

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.,
Petitioner,

v.

KAMATANI CLOUD, LLC,
Patent Owner.

Case IPR2017-01370
Patent 6,873,940 B1

Before MELISSA A. HAAPALA, *Acting Vice Chief Administrative Patent Judge*, DAVID C. MCKONE, and BARBARA A. PARVIS, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

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

I. INTRODUCTION

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. The evidentiary standard is a preponderance of the evidence. *See* 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). For the reasons that follow, we determine that Unified Patents Inc. (“Petitioner”) has not shown by a preponderance of the evidence that claims 1, 2, 5, 7–13, 15–18, 21, 23–28, 30–32, 34, 35, and 38–41 of U.S. Patent No. 6,873,940 B1 (Ex. 1001, “the ’940 Patent”) are unpatentable.

A. *Background*

Petitioner filed a Petition (Paper 1, “Pet.”) to institute an *inter partes* review of claims 1, 2, 5, 7–13, 15–18, 21, 23–28, 30–32, 34, 35, and 38–41 (“the challenged claims”) of the ’940 Patent.¹ Kamatani Cloud, LLC (“Patent Owner”) filed a Preliminary Response. Paper 9 (“Prelim. Resp.”). Pursuant to 35 U.S.C. § 314, we instituted trial on the challenged claims and grounds. Paper 10 (“Inst. Dec.”).

After institution of trial, Patent Owner filed a Patent Owner Response (Paper 13, “PO Resp.”), to which Petitioner filed a Reply (Paper 17, “Pet. Reply”). Patent Owner filed a Motion for Observations (Paper 21, “Mot.”) and Petitioner filed a Response (Paper 27). A transcript of the

¹ Petitioner omits claim 16 from certain listings of challenged claims (*see, e.g.,* Pet. 1, 4), but Petitioner provides contentions challenging claim 16 (*see, e.g., id.* at 4, 62–63, 74). Accordingly, as stated in the Institution Decision, we treat Petitioner’s omission of claim 16 as a typographical error. *See* Inst. Dec. 2 n.2.

hearing held on June 25, 2018, has been entered into the record as Paper 29 (“Tr.”).

B. Related Matters

The parties state that the ’940 Patent was asserted in *Kamatani Cloud LLC v. Animetrics, Inc.*, No. 1:16-cv-05492 (SDNY), which was terminated September 12, 2016. Pet. 2; Paper 5, 2.

C. The ’940 Patent

The ’940 Patent is directed to a measurement service system for carrying out remote measurements. Ex. 1001, 1:7–11. Figure 3 of the ’940 Patent is reproduced below.

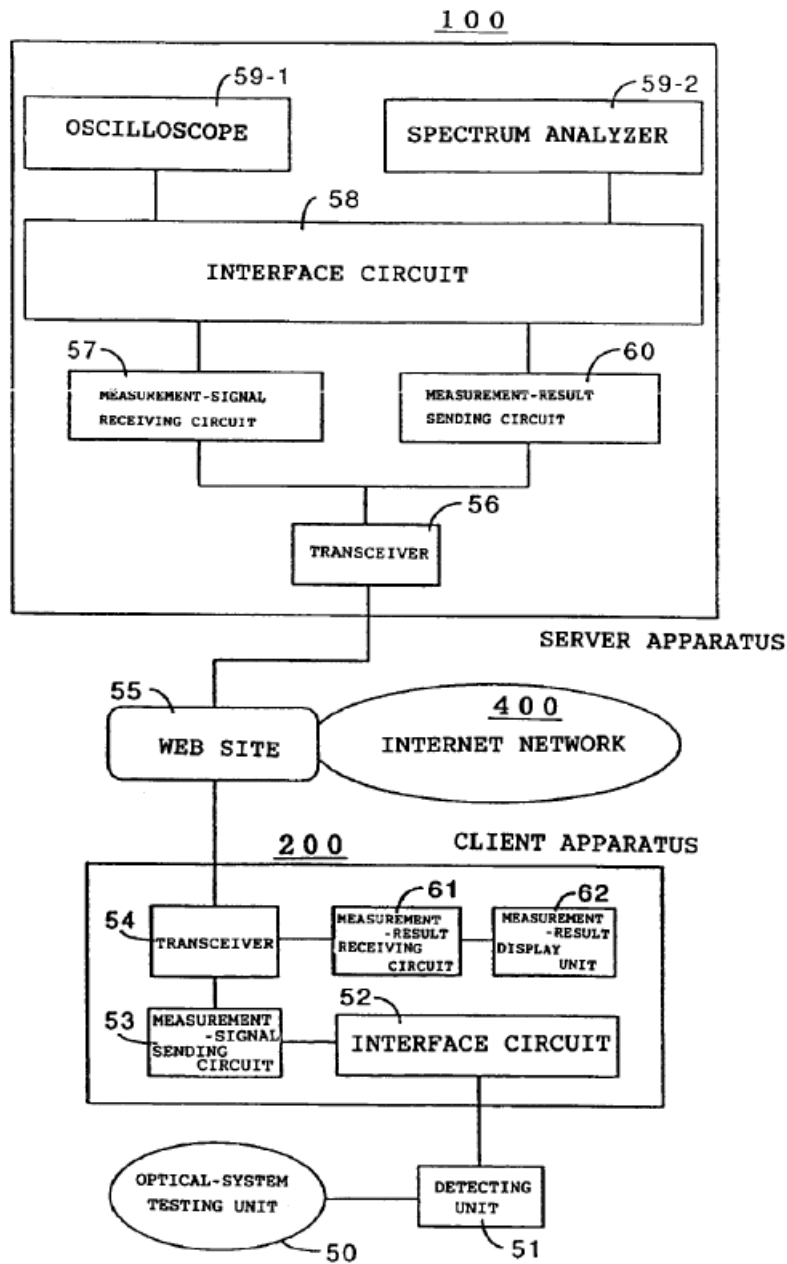


Figure 3 illustrates a diagram of a measurement service system having server apparatus 100 and client apparatus 200. *Id.* at 5:14–17, 5:40. Internet 400 is used for interactive communications between server apparatus 100 and client apparatus 200. *Id.* at 5:35–36, Fig. 3. Internet 400 receives signals from client apparatus 200 via Web Site 55. *Id.* at 5:33–34, Fig. 3. Web Site 55 also accepts applications for measurements and provides

billing. *Id.* at 5:37–39. Server apparatus 100 performs the functions of detecting whether the measurement data are capable of being measured by a measuring instrument in server apparatus 100, and notifying whether the measurement service is available. *Id.* at 5:46–50.

The measurement service system is used, for example, at an optical testing laboratory. *Id.* at 5:18–20. As shown in Figure 3 above, optical-system testing unit 50 obtains measurement data and detecting unit 51 detects the measurement data. *Id.* at 5:22–26. Interface circuit 52 of client apparatus 200 captures the detected measurement data as detection signals, and then modulates and codes the detection signals for transmission. *Id.* at 5:27–31. The modulated detection signals are transmitted to Internet 400 via Web Site 55. *Id.* at 5:33–34. The detection signals are received by server apparatus 100 and demodulated by measurement-signal receiving circuit 57. *Id.* at 5:66–6:2. The detection signals are transmitted to interface circuit 58, which transmits the demodulated detections signals to one of the measuring instruments, specifically, oscilloscope 59-1 or spectrum analyzer 59-2. *Id.* at 6:3–7, Fig. 3.

D. Illustrative Claim

Petitioner challenges claims 1, 2, 5, 7–13, 15–18, 21, 23–28, 30–32, 34, 35, and 38–41 of the '940 Patent. Pet. 1, 4. Claims 1, 17, 32, and 38–41 are independent claims. Claims 2, 5, 7–13, 15, 16, 18, 21, 23–28, 30, 31, 34, and 35 depend, directly or indirectly, from claims 1, 17, and 32. Independent claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A measuring service system comprising a server apparatus and a client apparatus connected to each other

through an interactive communication line, such that the client apparatus sends measurement data, input thereto from a measured medium, to the server apparatus through the interactive communication line, while the server apparatus executes measurement processing on the basis of the measurement data to send data on the measurement processing results to the client apparatus through the interactive communication line, wherein

said client apparatus comprises client-side modulation means for modulating the measurement data into signals suitable for transmission, and client-side demodulation means for demodulating the data on the measurement processing results into signals suitable for processing on said client apparatus, and

said server apparatus comprises at least one measurement means capable of executing measurement processing on the basis of the measurement data, means for detecting whether the measurement data are capable of being measured by any measurement means in the said server apparatus, and notifying whether the measurement processing is available and server-side modulation means for modulating the data on the measurement processing results into signals suitable for transmission.

Ex. 1001, 7:40–64.

