

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SQUARE, INC.,
Petitioner,

v.

UNWIRED PLANET LLC,
Patent Owner.

Case IPR2014-01164
U.S. Patent No. 7,376,433 B1

Before MICHAEL W. KIM, JENNIFER S. BISK, and
BARBARA A. PARVIS, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. *Background*

Square, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–17 (“the challenged claims”) of U.S. Patent No. 7,376,433 B1 (Exhibit 1001, “the ’433 Patent”). We instituted trial for all the challenged claims on the grounds of unpatentability below. Paper 7 (“Decision to Institute” or “Inst. Dec.”).

Claims	Basis	Asserted Prior Art
Claims 1–7 and 11–17	§102(e)	DeLorme ¹
Claims 7–10	§103(a)	DeLorme and Trask ²
Claims 1–6 and 11–16	§103(a)	Baker ³ and Hall ⁴
Claims 7–10	§103(a)	Baker, Hall, and Trask

After institution of trial, Unwired Planet LLC (“Patent Owner”) filed a Patent Owner Response (Paper 11, “PO Resp.”). Petitioner filed a Reply to the Patent Owner Response (Paper 17, “Pet. Reply”).

A hearing was held on September 16, 2015. The transcript has been entered into the record. Paper 27 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons given herein, Petitioner has shown by a preponderance of the evidence that the challenged claims are unpatentable.

B. Related Proceedings

Petitioner and Patent Owner state that the ’433 Patent has been asserted against Petitioner in the following district court case: *Unwired Planet LLC v. Square, Inc.*, No. 3:13-cv-00579 (D. Nev.). Pet. 2; *See* Mandatory Notice of Patent Owner Under 37 C.F.R. § 42.8(a)(2) (“Patent Owner Notice,” Paper 4).

¹ U.S. Patent No. 5,948,040 (“DeLorme”) (Ex. 1008).

² U.S. Patent No. 5,945,919 (“Trask”) (Ex. 1007).

³ U.S. Patent No. 6,505,046 B1 (“Baker”) (Ex. 1009). Petitioner additionally relies on U.S. Patent Appl. No. 60/066,653 (“Baker Provisional”) (Ex. 1010).

⁴ U.S. Patent No. 6,026,375 (“Hall”) (Ex. 1011).

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Patent Owner asserted a related patent, U.S. Patent No. 7,024,205 (“the ’205 patent”), in *Unwired Planet, LLC v. Google, Inc.*, No. 3:12-cv-00504 (D. Nev.). *See* Patent Owner Notice. The ’205 patent issued from the parent of the application that issued as the ’433 Patent. The ’205 patent is the subject of a covered business method patent review, CBM2014-00005, and an *inter partes* review, IPR2014-00036, both of which involve a different petitioner than the instant proceeding. *Id.*

Furthermore, U.S. Patent No. 7,711,100 (“the ’100 patent”) and U.S. Patent No. 8,275,359 (“the ’359 patent”) are involved in the same district court proceeding involving Petitioner identified above, and also concern location-based mobile service technology. The ’100 patent and the ’359 patent are not, however, in the same patent family as the ’433 Patent. Petitioner has requested Office review of the ’100 patent (Case CBM2014-00156) and the ’359 patent (Case IPR2014-01165).

C. The ’433 Patent

The ’433 Patent relates to subscriber delivered, location-based services. Ex. 1001, 1:18–24. The ’433 Patent states that location-based service systems have been implemented or proposed for wireless networks. *Id.* at 1:32–34. According to the ’433 Patent, these systems generally involve determining location information for a wireless transceiver and processing the location information to provide an output desired for a particular application. *Id.* at 1:34–37. The ’433 Patent also states that location-based services can be enhanced by personalizing the services provided by processing a request based, at least in part, on stored information regarding a subscriber. *Id.* at 2:13–18. Subscriber information may include account numbers, credit card numbers, other financial

information, lodging preferences, price limitations, and discount programs.
Id. at 2:18–23.

D. Illustrative Claim

Claims 1 and 15 are the independent claims challenged by Petitioner. Each of claims 2–14 depends, directly or indirectly, from claim 1, and each of claims 16 and 17 depends, directly or indirectly, from claim 15. Claim 1 is illustrative and is reproduced below:

1. A method of providing location-based services to a subscriber of a wireless network, the method comprising:
 - storing, on the network platform, subscriber profile information regarding the subscriber, the subscriber using a mobile unit;
 - thereafter receiving, on a network platform in communication with the subscriber, a service request from the mobile unit requesting information regarding the location-based services;
 - obtaining, on the network platform, location information regarding a location of the mobile unit;
 - identifying, on the network platform, a plurality of candidate service providers from a database of service providers, based upon the location of the mobile unit;
 - identifying, on the network platform, service provider information associated with the plurality of candidate service providers;
 - selecting, on the network platform, a subset of the plurality of candidate service providers based on the subscriber profile information, wherein selecting a subset comprises not selecting at least one of the plurality of candidate service providers;
 - outputting information regarding the subset of the plurality of candidate service providers to the mobile unit;
 - receiving an input from the mobile unit, wherein the input comprises a selection of a preferred service provider;
 - transmitting information regarding the subscriber to the preferred service provider;

initiating a transaction between the subscriber and the preferred service provider based on the information regarding the subscriber; and
receiving a transaction confirmation from the preferred service provider.

II. ANALYSIS

A. *Claim Construction*

As a step in our analysis in the Decision to Institute, we determined the meaning of the claims. The constructions are summarized in the table below.

Claim Term	Construction
“subscriber profile information”	“[I]nformation relating to a user.” Inst. Dec. 7.
“network platform”	“[C]omputer included on a network.” <i>Id.</i> at 8.
“mobile service provider”	“[S]ervice provider that changes its location.” <i>Id.</i> at 8. We determine that “mobile service provider” encompasses the examples provided in the ’433 Patent specification including taxi, courier, and police unit. <i>Id.</i> at 9.

Neither Petitioner nor Patent Owner disputes our constructions. Pet. Reply 2–3; PO Resp. 3–9; Tr. 8, 27. We discern no reason, based on the complete record now before us, to change our determinations thereof.

Patent Owner provides constructions for three additional terms. We evaluate two of these constructions below, but need not address the other. In particular, we need not evaluate Patent Owner’s contentions regarding whether “at least one of” modifies both the credit card number and the expiration date as recited in claim 12’s limitation “wherein the financial information comprises at least one of a credit card number and an expiration

date, a bank account number, or corporate account information,” because we determine that DeLorme discloses “corporate account information,” as discussed further below.

In an *inter partes* review, claim terms in an unexpired patent are interpreted 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); *see In re Cuozzo Speed Techs., LLC.*, 793 F.3d 1268, 1277–1279 (Fed. Cir. 2015) (“Congress implicitly approved the broadest reasonable interpretation standard in enacting the [America Invents Act (Pub. L. No. 112–29, 125 Stat. 284 (2011)) (‘AIA’)],” and “the standard was properly adopted by [United States Patent and Trademark Office (‘USPTO’)] regulation.”). Under the broadest reasonable construction standard, claim terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). We construe the terms below in accordance with these principles.

1. “*receiving a transaction confirmation from the preferred service provider*”

The term “receiving a transaction confirmation from the preferred service provider” is recited, for example, in independent claims 1 and 15. According to Patent Owner “receiving a transaction confirmation from the preferred service provider” means “receiving a transaction confirmation either directly from or indirectly from the preferred service provider.” PO Resp. 3. Patent Owner provides further clarification regarding its construction citing to Petitioner’s declarant, “Mr. Proctor[] testified during his deposition that ‘[i]t could be sent from a service provider via a central

service, or it can be sent directly, under the broadest reasonable meaning.”
Id. at 4 (citing Ex. 2003 at 140:4–9).

