

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CBS INTERACTIVE INC., THE NEW YORK TIMES COMPANY,  
G4 MEDIA, LLC, and BRAVO MEDIA LLC  
Petitioner

v.

HELFERICH PATENT LICENSING, LLC and  
WIRELESS SCIENCE, LLC  
Exclusive Licensee and Patent Owner

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Case IPR2013-00033  
Patent 7,155,241

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Before JAMESON LEE, KEVIN F. TURNER, and JONI Y. CHANG,  
*Administrative Patent Judges.*

CHANG, *Administrative Patent Judge.*

FINAL WRITTEN DECISION  
*35 U.S.C. § 318(a) and 37 C.F.R. § 42.73*

## I. INTRODUCTION

CBS Interactive Inc., the New York Times Company, G4 Media, LLC, and Bravo Media LLC (collectively, “CBS”) filed a petition on October 25, 2012, requesting an *inter partes* review of the challenged claims of U.S. Patent No. 7,155,241 (“the ’241 patent”).<sup>1</sup> Paper 1 (“Pet.”). Helderich Patent Licensing, LLC and Wireless Science, LLC (collectively “HPL”) filed a patent owner preliminary response. Paper 20. Taking into account the patent owner preliminary response, the Board determined that the information presented in the petition demonstrated that there was a reasonable likelihood that CBS would prevail with respect to at least one challenged claim. Pursuant to 35 U.S.C. § 314, the Board instituted this trial on March 25, 2013, as to claims 1, 3-5, 11, 13, 15, 16, 18, 20, 21, 23, 24, 26, 28, 29, 41, 43-45, 51, 53-56, 58, 60, 61, 71, 73-75, 81, 82, 84, 86, 87, 89, 91, 92, and 94 of the ’241 patent. Paper 21 (“Dec.”).

After institution, HPL filed a patent owner response<sup>2</sup> (Paper 55, “PO Resp.”), and then a motion to withdraw (Paper 72) the arguments set forth in Section D (“Secondary Indicia of Nonobviousness of the ’241 Patent”) of the patent owner response (Paper 55, 49-57), which was granted

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<sup>1</sup> The Board terminated this proceeding with respect to Phoenix Newspaper, Inc., one of the real parties-in-interest who filed the petition. Paper 60.

<sup>2</sup> HPL filed an initial patent owner response (Paper 47) and then a revised patent owner response (Paper 55). This decision refers to the revised patent owner response (Paper 55) as the patent owner response, unless otherwise stated.

(Paper 77). CBS filed a reply to the patent owner response (Paper 74, “Pet. Reply”).

HPL also filed a motion to amend claims (Paper 48, “Mot. A.”); CBS filed an opposition (Paper 75, “Opp.”) to HPL’s motion to amend claims; and HPL then filed a reply (Paper 89, “PO Reply”) to CBS’s opposition. Oral hearing was held on October 23, 2013.<sup>3</sup>

This final written decision is entered pursuant to 35 U.S.C. § 318(a). We have jurisdiction under 35 U.S.C. § 6(c).

We hold that claims 1, 3-5, 11, 13, 15, 16, 18, 20, 21, 23, 24, 26, 28, 29, 41, 43-45, 51, 53-56, 58, 60, 61, 71, 73-75, 81, 82, 84, 86, 87, 89, 91, 92, and 94 of the ’241 patent are unpatentable under 35 U.S.C. § 103(a). HPL’s motion to amend claims is *denied*.

#### A. *Related Proceeding*

CBS indicates that the ’241 patent is involved in the following proceedings: *Helperich Patent Licensing, LLC v. Suns Legacy Partners LLC*, Case No. 2:11CV2304 (D. Ariz.); *Helperich Patent Licensing, LLC v. Bravo Media, LLC*, Case No. 1:11CV7647 (N.D. Ill.); *Helperich Patent Licensing, LLC v. CBS Corporation*, Case No. 1:11CV7607 (N.D. Ill.); and *Inter Partes* Reexamination Control No. 95/001,864. Pet. 2.

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<sup>3</sup> A transcript of the oral hearing is included in the record as Paper 121.

*B. The '241 Patent*

The '241 patent relates to a system for selective paging. Ex. 1001, 3:6-37. Specifically, the '241 patent discloses a paging system that notifies the user that a message has been received at a server on the network, but without sending the entire message to the user's mobile device. Ex. 1001, 3:6-37. The paging system allows the user to determine the priority of the message and whether the user wants to retrieve, play, erase, store, forward, or reply to the message at a convenient time, such as downloading the entire message, at less expensive off-peak hours, from the server to the user's mobile device. *Id.* Figure 2 of the '241 patent, reproduced below, illustrates a paging transceiver:

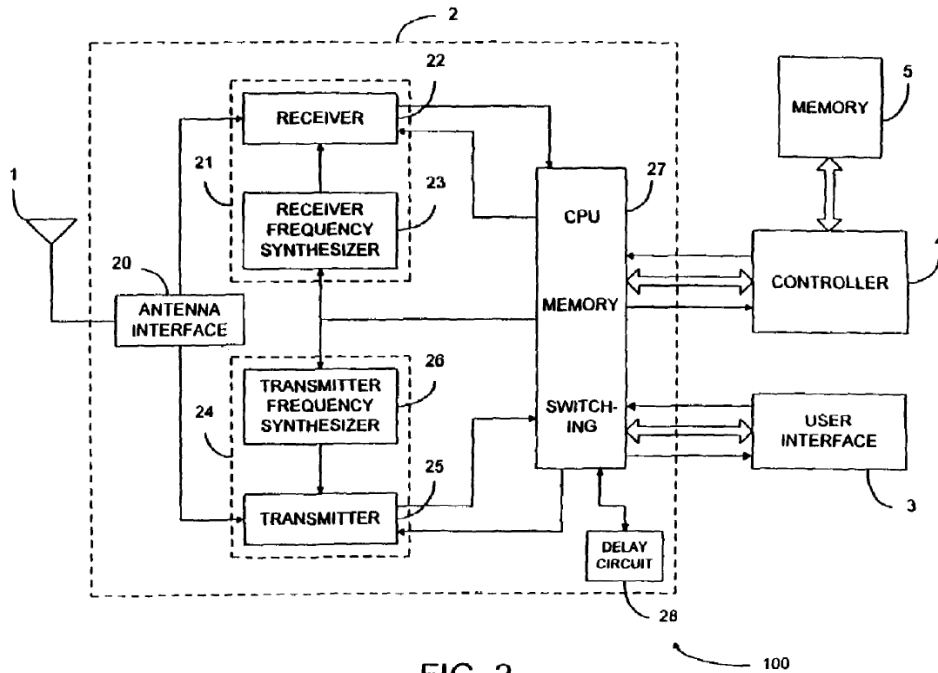


FIG. 2

As shown in Figure 2 of the '241 patent, paging transceiver 100 comprises antenna 1, transceiver 2, user interface 3, controller 4, and

memory 5. *Id.* at 4:4-47. Transceiver 2 includes antenna interface 20 that directs signals received from antenna 1 to receiver section 21 and directs signals transmitted from transmit section 24 to antenna 1. *Id.* at 5:18-30. CPU 27 performs the function selected by the user, such as retrieving the entire message from the network. *Id.* at 13:5-11; Step 133 of Fig. 9.

Figure 3 of the '241 patent, reproduced below, depicts a block diagram of a communication system:

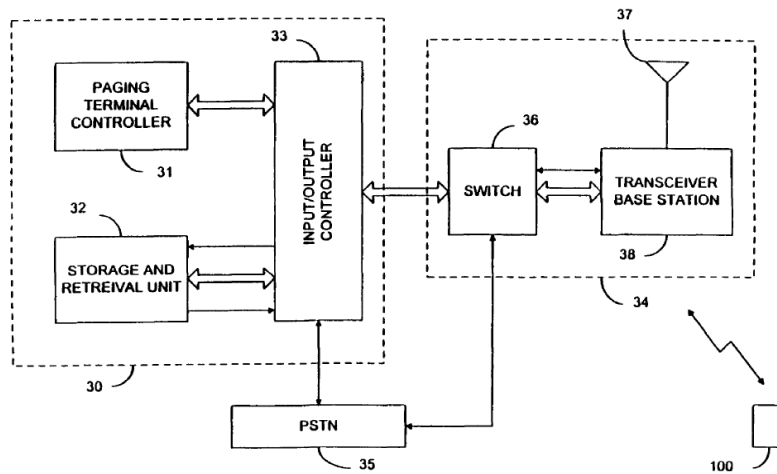


FIG. 3

Figure 3 of the '241 patent illustrates that system 30 and base station 34 are interconnected to each other, and both are connected to Public Switched Telephone Network (PSTN) 35. *Id.* at 6:17-21. Base station 34 comprises switch 36, transceiver antenna 37, and transceiver base station 38. To notify paging transceiver 100 that an unread message is waiting, paging terminal controller 31 sorts through subscriber listings that have a corresponding unread and un-notified message in storage and retrieval unit 32, and sends a page request to base station 34. *Id.* at 8:58-63. Switch 36 checks a home

location registry (HLR) to determine the registered location and status of remote paging transceiver 100, and then a page call is processed by transmitting selective call signals from transceiver base station 38 to paging transceiver 100. *Id.* at 8:63-67. If a page acknowledgment is desired for verification that paging transceiver 100 received the selective call signals, an ACK signal is transmitted manually or automatically from paging transceiver 100 to base station 34 for storage in the subscriber database of paging terminal controller 31. If the user selects a message to be forwarded, system 30 determines whether the message resides in the system, and then performs the required function. *Id.* at 12:22-33.

### *C. Illustrative Claim*

Of the challenged claims, claims 1, 41, and 71 are independent claims. Claims 3-5, 11, 13, 15, 16, 18, 20, 21, 23, 24, 26, 28, and 29 depend from claim 1; claims 43-45, 51, 53-56, 58, 60, and 61 depend from claim 41; and claims 73-75, 81, 82, 84, 86, 87, 89, 91, 92, and 94 depend from claim 71.

Claim 1, reproduced below, is illustrative (emphases added):

1. A system, comprising:

a storage unit that stores information for transmission to one or more devices;

*means for transmitting* to the one or more devices a selective call signal comprising an *information identifier identifying the information* and an acknowledgment request, wherein the information is not included in the selective call signal;

*means for receiving* a request transmitted from any one of the one or more devices, wherein the request is transmitted

via a two-way communication session with the system and *the request identifies the information and an action to be performed on the information*; and  
*means for performing the action.*

#### *D. Prior Art Relied Upon*

In its petition, CBS relies upon the following prior art references:

Smith	U.S. Patent 6,333,973	Dec. 25, 2001	(Ex. 1006)
Alanara	U.S. Patent 5,878,351	Mar. 2, 1999	(Ex. 1007)
Kane	U.S. Patent 5,487,100	Jan. 23, 1996	(Ex. 1008)

#### *E. Grounds of Unpatentability*

The Board instituted the instant trial based on the following grounds of unpatentability:

<b>Claims</b>	<b>Basis</b>	<b>References</b>
1, 3-5, 11, 13, 15, 16, 18, 20, 21, 23, 24, 26, 28, 29, 41, 43-45, 51, 53-56, 58, 60, and 61	§ 103(a)	Smith and Alanara
71, 73-75, 81, 82, 84, 86, 87, 89, 91, 92, and 94	§ 103(a)	Smith, Alanara, and Kane

## II. ANALYSIS

### *A. Claim Construction*

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b). Under the broadest reasonable construction standard, claim terms are given their ordinary and

customary meaning as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech. Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). An inventor may rebut that presumption by providing a definition of the term in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). In the absence of such a definition, limitations are not to be read from the specification into the claims. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

*“information identifier identifying the information”  
and “message identifier identifying the message”*

In its petition, CBS did not proffer a construction for each of the “identifying” claim terms: “information identifier identifying the information” and “message identifier identifying the message.”

