UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Google Inc.
Petitioner

v.

Visual Real Estate, Inc.
Patent Owner

Case IPR2014-01341
Patent 8,078,396

DECLARATION OF DAVID S. ALMELING IN SUPPORT OF PETITIONER'S MOTION FOR *PRO HAC VICE* ADMISSION

I, David S. Almeling, declare as follows:

1. I am a Partner with the law firm of O'Melveny & Myers LLP. I represent and advise Petitioner Google Inc. ("Google") in connection with the above-captioned *inter partes* review ("IPR") proceeding and in connection with the underlying district court litigation (*Visual Real Estate, Inc. v. Google, Inc.,* Case No. 3:14-cv-00274-TJC-JRK (M.D. Fla.)) on the patent at issue in this IPR, U.S. Patent No. 8,078,396 ("'396 Patent").

2. I have been a member in good standing of the Bar of the State of California since 2005. My California State Bar number is 235449. I am also admitted to practice before numerous federal courts:

a. U.S.D.C. for the Northern District of California (since 2006);

b. U.S.D.C. for the Eastern District of California (since 2006);

c. U.S.D.C. for the Southern District of California (since 2011);

d. U.S.D.C. for the Central District of California (since 2012);

e. U.S.D.C. for the Eleventh Circuit (since 2005);

f. U.S.D.C. for the Ninth Circuit (since 2007);

g. U.S.D.C. for the Federal Circuit (since 2009); and

h. U.S. Supreme Court (since 2009).

3. I practice litigation, primarily patent infringement litigation, and have done so throughout my career as an attorney. I have litigated dozens of patent cases across the country, including in California, Delaware, Florida, Nevada, Pennsylvania, Texas, Washington, and Wisconsin. A copy of my biography is provided as Appendix A.

4. I have been actively involved in the present IPR proceeding regarding the ’396 Patent, and in the related IPR proceedings concerning the ’396 Patent, U.S. Patent Nos. 7,389,181 (“181 Patent) and 7,929,800 (“’800 Patent”). The three other related IPR proceedings have Case Nos. IPR2014-01338, IPR2014-01339, and IPR2014-01340, and the ’181 Patent and ’800 Patent are also asserted against the Petitioner in the same above-identified district court litigation as the ’396 Patent. I represent Petitioner in concurrent litigation involving the ’181, ’800, and ’396 Patents, and I have extensively reviewed each of the patents and the Patent Owner’s preliminary infringement contentions served in the litigation. I have gained significant familiarity with the claim construction issues (implicit and explicit) in those cases, including the Patent Owner’s claimed claim scope as disclosed in its infringement contentions. These issues significantly overlap with the corresponding issues in these IPR proceedings. For example, in the related IPR Case No. IPR2014-01340, the Petition notes that the Patent Owner

argued in its infringement contentions that the claims should interpreted such that claimed "server" need not capture the images, which is relevant to the scope of the claims and to the application of prior art references in that IPR proceeding. Moreover, not only have I reviewed and understand each of the '181, '800, and '396 Patents and their corresponding file histories, but my work in the concurrent litigation has also resulted in my detailed review of the Petition for *Inter Partes* Review (including the proposed invalidity grounds therein, the cited references, and exhibits), the accompanying Declaration of Dr. Fuchs, and the Board's Decision instituting *Inter Partes* Review in each of in these IPR proceedings (Case Nos. IPR2014-01338, IPR2014-01339, IPR2014-01340, and IPR2014-01341).

5. In each of these IPR proceedings, I have advised Petitioner on strategy regarding Petitioner's affirmative arguments and Petitioner's counterarguments to the Patent Owner's positions. And, for the present IPR proceeding and for the three other related IPR proceedings that have Case Nos. IPR2014-01338, IPR2014-01339, and IPR2014-01340, I have worked with Petitioner to find and identify the references relied upon in the petitions and to draft the petitions and other submissions to the Office.

6. The prior art references at issue in the IPR proceedings were also at issue in the underlying litigation, and I have reviewed a vast amount of

additional, related prior art—all of which were disclosed in invalidity contentions that I supervised and signed.

