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Paper No. 61
Date Entered: April 24, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA SOLUTIONS, INC.
Petitioner

v.

MOBILE SCANNING TECHNOLOGIES, LLC
Patent Owner

Case IPR2013-00093
Patent 6,065,880

Before, GLENN J. PERRY, BRIAN J. McNAMARA and MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

McNAMARA, *Administrative Patent Judge*.

FINAL WRITTEN DECISION

35 U.S.C. § 318(a) and
37C.F.R. § 42.73

BACKGROUND

Motorola Solutions, Inc. ("Petitioner") filed a petition for *inter partes* review (Paper 9, "Petition") of claims 18-20 of U.S. Patent No. 6,065,880 ("the '880 Patent") owned by Mobile Scanning Technologies LLC ("Patent Owner").

In a Decision to Institute entered on April 29, 2013 (Paper 28), we instituted a trial on the following grounds under 35 U.S.C. § 102:

Claim 18 as anticipated by Ruppert[1];

Claim 18 as anticipated by PPT4100 System Administration Manual[2]; and

Claim 20 as anticipated by PPT4100 System Administration Manual.

We also instituted a trial on the following grounds under 35 U.S.C. § 103:

Claims 18, 19 and 20 as unpatentable over the combination of Ruppert and Dvorkis[3]; and

Claims 18, 19 and 20 as unpatentable over the combination of the PPT4100 System Administration Manual and the SE1000 Series Integration Guide[4].

In this Final Written Decision, we hold that claims 18, 19 and 20 of the '880 Patent are unpatentable.

THE '880 PATENT

The '880 Patent describes an adapter electrically coupled to a personal data assistant (PDA). (Ex.1001, Abstract). The adapter includes a laser or other light

[1] U.S. Patent No. 5,424,524 (Ex. 1019).
[2] PPT4100/4110 System Administration Manual, Rev. A, Symbol Technologies, Inc., May, 1994 (Ex. 1011).
[3] U.S. Patent No. 5,552,592 (Ex. 1024).
[4] SE1000 Series Scan Engine Family Specification, Symbol Technologies, Inc., 1994 http://web.archive.org/web/19980615025136/http://www.symbol.com/STooooo70.HTM (Ex. 1006).

source which emits a light beam that can be modified into a digital signal to download information to a PDA equipped with a photo detector or to be used as a presentation pointer. Ex. 1001, Abstract. The adapter also includes a photo detector positioned so that light from the laser can be reflected from a bar code, received by the photo detector, and converted to a digital signal, which is then forwarded to the PDA. *Id.* Electronic components of the adapter can be integrally incorporated into the PDA, so as to eliminate the need for the adapter. *Id.* at col. 2, ll. 22-24. A single embedded PDA design is the subject of the challenged claims. The PDA is conventional. *Id.* at col. 2, ll. 60-61.

ILLUSTRATIVE CLAIMS

Claim 18 of the '880 patent, which was amended as indicated in an *ex parte* reexamination certificate issued under 35 U.S.C. § 307, is illustrative of the subject matter at issue in this proceeding.

> 18. A PDA comprising:
> a single embedded PDA design comprising:
> (a) a housing having a front face extending between a top end and an opposing bottom end, a display screen is positioned on the front face and an interface connector is positioned at the bottom end,
> (b) a micro controller is disposed within the housing and is electrically coupled to the connector;
> (c) a laser is disposed within the housing and is configured to emit a light beam through the top end of the housing;
> (d) an analog to digital converter is disposed within the housing and is electrically coupled with the micro controller
> (e) a photo detector is positioned at the top end of the housing and is configured to receive reflected light from the laser.

Claim 19, which depends from claim 18, recites that the PDA further comprises means for converting light from the laser into a digital signal. Claim 19 does not recite whether this means is for transmitted light or received light.

Claim 20, which also depends from claim 18, recites that "the laser emits a visible red light that is sufficiently collimated to function as a pointer."

