

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WAVEMARKET INC. d/b/a LOCATION LABS,
Petitioner,

v.

LOCATIONET SYSTEMS LTD.,
Patent Owner.

Case IPR2014-00199
Patent 6,771,970 B1

Before KRISTEN L. DROESCH, GLENN J. PERRY, and
SHERIDAN K. SNEDDEN, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Wavemarket, Inc. d/b/a Location Labs (“Petitioner”) filed a Petition¹ (Paper 6, “Pet.”) to institute an *inter partes* review of claims 1–19 of U.S. Patent No. 6,771,970 B1 (“the ’970 Patent”). LocatioNet Systems Ltd. (“Patent Owner”) timely filed a Preliminary Response. Paper 12. In a May 9, 2014 Decision (Paper 18, “Dec.”), we instituted review of claim 18.

Following institution, Patent Owner filed a Response (Paper 35, “PO Resp.”) and Petitioner filed a Reply (Paper 39, “Pet. Reply”). Patent Owner relies upon the Declaration of Narayan Mandayam Ph.D. (Ex. 2016, “Dr. Mandayam’s Declaration”) in support of its Response.

Petitioner relies upon the Declaration of Scott Hotes Ph.D. (Ex. 1013) in support of its Petition and the Declaration of Craig Rosenberg Ph.D. (Ex. 1020, “Dr. Rosenberg’s Declaration”) in support of its Reply.

Patent Owner filed a Motion to Exclude certain of Petitioner’s evidence. Paper 43 (“PO Mot. Excl.”). Petitioner filed an Opposition (Paper 48, “Pet. Opp.”), and Patent Owner filed a Reply (Paper 51, “PO Reply Opp.”). Patent Owner also filed a Motion for Observations on the Cross Examination of Craig Rosenberg Ph.D. (Paper 44, “PO Mot. Obs.”) and Petitioner filed a Response to Patent Owner’s Observations (Paper 49, “Pet. Resp. Obs.”).

¹ Throughout this Decision, we refer to the corrected Petition (Paper 6) filed on December 13, 2013.

Petitioner filed a Motion to Exclude certain of Patent Owner's evidence. Paper 42. Patent Owner filed an Opposition (Paper 47), and Petitioner filed a Reply (Paper 50).

We heard oral argument on February 10, 2015. Paper 55 ("Tr.").

We have jurisdiction 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 that follow, Petitioner has shown by a preponderance of the evidence that claim 18 is unpatentable.

B. Related Proceedings

Petitioner indicates the '970 Patent is at issue in the following actions (Pet. 2):

- (1) *CallWave Communications, LLC v. AT&T Mobility, LLC*, No. 1:12-cv-01701-RGA (D. Del.);
- (2) *CallWave Communications, LLC v. Sprint Nextel Corp*, No. 1:12-cv-01702-RGA (D. Del.);
- (3) *CallWave Communications, LLC v. T-Mobile USA Inc*, No. 1: 12-cv-01703-RGA (D. Del.);
- (4) *CallWave Communications, LLC v. Verizon Communications Inc.*, No. 1:12-cv-01704 (D. Del.); and
- (5) *CallWave Communications, LLC v. AT&T Mobility LLC*, No. 1:12-cv-01788 (D. Del.).

C. The '970 Patent

The '970 Patent relates to a system and method for location tracking of mobile platforms. Ex. 1001, Abs., col. 2, ll. 2–28, col. 3, ll. 4–24.

Figure 1 of the '970 Patent, reproduced below, schematically depicts a location tracking system. *Id.* at col. 3, ll. 31–32.

