

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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LYFT, INC. AND BUMBLE TRADING LLC,  
Petitioner,

v.

IKORONGO TECHNOLOGY LLC et al.,  
Patent Owner.

U.S. Patent No. RE45,543

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Case No. IPR2021-00423

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**PATENT OWNER PRELIMINARY RESPONSE TO PETITION  
PURSUANT TO 37 C.F.R. §42.107(a)**

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### EXHIBIT LIST

Exhibit	Description
2001	<i>Ikorongo Texas LLC v. Samsung Electronics Co., Ltd.</i> , No. 6:20-cv-00259-ADA (W.D. Tex.), Dkt. 74 (Amended Scheduling Order) (issued: April 13, 2021).
2002	<i>Ikorongo Texas LLC v. Lyft, Inc.</i> , No. 6:20-cv-00258-ADA (W.D. Tex.) Dkt. 75 (Amended Scheduling Order) (issued: April 13, 2021).
2003	<i>Ikorongo Texas LLC v. LG Electronics, Inc. et al.</i> , No. 6:20-cv-00257-ADA (W.D. Tex.) Dkt. 83 (Amended Scheduling Order) (issued: April 13, 2021).
2004	<i>Ikorongo Texas LLC v. Bumble Trading Inc.</i> , No. 6:20-cv-00256-ADA (W.D. Tex.) Dkt. 64 (Amended Scheduling Order) (issued: April 13, 2021).
2005	<i>Ikorongo Texas LLC v. Uber Technologies, Inc.</i> , No. 6-20-cv-00843-ADA (W.D. Tex.) Dkt. 24 (Scheduling Order) (issued: Jan. 12, 2021).
2006	Invalidity Contentions served by Samsung in <i>Ikorongo Texas LLC v. Samsung Electronics Co., Ltd.</i> , No. 6:20-cv-00259 (W.D. Tex.).
2007	Reserved
2008	Reserved
2009	Reserved
2010	Reserved

2011	IAM Interview with Judge Alan Albright, <i>available at</i> <a href="https://www.iam-media.com/law-policy/albright-the-last-thing-anyone-should-think-about-venue-it-plaintiff-friendly">https://www.iam-media.com/law-policy/albright-the-last-thing-anyone-should-think-about-venue-it-plaintiff-friendly</a> .
2012	<i>Google et al. v. Ikorongo Texas et al.</i> , IPR2021-00127 (Decision Denying Institution regarding U.S. Patent No. RE45,543)

## I. INTRODUCTION

Ikorongo Technology LLC and Ikorongo Texas LLC (“Patent Owner”) submit this Preliminary Response to the Petition for *Inter Partes* Review (“Pet.” or “Petition”) of United States Patent No. U.S. Patent No. RE45,543 (“RE’543 patent”) naming as Petitioners Lyft, Inc. and Bumble Trading, LLC. Pet. 1.

**As Petitioner readily admits, “[t]he patentability analysis in this Petition is *identical* to the petition filed in IPR2021-00127.” Pet. 1. The Board denied institution in that IPR on the merits. Ex. 2012 (Decision Denying Institution in IPR2021-00127). Accordingly, this Petition should be denied for at least the same reasons. The remainder of this response, including the discussion of Callegari, is substantively identical to the POPR filed in IPR2021-00127, with (1) an additional section discussing the decision denying institution, (2) updated cites throughout, and (3) some updates in the argument concerning discretionary denial.**

The Petition asserts the following challenges to claims 32, 34, 36, 38–39, 41, 43–49, 51, 53–62, 72, and 76 of the RE’543 patent:

Ground	References	Basis	Challenged Claim(s)
1	Callegari <sup>1</sup>	§ 103	76
2	Callegari and Friedman <sup>2</sup>	§ 103	32, 34, 36, 39, 41, 43–49, 51, 53–62, and 72
4	Callegari, Friedman, and	§ 103	38

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<sup>1</sup> Ex. 1005, U.S. Patent Application Publication No. 2003/0055983 to Callegari (“Callegari”).

<sup>2</sup> Ex. 1009, U.S. Patent No. 6,714,791 to Friedman (“Friedman”).

	Eschenbach <sup>3</sup>		
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Pet. 20.

Several threshold and dispositive issues demonstrate the Petition should be denied. First, the Board should exercise its discretion to deny institution under 35 U.S.C. § 314(a). Among other relevant factors favoring denial, parallel litigations (involving the same parties and raising overlapping issues) are well underway, and trial is scheduled to be complete four months prior to the statutory deadline for a final written decision.

Second, the Board should deny institution because Petitioner *did not even allege*, let alone demonstrate, that the relied upon disclosures in Callegari are sufficiently supported in an underlying priority application so as to qualify as prior art under pre-AIA § 102(e). Specifically, the Callegari reference was filed and published after the priority date of the RE’543 patent claims.<sup>4</sup> As such, Callegari can only be used as prior art under §102(e) if (1) the relied upon teachings are sufficiently supported in an earlier provisional application of Callegari and (2) the provisional application supports at least one claim in Callegari’s published application. MPEP § 2136. While the Petition attempts to show the latter requirement (Pet. 3-11), neither Petitioner nor its declarant even attempt to demonstrate the former requirement that the relied upon teachings in Callegari are fully supported in an earlier provisional application. By ignoring the question of whether the allegedly invalidating

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<sup>3</sup> Ex. 1010, U.S. Patent No. 6,373,429 to Eschenbach (“Eschenbach”).

<sup>4</sup> The RE’543 patent is a reissue of U.S. Patent No. 7,080,139 filed on April 24, 2001. Callegari was filed almost a year later on March 19, 2002.

disclosures in Callegari are even supported by the earlier application, Petitioner has failed to sufficiently show that Callegari is prior art. Whether or not disclosure found in Callegari – but not supported by the earlier application – teaches or suggests RE’543 claim limitations is wholly irrelevant because such disclosure is not prior art.<sup>5</sup> Because Callegari is the exclusive or primary reference in each proposed ground, this failure by Petitioner is fatal to all grounds and the Petition *in toto*.

Third, the Board should deny institution because the record contains no argument or evidence to support a conclusion that any of the provisional applications (Ex. 1006–1008)<sup>6</sup> to which Callegari claims priority itself contains subject matter sufficient to renders obvious any challenged claim alone or in combination with Friedman and/or Eschenbach. In fact, Petitioner does not even offer such a theory.

Because denial is independently warranted under at least 35 U.S.C. §§ 312(a) and 314(a), the Board need not reach the substantive merits of the Petition. A preliminary substantive analysis is nevertheless presented herein because Petitioner cannot meet its burden and the Board has held that “weakness on the merits” or even a “closer call” also weighs in favor of discretionary denial under § 314(a) and precedential opinions interpreting the same, particularly given the earlier district court trial date her here.

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<sup>5</sup> Patent Owner does not concede (and indeed contests) that even if relied upon portions of Callegari constituted prior art that Callegari, alone or in combination, renders obvious any challenged claim. Furthermore, Patent Owner reserves the right to swear behind the provisional application filing date.

<sup>6</sup> In fact, the Petition does not cite to any disclosures in Ex. 1006 or 1008, and fails to support any ground based on the disclosure of Ex. 1007 itself.



