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Paper 46
Entered: September 9, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA MOBILITY LLC,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

Case IPR2014-00504
Patent 7,382,771 B2

Before MICHAEL W. KIM, PATRICK R. SCANLON, and KRISTINA M. KALAN, *Administrative Patent Judges.*

SCANLON, *Administrative Patent Judge.*

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

I. INTRODUCTION

A. Background

Petitioner, Motorola Mobility LLC, filed a Revised Petition (Paper 4, "Pet.")[1] requesting an *inter partes* review of claims 1–4, 7, and 18 of U.S. Patent No. 7,382,771 B2 (Ex. 1001, "the '771 patent") pursuant to 35 U.S.C. §§ 311–319. Patent Owner, Intellectual Ventures II LLC, subsequently filed a Preliminary Response (Paper 7, "Prelim. Resp."). On September 10, 2014, we instituted an *inter partes* review as to all challenged claims (Paper 12, "Dec. on Inst.").

After institution, Patent Owner filed a Patent Owner Response (Paper 20, "PO Resp."), and Petitioner filed a Reply (Paper 26, "Pet. Reply"). Petitioner relies on the Declaration of Sumit Roy, Ph.D. (Ex. 1010, the "Roy Declaration") and the Second Declaration of Sumit Roy, Ph.D. (Ex. 1012, the "Second Roy Declaration") in support of its contentions, and Patent Owner relies on the Declaration of Ahmed H. Tewfik, Ph.D. (Ex. 2004, the "Tewfik Declaration") and the Declaration by Larry LeBlanc (Ex. 2006, the "LeBlanc Declaration") in support of its contentions.

Patent Owner filed a Motion for Observation (Paper 31, "Mot. for Obs.") on the cross-examination testimony of Petitioner's declarant, Dr. Roy. Petitioner filed a response (Paper 40, "Obs. Resp.").

Petitioner filed a Motion to Exclude (Paper 33, "Mot. to Exclude") certain Exhibits submitted by Patent Owner in the proceeding. Patent Owner filed an Opposition to the Motion to Exclude (Paper 37, "Opp. to

[1] Paper 4 is a Revised Petition for *inter partes* review, filed March 25, 2014. The original Petition for *inter partes* review (Paper 1) has been accorded the filing date of March 10, 2014. Paper 3.

Mot. to Exclude"), and Petitioner filed a Reply (Paper 41, "Pet. Reply to Mot. to Exclude").

An oral hearing was held on May 5, 2015. A transcript of the hearing is included in the record. Paper 45 ("Tr.").

We have jurisdiction under 35 U.S.C. § 6(b). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 1–4, 7, and 18 of the '771 patent are unpatentable. Petitioner's Motion to Exclude is dismissed.

B. Related Matters

The parties indicate that the '771 patent is involved in the following district court proceeding: *Intellectual Ventures I LLC v. Motorola Mobility LLC*, No. 0:13-cv-61358-RSR (S.D. Fla.). Pet. 2; Paper 6, 1.

C. The '771 Patent

The '771 patent, titled "Mobile Wireless Hotspot System," issued on June 3, 2008. The '771 patent relates to "providing a mobile wireless access point for use with high-speed wireless devices." Ex. 1001, 1:5–7. Figure 2, reproduced below, illustrates Mobile Hotspot System ("MHS") 40 for accomplishing this objective:

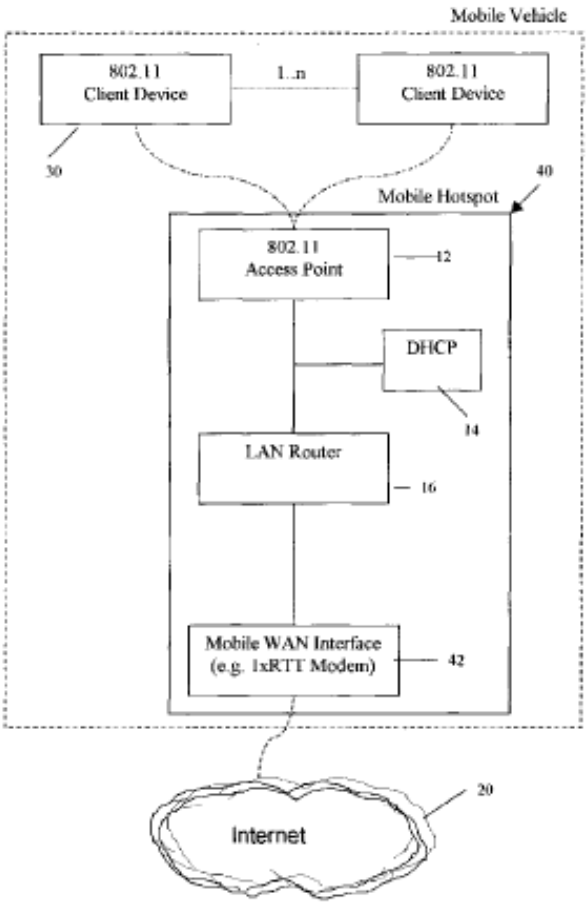

Figure 2 depicts Mobile Hotspot System ("MHS") 40.

MHS 40 includes access point 12 for connecting with client devices 30 and mobile long-range wireless ("WAN") interface 42 for establishing an Internet connection. *Id*. at 3:37–42. Mobile WAN interface 42 allows MHS 40 to be deployed in a moving vehicle. *Id*. at 3:42–44. Local Area Network ("LAN") Router 16 directs traffic between access point 12 and mobile WAN interface 42. *Id*. at 3:33–34, 4:1.

D. Illustrative Claim

Claim 1 of the '771 patent, the only independent claim of the challenged claims, is illustrative of the claimed subject matter:

1. A mobile wireless hot spot system, comprising:

> a) a short-range, high-speed wireless access point operative to communicate with short-range client devices;
>
> b) a long-range, wireless Internet access interface operative to communicate with the Internet; and
>
> c) a Local Area Network (LAN) routing system managing the data path between said wireless access point and said Internet access interface,
>
> wherein said mobile wireless hotspot system is a stand-alone system that enables client devices configured for short-range, high-speed wireless Internet access to use said mobile wireless hotspot system to access the Internet without the need to access an external service controller server.

Ex. 1001, 6:16–28.

E. Prior Art

The instituted grounds of unpatentability in this *inter partes* review are based on the following prior art:

1. U.S. Patent Application Publication No. 2004/0085944 A1, published May 6, 2004 ("Boehm") (Ex. 1005);

2. U.S. Patent No. 7,599,691 B1, issued Oct. 6, 2009 ("Mitchell") (Ex. 1006);

3. U.S. Patent Application Publication No. 2005/0039208 A1, published Feb. 17, 2005 ("Veeck") (Ex. 1008).

F. Instituted Grounds of Unpatentability

We instituted the instant *inter partes* review on the following grounds of unpatentability:

Reference(s)	Basis	Claims Challenged
Boehm	§ 102(e)	1 and 2
Mitchell and Boehm	§ 103(a)	1, 3, 4, 7, and 18
Veeck, Boehm, and Mitchell	§ 103(a)	1–4 and 18

Dec. on Inst. 20.

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, the Board interprets claims using the "broadest reasonable construction in light of the specification of the patent in which [they] appear[]." 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1277–79 (Fed. Cir. 2015), *reh'g en banc denied*, 2015 WL 4100060 (Fed. Cir. July 8, 2015). Under the broadest reasonable interpretation standard, claim terms are given their ordinary and customary meaning in view of the specification, as would be understood by one of ordinary skill in the art at the time of the invention. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). "In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence." *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–17 (Fed. Cir. 2005) (en banc)).

