

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.,
Petitioner,

v.

SEVEN NETWORKS, LLC,
Patent Owner.

IPR2020-00425
Patent 9,438,550 B2

Before THU A. DANG, KARL D. EASTHOM, and JONI Y. CHANG,
Administrative Patent Judges.

DANG, *Administrative Patent Judge.*

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background

Apple Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–40 (the “challenged claims”) of U.S. Patent No. 9,438,550 B2 (Ex. 1001, “the ’550 patent”). Paper 2 (“Pet.”). Seven Networks, LLC (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

Under 37 C.F.R. § 42.4(a), the Board has authority to determine whether to institute an *inter partes* review. Institution of an *inter partes* review may not be authorized “unless . . . the information presented in the petition . . . and any response . . . 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).

Upon consideration of the Petition and the Preliminary Response, we exercise our discretion under § 325(d) to deny institution because substantially the same arguments previously were presented to the Office. Accordingly, no trial of the ’550 patent is instituted.

B. Related Matters

Petitioner identifies the ’550 patent as the subject of *SEVEN Networks, LLC v. Apple Inc.*, 2:19-cv-00115 (E.D. Tex.). Pet. 65.

C. The ’550 Patent

The ’550 patent, titled “Mobile Device Power Management in Data Synchronization over a Mobile Network with or without a Trigger Notification,” issued on September 6, 2016, from an application filed on October 1, 2015, which is a continuation of application Ser. No. 14/623,514 filed on February 17, 2015, now U.S. Patent No 9,608,968 (“the ’514 application” or “the parent application” or “the ’968 patent”), which in turn

is a continuation of application Ser. No. 11/470,802 filed on September 7, 2006, now U.S. Patent No. 8,989,728 (“the ’802 application” or “the grandparent application” or “the ’728 patent”), which then in turn is a continuation of application Ser. No. 10/339,368 filed on January 8, 2003, now U.S. Patent No. 7,139,565 (“the ’368 application” or “the great-grandparent application” or “the ’565 patent”). Ex. 1001, codes (54), (45), (22), (63). The ’968 patent, the ’728 patent, and the ’565 patent are “incorporated by reference in their entirety” in the ’550 patent. *Id.* at 1:9–22.

The ’550 patent describes a method for transferring data between a mobile device and a client, which includes sending transactions from the mobile device to the client over a connection and determining how often to receive new data. *See* Ex. 1001, code (57). An illustration of one embodiment of the ’550 patent’s connection architecture is depicted in Figure 6, reproduced below:

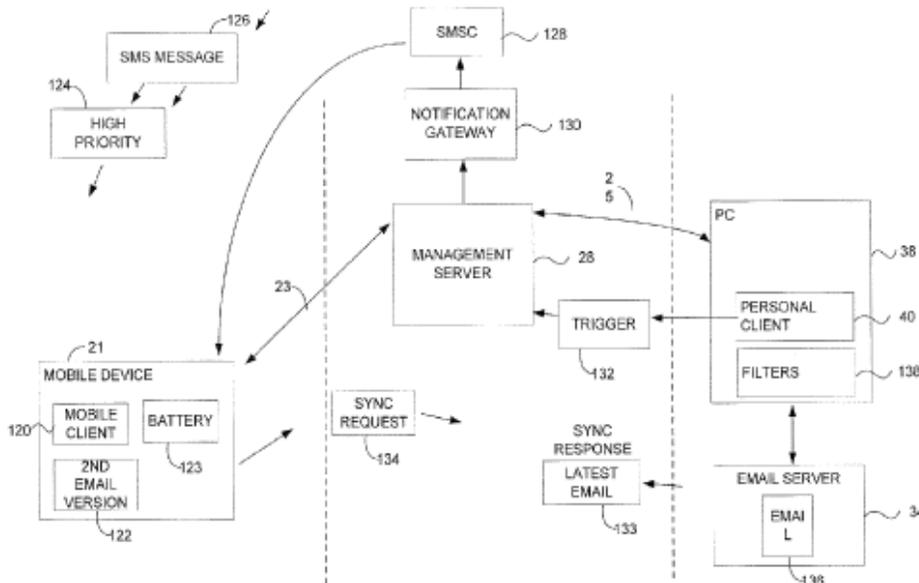


FIGURE 6

Figure 6 shows a connection architecture depicting how a mobile device is synchronized. *Id.* at 2:22–23.

