

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners

v.

FENDGO, LLC,

Patent Owner

Case IPR2024-00114

U.S. Patent No. 11,265,404

PETITIONERS' NOTICE OF APPEAL

By Electronic Filing

Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By Electronic Mail

Office of the General Counsel
efileSO@uspto.gov
U.S. Patent & Trademark Office
Madison Building East, 10B20
600 Dulany Street
Alexandria, VA 22314-5793

By Electronic Filing

Circuit Executive and Clerk of Court
United States Court of Appeals for the Federal Circuit
717 Madison Place, NW
Washington, DC 20439

Pursuant to 35 U.S.C. §§ 141(c), 142 and 319; 37 C.F.R. §§ 90.2(a), 90.3(a), and 90.3(b)(1); Federal Rule of Appellate Procedure 15; and Federal Circuit Rule 15, Petitioners Samsung Electronics Co., Ltd. and Samsung Electronics, America, Inc., (“Petitioners” or “Samsung”) hereby appeal to the United States Court of Appeals for the Federal Circuit from the Patent Trial and Appeal Board’s (“Board”) Decision Denying Petitioner’s [sic] Request for Rehearing entered on August 19, 2025 (Paper No. 34) (“Rehearing Request Decision”) in IPR 2024-00114, the Final Written Decision entered on April 30, 2025 (Paper No. 32) (“Final Written Decision”) in IPR 2024-00114, and from all underlying findings, determinations, rulings, opinions, orders, issues, and decisions regarding the *inter*

partes review of U.S. Patent No. 11,265,404 (“the ’404 Patent”) in IPR 2024-00114. A copy of the Rehearing Request Decision is attached as Exhibit 1 and a copy of the Final Written Decision is attached as Exhibit 2.

In accordance with 37 C.F.R. § 90.2(a)(3)(ii), Petitioners identify that the issues on appeal include, but are not limited to: whether the Board erred in determining that Petitioners had not shown by a preponderance of the evidence that (1) claims 1-8 are unpatentable under § 103(a) based on DiPerna964 and Strack; and (2) any Board finding, determination, judgment or order related to the foregoing issues, as well as all other issues decided adversely to Petitioners, including, without limitation, the Board’s construction and application of the claim language, the Board’s interpretation of the prior art, the Board’s interpretation of expert evidence, and the Board’s application of the law.

The Board issued its Rehearing Request Decision on August 19, 2025. This notice is therefore timely filed within sixty-three (63) days of the Board’s decision, as prescribed by 35 U.S.C. § 142 and 37 C.F.R. §§ 90.3(a)(1) and 90.3(b)(1).

Petitioners are concurrently filing this Notice of Appeal with the Director of the United States Patent and Trademark Office and the Clerk of the United States Court of Appeals for the Federal Circuit, along with the required fees.

Petitioners do not believe that any fees are due to the United States Patent and Trademark Office with this Notice of Appeal. However, if any such fees are due, the Director is authorized to charge the fees to Deposit Account No. 50-2387.

Dated: October 20, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of this PETITIONERS' NOTICE OF APPEAL was filed on October 20, 2025 with the Director of the United States Patent and Trademark Office by electronic mail to efileSO@uspto.gov, which is the email address as indicated on the United States Patent and Trademark Office's webpage for the Office of the General Counsel, <https://www.uspto.gov/about-us/organizational-offices/office-general-counsel>.

A copy of this Notice of Appeal is also being filed and served on October 20, 2025 as follows:

USPTO Patent Trial and Appeal Board:

Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

(via PTAB P-TACTS)

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Counsel for Petitioners

Exhibit 1

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.

IPR2024-00114
Patent 11,265,404 B2

Before, SCOTT C. MOORE, JON M. JURGOVAN, and
AARON W. MOORE, *Administrative Patent Judges*.

JURGOVAN, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, “Petitioner”) request rehearing (Paper 33, “Req. Reh’g”) of our Final Written Decision (Paper 32, “Final Dec.”) entered in the subject *inter partes* review at the conclusion of trial pursuant to 35 U.S.C. § 318(a). In the Final Written Decision, we determined that Petitioner had not demonstrated unpatentability of claims 1–8 of U.S. Patent No. 11,265,404 B2 (Ex. 1001, the “’404 patent”).

A party dissatisfied with a decision of the Board is permitted to file a request for rehearing. 37 C.F.R. § 42.71(d). The requesting party, in this case, Petitioner, bears the burden of showing that the decision should be modified, and “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed.” *Id.*

The subject of Petitioner’s request for rehearing is limitation 1[d] of claim 1 of the ’404 patent, recited as follows:

a panic button, adapted to, when activated, ready itself to perform the following panic button functions: (1) dialing a public or private network for an emergency purpose and (2) activating the transmitting unit.

The recited functions are referred to as “panic button” functions (1) and (2).

