

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner,

v.

UNWIRED PLANET, LLC,
Patent Owner.

Case CBM2014-00005
Patent 7,024,205 B1

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

PARVIS, *Administrative Patent Judge*.

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

I. INTRODUCTION

On October 8, 2013, Google Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”), requesting a review of U.S. Patent No. 7,024,205 B1 (Ex. 1001, “the ’205 patent”) under the transitional program for covered business method patents. Petitioner challenged the patentability of claims 1–6 of the ’205 patent under 35 U.S.C. §§ 101, 103, and 112, first and second

paragraphs. Pet. 30–32. On April 8, 2014, we instituted trial for all challenged claims, 1–6 of the ’205 patent, on the ground that the challenged claims are unpatentable, under 35 U.S.C. § 112, first paragraph,¹ as lacking written description support. Paper 10 (“Decision to Institute” or “Inst. Dec.”).

After institution of trial, Patent Owner, Unwired Planet, LLC (“Patent Owner”) filed a Patent Owner Response (“PO Resp.”). Paper 23. Petitioner filed a Reply to the Patent Owner Response. Paper 25 (“Pet. Reply”).

A consolidated oral hearing for CBM2014-00004, CBM2014-00005, CBM2014-00006, IPR2014-00027, IPR2014-00036, and IPR2014-00037, each involving the same Petitioner and the same Patent Owner, was held on January 13, 2015. The transcript of the consolidated hearing has been entered into the record. Paper 31 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 328(a) and 37 C.F.R. § 42.73.

Petitioner has shown by a preponderance of the evidence that claims 1–6 of the ’205 patent are unpatentable.

A. *The ’205 Patent*

The ’205 patent relates to subscriber delivered, location-based services. Ex. 1001, 1:14. The ’205 patent states that location-based service systems have been implemented or proposed for wireless networks. *Id.* at 1:28–30. According to the ’205 patent, these systems generally involve

¹ Section 4(c) of the Leahy-Smith America Invents Act (“AIA”) re-designated 35 U.S.C. § 112, ¶ 1, as 35 U.S.C. § 112(a). Pub. L. No. 112-29, 125 Stat. 284, 296 (2011). Because the ’205 patent has a filing date before September 16, 2012 (effective date of § 4(c)), we will refer to the pre-AIA version of § 112.

determining location information for a wireless transceiver and processing the location information to provide an output desired for a particular application. *Id.* at 1:30–33. The '205 patent indicates that location-based services can be expanded by receiving a service request from subscriber equipment and delivering to the subscriber equipment information based, at least in part, on a location of the subscriber equipment. *Id.* at 1:59–67. The '205 patent provides exemplary requests for services: *TRAFFIC, *HOTEL, *TOW, *PIZZA, and *ATM. *Id.* at 2:32–35. The '205 patent also states that location-based services can be enhanced by personalizing the services provided by processing a request based, at least in part, on stored information regarding a subscriber. *Id.* at 2:9–14. Subscriber information may include account numbers, credit card numbers, other financial information, lodging preferences, price limitations, and discount programs. *Id.* at 2:14–19.

B. Related Matters

Petitioner states that the '205 patent has been asserted against Petitioner in a related district court proceeding in the District of Nevada. Pet. 1, 19. Additionally, Petitioner filed the following *inter partes* review before the Patent Trial and Appeal Board involving the '205 patent: IPR2014-00036. A Final Written Decision in IPR2014-00036 is entered concurrently with this decision.

Furthermore, U.S. Patent No. 7,203,752 (“the '752 patent”) and U.S. Patent No. 7,463,151 (“the '151 patent”) are involved in the same district court proceeding identified above, and also concern location-based, mobile service technology. The '752 patent and the '151 patent are not, however, in the same patent family as the '205 patent. Petitioner has requested Office

review of the '752 patent (Case Nos. CBM2014-00006 and IPR2014-00037) and the '151 patent (Case Nos. CBM2014-00004 and IPR2014-00027).

