

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC., GOOGLE INC., and MOTOROLA MOBILITY LLC,
Petitioner,

v.

ARENDI S.A.R.L.,
Patent Owner.

Case IPR2014-00208
Patent 7,917,843 B2

Before HOWARD B. BLANKENSHIP, SALLY C. MEDLEY, and
TREVOR M. JEFFERSON, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

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

I. BACKGROUND

Apple Inc., Google Inc., and Motorola Mobility LLC (collectively “Petitioner”) filed a request for *inter partes* review of claims 1–44 of U.S. Patent No. 7,917,843 B2 (“the ’843 patent”) (Ex. 1001) under 35 U.S.C. §§ 311–319. *See* Paper 1 (“Petition” or “Pet.”). On June 11, 2014, the

Board instituted an *inter partes* review of claims 1, 2, 8, 14–17, 20, 21, 23, 24, 30, 36–39, 42, and 43 on an asserted ground of unpatentability for obviousness. Paper 8 (“Dec. on Inst.”).

Subsequent to institution, Patent Owner Arendi S.A.R.L. filed a patent owner response (*see* Paper 17, “PO Resp.”). Petitioner filed a reply to the Patent Owner Response (*see* Paper 21, “Pet. Reply”). Patent Owner filed a motion to exclude evidence (Paper 24), Petitioner opposed (Paper 27), and Patent Owner replied (Paper 28).

Oral hearing was held on February 4, 2015.¹

The Board has jurisdiction under 35 U.S.C. § 6(c). This final written decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 1, 2, 8, 14–17, 20, 21, 23, 24, 30, 36–39, 42, and 43 of the ’843 patent are unpatentable.

The Challenged Patent

The ’843 patent relates to a computer program that receives information typed by a user into a document (as in a word processor) and searches an external source, such as a database, to determine if the typed information exists in the database. The computer program may add a user-selectable button to the word processor that causes execution of another program to receive the typed information and to search the database. Ex. 1001, col. 3, ll. 35–54. Consequently, the user does not have to learn how to use and have access to the database. *Id.* at col. 1, ll. 43–49.

Figure 3 of the ’843 patent is reproduced below.

¹ The record includes a transcript of the oral hearing. Paper 32.

