

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE, INC. and
LG ELECTRONICS, INC.,
Petitioner,

v.

CORE WIRELESS LICENSING S.A.R.L.,
Patent Owner.

Case IPR2015-01715
Patent 7,072,667 B2

Before LYNNE E. PETTIGREW, CHRISTA P. ZADO, and
JESSICA C. KAISER, *Administrative Patent Judges*.

ZADO, *Administrative Patent Judge*.

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

I. INTRODUCTION

We have authority to hear this *inter partes* review under 35 U.S.C. § 6, and this Final Written Decision (“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 Google Inc. and LG Electronics, Inc. (collectively, “Petitioner”) have not shown claims 1–15 of U.S. Patent No. 7,072,667 B2 (Ex. 1001, “the ’667 patent”) to be unpatentable. *See* 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d).

A. Procedural History

Petitioner filed a Petition (Paper 3, “Pet.”) to institute *inter partes* review, and Core Wireless Licensing S.A.R.L. (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”). On February 18, 2016, we instituted an *inter partes* review of claims 1–15 of the ’667 patent. Paper 8 (“Dec. to Inst.”). Patent Owner filed a Response (Paper 12, “PO Resp.” or “Response”), and Petitioner filed a Reply (Paper 15, “Reply”). A transcript of an oral hearing held on November 2, 2016 (Paper 20) has been entered into the record.

B. Related Proceedings

Petitioner informs us that Patent Owner has asserted the ’667 patent against LG Electronics, Inc. and LG Electronics MobileComm USA in the litigation styled *Core Wireless Licensing S.a.r.l. v. LG Electronics, Inc.*, 2:14-cv-00911 (E.D. Tex.), filed September 26, 2014, which has been consolidated with *Core Wireless Licensing S.a.r.l. v. LG Electronics, Inc.*, 2:14-cv-00912 (E.D. Tex.). Pet. 1–2; *see also* Paper 6, 2. The parties inform us that the ’667 patent is also at issue in the following proceeding:

Core Wireless Licensing S.a.r.l. v. Apple Inc., 6:14-cv-00751 (E.D. Tex.).

Pet. 1–2; Paper 6, 2.

Petitioner has also filed another petition for *inter partes* review of the '667 patent (IPR2015-01714). Pet. 2; Paper 6, 2.

The '667 patent also is subject to *inter partes* review in IPR2015-01896.

C. The '667 Patent

The '667 patent is titled “Location Information Service For A Cellular Telecommunications Network,” and generally relates to a method and system for providing location finding information to a mobile station independently of a vendor. Ex. 1001, 1:52–65. Figure 1 of the '667 patent is reproduced below:

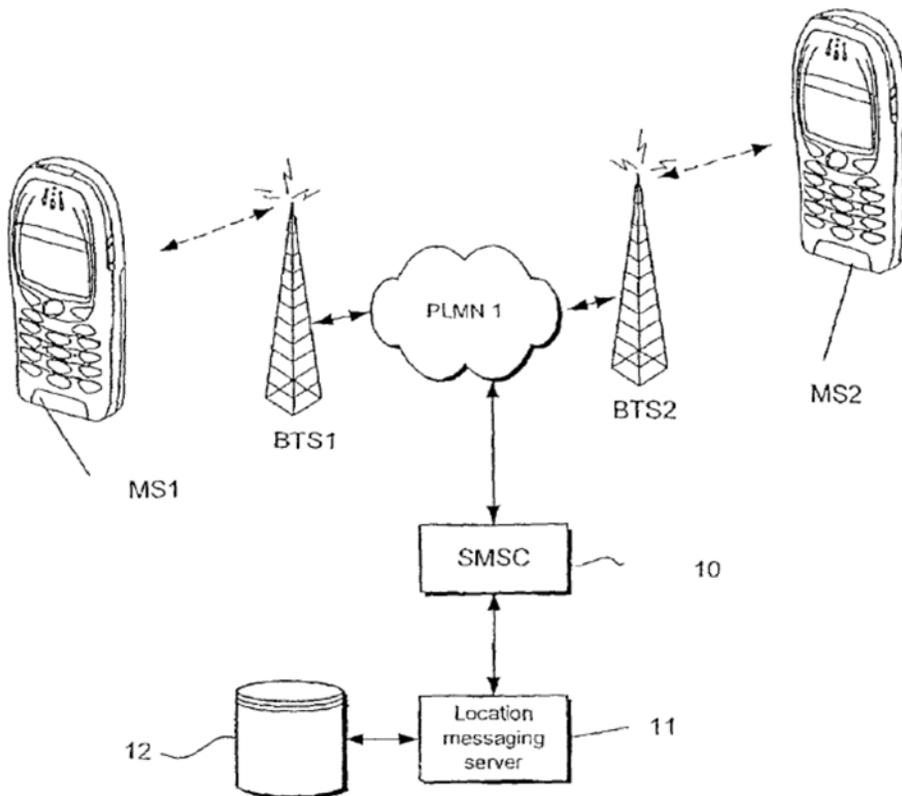


Fig. 1

Figure 1 depicts a cellular telecommunications network including public land mobile network PLMN1 that provides cellular service to mobile stations MS1 and MS2 via base transmitter stations BTS1 and BTS2. Ex. 1001, 2:62–3:3. Figure 1 further depicts short message service (SMS) center SMSC 10 connected to PLMN1 for processing SMS messages containing location information requests and responses, location messaging server 11, and database 12. *Id.* at 3:8–16. As shown in a timing diagram depicted in Figure 2, mobile station MS1 sends request 15, containing MS1’s telephone number and data category D1, D2, or D3 (corresponding to landmark data, railway stations, and restaurant data, respectively) to PLMN1 via BTS1. *Id.* at 3:41–65. PLMN1 generates and sends request 16, containing the identity of the cell (i.e., C1) in which MS1 is located, to SMSC 10. *Id.* SMSC 10 refers the request to location messaging server 11, which retrieves data stored in database 12 corresponding to cell C1 and data category D1, D2, or D3. *Id.* SMSC 10 then creates an SMS text message containing the retrieved data from database 12, and the text is routed back to the original requesting mobile station MS1. *Id.* at 3:66–4:12. The ’667 patent discloses that “[i]t will be understood that with the described system, there is no need to pre-register with the location service that may be provided free of charge by the network operator, or at the usual tariff for SMS messages.” *Id.* at 5:24–27. The ’667 specification describes additional optional features and embodiments.

D. Illustrative Claims

Claims 1, 10, 12, and 13 are independent, and claims 2–9, 11, 14 and 15 depend directly or indirectly therefrom. Claim 1 is illustrative, and is reproduced below:

1. A method of providing a location finding service to mobile stations in a cellular telecommunications network, comprising:
sending a request for location finding information from a mobile station as a message through the network to a location message server; and
receiving data from a data store corresponding to the location finding information based on the cell occupied by at least one mobile station; and
sending the data through the network from the location message server as a message to the mobile station that requested the location finding information; and wherein
the method is performed without pre-registering the mobile station for the location finding service.

E. Art Cited in Petitioner's Challenges

Petitioner cites the following references in its challenges to patentability:

| Reference | Designation | Exhibit No. |
|---------------------------------|--------------------|--------------------|
| PCT Publication No. WO 00/36430 | Staack | 1003 |
| U.S. Patent No. 6,275,707 B1 | Reed | 1004 |
| U.S. Patent No. 6,442,391 B1 | Johansson | 1005 |

F. Grounds of Institution

We previously instituted trial on the following grounds:

Claims 1–3 and 8–14 of the '667 patent under 35 U.S.C. § 102(b) as unpatentable over Staack;

Claim 4 of the '667 patent under 35 U.S.C. § 103(a) as unpatentable over Staack and Johansson; and

Claims 5, 6, 7, and 15 of the '667 patent under 35 U.S.C. § 103(a) as unpatentable over Staack and Reed.

Dec. to Inst. 20.

II. DISCUSSION

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their “broadest reasonable construction in light of the specification of the patent” in which they appear. 37 C.F.R. § 42.100(b); *see also Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2141–46 (2016). The terms also generally are given their ordinary and customary meaning as would be understood by one of ordinary skill in the art in the context of the disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). For purposes of this decision, we determine no claim terms require construction. *See Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011) (“[C]laim terms need only be construed ‘to the extent necessary to resolve the controversy.’”) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

B. Principles of Law

To prevail in its challenges to the patentability of the claims, Petitioner must prove its propositions by a preponderance of the evidence. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). A claim is unpatentable under 35 U.S.C. § 102 if “the prior art reference discloses every element of the claim” *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. Am. Hoist & Derrick Co.*, 730 F.2d 1452, 1457 (Fed. Cir. 1984)). “[A]bsence from the reference of any claimed element negates anticipation.” *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986). Section 103 of Title 35, U.S. Code, “forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole

would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (quoting 35 U.S.C. § 103).

