

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Under Armour Inc.

Petitioner

v.

adidas AG,

Patent Owner

Case No. IPR2015-00696

Patent No. 8,068,858

PATENT OWNER'S PRELIMINARY RESPONSE

UNDER 37 C.F.R. § 42.107(a)

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EXHIBIT LIST

| Exhibit No. | Document |
|-------------|--------------------------------------------------------------------------------------------------|
| 2001 | Feb. 26, 2007, Declaration of Jon Werner Filed During Prosecution of Application No. 10/759,289. |

I. INTRODUCTION

Petitioner fails to establish a reasonable likelihood of success with regard to any grounds raised in the Petition for *inter partes* review filed February 5, 2015 (“Petition”). The Petition is disorganized and glosses over or wholesale ignores claim limitations. Indeed, as initially explained below, the Ground 2 anticipation assertion is fatally and facially flawed, as the Petition does not identify what the references actually or inherently disclose for relevant limitations. As to all Grounds, the Petition does not demonstrate that each reference fully anticipates the claims. Instead, Petitioner relies on impermissible hindsight to confuse what have only recently become common smartphone functions with dissimilar, dedicated GPS devices that do not disclose each claim limitation.

For these reasons, and others, the Petition does not articulate how the challenged claims are anticipated by the cited references. The Board should therefore find that each of Grounds 1-3 fails and deny the Petition.

II. BACKGROUND

Contrary to the Petition’s assertion, Patent Owner does not claim to have invented a mobile phone, a GPS, or the combination of a mobile phone and a GPS. Rather, the claimed invention relates to a novel way to monitor a user’s performance during an athletic activity with a single integrated device. As described in a declaration filed during prosecution of the Application that led to

this Patent's parent, U.S. 7,292,867, the claimed systems and methods enable "active individuals to achieve their fitness and lifestyle goals by wirelessly capturing and monitoring their activities, such as a running, cycling and walking, in real-time on GPS-enabled mobile phones." Ex. 2001 at p. 2.

Representatives of leaders in the mobile industry such as QUALCOMM and ESRI noted the novelty of the claimed system. *Id.* at 2-3. For example, an Application Engineering Manager at QUALCOMM, who had used conventional GPS devices for several years, described the invention as "unique in that it not only automated data collection for the user during the activity, but simultaneously provided a single source web-based training log where all the activities would be recorded." *Id.* at 3. These accolades support the inventiveness of the claims of the '858 Patent and weigh heavily against any obviousness grounds raised in the Petition.

The Petition does not establish that the prior art discloses the claimed device, by either anticipation (Grounds 1-3) or obviousness, which the Petition does not raise. Rather, the Petition cites to a group of disparate GPS related references, none of which describe the features claimed in the '858 Patent.

III. GROUND 2 IS A FACIALLY INSUFFICIENT ANTICIPATION REJECTION.

Ground 2 fails because it does not establish that the reference anticipates the challenged claims. "A claim is anticipated only if each and every element as set

forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131; *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989) (“Every element of the claimed invention must be literally present, arranged as in the claim.”). Instead of relying on express or inherent disclosure, the Petition instead relies on what “would be understood by a person of ordinary skill in the art.” A proper anticipation rejection requires that “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson*, 868 F.2d at 1236. The Petition’s reliance on what a person of skill in the art would have understood, as opposed to what is actually expressly or inherently disclosed, does not establish that the identical invention is disclosed in Wadell (Ex. 1003).

For Ground 2, the Petition repeatedly relies on what a person of skill in the art may have recognized. The Petition concludes that “one of ordinary skill in the art **would understand** Wadell to disclose initiation of a visual display—including both performance and position information—on a remotely located user’s computer, with the display also indicating the user’s location with respect to a route path.” Petition at 28 (emphasis added). Support for this conclusion is at page 27, which references expert testimony at UA-1005 ¶68. Notably, that paragraph follows several paragraphs discussing the Wadell disclosure, but nothing

in those paragraphs discloses initiating a visual display with indications of player positions relative to a route path. Instead, Petitioner’s argument, at most, seems to be that use of the Wadell system may possibly perform the recited limitation. But this does not meet the standard for anticipation. At best, it is an undeveloped inherency argument, yet Petitioner does not even attempt to satisfy the inherency requirement that the limitation is necessarily present and not shown through mere “probabilities or possibilities.” *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268–69 (Fed. Cir. 1991).

The Petition includes similar analysis for other limitations, e.g., at page 27 the Petition states, “one of ordinary skill in the art **would understand** Wadell to disclose that any of the collected data—which can include performance data such as heart rate and speed, and location data such as ‘position on a course’—can be visually displayed ‘in the form of an Internet webpage.’” Petition at 27 (emphasis added). Regardless of whether this is correct, and Patent Owner asserts that it is not, anticipation is not established based on what a person of skill in the art “would understand.” Anticipation instead requires showing that disclosure is expressly or inherently found in the prior art reference. *See* MPEP § 2131.

Likewise, the Petition makes similar leaps in stating that “tower transceivers perform essentially the same function as cellular towers (relaying radio signals over large distances), and **would be understood by one of ordinary skill** in the art

to be part of a wireless wide-area network.” Petition at 25 (emphasis added). For support, the Petition cites expert testimony that says “[o]ne of ordinary skill in the art would understand these tower transceivers to be elements of a wide-area wireless network.” UA-1005 at ¶63. But, in fact, both Wadell and the expert testimony show that skilled persons understand the tower transceivers are actually “field-position devices.” *See id.* at ¶62 (“the field-position devices constitute ‘tower transceivers’ (214)”). Such field-position devices are spaced around the medium and while each can communicate with a player crossing a sensor, there is nothing cited to indicate that the tower transceivers themselves are networked together. UA-1003.013 at 12:30.