In this Final Written Decision, we construe only those claim terms in controversy, and we do so only to the extent necessary to resolve the controversy. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

1. "Local Area Network (LAN) routing system managing the data path between said wireless access point and said Internet access interface"

In the Petition, Petitioner proposed that the limitation "a Local Area Network (LAN) routing system" in claim 1 be construed as "a local area network or equivalent circuitry communicating data at least between a long range Internet access interface and short range wireless interface of the mobile hotspot." Pet. 7; *see also* Ex. 1010 ¶ 46 ("the broadest reasonable construction of 'LAN routing system' consistent with the specification is 'a local area network or equivalent circuitry communicating data at least between a long range Internet access interface and short range wireless interface of the mobile hotspot'"); Ex. 1012 ¶ 16 (restating the same construction for "LAN routing system").

Patent Owner proposes that the limitation "a Local Area Network (LAN) routing system managing the data path between said wireless access point and said Internet access interface" be construed as "a system that communicates data between the access point and the Internet access interface, and manages the data path therebetween by controlling client devices' access to the Internet and by controlling access to the client devices from the Internet." PO Resp. 7–8 (citing Ex. 2004 ¶ 18).

Patent Owner argues that Petitioner's proposed construction is "incorrect because it ignores the plain language of Claim 1, which states that the routing system is for 'managing' the data path between the access point and the Internet access interface. *Id.* at 6 (citing Ex. 2004 ¶ 14). On the other hand, Petitioner argues that Patent Owner's proposed construction is overly narrow in that it requires a routing system to "control" client access to and from the Internet. Pet. Reply 12.

We agree with Patent Owner that Petitioner's proposed construction does not take into account properly the "managing the data path" claim language, even given that Petitioner construes only the limitation "a Local Area Network (LAN) routing system" rather than the entire phrase. In any event, we decline to adopt Petitioner's proposed construction because it erroneously equates a LAN routing system to "a local area network or equivalent circuitry." We do not view a LAN *routing system* as being equivalent to a LAN itself or circuitry "equivalent" to a LAN, which Petitioner has not described.

We also decline to adopt Patent Owner's proposed construction, which is not supported adequately. Specifically, Patent Owner does not explain sufficiently why managing the data path necessarily is accomplished "by controlling client devices' access to the Internet and by controlling access to the client devices from the Internet." Patent Owner asserts that the Specification of the '771 patent describes managing the data path "by controlling the client devices' access to the Internet, such as by requiring authentication before permitting access" and preventing "unauthorized access in the opposite direction by 'allow[ing] all client devices 30 to share a single external Internet address.'" PO Resp. 5–6 (citing Ex. 1001, 4:1–14); *see also* Tr. 43:10–14 (stating the Specification "talks about managing as controlling the client devices' access to the Internet, things like authentication, and controlling access to client devices from the Internet, like sharing a single Internet address"). The Specification, however, does not describe "managing the data path" explicitly, and we are not persuaded that the "managing the data path" claim language necessarily includes the authentication and sharing functions described in the cited passages. As

such, Patent Owner's reliance on the cited passages in its construction seeks to improperly read limitations from the Specification into the claim. *See In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004) ("We have cautioned against reading limitations into a claim from the preferred embodiment described in the specification, even if it is the only embodiment described, absent clear disclaimer in the specification.").

Dr. Tewfik testifies that "[i]n computer networking, routing systems allow data to be exchanged between networks by forwarding data to a recipient device in one network from a sending device in another network." Ex. 2004 ¶ 10. Dr. Tewfik further testifies that, "[i]n the '771 patent, the LAN routing system is the LAN [R]outer 16," and the LAN routing system allows data to be exchanged between the short-range local network and the Internet. *Id.* ¶ 11. This testimony is not dissimilar to Dr. Roy's testimony that a LAN routing system "routes (i.e. communicates) data between a client device that is accessible via a short-range wireless interface and the Internet that is accessible [via] a long range Internet access interface." Ex. 1012 ¶ 18. Thus, Dr. Tewfik and Dr. Roy essentially are in agreement that a routing system directs (i.e., exchanges, routes, or communicates) data between networks. This meaning is consistent with the Specification of the '771 patent, which describes LAN Router 16 as "direct[ing] traffic from the access point **12** to the Internet **20** via the fixed WAN interface **18**." Ex. 1001, 3:33–34.

Therefore, applying the broadest reasonable interpretation of the claims in light of the Specification, we interpret the phrase "a Local Area Network (LAN) routing system managing the data path between said wireless access point and said Internet access interface" to mean "a system that directs data

between a local area network and the Internet by managing the data path between a wireless access point and an Internet access interface."

2. "Internet access"

In its Response, Patent Owner contends that the "ordinary and customary meaning of 'Internet access' [in claim 1] is the 'ability to ***send and receive*** information via the Internet.'" PO Resp. 8 (citing Ex. 2004 ¶ 19). Patent Owner further contends that the plain language of claim 1 is consistent with this ordinary and customary meaning. *Id.* (citing Ex. 2004 ¶ 20). In addition, Patent Owner argues that Petitioner's declarant, Dr. Roy, "described the hallmarks of 'Internet access' as including the ability to send and receive e-mail and to browse particular webpages," and both of these activities require sending and receiving information. *Id.* at 9 (citing Ex. 2031, 21:3–11; Ex. 2004 ¶ 21). Lastly, Patent Owner contends that the Specification of the '771 patent "describes the Internet access offered by the disclosed mobile wireless hotspot system in ways that are consistent with [the asserted] ordinary and customary meaning." *Id.* (citing Ex. 2004 ¶ 22). Based on these contentions, Patent Owner proposes that "Internet access" should be construed to mean the "ability to send and receive information via the Internet." *Id.* at 10 (citing Ex. 2004 ¶ 23); *see also* Tr. 43:15–44:10 (arguing that "Internet access" means sending and receiving information).

Petitioner disagrees, arguing that "'Internet access' need not include the ability to both receive and send data—either sending or receiving data (e.g., web pages, e-mail) is enough," and that the "plain meaning of the term 'Internet access' includes obtaining web pages or similar data." Pet. Reply 11 (citing Ex. 1012 ¶¶ 13, 15). Petitioner also argues that Patent Owner's assertion that Dr. Roy testified that Internet access must be "bi-

directional" is misleading. *Id.* Instead, Petitioner asserts that Dr. Roy "stated merely that Internet access includes 'accessing particular Web pages.'" *Id.* (quoting Ex. 2031, 21:3–11). Petitioner argues that Dr. Roy subsequently testified that "if a device can receive e-mail or web pages via the Internet, that device has access to the Internet." *Id.* (citing Ex. 1012 ¶¶ 13–15).

Petitioner's arguments are more persuasive. Patent Owner has not explained sufficiently why merely receiving information from the Internet (without the ability to send information to the Internet) is not a form of accessing the Internet. The Specification of the '771 patent does not describe "Internet access" in terms of requiring the ability to both send and receive information via the Internet. Moreover, contrary to Patent Owner's assertion (*see* PO Resp. 8), the claim 1 language that the mobile wireless hotspot system "enables client devices . . . to access the Internet" does not suggest the client devices must both send and receive information via the Internet. Thus, we agree with Dr. Roy that by obtaining data via the Internet, a device has accessed the Internet. *See* Ex. 1012 ¶ 13.

Accordingly, based on the full record, we determine that the broadest reasonable interpretation of "Internet access" is "the ability to send and/or receive information via the Internet."

3. "stand-alone system"

In the Decision on Institution, we interpreted "stand-alone system" to mean "a system capable of operating independently of any other system." Dec. on Inst. 8–9. The parties do not dispute this interpretation (PO Resp. 10; Pet. Reply 13), and we see no reason to modify this interpretation

in light of the record developed at trial. Accordingly, we adopt this interpretation for this Final Written Decision.