Petitioner contends that the term “indirectly” does not appear in the patent specification and would itself require further construction. Pet. Reply 3. Petitioner’s contention is not persuasive because the ’433 Patent Specification describes how a transaction confirmation is sent. In particular, the ’433 Patent Specification states that a transaction confirmation “is received (324) by the system and, in turn, transmitted (326) to the subscriber to complete the process,” which we discern as being “indirect,” as the “system” is not a part of the preferred service provider. Ex. 1001, 8:50–53.

In light of Patent Owner’s contentions that an order is not a transaction (PO Resp. 49), we construe “transaction.” The ’433 Patent Specification does not define “transaction.” A dictionary sets forth a plain and ordinary meaning of “transaction” as follows: “something, such as a business deal, that is settled or is in the process of being settled.” CHAMBERS 21ST CENTURY DICTIONARY (Mari Robinson & George Davidson eds., 2001), *available at* <http://search.credoreference.com/content/entry/chambdict/transaction/0> (Ex. 3001).

The dictionary definition is consistent with the ’433 Patent Specification. For example, the ’433 Patent Specification describes that “[t]he subscriber may direct the location-based service application running on the platform to transmit credit card or other subscriber information to a selected hotel or other service provider in order to consummate a transaction.” Ex. 1001, 7:53–57.

Upon review, we determine that “receiving a transaction confirmation from the preferred service provider” means “receiving a confirmation of something, such as a business deal, that is settled or is in the process of being settled either directly from or indirectly from the preferred service provider.”

2. “*network-assisted location finding technology*”

The term “network-assisted location finding technology” is recited in claim 2. Patent Owner contends that “network-assisted location finding technology” means “a location finding technology that analyzes signals communicated between network equipment and the mobile device to calculate a location of the mobile device which operates in conjunction with external systems that calculate mobile device location based on signals from external sources.” PO Resp. 7. Patent Owner further contends that “‘network assisted location finding technology’ is not standalone GPS [Global Positioning System] technology.” *Id.* at 7. Petitioner contends that “GPS is a location finding technology,” but does not otherwise provide its own construction. Pet. Reply 3.

The ’433 Patent Specification does not define “network-assisted.” A dictionary sets forth a plain and ordinary meaning of “assist” as follows: “to help.” CHAMBERS 21ST CENTURY DICTIONARY (Mari Robinson & George Davidson eds., 2001), *available at* <http://search.credoreference.com/content/entry/chambdict/assist/0> (Ex. 3002). The dictionary definition of “assist” is useful in ascertaining the way in which one of ordinary skill in the art would use the claim term. *Starhome GmbH v. AT&T Mobility LLC*, 743 F.3d 849, 856–57 (Fed. Cir. 2014). This definition is consistent with the ’433 Patent Specification. Neither party has

pointed to portions of the '433 Patent Specification that use the term “assist” or “assisted” with respect to location finding technology. The '433 Patent Specification uses the term “assist” as an action performed by an emergency dispatcher when responding to a call (Ex. 1001, 1:42–44), and as an outcome of sending the location of a car phone in a stolen car to authorities (*id.* at 1:50–53). The '433 Patent Specification indicates that “location information may be based on an output from any suitable location finding equipment (LFE) or a combination thereof.” Ex. 1001, 2:50–52. The '433 Patent Specification provides examples of LFEs including “network based systems” and “external systems that determine location based on signals from external sources, e.g., Global Positioning System (GPS) signals.” *Id.* at 2:52–59. Additionally, according to the '433 Patent Specification “[s]uch LFE inputs may be used in raw form or, more preferably, may be processed in conjunction with other LFE inputs, mapping information or the like to provide enhanced location information.” *Id.* at 2:59–63.

Patent Owner contends that “the '433 [P]atent [] broadly differentiates between ‘network based systems’ and ‘external systems.’” PO Resp. 7 (citing Ex. 1001, 2:50–59). In reliance on the testimony of Dr. Sandeep Chatterjee, Patent Owner concludes “[t]hus, the '433 [P]atent specification makes clear that ‘network assisted location finding technology’ does not encompass unassisted GPS.” *Id.* at 7–8 (citing Ex. 2002 ¶¶ 73–75). Dr. Chatterjee relies on the portion of the specification noted above for his view. Ex. 2002 ¶¶ 73, 75. For example, Dr. Chatterjee testifies, “the patentee would not have called out this distinction if he had intended for ‘network assisted location finding technology’ to include unassisted GPS signals.” *Id.* ¶ 75.

Patent Owner's contentions and Dr. Chatterjee's testimony, however, are not consistent with the '433 Patent Specification and the claims with respect to the aforementioned claim limitation of "network-assisted location finding technology." In particular, the '433 Patent Specification describes "network based systems" and "external systems." Ex. 1001, 2:52–57 (emphasis added). To the extent that the '433 Patent Specification distinguishes network based systems from external systems, we are unpersuaded that it is relevant to a construction of "network-assisted location finding technology," and in any case, the claims do not recite this distinction.

Upon review, we determine that "network-assisted" means "helped by the network." We determine that "location finding technology" needs no express construction, except that we note that it encompasses the examples of location finding equipment set forth in the specification including cell, microcell, angle of arrival, time of arrival, time delay of arrival, and GPS. *Id.* at 2:52–59.

B. Anticipation by DeLorme

Petitioner contends that claims 1–7 and 12–17 of the '433 Patent are unpatentable as anticipated by DeLorme. Pet. 47–56. In support of this ground, Petitioner presents a Declaration by Mr. James A. Proctor, Jr. (Ex. 1012).

In the Decision to Institute, we determined that Petitioner had shown a reasonable likelihood of prevailing on this proposed ground of unpatentability. Inst. Dec. 15. Additionally, we determined that Petitioner had shown a reasonable likelihood in prevailing on a ground that claim 11 of the '433 Patent is unpatentable as anticipated by DeLorme. *Id.* at 14.

Petitioner requested review of claim 11 based on other grounds. *See, e.g.*, Pet. 23, 42–43. As set forth in our Decision to Institute, we determined that Petitioner had a reasonable likelihood of prevailing on its assertions that DeLorme discloses every limitation claims 1–7 and 11–17 of the '433 Patent. Inst. Dec. 9–15.

To establish anticipation, each and every element in a claim, arranged as is recited in the claim, must be found in a single prior art reference. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001). We evaluate the parties' contentions below.

1. *DeLorme*

DeLorme relates to systems that permit individuals to make travel arrangements via a computer network. Ex. 1008, 1:29–32. In particular, DeLorme describes the Travel Reservation and Information Planning System (“TRIPS”), which is a completely integrated system that enables an individual to locate, select, and schedule travel, so as to execute customized or personalized travel arrangements in association with map displays or other output of travel routes. *Id.* at 1:32–46. Figure 3 is reproduced below.

OBJECT I.D.	e.g. unique random number
TOPICAL DATA	e.g. Names/Activities
GEOGRAPHIC DATA	e.g. Places/Routes
TEMPORAL DATA	e.g. Date/Times
ACCOUNTING DATA	e.g. Transactions

FIG 3

Figure 3 illustrates a representation of the TRIPS data structure.

