Trials@uspto.gov
571-272-7822

Paper 20
May 19, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FOURSQUARE LABS, INC.,
Petitioner,

v.

MIMZI, LLC,
Patent Owner.

IPR2019-01287
Patent 9,128,981 B1

Before STACEY G. WHITE, J. JOHN LEE, and NORMAN H. BEAMER, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

DECISION
Denying Patent Owner's Request for Rehearing of Decision on Institution
37 CF.R. § 42.71(d)

INTRODUCTION

Foursquare Labs, Inc. ("Petitioner") filed a Petition (Paper 1, "Pet.") requesting an *inter partes* review of claims 1–19 ("the challenged claims") of U.S. Patent No. 9,128,981 B1 (Ex. 1001, "the '981 Patent"). Mimzi, LLC ("Patent Owner") timely filed a Preliminary Response (Paper 7, "Prelim. Resp."). Petitioner filed an authorized Reply to the Preliminary Response (Paper 9, "Reply"), and Patent Owner filed an authorized Sur-reply (Paper 10, "Sur-reply"). On January 14, 2020, we issued a decision instituting an *inter partes* review (Paper 11, "Institution Decision" or "Inst. Dec."), concluding that Petitioner demonstrated a reasonable likelihood of prevailing on its asserted unpatentability grounds against the challenged claims (*id.* at 37).

Patent Owner timely filed a Request for Rehearing of the Institution Decision. Paper 14 ("Req. Reh'g"). For the reasons explained below, Patent Owner's Request is *denied*.

DISCUSSION

A party requesting rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). The party must identify all matters it contends were misapprehended or overlooked by the Board. *Id*. The Board applies an abuse of discretion standard when reviewing a decision on a petition for rehearing. 37 C.F.R. § 42.71(c).

Patent Owner's Request addresses our preliminary determination that the Yoo reference[1] asserted by Petitioner qualifies as prior art. *See* Req.

[1] Yoo, US 2009/0281988 A1, filed May 6, 2008, published Nov. 12, 2009 (Ex. 1003, "Yoo").

Reh'g 2–10; Inst. Dec. 13–20. As explained below, Patent Owner has not shown any abuse of discretion in that determination, or otherwise identified an error requiring modification of the Institution Decision.

In the Institution Decision, we first determined preliminarily that the governing statute was 35 U.S.C. § 102(a)(2) (2013), as amended by the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) ("AIA"). Inst. Dec. 13–19. On the record available at the time, we agreed with Petitioner that the '981 Patent included claims with an effective filing date on or after March 16, 2013, the effective date of the AIA amendment to § 102. *See id.*; Reply 1–2; AIA § 3(n)(1). Specifically, we determined (preliminarily) that the challenged claims are not adequately supported by the written description of U.S. Patent Application No. 12/181,956 ("the '956 Application"), and, thus, could not claim priority to the '956 Application, the only application in the priority chain that was filed before the AIA's relevant effective date. Inst. Dec. 17–19.

Under post-AIA § 102(a)(2), a published patent application of another inventor (like Yoo) is prior art if it "was effectively filed before the effective filing date of the claimed invention." Yoo was filed on May 6, 2008. Ex. 1003, code (22). Consequently, under post-AIA § 102(a)(2), Yoo would qualify as prior art because its filing date is before the effective filing date of the claimed invention.[2] Ex. 1001, code (60).

[2] We note that Yoo's effective filing date precedes *all* of the possible effective filing dates listed on the face of the '981 Patent, including the July 29, 2008 filing date of the '956 Application. *See* Ex. 1001, code (60). As noted above and discussed further below, however, whether the claims are supported by the '956 Application relates to the threshold issue of whether post-AIA § 102(a)(2) applies to Yoo.

Patent Owner argues that we misapprehended the available evidence and, thus, erroneously determined that the '956 Application does not provide sufficient written description support for the challenged claims. *See* Req. Reh'g 2–6. According to Patent Owner, Yoo does not qualify as prior art as a result, and the Petition, thus, should have been denied. *See id*. at 9. We disagree for the following reasons.

