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Paper 31
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC., MOTOROLA MOBILITY LLC, and
SAMSUNG ELECTRONICS CO., LTD.,
Petitioners,

v.

ARENDI S.A.R.L.,
Patent Owner.

Case IPR2014-00452[1]
Patent 6,323,853 B1

Before MICHAEL R. ZECHER, NEIL T. POWELL, and
KEVIN W. CHERRY, *Administrative Patent Judges.*

POWELL, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

[1] Case IPR2014-01518 has been joined with this proceeding.

I. INTRODUCTION

Petitioners Google Inc. ("Google") and Motorola Mobility LLC ("Motorola") filed a Petition requesting *inter partes* review of claims 1–79 of U.S. Patent No. 6,323,853 B1 ("the '853 patent"). IPR2014-00452, Paper 1 ("Pet."). On August 20, 2014, we instituted an *inter partes* review of claims 1–79 based on certain grounds presented in the Petition. IPR2014-00452, Paper 10 ("Dec. to Inst."). On November 3, 2014, Patent Owner, Arendi S.A.R.L., filed its Patent Owner Response. IPR2014-00452, Paper 17 ("PO Resp."). On February 3, 2015, Google and Motorola filed a Reply. IPR2014-00452, Paper 23 ("Pet. Reply").

Samsung Electronics Co., Ltd. ("Samsung") filed a second Petition for *inter partes* review of claims 1–79 of the '853 patent. IPR2014-01518, Paper 1. The second Petition challenged claims 1–79 on the same grounds as those for which we instituted trial in IPR2014-00452. Concurrent with the second Petition, Samsung filed a motion to join IPR2014-01518 with IPR2014-00452. IPR2014-01518, Paper 3. On March 18, 2015, we instituted an *inter partes* review with respect to all challenges raised in the second Petition, joined IPR2014-01518 with IPR2014-00452, and terminated IPR2014-01518. IPR2014-01518, Paper 10; IPR2014-00452, Paper 26.[2]

An oral hearing was held on April 21, 2015. A transcript of the oral hearing is included in the record. Paper 30 ("Tr.").

[2] From this point forward, all references to "Petitioners" refer to Google, Motorola, and Samsung. Additionally, from this point forward, all references to papers and exhibits refer to the documents filed in IPR2014-00452.

We have jurisdiction under 35 U.S.C. § 6(b). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons that follow, we determine that Petitioners have shown, by a preponderance of the evidence, that claims 1–79 of the '853 patent are unpatentable.

A. Related Proceedings

The '853 patent has been asserted in several district court cases in the U.S. District Court for the District of Delaware, including *Arendi S.A.R.L. v. Motorola Mobility LLC*, Case No. 1-12-cv-01601; *Arendi S.A.R.L. v. Google Inc.*, Case No. 1-13-cv-00919; and *Arendi S.A.R.L. v. Samsung Electronics Co. Ltd.*, Case No. 1-12-cv-01598. Pet. 1; *see* Paper 6, 2–3. Additionally, other patents related to the '853 patent have been the subject of petitions for *inter partes* review in other cases, including IPR2014-00203, IPR2014-00206, IPR2014-00207, IPR2014-00208, IPR2014-00214, and IPR2014-00450. Paper 6, 3.

B. The '853 Patent (Ex. 1001)

The '853 patent discloses a method, system, and computer readable medium that provide a function of searching a database or file for information corresponding to text in a program, such as a word processor. Ex. 1001, Abstract. If the database or file includes the corresponding information searched for, the information is displayed and possibly inserted into the word processor. *Id.* The '853 patent discusses an example of this function in connection with Figures 3 and 4. *Id.* at col. 5, l. 60–col. 6, l. 2.

Figure 3 is reproduced below.

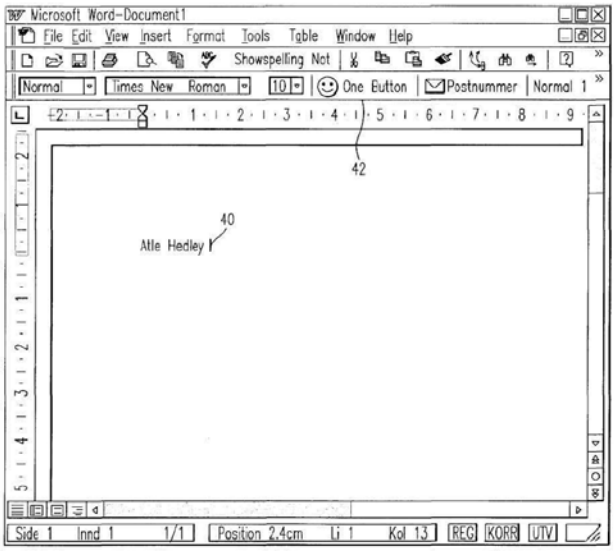

FIG. 3

Figure 3 shows a word processor document in which a user has typed name 40. *Id.* at col. 5, ll. 60–62. When the user hits button 42, the program according to the '853 patent retrieves name 40 from the document and then searches for name 40 in a database. *Id.* at col. 5, ll. 62–65. As a result of this search, the program retrieves address 44, which is associated with name 40, and inserts address 44 in the document, as shown in Figure 4, reproduced below. *See id.* at col. 5, ll. 65–67.

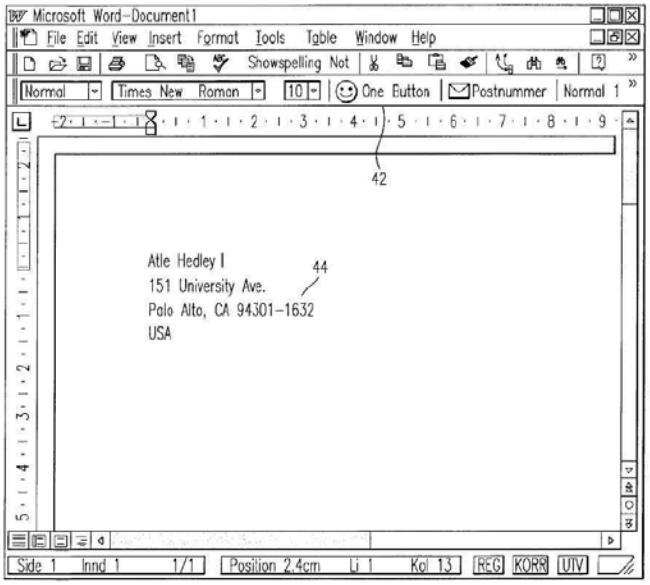

FIG. 4

Figure 4 shows the word processor document of Figure 3 with address 44 inserted. *See id.* The '853 patent discusses its process in greater detail in connection with Figure 1a, reproduced below. *Id.* at col. 4, l. 22–col. 5, l. 57.

