

Filed on behalf of TRACBEAM, LLC

By: Sean Luner
DOVEL & LUNER, LLP
201 Santa Monica Blvd, Suite 600
Santa Monica, CA 90401
Telephone (310) 656-7066
sean@dovel.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

T-MOBILE US, INC., T-MOBILE USA, INC.,
TELECOMMUNICATION SYSTEMS, INC., ERICSSON INC., and
TELEFONAKTIEBOLAGET LM ERICSSON
Petitioners,

v.

TRACBEAM, LLC,
Patent Owner

Case No. IPR2015-01713
Patent 8,032,153

**PATENT OWNER'S PRELIMINARY RESPONSE TO THE PETITION
FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 8,032,153 UNDER 35
U.S.C. § 313 PURSUANT TO 37 C.F.R. § 42.107**

Table of Contents

I.	Introduction.....	1
II.	The Petitioners fail to satisfy their burden of demonstrating that the challenged claims are unpatentable.	1
A.	Petitioners’ burden.	1
B.	Petitioners fail to satisfy their burden for each claim.	6
	1. Claim 1.....	6
	2. Claims 3 and 15.....	10
III.	Conclusion.	11

Table of Authorities

Cases

<i>Apple Inc. v. ContentGuard Holdings</i> , IPR2015-00440, Paper 11 (July 13, 2015)	1
<i>Billy Goat Industries, Inc., v. Schiller Grounds Care, Inc.</i> , IPR2014-00742, Paper 8 (November 7, 2014)	5
<i>CallCopy, Inc. v. Verint Americas, Inc.</i> , IPR2013-00492, Paper 14 (Feb. 5, 2014)	11
<i>Christie Medical Holdings, Inc. v. The Research Foundation of The City College of New York</i> , IPR2015-00213, Paper 19 (September 18, 2015)	4
<i>Cisco Systems, Inc. v. C-Cation Technologies, LLC</i> , IPR2014-00454, Paper 12 (August 29, 2014)	4, 9
<i>Kloster Speedsteel AB v. Crucible, Inc.</i> , 793 F.2d 1565 (Fed. Cir. 1986)	3
<i>Liberty Mutual Insurance Co. v. Progressive Casualty Insurance Co.</i> , CBM-2012-00003, Paper 8 (Oct. 25, 2012)	5
<i>Synopsys, Inc. v. Mentor Graphics Corp.</i> , IPR2012-00041, Paper 16 (Feb. 22, 2013)	2, 3, 5
<i>Universal Remote Control, Inc. v. Universal Electronics, Inc.</i> , IPR2013-00152 Paper 8 (August 19, 2013)	3
<i>Whole Space Industries Ltd. v. Zipshade Industrial (B.V.I.) Corp.</i> , IPR2015-00488, Paper 14 (July 24, 2015)	4, 6
<i>Wowza Media Systems, LLC and Coffee Cup Partners, Inc. v. Adobe Systems, Inc.</i> , IPR2013-00054, Paper 16 (July 13, 2013)	2

Statutes

35 U.S.C. § 312	1, 2, 5, 6
-----------------------	------------

Regulations

37 C.F.R. § 42.104	passim
37 C.F.R. § 42.22	2, 4, 6, 9

I. Introduction.

In this Petition for *Inter Partes* Review, the Petitioners assert that claims 1, 3, and 15 of the ‘153 patent are obvious based on Loomis. The Petition fails to demonstrate that each claim element is found in or rendered obvious by Loomis. Accordingly, the Petition should be denied as to all claims.¹

II. The Petitioners fail to satisfy their burden of demonstrating that the challenged claims are unpatentable.

A. Petitioners’ burden.

The controlling statute requires that a petition for *inter partes* review “identif[y]...with particularity...the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3)²; *Apple Inc. v. ContentGuard Holdings*, IPR2015-00440, Paper 11 at 5-6 (July 13, 2015) (“a petition for inter

¹ The Petition also challenges claims 16, 20, 21, 23, 27, and 29. These claims are no longer asserted in the co-pending litigation against T-Mobile and the Petitioners agreed to file a *Joint Motion to Limit Petition* under 37 C.F.R. § 42.71 to remove these claims from this proceeding.

² Emphasis added unless otherwise noted.

partes review must ‘identif[y], in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.’”) (*quoting* 35 U.S.C. § 312(a)(3)).

