

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

ARENDI S.A.R.L.
Patent Owner

Case IPR2014-00203
Patent 8,306,993 B2

Before SALLY C. MEDLEY, TREVOR M. JEFFERSON, and
PETER P. CHEN, *Administrative Patent Judges*.

CHEN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Motorola Mobility LLC, Google Inc., and Apple Inc. (collectively, “Petitioner”) filed a Corrected Petition requesting *inter partes* review of claims 1-24 of U.S. Patent No. 8,306,993 B2 (Ex. 1001, “the ’993 patent”). Paper 5 (“Pet.”). Arendi S.A.R.L. (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides:

THRESHOLD.—The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

Upon consideration of the Petition and Preliminary Response, we are not persuaded the information presented by Petitioner has established a reasonable likelihood that Petitioner would prevail in showing the unpatentability of any of the challenged claims of the ’993 patent. Accordingly, we deny institution as to all claims of the ’993 patent.

A. Related Proceedings

According to the Patent Owner, the ’993 patent and related patents are currently at issue in the following cases pending in the United States District Court for the District of Delaware: *Arendi S.A.R.L. v. Yahoo! Inc.* (1:2013cv00920); *Arendi S.A.R.L. v. Google Inc.* (1:2013cv00919); *Arendi S.A.R.L. v. HTC Corp.* (1:2012cv01600); *Arendi S.A.R.L. v. Sony*

Mobile Communications (USA) Inc. (1:2012cv01602); *Arendi S.A.R.L. v. Nokia Corporation* (1:2012cv01599); and *Arendi S.A.R.L. v. Blackberry Limited* (1:2012cv015).

The '993 patent is also the subject of another petition for *inter partes* review, *Samsung Electronics Co. Ltd. v. Arendi S.A.R.L.*, IPR 2014-00214.

B. The '993 Patent

The '993 patent is titled “Method, System and Computer Readable Medium for Addressing Handling From an Operating System.” The subject matter of the '993 patent relates to computer-implemented processes for automating a user’s interaction between a first application, such as a word processor or spreadsheet, and a second application, such as a contact manager with a database. Ex. 1001, col 1, l. 60–col. 2, l. 31.

Figure 4 of the '993 patent is reproduced below.

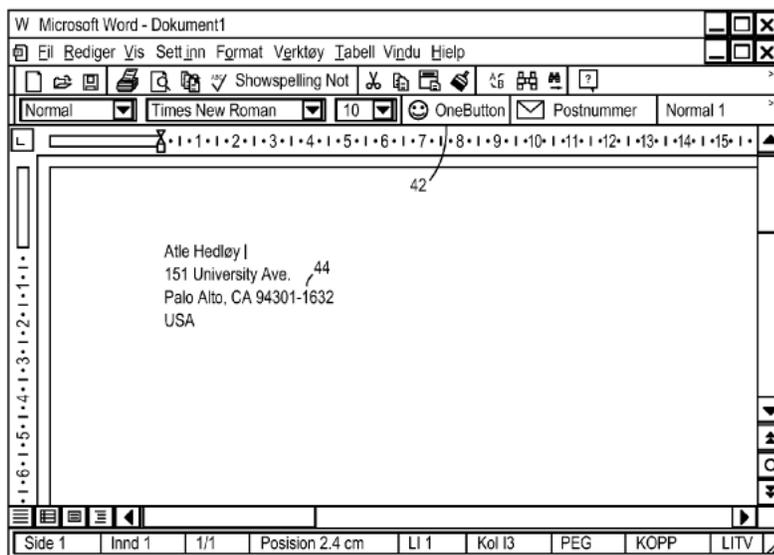


FIG. 4

Figure 4 illustrates a starting point in a document, such as a word processing document. The user types into the document the name and

address of existing contact 44. When the user clicks on OneButton 42, the claimed process is launched, analyzing the document to identify contact information and searching a contact database. Ex. 1001, col. 7, ll. 27-34.

Figure 1 of the '993 patent is reproduced below.

