

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC CORPORATION, ZTE (USA), AMAZON.COM, INC.,
PANTECH CO., LTD., PANTECH WIRELESS, INC., DELL INC.,
LG ELECTRONICS, INC., and LG ELECTRONICS U.S.A., INC.,
Petitioners,

v.

CELLULAR COMMUNICATIONS EQUIPMENT LLC,
Patent Owner.

Case IPR2014-01135
Patent 6,377,804

Before JENNIFER S. BISK, GREGG I. ANDERSON and
ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

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

INTRODUCTION

A. *Background*

NEC Corporation of America, NEC Mobile Communications, Ltd.,¹ HTC Corporation, Amazon.com, Inc., ZTE (USA), Inc., Pantech Co., Ltd., Pantech Wireless, Inc., Dell Inc., LG Electronics, Inc., and LG Electronics U.S.A., Inc. (collectively, “Petitioner”), filed a Corrected Petition (Paper 4, “Pet.”) requesting an *inter partes* review of claims 1–12 of U.S. Patent No. 6,377,804 (Ex. 1001, “the ’804 patent”). Patent Owner, Cellular Communications Equipment LLC, filed a Preliminary Response. Paper 9 (“Prelim. Resp.”). On January 20, 2015, we instituted a review (Paper 11, “Institution Decision” or “Inst. Dec.”) based upon Petitioner’s assertion that (1) claims 1, 3, and 5–9 are anticipated by Sasuta,² and (2) claims 1, 3, 4, 6, and 7 are anticipated by Lawrence.³

This is a Final Written Decision under 35 U.S.C. § 318(a). For the reasons set forth below, Petitioner has not shown by a preponderance of the evidence that claims 1 and 3–9 of the ’804 patent (“the challenged claims”) are unpatentable.

B. *Related Proceedings*

The parties indicate that the ’804 patent is the subject of several proceedings in the United States District Court for the Eastern District of Texas. Pet. 1–2; Paper 6, 2–3.

¹ NEC Mobile Communications, Ltd. was formerly known as NEC CASIO Mobile Communications, Ltd. Paper 8, 2. NEC Corporation of America and NEC Mobile Communications, Ltd. were dismissed on February 12, 2015. Paper 20, 2–3.

² U.S. Patent No. 5,862,490 (“Sasuta”).

³ U.S. Patent No. 5,819,173 (“Lawrence”).

C. The '804 Patent

The '804 patent relates to mobile communication systems. Ex. 1001, Title. Specifically, the '804 patent discusses the coexistence of a variety of mobile telephone standards, including new generation standards that are implemented with the expectation that they will eventually supersede older standards. *Id.* at 1:14–27. The '804 patent explicitly discusses GSM, TDMA, and the Universal Mobile Telecommunication System (“UMTS”) communication standards. *Id.* at 1:15–27. Networks using these communication standards may coexist and frequently differ in both geographical coverage and scope of services provided. *Id.* at 2:11–20. This results in certain geographical areas being covered by more than one network, each using a different communication standard and providing differing services. *Id.* The '804 patent describes taking advantage of this overlap by transferring from a network operating on one standard to a second network operating on a different standard when a mobile communication device requests a service provided by the second network, but not the first network. *Id.* at 1:65–2:10.

As an example, the '804 patent describes the situation in Europe in which the more recently implemented UMTS networks likely have only limited geographical coverage, at least for an initial period of time. *Id.* at 3:17–20. Figure 1 of the '804 patent is reproduced below.

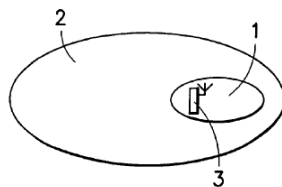


FIG. 1

Figure 1 shows schematically the geographical coverage of two networks. *Id.* at 3:3–5. Area 1, which falls wholly within area 2, illustrates the coverage provided by the UMTS network. *Id.* at 20–22. Area 2 represents a pre-existing GSM network. *Id.* Figure 2 of the '804 patent is reproduced below.

