UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC, Petitioner,

v.

MIRA ADVANCED TECHNOLOGY SYSTEMS, INC., Patent Owner.

IPR2022-00742 Patent 10,594,854 B2

Before STACEY G. WHITE, JOHN A. HUDALLA, and JOHN R. KENNY, *Administrative Patent Judges*.

WHITE, Administrative Patent Judge.

JUDGMENT Final Written Decision Determining All Challenged Claims Unpatentable 35 U.S.C. § 318(a)

I. INTRODUCTION

Google LLC ("Petitioner") filed a Petition requesting *inter partes* review of claims 1–7 ("the challenged claims") of U.S. Patent No. 10,594,854 B2 (Ex. 1001, "the '854 patent"). Paper 1 ("Pet."). We instituted *inter partes* review of the challenged claims on all asserted grounds. Paper 13 ("Dec."). After institution, Mira Advanced Technology Systems, Inc. ("Patent Owner") filed a Corrected Patent Owner Response¹ (Paper 17, "PO Resp."), Petitioner filed a Reply (Paper 18, "Reply"), and Patent Owner filed a Sur-reply (Paper 23, "Sur-reply"). An oral hearing was held on July 28, 2023, and a transcript of the hearing is included in the record (Paper 27, "Tr.").

We have jurisdiction under 35 U.S.C. § 6. This Decision is issued pursuant to 35 U.S.C. § 318(a). For the reasons that follow, we determine Petitioner has shown, by a preponderance of the evidence, that claims 1–7 of the '854 patent are unpatentable.

A. Related Matters

The parties indicate that the '854 patent is subject to the following district court proceeding: *Mira Advanced Technology Systems, Inc. v. Google LLC*, No. 1:21-cv-07931 (S.D.N.Y.). Pet. 2; Paper 5, 1.

B. The '854 Patent

The '854 patent is titled "Location Based Personal Organizer." Ex. 1001, code (54). Generally, the '854 patent describes a system for linking a task to be performed at a physical location listed in a contact list

¹ We authorized Patent Owner to file the Corrected Patent Owner Response (Paper 17) to address typographical errors in its original Patent Owner Response (Paper 16). We refer exclusively to the Corrected Patent Owner Response in this Decision.

with global position system ("GPS") coordinates for that location. *Id.* at 1:55–62. Both the task and the location are stored in a communication device, such as a mobile phone. *Id.* at 1:24–34; 1:55–58. The communication device will then display the task when the device is at the appropriate location. *Id.* at 1:64–65.

Figure 4 of the '854 patent is reproduced below.



Fig. 4

Figure 4 shows a flow diagram illustrating a method for generating a GPS enabled contact list. Ex. 1001, 2:17–23. Communication device 11 is shown at the top of Figure 4. Id. at 4:31–35. A downward arrow points from the bottom of communication device 11 to a contact list. Id. at Fig. 4. "[C]ontact list (CL) is provided in communication device with means for users to enter contact information of individuals and businesses." Id. at 3:1-3. In Figure 4, the contact list is depicted as a data table with business names in the first column, followed by data fields in the columns to the right, titled in the following sequence: Name, Address, City, State, Zip, Phone, Fax, URL, GPS, and Task. Id. at Fig. 4. A user may enter "unique identifier information," such as phone number 43, into the data field for a new contact list entry, without any additional information in other data fields. Id. at 4:31–35. A downward arrow points from the bottom of the contact list to web server 21 equipped with GPS receiver 42, which communicates (shown as a bidirectional arrow) with GPS satellite 10. Id. at 4:24–27. A downward arrow points from the bottom of web server 21 to the contact list showing that the remaining data fields are automatically populated from the web server based on the GPS coordinates corresponding to the location identified by the user. Id. at 4:35–42. "Preferably, contact information database in web server (21) and contact list database in communication device (11) have identical structure." Id. 4:40-42.

Figure 6 of the '854 patent is reproduced below.

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Figure 6 shows a flow diagram illustrating a method for displaying a task list reminder. Ex. 1007, 5:14–15. GPS satellite 10 is shown at the top of Figure 6. A bidirectional arrow is located between GPS satellite 10 and communication device 11. *Id.* at Fig. 6. An arrow points from the right side of communication device 11 to "means to determine GPS coordinates of current location of communication device" 62. *Id.* at 5:4–7.

Communication device 11 determines (arrow 63) if its current GPS location matches with GPS coordinates in the contact list. *Id.* at 5:7–10. If the current location GPS matches the contact list GPS entry, communication device 11 determines whether a task is associated with the contact list entry. *Id.* at 5:10–13. When the task from task list 61 matches the GPS coordinates, communication device 11 displays a task list reminder to a user shown as arrow 64 pointing from the contact list to the display of communication device 11. *Id.* at 5:14–17.

C. Illustrative Claim

Of the challenged claims, claim 1 is independent. Claims 2–7 depend directly from claim 1. Claim 1 is reproduced below.

 $[1. \text{ pre.a}]^2$ 1. A method for providing location-based notifications using (i) a mobile communication device of a user equipped with an on-board GPS device and (ii) a remote geo-code database accessible through a remote server,

[1.pre.b] the remote geo-code database storing contact information linked to geographical locations such that each stored set of GPS coordinates corresponding to a respective geographical location is mapped to a respective set of contact information of an entity located at the respective geographical location,

[1.pre.c] the mobile device configured to be communicable to and from the remote server,

[1.pre.d] the mobile device configured to store and display a first collection of one or more viewable entries,

² The labels come from Petitioner's parsing of the claims into pre.a-pre.h for the claim's preamble and 1.a-1.h for the body of the claim. *See* Pet. 12–25 (preamble) and 25–40 (claim body).

[1.pre.e] each said viewable entry configured to be linked with a respective geographical location,

[1.pre.f] each said viewable entry configured to store a location-denoting text denoting the respective geographical location and a respective set of GPS coordinates identifying the respective geographical location,

[1.pre.g] each said viewable entry configured to store a respective reminder text denoting a respective task linked with the respective geographical location,

[1.pre.h] each said viewable entry configured to have a respective set of user interfaces, which, when selectively displayed on the mobile device, enable the user, for the respective viewable entry, to at least (a) search for, through use of the remote geo-code database, the respective location-denoting text and the respective set of GPS coordinates^{3 4} and (b) view at least both the respective location-denoting text and the respective reminder text, the method comprising:

[1.a] the mobile device displaying a first set of one or more user interfaces enabling the user to input a first input text for the respective reminder text of a first viewable entry of the first collection so that the mobile device receives and stores the first input text as the respective reminder text of the first viewable entry subsequently viewable through the respective set of user interfaces thereof;

³ Patent Owner uses a different nomenclature when referring to the part of the claim. In particular, Patent Owner discusses a portion of the claim that it refers to as CL 1.a. CL 1.a covers majority of the limitation that Petitioner has labeled pre.h from the beginning of pre.h up through the end of the subsection (a) of this portion of the preamble (this portion of limitation 1.pre.h that is CL1.1 is italicized).