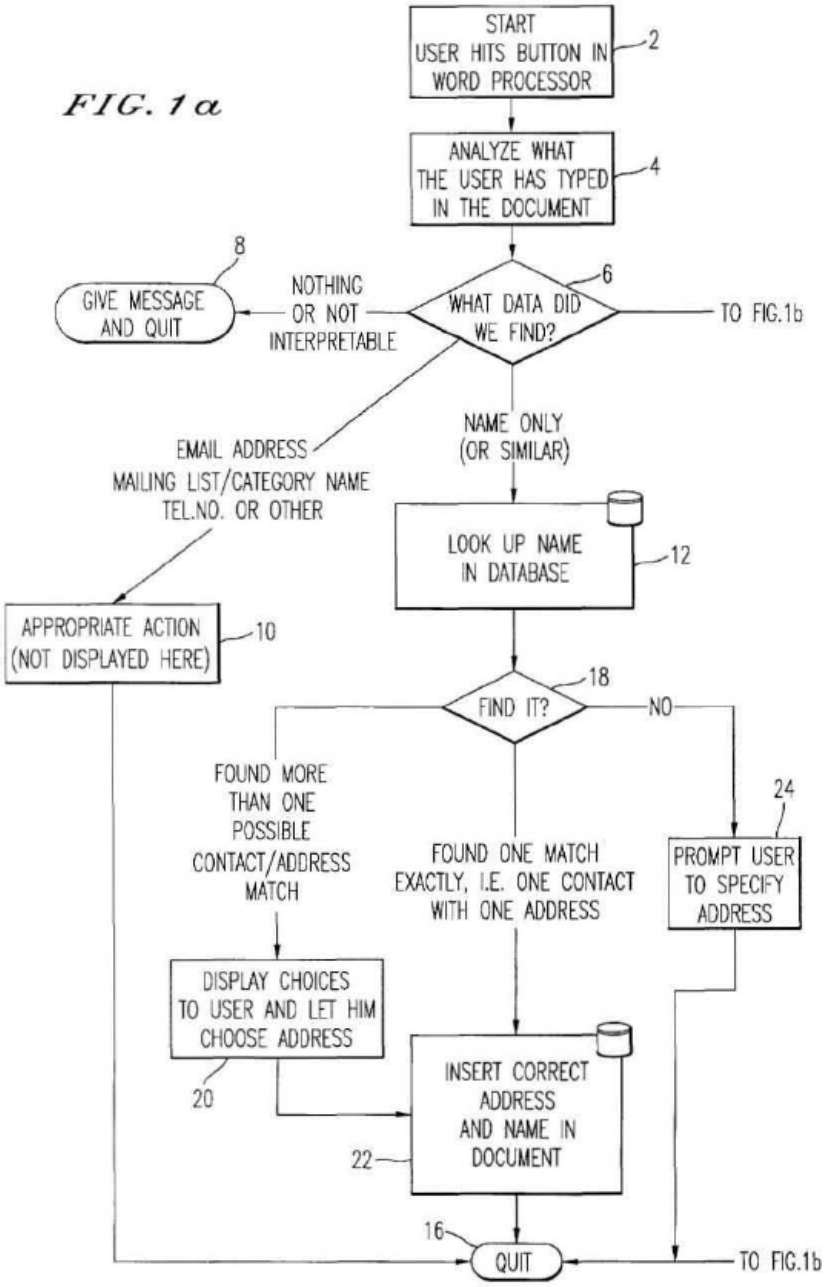

Figure 1a shows a flow chart illustrating a method according to the '853 patent. *Id.* at col. 2, ll. 38–40. At step 2, the user initiates the

analyzing and searching processes by commanding a button, such as button 42 shown in Figures 3 and 4. *See id.* at col. 4, ll. 23–25; col. 5, ll. 62–65; col. 6, ll. 1–2. At step 4, "the program analyzes what the user has typed in the document." *Id.* at col. 4, ll. 24–25.

At step 6, the program determines what it found in the document. *Id.* at col. 4, ll. 25–26. If the program found nothing or uninterpretable information in the document, the program proceeds to step 8, in which the program provides an appropriate message for the user. *Id.* at col. 4, ll. 26–29. If the program found "an e-mail address mailing list/category name telephone number or other information, at step 10 an appropriate action is performed by the program." *Id.* at col. 4, ll. 38–41.

If the program found only a name, initials, or the like, "the program looks up the name in the database at step 12," and determines at step 18 what it found. *Id.* at col. 4, ll. 39–44. If the program found that the name matches only one contact associated with only one address in the database, the program inserts the address and name in the document at step 22. *Id.* at col. 4, ll. 50–53. If the program found multiple possible addresses associated with the name in the database, the program presents the user with menu choices that allow the user to select the correct name and address for insertion in the document at step 22. *Id.* at col. 4, ll. 44–49.

At the end of the written description, the '853 patent discusses various ways in which its disclosure is not limited to the examples discussed in connection with Figures 1–16. For example, the '853 patent states:

> Although the present invention is defined in terms of a program retrieving information from a document before searching a database, the user may select the information in the document to be searched by the program in the database (e.g., by highlighting, selecting, italicizing,

> underlining, etc.), as will be readily apparent to those skilled in the art.

Id. at col. 10, ll. 5–9.

C. Illustrative Claim

Petitioners challenge claims 1–79 of the '853 patent. Claim 1 is the only independent claim and reads as follows:

> 1. A computerized method for information handling within a document created using an application program, the document including first information provided therein, the method comprising:
>
> providing a record retrieval program;
>
> providing an input device configured to enter an execute command which initiates a record retrieval from an information source using the record retrieval program;
>
> upon a single entry of the execute command by means of the input device:
>
> analyzing the document to determine if the first information is contained therein, and
>
> if the first information is contained in the document, searching, using the record retrieval program, the information source for second information associated with the first information; and
>
> when the information source includes second information associated with the first information, performing at least one of,
>
> (a) displaying the second information,
>
> (b) inserting the second information in the document, and

(c) completing the first information in the document based on the second information.

Ex. 1001, col. 10, ll. 28–52.

D. The Prior Art

The pending grounds of unpatentability in this *inter partes* review are based on the following prior art:

U.S. Patent No. 5,923,848, issued July 13, 1999 ("Goodhand") (Ex. 1003).

Gordon Padwick et al.,[3] USING MICROSOFT OUTLOOK 97 (Que® Corporation[4] 1997[5]) ("Padwick") (Ex. 1004).

[3] Our citations to Padwick refer to the page numbers inserted at the bottom center of each page. The Petition cites to the page numbers that appear in either the upper left or upper right portion of most pages of Padwick. We do not cite to these page numbers because some pages do not include these page numbers.

[4] The Petition identifies "Microsoft Press" as the source of Padwick. Pet. iii. Padwick, however, identifies "Que® Corporation" as the publisher. Ex. 1004, 5. Petitioners do not identify any evidence that Microsoft Press is the source of Padwick. Indeed, Mr. Dennis R. Allison, Petitioners' declarant, testifies that Padwick was published by Que® Corporation. Ex. 1002 ¶ 198.

[5] Padwick identifies 1997 as its copyright date. Ex. 1004, 5. The Petition identifies 1996 as the date of Padwick. Pet iii. Mr. Allison testifies that "Padwick has a copyright date of 1997," but that he "can also see from the bibliographic information that Padwick has a Library of Congress control number having the first two digits '96', which indicates that it was deposited with the Library of Congress in 1996" and that "[e]xperts in this field would reasonably rely on this data to establish a publication date." Ex. 1002 ¶ 199. For purposes of this decision, we need not decide, as Patent Owner does not dispute, whether the evidence regarding the Library of Congress control number establishes a publication date earlier than the 1997 copyright date explicitly listed in Padwick.

E. Instituted Grounds of Unpatentability

We instituted an *inter partes* review involving the following grounds of unpatentability:

Reference[s]	Basis	Claims Challenged
Goodhand	§ 103(a)	1–9, 11, 13–29, 38–45, 57–64, 66, 68–75, 77, and 79
Goodhand and Padwick	§ 103(a)	6, 10, 12, 21, 27, 30–37, 42, 46–56, 61, 65, 67, 72, 76, and 78

Petitioners support their challenges with a Declaration executed by Dennis R. Allison, on February 20, 2014 ("Allison Declaration") (Ex. 1002). Patent Owner relies on a Declaration executed by John V. Levy, Ph.D., on October 21, 2014 ("Levy Declaration") (Ex. 2008).

II. ANALYSIS

A. Claim Interpretation

"A claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears." 37 C.F.R. § 42.100(b); *see also In re Cuozzo Speed Techs., LLC*, No. 2014-1301, 2015 WL 4097949, *7–*8 (Fed. Cir. July 8, 2015) (In considering the broadest reasonable interpretation standard for *inter partes* review proceedings, the United States Court of Appeals for the Federal Circuit determined that "Congress implicitly approved the broadest reasonable interpretation standard in enacting the AIA," and "the standard was properly adopted by PTO regulation."),[6] *reh'g en banc denied*, _F.3d_, 2015 WL

[6] Patent Owner objects in its Response to our application of the broadest reasonable construction standard in *inter partes* review proceedings. PO

4100060 (Fed. Cir. July 8, 2015). Under that standard, the claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010). Thus, we generally give claim terms their ordinary and customary meaning. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) ("The ordinary and customary meaning is the meaning that the term would have to a person of ordinary skill in the art in question.") (citation and internal quotation marks omitted).

