

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FOURSQUARE LABS, INC.,
Petitioner,

v.

SILVER STATE INTELLECTUAL TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2014-00159
Patent 7,343,165 B2

Before GLENN J. PERRY, LYNNE E. PETTIGREW, and
JEREMY M. PLENZLER, *Administrative Patent Judges*.

PETTIGREW, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

We have jurisdiction to hear this *inter partes* review under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed herein, Petitioner, Foursquare Labs, Inc., has not shown by a preponderance of the evidence

that claim 1 of U.S. Patent No. 7,343,165 B2 (Ex. 1001, “the ’165 patent”) is unpatentable.

A. Procedural History

Petitioner filed a Petition for *inter partes* review of claims 1–5 and 7–9 of the ’165 patent. Paper 1 (“Pet.”). Patent Owner, Silver State Intellectual Technologies, Inc., filed a Preliminary Response. Paper 5. On May 28, 2014, pursuant to 35 U.S.C. § 314, we instituted an *inter partes* review of claim 1 of the ’165 patent on the ground of anticipation by Fraccaroli¹ under 35 U.S.C. § 102(e). Paper 6 (“Inst. Dec.”).

Subsequent to institution, Petitioner filed a Request for Rehearing, Paper 8, which we granted for the limited purpose of modifying our construction of one claim term, Paper 13 (“Reh’g Dec.”). Thereafter, Patent Owner filed a Patent Owner Response, accompanied by a Declaration of Dr. Craig Rosenberg. Paper 14 (“PO Resp.”). Petitioner filed a Reply to the Patent Owner Response, along with a Declaration of Mr. Chris Schmandt. Paper 17 (“Reply”); Ex. 1027. We held an oral hearing on February 24, 2015. A transcript of the oral hearing is included in the record. Paper 27 (“Tr.”).

B. Related Proceedings

The parties indicate that the ’165 patent is the subject of *Silver State Intellectual Technologies, Inc. v. Foursquare Labs, Inc.*, No. 2:12-cv-01308 (D. Nev.). Pet. 1; Paper 4, 2 (Patent Owner’s Mandatory Notices).

¹ U.S. Patent No. 6,549,768 B1, issued Apr. 15, 2003 (Ex. 1003).

C. The '165 Patent

The '165 patent, titled “GPS Publication Application Server,” describes a system and method for providing a mobile device user’s location and information related to the location. Ex. 1001, 1:13–15. The disclosed system includes a Global Positioning System (GPS) server, which receives information from a user’s mobile device, or personal communication device (PCD), over a wireless communication link. *Id.* at 3:43–47. For example, the PCD provides the GPS server with the present location of the PCD and a tag indicating the identity of the PCD. *Id.* at 3:62–64. Information provided to the GPS server includes “information relating to the location of the PCD.” *Id.* at 3:47.

The system also includes an application server, which receives information from the GPS server via the Internet or an intranet. *Id.* at 3:66–4:1. Upon receipt of information related to the PCD and its location, the application server stores the information in a user-specific data space, which may be located on the same computer as the application server or in a separate computer system. *Id.* at 4:1–6. The user and other individuals may contact the application server to request information stored in the user-specific space, such as the location of the PCD or the user’s contact information. *Id.* at 4:12–17. The user may determine the access privileges of individuals requesting information from the user-specific space associated with the user. *Id.* at 4:66–5:3.

D. Challenged Claim

Claim 1, the only claim at issue in this *inter partes* review, reads:

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

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

[c] associating a mobile communication device with the user;

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

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

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

[g] storing the additional data regarding the user in the user-specific space;

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

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

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

Id. at 7:21–42 (with paragraph lettering added by the parties).

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, we construe claim terms in an unexpired patent according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b). Consistent with the broadest reasonable construction standard, claim terms are presumed to have their ordinary and customary meaning, as understood by a person of ordinary skill in the art, in the context of the entire patent

disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

Limitation [f] of claim 1 requires receiving from the user “*additional data* regarding the user, the additional data being related to the geographic location of the user.” Ex. 1001, 7:31–33 (emphasis added). In our Decision on Institution, based on the ordinary and customary meaning as understood by an ordinarily skilled artisan in view of the disclosure of the ’165 patent, we construed this claim language as “data related to the user and to the geographic location of the user that is in addition to data indicative of the location of the user.” Inst. Dec. 7. The parties do not dispute this construction in their respective Patent Owner Response and Reply. Considering all of the evidence of record, we maintain this construction for this Final Written Decision.

