

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, LLC,
Petitioner,

v.

2BCOM, LLC,
Patent Owner.

IPR2020-00996
Patent 7,127,210 B2

Before MICHELLE N. WORMMEESTER, JOHN A. HUDALLA, and
SHARON FENICK, *Administrative Patent Judges*.

FENICK, *Administrative Patent Judge*.

JUDGMENT

Final Written Decision

Determining No Claims Unpatentable

Dismissing Petitioner's Motion to Strike

Dismissing Patent Owner's Motion to Exclude

35 U.S.C. § 318(a)

I. INTRODUCTION

A. Background and Summary

Unified Patents, LLC ("Petitioner") filed a Petition for *inter partes*
review of claims 12–17 and 19–21 of U.S. Patent No. 7,127,210 B2

(Ex. 1001, “the ’210 patent”). Paper 2 (“Pet.”). 2BCom, LLC (“Patent Owner”) filed a Preliminary Response. Paper 6. After further briefing regarding discretionary denial of institution under 35 U.S.C. § 314(a) (Papers 8, 9, 11, 14), we determined that the information presented in the Petition established that there was a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims and we instituted this proceeding on December 3, 2020, as to all challenged claims and all grounds of unpatentability. Paper 16¹ (“Dec. on Inst.”).

During the course of trial, Patent Owner filed a Patent Owner Response (Paper 24, “PO Resp.”), Petitioner filed a Reply to the Patent Owner Response (Paper 32, “Pet. Reply”), and Patent Owner filed a Sur-reply (Paper 35, “PO Sur-reply”). An oral hearing was held on September 9, 2021, and a transcript was entered (Paper 56, “Tr.”).

Petitioner filed Declarations of Dr. Vijay Madiseti (Ex. 1003) and Dr. Sylvia Hall-Ellis (Ex. 1010) with its Petition. Petitioner filed Declarations from Gordon MacPherson (Ex. 1036), Dr. Hall-Ellis (Ex. 1037), and Angela M. Oliver (Ex. 1050) with its Reply.

With our authorization (Paper 37), Petitioner filed a Motion to Strike Portions of Patent Owner’s Sur-Reply and Improper Sur-Reply Evidence (Paper 38, “Pet. Mot. Strike”) and Patent Owner filed an Opposition to this Motion (Paper 41, “PO Opp. Mot. Strike”). In addition, Patent Owner filed a Motion to Exclude (Paper 43, “PO Mot. Exclude”), Petitioner filed an Opposition (Paper 48, “Pet. Opp. Mot. Exclude”), and Patent Owner filed a Reply (Paper 51, “PO Reply Mot. Exclude”).

¹ The Decision on Institution was entered as board and parties only; after the parties agreed no redactions were necessary, a public version was entered as Paper 47.

We have jurisdiction under 35 U.S.C. § 6(b)(4). This decision is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of claims 12–17 and 19–21 of the '210 patent. For the reasons discussed below, Petitioner has not demonstrated by a preponderance of the evidence that claims 12–17 and 19–21 of the '210 patent are unpatentable. We also dismiss as moot Petitioner's Motion to Strike and Patent Owner's Motion to Exclude.

B. Related Matters

The parties identify the following five district court cases as related: *2BCom, LLC v. FCA US LLC Chrysler Corp.*, No. 2:20-cv-10023 (E.D. Mich.); *2BCom, LLC v. Kia Motors America*, No. 8:20-cv-676 (C.D. Cal.); *2BCom, LLC v. TP-Link USA Corporation d/b/a TP-Link North America Inc.*, No. 8:20-cv-708 (C.D. Cal.); *2BCom, LLC v. Bayerische Motoren Werke AG et al.*, No.2:20-cv-3537 (C.D. Cal.); and *Amazon.com, Inc. et al. v. 2BCom, LLC*, No. 8:20-cv-00822 (C.D. Cal.). Pet. 1–2; Paper 4 (Patent Owner's Mandatory Notices), 1. In addition, Patent Owner identifies *2BCom, LLC v. D-Link Systems, Inc.*, No. 8:20-cv-00686 (C.D. Cal.) as related. Paper 4, 1.

C. The '210 Patent

The '210 patent describes communications among wireless communications apparatuses. Ex. 1001, code (57), 1:14–20, 2:20–24. Generally, according to the embodiments described, a wireless communication apparatus, upon establishing connection with another apparatus, automatically changes how it responds to requests from any additional apparatuses so that no additional connections are established. *Id.* at code (57), 1:14–20, 2:20–50, 9:27–38. Figure 2, reproduced below, is a

functional block diagram of one wireless communication apparatus, a notebook computer. *Id.* at 3:4–6, 3:36–4:13.

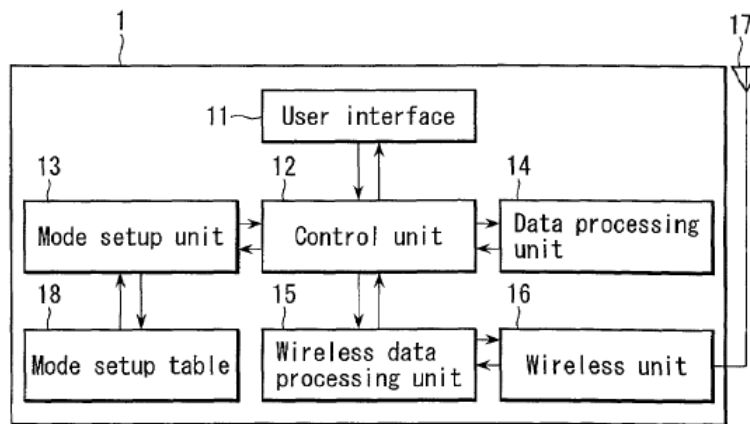


FIG. 2

Figure 2 shows notebook computer 1 that includes user interface 11 and antenna 17 that transmits and receives radio waves from and to other wireless communication apparatuses. *Id.* at 3:42–45, 3:62–4:4. Notebook computer 1 also includes mode setup unit 13 that receives control data from control unit 12. *Id.* at 3:58–61. Mode setup unit 13 shifts the notebook computer to different connection modes that control certain responses of notebook computer 1 to communication requests from external devices. *Id.* at 3:58–61, 6:3–49.

