

**UNITED STATES PATENT AND TRADEMARK OFFICE**

---

**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

---

FOURSQUARE LABS, INC.,

Petitioner,

v.

BOARDACTIVE CORPORATION,

Patent Owner.

---

**U.S. PATENT NO. 10,621,620 B1**

**Title: PLATFORM FOR LOCATION AND TIME BASED  
ADVERTISING**

IPR2023-00918

**PATENT OWNER'S PRELIMINARY RESPONSE  
UNDER 35 U.S.C. § 42.107**

August 30, 2023

## TABLE OF CONTENTS

|                                                                                                                                  |    |
|----------------------------------------------------------------------------------------------------------------------------------|----|
| TABLE OF EXHIBITS .....                                                                                                          | xi |
| I. INTRODUCTION .....                                                                                                            | 1  |
| II. MANDATORY NOTICES (37 C.F.R. § 42.8) .....                                                                                   | 2  |
| A. Real Party in Interest .....                                                                                                  | 2  |
| B. Related Matters.....                                                                                                          | 2  |
| C. Counsel and Service Information.....                                                                                          | 3  |
| D. 37 C.F.R. § 42.28(b)(4): Service Information.....                                                                             | 4  |
| III. DISCRETIONARY DENIAL IS APPROPRIATE .....                                                                                   | 4  |
| A. The Petition lacks Particularity. ....                                                                                        | 4  |
| B. The Petition must specify where each element of the claim is<br>found in the prior art.....                                   | 7  |
| IV. BACKGROUND OF U.S. PATENT NO. 10,621,620 .....                                                                               | 10 |
| V. PERSON OF ORDINARY SKILL IN THE ART .....                                                                                     | 10 |
| VI. THE CHALLENGED CLAIMS .....                                                                                                  | 11 |
| VII. CLAIM CONSTRUCTION .....                                                                                                    | 11 |
| C. The term “Consumer” should be construed as a “user or person to<br>whom an advertisement is sent to elicit engagement.” ..... | 11 |
| D. Petitioner has waived its right to make new claim construction<br>arguments by failing to include them in its Petition. ....  | 13 |
| VIII. OVERVIEW OF THE PRIOR ART .....                                                                                            | 14 |
| A. Verizon (Exh. 1004).....                                                                                                      | 14 |
| B. Kerr (Exh. 1005).....                                                                                                         | 15 |

|     |                                                                                                                                                   |    |
|-----|---------------------------------------------------------------------------------------------------------------------------------------------------|----|
| C.  | Geer (Exh. 1006).....                                                                                                                             | 16 |
| D.  | Muhire (Exh. 1007) .....                                                                                                                          | 16 |
| E.  | Sehn (Exh. 1008).....                                                                                                                             | 17 |
| F.  | Alcatel (Exh. 1009) .....                                                                                                                         | 17 |
| G.  | Cellco (Exh. 1010) .....                                                                                                                          | 18 |
| IX. | RESPONSE TO SPECIFIC IPR GROUNDS .....                                                                                                            | 19 |
| H.  | GROUND I: Anticipation of Claims 28 and 29 under 35 U.S.C.<br>§ 102 by Verizon. ....                                                              | 19 |
| 1.  | Independent Claim 28—“A method comprising:” .....                                                                                                 | 20 |
| a.  | “registering asset data, wherein registering the<br>asset data comprises at least one of the<br>following: .....                                  | 20 |
|     | registering a first geolocation associated with<br>one of the following: .....                                                                    | 20 |
|     | a physical asset, and .....                                                                                                                       | 20 |
|     | a virtual asset; .....                                                                                                                            | 20 |
| b.  | “receiving media content to be associated with<br>at least one registered asset;” .....                                                           | 23 |
| c.  | “specifying a plurality of rules for delivering<br>the media content, wherein specifying the<br>plurality of rules comprises specifying: .....    | 24 |
|     | a first delivery rule associated with at least one<br>element of profile data corresponding<br>with a recipient of the media content,<br>and..... | 24 |
|     | a second delivery rule associated with a second<br>geolocation at which the recipient is<br>tracked.” .....                                       | 24 |
| d.  | “receiving an indication that the recipient is<br>proximate to the first geolocation, comparing<br>the first delivery rule and the at least one   |    |