The simplified standard TRIPS data structure illustrated in Figure 3 is used to build TRIPS databases and TRIPS data objects. *Id.* at 32:1–3. Electronic communications among TRIPS devices are performed by constructing data packets conforming to the standard illustrated in Figure 3. *Id.* at 32:3–7. The TRIPS data structure includes a unique random object identifier, topical data such as activities, things-to-do, organizations, products, goods, services, and other content related to travel, geographic data, temporal data such as dates and times, and accounting data, such as user identity and membership information. *Id.* at 32:31–40, 34:26–30, Fig. 3. Enrolled or registered TRIPS users input individual profiles, which include preferences or personal travel planning operational parameters that are global settings for individual travel planning sessions. *Id.* at 61:10–16. For example, TRIPS users select one or more participating providers within an Accounting Subsystem table, such as a favorite airline or chain of hotels. *Id.* at 71:39–50.

According to one embodiment of TRIPS, mobile users at remote locations may access TRIPS using a wireless communication unit (“WCU”), which is typically a handheld device or is mounted or used in a vehicle. *Id.* at 71:61–72:2. The portable mobile device or WCU preferably includes a position sensor unit, such as a Global Positioning System (GPS) sensor and transmitter (*id.* at 2:8–11) and user input and output capability (*id.* at 72:2–15). Exemplary WCUs include notebooks, laptop personal computers, personal digital assistants, and smart cellular phones. *Id.* at 75:33–45.

Figure 9B is reproduced below.

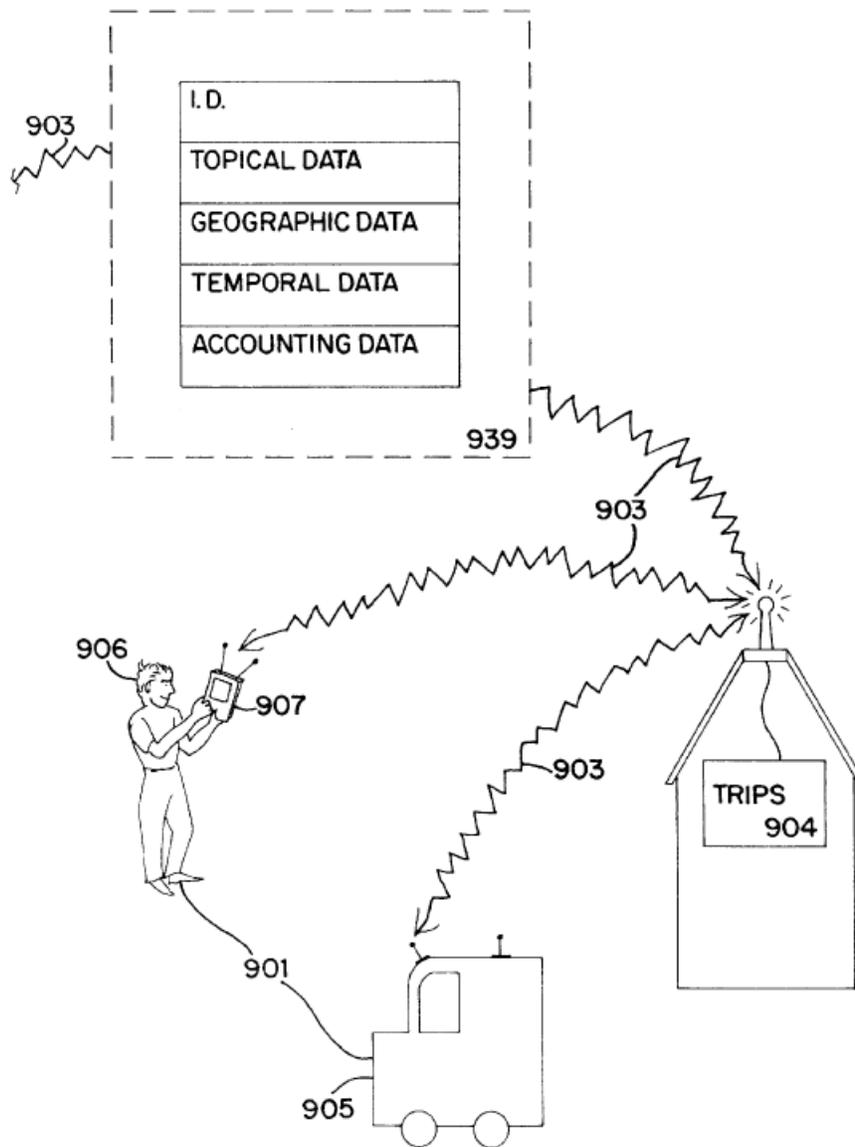


FIG 9B

Figure 9 illustrates automated travel information processing of inquiries from users equipped with wireless communication units and GPS.

Figure 9 illustrates two-way wireless communications between WCU 907 and TRIPS database 904. *Id.* at 73:50–52. Two-way wireless

communications involves TRIPS data packets formatted in accordance with the standard discussed above with respect to Figure 3. *Id.* at 73:20–22.

TRIPS users can use portable TRIPS in conjunction with TRIPS travel plans prepared in advance of travel. *Id.* at 72:23–26. Alternatively, TRIPS users can call to obtain assistance en route, which does not require a previously arranged travel plan. *Id.* at 72:63–67.

2. *Independent Claim 1*

We have reviewed Petitioner’s contentions and supporting evidence, including the Declaration of Mr. Proctor (Ex. 1012 ¶¶ 104–29), which read all elements of claim 1 of the ’433 Patent onto the disclosure of DeLorme. Pet. 47–56. For instance, regarding the first element of claim 1, which requires storing subscriber profile information, Petitioner points to (Pet. 49) the following description: “[e]nrolled or registered TRIPS retail consumers can input individual profiles, preferences or personal travel planning operational parameters.” Ex. 1008, 61:10–16. As Petitioner notes (Pet. 50), in reliance on the testimony of Mr. Proctor (Ex. 1012 ¶ 110), these profiles include global settings that avoid repetitive entry of routine information including preferences such as nonsmoking, preferred transportation modes or accommodation providers, and topical interests such as favorite foods. Ex. 1008, 61:10–26.

Regarding the next three elements of claim 1, which require receiving a service request from the mobile unit, obtaining the mobile unit’s location, and identifying candidate service providers and associated service provider information, Petitioner relies on DeLorme’s description of processing TRIPS service requests received from a wireless communication unit. *See* Pet. 49–50. For instance, in accordance with the portable embodiment of TRIPS

cited by Petitioner (Pet. 49–50), DeLorme discloses a mobile sending a “specific request” to TRIPS “in conjunction with GPS 908 data on the current location” of the mobile (Ex. 1008, 77:36–38). The request and GPS data are used to “search[] the TRIPS database for restaurants located in the vicinity of . . . the remote TRIPS user.” *Id.* at 77:40–42.

Patent Owner does not dispute Petitioner’s contentions regarding the first four elements of claim 1, except that Patent Owner contends the subscriber profile is not used to narrow search results. Patent Owner’s contention in that regard relates more to a subsequent limitation that is discussed below.

Regarding the next two elements of claim 1, which require selecting, on the network platform, a subset of the candidate service providers based on the subscriber profile and outputting the subset to the mobile, Petitioner relies on the overall TRIPS system, including the TRIPS database and data structure, as well as the mobile embodiments described with respect to Figures 9A and 9B. Pet. 47, 48, 50 (citing Ex. 1008, Abstract, 7:66–8:9, 8:5, 8:23–30, 17:41–43, 32:1–7, 61:10–26, 71:1–78:21, Figs. 3, 9A, 9B). Petitioner also relies on the testimony of Mr. Proctor. Pet. 47, 48, 50 (citing Ex. 1012 ¶¶ 111–123, 126–129). Mr. Proctor testifies “[w]hen a user, including a mobile user, searches for nearby services, DeLorme teaches using that user’s preferences to send search results.” Ex. 1012 ¶ 126 (citing Ex. 1008, 61:10–26, 17:41–42, 71:41–44, 71:46–50, 26:24–28, 77:48–50).