Specifically, the connection modes affect notebook computer 1's responses to two kinds of request messages received from other wireless devices: inquiries and paging signals. *Id.* at 4:5–5:9, 4:14–41. An inquiry is a signal sent from a wireless communication apparatus ("apparatus A") to check for the presence of other wireless communication apparatuses in the area. *Id.* at 4:49–58, Figs. 4–6 (element SA1). Upon receiving an inquiry sent from an apparatus A, a second wireless communication apparatus ("apparatus B") can reply by sending inquiry response data, including its

unique address, to apparatus A. *Id.* at 5:59–6:19, Figs. 4–6 (elements SB1, SB2). That unique address of apparatus B can then be used by apparatus A to connect with the apparatus B; this process involves apparatus A sending a paging signal to apparatus B. *Id.* at 5:20–29, Figs. 4–6 (element SA3). Apparatus B can then send a page response, and after authentication (if necessary) a connection is established. *Id.* at 5:30–5:66, Figs. 4–6 (elements SB4, SA4, SA5, SB5, SA6, SB6, SA7, SB7).

According to the invention, upon establishing such a connection the mode of an apparatus may be changed: “[w]hen the mode setup unit 13 receives control data representing the completion of connection with another wireless communication apparatus, the mode setup unit 13 automatically changes setups for an inquiry or paging from still another wireless communication apparatus.” *Id.* at 4:5–9. Mode setup unit 13 does this by consulting mode setup table 18, which describes the mode to be selected upon connection establishment with specific addresses associated with external wireless devices. *Id.* at 4:10–19, Fig. 3. For example, mode setup table 18 may specify that, for notebook computer 1, “when connection with a device corresponding to unique address A is established, this means that the mode changes to non-connectable mode 1. When connection with a device corresponding to unique address B is established, this means that the mode changes to a non-discoverable mode.” *Id.* “The non-connectable mode and non-discoverable mode are defined by the Bluetooth standard.” *Id.* at 4:20–21.

In the first non-connectable mode, the device does not respond to a page signal received from another wireless device. *Id.* at 4:31–34; 8:5–9:9. In the second non-connectable mode, the device responds to a page signal by sending a page denial. *Id.* at 4:31–34; 6:62–8:3. In non-discoverable mode,

the device does not respond to an inquiry signal received from another wireless device. *Id.* at 4:26–30; 6:24–60. A device may be in both a non-connectable and a non-discoverable mode at the same time. *Id.* at 9:12–14.

D. Illustrative Claims

The Petition challenges independent claims 12, 20, and 21, and dependent claims 13–17 and 19, which depend directly or indirectly from claim 12. Claim 12 illustrates the challenged claims at issue:

12. A communication method in a wireless communication apparatus, comprising:

setting up a first mode where the wireless communication apparatus is connectable with at least a first wireless communication device and a second wireless communication device and accepts a connection request from the first wireless communication device;

establishing a connection with the first wireless communication device;

discovering a completion of the connection with the wireless communication apparatus;

setting up a second mode where, in a state where the connection with the first wireless communication device is established, the wireless communication apparatus is inhibited from establishing a connection with the second wireless communication device with respect to a connection request from the second wireless communication device; and

shifting from the first mode to the second mode after the completion of the connection.

Ex. 1001, 10:53–11:6.

E. Prior Art and Instituted Grounds

We instituted *inter partes* review of claims 12–17 and 19–21 of the '210 patent on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
12, 13, 15, 17, 20, 21	103 ²	Bluetooth Profiles ³ , Nüsser ⁴
12, 14, 16, 19–21	103	Bluetooth Profiles, Cooper, ⁵ Nüsser

F. Level of Ordinary Skill in the Art

Relying on the testimony of Dr. Vijay K. Madiseti, Petitioner contends that a person of ordinary skill in the art (“POSITA”) “at the priority date of the '210 Patent would have had a bachelor’s degree in electrical engineering, computer engineering, computer science, or a related subject, and one to two years of work experience in wireless communications.” Pet. 14 (citing Ex. 1003 ¶¶ 48–52). “Less experience is necessary with additional education (e.g., a Master’s degree), and likewise, less education is necessary with additional work experience (e.g., 5–6 years).” *Id.* Patent Owner does not propose a level of ordinary skill or comment on Petitioner’s proposal.

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 103. The '210 patent was filed before March 16, 2013 (the effective date of the relevant amendment), so the pre-AIA version of § 103 applies.

³ Specification of the Bluetooth System, Profiles v1.0B (Dec. 1, 1999) (Ex. 1007) (“Bluetooth Profiles”).

⁴ R. Nüsser and R. M. Pelz, “Bluetooth-based wireless connectivity in an automotive environment,” *Vehicular Technology Conference Fall 2000. IEEE VTS Fall VTC2000. 52nd Vehicular Technology Conference*, vol. 4, pp. 1935–42 (Ex. 1006) (“Nüsser”).