Petitioners and Patent Owner proffer constructions for a number of terms. Pet. 11–14; PO Resp. 9–19, 36–45; Pet. Reply 7–14. In this decision, we construe only those claim terms in controversy, and we do so only to the extent necessary to resolve the controversy. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

1. "upon a single entry of the execute command by means of the input device: analyzing the document to determine if the first information is contained therein" (claim 1)

Patent Owner argues that this claim language requires a number of things. Patent Owner argues that in claim 1 the recited "analyzing" is a separate process from and a pre-condition to the "searching" process subsequently recited in the claim language—namely, "if the first information is contained in the document, searching, using the record retrieval program, the information source for second information associated with the first information." PO Resp. 12–13. Patent Owner also contends that claim 1 "require[s] distinguishing the presence of first information, from other text

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Resp. 45–53. *Cuozzo*, which was decided after Patent Owner filed its Response, resolves this argument by affirming our use of the broadest reasonable construction standard in *inter partes* review proceedings involving unexpired patents.

in the document, and this process is triggered by a single entry of the execute command." *Id*. at 11. Patent Owner further argues that, "[b]ecause the broadest reasonable construction cannot be inconsistent with the explicit basis for allowance of the application leading to issuance of the '853 Patent, claim 1 rules out user selection of contact information." *Id.* at 35.

Petitioners contest Patent Owner's claim construction arguments. Petitioners argue that the disputed claim language does not require distinguishing contact information from other text in the document.[7] Pet. Reply 7–9. Additionally, Petitioners argue that Patent Owner misconstrues the claim language related to the recited "single entry of the execute command." *Id.* at 10–12. Furthermore, Petitioners dispute Patent Owner's claim construction arguments based on the prosecution history of the '853 patent. *Id.* at 12–14.

a. Patent Owner's argument that the recited "analyzing" is separate from and a precondition to the "searching" recited in claim 1

Patent Owner argues that claim 1 requires "(first) 'analyzing the document to determine if the first information is contained therein" and (second) 'if the first information is contained in the document,' then

[7] Some statements in Patent Owner's Response tend to imply that Patent Owner believes claim 1 requires distinguishing "contact information" from other information. *See, e.g.*, PO Resp. 6 ("The logical flow diagram of Fig. 1 therefore shows that a computer process corresponding to 'upon a single entry of the execute command by means of the input device:/ analyzing the document to determine if the first information is contained therein' in claim 1 of the '853 Patent distinguishes contact information from other text in the document."). At the oral hearing, Patent Owner confirmed that its argument in this regard is that the claims require distinguishing "first information" from other information, not that the claims require distinguishing "contact information" from other information. Tr. 37, l. 6–38, l. 1.

'searching, using the record retrieval program, the information source for second information associated with the first information.'" PO Resp. 12–13. Patent Owner further argues that:

> The analyzing process precedes the searching process, which is a separate process. A determination by the analyzing process that "the first information is contained in the document" is a pre-condition for the searching process. The Board adopted this construction in its Institution Decision (p. 13).

Id. at 13.

Consistent with Patent Owner's arguments, our Institution Decision expressed agreement with Patent Owner regarding this aspect of the meaning of claim 1, stating that:

> The plain language of the claim sets out "analyzing" and "searching" as separate actions, conditioning the execution of the searching action on a determination that the document contains the first information. The written description discloses a system consistent with the plain meaning of the claim language (*see, e.g.*, Ex. 1001, col. 4, l. 22–col. 5, l. 7), and there is no cited evidence that the proper construction of the claim differs from its plain meaning).

Dec. to Inst. 13. The record developed at trial provides no reason to modify this interpretation.

b. Patent Owner's argument that the claim language requires distinguishing first information from other text in the document

In support of its assertion that claim 1 requires distinguishing first information from other text in the document, Patent Owner argues the following: 1) the "analyzing" step determines *if* the document contains the "first information"; and 2) the claims do not preclude the document from having other text from which the first information would have to be

distinguished. PO Resp. 13–14. Patent Owner also argues that this interpretation is "consistent with the logical flow shown in Fig. 1 and as the logical flow is described in the '853 Patent." *Id*. at 14; *see id.*at 14–16.

Petitioners disagree. Pet. Reply 7–8. Petitioners argue that, "[b]ecause the word 'first' does not limit the word 'information' by type, the 'analyzing' step—which [Patent Owner] drafted—requires only a determination that some piece of information is present in the document." *Id*. at 8. Petitioners argue that the Specification of the '853 patent contradicts Patent Owner's argument that the claim requires distinguishing the first information from other information. *Id*. Specifically, Petitioners note that Figures 3 and 14 and the corresponding disclosure in the '853 patent provide examples where the only information in a document is one instance of first information, specifically the name "Atle Hedley." *Id*.

We disagree with Patent Owner's argument that the claims require distinguishing first information from other text in the document. We first consider the plain language of the claim, which says nothing about any other text in the document, much less distinguishing the "first information" from any other text in the document. Turning to the other disclosures in the '853 patent, the example discussed in connection with Figure 3 discloses analyzing a document that does not contain any text other than the "first information," which, in that instance, is the name "Atle Hedley." *See* Ex. 1001, col. 5, ll. 60–67; Fig. 3. This example contradicts Patent Owner's argument that the disclosures in the Specification indicate the claims require distinguishing first information from other text in the document.

c. Patent Owner's argument that the analyzing process is triggered by a single entry of the execute command

Because the claim language specifies that the "analyzing" process occurs "upon a single entry of the execute command," Patent Owner argues that claim 1 "rule[s] out action by the user, such as selection of text in the document to be analyzed, as a condition for the analyzing to take place." PO Resp. 17 (citing Ex. 2008 ¶ 25). Citing a dictionary, Patent Owner argues that "[t]he word 'upon' means 'on', and is 'used to say that someone or something is very close or has arrived.'" *Id.* (citing FREE MERRIAM-WEBSTER DICTIONARY, accessed on October 6, 2014 at http://www.merriam-webster.com/dictionary/upon). Patent Owner then argues that "[i]n this context, the meaning of 'upon' is clearly that the analyzing process occurs as a result of and proximate in time to entry of the execute command." *Id.* (citing Ex. 2008 ¶ 24). Emphasizing that the claim recites "upon a *single* entry" and arguing that "the execute command triggers the 'analyzing of the document to determine if the first information is contained therein,'" Patent Owner argues that the claims preclude any action other than the single entry of the execute command as a condition to execution of the "analyzing" process. *Id.* at 17–18 (citing Ex. 2008 ¶ 25).

Petitioners counter that the word "single" in the disputed claim language modifies "entry," arguing that "[t]he claim thus excludes the 'analyzing' happening only after two (or more) entries of the execute command." Pet. Reply 11. Noting that claim 1 uses the "comprising" transitional term, Petitioners argue that the claim does not restrict actions prior to entry of the execute command. *Id.* Petitioners further argue that "Dr. Levy has admitted [that]. . . even in the '853 patent there are a large number of user actions that must occur prior to the 'execute command' if

one wants to trigger the 'analyzing' step." *Id.* at 11–12 (citing Ex. 1016, 75, l. 21–79, l. 18).

At the oral hearing, Patent Owner sought to rebut Petitioners' assertions and clarify its initial argument. Patent Owner asserted that Petitioners' assertion that "single" only excludes multiple entries of the execute command "challenges the imagination." Tr. 30, ll. 3–10. Patent Owner further asserted that Petitioners' argument is illogical in the context of other claim language. *Id.* at 30, ll. 3–23. Patent Owner referred to the recitation in claim 1 of "an execute command which initiates a record retrieval." *Id.* at 30, ll. 12–17. Given this claim language, Patent Owner argued that "[t]herefore, by definition, the first execute command has already initiated the record retrieval because that's what the claim says it does." *Id.* at 30, ll. 18–20. Based on this assertion, Patent Owner suggested that the claim term "single" would be redundant if it only excluded multiple entries of the execute command. *Id.* at 30, ll. 20–23.

In response, Petitioners asserted that Patent Owner's argument does not make sense in the context of "a specification that expressly includes user selection in a family of patents that otherwise expressly claims user selection." *Id.* at 46, ll. 18–23.

We agree with Patent Owner insofar as the disputed claim language requires that the recited "analyzing" ensues when "a single entry of the execute command" occurs. This follows from the plain meaning of the claim language, and no evidence to the contrary has been cited.