C. Illustrative Claim

Of the challenged claims 1–6, only claim 1 is independent. Claims 2–6 each depend directly from claim 1. Claim 1 is reproduced below:

1. A method for providing location based services in a wireless network comprising the steps of:

receiving, on a network platform in communication with a subscriber using a mobile unit via an air interface, a service request requesting service provider information regarding said location based services, said service request including service type information identifying a type of service for which said service provider information is requested;

obtaining, on said network platform, location information regarding a location of said mobile unit determined using a network assisted location finding technology, said technology being operative to provide location information regarding said mobile unit based at least in part on a position of the mobile unit in relation to a known location of a stationary ground based network structure;

identifying, on said network platform, first and second service providers and associated first and second service provider information based upon said service type information and said determined location of said mobile unit wherein said first service provider is farther from said mobile unit than said second service provider;

accessing stored subscriber independent prioritization information, separate from said service type information, relating to a prioritization for presenting service provider information to a subscriber, said stored prioritization information establishing a basis independent of proximity and independent of any subscriber preferences for prioritizing said first and second service provider information;

based upon said stored prioritization information, prioritizing said first and second service provider information, wherein said first location information is assigned a higher

priority than said second location information; and
outputting both said first and second service information
on said mobile unit based upon said step of prioritizing.

D. The Pending Ground of Unpatentability

The pending ground of unpatentability is that claims 1–6 are unpatentable, under 35 U.S.C. § 112, first paragraph, as lacking written description support.

II. ANALYSIS

A. *Claim Construction*

In a covered business method patent 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. *In re Cuozzo Speed Techs.*, No. 2014-1301, 2015 WL 448667, at *6–*8 (Fed. Cir. Feb. 4, 2015) (“Congress implicitly adopted the broadest reasonable interpretation standard in enacting the AIA,” and “the standard was properly adopted by PTO regulation.”); 37 C.F.R. § 42.300(b). Under the broadest reasonable construction standard, claim terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). We must be careful not to read a particular embodiment, appearing in the written description, into the claim, if the claim language is broader than the embodiment. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993). We construe the terms below in accordance with these principles.

1. *Decision to Institute*

In the Decision to Institute, we determined that “network platform”

means “a computer included on a network.” Inst. Dec. 8. Additionally, we determined that no express construction of either “independent” or “network administrator” was necessary at that point in the proceeding. *Id.*

We discern no reason, based on the complete record now before us, to change our determinations thereof, except we determine the broadest reasonable interpretation of “network administrator.”

2. *The Parties’ Arguments*

Patent Owner contends that the phrase “preferred service providers defined by the *network administrator*” set forth at column 8 of the ’205 patent specification provides written description support for both claim limitations challenged by Petitioner. *See e.g.*, PO Resp. 9, 27–28 (emphasis added). As further noted by Patent Owner (Prelim. Resp. 14), claim 4, which depends from claim 1, recites “network administrator.” To evaluate the parties’ dispute regarding whether the ’205 patent specification provides adequate written description support for the challenged claims, we determine the broadest reasonable interpretation of “network administrator.”

Patent Owner also contends that “wherein said first location information is assigned a higher priority than said second location information,” as recited in claim 1, means “wherein the information relating to the first service provider is assigned a higher priority than the information relating to the second service provider.” PO Resp. 7. We evaluate Patent Owner’s contention below.

Furthermore, the parties dispute whether the ’205 patent specification provides written description support for “*prioritization* information establishing a basis independent of proximity and independent of *any subscriber preferences* for prioritizing said first and second service provider

information” (emphases added), as recited in claim 1. Neither party provides a construction for any portion of this limitation, except for the contentions provided for the term “independent,” noted above. To evaluate the parties’ contentions regarding the above-referenced phrase, we determine the broadest reasonable interpretation of “prioritization” and “any subscriber preferences.”

3. “*network administrator*”

Petitioner contends that “network administrator” is “a person or entity that manages services provided by the network platform.” Pet. 27. Patent Owner contends that Petitioner’s proposed construction is too narrow, because “there is no management required by the claims or examples in the specification.” Prelim. Resp. 14. Instead, Patent Owner proposes a slightly modified version of Petitioner’s proposed construction that excludes the word “manages” i.e., “an administrator, being a person or entity, for the network platform.” In the Decision to Institute, we declined to adopt either parties’ construction and determined no express construction was necessary at that time. Inst. Dec. 8. To evaluate Patent Owner’s contention that ’205 patent specification’s phrase “preferred service providers defined by the *network administrator*” provides written description support for both claim limitations challenged by Petitioner (*see e.g.*, PO Resp. 9, 27–28 (emphasis added); *see also* Prelim. Resp. 14 (“[c]laim 4 simply refers to the source establishing the information stated in [claim 1]” (citation omitted))), we determine the broadest reasonable interpretation of “network administrator.”