HPL also did not submit a construction for any of those “identifying” claim terms in its patent owner preliminary response. However, HPL, in its patent owner response, argues that the Board’s construction set forth in the Decision on Institution (Dec. 12-13) for the claim term “information identifier identifying the information”—“descriptive material about the information”—is unreasonable, because it includes “descriptive material,” and proposes a construction for each of the “identifying” claim terms. PO Resp. 17-32. On the other hand, CBS agrees with the Board’s construction and urges the Board not to “interpret the claim terms narrowly by reading Figure 11 of the ’241 patent and extrinsic evidence” into the claims, as proposed by HPL. Pet. Reply 8.



Upon review of the parties' arguments and the evidence before us, including the specification and claims of the '241 patent, we have reevaluated our claim construction set forth in the Decision on Institution, and decided that it is necessary to construe both "identifying" claim terms. For this decision, in light of the claims and specification, we construe the claim term an "information identifier for identifying the information" broadly, but reasonably, as "data that identify the remotely stored information, facilitating the process of locating and retrieving the remotely stored information." Similarly, we construe the claim term a "message identifier for identifying the message" as "data that identify the remotely stored message, facilitating the process of locating and retrieving the remotely stored message."

As discussed below, we decline to adopt HPL's proposed claim constructions for the "identifying" claim terms, as they would import improperly limitations from extrinsic evidence and negative limitations from a preferred embodiment disclosed in the specification into the claims. *See, e.g., Superguide Corp. v. DirectTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004) ("Though understanding the claim language may be aided by the explanations contained in the written description, it is important not to import into a claim limitations that are not a part of the claim.")

We begin our claim construction analysis with the claims. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) ("It is a bedrock principle of patent law that the claims of a patent define the invention to which the patentee is entitled the right to exclude.") (citations and quotations

omitted)). Although some of the dependent claims are not involved in the instant proceeding, we review the claim features including those in dependent claims, as dependent claims further define the claim features in the involved independent claims. *Id.* at 1314 (“Because claim terms are normally used consistently throughout the patent, the usage of a term in one claim can often illuminate the meaning of the same term in other claims.”).

The claim term an “information identifier identifying the information” is recited in independent claims 1 and 71. For instance, claim 1 recites “a storage unit that *stores information* for transmission to one or more devices; means for transmitting to the one or more devices a selective call signal comprising *an information identifier identifying the information* and an acknowledgment request, wherein the information is not included in the selective call signal.” The claim term a “message identifier identifying the information” is recited in independent claim 41 and several dependent claims. In particular, claim 41 recites “*storing a message* intended for the transmitting and receiving device; transmitting to the transmitting and receiving device a selective call signal comprising an acknowledgment request and a *message identifier identifying the message*, wherein the message is not included in the selective call signal.” Claim 53, which depends from claim 41, recites “wherein the *message identifier comprises a code* that identifies the information stored in the storage unit.” Claim 54, which depends from claim 53, recites “wherein the code is a unique code.” Claim 55, which depends from claim 54, recites “wherein the code is a number.” Claim 63, which depends from claim 41, recites “wherein the

information identifier specifies an address of the information stored in the storage unit.”

At the outset, based on our review of the claim language, we observe that the claim terms “information,” “message,” “information identifier,” and “message identifier” are used loosely with considerable overlap, having boundaries that are not well-defined. For example, claim 53, which depends from claim 41, recites “*message identifier* comprises a code that identifies *the information* stored in the storage unit.” Claim 41, however, recites “storing *a message* intended for the transmitting and receiving device,” and not “an information.” It is unclear what *information* dependent claim 53 is referring to, as a message and selective call signal each include information. *See also* claims 47-48, 61. As another example, claims 63 and 64, which depend from claim 41, recite “*the information* identifier” and “*said information* identifier.” But Claim 41 recites “a *message* identifier identifying the *message*” and not “an *information* identifier.”

Our claim construction for each “identifying” term is consistent with the claims and specification of the ’241 patent. In the context of the claims, the claim term an “information identifier identifying the information” has the function of identifying the remotely stored information, and facilitating the process of locating and retrieving the remotely stored information. *See, e.g.*, claim 1 (“means for performing an action on the stored information for transmission to one or more devices”); Ex. 1001, 3:34-37 (“The user can . . . retrieve the message, play the message, erase the message, store the message, . . .”). And the claim term a “message identifier identifying the

message” has the function of identifying the remotely stored message, and facilitating the process of locating and retrieving the remotely stored message. *See, e.g.*, Ex. 1001, 3:7-10 (“A paging system notifies a [mobile] paging transceiver that a message has been received [at the server] but does not initially transmit the associated message [to the mobile paging transceiver]. The user, upon being notified of the message, can then download the entire message [from the server to the mobile page transceiver].”); *id.* at 10:29-54; Fig. 8. Further, an information identifier or message identifier may comprise a code (*see, e.g.*, claims 13 and 53), unique code (*see, e.g.*, claim 54), or number (*see, e.g.*, claims 15 and 55). The information identifier may specify an address of the stored information (*see, e.g.*, claims 63 and 94).

In addition, the specification of the ’241 patent describes:

As discussed above, the message may be identified in a number of ways, such as with a message code or by specifying the location in memory where the message is stored. The call to the system 30 would automatically provide the transceiver identification information to the system 30, although the paging transceiver 100 could provide this information with the other information provided to the system 30.

Ex. 1001, 18:56-67. In light of the specification, we observe that the remotely stored message or information may be identified in a number of ways.

Turning to HPL’s proposed claim constructions, HPL asserts that the broadest reasonable interpretation of the claim term “message identifier identifying the message” is “a label, symbol, or token that establishes the

identity of the message that is stored in the system, such as a code or the message's address in the system.” PO Resp. 17. HPL also contends that the broadest reasonable interpretation of the claim term “information identifier identifying the information” should be “a label, symbol, or token that establishes the identity of the information that is stored in the system, such as a code or the information's address in the system.” PO Resp. 32. HPL asserts that the claim term “information identifier” corresponds to the claim term “message identifier.” PO Resp. 25 (citing Ex. 2056 ¶ 169). According to HPL, “the difference is whether the remotely stored data (not included in the selective call signal) is a ‘message’ or is ‘information.’” *Id.* In support of its position, HPL proffers the declarations of Dr. John R. Grindon and Dr. Bobby R. Hunt. PO Resp. 17-22 (citing Ex. 2056 ¶¶ 139-147; Ex. 2054 ¶¶ 21-24, 37, 39, 40, 50, and 61-64).

Upon consideration of HPL's proposed claim constructions, arguments, and supporting evidence, we decline to adopt HPL's proposed claim constructions as the broadest reasonable interpretations. First, HPL and its expert testimony do not provide a meaningful explanation of what *establishing the identity* of the information or message means. PO Resp. 17-20; Exs. 2052, 2054, 2056. They also fail to point out where the specification discloses *establishing the identity* of the information or message. Based on our review of the specification, it is unclear to us what is *establishing an identity*. It is well settled that if a feature is not necessary to give meaning to what the inventor means by a claim term, it would be “extraneous” and should not be read into the claim. *Renishaw PLC v.*

*Marposs Societa' per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998); *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1433 (Fed. Cir. 1988). In that regard, “extrinsic evidence may be used only to assist in the proper understanding of the disputed limitation; it may not be used to vary, contradict, expand, or limit the claim language from how it is defined, even by implication, in the specification or file history.” *Bell Atl. Network Servs. v. Covad Commc'ns Grp.*, 262 F.3d 1258, 1269 (Fed. Cir. 2001).

Through its arguments, HPL attempts to limit the “identifying” claim terms to only “message ID” or “message identification” as illustrated in Figure 11 of the '241 patent and described in the related disclosure (Ex. 1001, 17:46-18:43). PO Resp. 28. In particular, HPL and its expert testimony assert that the broadest reasonable interpretation of the “identifying” claim terms should *exclude* the message type, message length, message priority, return address, caller’s telephone number, or additional descriptive information. PO Resp. 17-20 (citing Ex. 1001, 12:66-13:7; 17:64-18:3; 18:14-22); Ex. 2056 ¶¶ 148-169 (citing *e.g.*, Ex. 2052 ¶ 41; Ex. 2054 ¶¶ 20-25, 31-40, 48-50, 55-56, 60-61). HPL argues that the “additional descriptive information” is different from the “message ID” and “message identification” shown in Figure 11 of the '241 patent and described in the related disclosure (Ex. 1001, 17:46-18:43). PO Resp. 28.

We are not persuaded by HPL’s arguments and expert testimony, as they attempt to import improperly negative limitations from a preferred embodiment disclosed in the specification into the claims. It is well settled

that limitations should not be imported from a particular embodiment appearing in the written description into the claim if the claim language is broader than the embodiment. *Van Geuns*, 988 F.2d at 1184; *Superguide*, 358 F.3d at 875.

HPL and its expert testimony fail to recognize that the specification expressly warns that the preferred embodiments disclosed in the specification should not be read “to limit the invention to the precise forms disclosed.” Ex. 1001, 19:48-53; *see also id.* at 4:41-43. In particular, the specification indicates that the data transmission, as shown in Figure 11, is merely an example. Ex. 1001, 17:46-47 (“*An example of the data transmission 201 sent from system 30B or 30C to system 30 A is shown in FIG. 11.*”); *id.* at 18:10-13 (“*Although the data transmission 201 preferably includes this information, the data transmission 201 may include additional or fewer fields than the example provided in FIG. 11.*”) (emphasis added).

Contrary to HPL’s contention and expert testimony, the specification does not limit “an information identifier identifying the information” or “a message identifier identifying the message” to only the “message ID” or “message identification” shown in Figure 11 of the ’241 patent and described in the related disclosure (Ex. 1001, 17:46-8:43). In fact, the specification states that “the message may be identified in a number of ways, such as with a message code or by specifying the location in the memory where the message is stored.” Ex. 1001, 18:60-63.

HPL’s argument and its expert testimony are based on the erroneous premise that the claim term “an information identifier identifying the

information” cannot include *other additional information* because the “message ID” box is listed as a separate item from the “additional information” box in Figure 11 of the ’241 patent. PO Resp. 19. Neither HPL, nor its expert testimony, cites to an express definition set forth in the specification that requires us to construe “an information identifier identifying the information” as the “message ID” shown in Figure 11. We decline to import limitations into the claims in absence of a special definition set forth in the specification. There is a “heavy presumption” that a claim term carries its ordinary and customary meaning. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002). An inventor may rebut the presumption by providing a definition of the term in the specification with reasonable clarity, deliberateness, and precision. *See Paulsen*, 30 F.3d at 1480. Here, HPL has not alleged that the inventor of the ’241 patent acted as his own lexicographer and provided a special definition in the specification for each “identifying” claim term that is different from its recognized meaning to one with ordinary skill. Therefore, we decline to import the negative limitations from a preferred embodiment disclosed in the specification into the claims, as urged by HPL and its expert testimony. *See Deere & Co. v. Bush Hog, LLC*, 703 F.3d 1349, 1354 (Fed. Cir. 2012) (“While claim terms are understood in light of the specification, a claim construction must not import limitations from the specification into the claims.”).