We do not agree, however, with Patent Owner's argument that claim 1 "rule[s] out action by the user, such as selection of text in the document to be analyzed, as a condition for the analyzing to take place." PO Resp. 17

(citing Ex. 2008 ¶ 25). According to the plain meaning of "upon a single entry of the execute command . . . analyzing the document," the word "single" does modify entry, thereby excluding multiple entries of the execute command. Additionally, claim 1's use of the transitional term "comprising" indicates that the method may include other actions prior to the recited "single entry of the execute command." Furthermore, contrary to Patent Owner's assertion, the claim language "an execute command which initiates a record retrieval from an information source," by itself, does not convey clearly that the record retrieval necessarily occurs because of one entry of the execute command. Moreover, the portion of Dr. Levy's deposition testimony cited by Petitioners persuades us that the system disclosed by the '853 patent would require user actions prior to entering the execute command to trigger the analyzing process. *See* Ex. 1016, 75, l. 21–79, l. 18; Pet. Reply 11–12. Additionally, as noted by Petitioners, Patent Owner's argument is contradicted by the Specification's disclosure that:

> Although the present invention is defined in terms of a program retrieving information from a document before searching a database, the user may select the information in the document to be searched by the program in the database (e.g., by highlighting, selecting, italicizing, underlining, etc.), as will be readily apparent to those skilled in the art.

Ex. 1001, col. 10, ll. 5–10; Tr. 46, ll. 18–23.

d. Patent Owner's prosecution history argument

Patent Owner argues that "[t]he public record of the [United States Patent and Trademark Office ("PTO")] . . . shows that the limitations of 'upon a single entry of the execute command by means of the input device:/ analyzing the document to determine if the first information is contained therein' . . . rule out user selection of the first information." PO Resp. 39.

Patent Owner contends that "the present case involves a clear disavowal of claim scope supported by reliance upon the PTO's amendment request and acceptance, and recognized by the courts." *Id.* at 44. Patent Owner notes that the U.S. District Court for the District of Rhode Island, in *Arendi U.S.A., Inc. v. Microsoft Corp.*, Case No. 02-343-T, found a clear disavowal of claim scope consistent with the claim construction arguments advanced by Patent Owner in this case. *Id.* at 39–40. In concert with this, Patent Owner argues that the Federal Circuit summarily affirmed the District Court in *Arendi U.S.A., Inc. v. Microsoft Corp.*, 168 F. App'x 939 (Fed. Cir. 2005). *Id.* at 40. Patent Owner argues that, in an *inter partes* proceeding at the PTO, it is proper to consider prosecution history when construing a claim. *Id.* at 43 (citing *Tempo Lighting, Inc. v. Tivoli, LLC*, 742 F.3d 973 (Fed. Cir. 2014)).

In response, Petitioners argue that we should not consider prosecution history when construing claims in an *inter partes* review. Pet. Reply 12–13 (citing *Marine Polymer Tech., Inc. v. HemCon, Inc.*, 672 F.3d 1350, 1364 (Fed. Cir. 2012) (en banc); *Tempo Lighting*, 742 F.3d at 978). Petitioners also dispute Patent Owner's assertion that the PTO requested amendment of the claims. *Id*. at 13–14.

Since Patent Owner filed its Response and Petitioners filed their Reply, the Federal Circuit has admonished that "[t]he PTO should also consult the patent's prosecution history in proceedings in which the patent has been brought back to the agency for a second review." *Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015). Accordingly, we consider the cited portions of the prosecution history and the parties' arguments about them.

Patent Owner cites a number of documents from the prosecution history of U.S. Patent Application No. 09/189,626 ("the '626 application"), which issued as the '853 patent. Patent Owner cites an Office Action (Ex. 2001) in which the pending claims of the '626 application were rejected based on U.S. Patent No. 6,085,201 to Tso (Ex. 2003, "Tso"). PO Resp. 36. Patent Owner also cites a subsequent Interview Summary (Ex. 2002), Amendment (Ex. 2004), and Notice of Allowance (Ex. 2005). *Id.* at 37–39. We have considered all of these documents, as well as Patent Owner's arguments regarding them.

We find that the cited prosecution history does not demonstrate a clear disavowal of text selection. The Remarks section of the Amendment addresses a number of different subjects. *See* Ex. 2004, 2–4. The first four paragraphs of the Remarks section present background information, including a request for reconsideration, a summary of the status of the claims, a summary of the Office Action, and a summary of an interview between the applicant and examiner ("the examiner interview"). *Id.* at 2–3. The paragraph summarizing the examiner interview bridges pages 2 and 3. *Id.* This paragraph describes an exploratory discussion between the applicant and the examiner about distinguishing Tso, a discussion in which "[n]o agreement was reached." *Id.* at 3. In the following paragraph, the Amendment addresses the scope of the claims, explaining that:

> *Claim 8 has been amended to clarify that according to Applicants' invention*, upon a single entry of an execute command by means of an input device, a document is analyzed to determine if first information is contained therein, and if the first information is contained in the document, an information source is searched for second information associated with the first information using a record retrieval program.

Id. (emphasis added). We find that this latter paragraph contains the only clear statement from the applicant regarding the scope of the claims, and, in our view, it says nothing about whether the claims preclude or encompass text selection. *See id.*

Additionally, we find unpersuasive Patent Owner's citation of the examiner's statements in the Notice of Allowance. *See* PO Resp. 38–39. "[I]t is the applicant, not the examiner, who must give up or disclaim subject matter that would otherwise fall within the scope of the claims." *Sorensen v. Int'l Trade Comm'n*, 427 F.3d 1375, 1379 (Fed. Cir. 2005) (citations omitted).

Furthermore, we find unpersuasive Patent Owner's observation that the Federal Circuit affirmed the decision of the District of Rhode Island. Although we recognize that the Federal Circuit's decision summarily affirmed the decision of the District Court of Rhode Island, the Federal Circuit's decision does not provide guidance as to whether there had been a clear disavowal of subject matter during the prosecution of the '626 application. *See Arendi*, 168 F. App'x 939; *see also* Fed. Cir. R. 36 (noting five possible circumstances for summary affirmance).

Because we find that the prosecution history does not contain a clear disavowal of text selection by a user, we do not adopt Patent Owner's suggestion that we construe the claims as precluding text selection by a user. *See Seachange Int'l., Inc. v. C-COR, Inc.* 413 F.3d 1361, 1373 (Fed. Cir. 2005) ("A disclaimer must be clear and unambiguous."). As the Federal Circuit notes, the prosecution history "often lacks the clarity of the specification and thus is less useful for claim construction purposes." *Phillips v. AWH Corp.*, 415 F.3d 1302,1317 (Fed. Cir. 2005) (en banc)

(citations omitted). As noted above, the Specification of the '853 patent states that "the user may select the information in the document to be searched by the program in the database." Ex. 1001, col. 10, ll. 5–10.

B. Obviousness of Claims 1–9, 11, 13–29, 38–45, 57–64, 66, 68–75, 77, and 79 Based on Goodhand

Petitioners assert that claims 1–9, 11, 13–29, 38–45, 57–64, 66, 68–75, 77, and 79 are unpatentable under 35 U.S.C. § 103(a) over Goodhand. Pet. 14–37; Pet. Reply 1–15. Petitioners explain how Goodhand teaches or renders obvious each of the limitations of the challenged claims. Petitioners also rely on the Declaration of Mr. Allison. Ex. 1002. Patent Owner disagrees with Petitioners' assertions and relies on the Declaration of Dr. Levy. *See* PO Resp. 1–54; Ex. 2008.

1. Goodhand (Ex. 1003)

Goodhand discloses a system and method that handles e-mail. Ex. 1003, Abstract. Goodhand discloses that "the preferred application program is divided into several modules, including a calendar manager, a task list manager, a contact manager, a message manager (e-mail), and a notes manager." *Id.* at col. 8, ll. 46–49. Goodhand notes that either a stand-alone or a distributed computing environment could be used to implement its system and method. *Id.* at col. 8, ll. 55–58. Goodhand further notes that "the primary interaction between the preferred program and the operating system involves message related tasks," and that "[t]he preferred operating system incorporates the Messaging Application Programming Interface (MAPI)." *Id.* at col. 12, ll. 38–43. Goodhand discloses that MAPI provides a number of messaging functions, including access to address books. *Id.* at col. 12, ll. 40–49.

When a user is composing a new e-mail message, Goodhand's system helps the user by resolving automatically recipient display names. *Id.* at col. 4, ll. 49–51. Goodhand explains that "'resolving' the names means attempting to match display names in the address field to specific user aliases that are included in a centralized address book or directory, which is typically stored on a remote server, such as a remote memory storage device 33." *Id.* at col. 17, ll. 25–29. Goodhand discusses an example of this process in connection with Figures 6a–6c. *Id.* at col. 17, ll. 6–9. Figure 6a is reproduced below.

