

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

S.M.R. INNOVATIONS LTD and Y.M.R. TECH LTD,
Patent Owner.

IPR2024-01050
Patent 7,969,990 B2

Before STACEY G. WHITE, CHRISTOPHER L. OGDEN, and
MARY C. HOFFMAN, *Administrative Patent Judges*.

OGDEN, *Administrative Patent Judge*.

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

I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) under 35 U.S.C. §§ 311–319 requesting *inter partes* review of claims 1–3, 9, and 24 of U.S. Patent No. 7,969,990 B2 (Ex. 1001, “the ’990 patent”). S.M.R. Innovations LTD and Y.M.R. Tech LTD (collectively, “Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”). With our authorization, Petitioner also filed a Preliminary Reply. (Paper 7, “Prelim. Reply”).

Under the authority delegated to us by the Director of the U.S. Patent and Trademark Office under 37 C.F.R. § 42.4(a), we may only institute an *inter partes* review when “the information presented in the petition . . . and any 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.” 35 U.S.C. § 314(a); *see also* 37 C.F.R. § 42.108(c). Applying that standard, we do not institute an *inter partes* review, for the reasons explained below.

II. BACKGROUND

A. THE ’990 PATENT (EX. 1001)

The ’990 patent describes an “apparatus for rerouting data including multimedia data,” which “may be attached to any device having data processing capability.” Ex. 1001, code (57). An embodiment is illustrated in Figure 1, reproduced below:

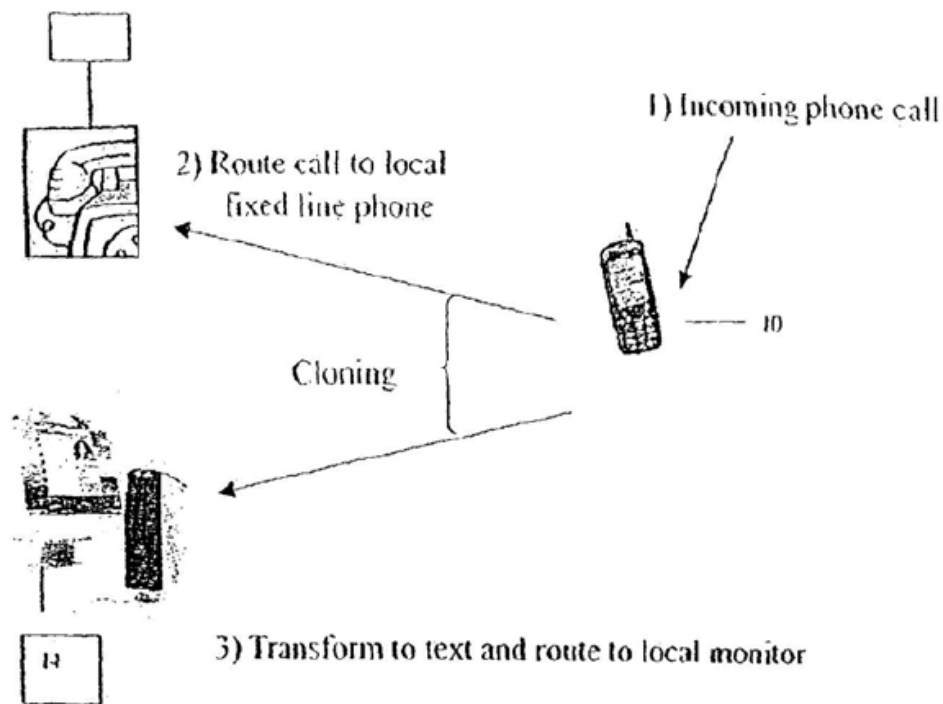


Fig. 1

Figure 1 “is a simplified schematic diagram showing a cellular telephone 10 in proximity to a fixed telephone 12 and a computer monitor 14.” Ex. 1001, 5:41–43. (The number label for telephone 12 is not visible in the figure.) “An incoming call is received at cellular telephone 10” (step 1) which “detects the presence of the other devices 12 and 14 and allows the user to retain the call at the cellular telephone 10 or alternatively to transfer it to either of the other devices 12 and 14” as audio on fixed telephone 12 (step 2) or as voice converted to text to be shown on computer monitor 14 (step 3), respectively. *Id.* at 5:45–57.