7. Since 2009, I have represented Petitioner in connection with many patent litigations and PTO proceedings regarding the technology at issue in this IPR, which relates generally to Geographical Information Systems ("GIS"), graphics, and navigation technology, and Petitioner's products in this technology category, including Google Maps and Google Earth. The following lists six of those matters:

a. *Micrografx, LLC v. Google, Inc.,* Case No. 3-13-cv-03595 (N.D. Tex.) and *Micrografx, LLC v. Samsung Telecommunications America, LLC et al,* Case No. 3-13-cv-03599 (N.D. Tex.): I represent Google, Samsung Electronics America, Inc., and Samsung Electronics Co., Ltd. as counsel of record concerning three patents-in-suit: U.S. Patent Nos. 5,959,633 ("Method and System for Producing Graphical Images"), 6,057,854 ("System and Method of Providing Interactive Vector Graphics Over a Network"), and 6,552,732 ("System and Method of Providing Interactive Vector Graphics Over a Network"). I have been admitted as counsel *pro hac vice* on behalf of these petitioners in IPR Case Nos. IPR2014-

00532, IPR2014-00533, and IPR2014-00534 regarding these patents.

b. *Tierravision Inc., v. Research in Motion Ltd. et al.*, Case No. 3:11-CV-0639 (S.D. Cal.): I represent Google as counsel of record concerning Reissue No. RE41983, titled "Method of Organizing and Compressing Spatial Data." I have also been advising Google regarding *Inter Partes* Reexamination Control No. 95/001,801 regarding this patent.

c. *Vederi, LLC v. Google Inc.*, Case No. 2:10-cv-07747 (C.D. Cal.): I represent Google as counsel of record concerning four patents-in-suit: U.S. Patent Nos. 7,239,760 ("System and Method for Creating, Storing, and Utilizing Composite Images of a Geographic Location"), 7,805,025 ("System and Method for Creating, Storing and Utilizing Images of a Geographic Location"), 7,577,316 (same title) and 7,813,596 (same title). I have also been advising Google regarding *Inter Partes* Reexamination Control Nos. 95/000,681, 95/000,682, 95/000,683, and 95/000,684 regarding these patents, and I have applied to appear *pro hac vice* in these proceedings; that petition is still pending. The litigation and the reexaminations

concern patents from the same family as a Di Bernardo patent application, which is a prior art publication at issue in this proceeding.

d. *Silver State Intellectual Technologies, Inc. v. Google Inc. et al.,* Case No. 2-14-cv-00662 (D. Nev.): I represent Google as counsel of record concerning U.S. Patent Nos. 6,525,768 ("Positional Camera and GPS Data Interchange Device"), 6,529,824 ("Personal Communication System for Communicating Voice Data Positioning Information"), 7,475,057 ("System and Method for User Navigation"), 7,650,234 ("Technique for Effective Navigation Based on User Preferences"), 8,538,498 ("Technique for Effective Communications with, and Provision of Global Positioning System (GPS) Based Advertising Information to, Automobiles"), and 8,700,312 ("Personal Communication System to Send and Receive Voice Data Positioning Information").

e. *Walker Digital LLC v. Google, Inc. et al.*, Case No. 1:11-CV-00309 (D. Del.): I represented Google and Samsung Telecommunications America, LLC ("STA") as counsel of

record concerning U.S. Patent No. 6,199,014, titled "System for Providing Driving Directions with Visual Cues." I also advised Google and STA regarding *Inter Partes* Reexamination Control No. 95/002,031 regarding this patent.

f. *Webmap Techs. LLC v. City Accommodations Network Inc. et al.*, Case No. 2:09-CV-00343 (E.D. Tex.): I represented Google as counsel of record concerning U.S. Patent No. 6,772,142, titled "Method and Apparatus for Collecting and Expressing Geographically-Referenced Data." I also advised Google regarding *Inter Partes* Reexamination Control No. 95/000,554 regarding this patent.

g. I have also represented Petitioner in other, non-public disputes regarding Petitioner's GIS, graphics, and navigation technologies.

