

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASUSTEK COMPUTER INC. AND
ASUS COMPUTER INTERNATIONAL,
Petitioner,

v.

MAXELL, LTD.,
Patent Owner.

Case IPR2019-00071
Patent 6,430,498 B1

Before TERRENCE W. McMILLIN, JOHN A. HUDALLA, and
JASON W. MELVIN, *Administrative Patent Judges*.

McMILLIN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

I. INTRODUCTION

ASUSTek Computer Inc. and ASUS Computer International (“Petitioner”) filed a Petition (Paper 2, “Pet.”) to institute an *inter partes* review of claims 1–13 of U.S. Patent No. 6,430,498 B1 (Ex. 1001, “the ’498 patent”). Maxell, Ltd. (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”).

We have authority under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the Petition and the Preliminary Response shows that “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a); *see also* 37 C.F.R. § 42.4(a) (“The Board institutes the trial on behalf of the Director.”). Upon consideration of the Petition, the Preliminary Response, and the supporting evidence, we conclude that the information presented in the Petition does not establish a reasonable likelihood that Petitioner will prevail with respect to any of the claims challenged in the Petition. Accordingly, we do not institute an *inter partes* review as to the challenged claims of the ’498 patent.

A. *Related Matter*

The parties indicate that the ’498 patent has been asserted in *Maxell, Ltd. v. ASUSTek Computer Inc. & ASUS Computer International*, 3-18-cv-01788 (C.D. Cal.), filed March 22, 2018. Pet. 2; Paper 5, 1.

B. The '498 Patent

The '498 patent is titled, "Portable Terminal With The Function of Walking Navigation." Ex. 1001, (54). "[T]he portable terminal of the present invention with the function of walking navigation is provided with data communication, input, and display devices just like those of ordinary portable telephones and PHS [Personal Handyphone System] terminals, as well as a device for getting location information and a device for getting direction information denoting the user's present place." *Id.* at 2:56–62. Figure 1 of the '498 patent is reproduced below.

FIG. 1

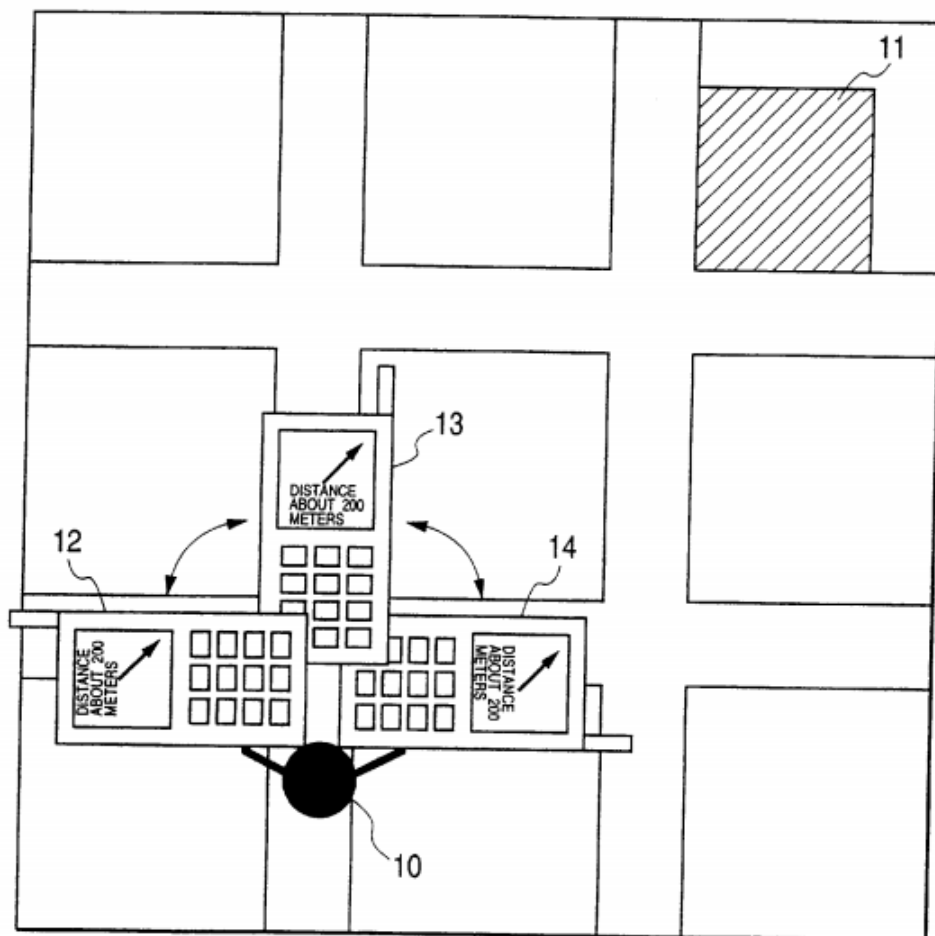


Figure 2 depicts the data display of the portable terminal of a user 10 walking towards destination 11. *Id.* at 5:1–4. Figure 10 of the '498 patent is reproduced below.

