

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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**MOTOROLA MOBILITY LLC**  
Petitioner,

v.

**MICHAEL ARNOUSE**  
Patent Owner.

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Case IPR2013-00010 (MT)  
Patent 7,516,484

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Before MICHAEL P. TIERNEY, JONI Y. CHANG and  
JENNIFER S. BISK, *Administrative Patent Judges*.

CHANG, *Administrative Patent Judge*

DECISION  
Institution of *Inter Partes* Review  
37 C.F.R. § 42.108

## I. BACKGROUND

On October 2, 2012, Motorola Mobility LLC (“Motorola”) filed a petition requesting an *inter partes* review of U.S. Patent 7,516,484 (“the ’484 patent”).<sup>1</sup> (“Pet.” Paper 2.) In response, the patent owner, Michael Arnouse (“Arnouse”), filed a preliminary response on January 7, 2013. (“PR” Paper 14.) We have jurisdiction under 35 U.S.C. §§ 6(b) and 314. The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a) which provides:

**THRESHOLD** -- The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

Motorola challenges the patentability of claims 1, 3, 7, 15, 16, 18, and 20 of the ’484 patent. We determine that the information presented in the petition and patent owner preliminary response shows that there is a reasonable likelihood that Motorola would prevail with respect to at least one challenged claim. Accordingly, we authorize an *inter partes* review to be instituted for the ’484 patent.

Motorola indicates that the ’484 patent is the subject of litigation styled *Arnouse Digital Devices Corp. v. Motorola Mobility, Inc.*, No. 5:11-cv-00155-cr (D. Vt.). (Pet. 2.)

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<sup>1</sup> The Board has determined that the petition was timely filed. (Paper 20.)

*A. The '484 Patent*

The '484 patent describes a reader adapted for a portable computer. (Ex. 1001, Abs.) According to the '484 patent, when the reader and portable computer are connected together, the combined system becomes a fully functional personal computer. (*Id.*) By itself without connecting to the portable computer, the reader is a non-functioning “shell” that includes at least one input device and at least one output device, such as a keyboard and a display. (*Id.*) A user cannot interact with the portable computer without the reader. (Ex. 1001, Abs.) Figure 4, reproduced below, shows a computer system that has a portable computer and a plurality of readers:

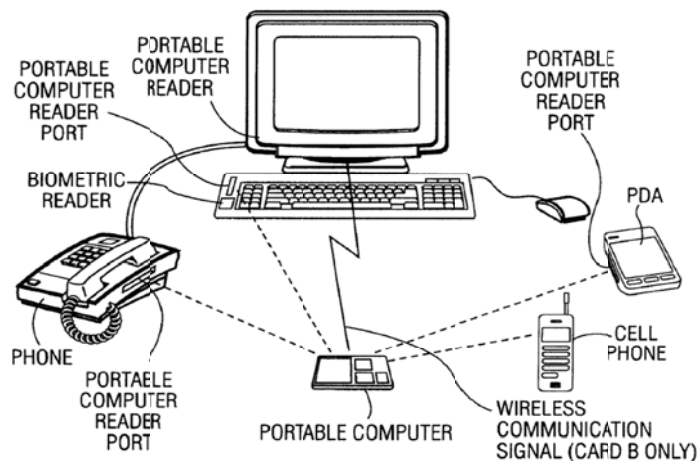


FIG. 4

Figure 4 illustrates an embodiment of the '484 patent.

As shown in Figure 4, a plurality of readers may be located at various locations so that a user may use the portable computer in those remote locations. (Ex. 1001 6:59-7:6.) The main function of the readers is to allow a user to interact with the portable computer. (*Id.*)

*B. Representative Claim*

On the claims challenged, claims 1 and 15 are the only independent claims. Claims 3 and 7 depend from claim 1, and claims 16, 18, and 20 depend from claim 15.