⁵ Cooper, U.S. 2002/0123325 A1, pub. Sept. 5, 2002 (Ex. 1008) (“Cooper”).

We adopt Petitioner’s proposed level of ordinary skill in the art, which comports with the teachings of the ’210 patent and the asserted prior art.

II. ANALYSIS

In the Petition, Petitioner presented arguments regarding the unpatentability of the challenged claims, including claim construction arguments (Pet. 15–31), a discussion of the propriety of the proposed combinations of the references (Pet. 38–42, 74–76) and the unpatentability of the claims in light of those proposed combinations (Pet. 43–73, 77–87). In the Decision on Institution, we determined that Petitioner had established a reasonable likelihood that it would prevail in showing the unpatentability of the challenged claims over the asserted prior art. Dec. on Inst. 9–39. This included a determination that, for purposes of institution and in accordance with the Board’s precedential decision in *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 13 (PTAB Dec. 20, 2019) (precedential) (“*Hulu*”), Petitioner had established a reasonable likelihood that Bluetooth Profiles and Nüsser each qualify as prior art printed publications. Dec. on Inst. 19–23.

In its Response and Sur-reply, Patent Owner argues that Petitioner has not shown by a preponderance of the evidence that either Nüsser or Bluetooth Profiles is prior art to the ’210 patent, and that, therefore, Petitioner has not shown the unpatentability of the challenged claims. PO Resp.; PO Sur-reply. Upon examination, we agree with Patent Owner that Petitioner has not proven by a preponderance of the evidence that Nüsser qualifies as prior art to the ’210 patent. Given that Nüsser is asserted in both instituted grounds, we determine that Petitioner has not shown by a preponderance of the evidence that the challenged claims are unpatentable on the instituted grounds.

1. Legal Standards

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (noting that 35 U.S.C. § 312(a)(3) requires *inter partes* review petitions to identify “with particularity ... the evidence that supports the grounds for the challenge to each claim”). This burden never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burdens of proof in *inter partes* review).

The standard of proof for a final decision is whether the petitioner has met “the burden of proving a proposition of unpatentability by a preponderance of the evidence.” 35 U.S.C. § 316(e).

In an *inter partes* review, a petitioner “may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.” 35 U.S.C. § 311(b). As discussed *supra* at footnote 2, we apply the pre-AIA version of the relevant statutes.

Pre-AIA section 102(a) provides that a person is entitled to a patent unless the invention was known or used by others before the invention by the applicant for a patent. 35 U.S.C. § 102(a) (2006) (pre-AIA amendments). Pre-AIA section 102(b) provides that a person shall be entitled to a patent unless the invention was described in a printed publication more than one year prior to the date of application for patent in the United States. 35 U.S.C. § 102(b) (2006); *GoPro, Inc. v. Contour IP Holding LLC*, 908 F.3d 690, 693 (Fed. Cir. 2018); *In re Corcoran*, 640 F.2d

1331, 1333 (CCPA 1981); MPEP 2133. The “statutory bar” date, or critical date, of one year prior to the date of the United States application set forth in pre-AIA 102(b) is not overcome or extended by a foreign priority claim. *In re Foster*, 343 F.2d 980, 986 (CCPA 1965); MPEP 2133.02 II.

The determination of whether a document is a “printed publication” under 35 U.S.C. § 102 “involves a case-by-case inquiry into the facts and circumstances surrounding the reference’s disclosure to members of the public.” *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004).

“Because there are many ways in which a reference may be disseminated to the interested public, ‘public accessibility’ has been called the touchstone in determining whether a reference constitutes a ‘printed publication.’” *Jazz Pharm., Inc. v. Amneal Pharm., LLC*, 895 F.3d 1347, 1355 (Fed. Cir. 2018) (quoting *In re Hall*, 781 F.2d 897, 898–99 (Fed. Cir. 1986)). A reference is considered publicly accessible if it was “disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.” *Id.* at 1355–56 (quoting *In re Wyer*, 655 F.2d 221, 226 (CCPA 1981)); *see also Medtronic, Inc. v. Barry*, 891 F.3d 1368, 1380 (Fed. Cir. 2018).

2. *The Parties’ Evidence and Positions*

a) *The Petition and Evidence Submitted with the Petition*

In the Petition, Petitioner argued that “library records show that *Nüsser* was available digitally through the Auraria Library at the University of Colorado - Denver by June 23, 2000.” *Id.* at 6 (citing Ex. 1010 ¶¶ 45–50). Dr. Hall-Ellis, in her declaration, attaches as an exhibit and references Exhibit B1, a Machine-Readable Cataloging (“MARC”) record for an alleged digital version of the proceedings of the 2000 IEEE (Institute of Electrical and Electronics Engineers) 52nd Vehicular Technology

Conference, from which the Nüsser reference was retrieved by Dr. Hall-Ellis. Ex. 1010 ¶¶ 45–46, Attachments 1006, B1. Dr. Hall-Ellis asserts that this MARC record shows that the digital version was catalogued in the library on June 23, 2000, and “[t]herefore, this volume would have been available to users in the Auraria Library” on that date. *Id.* ¶ 47. In support of this, Dr. Hall-Ellis cites field 008 of the Attachment B1 MARC record, which contains the date code for June 23, 2000. *Id.* ¶ 47, Attachment B1. Elsewhere in her declaration, Dr. Hall-Ellis explains that this field contains the date of creation of a MARC record, which “reflects the date on which, or shortly after which, a work was first acquired and cataloged by the library that created the original MARC record.” *Id.* ¶ 37.

