

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

LOCATIONNET 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*.

DECISION ON REQUEST FOR REHEARING
37 C.F.R. § 42.71(d)

I. INTRODUCTION

A. Background

In a May 9, 2014 Decision (Paper 18, “Dec.”), we instituted *inter partes* review of claim 18 of U.S. Patent No. 6,771,970 B1 (“the ’970 Patent”).

Following institution, LocationNet Systems Ltd. (“Patent Owner”) filed a Response (Paper 35, “PO Resp.”) and Wavemarket, Inc. d/b/a Location Labs (“Petitioner”) filed a Reply (Paper 39, “Pet. Reply”). Petitioner relies upon the Declaration of Craig Rosenberg Ph.D. (Ex. 1020) 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.”).

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

Patent Owner filed a Request for Rehearing (Paper 57, “Req. Reh’g”) of our Final Written Decision (Paper 56, “Final Dec.”) of May 7, 2015 in which claim 18 of the ’970 Patent was determined to be unpatentable.

II. STANDARD OF REVIEW

In its request for rehearing, the dissatisfied party must identify, specifically, all matters the party believes the Board misapprehended or overlooked, and the place where each matter was addressed previously. 37 C.F.R. § 42.71(d). Upon a request for rehearing, the decision on a petition will be reviewed for an abuse of discretion. 37 C.F.R. § 42.71(c).

III. DISCUSSION

Patent Owner argues the Board misapprehended or overlooked the intrinsic evidence supporting the proper claim construction for the terms “map database,” and “map engine for manipulating said map database.” Req. Reh’g. 1. Patent Owner also argues the Board misapprehended or overlooked the evidentiary standard for admissible expert testimony. *Id.*

Intrinsic Evidence for Claim Construction

Patent Owner argues the Board, in rendering the Final Written Decision, misapprehended or overlooked intrinsic evidence against our construction of “map database,” and “map engine for manipulating said map database,” that is overly broad and unreasonable. Req. Reh’g 2–8. Specifically, Patent Owner argues that we misapprehended or overlooked the ’970 Patent’s disclosure of numerous functions performed using the claimed “map database,” including the following:

supplying “street names derived from map databases” (Ex. 1001 at 5:45-50), “correlating between maps stored in the database (5)” (*id.* at 4:15-20), “the step of correlating the location of each remote platform with a map database” (*id.* at 3:21-25), “access said map database for correlating map to said location information, so as to obtain correlated location information” (*id.* at 9:1-3).

Req. Reh’g 3 (citing PO Resp.10–11; PO Mot. for Observations 11–13; Tr.14, ll. 8–24, 19, ll. 14–19).

We are not persuaded by Patent Owner’s argument that our claim construction is unreasonably broad due to a failure to construe “map database” and “map engine for manipulating said map database,” in accordance with the alleged disclosures of the ’970 Patent. It is well-settled

that it is improper to import limitations from the specification into the claims. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

The '970 Patent does not disclose, explicitly or implicitly, that the map database performs the functions of deriving street names, and correlating between maps and location and/or positioning information. In contrast to Patent Owner's arguments, the '970 Patent discloses "[i]t may be linked to an SMS (simple messaging service) server (140) and supply locations as coordinates, street names derived from map databases or other location data available to mobile telephones (141), pagers (142), etc." Ex. 1001, col. 5, ll. 45–53. The pronoun "it" refers to the subject of the preceding sentence—location determination system 1. *Id.* at col. 5, ll. 43–45. The '970 Patent also discloses the following: (1) "**map server (4)** is capable of correlating between maps stored in the database (5) and positioning information," (*id.* at col. 4, ll. 17–20 (emphasis added)); and (2) "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," (*id.* at col. 8, l. 66–col. 9, l. 3 (emphasis added)). In other words, the map server (4) and at least one mobile platform location system are the subjects of the aforementioned sentences that perform the correlating between maps and positioning and/or location information. Lastly, the '970 Patent discloses "[s]tep (e) may further comprise the step of correlating the location of each remote platform with a map database and transmitting a map having marked said remote platform location(s) to said subscriber." *Id.* at col. 3, ll. 21–24. This sentence is written in passive voice; it does not include a subject.

Patent Owner also argues that we misapprehended or overlooked the described functionality of the “map engine” in the ’643 Application. Req. Reh’g 5. Specifically, Patent Owner contends the ’643 Application “explains that the ‘integrated map engine’ operating on the Company Device (41) is not only used to extract a map from the map database, but is also used to ***correlate the location data with the desired map stored in the map database.***” *Id.*; see *id.* at 6. Patent Owner asserts the ’643 Application discloses the following: (1) “Each of the specified ***Company Devices ((41) to (44))*** is associated with a map database (not shown) and a known per se map engine for accessing the map database and ***is capable of correlating between maps and the positioning information*** received from the vehicle’s tracking unit” (*id.* at 5–6 (quoting Ex. 1002, 4, ll. 1–4)); and (2) “The latter ***[i.e., Company Device (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***” (*id.* at 6 (quoting Ex. 1002, 5, ll. 4–7)). Patent Owner concludes “[i]t is clear that the verb of the sentence (*i.e.*, correlates) is performed by the Company Device (41) using *its* [Company Device (41)’s] integrated map engine.” *Id.* Patent Owner further contends the ’970 Patent and the language of claim 18 is consistent with the alleged disclosure of the ’643 Application. *Id.* at 6–8 (quoting Ex. 1001, col. 4, ll. 15–20, col. 8, ll. 59–61).

