

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner,

v.

UNWIRED PLANET, LLC,
Patent Owner.

Case IPR2014-00027
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. § 318(a) and 37 C.F.R. § 42.73

INTRODUCTION

B. Background

Petitioner, Google Inc., filed a Petition (Paper 3, “Pet.”) to institute an *inter partes* review of claims 21 and 22 (“the challenged claims”) of U.S. Patent No. 7,463,151 B2 (Ex. 1001, “the ’151 patent”). 35 U.S.C. § 311. On April 8, 2014, we instituted a review (Paper 12, “Decision to Institute” or “Dec.”) based upon Petitioner’s assertion that the challenged claims are unpatentable based on the following grounds:

Reference[s] ¹	Basis	Claims Challenged
Fries	§ 102	21 and 22
Rautila	§ 102	21 and 22
Takaragi and Giaglis	§ 103	21 and 22

A consolidated hearing for CBM2014-00004, CBM2014-00005, CBM2014-000006, 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. § 318(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.

C. The ’151 Patent

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

¹ U.S. Patent No. 6,592,032 (Ex. 1005) (“Takaragi”); U.S. Patent No. 6,549,625 (Ex. 1007) (“Rautila”); WO 02/078381 (Ex. 1004) (“Fries”); George M. Giaglis et al., *Towards a Classification Framework for Mobile Location Services, in Mobile Commerce: Technology, Theory and Applications* 64–81 (Idea Group Publishing, 2003) (Ex. 1006) (“Giaglis”).

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

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.

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.

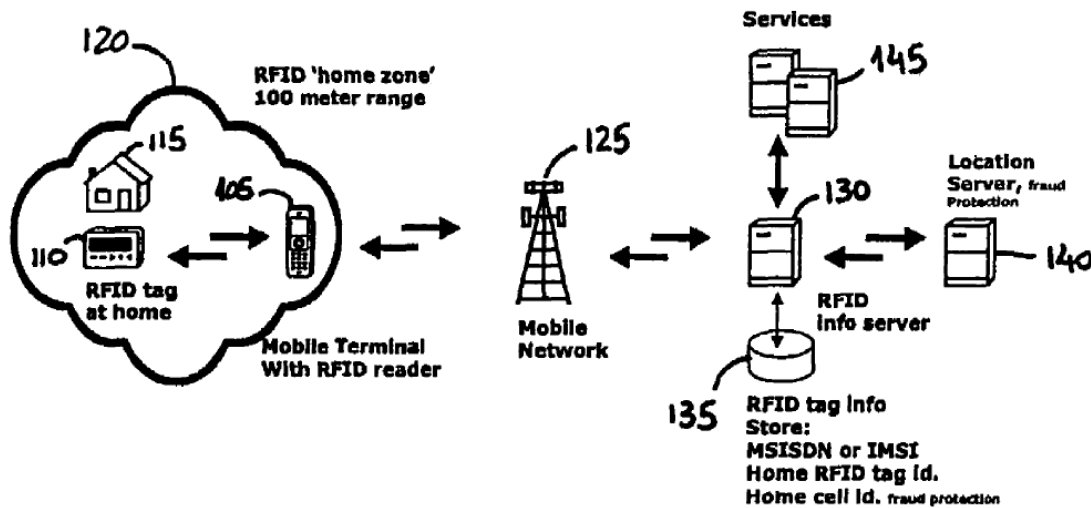


Figure 1 is a diagram of an SRC system using an RFID tag as the SRC device. *Id.* at 1:51–52, 3:7–11. RFID-enabled mobile terminal 105 can read information from RFID tag 110 and can connect to mobile network 125. *Id.* at 3:11–19. Mobile network 125 is coupled to RFID tag information server 130. *Id.* 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.

D. 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 covered business method patent review before the Board involving the '151 patent in the following proceeding: CBM2014-00004. A final written decision in CBM2014-00004 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).

