

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner,

v.

UNWIRED PLANET, LLC,
Patent Owner.

Case CBM2014-00004
Patent 7,463,151 B1

Before MICHAEL W. KIM, JENNIFER S. BISK, and
BARBARA A. PARVIS, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 328(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

A. Background

Petitioner, Google Inc., filed a Petition pursuant to § 18 of the Leahy-Smith America Invents Act (“AIA”).¹ Paper 1 (“Pet.”). The Petition challenged claims 21 and 22 (“the challenged claims”) of U.S. Patent No. 7,463,151 B1 (“the ’151 patent”). On April 8, 2014, we instituted a transitional covered business method patent review based upon Petitioner’s assertion that the challenged claims are unpatentable under 35 U.S.C. §§ 101 and 112, second paragraph. Paper 8 (“Dec.”). A consolidated hearing for CBM2014-00004, CBM2014-00005, CBM2014-00006, IPR2014-00027, IPR2014-00036, IPR2013-00037, involving the same parties, was held January 13, 2015. Paper 31 (hearing transcript).

This is a Final Written Decision under 35 U.S.C. § 328(a). Based on the record presented, we are persuaded that Petitioner has shown by a preponderance of the evidence that the challenged claims are unpatentable under 35 U.S.C. § 101.

B. The ’151 Patent

The ’151 patent relates to mobile wireless networks—providing mobile services using short-range radio communication (“SRC”)² devices.

¹ Pub. L. No. 112-29, 125 Stat. 284, 296–07 (2011).

² Within the ’151 patent, the abbreviation “SRC” is used several times, most often to refer to “short-range radio communication.” *See e.g.*, Ex. 1001, 5:21–23, 8:17 (claim 21). A few instances of the “SRC” abbreviation, however, refer to “short range communication” without the word “radio.” *Id.* at 7:32–33 (claim 17), 8:30–32 (claim 22). Neither party asserts that the abbreviation “SRC” has a different meaning when referring to the phrase “short range communication” without the word “radio.” Thus, for purposes of this Decision, we treat “SRC” as having the same meaning everywhere it is used in the ’151 patent.

Ex. 1001, 1:7–10. An SRC device is described, for example, as a radio frequency identification (“RFID”) tag, “a Bluetooth base station or transponder, or a WiFi device such as a wireless router,” which may or may not be fixed physically within a mobile network. *Id.* at 2:9–21.

The ’151 patent recognizes that, at the time of filing, it could be difficult to locate a mobile terminal (e.g., a cellular telephone) within a mobile network. *Id.* at 1:65–67. For example, using the cell servicing the mobile terminal to determine location may not result in a clearly defined location if the cell covered an overly large physical area. *Id.* at 1:67–2:4. On the other hand, using a Global Positioning System (“GPS”) to determine location could be excessively time consuming. *Id.* at 2:4–8. To address these problems, the ’151 patent discloses using an SRC device to locate a mobile terminal. *Id.* at 1:23–30. In addition to locating the mobile terminal, the SRC device can be used to authenticate and provide services to the mobile terminal. *Id.*

The ’151 patent describes an example in which the SRC device provides identification information to a mobile terminal configured to communicate with the SRC device (“an SRC-enabled mobile terminal”). *Id.* at 1:40–47. The mobile network (or an SRC device information server coupled to the mobile network) then allows a service to be provided to that mobile terminal upon authentication of the identification information. *Id.* Figure 1 of the ’151 patent, reproduced below, illustrates this embodiment.

