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SILVER STATE INTELLECTUAL TECHNOLOGIES, INC.

IN THE UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

OAKLAND DIVISION

SILVER STATE INTELLECTUAL TECHNOLOGIES, INC., a Nevada corporation, Plaintiff, v. FACEBOOK, INC., a Delaware corporation, Defendant.	Civil Action No. 4:17-cv-03349-JSW **PLAINTIFF SILVER STATE INTELLECTUAL TECHNOLOGIES, INC.'S OPENING BRIEF ON CLAIM CONSTRUCTION** Date: TBD Time: TBD Courtroom: 5 – 2nd Floor Judge: Hon. Jeffrey S. White

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I. INTRODUCTION

The asserted patents are directed to new and useful systems and methods that operate in a networked environment to acquire and share data related to the locations of people with mobile communication devices, such as smartphones. There are three disputed claim terms from the patents: (1) "associating a mobile communication device with the user," (2) "providing the data indicative of the location of the user," and (3) "data related to a proximity of the location of the mobile communication device."

Facebook contends that the first and third terms are indefinite to a person of ordinary skill in the art. They are not. Facebook's perception of ambiguity is based on the appearance of "associating" in the first claim term and "proximity" in the third claim term. Both are simple words that are used within the patent with their ordinary meanings. They are readily understandable to a person of ordinary skill in the art, and they were interpreted with no difficulty by the Patent Examiner. Indeed, Facebook uses these terms regularly in its own patent claims.

Facebook contends that "providing the data indicative of the location of the user" should be interpreted to mean "sending the data indicative of the location of the user." Facebook's proposal replaces the term "providing" with the narrower term "sending." Silver State proposes that the term should be interpreted to have its plain and ordinary meaning, which is broader than Facebook's proposed modification because it encompasses *all manners of providing* the data, not only the *sending* of the data. Facebook's narrow construction is not taught by the patent specification, claims, or file history. As is common in claim construction disputes, Defendant Facebook is seeking to redefine the ordinary meaning of the claim terms in order to narrow the proper scope of the claims and thereby attempt to escape infringement.

Silver State's positions are supported by a Declaration of Craig S. Rosenberg, Ph.D., its technical expert, who has provided opinions for the Court's consideration. A copy of Dr. Rosenberg's curriculum vitae is attached to his declaration as Exhibit A. Silver State also provides documentary evidence for the Court's consideration attached as Exhibits 1–22 to the Declaration of David G. Jankowski, filed concurrently herewith.

II. SUMMARY OF THE INTRINSIC RECORD

Copies of U.S. Patent Nos. 7,343,165 ("the '165 patent") and 8,892,117 ("the '117 patent") are attached as **Exhibits 1 & 2**, respectively. Each is titled "GPS Publication Application Server." Silver State asserts that Facebook infringes Claim 1 of the '165 patent and Claims 1–9, 11–13, and 15–22 of the '117 patent.

A. The Patent Specification

The '165 patent is based on a utility patent application converted from a provisional application filed in April 2000. (Ex. 1, 1:6–9.) The '117 patent is based on a continuation application. (Ex. 2, 1:6–10.) The two patents share a common specification, except that the latter has formalized figures.

1. Background

At the time of the invention, mobile communication devices such as cell phones had been developed that allowed a person to speak with others remotely even when the person had no access to landline telephones. The inventor recognized the difficulty a cell phone user on the go faced in obtaining and sharing with others reliable information on their location and surroundings. One difficulty derives from the fact the user may not know their location or the businesses and resources around them. (Ex. 1, 1:35–37.) Another difficulty is that the user may be indisposed or otherwise unable to speak on their cell phone with others with whom they would like to share such information. (*Id.*, 1:41–44.) The mobile devices at that time worked well for voice communications, but they could not readily access information sources that were then becoming available on the Internet:

> [I]ndividuals on the move often have unique information requirements, particularly with respect to information concerning places near their location. Such needs are also not fully met by mobile communication systems, even though such information is generally available on communication networks. For example, server computers reachable through the internet are commonly provide nearly boundless information, with much of the information having geographical relevance. Such information is often largely unavailable to users of mobile communication systems, and moreover is not particularly adapted to suit the needs of users of mobile communication systems.

(*Id.*, 1:51–62.) (*See also* Rosenberg Decl. ¶ 13.) The patents address these shortcomings.

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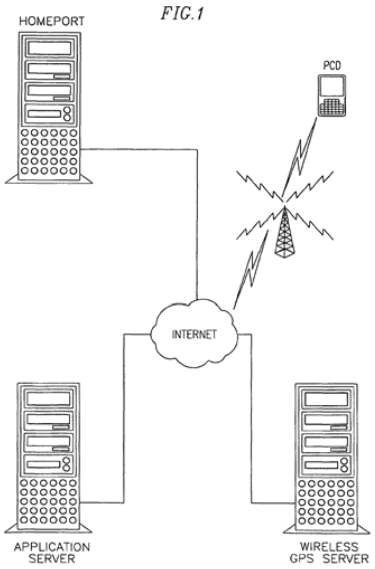
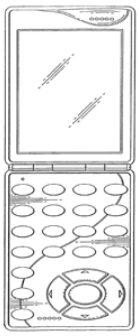
2. Detailed Description

