

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL
BOARD

SQUARE, INC.
Petitioner

v.

J. CARL COOPER
Patent Owner

Case IPR2014-00158
Patent No. 8,490,875

NOTICE OF APPEAL TO THE FEDERAL CIRCUIT (35 U.S.C. § 141(c))

To: Office of the General Counsel
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Patent Owner hereby provides notice of appeal to the US Court of Appeals for the Federal Circuit under 35 U.S.C. §§ 141 and 142 from the final written decision of the Patent Trial and Appeal Board dated May 8, 2015.

Pursuant to 37 C.F.R. § 90.2(a)(3)(ii) the expected issues on appeal will include

1. Whether *Inter Partes* Review proceedings (namely IPR2014-00158) violate the United States Constitution, Article III, based on the Separation of Powers doctrine, as well as Patent Owner's Seventh Amendment right to a jury trial on adjudications of patent validity.

2. Whether Petitioner has shown by a preponderance of the evidence, that claims 1-7, 9-14, 16-31, 33, and 34 of U.S. Patent No. 8,490,875 are unpatentable as anticipated.

Patent Owner has electronically filed this notice with the Patent Trial and Appeal Board, pursuant to 37 C.F.R. § 90.2(a)(1), 37 C.F.R. § 42.6(b)(1) and Federal Circuit Rule 15(a)(1).

Simultaneously herewith, patent owner is providing the Federal Circuit an electronic copy of the present Notice of Appeal (pursuant to 37 C.F.R. § 90.2(a)(2)(i) and 15(a)(1)) together with a \$500 fee (pursuant to 37 C.F.R. § 90.2(a)(2)(ii) and Federal Circuit Rule 52(a)(3)(A)).

All copies include a copy of the final written decision.

Date: July 7, 2015

Respectfully submitted,

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***Counsel Patent Owner J. Carl Cooper
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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing NOTICE OF APPEAL TO THE FEDERAL CIRCUIT (35 U.S.C. § 141(c)) was filed on July 7, 2015 with the United States Patent & Trademark Office, and served electronically on July 7, 2015 on the following counsel of record for Petitioner at the below-listed email address:

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SQUARE, INC.,
Petitioner,

v.

J. CARL COOPER,
Patent Owner.

Case IPR2014-00158
Patent 8,490,875 B2

Before JAMESON LEE, GEORGE R. HOSKINS, and
KRISTINA M. KALAN, *Administrative Patent Judges*.

HOSKINS, *Administrative Patent Judge*.

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

I. INTRODUCTION

Square, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1–14 and 16–34 of U.S. Patent No. 8,490,875 B2 (Ex. 1001, “the ’875 patent”). Petitioner submitted the Declaration of Henry N. Dreifus (Ex. 1011) in support of the Petition. J. Carl Cooper (“Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.”). On May 15, 2014, we instituted an *inter partes* review of claims 1–7, 9–14, 16–31, 33, and 34 on four of the six unpatentability grounds alleged in the Petition. Paper 10 (“Inst. Dec.”).

After institution of trial, Patent Owner filed a Patent Owner Response (Paper 18, “PO Resp.”). J. Carl Cooper, the Patent Owner in this proceeding and the sole inventor of the ’875 patent, executed a Declaration (Ex. 2004) in support of the Response. Petitioner filed a Reply (Paper 20, “Pet. Reply”). An oral hearing was held January 9, 2015. Paper 35 (“Tr.”). The Board has jurisdiction under 35 U.S.C. § 6.

For the reasons provided below, Petitioner has shown, by a preponderance of the evidence, that claims 1–7, 9–14, 16–31, 33, and 34 of the ’875 patent are unpatentable. Further, Patent Owner’s Motion to Exclude Evidence (Paper 22) is dismissed.

A. *Related Proceedings*

Petitioner and Patent Owner have identified two district court proceedings that would affect, or be affected by, a decision in this proceeding: *eCharge Licensing, LLC v. Square, Inc.*, No. 1:13-cv-06445 (N.D. Ill.), and *SCVNGR, Inc. v. eCharge Licensing, LLC*, No. 1:13-cv-12418 (D. Mass.). Pet. 7–8; Prelim. Resp. 2–3; Paper 5, 2.

B. The '875 Patent

The '875 patent discloses a “universal credit card” apparatus for allowing “access to numerous accounts, services, features, etc. with just one card thereby eliminating the need to carry, store or retain numerous cards.” Ex. 1001, Title, 3:42–46. Such an apparatus may also perform other functions, for example, telephone functions. *Id.* at 3:46–50. Figure 8 of the '875 patent is reproduced below:

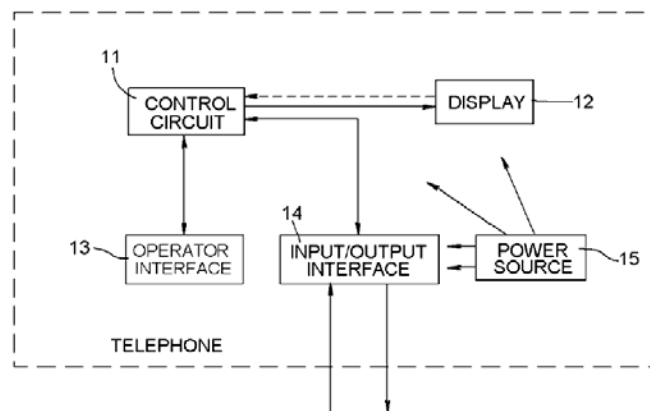


Figure 8

Figure 8 shows a telephone embodiment of the invention. *Id.* at 2:46–47. The telephone embodiment includes control circuit 11, display 12, operator interface 13, input/output interface 14, and power source 15. *Id.* at Fig. 8. Control circuit 11 includes a memory (not shown in Figure 8) and controls the other components of the apparatus. *Id.* at 4:9–13. Information stored in the memory may include “several sets of data corresponding to account related information or patterns for different credit cards, identification cards and the like.” *Id.* at 3:10–13.

Input/output interface 14 includes an emitter and a receiver. *Id.* at 5:15–21, 5:40–43. The emitter may, for example, be an infrared LED, an antenna, a coil, a transducer, or a display. *Id.* at 5:15–17, 5:25–26. The receiver may, for example, be a photo transistor, a magnetic reader strip, or an operator interface. *Id.* at 5:18–21, 5:23–24, 4:39, 5:30.

C. Illustrative Claim

Claim 1 is illustrative of claims 1–7, 9–14, 16–31, 33, and 34:

1. An apparatus comprising:
in a telephone:
 - a control circuit;
 - a memory coupled to the control circuit, the memory configured to store information related to at least one credit card account;
 - a designator for selecting the information from the memory;
 - a display coupled to the control circuit and configured to display at least part of the information upon selection of the designator; and
 - an emitter coupled to the control circuit and configured to transmit a signal relating to the information, the emitter comprising at least one of an antenna, coil, a transducer, the display, and an infrared LED.

Ex. 1001, 9:60–10:7.

D. Prior Art Supporting Instituted Unpatentability Grounds

Kikinis	U.S. Patent No. 5,835,732	Nov. 10, 1998	Ex. 1005
Gutman	U.S. Patent No. 5,221,838	June 22, 1993	Ex. 1006
Pitroda	U.S. Patent No. 5,590,038	Dec. 31, 1996	Ex. 1008
Hennige	U.S. Patent No. 5,276,311	Jan. 4, 1994	Ex. 1009

E. Instituted Unpatentability Grounds

We instituted an *inter partes* review of the '875 patent based on the following four unpatentability grounds alleged in the Petition. Inst. Dec. 31.