CLAIM CONSTRUCTION

As discussed further herein, a significant issue raised by the parties in this case concerns the construction of the term "personal data assistant" (PDA). We extensively addressed the construction of PDA in our Decision to Institute at pages 6-11. For the reasons discussed therein, we construed PDA to mean *a substantially hand-sized computer used for storing and manipulating an amount of data and capable of exchanging information with a host. Id.* at 11. Patent Owner advocates a different construction, i.e., one that includes a synchronization functionality. *See* PO Resp. 6-12.

In *inter partes* review, a claim of an unexpired patent is given its broadest reasonable construction consistent with the specification of the patent in which it appears. 37 C.F.R. § 41.100(b).

The specification of the '880 Patent states:

> Personal data assistants (hereinafter "PDAs") are small, substantially hand-sized computers that are used for storing, manipulating, and retrieving a defined amount of data.

Ex. 1001, col. 1, ll. 11-13.

The specification identifies "[o]ne example of a PDA is the PalmPilot®," which is manufactured by 3Com and functions primarily as an electronic day planner and address recorder. *Id.* at col. 1, ll. 13-16. Patent Owner's expert, Dr. Ikhlaq Sidhu, testified that the '880 Patent "doesn't go into specifics of what a PDA is[,] except possibly to indicate that the PalmPilot PDA is . . . an example of a PDA." Ex. 1047, 175.

The specification states that a shortcoming of PDAs is that the process for transferring data between a PDA and a personal or network computer requires physically, electrically coupling a cradle to the host computer and physically, electrically coupling the PDA to the cradle, so that software in the host can access the PDA to download or upload information between the host and the PDA. Ex. 1001, col. 1, ll. 17-24. Thus, one object of the invention is to download information quickly and easily to a host without physically, electrically coupling the PDA to the host. *Id.* col. 1, ll. 39-43. According to the '880 Patent, another shortcoming of PDAs is the difficulty of manually inputting data into devices that lack a keyboard. *Id.* at col. 1, ll. 29-35. Thus, a second objective is to provide a PDA with an adapter that can be used to load data quickly into the PDA. *Id.* col. 1, ll. 44-47. The "inventive adapter," *id.* at col. 2, ll. 60-61, whose electronics can be integrally incorporated with a PDA, is a bar code scanner structure, as described above in our discussion of the '880 Patent.

The preamble of the claims is drawn to a PDA. The claim limitations recite only a single embedded PDA design.[5] The claimed design comprises specific hardware elements, i.e., a housing, a microcontroller, a laser, an analog-to-digital converter, and a photo-detector.

Patent Owner contends that "the '880 Patent does not suggest that all hand-sized computers are PDAs, nor does it suggest that the term PDA, as used in the claims, should not be interpreted as including other aspects of PDAs known to those of skill in the art." PO Resp. 10. Notwithstanding the description of PDA given in the specification cited above, Patent Owner argues that the function of

[5] We have construed "single embedded PDA design" to mean that all the components of the claim are integrated within a single device. Dec. to Institute, 13-14.

recording personal information, such as day planner and address book information, as performed by the exemplary PalmPilot®, requires that the claim be construed to include the ability to synchronize data with a host computer. *Id.* at 8. Patent Owner notes that our Decision to Institute referenced the Pilot Handbook, published by U.S. Robotics, a predecessor of 3Com, which states that one can use a desktop computer to synchronize and back-up the data stored in one's Pilot, or to transfer data into the Pilot from other sources such as a database application. PO Resp. 11, s*ee*, Ex. 1026, 8. It is not clear from this text how "synchronize" differs from "back up." In addition, transferring data from a database to a Pilot is not synchronization of the Pilot and the database.

Citing the testimony of its expert, Dr. Sidhu, Ex. 3014 ¶14, Patent Owner further states that:

> Synchronization in the context of a PDA and host computer means that as a system, the PDA and the host computer each keep a copy of data stored by certain applications running on the PDA; that is, the same data is also stored by parallel applications on the host computer when synchronization occurs.