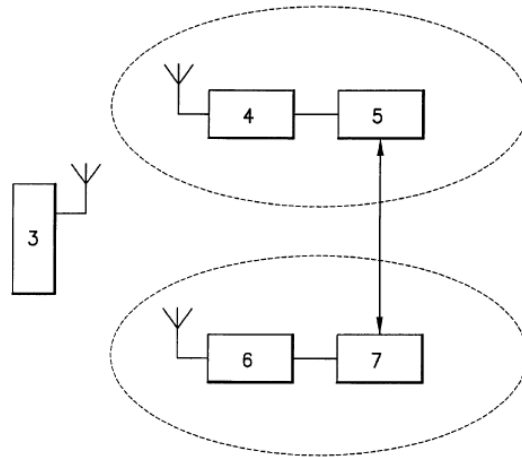


FIG.2

Figure 2 shows a diagram of the architectures of the networks shown in Figure 1. *Id.* at 3:6–7. Mobile station 3 communicates with either UMTS base station subsystem 4 or GSM base station subsystem 6. *Id.* at 3:46–49. To provide seamless operation when mobile station 3 moves between network coverage areas, the two core networks, 5 and 7, cooperate according to a roaming agreement. *Id.* at 3:49–51. In the situation where mobile station 3 is registered with the GSM network of area 2 as its home public land mobile network (HPLMN), and requires the use of a service provided by a UMTS network, but not the GSM network, mobile station 3 must “roam” for that service. *Id.* at 3:52–59. This activity is referred to as “roaming for service” and differs from traditional “roaming for coverage” defined in the GSM specification. *Id.* at 3:56–61, 3:66–4:4. Roaming for

service, unlike roaming for coverage, does not require location updates or location registration because the mobile station can remain registered with its home network, which knows the location of the mobile station. *Id.* at 2:66–4:3. Figure 3 of the '804 patent is reproduced below.

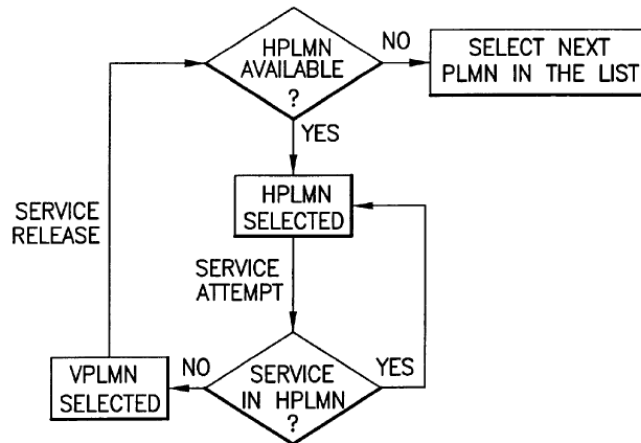


FIG.3

Figure 3 is a flow chart of mobile station 3 operating in the coverage area of the networks shown in Figure 1. *Id.* at 3:8–9. Figure 3 illustrates that mobile station 3 will select the HPLMN “so long as that network is available and the selected service is provided by the HPLMN.” *Id.* at 3:61–65.

D. Illustrative Claim

Of the challenged claims in the '804 patent, claim 1⁴ is independent. Claims 3–9 depend, either directly or indirectly, from claim 1. Claim 1 is reproduced below.

⁴ Subsequent to the filing of the Petition, a Certificate of Correction was issued changing the language of claim 1. Ex. 2001, 12. This decision will refer exclusively to this corrected version of claim 1 (discussed in the Petition as “claim 1 as allowed but not issued”).

1. A method of operating a mobile communication device within a geographical area having overlapping coverage from first and second mobile telephone networks, where said first network is the home network of the mobile communication device and said first and second networks provide respective first and second sets of services in said geographical area, the method comprising the steps of:

choosing a desired service to be requested;

determining if the desired service belongs to said first set;

and

if the desired service belongs to said first set, then registering the device with said first network,

if the desired service does not belong to said first set, then registering the device with said second network if the desired service belongs to said second set.