Basis	Reference	Claims Challenged
§ 102(e)	Kikinis	1–7, 9–14, 16–21, 23–31, 33, and 34
§ 102(b)	Gutman	1–7, 9–14, 16–21, 23–31, 33, and 34
§ 102(e)	Pitroda	14 and 16–24
§ 102(a)	Hennige	14, 16–21, 23, and 24

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, a claim in an *unexpired* patent is given its broadest reasonable construction. 37 C.F.R. § 42.100(b) (2014). However, the parties have agreed that the '875 patent expired on April 3, 2015. Paper 15. We have previously indicated to the parties that, in the event the '875 patent were to expire prior to a final written decision, the broadest reasonable construction would not apply. Paper 13, 4 (citing *In re Rambus*, 694 F.3d 42, 46 (Fed. Cir. 2012)). Therefore, we review the claims similarly to how a district court would review them, giving the terms their ordinary and customary meanings, as would be understood by a person of ordinary skill in the art at the time of the invention, having considered the language of the claims, the specification, and the prosecution history of record, pursuant to *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). See Paper 13, 4. However, there is no presumption of validity in this proceeding, and we will not apply a rule of construction with an aim to

preserve the validity of the claims. *See* 35 U.S.C. § 316(e) (Petitioner’s burden of proving a proposition of unpatentability is a preponderance of the evidence); Paper 13, 4.

1. “Telephone” (Claims 1–7, 9–13, 25–31, 33, and 34)

Patent Owner contends a “telephone,” as understood by a person of ordinary skill in the art, must include at least a “microphone” and a “speaker.” PO Resp. 19–20; Tr. 23:24–24:9. Patent Owner proffers two evidentiary sources in support. The first is the dictionary definition of “telephone set” found in *The New IEEE Standard Dictionary of Electrical and Electronics Terms* 1345 (5th ed. 1993, Gedimas P. Kurpis chair). Ex. 2001. The second is the testimony of Mr. Cooper. Ex. 2004 ¶¶ 130–133; *see also* Ex. 1017, 170:3–172:8 (indicating a device is defined by its function, and the main function of a telephone is to carry on conversations between human beings).

Petitioner contends the Patent Owner’s proffered dictionary definition defines “telephone set,” not “telephone.” Pet. Reply 4. Petitioner further contends the appearance of “telephone” in parentheses after “telephone set” in the definition “only indicates a descriptive category” of the defined term, so the definition “does not equate” the two terms. *Id.* at 4–5.¹

¹ The Reply was accompanied by Exhibit 1014, an excerpt from the *Wiley Electrical and Electronics Engineering Dictionary* (2004) defining several terms relating to “telephone.” However, the Reply fails to explain the significance of Exhibit 1014. We therefore decline to consider Exhibit 1014 in this proceeding. *See, e.g.*, 37 C.F.R. § 42.22(a)(2) (2014) (Petition must explain significance of evidence).

The intrinsic evidence pertinent to “telephone” is sparse. Ex. 1001, 9:60–10:7 (representative claim 1), 2:46–47, 3:46–50, Fig. 8. Therefore, recourse to extrinsic evidence such as dictionary definitions is appropriate. *Phillips*, 415 F.3d at 1320–24. We determine, based on Patent Owner’s proffered dictionary definition and the testimony of Mr. Cooper, that a person of ordinary skill in the art would conclude a “telephone” includes a microphone and a speaker.

Petitioner’s argument that the *IEEE Dictionary* definition is not probative because “telephone” is only a descriptive category of the defined term “telephone set” is not persuasive. In the ’875 patent claims and specification, a “telephone” is one structural component of an overall apparatus. Therefore, the issue presented is: What is the minimum collection of structural components required to be the “telephone” structure of the ’875 patent? In that context, it is appropriate to consider the *IEEE Dictionary* definition of “telephone set.” The definition’s inclusion of “telephone” as a “descriptive category” of “telephone set” does not mean that the definition is irrelevant to the present inquiry. Further, the *IEEE Dictionary* definition of “telephone set” as including a microphone and a speaker is consistent with the common usage of “telephone” to mean “an instrument or system for *conveying speech* over distances by converting sound into electric impulses sent through a wire wholly or in part; it consists of a *transmitter and receiver*, often with a dialing mechanism for connecting lines.” *Webster’s New World Dictionary of American English* (3rd College Ed. © 1988, Victoria Neufeldt ed. in chief) (Ex. 3002, emphases added). In order to transmit and receive electric impulses to convey speech, the

telephone instrument or system would include structural components, i.e., a microphone and a speaker.

For the foregoing reasons, we determine a “telephone” as recited in the ’875 patent includes a microphone and a speaker.

2. “*Emitter . . . Configured to Communicate a Signal*”
(*Claims 14 and 16–24*)

Patent Owner contends the ’875 patent specification confirms that a person of ordinary skill in the art would know the “emitter” in claim 14 “*must* communicate to ‘outside devices.’” PO Resp. 23–24 (emphasis added, citing Ex. 1001, 5:15–17, 5:25–26); Ex. 2004 ¶¶ 49–50, 70–79. We determine, however, that a person of ordinary skill in the art would conclude an “emitter,” as that term is used in claim 14, is not limited necessarily to communication with outside devices.

That determination is supported, firstly, by the language of the claims. Claim 14 recites an emitter “configured to communicate a signal.” Claim 16, which depends from claim 14, recites that the apparatus comprises “a receiver configured to receive data *from an external device.*” Ex. 1001, 11:12–13 (emphasis added).² Claim 16 indicates Patent Owner knew how to limit communication to outside or external devices. There is no such limiting language for the emitter in claim 14.

In light of that claim structure, we are not persuaded by Patent Owner’s contention that the following passage from the ’875 patent

² Claim 1 of U.S. Patent No. 6,764,005 B2, which issued from an application to which the ’875 patent claims priority, similarly recites “an emitter . . . for transmitting account identifying information *to said host system.*” IPR2014-00156, Ex. 1001, 10:1–3 (emphasis added).

specification requires limiting the “emitter” to communication with outside devices:

Emitter 7 may be the preferred infrared LED, antenna, coil, transducer, or *any other device capable of conveying information or patterns from the invention to outside devices*, and receiver 8 is preferred to be a photo transistor but may also be *any such apparatus or device capable of receiving information or patterns from outside devices* to be used by the invention.

Ex. 1001, 5:15–21 (emphases added). Patent Owner does not explain persuasively why that disclosure, which treats emitters and receivers on an equal basis concerning communication with outside devices, would necessarily mean “emitter” in claim 14 must communicate with outside devices, when dependent claim 16 specifies that the receiver must communicate with outside devices. We do not accept Patent Owner’s suggestion that transmission to outside devices is required “implicitly” by claim 14. Tr. 35:20–36:18.

Moreover, claim 14 recites that “the display” is a permissible “emitter.” *See also* Ex. 1001, 5:25–26 (“the display 12 may be utilized to provide the emitter function”). The ’875 patent specification discloses that the signals communicated by the display may be communicated either to an outside device (Ex. 1001, 8:49–58) or to a user of the claimed apparatus (*id.* at 3:20–28, 6:6–17).

We do not construe the “emitter” of claim 14 as being limited to communication to an outside device. That would impermissibly incorporate a limitation from the specification into the claims. *RF Delaware, Inc. v. Pacific Keystone Techs., Inc.*, 326 F.3d 1255, 1263–64 (Fed. Cir. 2003).