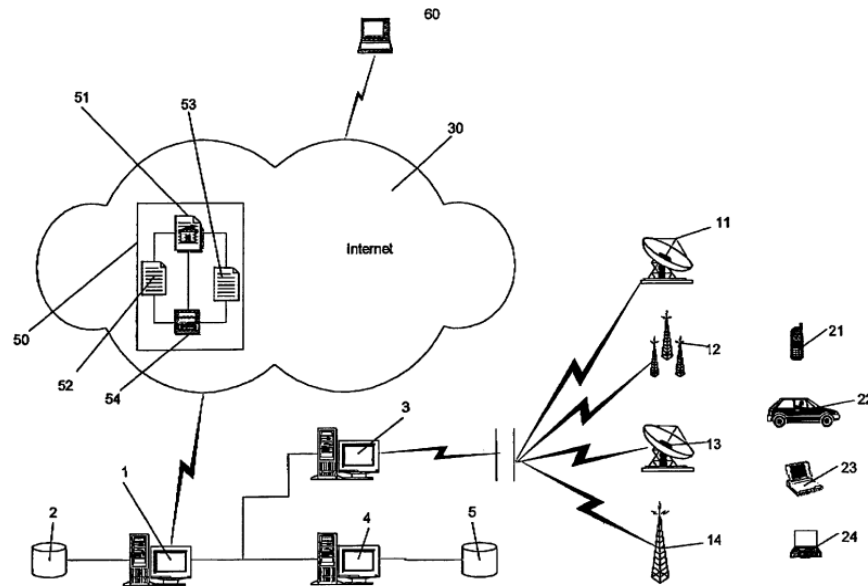


Figure 1 illustrates mobile platforms 21, 22, 23, and 24, and location tracking systems 11, 12, 13, and 14 that communicate with communication subsystem 3 of location determination system 1. Ex. 1001, col. 3, l. 44–col. 4, l. 11. Location determination system 1 is linked to database 2 and map server 4 that accesses map database 5. *Id.* at col. 4, ll. 12–22. Location determination system 1 hosts website 50 on Internet 30. *Id.* at col. 4, ll. 23–28. A subscriber to location determination system 1, and equipped with computer 60 running an internet browser, logs on to website 50 and selects a mobile platform from among mobile platforms 21–24 for which the location is sought. *Id.* at col. 4, ll. 29–39. The request is passed from web site 50 to location determination system 1, which passes the request to communication

subsystem 3. *Id.* at col. 4, ll. 12–15, 39–45. Communication subsystem 3 formats the request for transmission to a location tracking system 11–14, and transmits the request. *Id.* at col. 4, ll. 6–11, 46–48, col. 5, l. 51–col. 6, l. 2. Location tracking system 11–14 receives the request, determines the location of the requested mobile platform, and transmits the location information back to communication subsystem 3. *Id.* at col. 4, ll. 48–52, col. 6, ll. 2–11. Communication subsystem 3 associates the location information with the request and passes it to location determination system 1, which passes the location of the requested mobile platform 21–24 to map server 4. *Id.* at col. 4, ll. 52–56. Map server 4, using a map engine, obtains a map of the area in which the requested mobile platform 21–24 is located, marks the position of the mobile platform on the map, and passes it to location determination system 1. *Id.* at col. 4, ll. 56–59. The map then is passed to the web browser running on subscriber's computer 60. *Id.* at col. 4, ll. 60–61, col. 5, ll. 19–24.

D. Claim 18

Claim 18 is reproduced below (disputed limitations italicized):

18. A system for location tracking of mobile platforms, each of which is equipped each with a tracking unit, each being adapted to determine the location of a respective mobile platform according to a property that is predetermined for each mobile platform; the system comprising:

(a) a location server communicating through a user interface with at least one subscriber equipped with a browser; said communication having inputs that include at least the subscriber identity, the mobile platform identity and map information;

(b) at least one mobile platform location system coupled to said location server for receiving the mobile platform identity

and map information that pertain to mobile platforms associated with the respective mobile platform location system; *each one of said mobile platform location systems being associated with a map database and map engine for manipulating said map database;*

(c) at least one remote tracking service communicating with said respective mobile platform location system for receiving mobile platform identity and returning mobile platform location information;

the at least one mobile platform location system being adapted to receive said mobile platform location information and access said map database for correlating map to said location information, so as to obtain correlated location information;

said location server being adapted to receive the correlated location information and forward them to said browser.

II. ANALYSIS

A. Claim Construction

We interpret claims using the “broadest reasonable construction in light of the specification of the patent in which [they] appear[.]” 37 C.F.R. § 42.100(b); *see* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). “[C]laim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (quotations and citation omitted). “[T]he specification ‘is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (en banc) (quoting *Vitrionics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (1996)). Extrinsic evidence, such as dictionaries and expert testimony, may be useful, but it is unlikely to result

in a reliable interpretation of patent claim scope unless considered in the context of the intrinsic evidence. *Id.* at 1319.

For the purpose of our Decision instituting *inter partes* review we did not construe expressly any of the claim terms and phrases recited in claim 18. *See* Dec. 6–7. In its Response, Patent Owner presents explicit constructions for “map database” and “map engine for manipulating said map database,” recited in claim 18. PO Resp. 10–11, 13.