PO Resp. 8. Dr. Sidhu testifies that, in contrast to a day planner, which is a paper version of a PDA, maintaining on a host computer a copy of the data entered on a PDA avoids losing information when the PDA is lost or damaged, and allows information to be entered either at the PDA or the host. PO Resp. 8-9, Ex. 1034 ¶13.

It is noteworthy that neither Patent Owner nor Dr. Sidhu cites to any disclosure in the '880 Patent specification supporting the importation of a synchronization function into the claims or to any support for Patent Owner's proposed definition of synchronization. *See*, Ex. 1047, 175, 177. Claim 18

includes the term PDA in its preamble, but limits the claimed subject matter to a PDA comprising a single embedded PDA design incorporating specific physical elements. Claim 18 does not recite the functionality described by Patent Owner and Dr. Sidhu, nor does the '880 Patent specification discuss such functionality as an element of PDA design.

Patent Owner does not address how the ability to back-up PDA data on a host computer or the ability to transfer data from a host to a PDA requires synchronization. Patent Owner argues that allowing a data set to be kept common between the host computer and a PDA, regardless of which data set is changed first, conforms to Webster's definition of "synchronizing," i.e., "1: to represent or arrange (events) to indicate coincidence or coexistence." PO Resp. 9. Events, or in this case data, that are synchronous occur coincidently or coexist. There is no requirement in the definition of synchronous that the data in two devices be identical. Devices are synchronized when they perform tasks or contain data simultaneously or in a fixed time relationship, even if those devices contain different data. Claim 18 recites a design that incorporates physical elements, but recites no functional limitations on the PDA and no events or data that are coincident or coexist. The Patent Owner does not identify any description in the '880 Patent of events or data that are coincident or coexist.

Dr. Sidhu's explanation of synchronization merely states that the PDA and the host computer keep a copy of data stored by certain applications running on the PDA when synchronization occurs. PO Resp. 8, Ex. 1034 ¶14. Dr. Sidhu's proposed definition does not state whether the host computer keeps a copy of all the data stored by a particular application running on the PDA, which applications constitute the "certain applications" in his proposed definition, when

synchronization occurs, or how synchronization is implemented. The ’880 Patent contains no disclosure concerning such synchronization issues.

Dr. Sidhu also testified that the ’880 Patent does not describe how synchronization happens in a PDA and that the purpose of the ’880 Patent is to describe another invention that is related to a PDA. Ex. 1047, 177. As previously discussed, the ’880 Patent specification states that the objective of the “inventive adapter” is to ease inputting data to a PDA, e.g., by reading a bar code, and to improve transferring data to a host. The ’880 Patent does not describe the content of that data, or state that any data in the PDA and the host must be the same at any particular time.

In consideration of the above, we are not persuaded that the presence of the term PDA requires that we construe the claims to include a synchronization functionality that is neither claimed nor described in the ’880 Patent.

Patent Owner also argues that the term PDA should be limited further to synchronizing data from a “personal assistance application.” PO Resp. 12. Although Patent Owner does not define “personal assistance application,” Patent Owner argues that the term involves storing “personal information.” *Id.* at 18. We understand Patent Owner’s argument to be that personal information means day planer and address information stored by the PalmPilot.® The claims of the ’880 Patent recite a PDA, are not limited to a PalmPilot, and do not recite any particular data. Particular embodiments in the written description will not be used to limit claim language that has broader effect. *Electro Sci. Indus., Inc. v. Dynamic Details, Inc.*, 307 F. 3d 1343, 1349 (Fed. Cir. 2002).

The ’880 Patent contradicts Patent Owner’s proposed limited construction. The ’880 Patent states:

> As a result of being able to scan bar code readings into the PDA, the functionality of the PDA is substantially increased. For example, the PDA can now effectively be used for monitoring and controlling inventory or other products on which bar codes can be positioned.