8. Through this work, I have developed in-depth knowledge of the issues and technology within GIS, graphics, and navigation technologies. This knowledge includes my analysis of a significant number of patents, articles, books, software programs, products, industry conference proceedings, and other materials regarding GIS, graphics, and navigation technologies. I have used this knowledge on behalf of Petitioner to help prepare invalidity

contentions, expert reports on invalidity, requests for *inter partes* reexamination, and requests for IPR. My GIS, graphics, and navigation knowledge also includes knowledge gained from working closely with several GIS, graphics, and navigation experts from academia and industry, both as expert witnesses in litigation and as declarants in PTO proceedings. I have taken and defended more than a half-dozen expert depositions regarding GIS, graphics, and navigation technologies, including depositions regarding invalidity. I have also taken and defended more than a half-dozen factual depositions regarding GIS, graphics, and navigation technologies, including taking depositions of named inventors of GIS, graphics, and navigation patents and defending depositions of Petitioner's engineers. I have subpoenaed and coordinated with numerous GIS companies, including working with their employees and reviewing their document productions. And I have had dozens of meetings with Petitioners' engineers regarding GIS, graphics, and navigation products.

9. I have worked closely with Dr. Henry Fuchs, who provided a declaration in this IPR, regarding his declaration. I was also involved in identifying and retaining Dr. Fuchs as an expert in this IPR, and I signed his engagement letter. I also conferred with Dr. Fuchs during Dr. Fuchs' work on his declaration in the present IPR proceeding.

10. I frequently publish and present CLE programs on issues concerning patent law and trade secret law.

11. I have not been suspended or disbarred from practice before any court or administrative body. No sanction or contempt citation has been imposed against me by any court or administrative body. I have never had an application for admission to practice before any court or administrative body denied, except that a request for *pro hac vice* admission in reexamination proceeding 95/001,801 was treated as a petition under 37 C.F.R. § 41.3 and denied due to an absence of information addressing the specific requirements for a petition in a reexamination proceeding.

12. In the last three years, and in addition to my pending applications in the above-captioned proceeding (IPR2014-01341) and the related three proceedings (IPR2014-01338, IPR2014-01339, and IPR2014-01340), I have applied to appear *pro hac vice* before the Office in three sets of Patent Office proceedings:

a. First, as described above in paragraph 7(a), I applied and was admitted as counsel *pro hac vice* in three related IPR proceedings that involve GIS technologies: IPR Case Nos. IPR2014-00532, IPR2014-00533, and IPR2014-00534.

b. Second, as described in paragraph 7(c) above, I have applied to appear *pro hac vice* before the Office in a set of reexamination proceedings (*Inter Partes* Reexamination Control Nos. 95/000,681, 95/000,682, 95/000,683, and 95/000,684). The petitions in those reexamination proceedings are still pending.

c. Third, as described in paragraph 11 above, I applied to appear *pro hac vice* before the Office in another reexamination proceeding *(Inter Partes* Reexamination Control No. 95/001,801). My application in that reexamination proceeding was treated as a petition under 37 C.F.R. § 41.3 and denied due to an absence of information addressing the specific requirements for a petition in a reexamination proceeding.

13. I have read and will comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials set forth in part 42 of the Code of Federal Regulations.

14. I will be subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq*. and disciplinary jurisdiction pursuant to 37 C.F.R. § 11.19(a).

15. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. I further declare that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patents issued thereon.

Respectfully submitted,

Date: 3/5/15

David S. Almeling
O'Melveny & Myers LLP

David Almeling

PARTNER

David Almeling is a partner in O'Melveny's San Francisco office and a member of the Intellectual Property and Technology Practice Group within the Litigation Department.

David focuses his practice on both patent and trade secret litigation. He is also a leader in those fields. Among his other awards, David was recognized in *The National Law Journal's* 2014 "Intellectual Property Trailblazers & Pioneers," which highlights 50 of the top intellectual property lawyers across the country "who are raising the bar in intellectual property law." David was also named on *The Recorder's* 2013 list of "Lawyers on the Fast Track," which identifies 50 California lawyers across all legal fields "whose early accomplishments indicate they will be tomorrow's top lawyers and leaders."