Map Database

Patent Owner asserts, with supporting expert testimony, “the ordinary and customary meaning of map ‘database’ as understood by a person of ordinary skill in the art as well as a layperson is a collection of map data that is organized so that it can easily be accessed, searched, managed, and updated.” PO Resp. 10–11 (citing Ex. 2016 ¶ 28; Ex. 2017, 61; Ex. 2018, 126). Patent Owner relies on the testimony of Dr. Narayan Mandayam, which provides two dictionary definitions to support the opinion regarding the ordinary and customary meaning of map database. Ex. 2016 ¶ 28 (citing Ex. 2017, 61; Ex. 2018, 126). The provided dictionaries define “database” as follows: (1) “[a]n organized collection of information that can be searched, retrieved, changed, and sorted using a collection of programs known as a database management system” (Ex. 2017, 61); and (2) “[a] collection of information organized in such a way that a computer program can quickly select desired pieces of data” (Ex. 2018, 126).

Turning to the intrinsic evidence, the ’970 Patent Specification utilizes the term “map database” in the following contexts: (a) “maps stored in the database (5),” (b) “a map from said at least one map database,” (c) “[t]he

map database may include maps formatted as at least one of the following: Raster Map in various scales, vector maps and air photo,” (d) “[a] map database (5) in formats such as Raster, Vector, Topographic or aerial photographs;” and (e) “accessing a map database (5).” Ex. 1001, col. 2, ll. 32, 46–48, col. 4, ll. 15–17, col. 5, ll. 3–6.

We are not persuaded by Patent Owner’s argument that its proposed construction of “map database” is consistent with the ’970 Patent Specification. PO Resp. 11 (citing Ex. 1001, col. 2, ll. 46–48, col. 4, ll. 15–22, col. 5, ll. 45–50). Patent Owner’s proposed construction is narrower than the ’970 Patent’s broad disclosure of a map database as collection of maps that can be accessed. In addition, Dr. Mandayam’s opinion is not supported fully by the provided dictionary definitions for database. *See* 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”).

We give more weight to the intrinsic evidence than we give to Patent Owner’s extrinsic evidence, as the ’970 Patent Specification serves as the best guide regarding the construction of “map database.” Accordingly, the broadest reasonable construction in light of the ’970 Patent Specification for “map database” is an organized collection of map data that can be accessed.

Map Engine for Manipulating Said Map Database

Patent Owner contends, with supporting expert testimony, “the ordinary and customary meaning of the term map database ‘engine’ as understood by a person of ordinary skill in the art and a layperson is a program or module for accessing, searching, managing, and updating the

map database.” PO Resp. 13–14 (citing Ex. 2016 ¶ 32; Ex. 2019, 208). For clarification, claim 18 recites “map engine for manipulating said map database” Ex. 1001, col. 8, l.61, not “map database engine,” as asserted by Patent Owner. In other words, Patent Owner contends a “map engine” should be construed as a program or module, and the phrase “for manipulating said map database” should be construed as “for accessing, searching, managing, and updating the map database.” *Id.* Patent Owner’s expert Dr. Narayan Mandayam provides a dictionary definition to support the opinion regarding the ordinary and customary meaning of map engine. Ex. 2016 ¶ 32 (citing Ex. 2019, 208). The provided dictionary defines “engine” as “[t]he portion of the program that determines how the program manages and manipulates data. Another name for processor.” Ex. 2019, 208.

Petitioner counters Patent Owner’s proposed construction and points out that the ’970 Patent Specification recites the term “map engine” in two instances, and does not include the term “manipulating.” Pet. Reply 9 (citing Ex. 1001 col. 4, ll. 5–17, 55–58); *see* Ex. 1001. The ’970 Patent Specification discloses the interaction of the map engine and map database in the following contexts: (1) “a map server (4) operating a **map engine for accessing a map database** (5),” and (2) “the map server (4) which **obtains a map** of the area in which the vehicle (22) is **located using the map engine.**” Ex. 1001, col. 4, ll. 15–17, 55–59 (emphases added). Petitioner argues that based on the ’970 Patent Specification disclosure, “it must be presumed that accessing and/or obtaining a map from a map database reads on the claimed ‘manipulating’ of the map database.” Pet. Reply 9.

