

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*.

DECISION

Institution of *Inter Partes* Review  
35 U.S.C. § 314(a) and 37 C.F.R. § 42.108(a)

## I. INTRODUCTION

Microsoft Corporation (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1–10 (the “challenged claims”) of U.S. Patent No. 8,848,892 B2 (Ex. 1001, “the ’892 patent”). Mira Advanced Technology Systems, Inc. (“Patent Owner”) filed a Corrected Preliminary Response (Paper 9, “Prelim. Resp.”).

Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any response . . . 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); *see* 37 C.F.R. §§ 42.4, 42.108. For the reasons described below, we determine that Petitioner has established a reasonable likelihood of prevailing in showing the unpatentability of at least one challenged claim. Accordingly, we institute an *inter partes* review of claims 1–10 of the ’892 patent.

## II. BACKGROUND

### A. *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.

### B. *The ’892 Patent*

The ’892 patent describes a method for attaching memo data to a contact list entry. Ex. 1001, Abstract. 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 memo

into contact list entries and provides reminders of the 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 an exemplary embodiment, a data field is added to each contact list entry to input memo data associated with the contact entry. *Id.* at 2:6–9. 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.

### *C. 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.

*D. Asserted Prior Art and Grounds of Unpatentability*

Petitioner cites the following references in its challenges to patentability.

Reference and Relevant Date	Designation	Exhibit No.
U.S. Patent No. 7,130,617 B2 (issued Oct. 31, 2006)	Matsumoto <sup>1</sup>	Ex. 1004
European Patent Application Pub. No. EP 1739937 A1 (published Jan. 3, 2007)	Sony	Ex. 1005

Petitioner asserts the following grounds of unpatentability (Pet. 3):

Claims Challenged	Statutory Basis	Reference(s)
1–4 and 6–9	§ 103(a)	Matsumoto
1–10	§ 103(a)	Sony
1–10	§ 103(a)	Sony and Matsumoto <sup>2</sup>

Petitioner also relies on the Declaration of Peter Rysavy (Ex. 1002).

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<sup>1</sup> For clarity and ease of reference, we only list the first named inventor.

<sup>2</sup> As discussed below, in the purported ground based on Sony and Matsumoto, Petitioner in fact argues two separate grounds in the alternative—namely, one based on Sony alone and another based on the combination of Sony and Matsumoto.

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