David is a nationally respected authority on patents and trade secrets. David's second book on trade secret law, *Trade Secret Law and Corporate Strategy*, was published by LexisNexis in 2015. He has also published more than a dozen articles in best-in-class publications, and he has presented more than two dozen CLE presentations. David holds leadership roles in state and national intellectual property bar associations.

David has been successful in every stage of litigation, from securing fast and favorable results through early settlements or motion practice to preserving victories at the Federal Circuit. Clients also entrust David with a wide variety of non-litigation tasks, from conducting pre-filing patent analysis to investigating the alleged theft of trade secrets.

Illustrative Professional Experience

Illustrative Patent Litigation

- Defended an industry-leading, Mountain View-based multinational public cloud computing company in ten patent cases. One in E.D. Tex. involved a web-based interactive map technology and resulted in a complete victory in which the U.S. Patent & Trademark Office invalidated the asserted patent in reexamination. Another case in E.D. Tex. involved the use of electronic tokens to conduct internet commerce and resulted in a fast and favorable settlement. David is currently defending the company in several cases, including one in S.D. Cal. involving the organization of map data on portable wireless devices; one in D. Del. involving a method for providing navigational instructions that include photographs of locations along the route; one in N.D. Tex. involving three patents relating to computer graphics; one in M.D. Fla. involving three patents related to generating video and image data; and one in D. Nev. involving seven patents related to GPS, maps, and navigation technologies.
- Defended a Korea-based, multinational public electronics company in four patent cases. One, in E.D. Tex., involved vehicle collision systems and resulted in a favorable settlement. David is currently defending the company in a several cases, including a case in D. Del. that involves a method for providing navigational instructions that include photographs of locations along the route and in a N.D. Tex. case involving three patents relating to computer graphics.
- Represented a San Jose-based public semiconductor manufacturer in several patent cases. One in E.D. Pa. involved voltage and temperature compensated amplifiers and resulted in a complete victory in which the case was dismissed shortly after O'Melveny filed a Rule 11 motion. Two other cases resulted in a fast and favorable settlement: one in N.D. Cal. involved all-silicon oscillators for generating clock signals and the other in E.D. Tex. involved PCI Express technology.

- Defended a Cupertino-based multinational public consumer electronics and software company in a patent case involving antivirus software that resulted in a favorable settlement involving the licensing of a portfolio of patents shortly after service of strong invalidity contentions. (E.D. Tex. and S.D. Fla.)
- Defended an electronic design automation company in a patent case relating to automated design of integrated circuits, resulting in a favorable settlement after a summary judgment ruling that the plaintiff lacked standing. (N.D. Cal.)
- Represented a biometric payment solutions company in an appeal that decided the ownership of fifteen patents, resulting in a Federal Circuit decision that gave a complete victory to the company. (Federal Circuit)
- Represented two global electronics companies in their assertion of patent infringement claims against a provider of wireless networking technology, resulting in a Federal Circuit decision approving, for the first time, of proving infringement through compliance with a technical standard. (Federal Circuit and W.D. Wis.)
- Currently defending an online video service company in two patent cases, both in C.D. Cal.: one involves a method for creating and streaming interactive video and the other involves a method for managing and marketing digital video.
- David also has substantial experience and success advising companies regarding proceedings in the U.S. Patent & Trademark Office. He has been involved in more than two dozen ex parte and inter partes reexaminations. And he is currently involved in nearly a dozen Inter Partes Review and Covered Business Method proceedings.

