



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SNAP, INC.,
Petitioner,

v.

SRK TECHNOLOGY LLC,
Patent Owner.

IPR2020-00820
Patent 9,930,159 B2

Before KRISTEN L. DROESCH, GEORGIANNA W. BRADEN, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Snap Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1, 3–17, 19–21, and 23–26 (“challenged claims”) of U.S. Patent No. 9,930,159 B2 (Ex. 1001, “’159 Patent”). Paper 2 (“Pet”). Petitioner filed a Declaration of Christopher M. Schmandt (Ex. 1002) with its Petition. SRK Technology LLC (“Patent Owner”) filed a Preliminary Response. Paper 9 (“Prelim. Resp.”). Pursuant to our authorization, Petitioner filed a Reply to the Preliminary Response (Paper 11, “Reply to Prelim. Resp.”) to address the issue of discretionary denial under 35 U.S.C. §§ 314(a), 325(d), to which Patent Owner filed a Sur-Reply (Paper 13, “Sur-Reply to Prelim. Resp.”).

We have authority to determine whether to institute review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4. An *inter partes* review may not be instituted unless it is determined that “the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (2018).

For the reasons provided below, we determine based on the record before us that there is a reasonable likelihood Petitioner would prevail in showing at least one of the challenged claims is unpatentable.

B. Related Matters

The parties indicate the ’159 Patent is or has been the subject of litigation in *SRK Technology LLC v. Snap, Inc.*, Case No. 2:19-cv-02515-PSG–JPR (C.D. Cal). See Pet. 1; Paper 4, 2; Paper 7, 2. Patent Owner

further indicates that the proceeding in IPR2020-00819 challenging claims of U.S. Patent No. 8,996,059 (“’059 Patent”) would affect, or may be affected, by a decision in this proceeding. *See* Paper 4, 2; Paper 7, 2.

C. The ’159 Patent (Ex. 1001)

The ’159 Patent relates to a method and system for determining a communication mode for recording a media message on a communication device. *See* Ex. 1001, code (57). The method and system includes an adaptive recording application executable by a processor configured to record the media message on the communication device. *See id.* at 7:7–10. The adaptive recording application detects activation (e.g., click, touch, press, push, tap) of an interface element on the communication device for initiating the recording of the media message. *See id.* at 7:10–17. The adaptive recording application determines the duration of the activation of the interface element and compares the duration with one or more configurable timing parameters. *See id.* at 7:24–33, Fig. 1A. The configurable timing parameters can be fixed as a system settable parameter, a user-settable parameter, or may vary, and can be calculated based on the type of communication device, characteristics of the user, user interactions, past interactions, etc. *See id.* at 7:47–53. The adaptive recording application can learn and change the configurable timing parameters based on the user’s behavior with the adaptive recording application. *See id.* at 7:56–59. Based on the duration of the activation of the interface element, the adaptive recording application selects one of the communication modes. *See id.* at 7:60–65. For example, the adaptive recording application can select the tap-to-start communication mode if the duration of the activation is less than a critical time, or can select the push-to-talk communication mode if the

duration of the activation is greater than the critical time. *See id.* at 7:65–8:4, Fig. 2. The adaptive recording application triggers recording of the media message in the selected mode. *See id.* at 7:57–58.

In another embodiment, the adaptive recording application, upon detection of activation of the interface element, determines the presence or absence of a media signal during and/or after the activation of the interface element, and selects one of the communication modes for recording based on the presence or absence of the media signal. *See Ex. 1001, 8:10–9:26; Fig. 1B.* In yet another embodiment, the adaptive recording application, upon detection of activation of the interface element, determines the duration of the activation of the interface element, determines the presence or absence of a media signal during and/or after the activation of the interface element, and selects one of the communication modes for recording based on a comparison of the duration of the activation element with one or more configurable timing parameters and the presence or absence of a media signal. *See Ex. 1001, 10:26–57, Fig. 1C.*

D. Illustrative Claims

Claims 1, 13, 20, 24, 25, and 26 are independent and claims 3–12, 14–17, 19, 21, and 23 variously depend from claims 1, 13, and 20. Claims 1 and 13 are illustrative and reproduced below:

1. A computer implemented method for determining a communication mode, comprising:
 - detecting activation of an interface element by an application on a communication device;
 - determining a duration of said activation of said interface element by said application;

comparing said duration of said activation of said interface element with one or more configurable timing parameters by said application; and
selecting, in response to said detection of said activation of said interface element, one of a plurality of communication modes by said application based on said comparison of said duration of said activation of said interface element with said one or more configurable timing parameters.

Ex. 1001, 27:9–23.

13. A computer implemented method for determining a communication mode, comprising:
 - detecting activation of an interface element by an application on a communication device;
 - determining by said application, using an input device of said communication device, one of a presence and an absence of a media signal in proximity of said communication device, during and/or after said activation of said interface element; and
 - selecting, in response to said detection of said activation of said interface element, one of a plurality of communication modes by said application based on said determination of said one of said presence and said absence of said media signal.

Ex. 1001, 28:21–34.

E. Asserted Challenges to Patentability and Asserted Prior Art

Petitioner asserts the following challenges to the patentability of claims 1, 3–17, 19–21, and 23–26:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 3–7, 20, 21, 23–25	103	Newman ¹ , Araki ^{2,3} , Trewin ⁴
8–12	103	Newman, Araki, Trewin, Ronkainen ⁵
13–17, 19, 26	103	Newman, Araki, Ronkainen

II. ANALYSIS

A. Discretion under 35 U.S.C. § 314(a)

Patent Owner argues that we should exercise our discretion and deny institution based on a parallel district court proceeding in *SRK Technology LLC v. Snap, Inc.*, Case No. 2:19-cv-02515-PSG–JPR (C.D. Cal) (“District Court proceeding”) and other circumstances regarding discovery issues for evidence of secondary considerations. *See* Prelim. Resp. 43–50; Sur-Reply to Prelim. Resp. 1–4.

Under § 314(a), the Director has discretion to deny institution of an *inter partes* review. *See* 37 C.F.R. § 42.4(a) (“The Board institutes the trial on behalf of the Director.”); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *SAS Inst., v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (“[Section] 314(a) invests the Director with discretion on

¹ Ex. 1003, US Patent No. 9,063,629 B2, issued June 23, 2015 (“Newman”).

² Ex. 1005, JP 3888584 B2, issued March 7, 2007.

³ Ex. 1004, English Translation of Ex. 1005, (“Araki”).

⁴ Ex. 1007, US Patent No. 6,948,136 B2, issued Sep. 20, 2005 (“Trewin”).

⁵ Ex. 1006, US Patent No. 7,721,227 B2, issued May 18, 2010 (“Ronkainen”).

the question whether to institute review” (emphasis omitted)); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”).

In *NHK Spring Co. v. Intri-Plex Techs., Inc.*, the Board denied institution relying in part on § 314(a) because the parallel district court proceeding was scheduled to finish before the Board reached a final decision. IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential). Following *NHK*, the Board articulated the following factors for consideration when determining whether to exercise discretion to deny institution in view of a parallel district court proceeding:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 5–6 (PTAB March 20, 2020) (precedential, designated May 5, 2020) (“*Fintiv*”). “These factors relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.* at 6. In evaluating these factors, we take “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.* (citing Patent Trial and Appeal Board

Consolidated Trial Practice Guide November 2019 (“CTPG”), 58). We address each of these factors in turn below.

1. Analysis of Fintiv Factors

a. Whether the court granted a stay and the proximity of court’s trial date

Patent Owner acknowledges that the parallel District Court proceeding is stayed currently. *See* Prelim. Resp. 47. Patent Owner contends that if the Petition was denied, “it is likely that the District Court case would resume and that a trial would be held at or before the date on which a final written decision would be due.” *Id.* at 47; *see id.* at 47–48 (citing Ex. 2009; Ex. 2010, 3:13–4:2); *see also id.* at 46 (“[A] speedy resolution in less than a year is likely once the Petition is denied.”). Patent Owner asserts that prior to the stay, the trial date was set for April 2021, and contends that “if the Petition is denied, it is likely that the trial court would ‘tighten up’ the dates and permit an expedient trial within ten months or less— a faster resolution than the 12 month period from institution to Final Written Decision pr[e]scribed by statu[t]e.” *Id.* at 48; *see id.* at 47–48. Patent Owner further argues that this factor is not dispositive because, if institution is denied, the District Court would likely resolve overlapping issues of invalidity prior to a deadline for a final written decision. *See* Sur-Reply to Prelim. Resp. 3.

In reply, Petitioner contends that if institution is granted based on the Petition before us, or the petition filed in IPR2020-00819, the District Court proceeding will remain stayed until issuance of the final written decision(s). *See* Reply to Prelim. Resp. 1 (citing Ex. 1019, 2). Petitioner asserts the Board has recognized that a stay of the parallel proceeding weighs strongly against exercising discretion to deny institution because it allays concerns

about inefficiency and duplication efforts. *See id.* (citing *Fintiv* at 6).

Petitioner argues that Patent Owner offers only unfounded speculation as to how the court might proceed if both petitions are denied. *See id.* (citing Prelim. Resp. 47–48). Petitioner further argues that because of the stay, any guessed-at trial date is irrelevant. *See id.* (citations omitted).

We agree with Petitioner that the District Court’s stay of the litigation pending denial of institution or a final written decision allays concerns about inefficiency and duplication of efforts. *See Fintiv* at 6. The granting of a stay pending *inter partes* review has weighed strongly against exercising discretion to deny institution under *NHK*. *See id.* Accordingly, consideration of the first *Fintiv* factor weighs strongly against exercising discretion to deny institution.

Although Patent Owner asserts that, should institution be denied, “it is likely that the District Court Litigation would resume and that trial would be held at or before the date on which a final written decision would be due,” we agree with Petitioner that this amounts to “unfounded speculation as to how the court might proceed.” Therefore, consideration of the second *Fintiv* factor also does not weigh in favor of exercising discretion to deny institution.

b. Investment in the parallel proceeding by the court and the parties

Patent Owner contends the parties and the District Court each have invested substantial resources in the parallel proceeding and that the proceeding is at an advanced stage. *See* Prelim. Resp. 46; Sur-Reply to Prelim. Resp. 2. According to Patent Owner, infringement contentions and invalidity contentions have been served, discovery has been conducted, and, at the time the Petition was filed, Markman positions had been exchanged

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and the parties were preparing for Markman briefing. *See* Prelim. Resp. 46 (citing Ex. 2009).

Petitioner contends the District Court proceeding is in its early stages—the parties have only exchanged preliminary contentions and claim construction positions, and the District Court has not issued a claim construction order. *See* Pet. 3; Reply to Prelim. Resp. 2. Petitioner asserts that neither party has taken any depositions and the court has not engaged in claim construction or motion practice. *See* Reply to Prelim. Resp. 2. Petitioner further asserts that, because the District Court proceeding will remain stayed if institution is granted on this Petition or the petition filed in IPR2020-00819, no further work will occur in the District Court proceeding until a final written decision is issued. *See id.*

We agree with Petitioner that the District Court proceeding was in its early stages prior to the stay. The record before us indicates that the District Court has not issued any substantive orders related to the '159 Patent, and has not substantially invested in the case, apart from holding a scheduling conference in November 2019 and granting the parties joint stipulation to stay the parallel proceeding in April 2020. *See* Ex. 1019, 2009, 2010. “If, at the time of the institution decision, the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution.” *Fintiv* at 9–10. Importantly, no claim construction orders have issued in the District Court proceedings. *See id.* at 10 (“[C]laim construction orders may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial.”). We recognize that the weight to give claim construction orders varies because some district courts may postpone significant discovery until after

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the issuance of a claim construction order, while others may not. *See Fintiv* at 10 n.7. Although Patent Owner relies on the fact that Markman positions had been exchanged and the parties were preparing for Markman briefing (*see* Prelim. Resp. 46), Patent Owner does not identify the significant discovery that has been completed. Rather, discovery is not complete because, according to Petitioner, neither party had taken any depositions. *See* Reply to Prelim. Resp. 2. Where the District Court has not issued claim construction orders and the discovery process is not yet complete, the remaining investment of time and effort likely necessary to bring co-pending litigation to trial appears to far outweigh that which has already been invested. *See Juniper Networks, Inc. v. Packet Intelligence LLC*, IPR2020-00336, Paper 21 at 18 (PTAB Sept. 10, 2020).