The '550 patent recognizes that it may be necessary from time to time to synchronize a version of a user's local data on a mobile device with the local version on the email server. *Id.* at 7:50–53. In one embodiment, mobile device 21 periodically sends out synchronization requests 134 to personal client 40, and personal client 40 generates response 133 pursuant to synchronization request 134 that contains the latest emails, or other local user data, wherein response 133 is sent back to mobile device 21 and is used for updating data 122. *Id.* at 7:53–59.

Mobile device 21 can periodically initiate synchronization according to an amount of charge remaining in battery 123, such that, for example, when battery 123 has a relatively large amount of charge remaining, mobile device 21 may synchronize more frequently than when battery 123 has a relatively small amount of charge remaining. *Id.* at 9:2–9. Different charge gradient levels can be used for varying how often mobile device 21 synchronizes with personal client 40, such that, for example, mobile device 21 may synchronize every 5 minutes when battery 123 has 75% or more charge remaining, synchronize every 10 minutes when battery 123 is between 75% and 50% charged, and only synchronize with personal client 40 every 30 minutes when battery 123 is between 50% and 25% charged. *Id.* at 9:10–20. To further conserve power, synchronization can be varied according to the day of the week, for example, mobile device 21 may synchronize less often on weekends than on weekdays. *Id.* at 9:21–24.

*D. The '368 Application (“the Great-Grandparent Application”)*¹

The '368 application describes a real-time communication architecture that establishes a continuous connection between an enterprise network and a communication management system, wherein the connection is continuously held open allowing mobile devices real-time access to enterprise data sources such as email systems. Ex. 2007, 2:6–9.

In the '368 application, the mobile device may store a second version of the user's local data, wherein, like the '550 patent, the '368 application recognizes that it may be necessary from time to time to synchronize a version of a user's local data on the mobile device with the local version on the email server. *Compare* Ex. 2007, 12:22–24 *with* Ex. 1001, 7:50–53. In an embodiment similar to one in the '550 patent, the '368 application's mobile device periodically sends out synchronization requests to the personal client, the personal client generates a response pursuant to the synchronization request that contains the latest emails, or other local user data, and the response is sent back to the mobile device and is used for updating data. *Compare* Ex. 2007, 12:24–13:1 *with* Ex. 1001, 7:53–59.

Similar to the '550 patent, in the '368 application, the mobile device can periodically initiate synchronization according to an amount of charge remaining in battery such that when the battery has a relatively large amount of charge remaining, the mobile device may synchronize more frequently than when the battery has a relatively small amount of charge remaining. *Compare* Ex. 2007, 15:8–13 *with* Ex. 1001, 9:2–9. In a similar example, the

¹ The '368 application (Ex. 2007) published as US Patent Publication No. 2003/0157947 A1 (Ex. 1004, “Fiatal”). Petitioner relies upon Fiatal to challenge all claims of the '550 patent under the sole asserted ground set forth in the Petition. Pet. 1.

mobile device may synchronize every 5 minutes when the battery has 75% or more charge remaining, synchronize every 10 minutes when the battery is between 75% and 50% charged, and only synchronize every 30 minutes when the battery is between 50% and 25% charged. *Compare* Ex. 2007, 15:14–20 *with* Ex. 1001, 9:10–20. Synchronization in the '368 application can similarly be varied according to the day of the week, synchronizing less often on weekends than on weekdays, for example. *Compare* Ex. 2007, 15:21–23 *with* Ex. 1001, 9:21–24.

E. The '802 Application (“the Grandparent Application”)

The '368 application is “incorporated by reference in its entirety” in the '802 application. Ex. 1021 ¶ 1.

F. The '514 Application (“the Parent Application”)

The '802 application is “incorporated by reference in [its] entirety” in the '514 application. Ex. 1022, 1:7–17.

G. The Challenged Claims

Of the challenged claims, claims 1, 15, and 32 are the independent claims. Claims 2–14, 16–31, and 33–40 depend respectively from claims 1, 15, and 32. Claim 1 is illustrative, and is reproduced below:

1. A method for transferring data between a mobile device and a host, comprising:

sending, in response to instructions from a processor, application data requests from a mobile device to a host over a first connection at a first frequency;

receiving data from the host responsive to the sent application data requests;

selecting a power management mode, from a plurality of power management modes, based on an amount of battery power remaining on the mobile device, wherein selecting a power management mode is further based on the amount of battery power remaining being below a predetermined amount;

changing the frequency that the application data requests are sent from the first frequency to a second frequency associated with the selected power management mode;

wherein at least two of the power management modes are a low power mode configured to conserve the amount of battery power remaining on the mobile device and a normal operation mode,

wherein the normal operation mode is configured to allow the mobile device to send application data requests more frequently than when the mobile device is in low power mode,

wherein the frequency at which some application data requests are sent is not changed to the second frequency while the mobile device is in the low power mode; and

exiting the low power mode when an amount of battery power remaining is above a predetermined amount.