ANALYSIS

A. Identification of Real Parties in Interest

The Petition identifies several real parties in interest. Pet. 1. Based on the information in the Petition and Preliminary Response, we did not identify any issues under 35 U.S.C. § 312(a)(2) or § 315(b), and we instituted an *inter partes* review. See Inst. Dec. 2. Patent Owner argues in its Response that NEC Corporation and HTC America are real parties in interest that are not identified in the Petition. Paper 29 (“PO Resp.”) 2. According to Patent Owner, the Institution Decision should be vacated because, under 35 U.S.C. § 312(a)(2), a petition that does not identify all the real parties in interest cannot be considered. *Id.* For the reasons discussed below, we do not vacate the Institution Decision.

1. NEC Corporation

The Petition identifies NEC Corporation of America (“NEC America”) and NEC Mobile Communications, Ltd.⁵ (“NEC Mobile”) as real parties in interest. Pet. 1. Patent Owner argues that the Petition also should have identified NEC Corporation as a real party in interest because NEC Corporation controlled the participation of NEC America and NEC Mobile in this case. PO Resp. 8. Specifically, Patent Owner argues that NEC Corporation executed a Settlement Agreement with Patent Owner that required NEC America and NEC Mobile to withdraw from this case. *Id.* at 9–10. Patent Owner also argues that certain statements in the Motion to Terminate NEC America and NEC Mobile demonstrate that NEC Corporation controlled the participation of NEC America and NEC Mobile in this case. *Id.* at 8–9.

Patent Owner and NEC Corporation executed the Settlement Agreement that allegedly demonstrates NEC Corporation’s control with respect to this case on November 17, 2014. *Id.* at 6. Because Patent Owner is a party to the Settlement Agreement, Patent Owner knew of its terms at that time. *Id.* Thus, Patent Owner could have raised the issue of whether NEC Corporation is a real party in interest when the Settlement Agreement was executed, but did not. Patent Owner, NEC America, and NEC Mobile filed the Motion to Terminate that allegedly demonstrates NEC Corporation’s control with respect to this case on February 6, 2015. Paper 19. Because Patent Owner signed the Motion to Terminate, Patent Owner knew of the statements therein at that time. *Id.* at 7–8. Thus, Patent Owner

⁵ NEC Mobile Communications, Ltd. was formerly known as NEC CASIO Mobile Communications, Ltd. Paper 8, 2.

also could have raised the issue of whether NEC Corporation is a real party in interest when the Motion to Terminate was filed, but did not.

Patent Owner instead waited until after we granted the Motion to Terminate and dismissed NEC America and NEC Mobile from this case to argue that NEC Corporation had controlled their participation. Ex. 2002, 19:18–25:18. The result of Patent Owner’s delay is that the parties whose conduct is in question no longer are involved in this case. Patent Owner previously assured the remaining parties and the Board that “NEC’s termination from the IPRs [would] have little, if any, impact on the remaining parties or the Board.” Paper 19, 5. Yet, now, Patent Owner seeks the extraordinary remedy of terminating this case in its entirety based on statements made in the documents that secured the dismissal of NEC America and NEC Mobile (documents which the remaining parties did not sign). Given Patent Owner’s delay and previous assurances regarding the dismissal of NEC America and NEC Mobile, we decline to terminate this case with respect to the remaining parties. *See* 37 C.F.R. § 42.12.

2. *HTC America*

The Petition identifies HTC Corporation as a real party in interest. Pet. 1. Patent Owner argues that HTC America should have been identified as a real party in interest in the Petition because of the relationship between HTC America and HTC Corporation. PO Resp. 12–19. Specifically, Patent Owner argues that: 1) HTC America is a wholly owned subsidiary of HTC Corporation (*id.* at 12); 2) HTC America and HTC Corporation often act jointly in other cases (*id.* at 12–15); 3) HTC America and HTC Corporation share inside and outside counsel (*id.* at 13–14); 4) the power of attorney for HTC Corporation was signed on behalf of an HTC America employee (*id.* at

14); and 5) HTC America is identified as a real party in interest in most other petitions for *inter partes* review that identify HTC Corporation as a real party in interest (*id.* at 15–16). Patent Owner’s argument is not persuasive.