E. The Challenged Claims

Petitioner challenges claims 21 and 22 of the '151 patent. Both claims are independent and recite the following:

21. A method for providing a promotional mobile service to a short-range radio communication (SRC) enabled mobile terminal over a mobile network, the method comprising:

receiving SRC device information from the SRC-enabled mobile terminal over the mobile network, the SRC device information acquired by the SRC-enabled mobile terminal from an SRC device;

authenticating the SRC device information; and

in response to authenticating the SRC device information providing the promotional mobile service to the SRC-enabled mobile terminal over the mobile network on a time-limited basis.

Ex. 1001, 8:16–27.

22. A method for receiving an advertisement over a mobile network, the method comprising:

acquiring short range communication (SRC) device information from a SRC device using an SRC-enabled mobile terminal;

providing the SRC device information to a mobile service provider over the mobile network; and

receiving the advertisement over the mobile network.

Ex. 1001, 8:28–35.

ANALYSIS

A. Claim Construction

In the Decision to Institute, we concluded that the term “on a time-limited basis,” as used in claim 21 means “temporarily such as when the

mobile terminal is in the radio communication range of the SRC device.” Dec. 8–9. In its Response (Paper 23, “PO Resp.”), Patent Owner asserts that this definition improperly allows the required impermanence to depend on proximity rather than depending solely on time. PO Resp. 4–12. Patent Owner’s proposed alternative is “lasting or effective until a temporal limit has been reached.” *Id.* at 6. Petitioner, on the other hand, agrees with our conclusion in the Decision to Institute, arguing that “[b]ecause the specification’s only example of how the mobile service is provided temporarily involves limiting the service to the time when the mobile terminal is in the SRC device’s range, the Board properly included that as an example.” Paper 25 (“Reply”) 2.

The parties appear to agree that the plain and ordinary meaning of “time-limited” is “during a limited time” or “temporarily provided” and that nothing in the phrase “on a time-limited basis,” itself, suggests *how* the time duration is determined. See PO Resp. 6 (“provided for some limited time (*i.e.*, on a time-limited basis)”; Reply 7 (citing Ex. 1026 (Merriam-Webster Dictionary definition of “temporarily” as “during a limited time”)). The dispute is whether the term “on a time-limited basis” as used in claim 21 is limited to periods of time bound only by temporal restrictions (e.g., a preset time limit of 24 hours) or if the term is broader, including not only temporal restrictions, but also other methods of making the service temporary (e.g., when an SRC device, mounted on a vehicle, moves out of range). For the reasons described below, we conclude that the broadest reasonable construction of “on a time-limited basis” is not limited to periods of time bound only by temporal restrictions.

1. The Specification

The parties agree that the '151 patent does not define expressly the term “on a time-limited basis.” In fact, the only place the '151 patent uses the term is within claim 21. The '151 patent does, however, give some context from which to discern the meaning of the term. Both parties point to two relevant sections of the Specification. The first states as follows:

[A]n SRC device may be mounted on an advertising vehicle in order to temporarily provide a mobile service to SRC-enabled mobile terminals within the vehicle's range.

Ex. 1001, 4:13–16. Petitioner argues that this excerpt is the '151 patent's only example of *how* a mobile service may be provided temporarily. Reply 5. According to Petitioner, construing “on a time-limited basis” to exclude this “range-based example” improperly would “exclude the specification's only example explaining how the promotional service is time-limited.” *Id.* (citing *Vitronics Corp. v. Conceptronic*, 90 F.3d 1576, 1583 (Fed. Cir. 1996)).

Patent Owner disagrees, arguing that the concept articulated in this excerpt is a different embodiment than the embodiment covered by claim 21. PO Resp. 10. According to Patent Owner, because the promotional service that is provided “on a time-limited basis” in claim 21 is provided “over the mobile network” (as opposed to being provided by the SRC device) there is no reason to tie the duration of that service to the proximity of the SRC device. PO Resp. 5–6. In other words, according to Patent Owner, the embodiment described by this first excerpt does not make sense in relation to claim 21, because the only step in the claimed method at which the location of the SRC device is relevant is during the time when the mobile

terminal is receiving the SRC device information—*not* when the service is being provided. *Id.* at 5–6, 11.