## II. OVERVIEW OF THE RE '543 PATENT

The RE'543 patent is a reissue of U.S. Patent No. 7,080,139, filed April 24, 2001—two decades ago. The RE'543 patent is entitled “Method and Apparatus for Selectively Sharing and Passively Tracking Communication Device Experiences.” The RE'543 patent provides the following general overview:

A common theme among aspects of the present invention is collecting data regarding a user's computer usage experience and sharing that data. So-called “buddies” identified on buddy lists of instant messaging products can share selected aspects of their computer usage experiences. Administrative tools and processes can be provided to set up selective collection and sharing of data. Collection tools and processes operate on a variety of computer usage activities and user responses to their computer usage experiences. Processing tools and methods filter, integrate and correlate the collected data. Display tools and processes make portions of the data accessible on a pre-defined basis. Such as according to defined rights of buddies. Aggregation tools and processes assemble statistics about user experiences across different bases, such as buddy lists, categories of users, and all service participants.

RE'543 patent, 2:39–59.

Certain embodiments are described with reference to a “visited location database (‘VLD’) 100B.” *Id.*, 3:26–28. Among other described features, “[t]he VLD also could store geographic information regarding the location, such as geo-coded

data,” visited by a location-aware device. *Id.*, 3:44–46. An access control list or “ACL” also can be maintained as a database. Among other described features, an ACL may be used to identify buddies and control their access to visited geographic location data stored in the VLD. *Id.*, 4:4–13. The RE’543 patent provides a detailed description of how “[a] user could set up his or her own ACL via buddy list and access control list administration functions.” *Id.* In various embodiments, the ACL and VLD interoperate to enable a user to control who may have access to geographic information visited by the user’s location-aware device.

Fifteen of the twenty-six claims challenged in the Petition are written in independent form—i.e., independent claims 32, 39, 46–49, 51, 53–57, 72, and 76. The Petition, however, mostly ignores the actual claim language of each claim and instead largely refers back to its challenge of independent claim 76 in Ground 1, which in turn also does not focus on the actual claim language but instead refers back to a discussion of alleged “Core Elements” that Petitioner unilaterally presented for analysis. The actual language of claim 76 is reproduced below:

76. A computer-implemented method of sharing computer usage experiences, including:

[a] a location-aware device adapted to:

[b] record geographic location data while visiting geographic locations using a satellite-based location-fixing protocol;

[c] enable access to one or more lists of other users to identify one or more other users with whom the geographic location data may be shared;

- [d] enable definition of rights of the one or more other users to access the geographic location data; and
- [e] send at least a portion of the geographic location data to a tracking server; and
- [f] the tracking server adapted to:
  - [g] receive the at least a portion of the geographic location data from the location-aware device; and
  - [h] share the at least a portion of the geographic location data with the one or more other users in accordance with the rights of the one or more other users.

*Id.*, claim 76, 28:48–66.

### III. RELATED PROCEEDINGS

The RE'543 patent is at issue in the following related proceedings:

Case	Filing Date
<i>Ikorongo Texas LLC v. Samsung Electronics Co., Ltd.</i> , No. 6:20-cv-00259-ADA (W.D. Tex.)	Mar. 31, 2020
<i>Ikorongo Texas LLC v. Lyft, Inc.</i> , No. 6:20-cv-00258-ADA (W.D. Tex.)	Mar. 31, 2020
<i>Ikorongo Texas LLC v. LG Electronics, Inc. et al.</i> , No. 6:20-cv-00257-ADA (W.D. Tex.)	Mar. 31, 2020
<i>Ikorongo Texas LLC v. Bumble Trading Inc.</i> , No. 6:20-cv-00256-ADA (W.D. Tex.)	Mar. 31, 2020
<i>Ikorongo Texas LLC v. Uber Technologies, Inc.</i> , No. 6-20-cv-00843-ADA (W.D. Tex.)	Sep. 15, 2020
<i>Unified Patents, LLC f/k/a Unified Patents Inc. v. Ikorongo Technology LLC et al.</i> , No. IPR2020-01379 (PTAB) <sup>7</sup>	Aug. 6, 2020

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<sup>7</sup> Institution was denied in IPR2020-01379 on February 11, 2021. *Id.* at Paper 21.

**IV. THE BOARD SHOULD DENY THIS PETITION FOR THE SAME REASONS IT DENIED IDENTICAL PETITION IPR2021-00127**

As Petitioner admits, “[t]he patentability analysis in this Petition is identical to the petition filed in IPR2021-00127.” Pet. 1. The Board denied institution in that IPR on the merits. Ex. 2012 (Decision Denying Institution in IPR2021-00127). Accordingly, this Petition such be denied for at least the same reasons. Specifically, the Board held that “Patent Owner argues ‘Petitioner *did not even allege*, let alone demonstrate, that the relied upon disclosures in Callegari are sufficiently supported in [the Callegari ’187 Provisional] so as to qualify as prior art under pre-AIA § 102(e).’ Prelim. Resp. 2. Based on our review of the record before us, we are persuaded by Patent Owner’s argument and determine that Petitioner has not demonstrated a reasonable likelihood that it would prevail in showing that any of claims 32, 34, 36, 38, 39, 41, 43–49, 51, 53–62, 72, and 76 is unpatentable as obvious over Callegari, alone or in combination with the other asserted references, as discussed below.” Ex. 2012 at 11. As in that case, Callegari is relied upon for each ground and the record evidence presented by Petitioner is identical in this petition and thus institution should be denied for at least the same reasons.

**V. THE BOARD SHOULD EXERCISE DISCRETION UNDER 35 U.S.C. § 314(a) TO DENY INSTITUTION**

The Director has discretion to deny institution under §314(a). *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016). Discretionary denial is warranted

here because institution would be an inefficient duplication of parallel litigations. As shown above, the RE'543 patent is asserted in five district court cases pending before Judge Albright in U.S. District Court, Western District of Texas – all five of which are set for trial prior to the due date for a final written decision should this IPR be instituted.

The Board considers the presence and status of parallel district court litigation in determining institution. *NHK Spring Co., Ltd. v. Intri-plex Technologies*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential) (“*NHK*”) and *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”); *see also General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16–17 (PTAB Sept. 6, 2017) (“[W]e recognize that an objective of the AIA is to provide an effective and efficient alternative to district court litigation.”).

*Fintiv* sets forth a non-exhaustive list of factors that balance considerations of system efficiency and fairness when a patent owner raises an argument for discretionary denial due to the advanced state of a parallel proceeding(s). *Fintiv*, IPR2020-00019, Paper 11 at 5–6. The factors are:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;

4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

*Id.*

As explained below, there is some overlap among these factors and some facts may be relevant to more than one factor. Therefore, in evaluating the factors, the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review. *See Consolidated Trial Practice Guide* November 2019 (“TPG”) at 58 (quoting 35 U.S.C. § 316(b)).

A holistic view of the *Fintiv* factors reveals the present circumstances favor discretionary denial. Petitioner addresses the factors, but its reasoning is legally and factually flawed, as explained further below.