Petitioner criticizes the Final Written Decision for stating that Petitioner did not meet its burden to explain how Strack’s button press collects and transmits audio, video, and location data that would ready the panic button to perform recited “panic button” functions (1) and (2). *Id.* (citing Final Dec. 22). Petitioner asserts this reflects misapprehension of the Petition because Petitioner “did not rely on Strack for a teaching of a button

press that readies the button to perform the claimed functions.” *Id.*

Petitioner asserts that it relied on DiPerna964 to disclose that activating the panic button causes it to perform “panic button” functions (1) and (2) recited in limitation 1[d], and Strack teaches an “arming and timer technique” that would have been obvious to apply to DiPerna964, such that their combined teachings render the challenged claims, including limitation 1[d], obvious.

Petitioner overlooks that Strack’s “arming and timer technique” is initiated by the button press, triggering the “duress timer” and the recording of audio and video data, as Petitioner acknowledged in the Petition. Pet. 15. Hence, Strack’s “arming and timer technique” and what happens after the button press are one and the same, and Petitioner’s quibbling with the language of the Final Written Decision is not sufficient to warrant rehearing, let alone modification.

Moreover, Petitioner overlooks that the Final Written Decision states “neither DiPerna964, nor Strack nor their combination teach or suggest limitations 1[d] and 1[e].” Final Dec. 22. For example, Petitioner did not show by a preponderance of the evidence that the combination of DiPerna964 and Strack teaches or suggests a panic button that “readies itself” to perform panic button functions (1) and (2).

In addition, Petitioner focuses on limitation 1[d] in its Request for Rehearing, but we also found limitation 1[e] to be missing from the combination. *Id.* at 21. Even if we agreed with Petitioner’s argument with respect to limitation 1[d], which we do not, we still would deny rehearing because Petitioner does not challenge our finding with respect to limitation 1[e].

For the foregoing reasons, we are not persuaded that Petitioner's Request for Rehearing has established that the Board misapprehended or overlooked any matters, or otherwise committed prejudicial error, in the Final Written Decision.

ORDER

For the foregoing reasons, it is

ORDERED that Petitioner's Request of Rehearing is *denied*.

Summary before Request for Rehearing:

Claim(s)	35 U.S.C. §	Reference(s)/Basis	Claim(s) Shown Unpatentable	Claim(s) Not shown Unpatentable
1–8	103	DiPerna964, Strack		1–8

Summary after Request for Rehearing:

Claim(s)	35 U.S.C. §	Reference(s)/Basis	Claim(s) Shown Unpatentable	Claim(s) Not shown Unpatentable
1–8	103	DiPerna964, Strack		1–8

IPR2024-00114
Patent 11,265,404 B2

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Exhibit 2

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.

IPR2024-00114
Patent 11,265,404 B2

Before, SCOTT C. MOORE, JON M. JURGOVAN, and
AARON W. MOORE, *Administrative Patent Judges*.

JURGOVAN, *Administrative Patent Judge*.

DECISION
Final Written Decision
Determining No Challenged Claims Unpatentable
35 U.S.C. § 318(a)

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 1–8 of U.S. Patent No. 11,265,404 B2 (Ex. 1001, the “’404 patent”). Paper 2 (“Petition” or “Pet.”). Patent Owner, Fendgo, LLC, filed a Preliminary Response to the Petition on February 22, 2024. Paper 9 (“Prelim. Resp.”). We instituted *inter partes* review under 35 U.S.C. § 314(a). Paper 10 (“Institution Decision” or “Inst. Dec.”).

During the trial, Patent Owner filed a Response (Paper 14, “PO Resp.”), Petitioner filed a Reply (Paper 16, “Pet. Reply”), and Patent Owner filed a Sur-Reply (Paper 18, “PO Sur-Reply”).

Petitioner and Patent Owner (“the parties”) requested oral argument (Papers 19 and 20). A hearing was conducted on February 19, 2025, and a transcript is included in the record. Paper 31 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a). Having reviewed the complete trial record, we determine that Petitioner has not shown, by a preponderance of the evidence, that challenged claims 1–8 are unpatentable.

B. *Real Parties in Interest*

Petitioner identifies Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. as the real parties in interest. Pet. 27 (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 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. 27; 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. 27; 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, such as pepper spray, with a mobile phone/device to protect against violent crime. *Id.* at 1:21–31, 2:50–3:3. The ’404 patent states 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” and provides the capability to quickly notify authorities to come to the aid of a person under attack. *Id.* at 2:36–42.

The '404 patent provides an embodiment in which a mobile device includes a camera unit, location unit, transmitting unit, and panic button. *Id.* at 3:51–58. The panic button activates the camera, location unit, and transmitting unit to obtain and transmit image, audio, and location data to an emergency service. *Id.* at 7:8–16.