The '970 Patent relies on Provisional Patent Application 60/157,643 (Ex. 1002, "'643 Application") to establish domestic priority. The '643 Application includes language nearly identical to the language recited in claim 18 (*compare* Ex. 1001, claim 18, *with* Ex. 1002, 2, claim 1), and provides additional illumination regarding the disclosed interaction of the map engine and map database. Specifically, the '643 Application discloses the interaction of the map engine and map database in the following contexts: (1) "[e]ach of the specified Company Devices ((41) to (44))[(i.e., mobile platform location systems)] is associated with a map database (not shown) and **a known *per se* map engine for accessing the map database . . . ;**" and (2) "[t]he latter [(i.e., unit 41)] correlates the so received location data with the desired **map** (as defined in input (63)) **as extracted from the map database using its integrated map engine.**" Ex. 1002, 4, ll. 1–3, 5, ll. 4–6 (emphases added). The disclosure in the '643 Application of the map engine accessing the map database, and extracting a map from the map database, is consistent with, and complementary to, the '970 Patent Specification disclosure of the map engine accessing the map database, and obtaining a map from the map database.

We are not persuaded that Patent Owner's proposed construction for "map engine for manipulating said map database" is consistent with the '970 Patent Specification and the express language of claim 18. PO Resp. 14 (citing Ex. 1001, col. 4, ll. 16–17, 55–58, claim 18; Ex. 2016 ¶ 32); *see also* Tr. 16–18 (asserting the '970 Patent Specification discloses the step of

correlating is performed using the map engine).² Patent Owner’s proposed construction is narrower than the ’970 Patent and ’643 Application disclosures of the map engine accessing the map database, or obtaining or extracting a map from the map database. Additionally, Dr. Mandayam’s opinion is not supported fully by the provided dictionary definitions for the term “engine.” See 37 C.F.R. § 42.65(a).

We give more weight to the intrinsic evidence than we give to Patent Owner’s extrinsic evidence, as the ’970 Patent Specification serves as the best guide regarding the construction of “map engine for manipulating said map database.” Therefore, the broadest reasonable construction in light of the ’970 Patent Specification for “map engine for manipulating said map database” is an element or component for accessing the map database or obtaining or extracting map data from the map database.

B. Asserted Ground of Unpatentability

We instituted review of claim 18 as unpatentable under 35 U.S.C. § 102(e) as anticipated by Elliot.³ Dec. 15–17, 30.

Elliot

Elliot describes a wireless communications system which tracks the current and historical locations of a device worn or carried by a person, and

² The ’970 Patent discloses the *map server* (4) is capable of correlating between maps stored in the database (5) and the received positioning information. Ex. 1001, col 4, ll. 17–20. Similarly, claim 18 recites the “mobile platform location system being adapted . . . for correlating map to said location information so as to obtain correlated location information.”

³ U.S. Patent No. 6,243,039 B1 (Ex. 1003).

provides widely available access to the data referencing these locations. Ex. 1003, col. 2, ll. 29–35.

Figure 1 of Elliot, reproduced below, depicts the network architecture of the system. Ex. 1003, col. 4, ll. 18–19.

