

## **Motorola Mobility LLC v. Intellectual Ventures II LLC: Conception Not Established in Final Written Decision Finding Challenged Claims Unpatentable IPR2014-00504**

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*Takeaway: Conception requires contemporaneous recognition and appreciation of the limitations of the claimed invention, not merely fortuitous inherency. Inventor testimony alone is insufficient to prove conception; some form of corroboration must be shown.*

In its [Final Written Decision](#), the Board found all challenged claims of the '771 patent unpatentable and dismissed Petitioner's motion to exclude. Specifically, the Board determined that "Petitioner has shown by a preponderance of the evidence that claims 1-4, 7, and 18 of the '771 patent are unpatentable." The '771 patent relates to "providing a mobile wireless access point for use with high-speed wireless devices."

The Board first addressed claim construction under the broadest reasonable construction. For the term "Local Area Network (LAN) routing system managing the data path between said wireless access point and said Internet access interface," the Board interpreted the phrase to mean "a system that directs data between a local area network and the Internet by managing the data path between a wireless access point and an Internet access interface." The Board declined to adopt Patent Owner's proposed construction that "improperly read limitations from the Specification into the claim." The Board construed the term "Internet access" to mean "the ability to send and/or receive information via the Internet." The Board rejected Patent Owner's argument that the ordinary and customary meaning is the ability to send *and* receive information via the Internet. The Board lastly construed "stand-alone system" to mean "a system capable of operating independently of any other system," as adopted in the Decision on Institution, which the parties did not dispute.

The Board next addressed Patent Owner's argument that the Boehm reference does not qualify as prior art to the inventors' alleged prior conception and reduction to practice or diligence prior to November 4, 2002. "To remove Boehm as a prior art reference, the record must establish either: (1) a conception and reduction to practice before the filing date of Boehm; or (2) a conception before the filing date of the Boehm patent combined with diligence and reduction to practice after that date." See *Taurus IP, LLC v. DaimlerChrysler Corp.*, 726 F.3d 1306, 1323 (Fed. Cir. 2013). As the Board explained:

"Conception exists when a definite and permanent idea of an operative invention, including

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every feature of the subject matter sought to be patented, is known.” *Sewall v. Walters*, 21 F.3d 411, 415 (Fed. Cir. 1994). Furthermore, “[t]he conception analysis necessarily turns on the inventor’s ability to describe his invention with particularity. Until he can do so, he cannot prove possession of the complete mental picture of the invention.” *Burroughs Wellcome Co. v. Barr Labs., Inc.*, 40 F.3d 1223, 1228 (Fed. Cir. 1994). Objective evidence that corroborates an inventor’s testimony regarding the conception of the invention is required “because of the danger in post-hoc rationales by an inventor claiming priority.” *Invitrogen Corp. v. Clontech Labs., Inc.*, 429 F.3d 1052, 1065 (Fed. Cir. 2005). The sufficiency of corroboration is determined according to a “rule of reason.” *Price v. Symsek*, 988 F.2d 1187, 1195 (Fed. Cir. 1993). This approach, however, “does not dispense with the requirement for some evidence of independent corroboration.” *Coleman v. Dines*, 754 F.2d 353, 360 (Fed. Cir. 1985).

The Board disagreed with Patent Owner that its proffered evidence “demonstrates that the inventors conceived of using the functions alleged to be included in the Windows 98 operating system to provide a LAN routing system for the MHS1.” First, Patent Owner “has not established sufficiently that the version of Windows 98 used in the MHS1 included the stated functions.” Second, even if the functions were present, “Patent Owner does not present sufficient evidence that the inventors knew of and intended to use these functions at the time of the alleged conception.” “[T]his failure to show contemporaneous intent by the inventors to use these functions in the manner now asserted defeats conception.” See, e.g., *Mycogen Plant Sci., Inc. v. Monsanto Co.*, 252 F.3d 1306, 1314 (Fed. Cir. 2001). Finally, “Patent Owner’s evidence fails to establish adequately the prior conception of a stand-alone system that enables Internet access without the need to access an external service controller server.” Upon reviewing the record as a whole under the “rule of reason,” the Board determined “that the evidence does not establish that the inventors conceived the invention of the challenged claims prior to November 4, 2002.” Thus, “Petitioner has met its burden of proving that Boehm is prior art to the challenged claims under 35 U.S.C. § 102(e).”

The Board then addressed the claim challenges. First, regarding anticipation by Boehm, the Board was “persuaded that Boehm discloses a mobile wireless hot spot system with the limitations of claims 1 and 2.” Second, regarding obviousness over Mitchell and Boehm, “Petitioner has shown, by a preponderance of the evidence, that [claims 1, 3, 4, 7, and 18 are] unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Mitchell and Boehm.” The Board was not persuaded by Patent Owner’s arguments that relied on incorrect claim interpretations. Third, regarding obviousness over Veeck, Boehm, and Mitchell, “Petitioner has shown, by a preponderance of the evidence, that [claims 1-4 and 18 are] unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Veeck, Boehm, and Mitchell.” Similarly, Patent Owner’s arguments were not persuasive for relying “on an overly narrow construction of the claim language.” Thus, all challenged claims were found unpatentable.

The Board also addressed real parties-in-interest. The Petition identified Google Inc. as owning “more than a 10% ownership of [Petitioner],” and the Board, in the Decision on Institution, “determined that the Petition sufficiently identified all real parties-in-interest pursuant to 35 U.S.C. § 312(a)(2).” Patent Owner argued that the Board’s determination relied on an incorrect statutory interpretation, but the Board was not persuaded, declining “to dismiss the Petition for the same reasons given in the Decision on Institution.”

Finally, the Board addressed Petitioner’s motion to exclude. The Board was “not persuaded by

Patent Owner's assertion that Petitioner failed to properly preserve its relevance and authentication objections during the deposition of Dr. Roy." The *inter partes* rules "do not require that an objection be *preserved* during a deposition." "Although an objection to evidence submitted during a deposition must be *made* during the deposition, 37 C.F.R. § 42.64(a), an objection must be *preserved* by timely filing a motion to exclude, 37 C.F.R. §§ 42.53(f)(8), 42.64(c)." Even after determining that the objections made during deposition "included sufficient detail to notify Patent Owner that supplemental evidence of relevance and authentication was needed," the Board nonetheless determined that the challenged exhibits "do not provide sufficient corroboration of conception." Thus, the motion to exclude was dismissed as moot.

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