The third *Fintiv* factor also provides that a petitioner's diligence or delay in filing a petition may be relevant. *See Fintiv* at 11–12. If the evidence shows that a petitioner filed its petition expeditiously, such as promptly after becoming aware of the claims being asserted, this fact has weighed against denying institution. *See id.* at 11 (citing *Intel Corp. v. VLSI Tech. LLC*, IPR2019-01192, Paper 15 at 12–13 (PTAB Jan. 9, 2020); *Illumina Inc. v. Natera, Inc.*, IPR2019-01201, Paper 19 at 8 (PTAB Dec. 18, 2019)). If, however, the evidence shows that the petitioner did not file its petition expeditiously, such as at or around the same time that the patent owner responded to the petitioner's invalidity contentions, or even if a petitioner cannot explain the delay in filing its petition, these facts have favored denial. *See Fintiv* at 11–12 (citing *Next Caller, Inc. v. TRUSTID, Inc.*, IPR2019-00961, Paper 10 at 16 (PTAB Oct. 16, 2019)).

Patent Owner contends that Petitioner's delay in filing the petition weighs in favor of denying institution under § 314(a). *See* Prelim. Resp. 46–47 (quoting *Next Caller*, Paper 10 at 15–16; *Fintiv* at 11–12). According to Patent Owner, the parallel District Court proceeding was initiated on April 3, 2019, but Petitioner did not file this Petition until more than a year later on April 8, 2020. *See id.* at 47. Patent Owner contends that Petitioner cannot justify the magnitude of its delay. *See* Sur-Reply to Prelim. Resp. 2.

In reply, Petitioner argues that the parallel District Court proceeding was still in its early stages when the Petition was filed. *See* Reply to Prelim. Resp. 3. Petitioner argues, moreover, that the timing of filing enabled the Petition to take into account both parties' claim construction positions, which resulted in a more focused and thorough petition than what would have been possible even weeks earlier. *See id.*

Patent Owner disputes Petitioner's argument regarding claim construction because the Petition does not propose any express claim constructions. *See* Sur-Reply to Prelim. Resp. 2 (citing Pet. 8). Patent Owner contends that Petitioner's "delay in filing this Petition and its misleading excuse both favor discretionary denial." *See id.*

We find that the Petition was filed neither expeditiously nor with delay because, although it was not filed promptly after Petitioner became aware of the claims being asserted in the invalidity contentions filed in the District Court on January 31, 2020 (Ex. 2020), it was not filed in close proximity to any response by Patent Owner to the invalidity contentions because Patent Owner did not file a response prior to the stay of the proceedings. In view of our finding that the parallel District Court

proceeding was in an early stage prior to the stay, the timing of the filing of the Petition does not weigh in favor of exercising discretion to deny institution. *See Supercell Oy v. Gree, Inc.*, PGR2020-00038 Paper 14 at 15 (PTAB Sept. 3, 2020) (Although the petition was filed late within the statutory filing window, because the evidence demonstrated that only minimal investments had been made in the parallel proceeding, the panel was not persuaded that the petitioner's delay in filing the petition was a compelling countervailing reason to exercise discretion to deny institution).

On balance, the considerations of the third *Fintiv* factor weigh against exercising discretion to deny institution.

c. Overlap between the issues raised in the petition and in the parallel proceeding

Patent Owner asserts that the parallel District Court proceeding involves the same patent and the same claims. *See* Prelim. Resp. 44–45 (citing Pet. 1; Ex. 2007, 1; Ex. 2008, 1). Patent Owner contends that Petitioner's invalidity contentions in the parallel District Court proceeding include an explicit reference to Ronkainen and an implicit reference to Newman. *See id.* at 45 (citing Ex. 2008, 9). Patent Owner alleges that Petitioner's invalidity contentions are similar to those raised in its Petition. *See id.* (citing Ex. 2008, 15–18). Patent Owner further contends that resolution of Petitioner's challenges to the same claims in the District Court proceeding will necessarily resolve key issues presented in the Petition. *See id.* at 45–46

Petitioner does not dispute that the Petition challenges the same claims as those asserted in the District Court proceeding. Reply to Prelim. Resp. 2. Petitioner contends that an *inter partes* review could dispose of the

entire District Court proceeding. *See id.* Petitioner, however, asserts that the art is not the same. According to Petitioner, “Patent Owner does not dispute that three of the four references in the Petition—Newman, Trewin, and Araki—were *not* included in the [D]istrict [C]ourt [proceeding].” *Id.* (citing Ex. 2008, 22–23, 34). Petitioner further argues that Patent Owner’s vague allegations that Petitioner made “very similar arguments” should be entitled to no weight. *See id.* (citing *Comcast Cable Commc ’ns, LLC v. Veveo, Inc.*, IPR2019-00239, Paper 15 at 11 (PTAB July 5, 2019)).

Patent Owner argues that Petitioner does not contest in its Reply that it made the same arguments based on Ronkainen. *See* Sur-Reply to Prelim. Resp. 1. Patent Owner also argues that Petitioner misstates that Newman was not included in the District Court proceeding because, according to Patent Owner, Petitioner “ignores that its invalidity contentions incorporate Newman based on its identification on the face of the ’159 Patent.” *Id.* (citing Prelim. Resp. 38–39). Patent Owner further asserts that Petitioner ignores that the Petition paraphrases Petitioner’s invalidity contentions regarding motivation to combine the “interface element” and “critical time” references based on purported relation to buttons of a user interface. *See id.* (comparing Pet. 36, with Ex. 2008, 16–17). Patent Owner contends that Petitioner incorrectly relies on the *Comcast* decision for the proposition that this is of no weight, because the *Comcast* decision was based on the absence of evidence showing the similarity of Petitioner’s arguments to those made previously, while Petitioner’s invalidity contentions show its arguments. *See id.* at 1–2.

If the prior art and arguments in the parallel proceeding are substantially identical to those presented in a petition, “concerns of

inefficiency and the possibility of conflicting decisions [would be] particularly strong.” *Fintiv* at 12. “Conversely, if the petition includes materially different grounds, arguments, and/or evidence than those presented in the district court, this fact has tended to weigh against exercising discretion to deny institution.” *Id.* at 12–13.

We agree with Petitioner that the invalidity contentions do not include the Araki and Trewin references. *See generally* Ex. 2008. Nonetheless, we acknowledge that Ronkainen is explicitly included while Newman is implicitly included in the invalidity contentions, as argued by Patent Owner. *See* Ex. 2008, 5–6, 15–18, 31. The Araki reference is not included in the invalidity contentions, but is used in the Petition for every proposed challenge to patentability. Therefore, we find the prior art and arguments included in the Petition are materially different than those presented in the District Court. Additionally, the Trewin reference is relied upon for two of the three challenges to patentability presented addressing all of the challenged claims. As a further example of a material difference, we note that the Petition explicitly relies on Ronkainen for teaching the “determining . . . one of a presence and an absence of a media signal,” as recited in claim 13 (*see* Pet. 57–58), yet Petitioner’s invalidity contentions addressing this same limitation do not include the Ronkainen reference (*see* Ex. 2008, 19–20).

Notwithstanding the material differences between Petitioner’s challenges and the invalidity contentions, due to the stay of the parallel District Court proceeding, the Board will likely address patentability issues prior to the District Court reaching invalidity issues at trial, thereby obviating concerns of inefficiency and conflicting decisions while providing

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the possibility of simplifying issues for trial in the parallel District Court proceeding. *See, e.g., MED-EL Elektromedizinische Geräte GmbH v. Sonova AG*, IPR2020-00176, Paper 13 at 15 (PTAB June 3, 2020) (“As to the fourth factor, the parties do not dispute that overlap exists between the invalidity issues in this case and in the district court. This overlap may inure to the district court’s benefit, however, by simplifying issues for trial should we reach our determination on the challenges raised in the Petition before trial.”).

Based on the aforementioned material differences between the challenges to patentability set forth in the Petition compared to the invalidity contentions before the District Court, as well as the stay of the parallel District Court proceeding, the considerations of the fourth *Fintiv* factor weigh against exercising discretion to deny institution.

d. Whether the petitioner and defendant in the parallel proceeding are the same party

Petitioner does not dispute Patent Owner’s contention that the Petitioner here, and the defendant in District Court, are the same party. *See* Prelim. Resp. 44; *generally* Reply to Prelim. Resp.; Sur-Reply to Prelim. Resp. 1. In consideration of the fact that the parallel District Court proceeding is stayed, and there is not substantial overlap between the invalidity contentions and the Petition challenges, we regard the consideration of the fifth *Fintiv* factor as neutral or, at most, weighing slightly in favor of exercising discretion to deny institution.

e. Other circumstances, including the merits

Patent Owner also argues that the ability to develop facts related to secondary considerations that are within the control of Petitioner and would

have been the focus of the District Court proceedings is a compelling factor that weighs heavily in favor of denying institution. *See* Prelim. Resp. 48. Patent Owner asserts that critical areas of discovery relevant to secondary considerations include Petitioner’s patent filings, including U.S. Patent No. 8,428,453 to Spiegel (Ex. 2002, “Spiegel” or “Spiegel Patent”), the interference between Mojo Media and Snapchat Inc. related to Spiegel (Ex. 2001), Petitioner’s SEC filings and statements therein (Ex. 2004, 89), and industry praise, commercial success, and unexpected results related to Petitioner’s products that practice one or more of the asserted claims of the ’159 Patent (Ex. 2005; Ex. 2011). *See id.* at 48–49. According to Patent Owner, “[i]t would be in the interest of justice for this discovery to be borne out in a U.S. District Court where discovery is not subject to the limitations of PTAB practice.” *Id.* at 49–50. Patent Owner contends that this factor weighs heavily in favor of denial of the Petition. *See id.* at 50. In reply, Petitioner contends that “Patent Owner’s vague allegations and speculation about secondary considerations are not a basis for denying institution, otherwise every petition containing an obviousness ground could be defeated at the institution stage by the mere proposition that discovery is required regarding secondary considerations.” *See* Reply to Prelim. Resp. 3–4 (citing *Samsung Elecs. Co. v. Dynamics, Inc.*, IPR2020-00504, Paper 11 at 19–22 (PTAB Aug. 12, 2020)).

We are not persuaded by Patent Owner’s arguments. Patent Owner does not meaningfully explain why it would be in the interests of justice for discovery regarding secondary considerations to take place before the District Court instead of before the PTAB. Although we recognize that routine discovery in trial proceedings before the PTAB is limited compared

to U.S. District Courts, we note that our rules provide parties the ability to file a motion for additional discovery. *See* 37 C.F.R. § 42.51(b)(2); CTPG 23–28 (available at <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>). Parties can generally seek the same types of discovery under the Federal Rules of Civil Procedure. *See* CTPG 24. We further note that the standard for granting a motion for additional discovery is “in the interests of justice.” *See* 37 C.F.R. § 42.51(b)(2); *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012–00001, Paper 26 (PTAB March 5, 2013) (precedential). The parties’ additional dispute regarding the existence of evidence of secondary considerations (*see* Reply to Prelim. Resp. 3–4; Sur-Reply to Prelim. Resp. 3–4) bear little relevance to Patent Owner’s argument that discovery related to secondary considerations before the District Court instead of the PTAB is in the interests of justice and weighs heavily in favor of denying institution. We evaluate Patent Owner’s contentions and evidence regarding secondary considerations below in addressing the merits of Petitioner’s patentability challenges.

As noted above, the sixth *Fintiv* factor may include consideration of the merits. As explained in the detailed analysis below, we find that the merits of Petitioner’s patentability challenges appear to be strong at this stage of the proceeding.