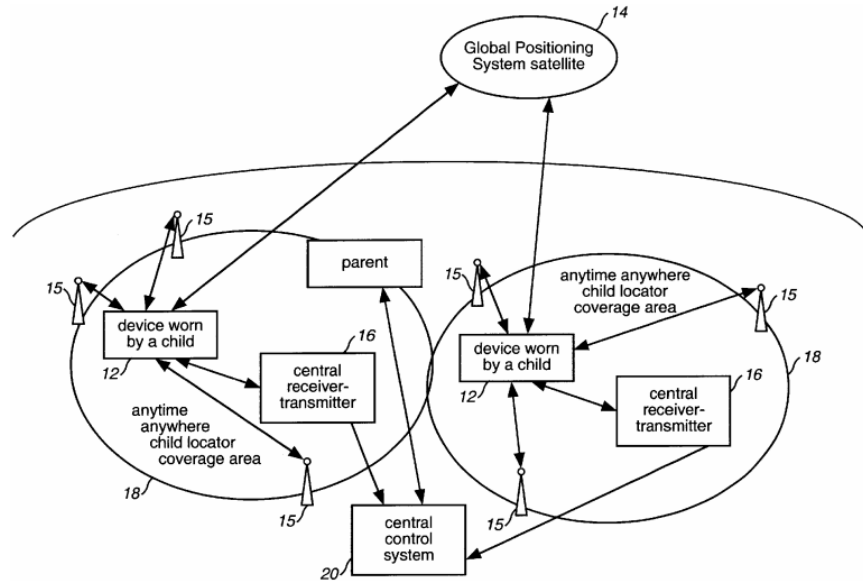
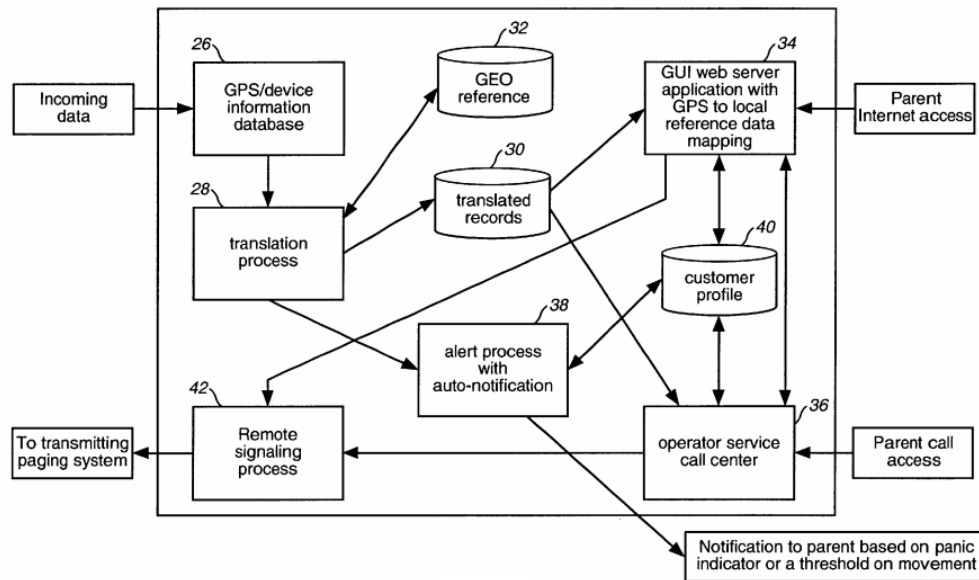


Figure 1 illustrates device 12 worn or carried by a child, GPS (Global Positioning System) satellite 14, ground based position systems 15, central receiver-transmitter 16, and central control system 20. *Id.* at col. 4, l. 52–col. 5, l. 46. Device 12 receives broadcast signals from each of three GPS satellites 14, triangulates the three signals, and determines the coordinates of the current location of device 12. *Id.* at col. 4, ll. 55–58. “Similarly, the signals may be received from [] ground based position system 15.” *Id.* at col. 4, ll. 59–60. Device 12 encodes the location coordinates into a data package and sends the data to central receiver-transmitter 16, which may be any type of cellular transmission system. *Id.* at col. 4, l. 66–col. 5, l. 5. The data signal transmitted by device 12 includes the current GPS coordinates, the current time, and the device identification code of transmitting device 12.

Id. at col. 5, ll. 32–35. Central receiver-transmitter 16 receives the transmission from device 12 and forwards the data signal to centralized control system 20. *Id.* at col. 5, ll. 41–43.

Figure 3 of Elliot, reproduced below, depicts the process architecture of central control system 20. Ex. 1003, col. 4, ll. 22–23, col. 6, ll. 18–19.



The central control system of Figure 3 includes GPS/device information database 26, translation process 28, translated record database 30, and web server 34. *Id.* at col. 6, ll. 31–65, col. 7, ll. 1–13. Central control system 20 receives data from device 12 via central receiver-transmitter 16, decodes the data from the transmission message, and stores the data in GPS/device information database 26. *Id.* at col. 6, ll. 22–24, 31–32, 35–36. The data include the current GPS coordinates of device 12, the current time stamp, and device identification code. *Id.* at col. 6, ll. 32–34. Translation process 28 translates the GPS coordinates to a commonly recognized location reference, such as graphical maps. *Id.* at col. 6, ll. 37–38, 45–52, col. 2, ll. 11–13. The translated data signals are stored as records in translated record

database 30. *Id.* at col. 6, ll. 64–65. Web server 34 functions as a web interface for central control system 20 to enable web access to central control system 20. *Id.* at col. 7, ll. 1–5. Web server 34 provides the subscriber parent with the location data stored in translated record database 30 by transmitting a graphical map display embedded in a web page by incorporating a graphic source file for the map into an HTML page as a graphics file “image” (i.e., map source file, graphics image source file, GIF), and including the current GPS coordinates of device 12 depicted on the map with a distinguishing mark “X.” *Id.* at col. 6, ll. 47–50, col. 7, ll. 6–13, col. 9, ll. 12–42. Maps of non-local areas are also available. *Id.* at col. 9, l. 10; *see also id.* at col. 3, ll. 2–4 (web server 34 with its associated files provides graphical maps).