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

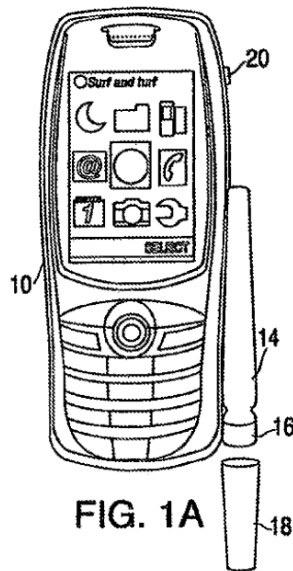


Figure 1A shows that the mobile device 10 includes a panic button 20 and other buttons. *Id.* at 8:2–3. A “safety” switch (not shown) may be moved into position to ready the panic button to contact 911 when pressed. *Id.* at 6:54–59. The panic button may also be activated by depressing the panic button together with another button. *Id.* at 3:63–64. The mobile device may also include a voice activation unit. *Id.* at 3:59–60, 65, 5:60–62, claim 17. “The self-defense device can be activated by way of a panic button and/or can be voice activated, for example, upon the shout of a voice command by the victim.” *Id.* at 5:60–62.

Figure 1A also shows that mobile device 10 includes attached vial 14 that contains pepper spray or mace. *Id.* at 7:66–8:2.

E. Challenged Claims

Claim 1 is independent, and claims 2–8 depend therefrom. Claim 1 is shown below with Petitioner’s identifiers indicated in brackets and with disputed claim language emphasized in bold and italics.

1. [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 the image data, the audio data, and the location data as emergency information to a specified location, along with specific information including owner identification information; and

[d] ***a panic button, adapted to, when activated, ready itself to perform the following panic button functions: (1) dialing a public or private network for an emergency purpose and (2) activating the transmitting unit,***

[e] ***wherein the panic button is activated by a depressing of the panic button together with another button at substantially the same initial time such that no panic button function is activated unless both buttons are depressed.***

Ex. 1001, 8:40–56.

F. Evidence of Record

Petitioner relies upon the following prior art references¹:

Name	Reference	Date	Exhibit No.
DiPerna964	US 2006/0201964 A1	Published Sept. 14, 2006	Ex. 1028
Strack	US 10,460,590 B2	Issued Oct. 29, 2019	Ex. 1029

Petitioner also supports its challenges with a declaration from Dr. William R. Michalson. Ex. 1002. Patent Owner relies on a declaration from Dr. George Edwards. Ex. 2001. Depositions of these declarants are also in the record. Ex. 1037 (Edwards); Ex. 2002 (Williams).

G. The Asserted Challenges to Patentability

Petitioner asserts the following challenge to patentability (Pet. 1–4):

Challenged Claims	35 U.S.C. §	Reference(s)/Basis
1–8	103	DiPerna964, Strack

II. ANALYSIS

In this section, we discuss Petitioner’s challenge to claims 1–8 of the ’404 patent and Patent Owner’s arguments for patentability. For the reasons that follow, we determine that Petitioner has not shown by a preponderance of the evidence that claims 1–8 are unpatentable.

¹ Petitioner alleges that, as a result of the “ready itself” amendment during prosecution, claims 1–8 of the ’404 patent are not entitled to priority before the filing date of January 19, 2019. Pet. 1–2. Petitioner contends DiPerna964 is prior art under § 102(a)(1), and that Strack is prior art under § 102(a)(2) (Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”)). *Id.* at 4.

A. 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).

While neither Petitioner nor Patent Owner initially proposed any claim constructions, over the course of the trial, the parties disputed the meaning of certain claim language in their briefs and at the oral hearing. The disputed claim language is claim 1’s recitation of “***a panic button, adapted to, when activated, ready itself*** to perform the following panic button functions: (1) dialing a public or private network for an emergency purpose and (2) activating the transmitting unit.”

Accordingly, following the hearing, we authorized the parties to submit supplemental claim construction briefs, which they did. Papers 28–30. After consideration of those papers on the full record, we provide a construction for a claim term consistent with 37 C.F.R. § 42.100(b), as discussed below.

1. Petitioner’s Contentions

Petitioner contends that “the plain meaning of this limitation is met where the panic button, when activated, takes at least one preparatory step in

advance of performing the claimed functions, such as recording the image, audio, and location data that is transmitted.” Paper 29, 4 (citing Pet. 17–18; Ex. 1002 ¶¶ 87–91). Petitioner states that “the ’404 patent discloses that the panic button can, itself, perform certain functions when it is activated.” *Id.* (citing Ex. 1001, 4:23–25, 6:54–59). According to Petitioner, “the ’404 patent does not, however, disclose any embodiment where activating the panic button merely causes the panic button to perform a preparatory step before performing the claimed functions.” *Id.* Petitioner argues that while Patent Owner stresses that the ’404 patent discloses that the button can start the speech recognition process, it is the uttered “code word” which “activates” the panic button. *Id.* (citing Ex. 1001, 3:59–60). Petitioner asserts that “[t]here is no disclosure of any embodiment in which the panic button is ‘activated,’ performs a preparatory step (i.e., readies itself), and then performs the claimed functions.” *Id.*

