

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

MASA LLC  
Patent Owner.

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Case IPR2016-00748  
Patent 8,519,834 B2

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Before KARL D. EASTHOM, JEFFREY S. SMITH, and TRENTON A.  
WARD, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

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

## I. INTRODUCTION

Petitioner, Apple Inc., filed a Petition for *inter partes* review of claims 6–14 of U.S. Patent No. 8,519,834 B2 (Ex. 1001, “the ’834 patent”). Paper 2 (“Pet.”). Patent Owner, Masa LLC, filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). We instituted trial for claims 6–14 (the “challenged claims”). Paper 7 (“Inst. Dec.”). Patent Owner filed a Response. Paper (“PO Resp.”). Petitioner followed with a Reply. Paper (“Pet. Reply”). The record includes a transcript of the Oral Hearing. Paper (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision issues pursuant to 35 U.S.C. § 318(a). Petitioner has shown by a preponderance of the evidence that claims 6–14 of the ’834 patent are unpatentable.

### A. *Related Matters*

The ’834 patent is at issue in *Masa LLC v. Apple Inc.*, Case No. 4:15-cv-00889-AGF (E.D. Mo.), filed June 5, 2015. Pet. 1; Paper 5 (Patent Owner’s Mandatory Notice), 2.

### B. *The ’834 Patent*

The ’834 patent is titled “Wrist Wound Vibrating Device,” and relates generally to a vibrating device for receiving an electronic signal from a transmitting unit of a cell phone. Ex. 1001, 1:5–8. The vibrating device of the ’834 patent includes an electronic receiver configured to receive the electronic signal from a cell phone transmitter. *Id.* at 1:64–66. The receiver is coupled to a vibrating unit and facilitates actuating the vibrating unit in

response to the received signal. *Id.* at 1:66 to 2:2. The receiver is also coupled to a display panel that displays the received signal. *Id.* at 2:2–5. Figure 1 of the '834 patent is reproduced below.

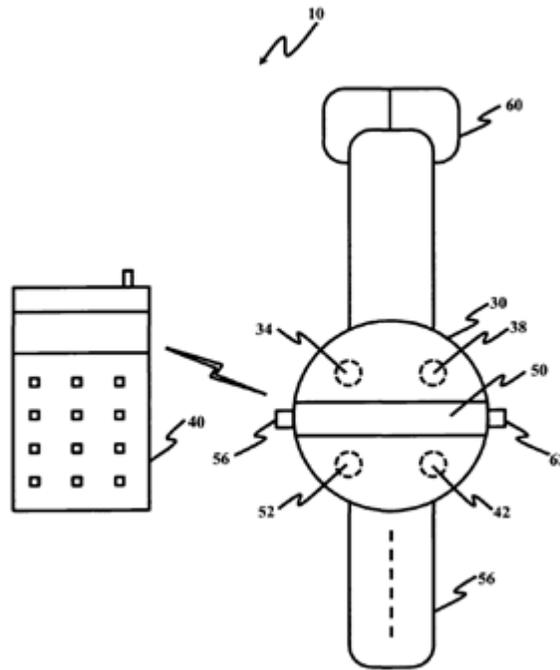


Figure 1 depicts a schematic representation of a wrist worn vibrating device and cell phone assembly 10 comprising vibrating device 30 in electronic communication with cell phone 40. *Id.* at 2:37–40. Cell phone 40 transmits an electronic signal to vibrating device 30. *Id.* at 2:41–57. Vibrating device 30 includes electronic receiver 34 configured to receive the electronic signal. *Id.* at 3:1–19. Vibrating device 30 includes vibrating unit 38 electronically coupled to receiver 34 configured to vibrate when the electronic signal is received from cell phone 40. *Id.* at 3:20–34. Display panel 50 electronically coupled to receiver 34 displays the electronic signal. *Id.* at 3:34–40. Memory unit 52 coupled to receiver 34 stores the received signal, a list of text messages, and a list of telephone numbers. *Id.* at 3:41–

55. A user may operate selector option switch 56 to select a text message from the list. *Id.* at 3:56–64. Then, after the user selects a stored recipient telephone number using selector option switch 56, electronic transmitter 42 coupled to memory unit 52 transmits the selected text message and recipient telephone number to cell phone 40. *Id.* at 3:64–4:25. Finally, cell phone 40 transmits the selected text message to the recipient telephone number. *Id.* at 4:25–36.

### *C. Illustrative Claim*

Claims 6 and 10 of the '834 patent are independent. Claim 6 is illustrative of the claimed subject matter:

6. A vibrating device including a vibrating unit that may be actuated in response to a first electronic signal, said vibrating device comprising:

an electronic receiver configured to be coupled to said vibrating device, said electronic receiver further configured to receive said first electronic signal, and at least one of a second electronic signal and a third electronic signal;

a vibrating unit configured to be coupled to said electronic receiver, said electronic receiver configured to facilitate actuating said vibrating unit in response to said first electronic signal;

a memory unit configured to be coupled to said electronic receiver, said memory unit further configured to store said first electronic signal;

a selector option switch configured to be coupled to said vibrating device, said selector option switch configured to select an electronic text message from a plurality of pre-programmed electronic text messages stored in said memory unit, said selector option switch further configured to select a

recipient telephone number from a list of telephone numbers stored in said memory unit; and

an electronic transmitter configured to be coupled to said memory unit of said vibrating device, said electronic transmitter further configured to transmit said electronic text message and said recipient telephone number to a cell phone receiver.

Ex. 1001, 8:10–37.

#### *D. Instituted Grounds*

Petitioner contends that claims 6–14 of the '834 patent are unpatentable based on the following specific grounds (Inst. Dec. 31):

<b>Reference(s)</b>	<b>Basis</b>	<b>Challenged Claims</b>
Acharya <sup>1</sup>	§ 102(b)	6–14
Acharya	§ 103	9, 10, 13, and 14
Acharya and Lee <sup>2</sup>	§ 103	9 and 13
Acharya and Narayanaswami <sup>3</sup>	§ 103	10 and 14
Sweeney <sup>4</sup> and Acharya	§ 103	6–14

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<sup>1</sup> U.S. Patent No. 7,840,681 B2, filed July 30, 2004, issued Nov. 23, 2010, (Ex. 1007, “Acharya”).

<sup>2</sup> U.S. Patent No. 7,796,548 B2, filed Mar. 22, 2006, issued Sep. 14, 2010 (Ex. 1009, “Lee”).

<sup>3</sup> C. Narayanaswami et al., *IBM’s Linux Watch: The Challenge of Miniaturization*, IEEE Computer, Vol. 35, 33–41, Jan. 2002 (Pet. 33), (Ex. 1008, “Narayanaswami”).

<sup>4</sup> U.S. Patent No. 7,945,292 B2, filed May 30, 2007, issued May 17, 2011, (Ex. 1012, “Sweeney”).

## II. DISCUSSION

### A. *Claim Construction*

In an *inter partes* review, we construe claim terms in an 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); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation standard as the claim interpretation standard to be applied in *inter partes* reviews). Consistent with the broadest reasonable construction, claim terms are presumed to have their ordinary and customary meaning as understood by a person of ordinary skill in the art in the context of the entire patent disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). 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).

#### 1. “*Selector Option Switch*”

Petitioner contends a person of ordinary skill in the art would construe the claim term “selector option switch” as excluding touch screen input devices, because the Specification of the ’834 patent describes a touch screen selector as a substitute for the selector option switch. Pet. 13–14. Patent Owner does not propose further construction of this term. PO Resp. 16. We agree with Petitioner that the broadest reasonable construction of the “selector option switch,” when read in light of the Specification of the

'834 patent, excludes touch screen input devices, because the Specification describes the touch screen selector as a substitute, not as an alternative, for the selector option switch. Ex. 1001, 4:7–9 (“Alternatively, the selector option switch 56 and confirming option switch 62 may be substituted with touch screen selector and confirming options respectively.”). We construe “selector option switch” to exclude touch screen input devices.

2. “*Coupled*”

Patent Owner contends a person of ordinary skill in the art would construe the claim term “coupled” as “connected, directly or indirectly.” PO Resp. 18. Petitioner agrees. Reply 2. Accordingly, we construe the claim term “coupled” to encompass at least a direct connection or an indirect connection.