Illustrative Trade Secret and other Matters

- Represented a biometric sensors company against two former employees in an arbitration involving claims of breach of contract and trade secret misappropriation. David served as second chair at the two-day hearing in front of a former federal judge, who found in the company's favor that the former employees breached certain provisions of the applicable agreements, including provisions regarding trade secrets. (JAMS)
- Represented a medical device company in six simultaneous cases involving software and hardware used to design orthodontic braces, resulting in a favorable settlement that included a significant payment to the client. The cases involved trade secret, trademark, and other claims. (N.D. Cal., W.D. Wis., ITC, and California state court)
- Defended an innovator of HD semiconductor chips in a case that involved trade secret, copyright, antitrust, and unfair competition claims. After the successful defeat of a motion for preliminary injunction on the trade secret claim, the litigation was resolved through a favorable settlement. (N.D. Cal.)
- Represented a leader in biometric fingerprint security solutions in a case involving trade secret claims, resulting in a favorable settlement that created the world's largest provider of fingerprint sensors and identity management software. (N.D. Cal.)
- Defended the world's largest manufacturer of watersports towboats in a trade secret and design patent case involving marine windshields, resulting in a favorable settlement shortly before trial. (M.D. Fla.)
- Represented an international nonprofit athletic institution in a trademark infringement case against various websites that sold fraudulent tickets, resulting in a complete victory in the form of permanent injunctions against the websites. (D. Ariz. and N.D. Cal.)
- Represented a large number of companies and individuals — both trade secret owners and alleged misappropriators — in various aspects of civil and criminal trade secret disputes that do not go to court, including devising trade secret protection programs, investigating alleged misappropriation and valuing trade secret claims, drafting cease-and-desist letters, enforcing and defending against non-competition agreements, responding to cease-and-desist letters, negotiating pre-litigation resolutions, hiring and terminating employees and dealing with issue related to employee mobility.
- Represented a nonprofit IP institute and filed an amicus brief on their behalf regarding the patentability of basic scientific research in the pharmaceutical industry. (U.S. Supreme Court)
- Represented, *pro bono*, a plaintiff who alleged a school district discriminated against her because of her Egyptian nationality and Islamic faith. David helped secure what was at the time the second largest award in a hostile school environment claim. (Ninth Circuit and D. Nev.)

Education

Duke University, J.D.: high honors; Order of the Coif; Note Editor, Duke Law Journal; Moot Court Board

University of Florida, B.A., Political Science: highest honors; Valedictorian; Phi Beta Kappa

