UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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GORDON * HOWARD ASSOCIATES, INC.,
Petitioner,

v.

LUNAREYE, INC.,
Patent Owner.

_____

Case IPR2014-00712
Patent 6,484,035 B2

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Before MICHAEL W. KIM, GEORGIANNA W. BRADEN, and
J. JOHN LEE, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

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

INTRODUCTION

On April 30, 2014, Gordon * Howard Associates, Inc. ("GH") filed a
Petition (Paper 2, "Pet.") requesting *inter partes* review of claim 3 of U.S.
Patent No. 6,484,035 B2 (Ex. 1002, "the '035 patent"). Patent Owner
LunarEye, Inc. ("LunarEye") filed a Preliminary Response. Paper 7
("Prelim. Resp."). An *inter partes* review of claim 3 was instituted on
October 17, 2014. Paper 8, 16 ("Inst. Dec."). After institution, LunarEye
filed a Patent Owner Response (Paper 17, "PO Resp."), and GH filed a
Petitioner Reply[1] (Paper 23, "Pet. Reply"). In addition, GH filed a Motion
to Seal requesting that Exhibit 1017 be sealed.[2] Paper 25 ("Mot. Seal"). An
oral hearing was held on May 13, 2015. Paper 42 ("Tr.").

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written
Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. As
discussed below, GH has shown by a preponderance of the evidence that
claim 3 of the '035 patent is unpatentable.

A. Related Proceedings

The '035 patent is at issue in a pending district court case involving
the same parties in this proceeding, *Lunareye, Inc. v. Gordon Howard
Associates, Inc.*, No. 9:13-cv-91 (E.D. Tex.). Pet. 1; Paper 6, 2.
Additionally, the '035 patent is the subject of IPR2014-01213, in which an

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[1] GH filed both a confidential Petitioner Reply (Paper 24), and a redacted
Petitioner Reply (Paper 23), in which confidential information is redacted.
The redacted information was not relied on for this Decision. Thus, all
citations to the Petitioner Reply refer to the redacted version.
[2] GH filed both confidential and redacted versions of the Motion to Seal
(Paper 25 (redacted); Paper 26 (confidential)) and Exhibit 1017. All
citations to the Motion refer to the redacted version.

inter partes review of claims 1–24 was instituted on February 3, 2015. *See Gordon * Howard Assocs., Inc. v. LunarEye, Inc.*, Case IPR2014-01213, 2015 WL 495016, at *16 (PTAB Feb. 3, 2015) (Paper 11).

B. The '035 Patent

The '035 patent relates to a "triggerable location-reporting apparatus," where the apparatus transmits its location information in response to a "trigger signal." Ex. 1002, Abstract. The Summary of the Invention states:

> In general, in one aspect, the invention features a triggerable location-reporting apparatus comprising a trigger signal, a GPS processor coupled to the trigger signal, a position signal carrying position information generated by the GPS processor in response to the trigger signal, a telemetry transmitter coupled to the position signal, and a telemetry transmit signal transmitted by the telemetry transmitter, the telemetry transmit signal carrying the position information.

Id. at 2:1–9. In addition, the apparatus may include a controller configured to switch on and off the power signals to the GPS processor and telemetry transmitter. *Id*. at 2:10–19. The specification indicates that this "power management" by the controller limits power drain. *Id*. at 6:23–40.

Further, the specification describes a "data selector" operating such that certain bits of location data from a GPS device are not included in the data signal transmitted by the apparatus—for example, "only the bits representing latitude, longitude, velocity and heading . . . are included in the data to transmit signal" while "the bits representing height and current time are discarded." *Id*. at 7:4–15; *see id*. at Figs. 6, 7. Additionally, the specification states that "it may be desirable to change the order that the various portions of the information are transmitted." *Id*. at 7:15–17. Thus, in sum, the data selector selects the data to be transmitted and arranges it

into the desired order. *Id*. at 7:18–20.