Similar to our discussion above addressing “map database”, we are not persuaded by Patent Owner’s arguments because the ’643 Application, and ’970 Patent do not disclose, explicitly or implicitly, that the map engine performs the function of correlating the location data with map(s). Contrary to Patent Owner’s arguments, the ’643 Application discloses Company

Device 41 as having an integrated map engine that performs the extraction of the desired map from the database, but discloses that Company Device 41 performs the correlation of the location data with the desired map. Ex. 1002, 4, ll. 1–5, 5, ll. 2–7. We also are not persuaded that the '970 Patent is consistent with the alleged disclosure of the '643 Application because, as explained above, the '970 Patent discloses the map server (4) and at least one mobile platform location system perform the correlating between maps and positioning and/or location information. Ex. 1001 col. 4, ll. 17–20, col. 8, l. 66–col. 9, l. 3.

For the foregoing reasons, we are not persuaded that we misapprehended or overlooked the intrinsic evidence in applying the broadest reasonable construction to “map database,” and “map engine for manipulating said map database.”

Admissibility of Expert Testimony

Patent Owner argues we misapprehended or overlooked *Sundance, Inc. v. DeMonte Fabricating Ltd.*, 550 F.3d 1356, 1364 (Fed. Cir. 2008), and *Morpho Detection, Inc. v. Smiths Detection, Inc.*, No. 211cv498, 2012 WL 6004085 at *1–2 (E.D. Va. Nov. 30, 2012) cited by Patent Owner to support its argument that Dr. Rosenberg’s testimony should be excluded as not admissible. Req. Reh’g 8–9 (citing PO Mot. to Exclude 2–5; PO Reply Opp. 1–2; Tr. 29, l. 3–30, l. 14). In the Final Written Decision, we determined Dr. Rosenberg was qualified as an expert based at least on Dr. Rosenberg’s experience, in particular, over four years of experience as founder and CEO of WhereWuz, a technology company focusing on location tracking applications for GPS enabled smartphones. Final Dec. 20.

Patent Owner asserts, under the Federal Rules of Evidence and Federal Circuit case law, a declarant who is not qualified as a person of ordinary skill in the art cannot testify as to issues of invalidity, the substance and disclosure of the prior art, or how a person of ordinary skill in the art would understand the prior art. Req. Reh’g 8; *see id.* at 9–11.

We considered and found unpersuasive Patent Owner’s substantially similar arguments in Patent Owner’s Motion to Exclude Evidence, and Patent Owner’s Reply to Petitioner’s Opposition. Final Dec. 18–19; *see* PO Mot. Exclude 2–5; PO Reply Opp. 1–3. A request for rehearing is not an opportunity to reiterate arguments that were addressed in our Final Written Decision, and merely express disagreement.

As explained in the Final Written Decision, 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. Final Dec. 19. Specifically, *Sundance* is binding authority; however, *Sundance* does not support fully Patent Owner’s arguments. The court in *Sundance* held, in the context of the admissibility of a testimony by a technically unqualified patent attorney, “it was an abuse of discretion to permit a witness to testify as an expert on the issues of noninfringement or invalidity unless that witness is qualified as an expert in the pertinent art.” *Sundance*, 550 F.3d at 1363.

We also are not persuaded by Patent Owner’s argument that *SEB S.A. v. Montgomery Ward & Co.*, 594 F.3d 1360 (Fed. Cir. 2010) is inapposite because the testimony offered in *SEB* did not relate to any issue of invalidity or the prior art. Req. Reh’g 9 (citing Final Dec. 19). Patent Owner does not explain adequately why the admissibility of testimony related to

infringement (see *SEB*, 594 F.3d at 1373) is distinct from the admissibility of testimony related to invalidity or the prior art. See Req. Reh’g. 9.

Similarly, we are not persuaded that *Mytee Prods., Inc. v. Harris Research, Inc.*, 439 F. App’x 882, 887 (Fed. Cir. 2011)(non-precedential) also is not pertinent because the proffered level of ordinary skill in the art in *Mytee* is that of an ordinary layman with average intelligence. *Id.* Patent Owner does not explain sufficiently why *Mytee* is inapplicable based on the proffered level of ordinary skill in the art. See *id.*

For all of the foregoing reasons, we are not persuaded that we misapprehended or overlooked the Federal Rules of Evidence and Federal Circuit case law regarding the admissibility of expert testimony.

IV. DECISION ON REHEARING

Petitioner’s request for rehearing is *denied*.

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