The corresponding regulation requires that a petition include a “detailed explanation of the significance of the evidence.” 37 C.F.R. § 42.22(a)(2); *Synopsys, Inc. v. Mentor Graphics Corp.*, IPR2012-00041, Paper 16 at 14 (Feb. 22, 2013) (“Per 37 C.F.R. § 42.22(a), each petition must include ... a detailed explanation of the significance of the evidence.”).

To satisfy these requirements, a petition must, for each challenged claim, “identify... [h]ow the construed claim is unpatentable” (37 C.F.R. § 42.104(b)(4)) and “specify where each element of the claim is found in the prior art patents or printed publications relied upon.” 37 C.F.R. § 42.104(b)(4). “[F]ailure to point out where each element is found in the prior art is a deficiency in the substantive requirements of the petition,” which warrants denial under Section 42.104(b)(4). *Wowza Media Systems, LLC and Coffee Cup Partners, Inc. v. Adobe Systems, Inc.*, IPR2013-00054, Paper 16 at 3 (July 13, 2013).

In addition, a Petition must, for each challenged claim, also identify: “the relevance of the evidence to the challenge raised, including identifying specific portions of the evidence that support the challenge.” 37 C.F.R. § 42.104(b)(5). “In

accordance with 37 C.F.R. § 104 (b)(5), the relevance of the evidence supporting the challenge must be provided including identification of specific portions of the evidence that support the challenge.” *Synopsys, Inc. v. Mentor Graphics Corp.*, IPR2012-00041, Paper 16 at 12, 14 (Feb. 22, 2013) (finding that “Petitioner’s conclusory statements, without more detail, fail to satisfy” 37 C.F.R. §§ 42.104(b)(4) and 42.104(b)(5), among other requirements).

Based on the controlling statute and regulations set forth above, to satisfy its burden, a petition must:

- (1) address “each element” of each challenged claim (37 C.F.R. § 42.104(b)(4))—if a ground fails to address even a single claim element, the Petition must be denied as to that ground. *See Universal Remote Control, Inc. v. Universal Electronics, Inc.*, IPR2013-00152 Paper 8 at 17 (August 19, 2013) (“‘[A]bsence from the reference of any claimed element negates anticipation.’ *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986) (citation omitted), *overruled on other grounds by Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337 (Fed. Cir. 2004). Petitioner has failed to identify any disclosure ... that meets all the requirements of claim 1.”).

- (2) provide a “detailed explanation of the significance of the evidence” (37 C.F.R. § 42.22(a)(2) and “the relevance of the evidence” (37 C.F.R. § 42.104(b)(5)) rather than conclusory assertions as to how each element is found in the reference. *Cisco Systems, Inc. v. C-Cation Technologies, LLC*, IPR2014-00454, Paper 12 at 11 (August 29, 2014) (“The Petition before us does not... include a detailed explanation of the significance of the quotations and citations from the applied references.”) (*citing* 37 C.F.R. §§ 42.104(b)(4)), 42.22(a)(2)); *Christie Medical Holdings, Inc. v. The Research Foundation of The City College of New York*, IPR2015-00213, Paper 19 at 7 (September 18, 2015) (“We found Petitioner’s argument conclusory, lacking sufficient explanation for how the cited evidence... support the anticipation of the challenged claims.”). “As explained in the Office Patent Trial Practice Guide, parties requesting *inter partes* review should ‘...focus on concise, well-organized, easy-to-follow arguments supported by readily identifiable evidence of record.’” *Whole Space Industries Ltd. v. Zipshade Industrial (B.V.I.) Corp.*, IPR2015-00488, Paper 14 at 9 (July 24, 2015) (*quoting* 77 Fed. Reg. 48,756, 48,763 (Aug. 14, 2012)).

(3) point “with particularity” (35 U.S.C. § 312(a)(3)) to specific language in the reference that anticipates each element—a petition must “identify[] specific portions of the evidence” (37 C.F.R. § 42.104(b)(5)) rather than block cite multiple paragraphs or pages from a reference. “Because the petition does not clearly point to specific language in [a reference] that anticipates each element of [the challenged claims], we decline to institute an *inter partes* review on the basis of anticipation by [the reference].” *Synopsys, Inc. v. Mentor Graphics Corp.*, IPR2012-00041, Paper 16 at 16 (Feb. 22, 2013).

A Petition should be denied if the Petition forces the Patent Owner and the Board to piece together the evidence to attempt to establish Petitioner’s ground:

It is Petitioner’s responsibility to explain specific evidence that supports its arguments, not the Board’s responsibility to search the record and piece together what may support Petitioner’s arguments.