C. Challenged Claim

The sole claim challenged in this Petition is independent claim 3,

which recites:

> 3.   A triggerable location-reporting apparatus comprising:
>
> a location-signal generating device configured to produce a location signal including location data when enabled;
>
> a data selecting device for selecting less than all of the location data to include in the location signal;
>
> a telemetry transmitter coupled to the data selecting device configured to transmit the location signal when enabled; and
>
> an enable controller configured to enable the location signal generating device and the telemetry transmitter when it receives a trigger signal and to disable the location-signal generating device and the telemetry transmitter after the telemetry transmitter transmits the location signal;
>
> wherein the data selecting device reorders the selected location data.

D. Instituted Ground of Unpatentability

This *inter partes* review of claim 3 was instituted solely on the ground

of unpatentability under 35 U.S.C. § 103 over Mohan[3] and Oncore.[4] Inst.

Dec. 16.

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[3] U.S. Patent No. 6,121,922 (issued Sept. 19, 2000) (Ex. 1006, "Mohan").
[4] Motorola, *Oncore User's Guide, Revision 7.0* (May 1996) (Ex. 1007, "Oncore"). The parties do not dispute that Oncore is a prior art printed publication under § 102(b). *See* Pet. 14 (citing Ex. 1011 ¶¶ 4–8 (Declaration of Art Sepin)).

ANALYSIS

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are construed according to their broadest reasonable interpretation in light of the specification. 37 C.F.R. § 42.100(b); *see In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1278–79 (Fed. Cir. 2015). Only those terms 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).

In the Decision on Institution, certain terms in claim 3 of the '035 patent were construed preliminarily as follows:

Claim Term	Claim Construction
location data	data generated by the location-signal generating device, which may include, but is not limited to, GPS data such as latitude, longitude, height, velocity, heading, and time
data selecting device	device capable of selecting location data to include in the location signal
reorders the selected location data	arranges the selected location data into the desired order for transmission

Inst. Dec. 6–9. During trial, the parties did not dispute the above construction of "location data," nor was any conflicting evidence presented. Thus, we maintain the same construction for this Decision, and we incorporate our previous analysis set forth in the Decision on Institution. *See* Inst. Dec. 6. The parties, however, raised certain issues relating to the terms "data selecting device" and "reorders the selected location data," which are addressed below.

1.   Data Selecting Device

LunarEye argues that "data selecting device" must be further

construed to exclude any device that is located physically inside of a GPS

receiver. PO Resp. 20–24 (citing Ex. 2024 ¶ 15 (Declaration of Joseph C.

McAlexander III)). According to LunarEye, the specification of the '035

patent distinguishes between the claimed data selecting device and a GPS

receiver, and a "Motorola® Oncore^{TM} GPS receiver" in particular.[5] *Id*.

LunarEye asserts this is an "implicit specification disclaimer" that precludes

any construction encompassing devices located within GPS receivers. Tr.

23:11–24:7. GH disagrees the specification compels such a limitation. Pet.

Reply 7–8; Tr. 15:10–14.

The record evidence does not support LunarEye's "disclaimer"

argument. LunarEye relies on the specification's descriptions of certain

embodiments. For example, Figure 2 of the '035 patent is a block diagram

depicting certain features of an embodiment of the claimed invention,

including Global Positioning Satellite System Receiver 48 ("GPS Receiver

48") and Controller 36. Ex. 1002, Fig. 2, 5:49–6:8. As an initial matter,

LunarEye does not identify anything in Figure 2 or its accompanying

description requiring that GPS Receiver 48 and Controller 36 be physically

distinct components. Even if there was such a requirement, however, "a

particular embodiment appearing in the written description may not be read

into a claim when the claim language is broader than the embodiment."

Superguide Corp. v. DirecTV Enters., Inc., 358 F.3d 870, 875 (Fed. Cir.

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[5] We note that claim 3 recites a "location-signal generating device," which is
not limited necessarily to a GPS receiver, much less a particular brand or
model of GPS receiver.

