

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

AGILYSYS, INC., ET AL.  
Petitioner,

v.

AMERANTH, INC.  
Patent Owner.

---

Case CBM2014-00014  
Patent 8,146,077 B2

---

Before JAMESON LEE, RICHARD E. RICE, and STACEY G. WHITE,  
*Administrative Patent Judges.*

RICE, *Administrative Patent Judge.*

DECISION  
Denying Institution of Covered Business Method Patent Review  
*37 C.F.R. § 42.208*

## INTRODUCTION

Agilysys, Inc. and 34 other entities<sup>1</sup> (collectively, “Petitioner”), filed an amended petition (“Pet.”) requesting a review under the transitional program for covered business method patents of U.S. Patent No. 8,146,077 B2 (Ex. 1001, “the ’077 patent”). Paper 8. Ameranth, Inc. (“Patent Owner”) filed a preliminary response (“Prelim. Resp.”). Paper 10. We have jurisdiction under 35 U.S.C. § 324.<sup>2</sup>

The standard for instituting a covered business method patent review is set forth in 35 U.S.C. § 324(a), which provides:

**THRESHOLD**—The Director may not authorize a post-grant review to be instituted unless the Director determines that the information presented in the petition filed under section 321, if

---

<sup>1</sup> Expedia, Inc., Fandango, LLC, Hotel Tonight, Inc., Hotwire, Inc., Hotels.com, L.P., Kayak Software Crop., Live Nation Entertainment, Inc., Micros Systems, Inc., Orbitz, LLC, Opentable, Inc., Papa John’s USA, Inc., Stubhub, Inc., Ticketmaster, LLC., Travelocity.com LP, Wanderspot LLC, Pizza Hut, Inc., Pizza Hut of America, Inc., Domino’s Pizza, Inc., Domino’s Pizza, LLC, Grubhub, Inc., Seamless North America, LLC, Order.in, Inc., Mobo Systems, Inc., Starbucks Corporaton, Eventbrite, Inc., Best Western International, Inc., Hilton Resorts Corp., Hilton Worldwide, Inc., Hilton International Co., Hyatt Corporation, Marriott International, Inc., Starwood Hotels & Resorts Worldwide, Inc., Usablenet, Inc., and Apple, Inc.

<sup>2</sup> See § 18(a) of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284, 329 (2011) (“AIA”) (providing that the transitional program for covered business method patents will be regarded as a post-grant review under chapter 32 of title 35, United States Code, and will employ the standards and procedures of a post-grant review, subject to certain exceptions).

such information is not rebutted, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.

Petitioner challenges the patentability of claims 1-18 of the '077 patent under 35 U.S.C. §§ 101, 112 ¶ 1, and 112 ¶ 2. Taking into account Patent Owner's preliminary response, we determine that the information presented in the petition does not establish that at least one of the challenged claims is more likely than not unpatentable. Accordingly, we do not institute a covered business method patent review as to any claim of the '077 patent. The petition is *denied*.

#### *A. Petitioner's Standing*

Section 18 of the AIA governs the transitional program for covered business method patent reviews. Section 18(a)(1)(B) of the AIA limits the filing of a petition for such reviews to persons or their privies who have been sued or charged with infringement of a covered business method patent.

Each of the entities listed as Petitioner asserts that it has been sued for infringement of the '077 patent. Pet. 25-26 (identifying 30 separate district court litigations).

#### *B. The '077 patent*

The '077 patent alleges that an inherent problem of personal digital assistant ("PDA") devices is that the small size of their displays limits the amount of information that may be displayed at any one time. Ex. 1001, 1:54-62. PDAs have not been "quickly assimilated into the restaurant and

hospitality industries,” according to the patent, because “their small display sizes are not readily amenable to display of menus as they are commonly printed on paper or displayed on, e.g., large, color desktop computer screens.” *Id.* at 2:12-17. A principal object of the ’077 patent “is to provide an improved information management and synchronous communications system and method which facilitates . . . generation of computerized menus for restaurants and other applications that utilize equipment with non-PC-standard graphical formats, display sizes and/or applications.” *Id.* at 2:61-67.

The specification of the ’077 patent describes a procedure for configuring a menu on a desktop computer and then downloading the menu configuration onto a point of sale (“POS”) interface on a handheld device. *Id.* at 7:44-47. The procedure comprises the following steps:

1. Add Modifiers;
2. Add Sub-Modifiers and link them to the Modifiers;
3. Create Menu categories;
4. Add menu items to the categories;
5. Assign Modifiers to the menu items;
6. Preview the menu on the POS emulator on the desktop PC;
7. Download the menu database to the handheld device.

*Id.* at 8:28-36. “[M]enu items are stored using a tree metaphor similar to how files are stored on a PC with folders and subfolders.” *Id.* at 8:4-6.

In the preferred embodiment, a “synchronous communications control module . . . provides a single point of entry for all hospitality applications to communicate with one another wirelessly or over the Web.” *Id.* at 12:39-42. “The single point of entry works to keep all wireless handheld devices

and linked Web sites in synch with the backoffice server (central database),” such that, for example, “a reservation made online is automatically communicated to the backoffice server which then synchronizes with all the wireless handheld devices wirelessly.” *Id.* at 12:47-54.

Figure 9 of the '077 patent is reproduced below:

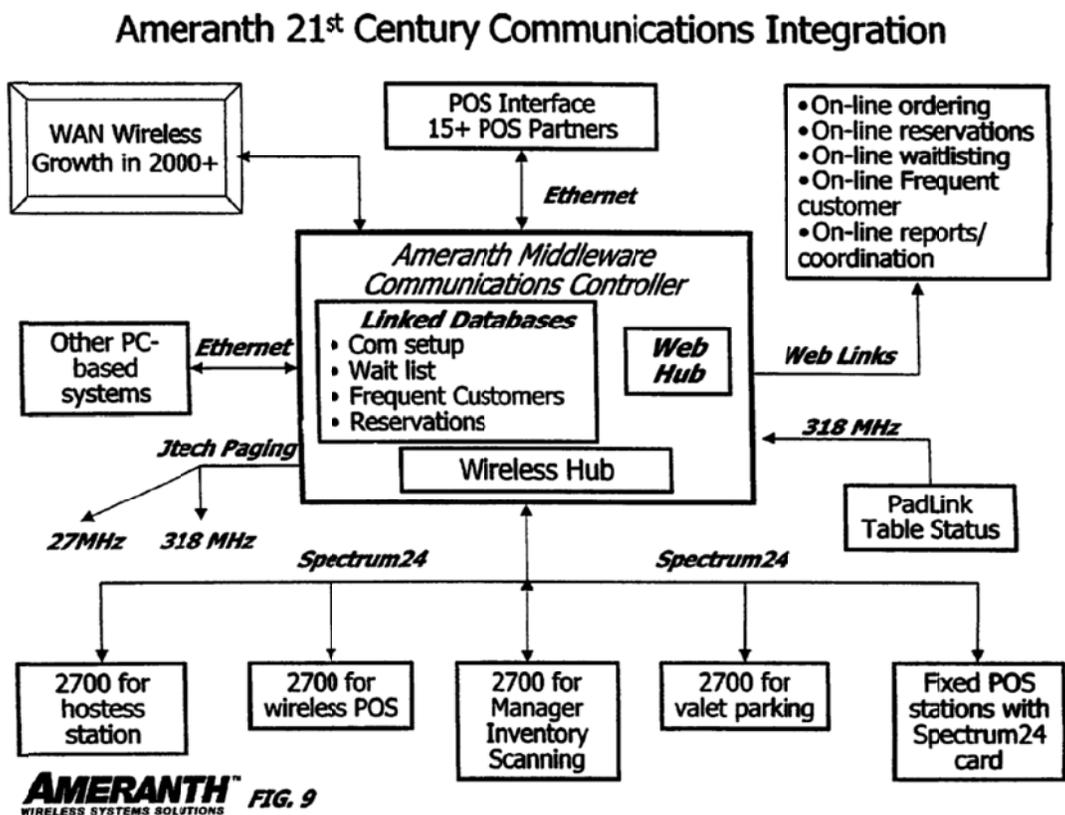


Figure 9 is an exemplary system diagram that illustrates how “[a] single point of entry works to keep all wireless handheld devices and linked web sites in synch with the backoffice server applications so that the different

components are in equilibrium at any given time and an overall consistency is achieved.” *Id.* at 5:29-33.

### *C. Illustrative Claims*

Claims 1, 9, and 13 are independent. Claims 2-8 depend from claim 1, claims 10-12 depend from claim 9, and claims 14-18 depend from claim 13. Claims 1, 7, and 13 are illustrative of the '077 patent, and are reproduced below:

1. An information management and real time synchronous communications system for configuring and transmitting hospitality menus comprising:
  - a. a central processing unit,
  - b. a data storage device connected to said central processing unit,
  - c. an operating system including a first graphical user interface,
  - d. a master menu including at least menu categories, menu items and modifiers, wherein said master menu is capable of being stored on said data storage device pursuant to a master menu file structure and said master menu is capable of being configured for display to facilitate user operations in at least one window of said first graphical user interface as cascaded sets of linked graphical user interface screens, and
  - e. menu configuration software enabled to generate a programmed handheld menu configuration from said master menu for wireless transmission to and programmed for display on a wireless handheld computing device, said programmed handheld menu configuration comprising at least menu categories, menu items and modifiers and wherein the menu configuration software is enabled to generate said programmed handheld menu configuration by utilizing parameters from the master menu file structure defining at least the menu categories, menu items and modifiers of the master menu such that at least

the menu categories, menu items and modifiers comprising the programmed handheld menu configuration are synchronized in real time with analogous information comprising the master menu,

wherein the menu configuration software is further enabled to generate the programmed handheld menu configuration in conformity with a customized display layout unique to the wireless handheld computing device to facilitate user operations with and display of the programmed handheld menu configuration on the display screen of a handheld graphical user interface integral with the wireless handheld computing device, wherein said customized display layout is compatible with the displayable size of the handheld graphical user interface wherein the programmed handheld menu configuration is configured by the menu configuration software for display as programmed cascaded sets of linked graphical user interface screens appropriate for the customized display layout of the wireless handheld computing device, wherein said programmed cascaded sets of linked graphical user interface screens for display of the handheld menu configuration are configured differently from the cascaded sets of linked graphical user interface screens for display of the master menu on said first graphical user interface, and

wherein the system is enabled for real time synchronous communications to and from the wireless handheld computing device utilizing the programmed handheld menu configuration including the capability of real time synchronous transmission of the programmed handheld menu configuration to the wireless handheld computing device and real time synchronous transmissions of selections made from the handheld menu configuration on the wireless handheld computing device, and

wherein the system is further enabled to automatically format the programmed handheld menu configuration for display as cascaded sets of linked graphical user interface screens appropriate for a customized display layout of at least

two different wireless handheld computing device display sizes in the same connected system, and

wherein a cascaded set of linked graphical user interface screens for a wireless handheld computing device in the system includes a different number of user interface screens from at least one other wireless handheld computing device in the system.

7. The information management and real time synchronous communications system in accordance with claim 1, further enabled to facilitate and complete payment processing directly from the wireless handheld computing device including: a) Billing; b) Status and c) Payment Information.

13. An information management and real time synchronous communications system for use with wireless handheld computing devices and the internet comprising:

a. a master database connected in said system and configured to store hospitality application information pursuant to a master database file structure;

b. at least one wireless handheld computing device connected in said system and configured to display said hospitality application information;

c. at least one web server connected in said system;

d. at least one web page connected in said system and configured to display said hospitality application information; and

e. real time communications control software enabled to link and synchronize hospitality application information simultaneously between the master database, wireless handheld computing device, web server and web page,

wherein the communications control software is enabled to utilize parameters from the master database file structure to synchronize the hospitality application information in real time

between the master database, at least one wireless handheld computing device, at least one web server and at least one web page such that substantially the same information comprising the hospitality application information is capable of being displayed on the wireless handheld computing device, at least one web page and other display screens of the synchronized system, such that the hospitality application information is synchronized between any connected users,

wherein the communications control software is enabled to act as a real time interface between the elements of the system and any applicable communications protocol,

wherein the communications control software is enabled to automatically and simultaneously configure the hospitality application information for display on both the wireless handheld computing device and the web page in conformity with a customized display layout unique to the wireless handheld computing device or the web page, wherein said customized display layout is compatible with the displayable size of the handheld computing device display screen or the web page, and

wherein the communications control software is further enabled to automatically format a programmed handheld configuration for display as cascaded sets of linked graphical user interface screens appropriate for a customized display layout of at least two different wireless handheld computing device display sizes in the same connected system, and

wherein a cascaded set of linked graphical user interface screens for a wireless handheld computing device in the system includes a different number of user interface screens from at least one other wireless handheld computing device in the system, and

wherein the system is enabled for real time synchronous transmission of the configured hospitality application information to the wireless handheld computing device, the web server and the web page and real time synchronous transmissions of inputs responding to the configured hospitality

application information from the wireless handheld computing device, or the web server or the web page.

*D. Covered Business Method Patent*

*1. Financial Product or Service*

Under § 18(a)(1)(E) of the AIA, the Board may institute a transitional proceeding only for a patent that is a “covered business method patent.” A “covered business method patent” is a patent that “claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.” AIA § 18(d)(1); *see* 37 C.F.R. § 42.301(a). For purposes of determining whether a patent is eligible for a covered business method patent review, the focus is on the claims. *See* Transitional Program for Covered Business Method Patents—Definitions of Covered Business Method Patent and Technological Invention; Final Rule, 77 Fed. Reg. 48,734, 48,736 (Aug. 14, 2012). A patent need have only one claim directed to a covered business method to be eligible for review. *Id.* The legislative history of the AIA “explains that the definition of covered business method patent was drafted to encompass patents ‘claiming activities that are financial in nature, incidental to a financial activity or complementary to a financial activity.’” 77 Fed. Reg. at 48,735 (Aug. 14, 2012) (quoting 157 Cong. Rec. S5432 (daily ed. Sept. 8, 2011)).

