

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AT&T MOBILITY, LLC
AND
CELLCO PARTNERSHIP D/B/A VERIZON WIRELESS,
Petitioners

v.

SOLOCRON MEDIA, LLC,
Patent Owner

Case IPR2015-00387
Patent No. 8,594,651 B2

**CORRECTED PETITION FOR *INTER PARTES* REVIEW OF
U.S. PATENT NO. 8,594,651
UNDER 35 U.S.C. §§ 311-319 AND 37 C.F.R. § 42.100 *ET SEQ.***

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PETITIONER'S EXHIBIT LIST

Exhibit 1001	Excerpts of Documents Showing Mr. Shanahan's Prosecution and Litigation Experience and Former Clients
Exhibit 1002	Complaint filed in <i>Solocron v. AT&T Mobility. LLC, et al.</i> , (E.D. Tex.) (Case No. 2:13-cv-1059)
Exhibit 1003	U.S. Patent No. 8,594,651
Exhibit 1004	U.S. Patent No. 6,421,429
Exhibit 1005	Copy of U.S. Patent App. 07/175022, as filed Aug. 11, 2004 (now U.S. Patent No. 6,421,429)
Exhibit 1006	Declaration of Jari Valli and Nokia 9110 Communicator User Manual
Exhibit 1007	Declaration of Mr. Mark Lanning Regarding U.S. Patent No. 8,594,651, dated 12/05/2014
Exhibit 1008	International Publication Number WO98/19438
Exhibit 1009	U.S. Patent No. 6,092,114
Exhibit 1010	Certified Translation of Japanese Patent Application Publication No. H4-304935, published May 13, 1994, filed in <i>MobileMedia Ideas, Inc. v. Apple Inc.</i> (Case No. 1:10-cv-00258)
Exhibit 1011	"Connectix Ships Color QuickCam 2 for Windows," Business Wire, March 10, 1997
Exhibit 1012	"First mobile videophone introduced," CNN.com, May 18, 1999

Petitioners AT&T Mobility, LLC and Cellco Partnership d/b/a Verizon Wireless (“Petitioners”) hereby request *inter partes* review of claims 1, 10, 12, 16, 17, 21, 23, 24, 25, 31, 32, 33, and 40 (“the challenged claims”) of U.S. Patent No. 8,594,651 (“the ’651 Patent”).

I. INTRODUCTION AND BACKGROUND

The ’651 patent is part of a family of nearly twenty patents owned by Solocron Media, LLC (“Solocron”), a small company based in Tyler, Texas near the Eastern District of Texas courthouse. Solocron acquired this portfolio from Michael Shanahan, a telecommunications and electronics patent prosecutor formerly of Fish & Neave and McDermott Will & Emery. *See, e.g.*, Exhibit 1001. Mr. Shanahan’s clients over the past fifteen years include Nokia, Inc. (“Nokia”) and other electronics companies. Exhibit 1001.

Solocron alleges that the ’651 patent relates to converting video files at an intermediate server. File conversion was well-known long before the ’651 patent, as evidenced by AT&T’s U.S. Patent No. 6,421,429 (“Merritt”), which discloses the claimed concepts using nearly identical terminology. Merritt is one example of invalidating prior art that was not presented to the Patent Office during the prosecution of the ’651 patent or any of the applications to which it claims priority.

For the reasons below, there is a reasonable likelihood that the challenged claims of the ’651 patent are unpatentable in light of the prior art, warranting *inter partes* review.

II. NOTICES, STATEMENTS AND PAYMENT OF FEES

A. Real Parties In Interest Under 37 C.F.R. § 42.8(b)(1)

The real parties in interest are AT&T Mobility, LLC and Cellco Partnership d/b/a Verizon Wireless.

B. Related Matters Under 37 C.F.R. § 42.8(b)(2)

Solocron sued the following entities (in addition to AT&T Mobility, LLC and Verizon Wireless) for infringement of the '651 Patent, along with six other patents, in the Eastern District of Texas on December 6, 2013 (Case No. 2:13-cv-01059) (hereinafter, "the Litigation"): Sprint Corporation, Sprint Communications Company L.P., Sprint Solutions Inc., and T-Mobile USA, Inc. *See* Exhibit 1002.

C. Lead and Back-Up Counsel Under 37 C.F.R. § 42.8(b)(3)

Petitioners designate lead and back-up counsel as noted below. Powers of attorney pursuant to 37 C.F.R. § 42.10(b) accompany this Petition.

For Petitioner Cellco Partnership d/b/a Verizon Wireless	
Lead Counsel	Backup Counsel
Kevin P. Anderson, Reg. No. 43,471	Floyd B. Chapman, Reg. No. 40,555 Scott A. Felder, Reg. No. 47,558
WILEY REIN LLP, ATTN: Patent Administration, 1776 K Street NW, Washington, DC 20006, Phone: 202.719.7000 / Fax: 202.719.7049	
For Petitioner AT&T Mobility LLC	
Lead Counsel	Backup Counsel
Theodore Stevenson, III, Reg. No. 39,040	Scott W. Hejny, Reg. No. 45,882 Nicholas Mathews, Reg. No. 66,067
MCKOOL SMITH PC, 300 Crescent Court, Suite 1500, Dallas, TX 75201 Phone 214.978.4000 / Fax 214.978.4044	

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