2004). LunarEye's reliance on other figures and descriptions of embodiments in the specification is unpersuasive for the same reason. *See* PO Resp. 20 & n.36; *see also* Ex. 2024 ¶¶ 15, 18–19 (LunarEye's proffered expert relying on descriptions of embodiments for opinion that data selecting device is external to GPS receiver). Merely describing a narrower embodiment does not constitute even an "implicit specification disclaimer" (Tr. 23:11–24:7), much less the clear disclaimer required to apply the limitation at issue to the claim. *See In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004).

In addition to its "disclaimer" argument, LunarEye also contends the claim language itself indicates the GPS receiver (i.e., location-signal generating device) and data selecting device are physically distinct components. PO Resp. 22. According to LunarEye, claim 3 specifies that the location-signal generating device "produce[s] a location signal including location data" *first*, and the data selecting device must be outside of the location-signal generating device because it operates on the *output* of the location-signal generating device, i.e., *after* the location signal is produced. *Id.* at 22–24; Tr. 36:6–22 (counsel for LunarEye citing as support Ex. 1002, 7:4–20, Figs. 2, 5, 9).

The claim language, however, does not support LunarEye's position. Claim 3 is an apparatus claim, not a method claim, and recites a series of components with their functions rather than claiming steps of a process. Moreover, claim 3 recites that the location-signal generating device is configured to "produce a location signal including location data," and that a function of the data selecting device is "selecting less than all of the location data to *include in the location signal*" (emphasis added). Thus, the claim

does not, "as a matter of logic or grammar," mandate that the data selecting device act *after* the location-signal generating device produces the location signal. *See Interactive Gift Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323, 1342–43 (Fed. Cir. 2001). To the contrary, the claim language indicates the data selecting device may participate *during* the production of the location signal by the location-signal generating device, because the data selecting device selects location data to include in "the" location signal (i.e., the same "location signal including location data" as that produced by the location-signal generating device, from which it derives its antecedent basis). *See* Pet. Reply 10–11. Thus, the claim language does not preclude the data selecting device from being located within—or, indeed, being a part of—the location-signal generating device. LunarEye does not identify any disclosure in the specification indicating that it is important for the data selecting device to act after the location-signal generating device produces the location signal, or disclaiming any particular order in which those components may operate. *See Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1371 (Fed. Cir. 2003).

LunarEye further argues, however, that the location signal recited with respect to the data selecting device actually is *not* the same location signal produced by the location-signal generating device, but rather a *second* location signal required by the claim. PO Resp. 23–24; Tr. 25:3–11, 31:3–33:9. LunarEye's argument is not supported by the claim language. Claim 3 only recites one "location signal." Nor does the specification support LunarEye's position. For example, LunarEye cites to Figure 5 of the '035 patent and contends items 52 and 56 constitute the two location signals allegedly required by the claim. Tr. 32:4–14. As LunarEye acknowledged

at the oral hearing (*id.* at 32:16–22), however, the specification identifies item 52 as "GPS *data* 52" (emphasis added), whereas item 56 is identified as "data to transmit *signal* 56" (internal quotation marks omitted, emphasis added). Ex. 1002, 6:61–7:3; *see also id.* at 8:18–24 (identifying GPS data 52 and data to transmit signal 56 in describing Figure 9 of the '035 patent).[6] Moreover, even if GPS data 52 also could be considered a location signal, it would be improper to import a requirement of a second location signal into the claim solely on the basis of embodiments depicted in the figures, without a clear disclaimer of the claim's broader scope. *See Superguide*, 358 F.3d at 875; *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

Based on the complete record, the broadest reasonable interpretation of the claim term "data selecting device" is "device capable of selecting location data to include in the location signal." Furthermore, the term does not preclude the data selecting device from being located physically within the location-signal generating device.