For the foregoing reasons, consideration of other circumstances, including Patent Owner’s concerns about discovery and the merits of Petitioner’s challenges weigh against exercising discretion to deny institution.

2. Conclusion

We have considered the circumstances and facts before us in view of the *Fintiv* factors. Because our analysis is fact-driven and we take a holistic view of the factors, no single factor is determinative of whether we exercise our discretion to deny institution under § 314(a). Based on the facts before us, the stay in the parallel District Court proceeding, the early stages of that parallel proceeding prior to the stay, and the lack of overlap between the invalidity contentions in the District Court proceeding and the challenges raised in the Petition allay any concerns regarding inefficiency, duplication of efforts, and the possibility of conflicting decisions. Of the remaining factors, we find only that Petitioner is the same as the defendant in the parallel proceeding to be neutral or to weigh slightly in favor of discretionary denial. Balancing all of the *Fintiv* factors, on this record, we determine that the circumstances presented here weigh against exercising discretion under § 314(a) to deny institution of *inter partes* review.

B. Discretion under 35 U.S.C. § 325(d)

Patent Owner asserts that the Board should exercise its discretion to deny institution of the *inter partes* review under 35 U.S.C. § 325(d). *See* Prelim. Resp. 50–56. For the reasons that follow, we decline to exercise discretion to deny institution based on § 325(d).

In evaluating arguments under § 325(d), we use

[a] two-part framework: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of [the] first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

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Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*”); see also *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to Section III.C.5, first paragraph) (listing factors to consider in evaluating the applicability of § 325(d)) (“*Becton, Dickinson*”).

Under *Advanced Bionics, Becton, Dickinson* factors (a), (b), and (d) are considered in the evaluation of whether the same or substantially the same art or arguments were previously presented to the Office. *Advanced Bionics* at 10. *Becton, Dickinson* identifies these factors as:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; and (d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art.

Becton, Dickinson at 17–18. If the first part of the *Advanced Bionics* framework is satisfied, we turn to the second part where *Becton, Dickinson* factors (c), (e), and (f) are considered in the evaluation of whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. *Becton, Dickinson* identifies these factors as:

- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and

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

Becton, Dickinson at 17–18.

1. Brief overview of pertinent prosecution history

The Notice of Allowability for parent Application No. 13/945,278, which issued as U.S. Patent No. 8,996,059, included a reasons for allowance, in which the Examiner noted that Newman discloses a communication device for recording a message on a first and second mode comprising detecting activation of a button on the communication device by touching or depressing the button in a duration of activation, and selecting a mode to record the message. *See* Ex. 1016, 2 (Nov. 2014 Office Action, 2; citing US 2014/0024324 A1, Abstract, ¶¶ 15, 96–98, 100, 110, 114, 118, 122–126, Figs. 4a–4c). The Examiner also noted that in the background of the invention section, the applicant disclosed activating a button for recording a message, in which a single press or tap on the button is used for a short message recording and “a kept-depressing button for recording until the button is released for a long message.” *Id.* (citing US 2014/0024324 A1 ¶¶ 3–7). The Examiner, however, found:

[t]he prior art of record failed to explicitly suggest or disclose selecting one of a plurality of communication modes for recording the media message based upon the comparison of the activated duration and a timing parameter (threshold), or based upon the presence or absence of a media signal after the activation of the interface element/button.

Id. at 2–3. The Notice of Allowability for parent Application No. 13/945,278 included a Notice of References Cited, which listed U.S. Patent Application Publication No. 2013/0110565 A1 to Means Jr. et al.

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(Ex. 2012, “Means Jr.”), but did not include any comments by the Examiner regarding the listed references. *See id.* at 2–3, 5.

During prosecution of the ’159 Patent, the Examiner relied on the teachings of Means Jr. to address then-pending claims 14–19 which depended from then-pending independent claim 13, which described an embodiment where the recording application selects one of a plurality of communication modes based on the presence or absence of a media signal. *See* Ex. 2003, 62–63 (Dec. 2016 Office Action, 7–8), 70–71 (May 2017 Office Action, 5–6), 86–87 (May 2016 Office Action, 4–5), 95–96 (Dec. 2015 Office Action, 5–6), 107–108 (amended claims submitted with March 2017 Response), 121–122 (amended claims submitted with Sept. 2016 Response), 142–143 (originally filed claims 13–19).

2. The parties’ contentions pertinent to the first part of the Advanced Bionics framework

Patent Owner contends the Petition should be denied pursuant to § 325(d) because similar art and arguments used in the Petition were presented previously to the Office. *See* Prelim. Resp. 51. More specifically, Patent Owner argues that factors (a), (b), and (d) of the *Becton, Dickinson* factors weigh in favor of denial because Newman was of record during prosecution, similar arguments made in the Petition were raised and addressed during prosecution of the ’159 Patent, and the additional references including Araki, Trewin, and Ronkainen are cumulative of the art that was before the Board. *See id.* at 52.

Patent Owner argues that Petitioner admits that the Newman reference used in the Petition is the same reference substantively considered by the Examiner during prosecution. *See* Prelim. Resp. 52; Sur-Reply to Prelim.

Resp. 4. Patent Owner argues that part one of the *Advanced Bionics* framework is met because the patentability challenges of the Petition rely on the same art that was substantively considered and used by the Examiner during prosecution. *See* Prelim. Resp. 53. Patent Owner also makes the following acknowledgement: “Petitioner relies on Araki ‘for the feature of selecting a communication mode based on the duration of activation’ and Ronkainen for ‘the further feature of selecting a communication mode based on the presence or absence of a media signal.’” *Id.* (citing Pet. 4).

Patent Owner also argues that an examination of Araki reveals that it is merely cumulative of Means Jr., which was discussed at length during prosecution of the ’159 Patent. *See* Prelim. Resp. 53–54. According to Patent Owner, “the Examiner analyzed Means Jr. and acknowledged that both push-to-talk and tap to record are known in the art.” *See id.* at 54 (quoting Ex. 2003, 63 (Dec. 2016 Office Action, 8)). Patent Owner points out that the Examiner also cited paragraph 16 of Means Jr., which Patent Owner characterizes as describing timers used to begin and end a recording. *See id.* (citing Ex. 2003, 62 (Dec. 2016 Office Action, 7)). In support of its arguments, Patent Owner reproduces a portion of paragraph 16. *See id.*

Paragraph 16, in pertinent part discloses:

According to an exemplary embodiment, a system, method and/or computer program product may include a computer implemented method of providing an employee or user activity management system comprising: receiving, by at least one processor, an indication to start or stop recording, wherein said indication comprises receiving at least one of a selection to start recording, a selection to stop recording, a trigger, or a toggle, comprising at least one of receiving said selection based on a timer, wherein said timer comprises at least one of a user defined timer or a signaled timer from a remote web server to

start recording user activity and stop recording said user activity; receiving said selection based upon receiving launching of at least one user-selected software application, or portion of at least one software application to start recording user activity; receiving said selection based upon receiving

Ex. 2012 ¶ 16.

Patent Owner notes that the Examiner's reasons for allowance indicated that the prior art failed to teach selecting one of a plurality of communication modes for recording the media/text message based upon the comparison of an activated duration and a timing parameter. *See* Prelim. Resp. 54 (quoting Ex. 2003, 71 (May 2017 Office Action, 6)). According to Patent Owner, "the Examiner already would have considered whether a button and associated timing parameter, such as Araki, was within the scope of the prior art." *Id.* at 55.

Petitioner asserts that Patent Owner does not dispute that Trewin, Ronkainen, and Araki were not considered during prosecution of the '159 Patent and '059 Patent. *See* Reply to Prelim. Resp. 4. Petitioner also notes that Patent Owner does not argue that Trewin or Ronkainen references, nor Petitioner's arguments regarding these references were the same or substantially the same as arguments presented previously to the Office. *See id.*

In reply, Petitioner contends that Patent Owner's argument that Araki is cumulative of Means Jr. is meritless because Patent Owner misleadingly suggests that the Examiner found that Means Jr. discloses both push-to-talk and tap-to-record communication modes. *See* Reply to Prelim. Resp. 4 (quoting Prelim. Resp. 54). According to Petitioner, "the Examiner never found that Means Jr. disclosed multiple communication modes, let alone the

claim step of selecting a communication mode based on duration of activation.” *Id.* at 4–5. Petitioner asserts that the Examiner found only that Means Jr. discloses initiating/starting recording of a message, and only rejected pending claims 14–19 which did not recite mode selection based on a duration of activation based on a prior art combination that included Means Jr. *See id.* at 5 (citing Ex. 2003, 62–63, 70–71, 107–108). Petitioner further asserts that no pending claims in the ’059 Patent were rejected based on Means Jr. *See id.* Finally, Petitioner contends that paragraph 16 of Means Jr., cited by Patent Owner, does not disclose or suggest a key teaching required by the challenged claims and disclosed by Araki—detecting a duration of activation of an interface element and selecting a communication mode based on that duration. *See id.*

Patent Owner counters that Araki and Ronkainen are both cumulative of Means Jr. under Petitioner’s arguments because Petitioner relies on Araki for the feature of selecting a communication mode based on the duration of activation and on Ronkainen for “the further feature of selecting a communication mode based on the presence or absence of a media signal. *See Sur-Reply to Prelim. Resp.* 5. According to Patent Owner, “[t]he Examiner explicitly stated that ‘it would have been obvious[] . . . to have Itoh, ***modified by Means, Jr.*** in order to start[] recording a message which will ***reduce[] recording time.***” *Id.* (quoting Ex. 2003, 62–63 (Dec. 2016 Office Action, 7–8)).

3. Analysis

As an initial matter, there is no dispute that Newman was presented previously to the Office. *See Pet.* 5; *Prelim. Resp.* 52. Patent Owner, however, does not present arguments to demonstrate that the additional

Araki, Trewin, and Ronkainen references were previously considered by the Office. *See* Prelim. Resp. 50–56. At best, Patent Owner merely argues “the additional references including Araki, Trewin, and Ronkainen are cumulative of the art that was before the [Office].” *Id.* at 52. For the reasons set forth below, we disagree. Accordingly, the only similarity between the asserted art and the prior art involved during examination is Newman.

We do not agree with Patent Owner that Araki is cumulative of Means Jr. In particular, we do not agree with Patent Owner’s argument that “the Examiner already would have considered whether a button and associated timing parameter, such as Araki, was within the scope of the prior art,” because Patent Owner too broadly characterizes the teachings of Araki that are relied upon in the Petition. The Petition relies on Araki for teaching determining the duration of activation of an interface element (*see* Pet. 17–21), and selecting one of a plurality of communication modes based on a comparison of the duration of the activation to one or more timing parameters (*see* Pet. 14–17, 26–28). The disclosures of Means Jr. cited by Patent Owner (*see* Prelim. Resp. 54 (quoting Ex. 2012 ¶ 16)) do not include the same or similar teachings as Araki that were relied upon in the Petition, e.g., selecting one of a plurality of communication modes based on a comparison of the duration of the activation of an interface element to one or more timing parameters. Instead, Means Jr. merely discloses starting and/or stopping a recording based on a processor receiving an indication that comprises receiving a selection that may be based on a timer that comprises either a user defined timer or a signaled time from a remote web server. *See* Ex. 2012 ¶ 16. We also note that the Examiner relied on the teachings of

Means Jr. to address then-pending claims 14–19, which depended from then-pending independent claim 13, which described an embodiment where the recording application selects one of a plurality of communication modes based on the presence or absence of a media signal. *See, e.g.*, Ex. 2003, 62–63 (Dec. 2016 Office Action), 121–122 (amended claims submitted with Sept. 2016 Response). Then-pending claims 13–19 did not include any description related to selecting one of a plurality of communication modes based on a comparison of the duration of an interface element with the timing parameter. *See, e.g., id.* at 121–122. For these reasons, we do not agree with Patent Owner’s contentions that Araki is cumulative of Means Jr. *See* Prelim. Resp. 53–54.