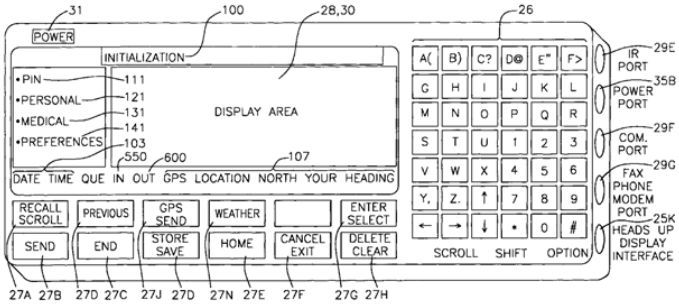
The Detailed Description describes a number of preferred embodiments of the claimed inventions. As part of the description, the specification incorporates by reference three additional patents: U.S. Patent No. 5,663,734, titled "GPS Receiver and Method for Processing GPS Signals," (*id*., 3:55–59); Ser. No. 09/126,936, now U.S. Patent No. 6,133,853, titled "Personal Communication and Positioning System," (*id*., 4:36–39); and U.S. Patent No. 6,148,261 (the "'261 patent"), titled "Personal Communication System to Send and Receive Voice Data Positioning Information," (*see* Ex. 1, 3:11–15 and 3:40–43). These three patents are attached as **Exhibits 3, 4 & 5**, respectively.

The Detailed Description describes systems and methods for tracking the location of a user's mobile communication device and providing location-relevant information to persons to whom the user has granted access privileges. The systems and methods can be used by users of mobile devices, such as cellphones, in communication with a computer server, such as via a cellular network or the Internet. (Ex. 1, 1:45–53.) Shown below is an example system in which the inventions can be practiced.



(Ex. 2 at Fig. 1; Rosenberg Decl. ¶ 15.) The "PCD" is a "personal communication device." (Ex. 1, 3:38.) Examples of PCDs are shown below.

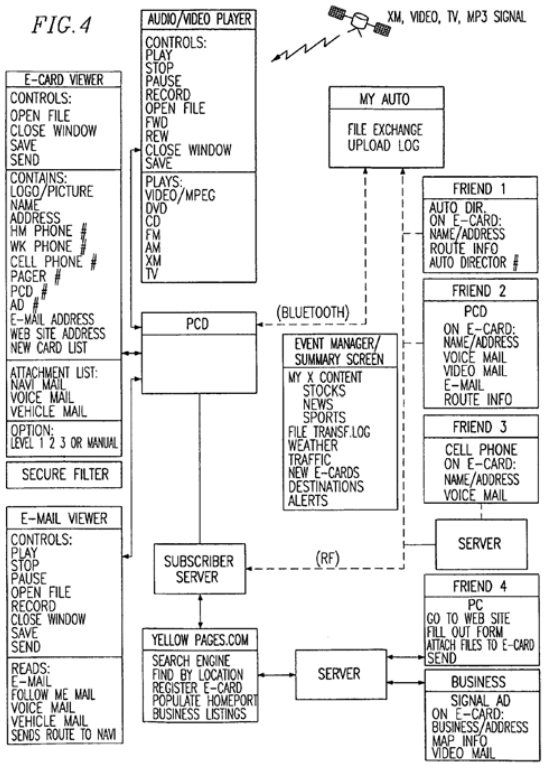




Ex. 2 ('117 patent) at Fig. 5 **Ex. 5 ('261 patent) at Fig. 2**

(Rosenberg Decl. ¶ 16.)

The PCD is equipped with a GPS receiver and wireless capability. (Ex. 1, 3:38–40.) The '261 patent describes the features of an example PCD. (Ex. 5, 7:24–16:53.) An example function flow diagram for the PCD is shown below.



(Ex. 2 at Fig. 4; Rosenberg Decl. ¶ 17.)

The location of a PCD can be determined using GPS signals provided to the device, and the location and location-relevant information can be stored in a space on a server that is

specific to the user. (Ex. 1, 2:8–20.) The information can be shared with others authorized by the user to have access privileges. (*Id.*, 2:21–25, 37–39; Rosenberg Decl. ¶ 18.)

B. The Patent Claims

Representative Claim 1 from each of the asserted patents is reproduced below with the disputed claim terms highlighted. For the Court's convenience, **Exhibit 6** presents all of the asserted claims with the disputed terms highlighted.

1. Exemplary Claim 1 of the '165 Patent

1. A method of providing contact information regarding a user, the method comprising:

allocating a user-specific space in memory accessible over a computer network to a specific user;

associating a mobile communication device with the user;

determining a geographic location of the user by receiving location information provided by a mobile communication device;

storing data indicative of the location of the user in the user-specific space;

receiving, from the user, additional data regarding the user, the additional data being related to the geographic location of the user;

storing the additional data regarding the user in the user-specific space;

receiving from the user an access list of possible requesters of the data and the additional data;

storing the access list of possible requesters of the data and the additional data in the user-specific space; and

providing the data indicative of the location of the user and the additional data regarding the user to possible requesters on the access list.

