

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC.,
Petitioner,

v.

M2M SOLUTIONS LLC,
Patent Owner.

IPR2022-00260
Patent 10,791,442 B2

Before KARL D. EASTHOM, DAVID C. MCKONE, and
FREDERICK C. LANEY, *Administrative Patent Judges*.

LANEY, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314, 37 C.F.R. § 42.4

I. INTRODUCTION

Amazon.com, Inc. (“Petitioner”) filed a Petition to institute an *inter partes* review of claims 1–30 (the “challenged claims”) of U.S. Patent No. 10,791,442 B2 (Ex. 1002, “the ’442 patent”). Paper 1 (“Petition” or “Pet.”). M2M Solutions LLC (“Patent Owner”) elected to waive its right to file a preliminary response. Paper 7, 1 (Patent Owner’s Notice of Waiving Preliminary Response).

We have authority to determine whether to institute an *inter partes* review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). *Inter partes* review may not be instituted unless “the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). A decision to institute under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018).

For the reasons set forth below, we determine that Petitioner has shown a reasonable likelihood that it would prevail in showing the unpatentability of at least one of the challenged claims. Accordingly, we authorize institution of an *inter partes* review of the challenged claims of the ’442 patent based on all grounds raised in the Petition.

A. *Real Party-In-Interest*

Petitioner and Patent Owner each identify itself as the real party-in-interest. Pet. 2; Paper 3, 2.

B. Related Proceedings

Petitioner and Patent Owner detail an extensive history of litigation involving the '442 patent and five related patents, including three cases filed in District Court for the District of Delaware, several petitions for *inter partes* review, and several appeals of final decisions reached by the Board to the United States Court of Appeals for the Federal Circuit (“Federal Circuit”). Pet. 2–3; Paper 3, 2–4. In particular, Petitioner identifies the PTAB proceeding in *Amazon.com, Inc. v. M2M Solutions LLC*, IPR2019-01205, Paper 43 (PTAB Jan. 25, 2021) (“’989 FWD”), which determined that the claims of U.S. Patent No. 10,038,989 (“the ’989 patent”) are unpatentable. Pet. 2. Patent Owner appealed that decision and it is currently pending before the Federal Circuit in Case No. 22-1124 (Fed. Cir., filed Nov. 5, 2021). Pet. 2–3; Paper 3, 2.

C. The '442 Patent

The '442 patent, titled “System and Method for Remote Asset Management,” describes “[a] system for autonomously monitoring and managing consumer device assets” that are “registered with a remote computer server platform.” Ex. 1001, code (54), (57). “Based upon the results of processing . . . the received consumer usage information, the remote computer server platform manages the consumer device assets by communicating management instructions” to modify automatically the stored data content files of the assets. *Id.* at (57). Figure 2, reproduced below, illustrates applications controlled by wireless modules in an asset management system.

FIG. 2

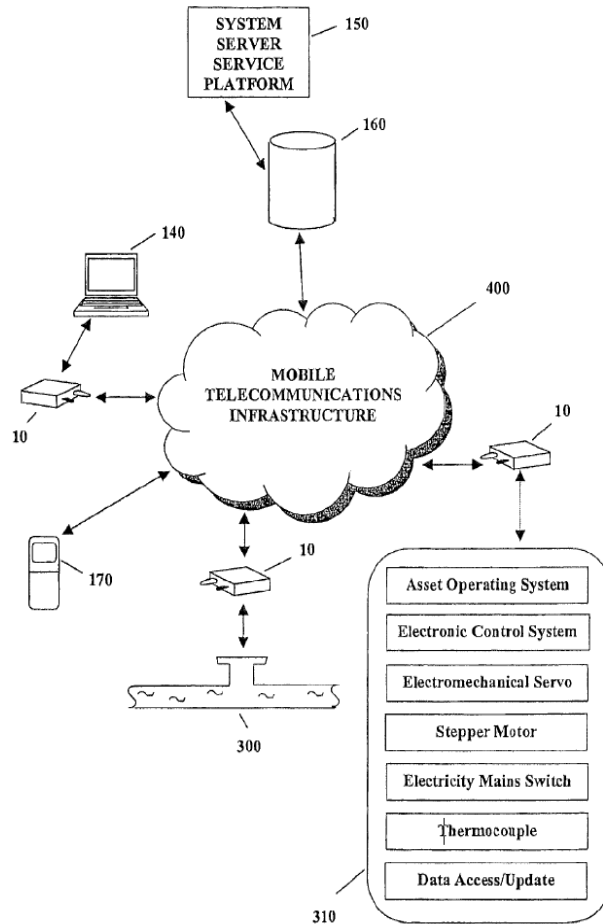


Figure 2 illustrates different applications 310 controlled by wireless module 10 in a mobile telecommunications network operating according to the GSM standard. *Id.* at 16:28–31.