⁴ For the purposes of the Decision, we use Petitioner's nomenclature wherever possible.

- [1.b]⁵ the mobile device displaying a second set of one or more user interfaces included in the respective set of user interfaces of the first viewable entry, the second set of one or more user interfaces enabling the user to input text on contact information of an entity located at the respective geographical location of the first viewable entry in using the user-inputted contact information to acquire both the respective locationdenoting text and the respective set of GPS coordinates of the first viewable entry through use of the remote geo-code database, the second set of one or more user interfaces including at least a first user interface element enabling the user to input a second input text for searching against a first set of one or more data fields of contact information of an entity located at the respective geographical location of the first viewable entry;
 - [1.c] the mobile device sending to the remote server a search request including the second input text and indicating a search criterion of the second input text being used to search against the first set of one or more data fields of contact information of an entity, the search request requesting for searching for, based on the search criterion, at least one result entity meeting the search criterion;
 - [1.d] the mobile device receiving from the remote server a set of result data of a first result entity including a respective set of contact information of the first result entity and a respective set of GPS coordinates of the first result entity identifying a respective geographical location where the first result entity is located, as a result of the remote server, upon receiving from the mobile device the search request, performing a search operation against the remote geo-code database based on the search criterion and

⁵ Patent Owner refers to the portion of the claim Petitioner has labeled 1.b as CL 1.b.

retrieving from the remote geo-code database, as a result of the search operation, the set of result data of the first result entity;

- [1.e]⁶ the mobile device setting and storing a first subset of the received respective set of contact information of the first result entity and the received respective set of GPS coordinates of the first result entity, as the respective location-denoting text of the first viewable entry and the respective set of GPS coordinates of the first viewable entry, respectively; and
- [1.f] the mobile device displaying an indication indicating a presence of the respective reminder text of the first viewable entry to remind the user of performing of the respective task denoted by the respective reminder text when a set of contemporaneous GPS coordinates of the mobile device corresponding to a contemporaneous geographical location of the mobile device, as captured by the on-board GPS device of the mobile device, corresponds with the stored respective set of GPS coordinates of the first viewable entry; and
- [1.g]⁷ wherein the second set of user interfaces include at least a first user interface enabling the user to input a set of one or more identifier values for a respective set of one or more data fields of contact information of an entity located at the respective geographical location of the first viewable entry, in uniquely identifying an entity located at the respective geographical location of the first viewable entry through use of the remote geo-database; and

⁶ Patent Owner refers to this portion of the claim as CL2.

⁷ Patent Owner refers to this portion of the claim as CL 1.c.

[1.h]⁸ wherein the set of one or more identifier values for the respective set of one or more data fields of contact information of an entity located at the respective geographical location of the first viewable entry, is calculated to be used as unique identifier information to uniquely identify an entity located at the respective geographical location of the first viewable entry through use of the remote geocode database.

Ex. 1001, 6:17–8:10.

D. Asserted Ground of Unpatentability

Petitioner asserts that claims 1–7 of the '854 patent would have been unpatentable on the following ground:

Claim(s) Challenged 35 U.S.C. §		Reference(s)/Basis	
1–7	$103(a)^9$	Dunton ¹⁰ , Barchi ¹¹ , Bedingfield ¹²	

Pet. 3. In support of its assertions, Petitioner submits declarations from Christopher Schmandt. Exs. 1003, 1020. Patent Owner did not provide declaration testimony.

⁸ Patent Owner refers to this portion of the claim as CL 1.d.

⁹ We apply the pre-AIA version of 35 U.S.C. § 103 because the claims at issue have an effective filing date prior to March 16, 2013, the effective date of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) ("AIA"). *See* Ex. 1001, code (22).

¹⁰ Dunton, US 2006/0061488 A1, pub. Mar. 23, 2006 (Ex. 1006, "Dunton")
¹¹ Barchi, U.S. Pat. No. 7,187,932 B1, issued Mar. 6, 2007 (Ex. 1008, "Barchi")

¹² Bedingfield, SR., US 2004/0260604 A1, pub. Dec. 23, 2004 (Ex. 1009, "Bedingfield")

II. ANALYSIS

A. Level of Ordinary Skill in the Art

In order to determine whether an invention would have been obvious at the time the application was filed, we consider the level of ordinary skill in the pertinent art at that critical time. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). The resolution of this question is important because it allows us to "maintain[] objectivity in the obviousness inquiry." Ryko Mfg. Co. v. Nu-Star, Inc., 950 F.2d 714, 718 (Fed. Cir. 1991). In assessing the level of ordinary skill in the art, various factors may be considered, including the "type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field." In re GPAC, Inc., 57 F.3d 1573, 1579 (Fed. Cir. 1995). Generally, it is easier to establish obviousness under a higher level of ordinary skill in the art. Innovention Toys, LLC v. MGA Entm't, Inc., 637 F.3d 1314, 1323 (Fed. Cir. 2011) ("A less sophisticated level of skill generally favors a determination of nonobviousness . . . while a higher level of skill favors the reverse.").

Here, Petitioner asserts that a person having ordinary skill in the art "in the technology field of the '854 Patent had a bachelor's degree in Computer Science, Computer Engineering, or Electrical Engineering, or an equivalent course of study, as well as 2 or more years of academic or industry experience in the field of wireless communication devices and location-based services." Pet. 12 (citing Ex. 1003 ¶ 65).

Patent Owner "generally agrees with Petitioner" as to the level of ordinary skill in the art and does not propose any changes to Petitioner's definition. PO Resp. 8.

Petitioner's description is consistent with the prior art and patent specification currently before us. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (prior art itself may reflect an appropriate level of skill). For purposes of our Decision, we adopt Petitioner's description.

B. Claim Construction

In an *inter partes* review proceeding, a patent claim shall be construed 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) (as amended Oct. 11, 2018). Our rule adopts the same claim construction standard used by Article III federal courts, which follow *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), and its progeny. Under this standard, the words of a claim are generally 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. *See Phillips*, 415 F.3d at 1312–13. Petitioner "interpret[s] all claim terms in accordance with their ordinary and customary meaning." Pet. 12. Patent Owner has not put forth any arguments in its papers related to claim construction.¹³ *See* PO Resp. 2. We determine that no claim terms require express construction for purposes of this Decision.

¹³ At the oral hearing, Patent Owner's counsel indicated that a formal claim construction would be useful, but he also stated that "it's too late to do anything like claim construction." Tr. 43:1–6, 34:8–12. Notwithstanding Patent Owner's comments at the oral hearing, we find that the issues in the case are amenable to resolution without an express claim construction.