We also do not agree with Patent Owner’s Sur-Reply contention that Ronkainen is cumulative of Means Jr. The Petition relies on Ronkainen for teaching selecting one of a plurality of communication modes based on the presence or absence of a media signal. *See* Pet. 50–53, 54–55, 57–58. Patent Owner, however, does not direct us to where Means Jr. discloses, teaches, or suggests selecting one of a plurality of communication modes based on the presence or absence of a media signal. *See* Prelim. Resp. 50–56; Sur-Reply to Prelim. Resp. 4–5. Patent Owner points only to the Examiner’s determination that it would have been obvious to modify the teachings of Itoh in order to start recording a message which will reduce recording time (*see* Sur-Reply 5), but does not explain sufficiently how the teachings of Ronkainen are cumulative of the teachings of Means Jr. *See* Prelim. Resp. 50–56; Sur-Reply to Prelim. Resp. 4–5.

We also do not agree with Patent Owner’s argument that the teachings of Trewin are cumulative of art that was before the Office (*see* Prelim.

Resp. 52). As one example, the Petition relies on Trewin for teaching “one or more configurable timing parameters,” as recited in at least claim 1 (*see* Pet. 21–26), but Patent Owner does not present arguments sufficient to demonstrate that the teachings of Trewin are cumulative of the teachings of any specific reference presented previously to the Office (*see* Prelim. Resp. 50–56).

We further do not agree with Patent Owner’s unsupported argument that similar arguments made in the Petition were raised and addressed during prosecution of the ’159 Patent. *See* Prelim. Resp. 52. Patent Owner does not meaningfully explain any overlap between arguments made during examination and the manner in which Petitioner relies on the prior art. *See id.* at 52 (“The arguments presented in the [P]etition are thus largely the same as the arguments that were already before the Office.”), 53 (“Petitioner largely repeats the same arguments that the Examiner used during prosecution.”).

In consideration of the first step of the *Advanced Bionics* framework and *Becton, Dickinson* factors (a), (b), and (d), we determine that neither the same or substantially the same art nor the same or substantially the same arguments were presented previously to the Office. Because the first step of the *Advanced Bionics* test is not satisfied, we need not proceed to the second part of the test. *See Advanced Bionics* at 8 (second step of the framework only applies “if either condition of the first part of the framework is satisfied”). Accordingly, we decline to exercise our discretion under 35 U.S.C. § 325(d) to deny institution of *inter partes* review.

C. Claim Construction

For petitions filed after November 13, 2018, the Board applies the same claim construction standard as that applied in federal courts. *See* 37 C.F.R. § 42.100(b) (2019). The claim construction standard used in a civil action under 35 U.S.C. § 282(b) is generally referred to as the *Phillips* standard. *See Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). Under the *Phillips* standard, generally words of a claim are given their ordinary and customary meaning. *Phillips*, 415 F.3d at 1312.

Petitioner does not provide explicit claim constructions for any claim term or phrase. *See* Pet. 8. Nonetheless, Petitioner addresses claim constructions for “adaptive recording application,” “configurable timing parameters,” “communication mode,” and “critical time” in the portions of the Petition addressing the challenges to patentability. *See* Pet. 21–22, 27, 31, 33. Patent Owner does not appear to dispute Petitioner’s constructions for these terms. In addition, we note that the ’159 Patent provides explicit claim constructions for the following terms that appear in the claims: “media message,” “communication mode,” “interface element,” “duration of activation,” “configurable timing parameters,” “critical time,” “media signal,” “lower threshold time,” and “upper threshold time.” *See, e.g.*, Ex. 1001, 2:67–3:58, 5:1–5:9, 6:40–7:1, 7:33–39, 14:6–10.

As demonstrated in the analysis below, we need not construe any claim terms or phrases. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“[W]e need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

D. Principles of Law

A claim is unpatentable under 35 U.S.C. § 103 if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) if in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

E. Level of Ordinary Skill in the Art

Petitioner asserts:

[a] person of ordinary skill as of July 2012 would have possessed at least a bachelor's degree in electrical engineering or computer science, and two years of work experience in multimedia data communications and user interfaces. A person could also have qualified with more formal education and less technical experience, or vice versa.

Pet. 5 (citing Ex. 1002 ¶¶ 15–21). Patent Owner does not dispute Petitioner's assertions addressing the skill level of a person of ordinary skill in the art. *See generally* Prelim. Resp. For the purpose of this Decision, we adopt Petitioner's definition of a person of ordinary skill in the art.

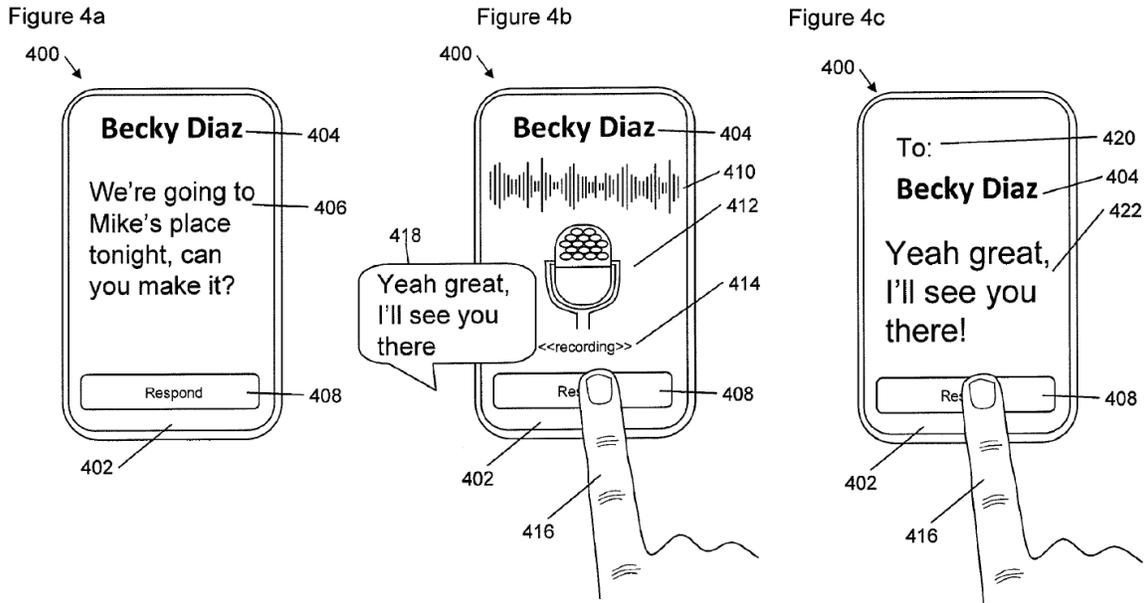
F. Proposed Unpatentability of Challenged Claims

1. Proposed Unpatentability of Claims 1, 3–7, 20, 21, and 23–25 over Newman, Araki, and Trewin

a. Overview of Newman (Ex. 1003)

Newman is directed to hand-held portable electronic devices that may provide one or more of audio/text/video communication functions and/or text transmission, interactive/non-interactive viewing functions, music recording/playing functions, downloading/sending of data functions, image capture functions, and gaming functions. *See Ex. 1003, 1:6–26.* The portable electronic devices provide a mode of operation with intermediate functionality (i.e., second mode) between an active first mode that allows a user to generally interact with the device and access the full functionality of the device and a standby-type or sleep-type mode (i.e., third mode) where the full availability of options is disabled. *See id. at 7:19–42, 8:43–55, 10:41–49.* The second mode of operation with intermediate functionality allows the user to access desired information directly, without the need for the user to consider which on-screen or menu option the user needs to select in order to interact with the desired information. *See id. at 7:43–47, 9:1–10.* “Operating a device using locked user interaction in an intermediate-type operating mode using specific limited user inputs may require a lower level of competence and ability of the user than operating a device allowing general unlocked user interaction.” *Id. at 7:62–67.* When a portable electronic device is operating in the intermediate type mode, the battery life may be prolonged and the processing activity may be reduced, requiring reduced battery recharging frequency and providing increased application speed. *See id. at 8:1–9.*

Figures 4a through 4c of Newman are reproduced below.



Figures 4a through 4c are illustrations depicting a user responding to a message received from a third party by dictating a message while operating in the mode of intermediate functionality. *See* Ex. 1001, 6:50–51, 6:56–58, 12:8–9. Figure 4a shows device 400 with touch-sensitive screen 402 displaying text message 406 received from third party 404. *See id.* at 10:51–53. Figure 4b shows a user has performed a locked user interaction of touching and holding down “respond” button 408 with finger 416. *See id.* at 10:55–57. Holding “respond” button 408 has activated device 400 to record sound for the duration of the activating user input, i.e., while “respond” button 408 is held. *See id.* at 10:59–61. Rather than holding down a dedicated button to provide activating user input, a first touch may begin recording and a second touch may end recording. *See id.* at 10:64–65, 11:2–4. Figure 4b shows the user dictating message 418 while holding “respond” button 408. *See id.* at 11:9–12. The device may be configured to operate voice recognition software to convert the user’s recorded voice into

text message 422. *See id.* at 11:25–27. Figure 4c shows the user has stopped speaking, but the user would like to check that message 422 appears as they wish before it is transmitted by continuing to hold down “respond” button 408. *See id.* at 11:43–49. To indicate that device 400 has recognized that the user has finished speaking, the word “To” 420 appears to show that message 422 as dictated will be sent to third party 404. *See id.* at 11:49–52. Releasing the press on the button automatically terminates the activating user input and begins the transmission of message 422 to third party 404. *See id.* at 11:60–65, Fig. 4d. The device also is configured to record the user’s voice message and transmit an audio recording of the message rather than a text version. *See id.* at 11:27–33.

b. Overview of Araki (Exs. 1004, 1005)

Araki discloses a speech-recognizing device that comprises a microphone-button-detecting portion for detecting an ON operation or both an ON operation and an OFF operation of a microphone button that is operated when the user is to speak. *See Ex. 1005 ¶¶ 15, 41.* A speech-recognizing portion of the speech-recognizing device carries out speech recognition based on the timing of the ON operation, or timing of both an ON and an OFF operation, detected by the microphone-button-detecting portion. *See id. ¶¶ 15, 41.* The user can operate the microphone button in two different methods, and includes a comparison of the pressing time interval against a set time interval. *See id. ¶ 16.* The microphone button can be operated in a first operating method of pressing for at least one second or a second operating method of pressing for less than one second. *See id. ¶ 69, Fig. 5 (step S14).* When operating in the first operating method, wherein the microphone button has been pressed for at least one second, the

device determines the ending time based on the time at which the microphone button is released and stops speech recognition. *See id.* ¶ 69, Fig. 5 (step S14: YES). When the microphone button has been pressed for less than 1 second, the automatic translating device performs speech recognition on the sound that is inputted after releasing the microphone button up until a nonspeech segment continues for at least three seconds. *See id.* ¶ 69, 71, Fig. 5 (step S14: NO).

c. Overview of Trewin (Ex. 1007)

Trewin discloses automatic, dynamic configuration of input devices used to control computer systems in order to accommodate the control requirements of users who have differing abilities, or users operating in a context which affects their control of an input device. *See Ex. 1007*, 1:13–19, 3:43–46, 4:58–63. The input device may comprise a physical device, such as a keyboard, mouse, or binary switch, or a less tangible means, such as speech input, and is used to control a target device such as a personal computer, household appliance, etc. *See id.* at 4:64–5:6. The input device has a number of configuration options that include, but are not limited to: the delay before a key on a keyboard starts to repeat – key repeat delay (KRD) – the rate at which keys repeat, etc. *See id.* at 5:9–18. The configurations, such as KRD, are implemented in software. *See id.* at 5:18–19, 8:55–58. For KRD, as the user presses keys on the keyboard, these actions generate key down and key up events that are passed to the operating system and automatic configuration agent software. *See id.* at 8:58–66, Fig. 8. Within the automatic configuration agent, the events are processed by an input monitor that passes the events to an analyzer and a user change recognizer. *See id.* at 8:66–9:3, Fig. 8. The analyzer uses the

events to calculate an appropriate KRD. *See id.* at 9:3–6. Based on detection of a change in user, the analyzer responds by restarting its calculations and passes a recommended KRD for a new user to a configurer to update the KRD. *See id.* at 9:6–21, 9:45–59, 10:28–48, 11:36–44; Figs. 8, 10, 12.

d. Analysis

For the purpose of this Decision and based on Petitioner’s identified disclosures of Newman, Araki, Trewin, and Mr. Schmandt’s supporting testimony (Ex. 1002), we are persuaded for the reasons provided below that Petitioner establishes sufficiently that the combination of Newman, Araki, and Trewin teaches or suggests all of the limitations recited in independent claims 1, 20, 24 and 25, and claims 3–7, 21, and 23 dependent therefrom.