(Ex. 1, 7:21–42 (emphasis added).)

2. Exemplary Claim 1 of the '117 Patent

Claim 1 of the '117 patent is set forth below with the one disputed claim term from the claim highlighted.

> 1. A location relevant server system comprising:
>
> a server receiving information indicating a location of a mobile communication device, and ***data related to a proximity of the location of the mobile communication device***, the server being connected to a network;
>
> memory accessible to the server, the memory storing information relating to a user of the mobile communication device, the memory including data concerning the location of the mobile communication device, personalized data regarding points of interest to the user of the mobile communication device, and data concerning establishment of communication with the mobile communication device; and
>
> wherein the server executes a program allowing access to the memory storing the information relating to the user of the mobile communication device, the program allowing different people different access to the memory based on the identity of the user.

(Ex. 2, 7:12–29 (emphasis added).)

C. <u>The Prosecution Histories</u>

Each of the patents underwent an extensive and rigorous examination by the U.S. Patent and Trademark Office ("PTO"). Copies of excerpts from the prosecution histories of the '165 and '117 patents are attached as **Exhibits 21 & 22**, respectively.

The '165 patent issued on March 11, 2008, from an application filed on April 11, 2001. In May 2004, the PTO mailed a first Office Action rejecting the pending claims. (Ex. 21 at 1–13.) Applicant responded and amended its claims. (*Id*. at 14–25.) In December 2004, the PTO mailed a second Office Action rejecting the pending claims. (*Id*. at 26–35.) Applicant responded and amended its claims. (*Id*. at 36–45.) In June 2005, the PTO mailed a third Office Action rejecting the pending claims. (*Id*. at 46–55.) Applicant filed a Request For Continued Examination ("RCE") and amended its claims. (*Id*. at 56–68.) In January 2006, the PTO mailed a fourth Office Action rejecting the pending claims. (*Id*. at 69–77.)

Applicant responded and amended its claims. (*Id*. at 78–86.) In July 2006, the PTO mailed a fifth Office Action rejecting the pending claims. (*Id*. at 87–95.) Applicant filed another RCE and amended its claims. (*Id*. at 96–112.) In February 2007, the PTO mailed a sixth Office Action rejecting the pending claims. (*Id*. at 113–120.) Applicant responded and amended its claims. (*Id*. at 121–131.) In October 2007, the PTO mailed a Notice of Allowance. (*Id*. at 132–137.)

The '117 patent issued on November 18, 2014, from a continuation application filed on March 10, 2008, one day before the issuance of the '165 patent. In April 2010, the PTO mailed a first Office Action rejecting the pending claims. (Ex. 22 at 1–9.) Applicant responded and amended its claims. (*Id*. at 10–16.) In December 2010, the PTO mailed a second Office Action rejecting the pending claims. (*Id*. at 17–30.) Applicant responded by filing an RCE and amending its claims. (*Id*. at 31–40.) In May 2013, the PTO mailed a third Office Action rejecting the pending claims. (*Id*. at 41–49.) Applicant responded and amended its claims. (*Id*. at 50–61.) In November 2013, the PTO mailed a Notice of Allowance for the pending claims. (*Id*. at 62–68.) Applicant filed an RCE to allow the PTO to consider additional prior art. (*Id*. at 69–70.) In March 2014, the PTO mailed a second Notice of Allowance. (*Id*. at 71–75.) Applicant again filed an RCE to allow consideration of additional prior art. (*Id*. at 76–77.) In June 2014, the PTO mailed a third Notice of Allowance. (*Id*. at 78–82.) Applicant again filed an RCE to allow consideration of additional prior art. (*Id*. at 83–84.) In October 2014, the PTO mailed a final Notice of Allowance. (*Id*. at 85–89.)

III. LEGAL STANDARD FOR CLAIM CONSTRUCTION

Claim construction is a question of law. *Markman v. Westview Instruments*, 517 U.S. 370, 388 (1996). Terms are to be given their ordinary and customary meaning to a person of ordinary skill in the art. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (*en banc*). The ordinary meaning of a claim term is assessed "in the context of the entire patent, including the specification." *Phillips*, 415 F.3d at 1313. The specification provides context for understanding the meaning to those skilled in the art. *CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d 1225, 1231 (Fed. Cir. 2005). But claims are not ordinarily limited to the

embodimentsdescribed in the specification. *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1370 (Fed. Cir. 2008); *Callicrate v. Wadsworth Mfg., Inc.*, 427 F.3d 1361, 1368 (Fed. Cir. 2005).

Claim construction also requires consideration of the patent's prosecution history, which provides "the complete record of the proceedings before the PTO and includes the prior art cited during the examination of the patent." *Phillips*, 415 F.3d at 1317. The file history provides evidence of how the PTO and the inventor understood the patent, however, "it often lacks the clarity of the specification and thus is less useful for claim construction purposes." *Id.*

The claims, specification, and prosecution history are known as "intrinsic" evidence, which is more useful than other evidence, labeled "extrinsic" evidence. Courts have discretion to rely on extrinsic evidence, such as expert testimony and technical treatises, to determine the customary meaning of a term. *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1216 (Fed. Cir. 1995). While extrinsic evidence may be useful to provide background, a court should disregard extrinsic evidence at odds with the intrinsic record. *Phillips*, 415 F.3d at 1317.