HPL also argues that two different terms, “message identifier” and “descriptive information,” cannot have the same meaning, directing our



attention to claims 21, 29, 31, 61, 69, and 92. PO Resp. 27-28. That argument is inapposite. The term “descriptive information,” as recited in those claims, further limits the “selective call signal” feature. Those claims do not preclude the “identifying” claim terms from comprising descriptive data that identify the remotely stored information or message. And our claim construction for each “identifying” claim term is not limited to descriptive information.

Finally, HPL asserts that “the ’241 patent repeatedly and uniformly refers to the ‘message identifier’ as what identifies the stored message or information.” PO Resp. 22. We agree with HPL, and observe that HPL’s assertion is consistent with our claim construction for the claim term “a message identifier for identifying the message”—namely, “*data that identify the remotely stored message, facilitating the process of locating and retrieving the remotely stored message.*” We further add “facilitating the process of locating and retrieving the remotely stored message,” in the view of the claims, which require the system to locate the remotely stored message on the server and perform the action on the message.

For the foregoing reasons, our claim construction for each “identifying” claim term is the broadest reasonable construction consistent with the specification and claims of the ’241 patent.

Means-Plus-Function Claim Elements

The parties identify several limitations recited in claim 1 as means-plus-function limitations that invoke 35 U.S.C. § 112, ¶ 6.<sup>4</sup> Pet. 6-7; Prel. Resp. 17-18; PO Resp. 16-17. We agree because: (1) each limitation uses the term “means for”; (2) the term “means for” in each limitation is modified by functional language; and (3) the term “means for” is not modified by any structure recited in the claim to perform the claimed function. *Personalized Media Cmmc 'ns LLC v. Int'l Trade Comm'n*, 161 F.3d 696, 703-04 (Fed. Cir. 1998) (A limitation using the term “means for” creates a rebuttable presumption that the drafter intended to invoke 35 U.S.C. § 112, ¶ 6.); *Sage Prods. v. Devon Indus., Inc.*, 126 F.3d 1420, 1427-28 (Fed. Cir. 1997) (The presumption is not rebutted if the term “means for” in each limitation is modified by functional language and is not modified by any structure recited in the claim to perform the claimed function.).

When construing a means-plus-function limitation under 35 U.S.C. § 112, ¶ 6, we first must identify the claimed function, and then we look to the specification to identify the corresponding structure that actually performs the claimed function. *Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1210 (Fed. Cir. 2003); *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1119 (Fed. Cir. 2002). For

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<sup>4</sup> Section 4(c) of the Leahy-Smith America Invents Act (AIA) re-designated 35 U.S.C. § 112, ¶ 6, as 35 U.S.C. § 112(f). Pub. L. No. 112-29, 125 Stat. 284, 296 (2011). Because the '241 patent has a filing date before September 16, 2012 (effective date), we will refer to the pre-AIA version of § 112.

computer-implemented means-plus-function claims, the corresponding structure of a means-plus-function limitation, however, must be more than simply a general-purpose computer or microprocessor to avoid pure functional claiming. *Aristocrat Techs. Austl. Pty Ltd. v. Int'l Game Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008). That is, the specification must disclose “enough of an algorithm to provide the necessary structure under § 112, ¶ 6” or a disclosure that can be expressed in any understandable terms, *e.g.*, a mathematical formula, in prose, or as a flowchart. *Finisar Corp. v. The DirectTV Group*, 523 F.3d 1323, 1340 (Fed. Cir. 2008).

1. “Means for transmitting to the one or more devices a selective call signal”

We first determine the claimed function for this limitation to be “transmitting to the one or more devices a selective call signal comprising an information identifier identifying the information and an acknowledgement request, where in the information is not included in the selective call signal.”

We next look to the specification of the '241 patent, which provides the following descriptions:

The *transceiver 2* is connected to the antenna 1 and is *for transmitting signals from the paging transceiver 100 and for receiving signals directed to the paging transceiver 100*. The signals that may be transmitted to, or received from, the paging transceiver 100 include, but are not limited to, such signals *as selective call signals, command data signals, signals corresponding to a message, and information data signals*. The transceiver 2 may comprise *a transceiver found in two way pagers or mobile radios* and preferably comprises a transceiver commonly used in a *portable mobile radiotelephone*.

Ex. 1001, 4:51-61 (emphases added).

The *transceiver 2*, as shown in more detail in FIG. 2, includes an antenna interface 20 connected to the antenna 1. The antenna interface 20 directs signals received from antenna 1 to a receiver section 21 of the paging transceiver 100 and directs *signals transmitted from a transmit section 24* to the antenna 1.

*Id.* at 5:18-23; Fig. 2 (emphases added).

The *transmit section 24* includes a transmitter 25 for receiving signals from the processor 27. The transmit section 24 also includes a transmitter frequency synthesizer 26 connected to the transmitter 25 which, based upon an input from the processor 27, selects the transmit frequency for the transmitter 25. *The signals output by the transmitter 25* are supplied to the antenna interface 20 and then to the antenna 1.

*Id.* at 5:39-46 (emphases added).

Although claims 7, 8, and 10 are not involved in the instant proceeding, we also review the claim language in those claims for our claim construction analysis for claim 1, as they ultimately depend from claim 1 and further define the features in claim 1. *See Phillips*, 415 F.3d at 1314. Claim 7 recites “wherein the information comprises audio and/or video information”; claim 8 recites “wherein the audio information comprises music”; claim 10 recites “wherein the device is a mobile radiotelephone”; and claim 38 recites “wherein the means for transmitting comprises a transmitter or transceiver.”

Given the descriptions in the specification and claims, we determine the corresponding structure for the recited function to be a transmitter or a

transceiver that includes a transmitter, such as a transceiver in a two-way pager, mobile radio, or a portable mobile radiotelephone.

2. *“Means for receiving a request transmitted from any one of the one or more devices”*

For this limitation, we identify the claimed function to be “receiving a request transmitted from any one of the one or more devices, wherein the request is transmitted via a two-way communication session with the system and the request identifies the information and an action to be performed on the information.”

In addition to the above reproduced descriptions, the specification further provides:

The *receive section* 21 includes a *receiver* 22 and a receiver frequency synthesizer 23. The receiver 22 is connected to the antenna 1 through antenna interface 20 and *receives the signals* directed to the paging transceiver 100. The receiver frequency synthesizer 23, based on an input from a processor 27, selects the frequency at which the receiver 22 receives signals. The received signals are passed from the receiver 22 to the processor 27.

Ex. 1001, 5:31-38 (emphases added).

We determine the corresponding structure for the claimed function to be a receiver or a transceiver that includes a receiver, such as a transceiver in a two-way pager, mobile radio, or a portable mobile radiotelephone.

3. *“Means for performing an action”*

The recited function for this means-plus-function limitation is “performing an action on the stored information for transmission to one or

more devices, wherein the stored information is not included in the selective call signal that was transmitted to the one or more devices.”

The specification provides examples of an *action* that the user may perform on the information:

The system may transmit some identifying information about the page to the user without sending the entire message. For instance, the base station may identify the type of message, such as email, voice, or text, and also indicate the caller or other descriptive material about the message. The user can then determine the priority of the message and whether he or she wants *to retrieve the message, play the message, erase the message, store the message, forward, reply, or otherwise act on the message.* The user is also *given control over the messages stored remotely from the paging transceiver and can erase or store these messages from the paging transceiver.* The paging transceiver may have a timer for allowing the user to program the paging transceiver to perform a desired function on a message at a particular time.

Ex. 1001, 3:24-37 (emphasis added); *see also id.* at 10:29-54; Fig. 8.

CBS asserts that the corresponding structure for the recited function is “system 30.” Pet. 7 (citing Ex. 1001, 6:17-36; 18:39-51 (“the user can decide what type of action to take upon the message or information at the system 30”)). In its patent owner response, HPL states that the specification “discloses ‘a controller circuit,’ ‘a CPU or control circuit,’ and ‘a [digital signal processor (DSP)] with appropriate operational code,’ as examples of a means for performing actions (such as storage and retrieval of messages).” PO Resp. 16-17 (citing Ex. 1001, 6:21-31). HPL directs our attention to the following portion of the specification (*id.*):

The *system 30* comprises a paging terminal controller 31 which may comprise *a controller circuit* and associated memory having a database of subscriber listings and corresponding selective call address fields. The paging terminal controller 31 communicates with storage and retrieval unit 32 and correlates messages with subscriber listings. The storage and retrieval unit 32 may comprise *a CPU or control circuit*, message information and program memory, memory interface circuitry and *a DSP with appropriate operational code for storage and retrieval of the desired messages*.

Ex. 1001, 6:21-31 (emphases added by HPL). HPL further maintains that the “means for performing an action” comprises a processor. PO Resp. 17 (citing claim 40 (“wherein the means for performing the action comprises a processor”)).

We observe that Figure 9 of the '241 patent, reproduced below, illustrates the process performed by the paging transceiver in response to the user's selected function (e.g., retrieving the message):

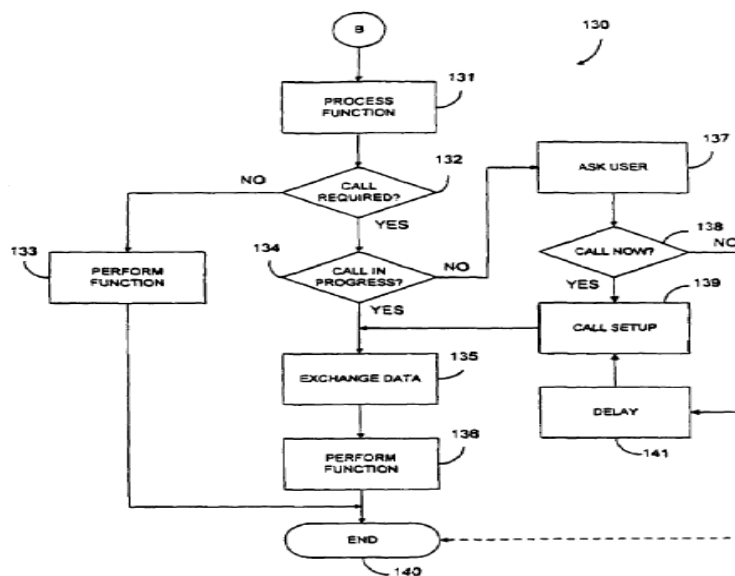


FIG. 9

As shown in Figure 9, CPU 27 at step 132 determines whether a call is required for performing the user's selected function. Ex. 1001, 10:55-60. If a call is not required, then at step 133, CPU 27 performs the requested function. *Id.* at 10:60-62. If a call is required, then CPU 27 sets up a call and exchanges data with system 30 and the function is performed at step 136. *Id.* at 10:63-67.