In Figure 2, wireless modules 10 communicate via mobile telecommunications infrastructure 400. *Id.* at 16:39–41. Mobile phone or message-enabled wireless terminal 170 communicates with specific wireless module 10 or with system server service platform 150 via point of inter-connection 160 with the mobile telecommunications infrastructure 400. Ex. 1001, 16:41–45. In one example, laptop PC 140a manages a small number of wireless modules. *Id.* at 16:46–48. In other examples, “[t]he wireless module (10) is capable of controlling many system operation

variables of the associated asset such as an asset operating system, an electronic control system, an electromechanical servo, a stepper motor, an electricity mains switch, a thermocouple and a means to access or update data (310).” *Id.* at 16:49–54. In another example, “[t]he wireless module has the capability to be integrated with a utilities meter such as a water flow meter (300) wherein water usage data can be remotely accessed from the wireless module integrated with the utility meter and forwarded to the water board.” *Id.* at 16:55–59. Other examples follow:

the remote programming of consumer devices such as solid state video recorders and other household equipment including heating systems and the like wherein the remote server may monitor the scheduling of preferred television broadcasts according to stored user preferences and forward messages of upcoming programmes to the user and organise the programming of a home video recorder in response to receiving messages back from the user,

id. at 11:37–44;

a mobile phone or similar PDA device such as for the activation or change of highway traffic speed indicators, wherein the wireless module receives data from authorised personnel or systems to change the display of the speed indicator to suit changing driving conditions due to an accident or change in weather,

id. at 11:51–56; and

an improved remote asset management system, which gathers data according to the use of a particular asset and forwards this data to a remote server for the purpose of optimising the asset and for designing an appropriate range of services to support the said use of the asset wherein the wireless module may comprise a display having a range of options such as pull down menus for internet or dedicated service access and wherein these might be improved if the range of options were prioritised automatically

according to the way the user preferred to use the device or in the order of access of mostly used features,

id. at 12:15–26.

D. The Challenged Claims

Petitioner challenges claims 1–30 of the '442 patent. Pet. 1. Claims 2–19 depend from independent claim 1. Claims 21–30 depend from independent claim 20. Independent claims 1 and 20 recite methods with similar limitations. Claim 1, reproduced below, illustrates the subject matter of the challenged claims:

1. [Element 1[Pre]] A method of operating a remote computer server platform to provide a range of consumer services by autonomously monitoring and managing a plurality of consumer device assets wirelessly connected to one or more communications networks, each asset having as on-device components operating system and application software, nonvolatile memory for storing files of data content for display to a consumer user of the device, and a display apparatus for displaying the stored data content, said method comprising:

[Element 1[a]] providing a remote computer server platform connected to the one or more communications networks, the remote computer server platform configured to execute software applications for monitoring and managing the plurality of consumer device assets, [Element 1[b]] each of said assets being registered with the remote computer server platform;

[Element 1[c]] receiving at the remote computer server platform communications sent from each of the plurality of consumer device assets containing operational status information indicative of an operational status of the particular sending consumer device asset, said communications having automatically resulted from at least one selected from the group consisting of preprogrammed conditions and programming instructions generated by the remote computer server platform;

[Element 1[d]] receiving at the remote computer server platform communications sent from each of the plurality of consumer device assets containing consumer usage information identifying the particular manner in which a consumer user has used a particular feature of the particular sending consumer device asset, said communications having automatically resulted from at least one selected from the group consisting of preprogrammed conditions and programming instructions generated by the remote computer server platform;

[Element 1[e]] monitoring the plurality of consumer device assets by the remote computer server platform by automatically processing, according to preprogrammed conditions, the received operational status information and the received consumer usage information;

[Element 1[f]] managing the plurality of consumer device assets by the remote computer server platform, by sending communications to one or more assets containing one or more management instructions that are based upon the results of having processed at least some of the received consumer usage information, said management instructions causing the display data content files stored in non-volatile memory on one or more of the assets to be automatically modified so as to provide a consumer service;

[Element 1[g]] wherein the remote computer server platform provides said consumer service on an autonomous basis unprompted in whole or in part by receipt of any request or command initiated by a consumer user of one or more of the plurality of consumer device assets; and

[Element 1[h]] wherein the aforesaid communications received by and sent from the remote computer server platform are transmitted over the one or more communications networks and comprise at least one selected from the group consisting of General Packet Radio Service (GPRS) data messages, Enhanced Data rates for GSM Evolution (EDGE) data messages, and other wireless packet switched data messages.