Two exceptions to the general rule that claims are to be given their ordinary meaning are: (1) when a patentee sets out a definition and acts as his own lexicographer, and (2) when the patentee disavows the full scope of a claim term either in the specification or during prosecution. *Thorner v. Sony Computer Entm't Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012). "To act as its own lexicographer, a patentee must 'clearly set forth a definition of the disputed claim term' other than its ordinary meaning." *Id.* at 1365 (quoting *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002)). A patentee must "clearly express an intent" to redefine the term. *Id.*

"The construction of claims is simply a way of elaborating the normally terse claim language in order to understand and explain, but not to change, the scope of the claims." *Embrex, Inc. v. Serv. Eng'g Corp.*, 216 F.3d 1343, 1347 (Fed. Cir. 2000) (internal quotations omitted). In many instances, however, elaboration is neither necessary nor helpful. Claim construction "is not an obligatory exercise in redundancy" and where the claim language is

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clear, the Court need not "repeat or restate every claim term." *U.S. Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554, 1568 (Fed. Cir. 1997).

The assessment of claim definiteness is a question of law performed by the Court as part of its duty as the construer of patent claims. *Personalized Media Commc'ns, LLC v. Int'l Trade Comm'n*, 161 F.3d 696, 705 (Fed. Cir. 1998). The standard for definiteness is whether "a patent's claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty." *Nautilus, Inc. v. Biosig Instruments, Inc*., 134 S. Ct. 2120, 2129, 189 L. Ed. 2d 37 (2014). Facts supporting indefiniteness must be proven by clear and convincing evidence. *Intel Corp. v. VIA Techs*., 319 F.3d 1357, 1366 (Fed. Cir. 2003).

IV. THE THREE CLAIM TERMS FOR THE COURT TO ADDRESS

A. "Associating A Mobile Communication Device With The User" Is Not Indefinite

Facebook contends that the phrase "associating a mobile communication device with the user" in Claim 1 of the '165 patent is indefinite because it "uses generic, high-level functional language that does not clearly define the outer bounds of the claim scope." (**Exhibit 20** (Facebook Invalidity Contentions) at 73:10–11.) Facebook is not asserting that "mobile communication device" by itself is ambiguous, and that term appears in claims of the '117 patent not challenged as indefinite. Likewise, Facebook is not asserting that "user" by itself is ambiguous, and "user" appears in claims of the '117 patent not challenged as indefinite. The ambiguity perceived by Facebook derives only from the entirety of the phrase, the act of "associating" a "mobile communication device" with the "user." As discussed below, the claim term describes the scope of the claim with reasonable certainty, and Facebook's assertion of ambiguity has no merit.

1. Consideration of the Intrinsic Record

The '165 patent specification uses the term "associating" with its plain and ordinary meaning: relationally connecting two things. For example, the specification discloses an embodiment that includes an electronic card, or "e-card," that stores user-specific information, such as a name, address, and phone number. (Ex. 1, 4:18–26; Fig. 2.) The

specification refers to "the individual ***associated*** with the e-card." (*Id*., 4:32–33.) The term *associated* is used with its ordinary meaning: relationally connected. In this case, the specification uses the term to refer to the relational connection between the individual and his or her e-card.

The specification also discloses an embodiment that includes a GPS server that performs certain functions, including communicating with users' personal communication devices. (Ex. 1, 4:55–5:3.) The specification states that "[t]he user calls a number ***associated*** with the GPS server to modify or review status or make additional requests and changes with respect to the user-specific space[.]" (*Id*., 4:63–65.) Once again, *associated* is used with its ordinary meaning. Here, the term refers to the relational connection between a phone number and a server that is accessible via that phone number.

The preferred embodiments disclose "associating a mobile communication device with the user" of the device. The specification teaches that the invention is used in connection with a personal computer device 17 (or "PCD"). (*Id*., 3:8–10.) The specification discloses that the PCD is equipped with a GPS receiver and wireless communication capability. (*Id*., 3:38–40.) The very name of the device—*personal* communication device—conveys that it is personal to the user. The features of the device further show its personal nature, including the use of a Personal Identification Number. (Ex. 5 at 9:3–5, 31–33; Fig. 2 (element 111).) The specification refers repeatedly to the invention being used in connection with a PCD, using the PCD acronym 45 times.

The specification refers to a user associated with the mobile communication device. The Summary of the Invention discloses that preferences are received from a user's PCD and stored on a server in storage space that is specific to the user. (Ex. 1, 2:13–17.) It also gives an example of providing advertising information to "a user's device once the user's travel pattern is established and personal preferences are considered." (*Id*., 2:26–28.) The Detailed Description associates a user with a personal device, teaching the use of a PCD "identifying tag" that identifies the PCD and associates it with user-specific data space on a server. (*Id*., 3:62–4:3.) Using this association, "other individuals may also contact the application server

request of the location of the ***PCD device***. This may be accomplished for example, in order to determine how to contact ***the individual using the PCD***." (*Id*., 4:14–17.)