Claim 18

Patent Owner does not dispute Petitioner’s assertions that Elliot describes the majority of the subject matter recited in claim 18. *See* PO Resp. 1–16; Pet. 30–33. Patent Owner’s arguments instead focus on the following limitations of claim 18: “each one of said mobile platform location systems being associated with a map database and map engine for manipulating said map database.” PO Resp. 1–3, 8–16. Petitioner asserts Elliot’s web server 34 functions as a web interface for central control system 20, and the web server 34 with its associated files provides graphical maps capable of showing the current and historical locations of device 12, thus, Elliot describes the disputed limitations of claim 18. Pet. 31 (quoting Ex. 1003, col. 3, ll. 2–4, col. 7, ll. 1–7).

Relying on its proposed construction for “map database,” discussed above in Section II.A., Patent Owner contends, with supporting expert testimony, Elliot’s web server does not describe a map database because it “fails to describe any data organization, management or functionality required for a database.” PO Resp. 10–11 (citing Ex. 2016 ¶¶ 26–28). Patent Owner also asserts Elliot’s disclosure of a web server that “provides” graphical maps does not describe the source of the graphical maps. *Id.* at 11–12 (citing Ex. 2016 ¶ 29).

In response to Patent Owner’s arguments, Petitioner contends Patent Owner ignores Elliot’s disclosure of not only a web server but the disclosure of a collection of graphical map files. Pet. Reply 3. Petitioner asserts Patent Owner’s expert Dr. Mandayam acknowledges that Elliot discloses a collection of graphical map files. *Id.* (citing Ex. 1019, 40, l. 18–41, l. 3). Petitioner argues Elliot is explicit that “graphical maps” or a “graphical display of a map” is a specific type of what Elliot refers generally to as a “location reference,” and “[t]he ‘collection’ of location references (*i.e.*, maps) is explicitly in the form of a database.” *Id.* at 4–5 (citing Ex. 1001, claim 10, col. 2, ll. 11–13, col. 5, ll. 52–57, col. 6, ll. 36–37, 64–67, col. 7, ll. 6–16, Fig. 3). With supporting expert testimony, Petitioner makes the following additional contentions: (1) “one of ordinary skill in the art would understand that [Elliot’s] ‘associated files’ that provide[] the . . . graphical maps to [web] server [34] constitute what Elliot expressly discloses as a map database (*e.g.* 30, Fig. 3);” and (2) Elliot “makes clear that the files contained in the database are organized in a way that makes them accessible.” *Id.* at 5 (citing Ex. 1020 ¶¶ 12–26); *see also* Tr. 34, l. 15 (“Our position is that database 30 [of Elliot] is the map database.”).

Based upon our review of the arguments and supporting evidence presented by each of the parties, we are persuaded that Petitioner has demonstrated by a preponderance of the evidence that Elliot's database 30, which includes graphical maps that can be accessed by web server 34, describes the "map database" recited in claim 18 and constitutes an organized collection of map data that can be accessed.

Relying on its proposed construction for "map engine for manipulating said map database," discussed above in Section II.A., Patent Owner contends Elliot's description suggesting commercially available software programs for producing and manipulating graphics images does not disclose a "map engine for manipulating said map database." PO Resp. 13–15 (citing Ex. 2016 ¶¶ 33–34).

In response, Petitioner contends Patent Owner's arguments mischaracterize the Petition and Decision instituting *inter partes* review. Pet. Reply 8. Petitioner clarifies that it is Elliot's web server 34 and the interaction of the web server 34 and the database 30 which describes the "map engine for manipulating said map database." *Id.* at 10–11 (citing Ex. 1003, col. 3, ll. 2–4, col. 7, ll. 1–13). Specifically, Petitioner directs attention to Elliot's description of web server 34 functioning as a web interface for central control system 20 to enable web access to the central control system, and web server 34 providing a subscriber with location data stored in the translated records database 30 in a graphical map display format. *Id.* at 11 (citing Ex. 1003, col. 7, ll. 1–13). Petitioner asserts, with supporting expert testimony, that based on Elliot's description, it is clear that Elliot's web server 34 accesses and obtains graphical map files from the map

database 30, and necessarily constitutes a “map engine for manipulating said map database.” *Id.* (citing Ex. 1020 ¶¶ 32–34).

Upon consideration of arguments and supporting evidence of each of the parties, we are persuaded by a preponderance of the evidence that Elliot’s web server 34 that accesses graphical maps from database 30 describes the “map engine for manipulating said map database,” recited in claim 18 and broadly constitutes an element or component for accessing the map database or obtaining or extracting map data from the map database.