One of Petitioner’s contentions is that DeLorme describes “a subset of the plurality of candidate service providers,” as recited in claim 1, as follows: “DeLorme’s mobile embodiment discloses that ‘[i]nformation on two or more restaurants can be presented to . . . the TRIPS user.’” Pet. 50

(citing Ex. 1008, 77:48–50). Patent Owner refers to text omitted by Petitioner, i.e., that the information can be “presented to *and/or selected by*” the user. PO Resp. 14 (citing Ex. 1008, 77:48–49 (emphasis added)). Patent Owner contends that this selection is made entirely on the mobile unit, and not on the network platform, as required by the claim. *Id.* at 15. Contrary to Patent Owner’s contention, Petitioner does not rely on “selected by” in the above-referenced disclosure for the recited “selecting, on the network platform, a subset of the plurality of candidate service providers,” as indicated by the omission of “selected by” from Petitioner’s contention. Indeed, we find that the “selected by” in the portion of DeLorme noted above occurs after the subset is formed.

Regarding “selecting, on the network platform, a subset of the plurality of candidate service providers,” as recited in claim 1, as Petitioner notes (Pet. 47), DeLorme describes that the TRIPS system includes a database (Ex. 1001, 8:23–30), i.e., a network platform. As Petitioner further notes (Pet. 47–48), the database employs a standard TRIPS data structure (*id.* at 32:1–7), which is searched by a primary key or other criteria (*id.* at 71:33–34). More particularly, as Mr. Proctor testifies (Ex. 1012 ¶ 126), DeLorme describes that “TRIPS users can arrange ‘filters’ or sorting operations that limit subsequent map tickets or presentations of TRIPS offerings” and “setting up filters . . . will concentrate her selection . . . on specified providers such as her favorite airline or chain of hotels.” Ex. 1008, 71:41–50. As Petitioner further notes in its Reply (Pet. Reply 11–12), the TRIPS database performs “state-of-the-art text searches and associations” or uses other “data matching technologies.” Ex. 1008, 56:36–42; *see also id.* at 67:6–11 (“matching reservations, tickets, and other special offers found in

the GOODS/SERVICES & PROVIDERS LIST 809 in FIG. 8A with topical, temporal, geographic and transactional ‘filters’ or relational database criteria as imposed over the course of the sequential component operations”).

Accordingly, we determine that Petitioner has made a sufficient showing that selecting is done on the network platform.

Patent Owner, additionally, contends that DeLorme’s mobile embodiments make no reference to using “subscriber profile information,” and that Petitioner’s reference to desktop embodiments in that regard is of no help, because Petitioner does not connect adequately the desktop embodiments to the mobile embodiments. PO Resp. 15. We disagree.

Petitioner relies on the testimony of Mr. Proctor, who testifies that subscriber profile information is used by mobile embodiments. Pet. 47, 48, 50 (citing Ex. 1012 ¶¶ 111–123, 126–129). Mr. Proctor testifies that DeLorme describes a “coordinated mobile embodiment,” which allows mobile users to pick up a session started on a desktop and an “on-the-go mobile embodiment,” which allows a mobile user to start and complete a travel session on the mobile device. Ex. 1012 ¶¶ 113, 114. Mr. Proctor’s testimony is consistent with the disclosure of DeLorme, which explains, “Fig. 9 illustrates portable TRIPS embodiments, which can function either with or without [r]elation to desktop TRIPS user setups as described heretofore with reference to FIG. 1A.” Ex. 1008, 72:20–23. Mr. Proctor also testifies “[i]n my opinion, a person of ordinary skill in the art would have understood that all the TRIPS functionality and options discussed before Fig. 9 would have still been available to the mobile users described in connection with Fig. 9.” Ex. 1012 ¶ 116. We again credit the testimony of Mr. Proctor as being consistent with the disclosure of DeLorme. DeLorme

further specifies that “FIG. 9 [portable] TRIPS embodiments also enable responsive previews or presentations . . . the capabilities for such previews or presentations are further detailed heretofore, particularly with reference to FIGS. 5, 6, 7, and 8 [illustrating filtering to concentrate a selection on a favorite airline or chain of hotels].” Ex. 1008, 77:1–14. As Petitioner further notes (Pet. Reply 10), DeLorme discloses by “identifying the individual remote user whose WCU 907 is sending a given transmission, the TRIPS service provider 904 can access the individual user account, *user profile* and ‘pre-filed’ travel plan output (if any).” Ex. 1008, 74:45–56 (emphasis added).

In reliance on the testimony of Dr. Chatterjee, Patent Owner contends that many functions described in connection with desktop embodiments were not possible to implement with DeLorme’s mobile embodiments. PO Resp. 12 (citing Ex. 2002 ¶¶ 40–42, 46–58). Patent Owner identifies one example mentioned in DeLorme, i.e., that DeLorme states that the mobile embodiment includes simplified input queries. *Id.* at 13. DeLorme describes that a mobile user can provide input with a “push-button” or indicating “yes” or “no” with voice recognition software. Ex. 1008, 77:53–55. Patent Owner, however, does not explain persuasively how this relates to selecting, on the network platform, a subset of the candidate service providers based on the subscriber profile, as recited in claim 1.

Regarding Dr. Chatterjee’s testimony, Dr. Chatterjee acknowledges that some amount of TRIPS functionality would be available via mobile devices. Ex. 2002 ¶ 48. Dr. Chatterjee, however, is vague with respect to his opinion of which functionalities would be too difficult to implement. *See e.g., id.* ¶¶ 48, 52, 53, 58. Dr. Chatterjee testifies regarding significant

challenges, but does not tie these challenges persuasively to his opinion that DeLorme's disclosure is inadequate. For example, Dr. Chatterjee testifies that "although distributed computing was known at the relevant time, distributed computing technologies at that time, e.g., the Common Object Request Broker Architecture (CORBA) and Microsoft's Distributed Component Object Model (DCOM), were difficult to deploy." *Id.* ¶¶ 50, 51 (citing Ex. 2014, 14; Ex. 2016, 10). Dr. Chatterjee, however, does not testify persuasively regarding (1) how CORBA and DCOM relate to the elements recited in claim 1 of the '433 Patent, or (2) how the challenges with implementing CORBA and DCOM undermine the explicit disclosure in DeLorme of TRIPS using stored preferences to narrow search results.

Patent Owner's contentions regarding "outputting information regarding the subset of candidate service providers to the mobile unit" (PO Resp. 19–25) are similar to those discussed above. Patent Owner's contentions again are based on excerpts of DeLorme discussed individually, without regard to other disclosures in DeLorme. Patent Owner does not take into account sufficiently the testimony of Mr. Proctor (Ex. 1012 ¶¶ 111–123, 126–129) regarding the disclosure in DeLorme that connects embodiments of the TRIPS system, including using a profile or an individual's preferences with mobile embodiments. For the reasons discussed above, we are persuaded that DeLorme discloses "outputting information regarding the subset of the plurality of candidate service providers to the mobile unit."

