EXHIBIT 7

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Paper 9
Entered: October 3, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.,
Petitioner,

v.

AGIS SOFTWARE DEVELOPMENT, LLC,
Patent Owner.

Case IPR2018–00818
Patent 9,408,055 B2

Before TREVOR M. JEFFERSON, CHRISTA P. ZADO, and KEVIN C. TROCK, *Administrative Patent Judges*.

TROCK, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

by reference," refers only to the immediately preceding '728 patent and does not include the '724 patent following it. Patent Owner is responsible for the use of this particular phrasing, and Patent Owner was in the best position to clarify any possible ambiguity in language. Given the standard that the '410 Application "must use language that is express and clear, *so as to leave no ambiguity* about the identity of the document being referenced, *nor any reasonable doubt* about the fact that the referenced document is being incorporated," we are not persuaded that the '410 Application incorporates the '724 patent by reference. *Northrop Grumman Info. Tech., Inc.*, 535 F.3d at 1344 (emphasis altered).

4. Written Description Requirement

As noted above, "to gain the benefit of the filing date of an earlier application under 35 U.S.C. § 120, each application in the chain leading back to the earlier application must comply with the written description requirement of 35 U.S.C. § 112." *Zenon Envtl., Inc.*, 506 F.3d at 1378 (quoting *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1571 (Fed. Cir. 1997)). In order to satisfy the written description requirement, "the description must 'clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.'" *Ariad Pharm., Inc.*, 598 F.3d at 1351 (quoting *Vas–Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562–63 (Fed. Cir. 1991)). "In other words, the 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.* *See also Ralston Purina Co. v. Far–Mar–Co, Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985).

The test for sufficiency requires "an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill

in the art. Based on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed." *Ariad Pharm., Inc.* 598 F.2d at 1351. As we discussed *supra*, the burden to demonstrate that the '410 Application satisfies this test has shifted to Patent Owner, and therefore is not on Petitioner.

Petitioner contends the '055 patent's claims are not adequately described and lack written description support in the '410 Application in two ways: 1) the '410 Application does not describe the specific steps for initiating IP-based location sharing as recited in the independent claims; and 2) the '410 Application does not describe user input specifying a particular symbol when adding a new entity to the display as recited in the independent claims. *See* Pet. 8–9, 18–27.

Patent Owner disputes Petitioner's contentions, and argues that "[t]he disclosure of the '410 Application reasonably conveys to one of skill in the art that the inventor was in possession of the Challenged Claims." Prelim. Resp. 17.

a. Initiating IP Based Communication

Independent claim 1 of the '055 patent is a method claim performed by a first device that obtains the telephone number contact information of a plurality of second devices, where the first device, in part,

> facilitate[es] initiation of Internet Protocol (IP) based communication between the first device and the respective second devices by using [the] respective telephone numbers to send, from the first device to the second devices, respective Short Message Service (SMS) messages including a telephone number of the first device and information usable b[y] the respective second

device to send IP-based communication to the first device;

Ex. 1001, 14:44–52.

As noted above, the burden of production is on Patent Owner to show that the '410 Application provides adequate written description support for this limitation in order to be entitled to rely on the '410 Applications earlier filing date. *In re NTP, Inc.*, 654 F.3d at 1276.

Patent Owner states, "[t]he '410 Application describes that '[t]he method and system include the ability of a specific user to provide polling in which other cellular phones, using SMS, internet or WiFi, report periodically,' and that '[a] user can manually poll any or all other cell phone devices that are used by all of the participants in the communication network.'" Prelim. Resp. 19–20 (citing Ex. 1006 ¶ 47). Patent Owner also states, "[t]he '410 Application describes the polling as a 'polling command' and further explains that '[t]he receiving cellular phone application code responds to the polling command with the receiving cellular phone's location and status which could include battery level, GPS status, signal strength and entered track data.'" *Id.* at 20 (citing Ex. 1006 ¶ 47). Patent Owner then argues, "[t]his description clearly indicates that applicant possessed the feature of sending SMS polling command message from a first device to a second device." *Id.*

Patent Owner also argues "[t]he '410 Application further demonstrates possession of a polling command that includes a 'telephone number of the first device and information usable b[y] the respective second device to send IP-based communication to the first device.'" *Id.* The '410 Application, Patent Owner argues, "describes 'a polling mode in each cell phone that permits a user to contact other cell phone users that have a

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