The ’205 patent specification describes the activities performed by a “network administrator” to be: “a network administrator may allow service providers to register in a location-based service provider database” (Ex.

1001, 3:35–36); “a network administrator may generate revenues based on fees charged to the service provider and/or subscriber in connection with accessing the location-based services system” (*id.* at 3:50–53); “[t]he menu may be ordered based on any of various criteria such as the preferences expressed in the subscriber profile, nearest to farthest, preferred service providers defined by the network administrator, etc.” (*id.* at 8:32–36); and “a network administrator such as a wireless carrier may provide a registration process for service providers” (*id.* at 9:23–26).

In the context of these activities, Petitioner’s construction is reasonable, except that the “network administrator” may administer in addition to manage services. Accordingly, we determine that construing “network administrator” as “a person or entity that manages or administers services provided by the network platform” is consistent with the ’205 patent specification and adopt it as the broadest reasonable interpretation.

We, additionally, note that a portion of the ’205 patent specification referring to a “location-based service administrator” states: “[s]uch profile information may be entered by a “carrier *or other* location-based service administrator.” *Id.* at 5:28–30 (emphasis added). Entering profile information is an an example of administering services provided by the network platform. Additionally, an exemplary network administrator is “a wireless carrier.” *Id.* at 9:23–24. We, therefore, further determine that “location-based service administrator” (*see* Ex. 1001, 5:29–30) is used interchangeably with “network administrator” (*see e.g., id.* at 8:35–36) in the ’205 patent specification.

4. *“wherein said first location information is assigned a higher priority than said second location information”*

Patent Owner contends that “wherein said first location information is assigned a higher priority than said second location information,” as recited in claim 1, means “wherein the information relating to the first service provider is assigned a higher priority than the information relating to the second service provider.” PO Resp. 7. Patent Owner’s contention is based on the claim language, as recited in the context of claim 1. PO Resp. 6–7.

The relevant excerpt of claim 1 is: “prioritizing said first and second service provider information, wherein said first location information is assigned a higher priority than said second location information.” As Patent Owner notes, in our Decision to Institute, we indicated that one of ordinary skill would have understood that the first and second location information refers to the first and second service provider information, respectively, recited in the immediately preceding limitation. Inst. Dec. 18.

Patent Owner’s contention, however, improperly substitutes “relating” for “associated.” In particular, we note that the claim first refers “first and second service provider information” in an earlier limitation by stating: “identifying, on said network platform, first and second service providers and *associated first and second service provider information*” (emphasis added).

We, therefore, determine that “wherein said first location information is assigned a higher priority than said second location information” means “wherein said first service provider information is assigned a higher priority than said second service provider information.”

5. “*prioritization*”

The term “prioritization” is recited, for example, in claim 1: “a prioritization for presenting service provider information to a subscriber” and “prioritization information establishing a basis independent of proximity and independent of any subscriber preferences for prioritizing.” Neither party provides a proposed construction for the term “prioritization.” We, however, construe this term as part of our evaluation of the parties’ dispute as to whether the ’205 patent specification provides written description support for the limitations challenged by Petitioner.

The specification does not provide a definition of “prioritization.” The IEEE Dictionary sets forth a plain and ordinary meaning of “priority” as follows: “A rank *order* of status, activities, or tasks.” Institute of Electrical and Electronics Engineers, *The Authoritative Dictionary of IEEE Standard Terms* 867 (7th Ed., IEEE Press 2000) (emphasis added) (Ex. 3001). This definition is consistent with the specification, which provides an example of “prioritization” as follows: “[t]he menu may be *ordered* based on any of various criteria such as preferences expressed in the subscriber profile, nearest to farthest, preferred service providers defined by the network administrator, etc.” Ex. 1001, 8:32–36 (emphasis added).

Upon review, we determine that construing “prioritization” to have its plain and ordinary meaning of “ordering” is reasonable and consistent with the specification. Therefore, we adopt it as a broadest reasonable construction.