2. Patent Owner’s Contentions

Patent Owner contends that the claimed language “should be given its plain and ordinary meaning, i.e., when activated the panic button readies itself to perform its function, and performs these functions upon further prompting by the user.” Paper 30, 5. Patent Owner asserts that the ’404 patent “has many safeguards in place to prevent falsely triggering the device” including a voice activation unit “which activates the panic button using a codeword.” *Id.* (citing Ex. 1001, 3:59–60). Patent Owner indicates that the ’404 patent discloses “[t]he panic button may be *activated by at least one of*: (1) a depressing or series of depressions of the panic button, (2) a depressing of the panic button for a predetermined time period, (3) *a depressing of the panic button together with another button*, and

(4) *a codeword.*” *Id.* (citing Ex. 1001, 3:60–65) (emphases ours). Patent Owner asserts that activating the panic button once causes it to ready itself, and then providing the “special code word for activation” triggers the button to “send a signal to a controller inside the device to activate [the process of notifying authorities],” such that the user can prevent accidental triggering of the device. *Id.* (citing Ex. 1001, 7:55–59).

3. Discussion

Reviewing the intrinsic evidence for the ’404 patent, we do not find the file history for the ’404 patent helpful in determining what is meant by the “ready itself” feature of claim 1. During prosecution, claim 1 as issued was numbered claim 7, and the “ready itself” feature was added to the claim with no statement from the applicant or examiner to explain why the amendment was made. Ex. 1004, 80, 100, 122.

After review of the ’404 patent’s description, we find no disclosure that pressing the panic button together with another button causes the panic button to ready itself to perform functions (1) and (2) as recited in limitation 1[d]. The closest descriptions we find to limitation 1[d] are that the safety switch readies the panic button to contact 911 (Ex. 1001, 6:59–62), that the panic button may be activated by pressing the panic button with another button (*id.*, 3:59–67, and that the panic button may start a speech recognition process that can trigger the device (*id.*, 7:61–62).

Consequently, claim 1 is itself the best source for determining what the claim language means. We determine that the ordinary and customary meaning of the “ready itself” feature of claim 1 is that the panic button “prepares itself to be triggered to perform the panic button functions (1) and (2).”

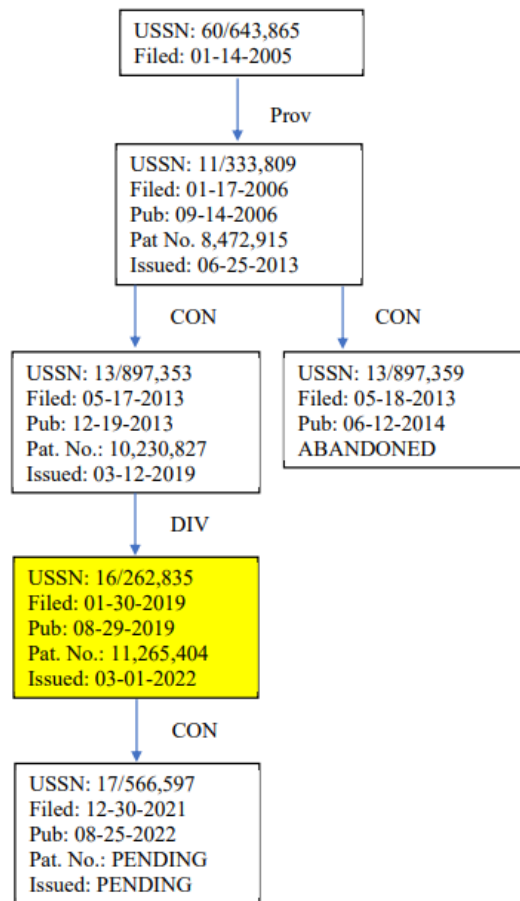
Since the intrinsic evidence is sufficiently clear to discern the meaning of the “ready itself” limitation, we do not resort to extrinsic evidence. *See Phillips*, 415 F.3d at 1317 (explaining that extrinsic evidence is less significant than intrinsic evidence); *Seabed Geosolutions (US) Inc. v. Magseis FF LLC*, 8 F.4th 1285, 1287 (Fed. Cir. 2021) (Court of Appeals gives primacy to intrinsic evidence and resorts to extrinsic evidence only if consistent with intrinsic evidence); *Sequoia Tech., LLC v. Dell, Inc.*, 66 F.4th 1317, 1324 (Fed. Cir. 2023) (Court of Appeals stating that its “decision rests solely on the intrinsic evidence”).

