

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner,

v.

SIMPLEAIR, INC.,
Patent Owner.

Case CBM2015-00019
Patent 8,572,279 B2

Before JAMES P. CALVE, JUSTIN T. ARBES, and TINA E. HULSE,
Administrative Patent Judges.

ARBES, *Administrative Patent Judge.*

DECISION

Denying Institution of Covered Business Method Patent Review
37 C.F.R. § 42.208

Petitioner Google Inc. filed a Petition (Paper 2, “Pet.”) requesting covered business method patent review of claims 1–4, 6–11, 13–21, 24, 27–35, 37, 38, 42, 43, 47–49, 54, 55, 62, and 63 of U.S. Patent No. 8,572,279 B2 (Ex. 1001, “the ’279 patent”) pursuant to 35 U.S.C. §§ 321–29. Patent Owner SimpleAir, Inc. filed a Preliminary Response (Paper 9, “Prelim. Resp.”). With its Preliminary Response, Patent Owner provided evidence that it filed with the Office a statutory disclaimer of claims 19, 24, 27, 33, 34, 53, 58, 61, 67, and 68 of the ’279 patent pursuant to 37 C.F.R. § 1.321(a). *See* Prelim. Resp. 25–26; Ex. 2005. Accordingly, no covered business method patent review will be instituted for claims 19, 24, 27, 33, and 34. *See* 37 C.F.R. § 42.207(e).

For the remaining claims 1–4, 6–11, 13–18, 20, 21, 28–32, 35, 37, 38, 42, 43, 47–49, 54, 55, 62, and 63, we determine whether to institute a covered business method patent review under 35 U.S.C. § 324.¹ Pursuant to 35 U.S.C. § 324(a), the Director may not authorize a covered business method patent review unless the information in the petition, if unrebutted, “would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.” For the reasons that follow, we have decided not to institute a covered business method patent review.

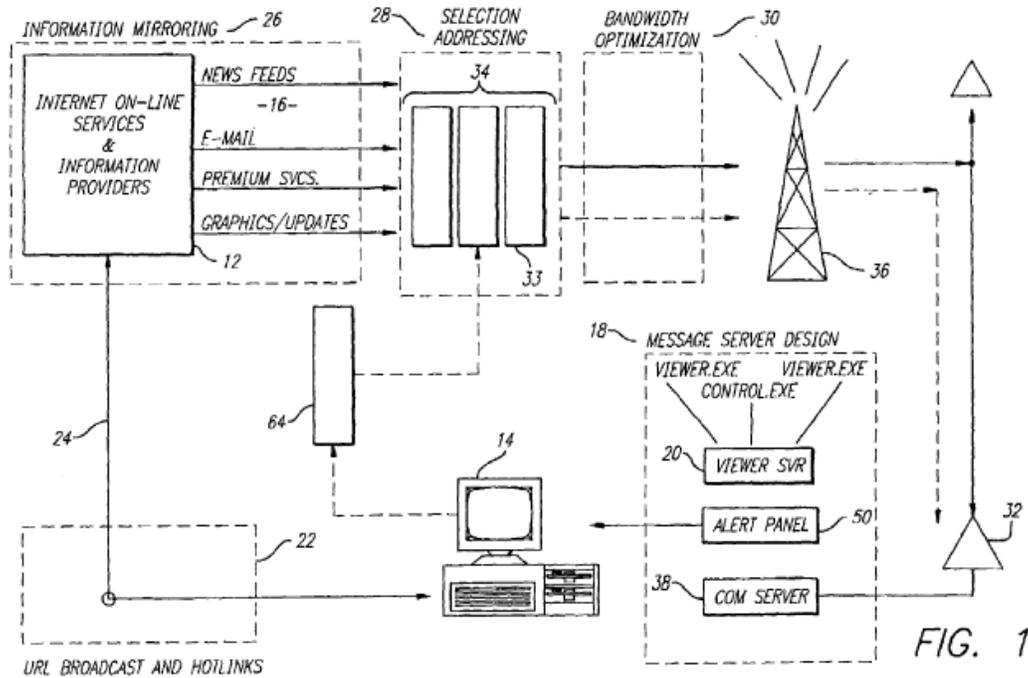
¹ *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,764–65 (Aug. 14, 2012) (“[A] patent owner may file a statutory disclaimer of one or more challenged claims to streamline the proceedings. Where no challenged claims remain, the Board would terminate the proceeding. Where one or more challenged claims remain, the Board’s decision on institution would be based solely on the remaining claims.”).

