UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MICROSOFT CORPORATION,
Petitioner,

v.

MIRA ADVANCED TECHNOLOGY, INC.,
Patent Owner.

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Case IPR2017-01052
Patent 8,848,892 B2

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Before MINN CHUNG, MICHELLE N. WORMMEESTER, and
KAMRAN JIVANI, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

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

I. INTRODUCTION

In this *inter partes* review, instituted pursuant to 35 U.S.C. § 314, Microsoft Corporation ("Petitioner") challenges the patentability of claims 1–10 (the "challenged claims") of U.S. Patent No. 8,848,892 B2 (Ex. 1001, "the '892 patent"), owned by Mira Advanced Technology Systems, Inc. ("Patent Owner"). The Board has jurisdiction under 35 U.S.C. § 6. This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. With respect to the grounds of unpatentability asserted by Petitioner, we have considered the papers submitted by the parties and the evidence cited therein. For the reasons discussed below, we determine Petitioner has shown by a preponderance of the evidence that claims 1–10 of the '892 patent are unpatentable.

II. BACKGROUND

A. *Procedural History*

On March 9, 2017, Petitioner filed a Petition (Paper 2, "Pet.") requesting an *inter partes* review of claims 1–10 of the '892 patent. Patent Owner filed a Corrected Preliminary Response. Paper 9 ("Prelim. Resp."). On September 22, 2017, we instituted an *inter partes* review of claims 1–10 of the '892 patent. Paper 11 ("Dec. on Inst."), 33.

After institution, Patent Owner filed a Patent Owner Response (Paper 16, "PO Resp."), to which Petitioner filed a Reply (Paper 19, "Pet. Reply").[1] An oral hearing was held on June 21, 2018. A transcript of the hearing is included in the record as Paper 30 ("Tr.").

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[1] With our permission, Patent Owner and Petitioner each filed an errata to their Patent Owner Response and Reply, respectively. Paper 29 (Errata to Patent Owner's Response); Paper 27 (Errata to Petitioner's Reply).

B. Related Proceedings

According to the parties, the '892 patent is the subject of the following proceeding: *Mira Advanced Tech. Sys., Inc. v. Microsoft Corp.*, No. 2:16-cv-88 (N.D. W. Va.). Pet. 1; Paper 4, 2. Additionally, certain claims of U.S. Patent No. 9,531,657 B2, which is a continuation of the '892 patent, are at issue in IPR2017-01411.

C. The '892 Patent

The '892 patent describes a method for attaching memo data to a contact list entry and providing users reminders of conversation points. Ex. 1001, Abstract, 1:24–33. As background, the '892 patent describes that, because users sometimes forget important conversation points with their contacts, a need exists for a contact list that allows entering memos into contact list entries and provides reminders of a memo when communication is initiated with the contact associated with the memo. *Id.* at 1:13–20.

Figure 1 of the '892 patent is reproduced below.

Name	Address	Phone	Fax	Email	URL	Memo

Figure 1 shows the database structure of the contact list of the '892 patent. *Id.* at 1:37–38. As shown in Figure 1, the contact list consists of multiple contact list entries. *Id.* at 2:1–2.

Each contact list entry comprises data fields to input contact information details, such as contact name, address, phone number, and email address. *Id.* at 2:3–6. In addition, a data field is provided in each contact list

entry to input memo data associated with the contact entry. *Id.* at 2:6–8. In an exemplary embodiment, the data field for memo may be integrated with the contact list entry. *Id.* at 2:8–9. Alternatively, the memo data field can be stored in a separate database, and the memo and the corresponding contact list entry can be related by a link. *Id.* at 2:9–12.

According to the '892 patent, memo data is displayed when the associated contact list entry is activated, such as when the contact list entry is selected to initiate outgoing communication (e.g., the phone number of the contact is dialed), or when incoming communication is received (e.g., an incoming phone call from the contact is detected). *Id.* at 1:26–31, 2:17–24, Abstract. The display of memo data serves as a reminder of the desired topic of conversation or conversation points when communication is initiated with the contact. *Id.* at 2:27–29, 32–35. Memo data may also be displayed at the end of a phone call, and the user has an option to erase, save, or edit the memo data. *Id.* at 2:29–32.

D. Illustrative Claim

Of the challenged claims, claims 1 and 6 are independent. Claim 1 is illustrative of the challenged claims and is reproduced below:

> 1. A method, performed by a communication device, for reminding a user of the communication device of a conversation point for a future phone call, the communication device having a processor and a display screen, the communication device having access to a saved contact list having one or more contact list entries, each contact list entry of the contact list including a first field configured to retrieve a stored phone number of a corresponding entity of the respective contact list entry, a second field configured to retrieve a stored name identifying the corresponding entity, and a memo field configured to attach memo data inputted by the user and displayable to show at least

one memo which is served to remind the user of the conversation point for the future phone call between the user and the corresponding entity, the method comprising:

(a) receiving, by the processor, a first input indicating that an incoming phone call from the stored phone number of a first contact list entry of the saved contact list is received;

(b) checking, by the processor after step (a), whether there is memo data that is attached to the memo field of the first contact list entry;

(c) activating, by the processor, the first contact list entry such that during the activating of the first contact list entry, the user accepts the incoming phone call and conducts the incoming phone call with the corresponding entity of the first contact list entry using the communication device as a result of the user's accepting the incoming phone call; and

(d) causing, by the processor, a first indication indicating a presence of the at least one memo of the attached memo data, to be automatically displayed on the display screen during the activating of the first contact list entry, when it is detected in the step (b), by the processor, that there is memo data attached to the memo field of the first contact list entry.

Ex. 1001, 2:59–3:27.

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