3. *“Transducer” (Claims 1–7, 9–14, 16–31, 33, and 34)*

Before trial was instituted, Petitioner and Patent Owner disagreed concerning the meaning of “transducer.” Inst. Dec. 6 (citing Pet. 11 and Prelim. Resp. 12–13). In the Institution Decision, we did not construe “transducer” because the meaning did not affect our reasons for instituting review. *Id.* During the oral hearing, however, Patent Owner agreed with Petitioner’s proposed construction that a transducer is “a device that converts a signal from one form of energy to another form of energy.” Pet. 11; Tr. 33:3–17; IPR2014-00156, Paper 37 (Hearing Transcript), 53–54.

When a claim limitation is defined in purely functional terms, as the parties propose, it raises difficult questions. *Halliburton Energy Services, Inc. v. M-I LLC*, 514 F.3d 1244, 1255 (Fed. Cir. 2008). Here, the parties have not provided sufficient reasons to regard “transducer” as a purely functional limitation. Thus, for the purposes of this opinion, we interpret the term “transducer” as a device recognizable to one of ordinary skill in the art as a transducer, and capable of converting a signal from one form of energy to another form of energy.

4. *“Information Related to at least one Identification Card Account” (Claim 12)*

In the Institution Decision, we concluded the term “identification” in claim 12 refers to identifying a person associated with an account, and construed “identification card account” to mean an account which has an associated card, wherein the card identifies a person associated with the account. Inst. Dec. 9–10. Neither party has disputed this construction during trial.

B. Prior Art References Considered During Prosecution

Patent Owner asserts “deference should be given” to the fact that Gutman, Pitroda, and Hennige were considered by the Examiner during prosecution of the ’875 patent, but does not indicate what form that “deference” should take. PO Resp. 3 n.1. In our consideration of the arguments and evidence presented in this proceeding, we recognize Gutman, Pitroda, and Hennige were before the Examiner when the ’875 patent was allowed.

C. Anticipation by Kikinis

Petitioner contends claims 1–7, 9–14, 16–21, 23–31, 33, and 34 of the ’875 patent are unpatentable as anticipated by Kikinis. Pet. 13–22.

1. Independent Claim 1

Claim 1 recites an apparatus comprising several components in a telephone, including a control circuit, a memory, a designator, and a display. Figure 11 of Kikinis is reproduced below:

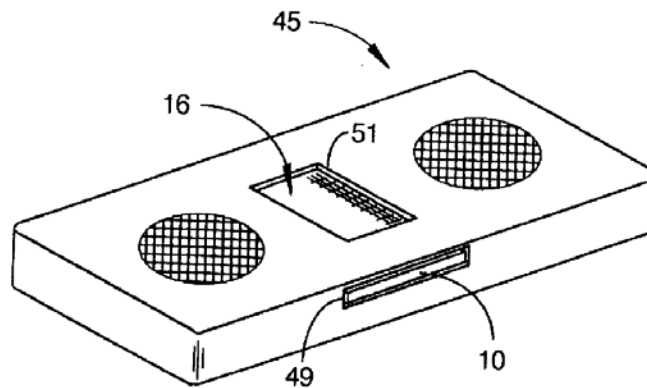


Fig. 11

Figure 11 shows micro personal digital assistant (“ μ PDA”) 10 docked in cellular or cordless telephone 45. Ex. 1005, 4:9–11, 14:26–29. We are persuaded by Mr. Dreifus’s testimony that, when μ PDA 10 is docked in telephone 45, μ PDA 10 is “in” telephone 45 as required by claim 1.³ Ex. 1011, 18–19⁴; Ex. 1005, 3:20–35, 14:26–35.

We are persuaded also by Mr. Dreifus’s testimony that μ PDA 10 has, as claimed, a microcontroller (Ex. 1005, Fig. 3, 5:48–60), a memory (*id.* at 5:61–6:2, 14:33–35), a touch-sensitive input as one designator (*id.* at Fig. 3, 6:57–65, 14:33–35), a thumbwheel input as another designator (*id.* at Fig. 4, 7:31–34, 14:44–47), and a display (*id.* at Fig. 3, 5:33–35, 14:31–41). Ex. 1011, 19–23. As shown in Figure 11 above, a user may operate telephone 45 by accessing touch-sensitive I/O interface 16 of μ PDA 10 through window 51 in telephone 45. Ex. 1005, 14:30–35, 6:57–65.

We are persuaded further that Kikinis expressly discloses the μ PDA 10 memory is configured to store information related to at least one credit card account, as required by claim 1. Ex. 1011, 19–20. Specifically, Kikinis states μ PDA 10 memory stores “all of the user’s collection of phone numbers, associated credit card numbers, access codes, etc.” Ex. 1005, 14:33–50.

³ The Institution Decision rejected a claim construction advanced by Patent Owner, seeking to distinguish claim 1 from Kikinis by asserting “‘in a telephone’ denotes a combination (not juxtaposition) of a telephone with the rest of the invention’s circuit elements.” Inst. Dec. 8, 13, 14. Patent Owner did not dispute, during trial, that Kikinis discloses the “in a telephone” limitation of claim 1.

⁴ Although the Dreifus Declaration contains numbered paragraphs, this opinion cites page numbers.

Patent Owner contends a person of ordinary skill in the art would understand that “associated credit card numbers” in Kikinis refers not to credit card accounts, but rather to phone cards or calling cards. PO Resp. 8–10; Ex. 2004 ¶¶ 92–119. We are not persuaded by this contention. It is contrary to the plain language of the Kikinis disclosure, referring to “credit card numbers” and “credit card information.” Ex. 1005, 14:39, 14:49.

Moreover, even if we accepted that “credit card” in Kikinis actually means “phone card,” still the use of a phone card as described by Mr. Cooper is merely one way a telephone company may extend credit to a customer, thereby making the phone card account one example of a credit card account as recited in claim 1. *See* Ex. 2004 ¶¶ 104–108. There is no limitation in claim 1 requiring the credit card account to be issued by a financial institution rather than a phone company.

Claim 1 further requires the display to be configured to display the credit card account information upon selection of the designator. We are persuaded by Mr. Dreifus’s testimony that Kikinis expressly discloses the μ PDA 10 display is so configured. Ex. 1011, 22–23. Kikinis states:

With the μ PDA docked, all of the software and memory of the μ PDA is available to the telephone and a user may operate the phone by I/O interface 16.

[1] In this aspect of the invention, unique control routines and *display configurations* are provided to enhance use of the cellular phone. For example, *all of the user’s collection of phone numbers, associated credit card numbers, access codes, etc. are readily available and may be quickly and conveniently accessed and used.* [2] In one aspect, a simple input displays alphabet letters to select, and once a letter is selected, a partial list of parties that might be called is displayed. One may scroll through the list by touch input or by use of the thumbwheel of

the μ PDA and select a highlighted entry. It is not required that the telephone numbers be displayed.

Once a party to be called is selected, the μ PDA dials the call, including necessary credit card information stored in the memory of the μ PDA for this purpose.

Ex. 1005, 14:33–50 (emphases and “[1]” and “[2]” added). For ease of reference in the following discussion, “[1]” identifies two sentences in the quoted disclosure, and “[2]” identifies the following four sentences.

We find the disclosure at [1] expressly discloses that when μ PDA 10 is docked in telephone 45, there are display configurations in which all of the user’s associated credit card numbers are readily available to be accessed and used. In particular, we find that disclosure reflects the action of displaying credit card account information in the μ PDA 10 display. The disclosure at [2] goes on to describe “one aspect” of the control routines and display configurations disclosed at [1], relating to selecting a party to be called using telephone 45.