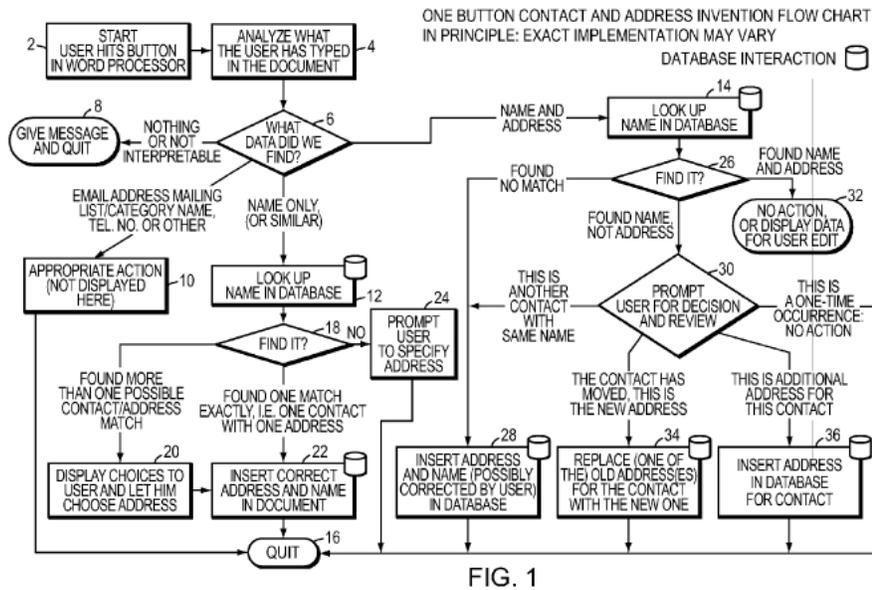


FIG. 1

Figure 1 depicts a flow chart of the address handling process initiated by the user clicking on OneButton 42 of Figure 4. At step 4, text typed by the user in a document is analyzed for contact information. At step 6, if the identified contact information includes a name and address, a search occurs in the database at step 14. When the database finds a name but not an address, at step 30, the user is prompted “for decision,” which leads to inserting address information into the database at step 36, or updating address information in the database at step 34. Ex. 1001, col. 4, l. 55–col. 5, l. 37.

Figure 9 of the '993 patent is reproduced below.

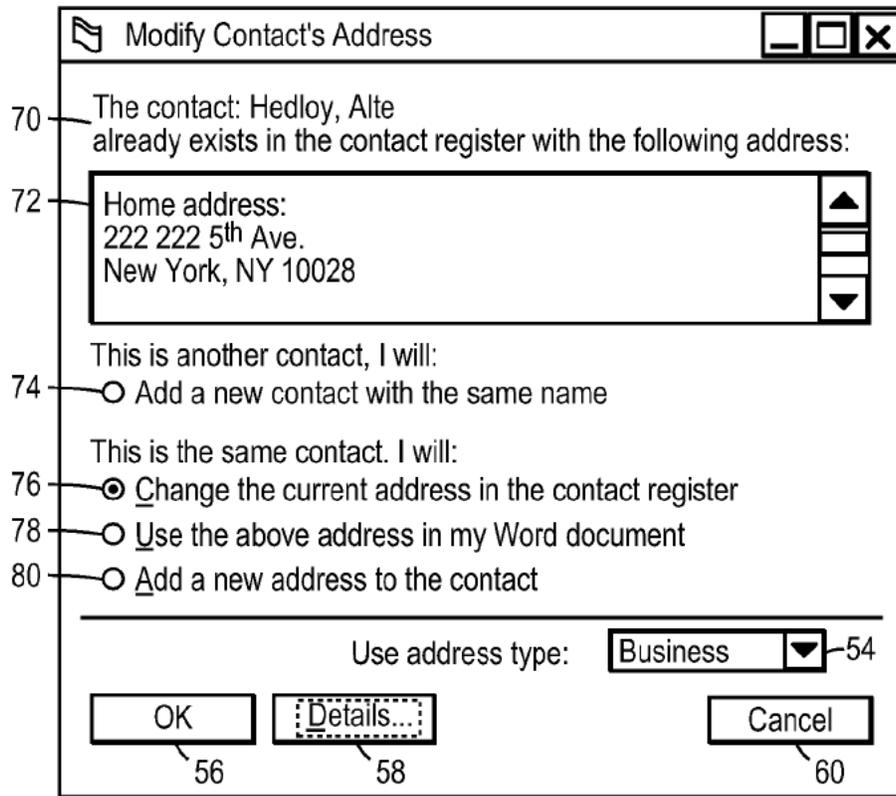


FIG. 9

Figure 9 illustrates a screen displayed to the user, who clicks on OneButton 42 of Figure 4 after typing a name and address into a document, where the name is in the contact database, but the address differs from the address typed by the user. The screen in Figure 9 gives the user a choice of adding a new contact or updating an existing contact. Ex. 1001, col. 7, ll. 27-42.