Regarding the remaining elements of claim 1, which require receiving a selection of a preferred service provider from the mobile, initiating a transaction between the subscriber and the preferred service provider, and receiving a transaction confirmation from the preferred service provider,

Petitioner relies on DeLorme's disclosure of a mobile user making a reservation, as well as other portions of DeLorme describing selecting a provider and making a reservation. Pet. 51–53 (citing Ex. 1008, 50:27–39, 50:42–53, 77:48–78:1, 78:17–21, Fig. 5; Ex. 1012 ¶ 129). Patent Owner does not provide contentions regarding these elements.

For the reasons given, we are persuaded that Petitioner has established by a preponderance of the evidence that independent claim 1 is unpatentable as anticipated by DeLorme.

3. *Independent Claim 15*

Independent claim 15 is similar to independent claim 1, except claim 15 recites, “selecting, on the network platform, one or more of the plurality of candidate service providers based on a comparison between the service provider information and the subscriber profile information.” Petitioner cites to DeLorme's reference to “database operations” as disclosing this claim limitation. Pet. 51 (citing Ex. 1008, 53:38–44); *see also* Pet. Reply 11–12 (citing Ex. 1008, 30:1–11, 44:32–38, 53:38–44, 56:36–49, Fig. 7, 59:4–10, 67:6–11, 68:63–69:3; Ex. 1012 ¶¶ 128, 129). The database operations include searching, ranking, filtering, sorting, and/or user selection as sequentially arranged by the user. Ex. 1008, 53:38–44. DeLorme further specifies the TRIPS database performs these operations by “matching” provider information with filters or relational database criteria. *Id.* at 67:6–11; *see also id.* at 56:36–49 (describing “state-of-the-art text searches and associations and other ‘fuzzy’ database search or data matching technologies”).

Patent Owner contends that DeLorme does not disclose comparing the user's preferences to the providers in the TRIPS database. PO Resp. 18.

Upon review of Petitioner's contentions and evidence, including disclosure of matching technologies discussed above, we are persuaded that DeLorme describes comparing user preferences with service provider information in the TRIPS database. Accordingly, we are persuaded that Petitioner has established by a preponderance of the evidence that independent claim 15 is unpatentable as anticipated by DeLorme.

4. *Dependent Claims 2–7, 11–14, 16, and 17*

We have reviewed the evidence and arguments submitted by Petitioner in its Petition, as well as the contentions and evidence set forth by Patent Owner in its Patent Owner Response. Pet. 53–56; PO Resp. 25–31. The evidence includes element-by-element analysis on pages 53–56 of the Petition and the Declaration by Mr. Proctor (Ex. 1012). We are persuaded that Petitioner has established by a preponderance of the evidence that each of claims 2–7, 11–14, 16, and 17 is unpatentable as anticipated by DeLorme.

For instance, Petitioner has shown sufficiently that DeLorme discloses “wherein the location information is determined using a network-assisted location finding technology,” as recited in claim 2. As discussed above, we determine that “network-assisted” means “helped by the network.” We also determine that “location finding technology” needs no express construction except that we note that it encompasses the examples of location finding equipment set forth in the specification including cell, microcell, angle of arrival, time of arrival, time delay of arrival, and GPS. *Id.* at 2:52–59. As Petitioner notes (Pet. 53–54), DeLorme discloses a WCU that includes “an attached or built-in global positioning satellite position sensor, or equivalent user location means.” Ex. 1008, 75:46–48; *see also* Pet. 48 (citing Ex. 1008, 71:1–78:21, Fig. 9).

Patent Owner contends that DeLorme fails to anticipate claim 2 because DeLorme discloses only one type of location finding technology—GPS. PO Resp. 25. Patent Owner’s contentions (*id.* at 25–26) are based on Patent Owner’s construction, which we did not adopt for the reasons discussed above. As noted with respect to claim construction, GPS is one of the examples of location finding equipment set forth in the ’433 Patent Specification. Ex. 1001, 2:52–59. Additionally, Petitioner has shown sufficiently that DeLorme discloses that the GPS sensor is not a stand-alone part, but is part of and assisted by the WCU (Ex. 1008, 75:46–48) and also is assisted or helped by the overall TRIPS system (*id.* at Figs. 9A, 9B).⁵

As an additional example, Petitioner has shown sufficiently that DeLorme discloses “wherein the plurality of candidate service providers are mobile service providers,” as further recited in claim 7. As discussed above, we construe “mobile service providers” as encompassing taxis. DeLorme describes candidate service providers that are mobile, including taxis. Ex. 1008, 21:40–47.

As a further example, Petitioner has shown sufficiently that DeLorme discloses “wherein the information regarding the subscriber comprises financial information” and “wherein the financial information comprises at least one of a credit card number and an expiration date, a bank account number, or corporate account information,” as recited in claims 11 and 12, respectively. Petitioner points to DeLorme’s disclosure of TRIPS storing a

⁵ Petitioner further notes (Pet. Reply 13) that DeLorme discloses hybrid location systems. Ex. 1008, 10:34–39.

user's credit card number in their account. Pet. 55 (citing Ex. 1008, 37:10–14).

As noted in our Decision to Institute, we instituted review on claim 11 on the ground that it is anticipated by DeLorme, because we determined that Petitioner had shown sufficiently that DeLorme discloses credit card information, which is a more specific form of “financial information” recited in claim 11. Inst. Dec. 14. Patent Owner contends that institution of *inter partes* review of claim 11 was improper because Petitioner does not request review of claim 11 in connection with DeLorme. PO Resp. 26. Petitioner, however, requested review of claim 11 based on other grounds. *See, e.g.*, Pet. 23, 42–43. Petitioner also requested review of claim 12, which depends from claim 11, on the ground that claim 12 is anticipated by DeLorme. By virtue of its dependency on claim 11, claim 12 requires the further limitation recited in claim 11. As noted in our Decision to Institute (Inst. Dec. 14), Petitioner showed, in the Petition, a reasonable likelihood that DeLorme discloses the limitations of both claims 11 and 12. Pet. 55 (citing Ex. 1008, 37:10–14).

Patent Owner had the opportunity to respond to Petitioner's contentions regarding claim 12 in the Petition and had notice that *inter partes* review was instituted with respect to both claims 11 and 12 on the ground that they are anticipated by DeLorme (Inst. Dec. 24). The Board's authority at the final decision stage is not limited to the grounds alleged in the Petition. *Cuozzo*, 793 F.3d at 1273. The Board is authorized to issue “a final written decision with respect to the patentability of any patent claim challenged by the petitioner and any new claim added under section 316(d).”

35 U.S.C. § 318(a). In this case, we determine that to hold to the contrary would exalt form over substance at the expense of common sense.

Patent Owner also contends that institution was improper because DeLorme does not disclose that the stored credit card number is transmitted to a preferred service provider. PO Resp. 27. Mr. Proctor, however, testifies that the TRIPS software has a transaction subsystem that lets users buy tickets and services using their credit cards or financial data. Ex. 1012 ¶ 109 (citing Ex. 1008, 8:49–54). We credit his testimony as consistent with the disclosure of DeLorme. Petitioner points to additional disclosure in DeLorme of sending credit or payments arrangements to preferred service providers. Pet. Reply 15 (citing Ex. 1008, 12:6–10). Upon review of Petitioner’s contentions and evidence, we determine that DeLorme discloses “wherein the information regarding the subscriber comprises financial information,” as recited in claim 11.