E. Asserted Grounds of Unpatentability

Petitioner asserts that the challenged claims are unpatentable, under 35 U.S.C. § 103(a), based on the following grounds (Pet. 4):

References	Challenged Claims
Sunshine ² and Miyajima ³	1, 2, 7–11, 13, 15–18, 23–26, 28, 30, 31, and 38–41
Sunshine, Miyajima, Ezekiel ⁴	16, 31 ⁵ , 32, 34, and 35
Sunshine, Miyajima, Nathanson ⁶	5, 12, 21, and 27

Petitioner relies on the Declaration of Mr. Arthur Zatarain (Ex. 1007) and the Second Declaration of Mr. Arthur Zatarain (Ex. 1030). Patent Owner relies on the Declaration of Dr. Vyacheslav Zavadsky. Ex. 2006.

II. DISCUSSION

A. Claim Construction

Only those terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999). To resolve the questions of patentability raised in the instant proceeding, we need only determine the broadest reasonable interpretation of “detecting whether the

² U.S. Patent No. 6,606,566 B1, issued Aug. 12, 2003 (Ex. 1004, “Sunshine”).

³ U.S. Patent Application No. 2002/0083128 A1, published June 27, 2002 (Ex. 1005, “Miyajima”).

⁴ U.S. Patent No. 5,790,977, issued Aug. 4, 1998 (Ex. 1006, “Ezekiel”).

⁵ Although a summary table in the Petition includes claim 31 for the first ground, but not the second (Pet. 4), as we noted in the Institution Decision, the Petition includes arguments for claim 31 in both the first and second grounds. Inst. Dec. 20, n.9. Additionally, we instituted as to claim 31 on both grounds. *Id.* at 29.

⁶ U.S. Patent No. 6,263,268 B1, issued July 17, 2001 (Ex. 1010, “Nathanson”).

measurement data are capable of being measured” recited in claims 1 and 32, and commensurately recited in the other independent claims.⁷ For the reasons given *infra* in Section II.D, we determine Petitioner has not shown that the asserted prior art combinations teach the detecting function recited in the independent claims; therefore, we need not make further determinations regarding the means-plus-function limitations or other claim construction issues.

1. Principles of Law

In an *inter partes* review, we construe claim terms in an unexpired patent according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b).⁸ “Under a broadest reasonable interpretation, words of the claim must be given their plain meaning, unless such meaning is inconsistent with the

⁷ In particular, independent claim 17 recites “said server apparatus detects whether the measurement data is capable of being processed,” independent claim 38 recites “a detector for indicating if received data is capable of being measured,” independent claim 39 recites “detecting whether the measurement data is capable of being measured,” independent claim 40 recites “the server apparatus detects whether the measurement data is capable of being measured,” and claim 41 recites “detecting if the measurement data can be processed.” Ex. 1001, 8:66–9:1, 10:25–27, 10:53–55, 11:3–5, 12:2–3.

⁸ Although the Patent Owner Response includes one sentence indicating that “Patent Owner agrees the *Phillips* standard applies,” elsewhere in its Response, Patent Owner indicates that the challenged claims must be given the broadest reasonable interpretation and Patent Owner’s contentions throughout its Response are consistent with that standard. *See, e.g.*, PO Resp. 11–31. Patent Owner indicates that the one inconsistency (*id.* at 19) was a typographical error and Patent Owner agrees broadest reasonable interpretation applies in the instant proceedings. Tr. 60:8–12.

specification and prosecution history.” *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1062 (Fed. Cir. 2016).

2. “detecting whether the measurement data are capable of being measured”⁹

Starting with the language of the claim, the dispute between the parties centers on “capable” and, more specifically, whether “capable” requires “functional ability.” *See, e.g.*, Pet. 10–11, 38–42; PO Resp. 21; Pet. Reply 11.¹⁰ In particular, we must determine whether detecting if data are “capable of being [measured/processed]” or “can be processed” means detecting “if any instrument has the functional ability to measure measurement data,” as Patent Owner proposes (PO Resp. 20) or merely detecting “whether [an] instrument is available to process data,” as proposed by Petitioner (Pet. 38–39).

As an initial matter, Petitioner contends “[w]hereas Patent Owner agreed to Petitioner’s and the Board’s construction of this limitation before [(Prelim. Resp. 12)], it now reads the word ‘capable’ to require ‘determin[ing] if any instrument *has the functional ability* to measure measurement data.” Pet. Reply 11. Petitioner’s construction, however, is identification of the function and corresponding structure in the ’940 Patent

⁹ And the aforementioned similar recitations in the other independent claims.

¹⁰ Claim 41 recites “detecting if the measurement data can be processed.” Ex. 1001, 12:2–3. Petitioner does not dispute Patent Owner’s contention (PO Resp. 15–20) that “can” has the same meaning as “capable.” *See generally* Pet. Reply. Indeed, Petitioner contends, “[c]laim differentiation does not require a different construction for ‘can’ than ‘capable.’” *Id.* at 14 n.7.

Specification for the means-plus-function recitations in claims 1 and 39. Pet. 10–11; Prelim. Resp. 12. Furthermore, Patent Owner provided only a one-sentence agreement with respect to that identification of the function and corresponding structure for the means-plus-function limitation. Prelim. Resp. 12. Importantly, in the Petition, Petitioner does not provide a construction analysis for “capable of” other than its implicit contention in its element-by-element analysis. Pet. 10–11, 38–47.

Additionally, in its Preliminary Response, Patent Owner disputed Petitioner’s showing for the detecting limitation. *See, e.g.*, Prelim. Resp. 27–28. Patent Owner’s dispute also clearly set forth disagreement with Petitioner’s implicit construction. *Id.* In particular, Patent Owner asserted: “it is clear from the above that ‘capable’ cannot be construed as merely ‘available.’” *Id.*

At the institution stage, with respect to the means-plus-function recitations in claims 1 and 39, we declined to formulate a construction that differed from that agreed to by the parties. Inst. Dec. 12. At that preliminary stage, we did not formulate a construction for “capable of” recited in claims 1 and 39. *Id.* We reminded the parties that “[a]t this preliminary stage, we have not made a final determination with respect to the patentability of the challenged claims or any underlying factual or legal issues.” *Id.* at 28–29.

We note that Patent Owner is not required to set forth all its contentions in its Preliminary Response and, further, is not required to file any Preliminary Response. *See, e.g.*, 35 U.S.C. § 314(a)–(b) (referring to “any response filed under section 313” and setting forth timing “if no such preliminary response is filed”); 37 C.F.R. § 42.107(a) (“The patent owner

may file a preliminary response”) (emphasis added). In its Patent Owner Response, Patent Owner sets forth detailed contentions regarding the broadest reasonable interpretation of “capable of” within the detecting limitations recited in each of the independent claims. *See, e.g.*, PO Resp. 19–31.

a) *The ’940 Patent Claim Language and Specification*

We turn to the words of the claims and the ’940 Patent Specification. Each of independent claims 1, 17, 32, and 38–41 requires detecting whether the measurement data are capable of being measured. Ex. 1001, 7:58–60, 8:66–9:1, 9:66–10:3, 10:25–27, 10:53–55, 11:3–5, 12:2–3. Petitioner asserts that this limitation is met by determining whether an instrument is available to process data. *See, e.g.*, Pet. 38–42. In the Institution Decision, we noted Patent Owner’s agreement with Petitioner’s proposed construction for the detecting means and declined to formulate a construction that differed from that agreed to by the parties, at that preliminary stage in the proceedings. Inst. Dec. 10–12 (citing *e.g.*, Pet. 10–11; Prelim. Resp. 12).

In response, Patent Owner asserts the “word ‘capable’” has “a customary and well understood definition,” which is “‘having the ability required for a specific task’ or more simply ‘functional ability.’” PO Resp. 20–21. Patent Owner further asserts that the broadest reasonable interpretation of detecting whether the measurement data are capable of being measured is detecting if any instrument has the functional ability to measure measurement data. *Id.* at 14–21. Patent Owner contends that its proposed construction is supported by all embodiments of the ’940 Patent Specification. *Id.* at 22–26 (citing *e.g.*, Ex. 1001, 6:3–13, 7:1–4, Figs. 2–4;

Ex. 2006 ¶¶ 18, 21, 23–34, 41–47). Petitioner maintains its assertions in the Petition that this limitation is met by determining whether an instrument is available to process data. Pet. Reply 22–27. Petitioner disputes Patent Owner’s contentions and asserts, for example, that Patent Owner “reorders” the limitation and “improperly imports limitations from recited embodiments.” Pet. Reply 11–18 (citing Ex. 1030 ¶¶ 28, 29, 60, 61).

The words of the claims are reproduced below.