**A. No litigation stay pending IPR has been requested, and there is no evidence one would be granted if requested (Factor 1).**

The first factor favors denial. Factor 1 asks whether “evidence exists that [a stay] may be granted if a proceeding is instituted.” *Fintiv*, Slip. Op. 6. Here, no IPR stay has been requested in any of the five parallel litigations, much less in all of them, nor is there *any* evidence of record that a stay would be granted if requested.<sup>8</sup> All

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<sup>8</sup> Petitioner Lyft filed a motion to transfer its action from WDTX to the Northern District of California, which was denied. Bumble withdrew its motion to transfer before it could be denied.

five parallel litigations are pending before Judge Albright in the Western District of Texas, who has publicly stated he generally does not stay trial for a pending IPR, even if instituted. Ex. 2011, 1 (“[Reporter:] You’re one of the judges who hears a lot of patent cases who has tended not to stay cases pending a PTAB decision – why is that? [Judge Albright:] You know, I have done that because I think that people have a constitutional right to assert their patent.”).

Here, Petitioner has not asserted it will seek a stay if institution is granted and has offered no evidence to weigh against (1) the fact that no defendant had moved for a stay pending IPR and (2) the lack of any evidence of record that a stay would be granted if requested. Thus, the record here only favors denial under factor 1.<sup>9</sup> This is particularly true here, where the district judge has publicly acknowledged the court’s general reluctance to stay litigation pending an IPR trial (Ex. 2011), and Petitioner offers no counterbalancing explanation as to why this particular case would be different.

**B. Trial in the district court will precede any final written decision (Factor 2).**

The second factor favors denial because trial in court would precede a final written decision if an IPR trial is instituted here. *Fintiv*, Slip. Op. 9. The Bumble,

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<sup>9</sup> Even if a motion for stay had been filed in related litigation, the court would likely consider similar factors to those set forth in *Fintiv*—*e.g.*, the amount of time already invested by the district court and the fact that trial here is scheduled to be completed four months prior to the Board’s deadline for a final written decision. *See Fintiv*, Slip. Op. at 7 n.12. Those factors would favor denying a motion for stay, just as they favor denial of institution here.

Lyft, LG and Samsung trials are each scheduled for March 2022. *See* Exs. 2001-2004, 3 (Order Amending Scheduling Order). The Uber trial is scheduled for March 2022. *See* Ex. 2005, 3. All the cases raise the same validity issues and there could potentially be five jury trials on the same validity questions as raised here, all many months prior to the statutory deadline for a final written decision. The Board has found this factor favors denial under similar circumstances. *See, e.g., Fintiv*, IPR2020-00019, Paper 15, Slip. Op. at 13 (PTAB May 13, 2020) (“Because the currently scheduled District Court trial is scheduled to begin *two months before* our deadline to reach a final decision, this factor weighs somewhat in favor of discretionary denial in this case.”) (emphasis added); *NHK*, Slip. Op. 20.

Petitioner counters that the second factor weighs against discretionary denial because LGE, Samsung, and Lyft have all moved to transfer their respective cases to the Northern District of California. Pet. 81. All those motions have been denied.

Factor 2 supports denial of institution.

**C. There has been and will continue to be significant investment in the co-pending litigations (Factor 3).**

The third factor favors denial because “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision” will have been substantial. *Fintiv*, Slip Op. 9. The Court has already conducted a Markman hearing and issued its Markman order in Petitioner Lyft and Bumble’s cases (as well as Samsung and LG’s). The Markman in the Uber case is set for March 25, 2021. Substantive discovery is open in the



Lyft/Bumble/Samsung/LG cases and expert reports will be due this fall. Each one of these circumstances weigh in favor of denial under this factor—collectively they make a compelling case for discretionary denial under § 314(a).

Thus, this factor favors denial.

**D. The Petition raises substantive issues that substantially overlap with co-pending litigation (Factor 4).**

The fourth factor favors denial. *Fintiv* states, “if the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.” Slip. Op. 12. Here, there is complete overlap in the claims challenged by Petitioner and those identified in invalidity contentions in parallel litigation (e.g., those filed by Bumble, Lyft, LG, Samsung, and Uber). *See generally* Ex. 2006. For example, parallel proceedings challenge the same exact claims.

There is also *complete* overlap in these parallel proceedings as to the art cited. Bumble, Lyft, Samsung, and LG’s invalidity contentions served in litigation rely upon all possible combinations of “Eschenbach, ... Callegari, ... [and/or] Friedman”—*i.e.*, the same references at issue here. Ex. 2006. This factor thus favors denial because the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding.

Petitioner argues that the fourth factor weighs against discretionary denial ostensibly because Petitioners “*will* stipulate in [the district court] that, if this IPR is instituted, they will not pursue the specific grounds identified in this Petition, and

listed below, before the district court.” Pet. 79, 82 (emphasis added). First, Samsung and LG made the same stipulation, but because their petition was denied, they allege they are not bound by the stipulation. Uber offered no such a stipulation. Thus, these issues will be litigated in the district court in any event – months before a decision here. Moreover, the contingent nature of Petitioners’ stipulation (which has not been filed in the district court) and its refusal to stipulate that it will not raise any prior art argument it could have raised in its IPR petition greatly weakens the stipulation.

Accordingly, this factor favors denial, particularly given (1) the overlap between parallel proceedings and (2) Petitioner’s decision to not offer any relevant and binding stipulation either prior to, or concurrent with, the filing of its Petition.

**E. At least two real-parties-in-interest are named defendants in parallel litigation (Factor 5).**

The fifth factor considers “whether the petitioner and the defendant in the parallel proceeding are the same party.” *Fintiv*, Slip. Op. 5–6, 13–14. Here, there is complete identity. This is precisely the sort of circumstances that weigh in favor of denial under factor 5. *Fintiv*, Slip. Op. 5–6, 13–14.

**F. Other circumstances, including the merits, warrant exercising discretion under Section 314(a) (Factor 6).**

The sixth factor favors denial. *Fintiv* states, “if the merits of the grounds raised in the petition are a closer call, then that fact has favored denying institution when other factors favoring denial are present.” Slip. Op. 15 (citations omitted). Here, the merits raised in the Petition are particularly weak, as shown herein. In fact, the Board

has already rejected the exact same substantive grounds in IPR2021-00127. This factor weighs in favor of denial.

**VI. PETITIONER FAILS TO ESTABLISH THAT THE RELIED UPON PORTIONS OF CALLEGARI QUALIFY AS PRIOR ART**

Petitioner fails to demonstrate the relied upon portions of Callegari are prior art. The RE'543 patent is a reissue of U.S. Patent No. 7,080,139 and thus has an effective filing date of April 24, 2001, *as a matter of law*. 35 U.S.C. § 100(i)(1) (“The effective filing date for a claimed invention in an application for reissue or reissued patent shall be determined by deeming the claim to the invention to have been contained in the patent for which reissue was sought.”). The Callegari application was filed almost a year later on March 19, 2002. Ex. 1005, (22). Thus, the RE'543 patent predates Callegari, and Callegari is *not prima facie* prior art under §102(e) or otherwise.

While Callegari claims priority under §119(e) to three provisional applications (Exs. 1006-1008) filed on March 19, 2001 (and thus before April 24, 2001), there is no presumption that the relied upon Callegari subject matter is entitled to a March 2001 effective filing date. Instead, Petitioner had a burden to demonstrate that the relied upon subject matter in Callegari is fully supported by one of the provisional applications (among other requirements) so as to possibly qualify as prior art under §102(e). But Petitioner and its declarant simply ignore this issue.