3. “*Cell Phone Receiver*”

Patent Owner contends a person of ordinary skill in the art would construe the term “electronic transmitter further configured to transmit said electronic text message and said recipient telephone number to a cell phone receiver” recited in claim 6 as an electronic transmitter configured to transmit said electronic text message and said recipient telephone number to *a receiver of a cell phone that is paired to the vibrating device*. PO Resp. 18–24 (emphasis added). According to Patent Owner, the claimed “cell phone” is “a cell phone that is paired to—*i.e.*, wirelessly communicates directly with—the vibrating device.” *Id.* at 18–19. To support this construction, Patent Owner highlights that the '834 patent discloses the electronic transmitter of the vibrating device is configured to be electronically coupled to an electronic receiver coupled to the cell phone.

*Id.* at 22. Patent Owner’s contention that the disclosure of a transmitter of a vibrating device coupled to a receiver of a cell phone means the “cell phone is paired to—*i.e.*, wirelessly communicates directly with—the vibrating device” contradicts Patent Owner’s position that “coupled” means connected, directly or indirectly.

Petitioner agrees that the Specification of the ’834 Patent discloses coupling the electronic transmitter of the vibrating device to the cell phone. Reply 4. But Petitioner contends the meaning of “coupled” is not limited to a direct, paired connection, but encompasses a direct or indirect connection. *Id.* at 5.

The Specification of the ’834 Patent does not set forth the construction of “cell phone receiver” as a direct, paired connection. In describing the connection between the vibrating device and the cell phone, the Specification does not use the term paired, nor the term direct connection. Rather, the Specification discloses the electronic transmitter of the vibrating device as electronically *coupled to* the receiver coupled to the cell phone. Ex. 1001, 4:12–16 (emphasis added).

We construe the scope of the term “electronic transmitter further configured to transmit said electronic text message and said recipient telephone number to a cell phone receiver” recited in claim 6, when read in light of the Specification of the ’834 patent, as encompassing at least an electronic transmitter further configured to transmit said electronic text message and said recipient telephone number to a receiver of a cell phone that is connected, directly or indirectly, to the vibrating device.

4. *“Received From A Cell Phone Transmitter”*

Patent Owner contends a person of ordinary skill in the art would construe the term “received from a cell phone transmitter” recited in claim 8 as received from the transmitter of a cell phone that is paired to the vibrating device. PO Resp. 18–24. In describing the connection between the vibrating device and the cell phone, the Specification does not use the term paired. Rather, the Specification discloses the electronic receiver in the vibrating device is configured to be electronically *coupled to* the electronic transmitter of the cell phone, and is further configured to receive the electronic signal transmitted from the transmitter. Ex. 1001, 3:1–11 (emphasis added). We have construed “coupled” to encompass a direct or indirect connection, as discussed above.

Accordingly, we are not persuaded that “received from a cell phone transmitter” is limited to received from a transmitter of a cell phone that is paired to the vibrating device. Rather, the scope of the term “received from a cell phone transmitter” as recited in claim 8, when read in light of the Specification’s disclosure of coupled, encompasses at least, received from a cell phone transmitter that is connected, directly or indirectly, to the vibrating device.

5. *“Memory Unit Further Configured to Store Said First Electronic Signal”*

Patent Owner contends a person of ordinary skill in the art would construes the claim term “memory unit further configured to store said first electronic signal” as a device in which information can be stored and retrieved for later use. PO Resp. 24. Dr. Shamos testifies that this

construction of the term “memory” is consistent with a dictionary definition of “a device (as a chip) or component of a device in which information esp[ecially] for a computer can be inserted and stored and from which it may be extracted when wanted.” Ex. 2005 ¶ 48 (citing Ex. 2004, Merriam-Webster’s Collegiate Dictionary).

Petitioner contends the duration of “later,” as set forth in Patent Owner’s proposed construction, is (a) not recited in the claim, (b) not required in light of the Specification, and (c) is indefinite. Reply 7. Dr. Sarrefzadeh testifies that the term “later” is not helpful because “later” for a computer network could be a single millisecond, or a minute, or an hour, or a year or more. Ex. 1014 ¶ 14. Dr. Sarrefzadeh further testifies that memory units such as individual flip-flops or registers are used to store information for a very short amount of time, and memory units such as RAM and ROM generally store information for a longer amount of time. *Id.* at ¶ 16. Dr. Sarrefzadeh testifies that in either case, the memory unit is holding, storing, or saving information. *Id.*

There is a degree of overlap between the dictionary definition cited by Patent Owner, and the testimony of Dr. Sarrefzadeh. In particular, both indicate that one of ordinary skill in the art would understand that a memory unit stores information for an amount of time. We construe the scope of “a memory unit further configured to store said first electronic signal” as encompassing at least a device or a component of a device, such as a RAM, ROM, flip-flop, or register, in which said first electronic signal can be inserted and stored and from which it may be extracted when wanted.

*B. Asserted Anticipation by Acharya:  
Claims 6–14*

Petitioner contends that nine claims of the '834 patent — independent claims 6 and 10, and dependent claims 7–9 and 11–14 — are unpatentable under 35 U.S.C. § 102(b) as anticipated by Acharya. Pet. 13–43. Patent Owner disputes Petitioner's position, arguing that Acharya fails to anticipate claims 7–9 and 11–14. PO Resp. 25–52. We have reviewed the Petition, Patent Owner's Response, Petitioner's Reply, as well as the relevant evidence discussed in those papers and other record papers. As described in further detail below, we determine that the record supports Petitioner's contentions that claims 7–9 and 11–14 are anticipated by Acharya, and we adopt Petitioner's contentions discussed below as our own. For reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 7–9 and 11–14 are anticipated by Acharya.

*1. Acharya (Ex. 1007)*

Acharya describes a method and apparatus for integrating a portable device within a session initiation protocol (“SIP”) infrastructure. Ex. 1007, Abstract. Figure 1 of Acharya is reproduced below.

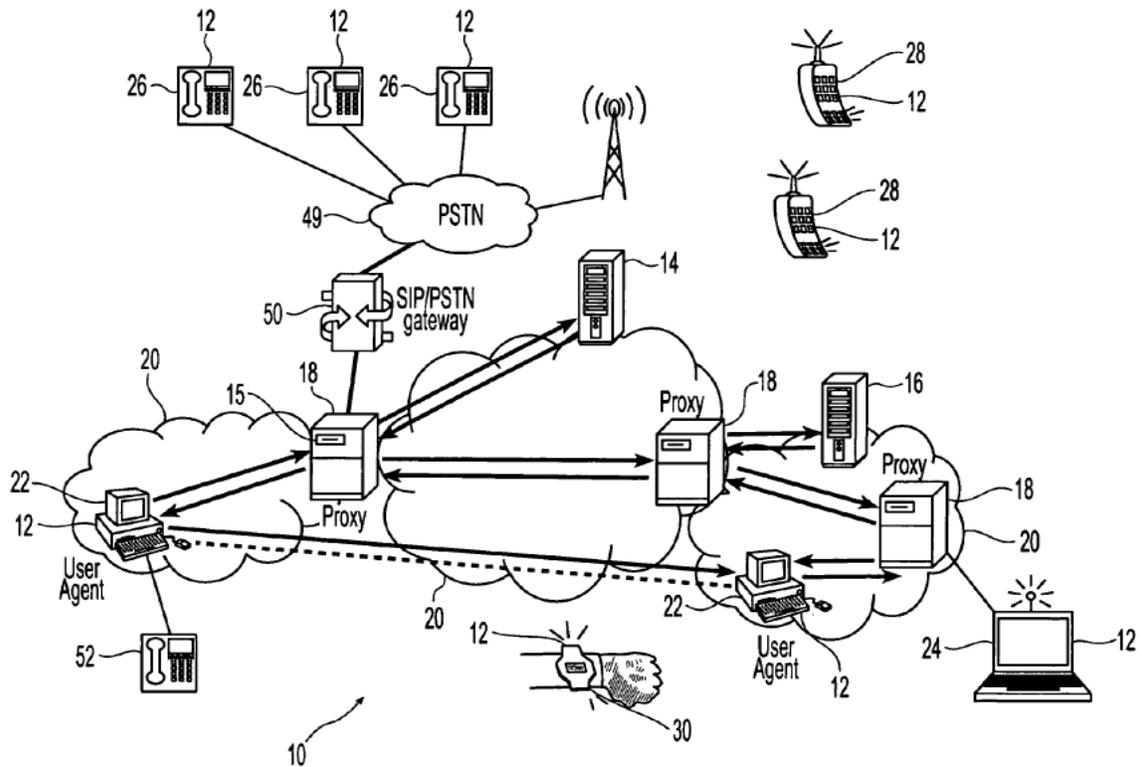


Figure 1 shows an example of portable device 30 within SIP infrastructure 10, which also includes user agents 12, redirect server 14, registration server 15, location server 16 and SIP proxy servers 18 deployed across networks 20, PSTN network 49, and SIP/PSTN gateway 50. Ex. 1007, 3:50–56. Each user agent 12 is associated with a user device such as desktop 22, laptop 24, wireless phone 26, and portable device 30. *Id.* at 3:56–63. Examples of portable device 30 include wireless or cellular phones 28, personal digital assistants, and a wearable device such as a wrist watch. *Id.* at 3:56–4:4.