B. Determination of whether Boehm Qualifies as Prior Art

The'771 patent issued from U.S. Patent Application No. 10/386,691, which was filed on March 13, 2003. Ex. 1001, [21], [22]. Petitioner asserts that Boehm qualifies as prior art under 35 U.S.C. § 102(e) because it was filed on November 4, 2002, prior to the earliest effective filing date of the '771 patent. Pet. 12. Patent Owner contends that Boehm is not prior art with respect to the '771 patent because a "reference is not available as prior art against a patent under 102(e) if filed after the *invention date* of the patentee." PO Resp. 12 (citing Pre-AIA 35 U.S.C. § 102(e); *Loral Fairchild Corp. v. Matsushita Elec.*, 266 F.3d 1358, 1362 (Fed. Cir. 2001)). In particular, Patent Owner contends the inventors conceived the invention prior to the November 4, 2002 filing date of Boehm, and reduced the invention to practice either before November 4, 2002 or, alternatively, after November 4, 2002, coupled with diligence beginning prior to November 4, 2002. *Id.* at 13–39.

To remove Boehm as a prior art reference, the record must establish either: (1) a conception and reduction to practice before the filing date of Boehm; or (2) a conception before the filing date of the Boehm patent combined with diligence and reduction to practice after that date. *See Taurus IP, LLC v. DaimlerChrysler Corp.*, 726 F.3d 1306, 1323 (Fed. Cir. 2013). Under either approach, however, it must be proven that conception occurred prior to November 4, 2002. *See id.*

"Conception exists when a definite and permanent idea of an operative invention, including every feature of the subject matter sought to

be patented, is known." *Sewall v. Walters*, 21 F.3d 411, 415 (Fed. Cir. 1994). Furthermore, "[t]he conception analysis necessarily turns on the inventor's ability to describe his invention with particularity. Until he can do so, he cannot prove possession of the complete mental picture of the invention." *Burroughs Wellcome Co. v. Barr Labs., Inc.*, 40 F.3d 1223, 1228 (Fed. Cir. 1994). Objective evidence that corroborates an inventor's testimony regarding the conception of the invention is required "because of the danger in post-hoc rationales by an inventor claiming priority." *Invitrogen Corp. v. Clontech Labs., Inc.*, 429 F.3d 1052, 1065 (Fed. Cir. 2005). The sufficiency of corroboration is determined according to a "rule of reason." *Price v. Symsek*, 988 F.2d 1187, 1195 (Fed. Cir. 1993). This approach, however, "does not dispense with the requirement for some evidence of independent corroboration." *Coleman v. Dines*, 754 F.2d 353, 360 (Fed. Cir. 1985).

1. Patent Owner's Arguments

Patent Owner primarily relies on the testimony of Mr. LeBlanc, one of the inventors of the '771 patent, to prove conception. PO Resp. 13–22; Tr. 28:22–29:2. In addition, Patent Owner relies on a document titled "MHS1 Systems Requirements Document" (Ex. 2009), which describes the inventors' first generation mobile wireless hotspot system,[2] to corroborate Mr. LeBlanc's testimony. PO Resp. 14; *see also* Tr. 28:6–8 (referring to Exhibit 2009 as "the key document that Mr. LeBlanc points to as his conception evidence"). Mr. LeBlanc testifies that Exhibit 2009 "shows that we had conceived of the mobile hotspot system invention no later than

[2] The inventors referred to the first generation or version of their mobile wireless hotspot system as the "MHS1." Ex. 2006 ¶ 9.

September 25, 2002." Ex. 2006 ¶ 14. The LeBlanc Declaration also presents a claim chart, which Mr. LeBlanc testifies "provides citations to Exhibit 2009, along with explanations which show our conception of the subject matter described in Claims 1–4, 7, and 18 of the '771 patent." *Id.* ¶ 15.

Patent Owner argues that the hardware components of the MHS1 "included a Microsoft Windows 98 laptop computer, as well as a Sierra Wireless 555 Aircard and a Prism2 card which both plugged into the laptop computer." PO Resp. 14–15 (citing Ex. 2009 § 2.4.1; Ex. 2004 ¶¶ 34–35). Regarding the LAN routing system of claim 1, Patent Owner asserts

> The Windows 98 operating system included a built-in access point controller, Internet connection sharing functionality, Dynamic Host Configuration Protocol (DHCP) functionality, Network Address Translation (NAT) functionality, and Wired Equivalent Privacy (WEP) functionality. (*Id.*) Exhibit 2009 demonstrates that the inventors had conceived of using these functions to provide a routing system for the MHS1.

Id. at 15; *see also* Ex. 2006 ¶ 15 ("The Windows 98 operating system included tools and functions for providing a software access point controller, Internet connection sharing functionality, DHCP functionality, and Wired Equivalent Privacy (WEP) functionality, which used authentication.").

Patent Owner also argues that Exhibit 2009 demonstrates that "the inventors intended that the MHS1 would communicate Internet data between the Internet interface card and the access point," and that the MHS1 would control access between the Internet and the client devices. PO Resp. 15–16 (citing Ex. 2009 § 2.3.4; Ex. 2004 ¶¶ 34–35; Ex. 1001, 4:10–14, 5:18–30).

Regarding the claim 1 limitation that the "mobile wireless hotspot system is a stand-alone system that enables client devices configured for

short-range, high-speed wireless Internet access to use said mobile wireless hotspot system to access the Internet without the need to access an external service controller server," Patent Owner argues that "Exhibit 2009 demonstrates that the MHS1 was a stand-alone system" because "it makes no reference to accessing an external service controller." PO Resp. 17. According to Patent Owner, Exhibit 2009 does reference, however, "providing DHCP functionality for the client devices." *Id.* (citing Ex. 2009 § 2.3.4). Furthermore, Patent Owner argues that "Windows 98 included built-in network address translation functionality and other services such that an external service controller was not needed." *Id.* (citing Ex. 2004 ¶ 34).

2. Petitioner's Arguments

Petitioner argues that Patent Owner's evidence fails to show conception of the claim 1 limitation of "a stand-alone system that enables client devices . . . to access the Internet without the need to access an external service controller server." Pet. Reply 2. In particular, Petitioner argues that "Patent Owner is using the ***lack of discussion of an external DHCP server*** in Exhibit 2009 to attempt to show that the system described therein affirmatively did not access an external service controller," and this "contention does not bear scrutiny." *Id.* at 3. According to Petitioner, "[n]owhere does Exhibit 2009 explain that the "DHCP process" is carried out internally in the hotspot ***without accessing an external DHCP server***." *Id.* at 4 (citing Ex. 2009 § 2.3.4; Ex. 1012 ¶¶ 29–31).

Petitioner also argues that the Tewfik Declaration (Ex. 2004) does not corroborate conception. *Id.* at 4–5. Petitioner asserts that the chart in ¶ 34 of the Tewfik Declaration "was not prepared by Dr. Tewfik—it was provided to him by Patent Owner's counsel, who in turn obtained it from the

inventor, Larry LeBlanc" (*id.* at 5 (citing Ex. 1014, 8:16–9:3, 9:9–19)), and "Dr. Tewfik did nothing to verify the chart's information other than to review Exhibit 2009 and rely on his personal experience" (*id.* (citing Ex. 1014, 10:1–14)).

In addition, Petitioner argues that

> "[c]onception requires contemporaneous recognition and appreciation of the limitations of the claimed invention, not merely fortuitous inherency." *Mycogen Plant Science, Inc. v. Monsanto Co.*, 252 F.3d 1306, 1314 (Fed. Cir. 2001). An inventor who failed to appreciate the claimed inventive features at the time of alleged conception cannot use his later recognition of those features to retroactively cure his inadequate conception. *See Hitzeman v. Rutter*, 243 F.3d 1345, 1358–59 (Fed. Cir. 2001).

Pet. Reply 5. According to Petitioner, however, "none of Patent Owner's documents show that the patentees recognized that Windows 98 had features that would enable Internet access without accessing an external service controller server." *Id.* Petitioner asserts that "[t]he single reference to Windows 98 [in Exhibit 2009] does not show conception of a system that enables Internet access ***without an external service controller server***." *Id.* at 6.