2.   *Reorders the Selected Location Data*

LunarEye argues the preliminary construction set forth in the Decision on Institution—"arranges the selected location data into the desired order for transmission"—is incorrect because it does not require the selected location data to be in a preexisting order. *See* PO Resp. at 28–32 (arguing the asserted prior art references fail to teach the "reorders" limitation because

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[6] According to LunarEye, GH's proffered expert, Dr. James M. Janky, testified that item 52 in the '035 patent constitutes a "location signal" (i.e., the alleged second location signal). Tr. 33:7–16 (citing Ex. 2023, 59:8–12). It is apparent from Dr. Janky's deposition transcript, however, that the cited testimony was intended to address aspects of the prior art Oncore device, not claim 3 of the '035 patent. *See* Ex. 2023, 59:8–60:13 (referencing "the block diagram of Oncore").

they do not disclose a preexisting order); Tr. 24:8–19 (asserting that "reorder implies an initial order"). According to LunarEye, "the 'reordering' in claim 3 requires ordered location data in a location signal before it is processed by the data selecting device." PO Resp. 29.

GH contends the preliminary construction is correct, and that the term "reorders the selected location data" does not require the data to be in an initial order before reordering. Pet. Reply 8–9. With respect to LunarEye's position, GH asserts that it "wrongly presumes that the data selecting device must act upon a location signal." *Id.* at 9.

Although the parties did not address specifically the construction of "reorders the selected location data" in either the Petition or the Preliminary Response, we construed the term due to its significance in the analysis of GH's asserted grounds of unpatentability. Inst. Dec. 9. Specifically, we construed the term preliminarily in the Decision on Institution as "arranges the selected location data into the desired order for transmission." *Id.* This construction was based on the '035 patent specification, which describes the reordering function:

> An example of the data selector function is illustrated in FIGS. 6 and 7. The Motorola® GT Plus OncoreTM GPS family of chips produces an digital output signal 86 containing bits representing the latitude, longitude, height, velocity, and heading of the apparatus 12 and the current time, as shown in FIG. 6. . . . Preferably, only the bits representing latitude, longitude, velocity and heading 88 are included in the data to transmit signal 56, as shown in FIG. 7. . . . Further, it may be desirable to change the order that the various portions of the information are transmitted. For example, it may be desirable to send the heading portion first. *The data selector selects the data to be transmitted and arranges it into the desired order*.

Ex. 1002, 7:4–20 (emphasis added). We concluded, "the specification explains that reordering the selected location data encompasses arranging the data received from the location-signal generating device (e.g., a GPS device) into the order desired for transmission." Inst. Dec. 9.

The ordinary meaning of the term "reorders"—as contrasted with "orders"—indicates a change in order. The specification supports this understanding of the term, stating that "it may be desirable to *change the order* that the various portions of the information are transmitted." Ex. 1002, 7:15–17 (emphasis added). Therefore, based on the parties' arguments and evidence developed since the Decision on Institution, we now determine the broadest reasonable interpretation of "reorders the selected location data" is "changes the order of the selected location data into the desired order for transmission."[7]

B. Alleged Unpatentability Under § 103

GH contends claim 3 of the '035 patent is obvious in light of the teachings of Mohan and Oncore. Pet. 21–38. Based on the complete record, GH has shown by a preponderance of the evidence that claim 3 is unpatentable for the reasons explained below.

1. Mohan

Mohan discloses a tracking system using a miniaturized geographic position determination and communications module. Ex. 1006, Abstract. The tracking system includes "GPS receiver 520," which produces a signal

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[7] On this record, it is unnecessary to resolve whether this claim term requires in every instance that the selected location data be placed first in an initial order before being reordered into a different order, because the asserted prior art teaches changing the order from an initial order to a different order, as explained below.

comprising "[g]eographic position data such as latitude, longitude and altitude." *Id.* at 3:5–15, Fig. 1. This geographic position data is then transmitted over a network via "communications transmitter/receiver 540." *Id.* Additionally, Mohan teaches that position information may be transmitted in response to activation of a panic function or a request from a remote location. *Id.* at 2:15–19. The system of Mohan also includes a power management subsystem:

> *Upon activation, the system enters a full power mode state* as shown at node 206, then enters an "acquire GPS position" state as shown at node 202. *When a positioning signal is received*, as indicated by symbol 203, the system remains in this state, as indicated by loop line 205, until a geographic fix has been determined. At this point, the system enters a ready state and a communications link is opened, as shown at node 208. The system remains in this state until a link has been established, at which point a ready condition is entered, and *identification and position information are transmitted* according to node 210, as shown by symbol 211.