We are not persuaded by Patent Owner’s assertion that the Kikinis disclosure at [1] fails to disclose “display” of credit card account information. PO Resp. 5–7; Ex. 2004 ¶¶ 102–113. First, we disagree with Patent Owner’s assertion that Mr. Dreifus admitted in deposition testimony that Kikinis fails to disclose the action of displaying credit card account information. PO Resp. 5–7 (citing Ex. 2003, 87–93). Rather, Mr. Dreifus testified that the “one aspect” of the Kikinis disclosure at [2], directed to selecting a party to be called, does not include a display of credit card account information. *See* Ex. 2003, 90:16–23, 91:7–18, 92:2–23. This does not discredit or undermine Mr. Dreifus’s testimony concerning the disclosure at [1]. Second, the testimony of Mr. Cooper cited in the Patent

Owner Response similarly focuses on “when a phone call is being made,” as reflected by the Kikinis disclosure at [2], rather than the more general disclosure at [1]. Ex. 2004, ¶¶ 102–103, 108–109, 111; *see* PO Resp. 7 (citing Ex. 2004 ¶¶ 102–113).

Claim 1 lastly recites an emitter coupled to the control circuit, configured to transmit a signal relating to the credit card account information. We are persuaded by Mr. Dreifus’s testimony that Kikinis expressly discloses an antenna emitter in the antenna of telephone 45. Ex. 1011, 23. Specifically, Kikinis discloses μ PDA 10 may be utilized to select a party to be called using telephone 45, and then “the μ PDA dials the call, including necessary credit card information stored in the memory of the μ PDA for this purpose.” Ex. 1005, 14:36–50. Thus, the express disclosure in Kikinis is that the necessary credit card information is included in the dialing of the call, and therefore transmitted by the antenna.

Patent Owner argues Kikinis fails to disclose that the credit card information stored in the μ PDA 10 memory is transmitted by the telephone 45 antenna. PO Resp. 10–11; Ex. 2004 ¶ 121. Mr. Cooper testifies the Kikinis disclosure at column 14, lines 48–50, is “ambiguous” and is consistent with things happening other than transmission of credit card account information using the antenna. Ex. 2004 ¶ 121.

We are not persuaded of ambiguity in the Kikinis disclosure. We further disagree with Patent Owner’s interpretation of Mr. Dreifus’s testimony as stating Kikinis does not disclose transmitting credit card account information using the antenna. PO Resp. 10–11 (citing Ex. 2003, 94). Rather, Mr. Dreifus testified that “the credit card information is included as part of the process of initiating and setting up the call” and “in

the process of dialing that call, it's also saying including necessary credit card information.” Ex. 2003, 93–95.

Patent Owner also argues the μ PDA 10 controller is not “coupled to” the telephone antenna, as claim 1 requires. PO Resp. 12–13; Ex. 2004 ¶¶ 123–129. Patent Owner cites the Kikinis disclosure at column 2, lines 12–22, that the μ PDA 10 controller is “effectively disable[d]” to provide a direct access to the μ PDA 10 software and data storage by the CPU of the host unit, i.e., telephone 45. PO Resp. 12; Ex. 2004 ¶ 123. That disclosure, however, relates to “an aspect” of the Kikinis invention, and Kikinis further provides “[i]n other embodiments many other cooperative operating modes may be accomplished between the two CPUs and accessible memory devices.” Ex. 1005, 2:12–13, 5:48–60. One such other embodiment is Figure 11, in which “the μ PDA dials the call” *Id.* at 14:48–50. Thus, when read as a whole, the Kikinis disclosure provides alternate embodiments disclosing a controller coupled to the telephone antenna.

Moreover, at the oral hearing, Patent Owner agreed with Petitioner that the “transducer” converts a signal from one form of energy to another form of energy. Tr. 33:3–17. Based on our construction of “transducer” provided above, we are persuaded by Mr. Dreifus’s testimony that Kikinis discloses a transducer in its IR interface 94. Ex. 1011, 23–24; Ex. 1005, Fig. 13, 13:21–27, 15:60–16:11. The signal emitted by IR interface 94 may transfer data from the μ PDA 10 memory to a host computer, which would include the credit card account information stored in the memory. Ex. 1011, 23–24; Ex. 1005, 5:49–58, 16:6–11. Thus, Kikinis discloses two structures,

each separately satisfying the “emitter” limitation of claim 1: antenna of telephone 45, and IR interface 94.

For the foregoing reasons, a preponderance of the evidence establishes that claim 1 is unpatentable as anticipated by Kikinis.

2. *Independent Claim 12*

Claim 12 is substantially identical to claim 1, except the information of claim 12 relates to an “identification card account” rather than a “credit card account.” A preponderance of the evidence establishes that Kikinis discloses the common limitations in claims 1 and 12. *See supra* Part II.C.1. An “identification card account” is an account that has an associated card, wherein the card identifies a person associated with the account. A credit card account is such an account. Therefore, a preponderance of the evidence establishes that claim 12 is unpatentable as anticipated by Kikinis.

3. *Independent Claim 13*

Claim 13 is substantially identical to claim 1, except claim 13 contains an additional limitation: “a console configured to communicate with the control circuit and receive data to provide access to at least one of an account, a service, and a feature.” A preponderance of the evidence establishes that Kikinis discloses the common limitations in claims 1 and 13. *See supra* Part II.C.1. We are persuaded by Mr. Dreifus’s testimony that Kikinis expressly discloses the console of claim 13 as expansion bus interface 20 or host interface 14 of μ PDA 10, or docking port 49 of

telephone 45.⁵ Ex. 1011, 46–48. Therefore, a preponderance of the evidence establishes that claim 13 is unpatentable as anticipated by Kikinis.

4. *Independent Claim 14*

Claim 14 is substantially identical to claim 1, except that it does not recite “in a telephone.” A preponderance of the evidence establishes that Kikinis discloses the common limitations in claims 1 and 14. *See supra* Part II.C.1. Therefore, a preponderance of the evidence establishes that claim 14 is unpatentable as anticipated by Kikinis.

5. *Independent Claim 25*

Claim 25 recites a method comprising four steps, each one of which finds a corresponding apparatus component in claim 1 for performing the step. A preponderance of the evidence establishes that claim 25 is unpatentable as anticipated by Kikinis, based on the analysis already provided for claim 1. *See supra* Part II.C.1.

6. *Dependent Claims 2–7, 9–11, 16–21, 23, 24, 26–31, 33, and 34*

As already discussed, a preponderance of the evidence establishes that Kikinis discloses the limitations of independent claims 1, 12, 13, 14, and 25. Petitioner further contends Kikinis discloses the additional subject matter recited in claims 2–7, 9–11, 16–21, 23, 24, 26–31, 33, and 34, each of which depends directly or indirectly from claim 1, 14, or 25. Pet. 20–22. We have

⁵ The Institution Decision rejected a claim construction advanced by Patent Owner, seeking to distinguish claim 13 from Kikinis by asserting the console is a separate, outside device with respect to the telephone. Inst. Dec. 7–8, 15–16. Patent Owner did not dispute, during trial, that Kikinis discloses the “console” limitation of claim 13.

reviewed the claim charts presented in the Petition and the Dreifus Declaration asserting that the additional subject matter of the dependent claims is disclosed in Kikinis. *Id.*; Ex. 1011, 26–30, 55–60, 67–71. Patent Owner’s Response relies solely on its arguments and evidence contesting the independent claims. The Scheduling Order cautioned Patent Owner that any arguments for patentability not raised in the Response would be deemed waived. Paper 11, 3. Accordingly, after due consideration of the argument and evidence advanced by Petitioner (*see, e.g.*, Inst. Dec. 16–18), we find a preponderance of the evidence establishes Kikinis expressly discloses each and every limitation of dependent claims 2–7, 9–11, 16–21, 23, 24, 26–31, 33, and 34, and conclude those claims are unpatentable as anticipated by Kikinis.