## 2. Analysis

### a. Independent Claim 6

Relying on the testimony of Dr. Majid Sarrafzadeh, Petitioner argues that Acharya discloses each limitation of independent claim 6, expressly or inherently. Pet. 15–19 (citing Ex. 1002).

#### i. “An Electronic Receiver and A Vibrating Unit”

Pointing to Acharya’s vibrating unit 30 and its associated receiver (*see* Ex. 1001, Fig. 1 above), Petitioner contends Acharya discloses “an electronic receiver configured to be coupled to said vibrating device, said electronic receiver further configured to receive said first electronic signal, and at least one of a second electronic signal and a third electronic signal” as recited in claim 6. Pet. 16 (citing Ex. 1007, 4:17–19). Similarly relying on unit 30, Petitioner contends Acharya discloses “a vibrating unit configured to be coupled to said electronic receiver, said electronic receiver configured to facilitate actuating said vibrating unit in response to said first electronic signal” as recited in claim 6. Pet. 16 (citing Ex. 1007, 4:1–22; 8:6–14; 13:53–58).

Petitioner relies on the testimony of Dr. Sarrafzadeh to argue that the electronic receiver must necessarily be coupled to the vibrating unit and must necessarily facilitate actuating the vibrating unit by notifying the vibrating unit when a signal has been received, in order for the device of Acharya to vibrate on receipt of a signal. Pet. 17 (citing Ex. 1002 ¶¶ 33–34). Dr. Sarrafzadeh testifies

[a]s a matter of logic, in order for the portable device of Acharya to vibrate in response to an incoming signal, such

as a telephone call or electronic message, the electronic receiver must communicate to some other component(s) of the portable device that a signal was received. This communication could be a direct signal to the vibrating unit or device, or the communication could be a signal routed through a microprocessor, memory, and possibly other components, to actuate the vibrator. In this sense – because the electronic receiver, on receiving an electronic signal from outside, provides a signal which actuates, directly or indirectly, the vibration generating mechanism, the electronic receiver of Acharya must be, in the words of claim 6, “configured to facilitate actuating the vibrating unit in response an electronic signal.” Without an actuating signal, the vibrator would never vibrate.

Ex. 1002 ¶ 34. In view of the cited disclosures in Acharya, we determine the record supports Petitioner’s contention that the vibrating unit 30 and associated electronic receiver of Acharya discloses the claimed “electronic receiver and a vibrating unit.”

*ii. “A Memory Unit”*

Petitioner contends Acharya discloses “a memory unit configured to be coupled to said electronic receiver, said memory unit further configured to store said first electronic signal” as recited in claim 6 in disclosing that a dynamic RAM and flash memory in the portable device hold a received invitation to join a media exchange session. Pet. 17 (citing Ex. 1007, 2:48–59, 4:14–15). Petitioner argues that the dynamic RAM and flash memory in Acharya must necessarily be coupled to the electronic receiver to hold the received invitation. Pet. 17 (citing Ex. 1007, 2:48–59, 4:14–15; Ex. 1002 ¶¶ 35–36).

Dr. Sarrafzadeh testifies as follows:

Acharya discloses that the portable device may receive and hold invitations to join media exchange sessions, for example, at Column 2, lines 48-59. In order to store the invitations received by the device, the electronic receiver must necessarily be able to transfer the invitations to at least a memory storage device, such as a register, for a specified period of time, and in order to effect that transfer, the electronic receiver must necessarily be coupled to a memory storage device. Without communication between the electronic receiver and a memory unit, the device could not “hold” invitations.

Ex. 1002 ¶ 36.

Patent Owner contends the description at column 2 of Acharya describes holding an invitation on the portable device, but does not disclose a “memory unit configured to store the first electronic signal,” as recited in claim 6. PO Resp. 39. Specifically, Patent Owner contends Acharya does not disclose storing any media, such as a text message, on the portable device. *Id.* at 39–40, 42. Patent Owner, relying on testimony of Dr. Shamos, contends that the hold functionality discussed in Acharya simply describes how the provisional messages are sent by a server in the SIP infrastructure and not by the callee. *Id.* at 41–42 (citing Ex. 2005 ¶ 92). According to Patent Owner, temporarily queuing a SIP request until the called party is available does not constitute storing a first electronic signal (such as an incoming call or text) for later retrieval by the user, and no other predefined responses to the SIP invite request require storing information on the portable device for later use. *Id.* at 42 (citing Ex. 2005 ¶ 93).

Patent Owner’s contention that temporarily queuing a SIP request until the called party is available does not constitute storing an incoming call or text is not commensurate with the scope of the claim. Claim 6 does not

limit the first electronic signal to an incoming call or text message. Rather, claim 6 recites a “memory unit further configured to store said first electronic signal.” Column 2 of Acharya discloses that “the portable control device processes the invitation . . . [by] holding the invitation for a specified period of time” (Ex. 1007, 2:48–59), which describes a “memory unit further configured to store said first electronic signal” as recited in claim 6.

Further, even under Patent Owner’s narrower construction, Patent Owner’s contention that temporarily queueing a SIP request does not constitute storing an incoming text is inconsistent with Acharya’s disclosure that the control message of a SIP-based publish-subscribe system received and held by the portable device carries an instant message. Petitioner, relying on testimony of Dr. Sarrefzadeh, contends that the SIP invite request held by Acharya can contain a text message in the body of the request.

Reply 18 (citing Ex. 1014 ¶¶ 17–21). Dr. Sarrefzadeh testifies that

requests, such as an INVITE message sent by the UAC can contain a message “body.” Ex. 2001 at 33. This is consistent with Acharya’s teaching that, particularly for IM messages and publish-subscribe content, “the payload of an IM is carried as a signaling message, i.e., the ‘control’ message itself carries the ‘media’ which is the IM payload in this case.” Ex. 1007 at 17:25–38. In such cases, when the request is held (or stored, or saved) by the portable device, so is the electronic signal because the request carries the electronic signal. . . . [B]oth Acharya and the cited Network Work Group Memo on SIP contemplate that the portable device or UAS can receive an invitation, which may contain a text message or publish-subscribe information, and may hold the invitation for “extended durations.”

Ex. 1014 ¶¶ 20–21 (citing Ex. 1007, 17:25–38).

Patent Owner's arguments either rely on a construction of "said first incoming signal" not commensurate with the scope of the claim, or are based on the premise that queuing the SIP request does not describe storing an incoming text, which we find unpersuasive given the disclosures of Acharya and the testimony of Dr. Sarrefzadeh.

In view of the cited disclosures in Acharya, we determine that the record supports Petitioner's contentions that Acharya describes "a memory unit configured to be coupled to said electronic receiver, said memory unit further configured to store said first electronic signal" as recited in claim 6.

*iii. "A Selector Option Switch"*

Petitioner contends Acharya discloses a selector option switch configured to be coupled to the vibrating device, configured to select an electronic text message from a plurality of pre-programmed electronic text messages stored in the memory unit, and configured to select a telephone number from a list of telephone numbers stored in the memory unit. Pet. 18 (citing Ex. 1007, 10:14–22; 12:11–26; 16:49–61). In view of the cited disclosures in Acharya, which include a selector switch such as a watch stem switch or a button, we determine the record supports Petitioner's contention that Acharya discloses the claimed "selector option switch."

*iv. "An Electronic Transmitter"*

Petitioner contends Acharya discloses "an electronic transmitter configured to be coupled to said memory unit of said vibrating device, said electronic transmitter further configured to transmit said electronic text message and said recipient telephone number to a cell phone receiver" as recited in claim 6. Pet 18–19; Reply 14–16. Specifically, Petitioner

contends that Acharya discloses the portable device has a Bluetooth transmitter. Pet. 18 (citing Ex. 1007, 4:17–22); Reply 14. According to Petitioner, the portable device establishes a connection with an initiating user’s device, such as a cellular phone. Pet. 18 (citing Ex. 1007, 8:40–44, 12:47–49); Reply 15. Petitioner contends Acharya discloses selecting a destination phone number from an address book on the portable device, and sending the phone number to the initiating user’s cellular phone. Pet. 18 (citing Ex. 1007, 12:14–16, 55–60); Reply 14–15. Petitioner contends that although Acharya describes transmitting the destination phone number to the initiating user’s device in relation to a call, the transmitter may instead transmit a text message along with the destination number to the initiating user’s cellular phone. Pet. 19 (citing Ex. 1007, 15:51–55); Reply 15.