Ex. 1002, 26:45–27:41 (bracketed information supplied by Petitioner).

E. Asserted Grounds of Unpatentability

Petitioner asserts that claims 1–30 would have been unpatentable on the following grounds.

Claim(s) Challenged	35 U.S.C. §¹	References
1–6, 13	103(a)	Kloba, ² Multer, ³ Hoyle ⁴
1–6, 13	103(a)	Kloba, Multer, Davis ⁵
7, 14, 16, 17, 19–25	103(a)	Kloba, Multer, Hoyle, Loughran ⁶
7, 14, 16, 17, 19–25	103(a)	Kloba, Multer, Davis, Loughran
8–12, 15, 18, 26–30	103(a)	Kloba, Multer, Hoyle, Loughran, Fong ⁷
8–12, 15, 18, 26–30	103(a)	Kloba, Multer, Davis, Loughran, Fong

Pet. 4–5. Petitioner relies on the Declaration of Peter Rysavy (Ex. 1003).

II. ANALYSIS

A. Principles of Law

If “the differences between the subject matter sought to be patented 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 renders the

¹ The Leahy-Smith America Invents Act (“AIA”) amended 35 U.S.C. § 103. See Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011). As the application that issued as the ’442 patent has an effective filing date before the effective date of the relevant amendments, the pre-AIA version of § 103 applies.

² Kloba et al., US 6,421,717 B1, issued July 16, 2002 (Ex. 1004).

³ Multer et al., US 6,671,757 B1, issued Dec. 30, 2003 (Ex. 1005).

⁴ Hoyle et al., US 6,141,010, issued Oct. 31, 2000 (Ex. 1009).

⁵ Davis et al., US 5,796,952, issued Aug. 18, 1998 (Ex. 1007).

⁶ Loughran et al., US 2002/0129107 A1, published Sept. 12, 2002 (Ex. 1006).

⁷ Fong, US 7,197,011 B2, issued Mar. 27, 2007 (Ex. 1008).

claim obvious. *KSR*, 550 U.S. at 406. The question of obviousness involves resolving 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 ordinary skill in the art; and (4) when available, evidence such as commercial success, long felt but unsolved needs, and failure of others. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966); see *KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors define the inquiry that controls.”). At this stage this stage of the proceeding, however, neither party has presented any objective evidence of non-obviousness.

The Court sets forth “an expansive and flexible approach” to the question of obviousness. *KSR*, 550 U.S. at 415. Whether a patent claiming the combination of prior art elements would have been obvious involves determining whether any improvement amounts to more than the predictable use of prior art elements according to their established functions. *Id.* at 417. Reaching this determination, however, requires more than merely showing that the prior art includes separate references covering each separate limitation in a challenged claim. *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011). Rather, obviousness additionally requires that a person of ordinary skill at the time of the invention “would have selected and combined those prior art elements in the normal course of research and development to yield the claimed invention.” *Id.*

B. Level of Ordinary Skill in the Art

The level of ordinary skill in the art provides “a prism or lens” through which to view the prior art and the claimed invention. *Okajima v.*

Bourdeau, 261 F.3d 1350, 1355 (Fed. Cir. 2001). The prior art at issue in the case often reflects the level of ordinary skill. *See Okajima*, 261 F.3d at 1355. Adding to the determination, the Court finds “[a] person of ordinary skill is . . . a person of ordinary creativity, not an automaton.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007).