C. Overview of the Asserted Prior Art 1. Dunton (Ex. 1006)

Dunton describes managing a task list on a communication device, e.g., a cellular telephone. Ex. 1006 ¶¶ 1, 5. According to Dunton, known techniques for managing task lists may be subject to various problems, because users may fail to input dates and times in a scheduling application software, may not be near the necessary resources to accomplish a task at the date and time entered by the user, or may not be given proper notification of a task reminder. *Id.* ¶¶ 5, 14. To address these issues, Dunton discloses a task management module ("TMM") that creates a task item and associates the task item with a task location. *Id.* ¶ 15. The TMM may be application software integrated with scheduling application software on a mobile or cellular telephone. *Id.* ¶¶ 11–13. The cellular telephone may include a GPS module communicating with a GPS source for determining device location. *Id.* ¶¶ 10–11.

Figure 3 is a flow diagram of the process for associating a task location with a task item, and is reproduced below. *Id.* ¶ 32.





FIG. 3

Figure 3, reproduced above, illustrates programming logic for the steps of: 1) creating a task item for a task list (block 302), 2) associating a task location with the task item (block 304), 3) locating a device location represented by GPS coordinates (block 306), 4) comparing the device location to the task location (block 308), and 5) generating a task reminder for the task item if the device location is near the task location (block 310). Ex. 1006 ¶ 32. Dunton describes each of these steps in further detail.

For example, Dunton describes a first step of creating "a task item in a conventional manner, such as entering a description of the task, a due date

for completion of the task, a category for the task, a priority level for the task, and so forth." *Id.* ¶ 26. Dunton describes a second step in which the TMM associates the task with a task location including "any location information that would assist a user in remembering to perform a given task." *Id.* Dunton discloses that the TMM may automatically retrieve location information, including an address, telephone number, and GPS coordinates, via an external database made available by a server via a network. *Id.* ¶ 15. Dunton discloses another embodiment in which a user may input the name for a location or touch a location on a map shown on a device display. *Id.* ¶ 34. The TMM may then retrieve location information from a location table or GPS map. *Id.* "The location table may comprise a data structure having a set of location names and their corresponding location information and may be formed and updated using information retrieved from [an external or internal] database." *Id.* ¶ 35.

Once the task list is populated with task items and task locations, the TMM "may receive the device location from the GPS module and compare the device location with the task location." *Id.* ¶ 16. The TMM "may then generate a task reminder for the task item if the device location is within a predetermined proximity range of the task location." *Id.* Specifically, the TMM may provide the task reminder as a notification via an indicator system. *Id.* ¶ 26. The indicator system "may be implemented with a number of visual, audible or sensory indicators capable of conveying information to a user," such as a text message on a display. *Id.* ¶¶ 28, 29.

Dunton's Table 1, which illustrates "a task list having multiple task items with associated task locations and indicator parameters," is reproduced below.

Task Item	Task Location	Indicator Parameter	Proximity Range
Buy Groceries	Location A	000 - Provide Continuous Beening	1.0 miles
Drop Off Dry Cleaning	Location B	001 - Audibly reproduce Task Item using Text-To-Speech	1.5 miles
Deliver Present To Friend	Location C	010 - Display Task Item	0.25 miles

TABLE 1

Ex. 1006 ¶ 37.

2. Barchi (Ex. 1008)

Barchi notes that it can be difficult to manage contact information in a database stored in a cellular telephone. Ex. 1008, 1:29–35. Barchi describes a need to permit a user to access and revise contact data, such as phone numbers and addresses on a cellular telephone. *Id*. To address this need, Barchi discloses automatically storing additional or revised contact information with an Internet-based search engine or database by using a reverse phone number lookup. *Id*. at code (57).

3. Bedingfield (Ex. 1009)

Bedingfield describes a system for a user to "access location-based yellow pages service," via a wireless communication network or the Internet. Ex. 1009 ¶ 22. Bedingfield discloses that "[k]nown network systems can determine user measured location information by identifying a street address . . . based on a phone number and then querying a geographic information system with the street address information." *Id.* For example, a user may enter a fixed-location telephone number and the location can be determined with "an automatic location database (e.g., an automatic location database comparable or similar to an automatic location information ('ALI')

database of an Enhanced 911 ('E-911') system)." *Id.* The location information may be provided as GPS information. *Id.* \P 21.

D. Obviousness over Dunton, Barchi, and Bedingfield

Petitioner asserts that claims 1–7 are unpatentable under 35 U.S.C. § 103(a) as obvious over Dunton, Barchi, and Bedingfield, citing the Declaration of Christopher Schmandt for support. Pet. 12–45 (citing Ex. 1003). Patent Owner counters that Petitioner does not show the integration required by the claim language. PO Resp. 13–24. Patent Owner further argues that secondary considerations also demonstrate nonobviousness. *Id.* at 24.

1. Independent Claim 1

Upon consideration of parties' contentions and supporting evidence in this full record, we are persuaded by Petitioner's showing and find that Petitioner has demonstrated that the limitations recited in independent claim 1 are taught by Dunton, Barchi, and Bedingfield. *See* Pet. 12–45. We address claim 1 below.

a) Summarizing Petitioner's Contentions

Petitioner's arguments are summarized as follows. With respect to the first part of the preamble¹⁴, Petitioner asserts that Dunton alone or combined with Bedingfield teaches location-based notifications through a location-based task reminder for mobile phones including an on-board GPS device. Pet. 13 (citing Ex. 1003 ¶¶ 146–154; Ex. 1006 ¶¶ 10, 11). Petitioner asserts that Dunton teaches "a remote geo-code database accessible through

¹⁴ We need not decide whether the preamble recitation is limiting because Petitioner establishes that it would have been taught or at least suggested by the cited art.

a remote server" *Id.* at 14 (citing Ex. 1006 ¶ 15). Alternatively, Petitioner asserts that Bedingfield discloses a remote geo-code database in the form of an automatic location database. *Id.* at 14–15 (citing Ex. 1009 ¶ 22; Ex. 1003 ¶ 153). Petitioner contends that one of ordinary skill would have been motivated to incorporate Bedingfield's disclosure of an automatic location database (i.e., geo-code database) to retrieve location information into Dunton to meet Dunton's stated objective of providing techniques for improving task management and that one of ordinary skill in the art would have had a reasonable expectation of success in combining these teachings. *Id.* at 15 (citing Ex. 1006 ¶ 1).

Petitioner asserts that Dunton and Bedingfield teach the remaining limitations recited in the preamble. *Id.* at 17–25 (citing Ex. 1003 ¶¶ 155– 176). In particular, Petitioner asserts that Dunton teaches "the mobile device configured to store and display a first collection of one or more viewable entries" (claim 1.pre.d.)¹⁵ because Dunton teaches displaying task reminders when the mobile device comes within proximity to a task location. *Id.* at 18–19 (citing Ex. 1003 ¶¶ 106–161; Ex. 1006 ¶¶ 26, 28, 29). Petitioner further asserts Dunton and Bedingfield teach (claim 1.pre.h):

each said viewable entry configured to have a respective set of user interfaces, which, when selectively displayed on the mobile device, enable the user, for the respective viewable entry, to at least (a) search for, through use of the remote geo-code database, the respective location-denoting text and the respective set of GPS coordinates and (b) view at least both the respective location denoting text and the respective reminder text[.]