We are not persuaded by Patent Owner’s conclusory statement that “Elliot fails to disclose that each one of the mobile platform locations systems is ‘associated with’ a corresponding map database and map engine, as required by claim 18.” PO Resp. 1–2; *see id.* 8, 9–10 (citing Ex. 2016 ¶ 26), 15–16. Patent Owner relies largely on arguments directed to the “map database,” and “map engine for manipulating said map database,” and does not meaningfully explain why Elliot fails to describe “each one of said mobile platform location systems being associated with a map database and map engine for manipulating said map database,” recited in claim 18. Patent Owner’s arguments also are not commensurate in scope with the claim limitations because claim 18 does not require a *corresponding* map database and map engine for each mobile platform location system. *Compare* PO Resp. 1–2, 8, 9–10, *with* Ex 1001, claim 18.

Patent Owner does not attempt to distinguish any other features of claim 18 over the system disclosed by Elliot. The record contains the same arguments and evidence regarding the merits of the alleged anticipation by Elliot of the remaining elements of claim 18 as it did at the time of our Decision to institute *inter partes* review. Accordingly, the preponderance of

the evidence of record supports a finding that Petitioner has set forth how the remaining limitations of claim 18 are described by Elliot. *See* Pet. 30–33.

Based on our review of the record before us, we are persuaded that Petitioner has shown by a preponderance of the evidence that Elliot anticipates claim 18.

C. Petitioner’s Motion to Exclude Evidence

Petitioner moves to exclude certain portions of Dr. Mandayam’s Declaration (Ex. 2016), and Exhibits 2017 through 2019 in their entirety. Paper 42. We do not rely on the aforementioned Exhibits in reaching our Decision. Accordingly, we dismiss Petitioner’s Motion to Exclude Evidence as moot.

D. Patent Owner’s Motion to Exclude Evidence

Patent Owner moves to exclude Dr. Rosenberg’s Declaration (Ex. 1020) in its entirety as inadmissible under Federal Rules of Evidence (“FRE”) 402, 403, 702, 703 and 37 C.F.R. § 42.65. PO Mot. Exclude 1. Patent Owner asserts Dr. Rosenberg’s Declaration is inadmissible for the following reasons:

because it fails to assist a trier of fact to understand or determine a fact in issue, is based upon insufficient facts or information, is not the product of reliable principles and methods, does not reliably apply the principles and methods to the facts of this case, and/or its probative value is substantially outweighed by the risk of prejudice and/or confusion.

Id. (citing FRE 402, 403, 702, 703).

Patent Owner argues that Exhibit 1020 is inadmissible under FRE 702 because Dr. Rosenberg is not qualified as a person of ordinary skill in the art. PO Mot. Excl. 2–5 (citing *Sundance, Inc. v. DeMonte Fabricating Ltd.*,

550 F3d 1356, 1358 (Fed. Cir. 2008); *see* PO Reply to Opp. 1–3 (citing *Morpho Detection, Inc. v. Smiths Detection, Inc.*, No. 2:11-cv-498, 2012 WL 6004085, *1–2 (E.D. Va. Nov. 30, 2012)). Specifically, Patent Owner argues that Dr. Rosenberg’s degrees in Industrial Engineering and Human Factors and completion of core engineering coursework do not meet the qualifications of a person of ordinary skill in the art set forth by either Patent Owner’s expert or Petitioner’s expert. PO Mot. Excl. 2–4 (citing Ex. 1020, 3; Ex. 1013, 6; Ex. 2016, 5; Ex. 2021, 1). Patent Owner also argues that Dr. Rosenberg’s work experience in “user interface design and software architecture” does not constitute work experience in “client-server systems, networking technologies and applications, data translations systems, and wireless and Internet communication protocol.” PO Mot. Excl. 4 (citing Ex. 1020, 2–5; Ex. 1013, 6).

Federal Rule of Evidence 702 permits a witness qualified as an expert by knowledge, skill, experience, training, or education to testify in the form of an opinion if a) the expert’s knowledge will help the trier of fact to understand the evidence or to determine a fact in issue, (b) the testimony is based upon sufficient facts or data, (c) the testimony is the product of reliable principles and methods, and (d) the witness has applied the principles and methods reliably to the facts of the case.