Petitioner additionally argues that Nüsser was indexed by subject matter. Pet. 6 (citing Ex. 1010 ¶¶ 49–50). To show this, Dr. Hall-Ellis relies solely on a different MARC record, attached as Attachment B2 to her initial declaration. Ex. 1010 ¶¶ 48–50, Attachment B2. Dr. Hall-Ellis obtained this MARC record from a different source (the OCLC (Online Computer Library Center)) and describes it as “the MARC record for the monographic serial of the proceedings volumes for the annual Fall and Spring conferences.” Ex. 1010 ¶ 48, Attachment B2. Dr. Hall-Ellis describes serial publications as “those publications that have the same collective title but are intended to be continued indefinitely with enumeration such as a volume or issue number.” *Id.* ¶ 42. Dr. Hall-Ellis declares, based on certain fields in the Attachment B2 MARC record, that this MARC record was created on August 15, 1996, and continues to be updated, with the last update prior to her retrieval of the MARC record occurring on November 26, 2018. *Id.* ¶ 48.

Regarding MARC records generally, Dr. Hall-Ellis testifies that a 050 field contains a Library of Congress call number, which may be used to show information regarding a subject matter classification. *Id.* ¶ 32. Dr. Hall-Ellis also explains that a 082 field may be the subject matter classification consistent with the Dewey Decimal classification system. *Id.* Dr. Hall-Ellis further testifies that fields numbered “6XX” are “Subject Access Fields” and that the 650 field is the “Subject Added Entry – Topical Term” field. *Id.* ¶ 31. Dr. Hall-Ellis declares that these fields in the MARC record of Attachment B2 show that the record included subject matter classifications consistent with the Library of Congress and Dewey Decimal classification systems. *Id.* ¶ 49 & nn.13, 14, Attachment B2. Dr. Hall-Ellis testifies that the Library of Congress field indicates the classification as “Electrical engineering. Electronics. Nuclear engineering—Radio—Special applications of radio, A-Z—Mobile communication systems” and that the Dewey Decimal classification indicates a classification as “Technology – Engineering – Applied physics – Electrical, magnetic, optical, communications, computer engineering, electronics, lighting – Electronics, communications engineering – Specific communications systems – Radio and radar – Radio – Radiotelephony – Periodicals.” *Id.* Additionally, Dr. Hall-Ellis describes the 650 fields as including five entries describing the subject matter of the proceedings volumes that are referenced by the Attachment B2 MARC record: “Mobile communication systems \$v Congresses,” “Motor vehicles \$x Electronic equipment \$v Congresses,” “Motor vehicles \$x Electric equipment \$v Congresses,” “Electronics in transportation \$v Congresses,” and “Artificial satellites in telecommunication \$v Congresses.” *Id.* ¶ 49.

Dr. Hall-Ellis concludes that “[i]n view of the above, the IEEE Vehicular Technology Conference Proceedings was publicly available on June 23, 2000, and in any event, before the alleged September 20, 2001, priority date, because by that date it had been received, cataloged, and indexed in the Auraria Library at the University of Colorado – Denver and made part of the OCLC bibliographic database.” *Id.* ¶ 50 (emphasis omitted).

In addition to arguments based on Dr. Hall-Ellis’s declaration, Petitioner argues that “the date printed on *Nüsser* itself (September 2000) provides additional evidence of its public accessibility.” Pet. 6. Petitioner also cites Dr. Madisetti’s declaration that “a person of ordinary skill in the art (‘POSITA’) in the relevant time frame would have frequently reviewed IEEE publications and attended IEEE conferences for information on relevant technologies.” *Id.* (citing Ex. 1003 ¶ 53).

b) Patent Owner’s Response

Patent Owner disputes Petitioner’s contentions about Nüsser’s public accessibility. PO Resp. 2–17. Patent Owner argues in the Response that Dr. Hall-Ellis did not provide credible testimony regarding attachment B1, the MARC record for the digital version of Nüsser, which is Exhibit 1006. *Id.* at 2–7. In particular, Patent Owner highlights certain facts that allegedly undermine Petitioner’s showing regarding public accessibility of a digital version. For example, Patent Owner notes that the final papers for the conference where Nüsser was allegedly published were not due until July 10, 2000, which is after the June 23, 2000, date (cited by Dr. Hall-Ellis) by which the digital conference proceedings were allegedly cataloged and available in the Auraria Library. *Id.* at 3–4 (citing Ex. 2019). Patent Owner also argues that the Auraria Library did not create the MARC record for the

alleged digital version of the conference proceedings, which undermines Dr. Hall-Ellis's testimony that the record creation date indicates public availability. *Id.* at 4–5. Patent Owner additionally argues that the various scholarly papers that cite Nüsser all post-date the critical date. *Id.* at 6 (citing Ex. 2014).

Patent Owner additionally argues that Dr. Hall-Ellis's testimony regarding Attachment B2 is flawed, including because the Attachment B2 MARC record was created much earlier than any possible date for Nüsser and continued to be updated afterwards, and because the record has not been shown to be for a reference which includes the Nüsser reference supplied as Exhibit 1006. *Id.* at 7–9. Patent Owner also criticizes Dr. Hall-Ellis' testimony because she did not confirm when or whether Nüsser was made publicly available in any of the 83 libraries that allegedly hold the serial publication of Attachment B2. *Id.* Patent Owner additionally contends that the subject matter classifications relied on by Petitioner would not have allowed one of ordinary skill to locate Nüsser. *Id.* at 9–13.

c) The Reply and Evidence Submitted with the Reply

In its Reply, Petitioner submits additional evidence and makes additional arguments regarding the public availability of Nüsser. Pet. Reply 1–16. Specifically, Petitioner argues that while Patent Owner “attempts to create uncertainty regarding the precise date” of Nüsser's public availability, the uncertainty is “of no moment” if all “date[s] discussed” would qualify Nüsser as prior art. Pet. Reply 1–2. Petitioner also modifies its position regarding the date of Nüsser's public availability from “by at least June 23, 2000” to “on or shortly after June 23, 2000.” *Compare* Pet. 4, *with* Pet. Reply 10–11.