¹⁵ Petitioner's discussion breaks up claim 1's preamble into parts pre.a through pre.h and breaks up the other elements of claim 1 into parts 1.a through 1.h. *See* Pet. 12–40. For ease of reference, we refer to Petitioner's labeling of the constituent parts of the claim.

Id. at 21–25 (citing Ex. 1003 ¶¶ 169–176). As to subsection (a) of 1.pre.h, Petitioner asserts that "Dunton teaches user interfaces for searching for location-denoting text and/or respective GPS coordinates." *Id.* at 22 (citing Ex. 1006 ¶¶ 34, 15). As to subsection (b) of 1.pre.h, Petitioner asserts that Dunton teaches viewing reminder texts through a display to notify users of task reminders. *Id.* (citing Ex. 1006 ¶¶ 26, 28, 29, 40). Petitioner asserts that Bedingfield also teaches using a geo-code database to search for location-denoting text and GPS coordinates. *Id.* at 23–24 (citing Ex. 1009 ¶¶ 22, 21; Ex. 1003 ¶¶ 153, 172). Petitioner further asserts that Bedingfield teaches displaying the names of advertisers along with location-denoting text (address and phone number) associated with geographic locations. *Id.* at 23 (citing Ex. 1009 ¶¶ 35, 47).

With respect to the limitation of "the mobile device displaying a first set of one or more users interfaces enabling the user to input a first input text for the respective reminder text . . ." (claim 1.a), Petitioner asserts that Dunton teaches this limitation through its discussion of a TMM (user interface) for inputting task items (reminder texts) that "are part of viewable entries because they are stored and subsequently viewable through, e.g., text on user interfaces (displays)." *Id.* at 25 (citing Ex. 1003 ¶¶ 177–180; Ex. 1006 ¶¶ 26, 18, 19, 13, 29).

For limitation 1.b, which recites "the mobile device displaying a second set of one or more user interfaces included in the respective set of user interfaces of the first viewable entry, . . . enabling the user to input text on contact information of an entity located at the respective geographical location," Petitioner asserts that Dunton teaches this limitation through its discussion of "inputting a name (a second input text for searching against a first set of . . . contact information) to search for location information that

corresponds to the claimed 'geographic location of the first viewable entry.'" *Id.* at 26–27 (citing Ex. 1006 ¶ 34). Petitioner asserts that this input functionality is a second set of one or more user interfaces. *Id.* at 27 (citing Ex. 1003 ¶ 183). Additionally, Petitioner asserts that Bedingfield teaches "a user inputting a phone number (a second input text) for searching against contact information of an entity located at a respective geographical location to receive information regarding the entity." *Id.* at 27–28 (citing Ex. 1009 ¶¶ 21, 22).

Regarding limitation 1.c, which recites "sending to the remote server a search request" and limitation 1.d, which recites "receiving from the remote server a set of result data", Petitioner asserts that Dunton teaches the user inputting a name for a location into a mobile device to retrieve location information from a location table that is part of the TMM or a remote database located on a server. *Id.* at 30 (citing Ex. 1003 ¶¶ 190–191; Ex. 1006 ¶¶ 15, 34, 35). Petitioner further asserts that Dunton discloses that the received data may include "contact information (*e.g.*, address or phone number) and GPS coordinates from a remote server." *Id.* at 31 (citing Ex. 1003 ¶¶ 192–194; Ex. 1006 ¶¶ 15, 34–36).

With respect to the limitation "setting and storing a first subset of the received respective set of contact information . . . and the received respective set of GPS coordinates . . . , as the respective location-denoting text of the first viewable entry and the respective set of GPS coordinates of the first viewable entry, respectively" (claim 1.e.), Petitioner asserts that Dunton teaches this limitation through its discussion of "a scheduling application integrated with TMM 106 that can 'associate a task location with the task." *Id.* at 32 (citing Ex. 1006 \P 26). More specifically, Petitioner asserts that Dunton teaches storing location names and GPS coordinates of the first

viewable entry which comprises a reminder text. *Id.* at 32-33 (citing Ex. 1006 ¶ 29).

For the limitation of "the mobile device displaying an indication indicating a presence of the respective reminder text of the first viewable entry to remind the user of performing of the respective task" (claim 1.f), Petitioner asserts that Dunton teaches this limitation through its discussion of using GPS coordinates to determine if a mobile device is within a certain predetermined proximity range of the task location and then displaying a reminder text. *Id.* at 33–35 (citing Ex. 1003 ¶¶ 198–200; Ex. 1006 ¶¶ 16, 29, 32, Fig. 3).

For the limitation, "wherein the second set of user interfaces include at least a first user interface enabling the user to input a set of one or more identifier values . . ." (claim 1.g), Petitioner asserts that Dunton alone or combined with Barchi teaches this limitation. Id. at 35-38 (citing Ex. 1003 ¶ 201–202). Specifically, Petitioner asserts that Dunton teaches "that a user may enter contact information as location information that uniquely identifies an entity's location," wherein the location information may include "longitude and latitude coordinates for a map, an address, telephone number, GPS coordinates, and so forth." Id. at 36 (citing Ex. 1006 ¶¶ 26, 15). Alternatively, Petitioner asserts that Barchi teaches "using a phone number associated with an entity at a geographic location to search for additional contact information and store that information." Id. (citing Ex. 1008, code (57)). Petitioner asserts that one of ordinary skill would have been motivated to look to Barchi to "obtain additional contact information using techniques like the reverse phone number lookup," thereby allowing Dunton's location-based task reminder to automatically obtain additional information related to tasks of interest. Id. at 37 (citing Ex. 1008, 3:10–14).

Regarding the limitation "wherein the set of one or more identifier values . . . is calculated to be used as unique identifier information to uniquely identify an entity located at the respective geographical location of the first viewable entry through use of the remote geo-code database" (claim 1.h), Petitioner asserts that Dunton alone or combined with Bedingfield teaches manually entering location information and then using "a remote geo-code database for uniquely identifying specific locations of entities." *Id.* at 39 (citing Ex. 1003 ¶¶ 203–204; Ex. 1006 ¶ 15).

b) Addressing Patent Owner's Arguments

Patent Owner's arguments are premised upon its assertion that certain integration features—which are not expressly recited in the claims—are nonetheless a required part of the claims. Patent Owner describes the asserted integration as follows:

The '854 patent claims an innovative location-based reminder function resulting from ingenuity of the inventor in coming up with the notion of integrating a conventional address book (which otherwise does not have a field of GPS coordinates for each row) with a personal organizer (organizing events or tasks) in such a manner that (1) a respective set of one or more user interfaces is integrated into a respective reminder entry[¹⁶] to obtain a respective set of GPS coordinates through a use of a well-known remote geo-code database in a specific manner (hereinafter "integrating feature 1") and (2) the obtained respective set of GPS coordinates is integrated into the respective reminder entry as well in that the obtained respective set of GPS coordinates is stored within the respective reminder entry as a part thereof (hereinafter "integrating feature 2").