Limitation [h] of claim 1 requires receiving from the user “an *access list* of possible requesters of the data and the additional data.” Ex. 1001, 7:36–37 (emphasis added). We initially construed this claim term in our Decision on Institution, and then modified the construction in our Decision on Petitioner’s Request for Rehearing. Inst. Dec. 8–9; Reh’g Dec. 3–4. In view of the ordinary meaning and use of the term in the ’165 patent, we construed this claim language as “a series of possible requesters who have the right to access, or make use of,” the data and the additional data. Reh’g Dec. 4. Neither party challenges this construction, which we maintain for this Final Written Decision after considering the full record.

B. Fraccaroli

Fraccaroli describes a method and system of matching persons through their mobile stations on a wireless communications network.

Ex. 1003, 1:10–13. More specifically, Fraccaroli discloses “a method of initiating contact between persons utilizing a wireless communications network on the basis of their physical location and the similarity of information which they have stored in the network.” *Id.* at 2:47–50. In one application, Fraccaroli’s system initiates contact between people who have indicated an interest in being put in contact with other people with similar interests. *Id.* at 2:50–54. In another possible application, Fraccaroli’s system initiates contact between people who know each other and have indicated a willingness to be put in contact with each other when they are in a certain area at the same time. *Id.* at 2:54–60.

In Fraccaroli, a user’s mobile handset is identified by a USER ID, and its location is determined, for example, using Global Positioning System (GPS). *Id.* at 4:64–65, 8:14–17. A matching profile for each user is stored on a server, along with information identifying the user in the cellular network. *Id.* at 5:30–32, 8:42–44. A user interacts with his profile via the Internet, using a browser on his handset. *Id.* at 8:48–54. The matching profile may include “the characteristics of the service subscriber such as business interests, personal interests, identity information of people whose proximity he wants to be aware of and put in contact with if close enough, etc.” *Id.* at 8:35–39. “The matching profile may range from very generic common interests to the specific identity of known persons. This identity information may . . . include the USER ID corresponding to the user that is utilized in the cellular network.” *Id.* at 8:44–48. A matching engine implements a matching algorithm by comparing matching profiles for each USER ID in a particular area. *Id.* at 5:38–41. When a match between users is made, the system sends a message signal to both users’ mobile stations

indicating a match; the message signal may include the name of the user of the other mobile station and information in the other user's matching profile, including contact information. *Id.* at 10:51–63.

Fraccaroli describes an additional application of the disclosed system:

The matching profile . . . is not limited to those items discussed above with relation to a dating service. In particular, [the] matching profile . . . may have just a few simple fields. For example, the invention could be applied in the situation of a large number of people attending a convention or other large event at the same convention center or other meeting place. The matching profile . . . could have a simple field identifying the user as one of the persons attending the event. The matching system could be set up to identify those persons once they enter the location area surrounding the convention center so that they are “matched” with the information center or registration desk of the convention who can in turn provide assistance. In this application, there is no need for extensive personal information, however the information provided for the user is still referred to as a “matching” profile for the purposes of this application.

Id. at 8:57–9:5.

C. Asserted Ground of Anticipation by Fraccaroli

To prevail in challenging claim 1, Petitioner must demonstrate by a preponderance of the evidence that claim 1 is anticipated by Fraccaroli. *See* 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). A reference anticipates a claim only if it “discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim.” *Net MoneyIN, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008).

The parties' arguments focus on limitations [f], [h], and [j] of claim 1. We begin with Petitioner's contentions regarding these limitations.

Limitation [f] is the step of “receiving, from the user, additional data regarding the user, the additional data being related to the geographic location of the user.” Ex. 1001, 7:31–33. For this limitation, Petitioner relies on the “simple field [in a user’s matching profile] identifying the user as one of the persons attending the event” in the convention scenario described in Fraccaroli. Pet. 29–30 (citing Ex. 1003, 8:60–9:2). Petitioner further states that a user of Fraccaroli’s system populates his own matching profile through a secure web page. *Id.* at 29 (citing Ex. 1003, 8:48–54).

Limitation [h] is the step of “receiving from the user an access list of possible requesters of the data and the additional data.” Ex. 1001, 7:36–37. Petitioner contends that Fraccaroli discloses this limitation because matching criteria in a user’s matching profile “may contain, among other things, specific individuals with whom a user wishes to share profile information when they are in the same vicinity.” Pet. 30 (citing Ex. 1003, 8:44–48).

Limitation [j] is the step of “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. 1001, 7:40–42. For this limitation, Petitioner cites Fraccaroli’s disclosure that when a match is made, the system sends a message signal to a user. Pet. 31–32 (citing Ex. 1003, 10:40–67). Fraccaroli explains that the message signal may include characteristics of the match that has occurred, and “could also include the name of the user of the other mobile station and/or information in the profile of the user of the other mobile station.” Ex. 1003, 10:57–63. Based on this disclosure, Petitioner asserts that Fraccaroli discloses providing message signals that include a user’s matching profile, which, in turn, includes location information and a field for event information. Pet. 32; Reply 13–

14. Thus, Petitioner alleges that when Fraccaroli's system sends a message signal to a matched user, the message signal includes "data indicative of the location of the user" and "additional data regarding the user," i.e., the information in the event field. Pet. 32; Reply 14.