C. Illustrative Claim

Claims 1-24 are the subject of the Petition, and claims 1, 9, and 17 are independent claims. Independent claim 1 is reproduced below.

1. A computer implemented method for information handling, the method comprising:

providing access to a contact database that can also be separately accessed and edited by a user and wherein the contact database includes at least three fields for storing contact information associated with each of one or more contacts, each of the at least three fields within the contact database being specific to a particular type of contact information selected from the group consisting of name, title, address, telephone number, and email address;

analyzing in a computer process textual information in a document configured to be stored for later retrieval to identify a portion of the document as first contact information, without user designation of a specific part of the textual information to be subject to the analyzing,

wherein the first contact information is at least one of a name, a title, an address, a telephone number, and an email address;

after identifying the first contact information, performing at least one action from a set of potential actions, using the first contact information previously identified as a result of the analyzing, wherein the set of potential actions includes:

(i) initiating an electronic search in the contact database

for the first contact information while it is electronically displayed in order to find whether the first contact information is included in the contact database; and when a contact in the contact database includes the first contact information, if second contact information in the contact database is associated with that contact, electronically displaying at least a portion of the second contact information, wherein the second contact information is at least one of a name, a title, an address, a telephone number, and an email address;

(ii) initiating electronic communication using the first contact information; and

(iii) allowing the user to make a decision whether to store at least part of the first contact information in the contact database as a new contact or to update an existing contact in the contact database;

wherein the computer implemented method is configured to perform each one of action (i), action (ii), and action (iii) using the first contact information previously identified as a result of the analyzing; and

providing for the user an input device configured so that a single execute command from the input device is sufficient to cause the performing.

D. Prior Art Relied Upon

Petitioner relies upon the following five prior art references:

Reference	Title	Ex. No.
Bonura	Thomas Bonura and James R. Miller, <i>Drop Zones, an Extension to LiveDoc</i> , SIGCHI Bulletin, Vol. 30, No. 2, April 1998, at 59-63	Ex. 1006
Magnanelli	M. Magnanelli, A. Erni, M. Norrie, <i>Academia: An Agent-Maintained Database Based on Information Extraction from Web Documents</i> , 14th European Meeting on Cybernetics and Systems Research (April 15, 1998)	Ex. 1007
Luciw	US 5,644,735	Ex. 1003
Bates	US 6,247,043 B1	Ex. 1004
Giordano	US 6,870,828 B1	Ex. 1005

E. The Asserted Grounds

Petitioner contends the challenged claims are unpatentable based on the following four grounds.

Reference(s)	Basis	Claims Challenged
Bonura and Magnanelli	§ 103	1-4, 6-12, 14-20, and 22-24
Bonura, Magnanelli, and Giordano	§ 103	5, 13, and 21
Luciw	§ 102(b)	1-2, 6-7, 9-10, 14-15, 17-18, and 22-23

Reference(s)	Basis	Claims Challenged
Luciw, Bates, and Giordano	§ 103	1-24

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, the Board interprets claim terms of 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); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). There is a “heavy presumption” that a claim term carries its ordinary and customary meaning. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002). However, a “claim term will not receive its ordinary meaning if the patentee acted as his own lexicographer and clearly set forth a definition of the disputed claim term in either the specification or prosecution history.” *Id.*

Petitioner submits proposed constructions for five claim terms: “contact database;” “initiating electronic communication;” “allowing the user to make a decision whether to store at least part of the first contact information in the contact database as a new contact or to update an existing contact in the contact database;” “input device,” and “button.” Pet. 9-11. Patent Owner proposed an alternative construction for only one of these five terms, “allowing the user to make a decision whether to store at least part of the first contact information in the contact database as a new contact or to update an existing contact in the contact database.” Prelim. Resp. 8-12.

In particular, Petitioner proposes as follows: (i) “contact database” means “software that allows access to information related to a person”; (ii) “initiating electronic communication” means “starting a process that leads to an electronic communication”; (iii) “input device” includes a GUI element on screen, and thus, is not limited to hardware devices; and (iv) “button” is a “touch screen, keyboard button, icon, menu, voice command device, etc.” Pet. 9-11. All of these proposed constructions are supported by citations, in the Petition or the accompanying declaration of Mr. Allison, to the ’993 patent. For purposes of this Decision, we adopt the Petitioner’s proposed constructions as the broadest reasonable constructions consistent with the specification.

