

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner,

v.

SIMPLEAIR, INC.,
Patent Owner.

Case CBM2014-00170
Patent 7,035,914 B1

Before MICHAEL R. ZECHER, STACEY G. WHITE, and
TINA E. HULSE, *Administrative Patent Judges*.

HULSE, *Administrative Patent Judge*.

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

I. INTRODUCTION

Google Inc. (“Petitioner”) filed a Petition requesting a covered business method patent review of claims 1–3, 7, and 22–24 of U.S. Patent No. 7,035,914 B1 (“the ’914 patent”). Paper 2 (“Pet.”). SimpleAir, Inc. (“Patent Owner”) timely filed a Preliminary Response to the Petition. Paper 10 (“Prelim. Resp.”).

We have jurisdiction under 35 U.S.C. § 324, which provides that a covered business method patent review may not be instituted 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.” 35 U.S.C. § 324. Upon considering the Petition and Preliminary Response, we determine that the information presented in the Petition does not demonstrate that any of the challenged claims is more likely than not unpatentable. We, therefore, deny the Petition.

II. BACKGROUND

A. *Petitioner’s Standing*

Section 18 of the Leahy-Smith America Invents Act (“AIA”) governs the transitional program for covered business method patent reviews.¹ Section 18(a)(1)(B) of the AIA limits such reviews to persons, or their privies, that have been sued or charged with infringement of a covered business method patent.

Petitioner asserts that Patent Owner has sued Petitioner for alleged infringement of the ’914 patent. Pet. 8; *see also id.* at 79 (identifying

¹ *See* Section 18(a) of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284, 329 (2011).

SimpleAir, Inc. v. Google Inc., No. 2-13-cv-00587 (E.D. Tex.) as a related matter). Petitioner, therefore, has standing to file the Petition.

B. The '914 Patent (Ex. 1001)

The '914 patent relates to wired and non-wired data transmission communication systems. Ex. 1001, 1:24–26. Wireless communication technology allows users to be notified of information anywhere and at any time. *Id.* at 1:52–53. Moreover, the '914 patent states that online services have made endless amounts of information available to individuals throughout the world. *Id.* at 1:58–61.

According to the '914 patent, however, these technologies suffer from numerous disadvantages. For example, the Specification states that the benefits of wireless technology only have been utilized for personal messaging with limited message length. *Id.* at 1:65–2:3. The Specification further states that immediate notification of information is not available. *Id.* at 2:22–26. Another problem, according to the '914 patent, is that data transmitted over existing wireless broadcast networks suffer from inevitable degradation of data. *Id.* at 2:27–40.

To address these issues, the '914 patent describes a system that allows for broadcast of up-to-the-minute notification centric information that provides an instant call to action for users who are provided with the ability to retrieve further detailed information instantaneously. *Id.* at 2:50–58.

C. Illustrative Claim

Claim 1 is the only independent claim challenged in this proceeding. Claims 2, 3, 7, and 22–24 all depend, directly or indirectly, from claim 1.

Claim 1 is illustrative of the subject matter of the challenged claims and is reproduced below:

1. A method for transmitting data to selected remote devices, comprising the steps of:
 - transmitting data from an information source to a central broadcast server;
 - preprocessing said data at said central broadcast server, further comprising the step of:
 - parsing said data with parsers corresponding to said central broadcast server;
 - transmitting said data to an information gateway for building data blocks and assigning addresses to said data blocks;
 - transmitting said data blocks from said information gateway to a transmission gateway for preparing said data blocks for transmission to receivers;
 - transmitting preprocessed data to receivers communicating with said devices; and
 - instantaneously notifying said devices of receipt of said preprocessed data whether said devices are online or offline from a data channel associated with each device.

D. The Asserted Grounds of Unpatentability

Petitioner challenges the patentability of claims 1–3, 7, and 22–24 of the '914 patent on the following grounds (Pet. 17–78):

References	Basis	Claims challenged
N/A	§ 101	1–3, 7, and 22–24
N/A	§ 112, ¶ 2	1–3, 7, and 22–24
Dartmouth System ²	§ 102/§ 103	1–3, 7, and 22–24
PIC Reference Guide ³ and Hays ⁴ (“Magic Link”)	§ 103	1–3, 7, and 22–24

² As discussed in Exs. 1010–1015.

³ Magic Link Personal Intelligent Communicator Reference Guide, ©1994 (Ex. 1018).

⁴ Hays, et al., WO 95/26113, published Sept. 28, 1995 (Ex. 1019).