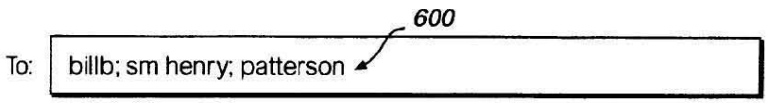

FIG.6a

Figure 6a shows an address field of an e-mail form in use to compose a message. *Id.* at col. 17, ll. 12–13. At the point shown in Figure 6a, a user has entered text into address field 600. *Id.* at col. 17, ll. 15–17. Goodhand discloses that, "[a]s soon as the user moves the cursor to another field on the e-mail form, the e-mail program module begins to resolve the recipient names in the background." *Id.* at col. 17, ll. 21–23. Goodhand also discloses that "[t]hose skilled in the art will appreciate that in the preferred application program, addresses are also resolved when the user sends the message or if the user selects the 'check names' command." *Id.* at col. 20, ll. 18–21. In the example shown in Figure 6a, to resolve the display names "billb," "sm henry," and "patterson," the system searches address book fields in an attempt to match each display name with the first name, last name, or alias of a registered user. *Id.* at col. 17, ll. 29–36.

Goodhand discusses a subsequent stage of the process in connection with Figure 6b, reproduced below. *Id.* at col. 17, ll. 38–52.

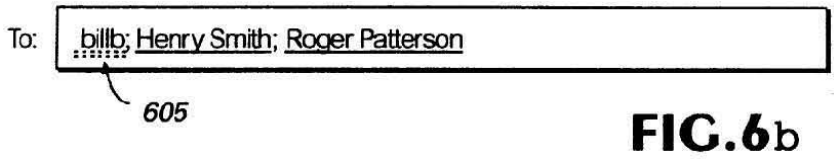

FIG. 6b

Figure 6b "illustrates the results of the effort to resolve the names." *Id.* at col. 17, ll. 38–39. If searching the address book identifies an unambiguous match for the display name of an intended recipient, the system inserts the full name of the intended recipient with a regular underline beneath it in the address field. *See id.* at col. 17, ll. 45–49, col. 19, ll. 26–52. In the example of Figure 6b, the system unambiguously matched the display names "sm henry" and "patterson" to "Henry Smith" and "Roger Patterson." *Id.* at col. 17, ll. 45–49. Accordingly, the system displays "Henry Smith" and "Roger Patterson" with a regular underline beneath each. *Id.*

Figure 6b further illustrates that squiggly line 605 appears underneath the display name "billb." *Id.* at col. 17, ll. 49–52; *see id.* at col. 19, ll. 52–53. This indicates that the system could not find a unique match for that display name. *Id.* Goodhand discloses that its system includes features that help a user address such an unresolved display name. *Id.* at col. 17, l. 53–col. 18, l. 13.

2. Discussion

Petitioners contend that each limitation of claims 1–9, 11, 13–29, 38–45, 57–64, 66, 68–75, 77, and 79 is taught expressly by, is inherent in, or is obvious over Goodhand. Pet. 14–37. Petitioners argue that the claim 1 recitations of "record retrieval program" and "initiates a record retrieval from an information source using the record retrieval program" are disclosed

by or obvious over Goodhand. *Id.* at 16–20. Petitioners argue that, "to the extent that the Patent Owner argues that Goodhand does not teach a separate 'record retrieval program', it would have been obvious to provide one." *Id.* at 17. Petitioners cite a number of Goodhand's disclosures as teaching or rendering obvious a separate record retrieval program. *Id.* at 17–20. Petitioners also contend that the claim 1 limitation "analyzing the document to determine if the first information is contained therein" is disclosed inherently by or is obvious in view of Goodhand. *Id.* at 20–21.

We have reviewed the evidence and arguments presented in the Petition, Patent Owner's Response, and Petitioners' Reply. Based on that review, we determine that Petitioners have demonstrated, by a preponderance of the evidence, that all of the limitations of each of claims 1–9, 11, 13–29, 38–45, 57–64, 66, 68–75, 77, and 79 are taught by or rendered obvious in view of Goodhand, and that each of these claims, considered as a whole, would have been obvious over Goodhand. Pet. 3–37; PO Resp. 1–53; Pet. Reply 1–15.

The parties' dispute revolves around claim 1's recitation of, "upon a single entry of the execute command by means of the input device: analyzing the document to determine if the first information is contained therein." Petitioners point to Goodhand's disclosures related to address resolution associated with its address field 600 as teaching or rendering obvious this disputed claim language. Pet. 14–16, 20–21, 23–25; Pet. Reply 1–15. Patent Owner disagrees with Petitioner's contentions. PO Resp. 1–54.

a. "upon a single entry of the execute command by means of the input device: analyzing the document to determine if the first information is contained therein"

Regarding the "execute command" recited in claim 1, Petitioners assert that Goodhand discloses three alternative execute commands that one can use to initiate address resolution. Pet. 23 (citing Ex. 1002 ¶ 119). As teaching one execute command, Petitioners note that Goodhand discloses a user can trigger address resolution by using a mouse or keyboard to move a cursor to a different field. *Id.* (citing Ex. 1003, col. 10, ll. 45–49, col. 17, ll. 21–29; Ex. 1002 ¶ 119). Regarding their assertion of two alternate execute commands, Petitioners explain that "Goodhand also discloses that the **execute command** could be a 'send mail' or 'check names' command." *Id.* at 23–24 (citing Ex. 1003, col. 20, ll. 18–21, col. 16, ll. 54–56; Ex. 1002 ¶¶ 119–120). In support of this assertion, Petitioners cite, *inter alia*, Goodhand's disclosure that "[t]hose skilled in the art will appreciate that in the preferred application program, addresses are also resolved when the user sends the message or if the user selects the 'check names' command." *Id.* (quoting Ex. 1003, col. 20, ll. 18–21).

Regarding the claim language, "upon a single entry of the execute command by means of the input device: analyzing the document to determine if the first information is contained therein," Petitioners first assert that Goodhand discloses a single entry of the execute command in the form of: "(1) moving the cursor to another field, (2) sending the email, or (3) clicking a 'check names' button." Pet. 24 (citing Ex. 1003, col. 17, ll. 21–29, col. 20, ll. 18–21, col. 16, ll. 54–56; Ex. 1002 ¶ 121). Petitioners elaborate that "Goodhand discloses that after the user enters the execute command, the computer **analyzes the document** to find display names or

addresses **(first information)** (Ex. 1002 at ¶122), and determine[s] whether they need to be resolved." *Id.* (citing Ex. 1002 ¶ 122).

Petitioners assert that Goodhand's system does this in two ways. *Id.* First, Petitioners argue that Goodhand's system determines whether address field 600 contains more than one name. *Id.* (citing Ex. 1002 ¶ 122, Fig. 6a). Second, Petitioners contend that, Goodhand's system analyzes and identifies the display names, and it uses the display names later as search terms. *Id.* (citing Ex. 1002 ¶ 122). Petitioners argue that, "[i]n order to identify the names, the system must **determine that they are there**." *Id.* (citing Ex. 1002 ¶ 122). Petitioners elaborate that, "[i]n other words, the system has analyzed the user-entered text string to find smaller strings that can be used as a search term in a database search." *Id.* (citing Ex. 1002 ¶¶ 101, 122).

Patent Owner contends that Goodhand's system does not need to analyze the document to determine if first information is contained therein. PO Resp. 26. In support of this contention, Patent Owner argues that the Goodhand system already knows that text in address field 600 is contact information, so "it is not necessary for the Goodhand system to perform the analyzing as required by the claim, namely 'analyzing . . . to determine if the first information is contained therein.'" *Id.* Patent Owner further argues that Goodhand's system does the same thing with all text entered into address field 600, "namely 'attempting to match the display names in the address field to specific user aliases that are included in a centralized address book or directory.'" *Id.*

We are persuaded by Petitioners that a person of ordinary skill in the art would have understood from Goodhand that its system performs analysis to determine if address field 600 contains any information, and its system is

capable of breaking down the information contained in address field 600 to isolate display names, which constitute first information. Mr. Allison provides credible, persuasive testimony supporting Petitioners' arguments. *See, e.g.*, Ex. 1002 ¶¶ 101–103, 122. Mr. Allison correctly asserts that Goodhand's system resolves individual display names and can search for each display name individually. *Id.* at ¶ 103 (citing Ex. 1003, col. 19, ll. 40–42); *see also* Ex. 1003, col. 17, ll. 33–36 ("Thus, in this example, the e-mail program will attempt to match 'billb,' 'sm henry," and 'patterson' with specific address book entries belonging to registered users."). Given this and Goodhand's disclosure that a user may enter multiple display names and other information (e.g., punctuation) (*see e.g.*, Ex. 1003, col. 17, ll. 12–20; Fig. 6a), we find credible and persuasive Mr. Allison's testimony that Goodhand's system "must first check to determine whether there is any text at all in the relevant address field," and "must then separate and identify display names that it will use in follow-on searches" (Ex. 1002 ¶ 122; *see* Ex. 1016, 109, l. 22–110, l. 9).

