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JUSTIN LESKO			WHITTINGTON, KENNETH	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CBS INTERACTIVE INC., THE NEW YORK TIMES COMPANY,
G4 MEDIA, LLC, and BRAVO MEDIA LLC,
Third Party Requesters,

v.

HELFERICH PATENT LICENSING, LLC,
Patent Owner.

Appeal 2016-004880
Inter Partes Reexamination Control No. 95/002,016
Patent US 8,134,450 B2
Technology Center 3900

Before JOHN A. JEFFERY, BRADLEY W. BAUMEISTER, and
JONI Y. CHANG, *Administrative Patent Judges*.

BAUMEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

Patent Owner (“Owner”) appeals the Examiner’s rejections of claims 1, 3–8, 10–15, and 17–54. We have jurisdiction under 35 U.S.C. §§ 134 and 315.¹ We affirm in part.

¹ Because the request for *inter partes* reexamination was filed in the instant proceeding before September 16, 2012, the pre-Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011)(“AIA”), version of 35 U.S.C. §§ 134 and 315 applies.

BACKGROUND

This proceeding arose from a request for *inter partes* reexamination of U.S. Patent 8,134,450 B2 (issued to Richard J. Helferich on Mar. 13, 2012 from Application 12/367,358, filed Feb. 6, 2009) (“the ’450 Patent”), and which, according to Patent Owner (PO App. Br. 7), is assigned to Wireless Science, LLC and Helferich Patent Licensing, LLC. The *inter partes* reexamination request 95/002,016 (“Request”) was filed June 14, 2012 by CBS Interactive Inc., The New York Times Company, Best Buy Co., Inc., G4 Media, LLC, Bravo Media LLC, and Phoenix Newspapers, Inc. (“Requesters”).² See Request for *Inter Partes* Reexamination Transmittal Form.

Owner asserts that “[t]here are no related PTO appeals or interferences involving the ’450 patent” (PO App. Br. 7),³ but then includes with its appeal brief, “Appendix B: Related Cases and Orders Pursuant to 37 C.F.R. 41.37(c)(ii)” (setting forth a list of approximately thirteen completed and pending reexaminations, an *inter partes* review, and approximately 24 resolved, dismissed, or appealed litigations).

² After the Request was filed, Best Buy filed a Notice of Non-Participation on July 27, 2012. Phoenix Newspapers filed a Notice of Non-Participation on June 25, 2013. CBS Interactive filed a Notice of Non-Participation on August 25, 2015. The New York Times filed a Notice of Non-Participation on October 30, 2015. G4 Media and Bravo Media filed a Notice of Non-Participation on December 1, 2015.

³ In addition to the above-noted Request, we also refer to various other documents throughout this Opinion, including (1) the Right of Appeal Notice, mailed Apr. 27, 2015 (“RAN”), which is incorporated by reference into the Examiner’s Answer, mailed October 23, 2015; and (2) the Appeal Brief by Patent Owner Appellant, filed July 27, 2015 (“PO App. Br.”).

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For reasons explained in more detail below, one particularly relevant related proceeding that was previously decided by this Panel is Appeal 2015-005486 in *inter partes* reexamination 95/001,867 (“the ’5486 Appeal”). This reexamination arose from a request by Requesters for an *inter partes* reexamination of U.S. Patent 7,499,716 B2 (issued to Richard J. Helferich on Mar. 3, 2009 from Application 11/399,513, filed Apr. 7, 2006).

We review the presently appealed rejections for error based upon the issues identified by Appellants, and in light of the arguments and evidence produced thereon. *See Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)).

Joint oral argument was held on November 15, 2016 for this appeal, as well as for related appeal 2016-005652 (taken from the *inter partes* reexamination 95/001,984 of U.S. Patent 7,835,757 B2). The combined hearing transcript will be entered into the record in due course.

THE INVENTION, APPEALED CLAIMS, AND REJECTIONS

The ’450 Patent describes the invention as follows:

Methods and systems that provide content to subscribers via wireless transmission by initiating a page that does not automatically provide associated content. The content provider conserves air time by not automatically transmitting the content. The information content may be of different types, such as voice, text, audio, or even video, and may be dynamic. In addition to the aforementioned, the content provider may provide to subscribers via wireless transmission songs or video clips or updates on weather or stock rates.

Abstract.

Independent claim 1, which is illustrative of the appealed claims, reads as follows with our emphasis added:

1. A method of providing content to a cell phone comprising:
a content provider causing the content to be stored in an internet accessible storage unit;

the content provider initiating a page to a content subscriber, the page including a notification that: (i) identifies the content, and (ii) includes an address of a system to be contacted to trigger retrieval of the content, but does not include the content;

wherein the page indicates that the content is available for a specified time; and

the content provider causing the content identified by the notification to become inaccessible at the internet accessible storage unit after the specified time identified by the initiated page.

Claims 1, 3–8, 10–15, and 17–54 are the subject of this appeal.

PO App. Br. 7. Claims 2, 9, and 16 are not subject to reexamination. *Id.*

The Examiner rejected all of the appealed claims as obvious under 35 U.S.C. § 103(a) based upon approximately twenty-one proposed grounds of rejection. RAN 18–49. The Examiner also rejected claim 54 under 35 U.S.C. § 112, ¶ 1, for lacking adequate written description. RAN 50–51. We address the obviousness and written-description rejections separately.

I.

