

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

MIRA ADVANCED TECHNOLOGY, INC.,
Patent Owner.

Case IPR2017-01411
Patent 9,531,657 B2

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 1–12 (the “challenged claims”) of U.S. Patent No. 9,531,657 B2 (Ex. 1001, “the ’657 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 1–12 of the ’657 patent are unpatentable.

II. BACKGROUND

A. Procedural History

On May 10, 2017, Petitioner filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1–12 of the ’657 patent. Patent Owner filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). On December 1, 2017, we instituted an *inter partes* review of all the challenged claims of the ’657 patent based on all the grounds presented in the Petition. Paper 8 (“Dec. on Inst.”), 40.

After institution, Patent Owner filed a Patent Owner Response (Paper 24, “PO Resp.”), to which Petitioner filed a Reply (Paper 25,

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“Pet. Reply”).¹ An oral hearing was held on June 21, 2018. A transcript of the hearing is included in the record as Paper 36 (“Tr.”).

B. Related Proceeding

According to the parties, the ’657 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 3, 1. Additionally, U.S. Patent No. 8,848,892 B2, which is a predecessor to the ’657 patent, is the subject of IPR2017-01052, in which we issued a final written decision finding all challenged claims unpatentable. *See Microsoft Corp. v. Mira Advanced Tech. Sys., Inc.*, Case IPR2017-01052 (PTAB Sept. 19, 2018) (Paper 31).

C. The ’657 Patent

The ’657 patent describes a method for attaching memo data to a contact list entry. Ex. 1001, Abstract. As background, the ’657 patent describes that, because users sometimes forget important conversation points with their contacts, a need exists for a contact list that allows entering memo data into contact list entries and provides reminders of the memo data when communication is initiated with the contact associated with the memo data. *Id.* at 1:25–32.

¹ With our permission, Patent Owner and Petitioner each filed an errata to their Patent Owner Response and Reply, respectively. Paper 35 (Errata to Patent Owner’s Response); Paper 33 (Errata to Petitioner’s Reply).

Figure 1 of the '657 patent is reproduced below.

Name	Address	Phone	Fax	Email	URL	Memo

Figure 1 shows the database structure of the contact list of the '657 patent. *Id.* at 1:49–50. As shown in Figure 1, the contact list consists of multiple contact list entries. *Id.* at 2:14–15.

Each contact list entry comprises data fields to input contact information details, such as contact name, address, phone number, and email address. *Id.* at 2:16–17. 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 2:20–21.

According to the '657 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 1:38–43, 2:27–31, 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 2:37–39, 42–46. 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 2:39–42.

D. Illustrative Claim

Of the challenged claims, claim 1 is the only independent claim.

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 communication, the communication device having a processor and a display screen, the communication device having access to a memory storing a contact list having a list of contact list entries, each contact list entry of the contact list including a first field configured to retrieve a stored communication address 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 can be served to remind the user of a conversation point for a future communication between the user and the corresponding entity, the method comprising:

(a) receiving, by the processor, a first input indicating a need to activate a first contact list entry of the contact list for the user to perform at least one of receiving and requesting a communication addressed to the stored communication address of the first contact list entry;

(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 performs at least one of receiving, requesting, drafting and conducting the communication addressed to the communication address of the first contact list entry; 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

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