References	Basis	Claims challenged
Kane ⁵ and Gifford ⁶	§ 103	1–3 and 7
Kane, Gifford, and Olazabal ⁷	§ 103	22–24
Nelson ⁸ and Kane	§ 103	1–3
Nelson, Kane, and Gifford	§ 103	7
Nelson, Kane, and Olazabal	§ 103	22–24

III. ANALYSIS

A. Covered Business Method Patent

Under § 18(a)(1)(E) of the AIA, the Board may institute a transitional proceeding only for a patent that 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); 37 C.F.R. § 42.301(a). For purposes of determining whether a patent is eligible for a covered business method patent review, the focus is on the claims. *See* Transitional Program for Covered Business Method Patents—Definitions of Covered Business Method Patent and Technological Invention; Final Rule, 77 Fed. Reg.

⁵ Kane, WO 94/08419, published Apr. 14, 1994 (Ex. 1009).

⁶ Gifford et al., *The Application of Digital Broadcast Communication to Large Scale Information Systems*, 3 IEEE J. ON SELECTED AREAS IN COMMUNICATIONS 457–67 (1985) (Ex. 1007).

⁷ Olazabal et al., US 5,323,148, issued June 21, 1994 (Ex. 1016).

⁸ Nelson et al., US 5,347,268, issued Sept. 13, 1994 (Ex. 1008).

48,734, 48,736 (Aug. 14, 2012). A patent need only have one claim directed to a covered business method to be eligible for review. *Id.*

1. *Financial Product or Service*

Claim 1 recites a method of transmitting data to selected remote devices. Ex. 1001, 33:16–17. Referring to Figure 2 of the '914 patent, the Specification teaches that “the data, which can include . . . stock quotes, . . . lotto, . . . etc. is then respectively parsed by parsers, such as the stock quote parser 106, . . . lotto parser 110 . . . and then transmitted to the content manager 114 located in the central broadcast server 34.” Ex. 1001, 8:11–16. Thus, the '914 patent contemplates expressly using the method of claim 1 for managing a financial product or service—that is, for transmitting stock quotes and lotto results to remote devices. We, therefore, determine that claim 1 of the '914 patent recites “a method . . . for performing data processing or other operations used in the practice, administration, or management of a financial product or service.” *See* AIA § 18(d)(1); 37 C.F.R. § 42.301(a).

Patent Owner contends that our interpretation of the financial prong is overly broad and “would contravene its purpose.” Prelim. Resp. 18–19. We disagree. 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.” 77 Fed. Reg. at 48,735–36. 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.* (citing 157 Cong. Rec. S5432 (daily ed. Sept. 8, 2011) (statement of Sen. Schumer) (emphasis added)). Thus, our

interpretation of the financial prong is consistent with the broad intent suggested by the legislative history. *See* 77 Fed. Reg. at 48,735–36.

2. *Technological Invention*

The definition of a “covered business method patent” in § 18(d)(1) of the AIA does not include patents for “technological inventions.”

When determining whether a patent is for a technological invention, we consider two prongs: “whether the claimed subject matter as a whole [1] recites a technological feature that is novel and unobvious over the prior art; and [2] solves a technical problem using a technical solution.” 37 C.F.R. § 42.301(b). To establish that the claims are not directed to a technological invention, Petitioner need only show that one prong does not exist in at least one claim.

According to the Office Patent Trial Practice Guide, the following claim drafting techniques are examples that typically do not render a patent a “technological invention”:

- (a) Mere recitation of known technologies, such as computer hardware, communication or computer networks, software, memory, computer-readable storage medium, scanners, display devices or databases, or specialized machines, such as an ATM or point of sale device.
- (b) Reciting the use of known prior art technology to accomplish a process or method, even if that process or method is novel and non-obvious.
- (c) Combining prior art structures to achieve the normal, expected, or predictable result of that combination.

Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,763–64 (Aug. 14, 2012).

Even if we assume that the problems solved and the solutions claimed by the ’914 patent are technical, as Patent Owner asserts (Prelim. Resp. 25–

29), we are persuaded that claim 1, as a whole, does not recite a technological feature that is novel and unobvious over the prior art. In particular, we are persuaded that claim 1 only recites the presence of well-known technologies to accomplish the claimed method. Petitioner argues that claim 1 recites “remote devices,” “a central broadcast server” with corresponding “parsers,” “an information gateway,” “a transmission gateway,” and “receivers,” all of which were well known in the art before the earliest possible critical date for the ’914 patent. Pet. 6; Ex. 1002 ¶¶ 64–68. For example, the Specification states that one skilled in the art will recognize that the present invention could be implemented on computers, televisions, telephones, and appliances, all of which were known at that time. Ex. 1001, 7:40–47. And the Specification states that the present invention “is designed to operate with any of the above known or developing transmission networks.” *Id.* at 9:21–25. The Specification also indicates that parsing is well known, stating “any type of information source and corresponding parser may be used.” *Id.* at 8:22–24.

