

Case IPR2015-\_\_\_\_\_  
Petition for *Inter Partes* Review

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

SOLOCRON MEDIA, LLC  
Patent Owner

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Case IPR2015-\_\_\_\_\_  
Patent No. 8,594,651

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**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**

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

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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.

<b>For Petitioner Cellco Partnership d/b/a Verizon Wireless</b>	
<b>Lead Counsel</b>	<b>Backup Counsel</b>
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