Because we are persuaded that Goodhand's system must determine if any information is present, and the system is capable of separating display names from other information, we are not persuaded that Goodhand's system already knows address field 600 contains contact information and only contact information. As discussed in greater detail below in Section II.B.2.b.i, semicolons represent one example of text from which Goodhand's system must separate the display names that it uses to resolve e-mail addresses.

Additionally, we are persuaded that the aspects of Goodhand's processing cited by Petitioners constitute essentially the same textual

analysis disclosed by the ’853 patent. Regarding determining whether the document contains any text, Petitioners cite Figure 1 of the ’853 patent as showing at steps 6 and 8 that, if the system finds in the document “nothing or not interpretable,” it provides an error message. Pet. Reply 5. In concert with this, Petitioners cite Dr. Levy’s testimony that the same thing would occur if a person clicks send without entering text in the address field in Microsoft Outlook 2010, which Dr. Levy equates with the disclosed system of Goodhand (Ex. 2008 ¶ 28). Pet. Reply 5. Regarding Goodhand identifying display names entered in address field 600, Petitioners argue that this analysis is essentially the same as the analysis shown in Figure 1 of the ’853 patent between step 6 and step 12, where the system determines that it found a name or something similar. *See* Tr. 13, ll. 15–18, 10, l. 14–11, l. 2. We find these arguments persuasive.

Patent Owner counters that the ’853 patent does not disclose that its system may find nothing in the document. Tr. 24, l. 21–25, l. 20. In support of this argument, Patent Owner cites the statement at column 4, lines 29–30 of the ’853 patent that “[t]he program analyzes what the user has typed in the document at step 4.” *Id.* at 24, l. 22–25, l. 2. Patent Owner argues that, because the ’853 patent discloses that step 4 involves analyzing “what the user has typed,” “it is clear” that the language “found nothing” in Figure 1a does not mean that the document contained no text. *Id.* at 25, ll. 18–20.

Contrary to Patent Owner’s assertions, the ’853 patent unequivocally says that, “[a]t step 6, the program decides what was found in the document and if the program *found nothing in the document* or what it found was un-interpretable the program goes to step 8 and outputs an appropriate message to the user.” Ex. 1001, col. 4, ll. 25–29 (emphasis added). Given this

statement, we read the disclosures regarding steps 4 and 6 as teaching that these steps determine what the user has typed in the document, which, in some instances, may be "nothing." Accordingly, contrary to Patent Owner's assertions, we read the '853 patent as disclosing that its system may analyze an empty document to determine if it contains information.

Patent Owner also asserts that in Goodhand "there is no determination *if* first information is present," arguing that "the Goodhand process starts only after the user has placed something in [address field 600]." PO Resp. 32. Dr. Levy likewise distinguishes Goodhand from the '853 patent on the basis that, "[i]n Goodhand, . . . a user enters address information into an Address (or "To:") field before the 'resolving' process begins." Ex. 2008 ¶ 126. Patent Owner and Dr. Levy base these assertions on Goodhand's disclosure of beginning the address-resolution process in response to a user moving the cursor out of the address field. PO Resp. 32 (citing Ex. 1003, col. 19, ll. 24–31); Ex. 2008 ¶ 126.

We find these assertions of Patent Owner and Dr. Levy unpersuasive. We first note that we do not agree with the assertion that a user moving the cursor out of address field 600 necessarily occurs only after the user has entered text in address field 600.

Additionally, Patent Owner's and Dr. Levy's assertions overlook Petitioners' correct assertion that Goodhand's system also starts its address-resolution process in response to triggers other than a user moving the cursor out of address field 600. Pet. 16, 23–24. Specifically, Goodhand discloses that its system starts the address-resolution process "when the user sends the message or if the user selects the 'check names' command." Ex. 1003, col. 20, ll. 18–21; *see* Pet. 23–24. Patent Owner and Dr. Levy provide no

credible reason to believe that address field 600 necessarily contains display names when these other triggers occur. Indeed, as Petitioners note, in his deposition testimony, Dr. Levy testified that if a user clicks send without entering any text in the address field, he "would expect an error message that says there's no valid addressees," noting that he did not "think it would be meaningful to search for null text" and that, "[i]f it was going to do a search process, it certainly doesn't do it based on a null input field." Ex. 1016, 109, l. 22–110, l. 9.

In view of the foregoing, we are persuaded that, by determining if address field 600 contains any information and, if so, identifying any display names contained therein, Goodhand's system "analyz[es] the document to determine if the first information is contained therein."

Furthermore, even if Goodhand did not teach this limitation, we are persuaded by Petitioners' argument that it would have been obvious to a person of ordinary skill in the art in view of Goodhand's disclosure. Pet. 21. As Petitioners reason, analyzing the document to determine if address field 600 contains any text and, if so, identifying any display names therein, would have been obvious "because performing that analysis would allow the system to use the identified display names in the searches expressly taught by Goodhand." Pet. 21; *see* Ex. 1002 ¶ 122.

b. Patent Owner's argument that Goodhand's system does not distinguish between first information and other text in the document

Patent Owner also argues that Goodhand's system does not distinguish between first information and other text in the document. PO Resp. 22–25. We find this argument unpersuasive. Patent Owner's argument that "the Goodhand system cannot distinguish between contact

information and other text" (*id.* at 22) is unpersuasive because Patent Owner concedes that the claims do not require distinguishing contact information from other text (Tr. 37, l. 6–38, l. 1). Furthermore, we find unpersuasive Patent Owner's argument that Goodhand's system does not distinguish between first information and other text in the document because, as explained in Section II.A.1.b above, we are not persuaded that claim 1 requires distinguishing first information from other text in the document.

Furthermore, even if claim 1 did require distinguishing first information from other text in the document, Petitioners persuade us that Goodhand's system is capable of performing this function. In addition to display names, Goodhand shows address field 600 containing other text, specifically semicolons and spaces. Ex. 1003, Fig. 6a, col. 17, ll. 12–20; *see* Pet. Reply 3. Goodhand also discloses that a user may enter "an Internet e-mail address in the form of xxxxx@yyyyy.zzz." Ex. 1003, col. 20, ll. 12–13; Pet. Reply 6. For at least the reasons discussed below, Petitioners persuade us that Goodhand teaches distinguishing between these different portions of text that may be entered in address field 600. Pet. Reply 6–7 (citing Ex. 1003, Figs. 6a–6c, col. 17, ll. 12–17). Moreover, as also discussed below, we are persuaded that, even if Goodhand's system did not distinguish between display names, semicolons, and fully formatted e-mail addresses, it would have been obvious in view of Goodhand to do so. *See, e.g.*, Pet. 21; *see* Ex. 1002 ¶ 122.

i. Distinguishing display names from semicolons and spaces

We are persuaded that Goodhand's system distinguishes display names from the semicolons and spaces between the display names. Mr. Allison testifies that a person of ordinary skill in the art would have

understood Goodhand as communicating that its system uses text processing of address field 600 to separate display names. Ex. 1002 ¶ 122. As Mr. Allison notes, Goodhand's system attempts to resolve individual display names and may search each display name individually. Ex. 1002 ¶ 103 (citing Ex. 1003, col. 19, ll. 24–55, col. 17, ll. 34–37; Figs. 6a–6c). For instance, as Petitioners note, Goodhand indicates that its system identifies the individual display names "billb," "sm henry," and "Patterson" shown in Figure 6a, disclosing that the "e-mail program will attempt to match 'billb,' 'sm henry,' and 'patterson' with specific address book entries belonging to registered users." Ex. 1003, col. 17, ll. 33–36; Pet. Reply 3.