Figure 2 is reproduced below:

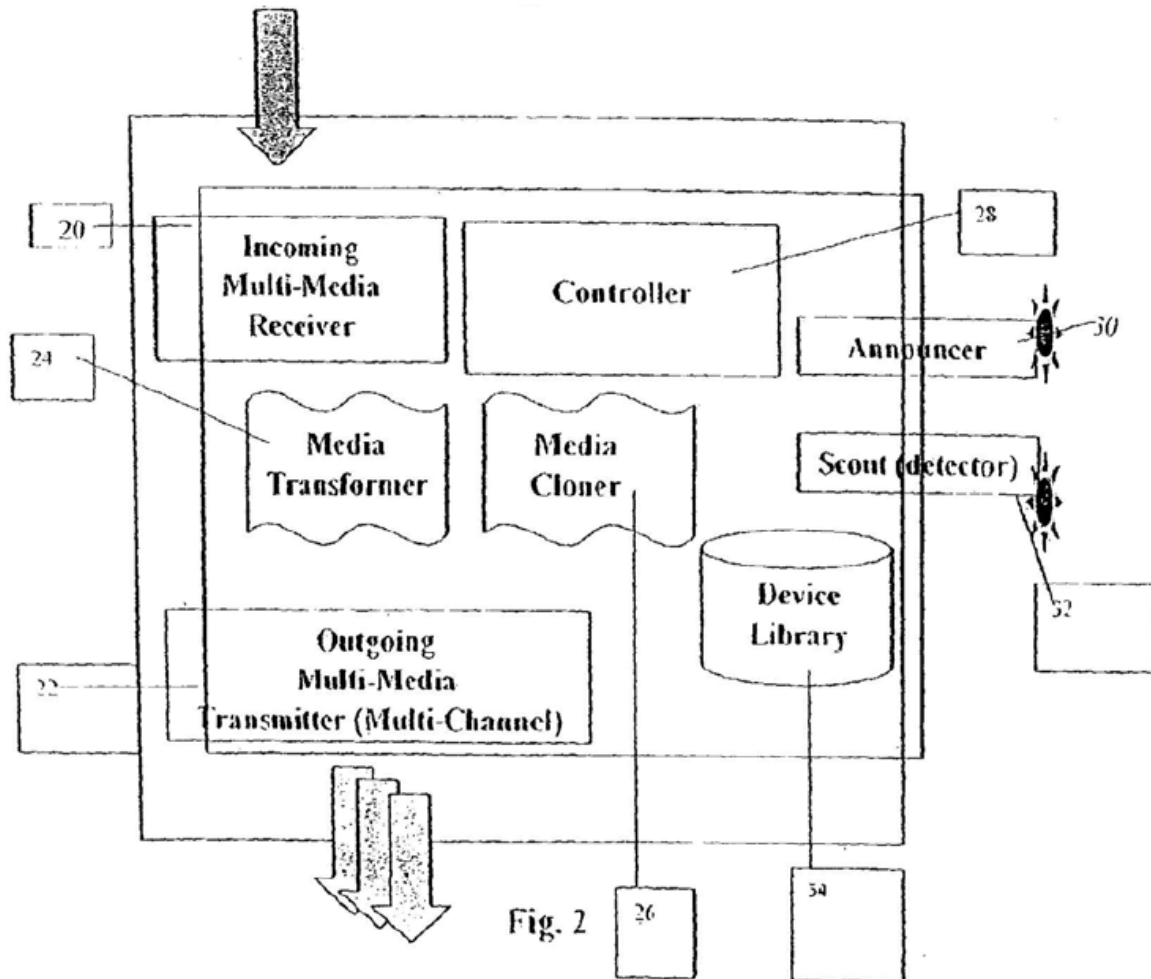


Figure 2 is a block diagram depicting a number of components, including “incoming multi-media receiver 20 which is responsible for capturing media content and passing it to one of the other components in the device.”

