

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA MOBILITY LLC,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

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*.

DECISION

Denying Petitioner's Request on Rehearing of
Final Written Decision on Remand
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Motorola Mobility LLC (“Petitioner”) filed a Revised Petition (Paper 4, “Pet.”)¹ requesting *inter partes* review of claims 1–4, 7, and 18 of U.S. Patent No. 7,382,771 B2 (Ex. 1001, “the ’771 patent”). We instituted an *inter partes* review as to (1) claims 1 and 2 under 35 U.S.C. § 102(e) as anticipated by Boehm²; (2) claims 1, 3, 4, 7, and 18 under 35 U.S.C. § 103(a) as unpatentable over Mitchell³ and Boehm; and (3) claims 1–4 and 18 under 35 U.S.C. § 103(a) as unpatentable over Veeck,⁴ Boehm, and Mitchell. Paper 12, 20. We did not institute an *inter partes* review on any of the other grounds set forth in the Petition. *Id.* On September 9, 2015, we issued a Final Written Decision holding that claims 1–4, 7, and 18 were unpatentable on the instituted grounds. Paper 46 (“Final Dec.”) 20–34, 39; *see also* Paper 47 (errata) 1–2.

The Final Written Decision was appealed by Patent Owner to the United States Court of Appeals for the Federal Circuit. *See* Paper 49. The Federal Circuit vacated our determination as to all claims, holding that the Board had erred in evaluating the evidence of prior conception offered by Patent Owner, and remanded for further consideration. *Intellectual Ventures II LLC v. Motorola Mobility LLC*, 692 F. App’x 626, 629 (Fed. Cir. 2017) (“*Intellectual Ventures II*”).

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.

² US 2004/0085944 A1, published May 6, 2004 (Ex. 1005, “Boehm”).

³ US 7,599,691 B1, issued Oct. 6, 2009 (Ex. 1006, “Mitchell”).

⁴ US 2005/0039208 A1, published Feb. 17, 2005 (Ex. 1008, “Veeck”).

On July 31, 2018, we entered an Order that modified the institution decision to include review of all challenged claims and all grounds presented in the Petition, in accordance with the U.S. Supreme Court’s decision in *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018). Paper 54, 6. On March 13, 2020, we issued a Final Written Decision on Remand, holding that Petitioner had not met its burden of showing, by a preponderance of the evidence, that claims 1–4, 7, and 18 of the ’771 patent were unpatentable as either anticipated by Boehm, or obvious over certain combinations of Mitchell, Boehm, Kellerer,⁵ and Veeck. Paper 84 (“Remand Dec.”).

On April 13, 2020, Petitioner filed a Request for Rehearing of the Final Written Decision on Remand. Paper 85 (“Req.”). For the reasons that follow, the Request is *denied*.

II. STANDARD OF REVIEW

In pertinent part, 37 C.F.R. § 42.71(d) states:

The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

Thus, a request for rehearing is not an opportunity merely to disagree with the Board’s assessment of the arguments or weighing of the evidence, or to present new arguments or evidence.

⁵ Wolfgang Kellerer et al., *(Auto) Mobile Communication in a Heterogeneous and Converged World*, IEEE Personal Communications, Dec. 2001, 41 (Ex. 1007, “Kellerer”).

III. ANALYSIS

Independent claim 1 of the '771 patent recites, in pertinent part, a mobile wireless hot spot system that 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” (the “stand-alone system limitation”). Ex. 1001, 6:24–28.

In the Final Written Decision on Remand, we determined that “under the rule of reason, . . . the evidence establishes that the inventors conceived the invention of claim 1 prior to November 4, 2002.” Remand Dec. 39. Petitioner argues that the Board “misapprehends or overlooks the context surrounding the inventor testimony and improperly relies on such testimony for corroboration.” Req. 3–9.

In the Final Written Decision on Remand, we determined that “we are not persuaded that Kellerer discloses a stand-alone system that enables client devices to access the Internet without the need to access an external access controller server.” Remand Dec. 61. Petitioner argues that the Board misapprehends and overlooks teachings of Kellerer that render a stand-alone system obvious. Req. 9–13.

We analyze each argument in turn.