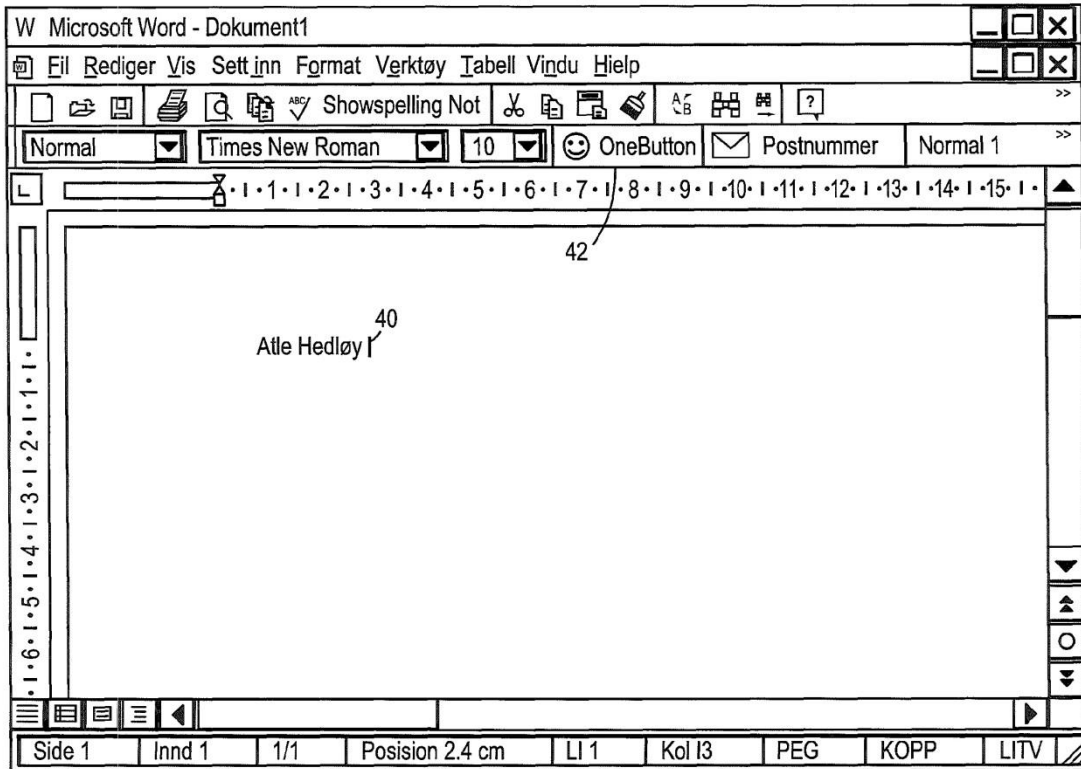


FIG. 3

Figure 3 is said to be a screen shot that illustrates the inputting of a name to be searched and an address handling button within a word processor. *Id.* at col. 2, ll. 51–54. The user has typed the name of an existing contact 40. The user selects button 42, marked “OneButton.” In response, the program of the invention retrieves existing contact 40 from the document and searches a database for the name of the existing contact. *Id.* at col. 7, ll. 30–37.

Figure 4 of the '843 patent is reproduced below.

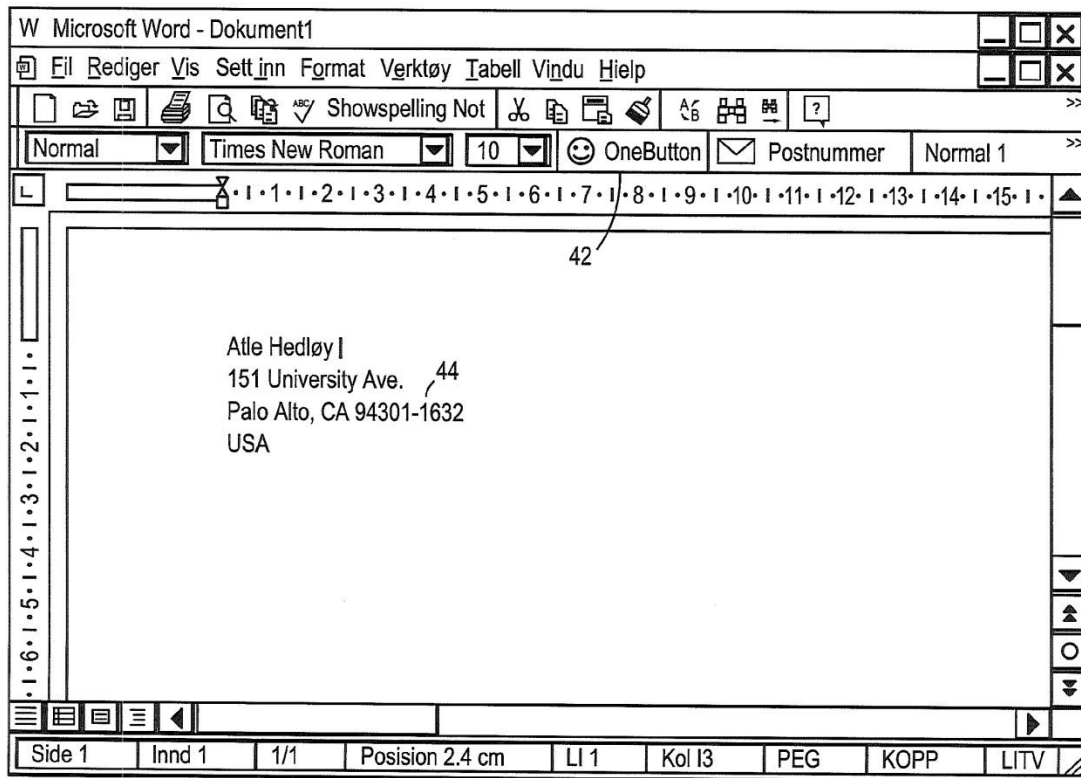


FIG. 4

Figure 4 is said to be a screen shot illustrating a retrieved address in a word processor. *Id.* at col. 2, ll. 55–57. The user has typed a name and new address of existing contact 44. The user selects “OneButton” 42 and the program of the invention retrieves existing contact 44 from the document and searches a database for the name of the existing contact. *Id.* at col. 8, ll. 13–19.