Specifically, Petitioner bore the burden to demonstrate, within the Petition

itself,<sup>10</sup> that the relied upon disclosure in Callegari qualified as prior art under § 102(e) based on the filing date of an underlying provisional application. A published U.S. patent application has an effective prior art date under pre-AIA § 102(e) as of the underlying provisional application filing date **only if** two distinct requirements are met: (1) “the prior application(s) must properly support the subject matter used to make the rejection in compliance with pre-AIA 35 U.S.C. §112, first paragraph or 35 U.S.C. §112(a)” and (2) at least one of the claims in the reference publication is supported by the written description of the provisional application in compliance with pre-AIA 35 U.S.C. § 112, first paragraph. MPEP §§ 2136(I), 2136(II) Example 2, and 2136.03; *see also, Amgen Inc. v. Sanofi*, 872 F.3d 1367, 1380 (Fed. Cir. 2017) (discussing *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015)); *In re Giacomini*, 612 F.3d 1380 (Fed. Cir. 2010).

The MPEP states this two-part requirement as follows:

The pre-AIA 35 U.S.C. 102(e) date of a reference that did not result from, nor claimed the benefit of, an international application is its earliest effective U.S. filing date, taking into consideration

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<sup>10</sup> *See* 35 U.S.C. § 312(a)(3) (requiring petitions to identify “with particularity ... the grounds on which the challenge to each claim is based”); *Wasica Finance GmbH v. Continental Automotive Systems, Inc.*, 853 F.3d 1272, 1286–87 (Fed. Cir. 2017) (“It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify with particularity the evidence that supports the grounds for the challenge to each claim.”) (quoting *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016), which quotes, in part, 35 U.S.C. § 312(a)(3)).

any proper benefit claims to prior U.S. applications under 35 U.S.C. 119(e) or 120. *For all benefit claims, the prior applications must properly support the subject matter used to make the rejection in compliance with pre-AIA 35 U.S.C. §112, first paragraph, or 35 U.S.C. §112(a). See MPEP §2136.02. In addition, for benefit claims under 35 U.S.C. 119(e), at least one claim of the potential reference must be supported by the written description of the relied upon provisional application* in compliance with pre-AIA 35 U.S.C. §112, first paragraph, or 35 U.S.C. §112(a), in order for the potential reference to be usable as prior art under pre-AIA 35 U.S.C. 102(e) as of a relied upon provisional application's filing date. See MPEP § 2136.03, subsection III.

MPEP §2136 (I) (emphasis added); *see also* MPEP § 2136(III) (“The provisional application must also describe, in compliance with pre-AIA 35 U.S.C. 112, first paragraph, or 35 U.S.C. 112(a), the subject matter relied upon in the reference patent or publication to make the rejection. See MPEP § 2136, examples 2, 4, and 7.”)

Judge Bataillon recently applied the two-part test as follows:

For Kim '168 to be prior art to the '239 patent, TCL was required to show that Kim '168 is entitled to the February 3, 2008 priority date of its provisional application ("Kim '808 provisional"), which comes before the priority date of the '239 patent. To do that, it had to show that the claims of Kim '168 are supported by the Kim '808 provisional application *and the portions of Kim '168 relied upon by TCL for invalidity are supported by the Kim '808 provisional application.*”

*Godo Kaisha IP Bridge I v. TCL Commc'n Tech. Holdings Ltd.*, No. CV 15-634-JFB, 2019 WL 1879984, at \*4 n.3 (D. Del. Apr. 26, 2019), *aff'd*, 967 F.3d 1380 (Fed. Cir. 2020) (citing *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1376, 1381 (Fed. Cir. 2015)) (emphasis added).

This is consistent with the legislative history to the 1952 Patent Act, which states (in part) that “Section (e) is another well-recognized condition imposed by a decision of the Supreme Court which was not expressed in the existing law; for purpose of anticipating subsequent inventors, a patent disclosing the subject matter speaks from the filing date of the application ***disclosing the subject matter.***” S. Rep. No. 1979, 82nd Cong., 2d. Sess. (1952), reprinted in 1952 U.S.C.C.A.N. 2394, 2399 (emphasis added). Consistent with the above principles, the Office designated precedential a ruling that a patent was § 102(e) prior art as of the filing date of its provisional application, based in part on a finding that the provisional application sufficiently supported ***the relied upon disclosure in the patent.*** *Ex parte Yamaguchi*, 2007-4412, 2008 WL 4233306, Slip. Op. 19–20 (PTAB Aug. 29, 2008) (precedential). This, of course, makes logical sense. Because Callegari is filed after the RE’543 priority date, if the relied upon disclosure is not fully supported by an earlier provisional application, then it would not be “prior” to the RE’543 filing date and thus could not be “prior art.”

Here, Petitioner only addressed one of the requirements, alleged support in a provisional application for at least one claim of Callegari (Pet. 3-11), but failed to even acknowledge the other (and more crucial) requirement – whether the Callegari

subject matter relied upon in Petitioner's grounds of rejection has sufficient § 112, first paragraph, support in any of the provisional applications.

Throughout the Petition, Callegari is quoted and cited as allegedly teaching certain claimed subject matter. Yet, nowhere does Petitioner even attempt to demonstrate that the quoted or cited subject matter has §112, first paragraph, support in any of the provisional applications. As a simple example, Callegari Fig. 5B is reproduced *ten times* in the Petition in support of an alleged prior art teaching. Pet. 11, 19, 20, 28, 31, 32, 37, 45, 71, 74. This figure does not appear in any of the provisional applications and nowhere does Petitioner explain how the subject matter of this figure (or associated text) has §112, first paragraph, support in a provisional application. There are numerous other examples of Petitioner's failure.

Furthermore, while each of the provisional applications is incorporated by reference into Callegari and the Petition string cites to particular pages/Figures of one of the provisional applications (Ex. 1007), the Petition provides no argument or explanation as to how the cited pages or figures allegedly teach or suggest the RE'543 claimed subject matter.

In short, Petitioner makes no attempt to prove that the relied upon portions of Callegari are in fact supported by an earlier provisional application or that any of the provisional applications to which Callegari claims priority (and which are incorporated by reference into Callegari) itself renders obvious the RE'543 claim language. Instead, Petitioner wrongly seeks the benefit of a provisional application filing date but then relies on new disclosure in Callegari that is not supported by any

of the provisional applications.

A hypothetical demonstrates the folly of Petitioner's position. Assume a patentee invented a new fuel injection engine and filed a patent application on January 1, 2000, which later issues as a patent. An IPR petition is submitted against that patent based on a published application filed in December 2000 that contains a disclosure of two embodiments: one is the same fuel injection engine as the patent and the second is a non-fuel injection engine. The published application also contains two claims – one to each embodiment. The published application was filed after the challenged patent in question and thus cannot qualify as prior art based on its own filing date. However, the published application claims priority to a provisional application filed in December 1999. Yet, that provisional only disclosed the non-fuel injection engine embodiment. Under Petitioner's faulty legal analysis, the fuel injection engine disclosure of the published application somehow magically becomes prior art despite being nowhere described or mentioned in the provisional application. Specifically, Petitioner would ignore the first part of the two-part test and instead argue that because at least one claim of the published application (the claim to the non-fuel injection engine) is supported by the provisional application, *the entire disclosure of the published application* is somehow entitled to the earlier provisional application priority date for §102(e) purposes. Not surprisingly, such an illogical position is not the law as demonstrated above.<sup>11</sup>

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<sup>11</sup> This hypothetical was based upon MPEP §2136 (II), Example 2.