Patent Owner also contends that DeLorme does not disclose the further recitation of claim 12, which requires that the financial information include both a credit card number and an expiration date. PO Resp. 29–30. Claim 12, however, recites “at least one of a credit card number and an expiration date, a bank account number, or *corporate account information*” (emphasis added). As Petitioner notes (Pet. 50), DeLorme discloses that a corporate client engaging a TRIPS online site to plan and arrange its employees’ business trips can implement corporate policies and information in TRIPS. Ex. 1008, 61:16–21. DeLorme describes that the information input into the user profile, such as the credit card number, is personal or business data. *Id.* at 37:10–14. We, therefore, determine that Petitioner has

shown sufficiently that DeLorme discloses as least “corporate account information,” as recited in claim 12.

Patent Owner does not provide contentions specific to claims 3–7, 13, 14, 16, or 17 and, instead, relies on its contentions provided for the independent claims. PO Resp. 32. In light of the arguments and evidence submitted, Petitioner has established by a preponderance of the evidence that each of claims 2–7, 11–14, 16, and 17 is unpatentable as anticipated by DeLorme.

C. Legal Standard of Obviousness

A patent claim is unpatentable if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. 35 U.S.C. § 103(a). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art;⁶ and (4) objective evidence of nonobviousness, i.e., secondary considerations. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). In an obviousness analysis, inferences and creative steps that a person of ordinary skill in the art would employ can be taken into account. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

⁶ Petitioner’s declarant proposes a definition for a person of ordinary skill in the art. Ex. 1012, 55:14–56:3. Patent Owner does not dispute Petitioner’s declarant’s proposed definition. Ex. 2002 ¶¶ 21–23. To the extent necessary, we adopt Petitioner’s definition.

D. Asserted Obviousness over DeLorme and Trask

Petitioner contends that claims 7–10 are unpatentable as obvious over the combination of DeLorme and Trask. Pet. 25–31. In the Decision to Institute, we determined that Petitioner had shown a reasonable likelihood of prevailing on this proposed ground of unpatentability. Inst. Dec. 15. In particular, we determined that Petitioner had a reasonable likelihood of prevailing on its assertions that the combined teachings of DeLorme and Trask teach every limitation of claims 7–10 of the '433 Patent. *Id.* at 15–17. We also found reasonable Petitioner's asserted rationale that a person of ordinary skill in the art would have combined the teachings of DeLorme and Trask to maximize available taxis and minimize delays by accounting for the location of the taxi. *Id.* at 16 (citing Pet. 56–57; Ex. 1012 ¶¶ 181–185).

1. Trask

Trask teaches a dispatcher free vehicle allocation (“DFVA”) system, which automatically recommends which of a plurality of vehicles can respond most quickly to an event. Ex. 1007, 2:21–25.

2. Dependent Claims 7–10

Patent Owner contends that Petitioner provides no valid reason to combine DeLorme and Trask. PO Resp. 51. Petitioner, in reliance on the testimony of Mr. Proctor, asserts that a person of ordinary skill would have found it obvious to combine DeLorme's system of taxi service providers and Trask, because Trask enhances DeLorme's system to maximize available taxis and minimize delays by accounting for the location of the taxi. Pet. 56–57 (citing Ex. 1012 ¶¶ 181–184). In the Decision to Institute, we credited Mr. Proctor's statements, as they are consistent with the teachings of DeLorme and Trask. Inst. Dec. 21. For example, Trask teaches tracking

the present position of taxis (Ex. 1007, 2:25–30) and comparing the locations of vehicles with customer requests to determine the most appropriate vehicle to dispatch (*id.* at 2:31–42).

Patent Owner, in reliance on the testimony of Dr. Chatterjee, contends that we should not have credited Mr. Proctor’s testimony, because he testifies that DeLorme teaches a taxi service, which is incorrect and is not supported by the teachings of DeLorme. PO Resp. 52 (citing Ex. 2002 ¶¶ 76–84). Patent Owner further contends “[w]ith no dispatched taxis in DeLorme, there would be no reason to incorporate Trask’s alleged benefits into DeLorme’s reservation system.” *Id.* at 53 (citing Ex. 2002 ¶¶ 85–87). Dr. Chatterjee acknowledges that DeLorme refers to taxis, but testifies that “[t]he fact that taxi coupons are made available in DeLorme’s system would not provide a person of ordinary skill in the art a reason to drastically modify DeLorme by incorporating an entirely new taxi dispatch system into TRIPS.” Ex. 2002 ¶ 87.

We credit the testimony of Mr. Proctor as being consistent with the teachings of DeLorme and Trask. For example, DeLorme lists exemplary providers of goods and services that can participate in TRIPS including “hotels, banks, campgrounds, retail stores, hairdressers, gas stations, restaurants, *taxis* . . . among many others.” Ex. 1008, 21:44–48 (emphasis added). Dr. Chatterjee’s testimony is conclusory and does not disclose facts or data supporting that modification of DeLorme would be “drastic” (Ex. 2002 ¶ 87). *See* 37 C.F.R. § 42.65(a).

Patent Owner, in reliance on the testimony of Dr. Chatterjee, also contends that one of ordinary skill in the art would have lacked the technical skills to combine DeLorme and Trask. PO Resp. 54 (citing Ex. 2002 ¶¶ 88–

99). Dr. Chatterjee testifies that a person of ordinary skill in the art had narrowly-focused experiences and would have needed to take instruction regarding the creative piece. Ex. 2002 ¶ 90. Dr. Chatterjee also testifies that it would have been a significant challenge for a person of ordinary skill in the art to extend DeLorme's environment into the Trask environment. *Id.*

Petitioner, in reliance on the testimony of Mr. Proctor, asserts that one of ordinary skill would have a reasonable expectation of success in incorporating Trask's teachings of mobile service providers equipped with GPS technology into DeLorme's mobile TRIPS system. Pet. 57 (citing Ex. 1012 ¶¶ 181–185). Additionally, Mr. Proctor testifies that DeLorme already uses the location of service providers to provide a list of results to the user, and also recognizes that in the case of taxis, the service provider itself may be mobile, so a person of ordinary skill in the art would have had a high expectation of success in adding Trask's taxi allocation system to DeLorme's TRIPS system. Ex. 1012 ¶¶ 182, 183.

Trask further supports Mr. Proctor's testimony. For example, Trask teaches obtaining mobile service provider location information using the same technology as described for use by mobile devices in DeLorme. *Compare* Ex. 1007, 5:55–65 (“Each of the plurality of taxis [] is equipped with a position determining system . . . [such as] a GPS based system (Global Positioning Satellite).”), *with* Ex. 1008, 2:9–11 (“[R]emote devices may include Global Positioning System (GPS) sensors and/or transmitters.”).

Dr. Chatterjee's testimony regarding the narrowly-focused experiences of a person of ordinary skill in the art is based on a mischaracterization of Mr. Proctor's deposition testimony (Ex. 2002 ¶ 90

(citing Ex. 2003, 26:23–30:5)). Mr. Proctor testifies regarding his job duties at Harris Corporation (*id.* at 26:23–28:19) and he responds to a question suggesting that the type of work he did wasn't common for recent graduates employed by Harris Corporation (*id.* at 28:20–22). Contrary to Dr. Chatterjee's characterization, Mr. Proctor's cited testimony is not responsive to questions regarding the level of skill in the art, but instead his own personal experiences. Additionally, he testifies that as a new graduate, he "had a great experience" (Ex. 2003, 26:25) in part because he was given a "research job" (*id.* at 29:7). We are not persuaded that Mr. Proctor's testimony supports that one of ordinary skill in the art, having a Bachelor of Science Degree in Electrical/Computer Engineering or Computer Science plus relevant academic or professional experience, would have been able to only follow instructions, as Dr. Chatterjee testifies (Ex. 2002 ¶¶ 21, 90). A person of ordinary skill is a person of ordinary creativity, not an automaton. *KSR Int'l Co.*, 550 U.S. at 421.