FIG. 10

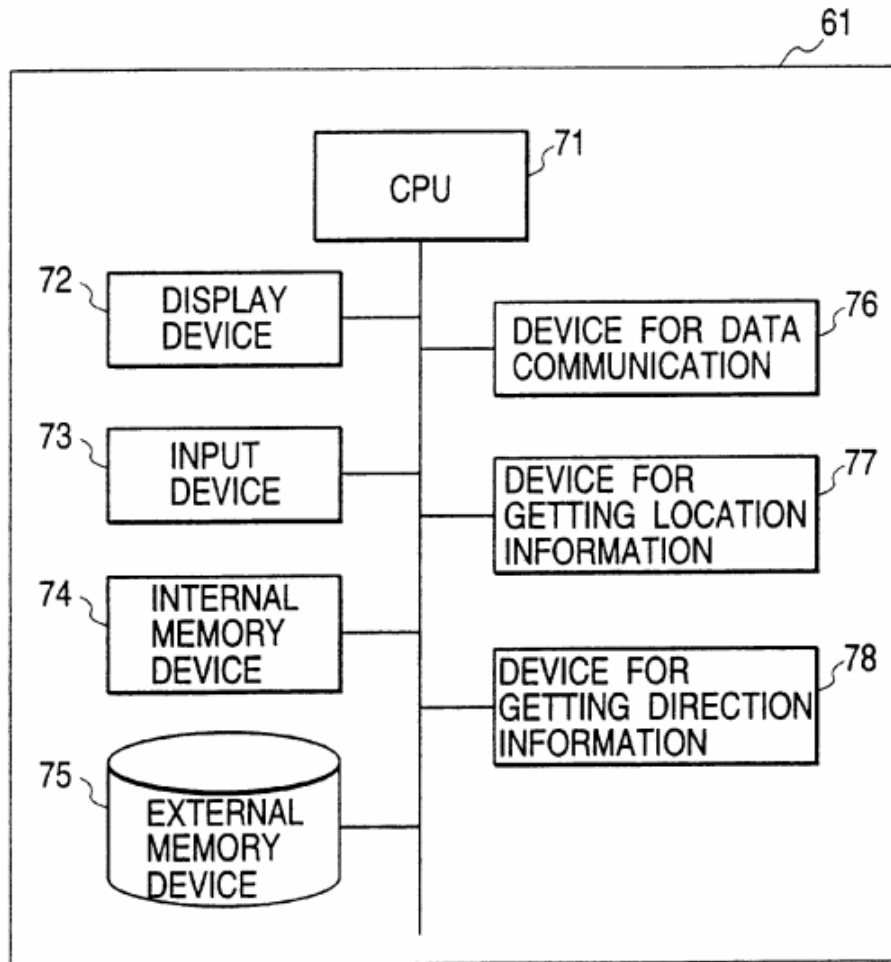


Figure 10 depicts “a block diagram of the portable terminal of the present invention with the function of walking navigation.” *Id.* at 4:61–62.

C. Illustrative Claim

Petitioner challenges claims 1–13 (all claims) of the ’498 patent. Pet. 1. Claims 1, 5, and 10 are independent claims. Independent claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A portable terminal with the function of walking navigation, comprising:
 - a device for getting location information denoting a present place of said portable terminal; and
 - a device for getting direction information denoting an orientation of said portable terminal,wherein a direction and a distance of a destination from said present place are denoted with an orientation and a length of line that is distinguished between starting and ending points to supply route guidance information as said walking navigation information.

Ex. 1001, 10:30–40. The “device for getting location information denoting a present place of said portable terminal” limitation is recited in all of the independent claims. *Id.*, *see also id.* at 10:62–63 (claim 5), 11:31–32 (claim 10).

D. Asserted Grounds of Unpatentability

Petitioner challenges claims 1–3 and 5–8 of the ’498 patent as obvious in view of Suzuki¹ and Nosaka.² Pet. 3 (statement of ground), 37–38 (motivation to combine), 45–72 (application of cited art to claims).