The prosecution history of the '165 patent also shows that the claim term is not indefinite. During PTO examination, if the Patent Examiner determines that the metes and bounds of a pending claim is not clear, the Examiner is to reject the claim as indefinite. *In re Packard*, 751 F.3d 1307, 1310 (Fed. Cir. 2014); *In re Zletz*, 893 F.2d 319, 322 (Fed. Cir. 1989). Here, Applicant presented the claim term to the PTO with its original utility application. During the course of an examination lasting six years, Examiner Lee Nguyen considered the claim term within pending claims on seven separate occasions. (Ex. 21 at 1–13, 26–35, 46–55, 69–77, 87–95, 113–120, 132–137.) During that review, not once did Examiner Nguyen determine the claim term was indefinite.

2. Consideration Of Extrinsic Evidence

It is the expert opinion of Silver State's technical expert, Dr. Craig Rosenberg, that a person of ordinary skill in the art at the time of the invention understood the scope of the claim term with reasonable certainty. (Rosenberg Decl. ¶¶ 21–26.)

Silver State's position is also supported by the dictionary definition of "associate," which is "to connect or bring into relation in thought, feeling, memory, etc." (**Exhibit 7** at 3.) The dictionary definition is consistent with the meaning applied by the asserted patents.

Silver State's position is further supported by Facebook's use of "associating" and variations thereof in its own patents. Examples are attached as **Exhibits 8–13**. Specifically:

- U.S. Patent Nos. 8,787,932 and 8,805,408, titled, "Personalized Location Information For Mobile Devices," each includes a Claim 1 that recites: "determining a geographic location of a mobile device ***associated with*** a user of a system." (Ex. 8, 14:14–15; Ex. 9, 14:14–15.)
- U.S. Patent No. 8,891,832 , titled, "Computer-Vision-Assisted Location Check-In," discloses a social networking system that "determines a location of the user based on location data stored ***in association with*** the matched images in photographic location database." (Ex. 10, 4:16–18.) Claim 1 recites

"automatically ***associating*** the user with a concept node of a social graph representing a social network, the concept node ***being associated with*** the determined location." (*Id.*, 15:27–29.)

- U.S. Patent No. 9,197,999, titled, "Providing A Location Identifier For A Location With Multiple Co-Users," includes a Claim 1 that recites "determining, by the one or more processors, that the geographic locations of at least two mobile devices ***associated with*** two or more co-users are each near a common location." (Ex. 11, 15:60–63.)
- U.S. Patent No. 9,204,255, titled, "Providing A Log Of Location Information For A Mobile Device," discloses a system in which "[e]lectronic content stored ***in association*** with a user is updated automatically with an indication of a location of the user. A mobile device used by the user identifies a location of the mobile device, which is assumed to be the location of the user." (Ex. 12, 3:58–62.) Claim 11 recites "***associating*** the selected representation of the geographic location of the mobile device with the message." (*Id.*, 16:49–50.)
- U.S. Patent No. 9,565,143, titled, "Presence And Geographic Location Notification Based On A Setting," discloses a system in which "the geographic location of a mobile communications device, such as a mobile telephone, ***associated with*** a user is disseminated to others based on a notification setting[.]" (Ex. 13, 5:2–5.) Claim 1 recites "***associating*** the defined subset of multiple users with the selected setting associated with the time slot." (*Id.*, 30:31–33.)

These are merely a sample of the many Facebook patents that use "associating" or variations thereof in patent claims. Facebook has no difficulty understanding the term in its own patents. Indeed, Facebook uses "associating" and variations thereof as claim terms without defining the terms, showing recognition that the terms are understandable to persons of ordinary skill without the need for express definitions.

For the reasons above, the scope of "associating a mobile communication device with the user" is reasonably understood to persons of ordinary skill, and the term is not indefinite.

B. The Meaning Of "Providing The Data Indicative Of The Location Of The User"

Silver State's position	Facebook's position
Plain and ordinary meaning: Providing the data indicative of the location of the user.	Sending the data indicative of the location of the user.

The party positions differ only in that Facebook substitutes the verb "sending" for the claim term "providing." As discussed below, the intrinsic record teaches that "sending" is one way of "providing" data, but it is not the only way. Facebook's proposed construction thus unduly narrows the claim scope and is incorrect. The term "providing" is sufficiently clear and does not require further elaboration. Jurors will be familiar with the ordinary meaning of this common word, and the Court need not construe it. *See, e.g., U.S. Surgical*, 103 F.3d at 1568; *O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1362 (Fed. Cir. 2008) (finding that the Court need not construe simple, unambiguous terms that embrace their ordinary meaning within the context of the patent). If the Court deems it appropriate to construe the claim term, its apply a meaning that encompasses the full scope of "providing" the recited data, and not narrow the claim term to only "sending" the recited data.

1. Consideration Of The Intrinsic Record

The term "providing" is broader than the term "sending." "Providing" is broader because "sending" is one way, but not the only way, of "providing" something. A person can provide their spouse with flowers by sending the flowers to the spouse's location, such as a workplace. But they can also provide their spouse with flowers without sending them, for example by leaving the flowers at home for the spouse to find later. Whether sent or left at home, the person has provided their spouse with a token of affection.