In its Preliminary Response, Patent Owner argues that the Petition fails to demonstrate that the claimed subject matter, as a whole, does not recite a technological feature that is novel and unobvious. Prelim. Resp. 20–25. Patent Owner first argues that the Petition does not address all components, such as the “data channel,” and, even if it did, Patent Owner asserts that a “petition cannot establish that a claimed method does not recite a technological feature that is novel and unobvious merely by showing that the physical components needed to practice that method were previously known in the art.” *Id.* at 21 (citing *Motorola Mobility, LLC v. Intellectual Ventures I, LLC*, Case CBM2014-00084, slip op. at 7 (PTAB Aug. 6, 2014))

(Paper 18); *Epsilon Data v. Rpost Commc'ns*, Case CBM2014-00017, slip op. at 9 (PTAB Apr. 22, 2014) (Paper 21)).

We are not persuaded by Patent Owner's arguments and determine that Petitioner has made a sufficient showing that the claimed subject matter, as a whole, does not recite a technological feature that is novel and unobvious over the prior art. Whether the step of "instantaneously notifying said devices of receipt of said preprocessed data whether said devices are online or offline from a data channel associated with each device" is novel and unobvious is irrelevant if the prior art technology used to accomplish that step was known. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,763–64.

Moreover, in our previous decision involving the '914 patent, we found that Patent Owner did not rebut Petitioner's assertion that the prior art technology used in claim 1 was known in the art. *Google Inc. v. SimpleAir, Inc.*, Case CBM2014-00054, slip op. at 7 (PTAB May 13, 2014) (Paper 19) ("the -054 case"). In the instant case, Patent Owner purports to address this argument in its Preliminary Response. Prelim. Resp. 24. But rather than rebut the Petitioner's assertion by identifying any prior art technology in the claims that was not known in the art, Patent Owner attacks the sufficiency of Petitioner's arguments. In other words, Patent Owner did not affirmatively state, for example, that the "data channel" of the claims was not well known in the art; instead it merely argued that Petitioner did not meet its burden. *See id.* We, however, are persuaded by Petitioner's contentions. Accordingly, we determine that claim 1 does not recite a technological feature that is novel and unobvious over the prior art. *See* 37 C.F.R. § 42.301(b).

We also have considered whether the method of claim 1 solves a technical problem using a technical solution, but, because we conclude that claim 1 does not recite a technological feature that is novel and unobvious over the prior art, the '914 patent is a “covered business method patent” and is eligible for a covered business method patent review.

B. Claim Construction

In a covered business method patent review, we interpret claim terms in an unexpired patent according to the broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.300(b). Under that standard, and absent a special definition, we give claim terms their ordinary and customary meaning, as would be understood by one of ordinary skill in the art at the time of the invention. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Any special definitions for claim terms must be set forth with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

1. Previously Construed Claim Terms

In the co-pending litigation, the District Court construed several terms of the '914 patent. Ex. 1023, 8–23, 25–41. Petitioner suggests that we adopt the District Court’s constructions, at least for purposes of this Decision to Institute, as we did in the -054 case. Pet. 11–13 (citing CBM2014-00054, Paper 19 at 9–11). At this time, Patent Owner does not appear to disagree and does not offer alternative constructions for any of the terms. For convenience, the District Court’s constructions of '914 patent claim terms are reproduced in the table below:

Claim term	Construction
“data channel”	“one or more communication channels or paths for accessing or viewing a category or subcategory of information that is provided by an information source over a communications network” (Ex. 1023, 14)
“whether said computing devices are online or offline from a data channel associated with each device”	“whether the remote computing devices are or are not connected via the Internet or another online service to a data channel associated with each computing device at the time the preprocessed data is received by the receivers” (Ex. 1023, 17)
“whether said computing devices are on or off”	“whether said computing devices are powered on or powered off” (Ex. 1023, 25)
“information source”	“one or more content or online service providers that provide data to the central broadcast server, such as an online source of news, weather, sports, financial information, games, personal messages, or e-mails” (Ex. 1023, 27–28)
“parsing said data with parsers”	“using multiple computer software programs, routines, or functions to break or divide data received from an information source into components whose content or format can be analyzed, processed or acted upon” (Ex. 1023, 31)
“an information gateway for building data blocks and assigning addresses to said data blocks”	“one or more software programs (or a portion of a program) that build data blocks and assign addresses to the data blocks” (Ex. 1023, 37)
“a transmission gateway for preparing said data blocks for	“one or more software programs (or a portion of a program) that prepare

Claim term	Construction
transmission to receivers”	the data blocks for their transmission to receivers and interface with other resources used to transmit the preprocessed data” (Ex. 1023, 39)
“central broadcast server”	“one or more servers that are configured to receive data [from] a plurality of information sources and process the data prior to its transmission to one or more selected remote computing device” (Ex. 1023, 41)
“contextual graphics”	“graphics relating to the context of the preprocessed data that has been received” (Ex. 1023, 46)

As we found in the -054 case, upon considering the District Court’s claim construction order, we determine that the construction of each of these claim terms is consistent with its broadest reasonable interpretation in light of the Specification. Accordingly, for purposes of this Decision to Institute, we adopt the District Court’s constructions of the claim terms reproduced in the table above.