|    |                                                                                                                                                                                                                                                                                                                                                           |    |
|----|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|----|
|    | element of profile data associated with the recipient;” .....                                                                                                                                                                                                                                                                                             | 25 |
| e. | “tracking a location that the recipient in response to a matching comparison; comparing the second delivery rule and the location in order to determine whether the recipient is proximate to the second geolocation; and delivering, upon fulfillment of the first deliver rule and the second delivery rule, the media content to the recipient.” ..... | 26 |
| 2. | Independent Claim 29: “A computer-readable medium comprising a set of instructions which when executed perform a method, the method comprising:” .....                                                                                                                                                                                                    | 27 |
| a. | “registering asset data, wherein registering the asset data comprises at least one of the following: .....                                                                                                                                                                                                                                                | 27 |
|    | registering a first geolocation associated with one of the following:.....                                                                                                                                                                                                                                                                                | 27 |
|    | a physical asset, and.....                                                                                                                                                                                                                                                                                                                                | 27 |
|    | a virtual asset.....                                                                                                                                                                                                                                                                                                                                      | 27 |
| b. | “media content to be associated with at least one registered asset;”.....                                                                                                                                                                                                                                                                                 | 27 |
| c. | “specifying a plurality of rules for delivering the media content, wherein specifying the plurality of rules comprises specifying: .....                                                                                                                                                                                                                  | 27 |
|    | a first delivery rule associated with a period of time, and.....                                                                                                                                                                                                                                                                                          | 27 |
|    | a second delivery rule associated with a second geolocation at which a recipient is tracked during the period of time;” .....                                                                                                                                                                                                                             | 27 |
| d. | “receiving an indication that the recipient is proximate to the first geolocation;”.....                                                                                                                                                                                                                                                                  | 27 |
| e. | “tracking a location associated with the recipient in response to a matching comparison;” .....                                                                                                                                                                                                                                                           | 27 |

|    |                                                                                                                                                                                                |    |
|----|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|----|
| f. | “comparing the second delivery rule and the location in order to determine whether the recipient is proximate to the second geolocation; and” .....                                            | 27 |
| g. | “delivering, upon fulfillment of the first delivery rule and the second delivery rule, the media content to the recipient.” .....                                                              | 27 |
| I. | GROUNDS II, III-XI, and XIII: Obviousness under 35 U.S.C. § 103 with two or more references. GROUNDS II, III-XI, and XIII: Obviousness under 35 U.S.C. § 103 with two or more references. .... | 29 |
| 1. | Motivation to Combine .....                                                                                                                                                                    | 29 |
| a. | No motivation to combine Verizon (Exh. 1004) and Kerr (Exh. 1005) (Ground II) .....                                                                                                            | 29 |
| b. | No motivation to combine Verizon (Exh. 1004), Kerr (Exh. 1005), and Geer (Exh. 1006) (Ground II). ....                                                                                         | 31 |
| c. | No motivation to combine Verizon (Exh. 1004) in view of Geer (Ex. 1006) (Ground II) .....                                                                                                      | 33 |
| d. | No motivation to combine Verizon (Exh. 1004) and Muhire (Exh. 1007) (Ground IV). ....                                                                                                          | 33 |
| e. | No motivation to combine Verizon (Exh. 1007) in view of Kerr (Exh. 1005) (Ground V). ....                                                                                                      | 34 |
| f. | No motivation to combine Verizon (Exh. 1004), Muhire (Exh.1007) in view of Kerr (Exh. 1005) (Ground V). ....                                                                                   | 35 |
| g. | No motivation to combine Verizon (Exh. 1004) with Kerr (Exh. 1005), in view of Sehn (Exh. 1008) (Ground VI). ....                                                                              | 35 |
| h. | No motivation to combine Verizon (Exh. 1004) with Kerr (Exh. 1005) and Muhire (Exh. 1007), in view of Sehn (Exh. 1008) (Ground VI). ....                                                       | 36 |
| i. | No motivation to combine Alcatel (Exh. 1009) in view of Kerr (Exh. 1005) (Ground VII). ....                                                                                                    | 36 |