Patent Owner does not dispute Petitioner’s contention (*see* Pet. 29) that the scope of the claims, including claim 7 in particular, encompasses

“payment processing.” Rather, Patent Owner argues that the claimed invention is not directed to “‘payment processing’ . . . *per se*,” but rather to “specialized computer software system functionality” that may be used in that context. Prelim. Resp. 9. Patent Owner further argues that “use of the inventions in a business to make money does not transform [them] into ‘financial services.’” *Id.*

Claim 7 of the ’077 patent is directed expressly to “payment processing,” and therefore, is at least “incidental to a financial activity” and/or “complementary to a financial activity.” *See* 77 Fed. Reg. at 48,735. Accordingly, we agree with Petitioner that claim 7 satisfies the “financial product or service” component of the definition set forth in § 18(d)(1) of the AIA.

## 2. *Technological Invention Exception*

The definition of a “covered business method patent” in § 18(d)(1) of the AIA does not include patents for “technological inventions.” To determine whether a patent is for a technological invention, we consider “whether the claimed subject matter as a whole recites a technological feature that [1] is novel and unobvious over the prior art [‘first prong’]; and [2] solves a technical problem using a technical solution [‘second prong’].” 37 C.F.R. § 42.301(b). Both the first prong and the second prong must be met for the exception to apply.

The following claim drafting techniques typically do not render a patent a “technological invention”:

(a) Mere recitation of known technologies, such as computer hardware, communication or computer networks, software, memory, computer-readable storage medium, scanners, display devices or databases, or specialized machines, such as an ATM or point of sale device.

(b) Reciting the use of known prior art technology to accomplish a process or method, even if that process or method is novel and non-obvious.

(c) Combining prior art structures to achieve the normal, expected, or predictable result of that combination.

Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,764 (Aug. 14, 2012).

With respect to the first prong, Petitioner argues that, as described in the '077 patent, the claimed subject matter does not recite a technological feature that is novel and unobvious over the prior art, because the claims recite merely computer-implemented functions or methods using known techniques. Pet. 35-36. Petitioner points to the statements in the specification that “[t]he software applications for performing the functions falling within the described invention can be written in any commonly used computer language” and “[t]he discrete programming steps are commonly known . . . .” *Id.* at 35 (quoting Ex. 1001, 12:57-61). Petitioner also directs us to statements in the specification that “[t]he inventive concept encompasses the generation of a menu in any context known to those skilled in the art where an objective is to facilitate display of the menu so as to enable selection of items from that menu” and “[a]ny display and transmission means known to those skilled in the art is equally usable with

respect to menus generated in accordance with the claimed invention.” *Id.* (quoting Ex. 1001, 15:26-37).

Patent Owner responds that a technological feature of every claim of the '077 patent is the functionality of specialized software to synchronize handheld computing device displays. Prelim. Resp. at 25-26 (pointing out claims directed to “synchronization of computerized menus . . . between a central/master menu/database and a wireless handheld computing device”).

Patent Owner also responds that:

core inventive concepts described in the '077 patent and reflected in the claims include software functionality for automatically transforming, reconfiguring, and correctly relinking the cascading tier structures of hospitality menu information for display and operation on different types and sizes of computerized devices (desktop PCs, laptops, smartphones, etc.), and synchronizing such hospitality data, and changes thereto, across the computerized system without the necessity of individualized updates/revisions to each device.

*Id.* at 26. Patent Owner additionally argues that “[w]hether certain aspects of the entire claimed system might have been known in the prior art is irrelevant” and that [t]he combination of all of the claimed features (including the novel features discussed above), considered as a whole, comprises a technological feature that was novel and unobvious over the prior art at the time of the invention.” *Id.*

Upon consideration of the respective positions of the parties, we are persuaded that the '077 patent does not qualify under the first prong of the technological invention exception. The issue is not whether the combination of features recited in any particular claim is patentable, but whether a

technological feature of the subject matter of the claims as a whole is novel and unobvious. *See* 37 C.F.R. § 42.301(b).

We are persuaded that the recited software functionality, on which Patent Owner relies, is not novel and unobvious, but rather the predictable and expected result of known programming steps. As Petitioner argues, the patent specification itself describes the “discrete programming steps” for creating the recited software functionality as “commonly known.” *See* Pet. 35 (citing Ex. 1001, 12:57-61). In addition, the specification discloses that, at the time of the invention, organizations had not made “the efforts or investments to establish automated interfaces to handheld and Web site menus and ordering options” due to “the unavailability of any simple technique for creating restaurant menus and the like for use in a limited display area wireless handheld device or that is compatible with ordering over the internet” (Ex. 1001, 2:52-60). The specification also discloses that use of menus was “conventional in GUIs [graphical user interfaces] for software applications,” including “cascading sets of menus which are displayable in context to show the parent/child relationships between options . . . .” *Id.* at 6:37-51. The specification states, moreover, that “[a] menu system of this type is incorporated into the preferred embodiment of the invention.” *Id.* at 6:51-53. On this record, we determine that the claimed subject matter of the ’077 patent, as a whole, does not recite a technological feature that is novel and unobvious over the prior art.<sup>3</sup>

---

<sup>3</sup> We do not need to decide whether the claims of the ’077 patent are directed

We conclude that the '077 patent is a “covered business method patent” eligible for a covered business method patent review.

*E. Alleged Grounds of Unpatentability*

Petitioner challenges claims 1-18 of the '077 patent based on the alleged grounds of unpatentability set forth in the table below:

<b>Basis</b>	<b>Challenged Claims</b>
§ 112 ¶ 2	1-18
§ 112 ¶ 1	1-18
§ 101	1-18

II. ANALYSIS

*A. Claim Construction*

As a first step in our analysis for determining whether to institute a covered business method patent review, we determine the meaning of the claims. In a covered business method patent review, a claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears. 37 C.F.R. § 42.300(b).

Patent Owner brings to our attention four district court claim construction decisions: three in Case No. 2:07-cv-00271-TJW-CE (E.D. Tex.), involving U.S. Patent Nos. 6,384,850 (the '850 patent), 6,871,325

---

to solving a technical problem using a technical solution. *See* Pet. 34-36; Prelim. Resp. 28-29.