Illustrative Claim

1. A computer-implemented method for finding data related to the contents of a document using a first computer program running on a computer, the method comprising:

displaying the document electronically using the first computer program;

while the document is being displayed, analyzing, in a computer process, first information from the document to determine if the first information is at least one of a plurality of types of information that can be searched for in order to find second information related to the first information;

retrieving the first information;

providing an input device, configured by the first computer program, that allows a user to enter a user command to initiate an operation, the operation comprising (i) performing a search using at least part of the first information as a search term in order to find the second information, of a specific type or types, associated with the search term in an information source external to the document, wherein the specific type or types of second information is dependent at least in part on the type or types of the first information, and (ii) performing an action using at least part of the second information;

in consequence of receipt by the first computer program of the user command from the input device, causing a search for the search term in the information source, using a second computer program, in order to find second information related to the search term; and

if searching finds any second information related to the search term, performing the action using at least part of the second information, wherein the action is of a type depending at least in part on the type or types of the first information.

Related Proceedings

According to the parties, the '843 patent is involved in the following lawsuits: *Arendi S.A.R.L. v. Apple Inc.*, No. 1:12-cv-01596-LPS (D. Del.); *Arendi S.A.R.L. v. Motorola Mobility LLC*, No. 1:12-cv-01601-LPS (D. Del.); *Arendi S.A.R.L. v. Yahoo! Inc.*, No. 1:13-cv-00920 (D. Del.); *Arendi S.A.R.L. v. Google Inc.*, No. 1:13-cv-00919 (D. Del.); *Arendi S.A.R.L. v. HTC Corp.*, No. 1:12-cv-01600 (D. Del.); *Arendi S.A.R.L. v. Sony Mobile Communications (USA) Inc.*, No. 1: 12-cv-01602 (D. Del.); *Arendi S.A.R.L. v. Nokia Corporation*, No. 1:12-2cv-01599 (D. Del.); *Arendi S.A.R.L. v. Blackberry Limited*, No. 1:12-cv-01597 (D. Del.); *Arendi S.A.R.L. v. LG Electronics Inc.*, No. 1:12-cv-015959 (D. Del.); and *Arendi S.A.R.L. v. Samsung Electronics Co. Ltd.*, No. 1:12-cv01598 (D. Del.). According to Patent Owner, patents related to the '843 patent are or were involved in the following *inter partes* reviews: IPR2014-00206, IPR2014-00207, IPR2014-00203, and IPR2014-00214. The Board denied *inter partes* review in IPR2014-00203 and IPR2014-00214. The Board instituted trial in IPR2014-00206 and IPR2014-00207.

Prior Art

Pandit	US 5,859,636	Jan. 12, 1999	Ex. 1009
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Asserted Ground of Unpatentability

The Board instituted *inter partes* review on the following asserted ground of unpatentability under 35 U.S.C. § 103(a) (Dec. on Inst. 19): claims 1, 2, 8, 14–17, 20, 21, 23, 24, 30, 36–39, 42, and 43 on the ground of obviousness over Pandit.

II. ANALYSIS

Claim Interpretation

Consistent with the statute and the legislative history of the Leahy-Smith America Invents Act (AIA), the Board will construe the claims of an unexpired patent using the broadest reasonable interpretation. 37 C.F.R. § 42.100(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). The claim language should be read 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).

Only terms which are in controversy need to be construed, and then only to the extent necessary to resolve the controversy. *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999). Because the meaning of claim terms is not in controversy in this trial proceeding, we do not construe any claim limitations for purposes of this Final Decision.

Section 103(a) Patentability

Pandit

Each of the independent claims of the '843 patent recites “performing a search . . . wherein the specific type or types of second information [found] is dependent at least in part on the type or types of the first information [used

as a search term].” Petitioner submits (Pet. 50–51) that Pandit discloses performing a search in an information source external to the document, which is a further requirement of the claim. Petitioner submits that Pandit discloses adding an identified number to an address book. Pet. 51; Ex. 1009, col. 2, l. 56 – col. 3, l. 10, Figs. 1d, 1f.