## **VII. LEVEL OF ORDINARY SKILL IN THE ART**

Patent Owner does not presently offer a competing definition for a person of ordinary skill in the art at this preliminary stage. Even if the Board adopted Petitioner's proposed definition, Petitioner fails to demonstrate a reasonable likelihood that the challenged claims are unpatentable. Patent Owner reserves the right to propose its own definition if trial is instituted.

## **VIII. CLAIM CONSTRUCTION**

Petitioner argues that “[n]o claim terms need to be construed by the Board at this time.” Because the procedural and substantive error are legion here, independent of any construction the Board may apply, Patent Owner does not propose any claim constructions at this time. Patent Owner reserves the right to propose specific constructions, however, in the unlikely event that trial is instituted.

## **IX. PETITIONER FAILS TO DEMONSTRATE A REASONABLE LIKELIHOOD OF UNPATENTABILITY FOR ANY CHALLENGED CLAIM**

Because denial is warranted under 35 U.S.C. § 314(a), as explained above, the Board need not reach the technical substantive merits of the Petition. A substantive analysis is nevertheless presented below because *Fintiv* instructs that a “weakness on the merits” and even a “closer call” favor discretionary denial when other factors favoring denial are also present. *Fintiv*, Paper 11 at 15.

Petitioner has the burden of proof to establish entitlement to relief. 37 C.F.R. § 42.108(c) (“review shall not be instituted for a ground of unpatentability unless

. . . there is a reasonable likelihood that at least one of the claims challenged . . . is unpatentable”). The Petition should be denied as failing to meet this burden.

The Petition allegedly raises obviousness challenges against claims 32, 34, 36, 38–39, 41, 43–49, 51, 53–62, 72, and 76 of the RE’543 patent. Fifteen of the twenty-six claims challenged in the Petition are written in independent form—i.e., independent claims 32, 39, 46–49, 51, 53–57, 72, and 76. Petitioner created its own claim limitations – which it refers to as “Core Elements” A-F and focuses its analysis on them instead of the actual claim language. Petitioner’s attempt to compare the prior art to the “gist” of the claims instead of the claims “as a whole,” including all the claim language, is legally improper. As the MPEP instructs, “[d]istilling an invention down to the ‘gist’ or ‘thrust’ of an invention disregards the requirement of analyzing the subject matter ‘as a whole.’” MPEP § 2141.02(ii) (citations omitted).

The Petition then compares the prior art to the core elements and then compares the core elements to the actual claim language. This approach is not proper and does not meet Petitioner’s burden. The Petition should be denied for this tactic alone.

Petitioner has failed to show that it is more likely than not that any of the challenged claims is invalid under a theory set forth in the Petition.

**A. All grounds fail because Petitioner has not shown that Callegari is Prior Art**

As demonstrated in Section VI above, Petitioner has not shown that the relied upon disclosures in Callegari have §112, first paragraph, support in any of the provisional applications and thus has failed to demonstrate that Callegari qualifies as

prior art. Because every ground relies upon Callegari, they all fail.

**B. Petitioner fails to establish that the '187 provisional application (Ex. 1007) supports or contains any invalidating subject matter**

The Petition contains numerous string cites to both Callegari and one of the provisional applications (Ex. 1007 or “the '187 provisional”), but Petitioner fails to explain how the cited '187 provisional pages allegedly provide written description support (under pre-AIA § 112, first paragraph) *for the subject matter relied upon in Callegari*. See §VI above. Accordingly, Petitioner has failed to establish that the relied upon subject matter of Callegari qualifies as prior art under pre-AIA § 102(e). Moreover, the '187 provisional in fact does not provide the necessary §112 support. This compels denial of the petition.

Another independent basis for denial is that neither Petitioner nor its declarant offer any explanation demonstrating how the cited pages of the '187 provisional *themselves* meet or render obvious the RE'543 patent claim language in question. In fact, the Petition does not appear to even suggest it is arguing this position. Again, the '187 provisional in fact does not provide such disclosure.

For every limitation where Callegari is relied upon, the Petition discusses subject matter allegedly disclosed in Callegari, followed by string citations to Callegari and the '187 provisional application. Yet, the Petition fails to explain how any of the string-cited pages *of the '187 provisional* allegedly rendered obvious the claim language in question.

At best, this tactic constitutes an improper request of the Board to peruse each

unexplained '187 provisional string cite and try to piece together a coherent argument on Petitioner's behalf. *See, e.g., Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Re-view of Patent Trial and Appeal Board Decisions*, 77 Fed. Reg. 48,617 (Aug. 14, 2012) (proscribing practices that would force the Board to "play archeologist with the record" and search for arguments outside the briefing) (citing *DeSilva v. DiLeonardi*, 181 F.3d 865, 866–67 (7th Cir. 1999)).

Petitioner's approach is deficient on its face. *See B.E. Tech., L.L.C. v. Google, Inc.*, No. 2015-1827, 2016 WL 6803057, at \*7 (Fed. Cir. Nov. 17, 2016) (agreeing with Board that a mere string citation, without accompanying explanation, did not meet the applicable burden to show written description support); *Intel Corp. v. Alacrittech, Inc.*, IPR2017-01391, Paper 81 at 43–44 (PTAB November 26, 2018) (holding "mere string citations without explanation are insufficient to meet even this lower threshold burden of production" and "[i]t is not the responsibility of the Board to search through the string citations to find sufficient written description support"); *Nichia Corp. v. Emcore Corp.*, IPR2012-00005, Paper 27 at 4, (PTAB June 3, 2013) (stating mere citation "without any explanation is on its face inadequate").

The Patent Owner should not be required to guess as to what Petitioner might have argued had it attempted to explain how the '187 provisional *itself* renders the claim language obvious or provides sufficient written description support for the alleged subject matter of Callegari relied upon in the Petition. The Board should not guess either. *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016) ("[W]e find no support for the PTO's position that the Board is free to adopt

arguments on behalf of petitioners that could have been, but were not, raised by the petitioner”).

Indeed, in the absence of a reasoned argument by Petitioner, Patent Owner has nothing to rebut. Nevertheless, as shown below in the context of exemplary claim limitations, Petitioner’s unexplained, string cites to the ’187 provisional (1) lack § 112 support for the alleged subject matter of Callegari and (2) fail to render obvious the claim language in question.

**1. Alleged Core Element D (collecting): “collecting data at the device”**

As noted above, Petitioner has improperly based its invalidity analysis on alleged “core elements” instead of focusing on the actual claim language. Petitioner relies exclusively on Callegari for this alleged “core element” and cross-references Petitioner’s generic analysis of what it refers to as “Core Element D (collecting): ‘collecting data at the device’” throughout the petition for every challenged independent claim. *See, e.g.*, Pet. 33 (cross-referencing “Section VIII.D” of Pet., which appears on pp. 27–29).

The burden does not shift to Patent Owner here. Nevertheless, scrutiny of the surrounding claim language reveals error arising from Petitioner’s untethered approach.