2. *“instantaneously notifying”*

Neither party offers a construction for the term “instantaneously notifying.” And the Specification does not expressly define the term, which appears only in the claims.

The Specification does, however, state that “[i]n accordance with the present invention, a user may be instantly notified of E-mail messages without being connected to an E-mail service provider.” Ex. 1001, 30:35–36. The Specification further states that when a user receives an E-mail message, “the user’s provider sends an E-mail notification to central

broadcast server.” *Id.* at 30:37–40. “Upon receiving this notification, the central broadcast server transmits an E-mail alert message to the user’s computer through the broadcast network.” *Id.* at 30:40–42.

The Specification also uses the word “instantaneously” in different contexts. For example, the Specification states that “the present system provides for broadcast of up to the minute notification centric information thereby providing an instant call to action for users who are provided with the ability to *instantaneously* retrieve further detailed information.” Ex. 1001, 2:54–58 (emphasis added). In addition, the Specification states that “[i]nformation is thus modified and updated *instantaneously* and wirelessly.” *Id.* at 3:50–51 (emphasis added).

In each example, the words “instantly” and “instantaneously” are used in a manner consistent with the ordinary and customary meaning of “instantaneously”—i.e., “occurring, done, or completed in an infinitesimal or very short space of time.” *See* Ex. 3001 (definitions of “instantaneous” and “instant”). As such, we determine the broadest reasonable interpretation of the term “instantaneously notifying” is “notifying in a very short space of time.”

C. Unpatentability Under 35 U.S.C. § 101

Petitioner argues that claims 1–3, 7, and 22–24 are not directed to patent-eligible subject matter under 35 U.S.C. § 101. Pet. 17–23. Patent Owner opposes Petitioner’s challenge. Prelim. Resp. 29–38. After considering the Petition and the Preliminary Response, we determine that Petitioner has not established that the claims are more likely than not unpatentable under § 101.

Section 101 provides that “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” The U.S. Supreme Court has carved out three exceptions to the broad categories of patent-eligible subject matter: laws of nature, natural phenomena, and abstract ideas. *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293 (2012).

In *Alice Corp. Pty, Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347 (2014), the Supreme Court set forth the analysis to distinguish claims for patent-ineligible laws of nature, natural phenomena, and abstract ideas from claims for patent-eligible applications of those concepts. *Id.* at 2355. The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If the claims are directed to a patent-ineligible concept, the second step in the analysis is to consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (citation omitted). That is, the second step is to “search for an ‘inventive concept’—i.e., an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Id.* (citation omitted).

The challenged claims of the ’914 patent each recite a “method,” which constitutes statutory subject matter under § 101. We must, therefore, determine whether the claims represent an unpatentable abstract idea. Petitioner has not persuaded us that it is more likely than not that they do.

Petitioner asserts that the claims are directed to the abstract idea of “packaging and routing information as part of a subscription service.” Pet. 17. Petitioner argues that the ’914 patent does not purport to disclose any new devices; instead, it accomplishes the alleged invention “through conventional data processing, transmitting, and receiving equipment.” *Id.* at 19. Petitioner also analogizes the claimed invention to conventional periodical publication delivery. *Id.* at 19–20. Specifically, Petitioner asserts that reporters gather information and send it to a central news office where editors analyze and parse through the information to determine what is newsworthy. According to Petitioner, the selected information is then put into a periodical and addressed to its individual subscribers. The postal system sorts and routes the periodicals to the subscribers, and the mail carrier delivers the periodicals to the subscribers’ mailboxes. Finally, Petitioner concludes that the mail carrier then raises the flags on the mailboxes to instantaneously notify the subscribers that their mail has arrived, which happens regardless of whether the subscribers are otherwise in communication with the source of the information. *Id.*

In response, Patent Owner asserts that Petitioner ignores the claim language and fails to address the actual claim limitations. Prelim. Resp. 32. We agree. Petitioner does not explain sufficiently how the challenged claims allegedly relate to the abstract idea of packaging and routing information as part of a subscription service. This is particularly true when none of the challenged claims recites a “subscription service” at all. Regardless, Petitioner’s analogy to conventional periodical publication delivery is no substitute for an analysis of how, or why, the claim language supports Petitioner’s assertion that the claims merely recite an abstract idea.