6. “*any subscriber preferences*”

The phrase “any subscriber preferences” is recited, for example, in claim 1: “prioritization information establishing a basis independent of

proximity and independent of any subscriber preferences for prioritizing.” Neither party provides a proposed construction for the term “any subscriber preferences.” We, however, construe this term as part of our evaluation of the parties’ dispute as to whether the ’205 patent specification provides written description support for the limitations challenged by Petitioner.

One exemplary use of the term “preferences” found in the ’205 patent specification states that a menu may be ordered based on any of various criteria, “such as preferences expressed in the subscriber profile.” Ex. 1001, 8:32–36. The ’205 patent specification also refers to a “smoking preference” of an individual subscriber (*id.* at 2:16–17) and “service preference information such as hotel room requirements” of an individual subscriber (*id.* at 5:19–20). In other words, every usage of “subscriber preferences” in the ’205 patent specification indicates that “subscriber preferences” pertain to an individual subscriber.

Regarding the term “any” in the context of “subscriber preferences,” the ’205 patent specification states, “[t]he profile information may include any of various recorded personal data for the user.” Ex. 1001, 4:1–2. The use of “may include” suggests that the profile information in some cases includes some, but not all recorded personal data for the user.

The ’205 patent specification provides additional description of information regarding individual subscribers as follows:

The subscriber profile information 114 includes information regarding individual subscribers that is useful in personalizing the location-based services and in processing individual service requests. Some examples of such information include: 1) financial information for use in executing a location-based service transaction such as credit card numbers and expiration dates, bank account numbers, or corporate account information;

2) service preference information such as hotel room requirements, information regarding discount programs or club memberships, and preferred chains or other service providers; 3) information regarding the subscriber's service usage profile such as typical travel times and roads, types of services most often requested by the subscriber and demographic information; and 4) the subscriber's willingness or desire to receive complementary service information and advertisements. Such profile information may be entered by a carrier or other location-based service administrator upon signing up for the service and may be periodically revised or automatically revised based on adaptive logic.

Id. at 5:13–31.

In light of the '205 patent specification, therefore, we determine that “*any* subscriber preferences” (emphasis added) pertains to any of the individual's credit card numbers, bank account numbers, hotel room requirements, club service memberships and other preferences of the individual subscriber, noted above. *Id.* As described in the '205 patent specification, the preferences are “recorded personal data for the user.” Ex. 1001, 4:1–2. We determine additionally that these subscriber preferences include, but are not limited to, preferences stored in the subscriber profile. *Id.* (“The profile information *may include* any of various recorded personal data” (emphasis added).)

For the reasons given, we determine, in light of the '205 patent specification, that the broadest reasonable interpretation of “any subscriber preferences” is recorded preferences of the individual subscriber using the mobile unit. The preferences of the individual subscriber include recorded personal data such as the individual's credit card numbers, bank account numbers, hotel room requirements, and club service memberships.

B. Lack of Written Description Support

Petitioner asserts that claims 1–6 of the '205 patent lack written description support under 35 U.S.C. § 112, first paragraph. Pet. 40–46. Specifically, Petitioner asserts that the specification, as originally filed, does not describe the following limitations recited in independent claim 1: (1) “said first location information is assigned a higher priority than said second location information” (*id.* at 40–41); and (2) “prioritization information establishing a basis independent of proximity and independent of any subscriber preferences for prioritizing said first and second service provider information” (*id.* at 42–46). Petitioner asserts that the limitations were added during prosecution and were never described in the originally filed application. *Id.* at 6–7, 40. As Petitioner correctly notes, during prosecution new claim 76 was added, which included these limitations for the first time and eventually became claim 1. *Id.* at 6–7 (citing Ex. 1003, 166–67).² Patent Owner acknowledges that the second of the challenged limitations of claim 1 was added by amendment (PO Resp. 16) and does not dispute Petitioner’s contentions that the first challenged limitation was added by amendment (*id.* at 26–28).