(1) Nüsser – Digital Format via Libraries

Petitioner in Reply argues that “Nüsser was available in digital format in the Auraria Library on *or shortly after* June 23, 2000” and that Dr. Hall-Ellis’ testimony on this point is credible. Pet. Reply 10–13 (emphasis added). Petitioner characterizes Dr. Hall-Ellis’ testimony as asserting not that Nüsser was generally available online in 2000, but rather that a “digital book version” of the work was available through a specific library in 2000. *Id.* at 12–13 (citing Ex. 1010 ¶ 45). Petitioner argues that Dr. Hall-Ellis’ testimony that Nüsser was available in a digital version of proceedings on or “shortly after” June 23, 2000 is consistent with an announced due date of July 10, 2000 for the submission of papers for the conference. *Id.* at 13 (citing Ex. 1010 ¶¶ 37–40, 47, 49; PO Resp. 4; Ex. 2019, 2). Petitioner additionally asserts that the date on the face Nüsser should be considered as part of the totality of the evidence. *Id.* at 2–3; Pet. 6.

(2) Nüsser – Dissemination at Conference

Petitioner additionally argues actual dissemination: “Nüsser was presented at IEEE conference in September 2000,” which is the date on the face of the reference. Pet. Reply 2–3 (citing Ex. 1006, 1, 2, 10, 15). Petitioner argues that this is confirmed by the copyright registration. *Id.* at 2, 4–5 (citing Ex. 1010 ¶ 50, Attachment B8).

Petitioner submits with the Reply a declaration from Gordon MacPherson, Director Board Governance & IP operations of the IEEE. Ex. 1036. Petitioner argues that the declaration confirms the date on the face of Exhibit 1006. Pet. Reply 2, 4 (citing Ex. 1036 ¶¶ 10–11). Mr. MacPherson declares that copies of the conference proceedings would have been made available no later than the last day of the conference, which Mr. MacPherson identifies as September 28, 2000. Ex. 1036 ¶ 11.

Petitioner argues that such actual dissemination establishes public accessibility. Pet. Reply 4, 14.

(3) *Nüsser – Print Format via Library*

With respect to questions raised by Patent Owner about Attachment B2 to Dr. Hall-Ellis’s first declaration, Petitioner argues that that MARC record relates to an entire serial publication over many years, and that “when an individual issue of a serial subscription was received by a library, it would be ‘verified as part of a subscription, checked in, and stamped or labeled with the institution’s name and the date’” and “it is highly unusual for a library to stop collecting and shelving a serial publication prior to the end of its publication run,” in which event the library would fill an end date into the MARC record. Pet. Reply at 6–7 (quoting Ex. 1010 ¶¶ 42, 43; citing *id.* ¶¶ 42–44, 48–50). Petitioner argues that “given the semi-annual nature of the publication,” Nüsser “would have been received and made available in the regular course of conduct” soon after it was published. *Id.* at 7–8 (citing Ex. 1010 ¶¶ 28, 48, Attachment B2 (field 310)). Petitioner asserts that “either semi-annual publication in 2000 would have pre-dated the priority date, as would the first semi-annual publication in 2001.” *Id.*

In response to Patent Owner criticism that Dr. Hall-Ellis did not confirm whether the serial publication of Attachment B2 was available in any of the 83 libraries mentioned in Attachment B2, Dr. Hall-Ellis, in a second declaration, provides a new MARC record from one of these libraries, the University of California – Berkeley, for a print version of the relevant volume of the proceedings. *Id.* at 8 (citing Ex. 1010 ¶ 48, Attachment B2; Ex. 2024 47:19–50:24; Ex. 1037 ¶ 22, Attachment E). As such, Petitioner contends that “the library at the University of California –

Berkeley would have received a print copy of *Nüsser* in regular course.” *Id.* (citing Ex. 1010 ¶¶ 42–44).

In addition to Dr. Hall-Ellis’s testimony regarding a print version in the University of California – Berkeley library, Petitioner cites Dr. Hall-Ellis’s description of an additional MARC record from the Linda Hall Library as showing that a print version of the proceedings for the conference was cataloged on December 18, 2000 in that library. *Id.* at 5 (citing Ex. 1037 ¶ 21, Attachment D).

(4) *Nüsser- Generally*

Petitioner additionally filed exhibits that Petitioner asserts are articles “published prior to or shortly after the priority date of the ’210 patent” that cite *Nüsser*. *Id.* at 5–6 & n.6 (citing Ex. 1038, 2 n.3; Ex. 1039, 19 n.7; Ex. 1040, 5 n.1; Ex. 1037 ¶¶ 23–25). Petitioner describes these as “all dated 2001” and specifically describes Exhibit 1040 as dated November 2001. *Id.* (citing Ex. 1045, 1). Dr. Hall-Ellis describes Exhibit 1039 as a paper presented at a conference held on October 22–25, 2001. Ex. 1037 ¶ 24.