Mr. Allison further testifies that it would have been apparent to a person of ordinary skill in the art that separating the individual display names in address field 600 "could have been done by taking advantage of the semicolon delimiter." Ex. 1002 ¶ 122. Consistent with this, Petitioners cite Goodhand's disclosure that a semicolon serves as a delimiter between display names. *See* Ex. 1003, col. 17, ll. 19–20; Pet. 4. We are persuaded that, in order to resolve individual display names, Goodhand's system analyzes the text in address field 600 to distinguish the individual display names from the semicolons and spaces between the display names. *See, e.g.*, Ex. 1002 ¶¶ 103, 122.

At the oral hearing, Patent Owner argued that the semicolons and spaces are part of "first information," as recited in claim 1. Tr. 43, ll. 17–23. Regarding this argument, we note claim 1 recites that the method includes "if the first information is contained in the document, searching, using the record retrieval program, the information source for second information associated with the first information." Ex. 1001, col. 10, ll. 40–44. Patent

Owner does not identify any reason to believe that Goodhand's system searches, using a record retrieval program, an information source for second information associated with the semicolons and spaces entered in address field 600. Nor does Patent Owner identify any disclosure of the '853 patent that persuades us the semicolons and spaces in Goodhand's address field constitute "first information" according to claim 1. Accordingly, we do not find Patent Owner's argument in this regard persuasive.

Patent Owner also cites an experiment that Dr. Levy performed with Microsoft Outlook 2010 as evidence that Goodhand does not distinguish first information from other information. PO Resp. 23–25 (citing Ex. 2008 ¶¶ 28–29). Dr. Levy asserts that the operation of Microsoft Outlook 2010 is representative of how Goodhand's system would operate. Ex. 2008 ¶ 28. We agree with Petitioners that the experiment does not support Patent Owner's contention that the system does not analyze text in the address field to distinguish between display names and other information. Pet. Reply 1–5.

In his experiment, Dr. Levy typed into the address field of Outlook's email template the following "shopping list": "cheesecake; apple sauce; baloney." Ex. 2008 ¶ 28. Dr. Levy testified that, "[w]hen one graphically invokes the 'send' button on the e-mail template, a window containing an error message pops up, with the heading 'Check Names' and the message 'Microsoft Outlook does not recognize 'cheesecake'./ Select the address to use: / (No suggestions).'" *Id.*

Regarding this experiment, Petitioners argue that:

> If [Patent Owner] were correct that no "analysis" is being performed, then Outlook would have displayed the message "Microsoft Outlook does not recognize 'cheesecake; apple sauce; baloney'". Instead, Outlook correctly identified the substring "cheesecake" as "first

> information", *discarding* the trailing semicolon and space, as well as the remainder of the string.

Pet. Reply 3 (citing Ex. 2008 ¶ 28). Petitioners also note that, in his deposition testimony, Dr. Levy explained that Outlook knew what to search "[b]ecause in Outlook a semicolon is a known delimiter between addresses in that field." Ex. 1016, 108, ll. 11–15. For at least these reasons, we agree with Petitioners that Dr. Levy's experiment does not provide persuasive support for Patent Owner's position.

Additionally, Petitioners persuade us that analyzing text to distinguish display names from semicolons and spaces constitutes essentially the same textual analysis disclosed in the '853 patent. Petitioners cite column 4, lines 29–37 of the '853 patent as providing examples of how a program may analyze text. Pet. Reply 4. Petitioners assert that "[t]he very first example uses 'paragraph/line separations/**formatting**, etc.'" *Id.* (quoting Ex. 1001, col. 4, ll. 31–32) (emphasis added by Petitioners). Petitioners also note that, when discussing the same disclosure in related U.S. Patent No. 7,921,356, Dr. Levy testified that the disclosed approaches for analyzing text were not exhaustive, but that analysis of text could be performed by looking at punctuation. *Id.* (citing Ex. 1016, 96, l. 19–97, l. 7). This evidence persuades us that Goodhand's use of semicolons to identify individual display names constitutes essentially the same textual analysis disclosed in the '853 patent.

ii. Distinguishing fully formatted e-mail addresses

Additionally, we are persuaded that Goodhand's system distinguishes between fully formatted Internet e-mail addresses and other display names. In support of their assertion that Goodhand treats fully formatted email

addresses differently than other information entered in address field 600, Petitioners cite Goodhand's disclosure that:

> When a user enters an Internet e-mail address in the form of xxxxx@yyyyy.zzz, the user need not create a new name in his or her directory before the name can be resolved. The preferred e-mail system simply identifies such an address as an Internet address and resolves it without further user intervention.

Ex. 1003, col. 20, ll. 12–15. Additionally, Petitioners cite the following portion of Dr. Levy's deposition. Pet. Reply 5–6.

> **Q And what happens in Outlook when you enter a proper e-mail address?**
>
> A Pretty much nothing until you send it. It would point -- it sends.
>
> **Q If you type in the "To" box a proper e-mail address, will it search the contact information database before sending it?**
>
> A That's a good question. *I actually haven't considered that.* I think it's likely that Outlook checks its local database of contacts to see if it knows this user, but it's not necessary.

Ex. 1016, 109, ll. 4–14 (emphasis added). Petitioners contrast this testimony with Dr. Levy's prior declaration testimony reproduced below. Pet. Reply 6.

> [T]he Goodhand system subjects any and all text that is typed into the address field of the e-mail template to the same process, namely "attempting to match the display names in the address field to specific user aliases that are included in a centralized address book or directory".

Ex. 2008 ¶ 27. In view of this evidence, we are persuaded that Goodhand's system distinguishes fully formatted e-mail addresses from other display

names and other text, contrary to the assertions of Patent Owner and Dr. Levy that Goodhand's system treats all information in address field 600 the same.

Additionally, we are persuaded that this aspect of Goodhand's processing constitutes essentially the same textual analysis disclosed in the '853 patent. Petitioners note that, in Figure 1a of the '853 patent, the process proceeds to box 10 when the system determines that the document contains an e-mail address. Tr. 13, ll. 6–15, 19–21. Petitioners assert that this disclosure in the '853 patent of distinguishing an e-mail address from a name is like Goodhand's disclosure of distinguishing a fully formatted email address from display names. *Id.* at 22–24. We find this comparison persuasive.

Patent Owner argues that Goodhand does not treat fully formatted e-mails differently than other display names. Tr. 42, ll. 13–24. Asserting that "resolves is a term of art," Patent Owner argues that the portion of Goodhand discussing the treatment of fully formatted e-mail addresses "tells us . . . that e-mails, like anything else that is entered in the 'to' field, are subject to the resolve process. So e-mails are not, contrary to what Petitioner[s] say[], they are not a different case." *Id.* at 42, ll. 19–23. Dr. Levy's deposition testimony regarding the treatment of fully formatted e-mails conflicts with Patent Owner's argument. *Compare* Tr. 42, ll. 13–14 *with* Ex. 1016, 108, l. 21–109, l. 14. We are persuaded that Goodhand distinguishes between fully formatted e-mail addresses and other display names appearing in address field 600.

c. Patent Owner's argument that Goodhand requires selection

As noted above, Patent Owner argues that certain language in the claims and the prosecution history of the '853 patent support a claim construction precluding user selection of text prior to the "single entry of the execute command," as recited in claim 1. PO Resp. 16–19. In combination with this, Patent Owner asserts that Goodhand's disclosure of a user entering text in address field 600 constitutes user selection of text. *Id.* at 1, 19, 21, 24–25 (citing Ex. 2008 ¶ 29). We find this argument unpersuasive because, as explained above in Sections II.A.1.c and II.A.1.d, we find Patent Owner's claim construction arguments unpersuasive.