Figure 1f of Pandit is reproduced below.

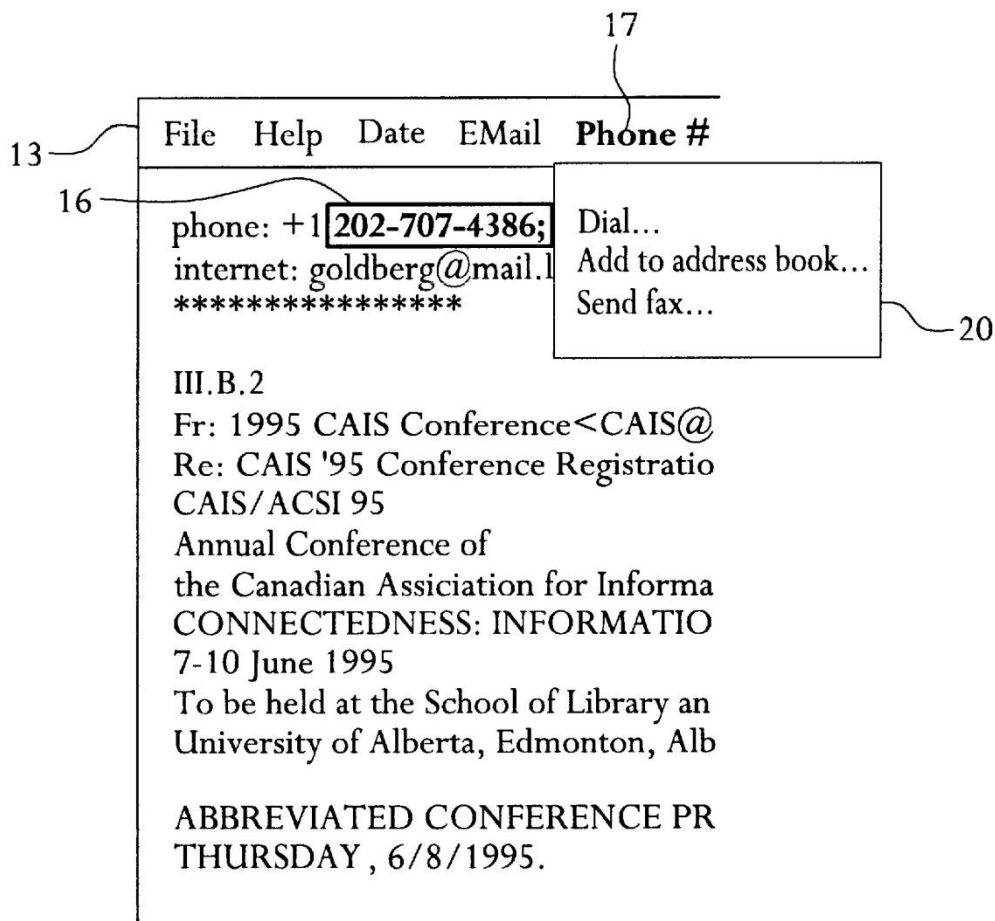


FIG. 1f

Figure 1f depicts a graphical representation of text on a video monitor. Ex. 1009, col. 1, ll. 59–60. The Figure shows that text (telephone number 16) has been selected by the user and highlighted. Pull down menu 17 (“Phone #”) in menu bar 13 has been selected, yielding pulled-down menu 20. Links in pulled-down menu 20 allow the user to, for example, select the link “Add to address book. . .” in order to call a program to add the selected text (telephone number 16) to the address book. *Id.* at col. 2, l. 1 – col. 3, l. 10.

Petitioner applies the teachings of Pandit to the challenged claims. Pet. 48–55. In particular, Petitioner submits that Pandit discloses each limitation of illustrative claim 1 except for performing a search as specified in step (i) of the claim. Petitioner, however, submits further that in order to avoid multiple entries of the same address, it would have been obvious that the first step in adding to an address book is to search the address book to determine if an entry already exists with the entered information, and displaying any associated information that is located. *Id.* at 51. Petitioner refers to the Declaration of Dr. Menascé. *Id.* Dr. Menascé concurs:

It would also have been obvious to a person of ordinary skill in the art at the relevant timeframe that the first step in adding to an address book is searching the address book to determine if an entry already exists with this information and displaying any associated information that is located. This would have been a matter of common sense to one of ordinary skill, in order to avoid multiple entries of the same address.