Ex. 1001, 9:52–10:14.

I. Asserted Grounds of Unpatentability

Petitioner challenges the patentability of claims 1–40 of the '550 patent on the following grounds (Pet. 1–2):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–40	103 ²	Fiatal, ³ Prabu, ⁴ Bernard, ⁵

Petitioner relies on the Declaration of Mr. Edward R. Tittel (Ex. 1003) in support of its unpatentability contentions.

II. ANALYSIS.

A. *Claim Construction*

We construe claims 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), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. 37 C.F.R. § 42.100(b) (2019). Thus, we apply the claim construction standard as set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

Petitioner proposes construction of the terms “a processor configured to allow the mobile device to:” (claims 15, 32). Pet. 16–21. Patent Owner does not address Petitioner’s proposed claim construction. *See generally* Preliminary Response.

Only terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Matal*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“[W]e need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’” (quoting *Vivid Techs.*,

² The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. § 103. Because the ’968 patent is a continuation of an application with a filing date of September 7, 2006, which is prior to the effective date of the applicable AIA amendments, we refer to the pre-AIA version of § 103. *See* Ex. 1001, code (63).

³ U.S. Patent Publication No. 2003/0157947 A1, published August 21, 2003, filed January 8, 2003 (Ex. 1004, “Fiatal”).

⁴ U.S. Patent Publication No. 2012/0221877 A1, published August 30, 2012, filed February 25, 2011 (Ex. 1005, “Prabu”).

⁵ U.S. Patent No. 8,019,325 B2, issued September 13, 2011, filed December 6, 2007 (Ex. 1006, “Bernard”).

Inc. v. Am. Sci. & Eng'g, Inc., 200 F.3d 795, 803 (Fed. Cir. 1999))). We determine that it is unnecessary to construe any claim term expressly to determine whether to institute a trial.

B. Discretion to Deny Institution under § 325(d)

Under § 325(d), in “determining whether to institute [an *inter partes* review], the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previous were presented to the Office.” *In Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GMBH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential), the Board applied a two-part framework in considering whether to exercise discretion to deny institution under § 325(d): “(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of the first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics*, Paper 6 at 8.

Within this two-part framework, the Board considers a number of non-exclusive factors in evaluating whether to exercise its discretion under § 325(d). *See Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first para.); *see also Advanced Bionics*, Paper 6 at 9–11. The factors set forth in *Becton, Dickinson* follow:

(a) the similarities and material differences between the asserted art and the prior art involved during examination;

(b) the cumulative nature of the asserted art and the prior art evaluated during examination;

(c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;

(d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art or patent owner distinguishes the prior art;

(e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and

(f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson at 17–18.

Factors (a), (b), and (d) of *Becton, Dickinson* relate to part 1 of the *Advanced Bionics* framework—whether the art or arguments presented in the Petition are the same or substantially the same as those previously presented to the Office. *Advanced Bionics*, Paper 6 at 10. Factors (c), (e), and (f) relate to part 2 of the *Advanced Bionics* framework—whether the Office committed a material error in its prior consideration of that art or arguments. *Id.* If the same or substantially the same art or arguments were previously presented to the Office, the Board then considers whether there the Office committed a material error. *Id.* “At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Id.* at 9.

1. Part 1: Whether the art or arguments presented in the Petition are the same or substantially the same as those previously presented to the Office

Petitioner contends that the application that issued as the '550 patent was filed on October 1, 2015, claiming priority through a chain of applications to much earlier dates, yet, “the Challenged Claims all require at least one feature never described in a valid priority document.”⁶ Pet. 3–4. Thus, Petitioner contends that “the earliest effective filing date of the '550 patent can be no earlier than its actual filing date, i.e., October 1, 2015.” Pet. 4. Based on this contention, Petitioner further contends that Fiatal, Prabu, and Bernard qualify as prior art. Pet. 1–2.