According to Patent Owner (PO Resp. 11), the embodiment claim 21 was intended to cover is the second relevant section of the '151 patent, which states as follows:

The mobile service provided to the SRC-enabled mobile terminal may be a promotional mobile service temporarily provided to the SRC-enabled mobile terminal.

Ex. 1001, 5:28–31. Patent Owner, however, does not explain what language in this excerpt discloses *how* the mobile service is made to be temporary. *See* PO Resp. 10–11. Instead, Patent Owner appears to conclude that because the first excerpt, disclosing range as a method of limiting time, is not related to claim 21 and this excerpt, which does not refer to range as a method of limiting time, is related to claim 21, claim 21 must not include range as a method of limiting time. *Id.* Even if we agreed with Patent Owner, that the subject matter of claim 21 encompasses only one of the two embodiments, we do not agree with Patent Owner's logic. It does not follow that the scope of one embodiment automatically excludes scope included by another embodiment simply because it is not incorporated expressly. And nothing in the '151 patent warrants such a conclusion here.

Moreover, we are persuaded that *both* excerpts are relevant to claim 21. We are not persuaded that language in either excerpt suggests that the service must be provided by the SRC device, but instead each example appears to contemplate providing services over a mobile network. *See* Reply 7 (citing Ex. 1027, 105:8–106:10). Thus, we see no reason to distinguish the excerpts for that reason. We also agree with Petitioner that the second excerpt on which Patent Owner relies to support claim 21,

includes no language explaining *how* service is provided temporarily. *See* Reply 6–7. Patent Owner has pointed to no other language in the ’151 patent, and we see no such language, describing how, other than proximity to the SRC device, the duration of service is determined.

Thus, we are not persuaded that the Specification provides any support for excluding the only description of how to provide service temporarily from the definition of “on a time-limited basis.” *See, e.g., NeoMagic Corp. v. Trident Microsystems, Inc.*, 287 F.3d 1062, 1074 (Fed. Cir. 2002) (“It is elementary that a claim construction that excludes the preferred embodiment ‘is rarely, if ever correct and would require highly persuasive evidentiary support.’”) (quoting *Vitronics Corp. v Conceptronic, Inc.* 90 F.3d 1576, 1583 (Fed. Cir. 1996)).

2. *The Prosecution History*

Each party argues that the prosecution history of the ’151 patent supports its respective interpretation of the term “on a time-limited basis.” *See* Pet. 13–14; PO Resp. 7–8; Reply 4–5. Specifically, as is relevant to this issue, the original application for the ’151 patent was filed including 20 claims—claims 1, 9, and 17 were independent. Claim 7, dependent from independent claim 1, ultimately was allowed by the Examiner because “patentability resides in ‘allowing a promotional mobile service to be temporarily provided to the SRC-enabled mobile terminal,’ in combination with the other limitations of the claim.” Ex. 1003, 58. This claim later was rewritten in independent form and issued as claim 21. *Id.* at 73–74. Claim 18, dependent from claim 17, recited “providing the mobile service while the SRC-enabled mobile terminal is within range of the vehicle.” *Id.* at 19. This claim was rejected under 35 U.S.C. § 103(a). *Id.* at 56.

Patent Owner argues that this history shows the Examiner differentiated between “temporarily” as recited by claim 7 and “within range of a transportable SRC device” as recited by claim 18 because the two claims did not rise and fall together. PO Resp. 7–8. Thus, according to Patent Owner, the Examiner must have thought there was a difference between “on a time-limited basis” and “within range of an SRC device.” *Id.*

According to Petitioner, the claims from which claims 7 and 18 depend are of different scope, undermining Patent Owner’s entire argument regarding the prosecution history. Reply 3–4. Petitioner also points to Patent Owner’s statement during prosecution that “Applicant notes that the element regarding providing a promotional mobile service on a time-limited basis was contained in a dependent claim that was indicated as allowable subject matter in the Office Action” as supporting a construction including “when the mobile terminal is in range.” Pet. 13–14 (citing Ex. 1003, 73–74).

