EXHIBIT 1

United States Court of Appeals for the Federal Circuit

UNWIRED PLANET, LLC,
Appellant

v.

GOOGLE INC.,
Appellee

2015-1812

Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No. CBM2014-00006.

Decided: November 21, 2016

WILLIAM M. JAY, Goodwin Procter LLP, Washington, DC, argued for appellant. Also represented by ELEANOR M. YOST; BRETT M. SCHUMAN, DAVID ZIMMER, San Francisco, CA.

JON WRIGHT, Sterne Kessler Goldstein & Fox, PLLC, Washington, DC, argued for appellee. Also represented by MICHAEL V. MESSINGER, JOSEPH E. MUTSCHELKNAUS, DEIRDRE M. WELLS; PETER ANDREW DETRE, Munger, Tolles & Olson, LLP, San Francisco, CA; ADAM R. LAWTON, Los Angeles, CA.

Before REYNA, PLAGER, and HUGHES, *Circuit Judges*.

REYNA, *Circuit Judge*.

Unwired Planet, LLC ("Unwired") appeals from the final written decision of the Patent Trial and Appeal Board ("Board") in Covered Business Method Patent Review No. 2014-00006. *Google Inc. v. Unwired Planet, LLC,* CBM2014-00006, 2015 WL 1570274 (P.T.A.B. Apr. 6, 2015) ("*CBM Final Decision*"). Because the Board relied on an incorrect definition of covered business method ("CBM") patent in evaluating the challenged patent, U.S. Patent No. 7,203,752 (the "'752 patent"), we *vacate* and *remand*.

BACKGROUND

U.S. Patent No. 7,203,752

The '752 patent is entitled "Method and System for Managing Location Information for Wireless Communications Devices." It describes a system and method for restricting access to a wireless device's location information. The specification describes a system that allows users of wireless devices (e.g., cell phones) to set "privacy preferences" that determine whether "client applications" are allowed to access their device's location information. '752 patent col. 1 ll. 60–65. The privacy preferences used to determine whether client applications are granted access may include, for example, "the time of day of the request, [the device's] current location at the time the request is made, the accuracy of the provided information and/or the party who is seeking such information." *Id.* at col. 1 l. 65 to col. 2 l. 1. "In operation, a client application will submit a request over a data network to the system requesting location information for an identified wireless communications device." *Id.* at col. 3 ll. 30–33. The system then determines, based on the user's privacy preferences, whether to provide the requested location information to a client application. *Id.* at col. 3 ll. 38–50.

Claim 25 is representative for the purposes of this appeal. It claims:

> A method of controlling access to location information for wireless communications devices operating in a wireless communications network, the method comprising:
>
> receiving a request from a client application for location information for a wireless device;
>
> retrieving a subscriber profile from a memory, the subscriber profile including a list of authorized client applications and a permission set for each of the authorized client applications, wherein the permission set includes at least one of a spatial limitation on access to the location information or a temporal limitation on access to the location information;
>
> querying the subscribe[r] profile to determine whether the client application is an authorized client application;
>
> querying the subscriber profile to determine whether the permission set for the client application authorizes the client application to receive the location information for the wireless device;
>
> determining that the client application is either not an authorized client application or not authorized to receive the location information; and
>
> denying the client application access to the location information.

Id. at col. 16 ll. 18–40.

CBM 2014-00006

On October 9, 2013, Google Inc. ("Google") petitioned for CBM review of claims 25–29 of the '752 patent. *See* Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112–29, § 18, 125 Stat. 284, 329–31 (2011).[1] On April 8, 2014, the Board instituted CBM review of all the challenged claims. As a threshold matter, the Board reviewed whether the '752 patent is a CBM patent. *See* AIA § 18(d); 37 C.F.R. § 42.301. The Board based its review on "whether the patent claims activities that are financial in nature, incidental to a financial activity, or complementary to a financial activity." *Google Inc. v. Unwired Planet, LLC*, CBM2014-00006, 2014 WL 1396978, at *7 (P.T.A.B. Apr. 8, 2014) ("*CBM Institution Decision*") (citing Board decisions). After examining the '752 patent's specification, the Board found the '752 patent to be a CBM patent, reasoning:

> The '752 patent disclosure indicates the "client application" may be associated with a service provider or a goods provider, such as a hotel, restaurant, or store, that wants to know a wireless device is in its area so relevant advertising may be transmitted to the wireless device. *See* ['752 patent col. 11 ll.] 12–17. Thus, the subject matter recited in claim 25 of the '752 patent is incidental or complementary to the financial activity of service or product sales. Therefore, claim 25 is directed to a method for performing data processing or other operations used in the practice, administration, or management of a financial product or service.

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[1] Section 18 of the AIA, pertaining to CBM review, is not codified. References to AIA § 18 in this opinion are to the statutes at large.

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