In any event, even if we agreed with Patent Owner's claim construction and we were to assume that the claimed "single entry of the execute command" precludes user selection of text, we are persuaded that Goodhand does not require user selection of text prior to executing this command. In support of their contention that Goodhand's disclosed process involves analysis to determine if first information is present, as opposed to user text selection, Petitioners compare Goodhand's disclosure to the '853 patent's discussion of exemplary analysis techniques. Pet. Reply 4, 10. For example, as discussed above in Section II.B.2.b.i, Petitioners equate Goodhand's use of semicolons to the '853 patent's disclosed analysis technique of using "paragraph/line separations/formatting, etc.," and Petitioners cite to Dr. Levy's deposition testimony that looking at punctuation constitutes a form of analysis. *Id.* at 4 (citing Ex. 1016, 96, l. 19–97, l. 7). Petitioners also point to the '853 patent's disclosure of using the term "Mr." to analyze text. *Id.* at 10 (citing Ex. 1001, col. 4, l. 34). Petitioners then argue that placement of text in address field 600 does not

constitute selection any more than placing text after the word "Mr." *Id.* These comparisons of Goodhand's disclosure to that of the '853 patent provide persuasive support for Petitioners' contentions that Goodhand's processing involves essentially the same textual analysis as disclosed in the '853 patent, and not user text selection, as argued by Patent Owner.

Patent Owner quotes Dr. Levy's testimony for the proposition that Goodhand's disclosure of entering text in address field 600 constitutes text selection. PO Resp. 24–25 (quoting Ex. 2008 ¶ 29). Dr. Levy asserts that Goodhand's system does not need to perform analysis to determine if first information is present in address field 600 because "user entry of text into the address field constitutes characterization of the text as name or alias information." Ex. 2008 ¶ 29. Dr. Levy elaborates that "the Goodhand system is not structured to distinguish between contact information and other textual content." *Id.* In concert with these assertions, Dr. Levy further asserts that entering text into address field 600 constitutes "selecting" the text because "[b]y entering text into the Address field, the user has designated that text as address information, just as if the user had selected particular text in a general-purpose field of a document to designate it as address information." *Id.*

For a number of reasons, we find Patent Owner's and Dr. Levy's assertions less persuasive than Petitioners'. For example, whereas Petitioners cite examples of textual "analysis" in the '853 patent to support their contention that Goodhand discloses textual analysis instead of selection, Patent Owner and Dr. Levy do not cite any specific examples of "selection" in the '853 patent to support their contention that Goodhand discloses selection instead of textual analysis. Patent Owner and Dr. Levy

do not discuss the '853 patent's disclosure regarding text selection, which states that "the user may select the information in the document to be searched by the program in the database (e.g., by highlighting, selecting, italicizing, underlining, etc.)." Ex. 1001, col. 10, l. 8. The disclosed examples of "selecting" text—highlighting, selecting, italicizing, underlining—differ from typing new text in address field 600, and neither Patent Owner nor Dr. Levy addresses the disparity.

Additionally, in asserting that Goodhand's disclosed process involves user text selection, Patent Owner and Dr. Levy do not discuss the "selection" disclosed by Tso that was allegedly distinguished during prosecution. The disclosure in Tso states:

> When a user wishes to compose a new e-mail message or generate a reply to a received e-mail message, the user selects a text string to be processed, for example, *by clicking on it*. The particular method by which such a selection is made will vary according to the user input device available to the user. For example, where the user has access to a laptop or other personal computer, *the selection could be accomplished using a mouse*. On the other hand, with a device having limited user interface capabilities, such as a Smartphone, *the selection could be accomplished by appropriately positioning a cursor using a touch keypad and pressing an "ENTER" key*.

Ex. 2003, col. 4, ll. 31–42 (emphases added). Here again, these examples differ from typing new text in address field 600, and neither Patent Owner nor Dr. Levy addresses the disparity.

Furthermore, Dr. Levy confuses the issue in his testimony that, by typing text in address field 600, the user "designated" the text, "just as if the user had selected" it. *See* Ex. 2008 ¶ 29. This assertion suggests that Goodhand's disclosure constitutes "selection" because it is like selection.

The assertion that an act is *like* selection does not persuade us that it actually *is* selection.

Additionally, Dr. Levy's assertion that Goodhand requires text selection, which appears in paragraph 29 of his Declaration, rests on the results of his experiment with Microsoft Outlook 2010. *See* Ex. 2008 ¶¶ 28–29. Dr. Levy asserts that, "[s]ince the Goodhand system in a preferred embodiment is implemented in Microsoft Outlook (Ex. 1003, col. 15, lines 38–40), and this functionality is preserved in Outlook 2010, one can employ Outlook 2010 to demonstrate the effect of the Goodhand system." Ex. 2008 ¶ 28. Dr. Levy does not cite adequate evidence to persuade us that operation of Microsoft Outlook 2010 is representative of the full scope of how Goodhand's system operates. Given this, and given that Dr. Levy's assertion that Goodhand requires user text selection rests on his experiment with Microsoft Outlook 2010, we find Dr. Levy's testimony unpersuasive.

Furthermore, as discussed above, Petitioners persuade us that Goodhand teaches or renders obvious performing analysis to determine if address field 600 contains any information and, if so, determining if address field 600 contains display names, as opposed to, e.g., semicolons and fully formatted e-mail addresses. This vitiates one of the principal bases of Dr. Levy's conclusion that Goodhand's process involves text selection—that "no analysis is required to 'determine if 'first information' is present.'" Ex. 2008 ¶ 29. Indeed, Patent Owner argues that if a user has selected information, no analysis is needed to determine if the document contains information. PO Resp. 18. By this reasoning, if a system analyzes a document to determine if it contains information, then the user must not have selected information. In light of Patent Owner's reasoning, we are

persuaded that Goodhand does not require text selection prior to the "single entry of the execute command."

Moreover, even if we assume that entering text in address field 600 did constitute selection of that text, we are not persuaded that Goodhand requires selection of text as a pre-condition to analyzing the document to determine if first information is contained therein. As explained above in Section II.B.2.a, we are persuaded that Goodhand teaches or renders obvious responding to movement of the cursor from address field 600, entry of a check names command, or entry of a send command by analyzing the document to determine if any text is contained in address field 600. As also explained in Section II.B.2.a, we are further persuaded that Goodhand does not require a user to enter text into address field 600 before moving the cursor from address field 600, entering a check names command, or entering a send command.

d. Summary

In summary, we determine that Petitioners have demonstrated, by a preponderance of the evidence, that claims 1–9, 11, 13–29, 38–45, 57–64, 66, 68–75, 77, and 79 are unpatentable because they would have been obvious over Goodhand.

C. Obviousness of Claims 6, 10, 12, 21, 27, 30–37, 42, 46–56, 61, 65, 67, 72, 76, and 78 Based on Goodhand and Padwick

Petitioners assert that claims 6, 10, 12, 21, 27, 30–37, 42, 46–56, 61, 65, 67, 72, 76, and 78 are unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Goodhand and Padwick. Pet. 37–44. Petitioners provide reasons explaining why it would have been obvious to combine the teachings of Goodhand and Padwick, and Petitioners explain how the combination of Goodhand and Padwick allegedly teaches the subject matter

of each of the challenged claims. *Id.* In doing so, Petitioners rely on the Declaration of Mr. Allison. Ex. 1002. With each of the challenged claims depending directly or indirectly from independent claim 1, Petitioners cite their challenge of independent claim 1 based on obviousness over Goodhand to address the limitations of claim 1. *See* Pet. 38 ("Goodhand is applied as in Ground 1, above."). Aside from the above-discussed arguments disputing Petitioners' treatment of the limitations of independent claim 1, Patent Owner does not address separately Petitioners' challenge of claims 6, 10, 12, 21, 27, 30–37, 42, 46–56, 61, 65, 67, 72, 76, and 78 as unpatentable under 35 U.S.C. § 103(a) over Goodhand and Padwick. We have reviewed the evidence and arguments presented, and we find Petitioners' assertions persuasive. We adopt Petitioners' proposed facts as our findings of fact with respect to the teachings of the prior art. We determine that Petitioners have demonstrated, by a preponderance of the evidence, that claims 6, 10, 12, 21, 27, 30–37, 42, 46–56, 61, 65, 67, 72, 76, and 78 are unpatentable because they would have been obvious over Goodhand and Padwick.

III. CONCLUSION

Petitioners have shown, by a preponderance of the evidence, that claims 1–9, 11, 13–29, 38–45, 57–64, 66, 68–75, 77, and 79 of the '853 patent would have been obvious over Goodhand.

Petitioners also have shown, by a preponderance of the evidence, that claims 6, 10, 12, 21, 27, 30–37, 42, 46–56, 61, 65, 67, 72, 76, and 78 would have been obvious over Goodhand and Padwick.

IV. ORDER

In consideration of the foregoing, it is

ORDERED that claims 1–79 of the ’853 patent are determined to be *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.

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