Claim 15, reproduced below, is representative:

A computing system comprising:

at least one portable computer, each comprising:

storage; and

at least one connector for connecting to at least one reader;

at least one reader, each comprising:

an input device;

an output device; and

a connector for connecting to the at least one portable computer,

wherein the portable computer excludes means for a user to interact directly with the portable computer,

wherein the reader and portable computer are configured to become a fully functioning computer when connected,

wherein the readers are configured so that they will not operate with a computer other than a portable computer of the system, and

wherein the reader is configured to be a non-functioning shell when not connected to the portable computer.

*C. Prior Art Relied Upon*

Motorola relies upon the following prior art references:

Nelson	U.S. Patent 5,436,857	Jul. 25, 1995	(Ex. 1004)
Kobayashi	U.S. Patent 5,463,742	Oct. 31, 1995	(Ex. 1003)
Jenkins	U.S. Patent 6,029,183	Feb. 22, 2000	(Ex. 1005)
Warren	U.S. Patent 6,999,792 B2	Feb. 14, 2006	(Ex. 1006)

*D. The Asserted Grounds*

Motorola challenges the patentability of claims 1, 3, 7, 15, 16, 18, and 20 of the '484 patent based on the following grounds (Paper 2 at 3-4):

1. Claims 1, 3, 7, 15, 16, 18, and 20 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Warren.
2. Claims 1, 3, 7, 15, 16, 18, and 20 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Kobayashi.
3. Claims 1, 3, 7, 15, 16, 18, and 20 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Nelson.
4. Claims 1, 3, 7, 15, 16, 18, and 20 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Jenkins.
5. Claims 1, 3, 7, 15, 16, 18, and 20 are unpatentable under 35 U.S.C. § 103(a) as unpatentable over Kobayashi, Nelson, or Warren in view of Jenkins.

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, claims are to be given their broadest reasonable interpretation consistent with the specification, reading claim language in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). This means that the words of the claim will be given

their plain meaning unless the plain meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989). In some cases, the ordinary meaning of claim language as understood by a person of skill in the art may be readily apparent even to lay judges, and claim construction in such cases involves little more than the application of widely accepted meaning of commonly understood words. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005) (en banc).

In its petition, Motorola states that the claim terms are presumed to take on their ordinary and customary meaning. (Pet. 5.) Motorola also states it “expressly reserves the right to present other interpretations of any of the ‘484 patent claims at a later time, which interpretation may differ, in whole or in part, from that presented within.” (Pet. 6.) In response, Arnouse argues that this statement amounts to a disavowal of any claim construction articulated in the petition and thus urges that the petition should be dismissed as incomplete. (PR 15-22.) We are not persuaded by Arnouse’s argument because Motorola also directs attention to the claim constructions made in the concurrent litigation, and identifies how the construed claims are unpatentable under the asserted grounds. (Pet. 38-52.) Moreover, we find Motorola’s statement reserving the right to present different interpretations in the future to carry little, if any, weight.

Motorola identifies the following claim language in claim 15 for which claim construction is sought: “the *portable computer excludes* means

for a user to interact directly with the portable computer.” (Pet. 39-42.)

In the related district court proceeding, Arnouse construed this limitation as<sup>2</sup>:

**By itself the portable computer cannot provide information to a user or receive information from a user.** In other words, the portable computer needs the reader for the user to interact with the programs, hardware, and user information of the portable computer. (Ex. 1013 at 6, row 2, col. 3.<sup>3</sup>) (emphasis added)

Motorola submitted the same construction (“by itself the portable computer cannot provide information to a user or receive information from a user”). (Ex. 1013 at 6, row 2, col. 2.)

Because that construction is also consistent with the specification of the ’484 patent and the plain meaning of the claim terms, we adopt it for this proceeding. For instance, the specification provides (Ex. 1001 col. 5:63-6:31, emphasis added):

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<sup>2</sup> Statements made in a related litigation may shed useful light to the meaning of the claim terms. Notably, the Joint Claim Construction and Prehearing Statement submitted by Motorola in Exhibit 1013 indicates how the parties construe the claim terms and where in the specification of the ’484 patent provides support for the terms. However, we recognize that statements made in the course of litigation may include some degree of bias and may support an interpretation more narrow than the broadest reasonable interpretation given by the Office. We thus discount any conclusory unsupported statements as to the definition of a claim term, and any statements that are contrary to the plain meaning of a term or the written description of the patent.