Additionally, Dr. Chatterjee's testimony that it would have been a significant challenge for a person of ordinary skill in the art to extend DeLorme's environment into the Trask environment (Ex. 2002 ¶ 90) is unpersuasive, because it is based in part on his conclusory statement that the person of ordinary skill in the art would have needed experience in three "disparate areas of technology" (*id.*). Also, similar to his testimony regarding anticipation, Dr. Chatterjee relies for this conclusion on the same documents describing CORBA and DCOM, without relating them persuasively to the asserted prior art or claims (*id.* at 98).

We further note Patent Owner's more general contentions that Petitioner fails to establish the level of ordinary skill in the art in support of

its combinations of teachings of the applied references. *See, e.g.*, PO Resp. 34–39. As the Federal Circuit has explained,

While it is always preferable for the factfinder below to specify the level of skill it has found to apply to the invention at issue, the absence of specific findings on the level of skill in the art does not give rise to reversible error “where the prior art itself reflects an appropriate level and a need for testimony is not shown.”

Okajima v. Bourdeau, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (finding that the Board was not required to set forth express findings as to level of skill in art and quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163–64 (Fed. Cir. 1985)). Here, we are persuaded that the prior art adequately reflects an appropriate level of skill. Additionally, Mr. Proctor proposes a definition for a person of ordinary skill in the art—a person with an engineering degree, either computer science or electrical engineering, and around two years of experience working in the wireless communications industry. Ex. 2003, 55:14–56:3. Patent Owner does not dispute Mr. Proctor’s proposed definition. Ex. 2002 ¶¶ 21–23. We agree that this definition is reasonable.

Patent Owner does not provide contentions specific to the further limitations recited in claims 8–10. PO Resp. 50–55. We also have reviewed the evidence and arguments submitted by Petitioner regarding claims 8–10 in its Petition, including the element-by-element claim analysis on pages 58 through 60 of the Petition. Each of claims 8–10 depends directly from claim 7. As discussed above, Petitioner has established by a preponderance of the evidence that claim 7 is anticipated by DeLorme. Petitioner also has shown sufficiently that Trask teaches the further limitations of claims 8 through 10.

Pet. 58–60 (citing Ex. 1007, 2:24–30, 4:28–30, 5:10–16, 5:39–65, 7:52–67, 8:1–4, 8:25–29, 8:49–61, Fig. 1).

In light of the arguments and evidence submitted, we are persuaded that Petitioner has established by a preponderance of the evidence that claims 7–10 are unpatentable as obvious over the combination of DeLorme and Trask.

E. Asserted Obviousness of Claims 1–6 and 11–16 Over Baker and Hall and Asserted Obviousness of Claims 7–10 Over Baker, Hall, and Trask

Petitioner contends that claims 1–6 and 11–16 of the '433 Patent are unpatentable as obvious over the combination of Baker and Hall, and that dependent claims 7–10 are unpatentable as obvious over the combination of Baker, Hall, and Trask. Pet. 31–47. In the Decision to Institute, we determined that Petitioner had shown a reasonable likelihood of prevailing on both of these proposed grounds of unpatentability. Inst. Dec. 17, 23. In particular, we determined that Petitioner had a reasonable likelihood of prevailing on its assertions that the combined teachings of Baker and Hall teach every limitation of claims 1–6 and 11–16 of the '433 Patent. *Id.* at 17–22. We also determined that Petitioner had a reasonable likelihood of prevailing on its assertions that the combined teachings of Baker, Hall, and Trask teach every limitation of claims 7–10 of the '433 Patent. *Id.* at 22–23.

Additionally, we found reasonable Petitioner's asserted rationale that a person of ordinary skill in the art would have combined the teachings of Baker and Hall to incorporate Hall's method for securing credit card payment into Baker's teaching of an interface to transmit credit card numbers to secure payment. *Id.* at 21 (citing Pet. 34; Ex. 1012 ¶¶ 159, 162). Furthermore, we found reasonable Petitioner's asserted rationale that a

person of ordinary skill in the art would have combined the teachings of Baker and Hall with Trask to maximize available taxis and minimize delays by accounting for the location of the taxi. *Id.* at 23 (citing Pet. 44; Ex. 1012 ¶¶ 168–175).

1. *Baker*⁷

Baker teaches deriving a subscriber's location and constructing a set of coupons or advertisements based on that location, for that subscriber. Ex. 1009, Abstract. The subscriber's location is compared to retailer records stored in a retailer database. *Id.* at 2:22–24. The process then sends messages with coupons or advertisements to the subscriber for each retailer or advertiser listed for that particular location. *Id.* at 2:25–27. The database additionally contains subscriber profiles that further filter the types of coupons or advertisements generated. *Id.* at 7:62–8:3.

2. *Hall*

Hall teaches enabling service providers to receive an order from a mobile customer, receive customer location information, and schedule the completion of the customer's order to coincide with the customer's arrival at a local facility. Ex. 1011, Abstract. Hall also teaches a financial agent that performs financial transactions on behalf of a customer by communicating with financial institutions in which customers have accounts and instructing the institution to transfer payment. *Id.* at 7:30–35.

⁷ For ease of reference in our analysis, we cite to Baker, but omit parallel citations to the Baker Provisional. Regarding Petitioner's contentions, however, we have reviewed Petitioner's citations to Baker and confirmed that the evidence that we rely on also is found in the Baker Provisional for all of the claims challenged on the grounds of obviousness involving Baker.

3. *Independent Claims 1 and 15*

In its responsive brief, Patent Owner contends that the combination of Baker and Hall fails to teach “receiving a transaction confirmation from the preferred service provider,” as recited in each of claims 1 and 15. PO Resp. 48. Patent Owner does not address any other limitations of claims 1 and 15. Patent Owner, however, also contends that Baker and Hall are not properly combinable. PO Resp. 40.

We turn to Patent Owner’s contentions relating to receiving a transaction confirmation from the preferred service provider, as recited in claim 1. As noted by Petitioner (Pet. 40–41), Hall teaches receiving an order from a mobile customer (Ex. 1011, Abstract), contacting the local facility selected, instructing it to prepare the order (*id.* at 9:57–9:60), and confirming the transaction via financial agent software that communicates, on behalf of the customer, with financial institutions and service provider agent software (*id.* at 7:29–38). Furthermore, Hall teaches “receiv[ing] order confirmation information from the service provider” (*id.* at 15:2–5).

Patent Owner contends that Hall’s teaching “receiv[ing] order confirmation information from the service provider” (*id.* at 15:2–5) is deficient because Hall does not reference a transaction. PO Resp. 49–50. For the reasons discussed above with respect to claim construction, we determine that “receiving a transaction confirmation from the preferred service provider” means “receiving a confirmation of something, such as a business deal, that is settled or is in the process of being settled either directly from or indirectly from the preferred service provider.” We determine that an “order” is an example of a something, such as a business deal, that is settled or is in the process of being settled. Furthermore, we

determine that Hall's teachings regarding financial agent software corresponds properly to "receiving a transaction confirmation from the preferred service provider," as recited in claims 1 and 15.

We also have reviewed the evidence and arguments submitted by Petitioner in its Petition, including the element-by-element analysis on pages 35–44 of the Petition and the Declaration by Mr. Proctor (Ex. 1012), regarding other limitations recited in claims 1 and 15. We are persuaded that Petitioner has shown sufficiently that each of the other limitations of independent claims 1 and 15 is taught by the combination of Baker and Hall.