As an initial matter, we first note that we determined in the Institution Decision that Petitioner had shown a reasonable likelihood of prevailing on its contention that *all of the challenged claims* are unpatentable as obvious over Ramer[3] and Hayashi.[4] Inst. Dec. 28–32. Patent Owner does not seek rehearing of that determination. Thus, even were we to agree with Patent Owner that Yoo is not prior art, we conclude that Patent Owner has not shown that the Institution Decision should be modified because we still would have instituted an *inter partes* review based on the Ramer/Hayashi ground. *See* 35 U.S.C. § 314(a) (prohibiting institution "unless the Director determines that . . . there is a reasonable likelihood that the petitioner would prevail with respect to *at least 1 of the claims challenged* in the petition" (emphasis added)); *cf. Chevron Oronite Co. v. Infineum USA L.P.*, IPR2018-00923, Paper 9, 10–11 (PTAB Nov. 7, 2018) (informative) (exercising discretion to deny institution because a reasonable likelihood of prevailing was shown for only two dependent claims out of twenty challenged claims); *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7, 42–43 (PTAB Jan.

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[3] Ramer, US 2007/0061302 A1, published Mar. 15, 2007 (Ex. 1004, "Ramer").

[4] Hayashi, US 2007/0255831 A1, filed Apr. 28, 2006, published Nov. 1, 2007 (Ex. 1005, "Hayashi").

24, 2019) (informative) (exercising discretion to deny institution because a reasonable likelihood of prevailing was shown for only two claims out of twenty-three challenged claims).

According to Patent Owner, however, the Supreme Court's decision in *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018), indicates that "trial must be terminated as to all grounds" because the asserted ground of unpatentability based (in part) on Yoo is defective.[5] Req. Reh'g 9. Even assuming *arguendo* that Patent Owner is correct about the purported defect in the Yoo-based ground, we disagree. In *SAS*, the Board had instituted an *inter partes* review on nine out of sixteen claims challenged in the petition, concluding that the petitioner had shown a reasonable likelihood of prevailing as to those nine but not as to the remaining seven claims. *SAS*, 138 S. Ct. at 1354. The Court, however, did not hold that the Board was required to have terminated the trial due to a partially "defective" petition. To the contrary, the Court held that the petitioner was entitled to a final written decision on *all claims challenged in the petition*. *Id.* at 1359–60. In other words, the Court held that all challenged claims should have been *included* in the *inter partes* review and had their patentability decided in the final written decision. *See id*. Here, we instituted trial on all claims, including on the Raymer/Hayashi ground; thus, our Institution Decision is consistent with *SAS*.

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[5] We need not address Patent Owner's argument (Req. Reh'g 9–10) that holding otherwise could lead to the Board instituting grounds of unpatentability that fall outside the scope of 35 U.S.C. § 311(b), because all of the grounds asserted in the Petition are § 103 grounds based on prior art patents or printed publications, including Yoo (as discussed herein and in the Institution Decision). *See* Pet. 7; Inst. Dec. 13–20.

In addition, we further conclude Patent Owner's Request for Rehearing should be denied because Patent Owner does not demonstrate that we abused our discretion or otherwise erred in determining, based on the available evidence, that Yoo qualifies as prior art under post-AIA § 102(a)(2). Patent Owner asserts that we misapprehended evidence establishing that the challenged claims of the '981 Patent are supported by the '956 Application and, thus, are entitled to its pre-AIA filing date. *See* Req. Reh'g 3–6. We disagree.

In the Institution Decision, we determined preliminarily that the '956 Application did not provide adequate written description support for the limitations in each challenged claim requiring searching a social network or social network database "based on" or "using" a transcript of a user's spoken request and metadata (e.g., location) associated with the spoken request. Inst. Dec. 17–19. In reaching that conclusion, we addressed paragraph 197[6] and Figure 6 of the '956 Application (*id.* at 17–18), but Patent Owner now asserts that we misapprehended that evidence (Req. Reh'g 3–6).