To satisfy the written description requirement, the focus is not just on whether the claims are supported by the specification, but whether one of ordinary skill in the art reasonably would conclude from the original disclosure that the inventor had possession of the claimed invention. *See,*

² Claim 4, which depends from claim 1, recites “wherein said step of accessing comprises obtaining information established by a network administrator regarding said prioritization for presenting said service provider information to said subscriber.” Claim 4 was added as claim 79 during prosecution. Ex. 1003, 233.

e.g., *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). Additionally, where an explicit limitation is not present in the written description, “it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation.” *Hyatt v. Boone*, 146 F.3d 1348, 1353 (Fed. Cir. 1998). Furthermore, “[n]egative limitations are adequately supported when the specification describes a reason to exclude the relevant limitation.” *Santarus, Inc. v. Par Pharm., Inc.*, 694 F. 3d 1344, 1351 (Fed. Cir. 2012).

We consider the challenged limitations in the context of claim 1. The second of Petitioner’s written description assertions is recited first in claim 1. It is shown in the portion of claim 1 reproduced below:

accessing stored subscriber independent prioritization information, separate from said service type information, relating to a prioritization for presenting service provider information to a subscriber, said stored *prioritization information establishing a basis independent of proximity and independent of any subscriber preferences for prioritizing said first and second service provider information*

(emphasis added). As mentioned above in the discussion of claim construction, the challenged limitation is referenced previously as “subscriber independent prioritization information.” In addition to the criteria recited in the challenged language, as evident from the cited portion of claim 1 above, the subscriber independent prioritization information must be “separate from said service type information.”

The first of Petitioner’s written description assertions is recited next in claim 1. It is shown in a portion of claim 1 reproduced below:

identifying, on said network platform, first and second

service providers . . . wherein said first service provider is farther from said mobile unit than said second service provider; accessing stored subscriber independent prioritization information . . .

based upon said stored prioritization information, prioritizing said first and second service provider information, wherein *said first location information is assigned a higher priority than said second location information*

(emphasis added). As discussed above with respect to claim construction, the broadest reasonable interpretation of the challenged limitation is “wherein said first service provider information is assigned a higher priority than said second service provider information.” In the portion of claim 1 reproduced above, the first service provider is farther from said mobile unit than the second service provider. We, therefore, refer to the second disputed claim recitation as “farther-over-nearer ordering.”

We evaluate the parties’ contentions regarding the written description assertions identified by Petitioner in turn.

1. Subscriber Independent Prioritization Information

Petitioner contends that the ’205 patent specification “never describes ‘prioritization information establishing a basis independent of proximity and independent of any subscriber preferences for prioritizing said first and second service provider information’” (Pet. 42), referred to herein interchangeably as “subscriber independent prioritization information.” Patent Owner points to the following description in the ’205 patent specification as support:

The menu may be ordered based on any of various criteria such as [1] the preferences expressed in the subscriber profile, [2] nearest to farthest, [3] preferred service providers defined by the network administrator, etc.

PO Resp. 9 (citing Ex. 1001, 8:32–36.)

In particular, Patent Owner contends that the third criterion, “preferred service providers defined by the network administrator, etc.” (Ex. 1001, 8:32–36) is not a basis of information established from proximity or subscriber preferences. *Id.* at 9–10. Patent Owner also relies on the Declaration of Dr. Christopher H. Kingdon, who contends “[t]his network administrator preference information is, by its very nature, determined by the network administrator—not by the subscriber, and not on the basis of proximity determined from location equipment.” *Id.* at 10 (citing Ex. 2002 ¶¶ 26, 27).

In its Reply, Petitioner contends that “the ’205 patent never discloses that the ‘administrator can enter information that is subscriber independent.’” Pet. Reply 4. Petitioner also contends that Patent Owner must show that the ’205 patent specification’s disclosure of “the preferred service providers defined by the network administrator” (Ex. 1001, 8:32–36) requires subscriber independence. Pet. Reply 4–5 (citing *Hyatt*, 146 F.3d at 1353). Additionally, Petitioner points to disclosure of an administrator entering subscriber profile information—which *is* based on subscriber preferences. *Id.* at 3–4 (citing Ex. 1001, 5:10–32.)

We agree with Petitioner (Pet. 42) that the ’205 patent specification does not disclose expressly the “stored subscriber independent prioritization information” limitation. We also agree with Petitioner (Pet. Reply 4) that the ’205 patent specification does not disclose an administrator entering information for prioritization that is subscriber independent.

