UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BMW OF NORTH AMERICA, LLC,

Petitioner,

v.

NORTHSTAR SYSTEMS LLC,

Patent Owner.

Patent No. 8,032,297
Filing Date: May 8, 2008
Issue Date: October 4, 2011

Inventor: Gabriel Jakobson
Title: METHOD AND SYSTEM FOR DISPLAYING NAVIGATION INFORMATION ON AN ELECTRONIC MAP

PATENT OWNER'S SUR-REPLY IN RESPONSE TO PETITIONER'S REPLY

Case No. IPR2023-00890

On September 15, 2023, the Board authorized Patent Owner to submit a seven-page sur-reply addressing Petitioner's reply. Ex. 3001.

Petitioner's reply is merely a belated attempt to add arguments to its Petition couched as "claim construction." In seeking its reply, Petitioner alleged that these arguments were unforeseen; however, Patent Owner did not seek any claim constructions in its Preliminary Response. Instead, Patent Owner addressed the plain language of the claims themselves. Petitioner's late arguments merely confirm that the Petition was severely deficient as the Petitioner ignored much of the claims, which it now attempts to rectify under the guise of claim construction. Petitioner's new arguments should not be considered, and the Petition should be denied.

I. ARGUMENT

First, regarding Petitioner's arguments about "Euclidean Vectors," Petitioner reads out the word "vector" from the plain language of the claim, which requires an "object vector indicator." Petitioner should have addressed the "vector" of the claims in its Petition, but it did not. Now, in reply, it raises new claim construction arguments that continue to exclude "vector" from the claims. For this reason alone, Petitioner's arguments should be rejected, and the Petition should be denied.

Second, regarding the argument that Petitioner refers to as the "particular with respect to a point" argument, Petitioner again ignores the plain language of the claim and context of the patent specification. The claims require computation of placement

of an OVI and reference the MO, as well as "creating the OVI containing the distance and travel related information." This plain language requires distance and travel related information, which must relate to ***a point on the map***, otherwise there would be no way to actually calculate this information. Petitioner does not provide any plausible explanation as to how such calculations could be performed other than from reference to a particular point on the map. Petitioner's argument would, therefore, read out this limitation entirely. Accordingly, Petitioner's new arguments should be rejected, and the Petition should be denied.

Third, regarding Petitioner's argument about the display of distance and travel-related information, Petitioner points to portions of the specification that are unrelated to the meaning of the claim terms at issue. The claim requires that the OVI is created "***containing*** the distance and travel-related information." The portions of the specification do not bear on the claim term as they do not address the meaning of the limitation "containing." This meaning is readily apparent from the language of the claim itself and Petitioner now asks the Board to remove the word "*containing*" from the claims. Accordingly, Petitioner's new arguments should be rejected, and the Petition should be denied.

Finally, regarding the *Fintiv* analysis, while BMW has now served its belated *Sotera* stipulation, BMW should not be credited with this stipulation as it has come at the eleventh hour. Additionally, BMW does not provide any justification for its

multiplication (rather than simplification) of the proceedings by filing a declaratory judgment action—an action where validity will certainly be at issue. In view of BMW's numerous deficiencies (which it has attempted but failed to rectify in its reply), and in view of BMW's efforts to increase the proceedings and burdens on the parties, the Board should exercise its discretion to deny institution.

II. CONCLUSION

For the foregoing reasons, Petitioner's late claim construction arguments should be rejected, and the Petition should be denied.

Dated: September 29, 2023

Respectfully submitted,

By: /*Vincent J. Rubino, III* /

Vincent J. Rubino, III (Reg. No. 68,594)
Lead Counsel for Patent Owner
Peter Lambrianakos (Reg. No. 58,279)
Back-up Counsel for Patent Owner
FABRICANT LLP
411 Theodore Fremd Avenue
Suite 206 South
Rye, New York 10580
Tel. 212-257-5797
Fax. 212-257-5796
Email: vrubino@fabricantllp.com
Email: plambrianakos@fabricantllp.com

CERTIFICATE OF SERVICE

A copy of PATENT OWNER'S SUR-REPLY IN RESPONSE TO PETITIONER'S REPLY has been served on Petitioner's counsel of record as follows:

Lionel M. Lavenue
Email: lionel.lavenue@finnegan.com
Email: BMW-NorthStar-IPRs@finnegan.com
FINNEGAN, HENDERSON, FARABOW,
GARRETT, & DUNNER LLP
1875 Explorer Street, Suite 800
Reston, VA 20190-6023

Kara A. Specht
Email: kara.specht@finnegan.com
FINNEGAN, HENDERSON, FARABOW,
GARRETT, & DUNNER LLP
271 17th Street, NW, Suite 1400
Atlanta, GA 30363-6209

Matthew Berntsen
Email: matthew.berntsen@finnegan.com
FINNEGAN, HENDERSON, FARABOW,
GARRETT, & DUNNER LLP
Two Seaport Lane
Boston, MA 02210-2001

Attorneys for BMW of North America, LLC

September 29, 2023 By: /*Vincent J. Rubino, III* /

Vincent J. Rubino, III (Reg. No. 68,594)
Lead Counsel for Patent Owner
FABRICANT LLP
411 Theodore Fremd Avenue,
Suite 206 South
Rye, New York 10580

Tel. 212-257-5797
Fax. 212-257-5796
Email: vrubino@fabricantllp.com