

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

BILLJCO LLC,
Patent Owner.

IPR2022-00129
Patent 8,566,839 B2

Before THU A. DANG, ROBERT J. WEINSCHENK, and
GARTH D. BAER, *Administrative Patent Judges*.

WEINSCHENK, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. *Background and Summary*

Apple Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1–3, 8, 20, 21, 23–27, 32, 44, 45, 47, and 48 (“the challenged claims”) of U.S. Patent No. 8,566,839 B2 (Ex. 1001, “the ’839 patent”). BillJCo, LLC (“Patent Owner”) filed a Preliminary Response (Paper 5, “Prelim. Resp.”) to the Petition.

An *inter partes* review may not be instituted unless “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Further, a decision to institute may not institute on fewer than all claims challenged in the petition. 37 C.F.R. § 42.108(a). Based on the arguments and evidence of record, Petitioner demonstrates a reasonable likelihood of prevailing in showing that at least one of the challenged claims of the ’839 patent is unpatentable. Accordingly, we institute an *inter partes* review as to the challenged claims of the ’839 patent on all the grounds of unpatentability in the Petition.

B. *Real Parties in Interest*

The parties identify themselves as the only real parties in interest. Pet. 1; Paper 4, 2.

C. *Related Matters*

The parties indicate that the ’839 patent is the subject of the following district court cases: 1) *BillJCo, LLC v. Apple Inc.*, No. 6:21-cv-00528 (W.D. Tex.) (“District Court Litigation”); 2) *BillJCo, LLC v. Cisco Systems, Inc.*,

No. 2:21-cv-00181 (E.D. Tex.); and 3) *BillJCo, LLC v. Hewlett Packard Enterprise Company*, No. 2:21-cv-00183 (E.D. Tex.). Pet. 1; Paper 4, 2.

D. The '839 Patent

The '839 patent relates to “managing information for automatic presentation or distribution.” Ex. 1001, 1:31–37. The '839 patent states that “[c]onventional advertising formats are handled with a specialized operating system for how to process the advertisement so that the source . . . ensures or maximizes its messaging while the recipient . . . is also able to control to a somewhat lesser extent when presentation is desired.” *Id.* at 4:33–38.

According to the '839 patent, “[t]he problem is the same advertisement may be treated differently at a different operating system,” and, thus, “[t]he originator . . . of the advertisement loses automatic control over how the advertisement should be presented at any operating system.” *Id.* at 4:38–42.

To address this alleged deficiency, the '839 patent describes “encoding information associated with the advertisement for how any receiving operating system is to present it.” *Id.* at 4:42–49. This technique “has the advantage of supporting heterogeneous operating systems with unique advertisement presentation capabilities based on a recipient’s preferences relative to an originator[’s] . . . intent, while doing so according to privileges, and in a ‘user-friendly’ manner.” *Id.* at 4:49–54.

E. Illustrative Claim

Of the challenged claims, claims 1 and 25 are independent. Claim 1 is reproduced below.

1. A method for information presentation by a receiving data processing system, said method comprising:
receiving, by said receiving data processing system, an object, said object containing information and instructions for

presenting said information, said instructions including an event specification to be monitored by said receiving data processing system for triggering when to present said information, said event specification including a whereabouts condition and a condition for detecting a particular user action by a user of said receiving data processing system, said whereabouts condition determining if a location of said receiving data processing system is in a vicinity of another data processing system;

storing, by said receiving data processing system, said information in a memory of said receiving data processing system;

processing, by said receiving data processing system, said instructions upon said receiving, by said receiving data processing system, said object;

configuring, by said receiving data processing system, a trigger event for said event specification in response to said processing, by said receiving data processing system, said instructions;

monitoring, by said receiving data processing system, said trigger event in response to said configuring, by said receiving data processing system, said trigger event;

recognizing, by said receiving data processing system, said trigger event, after said monitoring, by said receiving data processing system, said trigger event; and

presenting, by said receiving data processing system, said information, based at least in part by said whereabouts condition, upon said recognizing, by said receiving data processing system, said trigger event.