Independent Claim	Recitation
Claim 1	“detecting whether the <i>measurement data are capable of</i> being measured by any measurement means in the said server apparatus” (Ex. 1001, 7:59–61 (emphasis added)).
Claim 17	“detects whether the <i>measurement data is capable of</i> being processed at the server apparatus” (<i>id.</i> at 8:66–9:1 (emphasis added)).
Claim 32	“detecting whether the <i>measurement data are capable of</i> being measured by any measuring instrument in the said server computer” (<i>id.</i> at 9:66–10:2 (emphasis added)).
Claim 38	“a detector for indicating if <i>received data is capable of</i> being measured by said measuring instrument” (<i>id.</i> at 10:25–27 (emphasis added)).
Claim 39	“detecting whether the <i>measurement data is capable of</i> being measured by any measurement means in the server apparatus” (<i>id.</i> at 10:53–55 (emphasis added)).
Claim 40	“detects whether the <i>measurement data is capable of</i> being measured by any measuring instrument in the said server apparatus” (<i>id.</i> at 11:3–5 (emphasis added)).
Claim 41	“detecting if the <i>measurement data can be</i> processed” (<i>id.</i> at 12:2–3 (emphasis added)). ¹¹

¹¹ See *supra* n.10.

Consistent with Patent Owner’s claim construction contentions, each of the recitations in the independent claims requires detecting whether the measurement data are capable of being measured or processed by the server. *Id.* at 7:59–61, 8:66–9:1, 9:66–10:3, 9:66–10:2, 10:25–27, 10:53–55, 11:3–5, 12:2–3. Additionally, consistent with Patent Owner’s contentions, the ’940 Patent Specification describes that measuring or processing is performed by a measuring instrument having the ability required for a specific task, i.e., processing specific measurement data. *See, e.g.*, Ex. 1001, 6:3–13 (describing transmitting measurement data to one of an oscilloscope or a spectrum analyzer), 6:65–68 (describing transmitting measurement data to one tester), 7:1–9 (describing transmitting measurement data to one tester relating to the type of automobile), Figs. 3, 4 (each illustrating a server with different testers).¹²

We turn to Petitioner’s contentions, starting with its contentions relating to the language of the claims. Petitioner contends that Patent Owner “reorders” the recitation. Pet. Reply 12; *see also id.* at 21 (“‘capable’ applies to the ‘measurement data’ and ‘available’ applies to the ‘measurement processing’”). In particular, Petitioner contends the claims recite detecting whether measurement data are capable of being measured,

¹² Claim 1 further recites that the server comprises “at least one measurement means *capable of* executing measurement processing on the basis of the measurement data.” *Id.* at 7:56–58. Like the aforementioned detecting limitations recited in the independent claims, the recitation of “at least one measurement means *capable of* executing measurement processing” (*id.*) in claim 1 is consistent with the embodiments disclosed in the ’940 Patent Specification describing that measuring or processing is performed by a measuring instrument having the ability required for a specific task. Ex. 1001, 6:3–13, 6:65–68, 7:1–9, Figs. 3, 4.

but Patent Owner requires, instead, detecting whether any instrument is capable of measuring the data. *Id.* Petitioner, however, asserts that this limitation is met by determining “whether [an] instrument is available to process data.” *See, e.g.*, Pet. 38; *see also id.* at 41–42 (asserting that the detecting limitation is met by a server detecting “if an instrument to which it is coupled is available for use by the client”). The dispute between the parties centers on whether the detecting is of an instrument’s capability to measure the data (*see, e.g.*, PO Resp. 20–21), or of only an instrument’s availability (*see, e.g.*, Pet. 38–42).

During the hearing, however, Petitioner argued that Patent Owner’s alleged reordering “impermissibly narrows the claim.” Tr. 21:5–9. Petitioner argued that detecting whether data are capable of being measured is broader because it can be done by looking at the data alone to determine if it is “corrupted” or “garbled.” *Id.* at 19:18–20:23. Petitioner argued that Patent Owner’s proposed construction “would read out that option.” *Id.* at 21:5–9. Petitioner, however, acknowledges that the example it identified, i.e., corrupted data, is not described in the ’940 Patent Specification. *Id.* at 21:10–14. Petitioner also maintains that simply powering on an instrument is sufficient without explaining how such teaching relates to determining if received data are corrupted. *See generally* Pet.; Pet. Reply. We decline to formulate a construction based on Petitioner’s example of corrupted data, which is not used in Petitioner’s analysis of the grounds and is not supported by the ’940 Patent Specification.

Petitioner, additionally, contends the plain meaning of the words “capable” and “available” “substantially overlap.” Pet. Reply 25. Consistent with Patent Owner’s contentions, however, “different claim terms

are presumed to have a different meaning.” *See Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 93 F.3d 1572, 1579 (Fed. Cir. 1996). Petitioner contends the presumption is weakened “when different items in the claims are at issue as there is no redundancy.” Pet. Reply 23–24 (citing *Kraft Foods, Inc. v. Int’l Trading Co.*, 203 F.3d 1362, 1368 (Fed. Cir. 2000)). In *Kraft*, however, the United States Court of Appeals for the Federal Circuit explained “we agree with the district court that the written description and prosecution history overcome any presumption arising from the doctrine of claim differentiation.” *Kraft*, 203 F.3d at 1368. In the instant proceeding, for the reasons set forth herein, we find that the ’940 Patent Specification and prosecution history are consistent with Patent Owner’s contentions. *See, e.g.*, PO Resp. 20–21.

Furthermore, regarding the language of the claims, as set forth in the table above, the full limitations in the independent claims include qualifying language requiring detecting whether the measurement data are capable of being measured or processed by an instrument in the server. Ex. 1001, 7:59–61, 8:66–9:1, 9:66–10:2, 10:25–27, 10:53–55, 11:3–5, 12:2–3. On this record, we are not persuaded that merely detecting that an instrument is available, e.g., powered-on, takes into account the qualifying language in the claim requiring detecting whether the measurement data are capable of being measured or processed by that instrument. For instance, Petitioner does not explain how the detecting limitation is satisfied by determining that an instrument is available that is not able to measure the received data. Additionally, Petitioner’s contentions are not persuasive in light of the other intrinsic evidence, discussed below.

We next turn to Petitioner’s contentions relating to the ’940 Patent Specification. Petitioner contends that “Patent Owner’s reading of the specification is mistaken” because Patent Owner relies on description in the ’940 Patent Specification that does not use the term “capable.” Pet. Reply 15. During the hearing, Petitioner argued that the detecting limitations are discussed in only one place in the ’940 Patent Specification. Tr. 64:19–65:4. The portion of the ’940 Patent Specification referred to by Petitioner is reproduced below, along with surrounding text.

Therefore, applications for measurements are accepted on the Web site 55, and in some cases, the applicants may be billed online through Web site 55.

The server apparatus 100 and the client apparatus 200 may be a server computer and a client computer, respectively. In this case, a desired measuring instrument in the server apparatus 100 can be selected on the Web site 55 so that transmission of measurement data from the client apparatus 200 will be accepted.

The server computer may also have the functions of *detecting whether the measurement data are capable of being measured by any measuring instrument* in the server apparatus 100, and notifying whether the measurement service is available.

Further, the measurement service system may be such that the *operating state of each measuring instrument* can be confirmed on the Web site 55.

Ex. 1001, 5:37–54 (emphases added).

That portion of the ’940 Patent Specification, however, is consistent with Patent Owner’s contentions because the description distinguishes between detecting whether the measurement data are *capable of being measured* by a measuring instrument and the *further* requirement of confirming the *operating state* of the instrument. *Id.* Also that portion of

the '940 Patent Specification refers to whether the service is “available,” which differs from whether the data are “capable of” being measured by an instrument. *Id.*

Petitioner contends that neither the claims nor the specification suggest Patent Owner’s proposed “sharp distinction” and the specification “does not clearly state that these terms must have completely separate meanings.” Pet. Reply 23–24. Petitioner, however, refers to only the language of claim 1 and one portion of the '940 Patent Specification, discussed above. *Id.* (citing Ex. 1001, 5:37–54, 7:58–62). That portion of the '940 Patent Specification is more consistent with Patent Owner’s contentions than Petitioner’s.