For this decision, we determine the corresponding structure is CPU 27 of paging transceiver 100, as shown in Figure 2, and system 30, as shown in Figure 3, performing the steps of setting up a call, exchanging data with system 30, and performing the function.

*B. Obviousness Over Smith and Alanara, or with Kane*

CBS asserts that claims 1, 3-5, 11, 13, 15, 16, 18, 20, 21, 23, 24, 26, 28, 29, 41, 43-45, 51, 53-56, 58, 60, and 61 are unpatentable under 35 U.S.C. § 103(a) over Smith and Alanara. Pet. 10-42. CBS also asserts that claims 71, 73-75, 81, 82, 84, 86, 87, 89, 91, 92, and 94 are unpatentable under 35 U.S.C. § 103(a) over Smith, Alanara, and Kane. Pet. 42-59.

In support of its asserted grounds of unpatentability, CBS provides explanations as to how each limitation is met by the combination of cited prior art references and rationales for combining the prior art references. Pet. 10-59. CBS also relies upon a declaration of Dr. John C. Mitchell. Ex. 1012. Upon review of CBS's contentions and supporting evidence, as well as HPL's patent owner response and supporting evidence, we determine that CBS has demonstrated, by a preponderance of the evidence, that the



challenged claims are unpatentable under 35 U.S.C. § 103(a) over the cited prior art references.

*1. Principles of Law*

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). 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) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

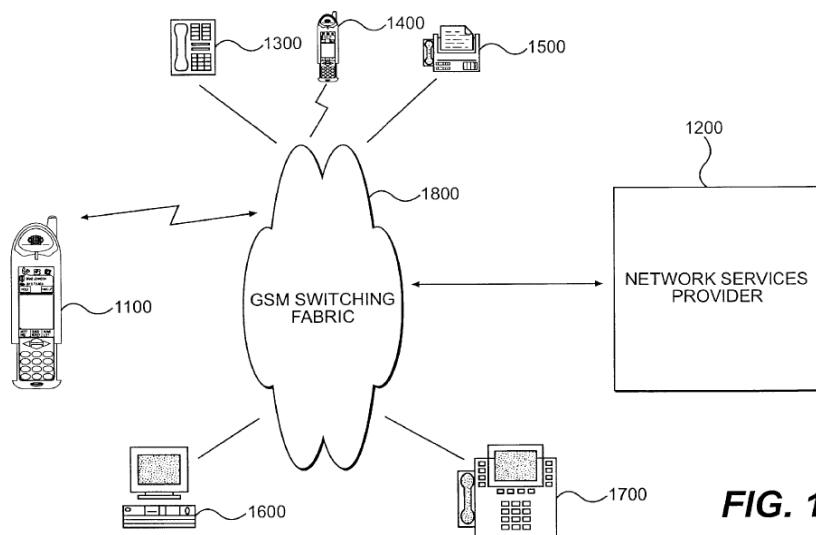
We analyze the instituted grounds of unpatentability in accordance with the above-stated principles. We also recognize that prior art references must be “considered together with the knowledge of one of ordinary skill in the pertinent art.” *Paulsen*, 30 F.3d at 1480. In that regard, “it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.” *In re Preda*, 401 F.2d 825, 826 (CCPA 1968). That is because an obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR*, 550 U.S. at 418; *see also Translogic*, 504 F.3d at

1259. The level of ordinary skill in the art is reflected by the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978).

## 2. Prior Art

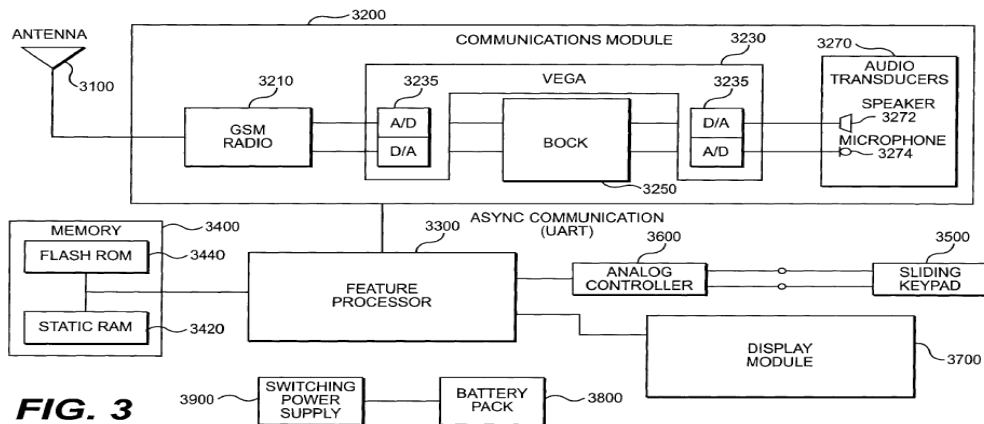
### a. Smith

Smith describes an integrated system for message handling. Ex. 1006, 2:26-31. Specifically, Smith's system has the capability to display different types of received messages, such as voice mails, facsimiles, e-mails, and text messages (or Short Messaging Service (SMS)). *Id.* at 3:32-59; 4:26-36. The system permits the user to view, prioritize, edit, playback, discard, forward, and respond to any type of messages. *Id.* Figure 1 of Smith, reproduced below, is a diagram of an integrated message center system:



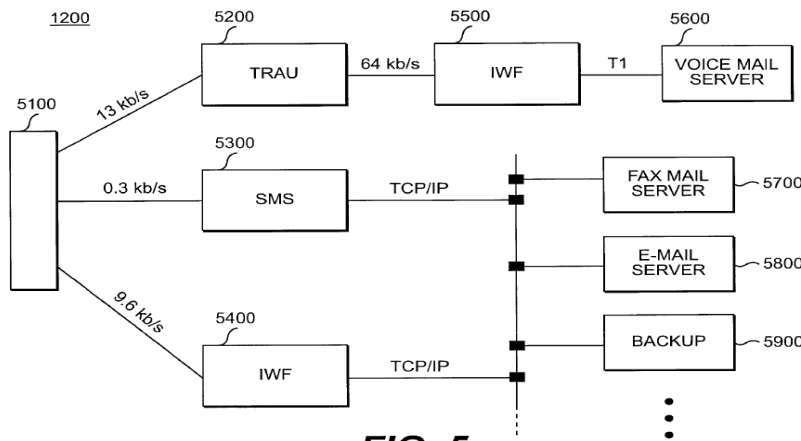
As illustrated in Figure 1 of Smith, the integrated message center is a logical entity that resides in mobile telephone 1100 and operates in conjunction with network services provider 1200 to inform the user of incoming and pending messages. *Id.* at 3:48-59. The user uses mobile telephone 1100 to view messages from callers having different types of caller equipment, such as ordinary telephone 1300, caller mobile telephone 1400 (which is similar to user mobile telephone 1100), facsimile equipment 1500, computer 1600, and Analog Display Services Interface (ADSI) telephone 1700. *Id.* at 3:60-67.

For example, when a caller enters an e-mail message and the user's e-mail address into computer 1600, computer 1600, using the user's e-mail address, directs the e-mail message to network service provider 1200 which stores the e-mail message, and then sends a short message to mobile telephone 1100, notifying the user of the pending e-mail message. *Id.* at 4:57-64. Network services provider 1200 stores many of the messages awaiting retrieval by the user and notifies the user of the pending messages. *Id.* at 4:1-14. Figure 3 of Smith, reproduced below, is a mobile telephone:



Referring to Figure 3, Smith's mobile device includes antenna 3100, communications module 3200, feature processor 3300, memory 3400, sliding keypad 3500, and display module 3700. *Id.* at 5:14-18. Sliding keypad 3500 enables the user to dial a telephone number, access remote databases and servers, and manipulate the graphical user interface. *Id.* at 6:39-42. These hardware elements permit the user to communicate with network services provider 1200 to retrieve messages. *Id.* at 6:66-7:1.

Figure 5 of Smith, reproduced below, illustrates the network services:



**FIG. 5**

Figure 5 shows that network services provider 1200 includes interface 5100, transcoder and rate adapter unit (TRAU) 5200, SMS server 5300, interworking function (IWF) servers 5400 and 5500, voice mail server 5600, fax mail server 5700, e-mail server 5800, and backup 5900. *Id.* at 7:1-6. In response to the notification from voice mail server 5600, SMS server 5300 formulates an SMS voice mail notification message to notify the user of the voice mail message. The voice mail notification message includes the caller's name and telephone number, a time and date stamp, and the name and address of voice mail server 5600. *Id.* at 7:51-56.

b. Alanara

Alanara discloses a mobile station for transmitting SMS messages and SMS acknowledgement messages in a digital cellular system. Ex. 1007, 2:46-51. In the background section, Alanara identifies information regarding SMS that was known in the art at the time of Alanara's invention. Specifically, SMS is a point-to-point or point-to-multipoint service that enables a user to send messages to, and receive text messages from, other users of a communications network. *Id.* at 1:13-17. "The network stores messages in at least one Message Center (MC), and Mobile Terminated (MT) messages are sent to the terminal by the MC." *Id.* at 1:26-28. "Various SMS protocol layers receive the messages and check their contents." *Id.* at 1:27-33. If the contents are valid, the message is received and stored. *Id.* Otherwise, the message is rejected. *Id.* Alanara also discusses several types of page systems that have a capability for the remote unit to transmit a message-received acknowledgement signal back to a central site. *Id.* at 1:33-54.

c. Kane

Kane describes an electronic mail message delivery system that includes an electronic mail network for delivering electronic mail messages from originating devices to destination devices. Ex. 1008, Abs. The electronic mail messages include network addresses for identifying originating and destination devices communicating the electronic mail messages and message data. *Id.*

3. *Discussion*

In its patent owner response, HPL maintains that the combinations of Smith, Alanara, and Kane do not disclose or render obvious the following claim limitations:

1. A “message identifier identifying the [stored] message” (recited in claim 41 and its [dependent claims]) or an “information identifier identifying the [stored] information” (recited in claims 1, 71, and their [dependent claims]);
2. “[T]he request identifies the message and an action to be performed on the message (recited in claim 41), or the request identifies the information and an action to be performed on the information” (recited in claims 1 and 71);
3. Wherein “the information identifier comprises a code,” “the message identifier comprises a code” “the code is a unique code,” “the code is a number,” or “the request comprises said code” (recited in dependent claims 13, 15, 16, 53, 54, 55, 56, 84, 86, and 87); and
4. An information identifier that “specifies an address of the information stored in the storage unit” (recited in dependent claims 23 and 94).

PO Resp. 33.

Our analysis will focus on these deficiencies alleged by HPL in its patent owner response. We address below the “identifying” claim limitations first, and then the “request” claim limitations.

- a. “Information identifier identifying the information” and “message identifier identifying the message”

The “identifying” claim limitations are recited in independent claims 1, 41, and 71. For instance, claim 1 recites “a storage unit that stores

information for transmission to one or more devices; [and] means for transmitting to the one or more devices *a selective call signal comprising an information identifier identifying the information and an acknowledgment request, wherein the information is not included in the selective call signal.*”

In its petition, CBS asserts that Smith discloses a storage unit that stores a message or information to be transmitted to a user, as recited in claims 1, 41, and 71. Pet. 11, 28, 43 (citing Ex. 1006, 4:57-64). CBS also takes the position that Smith discloses a selective call signal comprising a message or information identifier identifying the remotely stored message or information, as recited in the claims. Pet. 11-14, 29-32, 43-46. As support, CBS proffers the declaration of Dr. Mitchell. Ex. 1012.