Claim 1

(a) A computer implemented method for determining a communication mode, comprising:

Petitioner contends that, to the extent the preamble is limiting, the recited method is taught by, or obvious over Newman, Araki, and Trewin, as explained with respect to the limitations recited in the body of claim 1. *See* Pet. 14. Patent Owner does not dispute Petitioner’s assertions addressing the preamble. *See generally* Prelim. Resp. Nonetheless, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). Based on the current record, regardless of whether the preamble is limiting, we are persuaded Petitioner has shown adequately for the purpose of institution that the combined prior art discloses a computer implemented method for determining a communication mode, as recited in claim 1.

(b) detecting activation of an interface by an application on a communication device;

Petitioner asserts that Newman further teaches “detecting activation of an interface element by an application on a communication device” based on Newman’s disclosure of a reply button shown in Figure 3b and a respond button 408 shown in Figure 4b on a smartphone that are each capable of receiving user input or capturing the application of pressure from the user, and an email or messaging application. *See* Pet. 14–17 (reproducing Ex. 1003, Figs. 3b, 4a; citing Ex. 1003, 1:6–20, 1:30–34, 2:29–33, 8:39–42, 9:24–25, 10:32–35, 10:51–61, 18:41–45; Ex. 1002 ¶¶ 90, 93–94). Patent Owner does not dispute Petitioner’s assertions with respect to this limitation. *See generally* Prelim. Resp. Nonetheless, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378. Based on the current record, we are persuaded Petitioner has shown adequately for the purpose of institution that the combined prior art discloses “detecting activation of an interface element by an application on a communication device” as recited by claim 1.

(c) determining a duration of said activation of said interface element by said application;

Petitioner asserts that Newman discloses detecting an activation of an interface element by an application, and that a voice recording is carried out for the duration of that activation, but that Newman does not disclose determining a duration of that activation. *See* Pet. 17–18 (citing Ex. 1003, 10:59–63). Petitioner asserts that determining a duration of the activation is taught by and would have been obvious in view of Araki. *See id.*

Petitioner asserts that Araki discloses a speech recognition program, where depending on the duration that a button on a device is pressed, one of two operating modes for recording and performing speech recognition is selected—either push-to-talk or tap-to-start (i.e., “push to activate”). *See* Pet. 18 (citing Ex. 1005 ¶¶ 41, 46, 69, 71). Petitioner contends that Araki provides a specific example of detecting whether the button has been pressed for more or less than one second. *See id.* at 18–19 (reproducing a portion of Ex. 1005, Fig. 5, with annotations; citing Ex. 1005 ¶¶ 41, 46, Fig. 5 (step S14)).

For the purpose of this Decision and based on Petitioner’s citations to Newman, Araki, and Mr. Schmandt’s supporting testimony (Ex. 1002), we are persuaded by Petitioner’s position. Specifically, we are persuaded Petitioner sets forth sufficient articulated reasoning with rational underpinning to support the conclusion that it would have been obvious to one of ordinary skill in the art to modify the teachings of Newman to include (a) determining a duration of activation of a button and (b) selectively performing push-to-talk and tap-to-start modes as a result, as taught by Araki, in order (i) “to improve the flexibility and ease-of-use of the reply button[] and respond button [] in Newman” and (ii) to provide the “benefit of a more accurate recording of the message regardless of which mode is selected.” Pet. 19–21 (citing Ex. 1002 ¶¶ 99–101) *see KSR*, 550 U.S. at 418. In particular, Petitioner contends that a skilled artisan would have appreciated that users might be confused as to how the buttons work, for example, how the start and ending of a recording is determined when the button is pressed. *See id.* at 20. In support of its arguments, Petitioner directs attention to Araki’s disclosure addressing when a user does not

understand the use of the speech recognition device and how to activate the microphone button. *See id.* (citing Ex. 1005 ¶ 25). Petitioner asserts that Araki teaches the system can select a recording mode that reflects the user's intentions based on a duration of activation of the user interface element.

See id. (citing 1005 ¶ 89; Ex. 1002 ¶ 101). According to Petitioner:

[f]or example, regardless of the duration for which a user activated the “reply’ button []” and “respond’ button [],” the messaging program in Newman adapted based on Araki would have been able to more correctly record the voice message as the user intended, even for users with a limited understanding of how the button operated.

Id. (citing Ex. 1002 ¶ 101).

Patent Owner argues that Petitioner fails to identify where “determining a duration of said activation of said interface element by said adaptive recording application,” is found in Araki. *See Prelim. Resp.* 29. We do not agree with Patent Owner's argument because it is undeveloped and not commensurate in scope with the limitations of claim 1. *See Prelim. Resp.* 29–38. Moreover, Patent Owner's argument addresses the teachings of Araki individually, instead of addressing the combined teachings of Newman in view of Araki, as proposed by Petitioner. One cannot show non-obviousness by attacking references individually. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (“Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of the combination of references.”). We understand Petitioner to propose modifying the application of Newman to include determining a duration of the activation of the interface element, as taught by Araki. *See Pet.* 17–21.

(d) comparing said duration of said activation of said interface element with one or more configurable timing parameters by said application; and

Petitioner asserts the combined teachings of Newman and Araki teach “comparing said duration of said activation of said interface element with one or more configurable timing parameters by said application,” as recited in claim 1. *See* Pet. 21–22. Petitioner bases its assertion on the teachings of Newman as modified by Araki’s teaching of comparing a duration of activation of a button to whether it is pressed for more or less than one second. *See id.* at 21 (citing Ex. 1005 ¶¶ 69, 71, Fig. 5 (step S14)).

Petitioner acknowledges that Araki discloses an exemplary duration of one second, but asserts that Araki refers more generally to the duration as a “set time interval” or a “prescribed time interval.” *See id.* (citing Ex. 1005 ¶¶ 23, 24, claims 1, 4, 6, 7, 9). Petitioner asserts that it would have been obvious that the interval could have been implemented using other values. *See id.* (citing Ex. 1002 ¶ 121). Petitioner further acknowledges that the claim limitation requires one or more configurable timing parameters, where “configurable timing parameter” is described in the ’159 Patent as follows:

As used herein, the term “configurable timing parameters” refers to time parameters used by the adaptive recording application for comparison with the duration of activation of an interface element to enable the adaptive recording application to select one of the communication modes for recording the media message.

Ex. 1001, 3:35–40; *see* Pet. 21–22. Petitioner asserts the combination of Newman and Araki teaches a set time interval or prescribed time interval (e.g., one second) which corresponds to a configurable timing parameter consistent with the ’159 Patent description. *See* Pet. 22 (citing Ex. 1005 ¶¶ 23, 24).

Petitioner further asserts that if the word “configurable” incorporates a further requirement that the time parameter “can be set and changed by the application,” consistent with Petitioner’s litigation position, Newman and Araki do not teach this limitation as more narrowly construed. *See* Pet. 22. Petitioner asserts that this limitation, as more narrowly construed, would be obvious in view of the teachings of Trewin. *See id.*

Petitioner contends that Trewin teaches a technique for setting and changing parameters associated with input devices to improve the performance and control of the device according to the needs of a user. *See* Pet. 23 (citing Ex. 1007, 3:43–52; Ex. 1002 ¶ 106). Petitioner asserts that Trewin discloses the delay before a keyboard starts to repeat can be configured, e.g., pressing a letter key on a keyboard quickly causes only one letter to appear, but holding down the letter key for a given duration will cause the letter to repeat. *See id.* (citing Ex. 1007, 5:11–13). Petitioner asserts that Trewin’s key repeat delay (KRD) is analogous to the teachings of Araki because, like Araki’s microphone button, a key in Trewin can have two different behaviors based on how long the key is held down. *See id.* (citing Ex. 1002 ¶ 108). Petitioner points out that Trewin generally discloses the ability to configure and customize the repeat delay value based on the needs of the particular user. *See id.* (quoting Ex. 1007, 1:41–42). According to Petitioner, “[a]lthough Trewin’s discussion of the KRD focuses on physical keyboards, Trewin explains that its techniques are broadly ‘applicable to any control device that can be configured via software, and not necessarily one composed of physical buttons.’” *Id.* at 24 (citing Ex. 1007, 2:41–43, 13:23–28; Ex. 1002 ¶¶ 102 n.1, 108)

For the purpose of this Decision and based on Petitioner’s citations to Newman, Araki, and Mr. Schmandt’s supporting testimony (Ex. 1002), we are persuaded Petitioner sets forth sufficient articulated reasoning with rational underpinning to support the conclusion that it would have been obvious to one of ordinary skill in the art to modify the combined teachings of Newman and Araki in view of Trewin’s teachings such that the set or prescribed timing parameter (e.g., one second) was capable of being set and changed by the application in order “to allow the application to adapt to the needs of the specific user” and “best suit the needs and capabilities of the user, thus resulting in more accurate recording.” Pet. 24–26 (citing Ex. 1002 ¶¶ 109–114); *see KSR*, 550 U.S. at 418. In particular, Petitioner contends that “[a] skilled artisan would have appreciated that the amount of delay required by the user to properly utilize a single button/multiple function element . . . may vary from one user to the next, as users often have varying visual capabilities, motor skills, and reaction times based on their age, experience, familiarity with the application, and many other factors.” *See id.* at 25 (citing Ex. 1002 ¶ 111). In support of its arguments, Petitioner directs attention to Trewin’s disclosure that users with disabilities or novice users may have difficulty with single button/multiple function user interface elements because of inadvertently activating the “long press” repeat functionality. *See id.* (quoting Ex. 1007, 1:36–39). Petitioner further asserts that the ability of the user to configure timing parameters of input devices was a well-known feature of the Microsoft Windows and Apple Macintosh operating systems since at least the 1990s, and that, by 2011, it was known to provide configurability of the “tap and hold delay” parameter for touchscreen mobile devices. *See id.* at 25–26 (citing Ex. 1002 ¶ 110).

Patent Owner does not address the construction of “configurable timing parameters,” nor does Patent Owner dispute Petitioner’s assertions that the combination of Newman, Araki, and Trewin teaches this limitation of claim 1. *See generally* Prelim. Resp. Nonetheless, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

Based on the current record, regardless of whether the preamble is limiting, we are persuaded Petitioner has shown adequately for the purpose of institution that the combined teachings of Newman and Araki teach “comparing said duration of said activation of said interface element with one or more configurable timing parameters by said application,” as recited in claim 1.

(e) selecting in response to said detection of said activation of said interface element, one of a plurality of communication modes by said application based on said comparison of said duration of said activation of said interface element with one or more configurable timing parameters.

Petitioner asserts that the combination of Newman and Araki discloses or renders obvious implementing Newman’s application to select between either a push-to-talk (PTT) or a tap-to-start (TTS) communication mode based on comparing the duration of the activation of the “reply” button or “respond” button to a timing parameter such as 1 second. *See* Pet. 26–27 (citing Ex. 1005 ¶¶ 69–71, Fig. 5; incorporating by reference Pet. 21–23). Petitioner further asserts that modifying the combination of Newman and Araki in view of the teachings of Trewin would have resulted in a configurable timing parameter that would be compared to the duration of pressing the “reply” button or “respond” button in order to select the

communication mode. *See id.* at 27–28 (incorporating by reference Pet. 17–21).