Thus, Ground 2 fails for these reasons alone.

IV. CLAIM CONSTRUCTION

A. “wireless wide-area network” (claims 1, 11).

The Petition incorrectly proposes that the term “wireless wide-area network” is “a network that extends beyond the immediate vicinity of a user or room.” This construction is incorrect for at least the reasons discussed below. The Board should instead find that the Broadest Reasonable Interpretation of this term is “any wireless network other than a Local Area Network (LAN)”

The Petition’s construction introduces ambiguity into the claim language by defining the term based upon the “immediate vicinity of the user or room.” There

is no clear definition of “immediate vicinity.” For example, there is no clear meaning of how far removed the immediate vicinity may be from the user. Indeed, the plain meaning of “immediate vicinity” suggests the area that is in direct contact with the user.¹ This is certainly not the commonly understood meaning of a Wide Area Network. This ambiguity is not cured by inclusion of the “user or room.” For example, a room is an imprecise term, as the word “room” by itself simply means an area within a building.² This may encompass very small rooms (e.g., an office) up to very large rooms (e.g., the Superdome). Thus, under the Petition’s proposal, virtually any wireless network is arguably a “wireless wide-area network.”

Patent Owner proposes a construction that, while similar to the one proposed by Petitioner, takes into account the plain meaning of “wide-area network” in view of the specification and prosecution history. The specification describes a device comprising two different wireless interfaces: Local Wireless Interface(s) 110 and a

¹ <http://dictionary.reference.com/browse/immediate> (“having no object or space intervening nearest or next: in the immediate vicinity”) (last accessed May 14, 2015).

² <http://dictionary.reference.com/browse/room?s=t> (“a portion of space within a building or other structure, separated by walls or partitions from other parts”) (last accessed May 14, 2015).

WAN Wireless Transceiver 104. *See* Fig. 2A. This clearly refers to a receiver for short range transmission, e.g. a Local Area Network (LAN), and a second transceiver for a Wide Area Network (WAN). Thus, the specification contemplates two separate types of wireless network, a WAN and a LAN. Taking this into account, the Broadest Reasonable Interpretation of WAN is a network that is different from a LAN.

The specification distinguishes between long range communication via the WAN and short range communication. *See, e.g.,* '858 Patent, col. 4:22-26 (“The data sent and received by WAN wireless transceiver 104 may alternatively be communicated via an optional data port 108, which may employ short range wired or wireless communication”). Indeed, the specification repeatedly describes the wide area network as a cellular network. *See, e.g.,* '858 Patent, col. 3:53-55 (“a wireless wide-area network (WAN) communication system including a plurality of geographically distributed cellular telephone towers.”); col. 5:10-13 (“Portable training device 12 supports two-way wireless WAN communication with cellular telephone tower 30 with WAN wireless transceiver 104 and its associated antenna 106.”).

Further, as discussed above, the prosecution history of this application’s parent refers to use of a WAN in the form of a cellular network. A declaration filed during prosecution of the Application that led to this Patent’s parent, U.S.

7,292,867, explained that “[t]he claimed subject matter ... is embodied in a *mobile phone* application program developed by BiM named BiM Active. BiM Active is currently deployed on *mobile phones*” Exhibit 2001 at 2 (emphasis added). A mobile phone accesses a WAN in the form of the cellular network.

For each of the reasons discussed above, the appropriate construction of a wide area wireless network is “any wireless network other than a Local Area Network (LAN).”

B. “a portable fitness device” (claims 1, 11).

The Petition does not propose a construction for this claim term. This is likely because, as discussed in further detail below, the Petition argues that “a portable fitness device” is met by the combination of at least three modules: (1) a VSM, (2) central processing hub, and (3) RF Transmitter. *See, e.g.*, Petition at 12. That each of these is a separate component is further illustrated by Satava, Fig. 2, which was also included in the Petition at page 13.

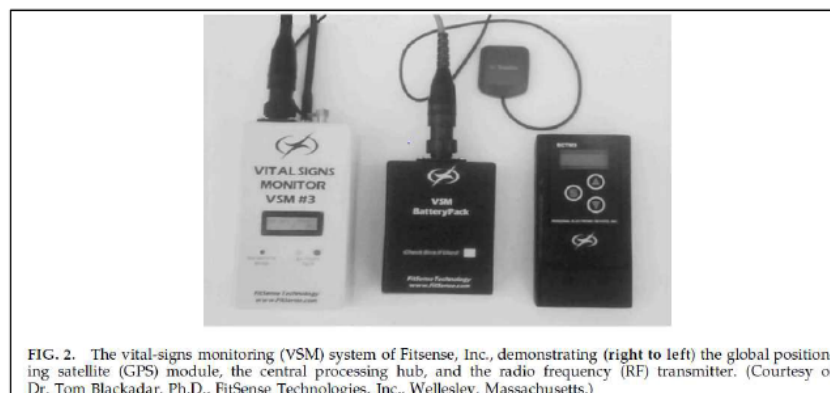


FIG. 2. The vital-signs monitoring (VSM) system of FitSense, Inc., demonstrating (right to left) the global positioning satellite (GPS) module, the central processing hub, and the radio frequency (RF) transmitter. (Courtesy of Dr. Tom Blackadar, Ph.D., FitSense Technologies, Inc., Wellesley, Massachusetts.)

