

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

QUALCOMM INCORPORATED,
Patent Owner.

IPR2018-01279
Patent 7,844,037 B2

Before DANIEL N. FISHMAN, MICHELLE N. WORMMEESTER, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining No Challenged Claims Unpatentable
Dismissing as Moot Patent Owner's Motion to Amend
35 U.S.C. § 318(a)

INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition to institute an *inter partes* review of claims 1–14 and 16–18¹ of U.S. Patent No. 7,844,037 B2 (Ex. 1001, “the ’037 patent”) pursuant to 35 U.S.C. §§ 311–319. Paper 2 (“Petition” or “Pet.”). Qualcomm Incorporated (“Patent Owner”) filed a Patent Owner Preliminary Response. Paper 10. We instituted an *inter partes* review of claims 1–14 and 16–18 on all grounds of unpatentability alleged in the Petition. Paper 11 (“Institution Decision” or “Inst. Dec.”).

After institution of trial, Patent Owner filed a Response (Paper 23, “PO Resp.”), Petitioner filed a Reply (Paper 38, “Petitioner’s Reply” or “Pet. Reply”), and Patent Owner filed a Sur-reply (Paper 39, “PO Sur-reply”). In addition, Patent Owner filed a Contingent Motion to Amend (Paper 24, “Motion to Amend” or “Mot. Amend.”), Petitioner filed an Opposition to Patent Owner’s Contingent Motion to Amend (Paper 31, “Opp. Amend”), Patent Owner filed a Reply to Petitioner’s Opposition (Paper 38, “Reply Amend”), and Petitioner filed a Sur-Reply to Patent Owner’s Reply (Paper 41, “Sur-reply Amend”).

Petitioner relies on the declaration testimony of Dr. Narayan Mandayam² (Exs. 1003, 1018) and Patent Owner relies on the declaration testimony of Dr. Kevin Jeffay (Ex. 2004).

¹ The Petition also sought *inter partes* review of claims 19–25. *See* Inst. Dec. 6–7. However, because those claims were statutorily disclaimed by the Patent Owner, they are treated as if they were never part of the ’037 patent. *Id.*

² Due to a family emergency, Dr. Mandayam was unable to appear for a deposition regarding his Second Declaration (Ex. 1018). *See* Order Modifying Scheduling Order, Paper 33; Ex. 3002 (email from Petitioner). Pursuant to the agreement of the parties and our Order, Dr. Cooperstock

An oral hearing was held on November 20, 2019, and the record contains a transcript of this hearing. Paper 44 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a). For the reasons that follow, we determine that Petitioner has not shown by a preponderance of the evidence that claims 1–14 and 16–18 are unpatentable. Because we do not find any of the challenged claims unpatentable, we dismiss as moot Patent Owner’s Contingent Motion to Amend.

BACKGROUND

A. Real Parties in Interest

Petitioner identifies Apple, Inc. as the real party in interest. Pet. 63.

Patent Owner identifies Qualcomm Incorporated as the real party in interest. Patent Owner’s Mandatory Notices, Paper 3, 2.

B. Related Matters

The parties identify the following dismissed patent litigation proceeding in which the ’037 patent was asserted: *Qualcomm Inc. v. Apple Inc.*, Case No. 3:17-cv-02403 (S.D. Cal.). Pet. 63; Patent Owner’s Mandatory Notices, Paper 3, 2; Petitioner’s Updated Mandatory Notices, Paper 21, 1. Additionally, Patent Owner identifies a second request for *inter partes* review of the ’037 patent: *Apple Inc. v. Qualcomm Inc.*, Case IPR2018–01280.³ Patent Owner’s Mandatory Notices, Paper 3, 2.

adopted Dr. Mandayam’s Second Declaration and was made available for deposition. *See* Ex. 2025, 7:8–21, 9:8–17 (Cooperstock Dep.); Order Modifying Scheduling Order, Paper 33.

³ We exercised our discretion to deny institution under 35 U.S.C. § 325(d). IPR2018-01280 Paper 11 (Decision Denying Institution); IPR2018-1280, Paper 13 (Decision Denying Request for Rehearing).

C. The '037 Patent

The '037 patent is titled “Method and Device for Enabling Message Responses to Incoming Phone Calls.” Ex. 1001, code (54). According to the '037 patent, the claimed invention enables “message replies to be made to incoming calls.” *Id.* at 1:64–65. “For example, rather than pick up a phone call or forward the phone call to voicemail, the user may simply generate a text (or other form of) message to the caller.” *Id.* at 1:67–2:3. Thus, when using the claimed invention,

[r]ather than answer the call or perform some other action like forwarding the call to voicemail, . . . the recipient computing device 110 issues a message response 122 to the calling device 120. In one embodiment, the message response 122 is an alternative to the user of the recipient device 110 having to decline or not answer the incoming call 112.