B. Priority Date for Claims 1–8 of the ’404 Patent

The ’404 patent was filed as U.S. Application No. 16/262,835 (“the ’835 application”) on January 30, 2019. Ex. 1001, codes (21), (22). The ’835 application is a division of U.S. Application No. 13/897,353 (“the ’353 application”), filed May 17, 2013. *Id.* at code (60). The ’353 application is a continuation of U.S. Application No. 11/333,809 (“the ’809 application”), filed January 17, 2006. *Id.* The ’809 application claims priority to U.S. Provisional Application No. 60/643,865 (“the ’865 provisional”), filed January 14, 2005. *Id.*

Petitioner provides the following illustration of the ’404 patent family:

'404 Patent Family Tree



Ex. 1032. Petitioner's illustration shows the '404 patent (yellow) and its relationship to other applications and patents in the '404 patent family, along with their filing, publication, and issuance dates.

1. *Petitioner's Contentions*

Petitioner contends that the challenged claims are not entitled to a priority date earlier than January 30, 2019. Pet. 1–2, 8–10; Pet. Reply 5–10.

Specifically, Petitioner notes that limitation 1[d] recites

a panic button, adapted to, when activated, ready itself to perform the following panic button functions: (1) dialing a public or private network for an emergency purpose and (2) activating the transmitting unit.

Pet. 9. Petitioner contends that the claimed “ready itself” in limitation 1[d] lacks written description support in the ’835 application (which issued as the ’404 patent) and the applications and provisional to which it claims priority (including the ’353 application discussed here). Pet. 1–2, 8–9.

Petitioner argues that “the ’353 application describes an embodiment in which the mobile device includes a ‘separate ‘safety’ switch which, upon being moved into position, readies the panic button to contact 911 upon being pressed”” but does not disclose any embodiment in which the panic button “readies itself” to perform any function. Pet. 9 (citing Ex. 1006, 5–6, 10, 13, 15; Ex. 1002 ¶ 53).

Petitioner asserts that Patent Owner has the burden to show that the challenged claims are supported by the ’353 application, which it has not done. Pet. Reply 5–6. Petitioner concedes that the ’353 application discloses “readying a panic button” but only by moving a safety switch or activating a voice activation unit, and thus does not disclose the full scope of limitation 1[d]. *Id.* at 6–9 (citing Ex. 1001, 3:59–64; *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000); *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997)). Petitioner further states that the ’353 application does not describe that activating the panic button starts a speech recognition process.² *Id.* at 8–9.

² During the trial hearing, Patent Owner’s counsel argued that claim 1 requires pressing the panic button together with another button to cause the panic button to ready itself by starting a speech recognition process to hear any codeword that the user has preset. Tr. 54:1–13. When the user says the codeword, the panic button performs the panic button functions of (1) dialing the public or private network and (2) activating the transmitting unit. *Id.*

Petitioner further argues that Patent Owner fails to acknowledge that limitation 1[d] requires the panic button, not the device, to “ready itself” and that the claim requires performance of two functions when Patent Owner mentions only one function (to contact 911). *Id.* at 9–10 (citing PO Resp. 7–8).

Petitioner thus argues that “a POSITA would not have understood the applicant to have been in possession of the invention claimed in claim 1 as of the priority date of the ’353 application” and that claim 1 is thus “not entitled to the priority date of the ’353 application.” Pet. 9–10 (citing Ex. 1002 ¶ 54); Pet. Reply 10.

2. *Patent Owner’s Contentions*

Patent Owner argues that the ’353 application provides written description support for readying a panic button. PO Resp. 6; PO Sur-Reply 1–3. According to Patent Owner, the ’353 application describes readying the panic button and safety device “in general.” PO Resp. 6 (citing Ex. 1006, 23). Patent Owner states that the ’353 application discloses a safety switch that readies the panic button to contact 911 (Ex. 1006, 23), and that “readying or activating a panic button or other components of the safety device, is a key feature repeatedly disclosed by the ’353 application.” *Id.* at 6–7 (citing Ex. 1006, 15, 17, 19–21, 23; Ex. 2001 ¶¶ 62, 64). Patent Owner argues that Petitioner’s expert declaration merely “parrots” Petitioner’s conclusory statements that the “ready itself” feature is not described in the ’353 application. *Id.* at 7 (citing Pet. 9; Ex. 1002 ¶ 53; Ex. 2001 ¶¶ 62–63).

In addition, Patent Owner argues that Petitioner “ignores disclosures in the ’353 application that specify the various methods by which the panic button ‘readies itself’ to perform the functions outlined in limitation 1[d].”

Id. at 7. Patent Owner states that, for example, the '404 patent discloses that the panic button starts a speech recognition process without immediately dialing 911 or activating the transmitter which triggers dialing of 911 upon recognition of the correct voice prompt, and thus discloses the “ready itself” feature of limitation 1[d]. *Id.* at 7–8 (citing Ex. 1006, 25; Ex. 2001 ¶ 64); PO Sur-Reply 1–3 (citing Ex. 1006, 15, 17–20, 24–25).