¹ Japanese Patent No. H07-280583 (Ex. 1004) (English translation Ex. 1005).

² Japanese Patent No. H10-170301 (Ex. 1007) (English translation Ex. 1008).

Petitioner challenges claims 1–3 and 5–8 of the '498 patent as obvious in view of Suzuki and Colley.³ Pet. 4 (statement of ground), 38–39 (motivation to combine), 72–80 (application of cited art to claims).

Petitioner challenges claims 1–3 and 5–7 of the '498 patent as obvious in view of Suzuki, Colley, and Ellenby.⁴ Pet. 4 (statement of ground), 39–40 (motivation to combine), 81–84 (application of cited art to claims).

Petitioner challenges claims 1–7 and 9–13 of the '498 patent as obvious in view of Norris⁵ and Colley. Pet. 4 (statement of ground), 41–42 (motivation to combine), 85–97 (application of cited art to claims).

Petitioner challenges claims 1, 2, 5, 6, 8, 10, and 12 of the '498 patent as obvious in view of Norris, Colley, and Nosaka. Pet. 4 (statement of ground), 42–43 (motivation to combine), 98 (application of cited art to claims).

Petitioner challenges claims 1, 2, 5, 6, 8, 10, and 12 of the '498 patent as obvious in view of Norris, Colley, and Ellenby. Pet. 4 (statement of ground), 43–44 (motivation to combine), 98–99 (application of cited art to claims).

The following table summarizes Petitioner's challenges to the claims of the '498 patent.

Claims	Basis	Cited Art
1–3 and 5–8	§ 103	Suzuki and Nosaka
1–3 and 5–8	§ 103	Suzuki and Colley
1–3 and 5–7	§ 103	Suzuki, Colley, and Ellenby

³ US 5,592,382 (Ex. 1011).

⁴ US 5,815,411 (Ex. 1022).

⁵ US 5,781,150 (Ex. 1010).

Claims	Basis	Cited Art
1–7 and 9–13	§ 103	Norris and Colley
1, 2, 5, 6, 8, 10, and 12	§ 103	Norris, Colley, and Nosaka
1, 2, 5, 6, 8, 10, and 12	§ 103	Norris, Colley, and Ellenby

Petitioner relies on the Declaration of Mr. Scott Andrews (Ex. 1003) to support its challenges to the claims of the '498 patent.

E. Cited Art

The earliest priority date claimed for the '498 patent is July 12, 1999. Ex. 1001, (30). Suzuki was published on October 27, 1995. Ex. 1005, (43). Nosaka was published on June 26, 1998. Ex. 1008, (43). Colley was issued on January 7, 1997. Ex. 1011, (45). Ellenby was issued on September 29, 1998. Ex. 1022, (22). Norris was issued on July 14, 1998. Ex. 1010, (45). Patent Owner does not challenge the prior art status of any of the cited art. *See generally* Prelim. Resp. We find that the cited art qualifies as prior art to the '498 patent.

II. ANALYSIS

A. Claim Construction

“a device for getting location information denoting a present place of said portable terminal”

Petitioner contends that “a device for getting location information denoting a present place of said portable terminal” is a means-plus-function limitation. Pet. 15. Petitioner argues, “[t]he term ‘device’ is a non-structural, nonce word that is tantamount to using the word ‘means’ because

it does not connote sufficiently definite structure.” *Id.* Patent Owner agrees that this limitation is a means-plus-function term. Prelim. Resp. 8. We determine that this limitation is a means-plus-function term because this limitation does not define the structure of the device but instead recites the functions performed by the device. Construing a means-plus-function claim term is a two-step process: first, we must identify the claimed function; then, we must determine what structure, if any, disclosed in the specification corresponds to the claimed function. *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1351 (Fed. Cir. 2015) (en banc).

Petitioner proposes “a device for getting location information denoting a present place of said portable terminal” should be construed as “a wireless or cellular antenna, **OR** a GPS, **OR** a Personal Handyphone System [PHS]; **AND** an infrared ray sensor; **AND** a control unit for analyzing received data, with the control unit calculating location information as disclosed in in [sic] 5:48–56, and Fig. 2.” Pet. 18–19 (emphasis in original). Petitioner cites the following passages from the Specification, “[f]or example, such a wireless antenna as a GPS, a PHS, etc., *as well as an infrared sensor* is used to measure location information” (Ex. 1001, 4:9–11 (emphasis added)) and “[t]he device for getting location information 77 is provided with such a wireless antenna, a GPS, a PHS, or the like; such a data receiver as an *infrared sensor*, or the like; and a control unit for analyzing received data, thereby calculating location information” (*id.* at 9:39–44 (emphasis added)) in support of this proposed construction. Pet. 16. Patent Owner “does not dispute Petitioner’s proposed construction[] for the corresponding structure” for this means-plus-function limitation. Prelim. Resp. 8–10.