We are not persuaded that the prosecution history sheds any light on the proper interpretation of “on a time-limited basis.” We agree with Petitioner that original independent claims 1 and 17 included several differences in scope beyond the specified time and proximity restrictions (e.g. claim 1 included an authenticating limitation and claim 17 did not). *See* Ex. 1003, 17–19. Thus, we are not persuaded that the Examiner’s comparative actions on claims 7 and 18 are relevant to the issue of how “on a time-limited basis” is construed. In addition, we are not persuaded that Patent Owner’s statement explaining the amendment of original claim 7 clarifies the scope of claim 21. Instead, because the original language of claim 7—“allowing a promotional mobile service to be temporarily provided

to the SRC-enabled mobile terminal”— it does nothing to clarify the question of *how* the mobile service was to be made temporary. See *id.* at 17.

We are, therefore, not persuaded that the prosecution history adds anything to our understanding of the term “on a time-limited basis” as it is used in the ’151 patent.

3. *Extrinsic Evidence*

Patent Owner provides testimony to support its proposed construction of the term “on a time-limited basis.” PO Resp. 4–12 (citing Ex. 2001 ¶¶ 21–30). The proffered testimony is virtually identical to the arguments in Patent Owner’s brief. For the reasons discussed above with respect to those arguments, we are not persuaded by this testimony. Thus, we are not persuaded that the extrinsic evidence adds anything to our understanding of the term “on a time-limited basis” as it is used in the ’151 patent.

4. *Conclusion*

We conclude that the broadest reasonable construction of “on a time-limited basis” is not limited, as Patent Owner proposes, to time intervals constrained solely by temporal limits. Instead, we interpret “on a time-limited basis” to mean simply “during a limited time” no matter how that time may be limited—whether by proximity, preset time limit, or some other method. Thus, we maintain the interpretation we adopted in our Decision to Institute—“temporarily such as when the mobile terminal is in the radio communication range of the SRC device.”

For purposes of this Decision, “on a time-limited basis” is the only term we determine needs explicit construction.

B. Claim 22

The Petition in this proceeding challenges the patentability of claims 21 and 22 of the '151 patent under 35 U.S.C. §§ 102 and 103. Pet. 17–59. After considering the arguments and evidence presented in the Petition, we instituted trial against both claims, concluding that Petitioner was likely to prevail in showing unpatentability of each of the claims. Dec. 17.

Patent Owner was then afforded the opportunity to file a Patent Owner Response to address “any ground for unpatentability not already denied” by our Decision to Institute. 37 C.F.R. § 42.120. In its Patent Owner Response, Patent Owner does not address claim 22. PO Resp. 2 (“The grounds of rejection for claim 22 are not addressed in the present Response.”). Moreover, the arguments Patent Owner makes with regard to claim 21 are all directed to a limitation not recited by claim 22—“providing the promotional mobile service to the SRC-enabled mobile terminal over the mobile network on a time-limited basis” (“the time-limited service limitation”).

Thus, for claim 22 we are left to consider only the evidence of record as presented in the Petition. See Pet. 17–59. As discussed below, after considering Petitioner’s evidence with respect to claim 22, we find that the preponderance weighs in favor of unpatentability.

C. Anticipation by Fries

1. Overview of Fries

Fries is a PCT Application that describes a system for delivering location related information to mobile telecommunication devices. Ex. 1004, Abs. Figure 1 of Fries is reproduced below:

Fig. 1

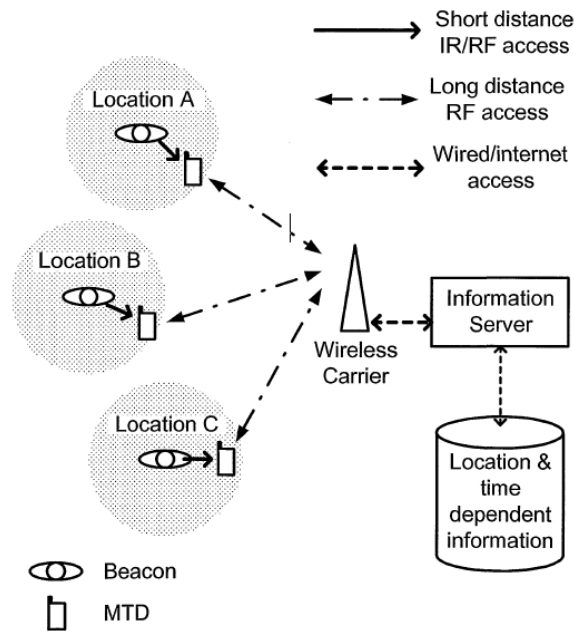


Figure 1 shows the system described in Fries with a plurality of localization devices (“beacons”) arranged in predetermined locations (A, B, C) where they may connect with mobile telecommunication devices (“MTDs”) over “short distance IR/RF access.” *Id.* at 9. One embodiment of a beacon—which need not be in a fixed position (*id.* at 11)—is based on Bluetooth technology (*id.* at 4). The MTDs also may communicate with a wireless carrier over “long distance RF access,” such as a cellular network. *Id.* at 9. The wireless carrier, in turn, communicates over a wired connection or the internet with an information server. *Id.*

When an MTD is brought into range of one of the beacons, the beacon may instruct the MTD to initiate a communication with the information server via the wireless carrier network. *Id.* at 12. These instructions may include an address code of the information server, as well as an identification code specific to the beacon so that the current location of the MTD can be determined by the information server. *Id.* at 4. The MTD then

sends an information request to the information server, including the identification code received from the beacon. *Id.* at 12. The information server matches the beacon identification code with information stored within a database and thereby selects location-specific information to provide to the MTD. *Id.* at 13. The information provided to the MTD may include advertising information pertinent to the MTD's location and the time of the communication. *Id.* at 11.

Fries provides several specific example applications of its system. Ex. 1004, 14–16. Two of these examples (“Example 1” and “Example 2” respectively), describe beacons arranged such that MTDs may query a wait time for a particular service. *Id.* In Example 1 the beacons are positioned at bus stops or taxi stations. *Id.* at 14. When an MTD comes within range, the beacon sends the MTD an identification code, which the MTD forwards to an information server. *Id.* The information server in turn retrieves the schedule of the next bus or nearest taxi based on the identified beacon, and provides the MTD an estimated waiting time. *Id.* at 15.

In Example 2 the beacon is installed in a “queue number ticket distributor[] that provides customers with queue number tickets, for example at a store or a bank office.” *Id.* In this example, the MTD receives a queue number from the beacon and forwards it to the information server, which in turn provides an estimated waiting time. *Id.* The information server can keep the MTD informed about remaining wait time “by periodically sending new messages with indications on the time remaining” until “the remaining time is less than a predetermined value, [when] the server sends a signal for alerting the customer.” *Id.*

2. Analysis

Petitioner asserts that Fries anticipates claims 21 and 22. Pet. 20–23. With respect to the time-limited service limitation, Petitioner points to Example 2 of Fries, described above, in which the information server delivers an approximate remaining waiting time for a particular queue number received from a beacon located at a ticket distributor. *Id.* at 22 (citing Ex. 1004, 15). In particular, Petitioner points to the following language:

The server will keep the customer informed about the actual remaining waiting time by periodically sending new messages with indications on the time remaining until the actual queue number will appear on the distribution display. When the remaining waiting time is less than a predetermined value, the server sends a signal for alerting the customer.

Ex. 1004, 15. We agree that this language discloses the time-limited service limitation. The service (informing the customer of remaining wait time), by definition, ends when the front of the queue is reached. Thus, the provided service is temporary. Patent Owner argues that this example does not disclose the time-limited service limitation because it “lasts as long as necessary based on the queue length” and “[t]he end of the queue is reached not on the basis of some scheduled time but on the basis of queue movement and queue conditions.” PO Resp. 14. As explained above, we are not persuaded that the time-limited service limitation excludes services that are temporary for reasons other than expiration of a scheduled time. Thus, we are persuaded that both Examples 1 and 2 of Fries independently, as relied upon by Petitioner, disclose the time-limited service limitation.