Whether a party is a real party in interest is a “highly fact-dependent question” that is evaluated “on a case-by-case basis.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,759–60 (Aug. 14, 2012). Some of the common considerations for determining whether a party is a real party in interest include whether the party funds, directs, or controls the petition or proceeding. *Id.* at 48,760. Here, Patent Owner does not identify any evidence indicating that HTC America funds, directs, controls, or otherwise is involved in *this* petition or proceeding. Patent Owner’s argument that HTC America and HTC Corporation acted jointly in other cases and that HTC America is named as a real party in interest in other cases does not indicate that HTC America is a real party in interest in this case. Similarly, Patent Owner’s argument that HTC America and HTC Corporation share counsel does not indicate that HTC America funds, directs, controls, or otherwise is involved in this case.

The only evidence specifically related to this proceeding is that an employee of HTC America is identified on the power of attorney for HTC Corporation. PO Resp. 12–18; *see also*, Ex. 2022, 24:20–25:6 (Transcript of conference call with the Board: counsel for Patent Owner “So if we want to talk about evidence specific to these cases, it’s this power of attorney in the 1135 case.”). We are not persuaded that this evidence, by itself, is sufficient to indicate that HTC America is a real party in interest in this case. There is no dispute that the actual signature on the power of attorney is from an

employee of HTC Corporation. *See* PO Resp. 14; Paper 33 (“Reply”) 23. And Petitioner represents that the reference to an HTC America employee on the document was a simple oversight. Reply 23. Patent Owner does not provide evidence to the contrary.

B. Claim Construction

We construe all claim terms using the broadest reasonable construction in light of the ’804 patent specification. 37 C.F.R. § 42.100(b). To properly resolve the issues presented in this proceeding, we address explicitly the term “home network.”

The term “home network” appears only in the preamble of claim 1. A preamble “is not limiting where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention.” *Catalina Marketing Int’l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002) (internal quotation marks omitted). *Id.* A preamble, however, “limits the invention if it recites essential structure or steps, or if it is necessary to give life, meaning, and vitality to the claim.” For example, “dependence on a particular disputed preamble phrase for antecedent basis may limit claim scope because it indicates a reliance on both the preamble and claim body to define the claimed invention.” *Id.*

Both parties agree that, although it is part of the preamble, the term “home network” acts as a limitation of claim 1. PO Resp. 25; Paper 42 (“Tr.”), 5–6 (Petitioner’s counsel: “We think that home network is limiting.”), 12–13 (Petitioner’s counsel: “Since the preamble, we agreed, is limiting . . .”). We agree that the preamble limits the scope of the challenged claims. The body of claim 1 refers to “said first network,” which refers to

the “first . . . mobile telephone network[]” recited in the preamble. The preamble further defines “said first network is the home network of the mobile communication device.” We are persuaded that this language “indicates a reliance on both the preamble and claim body to define the claimed invention” and is not merely a statement of intended purpose or intended use. *Catalina Marketing*, 289 F.3d at 808 (citing *Bell Comm’s Research, Inc. v. Vitalink Comm’s Corp.*, 55 F.3d 615, 620 (Fed. Cir. 1995)).

Patent Owner proposes a broadest reasonable interpretation of “home network”—“the network that the mobile communication device is preconfigured to access first.” PO Resp. 25. According to Patent Owner, several examples described in the ’804 patent, including those illustrated by Figures 3, 4a, and 4b, support this interpretation by showing a mobile station that is “preconfigured to access [the] home network first.” *Id.* at 25–27 (citing Ex. 1001, Figs. 3, 4a, 4b, 3:22–29, 3:61–65). Petitioner proposes a competing interpretation for the term—“the network to which the mobile stations subscribe.” Reply 3. Petitioner argues that there is “a clear and unambiguous definition” of the term in the specification. *Id.* (quoting Ex. 1001, 1:41–42 (“the ‘home’ network (i.e. the network to which the mobile stations subscribe”)).