Id. at 3:56–63.

As another alternative, in one implementation, the message creation data 222 is generated in response to a trigger from a user 202. The phone application 210, message response module 230, or some other component may prompt the user to message respond to a caller in response to receipt of call data 202. The prompt may occur shortly after the incoming call 204 is received, such as with or before the first “ring” generated on the computing device 200 for the incoming call. For example, the user may be able to elect message response as one option along with other options of answering or declining the incoming call 204.

Ex. 1001, 5:24–34. Figure 4 of the '037 patent (not reproduced) “illustrates a message for handling incoming calls with message replies, under an embodiment of the invention.” *Id.* at 1:53–54.

D. Illustrative Claims

Claim 1 is independent, is illustrative of the subject matter of the challenged claims, and reads as follows:

1. A method for operating a first computing device, the method being implemented by one or more processors of the computing device and comprising:

receiving, from a second computing device, an incoming call to initiate a voice-exchange session;

in response to receiving the incoming call, determining a message identifier associated with the second computing device, wherein the message identifier is determined based at least in part on data provided with the incoming call;

in response to receiving the incoming call, prompting a user of the first computing device to enter user input that instructs the first computing device to handle the incoming call by composing, while not answering the incoming call, a message to a user of the second computing device; and

responsive to receiving the incoming call and the user entering the user input, automatically addressing the message to the second computing device using the message identifier determined from the incoming call.

Ex. 1001, 9:63–10:15

E. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–14 and 16–20 would have been unpatentable on the following grounds:

Claims Challenged	35 U.S.C. §	References
1–8, 12–14, 16–18	103(a)	Mäkelä, ⁴ Moran ⁵
7–11	103(a)	Mäkelä, Moran, Tsampalis ⁶

⁴ US 6,301,338 B1, issued Oct. 9, 2001 (Ex. 1004).

⁵ US 2003/0104827 A1, published June 5, 2003 (Ex. 1006).

⁶ US 2004/0203956 A1, published Oct. 14, 2004 (Ex. 1007).

ANALYSIS

A. *Legal Standard*

In *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), the Supreme Court set out a framework for assessing obviousness under 35 U.S.C. § 103 that requires consideration of four factors: (1) the “level of ordinary skill in the pertinent art,” (2) the “scope and content of the prior art,” (3) the “differences between the prior art and the claims at issue,” and (4) “secondary considerations” of non-obviousness such as “commercial success, long-felt but unsolved needs, failure of others, etc.” *Id.* at 17–18. “While the sequence of these questions might be reordered in any particular case,” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 407 (2007), the Federal Circuit has “repeatedly emphasized that an obviousness inquiry requires examination of all four *Graham* factors and that an obviousness determination can be made only after consideration of each factor.” *Nike, Inc. v. Adidas AG*, 812 F.3d 1326, 1335 (Fed. Cir. 2016), *overruled on other grounds by Aqua Prods., Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017) (en banc). We note that, with respect to the fourth *Graham* factor, the parties have not presented argument or evidence directed to secondary considerations of nonobviousness. The analysis below addresses the first three *Graham* factors.

B. *Level of Ordinary Skill in the Art*

Factors pertinent to a determination of the level of ordinary skill in the art include (1) educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of workers active in the field. *Envtl. Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 696–697 (Fed. Cir. 1983) (citing

Orthopedic Equip. Co. v. All Orthopedic Appliances, Inc., 707 F.2d 1376, 1381–82 (Fed. Cir. 1983)). Not all such factors may be present in every case, and one or more of these or other factors may predominate in a particular case. *Id.* Moreover, these factors are not exhaustive but are merely a guide to determining the level of ordinary skill in the art. *Daiichi Sankyo Co. Ltd, Inc. v. Apotex, Inc.*, 501 F.3d 1254, 1256 (Fed. Cir. 2007).

Petitioner argues that a person having ordinary skill in the art would have had (1) “a Master of Science Degree in an academic area emphasizing electrical engineering, computer engineering, computer science, or an equivalent field (or a similar technical Master’s Degree, or higher degree) with a concentration in wireless communication and networking systems” or (2) “a Bachelor’s Degree (or higher degree) in an academic area emphasizing electrical engineering, computer engineering, or computer science and having two or more years of experience in wireless communication and networking systems.” Pet. 4 (citing Ex. 1003 ¶ 13). Additionally, Petitioner argues that “[a]dditional education in a relevant field, such as computer engineering, or electrical engineering, or industry experience may compensate for a deficit in one of the other aspects of the requirements stated above.” *Id.* (citing Ex. 1003 ¶ 13).