Ex. 1001, 6:22–24. “[O]utgoing multi-channel multi-media transmitter 22 . . . is responsible for transmitting (directly) media streams to external devices which are specified to it.” *Id.* at 6:26–29.

Other components include “media transformer 24,” which “is responsible for transforming its input (incoming media) into a required media type, or types, and outputting the resulting media stream(s), or

file(s).” *Id.* at 6:32–34. “Media cloner 26 is responsible for duplication of . . . input channel content, preferably received from the incoming multi-media receiver 20 . . . into as many output channels as indicated to it externally.” *Id.* at 6:45–48. “Controller 28 is responsible for managing all the other components and monitoring their activities.” *Id.* at 6:51–52.

Three other components are provided “to make decisions about selecting destinations and media types and in order to allow other devices to receive availability information.” Ex. 1001, 7:10–12. “[A]nnouncer device 30 is responsible for announcing to the environment the availability of a current device for accepting routed media.” *Id.* at 7:15–17. For example, during a call, a phone may announce to surrounding devices that it is unavailable for accepting routed media, and then announce its availability after the call is complete. *See id.* at 7:22–24, 7:21–24. “[S]cout device 32 is responsible for scanning the environment to find other devices therein and to determine their status, typically free or busy.” *Id.* at 7:50–52. Finally, “[d]evice library 34 contains information needed for communicating with various devices.” *Id.* at 7:56–57.

B. CHALLENGED CLAIMS AND GROUND

Representative claim 1 is as follows:

- [1Pre] 1. Apparatus for rerouting communication data,
comprising:
 - [1(a)] a mobile communication device comprising:
 - [1(a)(i)] an announcer device associated with said mobile
communication device, and configured for
indicating to surrounding equipment that said
mobile communication device is available to
receive rerouting, thereby to enable receipt of

rerouted data from said surrounding equipment,
and

[1(a)(ii)] a scout device associated with said mobile communication device, configured for scanning surroundings of said associated mobile communication device to identify and determine availability of compatible equipment in the vicinity, thereby to reroute data from said mobile communication device to a selected one of said surrounding equipment, wherein said rerouting comprises setting up a bidirectional communication link between said mobile communication device and said selected surrounding equipment, said bidirectional link having a first link direction from said mobile communication device to said selected surrounding equipment and a second link direction from said selected surrounding equipment to said mobile communication device, said bidirectional link carrying streaming data over both directions of said first link direction and said second link direction, and wherein said scout device is operable to determine media type requirements of said compatible equipment;

[1(a)(iii)] a media transformer, associated with said scout device, for transforming media into a form that accords with said determined media type requirements, wherein a plurality of types correspond to said media type requirements, and further comprising a user interface for allowing a user to select one of said media type requirements for transforming at said media transformer and

[1(a)(iv)] a media cloner, associated with said media transformer, for making multiple copies of a single incoming data stream, thereby to enable said apparatus to redirect said single incoming data

stream to a plurality of locations, at least some of said multiple copies being redirected via said media transformer.

Ex. 1001, 12:31–13:6 (Petitioner’s reference numbers added); *accord* Pet. 66–67. Claims 2, 3, 9, and 24 depend from claim 1. *See id.*, 13:7–14, 13:31–33, 14:51–52.

Petitioner argues a single ground for *inter partes* review, as summarized in the following table (*see* Pet. 7):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–3, 9, 24	103(a) (2006)	Chihara ¹ , BluetoothSpec ² , Everett, ³ Chang ⁴

C. DECLARATORY TESTIMONY

Petitioner submits a supporting declaration by Dr. Sayfe Kiaei.
Ex. 1003. Patent Owner does not submit declaratory testimony.

D. RELATED PROCEEDINGS

As a related matter, the parties identify *S.M.R. Innovations Ltd. v. Apple Inc.*, No. 6:23-cv-00479 (W.D. Tex. filed July 1, 2023), which was transferred to the Northern District of California on Nov. 14, 2024.⁵ Pet. 65;

¹ Chihara et al., US 2002/0068600 A1, published Jun. 6, 2002 (Ex. 1004).