We agree with Petitioner that the broadest reasonable interpretation of “home network” is “the network to which a mobile station subscribes,” as explicitly defined in the specification. Ex. 1001, 1:40–47. Nothing in the ’804 patent indicates that the patentee intended to modify this definition. In particular, the word “preconfigure” in Patent Owner’s proposed construction is never recited in the ’804 patent. We, therefore, are not persuaded that limiting the term “home network” in such a way is proper.

C. Anticipation by Sasuta

Petitioner asserts that Sasuta anticipates claims 1, 3, and 5–9. Pet. 3–32, 49–52. A claim is anticipated if each limitation of the claim is disclosed in a single prior art reference arranged as in the claim. *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008). We have considered the parties’ arguments and supporting evidence, and we determine that Petitioner has not shown by a preponderance of the evidence that claims 1, 3, and 5–9 are anticipated by Sasuta.

1. Overview of Sasuta

Sasuta discloses creating a catalog of service providers. Ex. 1010, 2:43–46 (“According to the inventive method, the communication unit catalogues the service attributes for each of the plurality of service providers so that a determination can be made as to which service providers are necessary to meet their service requirements.”). “[F]or each of the plurality of service requirements, one of the plurality of service providers is selected concurrently in order to facilitate that service requirement.” *Id.* at 2:46–49.

Figure 3 of Sasuta is reproduced below.

FIG. 3 300

	302	304	306	
101	DATA-S	1004,1012		308
	TELE	1011		310
	GROUP	1012,1022,1025		312
102	DATA-F	1001,1005,1013		314
	TELE	1025		316
	VIDEO	-		318
103	TELE	1001		320
	FAX	1010,1025		322

Figure 3 shows one portion of a centralized catalog of service attributes. *Id.* at 3:44–54. The catalog includes column 302, storing service provider identifiers, column 304, storing the provider’s communication service types, and column 306, storing affiliated communication units. *Id.* Sasuta describes communication unit 1012 as requiring the service slow data (“DATA-S”) and communication unit 1001 requiring the services fast data (“DATA-F”) and telephone interconnect (“TELE”). *Id.* at 3:63–4:16. Based on these requirements, communication unit 1012 chooses provider 101 for slow data and unit 1001 chooses provider 102 for fast data. *Id.* All three providers 101, 102, and 103 provide the telephone interconnect service and Sasuta discloses that, “since communication unit 1025 has already affiliated with service provider 102 (as indicated by record 316) for such services, service provider 103, with no currently active affiliation, is chosen to provide the telephone interconnect service for communication unit 1001, as indicated by record 320.” *Id.* at 4:7–16.

Figure 4 of Sasuta is reproduced below.

400

401	403	405	407	
101	-125	40	10	409
102	-85	25	4	411
103	-100	100	1	

(SERVICE PROVIDER ID) (RSSI- dbm) (RESOURCE USAGE-%) (NUMBER RESOURCES AVAILABLE)

FIG. 4

Figure 4 shows another portion of Sasuta’s centralized catalog. Ex. 1010, 2:19–21. The catalog includes column 410, storing service provider identifiers, column 403, storing characteristics of signal quality, 405, storing resource usage, and column 407, storing resource availability. *Id.* at 4:55–

61. Sasuta discloses a preferred embodiment in which a desired service requires both signal quality and resource availability to be optimized. *Id.* at 6:1–7. According to Sasuta, under these circumstances, “the communication unit would select service provider 102 for this service, as it has the best signal quality and the next best resource availability.” *Id.* at 6:7–10.

2. *Analysis*

Independent claim 1 recites “choosing a desired service to be requested” and “determining if the desired service belongs to said first set, then registering the device with said first network” where the first network is the home network—“the network to which a mobile station subscribes.” Ex. 2001, col. 6, ll. 32–42 (as modified by the Certificate of Correction). In other words, claim 1 requires a home network that is looked to first when selecting a service (“the home network preference limitation”).