<sup>3</sup> All references to the page numbers in Ex. 1013 refer to the page numbers located at the bottom, middle portion of each page.

In most embodiments, the computer does not contain means for a user to interact directly with the computer. In other embodiments, the computer contains means for interacting therewith. *By interacting directly it is meant that a user cannot access the software programs, hardware or other functionality such as sounds, visuals, etc., on the computer without a portable computer reader, which provides the means for accessing the computer...*

As provided above, in one embodiment, the portable computer does not comprise means for a user to interact directly with the contents of the computer. For example, as shown in FIGS. 1-3, *the portable computer does not have a display or monitor, a keyboard or keypad, voice input device, etc.* Rather, such input devices are included on the portable computer readers. In other embodiments, the computer may have such input/output devices. For example, in one embodiment, the portable computer itself is a cell phone that can access the internet via a wireless network.

The claim language “*the portable computer excludes means for a user to interact directly with the portable computer*” is also similarly recited in the preamble of claim 1 (“*a portable computer without input and output means for interacting directly therewith*”). In general, a preamble limits the invention if it recites essential structure or steps, or if it is “necessary to give life, meaning, and vitality” to the claim. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999). Here, the preamble of claim 1 is entitled to patentable weight as it recites additional structure that is not included in the claim body. The parties do not dispute that the preamble of claim 1 is limiting. (Ex. 1013 at 1, row 1, col. 1-3.)



Lastly, we recognize that the claim element “means for a user to interact directly with the portable computer” is a means-plus-function element invoking 35 U.S.C. § 112, ¶ 6 (now recodified as 35 U.S.C. § 112(f)). Based on the disclosure of the ’484 patent, the corresponding structure of that element is any component that allows a user to directly provide information to, or receive information from, the portable computer, such as a keyboard, keypad, display, or voice input device, on the portable computer. (Ex. 1001 col. 5:63-6:31, reproduced *supra*.)

*B. Anticipated by Warren*

Motorola asserts that the challenged claims are unpatentable under 35 U.S.C. § 102(a) as anticipated by Warren. (Pet. 42, citing to Ex. 1006.) We do not agree. Rather, we find that Warren does not describe all of the claim limitations.

In particular, Warren does not disclose the limitation “the *portable computer excludes* means for a user to interact directly with the portable computer” as recited in claim 15 and similarly recited in claim 1. “Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention.” *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444 (Fed. Cir. 1984).

Warren discloses an input-output device having a phone port for connecting to a portable phone. (Ex. 1006, col. 1:65-67.) For instance, Figure 1, reproduced below, illustrates an input/output device in use with a

portable phone to communicate with a computer and another cell phone:

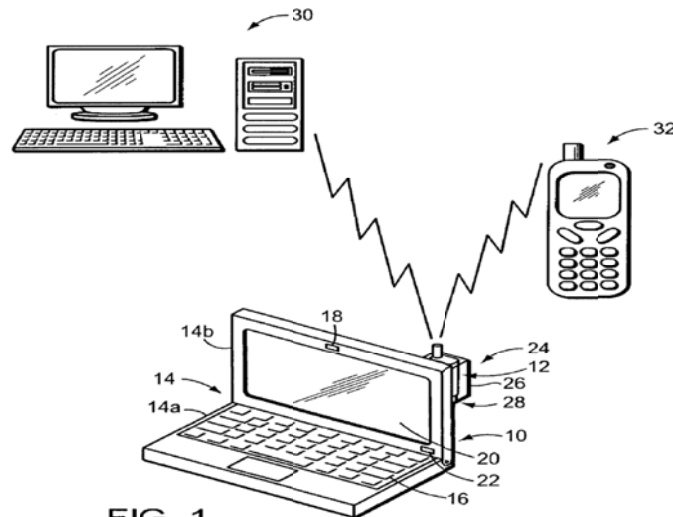


FIG. 1

Figure 1 illustrates an embodiment of Warren.