Ex. 1001, col. 2, ll. 17-21.

In light of the above, PDA, as used in the claims of the ’880 Patent, is not limited to a device that runs a personal assistance application or stores personal information.

Notwithstanding the disclosed inventory monitoring function, Patent Owner argues that there is no requirement in the definition of PDA that inventory data be synchronized with a host computer. PO Resp. 17. We agree. The ’880 Patent specifically states that depending upon the intended use and operational software, the PDA can simply store the bar code reading. Ex. 1001, col. 5, ll. 1-8. Thus, PDA, as used in the ’880 Patent, is not limited to devices that run personal applications or synchronize data with a host computer.

In view of Patent Owner’s position that the disclosed functions of monitoring and controlling inventory by a PDA do not require synchronization, the absence of any disclosure concerning synchronizing data in address and day planner applications, and the absence of any limitation concerning synchronization in the claims of the ’880 Patent, we do not limit the claimed PDA to one that synchronizes personal information with a host computer.

As discussed at pages 6-11 of our Decision to Institute, we construe PDA to mean *a substantially hand-sized computer used for storing and manipulating an amount of data and capable of exchanging information with a host.*

ANALYSIS OF PRIOR ART CHALLENGES

Challenges Under 35 U.S.C. § 102

Claim 18 as Anticipated by Ruppert

Our Decision to Institute addresses anticipation of claim 18 at pages 23-25. In that decision, we determined that Ruppert discloses a personal scanning device that comprises a bar code scanner coupled to a specially programmed digital computer that can use the output of the bar code reader. Ex. 1019, col. 4, ll. 34-39. Ruppert's personal scanner has a display screen 12 on a front face of the housing and a communications port 40 on the bottom, *id.*, Fig. 1, as recited in element (a) of claim 18. Within the housing, Ruppert discloses in Figure 3 that barcode scanner 46 is connected to microprocessor 40, which also is connected to a serial or parallel bi-directional data communications interface and port 85. *Id.* at col. 8, ll. 21-28. We have construed the microcontroller recited in claim 18 to include a microprocessor. Ruppert discloses that the microprocessor is electrically coupled to the interface connector, as recited in element (b) of claim 18. As recited in element (c) of claim 18, Ruppert is configured to emit a light beam, including a laser light beam, through scan window 18 at the top end of the housing. *Id.* at col. 5, ll. 44-55, Fig. 1. We also have determined that Ruppert inherently discloses an analog-to-digital converter electrically coupled to a photo-detector, as recited in elements (d) and (e) of claim 18. Dec. to Institute 25.

The Patent Owner Response does not dispute any of these findings. PO Resp. 12-14. Patent Owner argues that Ruppert does not anticipate claim 18 because, in failing to disclose that any data is synchronized between the personal bar code scanner and a host computer, Ruppert does not disclose a single embedded design having certain characteristics of a PDA. *Id.* at 5, 14. As we discussed above, claim 18 is drawn to a design that includes the above-described

structural elements. Claim 18 does not recite a synchronization functionality or a particular personal assistance application program, nor does the '880 Patent describe a synchronization functionality as an element of a PDA. Having determined that each of the structural elements recited in claim 18 is disclosed in Ruppert, we find that Petitioner has demonstrated by a preponderance of the evidence that Ruppert anticipates claim 18.

Applying Patent Owner's proposed construction of PDA would not alter the outcome.[6] The specification states that the PDA is conventional. Ex. 1001, col. 2, ll. 60-61. The structure recited in claim 18 does not impose any limitation on the functions performed by this admittedly conventional device. As discussed above, Ruppert discloses the incorporation of the claimed elements into a conventional device. Thus, even under Patent Owner's construction, the preponderance of the evidence demonstrates that claim 18 is anticipated by Ruppert.