A. Conception

1. Context Surrounding Inventor Testimony

Petitioner asserts that the Board wrongly concluded that the evidence of conception showed the stand-alone system limitation, even though “the evidence reveals a complete absence of corroboration regarding the key stand-alone system limitation.” Req. 3–4. Specifically, Petitioner asserts

that the Board “overlooks the actual teaching of Exhibit 2009 when it credits LeBlanc’s testimony,” misapprehends or overlooks that Dr. Tewfik’s testimony “fails as a matter of law to provide independent corroboration,” and also misapprehends or overlooks that Exhibit 2020 fails to provide contemporaneous evidence that the MHS1 was a stand-alone system. Req. 4–6.

We are not persuaded by Petitioner that we misapprehended or overlooked the evidence regarding conception of the stand-alone system limitation because, as explained below, the Board considered and analyzed expressly each piece of evidence Petitioner asserts was misapprehended or overlooked.

First, Petitioner asserts that the Board “overlooks the actual teaching of Exhibit 2009 when it credits LeBlanc’s testimony.” Req. 4–5. We disagree because we considered and analyzed expressly the teachings of Exhibit 2009 in crediting Mr. LeBlanc’s testimony. Remand Dec. 32–34. We cannot have misapprehended or overlooked that which we analyzed expressly.

Petitioner asserts that Exhibit 2009 does not disclose whether the hotspot was internal or external. Req. 4. Petitioner’s assertions are misplaced because the Board did not rely on Exhibit 2009 for disclosing an internal or external hotspot. For that, the Board relied on Exhibit 2006. Remand Dec. 34–35.

Petitioner asserts that Exhibit 2009 is “nothing more than an incomplete draft with over a dozen sections left blank.” Req. 5 (citing Remand Dec. 33; Ex. 2009 at 1, 9–14). We are not persuaded that we misapprehended or overlooked this argument because it was not presented

prior to Petitioner's Request for Rehearing. Although Petitioner provides citations to the record, we do not identify any portions in the record where this argument appears. *See* Req. 4 (citing Paper 26 at 1–6; Paper 52 at 2–7). Accordingly, we are not persuaded that we misapprehended or overlooked this argument because it was not before us.

In any case, even considering the draft form of Exhibit 2009, we are unpersuaded that the fact that Exhibit 2009 may be “incomplete” means that it cannot corroborate the stand-alone system limitation. Regardless of its completeness, a draft can still corroborate, such as we determined it did here by providing a comprehensive accounting of the components the MHS1 requires. *See* Remand Dec. 35–37 (discussing Exhibit 2020's reference to a “Mobile HotSpot” device with the same configuration as Exhibit's 2009's MHS1 as supporting the MHS1's disclosure of the stand-alone system limitation). If anything, Petitioner appears to be asserting that it should be accorded little weight. To that end, Petitioner's assertion is noted and considered, but does not change the outcome of this case.

Petitioner further asserts that the Board misapprehends or overlooks that Dr. Tewfik's testimony is not credible because he has “no personal knowledge” and “merely parrots the inventor's claim chart.” Req. 6. We disagree, because we considered and analyzed expressly Petitioner's argument and the basis for Dr. Tewfik's testimony. Remand Dec. 27, 30. We determined that Dr. Tewfik's testimony was credible, in that it was testimony concerning his opinion with respect to the claim chart, and also that his testimony was based, at least in part, on his personal experience with Windows 98 and its functionalities. *Id.* at 30. Indeed, the Federal Circuit noted that the rule of reason requires us to consider all pertinent evidence,

and then noted explicitly that Dr. Tewfik's testimony was one example of such pertinent evidence that needed to be considered. *See Intellectual Ventures II*, 692 F. App'x at 627–628. For these reasons, we are not persuaded that we misapprehended or overlooked the credibility of Dr. Tewfik's testimony.

Petitioner asserts that the Board misapprehends or overlooks that Exhibit 2020 does not corroborate that the MHS1 was a stand-alone system. Req. 5. First, Petitioner argues that the Board misapprehended or overlooked the fact that Exhibit 2020 is not contemporaneous evidence because it is dated over a month after Boehm. Req. 5 n.1. We disagree, because we considered and analyzed expressly the extent to which Exhibit 2020 serves as corroborating evidence for Mr. LeBlanc's testimony, and expressly took into account the date. Remand Dec. 35. Second, Petitioner argues that the Board misapprehended or overlooked the fact that Exhibit 2020 is ambiguous as to whether DHCP was implemented internally or externally. Req. 5 n.1. We disagree, because we considered and analyzed expressly this ambiguity, and determined the following:

Exhibit 2020's statement that the Mobile Hotspot assigns users private IP addresses instead lends credibility to Mr. LeBlanc's testimony that the MHS1 did not have the need to access an external service controller server to provide the DHCP functionality or to access the Internet. *See* Ex. 2006 ¶ 15.