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The Board should find that this is incorrect, and instead construe this term to require “a single portable device.”

The claims, the specification, and the prosecution history all support an interpretation of this phrase that requires one portable fitness device, rather than a combination of devices. **First**, the claim language recites “a portable fitness device.” The use of the singular “device” rather than plural “devices” refers to a single device. If this element covered multiple combined devices, it would instead recite “[one or more] portable fitness device[s],” as it does in other limitations for which multiple components are contemplated. *See, e.g.*, claim 11 (“***one or more processors*** of a server computer system.”). **Second**, the specification discloses a single portable fitness device. *See, e.g.*, Fig. 2A (disclosing a single device comprising modules such as local wireless interface 110, GPS receiver 100, Power supply 90, and display 84.) **Third**, as discussed above, a declaration filed during prosecution of the Application that led to this Patent’s parent, U.S. 7,292,867, explained that “[t]he claimed subject matter ... is embodied in a ***mobile phone application program*** developed by BiM named BiM Active. BiM Active is currently deployed on ***mobile phones***” Exhibit 2001 at 2 (emphasis added). A mobile phone is a single device.

For at least the foregoing reasons Patent Owner requests that the Board construe “a portable fitness device” to require “a single portable device.”

C. “while the first user is engaged in the physical activity” (claims 1, 11).

The Petition does not propose a construction for this claim term. In context with other claim limitations, it is clear that “while the first user is engaged in the fitness activity” means “in substantially real time.” For example, claim 1 requires that “the visual display further includes an indication of the first user’s location with respect to the route path.” Providing a location along a route would make little sense unless it was in substantially real-time. Further, the specification describes a user engaged in activities, e.g., during traversal of a route, making clear that such activities occur in “substantially real time.” ’858 Patent, col 9:43-44 (“substantially real time (i.e., during traversal of the route)”). Thus, the intrinsic record supports a definition of this term that requires substantially real-time. Further, the specification states that “[t]raining journal interface 232 also preferably permits a user to view routes currently being traversed in *substantially real time through* an interface similar to that depicted in FIG. 5B.” ’858 Patent, col. 16:25-38. (emphasis added). Indeed, in other embodiments the specification states, “[i]f a user stationed at a client computer system 44 desires to view a *substantially real time view* of the activities of multiple athletes traversing a common route, the user preferably logs into real-time interface 234 through HTTP server 214.” ’858 Patent, col. 16:31-34. (emphasis added).

Thus, in view of the specification and claim language “while the first user is engaged in the fitness activity” means “in substantially real time.”

V. THE PETITION DOES NOT ESTABLISH THAT EACH REQUIRED LIMITATION IS DISCLOSED BY THE CITED REFERENCES.

As discussed in further detail below, the Petition fails to establish that the cited references disclose each element of each claim. This is improper and does not meet the Petitioner’s burden of establishing a reasonable likelihood of success. The Board has denied a Petition to institute an *inter partes* review where the Petition failed to address every feature from the challenged claim and to show each feature in the cited references. *Medtronic, Inc. v. Nuvasive, Inc.*, IPR2013-00504, Paper 8, 2014 WL 1253033 (P.T.A.B. Feb. 13, 2014). Similarly, because each of the proposed rejections is an anticipation rejection, the Petition must show that “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131; *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). As explained further below, the Petition does not do so and therefore should be denied.

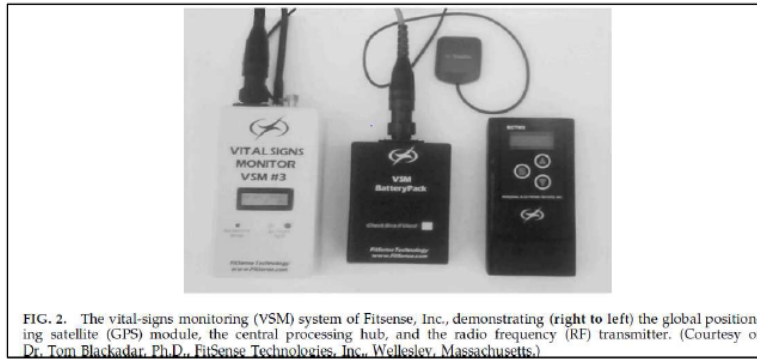
Further, the Petition proposes no rejections on obviousness grounds. The Petition therefore cannot establish a reasonable likelihood of success in establishing that any claim limitation is obvious in view of the prior art. *Callcopy, Inc. v. Verint Americas, Inc.*, IPR2013-00486, Paper 11, 2013 WL 8595753, at 5

(P.T.A.B. Feb. 5, 2013) (the Board does not “parse [Petitioner’s] mapping of disclosure in [the prior art] to elements of [the claims] into separate anticipation and obviousness grounds because doing so would substitute [the Board’s] analysis for [Petitioner’s].”)

A. Ground 1 Independent Claims 1 and 11 – The Petition Does Not Establish that Satava (Exhibit 1002) discloses “a portable fitness device.”

