

Fed. Circ. Affirms Google PTAB Win On Unwired Planet Patent

By Ryan Davis

Law360, New York (November 15, 2016, 6:02 PM EST) -- The Federal Circuit on Tuesday affirmed a Patent Trial and Appeal Board decision that an Unwired Planet location-based search patent challenged by Google is invalid, rejecting the patent owner's argument that the cited prior art was not analogous to the invention.

The appeals court held that the board reached the correct result in an America Invents Act inter partes review when it agreed with Google Inc. that Unwired Planet LLC's claimed invention was obvious in view of an earlier patent, a book and other prior art.

The patent covers a system for providing mobile phone users with search results based on their location, such as finding the nearest gas station. The invention also allows businesses who pay the network administrator to have their listings prioritized even if they are not closest to the user.

The PTAB found that the invention was obvious in view of an earlier patent on using a network to provide information about nearby consumer services, as well as a book on graphical user interfaces, among other prior art references. Unwired Planet argued that the book could not be used as prior art because it has nothing to do with location-based services, but the Federal Circuit disagreed.

"The field of endeavor of a patent is not limited to the specific point of novelty, the narrowest possible conception of the field, or the particular focus within a given field," the court wrote.

It said that the book and the patent are both in the field of interface design, with the patent focused on location-based services and the book on graphical user interfaces, so the PTAB correctly used the book as prior art.

"These two areas of focus overlap within the broader field of interface design because the teachings in graphical user interface design, including design principles for displaying text and ordering menus, have relevance in interfaces for location-based applications," the court said.

The court also rejected Unwired Planet's argument that there would be no motivation for a skilled artisan to combine the earlier patent with the other prior art to arrive at the claimed invention.

"Irrespective of whether a person of skill in the art would have recognized specific use of [the earlier patent,] substantial evidence exists if she could have seen the advantages of applying the teachings of [the book]" to improve it, the court said. "This is sufficient to render the combination obvious."

In addition to the inter partes review, Google challenged Unwired Planet's patent in a covered business method review at the PTAB, which also found the claims invalid. The Federal Circuit dismissed Unwired Planet's appeal of that decision as moot since it affirmed the invalidation of the claims in the inter partes review.

The Federal Circuit heard oral arguments in the case in June, in tandem with Unwired Planet's appeal of another PTAB ruling on a related patent that Google challenged only in a covered business method review, or CBM.

At the hearing, some judges questioned whether the patent should have qualified for review under the CBM program. They noted that the program was designed by Congress for patents related to financial products and said Unwired Planet's patent did appear to fit that definition. The court did not issue an opinion Tuesday on that case, which remains pending.

Unwired Planet was once a mobile software developer called Openwave Systems Inc. that shifted to patent licensing but sold off that business earlier this year for \$40 million.

Google declined to comment on the decision. An attorney for Unwired Planet could not immediately be reached for comment Tuesday.

The patents-in-suit are U.S. Patent Numbers 7,024,205 and 7,203,752 B2.

Federal Circuit Judges Jimmie V. Reyna, S. Jay Plager and Todd M. Hughes sat on the panel.

Unwired Planet is represented by William M. Jay, Brett M. Schuman, Eleanor M. Yost and David Zimmer of Goodwin Procter LLP.

Google is represented by Jon Wright, Michael V. Messinger, Joseph E. Mutschelknaus and Deirdre M. Wells of Sterne Kessler Goldstein & Fox PLLC and Peter Andrew Detre and Adam R. Lawton of Munger Tolles & Olson LLP.

The cases are Unwired Planet LLC v. Google Inc., case number 15-1810, in the United States Court of Appeals for the Federal Circuit.

--Editing by Christine Chun.