² Bluetooth SIG, Inc., *Specification of the Bluetooth System Version 1.1* (Feb. 22, 2001) (Ex. 1005).

³ Everett, US 6,701,162 B1, issued Mar. 2, 2004 (Ex. 1006).

⁴ Chang et al., US 2002/0062406 A1, published May 23, 2002 (Ex. 1007).

⁵ To avoid duplication with the parallel district court proceeding, Patent Owner argues that we should deny institution discretionarily under *Apple*

Paper 4, 4; Ex. 1047 (amended order granting motion to transfer); Prelim. Reply 1.

III. ANALYSIS

A claim is unpatentable under § 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.” 35 U.S.C. § 103; *see KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). When a ground in a petition is based on a combination of references, we consider “whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

We base our obviousness inquiry on factual considerations 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 skill in the art, and (4) any objective indicia of obviousness or non-obviousness that may be in evidence.⁶ *See Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 17–18 (1996).

Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020). Prelim. Resp. 9–14. Because we deny institution on the merits, we need not address this argument.

⁶ At this preliminary stage, the parties have not presented evidence of objective indicia of obviousness or non-obviousness.

Considering the above principles, we determine that Petitioner has not shown a reasonable likelihood that any of the challenged claims would have been obvious over Chihara, BluetoothSpec, Everett, and Chang, for the reasons explained below.

A. LEVEL OF ORDINARY SKILL IN THE ART

The level of ordinary skill in the pertinent art at the time of the invention is a factor in how we construe patent claims. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc). It is also one of the factors we consider when determining whether a patent claim is obvious over the prior art. *See Graham*, 383 U.S. at 17–18.

To assess the level of ordinary skill, we construct a hypothetical “person of ordinary skill in the art,” from whose vantage point we assess obviousness and claim interpretation. *See In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). This legal construct “presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan.” *Id.* (citing *In re Carlson*, 983 F.2d 1032, 1038 (Fed. Cir. 1993)).

Petitioner argues that a person of ordinary skill in the art would have had “a master’s degree in computer engineering, electrical engineering, or a related field, with at least 2 years of experience with wireless communications. Additional education or experience might substitute for the above requirements.” Pet. 3 (citing Ex. 1003 ¶¶ 29–31).

Patent owner contends that a person of ordinary skill “would have had a Bachelor’s degree in Computer Science, Computer Engineering, Electrical Engineering, or a related field in computing technology, and at least two years’ experience in wireless communication and mobile devices including

multimedia streaming, or equivalent education, research, experience, and knowledge.” Prelim. Resp. 2–3. In other words, Patent Owner argues that the person of ordinary skill would have had less education and more specific experience with mobile devices, including multimedia streaming, than Petitioner proposes.

Because Petitioner’s argument is supported by declaratory testimony, and Patent Owner does not provide supporting evidence for its argument, we adopt Petitioner’s articulation of the level of ordinary skill in the art. *See* Ex. 1003, ¶ 29 (citing Ex. 1001, 1:16–20, 4:18–55, 11:61–12:11).

B. CLAIM CONSTRUCTION

In an *inter partes* review, we construe a patent claim “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b).” 37 C.F.R. § 42.100(b). This generally 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.” *Id.* The ordinary and customary meaning of a claim term “is its meaning to the ordinary artisan after reading the entire patent,” and “as of the effective filing date of the patent application.” *Phillips*, 415 F.3d at 1313, 1321.

There are only two circumstances in which a construction departs from the ordinary and customary meaning: “1) when a patentee sets out a definition and acts as [their] own lexicographer, or 2) when the patentee disavows the full scope of a claim term either in the specification or during prosecution.” *Thorner v. Sony Comput. Entm’t Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012). Any such special meaning of a term “must be

sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.” *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998).

To construe the claim terms, “we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006).