C. Asserted Anticipation Based on Staack

Petitioner asserts that claims 1–3 and 8–14 of the ’667 patent are unpatentable as anticipated by Staack. Pet. 17–45; Reply 7–19. Petitioner proffers a Declaration of Dr. Chris G. Bartone to support its assertions. Ex. 1008. Patent Owner disputes Petitioner’s contentions, arguing that the claims are patentable over Staack. PO Resp. 23–43. We have reviewed the record, and we determine that Petitioner has not shown by a preponderance of the evidence that claims 1–3 and 8–14 of the ’667 patent are unpatentable as anticipated by Staack.

1. Overview of Staack (Ex. 1003)

Staack is titled “Locating System For Mobile Stations,” and relates to estimating the location of a mobile unit in a cellular radio system based on the cell in which the mobile unit is located. Ex. 1003, Abstract. Staack discloses mobile locating unit (MLU) 30 connected to a base station, MLU 30 having associated database 35a which stores the geographic location of the cell’s base station unit. *Id.* at 6:25–7:6.¹ The location of a mobile station, in one embodiment, is estimated to be the location of the base station that occupies the same cell as the mobile station. *Id.* at 7:11–15. Once the estimated location of the mobile station is determined, MLU 30 transmits the information as a text message to the mobile station or another unit. *Id.* at

¹ In this decision, we refer to the page numbers listed at the top of each page of Staack (Ex. 1003) for consistency with the parties’ citations.

9:12–13. Staack further discloses geographical database 35b associated with MLU 30, wherein database 35b stores locations of geographical features such as towns and roads. *Id.* at 9:17–26. Figure 7 of Staack, and accompanying description, discloses a signaling scheme involving a request by mobile station MS1 for information about the location of another mobile station MS2. *Id.* at 13:4–14:30, Fig. 7.

2. Analysis

Independent claims 1, 10, 12, and 13 require, in pertinent part, performing various steps or an apparatus or circuitry operable to perform various steps, including sending a request for location finding information from a mobile station, without pre-registering the mobile station with a location finding service. Central to our Decision is whether Petitioner has demonstrated by a preponderance of the evidence that Staack discloses this feature.

In the “Description of the Prior Art,” the ’667 patent specification describes methods of locating the position of a mobile station, i.e., cellular telephone, within a cellular communications network. Ex. 1001, 1:13–48. The ’667 patent specification describes one method as involving a location finding service offered by a vendor in which users define lists of friends they want to be able to locate, be seen by, or communicate with. *Id.* at 1:31–45. The ’667 patent specification discloses that a disadvantage of this method is that in order for a user to define lists, pre-registration with the vendor is required. *Id.* at 1:46–48. The ’667 patent specification further discloses that the solution to this problem is to provide a location information service that is independent of a vendor so that pre-registration will not be required. *Id.* at 1:52–54.

The '667 patent specification describes an embodiment of the alleged invention in the context of a GSM cellular network, a type of network the specification acknowledges was well known in the art. *Id.* at 2:62–3:7. Mobile station users within the GSM network necessarily subscribe to the GSM network, and are registered with a home location register (“HLR”). *Id.* (“The network . . . includes . . . a home location register as well known in the art.”); *see also* Ex. 1005, 4:30–49 (disclosing that each mobile station with a subscription to a mobile communications system GSM is registered with a home location register HLR). Subscription to the GSM network and registration in the HLR are not described in the '667 patent specification as forms of “pre-registering” for location finding services. On the contrary, the '667 patent specification describes mobile stations within the GSM network as using location finding services without pre-registering for such services. Ex. 1001, 2:62–3:7, 5:24–27. The '667 patent specification discloses that “[i]t will be understood that with the described system, there is no need to pre-register with the location service that may be provided free of charge by the network operator, or at the usual tariff for SMS messages.” *Id.* at 5:25–27. Accordingly, the '667 patent specification describes accomplishing the “without pre-registering” feature by having a network operator provide location finding services, rather than by having a vendor provide such services.

The issue before us is whether Petitioner has shown that Staack describes a mobile station that can send requests for location finding information without pre-registering for location finding services, as required by the claims. Petitioner argues that the “without pre-registering” limitation in the claims is a negative limitation that recites something the claim lacks.