In our Institution Decision, we adopted Petitioner’s formulation. Inst. Dec. 17. Patent Owner does not challenge Petitioner’s formulation. *See* PO Resp. 12–13; Ex. 2004 ¶ 57 (Jeffay Decl.) (“[F]or the purposes of this declaration, I have applied Petitioner’s proposed level of skill.”).

Accordingly, we adopt Petitioner’s proposed level of ordinary skill, except that we delete the qualifier “or more” to eliminate vagueness as to the amount of practical experience. The qualifier expands the range indefinitely without an upper bound, and thus precludes a meaningful indication of the

level of ordinary skill in the art. Therefore, a person having ordinary skill in the art would have had either (1) a Master of Science Degree in an academic area emphasizing electrical engineering, computer engineering, computer science, or an equivalent field (or a similar technical Master's Degree, or higher degree) with a concentration in wireless communication and networking systems or (2) a Bachelor's Degree (or higher degree) in an academic area emphasizing electrical engineering, computer engineering, or computer science and having two years of experience in wireless communication and networking systems. Moreover, additional education in a relevant field, such as computer engineering, or electrical engineering, or industry experience may compensate for a deficit in one of the other aspects of the requirements stated above.

C. Claim Construction

In this *inter partes* review, we construe claim terms in this unexpired patent according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b) (2018).⁷ “Under a broadest reasonable interpretation, words of the claim must be given their plain meaning, unless such meaning is inconsistent with the specification and prosecution history.” *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1062 (Fed. Cir. 2016). In addition, the Board may not “construe claims during [an *inter partes* review] so broadly that its constructions are

⁷ The Board applies the *Phillips* claim construction standard to petitions filed on or after November 13, 2018. See *Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board*, 83 Fed. Reg. 51,340 (Oct. 11, 2018) (codified at 37 C.F.R. § 42.100(b) (2019)). Because Petitioner filed its petition before November 13, 2018, we apply the broadest reasonable interpretation standard.

unreasonable under general claim construction principles.” *Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015) (emphasis omitted), *overruled on other grounds by Aqua Prods.*, 872 F.3d 1290. An inventor may provide a meaning for a term that is different from its ordinary meaning by defining the term in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

Additionally, “we need only construe those claim limitations ‘that are in controversy, and only to the extent necessary to resolve the controversy.’” *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

Petitioner proposes claim constructions for six terms: “voice-exchange session,” “instant messages,” “programmatically,” “automatically,” “one or more communication components,” and “one or more wireless communication ports.” Pet. 5–9. Patent Owner does not contest Petitioner’s proposed constructions but proposes its own constructions of “prompting” and “composing.” PO Resp. 14–36.

Based on the arguments presented during the trial regarding the patentability of the claims, we need only construe the term “composing.”

1. Patent Owner’s Arguments

According to Patent Owner, “[t]he plain and ordinary meaning of the term ‘composing [a message]’ is ‘manually providing content for [a message],’” and it is different than “manually providing message content prior to receiving the incoming call (i.e., a precomposed message).” PO Resp. 26–27 (citing Ex. 2004 ¶ 73; Ex. 2023). Patent Owner argues “Petitioner’s expert tacitly admitted that composing a message is different

from selecting a precomposed message.” *Id.* at 27; *see also* Ex. 2006, 126:22–127:5, 129:13–130:9 (Mandayam Dep.).

Patent Owner further argues that the ’037 patent “makes it clear that composing a message is different from inserting or selecting a pre-formulated or precomposed message content.” PO Resp. 28 (citing Ex. 2004 ¶ 75); *see also id.* at 28–29 (citing Ex. 1001, 4:1–3, 6:65–7:11; Ex. 2004 ¶ 75); PO Sur-reply 13–14. Patent Owner also draws a distinction between the language in claim 1 and the language recited in claims 15, 19, and 22. PO Resp. 29–30 (citing Ex. 2004 ¶¶ 76, 77; Ex. 1001, 11:6–8, 11:17–34).