Petitioner contends that a skilled artisan at the time of the invention would have had either: “a master’s degree in electrical engineering, computer engineering, computer science or the equivalent, with coursework covering networked devices and servers”; or “a bachelor’s degree in one of those fields and at least two years of industry experience working with networked devices and servers.” Pet. 20 (citing Ex. 1003 ¶ 53). Alternatively, in lieu of any formal education, Petitioner contends “four years of industry experience working with networked devices and servers” is sufficient. *Id.* (citing Ex. 1003 ¶ 53). Petitioner’s characterization of the level of skill possessed by a skilled artisan is substantially the same as the one the Board adopted in the ’989 FWD. ’989 FWD 28. The Specification, claims, and prior art presented in this proceeding are nearly identical to that discussed in the ’989 FWD; thus, the reasoning in the ’989 FWD is applicable in this proceeding, at least at this stage. Without any response at this stage of the proceeding from Patent Owner, no good reason exists to depart from the Board’s adopted skill level in the ’989 FWD, which Petitioner essentially proposes here. a

C. *Claim Construction*

In an *inter partes* review, we construe a patent claim “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b).” 37 C.F.R. § 42.100(b) (2020).

Under this standard, the words of a claim generally are given their “ordinary and customary meaning,” which is the meaning the term would have to a person of ordinary skill at the time of the invention, in the context of the entire patent including the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc).

In this proceeding, “Petitioner does not believe that any term of the ’442 patent need be construed; the claims should be given their plain meaning.” Pet. 8. Without any response from Patent Owner, we agree. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms that . . . are in controversy, and only to the extent necessary to resolve the controversy.’”) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)). Accordingly, we do not expressly construe any terms in the challenged claims.

D. Overview of the Asserted References

1. Kloba (Ex. 1004)

Kloba, titled “System, Method, and Computer Program Product for Customizing Channels, Content, and Data for Mobile Devices,” describes techniques for enabling Web content to be loaded onto mobile devices and for users of the mobile devices to interact with the Web content on their mobile devices during an off-line mode of the devices. Ex. 1004, code (54), code (57). Kloba’s Figure 1A, reproduced below, illustrates an exemplary data processing environment 102 including server 104, one or more devices 106, one or more adapters 118, and one or more providers 128:

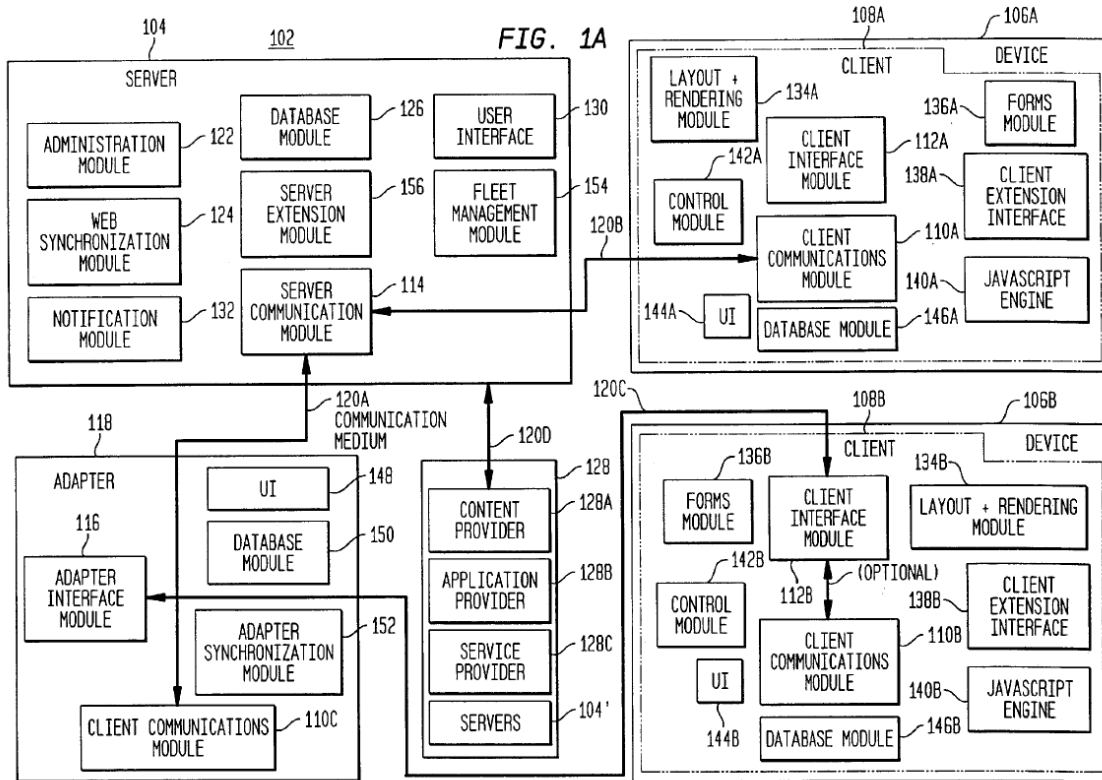


Figure 1A is a block diagram illustrating data processing environment 102 including server 104 and mobile computing devices 106. *Id.* at 7:21–27.