Requests for production in civil litigation provide another example. A party is obligated to provide documents to a propounding party in response to requests for production. The rules of civil procedure allow the party to provide its documents by sending hardcopies or electronic files. The rules also provide that the party can provide its documents without sending them, by making them available for inspection. Whether sent or made available, the party has provided documents in response to the request for production.

As discussed below, the '165 patent uses the terms *providing* and *sending* with these ordinary, disparate meanings.

a. The Patent Specification

The patent specification is "the single best guide to the meaning of a disputed term." *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). The term "providing" in its various word forms appears 44 times in the '165 patent specification, and the patent consistently uses the term with its ordinary, broad meaning. The specification often uses "provide" in a manner that is flatly inconsistent with the narrower concept of "send." Examples include:

- "[C]ommunication systems such as cellular telephones ***provide*** a simple and easy way to communicate with individuals carrying cellular telephones no matter where they are[.]" (Ex. 1, 1:21–24.)
- "[I]n some instances people are unable to answer their cellular telephone to ***provide*** their location information to those who know their telephone number." (*Id.*, 1:41–44.)
- "[T]he use of cellular telephones and generally mobile communication systems, ***provides*** for the increased transmission of information between individuals, particularly those on the move." (*Id.*, 1:45–48.)
- "The database therefore ***provides*** a source of information to the users of PCDs, particularly information regarding geographic locations." (*Id.*, 3:33–36.)
- "A personal communication device (PCD) 11 ***provides*** GPS receiver and wireless communication capability, particularly cellular telephone communication capability." (*Id.*, 3:38–40.)
- "The user may also ***provide*** varying levels of access to data in the user-specific space, or the e-card[.]" (*Id.*, 4:52–53.)
- "The user-specific storage space therefore ***provides*** for storage and retrieval of e-cards." (*Id.*, 5:18–19.)
- "[T]he space stores complete navigation information, maps, . . . as well as

providing Smart Contact manager, . . . and user schedule manager functions." (*Id*., 5:19–27.)

- "The PCD and the automobile telephone system are both coupled to user-specific storage areas which ***provide*** additional information." (*Id*., 5:44–46.)
- "The present invention therefore ***provides*** a location-centric information system." (*Id*., 7:15–16.)

The specification also uses "provide" in a manner that is consistent with providing something by sending it, but that does not exclude ways of providing other than sending. Examples include:

- "The PCD also ***provides*** the wireless GPS server information over the communication link, including information relating to the location of the PCD." (Ex. 1, 3:45–47.)
- "The GPS server ***provides*** the PCD location and identifier to an application server 15. The application server ***is provided*** the information from the GPS server via the Internet, or in some cases an intranet." (*Id*., 3:64–4:1.)
- "The PCD responds to the probe by ***providing*** position information to the GPS server. The GPS server ***provides*** the application server an indication of the PCD and an indication of the location of the PCD." (*Id*., 4:42–45.)
- "[T]he PCD can be used to provide e-mails indicative of the user's location in varying manners." (*Id*., 7:7–8.)

The specification also uses the terms "send" and "transmit." These terms are narrower than "provide," and the specification uses them with their ordinary narrower meanings. Examples include:

- "[O]ften to ***send*** a facsimile one needs to know the location and number of a fixed fax machine to which a fax may be ***sent***. Similarly, it is often difficult to courier packages to a person whose location is not known." (*Id*., 1:29–32.)
- "[T]he use of cellular telephones and generally mobile communication systems, provides for the increased ***transmission*** of information between individuals,

particularly those on the move." (*Id*., 1:45–48.)

- "In this new system and method certain preferences are ***sent*** from a wireless device to a GPS server[.]" (*Id*., 2:13–14.)
- "Using this system the user may simply ***send*** visited locations as determined by the GPS server to the users home page for storage and for populating a user's database." (*Id*., 2:30–33.)
- "The user can deny any party access upon ***sending*** data along with the GPS probe made by the GPS server." (*Id*., 2:49–51.)
- "The card may also include attachments, which is particularly useful when a user is ***transmitting*** e-cards to another person." (*Id*., 4:26–28.)
- "[I]n one embodiment the GPS server periodically ***transmits*** a request for, or probes, the location of a PCD." (*Id*., 4:40–42.)
- "The GPS server ***sends*** updated user information to the application server which stores the information in the user-specific space[.]"(*Id*., 4:59–61.)

The claim term is within a larger claim element: "providing the data indicative of the location of the user and the additional data regarding the user to possible requesters on the access list." The claim element is directed at providing information to "possible requesters" on an "access list." On this point, the specification states: "[t]he user may also provide varying levels of access to data in the user-specific space, or the e-card, to both persons known and unknown to the user." (Ex. 1, 4:52–54.) The persons are "requesters" who may have an interest in requesting information about the user. The user sets access privileges for possible requesters that dictate *who* may have access and *what information* may be accessed: "subscribers and parties requesting location and contact information on user are given information, which may vary by the requester. The user makes the determination as to the access privileges provided requester, generally prior to their request." (*Id*., 4:66–5:3.)