Referring to figure 1 of Warren, the input/output device 10 is shown as a laptop computer which includes a housing 14, keyboard 16, microphone 18, display screen 20, speaker 22, and phone interface 24 having a support member 26 that supports the portable phone 12 and a port 28 for communicating with the portable phone 12. (Ex. 1006, Abs; col. 4:15-43.) When the portable phone 12 is inserted into the support member 26, the user may bring up a web page or to view other data on the display 20 or utilize the keyboard 16 to enter data. (Ex. 1006, col. 4:44-62.)

As discussed *supra*, we construe the disputed limitation “the *portable computer excludes* means for a user to interact directly with the portable computer” as the portable computer, by itself, cannot provide information to a user or receive information from a user. Motorola equates Warren’s portable phone to the claimed portable computer. (Pet. 43.) However, we

do not find that Warren's portable phone meets the disputed limitation because Warren's portable phone *includes* a voice device, keyboard, and display screen, rather than *excludes* means for a user to interact directly with the portable phone.

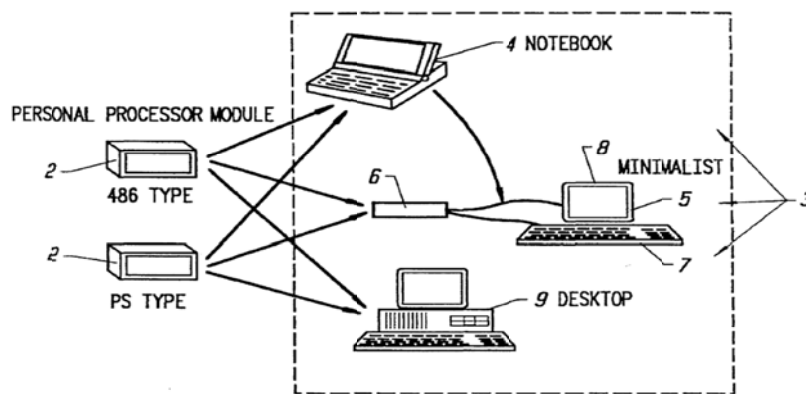
Specifically, Warren's portable phone, by itself, may be used as a conventional portable phone allowing the user to interact directly with the portable phone such as engaging in a conversation with another person and accessing information (*e.g.*, web pages or emails). (Ex. 1006, col. 1:20-27; 1:37-61; 4:44-56; 5:1-4.) Warren's portable phone has a mini keypad and display screen. (*Id.*) A user may enter data (*e.g.*, email messages) using the mini keypad and access to text and images of web pages using the mini display screen. (*Id.*) Given those disclosures, Warren's portable phone does not satisfy the limitation "the *portable computer* excludes means for a user to interact directly with the portable computer" as recited in claim 15 and similarly recited in claim 1. All other challenged claims depend from claim 1 or claim 15 and thereby require the same limitation.

For the foregoing reasons, Motorola has not demonstrated that there is a reasonable likelihood that it will prevail on its challenge that claims 1, 3, 7, 15, 16, 18, and 20 are anticipated by Warren. Accordingly, the petition is denied as to the ground based on Warren.

*C. Anticipated by Kobayashi*

Motorola asserts that the challenged claims are unpatentable under 35 U.S.C. § 102(a) as anticipated by Kobayashi. (Pet. 6.)