I. BACKGROUND

A. *The '279 Patent*

The '279 patent describes a “system and method for data communication connecting on-line networks with on-line and off-line computers.” Ex. 1001, col. 2, ll. 55–58. In one embodiment, wireless communication system 10 connects on-line information sources 12 with on- and off-line computers, such as personal computers 14. *Id.* at col. 5, ll. 40–43, Fig. 1. Data parsed from a plurality of incoming data feeds 16 of information sources 12 are transmitted wirelessly from central broadcast server 34 to commercial wireless carrier 36 to wireless receivers 32 that are connected to personal computers 14. *Id.* at col. 5, l. 60–col. 6, l. 1, col. 6, ll. 46–52. When data packets are processed and formed into a complete message, communications server 38 notifies user interface alert panel 50, which presents an icon that, when clicked, notifies viewers 20, which display particular data on computers 14. *Id.* at col. 6, ll. 46–60. Thus, remote computer 14 can receive information even while it is off-line (i.e., not connected to the Internet or on-line service). *Id.* at col. 7, ll. 10–13. Uniform Resource Locators (URLs) embedded in the data packets provide an automated wired or wireless connection or link 22 to information source 12 for obtaining detailed data. *Id.* at col. 6, ll. 62–66.

Figure 1 of the '279 patent is reproduced below.



As shown in Figure 1 above, real time data feeds from information sources 12 on the Internet are provided to server network 33 in central broadcast server 34, such as FTP server 102 and SMTP server 104. *Id.* at col. 8, ll. 9–15, Fig. 2. Data, “which can include but [are] not limited to stock quotes, weather, lotto, E-mail, etc.,” are “parsed by parsers, such as the stock quote parser 106, weather parser 108, lotto parser 110 and mail parser 112, and then transmitted to the content manager 114 located in the central broadcast server 34.” *Id.* at col. 8, ll. 15–21, 41–45. Content manager 114 communicates with information gateway 134, which builds data blocks and determines all applicable real and virtual addresses based on the type of information in the data block and user subscription data from subscriber database 130. *Id.* at col. 8, l. 62–col. 9, l. 17, col. 22, ll. 13–18. Wireless gateway 136 packetizes, compresses, and encrypts data blocks for

transmission over the wireless broadcast network to receivers. *Id.* at col. 9, ll. 18–24, col. 11, ll. 31–42, Fig. 4.

B. Illustrative Claim

Claim 1 of the '279 patent recites:

1. A system to transmit data from an information source to remote computing devices, the system comprising:

a central broadcast server configured to receive data from at least one information source and process the received data with at least one parser;

an information gateway communicatively coupled to the central broadcast server, the information gateway configured to build data blocks from the parsed data and assign addresses to the data blocks;

a transmission gateway communicatively coupled to one or both of the central broadcast server and the information gateway, the transmission gateway configured to prepare the addressed data blocks for transmission to receivers communicatively coupled to the remote computing devices and initiate transmission of the addressed data blocks to the receivers, wherein the transmission is made whether the remote computing devices are online or offline from a data channel associated with each remote computing device.

C. The Prior Art

Petitioner relies on the following prior art:

U.S. Patent No. 4,899,136, issued Feb. 6, 1990 (Ex. 1004, “Beard”);

U.S. Patent No. 5,339,392, issued Aug. 16, 1994 (Ex. 1031, “Risberg”);

U.S. Patent No. 5,414,773, issued May 9, 1995 (Ex. 1022, “Handelman”);

U.S. Patent No. 5,418,524, issued May 23, 1995 (Ex. 1006, “Fennell”);

International Patent Application Publication No. WO 94/08419, published Apr. 14, 1994 (Ex. 1009, “Kane”);

International Patent Application Publication No. WO 95/17062, published June 22, 1995 (Ex. 1021, “Pettus”);

David K. Gifford *et al.*, *The Application of Digital Broadcast Communication to Large Scale Information Systems*, SAC-3 IEEE J. ON SELECTED AREAS COMM. 457–67 (May 1985) (Ex. 1007, “Gifford”);

Sara Parker, *Windows cc:Mail Shines at Multiple Document Handling*, PC MAGAZINE, July 1991, at 49 (Ex. 1016, “Parker”);

Angela Gunn, *Wireless Communications: Connecting Over the Airwaves*, PC MAGAZINE, Aug. 1993, at 359–84 (Ex. 1017, “Gunn”);

George H. Forman & John Zahorjan, *The Challenges of Mobile Computing*, 1994 COMPUTER 38–47 (Ex. 1034, “Forman”);