Patent Owner contends that the Petition should be dismissed under § 325(d) because “the Petition presents the same arguments that the Office considered during the original prosecution.” Prelim. Resp. 23. According to Patent Owner, as “[t]he file history confirms[,] the Office considered the issue of written description support . . . when the Office entered the Examiner’s amendment adding to the challenged claims the very limitations that [the] Petitioner now argues lack the written description support.” *Id.* Patent Owner then contends that “Petitioner has not demonstrated that the Office materially erred in its previous determination that these limitations have such support.” *Id.*

Patent Owner points out that Petitioner’s challenge to the '550 patent’s benefit claims “turns on the answer to the question whether the '550 patent’s great-grandparent provides written description support for the claims under *35 U.S.C. § 112(a)*.” Prelim. Resp. 25–26. Thus, Patent

⁶ Because each of the non-provisional applications in the chain of priority of the '550 patent are continuation applications under 35 U.S.C. § 120, Petitioner’s assertion of lack of written description in the non-provisional applications in the priority chain embraces an assertion that the specification of the '550 patent itself lacks adequate written description of the feature added by amendment. Pet. 4.

Owner contends that the Petition “is not a conventional prior-art driven IPR challenge” and “is nothing more than a collateral attack on written description support under 35 U.S.C. § 112(a) under the guise of a benefit claim challenge under §120.” *Id.* According to Patent Owner, “the Office, during the original prosecution, already considered and answered the precise question of written description support under 35 U.S.C. § 112(a) raised here.” *Id.* Patent Owner asserts that the claim elements being challenged in the Petition “were not ones that slipped by without the Examiner noticing them,” but rather “they were entered by *Examiner’s amendment.*” *Id.* at 26–27 (citing Ex. 1002, 23–24, 26, 30). Patent Owner points out that, as set forth in an interview summary accompanying the Examiner’s amendment, the Examiner “had reviewed this specification at least three separate times, including the exact same Fiatal reference that Petitioner now asserts is prior art,” and “explained on the record that he ‘*[d]iscussed claim contents in view of the specification*’ with the applicant’s representative during an interview.” *Id.* at 27 (citing Ex. 1002, 37); *see also id.* at n.6 (“The same Examiner who examined the ’550 patent also examined U.S. Patent Nos. 7,139,565 (which issued from the great-grandparent application in the ’550 patent’s benefit claim), 8,989,728 (which issued from the ’550 patent’s grandparent), and 9,608,968 (which issued from the ’550 patent’s parent),” “Fiatal is the pre-grant publication of the great-grandparent application”).

According to *Advanced Bionics*, “[t]he factors set forth in *Becton, Dickinson* should be read broadly . . . to apply to any situation in which a petition relies on the same or substantially the same art *or arguments previously presented to the Office* during a proceeding pertaining to the challenged patent.” *Advanced Bionics*, Paper 6 at 10 (emphasis added). Here, as Patent Owner noted above, Petitioner’s challenge to the ’550

patent's benefit claims "turns on the answer to the question whether the '550 patent's great-grandparent provides written description support for the claims under 35 U.S.C. § 112(a)," wherein "the Office, during the original prosecution, already considered and answered the precise question of written description support under 35 U.S.C. § 112(a) raised [in the Petition]."

Prelim. Resp. 25–26. Further, as Patent Owner points out, the Examiner who examined the '550 patent also examined the great-grandparent application. *Id.* at 27, n.6 (citing Ex. 1002, 37).

We agree with Patent Owner that arguments presented in the Petition are the same or substantially the same as those previously presented to the Office. *Advanced Bionics*, Paper 6 at 10. Accordingly, we proceed to the part two of *Advanced Bionics* framework to determine whether the Office committed a material error.

2. Part 2: Whether the Office erred in a manner material to the patentability of challenged claims

Advanced Bionics requires consideration of whether the Office "erred in a manner material to the patentability of challenged claims." *Advanced Bionics*, Paper 6 at 8. If "reasonable minds can disagree," the Office did not materially err. *Id.* Factors (c), (e), and (f) of *Becton, Dickinson* guide the inquiry. Accordingly, we look at the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments. *Id.*

Petitioner contends that the '550 patent "is not entitled to the benefit of any earlier filing data in its priority chain." Pet. 4. According to Petitioner, the non-provisional applications in the priority chain "fail to demonstrate that the inventors were in possession of [contested claim features] before it was introduced during prosecution of the '550 patent." *Id.*

at 11. In particular, Petitioner contends that neither the specification of the '550 patent itself, nor any of the disclosures of applications in the priority chain, including the great-grandparent application, describes that “the frequency at which some application data requests are sent is not changed to the second frequency while the mobile device is in the low power mode.” *Id.* at 5–6 (citing Ex. 1001, 10:9–11, 11:16–19, 12:45–48; Ex. 1003 ¶¶ 54–62).