Accordingly, Patent Owner asserts that “the chain of priority is not broken” and “the challenged claims of the '404 patent are entitled to claim priority to the January 14, 2005 filing date of” the '865 provisional. PO Resp. 8; PO Sur-Reply 3.

3. Discussion

Petitioner bears the burden of persuasion regarding unpatentability throughout an *inter partes* review proceeding. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). Petitioner thus bears the initial burden to show that a reference is prior art, for example, by showing that the challenged patent's priority chain does not provide written description support under § 112(a). *Id.* at 1379. Once this is met, the burden of production then shifts to Patent Owner to show that the reference is not prior art, such as by proving entitlement to an earlier priority date. *Id.* at 1380.

“[E]ach application in the chain leading back to the earlier application must comply with the written description requirement of 35 U.S.C. § 112.” *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1571 (Fed. Cir. 1997). In other words, each application must “reasonably convey[] to those skilled in the art that the inventor had possession of the [later-claimed] subject matter as of the filing date.” *Parus Holdings, Inc. v. Google LLC*, 70 F.4th 1365,

1373 (citing *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc)).

On the full record, Petitioner has shown by a preponderance of the evidence that the '404 patent is not entitled to the '353 application's priority date. Pet. 8–10; Pet Reply 5–10. We begin our analysis by reviewing what the '353 application describes in relation to a panic button adapted to “ready itself” to perform certain functions.

The only mention of the word “readies” in a context similar to claim 1 is the following:

the panic button of the present invention can automatically contact 911 upon a press or series of presses of the button, or upon a codeword. There can also be a separate “safety” switch which, upon being moved into position, *readies the panic button to contact 911 upon being pressed.*

Ex. 1001, 6:57–62 (emphasis added). From this passage, we understand the “safety” switch to be “separate” from the panic button, not a part of it. This understanding is reinforced by claim 7 which depends from claim 1 and recites that the mobile device “further compris[es] a safety switch,” meaning it is a separate element from the panic button. Ex. 1001, 9:3–4.

Thus, the '353 application describes that moving the safety switch into position readies the panic button to contact 911, which is not the same as the panic button being activated to ready itself to perform functions (1) and (2) required by claim 1 of the '404 patent.

Patent Owner's reliance on disclosures elsewhere in the '353 application is unavailing. PO Resp. 5–8 (citing Ex. 1006, 15, 17, 19–21, 23, 25); PO Sur-Reply 2–3 (citing Ex. 1006, 15, 17, 19–20, 24–25)). For example, while the '353 application does mention voice activation with a codeword and activation by depressing of the panic button together with

another button (*see, e.g.*, Ex. 1006, 17, 21, 24–25), it does not mention that depressing the panic button together with another button causes the panic button to ready itself to perform recited functions (1) and (2). The application explains that “[t]he [panic] button can send a signal to a controller inside the device to activate [the code word activation] process” and “[t]he [panic] button can start the speech recognition process in one embodiment, to trigger the device.” Ex. 1006, 25. But that describes readying the *device* for activation by the code word, not readying the *button* to perform the recited functions. The ’353 application also mentions the word “ready” in relation to using a self-defense mechanism such as pepper spray, which does not appear to be related the readying of the panic button recited in claim 1. Ex. 1006, 15, 19–20.

Petitioner has thus met its burden to demonstrate that claims 1–8 of the ’404 patent lack written description support for a panic button adapted to “ready itself” to perform the recited functions because the limitation is not present in the ’353 application to which the ’404 patent claims priority.³ Pet. 8–10. The burden of production thus shifted to Patent Owner to demonstrate that the ’353 application has written description support for limitation 1[d], which it has not done on this record. PO Resp. 5–8; PO Sur-Reply 2–3.

³ We recognize that the ’835 and ’353 applications have identical disclosures, and that it thus logically follows that the ’835 application also lacks adequate written description support for claims 1–8. But in an *inter partes* review, we are only authorized to consider patentability arguments based on 35 U.S.C. §§ 102 and 103. *See* 35 U.S.C. § 311(b). Accordingly, we do not reach the separate issue of whether this lack of written description support renders claims 1–8 unpatentable under 35 U.S.C. § 112.

Accordingly, DiPerna964, having a publication date of September 14, 2006, more than one year before the '404 patent's filing date January 30, 2019, constitutes prior art under § 102(a)(1), as Petitioner contends. Pet. 1–2, 4, 8–10; Pet. Reply 5–10. In addition, Strack, having an issue date of October 29, 2019, and a filing date of July 26, 2016, which is before the '404 patent's filing date of January 30, 2019, constitutes prior art under § 102(a)(2), as Petitioner asserts. Pet. 4.