We are persuaded that the other limitations recited by independent claim 21 are disclosed by Fries. See Pet. 20–23; Dec. 9–10. For example,

we are persuaded that the MTDs described by Fries correspond to the claimed SRC-enabled mobile terminals and the beacons correspond to the claimed SRC device. We agree with Petitioner that Fries discloses an information server receiving SRC device information (in the form of a beacon ID) from an MTD over a mobile network, which information was acquired by the MTD from the beacon. Pet. 21 (quoting Ex. 1004, 12). Fries also discloses authenticating the device information by describing the information server matching process. *Id.* (quoting Ex. 1004, 13). Moreover, other than the time-limited service limitation, independent claim 22 is not different materially from claim 21 for purposes of comparison with Fries; thus, we are persuaded that Fries discloses all the limitations of claim 22.

We conclude that Petitioner has shown by a preponderance of the evidence that Fries anticipates claims 21 and 22.

D. Anticipation by Rautila

1. Overview of Rautila

Rautila is a patent directed to “connecting a mobile terminal to a database.” Ex. 1007. Figure 1 of Rautila is reproduced below:



Figure 1 illustrates a communication system in which mobile terminal 12 receives information broadcast by position transceiver 14 over link 24 with a short range (broadcast area 18) and may use Bluetooth protocols. Ex. 1007, 6:23–40. Mobile terminal 12 may be a cellular phone. *Id.* at 1:34–53. The system includes an information server with database 26. *Id.* at 6:63–64.

When mobile terminal 12 is brought into broadcast area 18, position transceiver 14 provides identification information to mobile terminal 12. *Id.* at 6:48–49. This identification information may include the “geographical coordinates” or the “street address” of position transceiver 14’s broadcast location 16, as well as the URL address of the information server. *Id.* at 3:49–64, 7:23–50. Mobile terminal 12 then forwards the identification information to the information server and database 26 via wireless cellular network 42. *Id.* at 7:42–65, 8:30–52. The information server decrypts the

information and matches the location of position transceiver 14 with information stored in database 26. *Id.* at 9:67–10:8. The service subsequently provided by the server to mobile terminal 12 may be advertising. *Id.* at 7:52–65, 8:63–9:11.

2. Analysis

Petitioner asserts that Rautila anticipates claims 21 and 22. Pet. 34–42. With respect to the time-limited service limitation, Petitioner argues that “Rautila’s mobile service is provided temporarily in that it is only provided when the mobile terminal is in range” and “[w]hen outside of that range, the promotional mobile services would no longer be provided to the mobile terminal.” Pet. 39–40 (citing Ex. 1007, 5:54–58).

Patent Owner agrees that “[s]ome of the information service examples described by Rautila appear to be proximity based, for example, operating when the mobile terminal ‘is in the vicinity of the position transceiver.’” Pet. 16 (quoting Ex. 1007, 2:43–48). According to Patent Owner, because this is “a spatial limitation, rather than a time limitation,” Rautila does not disclose the time-limited service limitation. As explained above, we are not persuaded that the time-limited service limitation excludes services that are temporary for reasons other than expiration of a scheduled time. Thus, we are persuaded that the proximity based examples of Rautila disclose the time-limited service limitation.

We are persuaded that the other limitations recited by independent claim 21 are disclosed by Rautila. *See* Pet. 34–42; Dec. 11–12. For example, we are persuaded that mobile terminal 12 described by Rautila corresponds to the claimed SRC-enabled mobile terminals and position transceiver 14 corresponds to the claimed SRC device. We agree with

Petitioner that Rautila discloses an information server receiving SRC device information (in the form of identification information) from mobile terminal 12 over the IP network, which information was acquired by mobile terminal 12 from position transceiver 14. Pet. 38. Rautila also discloses authenticating the device information by describing the information server matching process using database 26. *Id.* at 38–39. Moreover, other than the time-limited service limitation, independent claim 22 is not different materially from claim 21 for purposes of comparison with Rautila; thus, we are persuaded that Rautila discloses all the limitations of claim 22.