Admitted

California

Professional Activities

Law Clerk, Honorable Gerald B. Tjoflat, US Court of Appeals, Eleventh Circuit (2004-05)
Admitted to Practice, US District Court, Northern, Southern, Central, and Eastern Districts of California; US Court of Appeals, Ninth, Eleventh, and Federal Circuits; US Supreme Court
Co-Chair, Best Practices Subcommittee, Trade Secret Committee of the American Intellectual Property Law Association
Former Chair, Media Relations Subcommittee and the Amicus Subcommittee, Trade Secret Committee of the American Intellectual Property Law Association
Member, San Francisco Bar Association Section on Intellectual Property; American Bar Association Section on Intellectual Property Law; The Lawyers and Judges Golf Association of Northern California
Former Programming Director, Trade Secret Committee of the California Bar Association
Honors, Named in *The National Law Journal's* 2014 list of "Intellectual Property Trailblazers & Pioneers," which highlights the top 50 intellectual property lawyers "who are raising the bar in intellectual property law"; Recipient of a 2014 Distinguished Legal Writing Award from the Burton Awards; Named on *The Recorder's* 2013 list of "Lawyers on the Fast Track," which identifies 50 California lawyers "whose early accomplishments indicate they will be tomorrow's top lawyers and leaders"; named a "Rising Star" in intellectual property litigation in the 2013, 2014, and 2015 surveys conducted by Law & Politics Media Inc. and published in Northern California *Super Lawyers* Magazine and *San Francisco* magazine
Author, "Defend Trade Secrets Act — A Primer, an Endorsement, and a Criticism,"*Patently-O* (May 30, 2014); "Recent Trade Secret Reform, and What Else Needs to Change,"*IP Law 360* (September 23, 2013); "Seven Reasons Why Trade Secrets Are Increasingly Important," 27 *Berkeley Technology Law Journal* 1091 (November 2012), which was judged one of the best intellectual property articles published in 2012 and was selected for inclusion and republication in the 2013 edition of the *Intellectual Property Law Review*; "Keeping Secrets: A Practical Introduction to Trade Secret Law and Strategy" (Oxford University Press 2012); "The New, Improved Prior Use Defense: The Same Patent vs. Trade Secret Calculus," *Trade Secret Litigator* (April 17, 2012); "First Patent Reform, Now Trade Secret Reform," *Patently-O* (October 12, 2011); "Pros and Cons of Criminal Prosecution vs. Civil Enforcement," in *Trade Secret Litigation and Prosecution in California Supplement* (2011); "A Look At State Court Trade Secret Stats," *IP Law 360* (March 1, 2011); "A Statistical Analysis of Trade Secret Litigation in State Courts," 46 *Gonzaga Law Review* 57 (February 2011), which was judged one of the best intellectual property articles published in 2011 and was selected for inclusion and republication in the 2012 edition of the *Intellectual Property Law Review*; "Tracking Trade Secret Stats," *IP Law 360* (March 25, 2010); "A Statistical Analysis of Trade Secret Litigation in Federal Courts," 45 *Gonzaga Law Review* 291 (March 2010); "A Practical Case For Federalizing Trade Secret Law," *IP Law 360* (June 23, 2009); "Four Reasons to Enact a Federal Trade Secrets Act," 19 *Fordham Intellectual Property, Media & Entertainment Law Journal* 769 (April 2009); "Trade Secrets: The Identification Issue,"*National Law Journal* (August 2008); "DOJ, FTC Redefine Antitrust Rules on Patent Pools,"*National Law Journal* (October 29, 2007); "The Infringement-Plus-Equity Model: A Better Way to Award Monetary Relief in Trademark Cases," 14 *Journal of Intellectual Property Law 205* (2007); "Patenting Nanotechnology: Problems with the Utility Requirement," *Stanford Technology Law Review,* N1 (2004); "The Problems of Pouring-Rights Contracts," 53 *Duke Law Journal* 1111 (2003)
Speaker, "IP Issues in Business Transactions: Trade Secrets, Utility Patents, and Design Patents," Practicing Law Institute (February 26, 2015); "Developing Best Practices for Protecting Trade Secrets," Trade Secret Summit (December 5, 2014); "New Trade Secret Legislation and the Changing Rules of Trade Secret Litigation," Bridgeport Continuing Education (June 17, 2014); "Updates on Recent Developments in Trade Secret Law: Legislation, Litigation, and Business," American Intellectual Property Law Association (May 16, 2014); "New Legal Issues Impacting IP Transactions: Copyrights, Trademarks, Domain Names, Patents, and Trade Secrets," Practicing Law Institute (February 27, 2014); "Patents vs. Trade Secrets: Best Practices for Protecting and Enforcing IP," California Bar Association Intellectual Property Law Section (August 7, 2013); "What Lawyers and Their Clients Need to Know about the Changing Balance of Power Between Trade Secrets and Patents," American Intellectual Property Law Association (April 23, 2013); "Introduction to Trade Secret Law, Its Increasing Importance, and Its Changing Balance with Patent Law," University of Washington School of Law (October 29, 2012); "Understanding Patent Law and Trade Secret Law for In-House Counsel and Other Non-IP Lawyers," Bridgeport Continuing Education (August 24, 2012); "Why Trade Secret Litigation is Booming, and Why That Matters to Clients," Sonoma County Bar Association (January 23, 2012); "Why Every Lawyer Should Know More about Trade Secret Law," California Bar Association IP Institute (November 11, 2011); "Six Reasons That Trade Secrets Matter More and More to American Companies," Bridgeport Continuing Education's Prosecuting and Defending Corporate Raiding, Customer Trade Secret, and Employee Mobility Cases (February 25, 2011); "Trade Secret Litigation - A Statistical Analysis of Recent Trends

and Implications," California State Bar Cyber Institute (January 19, 2011); "Trade Secret Considerations for In-House Counsel and Executives," California State Bar Cyber Institute (January 11, 2011); "Someone Stole My Trade Secrets, Now What Do I Do?" Joint CLE provided by O'Melveny & Myers and Navigant Consulting (October 12, 2010); “The Evolution of Trade Secret Law: Reflecting on 30 Years of the Uniform Trade Secrets Act,” Hamline Law Review Symposium (April 16, 2010)

Adjunct Teaching Position, Trade Secret Law, Santa Clara University School of Law (2014); Advanced Patent Law, Santa Clara University School of Law (2007)