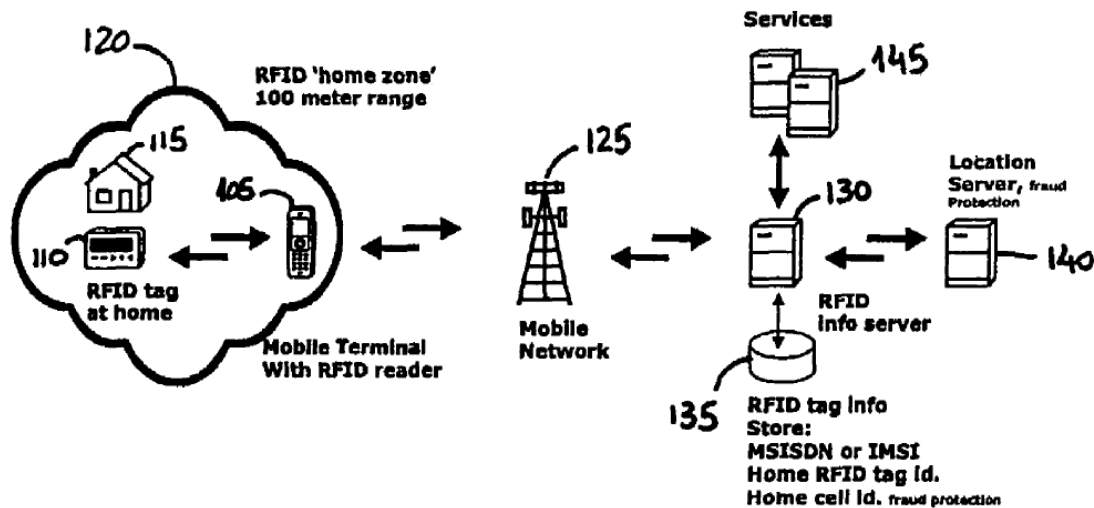


Figure 1 is a diagram of an SRC system using an RFID tag as the SRC device. *Id.* at 1:51–52, 3:7–11. RFID-enabled mobile terminal 105 can read information from RFID tag 110 and can connect to mobile network 125. *Id.* at 3:11–19. Mobile network 125 is coupled to RFID tag information server 130. *Id.* at 3:19–24. In this embodiment, when a subscriber using mobile terminal 105 initiates an action that requires a location determination, such as whether mobile terminal 105 is located in home zone 120, mobile terminal 105 may look to find a nearby RFID tag. *Id.* at 3:25–28. If mobile terminal 105 finds any RFID tags within its range, such as RFID tag 110, that RFID tag provides RFID tag identification information (SRC device information) to mobile terminal 105. *Id.* at 3:28–32. Mobile terminal 105 sends the acquired RFID tag identification information to RFID tag information server 130, which in turn verifies whether the provided RFID tag identification information matches the subscriber's home zone. *Id.* at 3:32–36. If the information matches, home zone services may be provided to mobile terminal 105. *Id.* at 36–38.

The '151 patent also describes using an SRC device such as RFID tag 110 in public or commercial environments—as opposed to the home environment shown in Figure 1—such as a retail store, airport, or shopping mall. *Id.* at 4:4–7. Because the SRC device need not be fixed physically within the network, it may “be mounted on an advertising vehicle.” *Id.* at 4:13–16. A customer with an appropriate SRC-enabled mobile terminal may obtain an access code from any SRC device within range, which code may then be used to obtain “a mobile service free of charge or at a promotional rate over a mobile network.” *Id.* at 4:7–12. This mobile service or reduced rate may be available temporarily while the SRC device is in range of the mobile terminal or while an advertisement is displayed on the mobile terminal. *Id.* at 4:13–18.

C. Related Matters

Petitioner states that the '151 patent has been asserted against Petitioner in a related district court proceeding in the District of Nevada. Pet. 59. Additionally, Petitioner filed a petition for an *inter partes* review in the following proceeding before the Board involving the '151 patent: IPR2014-00027. A final written decision in IPR2014-00027 is entered concurrently with this decision.

Furthermore, U.S. Patent No. 7,203,752 (“the '752 patent”) and U.S. Patent No. 7,024,205 (“the '205 patent”) are involved in the same district court proceeding identified above, and also concern location-based, mobile service technology. The '752 patent and the '205 patent are not, however, in the same patent family as the '151 patent. Petitioner has requested Office review of the '752 patent (Case Nos. CBM2014-00006 and IPR2014-00037) and the '205 patent (Case Nos. CBM2014-00005 and IPR2014-00036).

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