3. *Analysis*

As detailed below, in the Petition, Petitioner at first asserted a date of June 23, 2000 for the availability of Exhibit 1006. After Patent Owner presented evidence and highlighted inconsistencies regarding this date, in the Reply Petitioner modified its asserted date of availability to “on or shortly after” June 23, 2000, presented additional evidence and testimony regarding a print version without any evidence regarding any identity of the print version with the digital version, and provided additional evidence that does not confirm the availability of the digital version.

After considering the arguments and weighing the evidence presented by the parties, we determine that Petitioner has not proven by a

preponderance of the evidence that Nüsser (Exhibit 1006) was disseminated or otherwise made available to the extent that persons of ordinary skill in the art, exercising reasonable diligence, could locate it before the critical date of the invention. *See Medtronic*, 891 F.3d at 1380.

a) Critical Date

The U.S. application that issued as the '210 patent was filed on March 14, 2002. Ex. 1001, code (22). Petitioner argues that one of ordinary skill in the art could have located Nüsser and, therefore, that Nüsser was publicly accessible at least one year before March 14, 2002. Pet. 5–6, 8. In other portions of the Petition, however, Petitioner makes arguments relating to public accessibility of references prior to September 20, 2001, which is the foreign priority date for the '210 patent. Ex. 1001, code (30); Pet. 3, 7, 24–27. Dr. Hall-Ellis, in her first declaration, discusses availability one year before September 20, 2001, in other words, as of September 20, 2000. Ex. 1010 ¶¶ 24, 49, 51.

Because Patent Owner did not submit any evidence to establish an earlier invention date, we use the foreign priority date of the '210 patent, September 20, 2001, as the relevant date for our analysis of pre-AIA § 102(a). For our pre-AIA § 102(b) analysis, we consider the public accessibility of the references one year before the March 14, 2002, filing date of the U.S. application that issued as the '210 patent, that is, as of March 14, 2001. *See GoPro, Inc.*, 908 F.3d at 693; *see also Foster*, 343 F.2d at 986; MPEP 2133.02 II.

Whether the relevant date is March 14, 2001, or September 20, 2001, does not change our determination that Petitioner has not met its burden to show that Nüsser was publicly accessible before the critical date of the

invention. Because March 14, 2001, is the earlier of these two dates, we examine the availability of the asserted references as of March 14, 2001.

b) Nüsser - Digital Version of Nüsser (Exhibit 1006)

Petitioner has presented inconsistent statements and evidence with respect to its Exhibit 1006. Petitioner first asserts that Exhibit 1006 was available to users in the Auraria Library as of June 23, 2000, based on Dr. Hall-Ellis's testimony that the digital volume containing Exhibit 1006 "was cataloged in the Auraria Library . . . on June 23, 2000 [and] [t]herefore, this volume would have been available to users in the Auraria Library . . . on that date." Ex. 1010 ¶¶ 47, 50, Attachment B1; Pet. 4, 6, 8 (citing Ex. 1010 ¶¶ 45–50). Dr. Hall-Ellis bases her testimony on the presence of this date in field 008 of the MAC record that is Attachment B1 to her declaration. Ex. 1010 ¶ 47.

In the Reply, Petitioner changes its allegation regarding the timing of Nüsser's availability, now asserting it was available "on *or shortly after* June 23, 2000" without discussing or explaining the change. Pet. Reply 10–11; Tr. 14:14–20 (emphasis added). This appears to be based on Dr. Hall-Ellis's explanation that field 008 "reflects the date on which, *or shortly after which*, a work was first acquired and cataloged by the library that created the original MARC record." Ex. 1010 ¶ 37 (emphasis added). Dr. Hall-Ellis does not explain what period of time may be considered "shortly after," and Petitioner only presents attorney argument that, with final papers for the conference only due on July 10, 2000, a digital version of the proceedings still might have been available shortly after June 23, 2000. Pet. Reply 13 (discussing Ex. 2019).

However, as Patent Owner points out, Dr. Hall-Ellis's testimony also indicates that libraries occasionally use a previously-created MARC record

when they subsequently acquire a copy of a work that is the subject of such a previously-created MARC record, and that these MARC records may be initially created by vendors rather than libraries. PO Resp. 3–4 (citing Ex. 1010 ¶ 38; Ex. 1037 ¶¶ 14–15; Ex. 2024, 18:6–20:17, 45:5–20, 62:20–63:10). Moreover, Dr. Hall-Ellis testifies that the Auraria Library did not create the MARC record she relies on and that a library that subsequently acquires a copy of a work might not change the date in a previously-created MARC record 008 field (in this case June 23, 2000). Ex. 2024, 24:15–24; Ex. 1010 ¶ 38. As Patent Owner argues, this discrepancy between her testimony regarding the availability of the reference in the Auraria Library based on the 008 field, on the one hand, and regarding details in the MARC record and their possible meanings, on the other, significantly undermines her testimony regarding Nüsser’s availability on (or “on or shortly after”) June 23, 2000. PO Resp. 3–6.