Petitioner also relies on the testimony of Dr. Sarrafzadeh to argue that the electronic transmitter must necessarily be coupled to the memory unit to utilize the phone numbers and pre-programmed lists of actions and responses. Pet. 19 (citing Ex. 1002 ¶¶ 37–39). Dr. Sarrafzadeh testifies that

[i]n order for the electronic transmitter to send information from the memory unit, such as a destination phone number in a portable device address book, to the initiating user’s device, the electronic transmitter must necessarily be in communication with or “coupled to” the memory unit, either directly or through one or more intermediate structures, such as a microprocessor or other device. Otherwise, the electronic transmitter could not send (i.e., transmit) the information stored in the memory unit.

Ex. 1002 ¶ 39.

Patent Owner contends that Acharya’s disclosure of exchanging Instant Messages between the portable device and the intended recipient,

through the SIP infrastructure, does not disclose the electronic transmitter as claimed, because there is no intervening cell phone between the portable device and the other SIP device. *Id.* at 35–36 (citing Ex. 1007, Fig. 9; 17:3–22; Ex. 2005 ¶ 101). According to Patent Owner, the portable device of Acharya communicates through the Internet access point provided by laptop 24 that serves as a Bluetooth base-station and router. *Id.* at 36–37 (citing Ex. 1007, Fig. 1; 11:1–4; Ex. 2005 ¶ 102). Patent Owner, relying on testimony of Dr. Shamos, contends the word “Bluetooth” appears five times in Acharya, but none of these disclosures relate to using a Bluetooth connection to transmit a text message and telephone number directly to a paired cell phone. PO Resp. 37 (citing Ex. 2005 ¶ 104).

Dr. Shamos testifies that the embodiment of Acharya in which the portable device exchanges instant messages with an intended recipient’s cell phone does not include an intervening cell phone between the portable device and the other SIP device. Ex. 2005 ¶ 100 (citing Ex. 1007, Fig. 9; 17:3–22). Dr. Shamos further testifies that column 4 of Acharya discloses a Bluetooth connection between portable device 30 and laptop computer 24, but not between portable device 30 and the cell phones 28. Ex. 2005 ¶ 104 (citing Ex. 1007, Fig. 1; 3:50–4:22, 11:1–4). According to Dr. Shamos, “nothing in this cited material discloses the use of a Bluetooth connection between a cell phone and a watch . . . requiring transmission of said electronic message and said recipient telephone number to a cell phone receiver.” Ex. 2005 ¶ 104.

Dr. Shamos also testifies that column 13 of Acharya

discloses the *automatic* transfer of a call from a cell phone to a portable device 30 through a Bluetooth link or through the SIP infrastructure. *Id.* at 43-52. In this occurrence, the cell phone is “augmented” with a SIP user agent programmed to automatically transfer incoming calls to the portable device 30. *Id.* at lines 46-52. There is no disclosure of any communication from the portable device 30 back to the cell phone, as required by the claims. Nothing in this occurrence of “Bluetooth” discloses the use of a Bluetooth connection between a cell phone and a watch as required by the language of claims 6 and 10 requiring transmission of said electronic text message and said recipient telephone number to a cell phone receiver.

Ex. 2005 ¶ 104 (citing Ex. 1007, 13:43–52). Patent Owner contends that because Acharya does not disclose directly transmitting a text message and a telephone number to a paired cell phone using a wireless connection such as Bluetooth, Acharya does not disclose the electronic transmitter as claimed. *Id.* at 38 (citing Ex. 2005 ¶¶ 67 and 103).

Petitioner contends that claim 6 does not require the electronic transmitter to transmit the text message and phone number directly to a cell phone paired with the vibrating device. Reply 13. We agree with Petitioner. We construed the scope of the claim term an “electronic transmitter further configured to transmit said electronic text message and said recipient telephone number to a cell phone receiver” as encompassing at least an electronic transmitter further configured to transmit said electronic text message and said recipient telephone number to a receiver of a cell phone that is coupled (*i.e.*, connected, directly or indirectly) to the vibrating device. Therefore, Patent Owner’s contention is not commensurate with the scope of the claim. We determine that the record supports Petitioner’s contentions

that the Bluetooth transmitter of Acharya (Pet. 18 (citing Ex. 1007, 4:16–22)) can send a recipient’s telephone number (Pet. 18–19 (citing Ex. 1007, 12:14–16, 55–60)) and a text message (Pet. 19 (citing Ex. 1007, 15:51–55)) to an initiating user’s cell phone device (Pet. 18 (citing Ex. 1007, 8:40–44)).

Petitioner further contends that, even under Patent Owner’s narrow reading that this limitation requires a direct connection between the transmitter and the cellular phone, Acharya discloses this limitation in describing that the transmitter can send a text message along with the destination number to the initiating cellular phone using Bluetooth, such as a direct Bluetooth link between the cellular phone and the portable device. Reply 15–16 (citing Ex. 1007, 4:17–22, 13:46–52, 15:51–55, 19:43–45; Ex. 2006, 80:12–21).

We agree with Petitioner that even under Patent Owner’s narrow reading, Acharya discloses this limitation. Dr. Shamos is correct in stating that Acharya does not explicitly state that the portable device transmits a phone number and a text message directly to a paired cellular phone using Bluetooth. *See* 2005 ¶ 104. However, the sections of Acharya cited by Dr. Shamos in paragraph 104 of his Declaration disclose a portable device having a direct Bluetooth link (Ex. 1007, 4:17–19, 11:1–4, 13:46–52) to a user device such as a laptop or a cellular phone augmented with a SIP user agent (Ex. 1007, 3:50–66, 11:1–4, 13:46–52) that serves as a Bluetooth base-station and router into the SIP network for the portable device (Ex. 1007, Fig. 1; 11:1–4). This configuration allows the portable device to participate in media transfer such as an IM session over the SIP network (Ex. 1007, Fig. 9; 3:50–66, 17:3–10).

Although the cited sections of Acharya disclose that in one embodiment, the laptop, rather than the cellular phone, serves as the Bluetooth base-station and router into the SIP network, the additional sections of Acharya cited by Petitioner disclose that features and/or elements from any embodiment may be used singly or in combination with other embodiments (Ex. 1007, 19:43–45), and that the embodiments can be used for any type of media exchange communication session including audio, video, text, and combinations thereof (Ex. 1007, 15:51–55).

Even under Patent Owner’s narrower reading of the claim, we determine that a person of ordinary skill in the art, reading Acharya, would at once envision that the cellular phone of Acharya, with a direct Bluetooth link to the portable device (Ex. 1007, 13:46–52), and augmented with a SIP agent that controls media transfer (Ex. 1007, 3:50–66, 13:46–52), can serve as a Bluetooth base-station and router into SIP network 18 (Ex. 1007, 11:1–4) for the portable device to participate in an IM session over the SIP network (Ex. 1007, 15:51–55, 17:3–10).

We determine that the record supports Petitioner’s contentions that Acharya describes “an electronic transmitter configured to be coupled to said memory unit of said vibrating device, said electronic transmitter further configured to transmit said electronic text message and said recipient telephone number to a cell phone receiver” as claimed 6. Based on the foregoing discussion and the record, Petitioner has shown by a preponderance of the evidence that Acharya anticipates claim 6.

*b. Independent Claim 10 and Dependent Claim 14*

Petitioner contends independent claim 10 recites a vibrating device comprising an electronic receiver, a vibrating unit, a memory unit, a selector option switch, and an electronic transmitter configured as in claim 6, which are disclosed by Acharya. Pet. 19. Claim 10 further recites a strap. Ex. 1001, 8:60. Dependent claim 14 further recites a strap fastening mechanism including one of a buckle and a hook-and-loop fastener. *Id.* at 10:18–22. Petitioner contends Figure 1 of Acharya is an image of a wrist watch that appears to include a strap as recited in claim 10. Pet. 19–20 (citing Ex. 1007, Fig. 1; 4:4–7). Petitioner further contends the disclosure of Narayanaswami, incorporated by reference in Acharya, discloses a vibrating device having a watch strap with standard buckles and band holder pins as recited in claim 14. Pet. 20, 25 (citing Ex. 1008, Fig. 1; 33, 38). Patent Owner does not present separate arguments for the anticipation ground for claims 10 and 14. The burden, however, remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

Based on the foregoing discussion and the record, Petitioner has shown by a preponderance of the evidence that Acharya anticipates claims 10 and 14.