Paragraph 197 of the '956 Application (Ex. 3001) is reproduced in its entirety below.

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[6] In Patent Owner's briefing before institution, paragraph 197 was misidentified as paragraph 198. *See* Sur-reply 2 (citing "[p]aragraph 198" but quoting paragraph 197); Ex. 3001 ¶ 197. We inadvertently repeated this typographical error in the Institution Decision. *See* Inst. Dec. 17–18. In the Request for Rehearing, Patent Owner again erroneously cites paragraph 198 instead of paragraph 197. *See*, *e.g.*, Req. Reh'g 3, 6. We understand Patent Owner's arguments to relate to paragraph 197, and we refer to paragraph 197 herein to avoid further confusion.

> Referencing FIG. 2, for calls and dictation, the appended time-location transcript 253, along with attached call audio 121, attached synopsis audio 122, attached video 124, attached photos 125, and metadata 127 which may be recorded on or streamed live from Mobile Handset Phone 110 a, Voice Over IP (VOIP) Phone 110 b or land line phone 110C may be transmitted via the Internet or intranet, e.g., using TCP/IP for nearly lossless or at least high-quality data transmission, to the Centralized Community Search database, FIG. 6, 170 c.

Ex. 3001 ¶ 197. We explained in the Institution Decision that this disclosure "does not describe any searching or requesting information *from* the 'Centralized Community Search database,' much less searching or requesting such information based on, or using, a transcript of a spoken request and associated metadata such as location," and that "[r]ather, this disclosure describes information . . . that is submitted to become *part of* the database." Inst. Dec. 18 (citing Ex. 3001 ¶ 197[7]) (emphases in original).

According to Patent Owner, however, "[b]ecause the '956 Application discloses that the Centralized Community Search database is used for search . . . the transmitted transcript and metadata are clearly used and disclosed to search a social network database." Req. Reh'g 3. We disagree. Although the "Centralized Community Search database" is described elsewhere in the '956 Application as being searched (*see* Ex. 3001 ¶ 192), the above disclosure in paragraph 197 does not describe any search of the database, instead merely disclosing that certain information (including transcript 253 and metadata 127) is transmitted to the database. *See id.* ¶ 197; Inst.

[7] As noted above, the Institution Decision inadvertently cited paragraph 198, but clearly intended to cite paragraph 197, which is quoted in the Decision. *See* Inst. Dec. 17–18.

Dec. 18. Nor is there any mention in that paragraph of how that information is used. Thus, we discern no basis in paragraph 197 for Patent Owner's assertion that the transcript and metadata are "clearly used and disclosed to search a social network database." Req. Reh'g 3. Moreover, simply because the database generally is intended to be searched does not indicate that it is searched based on, or using, any particular information. *See id*.

In the Institution Decision, we also noted that other related disclosures of the '956 Application describe "the submission of 'speech-recognized text and location data' to a 'Centralized Community Search database,' e.g., a message about a traffic jam or road hazard, or a review of a restaurant or business" that becomes part of the database. Inst. Dec. 18 (quoting Ex. 3001 ¶¶ 186–192).[8] According to Patent Owner, however, we misapprehended these disclosures as well. Req. Reh'g 5–6. Specifically, Patent Owner argues that paragraph 192 "unambiguously states that the Centralized Community Search database 'may be searched or mined' 'with speech-recognized text and location data.'" *Id.* at 6.