Patent Owner argues that neither Newman nor Araki teaches or discloses a “communication mode” and a “plurality of communication modes for recording said media message by said adaptive recording application.” *See* Prelim. Resp. 29. According to Patent Owner, “Petitioner states that the ’159 Patent describes the ‘communication mode’ as a ‘mode for initiating and terminating recording of a media message on a communication device.’” *Id.* at 29–30 (quoting Pet. 27). Patent Owner contends, therefore, the ability to record a media message is required by each mode. *See id.* at 30. Patent Owner argues that Newman alone is deficient for teaching the ability to record, and Petitioner does not argue that Newman teaches or discloses an application with multiple modes. *See id.* (citing Pet. 14–15).

Patent Owner contends that Petitioner incorrectly characterizes Araki as teaching a button that causes recording. *See* Prelim. Resp. 30 (citing Pet. 27). Patent Owner asserts that Petitioner cites to paragraphs 41, 46, 69, 70, and 71 of Araki, but none of these paragraphs teach or suggest that depressing a button causes recording, and therefore none of these paragraphs teach or suggest that depressing a button causes communication or recording. *See id.* at 30–31 Patent Owner argues that paragraphs 41, 46, 69–71 of Araki discloses only speech recognition and automatic translating. *See id.* at 30–31 (quoting Ex. 1005 ¶ 71; citing Ex. 1005 ¶¶ 41, 46, 69–71). Patent Owner argues that, in Araki, storage of sound is performed by a completely different mechanism including a reusable buffer that is not affected by any buttons or interface elements, and where the alleged

recording is constant and performed in a single mode. *See id.* at 32–35 (reproducing Ex. 1005, Figs. 2, 4; citing Ex. 1005 ¶¶ 54, 58, 66).

Patent Owner also contends that Newman does not disclose an option to select between push-to-talk or tap-to-start recording mode. *See* Prelim. Resp. 36. Patent Owner points out that Newman states that in Figures 4a-4e the device is operating only in the second mode. *See id.* (quoting Ex. 1003, 10:50–51). Patent Owner further argues that Araki does not disclose the use of two communication modes with respect to recording because Araki does not disclose a recording device, any initiation or termination of recording, and any purported recording in a buffer begins before a duration time is determined. *See id.* (citing Pet. 27; Ex. 1005 ¶¶ 66, 69–71, Fig. 5). According to Patent Owner, “Araki’s single storage mode, which includes only a temporary buffer storing speech segments, is incompatible with recording media, such as voice or video” because “Araki[’s] algorithm cuts out silence.” *Id.* at 37; *see id.* at 36–37 (citing Ex. 1005 ¶ 66, Fig. 5).

We do not agree with Patent Owner’s arguments. Patent Owner’s arguments are misplaced and address the teachings of Newman alone and Araki alone instead of addressing the combined teachings of Newman in view of Araki, as proposed by Petitioner. One cannot show non-obviousness by attacking references individually. *See In re Merck*, 800 F.2d at 1097. Contrary to Patent Owner’s arguments, Petitioner does not rely on Newman alone for teaching an option to select between push-to-talk and tap-to-start modes and does not rely on the teachings of Araki alone to disclose recording or a recording application. Rather, we understand Petitioner to propose modifying Newman’s recording application to include Araki’s teachings of selecting between push-to-talk and tap-to-start modes based on

a comparison of the duration of the activation time to a timing parameter.
See Pet. 17–21, 26–28.

(f) Proposed Reasons to Combine

Patent Owner also argues there is no motivation to combine Newman with Araki because, according to Patent Owner, Petitioner’s motivations “are conclusory and do not set forth a well-reasoned rationale.” Prelim. Resp. 40. Patent Owner contends that Petitioner does not address disclosures of Newman and Araki that would be impediments to the combination, specifically, that Newman is focused on giving a user limited input, and not on providing a user multiple modes of interaction. *See id.* Patent Owner points out that the user only has one option available in the second mode to reply to the incoming message, but in a first mode has several options. *See id.* (quoting Ex. 1003, 9:41–42, 10:9–13). According to Patent Owner, “the purpose of Newman is to lower power by having limited interaction, and Petitioner provides no reasoning or rationale that would motivate one of skill in the art to increase the capabilities of the limited user interaction to allow for two more modes of media recording which would increase power consumption.” *Id.*

We do not agree with Patent Owner’s arguments. Patent Owner’s argument that Newman provides only a single option for replying to a message while the portable electronic device is operating in a second mode of intermediate functionality and allows only limited input compared to a first mode that allows a user several options (i.e., reply, forward, delete, archive, etc.) is not germane to Petitioner’s proposed modification. Petitioner’s proposed modification of Newman in view of Araki would enable Newman’s recording application operating in the mode of

intermediate functionality and limited input to operate using two modes for recording a voice message—i.e., tap-to-talk and push-to-start. In any event, we note that Newman discloses that the portable electronic device operating in a mode of limited input operates by activating the device to record by receiving the locked user interaction of a user holding the respond button (i.e., push-to-start), and also that it is envisaged that the portable electronic device may operate by activating the device to begin recording based on a first touch and end recording based on a second touch (i.e., touch to start). *See Ex. 1003, 10:50–11:12.*

(g) Objective Indicia of Non-Obviousness

Patent Owner contends that Petitioner’s failure to address secondary considerations should result in denial of the Petition. *See Prelim. Resp. 10, 41.* According to Patent Owner, Petitioner fails to address secondary considerations of commercial success and unexpected results “despite the fact that Patent Owner disclosed that it intended to rely on secondary considerations in the District Court litigation.” *Id.* at 10. Patent Owner points out that “[i]n the parallel district court proceeding, Patent Owner provided responses to interrogatories that directed Petitioner to its own financial documents and positive reviews of the Accused Products identified in Patent Owner’s infringement contentions, *i.e.* the Snapchat App.” *Id.*; *see id.* at 41 (Ex. 2006, 10). Patent Owner further argues that statements made by Petitioner in its SEC filings, marketing documents, Petitioner’s patent filings, and before the Office during an interference indicate strong secondary considerations of nonobviousness, and call into question the veracity of statements made by Petitioner. *See id.* at 10.

More specifically, Patent Owner argues that Petitioner had already conceded during prosecution of the Spiegel Patent that a timing parameter is not taught by the prior art when it acquiesced to the Examiner's statement of the reasons for allowance and permitted the application to issue. *See id.* at 16 (reproducing Ex. 2001, Oct. 2012 reasons for allowance 4; Ex. 2003, Nov. 2017 reasons for allowance 2). Patent Owner contends that Petitioner adopted and advocated for this position during interference proceedings involving the Spiegel Patent. *See id.* at 16–17 (quoting Ex. 2015, 20; citing Ex. 2015, 6, 19–24). Patent Owner contends that Petitioner's statements should be viewed as binding party admissions and should weigh heavily in favor of a finding of nonobviousness. *See id.* at 17 (quoting Ex. 2004, 89). Patent Owner further asserts that Petitioner's Spiegel Patent demonstrates long-felt need and non-obviousness of nearly the same claimed subject matter as that of the '159 Patent. *See id.* at 42 (citing Ex. 2002, 1:12–19; Ex. 2001, Oct. 2012 reasons for allowance 4); *see also id.* at 14 (arguing that Spiegel solves the same problem as the '159 Patent; reproducing Ex. 2002, Fig. 2, Ex. 1001, Fig. 2; quoting Ex. 2002, 1:14–18).

Patent Owner further argues that Petitioner's SEC filings include statements touting the features claimed in the '159 Patent and the later-filed Spiegel Patent and depict an increase in commercial success immediately after the Spiegel Patent was filed. *See id.* at 17–19 (reproducing Ex. 2004, 91 (graph); quoting Ex. 2004, 89); 425 (citing Ex. 2004, 89; Ex. 2014 ¶ 33)). According to Patent Owner, Petitioner's "SEC filings support a finding of nonobviousness because Petitioner has provided a direct correlation between the success of its product and the implementation of the features claimed in the '159 Patent." *Id.* at 19.

Patent Owner also argues that Petitioner has received industry praise touting the features of its patents as well as the features accused of infringement in the parallel District Court proceeding and claimed in the '159 Patent. *See* Prelim. Resp. 20 (quoting Ex. 2005, 2; citing Ex. 2005); *see also id.* at 42 (similar argument).

For objective indicia of nonobviousness to be accorded substantial weight, its proponent must establish a nexus between the evidence and the merits of the claimed invention. *ClassCo, Inc. v. Apple, Inc.*, 838 F.3d 1214, 1220 (Fed. Cir. 2016). “[T]here is no nexus unless the evidence presented is ‘reasonably commensurate with the scope of the claims.’” *Id.* (quoting *Rambus Inc. v. Rea*, 731 F.3d 1248, 1257 (Fed. Cir. 2013)). A patentee is entitled to a presumption of nexus “when the patentee shows that the asserted objective evidence is tied to a specific product and that product ‘embodies the claimed features, and is coextensive with them.’” *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1373 (Fed. Cir. 2019) (quoting *Polaris Indus., Inc. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1072 (Fed. Cir. 2018) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1130 (Fed. Cir. 2000))). “[T]he purpose of the coextensiveness requirement is to ensure that nexus is only presumed when the product tied to the evidence of secondary considerations ‘is the invention disclosed and claimed.’” *Id.* at 1374 (quoting *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988)). “[T]he degree of correspondence between a product and the patent claim falls along a spectrum. At one end of the spectrum lies perfect or near perfect correspondence. At the other end lies no or very little correspondence.” *Id.* “A patent claim is not coextensive with a product that includes a ‘critical’

unclaimed feature that is claimed by a different patent and that materially impacts the product's functionality.” *Id.* at 1375.

We have considered Patent Owner’s evidence and arguments, but we find it insufficiently developed at this stage of the proceeding to have sufficient weight to preclude a determination that Petitioner demonstrates a reasonable likelihood of success on this challenge to patentability. For example, at this stage of the proceeding and based on the current record, Patent Owner does provide analysis demonstrating sufficiently that Petitioner’s alleged infringing products (i.e., Snapchat App) and/or products covered by the Spiegel Patent are coextensive with the challenged claims. Therefore, at this stage of the proceeding, we determine that a presumption of nexus would be inappropriate. “A finding that a presumption of nexus is inappropriate does not end the inquiry into secondary considerations,” because a patent owner “is still afforded an opportunity to prove nexus by showing that the evidence of secondary considerations is the ‘direct result of the unique characteristics of the claimed invention.’” *Fox Factory*, 944 F.3d at 1373–75 (quoting *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996)). Accordingly, we invite the parties to further address the alleged evidence of objective indicia of non-obviousness during the trial.

(h) Summary

For all of the foregoing reasons, for the purpose of this Decision and based on the record before us, there is a reasonable likelihood Petitioner would prevail in showing claim 1 is unpatentable under 35 U.S.C. § 103 over Newman, Araki, and Trewin.

Independent Claim 20

Petitioner asserts that most of the limitations of independent claim 20 are substantively identical to the limitations of claim 1. *See* Pet. 32 (citing Ex. 1002 ¶ 136). Petitioner notes that, different from claim 1, claim 20 recites “critical time configured by said adaptive recording application.” *See id.* Petitioner contends that the configurable timing parameter taught by and obvious over Newman, Araki, and Trewin corresponds to the “critical time.” *See id.* (incorporating by reference Pet. 30–31). Patent Owner further asserts that “said adaptive recording application” lacks antecedent basis in claim 20 and, therefore, refers to the earlier recited “application.” *See id.* Patent Owner contends that “adaptive recording application” refers to the same “application” recited in claim 1. *See id.* (citing Ex. 1002 ¶ 139).