Ex. 1001, 64:59–65:26.

F. Evidence

Petitioner submits the following evidence:

Evidence	Exhibit No.
Declaration of Thomas La Porta, Ph.D. (“La Porta Declaration”)	1003

Evidence	Exhibit No.
Lutnick, US 2008/0167106 A1, published July 10, 2008 (“Lutnick”)	1005
Rankin, US 2002/0137462 A1, published Sept. 26, 2002 (“Rankin”)	1006
<i>Specification of the Bluetooth System: Wireless Connections Made Easy</i> , Volume 0 (Nov. 4, 2004) (“Bluetooth Core”)	1007
Evans, US 6,327,535 B1, issued Dec. 4, 2001 (“Evans”)	1026

G. Asserted Grounds

Petitioner asserts that the challenged claims are unpatentable on the following grounds:

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1–3, 8, 21, 23–27, 32, 45, 47, 48	103	Lutnick
20, 44	103	Lutnick, Rankin
23, 47	103	Lutnick, Evans
24, 48	103	Lutnick, Bluetooth Core

II. ANALYSIS

A. 35 U.S.C. § 314(a)

Patent Owner argues that we should exercise our discretion under 35 U.S.C. § 314(a) to deny the Petition. Prelim. Resp. 15–20. Section 314(a) states that

[t]he Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

Under § 314(a), we have discretion to deny institution of an *inter partes* review. *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016).

We consider several factors when determining whether to deny institution under § 314(a) based on a parallel district court proceeding, specifically

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”).

1. Factor 1 – Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted

Under the first *Fintiv* factor, we consider “whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.” *Id.* at 6. Petitioner argues that it “intends to move to stay the [District Court Litigation], and the opportunity for . . . simplification increases the likelihood that the [District Court] will grant a stay in view of IPR institution.” Pet. 62. Patent Owner argues that “a stay is not likely to be granted on a contested motion,” because the District Court grants stays in a low percentage of cases. Prelim. Resp. 15–16.

Neither party identifies any statements by the District Court or other evidence that specifically addresses a stay of the District Court Litigation. *See* Pet. 62; Prelim. Resp. 15–16. We decline to speculate based on the

record in this case whether the District Court would grant a stay of the District Court Litigation. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12 (PTAB May 13, 2020) (informative) (“*Fintiv IP*”). As a result, we determine that the first *Fintiv* factor is neutral.

2. *Factor 2 – Proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision*

Under the second *Fintiv* factor, we consider the “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision.” *Fintiv*, Paper 11 at 6. Petitioner argues that the District Court “tentatively set trial for February 13, 2023,” but “[t]here is no guarantee trial will commence” on that date. Pet. 62–63. According to Petitioner, “‘a court’s general ability to set a fast-paced schedule is not particularly relevant,’ especially where ‘the forum [W.D. Tex.] itself has not historically resolved cases so quickly.’” *Id.* at 63. Patent Owner argues that the “trial date is extremely reliable,” because the District Court and parties “have kept to the scheduling order fairly closely.” Prelim. Rep. 16–17.

The current trial date in the District Court Litigation is February 13, 2023, which we “generally take . . . at face value absent some strong evidence to the contrary.” Ex. 1022, 4; *see Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 13 (PTAB May 13, 2020) (informative) (“*Fintiv IP*”). The projected statutory deadline for a final written decision in this case is in May 2023. Because the trial date in the District Court Litigation is a few months before the projected statutory deadline for a final written decision in this case, we determine that the second *Fintiv* factor slightly favors exercising our discretion to deny institution.

3. *Factor 3 – Investment in the parallel proceeding by the court and the parties*

Under the third *Fintiv* factor, we consider the “investment in the parallel proceeding by the court and the parties.” *Fintiv*, Paper 11 at 6. Petitioner argues that “no discovery has taken place,” and although a claim construction hearing “is scheduled for February 10, 2022, it is unclear when the [District Court] will issue a [claim construction] order.” Pet. 64–65. Patent Owner argues that the District Court issued a claim construction order that construes three terms in the ’839 patent. Prelim. Resp. 18. Patent Owner also argues that Petitioner filed the Petition six months after Patent Owner served its complaint in the District Court Litigation. *Id.* at 17.