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

D. Level of Ordinary Skill in the Art

“The person of ordinary skill in the art is a hypothetical person who is presumed to know the relevant prior art.” *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (citing *Custom Accessories, Inc. v. Jeffrey–Allan Indus., Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986)). In determining the skill level, the Board may consider various factors including “the type of problems encountered in the prior art; prior art solutions to those problems;

rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.” *Id.* In a given case, every factor may not be present, and one or more factors may predominate. *Id.*

Petitioner contends as follows:

A person of ordinary skill in the art . . . at the time of the ’404 patent’s priority date—which, Petitioners contend for purposes of this Petition, is January 2019—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 2-3 years of experience in the field of telematics systems (e.g. familiarity with control and diagnostic systems, navigation systems and wireless communication technology). A greater amount of education, i.e. a doctorate in an academic area emphasizing electrical engineering, computer engineering, computer science, or a related technical field, would compensate for fewer years of work experience. The POSITA could have also obtained similar knowledge and experience through other means.

Pet. 6–7 (citing Ex. 1002 ¶ 15).

Patent Owner does not dispute Petitioner’s proposed level of skill in the art, which appears consistent with the educational level, technology, problems and solutions identified in the ’404 patent and 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 apply Petitioner’s proposed level in this Decision.

E. Obviousness over DiPerna964 and Strack

Having decided that DiPerna964 and Strack are prior art, and the meaning of the “ready itself” feature of claim 1, we now address Petitioner’s contention that claims 1–8 would have been obvious over the combination of

DiPerna964 and Strack. Pet. 10–22. Patent Owner provides no arguments against Petitioner’s contentions. Nonetheless, we decide that Petitioner has not shown by a preponderance of the evidence that claims 1–8 would have been obvious over the combination of DiPerna064 and Strack for the following reasons.

1. *DiPerna964 (Ex. 1028)*

With the exception of the claims and paragraph numbering, DiPerna964’s description is the same as the ’404 patent. *Compare* Ex. 1028 ¶¶ 1–51, Figs. 1A–2C, *with* Ex. 1001, 1:1–8:36, Figs. 1A–2C. *See* § I.D.

2. *Strack (Ex. 1029)*

Strack is titled “Method and System for Mobile Duress Alarm.” Ex. 1029, code (22) (emphasis and capitalization omitted). Strack discloses a mobile computing device 104 that includes a mobile application 102. *Id.* at 6:24–54, Fig. 1A. A user can press down one or more buttons of the device to trigger a potential security event. *Id.* at 7:2–4. The button press triggers the mobile application to enter an alarm state, which causes it to begin recording audio, video, and location information. *Id.* at 11:32–34. The mobile application may send an alert to a monitoring center 116 with event data including GPS location and streaming and/or recorded audio and video data. *Id.* at 11:34–37. The mobile application also initiates a telephone call from the mobile computing device 104 to an emergency telephone line of the monitoring center 116. *Id.* at 11:37–40.

Strack further discloses that a button or series of buttons may be used to place the mobile application in an armed state, which starts a duress timer. *Id.* at 2:51–60, 8:64–9:3. The duress timer begins counting down, and if it is not paused or stopped, the duress timer reaches zero and the armed stated of

the mobile application expires. *Id.* at 8:64–9:7, 13:16–18, Fig. 7. At this point, the mobile application enters an alarm state and performs the functions previously described. *Id.* at 11:32–47, 13:18–21, Fig. 7. Thus, a user may anticipate a potential security event by arming the mobile application, so even if the user becomes incapacitated during an emergency, the mobile application will contact the monitoring center when the duress timer expires. *Id.* at 6:55–65, 13:22–29, Fig. 7.

3. *Claim 1*

We now address Petitioner’s contentions for claim 1 and determine that it is only necessary to address limitations 1[d] and 1[e]. Because Petitioner has not met its burden to show by a preponderance of the evidence that the combination of DiPerna964 and Strack discloses or suggests limitation 1[d] in conjunction with limitation 1[e], we determine that claim 1 would not have been obvious.

Limitation 1[d]: Panic Button Readies Itself

Limitation 1[d] recites “a panic button, adapted to, when activated, ready itself to perform the following panic button functions: (1) dialing a public or private network for an emergency purpose and (2) activating the transmitting unit.”

Petitioner contends that DiPerna964 discloses a mobile device with a panic button that when activated activates the transmitting unit and contacts 911 in an emergency situation. Pet. 13–14 (citing Ex. 1028 ¶¶ 5, 7, 17, 23, 35–37, 41, 45).