D. Anticipation by Gutman

Petitioner contends claims 1–7, 9–14, 16–21, 23–31, 33, and 34 of the ’875 patent are unpatentable as anticipated by Gutman. Pet. 22–31.

1. Claims 1–7, 9–13, 25–31, 33, and 34

Each one of claims 1–7, 9–13, 25–31, 33, and 34 requires “a telephone.” As construed above, a telephone includes a microphone and a speaker. *See supra* Part II.A.1. For the following reasons, Petitioner has not established by a preponderance of the evidence that Gutman’s electronic wallet includes a telephone.

Figures 1, 2A, and 2B of Gutman are reproduced below:

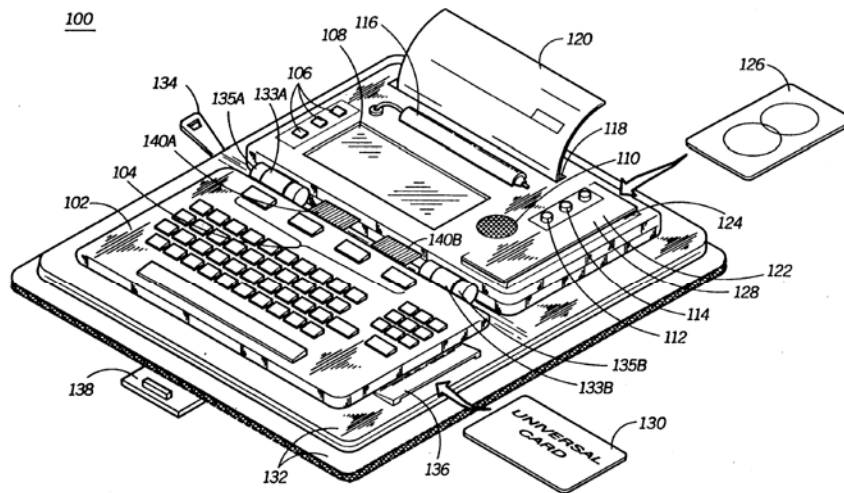


FIG. 1

Figure 1 shows electronic wallet 100. Ex. 1006, 4:36–39.

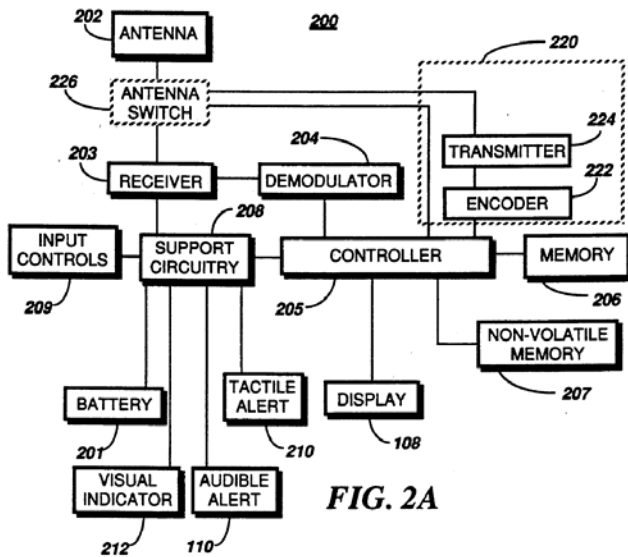


FIG. 2A

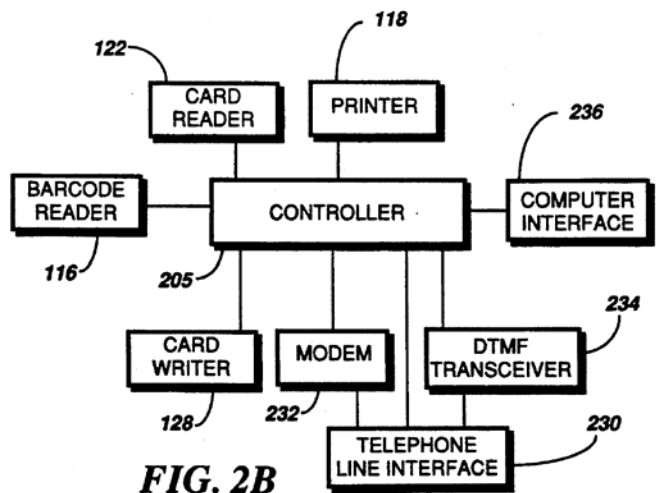


FIG. 2B

Figures 2A and 2B show block diagrams of several components in electronic wallet 100. *Id.* at 6:41–43. As shown in Figure 2B, electronic wallet 100 has telephone interface circuitry 230 connected to modem 232, Dual Tone Multi-Frequency transceiver 234, and controller 205. *Id.* at 9:10–13. Petitioner and Mr. Dreifus cite the Gutman written description at column 9, lines 10–26 as disclosing that electronic wallet 100 has “telephonic

capabilities.” Pet. 23–24; Ex. 1011, 72–73. Petitioner further relies, in the Reply, on other portions of the Gutman disclosure. Pet. Reply 6 (citing Ex. 1006, Fig. 2A, Fig. 3, 8:43–64, 9:10–22, 9:45–52). We find, however, nothing in the cited disclosures of Gutman that would indicate to a person of ordinary skill in the art that electronic wallet 100 includes a telephone microphone and a telephone speaker.⁶

Petitioner also relies on Gutman’s disclosure concerning U.S. Patent No. 4,831,647 to D’Avello et al. (Ex. 1007, “D’Avello”), which Gutman incorporates by reference. Pet. 24; Ex. 1011, 73. Gutman’s disclosure in this regard is reproduced here:

Furthermore, *a financial card reader 122, such as a magnetic card reader having a slot 124 capable of receiving a financial card (e.g., a MasterCard or Visa card) 126, for reading a representation of a financial information from the financial card 126 is included [in electronic wallet 100]. Such a financial card reader 122 may serve to read financial information from most or all of one’s personal cards using known standards . . . and known techniques. . . . The financial information may subsequently be stored into the electronic wallet 100. An exemplary communication system incorporating a financial card reader at a mobile radio-telephone unit is discussed in U.S. Pat. No. 4,831,647, issued May 16, 1989, to D’Avello et al. and entitled “Radiotelephone Credit Card Data Communications”, which is assigned to the assignee of the present invention and which is incorporated by reference herein.*

⁶ Electronic wallet 100 does have speaker 110 for generating an “audible alert.” Ex. 1006, 4:55–63, 8:19–26. Mr. Dreifus testified, however, he “cannot conclude whether the speaker is or isn’t a telephone speaker” and he “did not see a telephone mike” disclosed in Gutman. Ex. 2003, 63:2–64:20.

Ex. 1006, 5:44–65 (emphases added). Petitioner concludes from this disclosure that “[t]he financial reader of electronic wallet 100, *Gutman* explains, can be incorporated to the radio-telephone unit of *D’Avello*.” Pet. 24. Further, Petitioner argues, “[b]y incorporating *D’Avello*, *Gutman* fully references the content of the material in *D’Avello* as if the material was set forth in *Gutman*” and “[a]ccordingly, *Gutman* discloses a telephone.” Pet. Reply 6 (citing *Harari v. Lee*, 656 F.3d 1331, 1335–36 (Fed. Cir. 2011)).