The evidence of record indicates that the District Court and the parties invested minimal resources in the District Court Litigation as to issues of unpatentability involving the ’839 patent. The District Court issued a claim construction order that addresses three terms in the ’839 patent. Ex. 2003, 2–3. But, for two of the three terms, the District Court stated only that those terms have their “[p]lain and ordinary meaning.” *Id.* And the evidence of record indicates that fact discovery is ongoing, expert discovery has not begun, and the deadline for dispositive motions is not until November 2022. Ex. 1022, 3. Further, Petitioner exercised reasonable diligence in filing the Petition about six weeks after serving its preliminary invalidity contentions. Pet. 68; Ex. 2006, 81. Thus, we determine that the third *Fintiv* factor weighs against discretionary denial of institution.

4. *Factor 4 – Overlap between issues raised in the petition and in the parallel proceeding*

Under the fourth *Fintiv* factor, we consider the “overlap between issues raised in the petition and in the parallel proceeding.” *Fintiv*, Paper 11

at 6. Petitioner argues that “the Petition challenges the validity of claims 25–27, 32, 44, 45, 47, and 48, which are not being asserted in the [District Court] [L]itigation.” Pet. 65. Petitioner also states that “if the Board institutes IPR, Petitioner will not assert invalidity of the challenged claims in the [D]istrict [C]ourt [L]itigation using the grounds asserted in this [P]etition.” *Id.* Patent Owner argues that “Petitioner’s stipulation is quite limited in scope” and only mitigates “concerns of duplicate efforts and of potentially conflicting decisions ‘to some degree.’” Prelim. Resp. 18. Patent Owner also argues that because Petitioner relies on more references and more combinations in the District Court Litigation than in the Petition, instituting an *inter partes* review would decrease “efficiency” and increase “the possibility of conflicting decisions.” *Id.* at 18–19.

The Petition challenges claims 1–3, 8, 20, 21, 23–27, 32, 44, 45, 47, and 48, and relies on Lutnick, Rankin, Evans, and Bluetooth Core. Pet. 4. Petitioner’s invalidity contentions in the District Court Litigation address claims 1–3, 8, 20, 21, 23, and 24, and rely on Lutnick, Evans, and Bluetooth Core. Pet. 65; Ex. 2006, 7, 13. Nonetheless, Petitioner’s stipulation that it will not pursue the grounds asserted in the Petition in the District Court Litigation mitigates to some degree concerns of duplicative efforts and potentially conflicting decisions. Ex. 1012; *see Sand Revolution II, LLC v. Continental Intermodal Grp. – Trucking LLC*, IPR2019-01393, Paper 24 at 12 (PTAB June 16, 2020) (informative). Thus, we determine that the fourth *Fintiv* factor weighs marginally against discretionary denial of institution.

5. *Factor 5 – Whether the petitioner and the defendant in the parallel proceeding are the same party*

Under the fifth *Fintiv* factor, we consider “whether the petitioner and the defendant in the parallel proceeding are the same party.” *Fintiv*, Paper 11 at 6. Here, Petitioner is the defendant in the District Court Litigation. Pet. 66; Prelim. Resp. 19. But, as we discussed for the second factor, the trial date in the District Court Litigation is only a few months before the projected statutory deadline for a final written decision in this case. Under these circumstances, we determine that the fifth *Fintiv* factor slightly favors exercising our discretion to deny institution.

