

Polaris Wireless, Inc. v. TruePosition, Inc.: Final Written Decision IPR2013-00323

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Takeaway: A patent is only given benefit of an earlier priority application in a chain of continuation applications if the patent and priority application to which priority is sought share a common inventor, and patent owner has shown support under 35 U.S.C. § 112 for the patent claims for each application in the chain from the patent down to the priority application to which priority is sought.

In its [Final Written Decision](#), the Board found that, by a preponderance of the evidence, that all of the challenged claims (111-114) of the '299 patent are unpatentable. Also, the Board dismissed Petitioner's Motion to Exclude as moot, and dismissed-in-part and denied-in-part Patent Owner's Motion to Exclude.

The '299 patent relates to locating wireless devices such as those used in analog or digital cellular systems, personal communications systems, enhanced specialized mobile radios, and other types of wireless communications systems.

The Board began its analysis with claim construction starting with the term "trigger." Petitioner proposed construing "trigger" to mean "an indicium . . . that directly and but-for causes an action." Patent Owner proposes construing the term to mean "location services." Based on an analysis of the specification, the Board at least partially agreed with Patent Owner and determined that the term should be construed to mean "an event, message, message field, or message sequence sufficient to initiate, cause or task an action related to location-based services."

With regard to terms "network transaction," "mobile origination transaction," and "mobile termination transaction," Petitioner proposed interpretations that required a particular genus with a precise number of species. The Board determined that such a construction is overly restrictive.

With regard to the term "means for monitoring," Petitioner proposed that it should be construed in accordance with 35 U.S.C. § 112, sixth paragraph. Further, Petitioner argued that the no algorithm was provided, and thus the term cannot be interpreted. The Board disagreed, and determined that based on certain descriptions in the specification, it could discern the algorithm as "(1) passively receive data streams from a set of predefined links such that the operation of said wireless device and said wireless communications system is unaffected; and (2) scan or search the data streams from data of interest, such as particular messages or data fields within messages." Accordingly, the

Board determined that “means for monitoring” is construed to mean a computer that implements the above-mentioned algorithm.

The Board interpreted “means for detecting” and “means for initiating” in a similar manner.

The Board then turned to the first ground of unpatentability. In determining whether Zell anticipates claims 111-114, the Board first addressed Patent Owner’s argument that Zell did not qualify as 102(b) art based on the priority date of the ’299 patent. Petitioner argues that Patent Owner has not shown that the ’299 patent obtains priority under 35 U.S.C. § 120 to the earliest priority application in the chain, because the two applications do not have at least one common inventor. Patent Owner counters that each application in the chain of continuing applications has at least one common inventor with the immediately preceding application in the chain. The Board agreed with Petitioner that for the ’299 patent to obtain priority to the earliest priority application in the chain, the earliest priority application and the ’299 patent must have a common inventor. Thus, the Board determined that the ’299 patent was not entitled to the filing date of the earliest priority application. Further, the Board noted that Patent Owner did not meet its burden in showing how each application in the chain of continuing applications leading back to the earliest priority application complies with the written-description requirement. The Board was also persuaded that, by a preponderance of the evidence, Petitioner has shown that claims 111-114 are unpatentable as anticipated by Zell.

The Board then turned to second ground of unpatentability, which was obviousness of claims 111-114 over Abbadessa and Havinis. The Board was persuaded by Petitioner’s explanation of how the two references rendered the claims obvious, and was not persuaded by any of Patent Owner’s arguments. For example, Patent Owner argued that Abbadessa is directed to “identifying radio elements,” and not location, and thus cannot correspond properly to the recited “triggering” for location services. The Board was not persuaded by this argument, because Abbadessa was cited only for triggering while Havinis was cited for disclosing location, such that the combination of the two references properly taught the recited “triggering” for location services.

The Board then considered the Motions to Exclude. Petitioner’s Motion to Exclude portions of Patent Owner’s expert’s declaration was dismissed as moot, because the Board concluded that Petitioner has demonstrated by a preponderance of the evidence that the challenged claims are unpatentable regardless of the select portion of the declaration. Patent Owner’s Motion to Exclude various non-patent literature submitted by Petitioner in support of its positions in support of its positions concerning the requirements for claiming the benefit of priority in a chain of continuation applications, was dismissed as moot, because the Board’s decision did not rely in any part on the content of those exhibits. Finally, Patent Owner’s Motion to Exclude Petitioner’s expert’s testimony as hearsay, was denied, because the testimony was properly provided as a declaration, and cross-examination was available and conducted by Patent Owner. Patent Owner argued that the expert, as an officer with significant stock options and other interests in Petitioner, is a “quintessential paid, biased witness.” The Board noted that such an assertion goes to the weight of the expert’s testimony, not its admissibility, and that the Board considered and weighed the alleged “bias” in its analysis of the grounds of unpatentability.

***Polaris Wireless, Inc. v. TruePosition, Inc.*, IPR2013-00323**

Paper 62: Final Written Decision

Dated: November 3, 2014

**Patent 7,783,299 B2 Before: Jameson Lee, Joni Y. Chang, and Michael W. Kim Written By: Kim
Related Proceedings: *TruePosition, Inc. v. Polaris Wireless, Inc.*, Case No. 1:12-cv-00646 (D. Del.)**

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