We are not persuaded that *Gutman*’s discussion and incorporation of *D’Avello* leads to anticipation of the ’875 patent claims at issue here. “[U]nless a reference discloses within the four corners of the document *not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim*, it . . . cannot anticipate under 35 U.S.C. § 102.” *Net MoneyIn, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008) (emphases added). *D’Avello* does disclose a telephone communication system including a financial card reader. Ex. 1007, Fig. 5, 1:1–10, 5:23–28. Petitioner relies, however, upon *Gutman*’s *electronic wallet 100* as including all elements of the claims. *See, e.g.*, Pet. 22–29 (analysis of independent claims). Although *Gutman* at column 5, lines 44–65, discusses *D’Avello*’s telephone and financial card reader, *Gutman* does not indicate that electronic wallet 100 may include a telephone. *Gutman* indicates that the financial card reader of *D’Avello*’s telephone may be used in electronic wallet 100, but not that the telephone components (e.g. a microphone or speaker) of *D’Avello*’s telephone may be used in electronic wallet 100. Ex. 1006, 5:44–65.

For the foregoing reasons, Petitioner has not established by a preponderance of the evidence that Gutman's electronic wallet 100 includes a telephone microphone and a telephone speaker. Therefore, we conclude claims 1–7, 9–13, 25–31, 33, and 34 of the '875 patent have not been shown to be unpatentable as anticipated by Gutman.

2. *Claims 14, 16–21, 23, and 24*

Claims 14, 16–21, 23, and 24 do not require a telephone. For the following reasons, Petitioner has established by a preponderance of evidence that Gutman discloses the limitations in these claims.

Claim 14 recites an apparatus comprising a control circuit, a memory, a designator, a display, and an emitter. Referring to Gutman Figures 1, 2A, and 2B, reproduced above, we are persuaded by Mr. Dreifus's testimony that Gutman's electronic wallet 100 has the claimed control circuit in controller 205, and the claimed memory in memory 206 and non-volatile memory 207. Ex. 1011, 100–102; Ex. 1006, 6:49–7:6. We further are persuaded Gutman's wallet 100 has the claimed designator in user input controls 209, and the claimed display in display 108. Ex. 1011, 102–103; Ex. 1006, 4:55–60, 7:41–44, 8:19–29. We also agree Gutman's wallet 100 has the claimed emitter in antenna 202 and/or display 108. Ex. 1011, 105–106; Ex. 1006, 6:43–46, 8:43–64.

Patent Owner contends Gutman fails to disclose that wallet 100 displays or emits credit card account information, as recited in claim 14. PO Resp. 13–18; Ex. 2004 ¶¶ 134–143. Patent Owner concedes memory 206 stores, and display 108 displays, and antenna 202 emits, information relating to a “financial account,” but disputes that the financial account is a credit card account. PO Resp. 14. According to Patent Owner, although

wallet 100 reads financial information from financial cards such as a MasterCard or Visa card (Ex. 1006, 5:44–54), Gutman does not disclose that such credit card account information is ever stored in memory 206, or displayed, or emitted. PO Resp. 14–15. Patent Owner contends the credit card account information instead is stored in a microprocessor EEPROM. *Id.* at 15–16 (citing Ex. 1007, 5:14–16, 5:64–6:2, 7:18–20). Patent Owner further contends Mr. Dreifus testified that it is possible that the credit card storage memory in Gutman is different from memory 206 for display and emitting. PO Resp. 15–16 (citing Ex. 2003, 79, 83–84). Patent Owner contends the Institution Decision erred in finding that column 6, lines 16–20 of Gutman establish that the “financial institution account” information stored in memory 206 includes the credit card account information read by wallet 100. PO Resp. 17–18; Ex. 2004 ¶¶ 136, 140; *see* Inst. Dec. 19–20.

Patent Owner’s contentions are not persuasive. The Gutman disclosure, as a whole, indicates that the “account at a financial institution” discussed at column 7, lines 34–54 may be a credit card account. In the Background of Invention section, Gutman discusses “a number of unfortunate limitations” encountered with “[c]ontemporary financial communications systems.” Ex. 1006, 1:16–26. The Background section identifies a “second example” of such a system that includes use of “a financial card (e.g. a credit card).” *Id.* at 1:60–2:25. Gutman indicates the limitations of known credit card systems include that the financial information is maintained only at the financial institution, thus requiring a redundant paper trail, as well as an error-prone manual financial log maintained by the user. *Id.* at 2:57–3:2.

Gutman discloses that electronic wallet 100 reads financial information from multiple financial cards (e.g. credit cards) for storage in wallet 100, so that “the financial information from multiple financial cards may be better organized and secured in one place (i.e., within the electronic wallet 100)” as “subsequently more fully discussed.” *Id.* at 5:44–6:20. Thereafter, Gutman discloses how electronic wallet 100 maintains information from an “account at a financial institution” such as balance and transaction activity, by storing such information in memory 206, displaying such information on display 108, and emitting such information via antenna 202. *Id.* at 7:34–54, 8:21–29, 8:43–64. Thus, when Gutman is read as a whole, the disclosure of financial institution account information in column 7 includes credit card account information.

For the foregoing reasons, a preponderance of the evidence establishes that Gutman expressly discloses each and every limitation of independent claim 14. Petitioner further contends Gutman discloses the additional subject matter recited in claims 16–21, 23, and 24, each of which depends directly from claim 14. Pet. 29–31. We have reviewed the claim charts presented in the Petition and the Dreifus Declaration asserting that the additional subject matter of the dependent claims is disclosed in Gutman. *Id.*; Ex. 1011, 105–111. Patent Owner’s Response relies solely on its arguments and evidence contesting claim 14. The Scheduling Order cautioned Patent Owner that any arguments for patentability not raised in the Response would be deemed waived. Paper 11, 3. Accordingly, after due consideration of the argument and evidence advanced by Petitioner (*see, e.g.,* Inst. Dec. 21–22), we find a preponderance of the evidence establishes

Gutman expressly discloses each and every limitation of dependent claims 16–21, 23, and 24.

We conclude claims 14, 16–21, 23, and 24 are unpatentable as anticipated by Gutman.

E. Anticipation by Pitroda

Petitioner contends claims 14 and 16–24 of the '875 patent are unpatentable as anticipated by Pitroda. Pet. 31–38.

1. Independent Claim 14

Figure 3 of Pitroda is reproduced below:

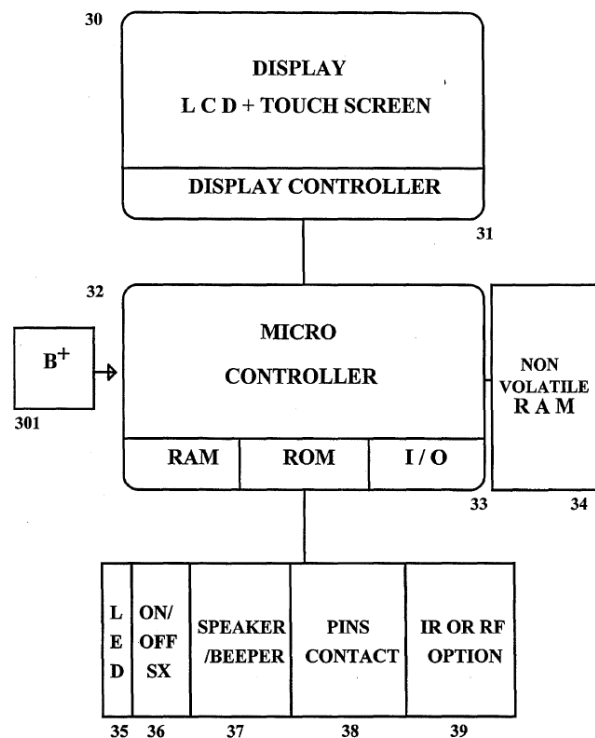


FIG. 3

Figure 3 shows a block diagram of a universal electronic transaction (“UET”) card. Ex. 1008, Abs., 8:28–29.