PO Resp. 1. In support of its position, Patent Owner directs us to the Summary of the Invention of the '854 patent which states that "[m]eans is

¹⁶ Patent Owner uses the term "reminder entry" to refer to the viewable entry recited in the preamble of claim 1. *See* Sur-reply 3 n.1.

provided to *integrate* GPS coordinates corresponding to physical address contained in its contact list." *Id.* at 2 (citing Ex. 1001, 1:55–58) (emphasis added). Patent Owner also directs us to the description of Figure 5, which states, "FIG. 5 shows a method of generation of GPS enabled contact list entry in contact list of communication device by means of download of GPS enabled contact information database from web server and subsequent *integration* with contact information database of communication device." *Id.* at 3 (citing Ex. 1001, 2:29–33) (emphasis added). Patent Owner also asserts that Figures 1, 4, and 5 of the '854 patent exemplify the asserted integration requirement. *Id.* at 1–4.

The term integration does not appear in the claims. In the absence of this term, Patent Owner directs us to several claim limitations that Patent Owner argues "realize[]" the integrating features by a combination of claim language. *Id.* at 4–6. Specifically, Patent Owner directs us to CL1.a¹⁷, CL1.b, CL1.c and CL1.d. as realizing "integrating feature 1" and CL 2 as realizing "integrating feature 2" (also referred to as "Claim Limitation 2" or "CL2"). The language of the limitations relied upon is reproduced below.

CL1.a "each said viewable entry configured to have a respective set of user interfaces, which, when selectively displayed on the mobile device, enable the user, for the respective viewable entry, to at least (a) search for, through use of the remote geo-code database, the respective location-denoting text and the respective set of GPS coordinates..." (emphasis added)

¹⁷ As noted above, Patent Owner uses a different nomenclature for the portion of the claim than language than the nomenclature used by Petitioner. The specific portion of the claim that Patent Owner refers are indicated above as part of the discussion of the illustrative claim (*see* § I.C.).

CL1.b	"the mobile device displaying a second set of one or more user
	interfaces included in the respective set of user interfaces of the
	first viewable entry, the second set of one or more user interfaces
	enabling the user to input text on contact information of an entity
	located at the respective geographical location of the first
	viewable entry in using the user-inputted contact information to
	acquire both the respective location-denoting text and the
	respective set of GPS coordinates of the first viewable entry
	through use of the remote geo-code database, the second set of
	one or more user interfaces including at least a first user
	interface element enabling the user to input a second input text
	for searching against a first set of one or more data fields of
	contact information of an entity located at the respective
	geographical location of the first viewable entry" (emphasis
	added)
CL1.c	"wherein the second set of user interfaces include at least a first
	user interface enabling the user to input a set of one or more
	identifier values for a respective set of one or more data fields of
	contact information of an entity located at the respective
	geographical location of the first viewable entry, in uniquely
	identifying an entity located at the respective geographical
	location of the first viewable entry through use of the remote
	geo-database" (emphasis added)
CL1.d	"wherein the set of one or more identifier values for the
	respective set of one or more data fields of contact information
	of an entity located at the respective geographical location of the
	<i>first viewable entry</i> , is calculated to be used as unique identifier
	information to uniquely identify an entity located at the
	respective geographical location of the first viewable entry
	through use of the remote geo-code database." (emphasis added)
CL2	The mobile device setting and storing a first subset of the
	received respective set of contact information of the first result
	entity and the received respective set of GPS coordinates of the
	Jirst result entity, as the respective location-aenoting text of the
	JIRST VIEWABLE entry and the respective set of GPS coordinates of
	ine jirsi viewable entry, respectively (emphasis added)

Id. at 5–6.

According to Patent Owner, CL 1.a (Ex. 1001, 6:36–42) recites that each "viewable entry" (e.g., a reminder to pick up milk) is configured to have a set of user interfaces, and this language indicates that the user interfaces "are provided to enable a user to obtain a matching set of GPS coordinates of the reminder entry through a use of the remote geo-code database as claimed, and therefore are integrated into the reminder entry." *See* PO Resp. 6. Similarly, Patent Owner argues that CL 1.b (Ex. 1001, 6:52–67), CL 1.c (*id.* at 7:39–44), and CL 1.d (*id.* at 8:1–11) each recite user interfaces "of" the viewable entry further reinforcing that the user interface is integrated into the viewable entry. PO Resp. 6–7.

As to the second integrating feature, Patent Owner contends that limitation CL2 (Ex. 1001, 7:22–28) recites the mobile device "setting and storing" contact information received from the geo-code database as the location-denoting text "of" the viewable entry. PO Resp. 6. Patent Owner argues that the language of CL2 indicates that "the obtained respective set of GPS coordinates is integrated into the respective reminder entry as well in that the obtained set of GPS coordinates is stored within the respective reminder entry as a part thereof." *Id.* at 8 (emphasis omitted).

Patent Owner contends that "the key and essence of the claimed subject matter is its integration aspect, which at least comprises Claim Limitation 1 (i.e. the combination of CL1.a, CL1.b, CL1.c and CL1.d) and Claim Limitation 2 (i.e., CL2)." *Id.* at 13. According to Patent Owner, we misunderstood its assertions regarding integration in our Decision on Institution and that

integration . . . is not the integration between the database and the user interfaces, as the Decision states. In fact, Patent Owner agrees with the Decision that there is no integration between the database and the user interfaces, in that the user interfaces are

loosely coupled to the database. Rather, the integration which the Patent Owner has referred to, comprises . . . the integrating between a respective set of user interfaces as claimed and a respective reminder entry, of which the respective set of user interface as claimed is a part.

Id. at 17 (emphasis omitted).

Patent Owner asserts that the cited art fails to teach integrating features 1 and 2. *Id.* at 13–14. Specifically, Patent Owner argues that in Dunton "the pre-set location table is separate from, and therefore is not part of, the respective reminder entry in the sense that the pre-set location table exists independent of a respective reminder entry." *Id.* at 14 (emphasis omitted).

We do not agree with Patent Owner's assertions. As Patent Owner admits, the term integration does not appear in the '854 patent claims. *See id.* at 18 ("the claim language . . . does not expressly use the term 'integration'"). The '854 patent specification only contains three mentions of integration. The Summary states that a means is provided "to integrate GPS coordinates . . . in its contact list." Ex. 1001, 1:56–57. The brief description of Figure 5 describes depicting a "method of generation of GPS enabled contact list entry . . . and subsequent integration with contact information database." *Id.* at 2:24–25. The third and final mention of integration was of a "GPS receiver integrated with communication device." *Id.* at 5:28–29. Thus, none of the mentions of integration in the specification describe integration of the user interface and the reminder entry. As such, we find no support for Patent Owner's arguments in the '854 patent specification.