In Figure 1A, “devices 106 [(e.g., devices 106A, 106B)] may be any type of data processing device,” such as mobile computing devices including handheld computers, cellular phones, Internet-enabled phones, pagers, radios, TVs, audio devices, car audio systems, recorders, text-to-speech devices, bar-code scanners, net appliances, mini-browsers, and personal data assistants (PDAs). Ex. 1004, 4:24–39 (Table 2), 10:41–50. Device 106 may include software, hardware, and/or combinations thereof related to client functionality (e.g., layout and rendering, control, user interface, client interface, database), rendering the device a client (e.g., clients 108A and 108B correspond to devices 106A, 106B, respectively). *Id.* at 10:51–65. “Client communications module 110 enables the client 108 to interact with

external entities, such as server 104. In embodiments, the client communications module 110 enables TCP/IP traffic.” *Id.* at 12:13–16. Server 104 maintains channels of data, and adds selected channels to clients 108A, 108B. *See id.* at 8:4–6. A channel includes a collection of objects, such as applications, services, images, movies, music, and links that can be transferred to client 108. *Id.* at 7:27–31. According to Kloba,

[t]he server 104 offers channels to clients 108. A client 108 may access the server 104 and view the collection of channels. The client 108 may then select any combination of the channels in the collection. The server 104 maintains a list of the channels associated with each of the clients 108.

During a synchronization process, the server 104 loads a device 108 with the channels associated with the client 108. Generally, the server 104 does this by obtaining from providers 128 the objects defined by the channels, and causing those objects to be stored on the client 108. Thus, during the synchronization process, the server 104 will load the client 108 with the selected channels. More particularly, the server 104 will load the client 108 with the objects associated with the channels.

The client 108 may process and use those objects when not connected to the server 104. The invention enables the client 108 to actively interact with the objects and channels.

In one embodiment, the client 108A directly interacts with the server 104 via some transmission medium 120B, which may be any wired or wireless medium using any communication protocol.

....

[A] web synchronization module 124 [of server 104] is an application/instance of server extension module 156 [of server 104], and controls synchronization of web content to client 108. The invention may include other synchronization modules (which are application/instances of server extension module 156) that control synchronization of other types of objects to clients 108. For example, the server 104 may administer a calendar that may be installed on clients 108. The synchronization of appointments, events and/or dates on this calendar between

clients 108 and the server 104 may be performed by a calendar synchronization module.

Id. at 8:7–26, 9:10–21. During a synchronization, control module 142 (of a client 108) identifies “deltas” (differences between versions of objects offered and those in the client) in the client databases identified by server 104 and sends the deltas to a synchronization module of server 104, or a synchronization module generated by third parties (as shown in Figure 1B).

Id. at 10:35–40, 19:51–67. The synchronization modules synchronize the deltas with providers 128 and compile instructions to synchronize clients 108A, 108B with providers 128. *Id.* at 20:11–17. Control modules 142A, 142B on clients 108A, 108B then execute the instructions. *Id.* at 20:23–25.

Server 104 also optimizes the Web content to display the content within parameters of the client devices 108, for example, by scaling the content as shown in Figure 1AA, reproduced below. Ex. 1004, 6:35–41, 28:20–36.