HPL counters that Smith’s notifications are generic “you have mail” notifications, and such notifications do not identify the specific message, “instead providing simply an indication of which system has the message and the message’s type.” PO Resp. 35 (citing Ex. 2052 ¶ 59; Ex. 2056 ¶¶ 170-177); *see also id.* at 33-34. HPL also argues that Smith does not disclose inherently an information identifier or message identifier as recited in the claims. PO Resp. 35-37 (citing Ex. 2001, 11-12). Specifically, HPL alleges that “there were several ways to retrieve messages without providing the recipient a message identifier in a selective call signal,” e.g., the user calls the voicemail system and selects the message. PO Resp. 36.

As support, HPL proffers the declarations of Dr. Hunt and Dr. Grindon. PO Resp. 35-37 (citing Ex. 2052 ¶¶ 51-95, Ex. 2054 ¶¶ 80-88, Ex. 2056 ¶¶ 170-177). HPL’s experts testify that the sender’s information

(e.g., name, telephone number, e-mail address) or the name and address of the e-mail server does not identify a particular remotely stored message, because the same sender from the same system may have sent several messages, and the server handles very large quantities of messages.

Ex. 2052 ¶ 59; Ex. 2054 ¶¶ 83-84. In particular, Dr. Grindon declares that the name and telephone number of a sender is not the same as providing a particular “file name” or “file number” that establishes a particular item of information (e.g., from among other items of information) from the sender.

Ex. 2054 ¶ 84. Dr. Grindon also testifies that “the time and date stamp cannot be used by the storage system to identify the content because the storage system did not generate, and is not aware of, the time and date stamp.” Ex. 2054 ¶ 85 (citing Ex. 1006, 8:5-8).

We are not persuaded by HPL’s arguments and expert testimony, as they narrowly focus on each data item in Smith’s notification message individually and fail to consider Smith’s disclosure as a whole from the perspective of one with ordinary skill in the art. *See Paulsen*, 30 F.3d at 1480. In particular, they narrowly focus on each item’s usual function, in isolation, and they do not recognize that data items may serve multiple functions. More importantly, they fail to recognize that the data items collectively, as disclosed in Smith, provide the function of identifying the remotely stored information or message and facilitating the process of locating, retrieving, and downloading the stored information or message from the server to the mobile telephone (*see, e.g.*, Ex. 1006, 10:38-56).



HPL's arguments and its expert testimony also are premised on overly narrow claim constructions of the "identifying" claim terms, importing improperly limitations from extrinsic evidence and from a preferred embodiment (Figure 11 of the '241 patent) disclosed in the specification. As articulated above, we decline to adopt HPL's proffered claim constructions. Instead, in light of the claims and specification, we construe the term "message identifier identifying the message" broadly, but reasonably, as "data that identify the remotely stored message, facilitating the process of locating and retrieving the remotely stored message." And we construe the term an "information identifier identifying the information" as "data that identify the remotely stored information, facilitating the process of locating and retrieving the remotely stored information." In our analysis below, for simplification, we mainly focus on Smith's e-mail embodiment, as the claimed remotely stored message and information each read on Smith's remotely stored e-mail message that contains information.

As CBS notes in its petition, Smith discloses:

When the caller uses computer 1600 to *send an e-mail message* to the user [of mobile telephone 1100 shown in Figure 1], the caller enters the message into the computer and affixes the user's e-mail address. The user's e-mail address directs the e-mail message to network services provider 1200. *Network services provider 1200 stores the e-mail message*, and then *sends a short [notification] message* to mobile telephone 1100, notifying the user of the pending e-mail message.

Pet. 11-12, 28-29, 43-44; Ex. 1006, 4:47-46; Fig. 1 (emphasis added).

The notification messages include “information regarding the source of each of the pending messages and the type of each of the pending messages,” and “each of the notification messages is automatically sent to the user when one of the pending messages is initially received.” Ex. 1006, 12:39-44. The notification messages also may include the sender’s name, telephone number, and e-mail address, a time and date stamp, and the name and address of e-mail server 5800. *Id.* at 8:5-9, 52-65.

Although one of the functions of the notification message is to identify the source of the actual remotely stored message, Smith discloses that the user can request a download of a particular remotely stored message from the server to the mobile device using the data items provided in the notification message that corresponds to the remotely stored message. Ex. 1006, 1:19-25; 2:46-50; 3:54-59; 10:42-56. In fact, Smith discloses that while the actual message continues to be stored remotely in the server on the network, the integrated message center permits the user, using his mobile device, to retrieve, view, prioritize, reply, edit, playback, discard, and forward the remotely stored message. *Id.*

CBS’s expert, Dr. Mitchell, testifies that “Smith discloses an information identifier that identifies stored information at least because a user can select one of the pending messages for retrieval based on the entries in the single selectable list.” Ex. 1012 ¶ 5. We credit Dr. Mitchell’s testimony because it is consistent with Smith’s disclosure.

As Dr. Mitchell notes, Smith discloses:

The user can select one of the pending messages for retrieval based on the entries in the single selectable list. In response to user selection, *the integrated message center retrieves the selected pending message for viewing and manipulation by the user.*

*Id.* (citing Ex. 1006, 2:46-50) (emphasis added).

More specifically, Smith discloses:

The integrated message center also serves as a mechanism by which the user can retrieve, manipulate, and *reply* to all types of messages. User manipulations of the pending messages might include the ability to *view, prioritize, edit, playback, discard, and/or forward messages.*

Ex. 1006, 3:54-59 (emphases added).

FIG. 12 is an example of a screen display in which the user wants to retrieve e-mail from a caller using computer 1600 (FIG. 1). Message center 6100 provides a graphical depiction of the SMS e-mail notification message that mobile telephone 1100 received from network services provider 1200. At this point, however, e-mail server 5800 in network services provider 1200 continues to store the actual e-mail message. *Message center 6100 permits the user to view the e-mail notification message and download the e-mail message from e-mail server 5800.*

When the user wants to retrieve the e-mail message after viewing the e-mail notification message, *the user first selects the e-mail icon corresponding to the e-mail message* from the message center display (FIGS. 7A and 7B), and then *instructs* mobile telephone 1100 to retrieve the e-mail message by *pressing* the “View” button. In response, *mobile telephone 1100 establishes a connection with network services provider 1200 to download the e-mail message from e-mail server 5800.*

Ex. 1006, 10:47-56 (emphases added). Smith also discloses that the message center allows the user to respond to any type of message by typing a text message and sending it to the original sender. Ex. 1006, 10:61-11:10; Figs 13A-13D.

Contrary to HPL's assertion that the user calls the voicemail system and selects the message, Smith's integrated message center (*see, e.g.*, Figures 7A and 7B) provides a graphical user interface display on the user's mobile telephone, permitting the user to view the notification message and request a download of the particular remotely stored message from the server to the mobile telephone. Ex. 1006, 8:12-17; 10:37-47. As HPL's expert, Dr. Hunt, explains, "the e-mail server handles very large quantities of messages in a short amount of time." Ex. 2052 ¶ 59. In response to the user's request for downloading a particular message, the mobile device establishes a connection with the network services provider to download the remotely stored message. Ex. 1006, 10:48-56. The server uses the information provided by the mobile device to identify and locate the particular message among large quantities of messages, and then downloads the particular message to the user's mobile device. Therefore, the data items in the notification message also serve the function of identifying the remotely stored message, facilitating the process of locating and retrieving the particular remotely stored message from the server to the mobile device.

HPL further argues that Smith does not teach a message identifier or information identifier comprising a code, unique code, or number, as required by claims 13, 15, 53, 54, 55, 84, and 86. PO Resp. 40-41. HPL

also contends that the name and address of the server merely identifies, at most, the address of a storage unit, but not the “address of the information stored in the storage unit” as recited in claims 23 and 94. PO Resp. 46-48.

CBS disagrees and argues that one with ordinary skill in the art would have recognized that “allowing users to retrieve [messages] such as voice mails, emails and faxes would require identification of the content and the content’s location.” Pet. Reply, 14-15. We agree with CBS.

HPL does not explain meaningfully the difference between the address of the information that is stored remotely in the server and the address of the server or the storage unit where the information is stored. In fact, the specification discloses that the message may be identified “by specifying the location in memory where the message is stored.” Ex. 1001, 18:60-63. Smith discloses that the remotely stored message or information is located on the server. Ex. 1006, 4:46-47. The address of the server or the storage unit where the information is stored would direct the system to locate the information. Therefore, one with ordinary skill in the art would have appreciated that the address of the server or the storage unit where the information is stored would be the address of that information.

Furthermore, as CBS points out, Smith discloses that the notification message includes the sender’s telephone *number*, the sender’s e-mail *address*, a *time and date stamp*, and the *name and address of e-mail server*. Pet. 20-21, 25, 37-39, 53-55, 59 (citing Ex. 1006, 8:1-10; Ex. 1012 ¶¶ 11-12, 16). As discussed above, Smith also discloses that the user at the mobile device can use the information provided in the notification message to

request a download of the remotely stored message from the server to the mobile device. Ex. 1006, 10:37-56 (“In response, mobile telephone 1100 establishes a connection with network services provider 1200 to download the e-mail message from e-mail server 5800.”). Therefore, Smith would have suggested to one with ordinary skill in the art the disputed limitations of a message identifier or information identifier comprising a code, unique code, or number and of specifying an address of the information.

HPL further argues that Smith’s hypertext markup language (HTML) code disclosure does not disclose a Uniform Resource Locator (URL) to a web page. PO Resp. 41-46. However, none of the challenged claims requires a URL to a web page. In fact, the ’241 patent does not contain any disclosure of a URL. CBS also relies upon other embodiments of Smith to disclose the disputed limitations. Pet. 54 (citing Ex. 1006, 8:5-8). As indicated above, the data items in Smith’s notification message—e.g., the sender’s telephone *number*, the sender’s e-mail *address*, a *time and date stamp*, and the name and *address* of e-mail server—would have suggested to one with ordinary skill in the art the “code” and “number” limitations as recited in claims 84 and 86. Although we observe that Smith does not disclose that a web page itself is the particular message for transmission, it is not necessary for us in this decision to consider the parties’ arguments regarding whether Smith discloses a URL to a web page (PO Resp. 41-46; Pet. Reply 13-14), as well as the parties’ supporting evidence on this issue and the parties’ contentions related to HPL’s preliminary infringement contentions (*see, e.g.*, Pet. 53-55).

For the foregoing reasons, CBS has demonstrated, by a preponderance of evidence, that the combinations of Smith, Alanara, and Kane would have rendered obvious to one with ordinary skill in the art the claimed invention, including the “identifying” disputed claim limitations.

b. The request identifies the information or message and an action to be performed on the information or message

In its petition, CBS asserts that Smith discloses a “request identifies the message and an action to be performed on the message,” as required by claim 41, and a “request identifies the information and an action to be performed on the information,” as required by claims 1 and 71. Pet. 17-19, 34-36, 49-52 (citing Ex. 1006, 10:48-56). As support, CBS relies upon the declaration of Dr. Mitchell. Ex. 1012 ¶¶ 8-10.