6. *Factor 6 – Other circumstances that impact the Board’s exercise of discretion, including the merits*

Under the sixth *Fintiv* factor, we consider “other circumstances that impact the Board’s exercise of discretion, including the merits.” *Fintiv*, Paper 11 at 6. Petitioner argues that the ’839 patent “has never been challenged in a PTAB post-issuance proceeding,” the Office “did not consider the prior art references asserted in this [P]etition . . . during prosecution,” and “the strength of Petitioner’s patentability challenges on the preliminary record favor institution.” Pet. 66–67. Patent Owner argues that “Petitioner made a weak showing on the merits.” Prelim. Resp. 20. Patent Owner also argues that “an IPR will not provide the parties with an in-depth analysis of the ‘839 patent” because “more art and bases for challenging the claims of the ‘839 patent were raised in the [District Court] Litigation.” *Id.*

As discussed below, on this record and at this stage of the proceeding, Petitioner presents a reasonably strong case that the challenged claims are unpatentable. *See Fintiv*, Paper 11 at 14–15 (“[I]f the merits of a ground raised in the petition seem particularly strong on the preliminary record, this

fact has favored institution.”). For example, Petitioner’s evidence shows that Lutnick teaches an “object containing information and instructions for presenting said information” and an “event specification including a whereabouts condition and a condition for detecting a particular user action,” which are the only limitations that Patent Owner disputes at this stage of the proceeding. *See* Section II.D.1. Thus, we determine that the sixth *Fintiv* factor weighs against discretionary denial of institution.

7. *Summary*

Based on our holistic view of the *Fintiv* factors, we decline to exercise our discretion under § 314(a) to deny the Petition.

B. Level of Ordinary Skill in the Art

Petitioner argues that a person of ordinary skill in the art would have had “at least a bachelor’s degree in computer science, computer engineering, or an equivalent, and two years of experience relating to wireless communications.” Pet. 5–6 (citing Ex. 1003 ¶¶ 39–40). Petitioner’s description of the level of ordinary skill in the art is supported by the testimony of Petitioner’s declarant, Dr. Thomas La Porta. Ex. 1003 ¶¶ 39–40. Patent Owner does not propose a description of the level of ordinary skill in the art or dispute Petitioner’s description. We adopt Petitioner’s description for purposes of this Decision.

C. Claim Construction

In an *inter partes* review proceeding, a claim of a patent is construed using the same standard used in a civil action under 35 U.S.C. § 282(b), including construing the claim in accordance with the ordinary and customary meaning of the claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. 37 C.F.R.

§ 42.100(b). Petitioner proposes construing the phrase “object containing information and instructions for presenting said information” in claim 1 and a similar phrase in claim 25 to mean “a self-contained object with both the information for presentation and the instructions describing under what conditions to present that information.” Pet. 8–10. Patent Owner does not propose an express construction for any claim terms. We determine that no claim terms require express construction for purposes of this Decision.

D. Obviousness of Claims 1–3, 8, 21, 23–27, 32, 45, 47, and 48 over Lutnick

Petitioner argues that claims 1–3, 8, 21, 23–27, 32, 45, 47, and 48 would have been obvious over Lutnick. Pet. 10–48. For the reasons discussed below, Petitioner demonstrates a reasonable likelihood of prevailing in showing that claims 1–3, 8, 21, 23–27, 32, 45, 47, and 48 would have been obvious over Lutnick.

1. Claim 1

Claim 1 recites “[a] method for information presentation by a receiving data processing system.” Ex. 1001, 64:59–60. Petitioner presents evidence that Lutnick teaches a method for displaying promotions on a mobile gaming device. Pet. 14–15 (citing Ex. 1005, code (57), ¶¶ 92, 193). At this stage of the proceeding, Petitioner shows sufficiently that Lutnick teaches the preamble of claim 1.¹

Claim 1 recites “receiving, by said receiving data processing system, an object, said object containing information and instructions for presenting

¹ Because Petitioner presents evidence that the prior art teaches the recitations in the preamble of claim 1, at this stage of the proceeding, we need not decide whether the preamble is limiting.

said information.” Ex. 1001, 64:61–63. Petitioner presents evidence that Lutnick’s mobile gaming device receives a promotion and instructions for presenting the promotion. Pet. 20–22 (citing Ex. 1005 ¶¶ 119, 128, 184, 290). Petitioner also presents evidence that Lutnick “describes situations where it would be beneficial to pre-download a program or software and promotions, for example in case there are connectivity issues between” a mobile gaming device and a casino server. *Id.* at 22–23 (citing Ex. 1005 ¶ 289). According to Petitioner, a person of ordinary skill in the art would have appreciated or found it obvious that “in this scenario, the promotions are transmitted with the program or software, such that this package is a ‘self-contained’ object because it is a single package including both the program or software and the promotions.” *Id.* at 22–25 (citing Ex. 1003 ¶¶ 86–90).