Setting aside Petitioner’s error in addressing only a contrived abstraction of the claim language, Petitioner’s reliance on Callegari is also deficient as a matter of law. Petitioner’s analysis of what it refers to “Core Element D (collecting)” lists a series

of characterizations of *non-prior-art* subject matter allegedly disclosed in Callegari *alone*, each followed by citations to Callegari and an unexplained string cite to the '187 provision. Pet. 27–29. For example, the Petition alleges:

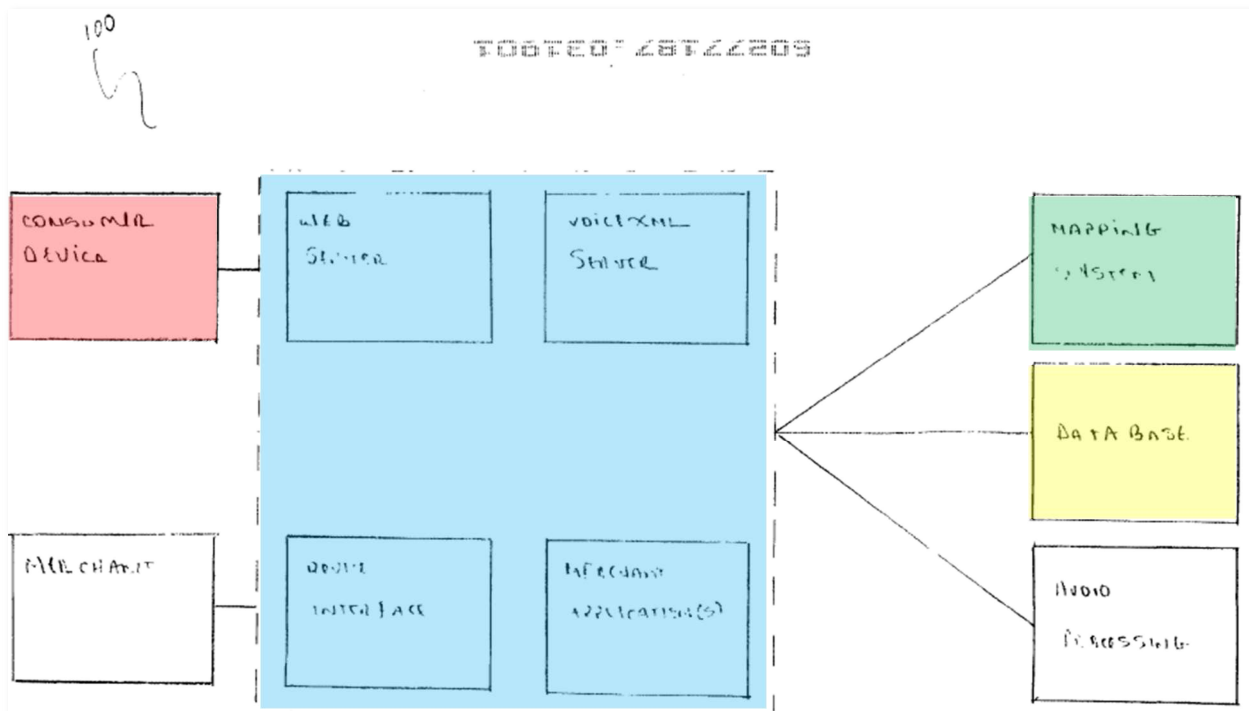
- “*Callegari* discloses that, in sensing mode, the consumer device collects geographic location data using its PDE, including a GPS.” Pet. 27 (citing Ex. 1005 ¶¶ 24, 44, 50, 57–58; Ex. 1007, 1, 5, 11, 13–14, 19, 25–26, and Fig. 3).
- Callegari discloses “[l]ocation data is collected at the consumer device before being reported to the presence server.” *Id.* (citing Ex. 1005 ¶¶ 42, 44, 57; Ex. 1007 11, 13–14, 19, 20, and 25).
- “*Callegari*’s sensing mode also collects data that includes more than one geographic location when a user is moving.” *Id.* 28 (citing Ex. 1005 ¶¶ 42–44; Ex. 1007, 15, 17–18, and 23).
- Alleging Callegari discloses “[t]he consumer device collects location data for these locations as the user’s location changes.” *Id.* 29 (citing Ex. 1005 ¶¶ 42, 57; Ex. 1007, 15, 17–18, 23–24, and 29).

First, the record lacks any explanation or demonstration of how the cited '187 provisional pages allegedly provide § 112 support *for the alleged subject matter relied upon in Callegari*. Second, the record also lacks any argument or explanation as to how the cited '187 provisional pages *themselves* render obvious the claim language. Instead, the Petition and declaration string cite to numerous pages of the '187 provisional without analysis. Petitioner’s burden for institution requires more than effectively a “see generally” citation, without any accompanying explanation.

*See, e.g., Intel Corp.*, IPR2017-01391, Paper 81 at 43–44 and *Nichia Corp.*, IPR2012-00005, Paper 27 at 4.

While the burden lies with Petitioner, who has not met it, what follows is an overview of deficiencies in Petitioner’s unexplained ‘187 provisional string cites. This analysis is offered simply to emphasize the deficiency of the Petition.

Petitioner cites Ex. 1007 at pp. 1, 5, 11, 13, 14, 15, 17-19, 23-26, 29 and Fig. 3 as allegedly meeting this “Core element.” Pet. 27-29. It is unclear how these pages correspond to the actual Ex 1007. Exhibit 1007 Page 1 is the application data cover sheet and provides no useful disclosure. Page 1 of the application itself (page 5 of the exhibit) does not appear to be relevant at all but does mention ‘187 provisional Figure 1, which is reproduced below, with color added for emphasis.



Ex. 1007, '187 provisional, Fig. 1 at p. 38 (coloring added).<sup>12</sup>

Figure 1 of the '187 provisional identifies the “consumer device” as the upper-left-hand box (colored red above). The consumer device is shown in Figure 1 as being distinct and separate from a dotted-line box (colored blue) encompassing a web server, VoiceXML source, device interface, and merchant application(s). *Id.* 4. Both the consumer device (colored red) and the components of the dotted-line box (colored blue) are shown as distinct and separate from the mapping system in the upper-right-hand corner (colored green) and the database (colored yellow). It is significant here that the database is shown as being distinct from and not even directly connected to the consumer device. Only the centralized database is described as “keep[ing] information.” Ex. 1007, 7; *see also id.* 22 (referring to “a central database”).

The '187 provisional cited pages do not describe or provide §112, first paragraph, written description of the consumer device shown in Figure 1 as having *resident thereon* any Positioning Determining Equipment (PDE) configured in the manner Petitioner suggests (though only in characterizing alleged disclosure *in Callegari*). Pet. 27-29. On the contrary, it states, “[t]he consumer device includes any computing device that will allow the consumer to interact with the merchant, such as a wired device or a wireless device.” Ex. 1007, 6–7. This generic description

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<sup>12</sup> Petitioner incorrectly asserts that it reproduced Fig. 1 of the '187 provisional at p. 7 of the Petition. Pet. 7. However, the faded, mirror-image numbering appearing at the top of Petitioner’s reproduction reveals the source to be a document *other than* the '187 provisional. *Id.*, 7 (citing Ex. 1007, Fig. 1). It is unclear why Petitioner did not correctly identify the source of its reproduction.



of the “consumer device” in the ’187 provisional fails to include a PDE as part of the consumer device. Pet. 27-29.<sup>13</sup> It also fails to render obvious the claim language in question.