Importantly, on this record, Petitioner has not shown how the '940 Patent Specification *supports* that the meaning of the words “capable” and “available” overlap, as Petitioner contends (Pet. Reply 22–26). Additionally, we are not persuaded by Petitioner that mere lack of the word “capable” (*id.* at 15) prohibits consideration of much of the description in the '940 Patent Specification. We find that the '940 Patent Specification supports Patent Owner’s contentions (PO Resp. 20–21). In particular, the '940 Patent Specification describes measuring instruments having the ability required for a specific task, i.e., processing specific measurement data. *See, e.g.,* Ex. 1001, 6:3–13, 6:65–68, 7:1–9, Figs. 3, 4. Additionally, the '940 Patent Specification describes selecting a desired one of the instruments, indicating that not all instruments are equally fit for the task. *See, e.g., id.* at 6:3–13 (“The interface circuit 58 selected desired one of measuring instruments”), 6:65–68 (“interface circuit 75 selects desired one of measuring instruments (testers)”), 7:1–9 (“[A] measuring instrument (tester)

is provided for each type of automobile so that a desired tester will be selected from all the testers.”).¹³

Relying on the deposition testimony of Dr. Zavadsky and the declaration testimony of Mr. Zatarain, Petitioner disputes reliance on one portion of the '940 Patent Specification on the basis that “an oscilloscope and a spectrum analyzer[] can operate on the same raw data.” Pet. Reply 17 (citing Ex. 1030 ¶¶ 28, 29; Ex. 1031, 48:3–17). Although Dr. Zavadsky testifies that some oscilloscopes have spectrum analyzer capabilities and can operate on the same data, he testifies that this is a theoretical possibility, not what is discussed in the '940 Patent Specification. Ex. 1031, 48:3–49:12. Mr. Zatarain does not testify regarding portions of the '940 Patent Specification and does not disclose the underlying facts or data on which his opinion is based. 37 C.F.R. § 42.65(a).¹⁴ Additionally, “extrinsic evidence may be used only to assist in the proper understanding of the disputed limitation; it may not be used to vary, contradict, expand, or limit the claim language from how it is defined, even by implication, in the specification or file history.” *Bell Atl. Network Servs. v. Covad Commc'ns Grp.*, 262 F.3d 1258, 1269 (Fed. Cir. 2001). Our reviewing court also has explained, “extrinsic evidence consisting of expert reports and testimony is generated at

¹³ Although these embodiments illustrate “capable of” with respect to multiple measuring instruments or testers, Patent Owner’s position is that the independent claims require detecting functional ability even for claims that encompass a single measuring instrument. Tr. 36:21–38:18.

¹⁴ During the hearing, Petitioner acknowledged that no embodiment in the '940 Patent Specification specifically describes two oscilloscopes and Petitioner could not point to an argument it made in the papers that such embodiment was contemplated. Tr. 12:18–13:22.

the time of and for the purpose of litigation and thus can suffer from bias that is not present in intrinsic evidence.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1318 (Fed. Cir. 2005) (en banc).

Petitioner further contends:

The driving force of Patent Owner’s construction (and its interpretation of its own construction) is its misunderstanding of the disclosed embodiments. In essence, Patent Owner contends that since the patent discussed a server connected to different types of instruments, the patent *must* disclose the server automatically deciding which instrument should process data.

Pet. Reply. 16 (citing PO Resp. 24–26). Petitioner continues that the ’940 Patent Specification discloses that the client “*can specify* which instrument to use,” but selection is not required by the claims. *Id.* at 16–17 (emphasis added).

Patent Owner, however, contends only that the broadest reasonable interpretation of the word “capable” requires having “functional ability.” PO Resp. 20–30. That the ’940 Patent Specification provides details regarding selecting a particular instrument, and Patent Owner refers to those portions of the ’940 Patent Specification, does not mean that Patent Owner purports to read into the claims the entirety of the embodiments. *Id.* Furthermore, Patent Owner does not propose importing limitations into the claims. Independent claims 1, 17, 32, 38, 39, and 40 expressly recite “capable” (Ex. 1001, 7:58–60, 8:66–9:1, 10:25–27, 10:53–55, 11:3–5) and independent claim 41 recites “can” (*id.* 12:2–3), which Petitioner agrees should be construed the same as “capable.” Pet. Reply 14. We find that Patent Owner’s contentions regarding the broadest reasonable interpretation

of “capable” are consistent with that term read in light of the ’940 Patent Specification.

b) *The Prosecution History*

The prosecution history of the ’940 Patent also is consistent with Patent Owner’s claim construction contentions. Petitioner contends “[d]uring prosecution, all of the independent claims were substantively amended only once,” to add “the requirement of *detecting whether processing is available* and notifying the client of the determination.” Pet. 6 (citing Ex. 1002, 92–100) (emphasis added). Patent Owner contends “two operative features” provided the basis for patentability i.e., “the ‘detect’ feature” and “the ‘notify’ feature.” PO Resp. 59. Contrary to Petitioner’s contention (Pet. 6) and consistent with Patent Owner’s contention (PO Resp. 59), during prosecution, the Examiner provided “a statement of reasons for the indication of allowable subject matter” as follows: “none of the prior art of record teaches or suggests that server computer has the *functions* of *detecting* whether the measurement data are *capable of* being measured by any measuring instrument in the server computer, and *notifying* whether the measurement service is *available*.” Ex. 1002, 82 (emphases added). In particular, the Examiner identified two separate “functions,” i.e., detecting whether data are capable of being measured and notifying of availability of the service. *Id.*

Contrary to Petitioner’s contention (Pet. 6) and consistent with Patent Owner’s contentions (PO Resp. 20–30), Applicant amended all the pending claims “to reflect the allowable subject matter and to clarify various informalities in the claims.” Ex. 1002, 92–100. As can be seen from the

actual amendments, the pending claims were amended to add the requirement of detecting whether data are capable of being measured in the server and certain of the claims were further amended to require notifying whether processing is available. *Id.* at 92–99.

Remarks later in prosecution also are consistent with Patent Owner’s claim construction contentions. In particular, following a subsequent rejection citing a newly discovered reference, Applicant argued that the detecting limitations distinguished the pending claims over that art. *Id.* at 122–127. More specifically, Applicant argued that the asserted prior art did not include a “suggestion or even a hint [] of providing a server computer that *detects* whether the measurement data input at the client computer *can be measured by a measuring instrument on the server computer.*” *Id.* at 122 (emphases added).

As our reviewing court has explained, “[t]he PTO should also consult the patent’s prosecution history in proceedings in which the patent has been brought back to the agency for a second review.” *Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015), overruled on other grounds by *Aqua Prods., Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017). In summary, although we agree with Petitioner’s contention that during prosecution, the independent claims were substantively amended only once, we do not agree that the amendment was to add “the requirement of detecting whether processing is available and notifying the client of the determination.” Pet. 6. Instead, consistent with Patent Owner’s contention (*see, e.g.*, PO Resp. 59), the amendment added the requirement of detecting whether the measurement data are *capable of* being measured by any measuring instrument in the server computer. *See, e.g.*, Ex. 1002, 92–100.

c) *Extrinsic Evidence*

Patent Owner submits dictionary definitions of the term “capable.” PO Resp. 20–22 (citing Exs. 2002; 2003). Petitioner argues that Patent Owner “cherry-picks” among the dictionary definitions and proposes adopting “the narrowest definition.” Pet. Reply 12–13. Petitioner also contends “other definitions of ‘capable’ ignored by Patent Owner” support Petitioner’s contentions. *Id.* at 22–23.

Patent Owner, however, asserts that even the definitions not specifically discussed in its Patent Owner Response are in agreement with Patent Owner’s contentions. Tr. 39:1–20. We agree. As an initial matter, Petitioner points to the following definition: “having the inclination or disposition.” Pet. Reply 23 (citing Ex. 2003). We are not persuaded of the applicability of that definition. Another definition identified by Petitioner having “general efficiency *and ability*” (Pet. Reply (citing Ex. 2002) (emphasis added)) supports Patent Owner’s contentions (*see, e.g.*, PO Resp. 20–21).

The remaining extrinsic definition identified by Petitioner for support also supports Patent Owner. Petitioner contends that extrinsic definition for “capable” is “permit ‘an action to be performed.’” Pet. Reply 23 (citing Ex. 2003). That construction, which is “[p]ermitting an action to be performed” includes the following examples “*an error capable of remedy; a camera capable of being used underwater.*” Ex. 2003. Petitioner does not explain how this example is consistent with its contentions. We find that the extrinsic definitions are consistent with Patent Owner’s contentions. *See, e.g.*, PO Resp. 20–22.

Mr. Zatarain testifies “[i]n my opinion, detecting the off-on status of an instrument satisfies a PHOSITA’s understanding of the term ‘capable’ as well as relevant dictionary definitions for that term.” Ex. 1030 ¶ 84.

Mr. Zatarain’s testimony then repeats the aforementioned definitions (*id.*), which we find are consistent with Patent Owner’s proposed construction.