The Petition does not establish that Satava expressly or inherently discloses “a portable fitness device.” As discussed above, the claims, the specification, and the prosecution history all support a construction of this phrase to require “a single portable device.” The Petition does not establish that such a device is disclosed by Satava.

With regard to this claim element the Petition cites to a plurality of devices, including at least three modules: (1) a VSM, (2) central processing hub, and (3) RF Transmitter. *See, e.g.*, Petition at 12 (“each climber wore a wearable vital signs monitoring system (“VSM”), pictured below in Figure 2, that included a GPS receiver, a vital signs monitor, a central processing hub, and a “[w]earable, wireless communication system with radio frequency (RF) transmission.”). That each of these is a separate device is further illustrated by Satava, Fig. 2, which was also included in the Petition at page 13.



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Thus, at best, Satava discloses the user carrying many portable devices. This does not meet the claim’s requirement of “a portable fitness device.” Further, the Petition does not offer any arguments for why the claim should be construed such that “a portable fitness device” is met by this combination of devices.

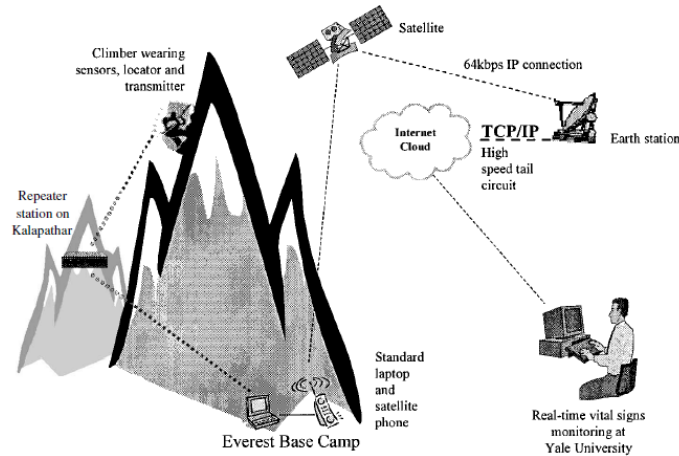
Accordingly, the Petition does not establish that Satava discloses “a portable fitness device,” as is required by independent claims 1 and 11.

B. Ground 1 Independent Claims 1 and 11 – The Petition Does Not Establish that Satava (Exhibit 1002) discloses “a wide-area wireless network.”

The Petition does not establish that Satava expressly or inherently discloses “a wide-area wireless network.” With regard to this claim element the Petition cites to Satava’s discussion of a wireless communication system for radio frequency (RF) transmission. This system does not anticipate “a wide-area wireless network,” as is required by the claims. As discussed above, the Petition’s proposed construction is incorrect for several reasons. The appropriate construction for the term “wide-area wireless network” is any wireless network

other than a Local Area Network (LAN).” This is supported by the claims, specification, and prosecution history.

Satava is related to a wearable system in which a person climbing Mt. Everest wore sensors, a GPS locator, and a transmitter. This transmitter was not a Wide Area Network transmitter. Rather, the transmitter connected to a Local Area Network. The network is designed to cover only a small area, Mount Everest, for a specific purpose, monitoring three climbers. The disclosed network transmitted from a local device to an RF repeater, which then transmitted to Everest Base Camp. This is a Local Area Network, because it covers only a small geographic area and is used by only a small number of devices. Indeed, the data followed a convoluted path to eventually arrive at Yale, evidencing that the network could not meet the requirements of a Wide Area Network. Specifically, from Everest Base Camp, a satellite phone transmitted data to a satellite uplink that eventually connected the data to Yale University. This order of transmission is clarified by Satava, Fig. 3, pasted below.



As is shown in the Figure above, the system contemplated by Satava is far different from the wide area network recited by the claims of the '858 Patent. Thus, Satava does not anticipate independent claims 1 and 11 for this additional reason.

C. Ground 1 Independent Claims 1 and 11 – The Petition Does Not Establish that Satava (Exhibit 1002) discloses “while the first user is engaged in the physical activity.”

The Petition does not establish that Satava expressly or inherently discloses “while the first user is engaged in the physical activity.” With regard to this claim element the Petition states that Satava discloses transmitting data every 5 minutes. Petition at 14, citing Satava at 5 (“[t]he vital signs and position were acquired every 5 minutes and archived and transmitted every 5 minutes.”). Satava uses the words “real-time” to describe data transmission. However, by real-time Satava is referring to its transmission of data every 5 minutes. As discussed above, “while the first user is engaged in the fitness activity” means “in substantially real time.”

Substantially real-time tracking is not disclosed or suggested by the cited sections of Satava, which explicitly state that [t]he vital signs and position were acquired every 5 minutes and archived and transmitted every 5 minutes.” Satava at 5.

Accordingly, for this additional reason the Petition fails to establish that Satava anticipates independent claims 1 and 11.