Patent Owner argues that the portions of Lutnick cited by Petitioner teach transmitting a promotion and instructions to a casino server or a marketer device, not to a mobile gaming device. Prelim. Resp. 6–7. On this record, Patent Owner’s argument is unavailing. Petitioner identifies specific portions of Lutnick that teach transmitting a promotion and instructions to a mobile gaming device. Pet. 20–22 (citing Ex. 1005 ¶¶ 119, 128, 184, 290). For example, Lutnick teaches that “the casino server may transmit instructions *to a mobile gaming device*” that “tell the mobile gaming device to present a promotion when, or only when the mobile gaming device is in a particular area of a casino.” Ex. 1005 ¶ 119 (emphasis added).

Patent Owner argues that Lutnick only teaches “data transmission (i.e., information about best time to run) to be compiled on the casino’s server for subsequent evaluation, not ‘instructions’ actually causing a

promotion to display on a mobile gaming device.” Prelim. Resp. 7–8. On this record, Patent Owner’s argument is unavailing. Petitioner identifies specific portions of Lutnick that teach transmitting instructions for presenting a promotion on a mobile gaming device. Pet. 20–22 (citing Ex. 1005 ¶¶ 119, 128, 184, 290). For example, Lutnick teaches that “the casino server may transmit *instructions* to a mobile gaming device” that “tell the mobile gaming device *to present a promotion when, or only when* the mobile gaming device is in a particular area of a casino.” Ex. 1005 ¶ 119 (emphases added).

Patent Owner argues that “[n]othing within the cited disclosures of Lutnick describes or suggests an advantage to **combining** transmission of a promotion with programming for displaying the promotion within a combined object.” Prelim. Resp. 9. Further, according to Patent Owner, “combining promotions with a program would have been contrary to convention wisdom at the time of the invention” because “doing so could make transmission more difficult, e.g., due to size.” *Id.* at 9–10.

On this record, Patent Owner’s argument is unavailing. Even if Lutnick does not teach transmitting a promotion and instructions in a single object, Petitioner presents evidence indicating that a person of ordinary skill in the art would have found it obvious to do so. Pet. 22–25 (citing Ex. 1003 ¶¶ 86–90). For example, Petitioner presents evidence that transmitting a promotion and instructions in a single object would have allowed the mobile gaming device to display a promotion even when there are connectivity issues between the mobile gaming device and a casino server. Pet. 24 (citing Ex. 1003 ¶ 90; Ex. 1005 ¶ 289). Further, even if transmitting a promotion and instructions in a single object would have increased the size of the

transmission, that alone does not negate Petitioner’s rationale for doing so. *See Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 n.8 (Fed. Cir. 2000) (“The fact that the motivating benefit comes at the expense of another benefit, however, should not nullify its use as a basis to modify the disclosure of one reference with the teachings of another.”).

Claim 1 recites “said instructions including an event specification to be monitored by said receiving data processing system for triggering when to present said information, said event specification including a whereabouts condition and a condition for detecting a particular user action by a user of said receiving data processing system, said whereabouts condition determining if a location of said receiving data processing system is in a vicinity of another data processing system.” Ex. 1001, 64:63–65:5.

Petitioner presents evidence that Lutnick teaches presenting a promotion when a mobile gaming device is in proximity of a specific location (i.e., a whereabouts condition). Pet. 25–26 (citing Ex. 1005 ¶¶ 141, 241, 255–256). Petitioner also presents evidence that Lutnick teaches presenting a promotion when a user of a mobile gaming device achieves a winning outcome (i.e., a particular user action).² *Id.* at 26–27 (citing Ex. 1005 ¶¶ 250–254).