Claim 14 recites an apparatus comprising a control circuit, a memory, a designator, and a display. We are persuaded by Mr. Dreifus's testimony that the UET card has the claimed control circuit and memory in micro controller 32⁷ with associated RAM and ROM, as well as additional non-volatile RAM 34. Ex. 1011, 123–124; Ex. 1008, 11:19–23. We further are persuaded Pitroda has the claimed designator and display in touch screen display 30. Ex. 1011, 125–129; Ex. 1008, 11:13–19. Touch screen display 30 may be used to select credit card account information from the UET card memory, to be shown in display 30. Ex. 1011, 124–129; Ex. 1008, 11:29–53, 13:59–14:9, 16:22–24.

Patent Owner contends Pitroda's micro controller 32 fails to meet all the requirements of claim 14, because an "external device operating via the contacts 13" and not micro controller 32 writes credit card account information in the UET card memory. PO Resp. 27–28; Ex. 2004 ¶ 179. This argument is not persuasive, because it misconstrues the scope of claim 14. The claim requires that the control circuit (i.e. Pitroda's micro controller 32) is "coupled to" the UET card memory; it does not specify that the control circuit performs the storage of data into the UET card memory. Pitroda's micro controller 32 is coupled to the UET card memory because, as Patent Owner concedes, micro controller 32 reads credit card account information from the UET card memory. PO Resp. 27–28 (micro controller 32 is "the device used for reading credit card account information from the UET memory to be displayed"); Ex. 2004 ¶ 179.

⁷ There is some confusion in Pitroda concerning whether micro controller is "32" or "33." Ex. 1008, Fig. 3, 11:19–23. We will use "32."

Claim 14 further recites an emitter configured to communicate a signal relating to the credit card account information. We are persuaded by Mr. Dreifus's testimony that Pitroda discloses such an emitter in its display 30, which can display bar code patterns. Ex. 1011, 129–130; Ex. 1008, Fig. 9, 8:43–44, 13:23–38. In particular, Pitroda states: “It is also possible to *display basic card information* such as the name, the card number, the date of issue, the date of expiration, etc., *in the form of a bar code pattern to be read by a bar code reader in a predetermined area*” of the display. Ex. 1008, 13:33–38 (emphases added).

Patent Owner contends the Pitroda disclosure reflecting display of “basic card information” does not relate to credit card account information as recited in claim 14, but rather relates to other kinds of information, such as a medical card, an ID card, a phone card, an airline travel card, a car rental card, or the UET card itself. PO Resp. 24–25; Ex. 2004 ¶¶ 164–166. Patent Owner, however, does not provide any persuasive reason why Pitroda's “basic card information” should refer to one or more of those other kinds of information, to the exclusion of credit card account information. We are persuaded by Mr. Dreifus's reading, whereby credit card account information is included on the display, especially because such information is one of the two principal embodiments (along with health care information) in the Pitroda disclosure. *E.g.*, Ex. 1008, 1:21–36, 2:1–26, 6:16–43.

Patent Owner further contends the entire bar code display functionality of Pitroda “is disclosed as a mere ‘possibility.’” PO Resp. 26. In Patent Owner's view, Pitroda fails to disclose that the bar code display is “configured to communicate a signal” as claimed, and merely having the capability to be so configured is insufficient to establish anticipation. *Id.* In

short, according to Patent Owner, “Pitroda’s bar code description is a hypothetical possibility, not an actual disclosed configuration.” *Id.* We are not persuaded by these arguments, and maintain our preliminary finding that the Pitroda disclosure at column 13, lines 33–38, reflects that the UET card in fact is configured to display basic card information via a bar code, not merely that it might be possible to modify the UET card to incorporate such a display.

Moreover, at the oral hearing, Patent Owner agreed with Petitioner that the “transducer” converts a signal from one form of energy to another form of energy. Tr. 33:3–17. Based on our construction of “transducer” provided above, we are persuaded by Mr. Dreifus’s testimony that Pitroda discloses a transducer in its infrared or radio frequency communication option 39. Ex. 1011, 129; Ex. 1008, Fig. 3, 9:54–63, 11:24–26. The signal emitted by IR/RF option 39 relates to credit card account information. Ex. 1011, 130; Ex. 1008, 16:35–41. Thus, Pitroda discloses two structures, each separately satisfying the “emitter” limitation of claim 14: display 30 and IR/RF option 39.

Patent Owner further argues Pitroda fails to anticipate because “there is no teaching to select information related to a credit card account causing the display of credit card account related information (in text or other recognizable form) to a person and display that same information in a bar code to a device.” PO Resp. 27. This argument is not persuasive, because it misconstrues the scope of claim 14. The claim requires that the “display” of information is performed “upon selection of the designator,” but does not specify that the “communicat[ion]” of information by the emitter is tied in any way to the selection. *See, e.g.*, Tr. 30:13–31:7. As set forth above,

Pitroda displays credit card account information upon selection of the designator. Ex. 1008, 11:29–53, 13:59–14:9, 16:22–24.

For the foregoing reasons, a preponderance of the evidence establishes that claim 14 is unpatentable as anticipated by Pitroda.

2. *Dependent Claims 16–24*

As already discussed, a preponderance of the evidence establishes that Pitroda discloses the limitations of independent claim 14. Petitioner further contends Pitroda discloses the additional subject matter recited in claims 16–24, each of which depends directly from claim 14. Pet. 36–38. We have reviewed the claim charts presented in the Petition and the Dreifus Declaration asserting that the additional subject matter of the dependent claims is disclosed in Pitroda. *Id.*; Ex. 1011, 130–139. Patent Owner’s Response relies solely on its arguments and evidence contesting claim 14. The Scheduling Order cautioned Patent Owner that any arguments for patentability not raised in the Response would be deemed waived. Paper 11, 3. Accordingly, after due consideration of the argument and evidence advanced by Petitioner (*see, e.g.*, Inst. Dec. 24–26), we find a preponderance of the evidence establishes Pitroda expressly discloses each and every limitation of dependent claims 16–24, and conclude those claims are unpatentable as anticipated by Pitroda.

F. *Anticipation by Hennige*

Petitioner contends claims 14, 16–21, 23, and 24 of the ’875 patent are unpatentable as anticipated by Hennige. Pet. 38–43.

1. *Independent Claim 14*

Figure 1a of Hennige is reproduced below:

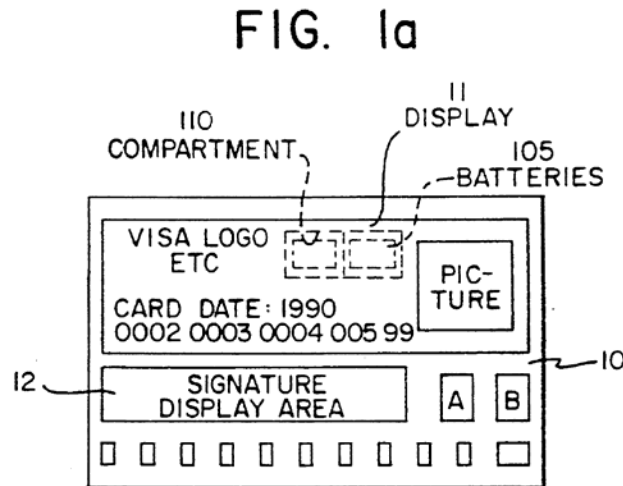


Figure 1a shows electronic multi-function card 10. Ex. 1009, 4:19–21.