HPL counters that Smith does not disclose a “request received by the remote system from the mobile device identifies a particular e-mail.” PO Resp. 39 (citing Ex. 2054 ¶ 83-91; Ex. 2052 ¶ 66-67); *see also id.* at 38-40. To substantiate HPL’s position, Mr. Grindon testifies that the cited portion of Smith includes “no evidence showing a request (i.e., ‘one single act or instance of asking for something’) that includes data identifying the information and data identifying an action or command to perform.” Ex. 2054 ¶ 88.

Upon review of the parties’ arguments and supporting evidence, we are not persuaded by HPL’s arguments and expert testimony, as they are premised incorrectly on the notion that a “request” cannot be a click of a button or icon from a graphic user interface display, which triggers a specific

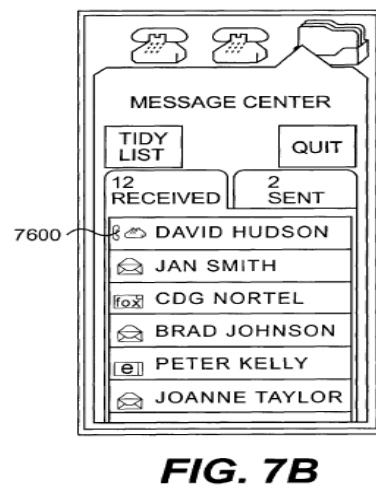
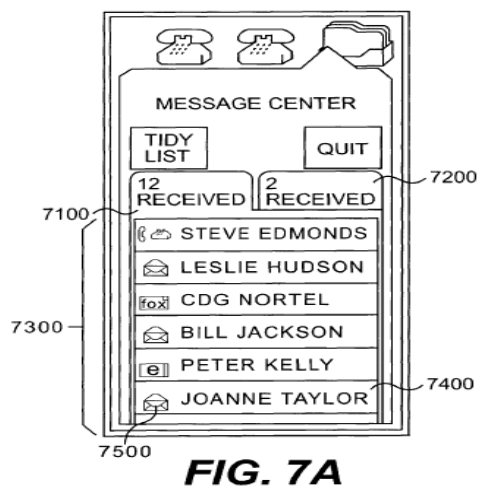
action on a particular remotely stored message. Rather, we determine that Smith would have suggested to one with ordinary skill in the art the disputed “request” limitations.

As noted by CBS, Smith discloses “retrieving the selected pending message from the mail server for viewing and manipulation by the user.” Pet. Reply 12 (citing Ex. 1006, 16:28-30; 16:43-47; Ex. 1019 ¶¶ 20-21). In its petition, CBS directs our attention to the following portion of Smith:

When the user wants to retrieve the e-mail message after viewing the e-mail notification message, the user first *selects* the e-mail icon corresponding to the e-mail message from the message center display (FIGS. 7A and 7B), and then *instructs* mobile telephone 1100 to retrieve the e-mail message by *pressing* the “View” button. In response, mobile telephone 1100 *establishes a connection* with network services provider 1200 to *download* the e-mail message from e-mail server 5800.

Ex. 1006, 10:37-56 (emphases added).

Figures 7A and 7B of Smith, reproduced below, illustrate example displays of received messages on the user’s mobile device.





As shown in Figures 7A and 7B, message center 6100 presents the user with scrollable selectable list 7300 of notification headers that identify the sender's names 7400 and identification icons 7500. Ex. 1006, 8:36-45. Although Smith does not show a written request sent from the user to the server in this embodiment, Smith nevertheless teaches that “the user first *selects* the e-mail icon corresponding to the e-mail message” (i.e., identifying the remotely stored e-mail message) from the message center display, and then “*instructs* the mobile telephone 1100 to retrieve the e-mail message by *pressing the ‘View’ button*” (i.e., requesting an action, e.g., retrieving, to be performed on the remotely stored e-mail message). *Id.* at 10:48-53 (emphasis added). In another embodiment of Smith, the user *replies* to a message by *typing* a text message using an on-screen keyboard and *sending the text message* to the original message sender. *Id.* at 10:61-11-20.

As HPL points out (PO Resp. 39-40) in another embodiment of Smith, the user, after viewing the voice mail notification message, can *select the voice mail icon* corresponding to the particular voice message (i.e., identifying the remotely stored voice mail). Ex. 1006, 9:54-10:2. In response, mobile telephone 1100 establishes a connection with network services provider 1200. *Id.* The user *interacts* with voice mail server 5600 *using the graphical controls* (Figure 10), e.g., *pressing the “Play button,”* and mobile telephone 1100 *translates the user's action* into corresponding DTMF tones to control voice mail server 5600, which interprets the tone as an instruction to play back the voice message. *Id.*

HPL and its expert testimony do not explain sufficiently why “identifying the message” cannot be performed by selecting the icon that is associated with the particular remotely stored message from the message center display. They also fail to explain adequately why retrieving and downloading the remotely stored message would not be “an action to be performed on the message” as recited in claim 41, or “an action to be performed on the information” as recited in claims 1 and 71. Therefore, the testimony of HPL’s experts regarding Smith’s lack of disclosure of a request is entitled to little weight. *See Rohm and Haas Co. v. Brotech Corp.*, 127 F.3d 1089, 1092 (Fed. Cir. 1997) (“Nothing in the rules or in our jurisprudence requires the fact finder to credit the unsupported assertions of an expert witness.”); *see also Velandar v. Garner*, 348 F.3d 1359, 1371 (Fed. Cir. 2003) (“In giving more weight to prior publications than to subsequent conclusory statements by experts, the Board acted well within [its] discretion.”).

HPL argues, and its experts testify, that “[v]oicemail systems at the time of Smith did not provide selective call signals that included message identifiers or information identifiers because the request for the voicemail messages were not able to include such message identifiers.” PO Resp. 40; Ex. 2054 ¶¶ 83-91; Ex. 2052 ¶ 67. However, we have addressed HPL’s argument and expert testimony concerning the “identifying” claim limitations previously and determined that they are not persuasive.

HPL also argues that Smith does not teach or suggest a request that comprises the code that identifies the remotely stored message or

information as recited in claims 16, 56, and 87. PO Resp. 40-41. As CBS points out, however, Smith discloses that the notification message includes the sender's telephone *number*, the sender's e-mail *address*, a *time and date stamp*, and the name and *address* of e-mail server. Pet. 22, 40, 56 (citing Ex. 1006, 7:51-8:10; *see also* 3:48-59; 9:36-10:2; 10:11-30; Ex. 1012 ¶ 11). As discussed above, the user at the mobile device uses the information provided in the notification message to request a download of the remotely stored message from the server. Ex. 1006, 10:48-56. Therefore, the data items in Smith's notification message—e.g., the sender's telephone *number*, the sender's e-mail *address*, a *time and date stamp*, and the name and *address* of e-mail server—would have suggested the “code” limitations.

HPL further argues that Smith's HTML disclosure does not disclose a URL to a web page. PO Resp. 41-46. HPL, however, fails to recognize that none of the challenged claims requires a URL to a web page and that CBS also relies upon other embodiments of Smith (*see, e.g.*, Ex. 1006, 3:48-59) to disclose the disputed limitations. As indicated previously, Smith's integrated message center allows the user to reply to all types of messages. Ex. 1006, 3:48-59; 10:61-63 (“Message center 6100 allows the user to respond to any type of message by either sending an SMS message or by establishing a voice call to the message sender”); Figs. 13A-D, 14A, 14B. Although we observe that Smith does not disclose that a web page itself is the particular message for transmission, it is not necessary for us in this decision to consider the parties's arguments regarding whether Smith discloses a URL to a web page (PO Resp. 41-46; Pet. Reply 13-14), as well

as the parties' supporting evidence on this issue and the parties' contentions related to HPL's preliminary infringement contentions (*see, e.g.*, Pet. 53-55).

For the foregoing reasons, CBS has demonstrated, by a preponderance of the evidence, that the combinations of Smith, Alanara, and Kane would have rendered obvious to one with ordinary skill in the art the claimed invention, including the "request" disputed claim limitations.

#### 4. *Antedating Smith*

HPL seeks to disqualify Smith as prior art by establishing a date of invention prior to the filing date of Smith. PO Resp. 12-15. As support, HPL submits a declaration of Mr. Richard Helferich, the sole inventor of the '241 patent. Ex. 2013. Upon consideration of HPL's arguments and the evidence before us, we determine that Mr. Helferich's declaration and other supporting evidence are inadequate to establish a date of invention prior to the filing date of Smith.

The '241 patent claims benefit of an earlier filing date, September 19, 1997, through two prior-filed applications. Smith qualifies as prior art under 35 U.S.C. § 102(e)(2), and has an actual filing date of April 23, 1997. Although Smith was filed before the earliest effective filing date of the '241 patent, 35 U.S.C. § 102(e)(2) requires the prior art patent to have been filed "before the invention by the applicant for patent." *See, e.g., Loral Fairchild Corp. v. Matsushita Elec.*, 266 F.3d 1358, 1362 (Fed. Cir. 2001). An inventor "may date his patentable invention back to the time of its conception, if he connects the conception with its reduction to practice by reasonable diligence on his part, so that they are substantially one

continuous act.” *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1577 (Fed. Cir. 1996) (internal citation and quotations omitted).

In his declaration, Mr. Helferich testifies that he conceived the subject matter of each challenged claims prior to April 23, 1997, the filing date of Smith (“the critical date”). Ex. 2013, 2-3. To corroborate Mr. Helferich’s testimony, HPL submitted an undated handwritten specification (Ex. 2017) that allegedly describes the claimed invention of the ’241 patent. Ex. 2013, 7-8, 16 (citing Ex. 2023). Mr. Helferich attempts to corroborate the date of the handwritten specification by testifying that he completed the handwritten specification prior to the critical date. *Id.* CBS counters that HPL fails to proffer corroborating evidence that the handwritten specification existed prior to the critical date. Pet. Reply 1. We agree with CBS.

“Conception must be proved by corroborating evidence which shows that the inventor disclosed to others his completed thought expressed in such clear terms as to enable those skilled in the art to make the invention.” *Coleman v. Dines*, 754 F.2d 353, 359 (Fed. Cir. 1985). The requirement for corroboration of inventor’s testimony arose out of a concern that inventors testifying at trial would be tempted to remember facts favorable to their case by the lure of protecting their patent or defeating another’s patent. *Mahurkar*, 79 F.3d at 1577. A rule of reason applies to determine whether the inventor’s testimony has been corroborated. *Price v. Symsek*, 988 F.2d 1187, 1194 (Fed. Cir. 1993). “The rule of reason, however, does not dispense with the requirement for some evidence of independent corroboration.” *Coleman*, 754 F.2d at 360.