Page 11 of Ex. 1007 is a cover page to an attached article in the provisional application and provide no useful information. Page 11 of the provisional application (Ex. 1007, page 15) would appear to be the first page of that article. It mentions geolocation in general, but does not provide support or even mention a consumer device that includes a PDE or has any of the features Petitioner asserts are relevant with respect to core element D. In fact, that page merely speculates as to what “will” be available *in the future*. Ex. 1007, p. 15. The speculative nature of this disclosure is apparent in the passage reproduced below:

Wireless data, voice, and wireless appliances are *the next big thing* . . . . We are in the early and opportune stages of this revolution that *will bring* location sensitive applications and services to the masses. This enabling capability *will move* very rapidly into the marketplace, fueled by regulatory requirements and the prospect of new, exciting, and profitable revenue opportunities. [¶] The combination of ubiquitous geolocation capability and state of art computing *will* generate new applications and whole new paradigms of how we live and work.

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<sup>13</sup> That the term “consumer device” does not inherently connote the requirement of having PDE *resident thereon* is confirmed in Callegari. *See, e.g.*, Ex. 1005 ¶ 57 (“The presence server 30 is configured to receive information as to *whether* a particular consumer device 20 includes the PDE 72.”) (emphasis added).

*Id.* (emphasis added). None of the speculation on that page addresses the subject matter at issue; and mere speculation as to what “will” soon be available cannot reasonably be relied upon as providing § 112 support for the alleged subject matter in question of Callegari, much less for what the claim language expressly requires.

Ex. 1007 pages 13 and 14 are tables of contents that provide no useful information. Application pages 13 and 14 (Ex. 1007 pp. 17-18) also fail to provide the necessary support. There is no discussion of “sensing mode” or a PDE, or a consumer device with a PDE thereon.

In fact, these ’187 provisional pages describe the alleged role of a Location Service Provider (LSP) and underscore the lack of written description for the subject matter Petitioner relies on in asserting Callegari. The ’187 provisional states that “[t]he Location Service Provider provides location determining technology abstraction.” Ex. 1007, 17. “This [LSP] provides the ‘where’ attribute and fundamental ‘where’ base functions *so necessary for this system to operate.*” *Id.* 18. The ’187 describes the LSP as “so necessary” for system operation because it is the *only* element identified as providing location information to the presence server. Moreover, Petitioner asserts that the LSP of Callegari is distinct and separate from the consumer device.

If the ’187 provisional had contemplated that the consumer device could use Positioning Determining Equipment (PDE) resident thereon to collect and report its own location, then the LSP would not be “so necessary” because the consumer device could simply collect its location data and provide it directly to the presence server.

Thus, the disclosure in the cited pages directed to the LSP only further underscores a lack of written description support for the alleged subject matter of Callegari, Core element D, much less for what the claims expressly requires.

Ex. 1007 page 15 is described above in connection with application page 11. Application page 15 (Ex. 1007 page 19) appears to be irrelevant and does not provide the necessary support required.

Ex. 1007 pages 17-19 are addressed above in connection with application pages 13-14. They fail to teach the required consumer device or required features including “sensing mode.” Application pages 17-19 (Ex. 1007 pp. 21-23) are similarly irrelevant. The mention that LSP “abstracts the Position Determining Equipment” on Ex. 1007 p. 21 fails to teach or provide §112 support for a consumer device with a PDE thereon and including the features relied upon by Petitioner including a “sensing mode.” In fact, that page and Ex. 1007 p. 23 contain the only references in the ’187 provisional to the phrase “position determining equipment.” That passing reference does not, however, describe the “positioning determining equipment” as being resident upon the consumer device, nor does it attribute to the “positioning determining equipment” the features and functionality Petitioner alleges. At most, the ’187 provisional states “[l]ocations may be created that have an area beyond the origin point and the resolution of *the position determining equipment.*” Ex. 1007, 23.

That “positioning determining equipment” exists somewhere (*e.g.*, at the LSP) and has a “resolution” fails to describe written description support for the alleged

subject matter of Callegari, much less render obvious the claim language at issue. It is also significant that this same section of the '187 provisional states that “[t]he size of a location is determined by *the resolution* of the positioning technology” and that “the Location Service Provider will return” that size. *Id.* 24 (emphasis added). That the resolution size is returned by the LSP reveals that the earlier passing reference to “*resolution* of the position determining equipment” would be understood as referring to equipment of the LSP itself. *Id.* 23–24. There is no argument or evidence in the record concerning the '187 provisional to support any contrary conclusion. Thus, this section, like all other pages included in Petitioner’s string cite, cannot reasonably be relied upon as providing § 112 support for the alleged subject matter in question of Callegari, much less for what the claim language expressly requires. The cite to application p. 18 (Ex. 1007 p. 22) appears wholly irrelevant.

The unexplained string citation in the Petition to pages 23-26 are similarly unhelpful. Ex. 1007 p. 23 was just described. Ex. 1007, pp. 24-26 provide no useful information and Patent Owner is at a loss as to what is being referenced. Application pp. 23-26 (corresponding to Ex. 1007 pp. 27-30) do not help Petitioner. Ex. 1007, pp. 27-28 appear entirely irrelevant to the issue at hand, instead addressing billing and content issues.

Ex. 1007, p. 29 addresses the web interface. Ex. 1007, p. 29. A subsection, under heading “7.9.3 Geolocation,” states, “User will be able to display maps with various features such as locations, services, content, etc.” *Id.* But this does not provide § 112 support for the relied upon alleged teaching of Callegari of the

consumer device *itself* allegedly collecting its own geographic location data automatically, using at least its own Position Determining Equipment (PDE) *residing thereon*. Cf. Pet. 27-28.

Ex. 1007, p. 30 addresses “External Interfaces” which grant “[e]xternal access for service developers” and proposes other server-side applications that may be provided as a service, and appears wholly irrelevant to the relied upon subject matter in Callegari. Ex. 1007, p. 30. Fig. 3 has no relevance to the matter at all as it does not address the consumer device or PDE.

None of the above provides §112, first paragraph, support for the alleged relied upon subject matter of Callegari. Petitioner also fails to even argue or explain how these cites would allegedly meet the claim language in question.

Petitioner’s unexplained string citation to page 29 is also unavailing. Ex. 1007 p. 29 was addressed above. Application page 29 (Ex. 1007 p. 33) provides no disclosure of a consumer device with a PDE thereon or any relevant features at issue for such a device.

It is also unclear why Petitioner included Figure 3 of the ‘187 provisional in a string cite following the assertion that “*Callegari* discloses that, in sensing mode, the consumer device collects geographic location data using its PDE, including a GPS.” Pet. 27. That figure is described as a “Buddy Lists Main Setup Page.” Ex. 1007, 40. It contains no description or illustration of a consumer device that itself collects geographic data using its PDE.