(“the ’325 patent”), and 6,982,733 (“the ’733 patent”) (Exs. 2014, 2015, 2016), and one in Case No. 2:10-CV-294-JRG-RSP (E.D. Tex.), involving the ’850 patent and the ’325 patent (Ex. 2017). Prelim. Resp. 31. Patent Owner requests that we adopt “all of the previous judicial constructions (Exhs. 2014-2017).” *Id.* We understand that the ’850 patent, the ’325 patent, and the ’733 patent are in the same patent family as the ’077 patent. However, even assuming that common terms in this family of patents should be construed consistently, and that the district court constructions are consistent with the broadest reasonable construction standard, we are not persuaded that construction of all the terms that have been construed are necessary to our decision in this case. Therefore, we deny Patent Owner’s request.

Petitioner proposes that each claim term or phrase be given its ordinary and customary meaning, but nevertheless, provides explicit constructions for seven claim terms. We will address only two of them, as construction of the others is not necessary to our decision. We will also discuss three additional terms that require construction.

*1. “hospitality application information” (claim 13)*

Neither party proposes a construction of “hospitality application information.” The meaning of this term, however, is material to Petitioner’s patentability challenge to claims 13-18 under § 101 for nonstatutory subject matter, discussed below.

We give the claim term “hospitality application information” its broadest reasonable construction, consistent with the specification, as

“information used to perform services or tasks in the hospitality industry.”  
*See, e.g.*, Ex. 1001, 5:17-18 (“hospitality applications, e.g., reservations, frequent customer ticketing, wait lists, etc.”); 12:33-34 (referring to “computerized hospitality applications”).

2. *“the hospitality application information is synchronized between any connected users” (claim 13)*

Petitioner does not propose an explicit construction for the phrase “the hospitality application information is synchronized between any connected users,” recited in claim 13, but rather contends that the phrase should be given its plain and ordinary meaning under the broadest reasonable construction standard. Pet. 40. Patent Owner contends that the claim term “synchronized,” included in that phrase, should be construed as “made to be the same.” *See* Prelim. Resp. 35.

The plain meaning of “synchronized” is “[made] synchronous in operation,” and the plain meaning of “synchronous” is “happening, existing or arising at precisely the same time.” *See* MERRIAM WEBSTER’S COLLEGIATE DICTIONARY 1196 (10th ed. 1993). The usage of “synchronized” in the specification is consistent with its plain meaning. *See, e.g.*, Ex. 1001, 2:38-41 (“a reservation made online would be automatically communicated to the backoffice server and then synchronized with all the wireless handheld devices wirelessly”); *see also id.* at 12:47-54 (“a reservation made online is automatically communicated to the backoffice server which then synchronizes with all the wireless handheld devices wirelessly”). On the present record, we do not agree with Patent Owner’s

proposed claim construction, because it does not reflect the “same time” aspect of the plain meaning of “synchronized.” We give the claim term “synchronized” its broadest reasonable construction, consistent with the specification, as “made to happen, exist, or arise at the same time.”

The parties disagree on whether the phrase “the hospitality application information is synchronized between any connected users” should be construed as a method step. *See* Pet. 40; Prelim. Resp. 34-35. We discuss this issue below in connection with Petitioner’s § 112 ¶ 2, unpatentability ground relating to the disputed phrase.

3. *“at least the menu categories, menu items and modifiers comprising the programmed handheld menu configuration are synchronized in real time with analogous information” (claims 1 and 9)*

Petitioner contends that the phrase “at least the menu categories, menu items and modifiers comprising the programmed handheld menu configuration are synchronized in real time with analogous information,” recited in each of claims 1 and 9, should be construed as a method step. Pet. 40-41. We discuss this issue below in connection with Petitioner’s § 112 ¶ 2, unpatentability ground relating to that phrase.

4. *“graphical user interface screens”*

Neither party proposes a construction of “graphical user interface screens.” The meaning of this term, however, is material to Petitioner’s patentability challenge under § 112 ¶ 1, for lack of written description, with respect to “cascaded sets of linked graphical user interface screens,” discussed below.

In its written description challenge, Petitioner argues that “[a]lthough the ’077 Patent describes the use of ‘cascading sets of menus’ *on a single graphical user interface*, the ’077 Patent fails to describe the use of ‘cascading sets of linked graphical user interface screens’ as recited by the Challenged Claims.” Pet. 44 (emphasis added); *see also id.* at 43 (referencing Ex. 1001, 14:37-63). We are not persuaded by Petitioner’s argument.

The specification describes a graphical user interface comprising a plurality of screen displays. *E.g.*, Ex. 1001, 6:37-51:

The use of menus is conventional in GUIs for software applications. . . . [I]n a typical desktop or interactive application, selection of a “file” from a menu bar may cause display of a context menu which provides “file” options. File options can have additional subordinate or child options associated with them. If a file option having subordinate options is selected, the child options are displayed in context in a child menu or submenu proximate to the selected parent option. One or more of the child options provided in the child menu may have further subordinate options. Thus, such a menu system comprises cascading sets of menus which are displayable in context to show the parent/child relationships between options of the context menu.

The “cascading sets of menus,” described in the portion of the specification quoted above, are cascading sets of screen displays.

We give the claim term “graphical user interface screens” its broadest reasonable construction, consistent with the specification, as “a plurality of screen displays that provide an interface for user operations, such as menu selections.”

5. *“unique to the wireless handheld computing device”*

Neither party proposes a construction of “unique to the wireless handheld computing device.” The meaning of this term, however, is material to Petitioner’s patentability challenge under § 112 ¶ 1, for lack of written description, with respect to “customized display layout unique to the wireless handheld computing device,” discussed below.

We determine that the broadest reasonable construction of “unique,” consistent with the specification, is “distinctly characteristic.” *See* MERRIAM WEBSTER’S COLLEGIATE DICTIONARY 1292 (10th ed. 1993). Therefore, we construe “unique to the wireless handheld computing device” to mean distinctly characteristic of the wireless handheld computing device.

6. *Remaining Claim Terms or Phrases*

All remaining claim terms or phrases recited in claims 1-18 are given their ordinary and customary meaning, as would be understood by one with ordinary skill in the art, and need not be construed explicitly at this time.

*B. 35 U.S.C. § 112 ¶ 2 Ground of Unpatentability*

As mentioned above, the parties dispute whether the claim term “the hospitality application information is synchronized between any connected users,” in claim 13, and the claim term “at least the menu categories, menu items and modifiers comprising the programmed handheld menu configuration are synchronized in real time with analogous information,” in each of claims 1 and 9, should be construed as method steps. The parties also dispute whether claims 1-18 are unpatentable under 35 U.S.C.

§ 112 ¶ 2, as indefinite, for mixing apparatus and method elements. *See* Pet. 40, 56-60; Prelim. Resp. 34-36, 50-56. We discuss these issues below.

1. *“the hospitality application information is synchronized between any connected users” (claim 13)*

Petitioner contends that the phrase “the hospitality application information is synchronized between any connected users” is a method step and that system claim 13, therefore, is unpatentable as indefinite for mixing apparatus and method elements. *See* Pet. 40, 56-57 (citing *IPXL Holdings, LLC v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005) (holding indefinite a claim covering both an apparatus and a method of using that apparatus)).