Douglas Comer & Vincent Russo, *Using ATM for a Campus-Scale Wireless Internet*, 1995 WORKSHOP ON MOBILE COMPUTING SYSTEMS AND APPLICATIONS 75–79 (Ex. 1051, “Comer”);

David Maltz & Kate Ehrlich, *Pointing The Way: Active Collaborative Filtering*, 1995 CHI '95 MOSAIC OF CREATIVITY 202–209 (Ex. 1062, “Maltz”); and

Steve Harris, *Internet: A Plague that Travels by Post; Easy to Do and Often Tricky to Trace, Spamming is Sweeping the Net*, THE GUARDIAN (LONDON), July 6, 1995, at 4 (Ex. 1005, “Harris”).

Petitioner also relies on the following materials, which Petitioner contends are evidence of a publicly disclosed prior art system referred to by Petitioner as the “Dartmouth System”:

Stephen Campbell, *Campus Email for Everyone: Making It Work in Real Life*, PROC. 1994 SANS III CONFERENCE: THE THIRD ANNUAL SYSTEM ADMINISTRATION, NETWORKING, AND SECURITY CONFERENCE 23–38 (Ex. 1011);

Declaration of James Matthews (Ex. 1010); and

Source code files (Exs. 1012–1015).

D. The Asserted Grounds

Petitioner challenges claims 1–4, 6–11, 13–21, 24, 27–35, 37, 38, 42, 43, 47–49, 54, 55, 62, and 63 of the '279 patent on the following grounds:²

Reference(s)	Basis	Claim(s) Challenged
N/A	35 U.S.C. § 101	1–4, 6–11, 13–21, 24, 27–35, 37, 38, 42, 43, 47–49, 54, 55, 62, and 63
Dartmouth System	35 U.S.C. § 102(a)	1, 2, 6–11, 13, 14, 16, 20, 24, 29, 35, 42, 43, 47–49, 54, and 63
Dartmouth System	35 U.S.C. § 103(a)	1, 2, 6–11, 13, 14, 16, 20, 24, 29, 35, 42, 43, 47–49, 54, and 63
Dartmouth System and Gunn	35 U.S.C. § 103(a)	3, 4, 30, 31, 33, 37, and 38
Dartmouth System and Beard	35 U.S.C. § 103(a)	15 and 18
Dartmouth System, Beard, and Risberg	35 U.S.C. § 103(a)	17
Dartmouth System, Beard, and Harris	35 U.S.C. § 103(a)	19

² As explained above, we do not consider any grounds challenging claims 19, 24, 27, 33, and 34, which Patent Owner statutorily disclaimed. *See* 37 C.F.R. § 42.207(e).

Reference(s)	Basis	Claim(s) Challenged
Dartmouth System and Comer	35 U.S.C. § 103(a)	21 and 55
Dartmouth System and Harris	35 U.S.C. § 103(a)	27
Dartmouth System and Fennell	35 U.S.C. § 103(a)	28 and 62
Dartmouth System, Gunn, and Beard	35 U.S.C. § 103(a)	32
Dartmouth System, Gunn, and Harris	35 U.S.C. § 103(a)	34
Kane, Gifford, and Maltz	35 U.S.C. § 103(a)	1–4, 8, 20, 24, 29, 35, 37, 38, 42, 54, and 63
Kane, Gifford, Maltz, and Pettus	35 U.S.C. § 103(a)	6, 7, 30, and 33
Kane, Gifford, Maltz, and Beard	35 U.S.C. § 103(a)	9, 10, 14–16, 18, 43, 48, and 49
Kane, Gifford, Maltz, and Parker	35 U.S.C. § 103(a)	11, 13, 43, and 47
Kane, Gifford, Maltz, Beard, and Risberg	35 U.S.C. § 103(a)	17
Kane, Gifford, Maltz, Beard, and Handelman	35 U.S.C. § 103(a)	19
Kane, Gifford, Maltz, Beard, and Forman	35 U.S.C. § 103(a)	21 and 55
Kane, Gifford, Maltz, and Handelman	35 U.S.C. § 103(a)	27

Reference(s)	Basis	Claim(s) Challenged
Kane, Gifford, Maltz, and Fennell	35 U.S.C. § 103(a)	28 and 62
Kane, Gifford, Maltz, Pettus, and Beard	35 U.S.C. § 103(a)	31 and 32
Kane, Gifford, Maltz, Pettus, and Handelman	35 U.S.C. § 103(a)	34

II. DISCUSSION

Section 18 of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), provides for the creation of a transitional program for reviewing covered business method patents, and limits reviews to persons or their privies that have been sued or charged with infringement of a “covered business method patent,” which does not include patents for “technological inventions.” AIA §§ 18(a)(1)(B), 18(d)(1); *see* 37 C.F.R. § 42.302. Petitioner bears the burden of demonstrating that the ’279 patent is a covered business method patent. *See* 37 C.F.R. § 42.304(a). For the reasons explained below, Petitioner has not demonstrated that the ’279 patent is a covered business method patent.