3. Discussion

We disagree with Patent Owner that Exhibit 2009 demonstrates that the inventors conceived of using the functions alleged to be included in the Windows 98 operating system to provide a LAN routing system for the MHS1. First, Patent Owner has not established sufficiently that the version of Windows 98 used in the MHS1 included the stated functions. Exhibit 2009 does not describe these functions. And, although Mr. LeBlanc testifies that Windows 98 included such functions (Ex. 2006 ¶ 15), "[i]nventor

testimony alone is insufficient to prove conception; some form of corroboration must be shown." *Slip Track Sys., Inc. v. Metal-Lite, Inc.*, 304 F.3d 1256, 1263 (Fed. Cir. 2002). Dr. Tewfik's related testimony (*see* Ex. 2004 ¶¶ 34–36) does not provide sufficient corroboration because it is based on information provided by Mr. LeBlanc rather than Dr. Tewfik's independent analysis. *See* Ex. 1014, 10:1–14.

Second, even if the version of Windows 98 used in the MHS1 did have the functions as asserted, Patent Owner does not present sufficient evidence that the inventors knew of and intended to use these functions at the time of the alleged conception. As noted by Petitioner, this failure to show contemporaneous intent by the inventors to use these functions in the manner now asserted defeats conception. *See, e.g.*, *Mycogen*, 252 F.3d at 1314 ("Conception requires contemporaneous recognition and appreciation of the limitations of the claimed invention, not merely fortuitous inherency.").

Patent Owner's argument that Exhibit 2009 demonstrates the inventors intended the MHS1 to communicate Internet data between the Internet interface card and the access point is not persuasive because such intent is not sufficient to show conception of the invention as recited in claim 1. Furthermore, we disagree with Patent Owner that Exhibit 2009 demonstrates that the MHS1 would *control* (i.e., "manage") access between the Internet and the client devices. This argument relies on the description in Exhibit 2009 of a "welcome page from the MHS1 [being] displayed" when the browser is started and the description in the '771 patent of the welcome page being used to provide authentication. PO Resp. 16 (citing Ex. 2009 § 2.3.4; Ex. 1001, 5:18–30). Exhibit 2009 alone, however, merely

describes displaying a welcome page; there is no mention of providing authentication or any other type of control. A disclosure from the '771 patent, which was filed March 13, 2003, cannot be relied on to show a conception prior to November 4, 2002.

Moreover, Patent Owner's evidence fails to establish adequately the prior conception of a stand-alone system that enables Internet access without the need to access an external service controller server. We agree with Petitioner that the fact that Exhibit 2009 does not discuss an external DHCP server does not establish affirmatively that the MHS1 as described in Exhibit 2009 did not need to access an external service controller. Furthermore, *even if* Windows 98 provided functions such that an external service controller was not needed, as asserted by Patent Owner (*see* PO Resp. 17), there is insufficient evidence that the inventors intended to use this functionality to avoid the need for the external server.

We also find the arguments made in Patent Owner's Motion for Observations unpersuasive. For example, Patent Owner contends that certain deposition testimony by Dr. Roy (*see* Ex. 2038, 10:3–14, 11:20–12:19, 14:19–15:16, 15:18–16:1, 38:18–42:22) is relevant to Exhibit 2020, which states at page 6 that "[t]he Mobile Hotspot assigns users private IP addresses", and this testimony "confirms that [the MHS1] was a 'stand-alone system' because it functioned as a DHCP server itself, not as a relay agent for a separate DHCP server." Mot. for Obs. 1–2. Patent Owner's own evidence, however, shows that Exhibit 2020 was created after November 4, 2002. Exs. 2020, 2021; *see also* PO Resp. 31–32 ("[t]he internal metadata for the Trouble Shooting Guide shows that it was created on December 13, 2002"). We thus agree with Petitioner that "Exhibit 2020 does not

corroborate any pre-Boehm conception or reduction to practice of any feature recited in claim 1." *See* Obs. Resp. 1.

Patent Owner also contends that Dr. Roy's deposition testimony regarding Exhibits 2036 and 2037 "provides additional corroboration for [Mr.] LeBlanc's testimony that he selected and used Windows 98 for its Internet Connection Sharing (ICS) tool to provide the MHS1 with NAT and DHCP functionality." Mot. for Obs. 5 (citing Ex. 2006, 7–8). This argument is not persuasive. First, Mr. LeBlanc merely testifies that the "MHS1 shall be deployed on a laptop PC (Windows 98)" and that the "Windows 98 operating system included tools and functions" for providing various features including DHCP functionality and network address translation functionality. Ex. 2006 ¶ 15. Mr. LeBlanc does not testify that he "selected and used" Windows 98 for any particular reason, let alone to provide NAT and DHCP functionality. As such, Exhibits 2036 and 2037 do not provide the corroboration asserted by Patent Owner. Second, Exhibits 2036 and 2037 both indicate they were "last reviewed" in 2007. Ex. 2036, 3; Ex. 2037, 2. Because this is several years after the alleged conception date, we determine that Exhibits 2036 and 2037 are entitled to little or no weight with respect to corroborating the alleged conception.

Upon reviewing the record as a whole under the "rule of reason," we determine that the evidence does not establish that the inventors conceived the invention of the challenged claims prior to November 4, 2002. We, therefore, find that Petitioner has met its burden of proving that Boehm is prior art to the challenged claims under 35 U.S.C. § 102(e).

C. Asserted Anticipation of Claims 1 and 2 by Boehm

Petitioner asserts that claims 1 and 2 are anticipated under 35 U.S.C. § 102(e) by Boehm. Pet. 3, 12–16.

Boehm discloses an "apparatus for providing a portable and adaptable Internet gateway enabling wireless Internet access." Ex. 1005 ¶ 9. Boehm's Figure 3, reproduced below, illustrates an exemplary embodiment of such an arrangement:

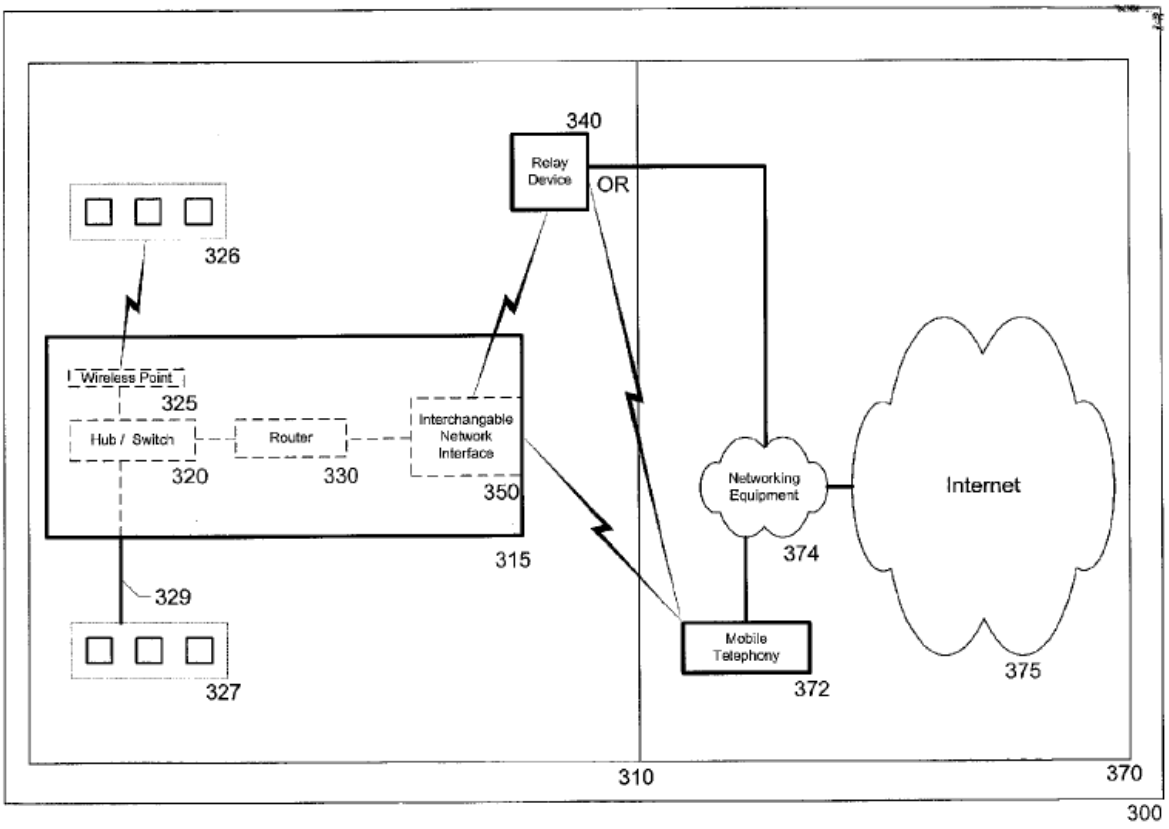

Figure 3 depicts a local area network connected to the Internet.