Claim 14 recites an apparatus comprising a control circuit, a memory, a designator, and a display. We are persuaded by Mr. Dreifus’s testimony that card 10 has the claimed control circuit in “the usual electronic circuit means which are regarded as standard today,” such as a microprocessor. Ex. 1011, 140–141; Ex. 1009, 4:39–44. Further, we agree card 10 has the claimed memory. Ex. 1011, 141; Ex. 1009, 3:64–67, 4:43–45, 6:17–23. As to the claimed designator and display, we agree card 10 has alpha-numeric input keys or separate selection input keys, as well as display 11 and signature display 12. Ex. 1011, 141–142; Ex. 1009, Figs. 1a–1b, 4:35–38, 5:55–65. The card 10 memory contains a data set for multiple credit card accounts, each including the special information or logo of the issuing company or bank, the card number and the date of expiry, any stored photos or, if desired, other machine-readable data and the user’s signature. Ex. 1011, 140–143; Ex. 1009, 3:28–32, 3:63–67, 5:55–6:11.

Claim 14 further recites an emitter configured to communicate a signal relating to the credit card account information. We are persuaded by Mr. Dreifus's testimony that Hennige discloses such an emitter in its "contactless means" for wireless communication "for example inductively, or serially by means of photoelectric elements, or the like." Ex. 1009, 4:49–53; Ex. 1011, 144 (citing Ex. 1009, 7:35–37). In particular, Hennige discloses that the contactless communication means may be utilized by checking terminal 20 "to inquire the general data of the card [10] organization" during a credit card payment transaction, which would include credit card account information stored in card 10. Ex. 1009, 7:9–45.

Patent Owner contends the Hennige disclosure at column 7, lines 9–45, fails to disclose the transmission of credit card account information from card 10 to checking terminal 20. PO Resp. 20–23. According to Patent Owner, Hennige's indication that checking terminal 20 may "inquire the general data of the card organization" is ambiguous and can mean many things unrelated to communicating credit card account related information. PO Resp. 22–23; Ex. 2004 ¶¶ 150–158. Further, Hennige indicates that the salesperson (not card 10) inputs "the invoice data" into checking terminal 20, which in Patent Owner's view "suggests a salesperson enters credit card information." PO Resp. 23; Ex. 1009, 7:39–41.

We are not persuaded by Patent Owner's contention that the Hennige disclosure is ambiguous as to the data communicated from card 10 to checking terminal 20. For example, Hennige indicates the data may include a digitally-stored signature of the user to permit authentication for the credit card transaction (Ex. 1009, 9:48–63), as well as data read from credit cards for transfer to card 10 (*id.* at 10:53–62, 11:29–38), both of which relate to a

credit card account. This reading is consistent with Hennige's suggestion that an advantage of card 10 is that there is no need for the magnetic stripe normally existing on single-purpose cards (*id.* at 7:50–55), because the data is communicated instead by the contactless means. The “invoice data” entered into checking terminal 20 by the salesperson (*id.* at 7:39–41) is the data for the underlying sales transaction, not the credit card data used to pay for the transaction (*id.* at 7:9–13).

We further do not agree with Patent Owner that the claimed emitter must communicate to outside devices. *See supra* Part II.A.2; PO Resp. 23–24. We, therefore, find that Hennige's display is an additional emitter, alternative to Hennige's contactless communication means. Ex. 1009, 4:21–34, 5:55–6:5. Hennige's display may include credit card account information in the form of the credit card company's logo, the account number, and the authorized user's photo and signature. *Id.* at 5:55–6:5, Figs. 1a–1b.

For the foregoing reasons, a preponderance of the evidence establishes that claim 14 is unpatentable as anticipated by Hennige.

2. *Dependent Claims 16–21, 23, and 24*

As already discussed, a preponderance of the evidence establishes that Hennige discloses the limitations of independent claim 14. Petitioner further contends Hennige discloses the additional subject matter recited in claims 16–21, 23, and 24, each of which depends directly from claim 14. Pet. 42–43. We have reviewed the claim charts presented in the Petition and the Dreifus Declaration asserting that the additional subject matter of the dependent claims is disclosed in Hennige. *Id.*; Ex. 1011, 145–148. Patent Owner's Response relies solely on its arguments and evidence contesting

claim 14. The Scheduling Order cautioned Patent Owner that any arguments for patentability not raised in the Response would be deemed waived. Paper 11, 3. Accordingly, after due consideration of the argument and evidence advanced by Petitioner (*see, e.g.*, Inst. Dec. 27–29), we find a preponderance of the evidence establishes Hennige expressly discloses each and every limitation of dependent claims 16–21, 23, and 24, and conclude those claims are unpatentable as anticipated by Hennige.

G. Patent Owner’s Motion to Exclude Evidence

Patent Owner filed a Motion to Exclude Evidence (Paper 22, “the Motion” or “Mot.”), to which Petitioner filed an Opposition (Paper 26, “Opp.”), and Patent Owner thereafter filed a Reply and a Corrected Reply (Paper 28, “Corr. Reply”). Petitioner has not filed any Motions to Exclude Evidence.

The Motion requests exclusion from evidence of *Webster’s Ninth New Collegiate Dictionary*. Mot. 1–2. We need not decide this portion of the Motion, because Petitioner has not submitted or relied upon that dictionary in this proceeding. Opp. 3.

The Motion requests exclusion from evidence of Exhibit 1014, an excerpt from the *Wiley Electrical and Electronics Engineering Dictionary*. Mot. 2. We have declined to consider Exhibit 1014 based on Petitioner’s failure to explain its significance, so we need not decide this portion of the Motion. *See supra* Part II.A.1.

The Motion requests exclusion from evidence of Exhibit 1015, a copy of an article from the *New York Times*, and Exhibit 1016, an excerpt from *The IEEE Standard Dictionary of Electrical and Electronics Terms* (6th ed. 1996, Jane Radatz chair). Mot. 3–4. We have not relied upon either

Exhibit 1015 or 1016 in reaching the present decision, so we need not decide these portions of the Motion.

For the foregoing reasons, Patent Owner's Motion to Exclude Evidence (Paper 22) is *dismissed*.

III. CONCLUSION

Petitioner has shown, by a preponderance of the evidence, that:

A. Claims 1–7, 9–14, 16–21, 23–31, 33, and 34 are invalid under 35 U.S.C. § 102(e) as anticipated by Kikinis;

B. Claims 14, 16–21, 23, and 24 are invalid under 35 U.S.C. § 102(b) as anticipated by Gutman;

C. Claims 14 and 16–24 are invalid under 35 U.S.C. § 102(e) as anticipated by Pitroda; and

D. Claims 14, 16–21, 23, and 24 are invalid under 35 U.S.C. § 102(a) as anticipated by Hennige.

IV. ORDER

For the foregoing reasons, it is:

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

FURTHER ORDERED that claims 1–7, 9–14, 16–31, 33, and 34 of the '875 patent are unpatentable; and

FURTHER ORDERED that, because this is a final 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 (2014).

IPR2014-00158
Patent 8,490,875 B2

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