FIG. 1AA

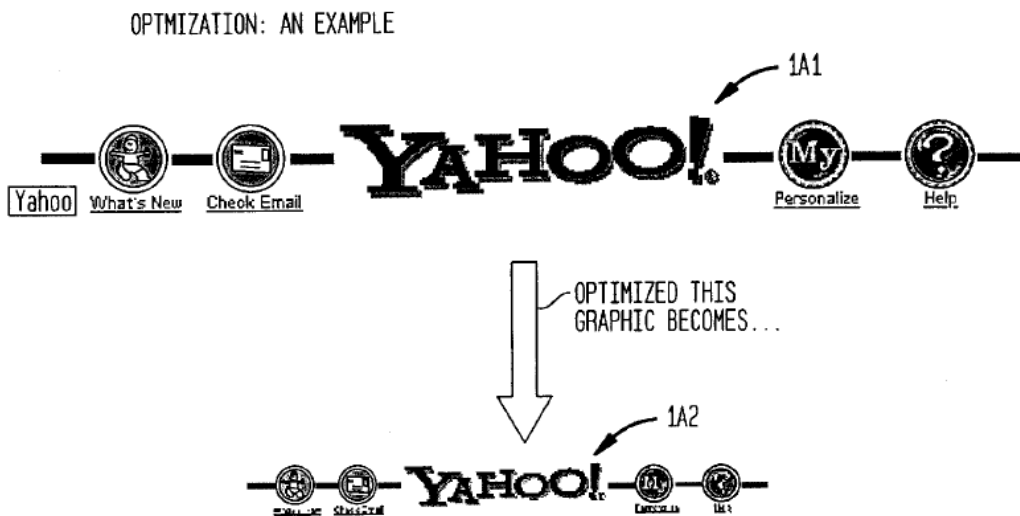


Figure 1AA illustrates a process that optimizes (via colors, size, etc.)

Web site page 1A1 for display 1A2 on a handheld device.
Id. at 6:35–40, 21:55–60, 28:30–31.

In Figure 1AA, Web page graphic display 1A1 represents a large screen desktop display, and Web page graphic display 1A2 represents an optimized version 1A2 of Web page graphic display 1A1 optimized to fit on handheld device 106/client 108. Ex. 1004, 28:32–36. Optimization of Web content display by server 104 enables the display to fit within the client's parameters, such as the client's dynamic memory specifications, high memory specifications, protected memory, storage memory, database memory, available storage space, screen size, user profile(s), color depth, applications on the device, buttons on the device, data markers, preferences, fonts, font specifications, sync type, supported data types, supported mime types, and connection/network profile. *Id.* at 28:21–30.

A user of a device can subscribe to a channel through the use of a user interface, including that of Figure 12, reproduced below:

FIG. 12



Figure 12 illustrates a screen shot of a channel subscription page displayed on client 108. *Id.* at 34:49–50.

During a synchronization, the server loads channels (e.g., FOX SPORTS, BLOOMBERG) selected by client 108 using the interface of Figure 12.

Ex. 1004, 34:49–54.

2. *Multer* (Ex. 1005)

Multer, titled “Data Transfer and Synchronization System,” describes systems for transferring data between two devices that require information to be shared between them. Ex. 1005, code (54), code (57), 5:11–13. Figures 1 and 2, reproduced below, illustrate configuration examples for transferring data between two devices:

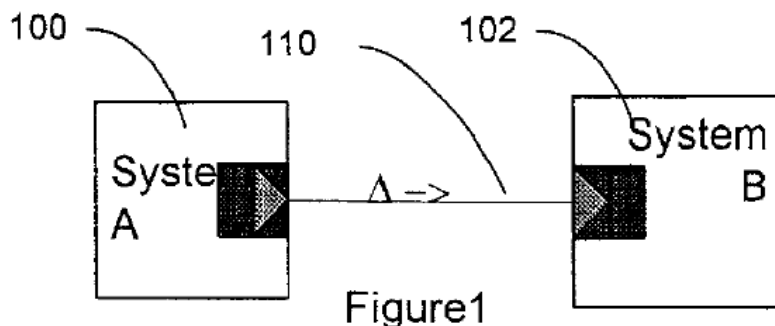
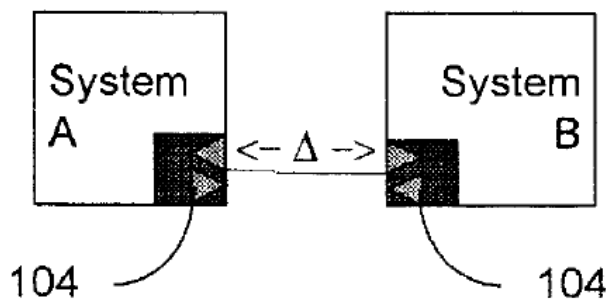


Figure 2



Figures 1 and 2 illustrate block diagrams of systems using differencing routines. *Id.* at 4:45–47, 5:57–60, 6:31–34.

In Figure 1, differencing transmitter 100 of System A examines a data structure of information to be transmitted to differencing receiver 102 of System B, extracts the information from System A, and converts it to difference information Δ . *Id.* at 5:57–6:8. Difference information Δ comprises only the changes to System B’s data that have occurred and instructions for implementing those changes on System B. *Id.* at 6:8–11. Differencing transmitter 100 transmits the difference information Δ to differencing receiver 102 via communication line 110. *See id.* at 5:60–65. “Difference information Δ received by differencing receiver 102 at System B is reconstructed at System B, and the changes reflected therein are updated on System B.” *Id.* at 6:16–19.