The specification thus teaches that the user *makes available* to selected requesters the selected information associated with the access privileges. Making the information available to the requesters with access privileges is a manner of providing information to the requesters

that is broader than merely sending information to them.

Considering the specification in its entirety, including the many examples provided above, shows that the patent does not use the terms "providing," "sending," and "transmitting" as synonyms. The patent uses the latter terms to refer to the narrower concept of providing something by sending or transmitting it. Facebook's proposed construction, substituting "sending" for "providing," is inconsistent with the patent specification and constitutes an improper narrowing of the claim term.

b. The Patent Claims

The claim term for the Court to construe appears at the end of Claim 1 of the '165 patent, which is reproduced in part below:

> 1. A method of providing contact information regarding a user, the method comprising: . . .
>
> receiving from the user an access list of possible requesters of the data and the additional data; . . . and
>
> **providing the data indicative of the location of the user** and the additional data regarding the user to possible requesters on the access list.

The claim term "providing" appears in Claims 1, 2, 11, and 12 of the '165 patent. "[C]laim terms are normally used consistently throughout the patent. *Phillips*, 415 F.3d at 1314. Such is the case here. The claims considered in their entirety reveal that "providing" has a different meaning than "sending." This is shown most clearly by Claims 2 and 8.

Independent Claim 2 recites, in pertinent part:

> 2. A location relevant server system comprising:
>
> . . .;
>
> a GPS server receiving information indicating a geographic location and a unique identifier associated with the PCD, the GPS server ***providing the PCD location and the unique identifier*** associated with the PCD to an application server[.]

(Ex. 1, 7:43–50.)

Claim 8 depends from Claim 2, and recites, "The system according to claim 2 wherein

the GPS server is further configured ***to send PCD locations and identifiers*** to the application server." (*Id*., 8:23–25.)

Claim 2 reads on a GPS server that provides certain recited information to an application server. The language of Claim 2 does not require a particular manner in which the information is to be provided to the application server. Claim 2 reads on a GPS server that sends the recited information to the application server. But Claim 2 also reads on a GPS server that provides the information in other ways, such as making the information available.

Claim 8 is narrower than Claim 2, because it includes the additional requirement that the GPS server be configured ***to send*** the recited information to the application server. Claim 2 may be characterized as being directed to a "genus" that requires providing the recited information, while Claim 8 is directed to a "species" of the genus that requires providing the information ***by sending it***.

It is well established that "the presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim." *Phillips*, 415 F.3d at 1314–15. Such is the case here. The recitation in Claim 8 of a GPS server configured ***to send*** the recited information creates a presumption that the "providing" of information by the GPS server in Claim 2 should not be construed to only mean providing information by sending it. Such a construction is also disfavored because it would render Claim 2 superfluous. *Merck & Co. v. Teva Pharm. USA, Inc*., 395 F.3d 1364, 1372 (Fed. Cir. 2005) ("A claim construction that gives meaning to all the terms of the claim is preferred over one that does not do so."); *Power Mosfet Techs., L.L.C. v. Siemens AG*, 378 F.3d 1396, 1410 (Fed. Cir. 2004) (a construction rendering a term superfluous is disfavored).

Silver State is not asserting Claims 2 and 8. But unasserted claims are part of the intrinsic record to be considered. "Other claims of the patent in question, both asserted and unasserted, can also be valuable sources of enlightenment as to the meaning of a claim term." *Phillips*, 415 F.3d at 1314 (citing *Vitronics*, 90 F.3d at 1582).

As noted above, the disputed claim term is within the claim element: "providing the data indicative of the location of the user and the additional data regarding the user to

possible requesters on the access list." The language of the full claim element reveals that the user is "providing" the information to "possible requesters" on the "access list." This is consistent with construing "providing" information to have its full breadth, including making the information available, or accessible, to the possible requesters on the access list.

Consideration of the claims shows that "providing" and "sending" are not synonyms. Facebook's proposed construction, substituting "sending" for "providing," is inconsistent with the claims and constitutes an improper narrowing of the claim term.

c. The Prosecution History

Nothing in the prosecution history of the '165 patent narrows or otherwise alters the meaning of this claim term from the meaning set forth from the specification and claims.

2. Consideration Of Extrinsic Evidence

It is the expert opinion of Dr. Rosenberg that a person of ordinary skill in the art at the time of the invention would interpret the disputed claim term to have its plain and ordinary meaning, which includes the full scope of the term "providing," and is not limited to providing by "sending," as proposed by Facebook. (Rosenberg Decl. ¶¶ 31–45.) Silver State's position is also supported by the dictionary definition of "provide," which is "to make available; furnish;" and "to supply or equip." (Ex. 7 at 4.) The definitions set forth in the dictionary are fully consistent with the meaning of "providing" that is consistently used throughout the asserted patents.

For the many reasons above, "providing the data indicative of the location of the user" should be construed to have its plain and ordinary meaning, which is not limited to "sending the data indicative of the location of the user."