Petitioner compounds its error in relying on certain figures and corresponding description in Callegari that were newly introduced in that application and were not first disclosed in the '187 provisional. *See, e.g.*, Pet. 28, 29 (reproducing Figs. 5B and 1, respectively, of Callegari, with annotations added by Petitioner). This only further underscores the deficiency of the Petition in relying on alleged subject matter contained only in Callegari, which postdates the RE'543 patent.

As shown by the exercise above, even if the Board were inclined to peruse Petitioner's unexplained string cites to the '187 provisional, there still would be no basis to piece together a coherent argument, on Petitioner's behalf, of sufficient § 112 support for the alleged subject matter of Callegari. It is also significant that the record also lacks *any* expert testimony explaining why, or indeed even alleging that, any passage encompassed by the string cite to the '187 provisional provides sufficient § 112 support for alleged subject matter of Callegari. Under the circumstances, Petitioner has not met its evidentiary threshold burden to show that the alleged subject matter of Callegari qualifies as prior art. This is independently fatal to the Petition.

The deficient and unfair approach of the Petition is underscored by the fact that Patent Owner has now utilized numerous pages of the instant preliminary response to address only a few of the unexplained string citations to the '187 provisional listed in the Petition. By offering unexplained string citations to numerous pages of the '187 provisional, Petitioner essentially attempts to incorporate the disclosure by reference, without offering any explanation of its significance. Such a Petition is plainly deficient on its face. Such tacit incorporation also unfairly bypasses word-

count limits for a Petition.

The above deficiencies taint the entire Petition. Every independent claim is analyzed under the same Core element D analysis. The Petition does not rely on any secondary reference to allegedly meet this element. As such, the Petition should be denied in its entirety.

**C. Even if Petitioner demonstrated that Callegari could qualify as prior art, Petitioner failed to establish that it renders obvious the challenged claims**

Because Callegari has not been shown to qualify as prior art, it should be disregarded by the Board. Nevertheless, the Petition is also substantively deficient in its assertion of Callegari, even if one were to look past the failure in the Petition to establish Callegari qualifies as prior art date wise. For the sake of completeness, and to further demonstrate the futility of the Petition, example substantive deficiencies of Callegari are discussed further below with reference to claim 76, though they are generally taint the entire Petition, at least in those instances the same assertion of Callegari is applied.

**1. Petitioner’s application of Callegari overlooks claim language interrelating the “accessing” and “defining” claim limitations versus the “collecting” and/or “reporting” claim limitations in challenged independent claims**

Limitation 76[c] recites “enable access to one or more lists of other users to identify one or more other users with whom the geographic location data may be shared.” Limitation 76[d] recites “enable definition of rights of the one or more other users to access the geographic location data.” Both of these limitations concern

access by the “one or more other users” to the “*geographic location data.*” Limitation 76[a] recites “record geographic location data *while visiting geographic locations using a satellite-based location-fixing protocol.*” Thus, limitation 76[a] defines *the* geographic location data recited in 76[c, d]. Limitation 76[e] states “send at least a portion of *the geographic location data* to a tracking server.”

Petitioner’s theory mixes and matches disparate actions and users in Callegari in a way that simply does not meet these requirements.

In Callegari, users operate in two general classes – content creators and “other users” that may receive the content.<sup>14</sup> A content creator creates “journal entries” that may be associated with specific locations. The content for a journal entry is created *manually* by the content creator and associated with a location. *See, e.g.,* Callegari ¶ 24 (“a journal entry *is entered* using a consumer communication device that may be wired or wireless.”); ¶ 35 (“When the first user 8 encounters a geographic location of interest, *the user* 8 accesses a system provided herein and *makes* a journal entry that includes information content associated with the geographic location and a definition that includes the geographic point of origin 2 and 4 of the location of interest.”); *id.* ¶ 36 (“The second *user* 9 *may also make a journal entry* regarding the same geographic location of interest and that entry will also be presented along with entry by the first user to any user who transmits an indication of location that overlaps with the geographic location of interest.”) (emphasis added in each preceding quotation).

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<sup>14</sup> This terminology is not used in Callegari but is clear from the description. Any given user may be both a content creator and an “other user,” but Petitioner’s theory still does not work in that case either.



The content creator may allegedly choose other users (via a buddy list) with whom this content might be made available to when those other users are in the vicinity of the location associated with the journal entry. For claim limitations 76[c] and 76[d], Petitioner has thus focused on their description of “Core Elements” B and C. Pet. 33 referring back to 24-27. In those sections Petitioner has focused on the content creator and their associated device since they create the “buddy list.” Pet. 24-27; Ex. 1005 ¶ 38 (“a list of users that share access to journal entries made by the first user 8.”), ¶ 79 (“A ‘buddy list’ is a user defined list of other Users with whom User defined location specific information is shared.”).

With respect to the claim limitation 76[b] “recording” and 76[e] “sending” requirements, however, Petitioner has focused on the other users. Pet. 33 referring to Core Elements D and E at Pet. 27-31. That is, the “sensing mode” of Callegari discussed by Petitioner concerns how other users (not the content creator) allegedly might transmit their location information to a server on a continuous or periodic basis so that journal entries in proximity to the transmitted locations may be provided to the device of the other users. Ex. 1005, ¶ 44. This allows devices of these other users (operating in “sensing mode”) to sense they are near the location of the journal entry (and if they are on a buddy list), to be provided the journal entry.

Petitioner’s theory does not meet the claim because Callegari would need to record and send the content creator’s visited geographic location data. Instead, in Petitioner’s flawed theory, Callegari collects or records and sends the other user’s data (from devices operating in “sensing mode”); not the content creator’s.

Petitioner makes a similar error in its treatment of all independent claims. Moreover, Petitioner's theories concerning Eschenbach and Friedman do not address or overcome these deficiencies in Callegari and thus all grounds fail.

**D. No Prima Facie Obviousness for any challenged dependent claim**

It is axiomatic that a dependent claim cannot be rendered obvious if the claim from which it depends is not rendered obvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) ("Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious."). Thus, the challenged dependent claims are not shown in the Petition to be obvious for at least the same reasons articulated above concerning the respective independent claim.

**X. CONCLUSION**

Patent Owner respectfully requests that the Board deny institution for the reasons stated herein.<sup>15</sup>

Date: May 24, 2021

Respectfully submitted,

By: /Howard Wisnia/  
Howard Wisnia; Reg. No. 37,502  
*Attorneys for Patent Owner*

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<sup>15</sup> Patent Owner does not concede as to the correctness of any assertion in the instant Petition not specifically addressed herein.

**CERTIFICATE OF COMPLIANCE**

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that this Preliminary Response to Petition complies with the type-volume limitation of 37 C.F.R. § 42.24(b)(1) because it contains fewer than the limit of 14,000 words, as determined by the word-processing program used to prepare the brief, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a)(1).

Date: May 24, 2021

Respectfully submitted,

By: /Howard Wisnia/  
Howard Wisnia; Reg. No. 37,502  
*Attorneys for Patent Owner*

**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. §§ 42.6(e), the undersigned certifies that an electronic copy of the foregoing PATENT OWNER'S PRELIMINARY RESPONSE PURSUANT TO 37 C.F.R. § 42.107(a), along with any accompanying exhibits that were filed with the paper, was served via the PTAB E2E system and/or via e-mail to Petitioner's counsel of record.

Date: May 24, 2021

Respectfully submitted,

By: /Howard Wisnia/  
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