Additionally, Petitioner argues that Nüsser was indexed by subject matter and that an interested person of ordinary skill in the art, exercising reasonable diligence, could have located the reference. Pet. 6 (citing Ex. 1010 ¶¶ 45–50); Pet. Reply 14–16. Petitioner relies on Dr. Hall-Ellis’s declaration testimony regarding the MARC record that is Attachment B2. Pet. 6 (citing Ex. 1010 ¶¶ 45–50). But, as Patent Owner argues, Petitioner presents no evidence regarding the relationship of Attachment B2, relating to the entire run of the serial publication in which Nüsser was published, to Exhibit 1006, which Petitioner presents as having been part of the digital version available in June 2000 or shortly thereafter. PO Resp. 8. Moreover, the Attachment B2 MARC record was created several years before the purported date of Nüsser, and the record was updated as recently as 2018. Ex. 1010 ¶ 48. Dr. Hall-Ellis admits that there is no indication as to when

the cited subject matter classifications were added to MARC records. Ex. 2024, 40:6–13, 52:18–56:16; *see* PO Resp. 13. Thus, Petitioner has not established that the subject matter classifications would have been available to one of ordinary skill in the art as of the critical date. Furthermore, we agree with Patent Owner (PO Resp. 11–13; PO Sur-reply 11) that the subject matter classifications for Attachment B2 are too broad and would have resulted in too many search results to meaningfully index a single paper—Nüsser—within an entire serial run of conference proceedings such that an ordinarily skilled artisan could have located it with reasonable diligence. *See Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 773 (Fed. Cir. 2018) (affirming a finding that an indexed reference was not publicly accessible where an ordinarily skilled artisan would have had to skim through hundreds of titles to find it). For these reasons, we do not credit Petitioner’s evidence regarding the subject matter classifications for Attachment B2.

With respect to the indexing by subject matter of the digital version as shown in Attachment B1, Petitioner argues that Patent Owner does not “address the 692 subject-matter headers in Attachment B1.” Pet. Reply 16. However, Petitioner did not initially cite subject matter headers from Attachment B1 in support of its public accessibility arguments. Pet. 6; Ex. 1010 ¶¶ 49–50. And, even if we were to consider Petitioner’s new reply arguments about the subject matter headers of Attachment B1 (Pet. Reply 14–15), we agree with Patent Owner that these alone result in too many search results to meaningfully index Nüsser, a single paper within a conference proceedings volume, such that an ordinarily skilled artisan could have located it with reasonable diligence. PO Resp. 11–13; PO Sur-reply

11. Thus, we do not credit Petitioner’s belated arguments and evidence regarding the subject matter classifications for Attachment B1.

Petitioner argues that the date on the first page of Nüsser and certain information on other pages provide additional evidence of public accessibility. Pet. 6 (citing Ex. 1006, 1 (“September 24–28, 2000”)); Pet. Reply 2–3 (citing Ex. 1006, 1, 2, 10, 15). Petitioner argues that, under the precedential *Hulu* decision, “indicia on the face of a reference, such as printed dates and stamps, are considered as part of the totality of the evidence,” and that the Board in *Hulu* accepted this type of evidence in its considerations. *Id.* (citing *Hulu* at 17–18). Pet. Reply 3. We considered these indicia from Nüsser at the time of institution, and we have considered them again now. Based on the entire trial record, we find that the indicia alone do not and cannot substantiate publication by the dates listed in Nüsser. Nor do they overcome significant gaps and inconsistencies in Petitioner’s proofs regarding the date by which Nüsser was made publicly accessible such that an ordinarily skilled artisan could have located it with reasonable diligence.

With respect to Exhibits 1038–1040, articles citing Nüsser as described *supra* at Section II.2.c.4, Petitioner argues that these articles establish that Nüsser was publicly available as of the critical date, because “even if these articles were published shortly after the priority date” they indicate accessibility as of that date, as “it is unlikely that Nüsser would have been published and then immediately cited in a final publication published a few weeks or months later.” Pet. Reply 5–6 & n.3 (emphasis omitted). However, Petitioner has not shown that Exhibit 1038 was published before March 14, 2001, and Exhibit 1039 and Exhibit 1040 were published after that date. *See* Ex. 1038, 1 & n.1 (describing an event in

February 2001 in the past tense); Ex. 1037 ¶ 24 (describing Ex. 1039 as presented in late October 2001); Pet. Reply 6 n.3 (citing Ex. 1045; describing Ex. 1040 as dated November 2001). With the exception of Exhibit 1038, for which only a year is shown, each exhibit was published more than “a few weeks or months” later than March 14, 2001, and thus we do not find them significant in establishing public accessibility as of that 102(b) date.

Petitioner argues that, as in *Hulu*, it has made arguments relating to several dates, each of which pre-date the critical date, and thus “uncertainty regarding the precise date” of public accessibility is of no moment. Pet. Reply 1–2 (citing *Hulu* at 19). However, unlike in *Hulu*, there are significant issues with the dates propounded, as described above.

On consideration of the evidence and record on these dates, especially with respect to the initially-asserted June 23, 2000, date, the evidence contains numerous flaws or gaps as discussed above. We are not persuaded by a preponderance of the evidence that a digital version of Nüsser was available prior to the critical date.

c) Nüsser – Additional Arguments

As discussed above, Exhibit 1006 was presented in the Petition as a publicly accessible reference on the basis of its availability in *digital* form through the *Auraria Library*, and on the basis of the date on its cover. Pet. 6 (citing Ex. 1010 ¶¶ 45–50; Ex. 1006, 1); Ex. 2024, 30:6–16 (describing Attachment B1 to Exhibit 1010 as relating to “an electronic resource”). As detailed above in Section II.2, Petitioner, initially and then in response to the Patent Owner’s assertions regarding issues with the Petitioner’s evidence of the public accessibility of Exhibit 1006, makes arguments regarding the MARC record that is Attachment B2 to Exhibit 1010. This attachment

relates to a print version of the serial proceedings issued over many years. Ex. 1010 ¶ 49; Ex. 2024, 45:23–45:15. Petitioner’s arguments relating to this MARC record therefore relate to the public accessibility of a print article as collected in serial proceedings. Additionally, Petitioner presents arguments relating to the actual dissemination of a print version of the proceedings at a conference and to a library. Pet. Reply 3–5 (citing Ex. 1036 ¶¶ 10–11; Ex. 1037 ¶ 21, Attachment D).