The dispute between the parties primarily relates to whether the third criterion set forth in the ’205 patent specification, “preferred service

providers defined by the network administrator, etc.” (Ex. 1001, 8:32–36) is a basis for prioritizing that is established independent from subscriber preferences. This is the only portion of the ’205 patent specification that Patent Owner identifies for providing written description support. PO Resp. 9–26. We agree with Petitioner that the challenged limitation is not explicitly present in the written description. Thus, to be properly supported, a person of ordinary skill must have understood, at the time the patent application was filed, that the phrase “preferred service providers defined by the network administrator, etc.” (Ex. 1001, 8:32–36) requires “prioritization information establishing a basis . . . independent of any subscriber preferences,” as recited in claim 1. *See Hyatt*, 146 F.3d at 1353. We are not persuaded that the ’205 patent specification describes a basis used by a network administrator to define preferred service providers that is subscriber independent.

Dr. Kingdon, who Patent Owner relies on for support, does not provide sufficient rationale for his opinion to the contrary. Ex. 2002 ¶ 27. In particular, Dr. Kingdon provides a conclusory statement, “[t]his preference information is, by its very nature, determined by the network administrator—not by the subscriber, and not on the basis of proximity determined from location finding equipment.” *Id.* Dr. Kingdon does not identify persuasive support in the ’205 patent specification or describe persuasively other evidence that supports his conclusion. *Id.* ¶¶ 23–27; *see also id.* ¶¶ 11–15 (describing a background of location based services including a description of certain handsets, promotion of implementation of location services worldwide by several companies, and an exemplary commercial launch in Sweden of a mobile positioning service). Expert

testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight. *See* 37 C.F.R. § 42.65(a).

Furthermore, the '205 patent specification provides an example of a network administrator performing an activity in a manner that is dependent on subscriber preferences. *See* Pet. Reply 4. In particular, the '205 patent specification describes the network administrator entering the subscriber profile (Ex. 1001, 5:28–32), which is an example of the network administrator managing or administering the services provided by the network platform on the basis of subscriber preferences. In other words, the '205 patent specification indicates that activities performed by the network administrator are not by their “very nature” performed in a manner that is independent of any subscriber preferences, contrary to Dr. Kingdon’s assertion (Ex. 2007 ¶ 27).

The '205 patent specification also describes the importance of personalizing the presentation to the subscriber. For example, the '205 patent specification states that “the functionality of location-based services in wireless or other communication networks can be *enhanced by personalizing* the services provided.” Ex. 1001, 2:9–12 (emphasis added). The '205 patent specification further states, “[t]he present invention is directed to *subscriber delivered or personalized* location-based services for communication networks.” *Id.* at 1:56–57 (emphasis added).³ No alternate example of prioritizing according to a subscriber-independent scheme, as now described by Patent Owner, has been identified.

³ As another indication of the importance of subscriber preferences in the '205 patent, the menu on which Patent Owner relies is created based on the subscriber preferences. Ex. 1001, 8:19–28.

Patent Owner also contends that because “preferred service providers defined by the network administrator” is a “third criterion,” it must be independent of the first two criteria. PO Resp. 9 (citing Ex. 1001, 8:32–36); *see also* Ex. 2002 ¶ 26 (“the third criterion, ‘preferred service providers defined by the network administrator,’ provides written description support for Phrase 1.”) The specification of the ’205 patent, however, simply states “[t]he menu may be ordered based on any of various criteria.” Ex. 1001, 8:32–33. The ’205 patent specification, as originally filed, does not indicate that one criterion is mutually exclusive of another criterion. The ’205 patent specification does not use the term “independent” or otherwise indicate that the network administrator defines preferred service providers on a basis that is “independent of any subscriber preferences,” as required in claim 1.

Patent Owner additionally contends that “an administrator can enter information that is subscriber dependent AND that same administrator can enter information that is subscriber independent,” so the above-referenced example or ordering based on preferred service providers defined by the network administrator is not negated by an alternate embodiment, if any. PO Resp. 11. Patent Owner similarly contends that the ’205 patent specification states that “location-based service information [optionally] can [] be personalized based on the subscriber profile information.” *Id.* at 15 (citing Ex. 1001, 5:11–12, 6:16–18). According to Petitioner, Patent Owner’s acknowledgment that an administrator can enter information that is subscriber dependent shows that the ’205 patent specification’s disclosure is deficient. Pet. Reply at 5.