Petitioner argues that, to the extent claim 20 requires an “adaptive recording application,” this is disclosed by and obvious over Newman and Araki alone, or in further combination with Trewin. *See* Pet. 33. Petitioner points out that “adaptive recording application is described in the ’159 Patent generally as an application that changes its manner of recording without requiring manual intervention. *See id.* (quoting Ex. 1001, 5:39–46; citing Ex. 1001, 11:60–67). Specifically, Petitioner asserts that “Newman’s application, as adapted based on Araki’s teachings, . . . would have predictably resulted in Newman’s application automatically adapting its manner of recording voice messages (e.g., tap-to-start or push-to-talk) based on the duration of time that a button was pressed, and without requiring user intervention.” *Id.* at 33. Petitioner also asserts the combination with Trewin to automatically adapt one or more timing parameters would have provided an additional way for automatically and more precisely adapting the

application's behavior to a user's intent when interacting with Newman's reply button or respond button. *See id.* at 33–34.

Patent Owner does not address substantively the limitations of claim 20 and Petitioner's contentions regarding claim 20. *See generally* Prelim. Resp. Nonetheless, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

For these reasons and for the same reasons as those explained above for claim 1, for the purpose of this Decision and based on the record before us, there is a reasonable likelihood Petitioner would prevail in showing independent claim 20 is unpatentable under 35 U.S.C. § 103 over Newman, Araki, and Trewin.

Independent Claim 24

Claim 24 recites similar limitations as those recited in independent claims 1 and 20, in the form of a system that includes a processor, a non-transitory computer readable storage medium, and several modules. *See* Pet. 35–41; *compare* Ex. 1001, 29:19–30:3 (claim 1), *with* Ex. 1001, 27:9–23 (claim 1), *and* 28:62–29:4 (claim 20). Claim 24 also recites a mode selection module configured to select one of a plurality of communication modes “based on one or a combination of: said comparison of said duration of said activation of said interface element with said one or more configurable timing parameters; and a determination of one of a presence and an absence of a media signal during and/or after said activation of said interface element.” *See* Ex. 1001, 29:19–30. Petitioner asserts that because claim 24 only requires that the selection of a communication mode is based on one of the recited options, and does not require selecting a communication mode based on the presence or absence of a media signal,

the combination of Newman, Araki, and Trewin disclose and render obvious the claimed selection based only on “said comparison of said duration of said activation of said interface element with one or more configurable timing parameters.” *See* Pet. 41. Petitioner also asserts that similar to claim 20, claim 24 recites “said adaptive recording application” without antecedent basis. *See id.* at 38. Petitioner contends that “said adaptive recording application” refers to the “application” recited earlier in claim 24. *See id.* (citing Ex. 1003 ¶ 156). Petitioner contends that, for the same reasons as those addressing claim 20, to the extent claim 24 requires an “adaptive recording application” it is disclosed by and obvious over Newman and Araki alone, or in further combination with Trewin. *See id.* at 37–38 (citing Ex. 1002 ¶ 157).

We have reviewed Petitioner’s contentions and supporting evidence addressing how Newman, Araki, and Trewin, as combined by Petitioner, teach or suggest the limitations of independent claim 24. *See* Pet. 35–41. Patent Owner does not address substantively the limitations of independent claim 24 and Petitioner’s contentions regarding claim 24. *See generally* Prelim. Resp. Nonetheless, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

For the same reasons as those addressed above for claims 1 and 20, for the purpose of this Decision and based on the record before us, there is a reasonable likelihood Petitioner would prevail in showing independent claim 24 is unpatentable under 35 U.S.C. § 103 over Newman, Araki, and Trewin.

Independent Claim 25

Claim 25 recites similar limitations as those recited in independent claim 24, but utilizes the term “computer program code” in place of “module” recited in claim 24. *See* Pet. 41–43; *compare* Ex. 1001, 30:26–41 (claim 25), *with* Ex. 1001, 29:19–30:3 (claim 24). We have reviewed Petitioner’s contentions and supporting evidence addressing how Newman, Araki, and Trewin, as combined by Petitioner, teach or suggest the limitations of independent claim 25, including the recited “computer program code.” *See* Pet. 41–43. Patent Owner does not address substantively the limitations of claim 25 and Petitioner’s contentions regarding claim 25. *See generally* Prelim. Resp. Nonetheless, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

For the same reasons as those addressed above for claims 1, 20 and 24, for the purpose of this Decision and based on the record before us, there is a reasonable likelihood Petitioner would prevail in showing independent claim 25 is unpatentable under 35 U.S.C. § 103 over Newman, Araki, and Trewin.

Dependent Claims 3–7, 21 and 23

Claims 3–7 depend ultimately from claim 1, and claims 21 and 23 depend from independent claim 20. Ex. 1001, 27:27–54, 29:5–7, 29:12–17. We have reviewed Petitioner’s contentions and supporting evidence addressing how the combination of Newman, Araki, and Trewin teach or suggest the additional limitations recited in dependent claims 3–7, 21, and 23. *See* Pet. 28–32, 33–35 (citations omitted).

Patent Owner does not address substantively the limitations of dependent claims 3–7, 21, and 23 and Petitioner’s contentions addressing these claims. *See generally* Prelim. Resp. Nonetheless, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

For the purpose of this Decision and based on the record before us, Petitioner establishes sufficiently that the combination of Newman, Araki, and Trewin teaches or suggests each of the additional limitations recited in dependent claims 3–7, 21, and 23.

e. Summary

For all of the foregoing reasons, for the purpose of this Decision, and based on the current record before us, we determine there is a reasonable likelihood Petitioner would prevail in showing claims 1, 3–7, 20, 21, and 23–25 are unpatentable under 35 U.S.C. § 103 over Newman, Araki, and Trewin.

2. Proposed Unpatentability of Claims 8–12 over Newman, Araki, Trewin, and Ronkainen

a. Overview of Ronkainen (Ex. 1006)

Ronkainen discloses a device and method of using a single button instead of multiple buttons to accomplish more than one functionality, where a long press of a button is used to perform a different function from a short press of the button. *See* Ex. 1006, 1:12–15, 2: 26–27, 2:36–39. The invention includes describing for the user one of a plurality of possible alternative actions that can be caused by a button that is currently being operated. *See id.* at 2:26–30, 2:39–40. Users are often unaware of their options, especially when a function is rarely used. *See id.* at 1:48–49.

The device includes a button and a sensor for sensing when the button is pressed. *See id.* at 4:59–61, Fig. 2. The sensor reports both the pressing of the button and the release of the button to a timer, which passes the information to a processing unit. *See id.* at 4:61–64, Fig. 2. The processing unit also controls a user display and the means for making the functions occur depending on when the button is released. *See id.* at 4:64–5:3, Fig. 2.

Figure 1 of Ronkainen is reproduced below.

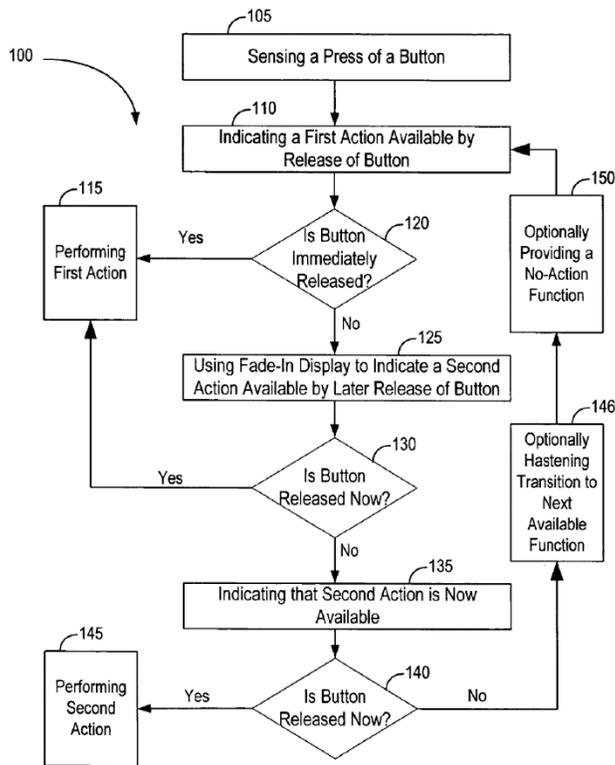


Figure 1 depicts a flowchart of a method for providing information regarding operation of a button on a device. *See Ex. 1006, 4:3–4, 4:12–14.* When a user presses the button, the device senses the button is pressed in step 105. *See id.* at 4:16–17. In step 110, the device provides information to the user during operation of the button that indicates a first action that the device can perform if the button were to be immediately released. *See id.* at 4:17–21. If the user immediately releases the button in step 120, the first action is

performed in step 115. *See id.* If the button is not immediately released by the user in step 120, in step 125 the display shows to the user a second action that will be later available by releasing the button. *See id.* at 4:21–24. If the button is released in step 130 before the second action becomes available, the first action is performed in step 115. *See id.* at 4:24–25. If the button is not released in step 130, an indication is provided in step 135 notifying the user that the second action is now available. *See id.* at 4:25–27. If the user releases the button in step 140 after the second action becomes available, the second action is performed in step 145. *See id.* at 4:27–29. The user may decide at step 140 not to release the button and instead wait for another action or actions become available. *See id.* at 4:29–31. The user may hasten the availability of another action in step 146, for example, by exerting extra pressure on the button. *See id.* at 4:32–33. The other action can optionally be a no-action function in step 150, or optionally be the first action 110. *See id.* at 4:34–36. Instead of waiting for a no-action function in step 150, it is also possible for the user to release the button, while avoiding any actions, by making a sound if the device is capable of audio recognition. *See id.* at 4:39–42. The user has the option to skip to the next functionality without having to wait for a time-out by pressing the button with extra pressure or saying a word, such as “skip,” if the device has audio recognition capability. *See id.* at 3:26–3:32.

b. Analysis

For the purpose of this Decision and based on Petitioner’s identified disclosures of Newman, Araki, Trewin, Ronkainen, and Mr. Schmandt’s supporting testimony (Ex. 1002), we are persuaded for the reasons provided below that Petitioner establishes sufficiently that the combination of

Newman, Araki, Trewin, and Ronkainen teaches or suggests all of the limitations recited in dependent claims 8–12.

Dependent Claim 8

Claim 8 depends from claim 1 and further recites:

wherein said one or more configurable timing parameters comprise a lower threshold time and an upper threshold time, and wherein said comparison of said duration of said activation of said interface element with said one or more configurable timing parameters by said application comprises comparing said duration of said activation of said interface element with said lower threshold time and said upper threshold time.

Ex. 1001, 27:55–63.

For the purpose of this Decision and based on the record before us, Petitioner establishes sufficiently that the combination of Newman, Araki, Trewin, and Ronkainen teaches and renders obvious the additional limitations recited in dependent claim 8. Petitioner asserts that the combination of Newman, Araki, and Trewin teach a configurable timing parameter in the form of a duration of time (e.g., one second) used to determine whether to select a push-to-talk mode or a tap-to-start mode. *See* Pet. 43 (incorporating by reference Pet. 17–21). Petitioner contends that the duration of the timing parameter could also be configured using Trewin’s techniques based on the user’s interaction with Newman’s application button. *See id.* Petitioner implicitly acknowledges that the combination of Newman, Araki, and Trewin does not teach two configurable timing parameters, a lower threshold time, and an upper threshold time, as required by dependent claim 8. *See id.* at 43–44. Petitioner asserts that Ronkainen teaches a lower threshold time and an upper threshold time based on Ronkainen’s disclosure of a time duration associated with a quick button

press and release (e.g., the time between steps 105 and 120 in Figure 1) and a time duration associated with a time-out of “short-press functionality” (e.g., after the time between steps 105 and 134 in Figure 1 has elapsed). *See id.* at 44–46 (reproducing Ex. 1006, Fig. 1 (with annotations); quoting Ex. 1006, 2:42–45, 2:48–50; citing Ex. 1006, 3:15–18, 4:60–5:3, 5:12–25; Ex. 1002 ¶ 181).