Id. at 5:10–20 (emphases added); *see id.* at Fig. 3. After the system reports the position information, the communications link is closed and the system enters a "low-power mode." *Id.* at 5:44–48. Mohan's claims recite "a controller operative to . . . cause the global positioning satellite receiver to receive and decode a signal . . . containing information relating to the geographic position of the module, cause the communications transceiver to communicate the information to a remote location, and disable the global positioning satellite receiver and communications transceiver when not in use." *Id.* at 7:29–39.

2.   *Oncore*

    The Oncore reference is a user's guide to Motorola's Oncore GPS receiver products. Ex. 1007, 1.1. Oncore discloses that GPS signals from

GPS satellites are routed to a "position processor (microprocessor [MPU])
section." *Id*. at 3.2. The MPU decodes and processes satellite data and
measurements used to compute position and velocity. *Id*. According to
Oncore, the Motorola GPS receiver transmits autonomous position, velocity,
heading, satellite tracking status, and time information in "three different,
user selectable I/O protocols." *Id*. at 1.1; *see id*. at 5.1–5.2.

Oncore provides further information regarding each available I/O
protocol. One of them is the "NMEA-0183 standard format," which
includes several "NMEA output messages." *Id*. at 5.7. A user can enable or
disable each output message independently. *Id*. Thus, more than one output
message can be enabled and transmitted. *See also id*. at 5.8 (discussing "the
case where more than one output message is scheduled during the same one
second interval"). One such message is the "GPGGA" message, which
includes certain data fields in the following order: UTC of position fix (i.e.,
time), latitude, longitude, GPS quality indicator, number of satellites being
used, HDOP, antenna height, geoidal separation, age of differential data, and
differential reference station ID. *Id*. at 6.149. Another such message is the
"GPGLL" message, which includes only latitude, longitude, and UTC of
position fix (i.e., time), in that order. *Id.* at 6.153. The GPGLL message
does not include several of the data fields included in the GPGGA message,
such as antenna height, and includes time in a different order relative to
latitude and longitude. *Compare id.* at 6.153, *with id.* at 6.149.

3.   *Analysis of the Teachings of Mohan and Oncore*

GH contends Mohan teaches each of the limitations of claim 3, except
those relating to the data selecting device. Pet. 21–30. In particular, GH
identifies Mohan's disclosures regarding its GPS receiver as teaching the

claimed location-signal generating device and its related limitations. *Id*. at
25–26 (citing Ex. 1006, 2:7–12, 3:5–15, Fig. 1). According to GH, the
communications transmitter/receiver of Mohan teaches the claimed
telemetry transmitter, and the disclosed power management system teaches
the claimed enable controller and its related limitations. *Id*. at 26–30 (citing
Ex. 1006, 3:2–15, 4:43–5:49, Figs. 1, 3). LunarEye does not dispute that
Mohan teaches these aspects of claim 3 of the '035 patent. The record
supports GH's contentions regarding Mohan.