The parties dispute the meaning of the remaining term, which appears in all of the challenged independent claims: “allowing the user to make a decision whether to store at least part of the first contact information in the contact database as a new contact or to update an existing contact in the contact database.” Patent Owner asserts that this term should be construed as “presenting to the user a choice between competing alternatives of storing a new contact or updating an existing contact.” Prelim. Resp. 8-12. Patent Owner cites Figure 9 and related disclosure of the ’993 patent, described above in Section I. B, in support of its proposed construction.

Petitioner asserts that the limitation is ambiguous and that the term could mean either “the user is allowed to make a decision between storing and updating” (which is similar to Patent Owner’s proposed construction), or the term could mean “the user is allowed to make a . . . ‘decision whether to store . . . or a decision whether to update.’” Pet. 10. Petitioner cites three portions of the specification as support for the latter interpretation, what

Petitioner calls “the second interpretation,” i.e., the decision being whether to store or not to store, or to update or not to update. We determine that this second interpretation in Petitioner’s proposed construction is not within the broadest reasonable construction of the term. The plain language requires a single step of making a single decision to store or update, not two separate, alternating steps for a user either to decide to store or to decide to update, as Petitioner seems to suggest. Thus, we agree with the Patent Owner that the plain language of the claim requires presenting to the user a choice between competing alternatives of storing a new contact or updating an existing contact. That interpretation is consistent with Figure 9 and the related portion of the specification, which describes that “[a]t this point, the user may select one of the four options 74-80, and command the OK button 56 to execute the selected options.” Ex. 1001, col. 7, ll. 42-44. This step corresponds to step 30 of Fig. 1 to prompt the user for decision and review. *Id.*, col. 7, ll. 48-50.

In contrast, Petitioner’s three citations to the specification are unrelated to Figure 9 and the related disclosure of the ’993 patent, which, as described above, bear directly on the claim language.

Accordingly, for purposes of this Decision, we determine that the broadest reasonable construction of this term consistent with the specification is Patent Owner’s proposed construction, “presenting to the user a choice between competing alternatives of storing a new contact or updating an existing contact.”

B. Claims 1-4, 6-12, 14-20, and 22-24 – Obviousness Over Bonura and Magnanelli

Petitioner contends claims 1-4, 6-12, 14-20, and 22-24 are unpatentable under 35 U.S.C. § 103 as obvious over Bonura and Magnanelli. Pet. 11-33.

Bonura (Exhibit 1006)

Bonura is titled “Drop Zones – An Extension to LiveDoc” and discloses a user interface for managing LiveDoc objects in the context of a set of typical user tasks. Ex. 1006 at 60. A Drop Zones “assistant” takes features identified by LiveDoc, interprets the feature’s meaning, and recommends appropriate actions, made visible when the user selects structures identified by LiveDoc and drags and drops them to the assistants.

Id. Figure 2 of Bonura is reproduced below.

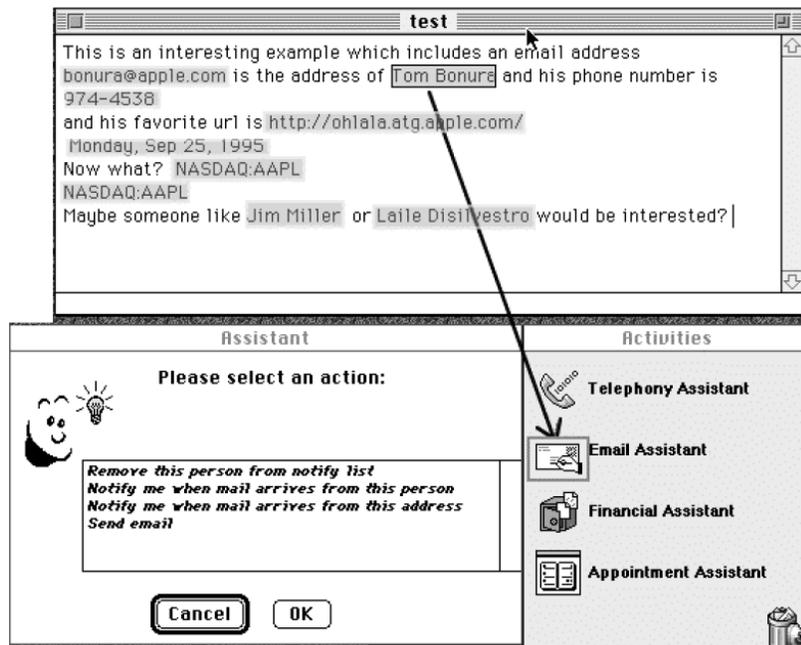


Figure 2: A user interaction with Drop Zones.