Ex. 1002 ¶ 99.

Pandit teaches further that, from pulled-down menu 20 (Ex. 1009, Fig. 1f), programs that can be called may include a writeable computer database of telephone and telefax numbers. *Id.* at col. 3, ll. 1–3. Dynamically linked

libraries may contain subroutines for implementing the invention with respect to telephone and telefax numbers. *Id.* at col. 4, ll. 20–31.

We find it reasonable to presume, as a matter of common sense and at the time of the invention, that the subroutine in Pandit would search for duplicate telephone numbers and, upon locating a duplicate entry, both the first information and associated (or second) information, such as the name and/or address associated with the telephone number, would be displayed to the user. A person having a bound paper address book would look first to determine if a potential new contact had been entered previously. A computerized search for duplicate entries would be a search “in order to find the second information, of a specific type or types,” as claimed, in the same sense that the ’843 patent’s search is in order to find the second information. As shown, for example, in Figure 1 of the ’843 patent, a name (first information) can be searched for in a database (12), and more than one possible contact or address (containing second information) may be found to match with the first information (18). Ex. 1001, Fig. 1. The first and the second information are displayed to the user for user action (20). *Id.* Searching a database for a telephone number in Pandit’s system, and displaying results, would be no different in substance from searching a database for a name, and displaying results, in the disclosed example in the ’843 patent. “What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 419 (2007).

Patent Owner's Response

Relying on the Declaration of Dr. John V. Levy (Ex. 2002), Patent Owner argues, with respect to Pandit, that a person of ordinary skill in the art would expect that a template would be displayed by which the user can enter the name of the party having the telephone number. PO Resp. 26. The search for duplicates would be conducted based on the name entered by the user rather than based on the telephone number. *Id.* at 27; Ex. 2002 ¶ 27.

Entry of a telephone number as depicted in Figure 1f of Pandit is, however, but one example of Pandit's teachings with respect to entry of data. *See* Pet. 50–51; Pet. Reply 14. Text including, for example, e-mail addresses, nouns, verbs, names, and street addresses can also be recognized. Ex. 1009, col. 2, ll. 24–31. Pandit at Figures 1c and 1d depicts recognition and entry of an e-mail address into an address book. Pandit teaches further that the entry may be made into a “general address book database.” *Id.* at col. 2, ll. 57–61. Searching for duplicate names and displaying associated data also is within the scope of the claimed invention of the '843 patent, as exemplified in Figure 1 of the patent. If a possible duplicate in the database is found for the name, the found data is displayed to the user. Ex. 1001, col. 4, ll. 43–49, Fig. 1 (reference numerals 12, 18, 20).

Moreover, with respect to Pandit's Figure 1f example of entering a telephone number into an address book, we agree with Patent Owner that “[a] telephone number stored in a database by itself is of little use.” PO Resp. 25 (quoting Ex. 2002 ¶ 21). The address database must include information associated with the telephone number (e.g., a name) as opposed to consisting of a mere list of telephone numbers. Although a human being entering a contact into a paper address book would not be expected to search

for duplicate telephone number entries, it would have been obvious to the ordinary artisan to utilize a computerized search for duplicate telephone entries when entering a telephone number in an electronic address book database as taught by Pandit.

Patent Owner submits that products having Contacts databases that were introduced in 2013 and 2014 do not automatically search for duplicate entries when a new contact is entered. “[T]he contact application simply stores a new entry without checking for duplicates.” PO Resp. 22. Patent Owner does not, however, provide a satisfactory explanation as to what relevance the allegation concerning more recent devices may have to what would have been obvious to one of ordinary skill in the art at the time of invention—on this record, November 10, 1998, the earliest-claimed priority date pursuant to 35 U.S.C. § 120. *See* Ex. 1001, col. 1, ll. 8–12. Further, Patent Owner does not allege that it *would have been non-obvious* in 2013 or 2014 to search for duplicate entries when entering a contact into a database.