This embodiment includes internal network 310 and external network 370. *Id*. ¶ 20. Internal network 310 includes portable wireless Internet gateway 315 connected to one or more devices 326, 327 forming a LAN. *Id*. Portable wireless Internet gateway 315 includes, *inter alia*,

wireless access point 325, router 330, and interchangeable network interface 350. *Id*. Wireless access point 325, which utilizes 802.11b wireless communication technology in one embodiment, provides a wireless interface with devices 326. *Id*. ¶ 21. Router 330 performs several functions, including serving as a barrier to protect the LAN from external network 370, providing routing, filtering, network address translation, DHCP, and other services, and providing a secure bridge between the connected networks. *Id*. ¶ 22.

Boehm's interchangeable network interface 350 provides wireless access to external network 370. *Id*. ¶ 23. "The use of an interchangeable network interface module allows the portable wireless Internet gateway 315 to be easily moved from one location to the next" and "allows the portable wireless Internet gateway 315 to connect to the Internet through a variety of wireless technologies." *Id*. ¶ 25.

Regarding claim 1, Petitioner argues that Boehm discloses (1) the recited short-range, high-speed wireless access point in the form of wireless access point 325; (2) the recited long-range, wireless Internet access interface in the form of interchangeable network interface 350; and (3) the recited LAN routing system in the form of router 330. Pet. 13. Petitioner also argues that Boehm discloses the recited stand-alone system without the need to access an external service controller server, because Boehm discloses "performing DHCP and network address translation locally rather than by requiring an external server accessible via a long-range network connection to do so." *Id*. at 13, 16. With respect to claim 2, Petitioner argues that Boehm discloses using 802.11b wireless communication technology. *Id*. at 16 (quoting Ex. 1005 ¶ 21).

Patent Owner does not contest that Boehm fails to disclose any of the claim limitations, but argues that Boehm does not anticipate claims 1 and 2 because Boehm is not available as prior art. PO Resp. 11–39. For the reasons discussed above (*see supra* Section II.B.), however, we determine that Boehm is prior art with respect to claims 1 and 2 under 35 U.S.C. § 102(e).

After considering Petitioner's and Patent Owner's positions, as well as the supporting evidence, we are persuaded that Boehm discloses a mobile wireless hot spot system with the limitations of claims 1 and 2. In particular, we agree with Petitioner that Boehm's system is a stand-alone system that provides Internet access without the need to access an external service controller server, because Boehm discloses that router 330 can "provide local DHCP service to the computers connected [thereto]." *See* Ex. 1005 ¶ 22. Accordingly, we determine that Petitioner has shown, by a preponderance of the evidence, that claims 1 and 2 are anticipated by Boehm.

D. Asserted Obviousness of Claims 1, 3, 4, 7, and 18 over Mitchell and Boehm

Petitioner challenges claims 1, 3, 4, 7, and 18 as unpatentable under 35 U.S.C. § 103 over Mitchell in view of Boehm and/or Kellerer. Pet. 3–4, 17–30. As such, this asserted ground actually sets forth three alternate grounds: (1) the combination of Mitchell and Boehm, (2) the combination of Mitchell and Kellerer, and (3) the combination of Mitchell, Boehm, and Kellerer. We instituted *inter partes* review on the ground based on the combination of Mitchell and Boehm, but not on the grounds based on the combinations of Mitchell and Kellerer or Mitchell, Boehm, and Kellerer. Dec. on Inst. 15.

1. Claim 1

According to Petitioner, "Mitchell discloses "[a] communication system [that] is provided for use with a mobile platform." Pet. 17 (citing Ex. 1005, Abstract). Petitioner contends that Mitchell discloses

> a mobile wireless hotspot system that includes: (1) a short-range, high-speed wireless access point (i.e., wireless network between aircraft server and client personal computers); (2) a long-range, wireless Internet access interface (i.e., satellite link for receiving Internet data); and (3) a local area network ("LAN") routing system (i.e., aircraft server for routing data between the Internet and the wireless network).

Id. at 18. Petitioner further contends that "[t]o the extent that Mitchell does not explicitly disclose that the mobile platform is a 'stand-alone system,' the modification of Mitchell to provide stand-alone functionality would have been obvious to one of ordinary skill in the art in view of the teachings of Boehm and/or Kellerer." *Id.* More specifically, Petitioner argues that "Boehm clearly and explicitly discloses a stand-alone system that does not need to access an external service controller server." *Id.* at 19, 25–26 (citing Ex. 1005 ¶¶ 20, 22). Petitioner concludes that Boehm's "functionality of such a stand-alone system would be an obvious modification to the system disclosed in Mitchell" because applying this known improvement "to the base system disclosed in Mitchell . . . would provide results that were predictable to one of ordinary skill in the art." *Id.* at 19 (citing Ex. 1010, 26).

Mitchell discloses aircraft satellite communication system 300 for distributing Internet service from direct broadcast satellites to a mobile platform embodied as an aircraft. Ex. 1006, 23:18–20, Fig. 12. Direct broadcast satellite ("DBS") receiver system 260, on board aircraft 250,

includes antenna 261 and Internet DBS receiver 364. *Id*. at 23:52–54, 57–58. Antenna 261 receives Internet service from satellite 340 via link 245, and the Internet service is processed by DBS receiver 364. *Id*. at 23:51–58, Fig. 12; *see also id*. at 19:64–67 ("The down converted L-band IF signal [from antenna 261] is sent to direct broadcast satellite receiver 264 for processing of the Internet service . . . .").

The Internet data from DBS receiver 364 are passed over serial data link 265 to aircraft network server 271, which is part of aircraft computer network 270. *Id*. at 23:61–63. Aircraft network server 271 distributes Internet service in aircraft 250—including client personal computer 272—via data link 273 or wireless network 275. *Id*. at 20:10–15, 23:64–66.

Patent Owner argues that the challenged claims are not obvious over the combination of Mitchell and Boehm because 1) Boehm is not available as prior art; and 2) the combination fails to make obvious certain features of the challenged claims. PO Resp. 39.

The first argument is not persuasive because we have determined that Boehm is prior art. *See supra* Section II.B. Regarding the second argument, Patent Owner asserts that Petitioner has failed to establish that Mitchell discloses the claimed long-range, wireless Internet access interface because "the devices in Mitchell's system upon which Petitioner relies do not provide 'Internet access' at all." PO Resp. 42 (citing Ex. 2004 ¶ 43.) According to Patent Owner, the structure in Mitchell cited by Petitioner (i.e., the link between satellite 340 and aircraft network server 271) does not provide Internet access because aircraft network server 271 receives, but does not send, Internet data. *Id.* at 42–43. This argument is not persuasive because it relies on Patent Owner's incorrect interpretation of "Internet

access" as requiring the ability to send and receive information. As noted above, however, we construe "Internet access" as "the ability to send and/or receive information via the Internet." *See supra* Section II.A.2.