Patent Owner further argues that its proposed claim construction is consistent with the prosecution history of U.S. Patent No. 8,737,578 (“the ’578 patent”), which is a continuation of U.S. Patent No. 8,311,189, which in turn is a continuation of the ’037 patent. *See* PO Resp. 31–32. According to Patent Owner, “each of the independent claims of the ’578 Patent requires ‘enabling the user to *select a pre-formulated or precomposed message content for the message or compose a message content for the message.*’” *Id.* at 32 (quoting Ex. 2007, 10:11–12:25); *see also* PO Sur-reply 14. Patent Owner further argues that the Examiner relied on the difference between pre-formulated message content and composing a message when allowing the claims. PO Resp. 32 (citing Ex. 2008). According to Patent Owner, the prosecution history of the related patent “reinforces the understanding that ‘composing’ does not mean rote insertion of pre-formulated or precomposed message content.” *Id.* at 31 (citations omitted).

Patent Owner also relies on the prosecution history of the ’037 patent as further support for its proposed construction. *See* PO Resp. 32–36.

Patent Owner further argues that “Petitioner’s rebuttal . . . fails to take into account the precise nature of the action that the user input instructs the

computer to perform—i.e., the claim language only requires the user input to instruct the computer to handle the call.” PO Sur-reply 12–13.

2. *Petitioner’s Arguments*

Petitioner argues that Patent Owner’s proposed construction is “unjustified” and “inconsistent with the plain language of claim 1.” Pet. Reply. 11; *see also id.* at 11–13. Specifically, Petitioner argues that the language recited in claim 1 “clearly recites that the user’s input ‘instructs’ the first computing device to perform an action, namely to handle the incoming call by composing . . . a message.” *Id.* at 11 (citing Ex. 1001, cl. 1; Ex. 1018 ¶ 50); *see also id.* at 11–12 (“Notably, the claim does **not** recite that the user composes the message, or that the first computing device enables the user to compose the message.” (citing Ex. 1001, cl. 1; Ex. 1018 ¶ 50)). According to Petitioner, “[t]he plain language of claim 1 simply cannot be interpreted to require that the user manually provide content for the message unless it is reframed to switch the actor that ‘handle[s] the incoming call by composing’ from the first computing device to the user.” *Id.* at 12 (citing Ex. 1001, cl. 1). Although Petitioner disputes the inclusion of the term manually, Petitioner does not object to the remaining portion of Patent Owner’s proposed construction. *See* Tr. 11–12.

3. *Our Analysis*

We agree with Patent Owner that “composing . . . a message” as recited in claim 1 means generating a message and does not encompass using pre-composed messages. That construction is consistent with the language recited in the claims, the ’037 patent, and the use of “composing” in a related patent.

We begin with the words of claim 1. Claim 1 recites “in response to receiving an incoming call, prompting a user of the first computing device to

enter user input that instructs the first computing device to handle the incoming call by composing, while not answering the incoming call, a message to a user of the second computing device.” Ex. 1001, 10:7–11. Based on the ordinary meaning of the claim language, the claim requires prompting a user to enter user input and that the entered user input “instructs the first computing device to handle the incoming call by composing . . . a message.” *See id.* That is, it is the user input—which itself is in response to an incoming call—which causes the composing to take place. Thus, the language of the claim requires that the composing takes place **after** the incoming call is received and the user input is entered. Therefore, the language of the claim precludes using content composed prior to the call and user input, i.e., a precomposed message. *See* Ex. 2004 ¶ 73 (Jeffay Decl.).

This construction is also consistent with the written description of the ’037 patent. The ’037 patent describes two different ways of generating messages. First, the ’037 patent describes how a device may be configured to respond to all incoming calls with a precomposed message, such as “on vacation.” Ex. 1001, 5:18–23. However, claim 1 was amended during prosecution to exclude automatically responding with a precomposed message, thus excluding that embodiment from the scope of claim 1. *See* Ex. 1002, 157 (amendment to claim 1), 165–68 (prosecution history of the ’037 patent) (distinguishing prior art references which automatically responded with a precomposed message); *see also* Ex. 2004 ¶ 70 (Jeffay Decl.) (“Accordingly, the Applicant amended the claims to distinguish over Brown and clearly disclaimed claim scope corresponding to the embodiments in which an incoming call is automatically responded to with a message.” (citing Ex. 1002, 166–68)).

In the second embodiment, a responsive message is created in response to a trigger—user input—from the user. *See* Ex. 1001, 5:24–54, 7:52–8:2, Fig. 4 (step 470 (“address message body”) is after steps 410 (“receive incoming call”) and 435 (“message response?”)). Because the message is generated in response to the user input, it does not exist prior to user input being entered. That is, a precomposed message is not being used.