Patent Owner disputes Petitioner’s contention. Prelim. Resp. 34-35. Patent Owner relies on an interlocutory district court decision in Case 3:12-cv-01633-JLS-NLS (S.D. Cal. 2013), holding that claim 13 is not a hybrid apparatus and method claim, because “synchronized” does not require any user action, but describes merely the ability of the system to synchronize applications and data between devices. *Id.* at 35-36; *see* Ex. 2018 (Order filed Jul. 5, 2013) at 15-17.

We agree with Patent Owner that the disputed phrase of claim 13 is a functional requirement and is not a method step. The phrase is part of a larger clause defining software functionality:

wherein the communications control software is enabled to utilize parameters from the master database file structure to synchronize the hospitality application information in real time between the master database, at least one wireless handheld computing device, at least one web server and at least one web

page such that substantially the same information comprising the hospitality application information is capable of being displayed on the wireless handheld computing device, at least one web page and other display screens of the synchronized system, *such that the hospitality application information is synchronized between any connected users* [emphasis added].

As such, claim 13 is directed to a system comprising communications control software that is capable of performing the recited functions. *See Microprocessor Enhancement Corp. v. Texas Instruments Inc.*, 520 F.3d 1367, 1375 (Fed. Cir. 2008) (distinguishing *IPXL Holdings* in a case involving an apparatus claim that was “clearly limited to a [] processor possessing the recited structure and *capable* of performing the recited functions”). Accordingly, we are not persuaded that claim 13 is indefinite as a hybrid apparatus and method claim.

2. “*at least the menu categories, menu items and modifiers comprising the programmed handheld menu configuration are synchronized in real time with analogous information*” (claims 1 and 9)

Petitioner contends that the phrase “at least the menu categories, menu items and modifiers comprising the programmed handheld menu configuration are synchronized in real time with analogous information,” recited in each of claims 1 and 9, should be construed as a method step. Pet. 40-41. Petitioner asserts that each of system claims 1 and 9 is unpatentable as indefinite for mixing apparatus and method elements. *See id.* at 56-57 (citing *IPXL Holdings*, 430 F.3d at 1384). Patent Owner disputes Petitioner’s construction and cites the interlocutory district court

decision, discussed above, holding that claims 1 and 9 (as well as claim 13) are not hybrid apparatus and method claims. *See* Prelim. Resp. at 35-36; Ex. 2018 at 15-17).

We agree with Patent Owner that the disputed phrase of claims 1 and 9 is a functional requirement and is not a method step. In each of claims 1 and 9, the disputed phrase is part of a larger clause “e,” which defines software functionality:

e. menu configuration software enabled to generate a programmed handheld menu configuration from said master menu for wireless transmission to and programmed for display on a wireless handheld computing device, said programmed handheld menu configuration comprising at least menu categories, menu items and modifiers and wherein the menu configuration software is enabled to generate said programmed handheld menu configuration by utilizing parameters from the master menu file structure defining at least the menu categories, menu items and modifiers of the master menu *such that at least the menu categories, menu items and modifiers comprising the programmed handheld menu configuration are synchronized in real time with analogous information* comprising the master menu [emphasis added].

As such, claims 1 and 9 are each directed to a system comprising menu configuration software that is capable of performing the functions recited in clause “e.” *See Microprocessor Enhancement Corp.*, 520 F.3d at 1375. Accordingly, we are not persuaded that claims 1 and 9 are indefinite as hybrid apparatus and method claims.

*C. 35 U.S.C. § 112 ¶ 1 Ground of Unpatentability*

Petitioner asserts that claims 1-18 of the '077 patent are unpatentable under 35 U.S.C. § 112 ¶ 1, for lack of written description. For the reasons discussed below, we are not persuaded that the challenged claims are unpatentable on that ground.

*1. The Written Description Requirement*

In order to satisfy the written description requirement, “the specification must describe an invention understandable to [a person of ordinary skill in the art] and show that the inventor actually invented the invention claimed.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). “[T]he test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Id.* (citations omitted). “[T]he level of detail required to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology.” *Id.* (citing *Capon v. Eshhar*, 418 F.3d 1349, 1357-58 (Fed. Cir. 2005)). The claimed invention need not be recited *in haec verba* in the specification, but “a description that merely renders the invention obvious does not satisfy the requirement.” *Id.* at 1352 (citing *Lockwood v. Am. Airlines*, 107 F.3d 1565, 1571-72 (Fed. Cir.1997)).

*2. “Cascaded sets of linked graphical user interface screens”*

Petitioner contends that the specification of the '077 patent fails to describe “in any detail” the limitation “cascaded sets of linked graphical user

interface screens,” as recited in independent claims 1, 9, and 13. Pet. 43. Petitioner argues that “[t]he only mention of ‘cascading’ in the ‘077 Patent is in reference to ‘cascading sets of menus.’” *Id.* (citing Ex. 1001, 6:37-53). Petitioner further argues that “[a]lthough the ’077 Patent describes the use of ‘cascading sets of menus’ on a single graphical user interface, the ’077 Patent fails to describe the use of ‘cascading sets of linked graphical user interface screens’ as recited by the Challenged Claims.” *Id.* at 44 (referencing Ex. 1001, 14:61-63).

Patent Owner argues in response that the specification supports this limitation. Prelim. Resp. 43 (citing Ex. 1001, 6:43-53). In particular, Patent Owner argues that the specification describes displaying menus as cascaded sets of, e.g., linked Web pages, which a person of ordinary skill would recognize as “cascaded sets of linked graphical user interface screens.”

Each menu of the system, as disclosed in the specification, may be displayed and navigation between a master menu and submenu is accomplished through linked GUI screens, for example in different Web pages, as would be easily understood by persons of skill in the art. (*See, e.g.*, ’077 col. 13:13-15:46 (discussion of master menus, modified menus, and menus generated to comply with particular criteria)).

*Id.* at 44. Patent Owner further argues:

Additionally, Figures 6-8 show display screens and Figure 7 shows menus displayed in a “PDA or Web page format,” or otherwise described as “page type” format (’077 col. 11:34-41) which any true POSA would know are also, e.g., different linked screens (in one particular embodiment of the invention).

*Id.*

As Patent Owner argues (*id.* at 43-44), the specification describes cascaded sets of linked screen displays that provide an interface for user operations, such as menu selections. Such screen displays are “graphical user interface screens,” as construed above.

For the foregoing reasons, we are not persuaded that the ’077 patent fails to describe adequately “cascaded sets of linked graphical user interface screens,” as required by claims 1, 9, and 13.