Moreover, every method can be generalized to the point of abstraction if the claim language is ignored. Here, Petitioner overlooks the various physical components recited by the claims, including the remote devices and the central broadcast server. But Petitioner’s analogy to conventional periodical publication delivery still fails because it does not account for each step of the claimed method. For example, claim 1 recites “instantaneously notifying said devices of receipt of said preprocessed data whether said devices are online or offline from a data channel associated with each device.” Petitioner contends that a mail carrier’s raising the flag on a mailbox instantaneously notifies subscribers that their mail has arrived regardless of whether the subscribers “are otherwise in communication with the sources of the information.” Pet. 20. Even if mail carriers did raise mailbox flags when delivering mail, Petitioner does not explain how being in communication with the source of the information equates to being “online or offline from a data channel associated with each device,” as required by the claims.

Petitioner’s generalized arguments, not directed to the specific language of the challenged claims, are insufficient to show that the claims more likely than not are directed to a patent-ineligible abstract idea. As such, we need not turn to the second step in *Alice* to look for additional elements that can transform the nature of the claim into a patent-eligible application of an abstract idea.

Based on the information presented in the Petition and supporting evidence, we are not persuaded that Petitioner has shown sufficiently that claims 1–3, 7, and 22–24 are more likely than not unpatentable as being directed to patent-ineligible subject matter under 35 U.S.C. § 101.

D. Unpatentability Under 35 U.S.C. § 112, ¶ 2

Petitioner argues that claims 1–3, 7, and 22–24 are unpatentable as indefinite under 35 U.S.C. § 112, ¶ 2. Pet. 23–26. Patent Owner opposes Petitioner’s challenge. Prelim. Resp. 38–50. After considering the Petition and the Preliminary Response, we determine that Petitioner has not established that the claims are more likely than not unpatentable as indefinite under § 112, ¶ 2.

Section 112, ¶ 2 requires that claims “particularly point[] out and distinctly claim[] the subject matter which the applicant regards as his invention.” During proceedings before the Office, the Board holds that a claim is indefinite “if a claim is amenable to two or more plausible claim constructions.” *Ex parte Miyazaki*, 89 USPQ2d 1207, 1211 (BPAI 2008) (precedential).

Patent Owner asserts that *Miyazaki* does not apply to post-grant proceedings. Prelim. Resp. 40–41. We disagree. The Board’s rationale in *Miyazaki* for applying this indefiniteness standard stems from two factors: (1) the broadest reasonable interpretation claim construction standard; and (2) the lack of a presumption of validity before the Office. *Miyazaki*, 89 USPQ2d at 1210–11. Because both factors are present in post-grant proceedings, the indefiniteness standard in *Miyazaki* applies here, as well.

Having set forth the standard for indefiniteness before the Board, we now turn to Petitioner’s argument. Petitioner contends that the various types of “data” recited in claim 1 are ambiguous. Pet. 24. Specifically, Petitioner argues that it is unclear whether the “preprocessed data” of the step of “transmitting preprocessed data to receivers communicating with said devices” refers to data that has been parsed. *Id.* Petitioner also argues that it

is unclear whether “said data” of the step of “transmitting said data to an information gateway for building data blocks and assigning addresses to said data blocks” refers to data that has been parsed. *Id.* at 24–25. Finally, Petitioner asserts that it is unclear whether or how the “preprocessed data” relates to “said data blocks.” *Id.* at 25.

We do not find Petitioner’s arguments persuasive. Claim 1 recites a method comprising a series of steps. Although we typically do not read a specific order of steps into method claims, we will do so if “the sequential nature of the claim steps is apparent from the plain meaning of the claim language and nothing in the written description suggests otherwise.” *See Mantech Envtl. Corp. v. Hudson Envtl. Servs., Inc.*, 152 F.3d 1368, 1375–76 (Fed. Cir. 1998).

Here, the plain language of claim 1 makes clear that each step must occur in the order recited, as each step refers to elements in the step before:

1. A method for transmitting data to selected remote devices, comprising the steps of:
 - transmitting data* from an information source *to a central broadcast server*;
 - preprocessing said data at said central broadcast server*, further comprising the step of:
 - parsing *said data* with parsers corresponding to said central broadcast server;
 - transmitting said data to an information gateway for building data blocks* and assigning addresses to said data blocks;
 - transmitting said data blocks from said information gateway to a transmission gateway for preparing said data blocks for transmission to receivers*;
 - transmitting preprocessed data to receivers* communicating with said devices; and
 - instantaneously notifying said devices of *receipt of said preprocessed data* whether said devices are online or offline from a data channel associated with each device.