In Figure 2, both System A and System B include functional blocks 104, each representing a differencing synchronizer that will allow difference information Δ to be both transmitted and received. *Id.* at 6:31–37. For example, System A and System B represent a portable computer and a desktop computer, respectively, and differencing synchronizer 104 extracts changes to contact information on either System A or System B at predetermined times, transmits the information Δ between the systems, and reconstructs the data on the receiving system to update information from the sending system, thereby synchronizing contact information between Systems A and B. *Id.* at 6:37–46.

Multer describes a “pull” synchronization and a “push” synchronization. *Id.* at 35:4–18, 37:40–61, Fig. 15, Fig. 16.

Synchronization can be triggered automatically:

Each device has its own triggering mechanism for initiating synchronization. Some devices, such as Windows clients and Palm® pilots are triggered manually when the user presses a

“sync” button. Other devices, such as a cellular telephone, may be triggered automatically after another device completes a sync. Regular, time-based triggers are supported as well.

Id. at 35:4–18, Fig. 15. In a “push” synchronization, a device uploads difference information (Δ s) to a server. *Id.* at 37:40–61, Fig. 16.

3. *Hoyle (Ex. 1011)*

Hoyle, titled “Computer Interface Method and Apparatus with Targeted Advertising,” discloses a system “for providing an automatically upgradeable software application that includes targeted advertising based upon demographics and user interaction with the computer.” Ex. 1011, code (54), code (57). Hoyle discloses a system for targeting advertisements on user computers, which have a software application with a graphical user interface that includes a banner region for advertisements. *Id.* at 7:30–31. These advertisements are stored in a database on the computer. *Id.* at 14:59–60. The application collects “computer usage information” relating to usage of the computer, “including such things as what programs [users] run, what information resources they access, what time of day or days of the week they use the computer, and so forth.” *Id.* at 3:34–38. This usage information is periodically sent to an “Advertising and Data Management Server” (ADM), which is connected to computers via the Internet. *Id.* at 7:12–13, 7:41–42, 8:30–33. The ADM server uses the usage information to “better target[] future advertising to the end user.” *Id.* at 7:43–44. New banner advertisements are sent as needed from the ADM server to computers. *Id.* at 7:38–41.

4. *Davis*

Davis, titled “Method and Apparatus for Tracking Client Interaction with a Network Resource and Creating Client Profiles and Resource Database,” “relates to a method and apparatus for monitoring client use of and interaction with a resource downloaded from a server on a computer network, for storing monitored data, for creating a database including profiles indexed by user and/or resource identity, and for generating customized resources based upon client profiles.” Ex. 1007, code (54), 1:8–14.

5. *Loughran (Ex. 1008)*

Loughran, titled “Method and Apparatus for Automatic Content Handling,” describes a system for performing autonomous data transfer between an email server and a mobile device such as a notebook computer. Ex. 1008, code (54), code (57), Fig. 1. The mobile device connects to the email server via a wireless data connection and downloads the email. *Id.* at code (57). For example, the email server compiles an SMS message incorporating a digital signature and transmits the email to the mobile device using SMS messages sent in accordance with the GSM short messaging service. *Id.* ¶¶ 37–38, code (57). Loughran also notes

it is usual for laptops and other mobile computing devices to be switched off when not in use. . . . The alert module [GSM transceiver] associated with the mobile device could be maintained in a low power consumption standby mode and on receipt of an SMS message containing an “EMAIL” header, power up the notebook.

Id. ¶ 40.

6. *Fong (Ex. 1010)*

Fong, titled “System, Computer Program Product and Method for Managing and Controlling a Local Network of Electronic Devices,” describes “a main server including software for managing network resources from a single point of administration, wirelessly connecting a plurality of electronic devices to the main server to create a wireless local area network (LAN), and managing the electronic devices using the software.” Ex. 1010, code (54), code (57). In Fong’s system, “main server 200 monitors the management initiating parameters of all electronic devices 202–212 connected to the wireless LAN.” *Id.* at 9:49–51. In one example,

if the main server 200 is set up to monitor the battery power of mobile terminals 208 and 212 and send a message to all terminals indicating that a particular terminal battery must be charged, the management initiating parameter is the battery power and the action is sending a message to all terminals on the wireless network.