This construction is also consistent with the use of compose in a related patent. *See Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 789 F.3d 1335, 1342–43 (Fed. Cir. 2015) (Statements made in the prosecution of related patents “are legally relevant to the meaning one of skill in the art would attribute to the identical term in the [challenged] patent.”); *NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282, 1293 (Fed. Cir. 2005), *abrogation on other grounds recognized by Zontek Corp. v. United States*, 672 F.3d 1309, 1323 (Fed. Cir. 2012) (Where “patents all derive from the same parent application and share many common terms, we must interpret the claims consistently across all asserted patents.” (citing *Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1350 (Fed. Cir. 2004))).

In a continuation of the ’037 patent, the independent claims each recite “in response to receiving the user input, enabling the user to *select a pre-formulated message content* for the message **or** *compose a message content* for the message.” Ex. 2007, 10:25–27, 10:64–67, 12:16–18 (the ’578 patent) (emphasis added). By indicating that a user can select either pre-formulated message content or compose a message, the related ’578 patent makes a clear distinction between composing a message and using a precomposed message. *See* Ex. 2004 ¶ 78 (Jaffey Decl.) (“As such, having considered the prosecution history of the patent family of the ’037 Patent, a POSITA would have understood the Applicant to have interpreted

‘composing’ a message to require manually providing the content for the message (and not selecting a pre-formulated message content).”).

The parties also dispute whether the composing is done manually by the user (Patent Owner’s position) or by the first computing device (Petitioner’s position). *Compare* PO Resp. 26–27, *with* Pet. Reply 11–13. However, because we construe claims “only to the extent necessary to resolve the controversy,” we do not resolve that dispute. *See Nidec*, 868 F.3d at 1017 (quoting *Vivid*, 200 F.3d at 803).

Accordingly, “composing . . . a message” means generating a message and does not encompass using precomposed messages.

D. Obviousness over (1) Mäkelä in view of Moran or (2) Mäkelä and Moran in View of Tsampalis

Petitioner argues the subject matter of claims 1–8, 12–14, and 16–18 would have been obvious to a person of ordinary skill in the art at the time of the invention in light of the teachings of Mäkelä and Moran. Petitioner further argues claims 7–11 would have been obvious to a person of ordinary skill in the art at the time of the invention in light of the teachings of Mäkelä, Moran, and Tsampalis. For the reasons discussed below, Petitioner has not shown by a preponderance of the evidence that claims 1–14 and 16–18 are unpatentable.

1. Summary of Mäkelä

Mäkelä is titled “Activation of a Telephone’s Own Call Answering Equipment According to the Number of the Calling Party” and is directed “to message services between telephone devices and in particular to using the number of the calling party for transmitting a message in a situation that the receiving party is busy.” Ex. 1004, code (54), 1:1–10. Mäkelä “provide[s] a method and an apparatus, by means of which the telephone

answering function can be adapted to operate in different ways according to the number of the calling party and the use of which for the mentioned purpose is simple and flexible.” *Id.* at 3:10–14. One such device is

a communication device characterized in that it comprises means for identifying the caller on the basis of an identification information included within the incoming call and for sending, according to a selection made by the user, a reply in response to the call, said reply being one of the following: a voice message, an e-mail message, a facsimile, an SMS message in the form of a character string.

Id. at 3:39–46.

2. *Summary of Moran*

Moran is titled “Rerouting/Reformat[t]ing Wireless Messages for Cross Connectivity Between Service Providers” and is directed to “a method and system for rerouting and reformatting messages so that users can send messages to other users that use different wireless service providers.”

Ex. 1006, code (54), ¶ 2. Specifically, Moran is directed “to provid[ing] a scheme that would provide a much higher degree of cross-compatibility for SMS messaging between users having different service providers [and which] may be implemented without requiring changes to the existing wireless services infrastructure.” *Id.* ¶ 8.

3. *Summary of Tsampalis*

Tsampalis is titled “Method and Apparatus for Providing Wireless Messaging” and is directed to a “mobile wireless communication device messaging format capabilities determinator circuitry” which can be used “to obtain second mobile wireless communication device messaging format capabilities information (110) of a second mobile wireless communication device (100)” along with circuitry “operable to send a message (112) in a message format compatible with at least one of the formats identified in the

second mobile wireless communication device messaging format capabilities information (110).” Ex. 1007, codes (54), (57).