C. "Data Related To A Proximity Of The Location Of The Mobile Communication Device" Is Not Indefinite

Facebook's invalidity contentions assert that "data related to a proximity of the location of the mobile communication device" in Claims 1 and 6 of the '117 patent is indefinite because '[p]roximity' is a relative term, and this generic and functional claim language in context does not sufficiently specify the scope of "'a proximity,' such as a

proximity to some certain location or thing that is not specified in the claim, in order to clearly define the outer bounds of the claim scope." (Ex. 20 at 73:17–21.) As discussed below, the term describes the scope of the claim with reasonable certainty.

1. Consideration Of The Intrinsic Record

To a person of ordinary skill in the art, the claim term describes the claim scope with reasonable certainty. The phrase "proximity" in the challenged claim term is used with its plain and ordinary meaning: nearness in place, time, or relation. In the claim, it recites "a proximity *of the location*," further clarifying that the term is referring to a nearness in place. The patent specification uses this ordinary meaning. The Background of the patent provides the motivation for the invention, noting that "individuals on the move often have unique information requirements, particularly with respect to information concerning places ***near their location***." (Ex. 2, 1:51–53.)

The '117 patent specification discusses that the system allows users to share information that may be of interest to a user of a PCD, including "allow[ing] the mobile users for example, to interrogate the fielded information web server to determine the location of ***nearby places of business*** in which they may have an interest." (*Id.*, 5:64–67.)

Facebook also contends that the claim term is indefinite because "a proximity" is not tied to "some certain location or thing." (Ex. 20 at 73.) But the claim language itself shows otherwise. The claim term recites "a proximity of the location *of the mobile communication device*." This provides the reference frame, relating the term proximity to the location of the mobile communication device recited earlier in the claim.

The prosecution history of the '117 patent also shows that the term is not indefinite. Applicant presented the claim term with its first amended set of patent claims. (Ex. 22 at 11.) During an examination lasting several years, Examiner Nguyen considered the term on at least five separate occasions. (*Id*. at 17–30, 41–49, 62–68, 71–75, 78–82.) Not once did Examiner Nguyen determine that the claim term was indefinite.

2. Consideration Of Extrinsic Evidence

It is the expert opinion of Dr. Rosenberg that a person of ordinary skill in the art at the

time of the invention understood the scope of the subject claim term with reasonable certainty. (Rosenberg Decl. ¶¶ 27–30.)

Silver State's position is also supported by the dictionary definition of "proximity," which is "nearness in place, time, relation, etc." (Ex. 7 at 5.) The definition set forth in the dictionary is fully consistent with the meaning applied by the asserted patents.

Silver State's position is further supported by Facebook's use of "proximity" in its own patents. Attached as **Exhibits 14–19** are five examples. Specifically:

- U.S. Patent No. 8,312,112, titled, "Systems And Methods For Automatically Locating Web-Based Social Network Members," includes a Claim 15 that recites: "determining whether the first user is ***in proximity to*** the second user based on the location information of the first user and location information of the second user." (Ex. 14, 9:41–43.)
- U.S. Patent No. 8,554,477, titled, "Meeting Notification And Modification Service," includes a Claim 4 that recites: "wherein the at least one selectable option comprises an option to search for points of interest ***within a proximity*** of the geographic location associated with the appointment." (Ex. 15, 33:22–25.)
- U.S. Patent No. 9,154,608, titled, "Data Exchange Between Antenna And Modem Of Mobile Device," includes a Claim 2 that recites: "wherein a source of the interference comprises an object coming into ***proximity*** or contact with the computing device." (Ex. 16, 8:60–62.)
- U.S. Patent No. 9,203,787, titled, "Identifying Users Sharing Common Characteristics," includes a Claim 22 that recites: "determining, by the at least one processor, a geographic location ***in physical proximity to*** the first user of the communications system based on the selected description of the location of the first user; determining that a second user of the communications system is ***within physical proximity to*** the geographic location; and providing a first indication that the second user and the first user are both ***within physical proximity*** to the geographic location." (Ex. 17, 22:38–47.)

- U.S. Patent No. 9,223,826, titled, "Pushing Suggested Search Queries To Mobile Devices," include a Claim 15 that recites: "wherein determining the intent of the first user is further based on ***the proximity*** of the first user to one or more concepts or second users associated with one or more second locations, ***the proximity*** of the first user being based on the distance between the first location of the first user and the second locations of one or more second locations." (Ex. 18, 27:22–28.)
- U.S. Patent No. 9,660,950, titled, "Sharing Television And Video Programming Through Social Networking," includes a Claim 3 that recites, "determining identities of the first and second users when the first and second users are at the same location and are both ***in proximity to*** a display device." (Ex. 19, 73:20–23.)

These patents are merely a sample of the many Facebook patents that use "proximity" in the patent claims. Facebook has no difficulty understanding the term when it appears in its own patents. Indeed, Facebook uses "proximity" as a claim term without defining it, showing recognition that a person of ordinary skill in the art understand the term's meaning without the need for an express definition. The same is true with Silver State's use of the term.

Accordingly, persons of ordinary skill in the art understand the scope of "data related to a proximity of the location of the mobile communication device" with reasonable certainty.

V. CONCLUSION

Silver State respectfully requests that the Court enter an order that comports with Silver State's claim construction positions.

Respectfully submitted,

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