Patent Owner responds to Petitioner's contentions with two main arguments. First, Patent Owner argues that Fraccaroli does not disclose limitation [f]—the "additional data" limitation. PO Resp. 13–16. Second, even if Fraccaroli discloses the "additional data" limitation, Patent Owner contends that Petitioner combines features from multiple distinct embodiments of Fraccaroli. *Id.* at 25–30. Because no single embodiment includes every limitation of claim 1, Patent Owner argues, Fraccaroli does not anticipate because the limitations are not arranged in the same way as recited in the claim. *Id.* at 16–30. We address these arguments in turn.

First, for limitation [f], Petitioner relies solely on the field in a user's matching profile identifying the user as a person attending an event, described in Fraccaroli in connection with a convention or other large event. *See* Pet. 29–30 (citing Ex. 1003, 8:60–9:2). Patent Owner argues that the event field in Fraccaroli's convention scenario does not qualify as "additional data" because it is not "related to the geographic location of the user," as required by claim 1. PO Resp. 14–15. According to Patent Owner, "the geographic location" in limitation [f] must be the "geographic location" that was determined in step [d] by receiving location information from a user's mobile device. *Id.* at 14. In other words, Patent Owner submits that the claim requires step [f] to be performed after step [d], or at least simultaneously with step [d], so that the user's geographic location already

has been determined when additional data regarding the geographic location is received from the user. *See* PO Resp. 14; Tr. 29:8–13.

Patent Owner further asserts that in Fraccaroli’s convention scenario, the system must be informed of the user’s planned attendance at a convention before the user goes to the convention. PO Resp. 14. Thus, Fraccaroli’s system receives information that a user plans to attend a convention, which is information related to the location of the convention. In Patent Owner’s view, the location of the convention cannot be the same as the user’s geographic location determined previously in step [d] because the user has not yet been to the convention. *Id.* at 14–15. Therefore, Patent Owner concludes, the information in Fraccaroli’s event field cannot be “additional data . . . related to the geographic location of the user,” as recited in claim 1. *Id.* at 15.

We are not persuaded by Patent Owner’s argument that Fraccaroli’s event field cannot correspond to the “additional data” recited in step [f] of claim 1. First, Patent Owner has not provided a convincing rationale for construing claim 1 to require the step of receiving additional data (limitation [f]) to be performed after the step of determining a user’s location (limitation [d]). “Unless the steps of a method actually recite or implicitly necessitate a specific order, the steps are not ordinarily construed to require one.” *Interactive Gift Express, Inc. v. CompuServe Inc.*, 256 F.3d 1323, 1342 (Fed. Cir. 2001). Here, the recitation of “a geographic location” in limitation [d] as antecedent basis for “the geographic location” in limitation [f] simply means that both limitations refer to the same “geographic location,” not that the user’s geographic location must be determined and stored before the additional data related to that geographic

location is received and stored. Moreover, we are not persuaded that Fraccaroli's system requires the user to update the event field of his matching profile to indicate he will attend the event in the future. But even if a user of Fraccaroli's system provides data for the event field indicating attendance at a convention at a later time, the geographic location of the convention will be the same as the user's geographic location determined in step [d], which may be performed after the user arrives at the convention. Thus, the data in the event field of a user's matching profile described in connection with the convention scenario in Fraccaroli satisfies the "additional data . . . related to the geographic location of the user" claim language recited in limitation [f] of claim 1.

Patent Owner's second main argument is that Fraccaroli discloses three distinct embodiments, and Petitioner's analysis of how Fraccaroli meets all the limitations of claim 1 "cobbles together features from multiple disparate and inconsistent embodiments." PO Resp. 25. In particular, Patent Owner argues that Petitioner relies on the event field in Fraccaroli's convention embodiment for disclosing the "additional data" limitation of step [f] and relies on aspects of the other two embodiments—the "dating" embodiment and the "closest friend" embodiment—for disclosing limitations [h] and [j]. *Id.* Because no single embodiment includes all of the limitations of claim 1 arranged as recited in the claim, Patent Owner argues that Fraccaroli does not anticipate claim 1. *Id.* (citing *Net MoneyIN*, 545 F.3d at 1371).

In response, Petitioner criticizes Patent Owner's analysis for failing to evaluate Fraccaroli "as a whole." Reply 6–10. Specifically, Petitioner contends that Patent Owner's argument regarding the various examples

discussed in Fraccaroli is based on a misapplication of *Net MoneyIN*. *Id.* at 7. According to Petitioner, the “salient question” is whether Fraccaroli discloses “examples” or “multiple, distinct teachings.” *Id.* In Petitioner’s view, Fraccaroli discloses a single invention and several ways of using it. *Id.* at 7–8.