We determine Patent Owner’s contention that “an administrator can enter information that is subscriber dependent AND that same administrator

can enter information that is subscriber independent” (PO Resp. 11) is not persuasive without an example or embodiment of subscriber independent prioritization information in the ’205 patent specification. *See Hyatt*, 146 F.3d at 1353. We also determine that the option Patent Owner points to does not remedy the deficiencies noted above. In particular, the option reflects that the service is based on location, “in the case of providing local food outlet, service station or hotel information, the location-based service information can include not only information regarding service providers *in the vicinity of the subscriber*, but can also identify local service providers or services meeting criteria specified by the profile information 114.” Ex. 1001, 6:19–24 (emphasis added). Claim 1 recites: “prioritization information establishing a *basis independent of proximity* and independent of any subscriber preferences for prioritizing said first and second service provider information” (emphasis added).

For similar reasons, Patent Owner’s analogy to *Honeywell Int’l, Inc. v. United States*, 609 F.3d 1292 (Fed. Cir. 2010) (Prelim. Resp. 51; Tr. 18:13–15) is misplaced. In *Honeywell*, although one embodiment did not provide written description support, the patent provided an alternate embodiment describing the limitation at issue. *Id.* at 1301 (“[i]n the case of the local display 37 using separate cathode ray tubes 51–53 or *other display transducers*, it is possible to more easily *filter offending colors . . .*” (emphasis added).) We are not persuaded that the ’205 patent specification contains any such alternate embodiment. For this same reason, we need not consider Patent Owner’s additional contentions that assume an example is provided. PO Resp. 22–26.

Claim 1 recites: “prioritization information establishing a basis

independent of proximity and independent of any subscriber preferences for prioritizing said first and second service provider information.” We determine that one of ordinary skill in the art would not have concluded from the original disclosure that the inventor had possession of this limitation as of the filing date. Accordingly, we determine that the ’205 patent does not provide written description support for the above-referenced limitation.

2. *Farther-Over-Nearer Ordering*

Petitioner asserts that the ’205 patent specification does not disclose expressly “said first location information is assigned a higher priority than said second location information,” referred to herein as “farther-over-nearer ordering.” Pet. 40. Patent Owner points to the same portion of the ’205 patent specification for providing written description support of the farther-over-nearer ordering limitation as it does for the prioritizing limitation discussed above. In particular, Patent Owner contends “[o]ne of ordinary skill in the art, upon reading and understanding the ’205 Patent would understand that the various criteria for ordering provides support for a farther-over-nearer ordering of service providers, because a network administrator is disclosed to define preferred service providers in contrast to the ‘nearest to farthest’ ordering criterion.” PO Resp. 27–28 (citing Ex. 1001, 8:33–36). Patent Owner also contends that “[t]he ‘preferred service providers’ criterion allows a network administrator to prioritize two service providers in a fashion that leads to a farther-over-nearer ordering.” PO Resp. 28 (citing Ex. 2002 ¶ 32).

We agree with Petitioner (Pet. 40) that the ’205 patent specification does not disclose expressly the farther-over-nearer ordering limitation.

Accordingly, we consider whether a person of ordinary skill would have understood, at the time the patent application was filed, that “preferred service providers defined by the network administrator, etc.” (Ex. 1001, 8:32–36) requires “said first location information is assigned a higher priority than said second location information,” as recited in claim 1. *See Hyatt*, 146 F.3d at 1353. We are not persuaded that a person of ordinary skill would have understood farther-over nearer ordering was required by the relied upon language.

For instance, we are not persuaded by Patent Owner’s contention that the third criterion provides such support because it is “in contrast to the ‘nearest to farthest’ ordering criterion.” PO Resp. 27–28 (citing Ex. 1001, 8:33–36). Patent Owner relies on Dr. Kingdon’s statement (PO Resp. 28 (citing Ex. 2002 ¶ 32)) that “[o]ne of ordinary skill in the art, upon reading and understanding the ’205 Patent, would understand that the various criteria for ordering provides support for a farther-over-nearer ordering of service providers, because a network administrator is disclosed to define preferred service providers in contrast to the ‘nearest to farthest’ ordering criterion.” Ex. 2002 ¶ 32. Dr. Kingdon does not provide persuasive evidence that the ’205 patent specification describes that the third criterion is “in contrast to” (*id.*) the second criterion. The ’205 patent specification, as originally filed, does not indicate that one criterion is mutually exclusive of or in contrast to another criterion. As discussed above, the ’205 patent specification does not otherwise indicate that the first (farther) service provider information is assigned a higher priority than the second (nearer) service provider information, as required in claim 1. Also, the ’205 patent expressly includes “nearest to farthest” ordering, which suggests that the inventor would have

stated expressly farther-over-nearer ordering, if the inventor had possession of that concept at the time the original application was filed.