Figure 2 depicts a document in which LiveDoc has identified the structure “Tom Bonura” with its personal Name recognizer. Ex. 1006 at 60. The window labeled “test” is a LiveDoc window showing the proper name Tom Bonura, his e-mail address, phone number, and other information. The user may select the identified “Tom Bonura” structure and drag and drop it on the Drop Zone, e.g., to the window labeled “Activities,” where the Email Assistant responds by presenting four actions relating to the person’s name and e-mail address. *Id.* at 60-61. The Email Assistant can “look inside another address book application for a person with the stated phone number,” *id.* at 61.

Magnanelli (Exhibit 1007)

Magnanelli is titled “An Agent-Maintained Database based on Information Extraction from Web Documents,” and discloses a system called “Academia” “to reduce the work of an academic in finding and updating information about other researchers,” by scanning documents such as web pages, where the scanned information can be used to interact with a contact database. Ex. 1007, 2. Figure 1 of Magnanelli is reproduced below.

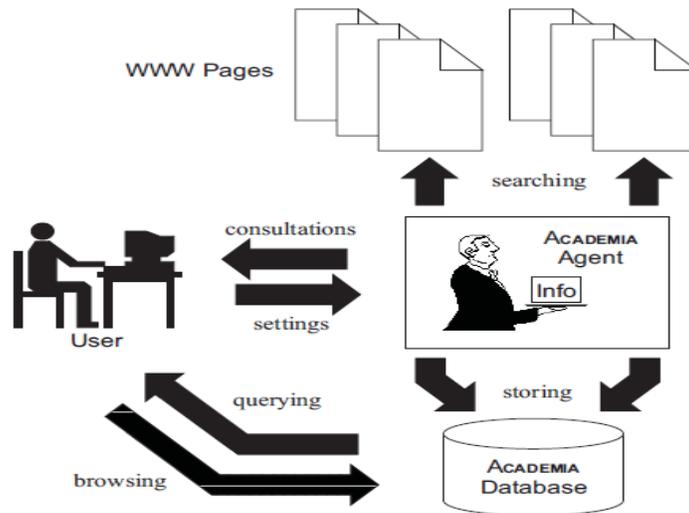


Figure 1: The components of ACADEMIA

Figure 1 depicts the components of the Academia system. A user interacts with the Academia Database, which contains contact and other information about people whose work the user is following. Ex. 1007, 2. The Academia Agent scans Internet pages and other documents for structures of interest representing contact and other information. *Id.* The system allows the User to choose whether to update the Database with facts about existing contacts. *Id.* at 3.

Analysis

Petitioner contends that claims 1, 2, 4, 7-10, 12, 15-18, 20, and 23-24 are unpatentable under 35 U.S.C. § 103(a) as obvious over Bonura and Magnanelli. In support of this asserted ground of unpatentability, Petitioner provides explanations of how it alleges the subject matter of each claim is disclosed by the combined teachings of Bonura and Magnanelli. Pet. 11-33.

Patent Owner contends the combination fails to disclose the limitation “allowing the user to make a decision whether to store at least part of the first contact information in the contact database as a new contact or to update an existing contact in the contact database,” which is recited in all challenged claims. Prelim. Resp. 32-34.

The Petition, in its element-by-element mapping, asserts this limitation is taught or suggested by Bonura’s disclosure of “add this person to my address book” and Magnanelli’s disclosure of having “the user who decides whether the [contact information] fact will be stored or not.” Pet. 29 (citing Ex. 1006, 60; Ex. 1007, 3).