*c. Dependent Claims 7 and 11*

Claims 7 and 11 recite a display panel configured to display an electronic signal. Ex. 1001, 8:38–41; 9:23 to 10:2. Petitioner contends Acharya also discloses a display panel configured to display an electronic signal. Pet. 21 (citing Ex. 1007, 4:17–19; 16:49–52; Figs. 3 and 5; Ex. 1008,

Fig. 1). Patent Owner does not present separate arguments for claims 7 and 11. The burden, however, remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

Based on the foregoing discussion and the record, Petitioner has shown by a preponderance of the evidence that Acharya anticipates claims 7 and 11.

*d. Dependent Claims 8 and 12*

Claims 8 and 12 recite the first electronic signal, and at least one of the second and third electronic signals, is received from a cell phone transmitter. Ex. 1001, 8:42–45; 10:3–6. Petitioner contends Acharya discloses the portable device receiving signals from a cell phone. Pet. 21 (citing Ex. 1007, Fig. 8; 8:10–13). Specifically, Petitioner contends that Acharya discloses the portable device “may be used as a front-end to other devices such as a cell-phone or PDA. For example, a watch screen can act as a proxy for the cell-phone or PDA’s user interface. Pet. 21 (citing Ex. 1007, 8:10–13). Petitioner relies on testimony of Dr. Sarrefzadeh to contend that in order to act as a proxy for the cell phone, the device must necessarily receive signals from the cell phone. *Id.* (citing Ex. 1002 ¶¶ 40–41). According to Petitioner, Acharya discloses the portable device receiving an electronic signal from a cell phone. *Id.* (citing Ex. 1007, Fig. 8).

Patent Owner contends that claims 8 and 12 require the vibrating device to receive electronic signals from a cell phone that is paired to the vibrating device. PO Resp. 42. According to Patent Owner, nothing in Figures 1 and 8 and the related disclosure of Acharya shows a direct

transmitter/receiver relationship between wearable device 30 and a cell phone as required by claims 8 and 12. *Id.* at 47–49.

Petitioner further contends claims 8 and 12 do not require a cell phone paired to the vibrating device. Reply 19. We agree with Petitioner, that Patent Owner’s contention is not commensurate with the scope of the claim, as discussed in our analysis of claim 6. We emphasize that claim 8 recites that “the first electronic signal, and at least one of the second and third electronic signals, is received from a cell phone transmitter,” not *directly* from a cell phone transmitter as Patent Owner contends. We determine that Figures 1 and 8 of Acharya show at least an indirect transmitter/receiver connection between the portable device and the cell phone. We determine that the record supports Petitioner’s contentions that Acharya discloses the portable device receives electronic signals from a cell phone.

Petitioner further contends that even under Patent Owner’s narrow construction of claims 8 and 12, Acharya discloses a cellular phone and a portable device exchanging text messages and other electronic signals over a direct, paired connection between the cellular phone and the portable device. Reply 19–20 (citing Ex. 1007, 13:46–52, 15:51–55). We agree with Petitioner. Even under Patent Owner’s narrower reading of the claim, we determine that the record supports Petitioner’s contention that Acharya discloses a cell phone with a direct Bluetooth link to the portable device.

Based on the foregoing discussion and the record, Petitioner has shown by a preponderance of the evidence that Acharya anticipates claims 8 and 12.

*e. Dependent Claims 9 and 13*

Claim 9 recites

said first electronic signal comprises one of an electronic text message with identifying information of a sender and identifying information of a caller, said second electronic signal comprises a date and time in real-time, and said third electronic signal comprises at least one of a calendar appointment notification signal, an e-mail notification signal, a current local weather signal, a current altitude signal, a current local temperature signal, a current local pressure signal, a current stock ticker signal, a current sport score signal, and a current news flash signal.

Ex. 1001, 8:46–56. Claim 13 recites similar limitations. *Id.* at 10:7–17.

Petitioner contends Acharya discloses displaying an incoming text message with a sender’s name and address, which describes the claimed first electronic signal. Pet. 21 (citing Ex. 1007, 16:49–52). Petitioner further contends Acharya discloses SIP runs in the context of Real-Time Transport Protocol (“RTP”). Pet. 24 (citing Ex. 1007, 1:36–39). Petitioner relies on testimony of Dr. Sarrafzadeh to argue the use of RTP disclosed by Acharya includes transmitting time stamps in real-time for synchronization, including date and time information, which describes the claimed second electronic signal. Pet. 24 (citing Ex. 1002 ¶¶ 42–44). Petitioner contends the publish-subscribe systems of Acharya, which provide information about weather conditions or stock prices, include the claimed third signal. Pet. 23–24 (citing Ex. 1007, 15:51–57; 17:39–58; 18:65 to 19:38). Patent Owner does not present separate arguments addressing these contentions.

Petitioner also contends the information contained in the second and third electronic signals recited in claims 9 and 13 is non-functional

descriptive material. Pet. 22–23. According to Petitioner, the information as claimed does not have a functional relationship with the vibrating device, and therefore does not distinguish claims 9 and 13 over the electronic signals disclosed by Acharya. Pet. 23 (citing Ex. 1007, 15:51–55).

Patent Owner responds that the information contained in the second and third signals as claimed is functional. PO Resp. 50–51. According to Patent Owner, the various electronic signals are functional and are entitled to patentable weight because the signals contain information used by application programs and information regarding their physical interrelationship within a memory. PO Resp. 51. Patent Owner also contends that the content of the electronic signals has a functional relationship with the vibrating device, because without the content, the device would be unable to determine what data to display to the user. *Id.*

Petitioner replies that the claimed electronic signals recite non-functional descriptive material because the signals are defined solely by what they communicate. Reply 21. According to Petitioner, the '834 patent draws no functional distinction between displaying one type of information versus another. *Id.* Petitioner also contends that the RTP of Acharya would include signals comprising the date and time in real-time. Reply 22–23 (citing Ex. 1007, 1:36–39, Ex. 1014 ¶¶ 29–30, Ex. 1002 ¶¶ 43–44).

Even under Patent Owner's reading that the various signals are functional and entitled to patentable weight, Acharya discloses that the signals received by the portable device include an incoming text message with the sender's name and address (Ex. 1007, 16:49–52), and information about weather and stock prices (Ex. 1007, 17:39–58). Further, Dr.

Sarrefzadeh testifies that Acharya's disclosure of RTP includes transmitting date and time information to the portable device. Ex. 1002 ¶¶ 42–44.

We determine that the record supports Petitioner's contentions that Acharya discloses displaying an incoming text message with a sender's name and address (Ex. 1007, 16:49–52), that the RTP of Acharya discloses transmitting date and time (Ex. 1002 ¶¶ 42–44), and that the stock and weather information disclosed by Acharya (Ex. 1007, 15:51–57; 17:39–58; 28:65 to 19:38) discloses a stock ticker signal and a weather signal within the meaning of claim 9. Based on the foregoing discussion and the record, Petitioner has shown by a preponderance of the evidence that Acharya anticipates claims 9 and 13.

*C. Asserted Obviousness of Claims 9, 10, 13, and 14 over Acharya*

For claims 9 and 13, Petitioner contends modifying the content of the electronic signals received by the vibrating device to substitute one kind of information for another would not have been technically difficult and would have yielded the predictable result of personalization. Pet. 26–27 (citing Ex. 1007, 15:51–55; 17:39–58; 18:65 to 19:38). Petitioner relies upon a similar disclosure as the anticipation challenge, but argues that it would have been obvious to one of ordinary skill in the art to include other kinds of informational content in the signals transmitted to the electronic device because “[e]xpanding or changing the subject matter communicated by the signals would have been a predictable modification of the technology for an art recognized purpose, i.e., personalization” to “appeal to different users and/or to allow users to personalize their device.” Pet. 26–27.

Patent Owner contends Petitioner or its expert did not provide any reason why a person of ordinary skill would have sought to combine particular available elements to reach the claimed invention. PO Resp. 52–54. According to Patent Owner, Acharya does not suggest a need for transmitting date and time information, or for transmitting, *inter alia*, a current local weather signal or a current stock ticker signal. PO Resp. 54–55.

Petitioner contends that Acharya discusses the feasibility and motivation to personalize a device to receive different kinds of signals and informational content. Reply 23 (citing Pet. 25–27). Specifically, Petitioner contends that Acharya teaches providing personalized information such as weather conditions or updates on stock prices. Pet. 26–27 (citing Ex. 1007, 15:51–57, 17:39–58, 18:65–19:38). Petitioner contends that a person of ordinary skill in the art would include information such as weather conditions or updates on stock prices as taught by Acharya in the electronic signals received and displayed by the portable device to achieve the predictable benefit of allowing users to receive personalized information as taught by Acharya. Pet. 27.