Next, Patent Owner argues that the combination of Mitchell and Boehm fails to disclose "a Local Area Network (LAN) routing system managing the data path between said wireless access point and said Internet access interface." PO Resp. 44–46. In particular, Patent Owner asserts that Mitchell's aircraft network server 271, which Petitioner identifies as the claimed LAN routing system, is a "server," not a "routing system," and "[s]ervers and routing systems are known and understood by those of ordinary skill in the art as different types of network devices that perform different functions." *Id.* at 44 (citing Ex. 2004 ¶ 47). Patent Owner further asserts that "Petitioner has not established, however, that Mitchell's aircraft network server 271 exerts control over access to the Internet by client devices, as through an authentication function," and "Petitioner likewise has not established that Mitchell's aircraft network server 271 controls access to the client devices from the Internet." *Id.* at 45–46 (citing Ex. 2004 ¶¶ 51, 52).

This argument, however, relies on an overly narrow construction of the claim language. We have determined that the broadest reasonable interpretation of the phrase "a Local Area Network (LAN) routing system managing the data path between said wireless access point and said Internet access interface" is "a system that directs data between a local area network and the Internet by managing the data path between the wireless access point and the Internet access interface." *See supra* Section II.A.1. Applying this interpretation, we agree with Petitioner that the terms "routing system" and

"server" are not mutually exclusive. *See* Pet. Reply 12 (citing Ex. 1012 ¶¶ 53, 54). Mitchell's aircraft network server 271 "distributes Internet service" in aircraft 250, including to client personal computer 252. Ex. 1006, 20:10–15. As such, aircraft network server 271 directs data between a local area network and the Internet. Furthermore, as argued by Petitioner (*see* Pet. Reply 12–13), aircraft network server 271 assigns client addresses to client computer 252 and identifies absent or corrupt files in the delivered Internet information. Ex. 1006, 20:28–31, 21:60–63. Accordingly, we are persuaded that aircraft network server 271 manages the data path between the wireless access point and the Internet access interface.

Finally, Patent Owner asserts that Mitchell's system is not a stand-alone system, as required by claim 1, because it requires back-channel 280 to send data to the Internet. PO Resp. 46–48. Patent Owner also asserts that Dr. Roy acknowledges that 1) "Mitchell teaches that the aircraft network server 271 is reliant upon a ground proxy server 294;" and 2) "according to Mitchell, client devices onboard the aircraft cannot communicate with the Internet without the ground proxy server 294 because of the management functions which it performs." Mot. for Obs. 9–10 (citing Ex. 2038, 85:5–87:22, 88:16–89:1). Patent Owner argues that this testimony shows that the Mitchell system is not a stand-alone system "because it does not operate independently of the management functions performed by the ground proxy server 294" to access the Internet. *Id.* at 10. Patent Owner also argues that the combination of Mitchell and Boehm fails to render the stand-alone system of claim 1 obvious because, even if it were obvious to combine the references in the manner proposed by Petitioner, this modification "still

would not change the fact that the Mitchell system requires a back-channel 280 in order to access the Internet." PO Resp. 48–49 (citing Ex. 2004 ¶ 59).

In response, Petitioner argues that Mitchell's system "can perform some operations independently, and thus is capable of operating independently of any other system." Pet. Reply 13. Petitioner also asserts that Dr. Roy testifies that Mitchell's back-channel 280 does not preclude Mitchell's system from being a stand-alone system. *Id.* (citing Ex. 1012 ¶¶ 60, 63); Obs. Resp. 10.

Patent Owner's arguments on this point are not persuasive. First, Dr. Roy's testimony regarding Mitchell's ground proxy server 294 is not instructive because ground proxy server 294 is included in the system shown in Figure 11 of Mitchell. Petitioner, however, relies on the system shown in Figure 12 of Mitchell, which does not include a ground proxy server. Second, we are persuaded by Petitioner's evidence and arguments that back-channel 280 does not preclude Mitchell's system from being a stand-alone system. Mitchell discloses that the system is suitable for "broadcast or push Internet use" without back-channel 280, but if "full active Internet is desired," then some means of communication from the client computer, such as back-channel 280, is necessary. Ex. 1006, 20:16–23. Accordingly, based on our construction of "Internet access" (*see supra* Section II.A.2), we determine that Mitchell's system can access the Internet without back-channel 280. Last, back-channel 280 is disclosed as part of Mitchell's aircraft satellite communication system 300. Ex. 1006, 24:3–4, Fig. 12. As such, back-channel 280 is not external to the system and does not access an external service controller server.

After considering Petitioner's and Patent Owner's positions, as well as the supporting evidence, we determine that Petitioner has shown, by a preponderance of the evidence, that claim 1 is unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Mitchell and Boehm.

2. Claims 3, 4, 7, and 18

Claims 3, 4, 7, and 18 each depend directly or indirectly from claim 1. Petitioner contends these claims are also unpatentable under 35 U.S.C. § 103 based on Mitchell and Boehm. Pet. 21–23, 26–30. In particular, Petitioner argues that Mitchell discloses the subject matter of these dependent claims. *Id.* We find these arguments persuasive.

Patent Owner does not present separate arguments against the unpatentability of claims 3, 4, 7, and 18, instead relying on these claims' dependence from claim 1 as the basis for their patentability. PO Resp. 49.

After considering Petitioner's and Patent Owner's positions, as well as the supporting evidence, we determine that Petitioner has shown, by a preponderance of the evidence, that claims 3, 4, 7, and 18 are unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Mitchell and Boehm.

E. Asserted Obviousness of Claims 1–4 and 18 over Veeck, Boehm, and Mitchell

Petitioner challenges claims 1–4 and 18 as unpatentable under 35 U.S.C. § 103 over Veeck in view of Kellerer, Boehm, and/or Mitchell.[3]

[3] The Petition is inconsistent with respect to whether Petitioner is challenging claims 1–4 and 18 as unpatentable over Veeck in view of Kellerer or Mitchell (*see* Pet. 4) or over Veeck in view of Kellerer, Boehm, and/or Mitchell (*see id.* at 47). In this Final Written Decision, we treat the Petition as challenging claims 1–4 and 18 as unpatentable over Veeck in view of Kellerer, Boehm, and/or Mitchell.

Pet. 3–4, 47–59. This asserted ground presents a number of different grounds based on several possible combinations of references. Of these various grounds, we instituted *inter partes* review only on the ground based on the combination of Veeck, Boehm, and Mitchell. Dec. on Inst. 19.

1. Claim 1

Petitioner contends that Veeck discloses

> a mobile wireless hotspot system that includes: (1) a short-range, high-speed wireless access point (i.e., a wireless LAN access point in communication with passenger devices); (2) a long-range Internet access interface (i.e., service provider communications device in communication with the Internet); and (3) a local area network ("LAN") routing system (i.e., a data server that communicates data between the wireless LAN access point and the service provider communications device).

Pet. 49. Petitioner argues that, although Veeck does not disclose explicitly that its long-range Internet access interface is *wireless*, the use of a wireless Internet access interface "is implied by Veeck's disclosure that the wireless data management system can be utilized on vehicles such as aircraft, buses, ships, and trains." *Id*. Petitioner relies on the Roy Declaration, which states that such vehicles would require a wireless long-range Internet access interface, to support this argument. *Id*. (citing Ex. 1010, 64).

Petitioner further contends that

> [t]o the extent that Veeck does not disclose explicitly disclose that the mobile platform is . . . a "stand-alone system" that does not need to access "an external service controller server," the modification of Veeck to provide such stand-alone functionality would be an obvious modification to one of ordinary skill in the art in view of the teachings of Kellerer and/or Boehm.

Id. at 51–52. More specifically, Petitioner argues that "Boehm clearly and explicitly discloses a stand-alone system that does not need to access an external service controller server." *Id*. at 53. Petitioner concludes that applying Boehm's known improvement "to the base system disclosed in Veeck . . . would provide results that were predictable to one of ordinary skill in the art." *Id*. at 53 (citing Ex. 1010, 67).