Billy Goat Industries, Inc., v. Schiller Grounds Care, Inc., IPR2014-00742, Paper 8 at 28 n. 4 (November 7, 2014).

[W]e will address only the basis, rationale, and reasoning put forth by the Petitioner in the petition, and resolve all vagueness and ambiguity in Petitioner’s arguments against the Petitioner.

Liberty Mutual Insurance Co. v. Progressive Casualty Insurance Co., CBM-2012-00003, Paper 8 at 10 (Oct. 25, 2012).

The Petition improperly shifts the burden of deciphering Petitioner's arguments onto Patent Owner and the Board, which, as we discussed above, is contrary to the statutory and regulatory provisions governing *inter partes* review proceedings, as well as the best practices outlined in the Office Patent Trial Practice Guide.

Whole Space Industries Ltd. v. Zipshade Industrial (B.V.I.) Corp., IPR2015-00488, Paper 14 at 18 (July 24, 2015) (*citing* § 35 U.S.C. § 312(a)(3); 37 C.F.R. §§ 42.22(a)(2), 42.104(b)(4)–(5)).

Here, the Petitioners fail to satisfy this burden for each challenged claim. Each claim is addressed in turn.

B. Petitioners fail to satisfy their burden for each claim.

1. Claim 1.

Petitioners assert that Loomis alone renders independent claim 1 obvious. Petitioners' analysis of Loomis contains several errors and omissions. Many of the errors and omissions cannot be demonstrated with sufficient clarity at this stage in the proceeding, as they would require deposition testimony to unravel. However, because the Petition clearly fails to meet its burden as to claim element 1.6 (using the label the Petition uses), the Petition should be denied.

Claim element 1.6 requires:

(b) for estimating a likely geographical approximation, GA_B , for a location, L_B , of a third one of the wireless mobile stations at a time T_B , said second mobile station location estimator generates GA_B without requiring a prior likely geographical location approximation generated by said first mobile station location estimator for locating the third wireless mobile station at the location L_B at substantially the time T_B .

‘153, col. 169:32-39.

Petitioners assert that:

- the GPS technique (*i.e.*, the outdoor technique) is the first mobile station location estimator, Pet. at 31;
- the radio technique is the second mobile station location estimator, *id.* at 32;
- the “GPS location information” is the first information related to likely geographical approximations for a location, *id.* at 32; and
- the “radio location information” is the second information related to likely geographical approximations for a location. Pet. at 33.

Thus, to satisfy their burden for claim element 1.6, Petitioner must demonstrate that Loomis discloses that the radio technique generates the radio location information without requiring prior GPS location information generated by the GPS technique. *See* Pet. at 39 (“the claim indicates that the ‘second mobile station location estimator’ does not use a geographical approximation from any

other location estimator in order to locate the wireless mobile station” (internal parentheticals omitted)). The Petition does not satisfy its burden.

The Petition asserts that this element is met because the “second mobile station location estimator”—*i.e.*, the radio technique—“operates independently from any other mobile station location estimator [i.e. the GPS technique] to generate its own geographical approximation.” *Id.* The Petition’s analysis fails because there is no support in Loomis for Petitioners’ assertion that the radio technique “operates independently” from the GPS technique to generate its own location estimate.

The Petition cites Loomis at 5:7-9 and 7:41-44, but neither cited passage supports Petitioners’ assertion. Both passages state that the outdoor LD (which is used for the GPS technique) operates independently of the radio LD system (Petitioner’s “second mobile station location estimator”). But these passages do not state the converse: that the radio LD system (Petitioner’s “second mobile station location estimator”) operates independently of the GPS technique. That is what Loomis would need to disclose to support Petitioners’ assertion.

In addition, that the outdoor LD system operates independently of the radio LD system does not disclose or even suggest that the converse is true. As an analogy, the weather operates independently of how many people are having picnic in the park. But the number of people having a picnic in the park can and does

depend on the weather. Therefore, Petitioner' citations to these passages from Loomis do not satisfy Petitioners' burden of demonstrating that Loomis discloses element 1.6. "The Petition before us does not ... specify sufficiently where each element of [claim element 1.6] is found in the applied references." *Cisco Systems, Inc. v. C-Cation Technologies, LLC*, IPR2014-00454, Paper 12 at 11 (August 29, 2014) (*citing* 37 C.F.R. §§ 42.104(b)(4) and 42.22(a)(2)).