|    |                                                                                                                                                |    |
|----|------------------------------------------------------------------------------------------------------------------------------------------------|----|
| j. | No motivation to combine Alcatel (Exh. 1009), Kerr (1005) in view of Muhire (Exh. 1007) (Ground VIII). .....                                   | 36 |
| k. | No motivation to combine Alcatel (Exh. 1009), and Kerr (Exh. 1005) in view of Verizon. (Exh. 1004) (Ground IX). .....                          | 37 |
| l. | No motivation to combine Alcatel (Exh. 1009), Kerr (Exh. 1005), and Muhire (Exh. 1007) in view of Verizon (Exh. 1004) (Ground X). .....        | 37 |
| m. | No motivation to combine Alcatel (Exh. 1009), Kerr (Exh. 1005), and Verizon (Exh. 1004) in view of Sehn (Ground XI). .....                     | 37 |
| n. | No motivation to combine Alcatel (Exh. 1009), Muhire (Exh. 1007), and Verizon (Exh. 1004) in view of Sehn (Ground XI). .....                   | 37 |
| o. | No motivation to combine Alcatel (Exh. 1009), Kerr (Exh. 1005), Muhire (Exh. 1007), and Verizon (Exh. 1004) in view of Sehn (Ground XI). ..... | 37 |
| p. | No motivation to combine Alcatel (Exh. 1009) with Kerr (Exh. 1005) (Ground XIII). .....                                                        | 38 |
| q. | No motivation to combine Alcatel (Exh. 1009) with Geer (Exh. 1006) (Ground XIII). .....                                                        | 38 |
| r. | No motivation to combine Alcatel (Exh. 1009) in view of Kerr (Exh. 1005) in view of Geer (Exh. 1006) (Ground XIII). .....                      | 38 |
| s. | No motivation to combine Verizon (Exh. 1004) with Cellco (Exh. 1010) to reach the claimed invention. (Ground III). .....                       | 38 |
| J. | GROUND XII: Anticipation of Claims 28 and 29 under 35 U.S.C. § 102 by Alcatel. ....                                                            | 39 |
| 2. | Independent Claim 28—“A method comprising:” .....                                                                                              | 40 |
| a. | “registering asset data, wherein registering the asset data comprises at least one of the following: .....                                     | 40 |

|    |                                                                                                                                                                                                                     |    |
|----|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|----|
|    | registering a first geolocation associated with<br>one of the following: .....                                                                                                                                      | 40 |
|    | a physical asset, and .....                                                                                                                                                                                         | 40 |
|    | a virtual asset; .....                                                                                                                                                                                              | 40 |
| b. | “receiving media content to be associated with<br>at least one registered asset;” .....                                                                                                                             | 41 |
| c. | “Specifying a plurality of rules for delivering<br>the media content, wherein specifying the<br>plurality of rules comprises specifying: .....                                                                      | 42 |
|    | a first delivery rule associated with at least one<br>element of profile data corresponding with a<br>recipient of the media content, and .....                                                                     | 42 |
| d. | a second delivery rule associated with a second<br>geolocation at which the recipient is tracked” .....                                                                                                             | 42 |
| e. | “receiving an indication that the recipient is<br>proximate to the first geolocation, comparing<br>the first delivery rule and the at least one<br>element of profile data associated with the<br>recipient;” ..... | 43 |
| 3. | Independent Claim 29: “A computer-readable medium<br>comprising a set of instructions which when executed<br>perform a method, the method comprising:” .....                                                        | 44 |
|    | f. “registering asset data, wherein registering the<br>asset data comprises at least one of the<br>following: .....                                                                                                 | 44 |
|    | registering a first geolocation associated with<br>one of the following: .....                                                                                                                                      | 44 |
|    | a physical asset, and .....                                                                                                                                                                                         | 44 |
|    | a virtual asset” .....                                                                                                                                                                                              | 44 |
|    | g. “media content to be associated with at least<br>one registered asset;” .....                                                                                                                                    | 44 |
| X. | SECONDARY CONSIDERATIONS .....                                                                                                                                                                                      | 44 |
|    | CONCLUSION .....                                                                                                                                                                                                    | 46 |

|                                 |    |
|---------------------------------|----|
| CERTIFICATE OF SERVICE .....    | i  |
| CERTIFICATE OF COMPLIANCE ..... | ii |

## TABLE OF AUTHORITIES

### Cases

|                                                                                                               |           |
|---------------------------------------------------------------------------------------------------------------|-----------|
| <i>Adaptics Ltd. v. Perfect Co.</i> ,<br>IPR2018-01596, 2019 Pat. App. LEXIS<br>4775 (PTAB Mar. 6, 2019)..... | 6, 40     |
| <i>Anderson v. Eppstein</i> ,<br>59 USPQ2d 1280 (BPAI 2001).....                                              | 9, 21     |
| <i>Apple Inc. v. Qualcomm Inc.</i> ,<br>IPR2018-01276, 2020, Pat. App. LEXIS<br>7895 (PTAB Feb. 3, 2020)..... | 9, 21, 26 |
| <i>Axonics, Inc. v. Medtronic, Inc.</i> ,<br>73 F.4th 950 (Fed. Cir. 2023).....                               | 32, 36    |
| <i>BlephEx, LLC v. Myco Indus., Inc.</i> ,<br>24 F.4th 1391 (Fed. Cir. 2022) .....                            | 19        |
| <i>BoardActive Corp. v. Foursquare Labs., Inc.</i> ,<br>22-cv-00597 (D. Del. 2022).....                       | 2         |
| <i>Connell v. Sears, Roebuck &amp; Co.</i> ,<br>722 F.2d 1542 (Fed. Cir. 1983).....                           | 19, 39    |
| <i>In re Bigio</i> ,<br>381 F.3d 1320 (Fed. Cir. 2004).....                                                   | 34        |
| <i>Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.</i> ,<br>821 F.3d 1359 (Fed. Cir. 2019).....         | 6, 40     |
| <i>Novartis AG v. Torrent Pharms.</i> ,<br>853 F.3d 1316 (Fed. Cir. 2017).....                                | 8         |