Remand. Dec. 37. Therefore, we are not persuaded that we misapprehended or overlooked Petitioner's assertion that Exhibit 2020 fails to corroborate the stand-alone system limitation.

Petitioner requests that the Board reassess its analysis under the rule of reason. Req. 9. Petitioner's request is improper and unnecessary, because the Final Written Decision on Remand employed a rule of reason

analysis. *See, e.g.*, Remand Dec. 16; *see also* 37 C.F.R. § 42.71(d) (A request for rehearing “must specifically identify all matters the [requesting] party believes the Board misapprehended or overlooked.”). Nonetheless, even considering Petitioner’s arguments anew, we reach the same conclusion as in the Final Written Decision on Remand for the reasons that follow.

Under the rule of reason, “all pertinent evidence is examined in order to determine whether the inventor’s story is credible.” *Fleming v. Escort Inc.*, 774 F.3d 1371, 1377 (Fed. Cir. 2014) (quoting *Sandt Tech., Ltd. v. Resco Metal & Plastics Corp.*, 264 F.3d 1344, 1350 (Fed. Cir. 2001)). However, “[t]he law does not impose an impossible standard of independence on corroborative evidence by requiring that every point of a reduction to practice be corroborated by evidence having a source totally independent of the inventor.” *Id.* (citing *Cooper v. Goldfarb*, 154 F.3d 1321, 1331 (Fed.Cir.1998)). Corroborating evidence need not constitute definitive proof of the inventor’s account or disclose each claim limitation as written. *Intellectual Ventures II*, 692 F. App’x at 627 (citing *Fleming*, 774 F.3d at 1377). Instead, “[t]he focus must be whether the totality of the evidence makes the inventor’s testimony credible.” *Intellectual Ventures II*, 692 F. App’x at 627 (citing *Fleming*, 774 F.3d at 1377).

To that end, although we stand by our previous analysis in the Final Written Decision on Remand with respect to the stand-alone system limitation, we summarize below certain aspects of that analysis for completeness. Specifically, Mr. LeBlanc testified that “the MHS1 itself executed the Dynamic Host Configuration Protocol (DHCP) for configuring client devices to connect with the Internet” and that “[t]he MHS1 also

performed network address translation using tools and functions included in Windows 98.” Ex. 2006 ¶ 15. Mr. LeBlanc’s further testified that the MHS1 did not require an external service controller server to provide the DHCP functionality or to access the Internet and that “user devices could connect via WiFi and obtain an IP address via DHCP implemented locally at the MHS1.” Ex. 2006 ¶¶ 15, 24.

The totality of the evidence, including Exhibit 2009, Dr. Tewfik’s testimony, and Exhibit 2020, corroborates Mr. LeBlanc’s testimony. For example, Exhibit 2009 references providing DHCP functionality for client devices and the MHS1 deploying Windows 98. Ex. 2009 §§ 2.3.4, 2.4.1.1.1. And Dr. Tewfik testified that Windows 98 provided DHCP functionality and “managed the connection between the WiFi short-range wireless system and the long range cellular data connection.” Ex. 2004 ¶ 35; Ex. 1014, 12:17–13:11. Exhibit 2020 states that the Mobile Hotspot assigns users private IP addresses. Ex. 2020, 6. This evidence collectively lends credibility to Mr. LeBlanc’s testimony that the MHS1 did not have the need to access an external service controller server to provide the DHCP functionality or to access the Internet. Moreover, we determined that other portions of Mr. LeBlanc’s testimony was adequately corroborated and credible. Remand Dec. 28–32, 40. Accordingly, upon reconsideration, we determine, once again, that the totality of the evidence corroborates sufficiently Mr. LeBlanc’s testimony with respect to the stand-alone system limitation under a rule of reason framework.

For the above reasons, we are not persuaded that the Board misapprehended or overlooked the context surrounding the inventor testimony.