Moreover, Petitioners' analysis fails because the radio technique in Loomis does depend on the location estimate by the GPS technique. As Petitioners acknowledge, the radio technique relies on signal phase measurements to operate: "Loomis' radio technique calculates the location of a hybrid LD device (i.e., a mobile station) using signal phase measurements." Pet. at 17; Loomis col., 6:52-55. These signal phase measurements in turn depend on the location estimate determined by the outdoor LD (GPS) module:

- "The outdoor LD unit 31 determines the (approximate) location of itself and of the adjacent radio LD unit 13 and uses this information in determining the relative phases of the radio LD signals transmitted by the sources 21, 23 and 25," Loomis 7:31-35;
- Fig. 9 ("Outdoor LD Unit Determines Its Location and Relative Phases of Radio LD Signals").

Therefore, the radio technique relies on the location estimate determined by the outdoor LD module. This is important because the location estimate from the outdoor LD module is the “prior likely geographical location approximation generated by said first mobile station location estimator” relied upon by the Petition. The Petition asserts that (1) the outdoor LD module uses the GPS technique (Pet. at 27), (2) the GPS technique is the “first mobile station location estimator” (Pet. at 31), and (3) the location estimate from the technique is the “geographical location approximation.” Pet. at 33. Accordingly, that the radio technique relies upon location estimates from the outdoor LD module means that the technique and its output depend on a prior likely geographical location approximation generated by said first mobile station location estimator. Loomis therefore not only fails to disclose but teaches away from claim element 1.6’s requirement that the “second mobile station location estimator generate[] GA_B without requiring a prior likely geographical location approximation generated by said first mobile station location estimator.”

2. Claims 3 and 15.

Claims 3 and 15 depend on claim 1. Because, as demonstrated above, Petitioners failed to carry their burden under 37 C.F.R. Section 42.104(b)(4) on claim 1, the Petition also fails as to claims 3 and 15 that depend on claim 1.

CallCopy, Inc. v. Verint Americas, Inc., IPR2013-00492, Paper 14 at 7 (Feb. 5, 2014) (“Because the grounds asserted against the dependent claims suffer from the defects of the grounds asserted against the independent claims, [the Board] need[ed] to address only the grounds asserted against independent claims.”). Accordingly, the Petition should also be denied as to dependent claims 3 and 15, for the same reasons the Petition should be denied as to base claim 1.

III. Conclusion.

For the reasons explained above, Petitioners fail to satisfy their burden. Therefore, the Petition should be denied.

Respectfully submitted,

Date: November 16, 2015

By: /Sean Luner/
Sean Luner, Esq.
Registration No. 36,588
DOVEL & LUNER, LLP.
201 Santa Monica Blvd, Suite 600
Santa Monica, CA 90401
Main Telephone (310) 656-7066
sean@dovel.com
Counsel for Patent Owner

Certificate of Filing and Service

I hereby certify that a true and correct copy of the foregoing **PATENT OWNER'S PRELIMINARY RESPONSE TO THE PETITION FOR INTER PARTES REVIEW UNDER 35 U.S.C. § 313 PURSUANT TO 37 C.F.R. §**

42.107 is being filed via PRPS and served by electronic mail this 16th day of

November 2015 on counsel for Petitioners as follows:

Brian W. Oaks
BAKER BOTTS, LLP,
98 San Jacinto Blvd., Suite 1500
Austin, TX 78701
Telephone (512) 322-5470
Facsimile (512) 322-3621
brian.oaks@bakerbotts.com

Douglas M. Kubehl
BAKER BOTTS, LLP,
2001 Ross Avenue
Dallas, TX 75201
Telephone (214) 953-6486
Facsimile (214) 661-4486
doug.kubehl@bakerbotts.com

Chad C. Walters
BAKER BOTTS, LLP,
2001 Ross Avenue
Dallas, TX 75201
Telephone (214) 953-6511
Facsimile (214) 661-4511
chad.walters@bakerbotts.com

Ross G. Culpepper
BAKER BOTTS, LLP,
2001 Ross Avenue
Dallas, TX 75201

Telephone (214) 953-6543
Facsimile (214) 661-4543
ross.culpepper@bakerbotts.com

Date: November 16, 2015

/Sean Luner/
Sean Luner, Esq.
Registration No. 36,588
DOVEL AND LUNER
201 Santa Monica Blvd, Suite 600
Santa Monica, CA 90401
Main Telephone (310) 656-7066
sean@dovel.com
Counsel for Patent Owner