Kobayashi discloses a single user computer system that can be separated into two parts: (1) a personal processor module (PPM) that can be easily transported (a portable computer); and (2) a docking station that includes input and output devices such as a keyboard and a display. (Ex. 1003, col. 3:9-17.) The user gains access to the computer system by connecting the PPM to the docking station. (Ex. 1003, col. 3:24-31.) Each PPM has a processor with related logic, memory (RAM/ROM/CASH MEMORY), and a mass storage device. (Ex. 1003, col. 3:40-47.) The PPM accommodates the hardware and software related to personal processing capability, the customized operating system, the graphic user interface, and the application software. (Ex. 1003, col. 3:18-23.) Figure 1 of Kobayashi, reproduced below, illustrates several exemplary PPMs and docking stations:



*FIG. 1*

Figure 1 of Kobayashi shows several exemplary PPMs and docking stations.

The PPM does not contain user interface input/output devices and/or devices such a keyboard, display, printer and the like. (Ex. 1003, col. 3:53-55.) Therefore, the PPM always needs a docking station to allow user interaction. (Ex. 1003, col. 6:3-39.) The PPM works once it is connected to a docking station through a multi-connector. (Ex. 1003, col. 3:54-60.) The docking station has a physical connector 24 that interfaces with the PPM connector 22. (Ex. 1003, col. 5:64 to 6:1; Figures 2, 18-22.) As shown in Figures 2 and 18-22, the docking station is configured specifically to interact with the PPM.

The docking station includes a housing, the input and output devices (*e.g.*, keyboard and display), and the interfaces to those devices. (Ex. 1003, col. 4:1-5.) Figure 1 of Kobayashi shows a computer notebook 4 where the input device of the docking station comprises a keyboard and the connector is contained on the keyboard. (Ex. 1003, Figure1.) The docking station does not include a processor, the application software, and operating system, but rather these components are carried in and supplied by the PPM. (Ex. 1003, col. 5:55-60; 6:14-26.)

The explanations provided by Motorola as to how each element of the challenged claims is met by Kobayashi have merit and are un rebutted. Based on this record, Motorola has demonstrated that there is a reasonable likelihood that it would prevail with respect to claims 1, 3, 7, 15, 16, 18, and 20 based on the ground that Kobayashi anticipates these claims.

*D. Anticipated by Nelson*

Motorola asserts that the challenged claims are unpatentable under 35 U.S.C. § 102(a) as anticipated by Nelson. (Pet. 14.)

Nelson describes a personal computer module system that has two separable parts: (1) the processor, hard drive and memory module 10 (“processor module”), and (2) a PC base unit 36. (Ex. 1004, col. 1:37-52; Figure 2.) Figure 2 of Nelson, reproduced below, illustrates a portable PC base unit and an associated processor module:

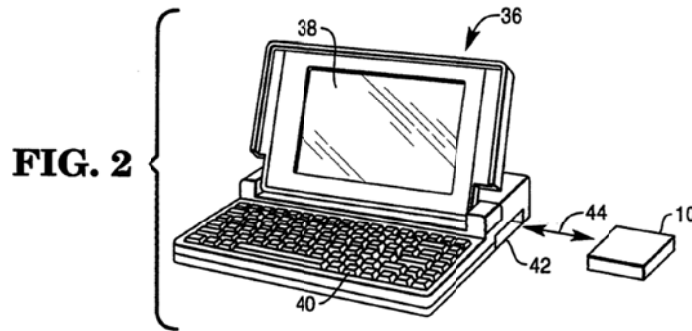


Figure 2 illustrates an embodiment of Nelson.

Figure 1 of Nelson, reproduced below, illustrates a block diagram of a processor module and an associated PC base unit:

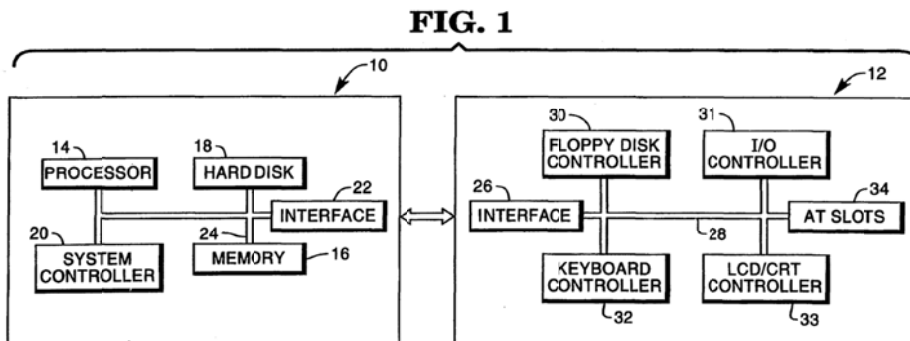


Figure 1 of Nelson shows a block diagram of a processor module and an associated PC base unit.