The Petition does not explain whether the home network preference limitation is disclosed explicitly or inherently by Sasuta. Pet. 31–32, 49; Ex. 1012, App’x A4. In our Institution Decision, we, therefore, assumed that Petitioner’s assertion was that this limitation was disclosed explicitly by Sasuta. Inst. Dec. 12–13. During the trial, Petitioner, however, made it clear that it does *not* assert that Sasuta explicitly discloses this limitation, but instead argues that at least part of this limitation, the home network portion, is inherently disclosed by Sasuta—“subscription to a home network is inherent in any working cellphone.” Reply 3; Tr. 9:11–22, 13:18–4. According to Petitioner, “[i]t is common knowledge that a cellular telephone must be subscribed with a service provider . . . [a]bsent a subscription with a service provider, a cellular telephone is inoperable.” *Id.* at 3–4. Petitioner,

thus, concludes that “[s]ubscription with a home network is inherent in the definition of a working cellular telephone.” *Id.* at 4.

Patent Owner argues Sasuta does not disclose the home network preference limitation and requests that we reconsider the portion of our Institution Decision finding that Sasuta explicitly discloses this limitation. PO Resp. 29–38. Patent Owner also argues that Petitioner has not met its burden to show that the home network preference limitation is disclosed inherently. Tr. 61:11–18. We agree with Patent Owner.

Nothing in Sasuta’s description requires that in choosing a service provider from the catalog of service providers, a provider must be chosen in any particular order. In fact, Sasuta is silent on whether any particular network, such as a home network, has priority and should be chosen first. The Petition relies, primarily, on Figures 3 and 4, and the corresponding descriptions, for support of anticipation by Sasuta. Pet. 31–32, 49 (citing Ex. 1010, 3:44–4:8, 6:1–10). These portions of Sasuta, however, do not describe a home network or any other type of network that is selected first among those networks listed in the catalog. To the contrary, the language corresponding with Figure 3 describes communication unit 1001 choosing service provider 103 for its telephone interconnect service, without any explanation, despite the fact that service provider 101 also includes that service. The language corresponding with Figure 4, similarly, does not shed any light on whether there is a home network that is always chosen first from the catalog of service providers. The only language relating to how a network is chosen in this portion of Sasuta states that “the communication unit uses this service characteristic information by comparing them against corresponding threshold values for these characteristics . . . [i]n this manner,

the communication unit can determine whether a particular service provider should be considered for providing a particular service.” Ex. 1010, 5:5–14. Thus, Sasuta does not disclose explicitly the home network preference limitation.

Petitioner also has not met its burden to show that the home network preference limitation is disclosed inherently by Sasuta. “To serve as anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991). Petitioner acknowledges that its inherency argument was not made until, at the earliest, the Reply brief, and that it did not proffer evidence on the issue. Tr. 14:16–18 (“JUDGE WEINSCHENK: What evidence have you provided us that shows us that [the home network preference limitation is] so well-known that we don’t need it in the reference? MR. THILL: In terms of the record, I don’t know that we made an explicit argument, and that was not part of the testimony of our expert.”); *see also* Reply 3–4 (asserting that “[a]bsent a [home network] cellular telephone is inoperable” and that it “is inherent in the definition of a working cellular telephone” to have a home network, but providing no citations to supporting evidence for these assertions).

Petitioner’s argument appears to be that if a gap in a prior art reference represents functionality that is so well-known that it exceeds a certain threshold, not only does that functionality need not be taught

explicitly by the reference, but it also need not be supported by evidence in the record. Tr. 25:18–26:12. Essentially, Petitioner asks us to take judicial notice that every working cellular telephone has a home network that it gives preference to when roaming for service. Tr. 76:7–25 (“MR. THILL: I would appeal to just common knowledge and your own personal experience, for that matter. If you buy a cell phone and don’t have a subscription, it will not work. You can dial 911 by law. But it will not work. . . . And out of personal experience, it looks for the network that’s designated internally as its home network. That’s the very first thing it always does. In many regards, this limitation is a trivial limitation.”).