Patent Owner argues that “winning a game is not a ‘*particular* user action *by a user* of said receiving data processing system’; instead, it is a category of responses by the mobile gaming device, not the user.” Prelim.

² Petitioner also presents evidence that Lutnick teaches presenting a promotion based on a user’s advertising preferences or based on a user coming into range of a beacon. Pet. 26–27. For purposes of this Decision, we need not rely on those teachings. Patent Owner may present any arguments regarding those teachings again in the Response after institution.

Resp. 13. On this record, Patent Owner’s argument is unavailing. Lutnick teaches that “a promotion may be presented to a player if *the player has achieved* a winning outcome.” Ex. 1005 ¶ 250 (emphasis added). Lutnick’s use of the phrase “the player has achieved” indicates that the promotion is triggered by the user’s action, not just a response by the mobile gaming device. *Id.*

Claim 1 recites “storing, by said receiving data processing system, said information in a memory of said receiving data processing system.” Ex. 1001, 65:6–8. Petitioner presents evidence that Lutnick teaches downloading a promotion to a mobile gaming device. Pet. 29–30 (citing Ex. 1005 ¶¶ 289–290). At this stage of the proceeding, Petitioner shows sufficiently that Lutnick teaches this limitation of claim 1.

Claim 1 recites “processing, by said receiving data processing system, said instructions upon said receiving, by said receiving data processing system, said object.” Ex. 1001, 65:9–11. Petitioner presents evidence that Lutnick’s mobile gaming device executes instructions for presenting a promotion. Pet. 30–31 (citing Ex. 1005 ¶¶ 55–56). At this stage of the proceeding, Petitioner shows sufficiently that Lutnick teaches this limitation of claim 1.

Claim 1 recites “configuring, by said receiving data processing system, a trigger event for said event specification in response to said processing, by said receiving data processing system, said instructions.” Ex. 1001, 65:12–15. Petitioner presents evidence that Lutnick teaches triggering a promotion when a mobile gaming device is in proximity of a specific location. Pet. 32–34 (citing Ex. 1005 ¶¶ 184, 209, 255–256, 392).

At this stage of the proceeding, Petitioner shows sufficiently that Lutnick teaches this limitation of claim 1.

Claim 1 recites “monitoring, by said receiving data processing system, said trigger event in response to said configuring, by said receiving data processing system, said trigger event.” Ex. 1001, 65:16–18. As discussed above, Petitioner presents evidence that Lutnick teaches triggering a promotion when a mobile gaming device is in proximity of a specific location. Pet. 32–35 (citing Ex. 1005 ¶¶ 184, 209, 255–256, 392). Petitioner also presents evidence that a person of ordinary skill in the art “would have appreciated that, in order to cause the promotion to be ‘triggered’ based on a player’s location, the [mobile gaming device] monitors the event that triggers the promotion display.” *Id.* at 34–35 (citing Ex. 1003 ¶ 109). At this stage of the proceeding, Petitioner shows sufficiently that Lutnick teaches this limitation of claim 1.

Claim 1 recites “recognizing, by said receiving data processing system, said trigger event, after said monitoring, by said receiving data processing system, said trigger event.” Ex. 1001, 65:20–22. Petitioner presents evidence that Lutnick teaches recognizing when a mobile gaming device is in proximity of a specific location. Pet. 36–37 (citing Ex. 1005 ¶¶ 255–256, 277, 392). At this stage of the proceeding, Petitioner shows sufficiently that Lutnick teaches this limitation of claim 1.

Claim 1 recites “presenting, by said receiving data processing system, said information, based at least in part by said whereabouts condition, upon said recognizing, by said receiving data processing system, said trigger event.” Ex. 1001, 65:23–26. Petitioner presents evidence that Lutnick teaches presenting a promotion when a mobile gaming device is in proximity

of a specific location. Pet. 37–38 (citing Ex. 1005 ¶¶ 242, 256, 392). At this stage of the proceeding, Petitioner shows sufficiently that Lutnick teaches this limitation of claim 1.