A “covered business method patent” is “a patent that *claims* a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.” AIA § 18(d)(1) (emphasis added); *see* 37 C.F.R. § 42.301(a). In promulgating rules for covered business method patent reviews, the Office considered the legislative intent and history behind the

AIA’s definition of “covered business method patent.” *See* Transitional Program for Covered Business Method Patents—Definitions of Covered Business Method Patent and Technological Invention; Final Rule, 77 Fed. Reg. 48,734, 48,735–36 (Aug. 14, 2012). The “legislative history explains that the definition of covered business method patent was drafted to encompass patents ‘*claiming* activities that are financial in nature, incidental to a financial activity or complementary to a financial activity.’” *Id.* at 48,735 (emphasis added) (citing 157 Cong. Rec. S5432 (daily ed. Sept. 8, 2011) (statement of Sen. Schumer)). When determining whether a patent is eligible for covered business method patent review, the focus is on “what the patent claims.” *Id.* at 48,736. A patent need have only one claim directed to a covered business method to be eligible for review. *Id.*

Petitioner cites two claims of the ’279 patent in support of its argument that the ’279 patent is a covered business method patent: claims 1 and 24. Pet. 5–7.

Claim 1

With respect to claim 1, Petitioner contends that the claim “encompasses a method used in the management of a financial product or service—that is, the disclosure of stock quotes and lotto results,” citing a prior decision in Case CBM2014-00054 holding that U.S. Patent No. 7,035,914 B1 (“the ’914 patent”), a parent of the ’279 patent, was a covered business method patent. Pet. 6–7 (citing *Google Inc. v. SimpleAir, Inc.*, CBM2014-00054, slip op. at 5–6 (PTAB May 13, 2014) (Paper 19)). According to Petitioner, the claims of the ’279 patent “overlap significantly” with the claims of the ’914 patent, and are “used in financial services.” *Id.*

Petitioner, however, provides no analysis of the language of claim 1 or explanation as to why the particular language of claim 1 recites an apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, as required by § 18(d)(1) of the AIA. As explained above, the focus of the “covered business method patent” inquiry is on the claims. Although claim 1 of the ’279 patent has some terms in common with various claims of the ’914 patent, it is not identical to any claim of the ’914 patent. They are different patents with different claims. Merely stating that claim 1 overlaps with claims of the ’914 patent, particularly without explaining how the claims overlap or even specifying what claims of the ’914 patent overlap, is insufficient for Petitioner to meet its burden. Further, to the extent Petitioner is attempting to rely on arguments it made for eligibility of the ’914 patent in the prior proceeding, such arguments cannot be incorporated by reference in its Petition in this proceeding. *See* 37 C.F.R. § 42.6(a)(3) (“Arguments must not be incorporated by reference from one document into another document.”).

Petitioner also argues that the Specification of the ’279 patent discloses data feeds that may include “stock quotes” or “lotto,” parsed by a “stock quote parser” or “lotto parser,” and that the ’279 patent “contemplates notification of financial news stories and pay-per-view events.” Pet. 6–7 (citing Ex. 1001, col. 8, ll. 11–13, 16–24, col. 20, ll. 21–28, 35–50, col. 28, l. 40, Fig. 2) (emphasis omitted). Petitioner, however, does not explain any relationship between the cited portions of the Specification and the specific language of claim 1, which is the focus of our inquiry. Again, Petitioner fails to show how the ’279 patent *claims* an

apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service.