Patent Owner does not direct us to binding authority sufficient to support its argument that in order for expert testimony to be admissible, the expert must be a person of ordinary skill in the art. We agree that “there is no requirement imposed by the FRE that an expert’s qualifications perfectly match the field of the patent at issue.” Pet. Opp. 6 (citing *SEB S.A. v. Montgomery Ward & Co.*, 594 F.3d 1360, 1373 (Fed. Cir. 2010)); *see also*

Mytee Prods., Inc. v. Harris Research, Inc., 439 F. App'x 882, 886–87 (Fed. Cir. 2011) (non-precedential) (upholding district court's admission of testimony of an expert who "had experience relevant to the field of the invention," despite admission that he was not a person of ordinary skill in the art). We also are persuaded by Petitioner's arguments that Dr. Rosenberg's experience is adequate to establish his technical expertise. Pet. Opp. 7 (citing Ex. 1020 ¶¶ 5, 6, 8; Ex. 1020, 23). In particular, and germane to the '970 Patent, we note Dr. Rosenberg has over four years of experience serving as the founder and CEO of a technology company WhereWuz which focuses on location tracking applications for GPS enabled smartphones. See Pet. Opp. 7; Ex. 1020 ¶ 8.

Patent Owner also contends that Dr. Rosenberg's Declaration is inadmissible under FRE 402, 403, 702, and 703 because Dr. Rosenberg's opinions: (1) are conclusory, (2) fail to apply any relevant and reliable analysis to the facts of the case, (3) do not disclose the underlying facts in many instances, (4) are not a product of reliable principles and methods applied to the facts of this case; and (5) lack any probative value. PO Mot. Excl. 5–6. Patent Owner asserts Dr. Rosenberg's opinion is not a product of reliable principles and methods because Dr. Rosenberg fails to identify definitions for "database," "manipulating," or "map engine for manipulating said map database," and does not explain what a person of ordinary skill in the art would understand the claim terms to mean in the relevant context. *Id.*; see PO Reply Opp. 3–5. Patent Owner also contends Dr. Rosenberg's Declaration lacks any probative value because Dr. Rosenberg lacks the qualifications of a person of ordinary skill in the art, and has failed to apply any relevant and reliable analysis to the facts of the case. PO Mot. Excl. 6.

Patent Owner's arguments addressing Dr. Rosenberg's testimony in this regard goes to the weight to be given to Dr. Rosenberg's testimony, not to its admissibility. *See* 37 C.F.R. § 42.65(a). It is within our discretion to assign the appropriate weight to the testimony offered by Dr. Rosenberg. *See, e.g., Yorkey v. Diab*, 601 F.3d 1279, 1284 (Fed. Cir. 2010) (holding the Board was well within its discretion to give more weight to one item of evidence over another "unless no reasonable trier of fact could have done so."); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d at 1368 ("[T]he Board is entitled to weigh the declarations and conclude that the lack of factual corroboration warrants discounting the opinions expressed in the declarations."). We are capable of determining the appropriate weight to be given to Dr. Rosenberg's testimony without risk of being prejudiced, confused, or misled by Dr. Rosenberg's testimony.

Accordingly, Patent Owner's Motion to Exclude is denied because Patent Owner has not demonstrated that Dr. Rosenberg's Declaration is inadmissible.

E. Patent Owner's Observations

Patent Owner's observations are directed to the cross-examination testimony of Dr. Rosenberg (Ex. 2022), who was deposed after Petitioner filed its Reply. We have considered Patent Owner's observations and Petitioner's response addressing whether certain portions of Dr. Rosenberg's cross-examination testimony: (1) contradict or undermine the testimony in the Dr. Rosenberg's Declaration (Ex. 1020) and the arguments in Petitioner's Reply, (2) call into question the analysis utilized by Dr. Rosenberg in rendering his opinion; and (3) support the arguments in Patent

Owner's Response. *See* PO Mot. Obs. 2–13; Pet. Resp. Obs. 2–15. We have accorded Dr. Rosenberg's testimony the appropriate weight, but Patent Owner's observations do not change our findings or conclusions.

III. CONCLUSION

Petitioner has shown by a preponderance of the evidence that claim 18 is unpatentable. Petitioner's Motion to Exclude Evidence is dismissed as moot. Patent Owner's Motion to Exclude Evidence is denied.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claim 18 of the '970 Patent is determined to be unpatentable;

FURTHER ORDERED that Petitioner's Motion to Exclude is dismissed as moot;

FURTHER ORDERED that Patent Owner's Motion to Exclude is denied; and

FURTHER ORDERED that because 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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