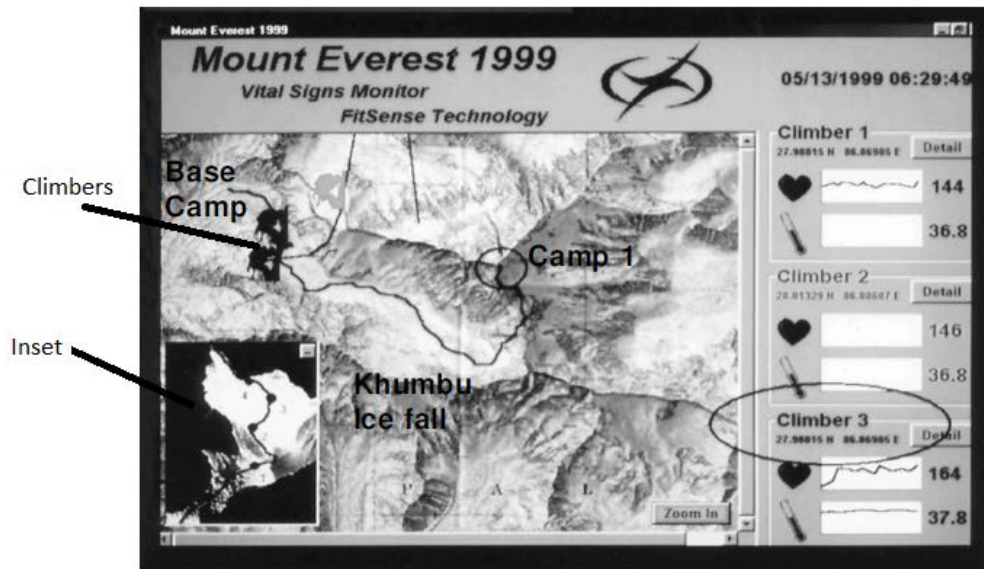
D. Ground 1 Independent Claims 1 and 11 – The Petition Does Not Establish that Satava (Exhibit 1002) discloses “an indication of the first user's location with respect to the route path.”

The Petition does not establish that Satava expressly or inherently discloses “an indication of the first user's location with respect to the route path.” The Petition proposes its own construction of the term “with respect to a route path” as “in relation to a predetermined path.”³ The Petition fails to establish that Satava discloses the user’s location with respect to a predetermined path. With regard to this limitation the Petition states that Satava’s interface “displayed the [sic] ‘the trail and location of an individual climber’—i.e., the path traced by the route the climbers actually took—it also displayed, in the inset, a ‘reference graphic representation of the vertical ascent usually taken to the summit.’” Petition at 16, citing Satava at 7. This does not anticipate showing “an indication of the first user's location with respect to the route path,” as is required by the Petition’s construction of this claim.

³ Patent Owner does not agree that this is the correct construction.

First, the Petition notes that the display shows “the path traced by the route the climbers actually took.” This is not a “predetermined” path as Petitioner advocates for its construction. Rather, it is the path the user actually took. Indeed, it makes no reference whatsoever to a predetermined path.

Second, the Petition cites to the route “usually taken to the summit.” However, the Petition ignores that display of the route “usually taken to the summit,” is separate from any display of the location of the climbers. Specifically, Satava states, with regard to Figure 4, “[t]he *inset in the lower left corner* is a reference graphic representation of the vertical ascent usually taken to the summit” Satava at 7 (emphasis added). As illustrated in the annotated version of Figure 4, below, this inset is different from the terrain map with an “overlay of the climber’s position.” *Id.* at 5. Thus, at most this inset shows a path. However, it does not show “an indication of the first user’s location with respect to the route path,” as is required by the claim.



Third, any path shown in the inset in Figure 4 does not disclose a predetermined path that the user will take. Nor does Figure 4 even show the route that the user is expected to take. Rather, it simply discloses a route that other climbers have taken. The actual climbers might take a completely different route. Indeed, common sense dictates that this route is unlikely to be the route that a climber will take. A harsh environment like Mount Everest is constantly changing and does not have a “fixed” path. A hiker is extremely unlikely to follow any sort of “predetermined path.” Rather, the hiker is likely to cut her own path when attempting to summit Mount Everest.

For each of the foregoing reasons the Petition does not establish that Satava discloses “an indication of the first user's location with respect to the route path,” under the Petition’s proposed construction.

E. Ground 2 Independent Claims 1 and 11 – The Petition Does Not Establish that Wadell (Exhibit 1003) discloses “a wide-area wireless network.”

The Petition does not establish that Wadell expressly or inherently discloses “a wide-area wireless network,” as is required by the claim. With regard to this claim element the Petition cites to Wadell’s discussion of tower transceivers. Petition at 24-25. These tower transceivers do not anticipate “a wide-area wireless network.”

As discussed above, the correct construction of a wide-area wireless network is “any wireless network other than a Local Area Network (LAN).” Wadell’s tower transceivers are not such a network. Rather, “tower transceivers,” refers to “field-positioned devices 206 placed at various locations around or along the medium 201.... the field-positioned devices 206 are known as tower transceivers (TTs).” Wadell, p. 12, ll. 9-11. Wadell further describes “the field-positioned device 206 is a fixed transceiver 214. The tower transceiver 214 is substantially a permanent fixture including a transceiver, an antenna 208, and a connection to the network 105 of Figure 1.” Wadell, p. 12, ll. 28-30. Thus, as discussed by Wadell, rather than referring to a wide-area network, the tower transceivers are instead individual towers that provide coverage over a single portion of a field or a track. Thus, even if the tower transceivers were interlinked, at best they would represent

a Local Area Network, not a Wide Area Network, as is required by the claims.

The difference is further demonstrated by Figures 2A-2C, pasted below.