4. *Analysis of “Composing . . . a Message (Claim 1)”*

Claim 1 recites “in response to receiving the incoming call, prompting a user of the first computing device to enter user input that instructs the first computing device to handle the incoming call by composing, while not answering the incoming call, a message to a user of the second computing device.” Ex. 1001, 10:6–11. Although the parties dispute various portions of this limitation, we focus on “composing . . . a message,” which is a dispositive issue.

a) *The Parties’ Arguments*

Petitioner argues Mäkelä teaches the prompting step, including “composing . . . a message.” Pet. 16–17. Specifically, Petitioner argues Mäkelä teaches that “in response to the incoming call, the communication device . . . sends a reply according to a selection made by the user[.]” *Id.* at 16 (quoting Ex. 1004:3:30–34). Petitioner further argues Mäkelä teaches transmitting an SMS message either automatically or in response to a user command and this can be performed either immediately or shortly after the call has come so that the user can select the appropriate function after seeing the telephone number of the calling party. *Id.* (citing Ex. 1004, 4:3–8; Ex. 1003 ¶ 62). Petitioner further argues Mäkelä teaches that the user is asked whether to send an SMS message in circumstances where the incoming call is not answered. *Id.* at 16–17 (citing Ex. 1003 ¶ 63; Ex. 1004, 3:64–4:3, 5:32–33, 10:16–20 (claim 4), 12:4–22 (claim 27)).

Petitioner also argues that Patent Owner’s “argument cannot be sustained because it is based on the unsustainable construction of ‘composing.’” Pet. Reply 14.

During the Hearing, Petitioner further argued that Mäkelä's claims 27 and 28 show that the user composes the message as part of generating a response. Tr. 21, 56–59.

Patent Owner argues Mäkelä does not teach or suggest composing a message in response to receiving the incoming call; instead, Patent Owner argues that “[Mäkelä] is directed exclusively to inserting pre-formulated, stored content for the message.” PO Resp. 43(citing Ex. 2004 ¶ 96); *see also id.* 41–51 (citations omitted). Patent Owner further argues that Dr. Mandayam “repeatedly admitted that [Mäkelä] only discloses the ability for the user receiving an incoming call to respond to the call by selecting a precomposed message that was created and stored in the device at some point prior to the incoming call.” *Id.* at 41–42; *see also id.* at 42–43 (citing Ex. 2006, 112:18–113:4, 128:8–130:9, 133:11–20).

b) Our Analysis

As a preliminary matter, we do not consider Petitioner's arguments raised during the Hearing regarding the teaching of Mäkelä's claim 28. Petitioner conceded that it did not address claim 28 in either the Petition or Petitioner's Reply. Tr. 58; *see also* Pet. 16–17 (setting forth arguments on the prompting limitation); Pet. Reply 14 (relying on arguments set forth in the Petition). However, Petitioner argues that we should consider the arguments Petitioner made in Petitioner's Opposition to the Contingent Motion to Amend. Tr. 58–59.

Our rules require the Petition to include “[a] full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence including material facts, and the governing law, rules, and precedent.” 37 C.F.R. § 42.22(a)(2) (2017). Additionally, the Petition “must identify . . . [h]ow the construed claim is unpatentable under

the statutory grounds [on which the petitioner challenges the claims], and must specify where each element of the claim is found in the prior art patents or printed publications relied upon.” 37 C.F.R. § 42.104(b)(4) (2017). Our rules further provide for a petitioner to file a reply to respond to arguments made in the patent owner’s response. *See* 37 C.F.R. § 42.23(b) (2019). Petitioner choose neither option to set forth its arguments regarding Mäkelä’s claim 28.

We decline Petitioner’s invitation to consider arguments presented in papers outside of the Petition and Petitioner’s Reply. We treat Petitioner’s request that we consider arguments only presented in the Opposition to the Motion to Amend as a request for incorporation by reference. However, our rules prohibit “incorporat[ion] by reference from one document into another document.” 37 C.F.R. § 42.6(a)(3) (2019); *see also DeSilva v. DiLeonardi*, 181 F.3d 865, 866–67 (7th Cir. 1999) (Incorporation “by reference amounts to a self-help increase in the length of the [] brief[,]” and “is a pointless imposition on the court’s time. A brief must make all arguments accessible to the judges, rather than ask them to play archeologist with the record.”)). Petitioner has not persuasively argued why we should not apply Rule 42.6(a)(3) in these circumstances. *See* 37 C.F.R. § 42.5(b) (2019) (“The Board may waive or suspend a requirement of parts 1, 41, and 42 and may place conditions on the waiver or suspension.”). Although Petitioner may have intended to make the argument in both Petitioner’s Reply and the Opposition to the Motion to Amend (Tr. 58–59), it did not do so.⁸

⁸ We note that the Petitioner’s Reply was well under the word count limit. *See* Pet. Reply Certification Under 37 CFR § 42.24. Petitioner has offered no explanation as to why it could not have included the argument in its Reply.