Petitioner further contends that Strack discloses a mobile device with an application that starts a duress timer upon a user’s pressing one or more buttons, which causes the device to begin recording audio and video. *Id.* at

15 (citing Ex. 1029, 4:7–17, 6:27–33, 8:48–9:3, 9:24–28, 12:45–13:5, claims 1, 2; Ex. 1002 ¶¶ 74, 77–79). Petitioner asserts that, if the duress timer expires, indicating a potential security event exists, the mobile application enters an alarm state and transmits GPS data and streaming and recorded audio and video data to a monitoring center. Pet. 15 (citing Ex. 1029, 8:64–9:3, 11:34–47, 13:11–29, 11:34–47, 12:42–13:29; Ex. 1002 ¶¶ 81–82).

Limitation 1[e]: Activation of Panic Button by Depressing Panic Button with Another Button

Limitation 1[e] recites “wherein the panic button is activated by a depressing of the panic button together with another button at substantially the same initial time such that no panic button function is activated unless both buttons are depressed.”

For limitation 1[e], Petitioner contends that DiPerna964 discloses that “[t]he panic button may be activated by . . . a depressing of the panic button together with another button.” Pet. 18–19 (citing Ex. 1028 ¶¶ 24, 41, claim 9; Ex. 1002 ¶¶ 92–94).

Discussion

We have construed the “ready itself” feature of claim 1 to mean that the panic button “prepares itself to be triggered to perform the panic button functions (1) and (2).” See § II.C.3, *supra*.

DiPerna964 discloses a separate “safety” switch that readies the panic button to contact 911 upon being pressed (Ex. 1028 ¶ 41), but there is no mention of pressing the panic button together with another button to cause the panic button to “ready itself” to perform panic button functions (1) dialing a public or private network for an emergency purpose and

(2) activating the transmitting unit, as limitations 1[d] and 1[e] require. DiPerna964 mentions pressing two buttons together to activate the panic button (*see, e.g.*, Ex. 1028 ¶¶ 17, 23–25, 27), but not to “ready itself” to perform recited functions (1) and (2).

Petitioner relies on Strack’s triggering the collection of audio, video, and location data for transmission to a remote location as equivalent to a panic button readying itself to, when activated, perform the panic button functions (1) dialing a public or private network for an emergency purpose and (2) activating the transmitting unit. Pet. 15–17 (citing Ex. 1002 ¶¶ 76–88). We do not agree with Petitioner’s contention because Petitioner fails to explain how Strack’s button press that collects and then transmits audio, video, and location data would ready the panic button to perform recited functions (1) and (2). It appears that Strack’s button press readies the device, not the button, to perform the functions.

As neither DiPerna964 nor Strack nor their combination teach or suggest limitations 1[d] and 1[e], we determine it is unnecessary to proceed further with the obviousness analysis. *PAR Pharm., Inc. v. TWI Pharms., Inc.*, 773 F.3d 1186, 1194 (Fed. Cir. 2014) (citing *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1164 (Fed. Cir. 2006) (stating that we consider motivation to combine and reasonable expectation of success only “if all the elements of an invention are found in a combination of prior art references”)).

Accordingly, Petitioner has not demonstrated by a preponderance of the evidence that the combination of DiPerna964 and Strack teaches or suggests that the panic button is adapted to, when activated, “ready itself” to

perform panic button functions (1) and (2) by pressing the panic button together with another button, as limitations 1[d] and 1[e] require.

Although Patent Owner relied solely on its priority argument in its briefs, and did not argue against Petitioner's assertion of obviousness, Petitioner must nonetheless meet its burden to show obviousness by a preponderance of the evidence. *Fanduel, Inc. v. Interactive Games LLC*, 966 F.3d 1334, 1343 (Fed. Cir. 2020). We determine that Petitioner has not met this burden here.

4. Claims 2–8

Claims 2–8 depend from claim 1 and thus include all of its limitations, including limitations 1[d] and 1[e]. For the reasons stated for claim 1, we determine that claims 2–8 have not been shown by a preponderance of the evidence to be obvious.

III. CONCLUSION

After considering the evidence and arguments presented in the Petition, we determine that Petitioner has shown by a preponderance of the evidence that the '404 patent is not entitled to the priority date of the '353 application, and that DiPerna964 and Strack are thus prior art to the '404 patent under 35 U.S.C. §§ 102(a)(1) and 102(a)(2), respectively.

However, Petitioner has not established by a preponderance of the evidence that claims 1–8 would have been obvious under 35 U.S.C. § 103 over the combination of DiPerna964 and Strack for lack of a teaching or suggestion of a panic button that, when activated by pressing the panic button together with another button, readies itself to perform the recited panic button functions.

IV. ORDER

For the foregoing reasons, it is

ORDERED that, pursuant to 35 U.S.C. § 318(a), claims 1–8 of the '404 patent have not been shown to be unpatentable; and

FURTHER ORDERED that any party seeking judicial review must comply with the notice and service requirements of 37 C.F.R. § 90.2.

In summary:

Claim(s)	35 U.S.C. §	Reference(s)/Basis	Claim(s) Shown Unpatentable	Claim(s) Not shown Unpatentable
1–8	103	DiPerna964, Strack		1–8

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