The Examiner rejects newly added claim 54 under 35 U.S.C. § 112, ¶ 1, for lacking adequate written description. RAN 50. Owner acknowledges this rejection (PO App. Br. 7), but does not present any arguments or challenge the rejection (*see generally* PO App. Br). Accordingly, we summarily affirm this § 112, ¶ 1, rejection of claim 54.

II.

Summary

Appealed claims 1, 3–8, 10–15, and 17–54 are all rejected as obvious under 35 U.S.C. § 103. Rather than reproduce all twenty-one of the appealed obviousness rejections individually, we reference pages 1–49 of the RAN for the details and reasoning. To summarize, though, each of the twenty-one obviousness rejections is based, in part, on Furuta (JP H8-181781; published July 12, 1996). *See* PO App. Br. 10. For the reasons set forth below, we find Owner’s arguments regarding Furuta to be persuasive. We, therefore, do not sustain any of the twenty-one obviousness rejections of the appealed claims.

Contentions

Turning to the merits, the Examiner relies upon Furuta for teaching the limitation of independent method claim 1, “wherein the page [to a content subscriber] indicates that the content is available for a specified time.” The Examiner likewise relies on Furuta for teaching the similar language of independent system claim 15, which is the only other independent claim, “the notification indicating that the digital content is available for a specified time.”

More specifically, the Examiner finds that the claimed content provider reads on Furuta’s service management station 2. RAN 21. The Examiner notes that Furuta’s service management station 2 transmits a date and time stamp to a cellular phone, referred to as Personal Handy Phone System (PHS) terminal 6. *Id.* (citing Furuta ¶ 38). The Examiner notes that Furuta further discloses a retention period during which the content is available, and

states that “[a]t the end of the retention period, the service management station 2 deletes the voicemail unless the user indicates that the message should be retained.” *Id.* at 22 (citing Furuta ¶ 41). The Examiner also reasons that

when the PHS terminal 6 receives the reception date and time of a voicemail, as disclosed, for example, in ¶38 of Furuta, the PHS terminal 6 also knows the time that the content (voicemail) is available 10 because the PHS terminal also knows when the voicemail will be deleted (i.e., the retention expiration date as disclosed in Furuta ¶38, and Figure 13 below).

RAN 22.

The Examiner then concludes that “the reception notification message sent from the service management station to the PHS terminal specifies a time (reception date and time) that indicates a time period (retention period) during which the content (voicemail) is available at the service management station.” *Id.*

Owner contends that Furuta fails to teach this specified-time limitation of independent claim 1. PO App. Br. 13–20, 52, and 53. Among other contentions, Owner asserts that “in Furuta, each *user’s* handset determines when the content (a user’s voicemail) is to become inaccessible. In contrast, in Helferich, it is the *content provider* that determines and dictates to the users in the paging notification when the content (e.g., breaking news story) will no longer be available.” PO App. Br. 14. *See also* PO App. Br. 52:

[T]he “retention period” as well as all the other data shown in [Furuta’s] Figure 13 is not a signal sent from the system, but instead is a message from the handset. The information in Furuta’s Figure 13 is generated and managed solely by the handset, never sent from the system.

Analysis

The Examiner appears to be interpreting independent claims 1 and 15 as requiring that the page initiated by the content provider merely needs to specify the time for which the content is available. However, claim 1, for example, instead requires that “the page indicates that the content is available *for* a specified time” (emphasis added). Claim 15 similarly requires “the notification indicating that the digital content is available *for* a specified time” (emphasis added). Furuta’s transmission of a date-and-time stamp may well satisfy the Examiner’s interpretation, but this date-and-time-stamp transmission does not satisfy the present claims’ actual language, which requires some indication that the availability is for some specified *duration*. That is, a page merely indicating when the content is sent does not constitute the page indicating that the content is available *for* a specified time.

We note for completeness that this Panel previously has addressed Furuta’s teachings in various ones of Owner’s related appeals. For example, in our Final Decision of the 2015-005486 Appeal, this Panel affirmed the obviousness rejections of claims 22, 23, 38, 39, 90, 91, 105, 106, 114, 115, 142, 143, 157, 158, 169, 184, and 185, all of which were based, in part, on Furuta. *See CBS Interactive Inc., The New York Times Company, G4 Media, LLC, and Bravo Media LLC, v. Helferich Patent Licensing, LLC*, Appeal No. 2015-005486 at 37–41 (PTAB, May 24, 2016). However, unlike the above-noted language of the present appeal’s claims, the cited claims of the ’5486 Appeal alternatively recited “the notification specifies a time that the content is available” (*see, e.g.*, Appeal ’5486, claim 22), or something

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similar thereto (*see, e.g.*, Appeal '5486, claim 142, (reciting “wherein the paging data signal specifies a time that the content is available”)).

CONCLUSIONS

For the reasons set forth above, we summarily sustain the written description rejection of claim 54. We do not sustain any of the adopted obviousness rejections of claims 1, 3–8, 10–15, and 17–54.

DECISION

The Examiner’s decision rejecting claim 54 is affirmed.

The Examiner’s decision rejecting claims 1, 3–8, 10–15, and 17–53 is reversed.

In the event neither party files a request for rehearing within the time provided in 37 C.F.R. § 41.79, and this decision becomes final and appealable under 37 C.F.R. § 41.81, a party seeking judicial review must timely serve notice on the Director of the United States Patent and Trademark Office. *See* 37 C.F.R. §§ 90.1 and 1.983.

AFFIRMED-IN-PART

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