Petitioner’s showing is persuasive. Petitioner provides several reasons, as outlined above, for modifying Acharya. For example, providing different types of information obviously would have appealed to different users, and would have allowed users to personalize their device. *See* Pet. 26–27.

Based on the foregoing discussion and the record, Petitioner has shown by a preponderance of the evidence that the teachings of Acharya render claims 9 and 13 obvious.

For independent claims 10 and 14, Petitioner contends persuasively that adding a strap with a buckle fastener to the portable wrist watch device of Acharya would have been obvious because wrist watches commonly have a strap secured to a wearer's wrist by a buckle in order to secure the device to the wrist. *See* Pet. 28–29 (citing Ex. 1007, 4:7–13).

Based on the foregoing discussion and the record, Petitioner has shown by a preponderance of the evidence that the teachings of Acharya render claims 10 and 14 obvious.

*D. Asserted Obviousness of Claims 9 and 13 over Acharya and Lee*

*1. Lee (Ex. 1009)*

Lee discloses a function of setting an internal time corresponding to a standard time at a current location in a mobile station. Ex. 1009, 3:45–47. To do this, the mobile station of an asynchronous scheme uses a Simple Network Time Protocol (“SNTP”), allowing the mobile station to easily update internal time information using a synchronized time. *Id.* at 3:48–52. The SNTP can provide a time value which can be used to exactly reset an internal time of the mobile station of an asynchronous scheme. *Id.* at 3:52–54. By using the SNTP, the mobile station of an asynchronous scheme can obtain exact time information and update the internal time by itself with the time suitable for an area in which a standard time is changed. *Id.* at 3:54–58.

*2. Analysis*

Petitioner contends independent claim 6 receives an electronic receiver configured to receive “at least one of a second electronic signal and a third electronic signal,” which renders the “second electronic signal comprises a date and time in real-time” recited in claim 9 an alternative option to the third electronic signal. Pet. 30. Petitioner also contends even if a signal comprising the date and time in real-time is construed as essential to the claims, receiving a signal conveying the date and time in real-time was known in the art. *Id.* In particular, Petitioner contends Lee teaches “said second electronic signal comprises a date and time in real-time” within the meaning of claim 9. *Id.* at 31.

To support this contention, Petitioner relies on Lee’s teaching of SNTP for transmitting an electronic signal with date and time information in real-time to a mobile station to update the internal time of the mobile station. Pet. 31–32 (citing Ex. 1009, 3:45–58; 4:19–24; 4:60 to 5:3; 5:33–46). Petitioner argues setting the time of the portable device of Acharya using the SNTP of Lee would have been obvious because the SNTP protocol allows the mobile station to automatically set time without a user having to manually set the time when the mobile station encounters a time difference such as movement between time zones. *Id.* at 32.

Patent Owner, relying on testimony of Dr. Shamos, contends a person of ordinary skill would not provide the time synchronization of Lee in the SIP protocol of Acharya, because the use of absolute time in SIP causes interoperability problems in elements that were not time synchronized. PO Resp. 57–58 (citing Ex. 2005 ¶¶ 129–132).

Petitioner contends that SIP runs on top of different transport protocols, including Real Time Protocol (RTP), which includes signals comprising the date and time in real time. Reply 24–25 (citing Ex. 1007, 1:36–39; Ex. 1014 ¶¶ 29–30; Ex. 1002 ¶¶ 43–44). According to Petitioner, excluding absolute time from certain SIP message headers and parameters would not prevent using SNTP to synchronize time on a device within a SIP network. Reply 24 (citing Ex. 1014 ¶ 31). Petitioner relies on Lee’s description of receiving a date and time signal to automatically set the time of the mobile device when the mobile station changes time zones, as motivation for one of ordinary skill in the art to send the date and time signal to the portable device of Acharya. Pet. 32; Reply 24 (citing Ex. 1009, 7:66–8:9, 8:37–46).

We determine that the records supports Petitioner’s contentions that the “second electronic signal comprises a date and time in real-time” is an alternative to the third electronic signal. Petitioner has also established that the combination of Acharya and Lee teaches transmitting an electronic signal with date and time information to the portable device, for the benefit of allowing the mobile station to automatically set time, as taught by the prior art.

Based on the foregoing discussion and the record, Petitioner has shown by a preponderance of the evidence that the combination of Acharya and Lee render claims 9 and 13 obvious.

*E. Asserted Obviousness of Claims 10 and 14 over Acharya and Narayanaswami*

*1. Narayanaswami (Ex. 1008)*

Narayanaswami discloses a wristwatch computer that looks like an ordinary watch but runs Linux computer operating system, features graphics, and offers wireless connectivity. Ex. 1008, 33. Figures 1(a) and 1(b) show a wristwatch computer having an organic light emitting diode (OLED) and a liquid crystal display (LCD) display, respectively. *Id.* at 34. Figures 1(a) and 1(b) also show a strap connected to the wristwatch computer. *Id.*

*2. Analysis*

Claim 10 of the '834 patent recites “a strap” and “a vibrating device coupled to said strap.” Ex. 1001, 8:60–61. Claim 14 recites a “wrist wound vibrating device in accordance with claim 10 wherein said strap is coupled to a wrist of the user using a strap fastening mechanism, said strap fastening mechanism including one of a buckle and hook-and-loop fastener.” *Id.* at 10:18–22. With respect to these challenged claims, Petitioner relies on Narayanaswami to teach a vibrating watch having a watch strap with standard buckles and band holder pins. Pet. 33–34. Petitioner contends adding the strap with the buckle fastener of Narayanaswami to the wrist watch of Acharya would have been obvious to a person of ordinary skill in the art at the time of the invention. *Id.* In particular, Petitioner argues Acharya discloses a wrist watch as an example of a portable device. Pet. 33 (citing Ex. 1007, 4:7–13). Petitioner also contends Narayanaswami discloses a vibrating device in the form of a watch having a watch strap with standard buckles and band holder pins. Pet. 33–34 (citing Ex. 1008, Fig. 1;

33, 38). Petitioner concludes combining the watch of Acharya with Narayanaswami's watch strap having a buckle yields a watch with a strap and a buckle. Pet. 34.

Patent Owner contends that Acharya does not disclose the memory unit and electronic transmitter limitations required by claims 10 and 14. PO Resp. 59. We find Patent Owner's contentions unpersuasive for the same reasons given in our anticipation analysis of claim 6 above.

Based on the foregoing discussion and the record, Petitioner has shown by a preponderance of the evidence that the combination of Acharya and Narayanaswami render claims 10 and 14 obvious.

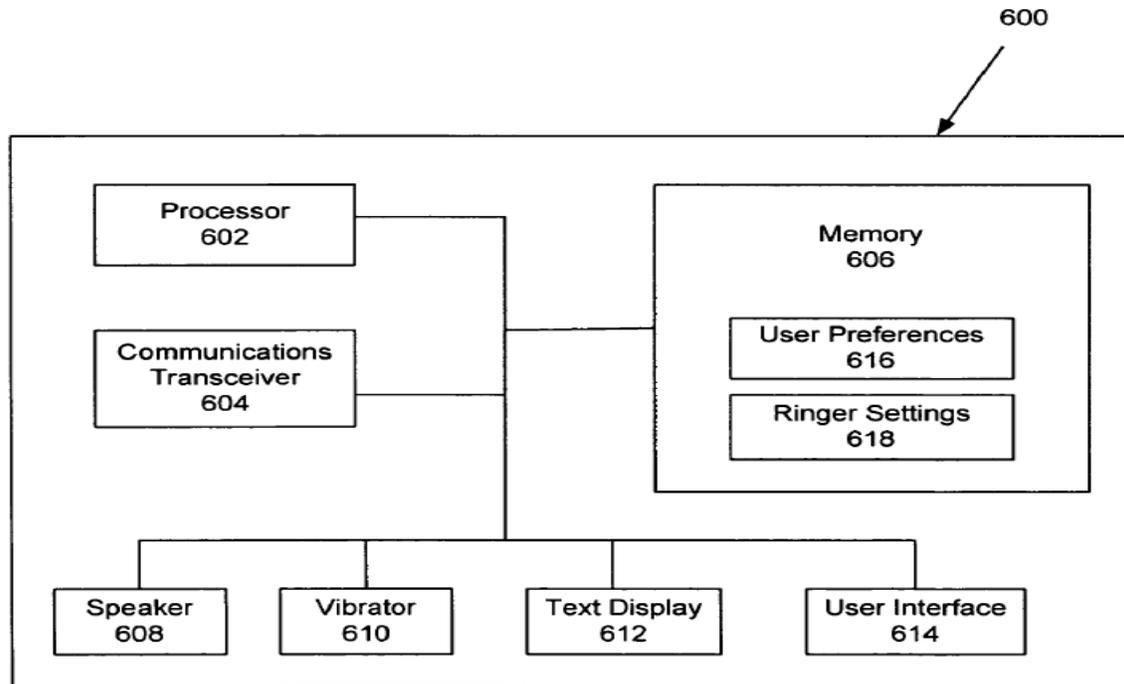
*F. Asserted Obviousness of Claims 6–14 over Sweeney and Acharya*

*1. Sweeney (Ex. 1012)*

Sweeney discloses a system and method for extending alerts for a wireless device. Ex. 1012, Abstract. A wireless ringer and a wireless device are linked through a wireless connection. *Id.* The wireless ringer is alerted in response to receiving an incoming communication on the wireless device in order for a user to access the wireless device to respond. *Id.* Figure 6 of

Sweeney shows an example of the wireless ringer and is reproduced below.