In the Preliminary Response, as Patent Owner points out, Petitioner’s challenge to whether the '550 patent is entitled to the priority date of its great-grandparent’s filing date “turns on the answer to the question whether the '550 patent’s great-grandparent provides written description support for the claims.” Prelim. Resp. 25–26. However, as noted above, the Office already addressed the issue of written description support, because, as Patent Owner points out, the claim elements being challenged in the Petition “were entered by Examiner’s amendment” in view of the specifications of '550 patent as well as the non-provisional priority applications, including the great-grandparent application. Prelim. Resp. 26–27 (citing Ex. 1002, 23–24, 26, 30) (emphasis omitted). As Patent Owner also points out, in the interview summary accompanying the Examiner’s amendment, the Examiner “explained on the record that he ‘[d]iscussed claim contents in view of the specification’ with the applicant’s representative during an interview.” *Id.* at 27 (citing Ex. 1002, 37) (emphasis omitted). In particular, the Examiner summarized as follows:

Proposed and discussed claim amendments with applicant’s representative in order [to] place claims in condition for allowance and expedite prosecution. *Discussed claim contents in view of the specification.* Applicant’s representative

accepted the final amendment proposals and authorized an[]
exa[m]iner amendment.

Ex. 1002, 37 (emphasis added).

Based on the record, and in particular, the Examiner's interview summary, the Examiner reviewed the great-grandparent's specification for support prior to entering the Examiner's amendment.

Moreover, although Petitioner contends the disclosures of the '550 patent and the great-grandparent do not support the claims, namely, do not describe that "the frequency at which some application data requests are sent is not changed to the second frequency while the mobile device is in the low power mode" (Pet. 5 (citing Ex. 1001, 10:9–11, 11:16–19, 12:45–48; Ex. 1003 ¶¶54–62)), Patent Owner explains how at least the great-grandparent specification supports the claims. *See* Prelim. Resp. 39–55. For clarity, Patent Owner provides a claim chart showing how the great-grandparent application provides written description support for each element of claim 1, including the contested element. *See id.* at 43–48. In particular, Patent Owner contends:

The architecture of Fig. 6 supports that the frequency at which some application data requests (namely, synchronization requests 134 triggered by events at PC 38/40, hereinafter "triggered requests") are sent (following a triggering event) are not changed to the second frequency (dictated by the low power mode schedule of synchronization every 10 minutes) while the mobile device is in the low power mode because these triggered synchronization requests have a frequency dictated by the triggering events occurring at PC 38/40 and not the mobile device's battery charge.

Prelim. Resp. 48 (citing Ex. 2007, 15:3-10).

Although Petitioner disagrees, Patent Owner sets forth a reasonable showing supported by the record, and Petitioner fails to overcome

persuasively the Examiner's finding of sufficient support for the claim amendments in the record. *See* Pet. 4–12, 23; *Advanced Bionics*, Paper 6 at 11. Even if “reasonable minds can disagree” as to whether there is adequate support in the great-grandparent application for the Examiner's amendment, the Office did not materially err. *Advanced Bionics*, Paper 6 at 9.

In view of this record, applying *Advanced Bionics*'s two-part framework, we determine that the same or substantially the same or substantially the same arguments were previously presented to the Office, and Petitioner has not demonstrated that the Office erred in a manner material to the patentability of challenged claims. *Advanced Bionics*, Paper 6 at 8.

For the foregoing reasons, we determine instituting an *inter partes* review would be an inefficient use of the Board's resources, and we exercise discretion to deny institution under 35 U.S.C. § 325(d).

III. CONCLUSION

Based on a balanced assessment of the circumstances of this case, we exercise our discretion under § 325(d) and deny the instant Petition requesting institution of *inter partes* review of the '550 patent.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition (Paper 2) is *denied* as to the challenged claims 1–40 of the '550 patent; and

FURTHER ORDERED that no *inter partes* review is instituted.

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