Patent Owner argues that the limitation in question, which appears in all of the independent claims 1, 9, and 17, is not met by the two above-cited passages. Prelim. Resp. 32-34. We agree. Neither Bonura nor Magnanelli, singly or in combination, teaches or suggests the recited limitation in the claimed method for information handling. That limitation, as construed in Section II. A, requires presenting to the user a choice between competing alternatives of storing a new contact or updating an existing contact. Prelim. Resp. 29-39. All of the claims, thus, require the user’s decision, and the system’s ability to store or update contact information, to be made at once, not serially or separately. Bonura discloses only the ability to store “this person to my address book,” and separately, Magnanelli discloses only how the Academia user updates an existing contact when it “decides whether the [contact information] fact will be stored or not.” The combination of Bonura and Magnanelli, however, does not describe allowing the user to make a decision to store or to update, because there is no language or depiction in either reference of such a choice being presented. Nor has Petitioner

provided a reason why a person of ordinary skill in the art would modify the combination to arrive at the claimed invention and, in particular, the single step of making a single decision whether to store contact information as a new contact or, alternatively, to update an existing contact.

Accordingly, on this record, we determine that the information presented by Petitioner fails to establish a reasonable likelihood of prevailing in showing that claims 1, 2, 4, 7-10, 12, 15-18, 20, and 23-24 would have been obvious over Bonura and Magnanelli.

C. Claims 5, 13, and 21: Obviousness over Bonura, Magnanelli, and Giordano

Petitioner contends that dependent claims 5, 13, and 21 are unpatentable under 35 U.S.C. §103 (a) as obvious over Bonura, Magnanelli, and Giordano (Ex. 1005). Pet. 33-35. Claims 5, 13, and 21 depend from independent claims 1, 9, and 17, respectively, which were the subject of Petitioner's unsuccessful ground based on Bonura and Magnanelli. Petitioner does not argue that Giordano teaches or suggests the limitation missing in Bonura and Magnanelli. Accordingly, on this record, we determine that Petitioner fails to establish a reasonable likelihood of prevailing on this ground with on dependent claims 5, 13, and 21.

D. Claims 1-2, 6-7, 9-10, 14-15, 17-18, and 22-23: Anticipated by Luciw

Petitioner contends claims 1-2, 6-7, 9-10, 14-15, 17-18, and 22-23 are unpatentable under 35 U.S.C. §102 (b) as anticipated by Luciw (Ex. 1003). Pet. 35-46.¹

Luciw (Exhibit 1003)

Luciw, titled “Method and Apparatus for Providing Implicit Computer-Implemented Assistance,” generally discloses computer-implemented assistance methods and an apparatus, in particular, relating to pen-based computer systems. Ex. 1003, col. 1, ll. 20-22; col. 4, ll. 13-17. In Luciw, a system with a database of “actions” may be suggested “implicitly” to a user in response to text entries, or explicitly in response to a user request. *Id.*, Abstract; col. 8, ll. 9-43. An embodiment of Luciw manages contact information and provides implicit assistance, such as providing a list of stored last names when the user types a first name. *Id.* at col. 8, ll. 1-13. Figure 6a of Luciw is reproduced below.

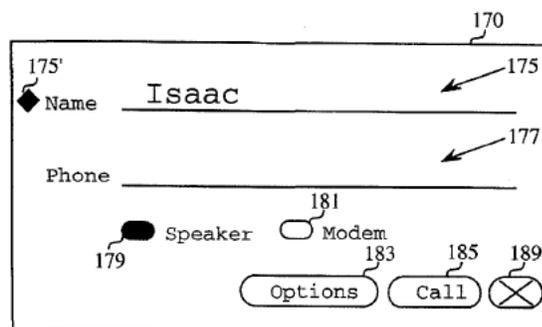


Figure 6a

¹ The Table of Contents refers to Luciw as a §102(b) reference, as do pages 3 and 35 of the Petition. Page 35, however, also refers to Luciw as a § 103 reference, and at page 46, the Petition argues that as to claims 10-16 and 18-24, “[t]hese claims are thus obvious for the same reasons as claim 28.” For purposes of this Decision, we treat Petitioner’s arguments regarding Luciw as based on § 102 and not on § 103.

Figure 6a depicts the user entering the first name “Isaac” in smart name field 175 of phone slip window 170. *Id.* at col. 11, ll. 40-45. Luciw defines a smart field as a predefined region on a computer screen, or a predefined region within a window on the computer screen. *Id.* at col. 8, ll. 16-19. Figure 6b of Luciw is reproduced below.