Mr Zatarain also testifies that an instrument that is not powered on “lacks the ability to perform any of its general functions.” *Id.* ¶ 85. But Mr. Zatarain’s testimony does not provide sufficient explanation as to why the meaning of the words “capable” and “available” overlap, as Petitioner contends (Pet. Reply 22–26). Additionally, Mr. Zatarain’s testimony is conclusory. *See* Ex. 1030 ¶¶ 84–85. We, instead, credit the testimony of Dr. Zavadsky that Patent Owner’s proposed construction is consistent with the understanding of one of ordinary skill in the art. *See, e.g.*, Ex. 2006 ¶¶ 28, 30–36.

d) Conclusion—“detecting whether the measurement data are capable of being measured”

Based on the entire trial record before us, for the reasons given, we are persuaded that Patent Owner’s proposed construction is consistent with the plain and ordinary meaning of the claim language as understood by a person of ordinary skill in the art in the context of the ’940 Patent Specification. *See* Ex. 1001, 5:40–54, 6:3–13, 7:1–4, Figs. 3, 4.

Accordingly we determine that the broadest reasonable interpretation of detecting if data are “capable of being [measured/processed]” or “can be processed” is detecting “if any instrument has the functional ability to measure measurement data,” as proposed by Patent Owner. PO Resp. 14–

21.¹⁵ We determine no further express construction is necessary for the detecting recitations in the independent claims.

B. Principles of Law (Obviousness)

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)); *see also* 37 C.F.R. § 42.104(b)(4) (requiring a petition to include a statement of the precise relief requested for each claim challenged, including “where each element of the claim is found in the prior art patents or printed publications relied upon.”). This burden never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008))

¹⁵ In particular, each of independent claims 1 and 32 recites “detecting whether the measurement data are capable of being measured,” independent claim 17 recites “said server apparatus detects whether the measurement data is capable of being processed,” independent claim 38 recites “a detector for indicating if received data is capable of being measured,” independent claim 39 recites “detecting whether the measurement data is capable of being measured,” independent claim 40 recites “the server apparatus detects whether the measurement data is capable of being measured,” and claim 41 recites “detecting if the measurement data can be processed.” Ex. 1001, 7:59–60, 8:66–9:1, 10:25–27, 10:53–55, 11:3–5, 12:2–3. Petitioner does not dispute Patent Owner’s contention (PO Resp. 15–20) that “can” has the same meaning as “capable” and instead contends that a different construction is not required. *See generally* Pet. Reply.

(discussing the burden of proof in *inter partes* review). Furthermore, Petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

A patent claim is unpatentable if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. 35 U.S.C. § 103(a). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) objective evidence of nonobviousness, i.e., secondary considerations. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). In an obviousness analysis, some reason must be shown as to why a person of ordinary skill would have combined or modified the prior art to achieve the patented invention. *See Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1374 (Fed. Cir. 2008).

C. Person of Ordinary Skill in the Art

Petitioner proposes that a person of ordinary skill in the art would have had a degree in computer science, electrical engineering, or computer engineering, or equivalent experience, and at least two years of experience in remote monitoring and control systems. Pet. 7 (citing Ex. 1007 ¶ 16). At the preliminary stage, Patent Owner agreed with Petitioner’s proposal (Prelim. Resp. 8) and Patent Owner has not subsequently disputed Petitioner’s proposal or offered an alternative (*see generally* PO Resp.).

Because we find Petitioner’s statement of the level of skill in the art (Pet. 7; Ex. 1007 ¶ 16) consistent with the level of skill implied by the prior art of record, we adopt Petitioner’s statement of the level of skill in the art.

Okajima v. Bourdeau, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (the prior art itself can reflect the appropriate level of skill in the art).

D. Obviousness

Petitioner contends each of independent claims 1, 17, and 38–41 is unpatentable, under 35 U.S.C. § 103(a), over Sunshine and Miyajima. Pet. 4, 14–50, 63–65, 67–72. Petitioner contends that independent claim 32 is unpatentable, under 35 U.S.C. § 103(a), over Sunshine, Miyajima, and Ezekiel. *Id.* at 4, 75–80.

1. Overview of Sunshine

Sunshine is directed to computer code for detecting and transmitting sensory data from one portable device to another for analytic purposes. Ex. 1004, 1:16–20. Figure 1 of Sunshine is reproduced below.

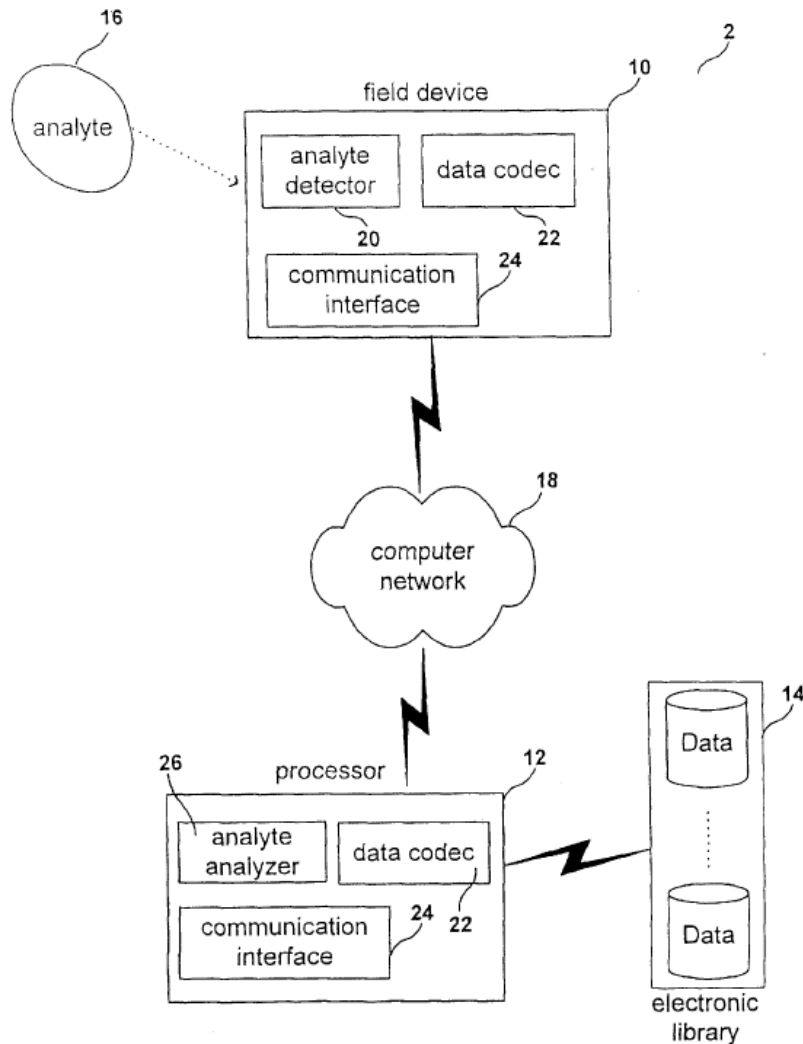


Fig. 1

Figure 1 illustrates a block diagram of a detection and transmission system.

As shown in Figure 1 above, detection and transmission system 2 includes field device 10 and processor 12. *Id.* at 4:23–24. Field device 10 is a portable, handheld device (*id.* at 4:64–67) and includes analyte detector 20 and data coder/decoder (“codec”) 22 (*id.* at 4:31–32). Analyte detector 20 detects the presence of analyte 16 and generates sensory data corresponding to a signature specific to the detected analyte. *Id.* at 4:33–37. Data codec 22

receives data from analyte detector 20, encodes and formats the data, and relays the data to computer network 18. *Id.* at 4:46–51.

A data codec in processor 12 receives data from field device 10 and processes or decodes that data and then sends the decoded data to analyte analyzer 26. *Id.* at 5:25–28. Analyte analyzer 26 compares data received from field device 10 with data retrieved from database 14 to identify the detected analyte. *Id.* at 5:35–39.

2. Overview of Miyajima

Miyajima is directed to an automatic remote electronic instrument connecting system. Ex. 1005 ¶ 1. Figure 1 of Miyajima is reproduced below.