Petitioner relies for its argument on a statement from the Manual of Patent Examining Procedure (“MPEP”): “The specification need not disclose what is well-known to those skilled in the art and preferably omits that which is well-known to those skilled and already available to the public.” Tr. 14, 26 (citing MPEP § 2164). This statement, however, is in a section titled “Specification Must be Enabling as of the Filing Date.” MPEP § 2164.05(a). It refers to the requirement that a patent application satisfy 35 U.S.C. § 112—“whether the disclosure is sufficient to enable those skilled in the art to practice the claimed invention.” *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1463 (Fed. Cir. 1984). It does not, however, support Petitioner’s theory of anticipation. The same is true for the cases referenced by the MPEP and relied upon by Petitioner. Tr. 26:3–8; MPEP 2164.05(a) (citing *In re Buchner*, 929 F.2d 660, 661 (Fed. Cir. 1991); *Hybritech Inc. v. Monoclonal Antibodies, Inc.* 802 F.2d 1367, 1384 (Fed. Cir. 1986); *Lindemann*, 730 F.2d at 1463). Even if we agreed with Petitioner’s legal argument, which we do not, we are not

persuaded that the home network preference limitation is so trivial, or the underlying facts so well-known, that Petitioner's lack of evidence on the subject is acceptable.

Therefore, because Sasuta does not disclose explicitly the home network preference limitation and Petitioner does not meet its burden to show that Sasuta inherently discloses that limitation, Petitioner has not shown by a preponderance of the evidence that Sasuta anticipates claims 1 and 3–9.

D. Anticipation by Lawrence

Petitioner asserts that Lawrence anticipates claims 1, 3, 4, 6, and 7. Pet. 53–56. We have considered the parties' arguments and supporting evidence, and we determine that Petitioner has not shown by a preponderance of the evidence that claims 1, 3, 4, 6, and 7 are anticipated by Lawrence.

Petitioner relies on a statement in the "Background of the Invention" section of Lawrence as teaching a home network as recited in claim 1. Pet. 38–39, 53–56 (citing Ex. 1011, 1:49–54). For the remaining portion of the home network preference limitation, however, Petitioner relies on language in the "Detailed Description" of Lawrence, describing a particular embodiment of the invention. Pet. 39–40, 53, 56 (citing Ex. 1011, 3:11–25, 3:30–39; 3:64–4:10, Fig. 1).

We agree that Lawrence, in the "Background of the Invention" section, discusses the concept of a home network as used by "a conventional wireless system." Specifically, Lawrence discloses that some wireless communicator manufacturers have attempted to address the problem of unavailable service features by including in their telephones Number

Assignment Modules (NAMs)—memory locations within the wireless communicator storing an assigned telephone number and a System Identification Number (SID), which uniquely identifies a particular wireless network that is primarily intended to provide airtime service for that communicator. Ex. 1011, 1:34–49. Lawrence then states: “A conventional wireless communicator determines whether at any given time it is located within its *home local service area* by scanning certain frequencies to receive SIDs broadcast by wireless networks and then comparing the received SIDs to SIDs stored in the NAM.” *Id.* at 1:49–54 (emphasis added). Thus, Lawrence discloses that the NAM allows the communicator “to identify the primary network to which it is pre-subscribed”—the home network. *Id.* at 1:54–58. Importantly, however, Lawrence adds that the NAM “does not allow the communicator to select a network based on the availability of a desired service feature.” *Id.* In other words, Lawrence discloses that although conventional wireless systems include home networks, they do not allow roaming for service.

In the “Detailed Description” section, Lawrence describes a wireless communicator that does support roaming for service. *Id.* at 2:29–58. Specifically, Lawrence states that “a wireless communicator tunes to a first signaling control channel over which a wireless network broadcasts carrier-specific information such as a [SID] number and a service menu,” which “lists the various service features available over the network.” Ex. 1011, 3:11–18. “If the wireless network offers the communication service feature requested by the user, the communicator initiates a service request to the wireless network.” *Id.* at 3:21–25. “If the first wireless network to which the communicator tunes does not offer the communications service feature

requested by the user, the communicator tunes to a second control channel to browse through the menu of the wireless network associated with the second control channel.” *Id.* at 3:30–34. This process continues until a network that offers the requested service is found or the list of networks is exhausted. *Id.* at 3:34–39.

