kim

We now address the disclosure of Martin and Kim, Petitioner's contention that claims 9, 10, and 12–14 would have been obvious over the combination of Martin and Kim, and Patent Owner's arguments for patentability for this ground.

1. Martin (Ex. 1009)

Martin is titled "System and Method for Reporting an Emergency Situation." Ex. 1009, code (54). Martin's Figure 2 is reproduced below.

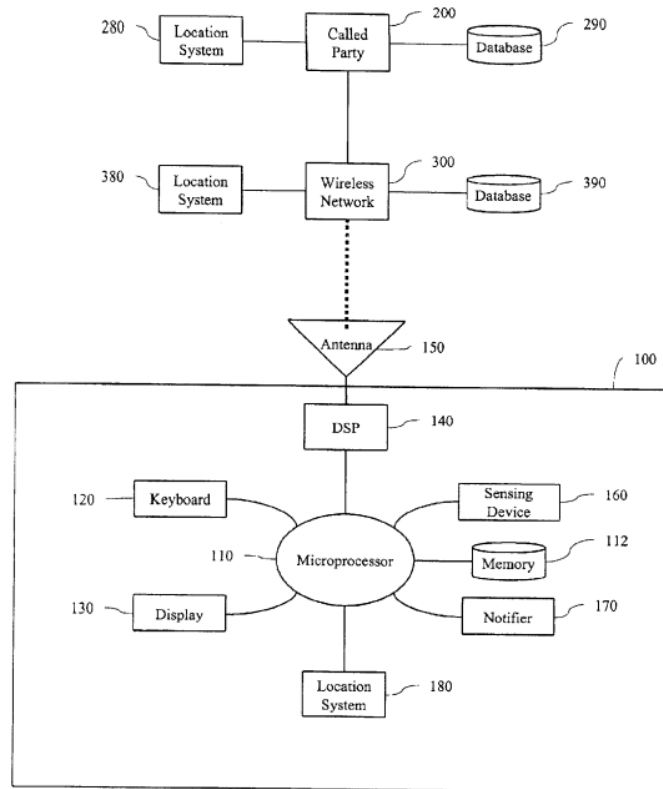


Figure 2

Martin's Figure 2 shows a wireless device 100 that connects to called party 200. Ex. 1009, 3:13–54. Wireless device 100 communicates with called party 200 via a wireless network 300. *Id.* at 3:48–54.

Wireless device 100 may constitute a wireless telephone. *Id.* at 3:29–31. Wireless device 100 may include a keyboard, display, camera, and microphone, and may capture content including sound and moving images. *Id.* at 3:31–42. The wireless device 100 may include a location system 180 that includes a GPS receiver. *Id.* at 3:55–65.

Martin further discloses a method that includes receiving a keystroke sequence (e.g., pressing a key one or more times), establishing a wireless communication session, and transmitting location, captured content (e.g.,

images, sound), and a user profile to a called party. *Id.* at 4:34–45, claims 1 and 4, Fig. 3.

2. *Claims 9, 10, and 12–14*

Petitioner contends that a POSITA would have been motivated to combine Martin and Kim with a reasonable expectation of success, and that the combination discloses or suggests each limitation of claims 9, 10, and 12–14. Pet. 54–67.

Patent Owner argues that Petitioner does not establish that image data, audio data, and location data are collected and transmitted at the same time together in response to a user pressing the panic button. Prelim. Resp. 15–18. Instead, Patent Owner contends that Martin sends location information and images sequentially. *Id.* at 16–18.

Reviewing claims 9, 10, and 12–14, we do not find any language requiring image data, audio data, and location data to be sent at the same time. Limitations not appearing in the claims cannot be relied upon for patentability. *Self*, 671 F.2d at 1348.

Petitioner has presented, on the current record, a reasonable likelihood that claims 9, 10, and 12–14 would have been obvious over the Martin-Kim combination.

A. *Ground 4B: Martin, Kim, and Dixit*

Petitioner contends that it would have been obvious to modify the Martin-Kim combination with Dixit’s five button presses as recited in claim 14. Pet. 67 (citing *id.* at §§ VIII.B and VIII.F.5; Ex. 1002 ¶¶ 349–350).

Patent Owner relies on the arguments it presented for ground 4A which do not undermine Petitioner's showing for the reasons explained above. Prelim. Resp. 18.

Petitioner has presented, on the current record, a reasonable likelihood that claim 14 would have been obvious over the Martin-Kim-Dixit combination.

IV. CONCLUSION

In light of the foregoing, based on the current record and at this stage of the proceeding, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing on its assertions that at least one of claims 9–15 of the '404 patent would have been obvious under 35 U.S.C. § 103 based on the grounds set forth in the Petition. Accordingly, we institute trial for all challenged claims on all grounds asserted by Petitioner. *See SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018); 37 C.F.R. § 42.108(a) (“When instituting . . . review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim”).

Our factual findings, conclusions of law, and determinations at this stage of the proceeding are preliminary, and based on the evidentiary record developed thus far. At this stage of the proceeding, we have not made a final determination with respect to the patentability of the challenged claims or to the construction of any claim term.

V. ORDER

For the foregoing reasons, it is

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 9–15 of the '404 patent is hereby instituted on all challenges to patentability set forth in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial and that the trial will commence on the entry date of this decision.

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