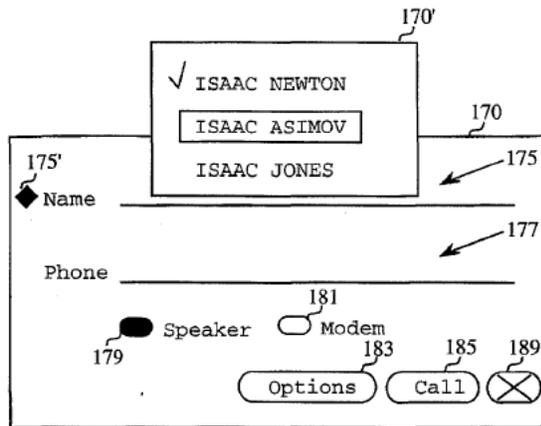


Figure 6b

Figure 6b depicts the presentation by the system of proposed last names that the user could be referring to when typing the first name “Isaac.” *Id.* at col. 11, l. 60 – col. 12, l. 6.

Analysis

In support of this asserted ground of unpatentability, Petitioner provides explanations of how it alleges the subject matter of each claim is disclosed by Luciw. Pet. 35-46.

Patent Owner contends Luciw does not anticipate the challenged claims because Luciw fails to disclose the limitation “allowing the user to make a decision whether to store at least part of the first contact information in the contact database as a new contact or to update an existing contact in

the contact database,” which is recited in all the challenged claims. Prelim. Resp. 43-45; *see* Section II. A above for the construction of this limitation.

The Petition, in its element-by-element mapping, asserts this limitation is met because “Luciw teaches updating a database with contact information.” Pet. 43. On its face, Petitioner’s assertion is unpersuasive, as it omits an explanation as to storing of first contact information, and the user being allowed to decide between storing and updating the database as required by the claims.

Petitioner next cites two portions of the specification of Luciw in its claim chart, but both relate only to updating of contact information, and not to storing of contact information or of allowing the user to decide between storing or updating contact information. Pet. 43 (citing Ex. 1003, col. 9, ll. 13-15, col. 12, ll. 54-60). Finally, the claim chart also cites claims 5 and 6 of Luciw, but again, those claims recite only “means for updating the database to contain information” (Pet. 43; Ex. 1003, col. 17, ll. 1-10), rather than the user being allowed to decide between storing at least part of the contact information in the contact database, or updating an existing contact in the contact database.

Accordingly, on this record, we determine that Petitioner fails to establish a reasonable likelihood of prevailing on this ground.

E. Claims 1-24: Obviousness over Luciw, Bates, and Giordano

Petitioner contends that claims 1-24 are unpatentable under 35 U.S.C. § 103 over Luciw, Bates, and Giordano.

Bates (Exhibit 1004)

Bates, titled “Apparatus, Program Products and Methods Utilizing Intelligent Contact Management,” discloses intelligent contact management,

including intelligent name lookup and automatic storage of new contacts.
Ex. 1004, Abstract; col. 10, ll. 22-29. Figure 3 of Bates is reproduced
below.