Patent Owner's argument, however, does not match the actual language of paragraph 192, which states: "The Centralized Community Search database of Location Blogs (with speech-recognized text and location data) may be searched or mined based on social network or type of

[8] Patent Owner asserts that we erred by considering these disclosures of the '956 Application because they were not cited by Petitioner. Req. Reh'g 7. These disclosures, however, relate to Figure 6 of the '956 Application (as does paragraph 197), which Patent Owner raised as evidence of written description support. *See* Sur-reply 2. Further, Petitioner did not have an opportunity to address Patent Owner's reliance on Figure 6 because Patent Owner raised it for the first time *in its Sur-reply*. *Id*.

information . . . ." Ex. 3001 ¶ 192. By switching the order of two quotes from paragraph 192, Patent Owner changes the meaning of the disclosure. Instead of stating that the database is *searched with* speech-recognized text and location data, as Patent Owner asserts (Req. Reh'g 6), paragraph 192 actually states that the database *includes* speech-recognized text and location data, which is searched "based on social network or type of information" (Ex. 3001 ¶ 192). Thus, paragraph 192 is consistent with the discussion in the Institution Decision.

Patent Owner also argues we misapprehended Figure 6 of the '956 Application, which is reproduced below.

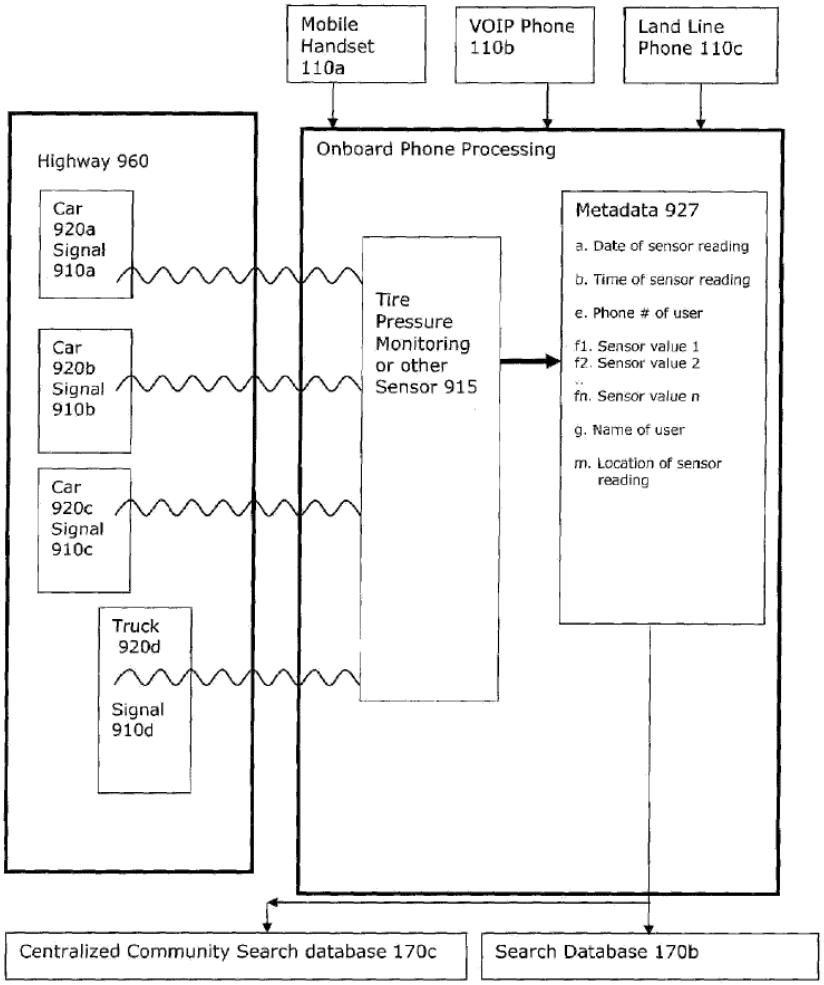


Figure 6

Ex. 3001, Fig. 6. Figure 6 depicts an embodiment of the invention described in the '956 Application in which "multiple mobile Phones [are used] for rolling surveillance by detecting tire pressure monitoring signals of adjacent vehicles." *Id.* ¶ 27. As shown, the data sent to Search Database 170b or Centralized Community Search database 170c may include "data picked up by using the Phone as a sensor, e.g., to record and transmit wireless data from another Phone or an adjacent automobile." *Id.* ¶ 179. "[T]ire pressure monitoring system (TPMS)" signals 920a-d from passing vehicles 920a-d are recorded by sensor 915 along with metadata and sent to Search Database 170b or Centralized Community Search database 170c. *Id.* ¶¶ 180–182.