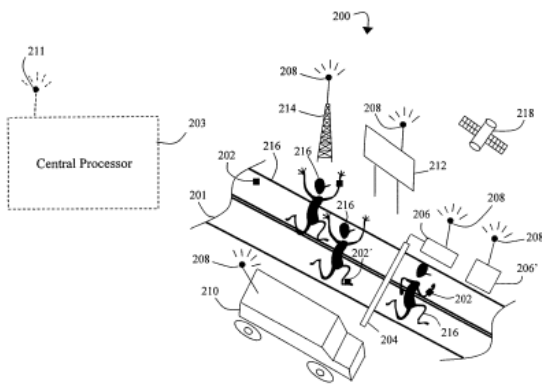


Figure 2A

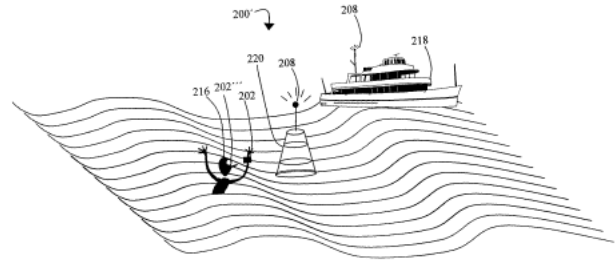


Figure 2B

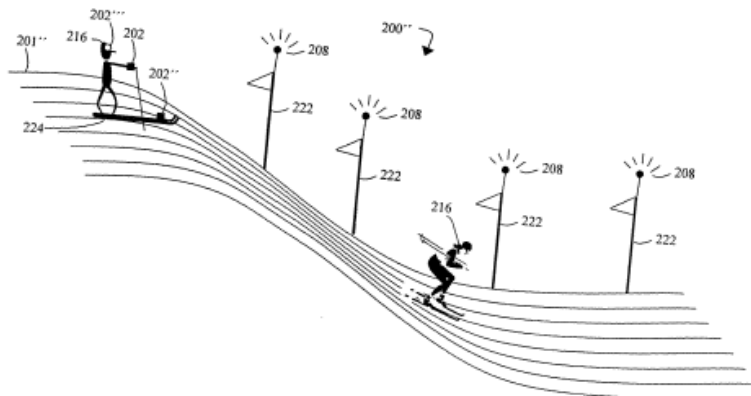


Figure 2C

Further, Wadell repeatedly discusses the limited range of the field positioned devices, stating, e.g., at page 12, ll. 23-25 (“When the players 216 with a player-mounted device 202 come *within range of a field-positioned device 206*, data is transmitted ...”) and page 19, ll. 2-4 (“As the player 216 comes *within communication range of a field-positioned device 104*, the player transceiver 306 wirelessly transmits”) (emphasis added).

As the Petition notes, Wadell states that “central processor 106 further includes an LAN or WAN (Internet) link 622.” Wadell, p. 27, l. 12. However, as shown by Figure 1, central processor 106 is not a component of the Player Mounted Device 102. Thus, this network connection is associated with the field positioned device 104. *See, e.g.*, Wadell, p. 9, ll. 3-4 (“The central processor 106, in an alternate embodiment, is integrated within the field-positioned device 104) and p. 26, ll. 17-19 (“In yet another embodiment, the processor 608 routes processed data to the field-positioned device 104 for transmission to the player-mounted device 102.”). Thus, this does not disclose that the Player Mounted Device 102 communicates using link 622.

Indeed, Wadell states that “[t]he tower transceiver 214 is substantially a permanent fixture including a transceiver, an antenna 208, and a connection to the network 105 of Figure 1.” Wadell, p. 12, ll. 28-30. Figure 1 describes Network 105 as “LAN and/or WAN.” Wadell, Fig. 1. Thus, at best, tower transceiver 214 is merely a transceiver in a short range wireless network (e.g., a LAN) that can then send data received via the LAN connection from the Player Mounted Device 102 onto a wide area network. This is further illustrated by Figure 1 (annotated below), which makes clear that the Player Mounted Device 102 is connected to Network 104 via Field Positioned Device 104.

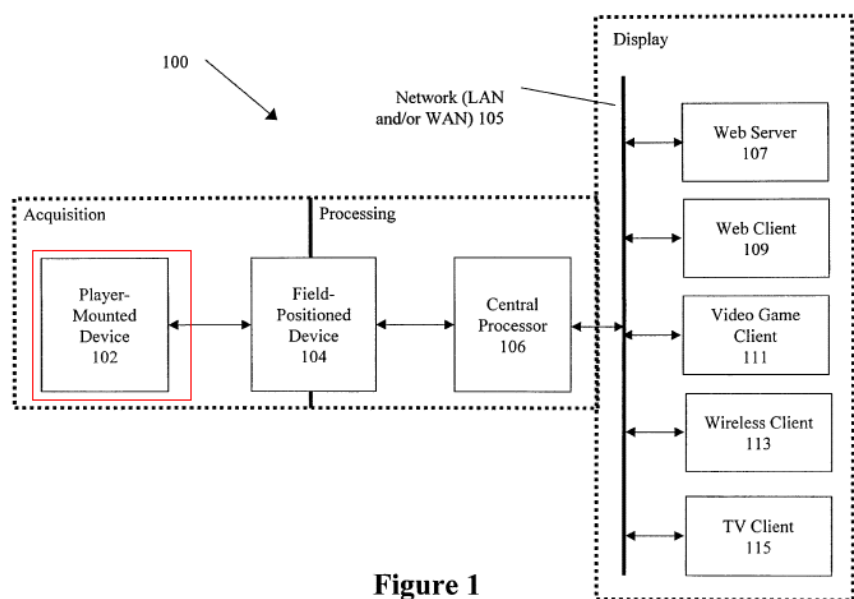


Figure 1

Accordingly, the cited tower transceivers of Wadell refer to a limited range device placed around a playing field, track, ski slope, etc. rather than a wide-area network as is required by the claims. Thus, the Petition has not established that Wadell anticipates claims 1 and 11.

