

United States Court of Appeals
for the Federal Circuit

ARENDI S.A.R.L.,
Appellant

v.

GOOGLE LLC, MOTOROLA MOBILITY LLC,
Appellees

2016-1249

Appeal from the United States Patent and Trademark
Office, Patent Trial and Appeal Board in No. IPR2014-
00452.

Decided: February 20, 2018

BRUCE D. SUNSTEIN, Sunstein Kann Murphy & Tim-
bers LLP, Boston, MA, argued for appellant. Also repre-
sented by ROBERT M. ASHER.

MATTHEW A. SMITH, Smith Baluch LLP, Washington,
DC, argued for appellees. Also represented by ROBERT J.
KENT, Turner Boyd LLP, Redwood City, CA.

Before NEWMAN, BRYSON, and MOORE, *Circuit Judges*.
NEWMAN, *Circuit Judge*.

The Petitioners Google LLC, Motorola Mobility LLC, and Samsung Electronics Co., Ltd. requested *inter partes* review of Claims 1-79 (all the claims) of U.S. Patent No. 6,323,853 (“the ’853 patent”) owned by Arendi S.A.R.L. (“Arendi”).¹ The Patent Trial and Appeal Board (“PTAB”) instituted review on the ground of obviousness, and after trial the PTAB held all of the claims unpatentable.² On Arendi’s appeal, we affirm the PTAB’s decision, based on the PTAB’s alternative claim construction.

Standards of Review

Claim construction and the determination of obviousness are questions of law, and review of the PTAB’s rulings thereon is *de novo*. *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 841–42 (2015); *Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1297 (Fed. Cir. 2015). Any underlying factual findings that draw on extrinsic evidence, such as dictionaries or treatises or expert testimony, are reviewed for support by substantial evidence in the record. *Teva*, 135 S. Ct. at 840–42; *Microsoft*, 789 F.3d at 1297; *see generally In re Gartside*, 203 F.3d 1305, 1315 (Fed. Cir. 2000) (following *Dickinson v. Zurko*, 527 U.S. 150, 152 (1999), and holding that the substantial evidence standard of the Administrative Procedure Act governs judicial review of PTO factual findings). Substantial evidence is “such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.” *Consol. Edison Co. of N.Y. v. NLRB*, 305 U.S. 197, 229 (1938).

¹ Samsung Electronics Co., Ltd. is not a party to this appeal.

² *Google Inc. v. Arendi S.A.R.L.*, No. IPR2014-00452, 2015 WL 4976582 (P.T.A.B. Aug. 18, 2015) (“PTAB Op.”).

The PTAB Erred in Its View of the Prosecution History

The '853 patent relates to a computerized method for identifying and substituting information in an electronic document. '853 patent at col. 2, ll. 5–25. The claims recite a method of information handling whereby information such as a name or address is identified in a document, a database is searched for related information, and the retrieved information is displayed and entered into the document, all on a single command from the user. Claim 1 is representative:

1. A computerized method for information handling within a document created using an application program, the document including first information provided therein, the method comprising:

providing a record retrieval program;

providing an input device configured to enter an execute command which initiates a record retrieval from an information source using the record retrieval program;

upon a single entry of the execute command by means of the input device:

analyzing the document to determine if the first information is contained therein, and

if the first information is contained in the document, searching, using the record retrieval program, the information source for second information associated with the first information; and

when the information source includes second information associated with the first information, performing at least one of,

(a) displaying the second information,

(b) inserting the second information in the document, and

(c) completing the first information in the document based on the second information.

The PTAB instituted *inter partes* review on the ground that the subject matter would have been obvious in view of U.S. Patent No. 5,923,848 (“Goodhand”), or in view of Goodhand in combination with Padwick *et al.*, “Using Microsoft Outlook 97” (Microsoft Press 1996) (“Padwick”).

Arendi argued to the PTAB that Goodhand does not show the claim limitation of the “single entry of the execute command,” and that this limitation was added to the claims during prosecution, in consultation with the examiner, in order to distinguish a cited reference, U.S. Patent No. 6,085,201 (“Tso”). While Goodhand was not cited during prosecution of the ’853 patent, Tso is similar to Goodhand and describes a system of information identification, search, retrieval, and insertion of found information into the document. *See Tso* at col. 2, ll. 7–30.

On October 17, 2000, the Arendi applicant held an interview with the examiner, during which

Applicant’s representative discussed the differences between the Tso and Borovoy references and the present invention. For instance, it was pointed out that in the Tso reference, the user must select the text string to be processed, whereas in the present invention, the user does not have to select the text string to be analyzed. Applicant’s representative may submit an After-Final Amendment that amends the independent claim to include this difference.

Interview Summary (Oct. 17, 2000) (J.A. 342).

On December 18, 2000, the applicant amended the claim that issued as claim 1 of the ’853 patent to require a

single entry execute command and analysis, as shown below with underlined text added by amendment:

upon a single entry of the execute command by means of the input device:

analyzing the document to determine if the first information is contained therein, and

if the first information is contained in the document, searching, using the record retrieval program, the information source for second information associated with the first information. . . .

Amendment Under 37 C.F.R. § 1.116 at 1–2 (Dec. 18, 2000) (J.A. 343–44). The Remarks accompanying the amendment included the following:

During the discussion [with the examiner on October 17, 2000], it was noted that columns 4–5 of Tso teach a user selecting a text string to be processed by clicking on the text string using various selection means. In this respect, the present invention does not require the user to select a text string to be processed since it functions automatically upon a single click of an input device, such as a button, menu item, etc.

Id. at 2–3 (J.A. 344–45) (underlining in original).

On January 2, 2001 the examiner wrote “Reasons for Allowance” that included the following statement:

[I]n Tso, the text string to be processed is determined by the current cursor position, as specified by the user [see col. 4, line 31 to col. 5, line 67], whereas the present invention “does not require the user to select the text string to be processed since it functions automatically upon a single click of an input device” to determine if the first information is contained within the document.

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