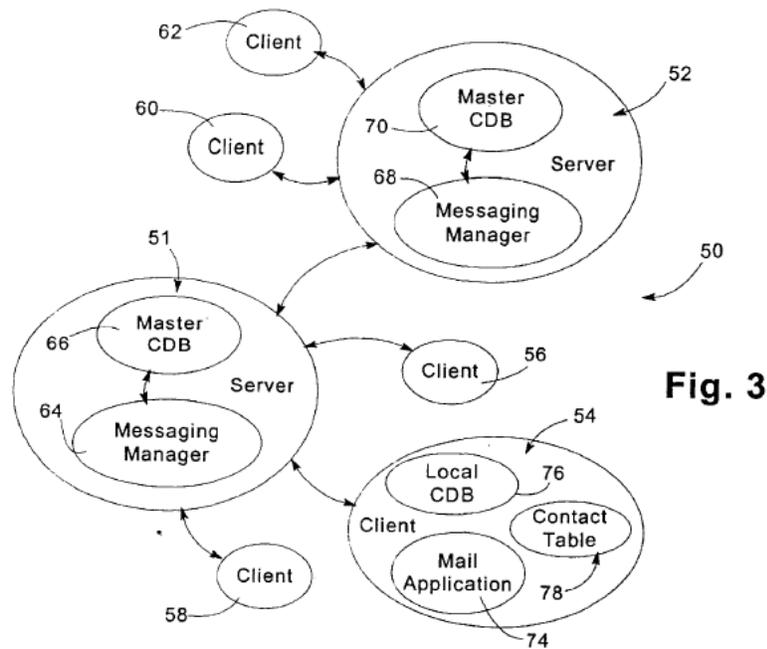


Fig. 3

Figure 3 depicts a block diagram of the primary software components in an e-mail messaging system disclosed by Bates. Ex. 1004, col. 4, ll. 43-44. E-mail messaging system 50 is distributed over servers 51 and 52 and clients such as 54, all clients having mail application 74, local contact database 76, and contact table 78. Ex. 1004, col. 7 ll. 21-23, 55-57.

Giordano (Exhibit 1005)

Giordano, titled “Method and Apparatus for Iconifying and Automatically Dialing Telephone Numbers Which Appear on a Web Page,” discloses a system for automatic detection of phone numbers in web pages via textual analysis, and for allowing users to take corresponding actions such as dialing a located phone number or saving the number to an address book. Ex. 1005, Abstract; col. 2, ll. 7-35.

Analysis

Petitioner contends all of the challenged claims 1-24 would have been obvious over Luciw, Bates, and Giordano. In support of this asserted ground of unpatentability, Petitioner provides explanations of how it alleges the subject matter of each claim is disclosed by the combined teachings of Luciw, Bates, and Giordano. Pet. 46-60.

Patent Owner contends Luciw, Bates, and Giordano fail to disclose the limitation “allowing the user to make a decision whether to store at least part of the first contact information in the contact database as a new contact or to update an existing contact in the contact database,” which is recited in all the claims challenged in this ground. Prelim. Resp. 43-50. *See* claim construction in Section II. A, above.

The Petition asserts this limitation is met because Giordano and Bates both disclose storing first contact information in the user’s local contact database, and Bates discloses updating an existing contact. Pet. 52-55. Patent Owner disputes this contention, arguing as to the updating feature that “Petitioners try to fill the gap left by Luciw (Exhibit 1003) by resorting to Giordano (Exhibit 1005) and Bates (Exhibit 1004). . . . Giordano fails to disclose, among other things, updating an existing contact in the user’s address book.” Prelim. Resp. 45. The Petition is indeed silent on such disclosure by Giordano.

Petitioner then asserts that Bates discloses updating an existing contact. Pet. 54-55; Ex. 1004, col. 13, l. 66–col. 14, l. 8. Petitioner contends the cited portion of Bates shows an alteration of a count field for the entry corresponding to a user name, which supposedly “constitutes an ‘update’ of that existing contact.” Pet. 55. Patent Owner argues the cited portion of

Bates does not disclose updating a contact in the local contact database, because the altered count field is not in the local contact database, but instead resides in the internal contact table, which as shown in Figure 3, is separate from the claimed contact database. Prelim. Resp. 48-49; Ex. 1004, Fig. 3; col. 7, ll. 55-57; col. 8, ll. 7-10.

Bates further discloses that the local contact database is, in fact, not updated if an entry for a user name already exists. Rather than being updated, the auto-add entry routine instead is terminated: “block 182 determine[s] whether or not the user name passed to the routine has an entry in the local contact database for the local user. If such an entry already exists, no further processing is required, and routine 152 terminates.” Ex. 1004, col. 15, ll. 27-31. We are persuaded by Patent Owner that neither Giordano nor Bates discloses updating an existing contact in the contact database. Prelim. Resp. 49.

Finally, the Petition makes no mention of whether or how the combination of Luciw, Bates, and Giordano teaches or suggests allowing the user to make a decision between storing or updating, as that limitation is construed in Section II. A above. Nor has Petitioner provided a reason why a person of ordinary skill in the art would modify the combination to arrive at the claimed invention and in particular, the single step of making a single decision whether to store contact information as a new contact or, alternatively, to update an existing contact.

Accordingly, on the present record, we determine that Petitioner fails to establish a reasonable likelihood of prevailing on this ground.

III. CONCLUSION

For the foregoing reasons, we determine that Petitioner fails to demonstrate a reasonable likelihood of prevailing on its challenge to the patentability of claims 1-24 of the '993 patent.

IV. ORDER

Accordingly, it is
ORDERED that the Petition is denied as to all challenged claims of the '993 patent.

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