Because these arguments relate to a print version of the conference proceedings, they amount to new arguments that Petitioner chose not to make in the Petition and are not responsive to Patent Owner’s arguments asserting flaws in Petitioner’s contentions and evidence, which related to whether the digital version of Nüsser, presented here as Exhibit 1006, was available on the critical date. Rather, they raise new issues regarding actual dissemination of or the availability of a print version of the proceedings for the conference. *See Acceleration Bay, LLC.*, 908 F.3d at 775; *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369–70 (Fed. Cir. 2016). New evidence may be submitted to respond to arguments raised in a prior brief or as rebuttal evidence, however, in this case, we do not agree that the new evidence and arguments here are responsive to Patent Owner’s arguments, but rather they appear to take a “new direction with a new approach.” Patent Trial and Appeal Board Consolidated Trial Practice Guide, November 2019 (“CTPG”),⁶ 73–75.

Petitioner does not show or assert that the print proceedings contain the same version of Nüsser as that presented as Exhibit 1006. Nor has Petitioner filed a copy of Nüsser from a print version of the proceedings

⁶ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

(either those asserted to have been distributed at the conference or present in the University of California – Berkeley or Linda Hall libraries).

Additionally, the MARC records presented for these proceedings and Dr. Hall-Ellis’s declarations regarding them are subject to some of the same issues we discuss above with respect to the digital form of Nüsser, in that field 008 may not indicate availability.

For these reasons, Petitioner’s arguments with respect to the print version of proceedings containing the Nüsser references do not establish that Exhibit 1006 qualifies as a publicly accessible printed publication.

d) Conclusion

For the reasons given above, Petitioner has not met its burden to show that Nüsser was disseminated or otherwise made available to the extent that persons of ordinary skill in the art, exercising reasonable diligence, could have located it before the critical date of the invention.

Both instituted grounds of unpatentability rely on Nüsser for certain teachings and for the motivation to combine and modify references to limit interference and distraction to a driver. Pet. 5, 40–42, 58, 61, 71, 74–76; *see* Dec. on Inst. 27–29, 36. Therefore, Petitioner fails to demonstrate by a preponderance of the evidence that any of the challenged claims are unpatentable based on the instituted grounds.

III. PENDING MOTIONS

A. Petitioner’s Motion to Strike

Petitioner moves to strike Patent Owner’s Sur-reply Exhibits 2034–2037 and portions of the Sur-reply that discuss those exhibits based on the CTPG. Pet. Mot. Strike 1.

Petitioner contends that the CTPG places a blanket bar on any new evidence other than deposition transcripts of the cross-examination of reply

witnesses. *Id.* at 2 (citing CTPG, 73). Petitioner argues that portions of the Sur-reply should be stricken as discussing improperly submitted exhibits, and that it is “beyond dispute” that they are “belatedly presented.” *Id.* at 3–4 (quoting CTPG, 80–81).

We do not rely on these exhibits or the related portions of Patent Owner’s Sur-reply. Accordingly, we dismiss as moot the Motion to Strike.

B. Patent Owner’s Motion to Exclude

Patent Owner moves to exclude all or part of Exhibits 1006, 1007, 1010, 1012, 1015–1018, 1023–1028, 1036–1040, 1045, and 1046. PO Mot. Exclude 1. Because we ultimately find for Patent Owner without excluding the documents listed in Patent Owner’s Motion, we dismiss as moot Patent Owner’s Motion to Exclude.

IV. CONCLUSION

After considering all the evidence and arguments in the complete record, we conclude that Petitioner fails to demonstrate, by a preponderance of the evidence, that any of the Challenged Claims are unpatentable. We dismiss as moot Petitioner’s Motion to Strike and Patent Owner’s Motion to Exclude.

In summary:

Claims	35 U.S.C. §	Reference(s)/ Basis	Claims Shown Unpatentable	Claims Not shown Unpatentable
12, 13, 15, 17, 20, 21	103	Bluetooth Profiles, Nüsser		12, 13, 15, 17, 20, 21
12, 14, 16, 19–21	103	Bluetooth Profiles, Cooper, Nüsser		12, 14, 16, 19–21
Overall Outcome				12–17, 19–21

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 12–17 and 19–21 are not unpatentable based on the instituted grounds of unpatentability;

FURTHER ORDERED that that Petitioner’s Motion to Strike is dismissed as moot;

FURTHER ORDERED that that Patent Owner’s Motion to Exclude is dismissed as moot; 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.

IPR2020-00996
Patent 7,127,210 B2

PETITIONER:

Raghav Bajaj
David L. McCombs
Jonathan R. Bowser
Angela Oliver
HAYNES AND BOONE, LLP
raghav.bajaj.ipr@haynesboone.com
david.mccombs.ipr@haynesboone.com
jon.bowser.ipr@haynesboone.com
angela.oliver.ipr@haynesboone.com

Roshan S. Mansinghani
Alyssa J. Holtslander
UNIFIED PATENTS, LLC
roshan@unifiedpatents.com
alyssa@unifiedpatents.com

PATENT OWNER:

Zachary D. Silbersher
Sergey Kolmykov
KROUB, SILBERSHER & KOLMYKOV PLLC
zsilbersher@kskiplaw.com
skolmykov@kskiplaw.com