Claim 18 Anticipated by PPT 4100 System Administration Manual

Our Decision to Institute, at pages 28-29, addressed anticipation by the PPT4100 System Administration Manual. The PPT4100 System Administration Manual discloses a hand-held computer, Ex. 1011, 1-1, that stores and manipulates an amount of data, *id*. 1-8, 3-1, and is capable of exchanging information with a host, *id*. at 1-1, 1-8, 3-1. The PPT4100 is a single embedded PDA design because the PPT 4100 System Administration Manual discloses all these features in an integrated apparatus.

As recited in element (a) of claim 18, the PPT4100 has a housing with a front face with display screen 4, a top end with scanner window 9 and an opposing

[6] We reach this issue because Patent Owner's Contingent Motion to Amend, as discussed further herein, proposes a substitute claim that recites explicitly the synchronization feature Patent Owner contends is inherent in the term PDA.

bottom end where serial communications port 20 is located. *Id*. at 1-5, 1-6. The PPT4100 also has a microcontroller in the form of a CPU, *id.* at 3-6.
The specification for the PPT4100 identifies the CPU as a PC-chip F8680A. Ex. 1012, 2. Software can be loaded into the PPT4100 to allow the terminal to run applications from an SRAM card. Ex. 1011, 3-1, 3-14. Among the applications is a DATA I/O driver. *Id.* at 3-13. Thus, we agree with Petitioner that the PPT4100 discloses a microcontroller electrically coupled to the interface connector, as recited in element (b) of claim 18.

The PPT4100 System Administration Manual shows that the PPT4100 incorporates an integrated bar code scanner, Ex. 1011, 4-4, 4-5, which emits light through the scanning window, thus disclosing a laser disposed within the housing to emit a light beam from a top end of the housing, as recited in element (c) of claim 18.

The PPT4100 specification sheet indicates that the PPT4100 incorporates the SE1000 scanning engine, which would include a photo-detector to receive light reflected from the bar code and an analog-to-digital converter to process the signal. *See* Dec. to Institute 29.

The Patent Owner does not dispute our findings concerning the structure of the PPT4100 as disclosed in the PPT System Administration Manual. PO Resp. 14-15. Patent Owner agrees that the PPT4100 discloses a data collection device to collect information from bar codes and transmit various information, including the bar code information, to a host computer. PO Resp. 5. However, Patent Owner argues that the PPT4100 System Administration Manual does not anticipate claim 18 because, in failing to disclose data is synchronized between the personal bar code scanner and a host computer, the reference fails to disclose a single embedded design with the characteristics of a PDA. *Id.* at 5, 14. As we discussed above,

claim 18 is drawn to a design that includes the above-described structural elements. Claim 18 does not recite a synchronization functionality or any particular personal assistance application program or data, nor does the '880 Patent describe a synchronization functionality as an element of a PDA. Having determined that the PPT4100 System Administration Manual discloses each of the structural elements recited in claim 18, we conclude that Petitioner has demonstrated by a preponderance of the evidence that the PPT4100 System Administration Manual anticipates claim 18.

Applying Patent Owner's proposed construction of PDA would not alter the outcome.[7] The specification states that the PDA is conventional. Ex. 1001, col. 2, ll. 60-61. The structure recited in claim 18 does not limit the functions performed by this admittedly conventional device. As discussed above, the PPT4100 System Administration manual discloses the incorporation of the claimed elements into a conventional device. Thus, even under Patent Owner's construction, the preponderance of the evidence demonstrates that Ruppert anticipates claim 18.