In the Institution Decision, we noted that Figure 6 is the only figure in the '956 Application to depict a "Centralized Community Search database." Inst. Dec. 18. We also determined preliminarily that Figure 6 "depicts an embodiment without any spoken request or transcript thereof, instead drawing input from sensor signals monitoring a car or truck." *Id*. According to Patent Owner, however, we overlooked "Mobile Handset 110a," "VOIP Phone 110b," and "Land Line Phone 110c" in Figure 6, which Patent Owner contends represent "voice inputs for spoken requests." Req. Reh'g 4.

As an initial matter, we cannot overlook an argument that was not made. In its pre-institution briefing, Patent Owner did not identify any of "Mobile Handset 110a," "VOIP Phone 110b," or "Land Line Phone 110c" as disclosing voice inputs for spoken requests. In the Request for Rehearing (Req. Reh'g 5), Patent Owner cites pages 1–3 of its Sur-reply as purportedly setting forth this argument, but those pages make no mention of *any* feature of Figure 6 except Centralized Community Search database 170c. *See* Sur-reply 1–3. A rehearing request may not be used to advance arguments not

previously made. *See Huawei Device Co. v. Optis Cellular Tech., LLC*, IPR2018-00816, Paper 19, 8–9 (PTAB Jan. 8, 2019) (precedential).

Even were we to consider this argument, however, we are not persuaded that we overlooked any feature of Figure 6 that would compel a conclusion that Figure 6 provides written description support for the limitations in the challenged claims requiring searching a social network or social network database "based on" or "using" a transcript of a user's spoken request and associated metadata. According to Patent Owner, "Mobile Handset 110a," "VOIP Phone 110b," and "Land Line Phone 110c" depicted in Figure 6 correspond to disclosures throughout the '956 Application of such structures generating transcripts. Req. Reh'g 5.[9] Assuming *arguendo* that Patent Owner is correct, Figure 6 still falls short of disclosing that a social network or social network database is searched based on, or using, such transcripts.

Figure 6 depicts information that is provided to Centralized Community Search database 170c, for example, but Patent Owner does not identify any evidence or persuasive reasoning indicating that such information includes spoken requests for information or that the Centralized

[9] In addition to Figure 2, Patent Owner summarily cites over 120 paragraphs of the '956 Application as purportedly supporting this contention. *See* Req. Reh'g 5. As it was Patent Owner's burden to "specifically identify all matters" it believes we misapprehended or overlooked, we decline to search through all of the cited material to attempt to locate the pertinent evidence, particularly given that none of it was cited previously. *See* 37 C.F.R. § 42.71(d); *Huawei*, IPR2018-00816, Paper 19, 8–9. Patent Owner did provide a quotation from one paragraph of the '956 Application, which appears to be from paragraph 98. *See* Req. Reh'g 5; Ex. 3001 ¶ 98. Thus, we consider only that paragraph and Figure 2.

Community Search database is *searched* based on, or using, such information. *See* Ex. 3001, Fig. 6. Similar to our discussion regarding paragraph 197 above, the '956 Application instead indicates that the information shown in Figure 6 as being provided to the Centralized Community Search database is to become *part of* the database. *See id.* ¶¶ 179–192, 197. Indeed, even Figure 2 and paragraph 98—which Patent Owner relies on (*see* Req. Reh'g 5)—refers only to "text transcript 250 of the call or dictation audio and text transcript 260 of the synopsis radio" (Ex. 3001 ¶ 98, Fig. 2), which corresponds to the disclosure that "call and voice annotations or synopsis (with speech-recognized text and location data)" can be shared with the public in a "Location Blog" (i.e., "a community or collective photographic memory") stored on the "Centralized Community Search database" (*id.* ¶¶ 186–189). Thus, we are not persuaded of error in our analysis of Figure 6.