Additionally, we are not persuaded by Patent Owner's contention that the third criterion "leads to" farther-over-nearer ordering. PO Resp. 28 (citing Ex. 2002 ¶ 32). Patent Owner's reliance on Dr. Kingdon is misplaced because his statement is conclusory and depends upon the wrong legal standard. For example, Dr. Kingdon states his conclusion that "[t]he preferred service providers criterion allows a network administrator to prioritize two service providers in a fashion that leads to a farther-over-nearer ordering." Ex. 2002 ¶ 32. Dr. Kingdon does not state that farther-over-nearer ordering is required as a result of ordering a menu in accordance with preferred service providers defined by a network administrator. *See Hyatt*, 146 F.3d at 1353. Neither Patent Owner nor Dr. Kingdon points to additional evidence or provides additional explanation. *See* 37 C.F.R. § 42.65(a).

Furthermore, farther-over-nearer ordering occurs by prioritizing the first and second service provider information, based upon said stored subscriber independent prioritization information, as recited in claim 1. For the reasons given above, we determine that the '205 patent specification does not provide written description support for the stored subscriber independent prioritization information limitation.

3. Conclusion

We determine that Petitioner has shown by a preponderance of the evidence that claim 1 of the '205 patent is unpatentable under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. Because claims 2–6 depend on independent claim

1, we also determine that Petitioner has shown by a preponderance of the evidence that claims 2–6 of the '205 patent are unpatentable under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement.

C. Eligibility for Covered Business Method Patent Review

Patent Owner contends that subsequent to our Decision to Institute, the Board has held, in a non-precedential case, that claims which describe software systems that have general utility, not specific to any application, are not directed to a financial product or service. PO Resp. 29 (citing *PNC Fin. Servs. Grp., Inc. v. Intellectual Ventures I LLC*, Case CBM2014-00032, slip op. at 10 (PTAB) (Paper 13)). Thus, according to Patent Owner, this patent should never have been involved in a covered business method review.

Petitioner's contentions and the challenged claims in this case differ from the contentions presented and the claims challenged in *PNC Financial*. In *PNC Financial*, the Board stated:

Thus, the mere assertion of a patent against a bank or other financial institution is not sufficient by itself to transform a patent claiming a generally applicable data processing technique to a covered business method patent. Petitioners' exclusive reliance on this factor, while failing to identify any reference to financial products or services in the Specification or claims, does not persuade us that any of the claims of the '298 patent are directed to a method for performing operations used in the practice, administration, or management of a "financial product or service" within the meaning of the AIA § 18(d)(1) and the legislative history associated with the statute.

Id. at 14.

In contrast, in this case, Petitioner has met its burden. Claim 1 recites: "receiving . . . a service request requesting service provider information" and

“identifying . . . first and second service providers.” As Petitioner correctly notes (Pet. 11 (citing Ex. 1001, 2:32–37, 6:28–29, 9:52–53)), the ’205 patent provides exemplary requests for services, which include an ATM. Ex. 1001, 2:32–35; *see also id.* at 7:16–19. An ATM allows clients of a financial institution to perform financial transactions electronically, such as withdrawing cash from a bank account. The ’205 patent indicates that the financial institution may be willing to pay for this service: “revenues may be generated from the subscriber and/or service providers based on the use of the location-based services system.” *Id.* at 8:46–48.

We, therefore, are not persuaded that the analysis in *PNC Financial*, as applied to these facts, would cause us to reach a different result in this proceeding.

III. CONCLUSION

We conclude that Petitioner has shown by a preponderance of the evidence that each of claims 1–6 of the ’205 patent are unpatentable under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. This is a Final Written Decision of the Board under 35 U.S.C. § 318(a).

IV. ORDER

For the foregoing reasons, it is
ORDERED that claims 1–6 of U.S. Patent No. 7,024,205 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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