Claim 20 as Anticipated by the PPT4100 System Administration Manual

Claim 20 depends from claim 18 and recites that the laser emits a visible red light sufficiently collimated to function as a pointer. Claim 20 limits only the characteristics of the laser and does not recite that the PDA, itself, functions as a pointer. The PPT4100 specification sheet discloses that the built-in SE1000 scanner uses a 675nm laser diode, Ex. 1012, 2-4, which, as noted in the declaration of Petitioner's expert Dr. David Allais ("Allais Decl."), is in the red color range. Ex. 1002, ¶ 0073. Therefore, the claimed collimated visible red laser is necessarily

[7] We reach this issue because Patent Owner's Contingent Motion to Amend, as discussed further herein, proposes a substitute claim that recites explicitly the synchronization feature Patent Owner contends is inherent in the term PDA.

present, and hence inherent, in the PPT4100. *See Akamai Techs., Inc. v. Cable & Wireless*, 344 F.3d 1186, 1192 (Fed. Cir. 2003); *Rosco, Inc. v. Mirror Lite Co.*, 304 F. 3d 1373, 1380 (Fed. Cir. 2002).

Patent Owner repeats the arguments it asserted with respect to claim 18, but does not provide any other evidence that claim 20 is patentably distinguished from the PPT4100 System Maintenance Manual. As discussed above, however, Petitioner has demonstrated by a preponderance of the evidence that the PPT4100 System Administration Manual anticipates claim 18. We conclude that Petitioner has shown by a preponderance of the evidence that the PPT4100 System Administration Manual anticipates claim 20. For the reason discussed above with respect to claim 18, we would reach the same conclusion applying Patent Owner's proposed construction of PDA.[8]

Challenges Under 35 U.S.C. § 103

Claims 18, 19 and 20 as unpatentable over the combination of Ruppert and Dvorkis

In this decision, we previously discussed the disclosure provided by Ruppert. Our Decision to Institute notes that Dvorkis, Exhibit 1024, discloses a prior art scanner in a housing with a laser light source, a detector producing an analog signal proportional to the intensity of reflected light, and a microprocessor and associated memory to digitize the analog signal. Dec. to Institute 26-27. Patent Owner does not dispute that Dvorkis discloses these elements of claim 18 or claim 20. PO Resp. 19. Patent Owner also does not dispute that the structure corresponding to the means for converting light from the laser to a digital signal

[8] We reach this issue because Patent Owner's Contingent Motion to Amend, as discussed further herein, proposes a substitute claim that recites explicitly the synchronization feature Patent Owner contends is inherent in the term PDA.

recited in claim 19, which we discussed in our Decision to Institute at pages 31-33, is disclosed by Dvorkis. *Id*. Patent Owner argues that Petitioner has failed to establish that the references disclose the characteristics of a PDA, i.e., a personal assistance application and the ability to synchronize data with a host computer, or that the inclusion of a synchronization feature would have been obvious to one of ordinary skill in the art. *Id.*

As we have discussed previously, claims 18, 19, and 20 are not limited to performing a synchronization function, nor does the '880 Patent disclose such a feature, as Patent Owner argues distinguishes the claims over Ruppert and Dvorkis. PO Resp. 19-20. For this reason, we conclude that the preponderance of the evidence demonstrates that claims 18-20 would have been obvious over the combination of Ruppert and Dvorkis.

We would reach the same conclusion, even under Patent Owner's proposed construction of PDA.[9] Ruppert discloses a personal scanning device, i.e., one used by a shopper, who, upon entering a store, downloads a price list from a store's computer, Ex. 1019, col. 6, ll. 1-18; col. 8, ll. 21-35, scans items into the device while shopping, and checks out by transferring the scanned information to the store's computer. *Id.* at col. 3, ll. 43, 47; Fig, 5; col. 9, ll. 54-61; col. 11, ll. 11-26. Even under Patent Owner's construction, Ruppert discloses that it would have been obvious for a PDA with the claimed structure to run a personal application that synchronizes its data to a host computer. Thus, even applying Patent Owner's construction to the claims, we conclude that the claims 18-20 would have been obvious over the combination of Ruppert and Dvorkis.

[9] We reach this issue because Patent Owner's Contingent Motion to Amend, as discussed further herein, proposes a substitute claim that recites explicitly the synchronization feature Patent Owner contends is inherent in the term PDA.