Patent Owner also contends that Baker and Hall are not properly combinable based on Dr. Chatterjee's testimony that a person of ordinary skill in the art would have been narrowly-focused. PO Resp. 40 (citing Ex. 2002 ¶¶ 63–66, 67–69, 108–116). Our analysis above relating to Dr. Chatterjee's similar testimony regarding DeLorme and Trask applies to this ground as well.

Patent Owner additionally asserts that Baker and Hall are directed to very different problems. PO Resp. 41 (citing Ex. 2002 ¶¶ 63–69, 100–107). Patent Owner relies on the testimony of Dr. Chatterjee, who testifies that "Baker relates to a system designed to deliver advertising to mobile devices using SMS messages," whereas "Hall does not use text messages and it does not relate to advertising in any way." Ex. 2002 ¶¶ 100, 101. Both Baker and Hall teach transmitting information to a customer wirelessly. *See* Ex. 1009, 2:8–10 ("The subscribers can be radiotelephone users, pager users, two-way radio users, or users of other forms of wireless communication."); *see also* Ex. 1011, 5:49–57, Fig. 1 ("MCPE [mobile customer premises equipment] 105 may be implemented, using a variety of devices such as cellular phone, .

. . . a personal digital assistant (“PDA”), . . . an ordinary cellular telephone and a home or laptop personal computer.”) Additionally, contrary to Dr. Chatterjee’s testimony, Hall teaches using information stored in its customer database to market products or services to a customer that are similar to those previously ordered. Ex. 1011, 9:13–18. Dr. Chatterjee’s testimony is not credible because it is not supported sufficiently by objective evidence.

Patent Owner further asserts that Mr. Proctor’s deposition testimony establishes that he improperly relied on hindsight bias and his declaration is not sufficient to establish obviousness. PO Resp. 41–47. Mr. Proctor testified that a person of ordinary skill in the art would have combined Baker and Hall in various ways depending on their objectives. Ex. 2003, 161:10–162:13. Patent Owner points to a question posed by its counsel asking **“[a]nd this example that you just gave me—is how you would combine their teachings if your objective were to create something like the ’433 patent; is that right?”** PO Resp. 43–44 (citing Ex. 164:4–12). We disagree that Mr. Proctor’s testimony in the affirmative to this question is an admission that he used hindsight bias, because Patent Owner’s contentions rely on incorrect characterizations of Mr. Proctor’s testimony. Patent Owner additionally alleges that Mr. Proctor belatedly identified the level of skill in the art (PO Resp. 47), which is not persuasive for the same reasons discussed with respect to DeLorme and Trask. We credit the testimony of Mr. Proctor regarding the combination of Baker and Hall as consistent with the teachings of these references.

In light of the arguments and evidence submitted, Petitioner has established by a preponderance of the evidence that each of claims 1 and 15 is unpatentable as obvious over the combination of Baker and Hall.

4. *Dependent Claims 2–6, 11–14, and 16*

Patent Owner does not argue separately the limitations added by these claims. We have reviewed the evidence and arguments submitted by Petitioner in its Petition including the element-by-element analysis on pages 41–43 of the Petition and the Declaration by Mr. Proctor (Ex. 1012). Petitioner has shown sufficiently that the combination of Baker and Hall teaches each of the limitations of claims 2–6, 11–14, and 16. Accordingly, we are persuaded that Petitioner has established by a preponderance of the evidence that each of claims 2–6, 11–14, and 16 is unpatentable as obvious over Baker and Hall.

5. *Dependent Claims 7–10*

Patent Owner does not argue separately these grounds, except to argue that Trask is not properly combinable with the combination of Baker and Hall. PO Resp. 55–60. Patent Owner’s arguments are similar to those discussed above with respect to the combination of DeLorme and Trask as well as the combination of Baker and Hall. Our analysis above pertains to Patent Owner’s contentions regarding Baker, Hall, and Trask. Additionally, again, we credit Mr. Proctor’s testimony as consistent with the asserted prior art.

We also have reviewed the evidence and arguments submitted by Petitioner in its Petition including the element-by-element analysis on pages 44–47 of the Petition and the Declaration by Mr. Proctor (Ex. 1012) regarding the limitations recited in claims 7–10. We are persuaded that Petitioner has shown sufficiently that each of the limitations of claims 7–10 is taught by the combination of Baker, Hall, and Trask.

In light of the arguments and evidence submitted, we are persuaded that Petitioner has established by a preponderance of the evidence that claims 7–10 are unpatentable as obvious over the combination of Baker, Hall, and Trask.

F. Patent Owner’s Motion to Exclude

Patent Owner seeks to exclude Petitioner’s Exhibits 1022 and 1024. Paper 24, 2. Exhibit 1022 is the Declaration of Dr. Sandeep Chatterjee in support of covered business method review in *SecureBuy, LLC v. Cardinal Commerce Corp.*, Case No. CBM2014-00035 (“CBM Declaration”). Exhibit 1024 is a copy of Unwired Planet’s infringement claim chart from a district court lawsuit involving Petitioner and Patent Owner, Case No. NVD-3-13-cv-00579 (“infringement chart”).

Petitioner has not explained persuasively how Exhibit 1022 relates to the issues in this *inter partes* review proceeding. Petitioner asserts that Dr. Chatterjee’s prior testimony supports Petitioner’s reasons to combine Baker and Hall. Pet. Reply 19. Petitioner, however, has not shown sufficiently how Dr. Chatterjee’s testimony relates to the Baker and Hall references asserted in this case. We, therefore, do not rely on Exhibit 1022 in this Decision and Patent Owner’s request is granted.

Regarding Exhibit 1024, i.e., the infringement chart, we are persuaded by Petitioner that Exhibit 1024 is offered not for the truth of the matter asserted (i.e., the content of the ’433 patent), but as evidence of how the Patent Owner has characterized the ’433 Patent and, in particular, the “transaction confirmation” limitation (Paper 26, 5–6). Patent Owner has not persuaded us that Exhibit 1024 is irrelevant, at least because its characterization of the ’433 Patent in the district court proceedings is

relevant to the credibility of its characterization of the '433 Patent in this proceeding. Accordingly, we decline to exclude Exhibit 1024.

For the foregoing reasons, Patent Owner's Motion to Exclude is *granted-in-part and denied in-part*.

III. CONCLUSION

For the foregoing reasons, we determine that the information presented in the Petition establishes by a preponderance of the evidence the unpatentability of each of claims 1–17 of the '433 Patent. In particular, we determine that Petitioner has established by a preponderance of the evidence the unpatentability of (1) claims 1–7 and 11–17, under 35 U.S.C. § 102(e), as anticipated by DeLorme; (2) claims 7–10, under 35 U.S.C. § 103(a), over DeLorme and Trask; (3) claims 1–6 and 11–16, under 35 U.S.C. § 103(a), over Baker and Hall; and (4) claims 7–10, under 35 U.S.C. § 103(a), over Baker, Hall, and Trask. This is a Final Written Decision of the Board under 35 U.S.C. § 318(a).

IV. ORDER

For the reasons given, it is
ORDERED that, pursuant to 35 U.S.C. § 318, claims 1–17 of U.S. Patent No. 7,376,433 are determined to be *unpatentable*;
FURTHER ORDERED that Patent Owner's Motion to Exclude is *granted-in-part and denied-in-part*;
FURTHER ORDERED that Exhibit 1022 shall be expunged; and
FURTHER ORDERED that, because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2014-01164
Patent 7,376,433 B1

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