For purposes of this institution decision, we adopt the construction proposed by Petitioner for the first “device” limitation in independent claims 1, 5, and 10. This construction is supported by the cited portions of the Specification of the ’498 patent. *See* Ex. 1001, 4:9–11, 9:39–44. We further note that Patent Owner does not dispute this construction.

It is not necessary to construe any other claim terms in order to make a decision whether to institute *inter partes* review. *See Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (“only those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy”).

B. Unpatentability

“a device for getting location information denoting a present place of said portable terminal”

As discussed directly above, our construction of the “a device for getting location information denoting a present place of said portable terminal” requires an infrared ray sensor. *See supra* § II.A. Patent Owner argues “neither Suzuki nor Nosaka disclose an ‘infrared ray sensor’—the phrase is completely absent from the translated copies of the references—a necessary component of Petitioner’s proposed construction.” Prelim. Resp. 14. With regard to Colley and Norris, Patent Owner similarly argues, “as with Suzuki . . . , Colley [and Norris] do[] not disclose an ‘infrared ray sensor’—the phrase is completely absent from the reference[s]—a necessary component of Petitioner’s proposed construction.” *Id.* at 28 (Colley), 38 (Norris), *see also id.* at 35, 52–53 (the combinations of references including Ellenby do not disclose this element).

We agree with Patent Owner. Petitioner fails to provide any evidence that the cited art teaches or suggests an infrared ray sensor. In its arguments mapping the art to the claims, Petitioner discusses an infrared ray sensor only in connection with Suzuki and only in the following passage from the Petition:

To the extent that it is determined that the device for getting location information must include an “antenna, a GPS, a PHS, or the like; such a data receiver as an infrared ray sensor, or the like; and a control unit for analyzing received data” as described in the ‘498 patent, Suzuki discloses a GPS receiver, which a POSITA would understand necessarily also includes an antenna, and includes *a beacon receiver, which a POSITA would recognize as a “data receiver as an infrared ray sensor, or the like”*, and it includes the current position measuring unit, which a POSITA would have understood to be a “control unit for analyzing received data”. ASUS-1003, ¶ 162. Thus, Suzuki describes all of the elements described by the ‘498 patent as being associated with claimed “a device for getting location information denoting a present place of said portable terminal.”

Pet. 47–48 (emphasis added). In this paragraph, Petitioner does not clearly contend that Suzuki teaches or suggests an infrared ray sensor but includes the indefinite phrase “or the like.” The cited paragraph (¶ 162) from Exhibit 1003 (Andrews Decl.) merely repeats the paragraph from the Petition verbatim. And there is no support in Suzuki for interpreting the “beacon receiver” as an infrared ray sensor. The only description of the “beacon receiver” in Suzuki states: “the beacon receiver 36 receives position information from a beacon arranged on the road.” Ex. 1005 ¶ 12. As such, Petitioner provides no reasoning or explanation as to how or why the disclosure of a “beacon receiver” in Suzuki teaches or suggests an infrared ray sensor. There is no disclosure of an infrared ray sensor in Suzuki.

In a petition for *inter partes* review, a petitioner is required to “identif[y], in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3); *see also* 37 C.F.R. § 42.104(b) (stating that a petition must identify how the challenged claim is to be construed and where each element of the claim is found in the prior art patents or printed publications relied upon). Petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016). In this case, Petitioner’s obviousness contentions do not identify with particularity evidence showing how the cited art teaches or suggests an infrared ray sensor commensurate with our construction discussed above. Thus, based on this record, Petitioner has not established that the cited art teaches or suggests “a device for getting location information denoting a present place of said portable terminal.” Because this limitation is a part of each claim of the ’498 patent (i.e., either by direct recitation or by dependency from another claim), we determine that Petitioner has not established a reasonable likelihood of prevailing against any claim challenged in the Petition.

III. CONCLUSION

On the record before us, we conclude that there is not a reasonable likelihood that Petitioner would prevail with respect to at least 1 of the claims challenged in the Petition. Petitioner fails to establish that the prior art teaches or suggests at least one limitation of the independent claims under the construction proposed by Petitioner and adopted by the Board.

Therefore, we do not institute *inter partes* review on any claims or any challenge to the claims.

IV. ORDER

Accordingly, it is:

ORDERED that the Petition is *denied*.

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