Id. at 10:10–16.

E. Obviousness of Claims 1–30

Petitioner argues that claims 1–6 and 13 would have been obvious in view of the combined teachings of Kloba, Multer, and Hoyle; claims 7, 14, 16, 17, and 19–25 would have been obvious in view of the combined teachings of Kloba, Multer, Hoyle, and Loughran; and claims 8–12, 15, 18, and 26–30 would have been obvious in view of the combined teachings of Kloba, Multer, Hoyle, Loughran, and Fong. Pet. 19–42, 47–73. Petitioner notes that these claims and grounds are “materially identical” to the claims and grounds addressed in the ’989 FWD, which determined all the claims of the ’989 patent are unpatentable. *Id.* at 1 (citing Ex. 1011 (comparing ’442 and ’989 patent claims); IPR2019–01205, Papers 43, 50). In Exhibit 1011,

Petitioner illustrates the similarities of the claims by providing a chart with claims 1–30 from the '442 and '989 patents side-by-side with underlines and strikethroughs added to the claims of the '442 patent to show the text added and deleted, respectively, relative to the '989 patent claims. Ex. 1011. Additionally, Petitioner notes for each of the claim elements in the '442 patent that the '989 FWD already determined that it was disclosed by the various combinations of Kloba, Multer, Hoyle, Loughran, and/or Fong. Pet. 19, 29, 30, 32, 35, 36, 47–73.

As noted above, Patent Owner has elected to waive its opportunity to submit a preliminary response to dispute Petitioner's contentions. Patent Owner's Notice of Waiving Preliminary Response, 1. And without the benefit of Patent Owner's input, we find at this stage of the proceeding that Petitioner's contention is persuasive that claims 1–30 of the '442 patent are insubstantially different than the ones we have already determined are unpatentable in the '989 FWD. Having studied the claims recited in both '989 patent and '442 patent, it is not evident that the '442 claims present materially different issues that alter the question of patentability.

For example, although the preambles for claims 1 and 20 in the '989 patent does not expressly recite each asset having “as on-device components” including “nonvolatile memory” (*see* Ex. 1011, 1,9), the '989 FWD determined that Kloba discloses a mobile device with nonvolatile memory. '989 FWD 39–40. Similarly, to the extent Element [1.f] of claim 1 and Element [1.g] of claim 20 in the '442 patent have been modified to more clearly recite that the “management instructions” are “based upon the results of having processed . . . the received consumer usage information” (*see* Ex. 1011, 2, 11), the '989 FWD determined that the

Kloba/Multer/Hoyle combination disclosed that too. *See* '989 FWD, 26–27, 57–68. Finally, regarding the different wording used for claims 4 and 22 in the '442 patent (*see* Ex. 1011, 4, 13), we find at this stage of the proceeding that the same findings and determinations for the corresponding claims in the '989 patent apply equally. *See* '989 FWD, 70–75.

As a result, we adopt and incorporate by reference our findings and determinations expressed in the '989 FWD that Petitioner has shown the combined teachings of Kloba, Multer, and Hoyle disclose the elements recited in claims 1–6 and 13; Kloba, Multer, Hoyle, and Loughran disclose the recited elements in claims 7, 14, 16, 17, and 19–25; Kloba, Multer, Hoyle, Loughran, and Fong disclose the recited elements in claims 8–12, 15, 18, and 26–30. *See* '989 FWD 38–86. Furthermore, after studying Petitioner's arguments and evidence regarding the claim elements in the '442 patent that have been modified from the corresponding ones in the '989 patent (*see* Pet. 19–28, 36–47, 51–53, 62–67), we find them persuasive and accept them as our own for purposes of institution. Therefore, on this record, we determine that Petitioner has shown a reasonable likelihood that it would prevail in showing the unpatentability of at least one of the challenged claims.

III. CONCLUSION

Based on the arguments in the Petition and the evidence of record, we determine that the Petition establishes a reasonable likelihood of prevailing in showing that claims 1–30 of the '442 patent are unpatentable.

Our factual findings, conclusions of law, and determinations at this stage of the proceeding are preliminary and based on the evidentiary record developed thus far. This is not a final decision as to the patentability of

claims for which *inter partes* review is instituted. Our final decision will be based on the record as fully developed during trial.

IV. ORDER

In consideration of the foregoing, it is hereby

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of all challenged claims of the '442 patent is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of the '442 patent is hereby instituted commencing on the entry date of this Decision, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial.

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