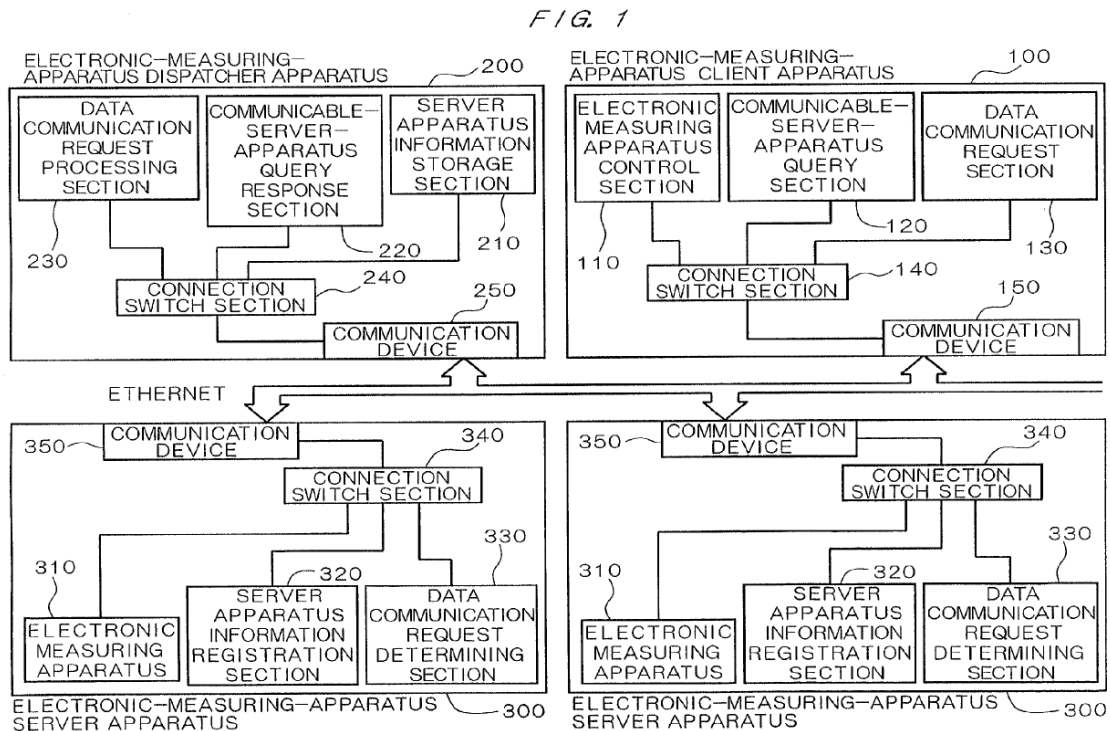


Figure 1 illustrates configuration of an electronic-measuring apparatus.

As shown in Figure 1 above, the electronic-measuring apparatus includes client apparatus 100 and server apparatus 300. *Id.* ¶ 35. Server

apparatus 300 includes measuring apparatus 310 and registration section 320. *Id.* ¶ 38. After power to electronic measuring apparatus 310 has been turned on, registration section 320 creates a unique registration (identification (ID) number) for measuring apparatus 310. *Id.* ¶¶ 38, 40.

3. *Discussion of Claim 1*

We begin our analysis with independent claim 1. Claim 1 is directed to a measuring service system comprising a client apparatus and a server apparatus. Ex. 1001, 7:40–64. Claim 1 recites that the server apparatus comprises “means for *detecting whether the measurement data are capable of being measured by any measurement means in the said server apparatus, and notifying whether the measurement processing is available.*” *Id.* (emphasis added). For the reasons given below, we find Petitioner has not shown that the asserted prior art combination teaches the detecting function recited in independent claim 1. We, therefore, need not make further determinations or findings regarding this means-plus-function limitation, for example, regarding the structure corresponding to this function and, further, we need not make further determinations or findings regarding other recitations in claim 1.

For most of the limitations recited in claim 1, Petitioner points to Sunshine’s teachings relating to the embodiment illustrated in Figure 1, reproduced and discussed in the summary above. Pet. 14–50 (citing, *e.g.*, Ex. 1004, Abstract, 2:31–3:30, 4:11–5:40, Fig. 1; Ex. 1007 ¶¶ 35, 40–48, 81–101). For the detecting and notifying means, Petitioner points to Miyajima’s teachings relating to determining whether Miyajima’s measuring apparatus 310 has been powered on and is available to process data, and if

so, creating registered information including the ID number. *Id.* at 38–47 (citing *e.g.*, Ex. 1005 ¶¶ 5, 6, 10–12, 13, 38, 40, 47, 58, Figs. 1–12, Abstract).

Regarding the function of detecting, Petitioner relies on Miyajima’s teachings of availability—i.e., whether the instrument is powered on and not processing other data. For instance, Petitioner contends:

Miyajima discloses, or at least renders obvious the function of this means-plus-function limitation because it discloses a client apparatus that can communicate with a remote server apparatus that is connected to an instrument. EX 1005 at Abstract. The server determines whether the instrument is *available* to process data (e.g., if it is powered on or if it is processing another client’s data). *Id.* at ¶¶ 47 and 58. This corresponds to the “detecting whether the measurement data are capable of being measured by any measurement means in the said server apparatus” limitation.

Pet. 38–39 (emphasis added); *see also id.* at 41–42 (asserting the same) (citing Ex. 1005 ¶¶ 5, 6, 12, 13, 38, 40, 47, 58, Figs. 1–12).

In Petitioner’s additional discussion, Petitioner again relies on only Miyajima’s teachings of availability, as follows:

[A] skilled artisan would have understood that *Miyajima* teaches a server that detects whether measurement data can be processed by disclosing the server detecting if an instrument to which it is coupled is *available* for use by the client. This is done by the server detecting if the instrument is powered on or if the instrument is not processing information on behalf of another client. Moreover, *Miyajima*’s disclosure is like the ’940 Patent’s (limited) discussion of detecting whether the data is capable of being measured at the server . . . Therefore, *Miyajima* discloses, or at least renders obvious, the “detecting . . .” function of this means-plus-function limitation.

Id. at 42 (citing Ex. 1001, 5:46–54) (emphasis added).

In its reasons to combine the teachings of Sunshine and Miyajima, Petitioner does not assert any further combination or modification and, instead, relies on Miyajima’s description regarding “benefits” of Miyajima’s teaching of determining availability. *Id.* at 45–47. For instance, Petitioner contends that Miyajima explains that determining availability “provides reliability,” “eliminates the step of confirming an instrument’s power state,” provides for “faster operation,” and “improves accuracy.” *Id.* at 45–46 (citing Ex. 1005 ¶¶ 10, 11, 13).

Petitioner also relies on the testimony of Mr. Zatarain set forth in his first Declaration. Pet. 16, 38–47 (Ex. 1007 ¶¶ 50–57, 99–101). Mr. Zatarain’s testimony in his first Declaration does not include identification of any portions of Sunshine or Miyajima in addition to those discussed above for the detecting function recited in claim 1. *See, e.g.,* Ex. 1007 ¶¶ 50–57, 99–101. Mr. Zatarain testifies regarding a claim chart. *Id.* ¶ 99 (citing Ex. 1015). For the detecting and notifying functions, the claim chart includes citations to and reproductions of only the same portions of Miyajima identified in the Petition. *See* Ex. 1015 (citing Ex. 1005 ¶¶ 5, 6, 12, 13, 38, 40, 47, 58, Figs. 1–12).

Petitioner’s contentions are premised on its claim construction contentions, which we did not adopt. More specifically, for the reasons discussed *supra* in Section II.A.2, we are persuaded that the broadest reasonable interpretation of detecting if data are “capable of being [measured/processed]” is detecting “if any instrument has the functional ability to measure measurement data,” as proposed by Patent Owner. PO Resp. 14–21. Petitioner relies on two paragraphs of Miyajima describing determining whether an instrument is powered on and, if so, if it is

processing another client's data. Pet. 38–45 (citing e.g., Ex. 1005 ¶¶ 47, 55). This description, however, merely is of detecting the instrument's availability. We do not find that Miyajima's description of determining whether an instrument is powered on and, if so, if it is processing another client's data (Ex. 1005 ¶¶ 47, 55) teaches “detecting *whether the measurement data are capable of being measured by any measurement means* in the said server apparatus” (emphasis added) in accordance with our construction, i.e., we do not find Miyajima teaches detecting “if any instrument has the functional ability to measure measurement data.”

In the Petition, Petitioner identifies other portions of Miyajima, but with insufficient explanation. In particular, the Petition includes portions of Miyajima in only a string citation as follows: “*Id.* at ¶ 58. *See also id.* at ¶¶ 5, 6, 12, 13, 38, 40, 47, 58, and Figs. 1–12.” Pet. 42. The Petition includes no further explanation or analysis. In the Declaration testimony of Mr. Zatarain, the portions of Miyajima are identified in only the accompanying chart simply by the paragraph number along with a reproduction of the text of that paragraph without explanation. Ex. 1007 ¶ 99; Ex. 1015. Petitioner does not provide sufficient explanation or analysis in the Petition for us to consider the portions in Miyajima that are simply included in the long citation and/or the chart. *See* 37.C.F.R. § 42.22 (explaining that each petition must include “[a] full statement of the reasons for the relief requested, *including a detailed explanation of the significance of the evidence*”) (emphasis added).