Nothing in the Specification suggests that claim 1 should be read in a way other than the order recited. Indeed, as Patent Owner notes, the Specification demonstrates that the data proceeds from an information source to a central broadcast server for parsing, to an information gateway, to a transmission gateway, and finally to the remote device. Prelim. Resp. 46 (citing Ex. 1001, 8:1–9:25); Ex. 1001, Fig. 2. Thus, to take any of the transmitting steps out of order would disrupt this procession of the data. Accordingly, we construe claim 1 to require that the steps occur in the order recited.

Given this order of steps, it is clear that “said data” in the second transmitting step refers to the data that has been preprocessed in the prior step. Moreover, “said data blocks” in the third transmitting step clearly refers to the data blocks that were built from the data recited in the step before it (i.e., “said data,” which has been preprocessed). Finally, the “preprocessed data” of the fourth transmitting step refers to data that has been preprocessed by parsing in the steps before it.

Because, on this record, we are not persuaded that the claim language is amenable to two or more plausible claim constructions, we determine that Petitioner has failed to show sufficiently that the claims are more likely than not unpatentable as indefinite under 35 U.S.C. § 112, ¶ 2.

E. Unpatentability over the Dartmouth System

Petitioner asserts that claims 1–3, 7, and 22–24 are unpatentable over the Dartmouth System under 35 U.S.C. § 102 or § 103. Pet. 26–41. Patent Owner opposes the challenge. Prelim. Resp. 52–59. After considering the Petition and Preliminary Response, we determine that Petitioner has not

shown sufficiently that it is more likely than not that any of the claims are unpatentable over the Dartmouth System.

1. *Overview of the Dartmouth System (Exs. 1010–1015)*

The Dartmouth System is an email and bulletin board system developed at Dartmouth College for use by Dartmouth’s students, faculty, and staff. Ex. 1011, 2.⁹ The majority of Dartmouth users use an email system called BlitzMail, which is a client/server system. *Id.* at 7. The BlitzMail server program provides message storage and forwarding functions needed by the BlitzMail client. *Id.* at 10. The BlitzMail client allows the user to read, reply to, compose, and file mail messages. *Id.* at 9.

2. *Analysis*

Petitioner asserts that the Dartmouth System discloses each limitation of claim 1 of the ’914 patent. Pet. 31–39. Regarding the last step of claim 1, Petitioner asserts that the Dartmouth System discloses the step of “instantaneously notifying said devices of receipt of said preprocessed data” because Dartmouth teaches that “[t]he receiver notifies the user device of the new message by providing a message to the notification driver, which alerts the user. The notification occurs ‘asynchronously.’” *Id.* at 38 (citing Ex. 1011, 13). Petitioner further states that “[t]o alert the user, the driver may provide ‘a beep, a flashing icon, a dialog box, or [an] automatic opening of a window for reading the new message.’” *Id.* (citing Ex. 1011, 13). Petitioner then concludes that the Dartmouth System “instantaneously notified the devices of receipt of the preprocessed data.” *Id.* at 39.

⁹ Citations to page numbers refer to the pagination located in the bottom, right-hand corner that was provided by Petitioner pursuant to 37 C.F.R. § 42.63(d)(2).

In response, Patent Owner notes that the evidence cited by the Petition states: “The notification server provides a flexible mechanism for asynchronously notifying a Macintosh user of some event.” Prelim. Resp. 53–54 (citing Ex. 1011, 13). As Patent Owner argues, however, the claim requires instantaneous notification of the device. *Id.*

We are persuaded by Patent Owner’s argument. The Petitioner fails to explain how asynchronous notification of a user of some event discloses, expressly or inherently, the step of “instantaneously notifying said devices of receipt of said preprocessed data.” That is, Petitioner does not explain how “*asynchronously* notifying” discloses “*instantaneously* notifying,” as required by the claim. Nor does Petitioner explain how “notifying a Macintosh *user* of some event” discloses “notifying said *devices* of receipt of said preprocessed data,” as further required by the claim.

Accordingly, we determine that Petitioner has failed to show sufficiently that claims 1, 2, and 22–24 are more likely than not anticipated by the Dartmouth System. Moreover, because Petitioner did not argue persuasively how the “instantaneously notifying” step of claim 1 would have been obvious over the asynchronous notification of the Dartmouth System, we determine that Petitioner has failed to show sufficiently that claims 3 and 7 are more likely than not unpatentable as obvious over the Dartmouth System, as well.

F. Obviousness over the Magic Link System

Petitioner asserts that claims 1–3, 7, and 22–24 are unpatentable as obvious over the PIC Reference Guide (Ex. 1018) and Hays (Ex. 1019), which Petitioner collectively refers to as “Magic Link.” Pet. 41–53. Based

on the circumstances of this case, we exercise our discretion under 35 U.S.C. §§ 324(a) and 325(d) to decline to institute trial on this ground.