3. “*A customized display layout unique to the wireless handheld computing device*”

Petitioner argues that the specification of the ’077 patent “fails to describe configuring menus (or hospitality application information) with a display layout ‘*unique to the wireless handheld computing device*,’” as recited in independent claims 1, 9, and 13. Pet. 45. Petitioner acknowledges that the ’077 patent describes customizing the menus during design to “be configured for *particular requirements* since fully customizable menu generation and display are contemplated” (*id.*, citing Ex. 1001, 11:42-44), but contends that “there is no written description in the ’077 Patent describing that the customization may include ‘a display layout *unique to the wireless handheld computing device*’” (*id.* at 45-46).

Patent Owner responds that the specification describes the use of “customized layout, views and fonts” (Prelim. Resp. 46, citing Ex. 1001, 10:20 – 11:14), “the display of menus on a variety of devices, including PDAs and Web pages (*id.*, citing Ex. 1001, 15:26-37, 2:61-67, 11:33-44), and customizing a POS device “with respect to ‘look and feel’ for the

particular version” (*id.*, quoting Ex. 1001, 11:46-48). Patent Owner argues that “[d]esigning for the ‘look and feel’ is designing for the ‘display layout’ and the ‘particular version’ is that version unique to the target device.” *Id.*

We are persuaded that the specification describes customizing display layouts for particular versions of handheld computing devices. Petitioner has not explained adequately why such customization is not “unique to the wireless handheld computing device,” as construed above.

For the foregoing reasons, we are not persuaded that the ’077 patent fails to describe adequately “a customized display layout unique to the wireless handheld computing device,” as required by claims 1, 9, and 13.

4. *“A customized display layout of at least two different wireless handheld computing device display sizes”*

Petitioner contends that “the ’077 Patent fails to describe in any detail a customized display layout of ‘at least two different wireless handheld computing device display sizes,’” as recited in independent claims 1, 9, and 13. Pet. 46. More specifically, Petitioner argues that “converting a menu to a ‘small PDA-sized display,’” as described in the specification, “suggests creating a display layout for a single wireless handheld computing device display size (i.e., a ‘small PDA-sized display’), as opposed to the ‘two different wireless handheld computing device display sizes’ recited in the Challenged Claims.” *Id.* at 47 (referencing Ex. 1001, 3:42-46).

Patent Owner responds that the specification expressly describes customizing display layouts for any number of handheld computing devices, and that a person of ordinary skill in the art would understand the

specification to teach “two or more views/sizes.” *See* Prelim. Resp. 48-49. Patent Owner points out that the specification discloses ““**multiple** handheld devices”” (*id.* at 48, citing Ex. 1001, 12:28-31), “the use of ‘customized layout, views, and fonts’” (*id.*, citing Ex. 1001, 10:20 – 11:14), “the display of menus on a variety of devices, including PDAs . . . and Web pages . . .” (*id.*, citing Ex. 1001, 15:26-37, 2:61-67, 11:33-44), and customizing “with respect to ‘look and feel’ for the particular version” (*id.*, 11:46-47).

We are persuaded that the specification discloses customizing the display layout of each of two or more devices having different screen display sizes. A “principal object” of the ’077 patent is to accommodate “non-PC-standard graphical formats[ and] display sizes.” Ex. 1001, 2:61-67. Further, we are not apprised of any restriction in the specification on use of known wireless handheld computing devices having different display sizes in the disclosed synchronous communications system, or any disclosure that the ability to customize display layout is limited to just a single display size. The portion of the specification cited by Petitioner refers to a *plurality* of handheld computing device display sizes, and does not suggest creating a display layout for just a single wireless handheld computing device display size, contrary to Petitioner’s argument. *See* Pet. 47; Ex. 1001, 3:42-46 (“The menu generation approach . . . has many advantages . . . in solving the problem of converting paper-based menus or Windows® PC-based menu screens to *small PDA-sized displays* and Web pages.”) (emphasis added).

For the foregoing reasons, we are not persuaded that the ’077 patent fails to describe adequately “a customized display layout of at least two

different wireless handheld computing device display sizes,” as required by claims 1, 9, and 13.

5. “A *different number of user interface screens from at least one other wireless handheld computing device*”

Petitioner argues that “the ’077 Patent fails to describe in any detail a user interface that ‘includes a different number of user interface screens from at least one other wireless handheld computing device in the system,’” as recited in claims 1, 9, and 13. Pet. 47. Petitioner additionally argues that the patent does not describe “the use of a different number of user interface screens for more than one wireless handheld device.” *Id.* at 47-48.

Petitioner’s arguments are not persuasive.

The limitation “a different number of user interface screens from at least one other wireless handheld computing device” appears in a clause that reads:

wherein a cascaded set of linked graphical user interface screens for a wireless handheld computing device in the system includes *a different number of user interface screens from at least one other wireless handheld computing device in the system.* [Emphasis added].

As discussed above, the specification discloses a system that uses multiple wireless handheld computing devices, as well as cascaded sets of linked graphical user interface screens. *See, e.g.*, Ex. 1001, 6:49-53, 11:33-44, 12:28-31. The issue is whether the specification adequately describes that the number of screens in a cascaded set for use on one handheld device can be different than the number of screens in a cascaded set for use on one or more other handheld devices, as required by the clause quoted above.

Figure 7 is a schematic representation of a POS interface on a wireless handheld device for use in displaying page menus. *Id.* at 6:1-3, 11:33-44. The specification discloses that the screen display could be configured differently than Figure 7, “*for particular requirements[,] since fully customizable menu generation and display are contemplated.*” *Id.* at 11:41-44 (emphasis added). “[I]n the restaurant menu generation embodiment, a modified menu can be generated to comply with a particular specification or group of criteria such as, e.g., ‘dinner,’ ‘low cholesterol,’ ‘low fat,’ ‘fish,’ ‘chicken,’ or ‘vegetarian.’” *Id.* at 15:6-9. “[T]he invention encompasses any combination of automatic and manual user selection of the items comprising the generated menu.” *Id.* at 15:16-18.

Petitioner has not explained sufficiently why the description in the specification of customizable menu generation would not have conveyed reasonably to a person of ordinary skill in the art that the number of linked graphical user interface screens on one device can be different from the number of linked graphical user interface screens on at least one other device, as the result of the generation of modified menus on one or more devices. Accordingly, we are not persuaded that the ’077 Patent fails to describe adequately a user interface that includes a different number of user interface screens from at least one other wireless handheld computing device in the system, as required by claims 1, 9, and 13.

6. “*Synchronous communications*”

Petitioner contends that “[t]he specification fails to provide required written description support necessary to establish that the Applicants were in

possession of the *full scope* of the Challenged Claims of the '077 Patent at the time of filing . . . .” Pet. 48. (emphasis added). Petitioner further contends:

Specifically, the Challenged Claims claim real time synchronization. For example, Claim 1 recites “[a]n information management and real time synchronous communications system” wherein “[at least the menu categories, menu items and modifiers comprising] the programmed **handheld menu** configuration are **synchronized in real time with** analogous information comprising **the master menu.**”

*Id.* at 48-49. Petitioner argues that the patent “describes only one synchronization activity – that of a database on the handheld unit with a master database.” *Id.* at 49 (citing Ex. 1001, 11:18-20 (“[A]n automated download procedure is provided to transfer the desktop database onto a handheld device and/or Web page.”)).