Based on our review of the record, we find Patent Owner’s argument to be persuasive. Fraccaroli describes three different “applications” of a matching system: the “dating” application (initiating contact between people who have similar interests), Ex. 1003, 2:50–54; the “closest friend” application (initiating contact between people who know each other when they are both present at the same time in a certain area), *id.* at 2:54–60; and the “convention” application (“matching” a user attending a convention with the information center or registration desk), *id.* at 8:60–9:5. Petitioner argues that Fraccaroli describes a matching profile that can be customized by including different parameters or fields, and that the field indicating a user’s attendance at an event is one such field that can be used in any of the applications. Reply 9; Tr. 9:9–14, 13:14–22, 15:12–17:3. Petitioner, however, does not direct us to any disclosure in Fraccaroli of “customization” of a matching profile.

Moreover, although Petitioner cites testimony of Dr. Rosenberg suggesting that an event field could be used in other scenarios, Reply 9 (citing Ex. 1028, 133:6–134:3), Petitioner does not point to, nor do we find, any use in Fraccaroli of the event field outside the convention scenario. Instead, Fraccaroli describes a matching profile for a convention application that has “just a few simple fields,” including a field that identifies the user as a person attending the convention. Ex. 1003, 8:58–65. Significantly,

Fraccaroli explains “there is no need for extensive personal information” in the convention application, but “the information provided for the user is still referred to as a ‘matching’ profile for the purposes of” the convention application. *Id.* at 9:2–5. In view of these statements, we find that the “matching profile” containing the event field for the convention scenario is described as an alternative to, and distinct from, the matching profiles used in the dating and closest friend applications. Similarly, we find that Fraccaroli describes a different matching procedure in the convention application, based on the field identifying the user as attending the event, rather than on other parameters such as common interests. *Compare id.* at 8:65–9:2, *with id.* at 8:35–46.

Petitioner argues that we are not constrained to proceed example-by-example when reviewing an allegedly anticipating prior art reference. Reply 7 (citing *Net MoneyIN*, 545 F.3d at 1369 n.5). Nevertheless, we still must determine whether the reference discloses all of the limitations arranged or combined in the same way as recited in the claim, even while looking at the reference as a whole. *See Net MoneyIN*, 545 F.3d at 1371. Claim 1 is a method claim reciting specific steps. Limitation [f] recites the step of “receiving, from the user, additional data regarding the user, the additional data being related to the geographic location of the user.” In Fraccaroli, only the convention application includes this step, with the information in the event field corresponding to the “additional data” recited in the claim. *See Ex. 1003*, 8:57–9:5. For limitation [h], which recites the step of “receiving from the user an access list of possible requesters of the data and the additional data,” Petitioner relies on information provided by the user in Fraccaroli’s closest friend application, i.e., a list of known

persons with whom the user wishes to share information. Pet. 30 (citing Ex. 1003, 8:44–48). Notably, Petitioner does not contend that the user in Fraccaroli’s convention application places the information center or registration desk on an access list. See Pet. 30–31; Tr. 60:7–11. Thus, the convention application does not include the step of receiving an “access list” from the user (limitation [h]), and the closest friend application does not include the step of receiving “additional data” from the user (limitation [f]).

For limitation [j]—the step of providing location data and additional data to possible requesters on the access list—Petitioner cites Fraccaroli’s description of message signals sent after a match is made. Pet. 31–32. Petitioner contends that message signals containing information from a user’s matching profile are sent in any of the embodiments disclosed in Fraccaroli. Reply 13 (citing Ex. 1003, 10:40–67). Nevertheless, Fraccaroli does not describe a process that includes both the steps of receiving “additional data” from a user and receiving an “access list” from a user. Therefore, even if message signals are sent in all embodiments or applications described in Fraccaroli, the reference does not disclose a process in which message signals including “additional data” are sent to possible requesters on an “access list,” as set forth in limitation [j]. Accordingly, we find that Petitioner has not shown that Fraccaroli discloses all of the limitations arranged or combined in the same way as recited in claim 1 and, thus, has not shown that Fraccaroli anticipates claim 1.

III. CONCLUSION

Based on the evidence and arguments, Petitioner has not demonstrated by a preponderance of the evidence that claim 1 of the ’165 patent is anticipated by Fraccaroli under 35 U.S.C. § 102(e).

IV. ORDER

Accordingly, it is:

ORDERED that claim 1 of U.S. Patent No. 7,343,165 B2 has not been shown to be unpatentable.

This is a final written decision. Parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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