Further, although not necessary in light of the aforementioned determination, after consideration, the portions of Miyajima in the string citation do not remedy the aforementioned deficiency. For instance,

although one of those portions includes the same term “desired” (Ex. 1005 ¶ 13) as is used in the ’940 Patent (*see, e.g.*, Ex. 1001, 6:3, 6:65), Miyajima simply introduces the term “desired” without explanation (Ex. 1005 ¶ 13). In particular, Miyajima describes that the server apparatus includes “a data communication request determining section for determining whether a *desired* electronic measurement instrument is enabled to communicate.” *Id.* ¶ 13 (emphasis added); *see also id.* ¶¶ 38, 40 (describing the same without using the term “desired”). Miyajima itself does not explain how an instrument becomes a “desired” instrument (*id.* ¶¶ 11–13) and Petitioner includes this portion in only a string citation without explanation (Pet. 42).

The remaining textual portions in that string citation, i.e., “[*s*]ee also *id.* at ¶¶ 5, 6, 12, 13, 38, 40, 47, 58, and Figs. 1–12” simply describe the inability of the measuring instrument to perform if it is not powered on. *See* Ex. 1005 ¶¶ 5 (describing that measurements cannot be executed normally if the power to the measuring apparatus has not been turned on), ¶ 6 (describing that “power is turned on to enable the measuring apparatus” is a condition that must be met to execute data communication between a computer and that measuring apparatus). The string citation also includes all figures of Miyajima, i.e., “and Figs. 1–12” without explanation or analysis. After consideration, the portions of Miyajima in the string citation do not remedy the aforementioned deficiency, i.e., that Petitioner has not shown that Miyajima teaches or suggests “detecting whether the measurement data are capable of being measured by any measurement means in the said server apparatus,” recited in claim 1.

We turn now to Petitioner’s contentions in its Reply. In its Reply, Petitioner points to additional disclosure in Miyajima not in the Petition (Reply 27–28 (citing Ex. 1005 ¶ 44)) that describes instead of specifying an identification number, a request “specifies the name of the corresponding electronic-measuring-apparatus server apparatus 300, so program mistakes can be reduced by setting this name so that the user can understand it easily (for example, Spectrum Analyzer).” Ex. 1005 ¶ 44. Relying on the testimony of Mr. Zatarain, Petitioner asserts that identifying instruments by name is “one way that Miyajima *discloses* detecting the functional abilities of the instruments on the server.” Reply 28 (citing Ex. 1030 ¶ 83) (emphasis added). Mr. Zatarain testifies:

Hence, Miyajima discloses detecting the functional abilities of its instruments because it accommodates different types of instruments that register themselves by name. For example, a client that desired measurement processing by a spectrum analyzer can be accommodated by a server having one or more instruments with that name. Correspondingly, if a server did not have that name, the system would detect that the measurement data was not capable of being processed at the server even if that server had other instruments that could operate on the type of data differently that the user desired.

Ex. 1030 ¶ 83.

Contrary to the assertions that the newly identified paragraph *discloses* the detecting function, Miyajima describes only that the request “*specifies the name* of the corresponding electronic-measuring-apparatus server apparatus 300, so program mistakes can be reduced by setting this name *so that the user can understand it easily* (for example, Spectrum Analyzer).” Ex. 1005 ¶ 44 (emphases added). Miyajima also describes only one type of measuring instrument, i.e., “Spectrum Analyzer.” *Id.*

Additionally, Petitioner asserts that Miyajima “at least suggests” the claimed feature, relying on the testimony of Mr. Zatarain. Reply 28 (citing Ex. 1030 ¶ 83). Mr. Zatarain, however, testifies that Miyajima “discloses” that “if a server did not have that name,” i.e., a name corresponding to a desired measuring instrument “the system would detect that the measurement data was not capable of being processed at the server even if that server had other instruments that could operate on the type of data differently than the user desired.” Ex. 1030 ¶ 83 (emphasis added). Miyajima, however, describes that the name is specified for only identification, i.e., “so that the user can understand it easily.” *See, e.g.*, Ex. 1005 ¶ 44. Mr. Zatarain’s testimony includes no reasoning why one having ordinary skill in the art would have modified Miyajima’s disclosure of simply identifying a Spectrum Analyzer by name. *See generally* Ex. 1030. Indeed, Mr. Zatarain’s testimony is that Miyajima discloses the detecting limitation, and he does not testify regarding whether Miyajima at least suggests it. *Id.* We are not persuaded that Miyajima discloses the detecting limitation.

In its Reply, in a footnote, Petitioner asserts that Miyajima is “similar to the ’940 Patent” and cites to some of the same portions of Miyajima discussed above with respect to the Petition. Reply 27 n.11 (citing Ex. 1005 ¶¶ 38, 40, 64–68; Ex. 1030 ¶¶ 65–69). Petitioner’s assertion is conclusory and again is accompanied by a long citation without sufficient explanation. *Id.* The portions of Miyajima in this citation that were not identified in the Petition are similar to those that were identified in the Petition, except they describe “indicating a status that indicates operational conditions or an alarm.” Ex. 1005 ¶¶ 64–68. We find that the further

description such as indicating operational conditions or an alarm simply provides whether an instrument is operational, not indicating that the measurement data can be measured and, therefore, the further description does not remedy the lack of teaching of detecting whether the measurement data are capable of being measured by any measuring instrument recited in claim 1.

In the same footnote in the Reply, Petitioner also cites to five paragraphs of the Reply Declaration of Mr. Zatarain without explanation or analyses. Reply 27 n.11 (citing *e.g.*, Ex. 1030 ¶¶ 65–69). Additionally, Mr. Zatarain testifies regarding one additional portion of Miyajima that is not identified in the Petition or the Reply. Ex. 1030 ¶¶ 65–69 (citing *e.g.*, Ex. 1005 ¶ 41). Arguments must not be incorporated by reference from one document into another document. *See* 37 C.F.R. § 42.6(a)(3). Although the lack of explanation in the Petition and Reply alone is reason not to consider the testimony and additional evidence (*id.*), as a further, independent reason for our determination, Mr. Zatarain’s testimony and the evidence do not remedy the aforementioned deficiency as the newly identified portion is repetitive of previously discussed portions of Miyajima.¹⁶

We, therefore, find that Petitioner’s assertions in its Reply regarding Miyajima do not remedy the aforementioned deficiency.

¹⁶ We further note that the additional portion describes *the client* obtaining a “list including the names of electronic-measuring-apparatus server apparatuses 300” (Ex. 1005 ¶ 41), not the server, whereas claim 1 requires the server detecting whether any measurement data are capable of being measured (Ex. 1001, 7:56–60).

In its Reply, Petitioner further contends that “even if Patent Owner’s interpretation of its construction is entertained,” Sunshine also discloses detecting the functions that the instrument can perform. Reply 27. In the Petition, however, Petitioner relies on only description in Miyajima for teaching the detecting function. *See* Pet. 38–47; *see also id.* at 64 (explaining in the Petition for the similar recitation in claim 17 that “*Sunshine* does not expressly disclose this limitation, but *Miyajima* teaches this limitation”). In the Reply, relying on the testimony of Mr. Zatarain, Petitioner asserts that in Sunshine, “the server detects if it cannot identify the analyte (thus performing a comparison of the abilities of the instrument to the raw data as Patent Owner requires).” Reply 27 (citing Ex. 1004, 9:9–28; Ex. 1030 ¶¶ 79–80). Mr. Zatarain testifies “*Sunshine* also discloses detecting that the analyte data cannot be processed by the server when a successful comparison of an analyte signature cannot be made.” Ex. 1030 ¶ 80 (citing Ex. 1004, 9:24).

Sunshine describes:

The data codec 22 in the processor 12 accepts the output signature from the field device 10 and then, after appropriate processing, passes it onto the analyte analyzer 26 for analysis. Depending on the detection technique used to detect the unknown analyte 16 and other relevant information which can be provided by the user, the processor 12 accesses the electronic library 14 retrieving the pertinent data corresponding to the signatures of various known analytes. The analyte analyzer 26 then compares the output signature with these known signatures to ascertain the identity of the detected analyte. If desired, the results of the comparison are transmitted to the field device 10 from the processor 12 for use by the user. Alternatively, the results of the comparison can be posted onto a web page for retrieval by the field device 10.

Optionally, if the output signature of the detected analyte is determined to be not currently included in the electronic library 14, the processor 12 can then appropriately update the electronic library 14 to reflect the new output signature and its accompanying information.

Ex. 1004, 9:9–28 (emphasis added).