Petitioner characterizes the term “synchronous communications” as a genus and argues that “the originally filed specification fails to provide the written description support necessary to establish that the Applicants were in possession of the full scope of the genus of ‘synchronous communications.’” *Id.* at 54. Petitioner asserts that the original specification “only arguably supports” a single species, i.e., “synchronizing information with a central database and a handheld’s existing local copy of same.” *Id.* Petitioner further asserts that the specification discloses use of web sites “only as another method of downloading an updated database to a handheld unit . . . .” *Id.* at 50 (citing Ex. 1001, 11:52-58).

Patent Owner responds that Petitioner has not provided any evidence (only attorney argument) to demonstrate that the disclosed embodiments are insufficient to describe the full scope of “synchronous communications.” Prelim. Resp. 60. Patent Owner agrees that the scope of “synchronization” in the claims is not limited to synchronizing an updated master database with the local database of a handheld device (*id.* at 56-60), but argues that when the original description describes something within the scope of the claim, “lack of written description must be demonstrated by more than pointing out the difference in scope” (*id.* at 60 (quoting *Alstom Power Inc. v. Hazelmere Res. Ltd.*, Appeal No. 2013-008262, 2013 WL 6681601, at \*9 (PTAB Dec. 17, 2013))). Patent Owner further argues that Petitioner has not considered factors such as the knowledge of one skilled in the art and the level of predictability in the field, or indicated that the specification reflects that the invention is, in fact, not broader than what is disclosed in the specification. *Id.* (citing *Alstom Power*, at \*9).

Patent Owner also argues that, “[i]n the present case, there is no difference in scope – the claim scope is fully described in the specification.” *Id.* Patent Owner relies on the disclosure in the specification of “fast synchronization between a central database and **multiple** handheld devices” and “synchronization and communication between a Web server and **multiple** handheld devices”). *Id.* at 48 (citing Ex. 1001, 12:28-31).

For the reasons articulated by Patent Owner, we are not persuaded that the ’077 Patent fails to describe adequately “synchronous communications,” as required by claims 1, 9, and 13.

Accordingly, Petitioner has not shown that it is more likely than not that claims 1-18 of the '077 patent lack adequate written description support in the specification.

*D. 35 U.S.C. § 101 Ground of Unpatentability*

Petitioner contends that that claims 1-18 are directed to non-statutory subject matter under 35 U.S.C. § 101. Pet. 60-79. Upon reviewing Petitioner's analysis and supporting evidence, and taking into account Patent Owner's arguments submitted in its preliminary response, we determine that Petitioner has not established that claims 1-18 are, more likely than not, directed to non-statutory subject matter under § 101.

*1. Section 101*

The Supreme Court has made it clear that the test for patent eligibility under § 101 is not amenable to bright-line, categorical rules. *Bilski v. Kappos*, 130 S. Ct. 3218, 3229-30 (2010). Further, the Federal Circuit has recognized that it has been especially difficult to apply § 101 properly in the context of computer-implemented inventions. *CLS Bank Int'l v. Alice Corp. Pty. Ltd.*, 717 F.3d 1269, 1277 (Fed. Cir. 2013).

Our analysis begins with the statute. Section 101 of title 35, United States Code, provides that:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

“In choosing such expansive terms . . . modified by the comprehensive ‘any,’ Congress plainly contemplated that the patent laws would be given wide scope.” *Bilski*, 130 S. Ct. at 3225 (quoting *Diamond v. Chakrabarty*, 447 U.S. 303, 308 (1980)). There are, however, three limited, judicially created exceptions to the broad categories of patent-eligible subject matter in § 101: laws of nature, natural phenomena, and abstract ideas. *Id.*

While an abstract idea by itself is not patentable, a practical application of an abstract idea may be deserving of patent protection. *Mayo Collaborative Servs v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293-94 (2012); *Bilski*, 130 S. Ct. at 3230; *Diamond v. Diehr*, 450 U.S. 175, 187 (1981). To be patent-eligible, a claim cannot state simply the abstract idea and add the words “apply it.” *See Mayo*, 132 S. Ct. at 1294. The claim must incorporate enough meaningful limitations to ensure that it claims more than just an abstract idea and is not merely a “drafting effort designed to monopolize the [abstract idea] itself.” *See id.* at 1297. Limiting the claim to a particular technological environment or field of use, or adding insignificant pre- or post-solution activity, does not constitute a meaningful limitation. *See Bilski*, 130 S. Ct. at 3230; *Diehr*, 450 U.S. at 191-92; *Parker v. Flook*, 437 U.S. 584, 595 n.18 (1978).

“[T]he relevant inquiry is whether a claim, as a whole, includes *meaningful* limitations restricting it to an application, rather than merely an abstract idea.” *Ultramercial, Inc. v. Hulu, LLC*, 722 F.3d 1335, 1344 (Fed. Cir. 2013) (citations omitted). With respect to computer-implemented inventions, “[t]his inquiry focuses on whether the claims tie the otherwise

abstract idea to a *specific* way of doing something with a computer, or a *specific computer* for doing something; if so, they likely will be patent eligible.” *Id.* at 1348. “While no particular type of limitation is necessary, meaningful limitations may include the computer being part of the solution, being integral to the performance of the method, or containing an improvement in computer technology.” *Id.* (citations omitted).

## 2. *Petitioner’s arguments*

Petitioner argues that claims 1-12 cover the abstract idea of generating menus. Pet. 64. Petitioner asserts that “[a]lthough the claims recite a computer ‘operating system,’ ‘data storage device,’ and ‘central processing unit,’ these computer-aided limitations are insufficient to impart patent eligibility to the otherwise abstract idea” of generating menus. *Id.* at 66. Petitioner also argues that “[a]lthough the claims are written as system claims, the underlying invention for patent-eligibility purposes is an abstract idea for marketing goods and services.” *Id.* at 65 n.10. Petitioner similarly argues that “[c]laims 1-12 impermissibly set forth basic functions of a general purpose computer at a high level of generality – e.g., generating, formatting, synchronizing, and transmitting menus.” *Id.* at 68 (citations omitted)).

With respect to claims 13-18, Petitioner argues that “[c]laim 13 is directed to the abstract idea of placing an order or reservation in a hospitality context using a general purpose computer and wireless handheld device.” *Id.* at 69. Petitioner argues that the recited “computer and web-based components (e.g., ‘database,’ ‘wireless handheld computing device,’ ‘web

server,’ ‘web page,’ ‘application software,’ etc.), . . . are token post-solution activity,” and do not “impart patent eligibility to the abstract idea of placing an order or reservation using a general purpose computer and wireless handheld device.” *Id.* at 70.