And, with regard to arguments concerning Mäkelä's claim 27, for the same reason discussed above, we limit our analysis to arguments actually presented in the Petition or Petitioner's Reply and do not consider arguments presented only in the Opposition to the Motion to Amend.

Similarly, to the extent arguments were presented concerning Mäkelä's claims 27 and 28 during the Oral Hearing, we do not consider them. *See Dell Inc. v. Acceleron, LLC*, 884 F.3d 1364, 1369 (Fed. Cir. 2018) ("Unless it chose to exercise its waiver authority under 37 C.F.R. § 42.5(b), the Board was obligated to dismiss Dell's untimely argument given that the untimely argument in this case was raised for the first time during oral argument."); *see also* Trial Practice Guide ("*During an oral hearing, a party may rely upon appropriate demonstrative exhibits as well as evidence that has been previously submitted in the proceeding, but may only present arguments relied upon in the papers previously submitted.*" (emphasis added)).

With regard to the merits, we agree with Patent Owner that Petitioner has not sufficiently shown how Mäkelä teaches "composing . . . a message" as recited in claim 1. Neither the Petition nor Petitioner's Reply specifically addresses when the reply message is prepared. *See* Pet. 16–17; Pet. Reply 14. Moreover, Dr. Mandayam—Petitioner's expert witness—conceded that the messages in Mäkelä are composed and stored prior to the incoming call being received:

Q. So I think just to repeat the question, is there any disclosure in Mäkelä that the message sent by the user in response to an incoming call is anything other than a message previously stored by the user before the incoming call? Yes or no, please.

...

THE WITNESS: The specification describes messages that have been composed ahead -- previously by the user with the ability to choose them.

....

Q. The modes of response listed in Claim 27, that is a voice message, an e-mail message, a facsimile, and an SMS message in the form of a character string are all limited to precomposed messages. Do you agree with that?

...

THE WITNESS: So the messages have been composed by the user and stored, as we have gone through this already a few times. So that is stored and composed and resides in the device. And the user is making the choice in response to a call to send whichever their preferred option is.

And there is some dynamism if you read through the specifications where there are responses you can fine-tune based on the amount of time you want to be not disturbed or the amount of time your meeting is in session. So there are things like that. But this is the characterization, and I think this is something I agree.

...

Q. So I think we agree that the user selects a message that is to be transmitted in response to an incoming call. The question is would you agree that in Mäkelä the user's selection of the message in response to an incoming call is limited to precomposed messages?

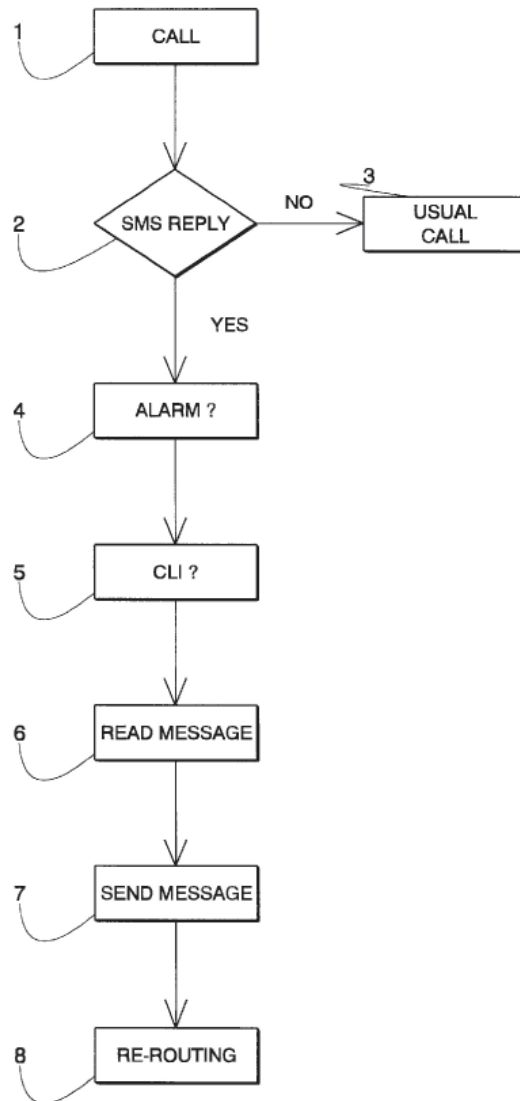
...

THE WITNESS: It is based on the set of messages that are available for the user to use.