In addition, we are not persuaded by Patent Owner's argument that the integration purportedly required by the claims of the '854 patent is distinct

from association as described in the cited references. Patent Owner "admits that the idea of associating GPS coordinates with a location name and storing that information on a server (e.g., claims 1.pre.b-f, 1.b-e, 1.g and 1.h, as enumerated in the Petition) was known in the prior art." PO Resp. 2. According to Patent Owner, however, "the ordered combination of CL1 and CL2, a respective reminder entry does NOT *associate* the set of GPS coordinates, but instead *contains* and *includes* the set of GPS coordinates, since the claim language uses the term 'of' to define the relationship between the respective set of GPS coordinates and a respective reminder entry as claimed." Sur-reply 6.

This argument is not persuasive because we see no support in the claims for such a requirement. As an initial matter, we do not find the word "of" to be limited to situations in which the GPS coordinates are contained or included within the viewable entry. The word "of" indicates a relationship, but it is not a narrow term and it is inclusive of a variety of relationships. For example, the coordinates of a grocery store need not be included in or contained within the grocery store and the same is true for the "GPS coordinates of the first viewable entry." The word "of" indicates the relationship between the GPS coordinates and the viewable entry, but it does not narrowly limit it in the way proposed by Patent Owner. See Ex. 3001 (providing eighteen definitions for the term "of," including "associated with," THE AMERICAN HERITAGE DICTIONARY (1994)). Claim 1 recites, in relevant part, "viewable entry configured to store a location-denoting text denoting the respective geographical location and a respective set of GPS coordinates." Ex. 1001, 6:30–32. It further requires "acquir[ing] both the respective location-denoting text and the respective set of GPS coordinates of the first viewable entry through use of the remote geo-code database." Id.

at 6:59–62. As such, claim 1 requires obtaining GPS coordinates from a database and storing that information. Claim 1, however, does not specify or otherwise require that these GPS coordinates be contained or included within the viewable entry. In addition, claim 1 does not state where the GPS coordinates are to be stored. Rather, the claims merely require that the viewable entry is "configured to store a location-denoting text denoting the respective geographical location and a respective set of GPS coordinates."

We also examine Patent Owner's argument that the claim language "realizes" the asserted integration features. As to the first integrating feature, Patent Owner argues that this feature relates to integrating the set of one or more user interfaces with the reminder entry such that the user interface "becomes part of the respective reminder entry." PO Resp. 13. The claim language that Patent Owner associates with the first integrating feature states, in relevant part, that a viewable entry is configured to have a set of user interfaces and that a mobile device displays a second set of one or more user interfaces included in the set of user interfaces of the viewable entry. *See* Ex. 1001, 6:36–42 (CL 1.a), *id.* at 6:52–67 (CL 1.b), *id.* at 7:39– 44 (CL 1.c), *id.* at 8:1–11 (CL 1.d). None of this language, however, requires that a user interface be integrated into or with the viewable entry.

As stated in the claim language, the recited viewable entry is linked with a geographic location and stores information including locationdenoting text, GPS coordinates, and reminder text. *See id.* at 6:28–36. The claim recites that the viewable entry is (1) "configured to have a respective set of user interfaces" that allow the user to search for location-denoting text and GPS coordinates and (2) configured to allow the user to view the location denoting text and reminder text. *See, e.g., id.* at 6:36–44; *see also id.* at 6:52–67, 7:39–44, 8:1–11 (reciting similar limitations). Thus, the

relationship between the user interface and the viewable entry recited in the claims is that the user interface enables the user to input text and allows the user to view text. *See id.* As such, the claim language does not support Patent Owner's assertion that integration is "the crux and essence of the claimed subject matter." *See* PO Resp. 4.

As to the second integrating feature, Patent Owner contends that CL2 requires that "the obtained respective set of GPS coordinates is integrated into the respective reminder entry as well in that the obtained set of GPS coordinates is stored within the respective reminder entry as a part thereof." *Id.* at 8. We agree with Petitioner's assertion that while claim 1 requires setting and storing of text and coordinates, it does not require that storage to occur in any specific place or manner nor does claim 1 require the storage of the user interface as part of the viewable entry. See Reply 8. Patent Owner does not direct us to any specific data structure or other means for storing GPS coordinates described in the '854 patent. See Tr. 25:6-9 (Patent Owner's counsel stating that "this claim is not really about data structure. It's about the scheme, the nature of the scheme, the way to let a user accomplish certain tasks. It's not really about data structure."); see also PO Resp. 17 ("Patent Owner agrees with the Decision that there is no integration between the database and the user interfaces, in that the user interfaces are loosely coupled to the database."). In addition, we credit Mr. Schmandt's testimony that the claims do not require GPS coordinates to be stored in a table as part of the same entry as the corresponding reminder, but rather "Claim 1 requires that GPS coordinates be stored by the mobile device and that they are associated with the first viewable entry, nothing more." Ex. 1020 ¶ 4. Further, there is no contrary expert testimony. As mentioned, Patent Owner has not provided any expert testimony in this proceeding. In

sum, we find that the claim limitations relied upon by Patent Owner do evidence a relationship between the user interface and the viewable entry, but we are not persuaded by Patent Owner's argument that the relationship requires the user interface and viewable entry to be integrated.

Petitioner's above-described contentions that these limitations are taught by Dunton and/or Bedingfield are reasonable and well supported by the text of the references. *See* Pet. 22–39. In short, Petitioner relies on Dunton's teaching of managing a task list on a communication device and in particular the viewing of reminder texts through a display which includes a user interface for searching location denoting text (*see id.* at 22 (citing Ex. 1006 ¶¶ 15, 26, 28, 29, 34, 40) 26–27 (citing Ex. 1006 ¶¶ 5, 15)), Bedingfield's teaching of using a geo-code database to search for location text and GPS coordinates (*see id.* at 23–24 (citing Ex. 1009 ¶¶ 21–22, 35, 47)), and the use of a phone number as input to search a database as taught in Barchi and Bedingfield (*see id.* at 37 (citing Ex. 1008, 3:10–14)). Taken together in the manner described by Petitioner, we find that these teachings would have taught a person of ordinary skill in the art the limitations cited by Patent Owner in support of its arguments regarding integrating features 1 and 2.