In that regard, an inventor’s testimony, standing alone, is insufficient to prove conception, as some form of corroboration is required. *Mahurkar*, 79 F.3d at 1577; *Price*, 988 F.2d at 1194; *In re NTP, Inc.* 654 F.3d 1279, 1291 (Fed. Cir. 2011) (“An inventor cannot rely on uncorroborated testimony to establish a prior invention date.”). The law requires sufficient proof for the date and identity of a physical exhibit offered to show conception. In that regard, the Federal Circuit stated “[t]his rule is not new to patent law” and observed:

Conception by an inventor, for the purpose of establishing priority, *cannot be proved by his mere allegation nor by his unsupported testimony where there has been no disclosure* to others or embodiment of the invention in some clearly perceptible form, such as drawings or model, *with sufficient proof of identity in point of time*. For otherwise, such facile means of establishing priority of invention would, in many cases, offer great temptation to perjury, and would have the effect of virtually precluding the adverse party from the possibility of rebutting such evidence. Hence it has been ruled in many cases that the mere unsupported evidence of the alleged inventor, on an issue of priority, as to . . . conception and the time thereof, cannot be received as sufficient proof of . . . prior conception.

*Price*, 988 F.2d at 1194-95 (emphases added) (citations omitted).

Here, the handwritten specification submitted to corroborate Mr. Helferich’s testimony that he conceived the claimed invention prior to the critical date is undated and unsigned. Ex. 2017. Mr. Helferich’s testimony—that he prepared and completed the handwritten specification prior to the critical date (Ex. 2013, 7-8)—is insufficient to corroborate the

date of the handwritten specification. An inventor's own testimony does not constitute "independent" corroboration of evidence that stems from the inventor himself or herself. *See NTP*, 654 F.3d at 1291-1292 (rejecting the contention that the inventors may seek to corroborate their testimony with a document and, at the same time, attempt to corroborate the date of the document with their testimony.). Consequently, we decline to accord the handwritten specification (Ex. 2017) a date prior to the critical date based on Mr. Helferich's declaration alone.

Other evidence proffered by HPL also does not demonstrate that Mr. Helferich conceived the claimed subject matter of the '241 patent prior to the critical date. For instance, Mr. Helferich declares that, prior to a trip to Korea with the Chief Executive Officer (CEO) of ReadyCom, he had described *generally* to ReadyCom "the nature of [his] conceptions." Ex. 2013, 4-5. Mr. Helferich's testimony does not provide specific information regarding the content of that disclosure. More significantly, Mr. Helferich's declaration fails to indicate that Mr. Helferich had disclosed the existence of the handwritten specification, or his conception of the claimed invention of the '241 patent, to the CEO of ReadyCom or others prior to the critical date. Ex. 2013. It is well settled that proof of conception requires objective evidence that the inventor has disclosed to others his "completed thought expressed in such clear terms as to enable those skilled in the art to make the invention." *See Coleman*, 754 F.2d at 359; *see also In re Jolley*, 308 F.3d 1317, 1323 (Fed. Cir. 2002). Therefore, Mr. Helferich's testimony as to his disclosure to the CEO of ReadyCom does not

demonstrate sufficiently that he conceived the claim invention prior to the critical date.

HPL also submits a long list of other exhibits. Exs. 2014-2016, 2018-2041. However, neither HPL, nor Mr. Helferich's testimony, explains adequately how any of these documents discloses the claimed subject matter prior to the critical date. The exhibits, individually or collectively, do not establish sufficiently that Mr. Helferich completed the handwritten specification, or conceived the claimed invention, prior to the critical date.

For instance, HPL proffers a draft Consulting Agreement between ReadyCom and Helferich Designs of Florida. Ex. 2014; Ex. 2013, 6-7. However, the dates on the agreement have been removed. *Id.* Furthermore, the agreement merely states that Mr. Helferich would engage in research and development of technology in the communications field and render consulting services in the area of wireless voice messaging technology. Ex. 2014, 2. It is not directed specifically to the claimed subject matter of the '241 patent, e.g., "selective call signal" or "message identifier identifying the message." Moreover, it could have been referring to Mr. Helferich's earlier issued patents (e.g., U.S. Patent Nos. RE 34,976, 4,846,301, and 4,905,003), or his future research and development work. Ex. 2013, 3-4.

The Confidential Technology Activities Report is said to reflect that Mr. Helferich had "completed several written disclosures of the inventions related to and defined in the Subject '241 Claims." Ex. 2015; Ex. 2013, 7-8. The report contains only three paragraphs: paragraph 1 is redacted;



paragraph 2 addresses US patent RE 34,976; and paragraph 3 merely states “[d]eveloping technologies involving use of the Internet and Internet protocol (IP) for use by READYCOM as a voice message transport alternative and tested models for Internet voice . . . . Continues to make improvements and prepared disclosure for work done . . . .” Ex. 2015. However, such information is too vague and general to be directed to the claimed invention of the ’241 patent. The report is not sufficient to establish that Mr. Helferich had completed any written disclosure of the claimed invention of the ’241 patent, much less the handwritten specification (Ex. 2017), prior to the critical date.

We also do not find Mr. Helferich’s Invention Development Agreements with ReadyCom (Exs. 2016, 2018-2021) and Invention Disclosure Forms (Exs. 2024-2027) adequate to corroborate the testimony of Mr. Helferich that he had conceived the claim invention, or completed the handwritten specification, prior to the critical date. Notably, the only version of the Invention Development Agreement that shows a date prior to the critical date is Exhibit 2018. The final version allegedly sets forth the terms and conditions under which Mr. Helferich would research, develop, and disclose to ReadyCom his earlier completed invention disclosures related to wireless messaging technology. Ex. 2013, 13-14 (citing Exs. 2020, 2021). However, none of the agreements contain information specifically related to the claimed subject matter of the ’241 patent. Exs. 2018-2021. For example, the reference to Mr. Helferich’s earlier completed invention disclosures is not specific to the claimed subject matter

of the '241 patent. *Id.* Nor do the agreements point out any specific written disclosure completed by Mr. Helferich prior to the critical date. *Id.* Moreover, the first handwritten Invention Disclosure Form (Ex. 2024) was not completed until July 31, 1997, after the critical date. Ex. 2013, 17. Therefore, none of the Invention Disclosure Forms demonstrates that Mr. Helferich conceived the claimed subject matter of the '241 patent, or drafted the handwritten specification (Ex. 2017), prior to critical date. These documents fail to show sufficiently that Mr. Helferich conceived the claimed invention prior to critical date.

For the foregoing reasons, HPL fails to provide sufficient evidence to establish that Mr. Helferich conceived the subject matter of each challenged claim prior to the critical date. Given that HPL fails to show conception prior to the critical date, it is not necessary for us to determine whether Mr. Helferich exercised reasonable diligence toward reducing the claimed subject matter to practice from a date just prior to the critical date.

*C. Motion to Amend*

HPL filed a motion to amend claims. Paper 48, "Mot. A." HPL proposes to amend claims 1, 3-5, 11, 13, 23, 24, 51, 53, 73-75, 81, 82, and 84 of the '241 patent. *Id.* at 2. For the reasons stated below, HPL's motion to amend claims is *denied*.

An *inter partes* review is more adjudicatory than examinational, in nature. *See Abbott Labs v. Cordis Corp.*, 710 F.3d 1318, 1326 (Fed. Cir. 2013). A motion to amend claims in an *inter partes* review is not itself an amendment. As the moving party, HPL bears the burden of proof to

establish that it is entitled to the relief requested. 37 C.F.R. § 42.20(c). In sum, HPL's proposed substitute claims are not entered automatically, but only upon HPL's having demonstrated the patentability of those substitute claims.

*1. Claim Construction*

Claim construction is an important step in a patentability determination. *Oakley, Inc. v. Sunglass Hut Int'l*, 316 F.3d 1331, 1339 (Fed. Cir. 2003); *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003) (“Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. . . . The second step in the analyses requires a comparison of the properly construed claim to the prior art.” (internal citations omitted)). A motion to amend claims must identify how the proposed substitute claims are to be construed, especially when the proposed substitute claims introduce new claim terms.

Here, HPL's proposed substitute claims introduce several new claim features, including “the means for transmitting is *configured to transmit an acknowledgment* to the one or more devices that the identified message has been deleted” (*see, e.g.*, proposed amended claim 3). Mot. A. 2-4. HPL does not provide any constructions for the new claim terms recited in its proposed amended claims. For example, although in its patent owner response HPL agrees with the Board's claim construction set forth in the Decision on Institution (Dec. 15-16) that the claim term “means for transmitting to the one or more devices a selective call signal,” recited in

claim 1, is a means-plus-function limitation invoking 35 U.S.C. § 112, ¶ 6, and states that the corresponding structure is a “transmitter or transceiver that includes a transmitter” (PO Resp. 16), HPL nevertheless does not explain whether that construction applies to the new limitation added in proposed amended claim 3. HPL does not explain which part of the system generates the acknowledgement, and how the transmitter is *configured to* transmit the acknowledgement to the one or more devices. Nor does HPL identify the corresponding structure that performs the recited function added in proposed amended claim 3. In that regard, HPL also fails to identify the particular algorithm disclosed in the specification that performs the recited function added in the proposed amended claim 3, or explain why an algorithm is not necessary for performing the recited function. *See WMS Gaming Inc. v. Int’l Game Tech.*, 184 F.3d 1339, 1349 (Fed. Cir. 1999) (For computer-implemented means-plus-function claims, the corresponding structure is the described algorithm executing on the computer hardware.); *see also Aristocrat*, 521 F.3d at 1333 (ruling that the claims were indefinite because of lack of disclosure of any specific algorithm used by the disclosed computer to perform the function recited in a means-plus-function element).

Without a reasonable construction of the claim features added in the substitute claims, HPL’s motion does not provide adequate information for the Board to determine whether HPL has demonstrated the patentability of its proposed substitute claims and, thus, HPL fails to meet its burden of proof under 37 C.F.R. § 42.20(c).

2. *Written Description Support*

A motion to amend claims must identify clearly the written description support for each proposed substitute claim, and the written description support in an earlier-filed disclosure for each claim for which benefit of the filing date of the earlier filed disclosure is sought. 37 C.F.R. § 42.121(b). The written description test is whether the *original disclosure of the application* relied upon reasonably conveys to a person of ordinary skilled in the art that the inventor had possession of the claimed subject matter as of the filing date. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). Therefore, the written description support must be shown in the original disclosure of the application that issued as the patent.

Here, HPL did not provide a copy of the original disclosure of the application, Application No. 11/050,775 (“the ’775 application”) that issued as the ’241 patent. Nor does HPL cite to the original disclosure of the ’775 application for the actual claim language of each proposed substitute claim. Although HPL cites to the ’241 patent, that alone is insufficient, as the specification of the ’241 patent is not the original disclosure. Moreover, HPL fails to provide a copy of the original disclosure of each earlier-filed application for which benefit of the filing date of the earlier-filed disclosure is sought. The title page of ’241 patent shows that the ’241 patent claims the benefit of two earlier-filed applications, namely Application Nos. 09/688,321 and 08/934,143. Merely citing to U.S. Patent No. 6,233,430, issued from the earliest-filed application (Application No. 08/934,143) for

which benefit is sought, is also insufficient. It is well settled that, where there is a chain of continuing applications, if any application in the chain fails to make the requisite disclosure of the claimed subject matter under 35 U.S.C. § 112, ¶ 1, then the claim is not entitled to the benefit of the filing date of the applications preceding the break in disclosure. *Hollmer v. Harari*, 681 F.3d 1351, 1355 (Fed. Cir. 2012). The burden should not be placed on the Board to sort through HPL's patents and the original disclosures of the '775 application and the two earlier-filed applications for which benefit is sought, to determine whether each proposed substitute claim is supported by the original disclosures of the '775 application and each of the earlier-filed applications.