In the prior -054 case, Petitioner challenged claims 1–3, 7, 22–24, and 69 of the '914 patent as being unpatentable over the “SkyTel” system. CBM2014-00054, Paper 19 at 8. We rejected that challenge because it relied on 27 different exhibits (Exs. 1009–1035), describing different embodiments of the system without providing a proper anticipation or obviousness analysis. CBM2014-00054, Paper 19 at 13–15.

Here, Petitioner returns, noting our earlier holding and stating “the SkyTel ground is reframed to focus on a single embodiment—the Magic Link product.” Pet. 3. The references the Petitioner relies upon—the PIC Reference Guide and Hays—were both considered in the -054 case. *See* CBM2014-00054, Exs. 1022 (PIC Reference Guide) and 1009 (Hays).

Under 35 U.S.C. § 324(a), the Board has discretion to deny a request for covered business method patent review. 35 U.S.C. §324(a) (“The Director *may* not authorize a post-grant review to be instituted”) (emphasis added). We also have discretion under 35 U.S.C. § 325(d), which states “[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.”

The Magic Link ground in the instant Petition challenges the same claims as the SkyTel ground in the -054 case. And the Magic Link ground relies on two of the same references relied upon in the prior SkyTel ground. Having considered the papers filed in both proceedings, we are persuaded that the instant Petition uses our prior Decision on Institution in the -054

case to bolster the SkyTel challenge that was advanced, unsuccessfully, in the -054 Petition. Indeed, Petitioner admits to “refram[ing]” the SkyTel ground in the instant Petition based on our prior Decision. Pet. 3.

Given that we have already considered the same or substantially the same prior art in connection with the same challenged claims, we exercise our discretion under §§ 324(a) and 325(d) to deny the request for covered business method patent review of those claims based on the Magic Link references.

G. Obviousness over Kane and Gifford

Petitioner asserts that claims 1–3, 7, and 22–24 are unpatentable as obvious over Kane and Gifford alone, or over Kane and Gifford in view of Olazabal. Pet. 53–65. Patent Owner opposes Petitioner’s challenge. Prelim. Resp. 67–77. After considering the Petition and the Preliminary Response, we determine that Petitioner has not shown sufficiently that any of the claims are more likely than not unpatentable as obvious over Kane and Gifford.

1. Overview of Kane (Ex. 1009)

Kane relates to an email system for delivering messages between X.400 terminal devices and portable selective call receivers. Ex. 1009, 3:6–10. According to Petitioner’s declarant, Dr. Vijay Madisetti, X.400 standards are a suite of standards for email. Ex. 1002 ¶ 139. In one embodiment, a central terminal receives a message from an X.400 network. Ex. 1009, 6:30–34. The message is routed from the central terminal to a paging transmitter system, and then over a paging communication channel for reception by one or more selective call receivers. The selective call

receivers preferably incorporate a paging receiver that operates to receive messages. *Id.* at 8:7–22.

2. *Analysis*

Petitioner asserts that the combination of Kane and Gifford render claim 1 obvious. In particular, Petitioner argues that Kane alone teaches the “instantaneously notifying” step of claim 1. Pet. 61–62. Petitioner contends the paging receiver of Kane couples a received message to a controller, which can determine whether the received message is intended for a particular selective call receiver. *Id.* at 61. Petitioner further states that “[a] user of the ‘selective call terminal 130’ can ‘access user input means 141 . . . at the remote unit 130 to cause the message data of a received message to be displayed.’” *Id.* at 61–62 (quoting Ex. 1009, 7:1–5). Petitioner then concludes, stating, “[i]n this way, the paging receiver 134 and the controller 136 instantaneously notify the selective call receiver 130 upon receipt of the message.” *Id.* at 62.

Patent Owner responds, stating that Petitioner has misquoted the passage from Kane by omitting key information. Prelim. Resp. 68. In full, the quoted passage from Kane states that “[a] user can access user input means 141, *such as buttons or switches*, at the remote unit 130 to cause the message data of a received message to be displayed on a display.” Ex. 1009, 9:1–4 (emphasis added). When read as a whole, Patent Owner asserts that Kane teaches a user electing, at some unspecified time—minutes or even hours—after receipt of a message, to push a manual button or switch to cause the message data of a received message to be displayed. As such, Patent Owner concludes that Kane does not teach “instantaneously notifying said devices of receipt of said preprocessed data.” Prelim. Resp. 68.

We agree with Patent Owner. Petitioner has not explained adequately how the cited portion of Kane teaches the step of “instantaneously notifying said devices of receipt of said preprocessed data.” In particular, although Kane teaches that the paging receiver 134 couples a received message to a controller 136, which “determine[s] whether the received message is intended for the particular selective call receiver 130” (Ex. 1009, 8:29–36), Petitioner never explains how or when the selective call receiver is notified of receipt of the message once that determination is made. Moreover, that a *user* can cause a received message to be displayed via buttons or switches says nothing about how or when the *device* is notified.