We additionally find that, even if Patent Owner's alleged integration features were required by the challenged claims, Dunton teaches such integration features. As to integrating feature 1, which purportedly requires integrating the user interface(s) into the reminder, Dunton teaches associating a task location with a task item. Ex. 1006 ¶ 34. Dunton's node 200 provides input functionality into which a user enters a geographic location by name. Pet. 26–27 (citing Ex. 1006 ¶¶ 5, 34). In response, Dunton's system provides location information such as GPS coordinates. *Id.*

at 27 (citing Ex. 1006 ¶ 15). Dunton further teaches that when Dunton's TMM is within a specified proximity of the location associated with a reminder its indicator system provides a visual or audio indication to the user. Pet. 22 (citing Ex. 1006 ¶¶ 26, 28–29). For example, Dunton describes that its "text messages display tasks such as 'deliver present to friend." *Id.* at 22 (citing Ex. 1006 ¶ 40). We are persuaded that Dunton teaches user interfaces that allow the user to perform searches for reminder location information and user interfaces to display reminder information and that such user interfaces demonstrate that Dunton teaches integrating a reminder entry and a user interface.

As to integrating feature 2, which Patent Owner asserts to require integrating the GPS coordinates into the reminder entry, Petitioner's declarant Mr. Schmandt opines that "GPS coordinates of the viewable entry can be stored in a variety of different data structures (including as in Dunton paragraph 34[)], where they are stored in a 'location table' and integrated with a 'task location' stored in the same table as the 'task item.'" Ex. 1020 ¶ 15. Petitioner directs us to Dunton's Table 1 with annotations provided by Petitioner. Reply 13–14. Annotated Table 1 is reproduced below.

Task Item	Task Location	Indicator Parameter	Proximity Range
Buy Groceries	Location A	000 - Provide Continuous	1.0 miles
Drop Off Dry Cleaning	Location B	Beeping 001 - Audibly reproduce	1.5 miles
Deliver	Location C	Task Item using Text-To-Speech 010 - Display	0.25 miles
Present To Friend		Task Item	

TABLE 1

Annotated Table 1, reproduced above, highlights in yellow the Task Item labeled "Buy Groceries" and its Task Location labeled "Location A." *Id.* Dunton's system provides an indication to the user (e.g., a text message) when the user gets within the stated proximity (here 1.0 miles) of Location A. Ex. 1006 ¶ 38. Petitioner contends that "Dunton expressly discloses that the 'task location may comprise location information' and 'location information may include . . . GPS coordinates." Reply 14 (quoting Ex. 1006 ¶ 15) (alternation in original); *see also* Pet. 32 ("Dunton's location information comprises GPS coordinates."). As such, we agree with Petitioner that "Dunton therefore teaches that GPS coordinates may be set and stored as the 'Task Location' field in the same table as Dunton's 'Task Item.'" Reply 14–15 (citing Ex. 1020 ¶¶ 18–19).

Patent Owner argues that this is insufficient because Dunton is merely associating the location information and the task item. Sur-reply 8. Patent Owner contrasts Dunton's teaching with the '854 patent's reminder entries that include location information and as such do not require an external table. *Id.* As to the external table, we note that Patent Owner stated, and we agree, that no integration between database and viewable entry is required by the '854 patent claims. *See* PO Resp. 17 ("that there is no integration between the database and the user interfaces, in that the user interfaces are loosely coupled to the database" (emphasis omitted)). In addition, we note that Patent Owner agrees that there is no specific structure required for the viewable entry. *See* Sur-reply 12 ("of course[] the claims do not require the 'first viewable entry' to have any specific structure, since that is not what the claims are about."). Patent Owner also points out that Dunton's Table 1 includes the text of "location A" and not GPS coordinates. Tr. 23:18–20 (JUDGE WHITE: So let me make sure I'm clear. Your issue with table 1 of

Dunton is that it says location A as opposed to a GPS coordinate. MR. MA: Absolutely. That is, in fact, that is the -- all the difference."). Dunton describes that its TMM "create[s] a task item and associate[s] a task location with the task item." Ex. $1006 \ 15$. Dunton expressly states that the task location may be "GPS coordinates." *Id*. Dunton further states that "[1]ocation information for a given location may be manually entered by a user, retrieved from an internal database stored in the memory of a node, or retrieved from an external database stored by a device external to a node." *Id*. As such, we find that Dunton's Table 1 shows a relationship between the location information and the task sufficient to teach the limitations of claim 1 even under Patent Owner's view that integration is required.

Patent Owner further argues that "the only motivation or reason to combine Dunton with either Barchi or Bedingfield, which Petitioner provides, is Dunton's reference to 'Techniques to improve management of such tasks may result in more productivity and better time management." PO Resp. 22 (emphasis omitted). Patent Owner contends that Petitioner's articulated motivation to combine is conclusory and without an adequate explanation to support a finding that a motivation to combine would have existed. *Id*.

We do not agree with Patent Owner's assertions. We find Petitioner's rationale for the combination to be well supported. Petitioner points out that "Dunton itself states that '[t]echniques to improve management of [] tasks may result in more productivity and better time management' and that '[a]ccordingly, there may be a need for such techniques in a device or network." Reply 17 (citing Ex. 1006 ¶ 1; Ex. 1003 ¶ 133) (alternations in original). Mr. Schmandt supports Petitioner's arguments by opining that "[a person of ordinary skill in the art] looking to obtain additional information

regarding where and when to perform tasks to improve management of tasks (as discussed in Dunton) would be motivated to look to references like Barchi that teach methods to obtain additional contact information using techniques like the reverse phone number lookup or use of other databases." Ex. 1003 ¶ 135. Thus, we agree with Petitioner and find that Dunton provides a rationale for looking to the other cited references to provide techniques to improve task management. As such, we find Petitioner's rationale for the combination to be persuasive and well supported.

Further, as noted, Petitioner's contentions regarding the teachings and suggestions of the asserted prior art and a rationale to combine are supported by the testimony of Mr. Schmandt. In contrast, Patent Owner has not submitted any expert testimony to support its contentions and instead relies heavily on mere attorney argument, which is not evidence. *See In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974) ("Attorney's argument in a brief cannot take the place of evidence.").

Based on our review of the evidence and arguments presented by the parties, we find that Petitioner has established that the combination of Dunton, Barchi, and Bedingfield teaches all of the limitations recited in claim 1.

c) Secondary Considerations of Non-obviousness

Patent Owner argues that secondary considerations demonstrate nonobviousness. PO Resp. 24. Secondary considerations may include long-felt but unsolved need, failure of others, unexpected results, commercial success, copying, licensing, industry praise, and expert skepticism. *Mintz v. Dietz & Watson, Inc.*, 679 F.3d 1372, 1379 (Fed. Cir. 2012). Evidence of secondary considerations "must always when present be considered en route to a

determination of obviousness." *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Drilling USA, Inc.*, 699 F.3d 1340, 1349 (Fed. Cir. 2012).