For this decision, we need only provide an express construction for one phrase. Limitation 1(a)(i) recites a mobile communication device comprising “an announcer device associated with said mobile communication device, and configured for indicating to surrounding equipment that said mobile communication device is available to receive rerouting, thereby to enable receipt of rerouted data from said surrounding equipment.” Ex. 1001, 12:33–39. In this decision, we refer to this as the “announcer device” limitation.

Petitioner argues that, by its plain language, the “announcer device” limitation means that the recited “mobile communication device is receiving rerouted data *from* surrounding equipment, rather than rerouting data *to* surrounding equipment.” Pet. 19. Nevertheless, Petitioner argues that we should interpret the limitation the way that Patent Owner allegedly argued in the parallel district court proceeding. Pet. 19–21. In that proceeding, according to Petitioner, “Patent Owner has repeatedly and consistently interpreted [limitations in claim 1] to capture a single scenario in which a

mobile device reroutes data *to* surrounding equipment.” Pet. 19 (citing Ex. 1043, Ex. G at 49–53; Ex. 1045, 1–11; Ex. 1046, 96–106).⁷

Patent Owner challenges Petitioner’s proposed interpretation of the “announcer device” limitation, and contends that it never argued for this in the parallel district court litigation. Prelim. Resp. 3–6. Rather, Patent Owner contends that its position in the parallel proceeding is that the limitation “should be given its plain meaning (consistent with its position here).” *Id.* at 5 (citing Ex. 2008).

Although Petitioner doesn’t promote it in its Petition, we agree with Petitioner’s undisputed contention that the ordinary and customary meaning of the “announcer device” limitation is that the “mobile communication device is receiving rerouted data *from* surrounding equipment, rather than rerouting data *to* surrounding equipment.” Pet. 19. This is in accord with the specification of the ’990 patent which states that “[t]he announcer device 30 is responsible for announcing to the environment the availability of a current device *for accepting routed media*.” Ex. 1001, 7:15–17 (emphasis added). The construction that Petitioner *does* promote, based on its interpretation of Patent Owner’s arguments in the parallel litigation, departs from the term’s ordinary meaning, yet Petitioner has presented no evidence to justify such a

⁷ Petitioner also argues that we should construe the term *media transformer* as a means-plus-function limitation invoking 35 U.S.C. § 112(f). Pet. 7–11. We need not construe this term to reach our decision not to institute trial in this proceeding. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

departure. For example, Petitioner has not shown that the patent applicant has plainly acted as lexicographer for the term, or has plainly disavowed the full scope of the term. *See Thorner v. Sony*, 669 F.3d at 1365; *Multiform Desiccants v. Medzam*, 133 F.3d at 1477. We are aware of no evidentiary basis for Petitioner’s proposed construction in the specification or prosecution history of the ’990 patent.

To the extent, if any, that Patent Owner may have argued in the parallel district court proceeding for a departure from the term’s ordinary meaning, we find no clear disavowal of the term’s scope, particularly in light of Patent Owner’s ultimate argument that the term should have its “[p]lain meaning.” Ex. 2008, 2.

C. OVERVIEW OF CHIHARA

Petitioner’s challenge relies primarily on *Chihara*, which describes a method of routing a data stream over a local wireless network from a mobile device to compatible devices such as a headset and a watch. Ex. 1004, code (57), ¶¶ 1, 78–81, 109–118, Figs. 7, 9, 13. An embodiment is shown in Figure 7, reproduced below:

FIG. 7

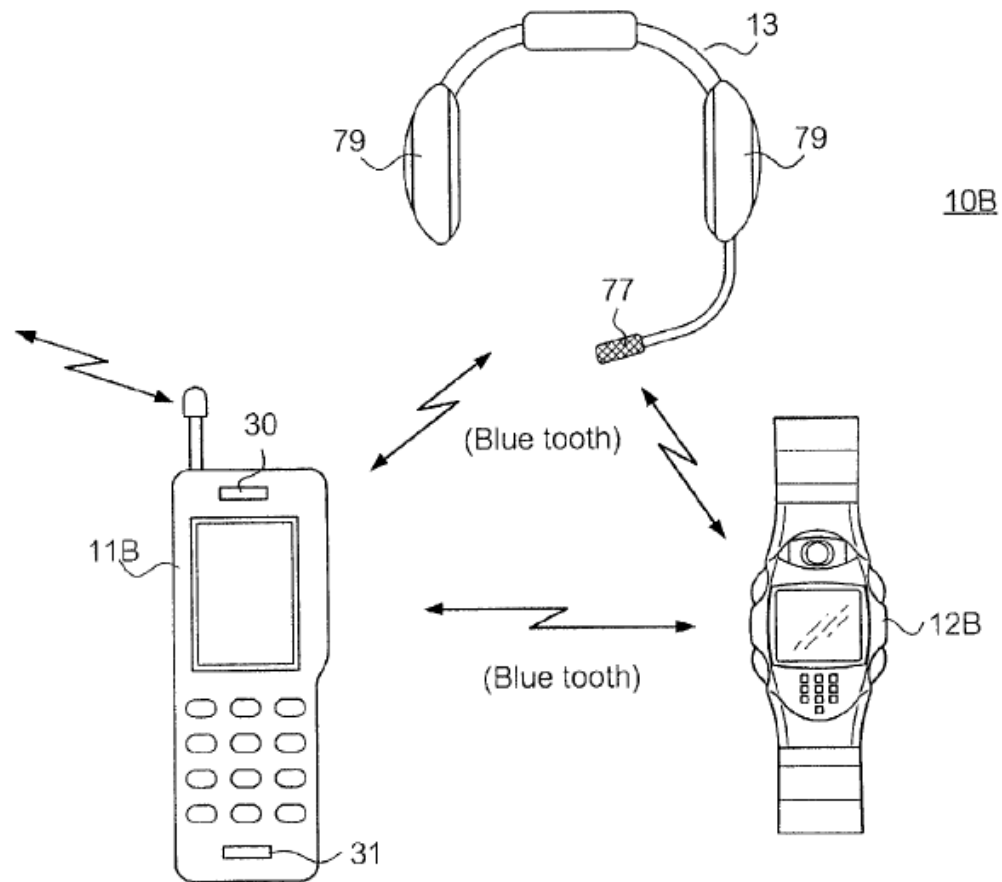


Figure 7 depicts “a mobile videophone system 10B . . . compris[ing] a mobile telephone device 11B, a wrist watch-type information apparatus 12B and a headset 13.” Ex. 1004 ¶ 78. Watch 12B and headset 13 communicate bidirectionally with phone 11B, from which they receive streamed video or music. *Id.* ¶ 79. Phone 11B contains Bluetooth module 35, which establishes communication links with watch 12B and headset 13. *Id.* ¶ 81. In one embodiment, phone 11B acts as a “master” device while watch 12B and headset 13 act as “slave” devices. *Id.* ¶ 101.

D. OVERVIEW OF BLUETOOTHSPEC

BluetoothSpec is a technical specification describing various features of Bluetooth, including the format of its channels and packets, how available

Bluetooth services are discovered, and how clients and servers interact. *See* Ex. 1005, 41–47, 335, 338, 371, 515–18.

E. “ANNOUNCER DEVICE” LIMITATION

As discussed above, the “announcer device” limitation recites “an announcer device associated with said mobile communication device, and configured for indicating to surrounding equipment that said mobile communication device is available to receive rerouting, thereby to enable receipt of rerouted data from said surrounding equipment.” Ex. 1001, 12:34–39; *see supra* Section III.B.

Based on Petitioner’s incorrect interpretation of the “announcer device” limitation, Petitioner argues that Chihara “teaches a mobile videophone system that reroutes data (e.g., phone call audio) received at mobile telephone device 11B to headset 13 and wrist watch-type apparatus 12B.” Pet. 21. According to Petitioner, Chihara “teaches bidirectional communication” between phone 11B and headset 13 or watch 12, such that a person of ordinary skill in the art “would have understood that the mobile telephone would have been enabled to receive rerouted data from the headset and wrist watch-type apparatus (*‘surrounding equipment’*) and vice versa.” Pet. 21 (citing Ex. 1003 ¶ 104–111). Petitioner argues that this is because phone 11B operates as the “master” device in the local wireless network, and as such, phone 11B’s “Bluetooth module . . . (controlled by a microprocessor and configured to transmit an ID packet) . . . would have functioned as an ‘*announcer device*’ to indicate availability of mobile telephone 11B.” Pet. 22 (citing Ex. 1003 ¶ 105); *see also* Pet. 22–25 (arguing that Chihara teaches

that phone 11B would pair itself with available surrounding devices within its scanning range).