Accordingly, we determine that Petitioner has failed to show sufficiently that claims 1–3 and 7 are more likely than not unpatentable as obvious over Kane and Gifford. Because Petitioner has not asserted that Olazabal cures the deficiency of Kane, we also determine that Petitioner has failed to demonstrate that dependent claims 22–24 are more likely than not unpatentable as obvious over Kane, Gifford, and Olazabal.

H. Obviousness over Nelson and Kane

Petitioner asserts that claims 1–3, 7, and 22–24 are unpatentable as obvious over Nelson and Kane, alone, or in combination with Gifford or Olazabal. Pet. 65–76. Patent Owner opposes the challenge. Prelim. Resp. 77–78. After considering the Petition and Preliminary Response, we determine that Petitioner has not shown sufficiently that any of the challenged claims are more likely than not unpatentable over the cited prior art.

1. *Overview of Nelson (Ex. 1008)*

Nelson relates to a radio frequency (“RF”) communication system that transmits information received in multiple data formats. Ex. 1008, Abstract. The RF communication system receives the information and parses it into a plurality of “nibbles,” which comprise a predetermined number of bits. *Id.* The nibbles are then provided to a terminal as a message, which is encoded by the terminal and then transmitted to a transmitter for transmission. *Id.*

2. *Analysis*

Petitioner argues that Nelson teaches the “instantaneously notifying” step of claim 1. Pet. 71. Petitioner asserts that “Nelson discloses that upon receipt of the messages the selective call receiver 20 decodes the messages and provides the resultant information to the ‘computing device 50.’” *Id.* (citing Ex. 1008, 5:69–6:6). Petitioner further states that the computing device then “reconstruct[s] the information utilizing the block headers to combine multiple messages.” *Id.* (citing Ex. 1008, 6:6–8). Based on this disclosure, Petitioner concludes that “the selective call receiver 20 . . . instantly notifies computing device 50 of receipt of the pre-processed data.” *Id.*

Patent Owner argues that the Petitioner “does not assert that Nelson discloses [the “instantaneously notifying” step] but instead relies on Kane for these limitations.” Prelim. Resp. 77. We disagree. As explained above, Petitioner relies on Nelson as teaching the step of “instantaneously notifying said devices of receipt of said preprocessed data.”

Nevertheless, we determine that Petitioner has not shown sufficiently that Nelson teaches that step. First, contrary to Petitioner’s statement, Nelson does not state that the selective call receiver decodes the messages

and provides the resultant information to the computing device “*upon receipt* of the messages.” Pet. 71 (citing Ex. 1008, 5:69–6:6) (emphasis added). Rather, Nelson is silent as to the timing of the decoding and the transmission of the information to the computing device. Second, upon reviewing the record in its entirety, we recognize that Petitioner’s declarant, Dr. Madisetti, testifies that Nelson’s silence on this point should be viewed as implicitly disclosing an instantaneous notification. *See* Ex. 1002 ¶ 175. Petitioner, however, does not present or develop this testimony from Dr. Madisetti in its Petition. Even if we were to consider this testimony from Dr. Madisetti, Petitioner has not shown that one of skill in the art would necessarily view the art in this manner. Because Petitioner cites insufficient evidence to support its conclusion that the selective call receiver “instantly notifies” the computing device of receipt of the preprocessed data, we determine that Petitioner has failed to show sufficiently that claims 1–3 are more likely than not unpatentable as obvious over Nelson and Kane. And because Petitioner has not argued that Gifford or Olazabal cure the deficiency in Nelson, we determine that Petitioner has failed to show sufficiently that dependent claims 7 and 22–24 are more likely than not unpatentable as obvious over the cited references.

IV. REMAINING ARGUMENTS

In light of the foregoing, we determine that all remaining arguments submitted by Patent Owner are moot. Accordingly, we decline to consider, for example, whether § 101 is a proper ground for a covered business method patent review (Prelim. Resp. 38), or whether covered business method patent reviews are unconstitutional (Prelim. Resp. 78–80).

V. CONCLUSION

Upon considering the Petition and the Preliminary Response, we determine that the information presented in the Petition does not demonstrate that it is more likely than not that any of the challenged claims of the '914 patent are unpatentable.

VI. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is denied as to all challenged claims of the '914 patent; and

FURTHER ORDERED that no covered business method patent review is instituted.

PETITIONER:

Michael Messinger
Joseph Mutschelknaus
Sterne, Kessler, Goldstein & Fox
mikem-PTAB@skgf.com
jmutsche-PTAB@skgf.com

PATENT OWNER:

Charles Wieland III
Robert Mukai
Buchanan Ingersoll & Rooney PC
charles.wieland@bipc.com
robert.mukai@bipc.com