Nothing in Lawrence specifically describes how the first signaling control channel is chosen. Moreover, there is no indication that the first signaling control channel that a wireless communicator tunes to is the home network described as being used by a conventional wireless communicator. Petitioner points to language in Lawrence that describes three operational states of the service request selector. Pet. 39–40 (citing Ex. 1011, 3:64–4:10, Fig.1). In the first state, “upon activation of the wireless communicator, the communicator automatically begins monitoring various signaling control channels and registers onto a wireless network that offers a preselected service.” Ex. 1011, 3:64–4:3. In the second state, “the communicator only begins monitoring signaling control channels when the user manually selects a desired service.” *Id.* at 4:3–6. In the third state, “the communicator begins monitoring various signaling control channels to conduct communication with a network that offers a service that the communicator itself identifies as being required.” *Id.* at 4:6–10. Although these examples discuss the monitoring of signaling control channels, and how that process is initiated, they do not shed any light on whether there is a specific order in which the control channels are monitored or that there is any particular network, such as a home network, that is tuned to first. Thus, Lawrence does not disclose explicitly the home network preference limitation.

At oral argument, Petitioner asserted that “given the definition provided in the background [for home network], a person of ordinary skill in the art would understand that . . . [t]he first network you tune to is the home network.” Tr. 74:7–11. This assertion depends on the same assumption that Petitioner made with respect to Sasuta—that we may take judicial notice that every working cellular telephone has a home network that it gives preference to when roaming for service. Tr. 73:2–78:12. For the reasons discussed above, we are not persuaded by this argument.

Therefore, because Lawrence does not disclose explicitly the home network preference limitation and Petitioner does not meet its burden to show that Lawrence inherently discloses that limitation, Petitioner has not shown by a preponderance of the evidence that Lawrence anticipates claims 1 3, 4, 6, and 7.

E. Petitioner’s Motion to Exclude

Petitioner filed a Motion to Exclude Exhibits 2005–2019 (Paper 38), to which Patent Owner filed an Opposition (Paper 40), and Petitioner filed a Reply (Paper 41). Petitioner’s Motion to Exclude Exhibits 2005–2019 is dismissed as moot because this Decision does not rely on Exhibits 2005–2019.

F. Petitioner’s Motion to Seal

Petitioner filed a Motion to Seal. Paper 32. Petitioner requests entry of a protective order and seeks to seal portions of Petitioner’s Reply. *Id.* at 1, 3. For the reasons discussed below, the Motion to Seal is granted.

The parties agree to the default protective order found in Appendix B of the Office Patent Trial Practice Guide with one modification. *Id.* at 3–4. Specifically, the parties limit the individuals who can access confidential

information to outside counsel for the parties, the Office, and their support personnel. *Id.* We hereby enter the Protective Order filed as Exhibit 1016 in this proceeding, which governs the treatment and filing of confidential information in this proceeding.

There is a strong public policy that favors making information filed in an inter partes review open to the public. *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 34, 1–2 (PTAB Mar. 14, 2013). The standard for granting a motion to seal is good cause. 37 C.F.R. § 42.54. That standard includes showing that the information addressed in the motion to seal is truly confidential, and that such confidentiality outweighs the strong public interest in having the record open to the public. *See Garmin* IPR2012-00001, Paper 34, 2–3. The portions of the Reply that Petitioner seeks to seal relate to the terms of the confidential Settlement Agreement between Patent Owner and NEC Corporation. Paper 32, 2–3. We have reviewed the Motion to Seal, the document sought to be sealed, and the redacted, public version of that document, and we determine that good cause exists to grant Petitioner's Motion to Seal.

CONCLUSION

Petitioner has not shown by a preponderance of the evidence that claims 1 and 3–9 are anticipated by Sasuta or Lawrence.

ORDER

Accordingly, it is

ORDERED that claims 1 and 3–9 of the '804 patent are not shown unpatentable;

FURTHER ORDERED that Petitioner's Motion to Exclude is *dismissed as moot*;

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FURTHER ORDERED that Petitioner's Motion to Seal is *granted*;
FURTHER ORDERED that the Protective Order filed as Exhibit 1016
is entered in this proceeding;

FURTHER ORDERED that the identified portions of Petitioner's
Reply (Paper 34) will be sealed; and

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

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