F. Ground 2 Independent Claims 1 and 11 – The Petition Does Not Establish that Wadell (Exhibit 1003) discloses “wherein the visual display further includes an indication of the first user's location with respect to the route path.”

The Petition does not establish that Wadell expressly or inherently discloses “an indication of the first user's location with respect to the route path.” As discussed above, the Petition proposes its own construction of the term “with respect to a route path” as “in relation to a predetermined path.”⁴ The Petition fails

⁴ Patent Owner does not agree that this is the correct construction.

to establish that Wadell discloses the user's location with respect to a predetermined path.

With regard to a "predetermined path" the Petition cites a phrase in Wadell that "Parameters may include for example, ... position on a course" Wadell, p. 4, ll. 3-6. The Petition then states that "a 'position on a course' necessarily involves a determination of athlete's location with respect to a predetermined course." Petition at 26. The Petition next states that one of the transmitted performance parameters includes "distance left in an event" and that "to calculate and subsequently transmit 'distance left in the event,' the system must necessarily have determined the athlete's position relative to a predetermined path. *Id.* This does not anticipate the claim limitation for several reasons.

First, the claim limitation requires "***wherein the visual display further includes an indication*** of the first user's location with respect to the route path." Neither of the cited sections makes any mention of displaying the user's location with respect to a route path, as is required by the claim. For example, the Petition itself makes this deficiency plain as the analysis of this limitation refers to collecting or transmitting data rather than displaying information. Petition at 26 (emphasis added) ("Wadell discloses, for example, that 'position on a course' is one of the performance parameters that the player-mounted device can ***collect and transmit.***" and "Wadell further discloses that the field-mounted devices are

capable of transmitting additional performance data to the player-mounted devices, including ‘... distance left in event’”). It is irrelevant whether the disclosed devices may transmit data. The claim limitation requires “the visual display further includes an indication of the first user's location with respect to the route path.” The Petition has not established that this is expressly or inherently disclosed by Wadell.

Second, the Petition states that determining “position on course” or “distance left in an event” both necessarily requires determining the athlete’s position relative to a predetermined path.” Petition at 26. This is incorrect. Neither of these requires a “predetermined path.” Rather, both could simply refer to a predetermined distance. In both instances, the only required information is how far the user has traveled. For example, with regard to a five mile race, if a user has travelled two miles, it is easy to determine (a) distance left in an event (three miles); and (b) position on the course (two miles into the course), without knowing the user’s location with respect to a route, predetermined or not. Thus, the Petition does not establish that Wadell necessarily visually indicates “the first user’s location with respect to the route path,” whether predetermined or not.

Third, the claim limitation requires “wherein the visual display includes performance related content ... and wherein the visual display further includes an indication of the first user’s location with respect to the route path.” Thus, the

display must show both (a) “performance related content,” and (b) “an indication of the first user’s location with respect to the route path.” The Petition does not even attempt to show that Wadell discloses showing both location and performance data on the same display. Rather, the Petition states “one of ordinary skill in the art would understand Wadell to disclose that any of the collected data ... can be visually displayed ‘in the form of an Internet webpage.’” Petition at 27. Even assuming *arguendo* that this is correct, it does not establish that both types of collected data are output onto the *same display at the same time*. Indeed, at pages 27-28, the Petition misquotes p. 15, ll. 26-28 of Wadell, leaving out the emphasized portion in the following sentence: “***In one embodiment***, the position and performance information is transmitted to a central processor **203 which downloads the data to a database. In another embodiment**, the information is adapted for viewing over the Internet.” As is shown by the emphasized portion, the Petition modifies the disclosure of the reference in an attempt to anticipate this limitation. Further, nothing about this statement discloses that a display shows both (a) “performance related content,” and (b) “an indication of the first user’s location with respect to the route path,” as is required by claims 1 and 11.

For at least the reasons discussed above, the Petition has failed to establish that Wadell anticipates claims 1 and 11.

G. Ground 3 Independent Claims 1 and 11 – The Petition Does Not Establish that Smith (Exhibit 1004) discloses “a wide-area wireless network.”

The Petition does not establish that Smith expressly or inherently discloses “a wide-area wireless network.” With regard to this claim element the Petition cites to Smith’s discussion of an RF unit 9. Petition at 33. As with the devices discussed above, this short range RF unit does not anticipate “a wide-area wireless network,” as is required by the claims. As discussed above, the correct construction of a wide-area wireless network is “any wireless network other than a Local Area Network (LAN).” Such a network is not disclosed by Smith. Smith describes that “[t]he transmission system ... is preferably a radio frequency transmission unit 9, miniaturized to reduce weight and power consumption.” Smith [0030]. Smith further states the “miniature radio frequency transmitter 9 [is] of low power requirement” Smith [0043]. Such a low power RF transmitter does not refer to a transmitter for a wide area network, as is required by both claims 1 and 11. Rather, this refers to a low power, at most Local Area Network, for transmitting within only a short range. Thus, Smith does not disclose a wide-area wireless network. Therefore, the Petition has not established that Smith anticipates claims 1 and 11.