Pet. 24. Petitioner argues that, as a consequence of being a negative limitation, the “without pre-registering” feature need not be expressly disclosed in the prior art reference, but rather may be described adequately if the reference does not require the presence of the feature. *Id.* (citing *CLIO USA, Inc. v. The Procter and Gamble Company*, IPR2013-00448, Paper 15 at 3 (PTAB Feb. 4, 2014) and *Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, IPR2013-00466, Paper 18 at 18 (PTAB Jan. 28, 2014)). Petitioner argues that the systems and methods disclosed in Staack do not require pre-registering for location finding services. Pet. 24. In support of its argument, Petitioner relies on Staack’s disclosure that a user of mobile station MS2 may set an indicator “I” to indicate whether another mobile station, MS1, is permitted to receive information about MS2’s location in response to a request by MS1. *Id.* at 25. Petitioner argues that to the extent this feature relating to indicator “I” may be considered pre-registering for location finding services, Staack discloses that this feature is optional. *Id.* (citing Ex. 1003, 14:16–17). According to Petitioner, because the alleged pre-registration feature in Staack is optional, Staack discloses both pre-registering and not pre-registering. *Id.* (citing *Upsher-Smith Labs., Inc. v. Pamlab*, 412 F.3d 1319, 1322 (Fed. Cir. 2005) (upholding a decision that a prior art reference that disclosed optionally including antioxidants in a composition taught compositions both with and without the antioxidants, and therefore was anticipatory)).

We are not persuaded by Petitioner’s arguments because Petitioner does not explain sufficiently how setting MS2’s indicator “I” involves optionally pre-registering “the mobile station” that sends a message requesting location finding information, as required by the claims. *See, e.g.*,

Ex. 1001, Claim 1 (“sending a request for location finding information from a mobile station . . . without pre-registering the mobile station for the location finding service”). In particular, Petitioner relies on Staack’s description of MS1 requesting information about the location of MS2 for disclosure of sending a request for location finding information by a mobile station. Pet. 18. Petitioner, however, does not provide evidence or argument that MS1 optionally pre-registers for services relating to obtaining location finding information. Petitioner instead identifies a feature in Staack relating to whether MS2 permits information about its location to be divulged to MS1. Pet. 25. Petitioner does not otherwise identify how Staack discloses that the mobile station that sends requests for location finding information optionally pre-registers for location finding services, nor does Petitioner provide sufficient argument or evidence that Staack otherwise discloses the claimed “without pre-registering” limitation. Petitioner, therefore, has not persuaded us that Staack describes the “without pre-registering” limitation.

We have reviewed the parties’ arguments and the evidence of record. Upon review, we determine that Petitioner has not demonstrated, by a preponderance of the evidence, that claims 1, 10, 12, and 13 of the ’667 patent are unpatentable as anticipated by Staack. We further determine that, due to their dependence on claims 1, 10, and 13, Petitioner has not demonstrated, by a preponderance of the evidence, that claims 2, 3, 8, 9, 11, and 14 of the ’667 patent are unpatentable as anticipated by Staack.

D. Asserted Obviousness Based on Staack and Johansson, and Staack, and Reed

Petitioner asserts that claim 4, which depends from claim 1, is unpatentable as obvious over the combination of Staack and Johansson. Pet. 55–60. Petitioner also asserts that claims 5–7 and 15, which depend either

from claim 1 or 13, are unpatentable as obvious over the combination of Staack and Reed. *Id.* at 46–55. Due to their dependence on claims 1 and 13, claims 4–7 and 15 also require the “without pre-registering” claim limitation. For reasons we discussed above, Petitioner had not demonstrated by a preponderance of the evidence that Staack discloses this limitation. Petitioner does not provide additional argument or evidence that Staack, alone or in combination with either Johansson or Reed, teaches or suggests this feature. Accordingly, Petitioner has not demonstrated that this feature would have been obvious.

We have reviewed the parties’ arguments and the evidence of record. Upon review, we determine that Petitioner has not demonstrated, by a preponderance of the evidence, that claim 4 of the ’667 patent is unpatentable as obvious over Staack and Johansson. We determine further that Petitioner has not demonstrated, by a preponderance of the evidence, that claims 5–7 and 15 of the ’667 patent are unpatentable as obvious over Staack and Reed.

III. SUMMARY

For the foregoing reasons, we determine that Petitioner has not demonstrated, by a preponderance of the evidence, that claims 1–3 and 8–14 of the ’667 patent are unpatentable under 35 U.S.C. § 102(b) over Staack; that claim 4 of the ’667 patent is unpatentable under 35 U.S.C. § 103(a) over Staack and Johansson; or that claims 5–7 and 15 of the ’667 patent are unpatentable under 35 U.S.C. § 103(a) over Staack and Reed.

IV. ORDER

Accordingly, it is

ORDERED that claims 1–15 of U.S. Patent No. 7,072,667 B2 have not been shown to be unpatentable; and

FURTHER ORDERED that, because this Decision is final, a party 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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