Claims 18, 19 and 20 as unpatentable over the combination of the PPT4100 System Administration Manual and the SE1000 Series Integration Guide

We discussed the disclosure in the PPT4100 System Administration Manual in an earlier section of this decision. Our Decision to Institute details the disclosure concerning scan engine implementation in the SE 1000 Series Integration Guide. Dec. to Institute 29-30. Patent Owner does not dispute that SE1000 Series Integration Guide discloses the corresponding claim elements. PO Resp. 16-18.

Patent Owner argues that the handheld computer in PPT4100 lacks PDA characteristics because it fails to teach a personal assistance application and the ability to synchronize. *Id.* Patent Owner also argues that Petitioner has failed to provide evidence that it would have been obvious to incorporate synchronization of data between a PDA and a host computer. Patent Owner argues that there would be no reason to include data synchronization capability in the PPT4100 device (or the device disclosed by Ruppert) because these devices do not store personal information. PO Resp. 18.

As previously discussed, the claims of the ’880 Patent are not limited to PDAs that store personal information. The claims also are not limited to circumstances in which data is synchronized. Ex. 1001, col. 2, ll. 5-21. The specification identifies inventory monitoring and control as one function of a PDA design incorporating the claimed physical elements. In the context of inventory control, the ’880 Patent specification describes a PDA with an integrated bar code scanner that can be used simply to store the bar code information. *Id.* at col. 5, l. 1-8. For these reasons, we conclude that the preponderance of the evidence demonstrates that claims 18-20 would have been obvious over the combination of

the PPT1000 Systems Administration Manual and the SE 1000 Series Integration Guide.

Objective Indicia of Non-Obviousness

Objective criteria constitute independent evidence of non-obviousness. *Mintz v. Dietz & Watson, Inc*., 679 F.3d 1372, 1378 (Fed. Cir. 2012). Patent Owner argues that Petitioner's Enterprise Mobility Division enjoyed net sales of nearly three billion USD in 2013 and, since its failed alliance with 3Com, Petitioner and the acquired Symbol Technologies company have generated an estimated 25 billion USD in sales. PO Resp. 22-23. Where the patent is said to cover a feature or component of a product, the patent owner has the burden of showing that the commercial success derives from the feature. *Tokai Corp., v. Easton Enters*., 632 F. 3d 1358, 1369 (Fed. Cir. 2011). Where that feature is found in the product of another, there must be proof that the feature falls within the claims. *E.g.*, *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (infringer's counsel stated at trial that the patent had been copied); *Hughes Tool Co. v. Dresser Indus*., *Inc*., 816 F.2d 1549, 1552 (Fed. Cir. 1987) (patented O-ring seal copied by defendant). Patent Owner has provided as Exhibits 3016-3019 documentation concerning certain graphics calculators. However, Patent Owner has made no showing of any nexus between these graphics calculator products and Petitioner's sales and, more importantly, no nexus between Petitioner's sales, the graphics calculators, and the subject matter recited in the claims.

Considering all the evidence, including the objective indicia cited by Patent Owner, we conclude that the preponderance of the evidence demonstrates that claims 18-20 would have been obvious.

MOTION TO AMEND

Having determined that claims 18-20 of the ’880 Patent are unpatentable, we consider Patent Owner’s Contingent Motion to Amend (Paper 44, “Motion to Amend”). Patent Owner’s proposed substitute claim 21 seeks to amend claim 18 by reciting that the single embedded PDA design is “configured to exchange and synchronize data with a host computer.” As support for this amendment, Patent Owner cites original U.S. Appl. Ser. No. 09/036,851 (Exhibit 3015, “the ’851 application”), which matured into the ’088 Patent. Patent Owner notes that page 6, lines 3-4 of the ’851 application states “[i]n one embodiment of the present invention, PDA 12 includes a PalmPilot® made by 3Com.” Motion to Amend 4. According to Patent Owner, “[a]t the time the application was filed, one skilled in the art would have appreciated that PalmPilot devices had the capability to synchronize, exchange and back up data with a host computer (e.g., using the HotSync feature of a PalmPilot device).” *Id.*