Petitioner contends that Chihara “does not describe the low-level Bluetooth protocol details implicated when mobile telephone device 11B uses its Bluetooth module . . . to indicate to surrounding equipment (e.g., headset 13, wrist watch-type apparatus 12B) that said mobile telephone device is available to receive rerouting.” Pet. 25. But according to Petitioner, the BluetoothSpec reference provides those details. *Id.*

For example, Petitioner argues that a person of ordinary skill in the art would have understood that Bluetooth module 35 in Chihara’s phone 11B transmits an ID packet including a code that “would have indicated to surrounding equipment that the mobile device is available to receive rerouting.” Pet. 27 (citing Ex. 1003 ¶ 115–116). “For example, such signaling indicates that the mobile device is powered on and transmitting signals to discover nearby “slave” devices (e.g., headset, wrist watch type information apparatus), which are used for rerouting (e.g., phone call).” Pet. *Id.* (citing Ex. 1003 ¶ 116).

In response, Patent Owner argues that Chihara and the other references fail to teach the “announcer device” limitation if that limitation is interpreted according to its plain meaning. Prelim. Resp. 6–8. According to Patent Owner, “Petitioner’s assertion that Chihara’s mobile device is able to receive data from a headset is not the same thing as the mobile device having an announcer device *configured to indicate to the headset* that the mobile device is available to receive rerouting.” *Id.* at 7. “Moreover, any data the mobile device received from the headset or the wristwatch would

not be rerouted data. It would be data that *originated* at the headset or wristwatch.” *Id.*

In light of our disagreement with Petitioner’s proposed claim-construction, we do not find persuasive Petitioner’s argument that Chihara teaches the “announcer limitation,” either alone or in light of BluetoothSpec. Although Petitioner shows that Chihara’s phone 11B announces its availability for pairing with nearby Bluetooth-compatible devices, Petitioner does not argue that phone 11B indicates availability to *receive* any rerouted data from either headset 13 or watch 12B. To the extent that phone 11B receives data for rerouting, it appears to receive it from a mobile or fixed communication network, not from any surrounding Bluetooth devices. *See, e.g.,* Ex. 1004 ¶¶ 79 (phone 11B receives video and audio data via “a fixed telephone network or another mobile telephone set accommodated in a mobile communication network,” and transmits that streaming data to watch 12B and headset 13), 53–54 (calls arrive via mobile telephone antenna 26, which are then processed and transmitted via Bluetooth antenna 21 to watch 12). Regarding the bidirectional communication between phone 11B and headset 13 or watch 12B, Petitioner has not pointed to any evidence that the data sent from watch 12B or headset 13 to phone 11B includes *rerouted* data. Similarly, Petitioner’s contention that Chihara’s phone 11B, in light of BluetoothSpec, indicates its availability (e.g., that the phone is “powered on” and transmits signals to discover nearby devices) fails to meet the plain language of claim 1, which requires the streaming device (phone 11B) to indicate its availability *to receive rerouted data* from the surrounding devices (headset 13 or watch 12B).

Thus, we determine that Petitioner has failed to show that Chihara, in view of BluetoothSpec and the other references, teaches the “announcer device” limitation. Therefore, Petitioner has not shown that it would be likely to prevail if we instituted an *inter partes* review.

IV. CONCLUSION

For the reasons above, Petitioner has not shown that there is a reasonable likelihood it would prevail in showing that at least one challenged claim of the '990 patent is unpatentable. Therefore, we deny the Petition.

V. ORDER

It is

ORDERED that the Petition is *denied*, and no trial is instituted.

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