Petitioner argues, as to all claims, that “[t]he computer limitations in the claims, e.g., computer ‘operating system,’ ‘central processing unit,’ ‘data storage device,’ or ‘wireless handheld computing devices,’ do not sufficiently tie the claims to an actual application of the idea.” *Id.* at 73 (citing *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333 (Fed. Cir. 2012)). Petitioner further asserts that “the Challenged Claims state that the ‘system’ is ‘enabled for’ performing certain steps, but the Challenged Claims ‘contain no hint as to how the information . . . will be sorted, weighed, and ultimately converted into a useable conclusion’ to accomplish the claimed methods.” *Id.* at 74 (citing *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1376 n.4 (Fed.Cir.2011)).

### 3. Patent Owner’s arguments

Patent Owner argues that “system claims 1-18 of the ’077 patent recite computers and applications of computer technology via specialized computer software.” Prelim. Resp. 67 (relying on *Ulramercial*, 722 F.3d at 1353) (“programming creates a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software”) (quoting *In re Alappat*, 33 F.3d 1526, 1545 (Fed.Cir.1994) (en banc)). Patent Owner also argues:

Each claim of the patent is directed to components arranged in a network, implemented in computing devices, and requiring intricate and complex computer programming that enables the interconnected hardware/software elements to all work together as defined by the claims. For example, the '077 claims recite a wireless handheld computing device (and Web page in the case of claims 13-18) which interacts with the rest of the system via specialized software functionality. The software limitations/requirements of the claims apply to the specifically recited wireless handheld device and Web page limitations as well as to the back office/central database/first menu software limitations/requirements.

*Id.* at 67-68.

#### 4. Analysis

Here, because the claims of the '077 patent are directed to a computer-implemented invention, we focus our analysis “on whether the claims tie [an] otherwise abstract idea to [1] a *specific* way of doing something with a computer, or [2] a *specific computer* for doing something.” *Ultramercial*, 722 F.3d at 1344. As discussed below, the independent claims of the patent meet both of these tests. We begin our analysis with claim 13.

Claim 13 recites (emphasis added):

13. An information management and real time synchronous communications system for use with wireless handheld computing devices and the internet comprising:

...

e) *real time communications control software* enabled to link and synchronize hospitality application information simultaneously between the master database, wireless handheld computing device, web server and web page,

*wherein the communications control software is enabled to utilize parameters from the master database file structure to*

*synchronize the hospitality application information in real time between the master database, at least one wireless handheld computing device, at least one web server and at least one web page . . .*

*wherein the communications control software is further enabled to automatically format a programmed handheld configuration for display as cascaded sets of linked graphical user interface screens appropriate for a customized display layout of at least two different wireless handheld computing device display sizes in the same connected system, . . . .*

According to Petitioner, claim 13 is directed to the abstract idea of placing an order or reservation in a hospitality context using a general purpose computer and a wireless handheld device. Pet. 69. However, claim 13 ties the alleged abstract idea to a system comprising real time communications control software enabled *to synchronize, in real time, order/reservation information* (“hospitality application information”) between: (1) a master database configured to store such information; (2) at least one wireless handheld computing device; (3) at least one web server; and (4) at least one web page. Further, claim 13 requires that the communications control software be enabled *to format automatically* a configuration for display as cascaded sets of linked graphical user interface screens appropriate for two different wireless handheld computing device display sizes.

We are persuaded that these features, along with others recited in claim 13, amount to more than mere “token post-solution activity,” contrary to Petitioner’s argument. *See* Pet. 70. Unlike *CyberSource*, where, as a practical matter, the use of a computer was not required to perform the

claims at issue (*see* 654 F.3d at 1376), the invention of claim 13 and dependent claims 14-18 is a specific computer-implemented system programmed by “real time communications synchronization software” to perform specialized functions, and falls within a category of patent-eligible subject matter.

We similarly are persuaded that the invention of claims 1 and 9 ties the alleged abstract idea of those claims, i.e., generating menus, to a specific computer-implemented system programmed by software to perform specialized functions. For example, the system is *enabled to synchronize, in real time*, information between a programmed handheld menu configuration and a master menu file structure stored on a central processing unit. In particular, the system is enabled for real time, synchronous transmission of the programmed handheld menu configuration to the wireless handheld computing device, and real time, synchronous transmission of selections from the programmed handheld menu configuration on the wireless handheld computer device. Further, claims 1 and 9 (like claim 13) require that the system be *enabled to format automatically* the programmed handheld menu configuration for display as cascaded sets of linked graphical user interface screens appropriate for two different wireless handheld computing device display sizes. We are persuaded that these features and others recited in claims 1 and 9 tie the claims to an actual computer-implemented application of the alleged abstract idea of generating menus.

In *Dealertrack*, on which Petitioner relies (*see* Pet. 73, citing *Dealertrack*, 674 F.3d at 1333), the claims recited “only that the method

[was] ‘computer aided’ without specifying any level of involvement or detail.” 674 F.3d at 1134. That is not the case here. Here, the claims include “meaningful limitations” to a specific computer-aided system programmed by software to perform specialized functions, as discussed above. *See Ultramercial*, 722 F.3d at 1348.

We recognize that claims 1 and 9 do not specify a particular mechanism for either transmitting the programmed handheld menu configuration to the wireless handheld computing device, or transmitting selections from the wireless handheld computer device. The Federal Circuit has stated, however, that such lack of specificity is not a determining factor under § 101:

This court understands that the broadly claimed method in the ‘545 patent does not specify a particular mechanism for delivering media content to the consumer (*i.e.*, FTP downloads, email, or real-time streaming). This breadth and lack of specificity does not render the claimed subject matter impermissibly abstract. Assuming the patent provides sufficient disclosure to enable a person of ordinary skill in the art to practice the invention and to satisfy the written description requirement, the disclosure need not detail the particular instrumentalities for each step in the process.

*Ultramercial*, 722 F.3d at 1353.

Accordingly, we are not persuaded that claims 1-18 are directed to non-statutory subject matter under 35 U.S.C. § 101.

### III. CONCLUSION

For the forgoing reasons, we determine that the information presented in the petition does not establish that any of claims 1-18 of the '077 patent are more likely than not unpatentable.

### ORDER

Accordingly, it is

ORDERED that Petitioner's petition for covered business method review is *denied*, and no covered business method review will be instituted pursuant to 35 U.S.C. § 324 as to any claim of the '077 patent on any of the grounds of unpatentability alleged by Petitioner in the petition.

Case CBM2014-00014  
U.S. Patent No. 8,146,077 B2

PETITIONER:

Richard Zembeck  
Gilbert Greene  
richard.zembeck@nortonrosefullbright.com  
bert.greene@nortonrosefullbright.com

PATENT OWNER:

John Osborne  
Michael Fabiano  
josborne@osborneipl.com  
mdfabiano@fabianolawfirm.com