According to Patent Owner, Petitioner's cited art "indicates that a [person of ordinary skill in the art], at the time of the claimed invention, simply did *not* grasp the ingenuity of the inventor in coming up with the notion of integrating a conventional address book with a personal organizer in such a manner that arrives at the integrating CL1 and CL2 of the claimed subject matter." PO Resp. 24. As such, Patent Owner argues that "the secondary considerations, to a large degree, confirm patentability of the claimed subject matter." *Id.*

Petitioner points out that Patent Owner "identifies no evidence (let alone *objective* evidence) of any product embodying the claimed features, any commercial success related to the '854 Patent, or any nexus between the two." Reply 21–22.

Further, there is no analysis or evidence demonstrating any long-felt but unsolved need addressed by the claims of the '854 Patent, any failure of others to arrive at the alleged invention of the '854 Patent, or any evidence of unexpected results by the inventor of arriving at the alleged invention of the '854 Patent.

Id. at 22. We agree. Patent Owner's Response and Sur-reply lack any evidence or even specific argument regarding objective considerations of non-obviousness and thus, the Patent Owner Response provides no basis for a determination of non-obviousness due to objective considerations. Thus, we do not find that any objective consideration in this case supports a determination of non-obviousness.

Petitioner further states that any arguments regarding objective considerations of non-obviousness pursued in the Patent Owner Preliminary Response are now waived because they were not asserted in the Patent

Owner Response. *Id.* at 21 n.4. Patent Owner asserts that waiver it not applicable because it did not expressly waive any arguments and "[u]nder a big umbrella like 'secondary considerations', concerns of waiver, however, do not preclude a party from proffering additional or new supporting arguments." Sur-reply 17–18 (emphasis omitted).

In the Decision on Institution, however, we expressly stated that "[a]ny arguments not raised by Patent Owner in a timely-filed response may be deemed waived, even if they were presented in the Preliminary Response." Dec. 1. Similarly, in the Scheduling Order, we also stated that "Patent Owner is cautioned that any arguments not raised in the response may be deemed waived." Paper 14, 9. Further, the Board's Trial Practice Guide also warns that "the Board may decline to consider arguments set forth in a preliminary response unless they are raised in the patent owner response." See Consolidated Trial Practice Guide¹⁸ at 52. As such, Patent Owner was on notice that waiver applies to "any arguments" in the Patent Owner Preliminary Response that were not included in the Patent Owner Response. Under these circumstances, we consider arguments from the Patent Owner Preliminary Response that were not included in the Patent Owner Response to be waived. And, as stated above, Patent Owner's postinstitution briefing does not include any creditable arguments regarding secondary considerations of non-obviousness.

d) Conclusions Regarding Claim 1

For the reasons discussed above, we are persuaded that Petitioner has shown that all limitations of claim 1 were taught by Dunton, Barchi, and

¹⁸ Available at https://www.uspto.gov/TrialPracticeGuideConsolidated https://www.uspto.gov/TrialPracticeGuideConsolidated.

Bedingfield and we are not persuaded that any objective indicia of nonobviousness have been established. Thus, we find that Petitioner has demonstrated by a preponderance of the evidence that claim 1 is unpatentable under § 103(a) as obvious over the combination of Dunton, Barchi, and Bedingfield.

2. Dependent Claims 2–7

Claims 2–7 all depend directly from claim 1 and Petitioner accounts for the limitations recited in these dependent claims. Pet. 40–45. Petitioner provides detailed explanations as to how the prior art combination teaches or suggests these remaining limitations and claims, citing Mr. Schmandt's testimony for support. *Id.* (citing Ex. 1003). Patent Owner makes no other arguments as to these dependent claims outside of the arguments discussed with respect to claim 1.

Claim 2 recites, in relevant part, that the contact information in the second input text is a phone number. Petitioner directs us to disclosures from Dunton (Ex. 1006 ¶ 15) and Barchi (Ex. 1008, code (57), 3:11-14) to teach this usage of a phone number. Pet. 40–41. Claim 3 recites, in relevant part, that "location-denoting text includes a name of an entity located at the respective geographical location." As evidence of obviousness of the claim, Petitioner directs us to Dunton's disclosure of a user inputting a name for a location. *Id.* at 42 (citing Ex. 1006 ¶ 34). Claim 4 recites, in relevant part, "the respective location-denoting text includes an address." As evidence of obviousness of the claim, Petitioner directs us to Dunton's disclosure of a user inputting a name for a location. *Id.* at 42 (citing Ex. 1006 ¶ 34). Claim 4 recites, in relevant part, "the respective location-denoting text includes an address." As evidence of obviousness of the claim, Petitioner directs us to Dunton's disclosure of a user inputting an address for a location. *Id.* at 42 (citing Ex. 1006 ¶ 15). Claim 5 recites, in relevant part, a display indication that "comprises the respective reminder text of the first viewable entry." As evidence of obviousness of the claim, Petitioner directs us to Dunton's disclosure of a

displaying reminder text. *Id.* at 43 (citing Ex. 1006 ¶¶ 18, 30, 40, Table 1). Claim 6 recites, in relevant part, "enabl[ing] the user to input a phone number value as the second input text for searching against one data field indicating a phone number of an entity." Petitioner directs us to Bedingfield's disclosure of a user interface for entering a location identifier such as a phone number. *Id.* at 43–44 (citing Ex. 1009 ¶¶ 5, 22). Claim 7 recites, in relevant part, "first user interface element of the second set of one or more user interfaces is included in the first user interface of the second set of one or more user interfaces." According to Petitioner, this is taught by Dunton's description of "a user enter[ing] a task (e.g., through a first set of interfaces) and then enter[ing] location information (e.g., through a second set of interfaces)." *Id.* at 44–45 (citing Ex. 1006 ¶ 26). As to dependent claims 2–7, we are persuaded by Petitioner's evidence and argument.

After reviewing the record, we find that Petitioner has shown that the combination of Dunton, Barchi, and Bedingfield teaches or suggests all of the limitations recited in dependent claims 2–7. Thus, we are persuaded that Petitioner has established by a preponderance of the evidence that claims 2–7 are unpatentable under § 103(a) as obvious over the combination of Dunton, Barchi, and Bedingfield.

III. CONCLUSION¹⁹

Based on the evidence presented with the Petition, the evidence introduced during the trial, and the parties' respective arguments, Petitioner

¹⁹ Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner's attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding. See* 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application

has shown by a preponderance of the evidence that each of claims 1–7 of the '854 patent is unpatentable.

In summary:

Claim(s)	35 U.S.C. §	Reference(s)/ Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1–7	103	Dunton, Barchi, Bedingfield	1–7	
Overall Outcome			1–7	

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner has established by a preponderance of the evidence that claims 1–7 of the '854 patent are unpatentable; 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.

or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. *See* 37 C.F.R. § 42.8(a)(3), (b)(2).

PETITIONER:

James Carmichael Stephen McBride <u>jim@carmichaelip.com</u> <u>stevenmcbride@carmichaelip.com</u>

PATENT OWNER:

Jundong Ma jma@dmpatentlaw.com