Veeck discloses a "wireless communication system for a transportation vehicle such as, for example, an aircraft, bus, cruise ship, and train." Ex. 1008, Abstract. Figure 2 of Veeck, reproduced below, illustrates wireless data management system 12.

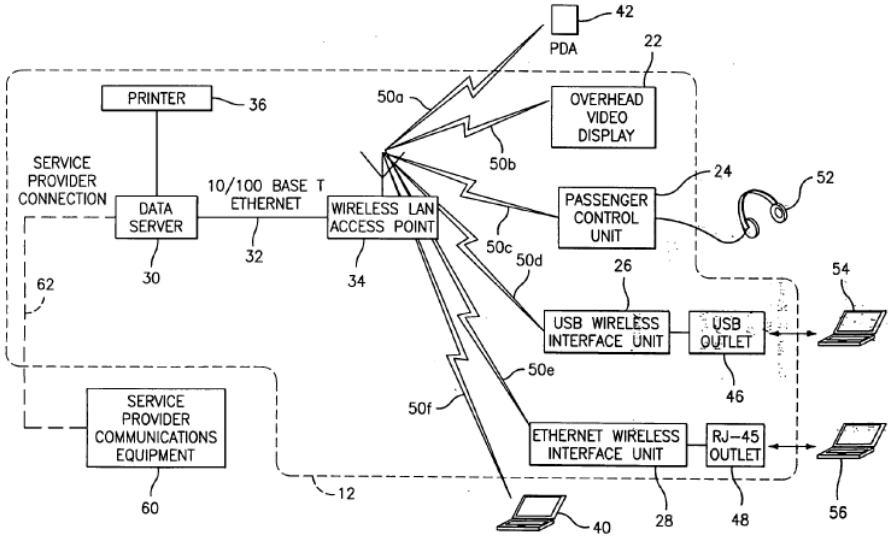

Figure 2 depicts Veeck's wireless data management system 12.

Wireless data management system 12 distributes data, including Internet data, to passenger devices within the cabin of a transportation vehicle. *Id*. ¶¶ 22, 23. System 12 includes data server 30 coupled to wireless local area network ("WLAN") access point 34 through serial or parallel communication connection 32. *Id*. ¶ 24. In addition, data server 30 is coupled to external service provider communications device 60 over serial

or parallel interface 62. *Id*. ¶ 27. External service provider communications device 60 may be coupled to a global communications network, such as the Internet, so that data server 30 may access data content available to communications device 60 from anywhere in the world. *Id*.

Veeck also discloses that WLAN access point 34 transmits data content to wireless components within a vehicle cabin. *Id*. ¶ 25. Such wireless components include "passenger personal computing devices . . . having compliant wireless interfaces such as, for example, wireless-enabled laptops 40." *Id*.

Patent Owner argues that the challenged claims are not obvious over the combination of Veeck, Boehm, and Mitchell because 1) Boehm is not available as prior art; and 2) the combination "fails to make obvious the 'routing system' and the 'stand-alone system' features of [the challenged] claims." PO Resp. 49.

The first argument is not persuasive because we have determined that Boehm is prior art. *See supra* Section II.B. Regarding the second argument, Patent Owner asserts that Petitioner has failed to establish that Veeck's data server 30 is a "routing system," as required by claim 1. PO Resp. 51 (citing Ex. 2004 ¶ 65). Patent Owner asserts that data server 30 is "a server, not a 'routing system,'" and "a person of ordinary skill in the art would not have understood it as a 'routing system,' as those terms are recognized in the art as different types of network devices that perform different functions." *Id.* at 51–52 (citing Ex. 2004 ¶ 66). Patent Owner also argues that

> Petitioner has not shown that Veeck's data server 30 controls access to the client devices from the Internet. Veeck discloses only that the data server 30 is for "distributing" Internet data to the client devices (Ex. 1008

> ¶ [0027]), but this would be understood simply as communicating data between the client devices and the Internet access interface.

Id. at 52–53 (citing Ex. 2004 ¶ 69).

This argument, however, relies on an overly narrow construction of the claim language. We have determined that the broadest reasonable interpretation of the phrase "a Local Area Network (LAN) routing system managing the data path between said wireless access point and said Internet access interface" is "a system that directs data between a local area network and the Internet by managing the data path between the wireless access point and the Internet access interface." *See supra* Section II.A.1. Veeck's data server 30 accesses data content from service provider communications device 60 and transmits data to WLAN access point 34. Ex. 1008 ¶¶ 27, 29, 30. As such, data server 30 directs data between a local area network and the Internet. Furthermore, we are persuaded by Petitioner's argument that data server 30 "can control clients' Internet access by distinguishing between different client devices when communicating content." *See* Pet. Reply 14 (citing Ex. 1008 ¶ 27). Accordingly, we are persuaded that data server 30 manages the data path between the wireless access point and the Internet access interface.

Patent Owner asserts that "Veeck explicitly teaches that the system is *not* a 'stand-alone system.'" PO Resp. 53–54 (citing Ex. 2004 ¶ 70). Patent Owner argues that Veeck simply discloses that "external service provider communications device 60 may, in turn, be coupled to a global communications network such as, for example, the Internet," without providing any further details on this connection. *Id.* at 54 (citing Ex. 1008 ¶ 27). Patent Owner argues that Veeck incorporated U.S. Patent No.

6,249,913 ("Galipeau") by reference "in order to provide such details." *Id.* (citing Ex. 1008 ¶ 3). Patent Owner then analyzes Galipeau and concludes that "[t]he reliance of the Veeck/Galipeau system on the ground server 232 for managing communications with the Internet means that the system is not a 'stand-alone system that enables client devices . . . to access the Internet.'" *Id.* at 56 (citing Ex. 2004 ¶ 75).

We find this argument unpersuasive and agree with Petitioner that "Veeck's Internet communication architecture is not limited by Galipeau." *See* Pet. Reply 15. In particular, although Veeck incorporates Galipeau by reference, Patent Owner does not direct us to any mention in Veeck that Galipeau is relied on for disclosing how external service provider communications device 60 is coupled to the Internet. We also are not persuaded by Patent Owner's assertion that Dr. Roy's testimony regarding Veeck's disclosure of how external service provider communications device 60 is coupled to the Internet shows Veeck is reliant upon Galipeau. Mot. for Obs. 10–11 (citing Ex. 2038, 92:8–21, 93:6–17, 95:19–96:11). Instead, we are persuaded by Petitioner's argument (described above) that the use of a wireless Internet access interface "is implied by Veeck's disclosure that the wireless data management system can be utilized on vehicles such as aircraft, buses, ships, and trains." *See* Pet. 49 (citing Ex. 1010, 64).

After considering Petitioner's and Patent Owner's positions, as well as the supporting evidence, we determine that Petitioner has shown, by a preponderance of the evidence, that claim 1 is unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Veeck, Boehm, and Mitchell.

2. Claims 2–4 and 18

Claims 2–4 and 18 each depend from claim 1. Petitioner contends these claims are also unpatentable under 35 U.S.C. § 103 based on Veeck, Boehm, and Mitchell. Pet. 53–54, 58–59. In particular, Petitioner argues that Veeck discloses the subject matter of claims 2–4. *Id.* at 58–59. Regarding claim 18, Petitioner argues "it would have been obvious to modify Veeck to include a manager for monitoring a WAN connection of the WAN Interface in order to provide a continuous connection to the Internet, for the same reasons discussed above, as disclosed in . . . Mitchell (pp. 21-22; Exh. 1010, p. 29-30)." *Id.* at 53–54. We are persuaded by these arguments.

Patent Owner does not present separate arguments against the unpatentability of claims 2–4 and 18, instead relying on these claims' dependence from claim 1 as the basis for their patentability. PO Resp. 57–58.

After considering Petitioner's and Patent Owner's positions, as well as the supporting evidence, we determine that Petitioner has shown, by a preponderance of the evidence, that claims 2–4 and 18 are unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Veeck, Boehm, and Mitchell.