As shown in Figure 2 of Nelson, the PC base unit 36 is a portable PC base unit that includes a housing, a display 38, a keyboard 40, a base unit 12, and a receptacle 42 which is configured to receive the module 10.

(Ex. 1004, col. 2:51-63.) A user may insert the processor module 10 into a PC base unit 36 to enable operations of the combined units as a complete data processing system. (*Id.*)

Nelson's processor module 10 includes a processor 14, a memory 16, a hard disk unit 18, a system controller 20, and an interface 22. (Ex. 1004, col. 2:25-30.) As shown in Figures 1 and 2, the processor module 10 does not include input and output devices for a user to interact directly with the processor module 10. (Ex. 1004, Figures 1-2.) Further, the PC base unit 12 does not include a processor, system controller, and memory, and therefore it could not function when it is not connected to the processor module 10. (*Id.*)

The interface 22 enables the processor module 10 to be coupled to the PC base unit 12. (Ex. 1004, col. 2:25-30.) The PC base unit interface 26 engages the interface 22 of the module 10 to couple the module 10 to the base unit 12. (Ex. 1004, col. 2:35-37.) "As represented by the double-headed arrow 44 in Figure 2, the module 10 may be readily moved into and out of the housing of the portable PC 36, with the interface 22 of the module 10 moving into and out of operative coupling with the interface 26 of the base unit 12." (Ex. 1004, col. 2:57-63.)

The explanations provided by Motorola as to how each element of the challenged claims is met by Nelson have merit and are un rebutted. Based on this record, Motorola has demonstrated that there is a reasonable likelihood that it would prevail with respect to claims 1, 3, 7, 15, 16, 18, and 20 based on the ground that Nelson anticipates these claims.

*E. Other Asserted Grounds*

Motorola also asserted that the challenged claims are anticipated by Jenkins and unpatentable over Kobayashi, Nelson, or Warren in view of Jenkins. Those asserted grounds are unnecessary as cumulative in light of the determination that there is a reasonable likelihood that the challenged claims are anticipated by Kobayashi and Nelson. Accordingly, the petition is denied as to the ground based on Jenkins and obviousness ground based on Kobayashi, Nelson, or Warren in view of Jenkins.

III. CONCLUSION

For the forgoing reasons, we determine that the information presented in the petition and patent owner preliminary response shows that there is a reasonable likelihood that Motorola would prevail with respect to claims 1, 3, 7, 15, 16, 18, and 20 of the '484 patent.



#### IV. ORDER

For the forgoing reasons, it is

**ORDERED** that pursuant to 35 U.S.C. § 314, an *inter partes* review is hereby instituted for the following grounds:

1. Claims 1, 3, 7, 15, 16, 18, and 20 as anticipated by Kobayashi; and
2. Claims 1, 3, 7, 15, 16, 18, and 20 as anticipated by Nelson;

**FURTHER ORDERED** that no other ground is authorized for the *inter partes* review;

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

**FURTHER ORDERED** that an initial conference call with the Board is scheduled for 2:00 PM Eastern Time on March 13, 2013; the parties are directed to the Office Trial Practice Guide, 77 *Fed. Reg.* at 48765-66, for guidance in preparing for the initial conference call, and should come prepared to discuss any proposed changes to the Scheduling Order entered herewith and any motions the parties anticipate filing during the trial.

Case IPR2013-00010  
Patent 7,516,484

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