Patent Owner also contends that we erred by determining (preliminarily) that Mr. Geer failed to conceive the limitations related to "using transcripts of a spoken request and associated metadata to search a social network database." Req. Reh'g 7–8. We disagree.

In the Institution Decision, we determined that the evidence then available did not establish that Mr. Geer had conceived of every feature of the invention of the challenged claims. Inst. Dec. 19–20. We first note that this determination is only relevant "if pre-AIA § 102(e) applied" instead of post-AIA § 102(a)(2). *See id.* at 19. Because Patent Owner does not demonstrate any relevant error in our determination (for purposes of assessing whether to institute trial) that post-AIA § 102(a)(2) applies, any

alleged error in our determinations regarding pre-AIA § 102(e) would be insufficient to warrant modification of the Institution Decision.

Further, the principal error that Patent Owner identifies with respect to Mr. Geer's alleged conception is the same as the purported error in our analysis of Figure 6 of the '956 Application. *See* Req. Reh'g 7–8.[10] Thus, for the same reasons discussed above regarding Figure 6, we also are unpersuaded that we erred in our analysis of Mr. Geer's alleged conception. Patent Owner also argues that we erred by considering Mr. Geer's conception at all because "Petitioner never argued that Mr. Geer failed to conceive" of the relevant limitations of the challenged claims. *Id.* at 8. This is plainly incorrect, however, because Petitioner argued that Patent Owner's evidence did not establish conception of the entire invention of the challenged claims, including the social network database limitations. *See* Reply 3–5.

Finally, Patent Owner asserts that we erred by even considering the '956 Application because it was not submitted by Petitioner as an exhibit. Req. Reh'g 7. Notably, Patent Owner did *not* argue prior to the Request for Rehearing that the '956 Application should not be considered because it was not submitted by Petitioner. As discussed above, arguments may not be raised for the first time in a rehearing request. *See Huawei*, IPR2018-00816, Paper 19, 8–9. Moreover, as we noted in the Institution Decision, the '956

[10] Patent Owner refers to Exhibit 2007 as a drawing "identical to Figure 6 of the '956 Application." Req. Reh'g 8. In fact, Exhibit 2007 is Mr. Geer's Declaration. Ex. 2007. We understand Patent Owner to have intended instead to refer to Exhibit 2012. *See* Ex. 2012, Fig. 6. We addressed Exhibit 2012 in the Institution Decision. Inst. Dec. 20.

Application is "a document publicly available from the Office and it is apparent that both parties had access to it for their briefs." Inst Dec. 17 n.8. Thus, we do not discern any failure of appropriate notice to Patent Owner, nor are we convinced that Patent Owner did not have an adequate opportunity to be heard regarding the '956 Application. *See* Req. Reh'g 7. Indeed, Patent Owner itself relied on the '956 Application in its Sur-reply as evidence of written description support for the challenged claims. *See* Sur-reply 2. Thus, we are not persuaded of error.

CONCLUSION

For the foregoing reasons, Patent Owner has not carried its burden of showing that we misapprehended or overlooked any matter, or abused our discretion, in a manner such that the Institution Decision should be modified. We note that many of Patent Owner's arguments concern *preliminary* determinations made in the Institution Decision, based only on the evidence available at that time, and only for purposes of determining whether to institute an *inter partes* review. Such issues are resolved finally only after the trial is completed and the record is complete, which includes ample opportunities for both parties to present arguments and further evidence on these issues.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's Request for Rehearing is *denied*.

PETITIONER:

Michael Carrillo
Steven Shipe
Joseph Paquin
BARNES & THORNBURG, LLP
michael.carrillo@btlaw.com
steven.shipe@btlaw.com
jpaquin@btlaw.com

PATENT OWNER:

Minghui Yang F.
Brad Liddle
CARTER ARNETT PLLC
myang@carterarnett.com
bliddle@carterarnett.com

Eric Evain
GRANT & EISENHOFER P.A.
eevain@gelaw.com