

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

INTERNATIONAL BUSINESS MACHINES CORPORATION,  
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,  
Patent Owner.

---

Case IPR2015-00089  
Patent 6,546,002 B1

---

Before GREGG I. ANDERSON, JON B. TORNQUIST, and  
ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

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

## INTRODUCTION

### A. *Background*

International Business Machines Corporation (“Petitioner”) filed a Petition (Paper 2, “Pet.”) pursuant to 35 U.S.C. §§ 311–319 to institute *inter partes* review of claims 1–24 of U.S. Patent No. 6,546,002 (“the ’002 patent,” Ex. 1004). Intellectual Ventures II LLC (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Based on these submissions, on April 27, 2015, we granted the Petition and instituted trial for claims 1, 2, 4, 6–12, 14, and 16–24 of the ’002 patent. Paper 8 (“Institution Decision” or “Dec. Inst.”).

After institution of trial, Patent Owner filed a Patent Owner Response. Paper 19 (“PO Resp.”). Petitioner filed a Reply. Paper 27 (“Pet. Reply”). In addition, the parties rely upon expert testimony. Petitioner proffered the Declaration of Henry Lieberman (“Lieberman Declaration,” Ex. 1001). Patent Owner proffered the Declaration of Dr. Tim Williams (“Williams Declaration,” Ex. 2005). A transcript of the deposition of Dr. Williams (“Williams Dep.,” Ex. 1032) was submitted by Petitioner. A transcript of the deposition of Mr. Lieberman (“Lieberman Dep.,” Ex. 1026) taken by Patent Owner was filed as an exhibit by Petitioner.

Patent Owner filed a Motion to Exclude Under 37 C.F.R. § 42.64(c) (“Motion,” “Mot.,” Paper 32). Petitioner filed an Opposition to Patent Owner’s Motion to Exclude (“Opposition,” “Opp.,” Paper 37), and Patent Owner filed a Reply to the Opposition to Motion (“Reply to Opposition,” “PO Reply,” Paper 38). The Motion is denied for the reasons set out below.

An oral hearing was held on January 15, 2016. The transcript of the consolidated hearing for this case and IPR 2015-00092 has been entered into the record. Paper 43 (“Tr.”).

IPR2015-00089

Patent 6,546,002 B1

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a). We conclude for the reasons that follow that Petitioner has shown by a preponderance of the evidence that claims 1, 2, 4, 6–12, 14, and 16–24 of the '002 patent are unpatentable.

*B. Related Proceedings*

Petitioner advises us that Patent Owner (“IV” in the case listing that follows) has asserted the '002 patent in the following seven patent infringement lawsuits, none of which name Petitioner as a defendant: (1) *IV v. PNC Fin. Servs. Grp., Inc.*, 2:13-cv-00740 (W.D. Pa.); (2) *IV v. Capital One Fin. Corp.*, 8:14-cv-00111 (D. Md.); (3) *IV v. PNC Fin. Servs. Grp., Inc.*, 2:14-cv-00832 (W.D. Pa.); (4) *IV v. Citigroup, Inc.*, 1:14-cv-04638 (S.D.N.Y.); (5) *IV v. Erie Indem. Co.*, 1:14-cv-00220 (W.D. Pa.); (6) *IV v. Old Republic Gen. Ins. Grp., Inc.*, 2:14-cv-01130 (W.D. Pa.); and (7) *IV v. Highmark, Inc.*, 2:14-cv-01131 (W.D. Pa.). Pet. 1. Petitioner also filed a separate petition for an *inter partes* review of claims 25–49 of the '002 patent.<sup>1</sup> *Id.*

*C. The '002 Patent*

The '002 patent describes a system and method for using a mobile interface agent to access information of a user. Ex. 1004, Abstract. The '002 patent describes using a mobile interface agent that allows a user to “access documents, files, programs, applications, URL bookmarks, IP addresses, telephone numbers, television channels, radio stations, and other

---

<sup>1</sup>The co-pending petition is IPR2015-00092.

menu items from any computer.” *Id.* The information accessed is specific to the user. *Id.*

Figure 15 of the '002 patent is reproduced below:

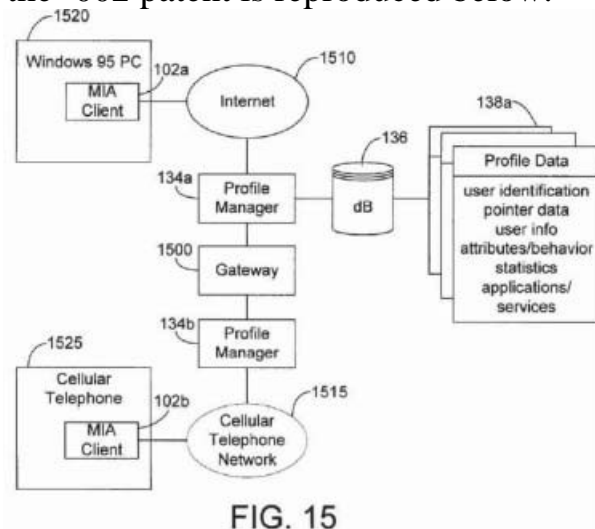


Figure 15 is a block diagram showing profile managers of multiple communication networks connected by a gateway. Ex. 1004, 5:41–44. Figure 15 shows Mobile Interface Agent (“MIA”) 102a running on a Windows 95 PC and MIA 102b running on a cellular telephone. *Id.* at 16:36–54. The MIA of the '002 patent allows access to “[a user’s] menu items (e.g., software programs, applications, files, folders, documents, telephone numbers, radio stations, and television channels), URL bookmarks, and user profile data.” *Id.* at 5:58–61.

The MIA may also “periodically update or query user profile data, facilitate the sharing of memory and data structures between applications/services both local and remote, allow various types of user interfaces to be attached (voice menu system, human-like graphical icon, etc.) and perform intelligent multi-platform conversion of application data.” Ex. 1004, 5:62–67. The MIA “can be accessible using any computer from any geographical location so long as the computer can be connected to a network.” *Id.* at Abstract. For example, “[t]he mobile interface agent can be accessible

IPR2015-00089

Patent 6,546,002 B1

using a computer, cable set top box, cellular phone, or other device from any geographical location.” *Id.* at 4:44–46.

The ’002 patent further explains that, during the process of initializing and creating a MIA, “MIA 102 downloads the appropriate information such as user profile, URL links, applications registered, etc. Some of the information downloaded may depend on the platform, geographical location, etc. that corresponds to the user’s connection location.” Ex. 1004, 14:50–54. “For example, if a user has purchased a Windows 98 only license for MS Word and moved to an Apple MacOS device, then the MS Word menu item may be disabled or not downloaded.” *Id.* at 14:54–57.

Figure 1B is reproduced below:

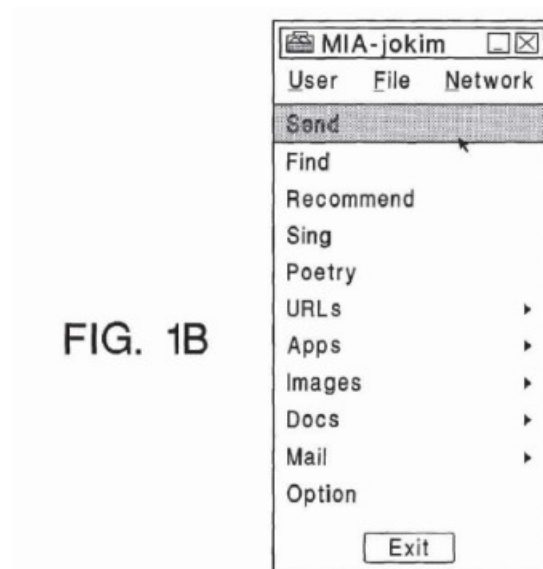


Figure 1B illustrates a menu used by the MIA once a user has logged on to the computer. *Id.* at 5:1–3. The set of menu items included in a MIA are “associated with a user’s specific configuration and profile.” *Id.* at 14:33–34. The “menu items/pointers shown in the user interface can be used to access and retrieve user specific resources and information.” *Id.* at 6:14–16.

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.