

Case IPR2015-_____
Petition for *Inter Partes* Review

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-_____
Patent No. 8,594,651

**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	Declaration of Jari Valli and Nokia 9110 Communicator User Manual
Exhibit 1005	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 1006	Declaration of Erin Flaucher
Exhibit 1007	International Publication Number WO 99/41920
Exhibit 1008	Declaration of Mr. Mark Lanning Regarding U.S. Patent No. 8,594,651, dated 12/05/2014
Exhibit 1009	International Publication Number WO 99/66746

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 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 well-known electronics companies. Exhibit 1001.

Solocron alleges that the ’651 patent relates to converting video file formats at an intermediate server. Specifically, Solocron is alleging that it first developed technology used to convert video files sent between wireless communication devices. Video file format conversion would only occur if a format change was required in order for the video file to be accessible by the recipients wireless communication device. However, as will be discussed in detail below, file conversion, including video file conversion, was well-known before the filing of

the '651 patent, as evidenced by Nokia's WIPO Patent Application No. WO 99/41920 ("*Hamalainen*"), which discloses the claimed concepts of the '651 patent. *Hamalainen* 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 claims 1, 10, 12, 16, 17, 21, 23, 24, 25, 31, 32, 33, and 40 of the '651 patent are unpatentable in light of the prior art, including *Hamalainen*, 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 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.

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