With respect to the data selecting device and related limitations of
claim 3, GH relies on the teachings of Oncore. Pet. 30–35. Considering the
evidence and arguments presented by both parties, we conclude GH has
shown sufficiently that Oncore's teachings would have led a person of
ordinary skill to a device, like the Oncore MPU, capable of selecting a
subset of GPS location data to include in an output signal in the form of an
NMEA output message—for example, including latitude, longitude, and
time for a "GPGLL" message, but not antenna height or other fields used in
a "GPGGA" message. *Id*. at 30–34; *see* Ex. 1010 ¶¶ 89–101; Ex. 1007, 5.7–
5.8, 6.149, 6.153. Furthermore, we conclude the record as a whole indicates
a person of ordinary skill would have found it obvious in light of Oncore to
change the order of the data fields for one NMEA message to construct a
different NMEA message—for example, changing the order of time, then
latitude, then latitude, such as in a GPGGA message, to the different order of
latitude, then longitude, then time, such as in a GPGLL message. Pet. 34–
35; Ex. 1010 ¶¶ 102–108; Ex. 1007, 5.7–5.8, 6.149, 6.153. Thus, GH has
shown sufficiently that Oncore teaches the data selecting device and related
limitations of claim 3 of the '035 patent.

LunarEye disputes GH's contentions regarding Oncore, but its arguments are unpersuasive. First, LunarEye argues Oncore discloses only a GPS receiver—i.e., a location-signal generating device—and, thus, a person of ordinary skill would not consider its teachings applicable to the recited data selecting device, which LunarEye contends must be a physically separate device. PO Resp. 19–22. As discussed earlier, however, the premise of LunarEye's argument—that a data selecting device must be physically distinct from the location-signal generating device—is not commensurate with the full scope of the claim. Claim 3 includes no such limitation when given its broadest reasonable interpretation.

Similarly, LunarEye's assertion that the Oncore GPS receiver cannot be the recited data selecting device, because it does not receive or further process its own output signal, also is unpersuasive. *See id.* at 22–25. As discussed earlier with respect to claim construction, LunarEye is incorrect that claim 3 requires the location-signal generating device to first produce a location signal that is received only afterward by the data selecting device to be processed for a second location signal. Rather, claim 3 only requires that the data selecting device process "location data," which is then included in the location signal produced by the location-signal generating device. As GH has demonstrated, the MPU of the Oncore device is described as receiving and processing location data, the result of which ultimately is transmitted as the output of the GPS receiver. Pet. 30–35; *see* Ex. 1007, 1.1, 3.2, 5.1–5.2.

Lastly, LunarEye contends the alleged data selecting device in Oncore identified by GH does not reorder selected location data as required by claim 3. PO Resp. 26–30. According to LunarEye, Oncore does not disclose any

initial order of the location data received by the GPS receiver. *Id.*; Tr. 50:23–53:2. LunarEye argues that when Oncore discusses generating multiple different NMEA messages, each message is constructed separately from the original, unordered data; thus, the data is *ordered* for each output message in the first instance, rather than *reordered*. PO Resp. 28–29; Tr. 53:3–18. In an obviousness analysis, however, we consider not only the express disclosures of the asserted prior art references, but also the "inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). Here, the record indicates that a person of ordinary skill would have had at least a bachelor's degree in electrical or computer engineering and familiarity with GPS and communications technology, such as that gained from five years of professional experience in the design and implementation of GPS technology. *See* Ex. 1010 ¶¶ 38–41 (Dr. Janky's testimony on level of ordinary skill); Ex. 2024 ¶¶ 8–9 (LunarEye's proffered expert, Joseph McAlexander, adopting Dr. Janky's testimony regarding level of ordinary skill). Considering the level of ordinary skill and the evidence of record, we find that Oncore would have taught or suggested to an ordinary artisan a device that changes the order of selected location data from one order (e.g., an NMEA message) to another order (e.g., a different NMEA message).

In conclusion, considering all of the parties' arguments and the full record, GH has shown sufficiently that the combination of Mohan and Oncore teaches or suggests each limitation of claim 3 of the '035 patent.