2. Reliance on Inventor's Testimony as Corroboration

Petitioner argues that the Board misapprehends or overlooks Petitioner's argument that "Exhibit 2009 says nothing about DHCP being implemented locally at the MHS1" and thus "improperly relies on [Mr.] LeBlanc's own testimony about Exhibit 2009 to determine what the exhibit purportedly shows." Req. 8.

We are not persuaded that we misapprehended or overlooked Petitioner's argument. We considered and analyzed expressly the extent of Exhibit 2009's disclosure, including Petitioner's argument that Exhibit 2009 "fails to explain that the DHCP process is carried out internally in the MHS1, without accessing an external DHCP server." Remand Dec. 33–34. We cannot have overlooked that which we analyzed expressly. At best, this assertion challenges the weight to be accorded the above evidence and testimony. Even when we discount the weight to be accorded Exhibit 2009 in light of Petitioner's assertions, we remain persuaded that Exhibit 2009 corroborates sufficiently Mr. LeBlanc's testimony with respect to conception of the stand-alone system limitation.

Specifically, Mr. LeBlanc testified about the MHS1's ability to execute DHCP and perform network address translation using Windows 98 without using an external service controller. *See supra* § II.A.1. Mr. LeBlanc cited Exhibit 2009 as evidence of corroboration. *Id.* (citing Ex. 2009 §§ 2.3.4, 2.4.1.1.1). The relevant inquiry here is not whether Exhibit 2009 discloses explicitly what Mr. LeBlanc asserts is disclosed, but whether Exhibit 2009 lends sufficient credibility to Mr. LeBlanc's testimony. To that end, § 2.3.4 references that DHCP configures client devices to connect to the Internet. Ex. 2009 § 2.3.4. Moreover, § 2.4.1.1.1 references that the MHS1

deploys Windows 98. *Id.* § 2.4.1.1.1. We find that these portions of Exhibit 2009 lend adequate credibility to Mr. LeBlanc’s testimony because they describe the MHS1 providing Internet access once the DHCP process is completed, without referencing an external DHCP server. Remand Dec. 34 (citing Ex. 2009 § 2.3.4[3]).

Finally, Petitioner argues that Exhibit 2009 must show that the MHS1 itself executed DHCP. Req. 8–9. Such a requirement is an overly-narrow, element-focused attack that is inconsistent with the required rule of reason analysis. *See Intellectual Ventures II*, 692 F. App’x at 628 (citing *TransWeb, LLC v. 3M Innovative Props. Co.*, 812 F.3d 1295, 1302 (Fed. Cir. 2016)). It is unpersuasive for the reasons set forth above.

B. Obviousness

Petitioner argues that the Board misapprehends or overlooks Kellerer’s teachings with respect to Figures 3 and 4 showing a stand-alone system. Req. 9–11. Specifically, Petitioner asserts that the Board misapprehends or overlooks that: (1) Figure 3 teaches server architecture located inside the car, and (2) Figure 4 shows “all of the components that are necessary to enable Internet access, including a central control unit, IP address management, routing, application servers (e.g., e-mail servers), and network managers provided within the hotspot.” *Id.* at 10.

We are not persuaded that we misapprehended or overlooked the teachings of Figures 3 and 4. First, Figure 4 of Kellerer was considered in the Final Written Decision on Remand. *See* Remand Dec. 49–50. Second, although our analysis in the Final Written Decision on Remand of Petitioner’s assertions regarding Kellerer’s teachings may not have explicitly mentioned Figures 3 and 4, these teachings were implicitly considered and

analyzed in our analysis of Kellerer. Specifically, these teachings were considered because the first and second of the three passages from Kellerer cited by Petitioner, and expressly addressed in the Final Written Description, relate to Figures 3 and 4. *See* Remand Dec. 56–60; Ex. 1007, 45.

Even if we were to have discussed Figures 3 and 4 explicitly, it would not have changed the outcome of our Decision. In Figure 4, Kellerer shows a block with a central control unit, address management, routing, an application server, and network managers. Exhibit 1007, 45. This block diagram, however, does not specifically address whether or not Internet access requires an external service controller. Moreover, Petitioner provides no citations to any passages that describe the functions of the central control unit, address management, routing, the application server, and the network managers. *See generally* Req. 9–13. We are not persuaded that Kellerer teaches all of the components that are necessary to enable Internet access based on Figure 4 alone. That these components are located inside the car, as shown in Figure 3, also does not specifically address whether or not Internet access requires an external service controller. Accordingly, we are not persuaded that Figures 3 and 4 render the stand-alone system limitation obvious.