Ex. 2006, 112:18-113:4, 129:13-130:9, 133:11-20.

Consistent with Dr. Mandayam's deposition testimony, Mäkelä describes that after receiving an incoming call and determining the caller identity information, "the apparatus reads from the memory the short

message stored therein” and “the message is [then] sent to the calling party.”
Ex. 1004, 4:11–16. This is shown in Mäkelä’s Figure 1, which is reproduced below.



Mäkelä’s Figure 1 “illustrates as a simple flow diagram a preferable embodiment of the method in accordance with the method.” *Id.* at 4:56–57. Step 6—which is performed after the call is received—shows that the message is read from memory and sent; but there is no teaching or

suggestion of composing the message after the call was received. *See Id.* at 5:11–15, Fig. 1.

Petitioner’s arguments regarding Mäkelä’s claim 27 are not persuasive. The only references to Mäkelä’s claim 27 in the Petition are as follows:

Mäkelä further teaches that the “short message” sent in response to the user input is sent “in a situation wherein the user of the portable terminal does not answer the” incoming call. *See* APPLE-1004, **claim 27** (emphasis added); *see also* claim 4, 3:64-4:3, 5:32-33; APPLE-1003, ¶63. Thus, Mäkelä discloses a user being asked whether to send a short message in a situation where the incoming call is not answered, thereby teaching that the prompting occurs without answering the incoming call. APPLE-1003, ¶63; *see* APPLE-1004, claim 4, **claim 27**, 3:64-4:3, 5:32-33.

Pet. 16–17 (underline emphasis in original, bold emphasis added). That is, Petitioner’s argument regarding Mäkelä’s claim 27 is not directed to the composing portion of the limitation; instead, it is directed to whether Mäkelä teaches prompting without answering the call. *See id.*

Because Petitioner has not shown that Mäkelä teaches composing a message after the call is received, Petitioner has not shown that Mäkelä’s teaches “**in response to receiving the incoming call, prompting a user** of the first computing device **to enter user input that instructs the first computing device** to handle the incoming call by **composing**, while not answering the incoming call, **a message** to a user of the second computing device” as recited in claim 1. (emphases added.)

We have considered the entirety of the evidence submitted by the parties, both for and against obviousness, and determine that Petitioner has not shown by a preponderance of the evidence that claims 1–8, 12–14, and 16–18 are unpatentable as obvious over Mäkelä in view of Moran.

Additionally, because Petitioner does not argue that Tsampalis cures the deficiencies of Mäkelä, we further determine that Petitioner has not shown by a preponderance of the evidence that claims 7–11 are unpatentable as obvious over Mäkelä in view of Moran and Tsampalis.

PATENT OWNER’S CONTINGENT MOTION TO AMEND

We have concluded that Petitioner has not proven by a preponderance of the evidence that claims 1–14 and 16–18 are unpatentable. Patent Owner filed a contingent motion to amend proposing “Claims 26–42 as substitutes for Claims 1–14 and 16–18 in the event that any of Claims 1–14 and 16–18 are found unpatentable.” Mot. Amend 1. Because we have not found any of the challenged claims unpatentable, Patent Owner’s Contingent Motion to Amend is dismissed as moot.

CONCLUSION

For the foregoing reasons, we conclude that Petitioner has not demonstrated by a preponderance of the evidence the unpatentability of claims 1–14 and 16–18 of the ’037 patent. Specifically, Petitioner has not demonstrated by a preponderance of the evidence that (1) claims 1–8, 12–14, and 16–18 would have been obvious under 35 U.S.C. § 103(a) in view of Mäkelä and Moran and (2) that claims 7–11 would have been obvious under 35 U.S.C. § 103(a) in view of Mäkelä, Moran, and Tsampalis.

Additionally, Patent Owner’s Contingent Motion to Amend is dismissed as moot.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, that Petitioner has not shown by a preponderance of the evidence that claims 1–14 and 16–18 of the '037 patent are unpatentable;

FURTHER ORDERED that Patent Owner's Motion to Amend is *dismissed* as moot; 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.

In summary:

Claims	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1–8, 12–14, 16–18	103(a)	Mäkelä, Moran		1–8, 12–14, 16–18
7–11	103(a)	Mäkelä, Moran, Tsampalis		7–11
Overall Outcome				1–14, 16–18

Motion to Amend Outcome	Claim(s)
Original Claims Cancelled by Amendment	
Substitute Claims Proposed in the Amendment	26–42
Substitute Claims: Motion to Amend Granted	
Substitute Claims: Motion to Amend Denied	
Substitute Claims: Not Reached	26–42

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