

## **Google Inc v. Unwired Planet: Final Written Decision CBM2014-00004**

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Takeaway: Where an expert provides testimony concerning the meaning of a claim term, the testimony should include factual support for his or her conclusions. Absent such support, the Board may give the testimony little weight.

In its Final Written Decision, the Board determined that claims 21 and 22 of U.S. Patent No. 7,463,151 B1 are unpatentable under 35 U.S.C. § 101.

The '151 patent relates to mobile wireless networks and, in particular, to providing mobile services using short-range radio communication ("SRC") devices. SRC devices include, for example, RFID tags, a Bluetooth base station or transponder, and a WiFi device such as a wireless router.

The Board began by determining the meaning of "SRC." In the Decision to Institute, it concluded that the term "encompasses, at least, RFID, Bluetooth, and WiFi communications." Patent Owner asserted that the term instead should be interpreted as "radio communications of a nominal range of 100 meters or less, such as used by practical systems performing typical applications of RFID, Bluetooth, and Wi-Fi communications." Petitioner disagreed, arguing that 100 meters is an arbitrary cutoff.

In analyzing the meaning of the term, the Board first reviewed the intrinsic evidence, finding that "SRC," as used in the patent, encompasses communications at a range used by the technologies named in the specification—RFID, Bluetooth, and WiFi—and other short-range radio communication technologies. The question, therefore, was whether the broadest reasonable interpretation also includes the additional limitation that the nominal range is 100 meters or less. According to the Board, Patent Owner pointed to "only one passage expressly supporting a range limitation of 100 meters," which the Board concluded was "simply one embodiment" and that there were other disclosed embodiments that included ranges of "100 feet or more." Thus, the Board was not persuaded that the intrinsic evidence limits the range of "SRC" to any particular numeric value.

The Board then considered the extrinsic evidence relied upon by Patent Owner. Although Patent Owner submitted expert testimony that "SRC has a well-understood meaning in the art of 'a nominal range of 100 meters or less, such as used by practical systems performing typical applications of RFID, Bluetooth, and Wi-Fi communications'" and that "all three examples of SRC technologies

listed by the '151 patent have 'a practical upper range in a typical deployment that is nominally 100 meters or less,'" the expert did not point to any factual support for his conclusions on this issue. The Board therefore gave very little weight to the testimony. The Board also was not persuaded that excerpts of publications submitted by Patent Owner "show that 'SRC' is, in general, limited to an upper range of 100 meters." The Board therefore was not persuaded that the extrinsic evidence "adds anything to [its] understanding of the term 'SRC' as it is used in the '151 patent."

Accordingly, the Board rejected the claim construction proposed by Patent Owner and instead interpreted "SRC" to be "communications at a range used by technologies such as RFID, Bluetooth, and Wi-Fi."

Turning to the merits, the Board first considered Petitioner's argument that the challenged claims are unpatentable under 35 U.S.C. § 112, ¶ 2, because "short" is "vague and relative," and the patent specification "provides no standard for evaluating shortness," thus rendering the claim term "SRC" indefinite. Patent Owner responded that "a person of ordinary skill in the art would understand that the upper bound of communication ranges for the example technologies, in 'typical' deployments is 100 meters." Although the Board did not agree that the broadest reasonable interpretation of "SRC" necessarily includes such an upper bound, it nevertheless agreed with Patent Owner that "a person of ordinary skill in the art would understand sufficiently what subject matter" the challenged claims cover. In particular, the Board was persuaded that "a person of ordinary skill in the art would understand that short-range communication covers a communication range 'shorter' than the range covered by mobile networks." Accordingly, the Board was not persuaded that Petitioner showed by a preponderance of the evidence that the challenged claims are unpatentable under 35 U.S.C. § 112, ¶ 2.

The Board then considered Petitioner's argument that the challenged claims are unpatentable under 35 U.S.C. § 101. The Board first analyzed whether the claims are directed to an abstract idea. Petitioner argued that "the claimed invention is directed to the abstract idea of providing information and receiving an advertisement." The Board agreed that "the claimed invention is directed to an abstract idea, specifically, the abstract idea of receiving information and providing services or advertisements based on that information" and noted that Patent Owner "has not identified any portion of the '151 patent inconsistent with this abstract idea." Patent Owner pointed to details concerning "the type of information transmitted, how that information is acquired, and whether it is used for authentication," but the Board concluded that "[t]he details emphasized by Patent Owner do not remove the claimed methods from the realm of the abstract. These details are characteristic of the invention's implementation, rather than its general idea." The Board then considered whether the challenged claims include "additional elements that can 'transform the nature of the claim' into a patent-eligible application of an abstract idea." The Board was not persuaded that the challenged claims "add an inventive concept sufficient to ensure that the patent in practice amounts to significantly more than a patent on the abstract idea itself." The Board concluded that the claimed hardware consisted of "commonly known technical solutions" and that "the claimed subject matter does not do anything more than simply instruct the practitioner to implement the abstract idea of gathering, authenticating, and transmitting data and services on generic technology." After considering the parties' arguments, the Board concluded that Petitioner showed "by a preponderance of the evidence that claims 21 and 22 of the '151 patent are unpatentable under 35 U.S.C. § 101."

**Before: Michael W. Kim, Jennifer S. Bisk, and Barbara A. Parvis**

**Written by: Bisk**

**Related Proceedings: *Unwired Planet, LLC v. Google Inc.* (D. Nev.); IPR2014-00027**

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