For the purpose of this Decision and based on Petitioner’s citations to Newman, Araki, Trewin, Ronkainen and Mr. Schmandt’s supporting testimony (Ex. 1002), we are persuaded Petitioner sets forth sufficient articulated reasoning with rational underpinning to support the conclusion that it would have been obvious to one of ordinary skill in the art to modify the combined teachings of Newman, Araki, and Trewin to include a lower threshold time and upper threshold time, as taught by Ronkainen such that Newman’s communication device, as modified to include the single-button tap-to-start and push-to-talk teachings of Araki, would initiate a tap-to-start communication mode in response to a quick tap (e.g., under 100 ms) of the respond button or initiate a push-to-talk communication mode in response to pressing the respond button for a longer duration (e.g., 1 second or longer) in order to provide multiple functions for a single button and during an intermediate time interval inform the user what will happen if the button continues to be pressed (i.e., push-to-talk recording mode). *See* Pet. 47–49 (quoting Ex. 1006, 1:27–31, 1:40–48, 3:1–7; citing Ex. 1005 ¶ 25; Ex. 1002 ¶¶ 183–187). Petitioner reproduces Ronkainen’s explanation that the utilization of a few buttons on a limited interface is enhanced by separating a short press of a button from a longer duration press. *See id.* at 48–49 (quoting Ex. 1006, 1:27–31). Petitioner further reproduces Ronkainen’s

explanation that when the function resulting from a long key press is not obvious, or is a hidden feature of the interface, the feature may be left unused or the user may have to guess what will happen. *See id.* at 49 (quoting Ex. 1006, 1:40–48). Petitioner also reproduces Ronkainen’s explanation that the long-press presentation give information about what the extra functionality is, which can be important in user interfaces where it is unclear what happens, and which can happen in some cases when the button count is extremely limited (e.g. only one button). *See id.* (quoting Ex. 1006, 3:1–7). Petitioner contends that the concerns expressed in Ronkainen are echoed in Araki, which discusses issues when a user may not understand how the recording button operates. *See id.* (citing Ex. 1005 ¶ 25).

Patent Owner does not address substantively the limitations of dependent claim 8 and Petitioner’s contentions regarding claim 8. *See generally* Prelim. Resp. Nonetheless, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

For the foregoing reasons and for the same reasons as those explained above in Section II.F.1.d with respect to claim 1, for the purpose of this Decision and based on the record before us, there is a reasonable likelihood Petitioner would prevail in showing dependent claim 8 is unpatentable under 35 U.S.C. § 103 over Newman, Araki, Trewin, and Ronkainen.

Dependent Claims 9–12

Claims 9–12 depend from claim 8, and ultimately depend from claim 1. We have reviewed Petitioner’s additional contentions and supporting evidence addressing how the combination of Newman, Araki, Trewin, and Ronkainen teaches and renders obvious the additional limitations recited in dependent claims 9–12. *See* Pet. 53–56 (citations

omitted). Patent Owner does not substantively address the limitations of dependent claims 9–12. *See generally* Prelim. Resp. Nonetheless, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

For the purpose of this Decision and based on the record before us, Petitioner establishes sufficiently that the combination of Newman, Araki, Trewin, and Ronkainen teaches or suggests each of the additional limitations recited in dependent claims 9–12.

c. Summary

For all of the foregoing reasons, for the purpose of this Decision, and based on the current record before us, we determine there is a reasonable likelihood Petitioner would prevail in showing dependent claims 8–12 are unpatentable under 35 U.S.C. § 103 over Newman, Araki, Trewin, and Ronkainen.

3. Proposed Unpatentability of Claims 13–17, 19, and 26 over Newman, Araki, and Ronkainen

a. Analysis

For the purpose of this Decision and based on Petitioner’s identified disclosures of Newman, Araki, Ronkainen, and Mr. Schmandt’s supporting testimony (Ex. 1002), we are persuaded for the reasons provided below that Petitioner establishes sufficiently that the combination of Newman, Araki, and Ronkainen teaches or suggests all of the limitations recited in independent claims 13 and 26, and claims 14–17, and 19 which depend from claim 13.

Independent Claim 13

(a) A computer implemented method for determining a communication mode, comprising:

Petitioner contends that, to the extent the preamble is limiting, the recited method is taught by, or obvious over Newman, Araki, and Ronkainen, as explained with respect to the limitations recited in the body of claim 13. *See* Pet. 56. Patent Owner does not dispute Petitioner's assertions addressing the preamble. *See generally* Prelim. Resp. Nonetheless, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378. Based on the current record, regardless of whether the preamble is limiting, we are persuaded Petitioner has shown adequately for the purpose of institution that the combined prior art discloses a computer implemented method for determining a communication mode, as recited in claim 13.

(b) detecting activation of an interface element by an application on a communication device;

Petitioner asserts that Newman, teaches this limitation for the same reasons as those addressed by Petitioner with respect to the identical limitations of claim 1. *See* Pet. 56–57 Patent Owner does not dispute Petitioner's assertions addressing these limitations. *See generally* Prelim. Resp. Nonetheless, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

(c) determining by said application, using an input device of said communication device, one of a presence and an absence of a media signal in proximity of said communication device, during and/or after said activation of said interface element; and

(d) selecting, in response to said detection of said activation of said interface element, one of a plurality of communication modes by said application based on said determination of said one of said presence and said absence of said media signal.

Petitioner acknowledges implicitly that Newman and Araki do not teach determining the presence or absence of a media signal in proximity of said communication device during and/or after user interface activation and, in response to detecting user interface activation, selecting a communication mode based on the determination of the presence or absence of the media signal. *See* Pet. 56–58. Petitioner incorporates by reference its analysis for claims 1, 8, 10, and 11. *See id.* (citing Ex. 1002 ¶¶ 214, 217). Petitioner points out that both Newman and Araki disclose communication devices with microphones. *See id.* at 57 (citing Ex. 1003, 10:50–55, 12:10–17; Ex. 1005 ¶¶ 50–51, Fig. 1:3). Petitioner asserts that Ronkainen discloses a microphone input device used to input the voice of a user in close proximity to the communication device. *See id.* (quoting Ex. 1006, 3:32–33, 6:33–34) Petitioner further asserts that Ronkainen teaches a skipping effect that allows a user to skip to the long press functionality without having to wait for the time out interval for the current function using audio recognition capability to monitor for audio input. *See id.* at 50–51 (citing Ex. 1006 3:27–33, 6:29–34 (claims 6 and 7); *see also id.* 55 (“Ronkainen discloses a ‘skipping effect’ that uses audio recognition (i.e., ‘**a presence...of a media signal**’) to skip-to a second function before a time-out associated with a first function elapses.”).

For the purpose of this Decision and based on Petitioner’s citations to Newman, Araki, Ronkainen, and Mr. Schmandt’s supporting testimony (Ex. 1002), we are persuaded Petitioner sets forth sufficient articulated reasoning with rational underpinning to support the conclusion that it would have been obvious to one of ordinary skill in the art to modify the combined teachings of Newman, and Araki to include determining the presence or absence of a media signal and selecting a communication mode based on the presence or absence of a media signal, as taught by Ronkainen in order to “allow[] brief messages to be retained, by detecting the input of voice as an immediate indication to skip to the push-to-talk (PTT) mode.” Pet. 51 (citing Ex. 1002 ¶ 188); *see KSR*, 550 U.S. at 418. Petitioner points out that in the tap-to-start (TTS) mode of Araki, in which the user presses and holds the microphone only for a short duration, the message recording does not begin until after the button is released. *See id.* at 50 (citing Ex. 1005 ¶ 71). Petitioner asserts that this creates a potential problem for recording brief voice messages, where the application interprets the user’s action as a short press and activates the tap-to-start mode, where the recording begins only after the button is released, thereby disregarding the brief message provided by the user. *See id.* (citing Ex. 1002 ¶ 188). According to Petitioner:

a skilled artisan would have recognized that Ronkainen’s technique would have improved Araki’s technique of selecting tap-to-start or push-to-talk by helping to resolve the usability issues that Araki expressly recognized, and would further Araki’s goal of “determin[ing] more appropriately the starting position and ending position of speech recognition, even when the timing with which the user presses the microphone button is inaccurate.”

Id. at 51–52 (quoting Ex. 1005 ¶ 89; citing Ex. 1002 ¶ 189).

Patent Owner does not dispute Petitioner’s contentions addressing the limitations of independent claim 13 that are not also recited in claim 1. *See* Prelim. Resp. 21–33. Nonetheless, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378. For the same reasons as those explained above with respect to claim 1, Patent Owner’s arguments regarding evidence of secondary considerations are insufficiently developed at this stage of the proceeding to have sufficient weight to preclude a determination that Petitioner demonstrates a reasonable likelihood of success on this challenge to patentability.

(e) Summary

For all of the foregoing reasons, for the purpose of this Decision and based on the record before us, there is a reasonable likelihood Petitioner would prevail in showing claim 13 is unpatentable under 35 U.S.C. § 103 over Newman, Araki, and Ronkainen.

Independent Claim 26

Petitioner asserts that the limitations of independent claim 26 are substantially identical to the limitations of claim 13. *See* Pet. 63 (citing Ex. 1002 ¶¶ 230–231). Petitioner asserts that claim 26 recites determining “presence and an absence of a media signal input into said communication device,” whereas claim 13 recites determining “presence and an absence of a media signal in proximity of said communication device.” *See id.* Petitioner contends that these differences in claim limitations are not meaningful because a skilled artisan would have understood that the media signal of Ronkainen would be input into the device. *See id.* (citing Ex. 1002 ¶ 232).

We have reviewed Petitioner's contentions and supporting evidence addressing how Newman, Araki, and Ronkainen, as combined by Petitioner, teach or suggest the limitations of independent claim 26. *See* Pet. 63.

Moreover, Patent Owner does not address substantively the limitations of independent claim 26 and Petitioner's contentions regarding claim 26. *See generally* Prelim. Resp. Nonetheless, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

For the same reasons as those addressed above for claim 13, for the purpose of this Decision and based on the record before us, there is a reasonable likelihood Petitioner would prevail in showing independent claim 26 is unpatentable under 35 U.S.C. § 103 over Newman, Araki, and Ronkainen.

Dependent Claims 14–17 and 19

Claims 14–17 and 19 depend from independent claim 13. Ex. 1001, 28:35–52, 28:57–61. We have reviewed Petitioner's contentions and supporting evidence addressing how the combination of Newman, Araki, and Ronkainen teach or suggest the additional limitations recited in dependent claims 14–17 and 19. *See* Pet. 58–63 (citations omitted). Patent Owner does not substantively address the limitations of dependent claims 14–17 and 19 and Petitioner's contentions addressing these claims. *See generally* Prelim. Resp. Nonetheless, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378.

For the purpose of this Decision and based on the record before us, Petitioner establishes sufficiently that the combination of Newman, Araki, and Trewin teaches or suggests each of the additional limitations recited in dependent claims 14–17 and 19.

b. Summary

For all of the foregoing reasons, for the purpose of this Decision, and based on the current record before us, we determine there is a reasonable likelihood Petitioner would prevail in showing independent claims 13 and 26 and dependent claims 14–17 and 19 are unpatentable under 35 U.S.C. § 103 over Newman, Araki, and Ronkainen.

III. CONCLUSION

For the foregoing reasons, we determine there is a reasonable likelihood that Petitioner would prevail in showing at least one of the challenged claims of the '159 Patent is unpatentable. Additionally, we decline to exercise our discretion under 35 U.S.C. §§ 314(a), 325(d) to deny either of the proposed challenges to patentability.

Our factual findings, conclusions of law, and determinations at this stage of the proceeding are preliminary, and based on the evidentiary record developed thus far. At this stage of the proceeding, the Board has not made a final determination as to the patentability of any challenged claim. Our final decision will be based on the record as fully developed during trial.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1, 3–17, 19–21, and 23–26 of the '159 Patent is instituted with respect to all challenges to patentability set forth in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of the '159 Patent shall commence

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on the entry date of this Order, and notice is hereby given of the institution
of a trial.

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