2. Claims 2, 3, 8, 21, 23–27, 32, 45, 47, and 48

Independent claim 25 recites limitations similar to those discussed above for claim 1. Dependent claims 2, 3, 8, 21, 23, 24, 26, 27, 32, 45, 47, and 48 depend, directly or indirectly, from claims 1 or 25. Petitioner presents evidence that Lutnick teaches the limitations of claims 2, 3, 8, 21, 23–27, 32, 45, 47, and 48. Pet. 13–48. Other than the arguments discussed above for claim 1, Patent Owner does not raise any separate arguments regarding claims 2, 3, 8, 21, 23–27, 32, 45, 47, and 48.

3. Summary

For the foregoing reasons, Petitioner demonstrates a reasonable likelihood of prevailing in showing that claims 1–3, 8, 21, 23–27, 32, 45, 47, and 48 would have been obvious over Lutnick.

E. Obviousness of Claims 20 and 44 over Lutnick and Rankin

Petitioner argues that claims 20 and 44 would have been obvious over Lutnick and Rankin. Pet. 49–51. Petitioner identifies evidence indicating that the Lutnick and Rankin combination teaches the limitations of claims 20 and 44, and that a person of ordinary skill in the art would have had reason to combine these references. *Id.* Other than the arguments discussed above, at this stage of the proceeding, Patent Owner does not raise any arguments relating to this asserted ground. On this record, Petitioner demonstrates a reasonable likelihood of prevailing in showing that claims 20 and 44 would have been obvious over Lutnick and Rankin.

F. Obviousness of Claims 23 and 47 over Lutnick and Evans

Petitioner argues that claims 23 and 47 would have been obvious over Lutnick and Evans. Pet. 51–56. Petitioner identifies evidence indicating that the Lutnick and Evans combination teaches the limitations of claims 23 and 47, and that a person of ordinary skill in the art would have had reason to combine these references. *Id.* Other than the arguments discussed above, at this stage of the proceeding, Patent Owner does not raise any arguments relating to this asserted ground. On this record, Petitioner demonstrates a reasonable likelihood of prevailing in showing that claims 23 and 47 would have been obvious over Lutnick and Evans.

G. Obviousness of Claims 24 and 48 over Lutnick and Bluetooth Core

Petitioner argues that claims 24 and 48 would have been obvious over Lutnick and Bluetooth Core. Pet. 56–61. Petitioner identifies evidence indicating that the Lutnick and Bluetooth Core combination teaches the limitations of claims 24 and 48, and that a person of ordinary skill in the art would have had reason to combine these references. *Id.* Other than the arguments discussed above, at this stage of the proceeding, Patent Owner does not raise any arguments relating to this asserted ground. On this record, Petitioner demonstrates a reasonable likelihood of prevailing in showing that claims 24 and 48 would have been obvious over Lutnick and Bluetooth Core.

III. CONCLUSION

Petitioner demonstrates a reasonable likelihood of prevailing in showing the unpatentability of at least one of the challenged claims of the '839 patent. At this stage of the proceeding, we have not made a final

determination with respect to the patentability of any of the challenged claims.

IV. ORDER

It is hereby

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–3, 8, 20, 21, 23–27, 32, 44, 45, 47, and 48 of the '839 patent is instituted with respect to all grounds of unpatentability set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of the '839 patent shall commence on the entry date of this Order, and notice is hereby given of the institution of a trial.

IPR2022-00129
Patent 8,566,839 B2

PETITIONER:

Larissa S. Bifano
Jonathan Hicks
Zachary Conrad
DLA PIPER LLP (US)
larissa.bifano@dlapiper.com
jonathan.hicks@dlapiper.com
zack.conrad@us.dlapiper.com

PATENT OWNER:

Brian R. Michalek
Joseph M. Kuo
Brian R. Landry
SAUL EWING ARNSTEIN & LEHR LLP
brian.michalek@saul.com
joseph.kuo@saul.com
brian.landry@saul.com