Petitioner also argues that the Board misapprehends or overlooks that Kellerer teaches application servers, address management, and a proxy cache within the hotspot that “are in relevant part identical” to the ’771 patent’s web server, address management, and local content module within the hotspot. Req. 11–12 (citing Ex. 1001; Ex. 1003, 79–71; Ex. 1007, Fig. 4, 5–6); Supp. Pet. Reply 13–14 (citing Ex. 1001; Ex. 1003, 79–71; Ex. 1007, Fig. 4, 5–6). Thus, “[t]o the extent the ’771 Patent describes a stand-alone

system that enables Internet access without the need to access an external service controller server, so must Kellerer.” Req. 12; *see* Supp. Pet. Reply 14.

In the Final Written Decision on Remand, we considered and analyzed expressly Kellerer’s teachings regarding application servers, and were not persuaded that Kellerer’s application servers taught the stand-alone system limitation. Remand Dec. 57–60. Therefore, we are unpersuaded that we misapprehended or overlooked Kellerer’s teachings regarding application servers.

We acknowledge that the Final Written Decision on Remand did not explicitly discuss Kellerer’s address management and proxy cache, although like Figures 3 and 4 set forth above, these teachings were implicitly addressed in the aggregate in our analysis of Kellerer’s system. For completeness, we explicitly address these teachings now.

Kellerer’s only reference to “[a]ddress management” is in Figure 4. *See generally* Exhibit 1007. Kellerer provides no further discussion on what the “[a]ddress management” block in Figure 4 does. *Id.* Petitioner provides no other citations regarding Kellerer’s address management function. *See generally* Req. 9–13. We are not persuaded that a passing and generic reference to “[a]ddress management” is identical to the ’771 patent’s address management functions such as DHCP. *See* Ex. 1001, 3:59–4:20, Figs. 2, 4.

Turning to Kellerer’s proxy cache, we agree that it is similar to the ’771 patent’s local content module. We are not, however, persuaded that Kellerer’s disclosure of a proxy cache alone supports sufficiently a teaching of the stand-alone system limitation. Accordingly, we are not persuaded that

Kellerer teaches a system that is in relevant part identical to the '771 patent's stand-alone system limitation.

Petitioner asserts that “the Board’s analysis of Kellerer is flawed” because “the Board imagines Kellerer might use an undisclosed external service controller server even though [Dr. Roy] testified one is not needed.” Req. 12–13 (citing Ex. 2004, 20:9–21). The assertion is misplaced because we considered and analyzed expressly the cited testimony from Dr. Roy and his basis for the conclusion that Kellerer’s email server did not need to access an external service controller. Remand Dec. 58–60. Ultimately, we were unpersuaded because we instead credited Dr. Tewfik’s opposing testimony in determining that Kellerer’s e-mail server did not support the stand-alone system limitation. *Id.* at 60.

To the extent Petitioner relies on Dr. Roy’s testimony for the fact that an external service controller server is not needed to support its arguments regarding Figures 3 and 4, and the gateway’s address management and proxy cache, we note that the cited portions of Dr. Roy’s testimony only addresses email servers, and do not address any other aspect of Figures 3 and 4, address management, or a proxy cache. Therefore, we are not persuaded that we misapprehended or overlooked Dr. Roy’s testimony regarding external service controller server arguments that were never made.

Petitioner argues that “[e]ven if, as the Board concludes, a person of ordinary skill in the art would have known that Kellerer’s email server could have been implemented either with or without an external service controller server, those are nothing more than predictable variations.” Req. 13. Petitioner, however, fails to provide a citation to the record where this argument was timely raised. *See id.* Accordingly, we are not persuaded that

we misapprehended or overlooked this argument because it was not before us prior to Petitioner's Request for Rehearing.

For the above reasons, we are not persuaded that the Board misapprehended or overlooked teachings in Kellerer that Petitioner argues would have rendered the challenged claims obvious.

III. CONCLUSION

Petitioner's Request for Rehearing is *denied*.

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