F. Real Parties-in-Interest

The Petition, in its real party-in-interest section, identified Google Inc. as owning "more than a 10% ownership of [Petitioner]." Pet. 1. In the Decision on Institution, we determined that the Petition sufficiently identified all real parties-in-interest pursuant to 35 U.S.C. § 312(a)(2). Dec. 8. Patent Owner argues that the Decision on Institution relies on a

legally incorrect interpretation of the statute. PO Resp. 58. In its Response, Patent Owner presents no substantially new arguments that require revisiting our determination regarding identification of real parties-in-interest. We, therefore, decline to dismiss the Petition for the same reasons given in the Decision on Institution.

G. Petitioner's Motion to Exclude

Petitioner moves to exclude Exhibits 2035–2037, which purport to be printouts from https://support.microsoft.com, because they "are not relevant to any issue in this proceeding and are not properly authenticated." Mot. to Exclude 1. Petitioner also moves to exclude any portions of Exhibit 2038 that reference Exhibits 2035–2037. *Id.*

Petitioner contends that Exhibits 2035–2037 should be excluded as irrelevant under Federal Rule of Evidence 402 because they "lack any description of the mobile hotspot as described in [the '771 patent] or the hotspot described in other evidence presented by the Patent Owner in this proceeding" and, thus, "lack any probative value regarding the use of Windows 98 in the mobile hotspot as conceived by the patentees." *Id.* at 4. Petitioner also contends that Exhibits 2035–2037 are irrelevant because they purport to describe features of Windows 98 that existed as of 2007 rather than as of the relevant time period of September 2002, when the mobile hotspot was allegedly conceived. *Id.* at 7.

In addition, Petitioner contends that Exhibits 2035–2037 should be excluded under Federal Rule of Evidence 901 as lacking proper authentication. *Id.* at 8–9. Specifically, Petitioner argues that "Patent Owner has failed to authenticate Exhibits 2035–2037" because "[n]o testimony has been presented from any individual with knowledge of

https://support.microsoft.com, the website from which these Exhibits were allegedly printed." *Id.* at 9.

Initially, Patent Owner asserts that the Motion to Exclude should be denied because Petitioner did not properly preserve its relevance and authentication objections during the deposition of Dr. Roy. Opp. to Mot. to Exclude 4–5. Patent Owner argues that the objections made by Petitioner's counsel during the deposition did not mention, and were not remotely related to, relevance or authentication. *Id.* at 5. Therefore, according to Patent Owner, "Petitioner's counsel's comments are inadequate to preserve objections for lack of relevance and authentication." *Id.* (citing 37 C.F.R. § 42.53(f)(4), (8)). Petitioner responds that

> Petitioner's counsel noted that the documents were "outside the scope of . . . this proceeding." Ex. 2038, 45:11–12. A document ***outside the scope*** of a proceeding is irrelevant to any issue in the proceeding. Petitioner's counsel also noted that no witness (including Dr. Roy) had reviewed the exhibits. *See* Ex. 2038, 45:14–15. The ability to review a document impacts whether a witness can testify to its authenticity. Thus, the objections included sufficient detail to notify Patent Owner that supplemental evidence of relevance and authentication was needed.

Pet. Reply to Mot. to Exclude 1.

Patent Owner also argues that Exhibits 2035–2037 and Dr. Roy's related testimony are relevant because "1) [t]hey rebut Petitioner's arguments and provide further corroboration for Patent Owner's already unrebutted evidence that Windows 98 included tools for providing Dynamic Host Configuration Protocol (DHCP) and network address translation (NAT) functionality; and 2) [t]hey are pertinent to the reliability of the opinions of Petitioner's expert, Dr. Roy." Opp. to Mot. to Exclude 5–6.

In response, Petitioner asserts that Exhibits 2035–2037 do not describe any feature of the patentees' mobile hotspot system, and Exhibit 2036 relates to Windows 98 *Second Edition* but there is no evidence of record that the patentees' mobile hotspot system used Windows 98 Second Edition. Pet. Reply to Mot. to Exclude 1–2. Petitioner disputes that Dr. Roy's alleged unfamiliarity with Microsoft Windows 98 is relevant to the reliability of his opinions because "Dr. Roy's knowledge of Windows 98 is not the disputed issue." *Id.* at 3. Also, Petitioner reiterates its assertion that Exhibits 2035–2037 describe features of Windows 98 that existed as of 2007 rather than 2002. *Id.* at 4.

In response to Petitioner's contention that Exhibits 2035–2037 lack proper authentication, Patent Owner argues that the Exhibits are authenticated under Federal Rules of Evidence 901(b)(4) and 902(7) because each Exhibit "includes numerous distinctive characteristics and trade inscriptions that sufficiently authenticate the documents," such as the registered trademark MICROSOFT, the Microsoft logo, and a Microsoft Internet address. Opp. to Mot. to Exclude 10–11. Patent Owner also argues that the Board has noted "that '[t]here is a strong public policy for making all information filed in a quasi-judicial administrative proceeding available to the public, especially in an *inter partes* review, which determines the patentability of a claim in an issued patent.'" *Id.* at 13 (quoting *EMC Corp. v. Personalweb Techs., LLC*, Case IPR2013-00084, slip op. 44–45 (PTAB May 15, 2014) (Paper 64)). In addition, Patent Owner points to the Declaration of Derek R. Bayles (Ex. 2039, the "Bayles Declaration") as further authenticating Exhibits 2035–2037.

We are not persuaded by Patent Owner's assertion that Petitioner failed to properly preserve its relevance and authentication objections during the deposition of Dr. Roy. The rules governing *inter partes* review do not require that an objection be *preserved* during a deposition. Although an objection to evidence submitted during a deposition must be *made* during the deposition, 37 C.F.R. § 42.64(a), an objection must be *preserved* by timely filing a motion to exclude, 37 C.F.R. §§ 42.53(f)(8), 42.64(c).

In this case, Petitioner asserts, and Patent Owner does not contest, that Patent Owner served Exhibits 2035–2037 during the deposition of Dr. Roy and did not notify Petitioner of its intent to introduce these Exhibits prior to the deposition. Mot. to Exclude 2. Under such circumstances, it would have been unfair to expect Petitioner to provide the basis of its objection during the deposition with a high degree of particularity.[4] Accordingly, we agree with Petitioner that the objections regarding Exhibits 2035–2037 made during the deposition of Dr. Roy "included sufficient detail to notify Patent Owner that supplemental evidence of relevance and authentication was needed." *See* Pet. Reply to Mot. to Exclude 1. We thus determine that Petitioner properly preserved its objections to Exhibits 2035–2037.

Nevertheless, even when we consider Exhibits 2035–2037 (*see supra* Section II.B.3), or any portions of Exhibit 2038 that reference Exhibits 2035–2037, we determine that they do not provide sufficient corroboration of conception. Accordingly, because we are in agreement with Petitioner's

[4] Contrary to § 42.64(b)(1), which involves objections to evidence submitted during a preliminary proceeding or once a trial has been instituted (i.e., evidence other than deposition evidence), § 42.64(a) does not specify a level of particularity with which an objection made during deposition must be made.

position on this issue for the reasons set forth above, even when considering the evidence that Petitioner seeks to exclude, Petitioner's Motion to Exclude is *dismissed* as moot.

III. CONCLUSION

Petitioner has shown, by a preponderance of the evidence, that claims 1 and 2 of the '771 patent are unpatentable under 35 U.S.C. § 102(e) as anticipated by Boehm.

Petitioner has shown, by a preponderance of the evidence, that claims 1, 3, 4, 7, and 18 of the '771 patent are unpatentable under 35 U.S.C. § 103 as obvious over the combination of Mitchell and Boehm.

Petitioner has shown, by a preponderance of the evidence, that claims 1–4 and 18 of the '771 patent are unpatentable under 35 U.S.C. § 103 as obvious over the combination of Veeck, Boehm, and Mitchell.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 1–4 and 18 of the '771 patent are determined to be *unpatentable*;

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