Contrary to Mr. Zatarain’s testimony, Sunshine describes updating the electronic library, not detecting an inability to measure. Ex. 1004, 9:9–28. Additionally, Petitioner has not explained how Sunshine performs the function of “notifying whether the measurement processing is available,” or whether Petitioner relies on Sunshine for detecting and Miyajima for notifying. Pet. 38–47; Reply 27–28. Indeed, Petitioner relies on this same disclosure in Sunshine for teaching executing measurement processing, also recited in claim 1. *See e.g.*, Pet. 32–38 (citing *e.g.*, Ex. 1004, 9:9–23). We find that Sunshine’s disclosure of detecting analyte 16 (Ex. 1004, 9:9–28) does not teach the detecting limitation recited in claim 1.

As an additional, independent reason we are not persuaded by Petitioner’s contentions in its Reply, Petitioner does not provide sufficient reasoning to combine the prior art teachings in the manner recited in claim 1, that addresses any newly identified portion of Sunshine or Miyajima. Pet. 38–47; Reply 27–28. Indeed, in the Reply, Petitioner relies on the same reasoning to combine and the same contentions regarding how the teachings are combined set forth in the Petition. *See generally* Reply (citing *e.g.*, Ex. 1004, 9:9–28; Ex. 1005 ¶¶ 41, 44). A conclusion of obviousness requires more than a mere assertion that the prior art includes separate references covering each separate limitation in a claim under examination. *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011). Rather, obviousness requires the additional showing that a person of

ordinary skill at the time of the invention would have selected and combined the prior art elements in the normal course of their work to yield the claimed invention. *Id.*

Petitioner does not point to any other evidence or make any assertions (Pet. 38–47; Reply 22–32) that remedy the aforementioned deficiency. Accordingly, we do not find that Petitioner has shown that the combination of Sunshine and Miyajima teaches “detecting whether the measurement data are capable of being measured by any measurement means in the said server apparatus,” recited in claim 1.

For the reasons given and based on the on the record before us, we determine that Petitioner has not shown by a preponderance of the evidence that claim 1 is unpatentable, under 35 U.S.C. § 103(a), over Sunshine and Miyajima.

4. *Discussion of Remaining Challenged Claims*

Petitioner asserts that (1) claims 2, 7–11, 13, 15–18, 23–26, 28, 30, 31, and 38–41 are unpatentable, under 35 U.S.C. § 103(a) as obvious over Sunshine and Miyajima (Pet. 50–72); (2) claims 16, 31, 32, 34, and 35 are unpatentable, under 35 U.S.C. § 103(a) as obvious over Sunshine, Miyajima, and Ezekiel (*id.* at 66, 67, 72–81); and (3) claims 5, 12, 21, and 27 are unpatentable, under 35 U.S.C. § 103(a) as obvious over Sunshine, Miyajima, and Nathanson (*id.* at 81–83).

a) *Claims 2, 7–11, 13, 15–18, 23–26, 28, 30, 31, and 38–41*

We turn to Petitioner’s contentions that claims 2, 7–11, 13, 15–18, 23–26, 28, 30, 31, and 38–41 of the ’940 Patent are unpatentable, under 35

U.S.C. § 103(a) as obvious over Sunshine and Miyajima. Pet. 50–72. Each of claims 2, 7–11, 13, 15, and 16 depends, directly or indirectly, on claim 1. Petitioner’s contentions for dependent claims 2, 7–11, 13, 15, and 16 (Pet. 50–63) do not remedy the deficiencies discussed with respect to claim 1. *See supra* § II.D.3.

We now turn to independent claims 17 and 38–41. As discussed *supra* in Section II.A.2, like claim 1, each of independent claims 17 and 38–41 requires detecting whether the measurement data are capable of being measured. Ex. 1001, 7:58–60, 8:66–9:1, 10:25–27, 10:53–55, 11:3–5, 12:2–3. In particular, independent claim 17 recites “said server apparatus detects whether the measurement data is capable of being processed,” independent claim 38 recites “a detector for indicating if received data is capable of being measured,” independent claim 39 recites “detecting whether the measurement data is capable of being measured,” independent claim 40 recites “the server apparatus detects whether the measurement data is capable of being measured,” and claim 41 recites “detecting if the measurement data can be processed.” Ex. 1001, 8:66–9:1, 10:25–27, 10:53–55, 11:3–5, 12:2–3. Petitioner’s contentions for independent claims 17 and 38–41 (Pet. 63–65, 67–72) reference back to its contentions for claim 1 and do not remedy the deficiencies discussed with respect to claim 1. *See supra* § II.D.3.

Each of dependent claims 18, 23–26, 28, 30, and 31 depends, directly or indirectly, on claim 17. Petitioner’s contentions for dependent claims 18, 23–26, 28, 30, and 31 (Pet. 65–67) reference back to its contentions for dependent claims 2, 7–11, 13, 15, and 16 and do not remedy the deficiencies discussed with respect to claims 1 and 17.

For the reasons given and based on the on the record before us, we determine that Petitioner has not shown by a preponderance of the evidence that claims 2, 7–11, 13, 15–18, 23–26, 28, 30, 31, and 38–41 of the '940 Patent are unpatentable, under 35 U.S.C. § 103(a) as obvious over Sunshine and Miyajima.

b) Claims 16, 31, 32, 34, and 35

We now turn to Petitioner's contentions that claims 16, 31, 32, 34, and 35 of the '940 Patent are unpatentable, under 35 U.S.C. § 103(a) as obvious over Sunshine, Miyajima, and Ezekiel. Pet. 66, 67, 72–81. As discussed *supra* in Section II.A., each of independent claims 1, 17, 32, and 38–41 requires detecting whether the measurement data are capable of being measured. In particular, like claim 1, claim 32 recites “detecting whether the measurement data are capable of being measured.” Ex. 1001, 9:55–10:3. For this limitation, Petitioner references back to its contentions for claim 1 and does not rely on Ezekiel. Pet. 80. Petitioner's contentions for claim 32 do not remedy the lack showing with respect to the detecting limitation and are deficient for the same reasons given for claim 1.

For claims 16, 31, 34, and 35, each depends, directly or indirectly, from claim 1 or claim 17. Petitioner does not rely on Ezekiel for the detecting limitation recited in the independent claims, or otherwise remedy the aforementioned deficiency discussed, for example, *supra* in Section II.D.3. Pet. 62–63, 66–67, 72–81.

For the reasons given and based on the on the record before us, we determine that Petitioner has not shown by a preponderance of the evidence

that that claims 16, 31, 32, 34, and 35 of the '940 Patent are unpatentable, under 35 U.S.C. § 103(a) as obvious over Sunshine, Miyajima, and Ezekiel.

c) Claims 5, 12, 21, and 27

Finally, we turn to Petitioner's contentions that claims 5, 12, 21, and 27 are unpatentable, under 35 U.S.C. § 103(a) as obvious over Sunshine, Miyajima, and Nathanson. Pet. 81–83. Each of claims 5, 12, 21, and 27 depends directly from claim 1 or claim 17. Petitioner does not rely on Nathanson for the detecting limitation recited in the independent claims, or otherwise remedy the aforementioned deficiency discussed, for example, *supra* in Section II.D.3. Pet. 81–83.

For the reasons given and based on the on the record before us, we determine that Petitioner has not shown by a preponderance of the evidence that claims 5, 12, 21, and 27 of the '940 Patent are unpatentable, under 35 U.S.C. § 103(a) as obvious over Sunshine, Miyajima, and Nathanson.

III. PATENT OWNER'S MOTION FOR OBSERVATIONS ON
CROSS-EXAMINATION OF PETITIONER'S REPLY DECLARANT

Patent Owner provides its Motion for Observations on Cross-Examination of Petitioner's Reply declarant, Mr. Zatarain. Paper 21. Petitioner provides its Response. Paper 27. We have considered Patent Owner's Motion and have determined that even upon consideration of Mr. Zatarain's Reply Declaration, Petitioner has not shown that the challenged claims are unpatentable. Accordingly, no further determinations are needed for the purposes of this Final Written Decision.

IV. CONCLUSION

For the foregoing reasons, Petitioner has not established by a preponderance of the evidence that (1) claims 1, 2, 7–11, 13, 15–18, 23–26, 28, 30, 31, and 38–41 are unpatentable, under 35 U.S.C. § 103(a) as obvious over Sunshine and Miyajima; (2) claims 16, 31, 32, 34, and 35 are unpatentable, under 35 U.S.C. § 103(a) as obvious over Sunshine, Miyajima, and Ezekiel; and (3) claims 5, 12, 21, and 27 are unpatentable, under 35 U.S.C. § 103(a) as obvious over Sunshine, Miyajima, and Nathanson.

V. ORDER

Accordingly, it is:

ORDERED that claims 1, 2, 5, 7–13, 15–18, 21, 23–28, 30–32, 34, 35, and 38–41 of the '940 Patent have not been shown to be unpatentable; and

FURTHER ORDERED that because this is a Final Written Decision, parties to the proceeding seeking judicial review of the Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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