We deny Patent Owner’s Motion to Amend. Although the ’851 application identifies the PalmPilot as one embodiment of a PDA, the claim is drawn more generally to a “single embedded PDA design” rather than to a PalmPilot. The language cited by Patent Owner states only that in one embodiment of the invention the PDA includes a PalmPilot. The written description does not state that there is only one embodiment. The written description does not state that, even in the one embodiment referenced, the PDA is a PalmPilot. Instead, the specification states that PDA includes a PalmPilot.

Patent Owner has identified no written description of the claimed PDA performing a synchronization function. Patent Owner’s expert, Dr. Ikhlaq Sidhu, testified that the ’880 Patent does not go into specifics of what a PDA is, except to indicate that the PalmPilot is an example of a PDA. Ex. 1047, 175. Dr. Sidhu also

testified that the specification of the ’880 Patent does not include a writing stating that synchronization is a necessary feature of a PDA, or a description of how such synchronization would be implemented. *Id.* at 176-177.

Patent Owner argued at the oral hearing that, in specifying synching, its proposed amendment simply clarifies what Patent Owner believes is an inherent feature of a PDA. Tr. 66. However, Patent Owner’s importation of a synchronization function into the claimed PDA is inconsistent with the description at page 9, lines 19-23, of the ’851 application, which states:

> By using the above configuration, bar codes can be quickly entered into PDA 12 without having to manually input the information. Depending on the intended use and operational software, PDA 12 can either *simply store the bar code reading* or can be used to access other information based on the bar code reading. By using adapter 10, PDA 12 can be used for inventory control or in other situations where bar codes can be used.

Ex. 3015, 9 (emphasis added).

Thus, synchronization is not necessarily inherent in a PDA, as that term is used in the specification of the ’880 Patent. In the absence of a specific description limiting the claimed PDA to one “configured to exchange and synchronize data with a host computer,” the above description of a PDA in the specification does not support Patent Owner’s proposal to limit claim 18 in this way. In consideration of the above, we deny the Motion to Amend as not supported by the written description.

We also deny the Motion to Amend on the basis that it does not add patentable subject matter. Patent Owner argued that the claims should be construed to incorporate the proposed limitation. However, as discussed above, even importing such a limitation into the claims, the claims are unpatentable.

When presented with the question of why, in view of the integration of bar code scanners with other conventional devices, it would not have been obvious to integrate a scanner with a PDA, Patent Owner argued long felt need. Tr. 74. However, Patent Owner admitted that the record did not include evidence of such long felt need. *Id.* at 74-75.

In view of these circumstances, Patent Owner's Motion to Amend is denied.

CONCLUSION

This is a final written decision of the Board under 35 U.S.C. § 318(a) and 37 C.F.R. §42.73. We hold that Petitioner has shown by a preponderance of the evidence that claims 18, 19, and 20 of the '880 Patent are unpatentable. Specifically, we hold that Petitioner has shown by a preponderance of the evidence that claim 18 is anticipated under 35 U.S.C. § 102 by Ruppert and that claims 18 and 20 are anticipated by the PPT4100 Systems Administration Manual. We further hold that Petitioner has shown by a preponderance of the evidence that claims 18, 19, and 20 are unpatentable under 35 U.S.C. § 103(a) over the combination of Ruppert and Dvorkis and over the combination of the PPT4100 Systems Administration Manual and the SE1000 Series Integration Guide.

ORDER

In consideration of the above, it is

ORDERED that claims, 18, 19, and 20 of the '088 Patent are unpatentable;

FURTHER ORDERED that Patent Owner's Motion to Amend is DENIED; and,

FURTHER ORDERED, that because this is a final written decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

For PETITIONER:

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