The obviousness inquiry “not only permits, but *requires*, consideration of common knowledge and common sense.” *DyStar Textilfarben GmbH & Co. v. C.H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1329 (Fed. Cir. 2009) (the obviousness analysis “may include recourse to logic, judgment, and common sense available to the person of ordinary skill that do not necessarily require explication in any reference or expert opinion”). Patent Owner argues, however, that “common sense” may only be applied when combining references that include all the required limitations, relying on *K/S HIMPP v. Hear-Wear Technologies, LLC*, 751 F.3d 1362, 1365 (Fed. Cir. 2014). PO Resp. 14–18.

In *Hear-Wear Technologies*, the United States Court of Appeals for the Federal Circuit determined that the Board did not err in requiring record evidence to support a third-party assertion that the structural features of “a plurality of prongs that provide a detachable mechanical and electrical connection” was a known prior art element. 751 F.3d at 1365. In this case, however, a claimed structural feature is not missing from the applied prior art. The conclusion of obviousness follows from a benefit that readily would have been apparent to one of skill in the art at the time of the invention. That benefit is provided by the mere retrieval and display of useful, pre-existing information to a user, using known methods.

“A person of ordinary skill is . . . a person of ordinary creativity, not an automaton.” *KSR*, 550 U.S. at 421. Accordingly, the obviousness inquiry must take account of the “routine steps” that a person of ordinary skill in the art would employ. *Ball Aerosol & Specialty Container, Inc. v. Ltd. Brands, Inc.*, 555 F.3d 984, 993 (Fed. Cir. 2009). Patent Owner’s expert admits that some database programs conduct a search for duplicates by default. Ex. 2002 ¶ 25; *see also* Pet. Reply 13. “[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *KSR*, 550 US at 417. We are not persuaded that retrieval and display of information was “uniquely challenging or difficult for one of ordinary skill in the art” (*Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418–19)).

Upon review of the Petition and supporting evidence, as well as the Patent Owner Response and supporting evidence, we conclude that

Petitioner has demonstrated, by a preponderance of the evidence, that claims 1, 2, 8, 14–17, 20, 21, 23, 24, 30, 36–39, 42, and 43 are unpatentable for obviousness over Pandit.

Patent Owner’s Motion to Exclude Evidence

Patent Owner moves to exclude Exhibit 1013, which is the deposition transcript of Petitioner’s expert, Dr. Daniel A. Menascé. Paper 24. Dr. Menascé was deposed by Patent Owner’s counsel on August 7, 2014, for this proceeding and for proceedings IPR2014-00206 and IPR2014-00207. Ex. 1013, 1. Patent Owner submits that the transcript is irrelevant to this proceeding and that the information should have been submitted as a request by Petitioner for entry of supplemental information.

Although Petitioner does not appear to discuss or rely on any portion of the transcript in its Reply to Patent Owner’s Response, Petitioner filed the Exhibit with its Reply. Petitioner argues that 37 C.F.R. § 42.53(f)(7) states that deposition testimony must be filed by its proponent as an exhibit. Paper 27, 3. Consistent with Petitioner’s position, the rule recently has been clarified. *See* Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board, 80 Fed. Reg. 28,561, 28,563 (May 19, 2015) (“To clarify that either party is permitted to file testimony as an exhibit, the Office amends 37 CFR 42.53(f)(7) to delete the phrase ‘by proponent’ in the second sentence.”). Because either party is permitted to file testimony as an exhibit, Petitioner’s filing of the exhibit is proper. Because we do not consider or rely on any content of Exhibit 1013 in making our determinations in this Decision, Patent Owner’s motion to exclude Exhibit 1013 is *dismissed* as moot.

III. CONCLUSION

Petitioner has demonstrated by a preponderance of the evidence that claims 1, 2, 8, 14–17, 20, 21, 23, 24, 30, 36–39, 42, and 43 of the '843 patent are unpatentable for obviousness over Pandit.

IV. ORDER

In consideration of the foregoing, it is

ORDERED that claims 1, 2, 8, 14–17, 20, 21, 23, 24, 30, 36–39, 42, and 43 of the '843 patent are *unpatentable*;

FURTHER ORDERED that Patent Owner's Motion to Exclude Evidence is *dismissed*; 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.

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