*FIG. 6*



Wireless ringer 600 includes processor 602, communications transceiver 604, memory 606, speaker 608, vibrator 610, text display 612, and user interface 614. Ex. 1012, 7:29–36. The memory 606 includes user preferences 616 and ringer settings 618. *Id.* at 7:36–37. Processor 602 processes signals received from the wireless device through communications transceiver 604. *Id.* at 7:38–40.

## 2. Analysis

### a. “An Electronic Receiver and A Vibrating Unit”

Petitioner argues Sweeney teaches an electronic receiver to receive electronic signals and a vibrating unit, where the electronic receiver facilitates actuating the vibrating unit in response to receiving the signal.

Pet. 35–36 (citing Ex. 1012, 1:55–64; 7:29–46; 8:11–24). In view of the cited disclosures in Sweeney, we determine the record supports Petitioner’s contention that Sweeney discloses the claimed electronic receiver and vibrating unit.

*b. “A Memory Unit”*

Petitioner argues Sweeney teaches an electronic memory. Pet. 36–37 (citing Ex. 1012, 1:58–59). Petitioner also argues Acharya teaches a memory unit coupled to an electronic receiver to hold an invitation received by the electronic receiver. Pet. 37 (citing Ex. 1007, 2:48–59; Ex. 1002 ¶¶ 35–36). Petitioner argues modifying the memory of Sweeney to be coupled to the receiver and to store the first electronic signal provides the benefit of avoiding missed calls by discretely notifying a user of incoming calls. Pet. 37 (citing Ex. 1012, 1:29–40). Petitioner also contends Acharya teaches holding incoming signals for a predetermined time would be helpful. *Id.* (citing Ex. 1007, 2:52–59).

Patent Owner contends the combination of Sweeney and Acharya does not teach a memory unit configured to store a first electronic signal, because Sweeney does not need to store alerts in the wireless ringer, and because Acharya teaches away from storing media on the portable device. PO Resp. 64–65 (citing Ex. 2005 ¶ 147; Ex. 1007, 8:45–52, 9:40–43). According to Patent Owner, Acharya teaches that it is preferred that media is stored on other SIP enabled devices or on proxy servers and not on the portable device itself. *Id.*

Petitioner responds that Acharya teaches that it is preferred that media is stored on other devices, but does not criticize, discredit, or otherwise

discourage storing text messages on the portable device. Reply 26–28 (citing Ex. 1014 ¶¶ 27–28). Dr. Sarrefzadeh testifies that

Acharya contemplates using media devices, with relatively greater power, memory, and possibly display capabilities, with a portable device. But Acharya also contemplates that if the user moves or the media device becomes unavailable, the portable device is capable of serving as an endpoint (“an alternate media device”) in the media exchange path. In order for this to work, the portable device must be capable of receiving and storing media. . . . There is no inconsistency in saying that Acharya describes a situational preference for using a media device to store media *and* that the portable device stores media. To the contrary, saying that the portable device does not or cannot store media is inconsistent with Acharya’s teachings that the portable device can join a media exchange session under a variety of conditions, including serving as an “alternate media device.”

Ex. 1014 ¶¶ 27–28 (internal citations omitted). Patent Owner’s contention that Acharya discloses a preferred alternative of storing media on other devices does not rebut Petitioner’s showing that Acharya teaches media can also be stored on the portable device. In view of the cited disclosures in Sweeney and Acharya, we determine the record supports Petitioner’s contention that the combination of Sweeney and Acharya teaches the claimed memory unit configured to store a first signal.

*c. “A Selector Option Switch”*

Petitioner contends Sweeney teaches the claimed selector option switch as button 304 or dial 306 to send a control signal to place a calling party on hold or to send a text message to a messaging party. Pet. 38–39 (citing Ex. 1012, 6:27–38; Fig. 3). Petitioner also contends Acharya teaches a selector option switch configured to be coupled to the vibrating device, to

select an electronic text message from a plurality of messages stored in memory, and to select a recipient's phone number from a list of phone numbers stored in memory. Pet. 39–40 (citing Ex. 177, 10:14–22, 12:11–26, 16:49–61). Petitioner contends modifying the selector option switch of Sweeney to select an electronic text message from a plurality of messages stored in memory and a recipient phone number from a list stored in memory would enable a user to avoid the inconvenience of finding and securing a larger wireless device. Pet. 40 (citing Ex. 1012, 1:29–40). Petitioner also contends adding the known selector option switch of Acharya to Sweeney's wearable device yields predictable results. Pet. 40–41.

In view of the cited disclosures in Sweeny and Acharya, we determine the record supports Petitioner's contention that the combination of Sweeny and Acharya teaches the claimed selector option switch.

*d. "An Electronic Transmitter"*

Petitioner also contends Sweeney teaches the wireless ringer includes an electronic transmitter that communicates with a wireless device, such as a cell phone, using a Bluetooth connection between the wireless ringer and the wireless device. Pet. 41 (citing Ex. 1012, 3:20–40; 7:54–56).

Patent Owner contends that the combination of Sweeney and Acharya does not teach the electronic transmitter, because the remote ringer in Sweeney does not use the SIP protocol and infrastructure. PO Resp. 66–67. Patent Owner further contends that neither Sweeney nor Acharya disclose transmitting a text message and a recipient telephone number from a vibrating device to a paired cell phone. *Id.* at 67–68. According to Patent Owner, the control signal sent by the wireless ringer to the wireless phone to

send a default text message to a calling or messaging party does not teach selecting and transmitting a preprogrammed text message to a cell phone. *Id.* at 68. Patent Owner further contends that Acharya does not disclose sending a text message and telephone number from a vibrating device to a paired cell phone. *Id.* at 69.

Petitioner relies on Sweeney to teach a Bluetooth connection between the wireless ringer and the cell phone. Pet. 41 (citing Ex. 1012, 3:20–40; 7:29–44; 7:54–56). Petitioner also contends Sweeney contemplates sending a control signal to the cell phone to activate, control, engage, or use features of the cell phone. Reply 26 (citing Ex. 1012, 6:27–38; Ex. 1014 ¶¶ 24–26). Petitioner relies on Acharya to teach selecting and transmitting a text message and telephone number to the cell phone. Pet. 41–42 (citing Ex. 4:17–22; 8:40–44; 12:14–16, 47–49, 55–60; 15:51–55).

Sweeney teaches using a button on the wireless ringer to send a control signal to the wireless device, such as a cell phone, to send a default text message to the calling or messaging party. Ex. 1012, 6:27–38. Acharya teaches selecting a text message and a telephone number and transmitting both to the initiating user’s device, such as a cell phone. Ex. 4:17–22; 8:40–44; 12:14–16, 47–49. Patent Owner’s argument that neither reference alone teaches transmitting a text message and a recipient telephone number from a vibrating device to a cell phone does not rebut Petitioner’s showing that the combination of Sweeney and Acharya teaches transmitting a text message and a recipient telephone number from a vibrating device to a cell phone.

In view of the cited disclosures in Sweeney and Acharya, we determine the record supports Petitioner's contention that the combination of Sweeney and Acharya teaches the claimed electronic transmitter.

*e. Reason to Combine*

Patent Owner argues Petitioner does not identify any reason that would have prompted a person of ordinary skill in the art to modify Sweeney to incorporate the teachings of Acharya. PO Resp. 60–62. Patent Owner further contends that Dr. Sarrefzadeh did not articulate a basis for combining the teachings of Sweeney and Acharya, and therefore Petitioner's analysis is based on bare attorney argument. PO Resp. 62.