We conclude that Petitioner has shown by a preponderance of the evidence that Rautila anticipates claims 21 and 22.

E. Obviousness Over Takaragi and Giaglis

1. Overview of Takaragi

Takaragi describes a method of controlling identification information stored in a storage medium. Ex. 1005, Abs. For example, Takaragi describes a portable card with an antenna that allows identification information stored on the card to be read or transmitted to a terminal for display. Ex. 1005, 1:42–2:11. Figure 1 of Takaragi is reproduced below:

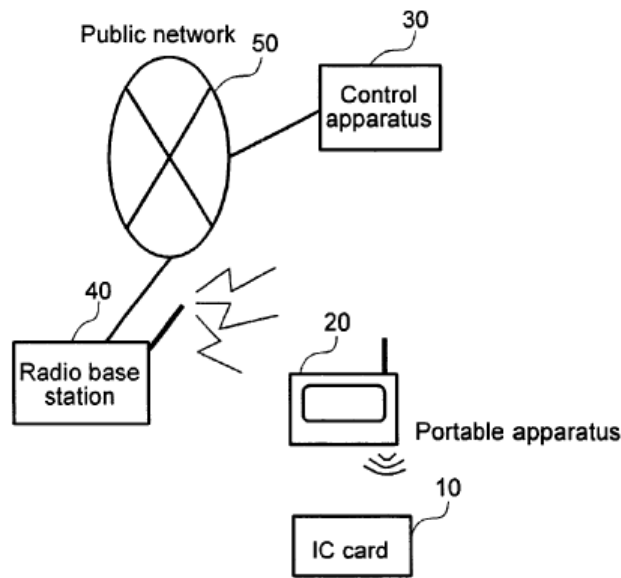


Figure 1 shows control apparatus 30 and portable apparatus 20 connected to each other by radio base station 40 and public network 50 of a mobile communication system for mobile telephones and other radio devices. Ex. 1005, 3:67–4:6. IC card 10 is a storage medium that may communicate using a “non-contact technique” by which “electromagnetic energy” is transferred.” *Id.* at 4:4–16, 4:23–32, 5:9–18. Control apparatus 20 may be implemented on a computer connected to an “ID database” that catalogs information. *Id.* at 10:6–21.

When portable apparatus 20 is brought into range of IC card 10, IC card 10 provides information to portable apparatus 20. *Id.* The information may include an ID number identifying IC card 10, as well as a keyed Message Authentication Code (“MAC”). *Id.* at 4:46–67, 7:48–55. Portable apparatus 20 then forwards the information to control apparatus 30 via public network 50 of a mobile communication system. *Id.* at 4:2–6, 7:48–55. Control apparatus 30 checks whether the information has been altered,

based on the keyed MAC. *Id.* at 7:65–8:14. If the information is determined not to be altered, control apparatus 30 supplies cataloged information associated with the ID number to portable apparatus 20 via network 50. *Id.* at 8:27–48. The cataloged information may have a validity time limit so that IC card 10 will need to be renewed from time to time, or will be valid only for a predetermined period. *Id.* at 15:49–61. For example, “IC card 10 can be used as a card that needs to be renewed such as a driver license” and “can be used as a gift voucher.” *Id.*

2. Overview of Giaglis

Giaglis is a paper describing “[t]he emerging world of Mobile Commerce.” Ex. 1006. It discusses various mobile location services (“MLs”) that can be provided to the user of a mobile device based on the exact geographical location of the mobile user at any time. Ex. 1006, Abs. One such service includes mobile advertising, with examples including “*mobile banners, alerts* (usually dispatched as SMS messages) and *proximity-triggered advertisements*.” *Id.* at 68 (emphasis in original).