4.   Reason to Combine

GH asserts that a person of ordinary skill would have been motivated to combine Mohan and Oncore because both disclose and relate to GPS

receiver technology. Pet. 35–37. In addition to the prior art references, GH also relies on the testimony of Dr. Janky, who stated that "[i]t would have been readily apparent and straightforward for one of ordinary skill in the art to combine" Mohan and Oncore. Ex. 1010 ¶ 109. He further testified that the "simple" substitution of the Oncore GPS device for the GPS device in Mohan would achieve predictable results, such as a GPS system with a GPS receiver capable of using industry standard data output formats as well as various other benefits of the Oncore GPS receiver outlined in the Oncore reference. *Id.* ¶¶ 110–113 (citing Ex. 1007, 1.1). We have considered Dr. Janky's testimony, including his underlying analysis and reasoning, and find it credible. Based on all of the evidence presented, including Dr. Janky's testimony, we conclude GH has articulated sufficient reasoning with rational underpinning to support the conclusion that a person of ordinary skill would have had reason to combine the teachings of Mohan and Oncore. *See KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

LunarEye argues that Mohan and Oncore teach away from the combination advanced by GH. PO Resp. 32–45. Specifically, LunarEye contends Mohan states that a device constructed according to its teachings should conform to certain size constraints to achieve adequate miniaturization. *Id.* at 35–40. The GPS device described in Oncore are too large and are, thus, incompatible with Mohan, according to LunarEye. *Id.* This argument is unpersuasive, however, because claim 3 of the '035 patent does not require miniaturization, nor does it include any limitations restricting the size of the claimed apparatus or any recited component device. LunarEye does not identify any portion of Mohan that criticizes, discredits, or otherwise discourages the combination of Mohan and Oncore

to produce the solution recited in claim 3. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). Merely describing the benefits of a miniaturized GPS device does not teach away from non-miniaturized devices. *See id.*; *In re Gurley*, 27 F.3d 551, 554 (Fed. Cir. 1994). Moreover, "[t]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference." *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). Thus, whether the GPS receiver described in Oncore is too large to be incorporated physically into the GPS device described in Mohan is inapposite, because claim 3 does not recite any limitations on size.

The next teaching away argument presented by LunarEye—that Oncore also teaches away from the asserted combination—fails for similar reasons. LunarEye asserts that Oncore teaches GPS receivers with antennae that are too large and consume too much power for the GPS devices disclosed in Mohan. PO Resp. 42–45. Claim 3, however, does not include any limitations on antenna size, nor does it include any limitations reciting particular levels of antenna power consumption.[8]

LunarEye also argues Oncore teaches away from the invention of claim 3 because Oncore teaches the use of NMEA messages compliant with the NMEA standard. *Id.* at 40–42. According to LunarEye, the NMEA standard is incompatible with the invention of the '035 patent because "the

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[8] To be sure, the '035 patent discusses the importance of managing power consumption, but the specification describes the use of a controller to manage power, not limiting the claimed invention to using only antennae with particular power consumption restrictions. *See*, *e.g.*, Ex. 1002, 6:23–40. Consistent with the specification, claim 3 recites an enable controller that disables certain components after use but does not recite any limitations on antenna or transmitter power consumption.

teachings of the '035 patent are directed to non-standard, proprietary data communications." *Id.* at 41. LunarEye's argument is unpersuasive, however, because claim 3 does not recite any requirement of "non-standard, proprietary data communications." LunarEye does not identify any support for such a narrow reading of the claim, and LunarEye fails to explain persuasively why such a requirement should be read into the claims.

CONCLUSION

Based on the evidence and arguments, GH has demonstrated by a preponderance of the evidence that claim 3 of the '035 patent is obvious in light of Mohan and Oncore.

MOTION TO SEAL

GH moves to seal Exhibit 1017. Mot. Seal. 2. As this is the Final Written Decision, we consider GH's Motion to Seal as a motion to expunge Exhibit 1017 from the record pursuant to 37 C.F.R. § 42.56. Exhibit 1017 was not relied on for this Decision. Consequently, GH's motion is *granted*, and Exhibit 1017 will be expunged.

ORDER

Accordingly, it is:

ORDERED that claim 3 of U.S. Patent No. 6,484,035 B2 is held unpatentable under 35 U.S.C. § 103; and

FURTHER ORDERED that Exhibit 1017 is expunged from the record.

This is a final written decision. Parties to the proceeding seeking judicial review of this Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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