For the foregoing reasons, HPL's motion to amend fails to set forth the written description support for each proposed substitute claim, in violation of both 37 C.F.R. § 42.121(b)(1) and § 42.121(b)(2).

### 3. *Patentability over Prior Art*

An *inter partes* review is neither a patent examination proceeding nor a patent reexamination proceeding. The proposed substitute claims, in a motion to amend, are not entered automatically and then subjected to examination. Rather, the proposed substitute claims will be added directly to the patent, without examination, if the patent owner's motion to amend claims is granted. The patent owner is not rebutting a rejection in an Office Action, as though this proceeding is a patent examination or a reexamination. Instead, the patent owner bears the burden of proof in demonstrating patentability of the proposed substitute claims over the prior

art in general, and thus entitlement to add these proposed substitute claims to its patent. In that regard, there is no presumption of validity as to the challenged claims or substitute claims in an *inter partes* review, and there is no inference of patentability of the substitute claims by virtue of that they are replacing the challenged claims.

In its motion to amend claims, HPL asserts that the “cited references (whether considered individually or in combination) do not disclose or render obvious the claimed Message ID.” Mot. A. 10-11. However, a mere conclusory statement that one or more added claim features are not described in the cited prior art, or would not have been suggested or rendered obvious by the prior art, is facially inadequate. HPL’s patentability analysis is limited to the prior art cited in the petition, and it does not identify the closest prior art known to HPL with respect to the proposed amended claims. HPL should have indicated, at least, that the prior art cited in the petition is the closest prior art known to HPL with respect to the proposed amended claims. Without indicating that its patentability analysis is based on the closest prior art known to HPL, HPL’s motion to amend provides insufficient information to establish that the patentability analysis as to the proposed claims is complete or reliable.

Moreover, HPL’s motion to amend is limited to anticipation analysis and does not demonstrate sufficiently that the substitute claims are nonobvious. *See, e.g., Minkin v. Gibbons*, 680 F.3d 1341, 1349-1351 (Fed. Cir. 2012) (A movant who was required to demonstrate patentability must prove, by a preponderance of the evidence, that the claims would have been

*novel and nonobvious.*). It is well settled that “anticipation and obviousness are separate conditions of patentability, requiring different tests and different elements of proof.” *Id.* at 1351; *see also KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 406-07 (2007).

Although HPL concludes that the substitute claims would not have been obvious to one of ordinary skill in the art (*see, e.g.*, Mot. 12), HPL merely discusses how each prior art reference cited in the petition individually does not disclose the features added in the substitute claim. Mot. 12-16. Such a patentability analysis is insufficient to demonstrate nonobviousness, because an analysis of whether the subject matter of a claim would have been obvious “need not seek out precise teachings direct to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *See KSR*, 550 U.S. at 418.

For instance, HPL states that “Smith is the sole reference asserted against the various identifier requirements of the ’241 claims and does not disclose or render obvious selective call signal including a message ID nor a message ID that uniquely identifies or specifies the location of the message stored in the storage unit.” Mot. 12. However, as discussed above, Smith discloses that the user can request a download of a particular remotely stored message from the server to the mobile device using the data items provided in the notification message that corresponds to the remotely stored message. Ex. 1006, 1:19-25; 2:46-50; 3:54-59; 10:42-56. More specifically, Smith discloses that while the actual message continues to be stored remotely in



the server on the network, the integrated message center permits the user, using his mobile device, to retrieve, view, prioritize, reply, edit, playback, discard, and forward the remotely stored message. *Id.* Given those teachings in Smith, one with ordinary skill in the art would have recognized that the data items provided in the notification message would contain sufficient information to identify the exact location of the remotely stored message so that the system can retrieve the message from the remote server and send it to the mobile device. In its motion to amend, however, HPL does not explain why it would not have been obvious to one with ordinary skill in the art to include a message ID that identifies the location of the message stored in the storage unit, in light of Smith that uses the data items provided in the notification message to locate and retrieve the remotely stored message. *See KSR*, 550 U.S. at 421 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”).

Additionally, HPL does not proffer any evidence as to the level of ordinary skill in the art at the time of the invention, which is a necessary factual inquiry for determining obviousness. *See Graham v. John Deere Co.*, 383 U.S. 1, 17-18. In fact, HPL does not address the level of ordinary skill in the art at the time of the invention and what was known previously regarding a message ID or a message ID that uniquely identifies or specifies the location of the message stored in the storage unit. At least some explanations should have been provided as to why a person with ordinary skill in the art, applying his or her own knowledge and creativity, would not have found the proposed claims obvious.

In sum, limiting the discussion to the references cited in the petition is insufficient to demonstrate patentability of the substitute claims over the prior art in general. Without having discussed the level of ordinary skill in the art, and what was known previously regarding the features added in the substitute claims, HPL's motion fails to demonstrate the patentability of the substitute claims.

#### *4. Conclusion*

For the foregoing reasons, HPL has not, in its motion, set forth a prima facie case for the relief requested or satisfied its burden of proof. Consequently, consideration of CBS's opposition and HPL's reply is unnecessary.

#### *D. CBS's Motion to Exclude Evidence*

CBS seeks to exclude: (1) the transcript of deposition testimony of Mr. Helferich on July 16, 2013 (Ex. 1041); (2) the transcript of deposition testimony of Dr. Mitchell on June 3, 2013 (Ex. 2012); (3) Declaration of Dr. Grindon (Ex. 2062 ¶¶ 41-43, 71, 72). Paper 94 ("Pet. Mot."). As the movant, CBS has the burden of proof to establish that it is entitled to the requested relief. 37 C.F.R. § 42.20.

CBS first argues that a portion of the transcript of Mr. Helferich's cross-examination testimony (Ex. 1041, 295:5-297:3) is outside the scope of Mr. Helferich's direct testimony (Ex. 2013), which was filed in support of

HPL's patent owner response for antedating Smith.<sup>5</sup> Pet. Mot. 1-2.

According to CBS, that portion of the transcript is cited in Exhibit 2026 ¶ 19. *Id.* HPL filed Exhibit 2026 in support of its reply (paper 89) to CBS's opposition (Paper 75) to HPL's motion to amend (paper 48).

CBS also submits that a portion of the transcript of Dr. Mitchell's cross-examination testimony (Ex. 2012, 100:1-11) is outside the scope of Dr. Mitchell's direct testimony (Ex. 1012). Pet. Mot. 3. CBS notes that HPL's patent owner response cites to that portion of the transcript to support its argument that Smith does not disclose a URL to a web page. *Id.* (citing PO Resp. 46).

Finally, CBS maintains that Dr. Grindon's testimony (Ex. 2062 ¶¶ 41-43, 71, 72) filed in support of HPL's reply concerning its motion to amend claims is inconsistent and unreliable as to what prior art he considered in forming his opinion. Pet. Mot. 5-11. Dr. Grindon's testimony (Ex. 2062) was submitted by HPL in support of its reply.

As indicated above, consideration of HPL's reply, as well as the evidence submitted in support of HPL's reply, is not necessary, because HPL did not, in its motion to amend claims, set forth a prima facie case for the relief requested or satisfied its burden of proof. Further, we also have indicated above that it is not necessary to consider HPL's argument

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<sup>5</sup> 37 C.F.R. § 42.53(d)(5)(ii) provides that "[f]or cross-examination testimony, the scope of the examination is limited to the scope of the direct testimony."

(PO Resp. 41-46) that Smith does not disclose a URL to a web page, as well as the related evidence, because the challenged claims do not require a URL and CBS relies upon other embodiments of Smith that we have determined to be sufficient to meet the limitations of the challenged claims. In any event, even without excluding HPL's evidence, we have determined that CBS has demonstrated, by a preponderance of the evidence, that the challenged claims of the '241 patent are unpatentable.

Accordingly, CBS's motion to exclude is *dismissed* as moot.

*E. HPL's Motion to Exclude Evidence*

HPL seeks to exclude the following: (1) the Reilly references<sup>6</sup> (Exs. 1028, 1030); and (2) a copy of Mr. Luch Deri's declaration (Ex. 1029). Paper 99 ("PO Mot."). As the movant, HPL has the burden of proof to establish that it is entitled to the requested relief. 37 C.F.R. § 42.20(c).

HPL argues that the Reilly references and the copy of Mr. Deri's declaration are new evidence and raise new issues, and that CBS has not demonstrated that the Reilly references are prior art. *Id.* at 1-3. HPL also contends that because Mr. Deri's declaration was submitted previously in the related reexamination proceedings rather than submitted as testimonial evidence in the instant proceeding, HPL did not have the opportunity to

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<sup>6</sup> Reilly et al., "Enabling Mobile Network Managers," Sixth International World Wide Web Conference (WWW6), <http://proceedings.www6conf.org/HyperNews/get/PAPER154.html>, pages 1-12 (April 7-11, 1997); Reilly et al., *Enabling Mobile Network Managers*, 29 COMPUTER NETWORKS AND ISDN SYSTEMS 1417-1428 (1997).

cross-examine Mr. Deri and, therefore, Mr. Deri's declaration is inadmissible hearsay and cannot be offered to prove the truth of the matter asserted. PO Mot. 4-8.

According to HPL, CBS submitted the Reilly references and the copy of Mr. Deri's declaration in support of its reply to HPL's patent owner's response. PO Mot. 1 (citing Pet. Reply 14). Specifically, CBS submitted the evidence to rebut HPL's argument that Smith does not disclose a URL to a web page. As articulated above, we have not considered CBS's rebuttal argument and related evidence—including the Reilly references and the copy of Mr. Deri's declaration—concerning the issue of whether Smith discloses a URL to a web page. The challenged claims do not require a URL and CBS relies upon other embodiments of Smith that we have determined to be sufficient to render the disputed limitations of the challenged claims obvious.

Accordingly, HPL's motion to exclude is *dismissed* as moot.

### III. CONCLUSION

CBS has met its burden of proof, by a preponderance of the evidence, in showing that claims 1, 3-5, 11, 13, 15, 16, 18, 20, 21, 23, 24, 26, 28, 29, 41, 43-45, 51, 53-56, 58, 60, and 61 are unpatentable under 35 U.S.C. § 103(a) over Smith and Alanara, and that claims 71, 73-75, 81, 82, 84, 86, 87, 89, 91, 92, and 94 are unpatentable under 35 U.S.C. § 103(a) over Smith, Alanara, and Kane.

HPL has not met its burden of showing that its proposed substitute claims are patentable.

IV. ORDER

In consideration of the foregoing, it is

ORDERED that claims 1, 3-5, 11, 13, 15, 16, 18, 20, 21, 23, 24, 26, 28, 29, 41, 43-45, 51, 53-56, 58, 60, 61, 71, 73-75, 81, 82, 84, 86, 87, 89, 91, 92, and 94 of the '241 patent are *cancelled*;

FURTHER ORDERED that HPL's Motion to Amend Claims is *denied*;

FURTHER ORDERED that CBS's Motion to Exclude Evidence is *dismissed*; and

FURTHER ORDERED that HPL's Motion to Exclude Evidence is *dismissed*.

Case IPR2013-00033  
Patent 7,155,241

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