3. Analysis

Petitioner asserts that a person of ordinary skill in the art would have found claims 21 and 22 obvious over the combination of Takaragi and Giaglis. Pet. 26–34 (citing Ex. 1002 (Declaration of Dr. Donald Cox)). Petitioner acknowledges that Takaragi does not teach expressly that the information provided to the mobile terminal is an advertisement or promotional mobile service, but argues that Giaglis compensates for these deficiencies. Pet. 26. In particular, Petitioner asserts that a person of skill in the art would make the simple substitution of Giaglis’s advertising applications for Takaragi’s cataloged information. *Id.* at 30–31 (citing KSR

Int'l Co. v. Teleflex, Inc., 550 U.S. 398, 417–418 (2007); Ex. 1002 ¶¶ 38–46). Petitioner asserts that it would have been obvious to one of skill in the art at the time of the invention to make this substitution based on Giaglis's statement that “advertising is amongst the first trial applications of MLS, due to its promising revenue potential” and “opportunities to advertisers to place effective and efficient promotions on mobile environments.” *Id.* at 30 (quoting Ex. 1006, 68).

Patent Owner explicitly addresses only the time-limited service limitation, arguing that neither reference describes services designed to last until or be effective until a temporal limit has been reached. PO Resp. 19–21. Specifically, Patent Owner argues that Takaragi does not disclose the time-limited service limitation, because “the service to validate the driver license or gift voucher keeps working even after the ‘time limit’ for the validity of the information” so “the validation service itself is not time-limited, despite the fact that the objects of the service” might be useless after a certain time period. *Id.* at 19–20. In other words, according to Patent Owner, outside any valid time limits, the mobile service will continue the service by sending a message that the card is invalid. *Id.* Patent Owner does not point to any disclosure of this post-valid period service in Takaragi. *Id.* (citing solely to Ex. 2001 ¶ 46 (Christopher H. Kingdon Declaration)).

We agree with Petitioner that Takaragi discloses the time-limited service limitation. For example, we are persuaded that the gift voucher service described in Takaragi corresponds to the claimed promotional mobile service. We agree with Petitioner that Takaragi discloses that such a card “is valid for only a predetermined period” and a person of skill in the art would understand that the gift voucher service may be provided only

during the valid period.³ See Ex. 1005, 15:57–61. We are not persuaded otherwise by Mr. Kingdon’s conclusory testimony to the contrary. Ex. 2001 ¶ 46.

We are persuaded that the other limitations recited by independent claim 21 are disclosed by Takaragi. See Pet. 26–34; Dec. 13–16. For example, we are persuaded that portable apparatus 20 described by Takaragi corresponds to the claimed SRC-enabled mobile terminal and IC card 10 corresponds to the claimed SRC device. We agree with Petitioner that Takaragi discloses control apparatus 30 receiving SRC device information (for example the ID number) from portable apparatus 20 over the network, which information was acquired by portable apparatus 20 from ID card 10. Pet. 31–32. Takaragi also discloses authenticating the device information by checking whether the information from ID card 10 has been altered. *Id.* at 32. Moreover, other than the time-limited service limitation, independent claim 22 is not different materially from claim 21 for purposes of comparison with Takaragi and Giaglis; thus, we are persuaded that the combination of Takaragi and Giaglis disclose all the limitations of claim 22. We also are persuaded that a preponderance of the evidence demonstrates that a person of ordinary skill in the art would have combined the teachings of Takaragi and Giaglis as described. See Pet. 30–31; Ex. 1002 ¶¶ 38–46.

We conclude that a preponderance of the evidence demonstrates that claims 21 and 22 are unpatentable based on the combination of Takaragi and Giaglis.

³ In fact, we are persuaded that the gift voucher service of Takaragi discloses the time-limited service limitation even using Patent Owner’s more narrow interpretation—“lasting or effective until a temporal limit has been reached.”

ORDER

Accordingly, it is:

ORDERED that claims 21 and 22 of the '151 patent are determined to be *unpatentable*; 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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PETITIONER:

Michael V. Messinger
Joseph E. Mutschelknaus
STERNE, KESSLER, GOLDSTEIN & FOX PLLC
mikem-PTAB@skgf.com
jmutsche-PTAB@skgf.com

PATENT OWNER:

Timothy E. Bianchi
Thomas C. Reynolds
SCHWEGMAN, LUNDBERG & WOESSNER, PA
tbianchi@slwip.com
treynolds@slwip.com
SLW-PTAB@slwip.com