

BlackBerry Corporation v. NXP B.V.: Final Written Decision IPR2013-00233

Article By:

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Takeaway: In responding to a Petitioner's obviousness arguments, Patent Owner must consider the full disclosure of the cited prior art and fully address the proposed combination with arguments that are commensurate with the scope of the challenged claims.

In its [Final Written Decision](#), the Board found that claim 3 of the '420 patent (the only challenged claim) was unpatentable under 35 U.S.C. § 103 on all three instituted grounds. The '420 patent relates generally to a mobile cellular telephone with a Global Positioning System ("GPS") receiver that powers up in response to direct interaction between the user and the mobile telephone.

The Board began with claim construction, stating that the terms are construed according to their broadest reasonable interpretation in light of the patent specification. The Board noted that Petitioner did not argue that any of the terms in the challenged claims should take on meanings other than their ordinary and customary meanings. Patent Owner argued that the plain and ordinary meaning of the words in their common usage applies, taken in the context of the '420 patent, and that the plain and ordinary meaning of "power up" is that the power supplied to something is increased. During the hearing, Petitioner acknowledged that the broadest reasonable interpretation of "power up" is "selectively increasing or adding power to the component." The Board determined that both proposed constructions are substantially equivalent. After looking at the usage of the term "power up" in the specification, the Board construed "power up" to mean increasing the power supplied.

The Board then looked at the first grounds of unpatentability: obviousness of claim 3 over Koss and O'Neill. Patent Owner first argued that Koss is not in the same field as the '420 patent because it teaches a mobile computer than can be used with a cellular telephone and not the "internet, enabled mobile cellular telephone" recited in claim 3. But the Board was not persuaded by this argument because Koss includes disclosures regarding hand-held mobile computers.

Patent Owner also argued that the mobile computer of Koss could not be a cellular telephone because Koss discloses that the mobile computer is used with a cellular telephone. The Board agreed with Petitioner that one of ordinary skill would have understood that a mobile computer using digital cellular technology (as was disclosed in Koss) could have been a handheld cellular telephone and that that mobile cellular telephones were well known as of the priority filing date of the '420 patent.

Patent Owner next argued that on of ordinary skill in the art seeking to conserve energy in an “internet enable, mobile cellular telephone” would not look to Koss because its mobile computer has a substantial capacity battery and is not subject to GPS receiver power conservation concerns and would not have combined Koss with O’Neill for the same reason. The Board found that this argument is contrary to Koss’s disclosure that its mobile computer may be a “hand-held device[]” and, as conceded during the hearing, all mobile devices under certain circumstances have power conservation concerns.

Patent Owner then argued that O’Neill discloses powering up the GPS receiver every time the user presses a button on the keypad, instead of selectively powering up the GPS receiver only “for certain key sequences input by the user that correspond to a particular website (or phone number)”. The Board noted that the arguments are not commensurate with the scope of claim 3, which merely requires that the GPS receiver is powered up “in response to a user selecting a particular web site,” not in response to entry of “certain key sequences.”

Finally, Patent Owner argued that the proposed combination of Koss and O’Neill would lack the functionality of claim 3 in which the GPS receiver is powered up in response to a user selecting a particular web site. The Board, however, found that Patent Owners’ arguments were not responsive fully to the proposed combination because Petitioner relied upon Koss, not O’Neill, for teaching that a GPS location is acquired in response to a user selecting a particular web site and combined it with O’Neill’s teaching of power conservation in activation of the GPS receiver. The Board concluded that the proposed combination taught the recited GPS receiver and that claim 3 would have been obvious over Koss and O’Neill.

The Board next analyzed whether claim 3 would have been obvious over Koss and Sheynblat. Patent Owner repeated its arguments regarding Koss, which were not persuasive to the Board. Patent Owner then argued that Sheynblat discloses reserving power an emergency phone call, not conserving power. The Board was not persuaded by Patent Owner’s attempt to draw a distinction between conserving power and reserving power because both are focused on reducing the power consumed by a GPS-enabled cellular telephone. Because a person of ordinary skill in the art would have relied upon selectively powering up the GPS receiver, as shown in Sheynblat, to modify the Koss disclosure of a mobile cellular telephone user selecting a particular web site, the Board concluded that claim 3 would have been obvious over Koss and Sheynblat.

Then the Board reviewed whether claim 3 would have been obvious over Jessup and O’Neill. Patent Owner’s arguments with respect to this combination were substantially similar to its arguments regarding the combination of Koss and O’Neill, which did not persuade the Board. As with earlier combinations, Patent Owner also again failed to respond fully to the proposed combination. After considering the arguments, the Board was persuaded that Petitioner established sufficiently that the combination of Jessup and O’Neill teaches that “the GPS receiver is arranged to power up in response to a user selecting a particular web site,” as recited in claim 3 and concluded that claim 3 would have been obvious over Jessup and O’Neill.

Finally, the Board examined whether claim 3 also would have been obvious over Jessup and Sheynblat. Patent Owner’s arguments with respect to this combination were substantially similar to earlier arguments concerning the individual references. In addition, the Board found that Patent Owner once again did not respond fully to the combination proposed by Petitioner. The Board was persuaded by Petitioner’s arguments and concluded that claim 3 also would have been obvious over Jessup and Sheynblat.

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Paper 24: Final Written Decision

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Patent 6,501,420

Before: Jennifer S. Bisk, Trenton A. Ward, and Brian P. Murphy

Written by: Ward

Related Proceedings: NXP B.V. v. Research In Motion Ltd., Case No. 6:12-cv-498 (M.D. Fla.); IPR2013-00232

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