

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*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Google Inc. and LG Electronics, Inc. (collectively, “Petitioner”) seeks rehearing (Paper 22, “Request” or “Req. Reh’g”) of our determination in the Final Decision (Paper 21, “Final Decision”) that Petitioner failed to demonstrate by a preponderance of the evidence that claims 1–15 of U.S. Patent No. 7,072,667 B2 (Ex. 1001, the “’667 patent”) are unpatentable. We have considered Petitioner’s Request, but for reasons that follow, we decline to modify our Final Decision.

II. LEGAL STANDARD

The standard of review for rehearing requests is set forth in 37 C.F.R. § 42.71(d), which provides:

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.

III. DISCUSSION

Petitioner challenges our determination that Petitioner failed to show that Staack¹ discloses either performing various steps or an apparatus or circuitry operable to perform various steps, “*without pre-registering the mobile station [for/with] the location finding service,*” as recited in the challenged claims. Req. Reh’g 1. Petitioner argues that in the Final Decision, we overlooked Petitioner’s argument that the “without pre-registering” claim limitation is met by the fact that pre-registering is not expressly required in Staack. *Id.* Petitioner argues that we instead only

¹ PCT Publication No. WO 00/36430 (Ex. 1003) (“Staack”).

considered an alternative argument in the Petition. *Id.* For reasons that follow, we disagree with Petitioner.

In the Petition, Petitioner argued that the “without pre-registering” limitation is a negative limitation that “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” (“negative limitation argument”). Pet. 24. Petitioner also argued that, to the extent Patent Owner proposed that maintaining a list of entities permitted to receive location information is considered registering, Staack discloses this feature is optional (“contingent argument”). *Id.* at 25. With respect to both arguments, Petitioner relied on disclosure in Staack regarding checking whether a first mobile station MS1 is permitted to receive location information about a second mobile station MS2 (“Staack check feature”). *Id.* (citing Ex. 1003, 14:16–23).

In the Request, Petitioner raises the discussion of the Staack check feature in the Final Decision, and argues that we failed to consider the negative limitation argument, but rather only considered the contingent argument. Req. Reh’g 4–5. We disagree because the Staack check feature was relied on by Petitioner not just for the contingent argument, but also for the negative limitation argument.

In the Final Decision, we expressly considered Petitioner’s negative limitation argument. Final Decision 9–10 (citing 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.”). We further noted that “Petitioner argues that the

systems and methods disclosed in Staack do not require pre-registering for location finding services,” and that in support of this argument Petitioner relied on the Staack check feature. Final Decision 10 (“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.”). Based on Petitioner’s arguments regarding the Staack check feature, we were not persuaded that Staack does not require “pre-registering.” *Id.* at 11. Accordingly, Petitioner’s negative limitation argument was not persuasive. *Id.* at 10–11.

We, therefore, did not overlook Petitioner’s negative limitation argument.

Petitioner also argues that in the Decision on Institution of *Inter Partes* Review in this proceeding (“Decision to Institute,” Paper 8), we agreed with Petitioner’s argument that Staack does not require pre-registering. Req. Reh’g 3. Petitioner’s argument misses a critical distinction. We stated in the Decision to Institute that we were persuaded that Staack does not explicitly disclose pre-registering. Decision to Institute 13. On the record before us at the time, we noted that we did not infer from Staack’s silence that pre-registering was required. *Id.* at 14 (citing *Süd-Chemi, Inc. v. Multisorb Techs., Inc.*, 554 F.3d 1001, 1005 (Fed. Cir. 2009)). It is insufficient, however, to show that Staack does not explicitly describe a feature. Rather, Petitioner needed to show that a person of ordinary skill in the art would have understood that Staack does not require pre-registering. *Süd-Chemi*, 554 F.3d at 1004–05. Based on the record developed at the time of institution, we determined that Petitioner had

shown a reasonable likelihood that it would prevail with respect to at least one challenged claim. Decision to Institute 14–15. In the Final Decision, however, we determined that Petitioner had not demonstrated unpatentability by a preponderance of the evidence. Final Decision 11–12. Notably, Petitioner did not provide sufficient evidence or argument during the proceeding that a person of ordinary skill in the art would have understood Staack does not require pre-registering. *Id.* at 9–12.

IV.CONCLUSION

Having considered Petitioner’s Request, Petitioner has not persuaded us, for the reasons discussed, that our Final Decision should be modified.

V. ORDER

Accordingly, it is:

ORDERED that the Request for Rehearing is *denied*.

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