H. Ground 3 Independent Claims 1 and 11 – The Petition Does Not Establish that Smith (Exhibit 1004) discloses “an indication of the first user's location with respect to the route path.”

The Petition does not establish that Smith expressly or inherently discloses “an indication of the first user's location with respect to the route path.” As discussed above, the Petition proposes its own construction of the term “with respect to a route path” as “in relation to a predetermined path.”⁵ The Petition fails to establish that Smith discloses the user’s location with respect to a predetermined path.

The Petition points to determining “the horses geographical position within the racing boundary” and “displaying the position of the horses on the racetrack.” Petition at 34. This does not establish that Smith discloses an indication with respect to a predetermined route path. For example, the cited section simply discuss showing a location in a track. This does not show the location with respect to a route. For example, it does not show (a) the direction of travel, (b) the number of times the horse will traverse the track, or (c) the actual path the horse will travel, e.g., the horse may not follow a straight line. All of these are required to show location with respect to a “predetermined” path. Thus, Smith does not expressly or inherently disclose showing displaying a location with respect to a predetermined path as is required by the Petition’s proposed construction. Thus, for this

⁵ Patent Owner does not agree that this is the correct construction.

additional reason the Petition has not established that Smith anticipates claims 1 and 11.

VI. THE PETITION FAILS TO MEET ITS BURDEN.

A. The Petition Lacks Claim Charts.

The Petition improperly fails to use claim charts. The Petition includes the claim language only in headings, and even then, includes the actual language recited by only three of the six challenged claims. The Trial Practice Guide notes, “claim charts can streamline the process of identifying key features of a claim and comparing those features with specific evidence.” 77 Fed. Reg. Vol. 157 (August 14, 2012) 78464. Thus, while not required, claim charts are helpful to clarify how the cited references map to the challenged claims. The lack of claim charts confuses the Petition and glosses over elements that, as discussed above, are not found in the cited references. This cannot meet Petitioner’s burden of showing a reasonable likelihood of success.

The deficiencies noted above result in a confusing Petition that does not clearly articulate each ground of rejection. Instead of presenting cogent and organized analysis of the prior art and claim elements, the Petition instead leaves it to the Board to divine how the prior art should be applied to each claim limitation. This is improper. The Board has denied other Petitions in which the Petitioner did not “explain how the cited portions correspond to the limitations for which they are

cited.” *Printing Indus. of Am. v. CTP Innovations, LLC*, IPR2013-00474, Paper 16, 2013 WL 8595751, at 6 (P.T.A.B. Dec. 31, 2013). Similarly, the Board has required that the Petitioner provide an argument for matching each cited portion of a reference to a limitation of the challenged claim. *See, e.g., Fontaine Engineered Products, Inc. v. Raildecks (2009), Inc.*, IPR2013-00360, Paper 9, 2013 WL 8595308 (P.T.A.B. Dec. 13, 2013). The Petition fails on each of these accounts. Thus, the Petition should be denied.

B. The Petition Includes Improper Cumulative Arguments.

The Petition includes three grounds for rejection. These grounds are cumulative of each other. Each ground addresses the exact same claims. Nowhere does the Petition explain why the Board should institute on all of these grounds. Nor does the Petition explain why each of these grounds is not cumulative of the others.

The Board may deny institution on redundant grounds “to secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b). “[N]umerous redundant grounds would place a significant burden on the Patent Owner and the Board, and would cause unnecessary delays.” *Liberty Mut.*, CBM2012-00003, Paper 7, at 2 (P.T.A.B. Oct. 25, 2012). “[M]ultiple grounds, which are presented in a redundant manner by a petitioner who makes no

meaningful distinction between them, are contrary to the regulatory and statutory mandates, and therefore are not all entitled to consideration.” *Id.*

Petitioner bears the burden to show that its grounds for rejection are not cumulative. *Liberty Mut. Ins. Co. v. Progressive Cas. Ins. Co.*, CBM2012-00003, Paper 7, at 2-3 (P.T.A.B. Oct. 25, 2012). Yet, the Petition does not even attempt to make such a showing. Therefore, trial should not be instituted for two of the challenges on the basis of Petitioner’s failure to show that these challenges are not redundant.

The Board has identified two types of redundancy: horizontal and vertical. The Petition suffers from at least horizontal redundancy. Horizontal redundancy “involves a plurality of prior art references applied not in combination to complement each other but as distinct and separate alternatives.” *Id.* at 3. Horizontal redundancy exists when multiple references “provide essentially the same teaching to meet the same claim limitation, and the associated arguments do not explain why one reference more closely satisfies the claim limitation at issue in some respects than another reference, **and** vice versa.” *Id.* (emphasis in original).

If the Board declines to deny the Petition as a whole on this basis, the Board should, at a minimum, deny all grounds that are found to be cumulative.

VII. CONCLUSION

For the foregoing reasons Patent Owner respectfully asserts that Petitioner has not established a reasonable likelihood of success and therefore requests denial of institution on the requested grounds.

By:  Dated: May 20, 2015

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this Preliminary Response and Exhibit 2001 were served via email on the date below, upon the following:

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