Further, we find persuasive Patent Owner’s argument that claim 1 recites only generic, context-neutral “data,” without any language relating to a financial product or service. *See* Prelim. Resp. 15–34 (citing a statement in the legislative history of the AIA that § 18(d)(1) is not intended to cover “technologies common in business environments across sectors and that have no particular relation to the financial services sector, such as computers, communications networks, and business software,” 157 Cong. Rec. S5441 (daily ed. Sept. 8, 2011) (statement of Sen. Leahy)). Claim 1 recites a central broadcast server configured to receive “data” from an information source and process the received data with “at least one parser,” an information gateway configured to build “data blocks” from the parsed data and assign addresses to the data blocks, and a transmission gateway configured to initiate transmission of the addressed data blocks to receivers. Claim 1, though, never specifies the type or nature of the “data.” This broad scope is reflected in the Specification, which describes numerous examples of data feeds and contemplates the use of any type of data and parser:

[I]nformation sources 12 provide data feeds to the central broadcast server 34 which performs selection, scheduling and addressing 28. In particular, real time data feeds from the Internet 13 in the information source 12 are provided to a network of servers 33 in the central broadcast server 34, such as the FTP server 102 and the SMTP server 104 illustrated in FIG. 2. The *data, which can include but is not limited to stock quotes, weather, lotto, E-mail, etc.* is then respectively parsed by parsers, such as the stock quote parser 106, weather parser 108, lotto parser 110 and mail parser 112, and then transmitted to the content manager 114 located in the central broadcast server 34. . . . *The present invention is not limited to the*

information sources or parsers described herein. Rather, any type of information source and corresponding parser may be used.

Ex. 1001, col. 8, ll. 9–28 (emphasis added); *see also id.* at col. 7, l. 66–col. 8, l. 3, col. 12, ll. 10–14 (describing the use of any type of data).

Other panels of the Board have found patents not to meet the definition of “covered business method patent” in similar circumstances. *See, e.g., Sega of Am., Inc. v. Uniloc USA, Inc.*, CBM2014-00183, slip op. at 11–13 (PTAB Mar. 10, 2015) (Paper 11) (claims were “directed to technology that restricts the use of software” where the software had “no particular relationship to a financial product or service”); *Salesforce.com, Inc. v. Applications in Internet Time LLC*, CBM2014-00162, slip op. at 9–10 (PTAB Feb. 2, 2015) (Paper 11) (patent specification referred to “banking, financial and securities activities” as “part of a long list of regulated industries . . . that use business software and could benefit from the invention”); *J.P. Morgan Chase & Co. v. Intellectual Ventures II LLC*, CBM2014-00160, slip op. at 6–12 (PTAB Jan. 29, 2015) (Paper 11) (claims pertaining to secure electronic communications had “general utility not limited or specific to any application”); *PNC Fin. Servs. Group, Inc. v. Intellectual Ventures I LLC*, CBM2014-00032, slip op. at 6–15 (PTAB May 22, 2014) (Paper 13) (claims described “software systems that have general utility not specific to any application”). We likewise conclude that Petitioner’s arguments regarding claim 1 and the Specification do not establish that the ’279 patent claims an apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service.

Claim 24

With respect to claim 24, Petitioner points to the claim's recitation that "the transmitted data comprises information relating to at least one of news, sports, financial markets, weather, an online chat, and/or an online forum." See Pet. 7. Patent Owner, however, statutorily disclaimed claim 24, along with other dependent claims reciting the same limitation, pursuant to 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321(a). See Prelim. Resp. 25–26; Ex. 2005. Accordingly, we treat the '279 patent as though claim 24 never existed. See *Vectra Fitness, Inc. v. TWNK Corp.*, 162 F.3d 1379, 1383 (Fed. Cir. 1998) ("This court has interpreted the term 'considered as part of the original patent' in section 253 to mean that the patent is treated as though the disclaimed claims never existed."); *Guinn v. Kopf*, 96 F.3d 1419, 1422 (Fed. Cir. 1996) ("A statutory disclaimer under 35 U.S.C. § 253 has the effect of canceling the claims from the patent and the patent is viewed as though the disclaimed claims had never existed in the patent."); see also *Genetics Inst., LLC v. Novartis Vaccines & Diagnostics, Inc.*, 655 F.3d 1291, 1299 (Fed. Cir. 2011) (holding that the Board's interference jurisdiction under 35 U.S.C. § 291 required "the existence of an interference, and a claim that 'never existed' [due to a statutory disclaimer] cannot form the basis for an interference"). Petitioner's argument regarding claim 24, therefore, is not persuasive.

For the foregoing reasons, based on the present record and particular facts of this proceeding, we determine that the information presented in the Petition does not establish that the '279 patent qualifies as a "covered business method patent" under § 18(d)(1) of the AIA. Therefore, we

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do not institute a covered business method patent review on any of the asserted grounds as to any of the challenged claims.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is denied as to all challenged claims of the '279 patent.

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