Contrary to Patent Owner's arguments, Petitioner articulates several reasons, supported by the record, for combining the references. Petitioner notes that "an apparent reason to combine the known elements in the fashion claimed by the patent" can be found in a variety of sources, including the "interrelated teachings of multiple patents." Reply 12 (citing *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007)). Petitioner argues persuasively that modifying the memory of Sweeney to store the first electronic signal provides the benefit of avoiding missed calls by discretely notifying a user of incoming calls. Pet. 37 (citing Ex. 1012, 1:29–40). Petitioner further argues persuasively that Acharya suggests that holding incoming signals at least for a predetermined time would be helpful. Pet. 37–38 (citing Ex. 1007, 2:52–59).

In view of the foregoing, we determine that the record supports Petitioner's contention that modifying the memory of Sweeney to store the

first electronic signal for at least a predetermined time as taught by Acharya would be helpful and would provide the benefit of avoiding missed calls.

Petitioner adds persuasively that modifying the selector option switch of Sweeney to select an electronic text message and a recipient's phone number from a memory unit as taught by Acharya yields the predictable benefits of increasing the flexibility and utility of Sweeney's wireless ringer, and enables a user to avoid the inconvenience of finding and securing a larger wireless device. Pet. 40 (citing Ex. 1012, 1:29–40). In view of the foregoing, we determine that the record supports Petitioner's contention that modifying the selector option switch of Sweeney to select a message and a phone number as taught by Acharya yields the benefits of increasing flexibility and utility of Sweeney's ringer, and enables the user to avoid securing a larger wireless device. Petitioner also argues persuasively that coupling the electronic transmitter of Sweeney to a memory unit as taught by Acharya, in order to transmit the electronic text message and recipient's phone number selected from the memory unit as taught by Acharya, yields the predictable result of sending information from the wireless device to a cell phone as taught by both Acharya and Sweeney. Pet. 41–43 (citing Ex. 1012, 3:20–40, 7:29–44, 56–56; Ex. 1007, 4:17–22, 8:40–44, 12:14–16, 47–49, 55–60, 15:51–55; Ex. 1002 ¶¶ 37–39); Reply 26 (citing Ex. 1007, 13:46–52).

In view of the foregoing, we determine that the record supports Petitioner's contention that coupling the electronic transmitter of Sweeney to a memory unit as taught by Acharya yields the predictable result of sending information from the wireless device to a cell phone. In addition to arguing

that Petitioner did not identify a reason to combine the teachings of Sweeney and Acharya, Patent Owner further contends that Sweeney's remote ringer could not function to initiate and control media sessions Acharya's SIP infrastructure, because it lacks SIP capabilities. PO Resp. 63–64 (citing Ex. 2005 ¶¶ 142–146. In particular, Patent Owner contends Sweeney is directed to a simple remote wireless ringer that wirelessly transmits notifications from the wireless device to the wireless ringer with no intermediate devices. PO Resp. 63 (citing Ex. 1012, 1:44–54). According to Patent Owner, one of ordinary skill in the art would not seek to implement Acharya's complex SIP media exchanges into Sweeney's simple Bluetooth connection. *Id.* (citing Ex. 2005 ¶¶ 78, 142–144).

Contrary to Patent Owner's argument, Petitioner contends the disclosure of Sweeney teaches a wireless ringer with the ability to send a control signal to a wireless device, or to activate, control, engage, or use the features of the wireless device. Reply 26 (citing Ex. 1012 6:27–38, Ex. 1014 ¶¶ 25–26). Dr. Sarrefzadeh testifies that

[a]s with the '834 patent, Sweeney contemplates sending messages between the wireless device and devices other than the wireless ringer. For example, Sweeney discusses "incoming calls" and "send[ing] a default text message to the calling or messaging party." Ex. 1012 at 6:27-48. Like the '834 patent, Sweeney does not disclose the network(s) that the wireless ringer and wireless device would operate within, such that the wireless device can receive and send messages to other devices. Acharya is not more complicated than Sweeney; Acharya is simply more complete than Sweeney because it discloses a communications network in which the wireless ringer of Sweeney might operate.

Ex. 1014 ¶ 26. In view of the foregoing, we determine that the record supports Petitioner's contention that the wireless ringer of Sweeney can operate in the communications network of Acharya. Based on the foregoing discussion and the record, Petitioner has shown by a preponderance of the evidence that the combination of Sweeney and Acharya renders claims 6–14 obvious.

### III. MOTION TO EXCLUDE

Patent Owner moves to exclude Paragraphs 7 and 24–28 of Dr. Sarrefzadeh's Reply Declaration (Ex. 1014), and portions of Petitioner's Reply. Paper 25 ("Motion"). Petitioner opposes the Motion. Paper 30 ("Opp."). Patent Owner replies to the Motion. Paper 33. As movant, Patent Owner has the burden of proof to establish that it is entitled to the requested relief. *See* 37 C.F.R. § 42.20(c).

According to Patent Owner, Dr. Sarrefzadeh cites to a new portion of Acharya, disclosing a direct Bluetooth connection between the portable device and cell phone, which could have been cited in Dr. Sarrefzadeh's first Declaration. Motion 2 (citing Ex. 1014 ¶ 7; Ex. 1007, 13:46–52). Patent Owner also contends that Dr. Sarrefzadeh expresses a new opinion on motivation to combine Sweeney and Acharya that does not respond to Patent Owner's Response, and could have been presented in the Petition. Motion 3–5 (citing Ex. 1014 ¶¶ 24–28).

Petitioner contends that Patent Owner's Response proposed a construction of the claims that requires a cell phone paired with a vibrating device, and that Patent Owner's Response asserted Acharya does not teach a

cell phone paired with the vibrating device. Opp. 5 (citing PO Resp. 35). Petitioner contends that the evidence cited in Paragraph 7 of the Reply Declaration addresses the contentions raised in Patent Owner's Response that the claims require a cell phone paired to a vibrating device, and that Acharya does not teach a cell phone paired with a vibrating device. *Id.* Petitioner also contends that paragraphs 24–28 of the Reply Declaration are not necessary to support Petitioner's prima facie case, but rather, rebut assertions made in Patent Owner's Response and Dr. Shamos's Declaration. Opp. 7–9. According to Petitioner, paragraphs 22–28 of the Reply Declaration rebut Patent Owner's contention that the SIP control device of Acharya is substantially different from the simple remote wireless ringer of Sweeney, and that Acharya teaches away from Petitioner's proposed combination. Opp. 8 (citing PO Resp. 2, 63, 65).

We agree with Petitioner that paragraphs 7 and 24–28 of the Reply Declaration respond to issues raised in Patent Owner's Response. Paragraph 7 provides testimony to rebut Patent Owner's contentions that the claims require a direct Bluetooth connection between a cell phone and a portable device, and that Acharya does not disclose a direct Bluetooth connection between a cell phone and a portable device. Paragraphs 24–28 of the Reply Declaration provide testimony to respond to Patent Owner's contentions that the devices of Acharya and Sweeney are substantially different, and Patent Owner's contentions that Acharya teaches away from the combination.

Patent Owner contends that Petitioner's arguments in the Reply that rely on newly cited portions of Acharya should be excluded. Motion 5–6 (citing Reply 11, 14, 16, 19, and 26; Ex. 1007, 12:61–13:6, 13:46–52).

Petitioner contends the rebuttal evidence and arguments in the Reply are not essential to Petitioner's prima facie case, and are directly responsive to Patent Owner's arguments. Opp. 11–15. We agree with Petitioner that the newly cited portions of Acharya are responsive to Patent Owner's contentions that the claims require a direct Bluetooth connection between a cell phone and a portable device, and that Acharya does not disclose this direct connection.

Therefore, Patent Owner does not meet its burden of showing that it is entitled to the requested relief. Accordingly, we deny Patent Owner's Motion with respect to excluding paragraphs 7 and 24–28 of the Reply Declaration (Ex. 1014) and to excluding Petitioner's arguments on pages 11, 14, 16, 19, and 26 of the Reply.

#### IV. CONCLUSION

For the foregoing reasons, we determine that Petitioner shows by a preponderance of evidence that claims 6–14 of the '834 Patent are unpatentable.

On this record, Petitioner has shown by a preponderance of the evidence that Acharya anticipates claims 6–14, that claims 9, 10, 13, and 14 would have been obvious over Acharya and the knowledge of one of ordinary skill in the art, that claims 9 and 13 would have been obvious over Acharya and Lee, and that claims 6–14 would have been obvious over Sweeney and Acharya.

V. ORDER

In consideration of the foregoing, it is hereby  
ORDERED that claims 6–14 of the '834 Patent are unpatentable;  
FURTHER ORDERED that Patent Owner's Motion to Exclude is  
denied; and

FURTHER ORDERED that, because this Final Written Decision is  
final, a party 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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