|                                                                                               |               |
|-----------------------------------------------------------------------------------------------|---------------|
| <i>SAS Institute Inc. v. Iancu</i> ,<br>138 S. Ct. 1348 (2018) .....                          | 6             |
| <i>Trading Techs. Int'l, Inc. v. IBG LLC</i> ,<br>921 F.3d 1378 (Fed. Cir. 2019) .....        | 8             |
| <i>United States v. Dunkel</i> ,<br>927 F.2d 955 (7th Cir. 1991) .....                        | 9, 21         |
| <i>Univ. of Strathclyde v. Clear-Vu Lighting LLC</i> ,<br>17 F.4th 155 (Fed. Cir. 2021) ..... | 31, 33        |
| <i>Xerox Corp. v. Bytemark, Inc.</i> ,<br>IPR2022-00624 (PTAB Feb. 10, 2023) .....            | 9, 24, 26, 30 |

## **Statutes**

|                          |             |
|--------------------------|-------------|
| 35 U.S.C. § 102 .....    | 19, 39      |
| 35 U.S.C. § 103 .....    | 29          |
| 35 U.S.C. § 112(b) ..... | 13          |
| 35 U.S.C. § 282(b) ..... | 11, 14      |
| 35 U.S.C. § 312(a) ..... | 1, 6, 7, 40 |
| 35 U.S.C. § 314(a) ..... | 5, 40       |

## **Other Authorities**

|                                                           |    |
|-----------------------------------------------------------|----|
| 77 Fed. Reg. 48,756, 48,763 (Aug. 14, 2012) .....         | 7  |
| Consolidated Trial Practice Guide 44-45 (Nov. 2019) ..... | 15 |

## **Regulations**

|                          |        |
|--------------------------|--------|
| 37 C.F.R. § 42.65 .....  | 9, 24  |
| 37 C.F.R. § 42.100 ..... | 11, 14 |

|                          |               |
|--------------------------|---------------|
| 37 C.F.R. § 42.104 ..... | 7, 13, 40, 41 |
| 37 C.F.R. § 42.107 ..... | 1             |

## TABLE OF EXHIBITS

| <b>Exhibit</b> | <b>Title</b>                                                     |
|----------------|------------------------------------------------------------------|
| 1001           | U.S. Patent No. 10,621,620 to Pittman (“Pittman”)                |
| 1002           | Declaration of Dr. Steven Goldberg, Ph.D.                        |
| 1003           | Petitioner’s Power of Attorney                                   |
| 1004           | U.S. Patent Application Publication No. 2015/0095124 (“Verizon”) |
| 1005           | U.S. Patent Application Publication No. 2016/0309292 (“Kerr”)    |
| 1006           | U.S. Patent Application Publication No. 2015/0262214 (“Geer”)    |
| 1007           | International Publication No. WO 2017/079838 A1 (“Muhire”)       |
| 1008           | U.S. Patent No. 9,094,137 (“Sehn”)                               |
| 1009           | European Patent Publication No. 2424278 A1 (“Alcatel”)           |
| 2001           | U.S. Patent No. 10,621,620 file history                          |

## I. INTRODUCTION

Patent Owner BoardActive Corporation (“BoardActive” or “Patent Owner”) submits the following Patent Owner Preliminary Response pursuant to 37 C.F.R. § 42.107(a). *See also* 37 C.F.R. § 42.107(b). Petitioner Foursquare Labs, Inc. (“Foursquare” or “Petitioner”) filed a Petition for *Inter Partes* Review of U.S. Patent No. 10,621,620 (the ’620 patent”) on May 9, 2023. (IPR2023-00918, Paper No. 1 (“Petition”)).

Patent Owner respectfully requests that the Board deny the Petition because Foursquare has failed to meet its burden to show a reasonable likelihood that at least one of the challenged claims is unpatentable. Specifically, Foursquare has not demonstrated a reasonable likelihood that any claim of the ’620 patent would be anticipated or rendered obvious in view of any of the thirteen (13) separate Grounds. Additionally, by use of “and/or” or “or” within five of the 13 Grounds, Petitioner has set forth a total of twenty-one (21) different combinations (two anticipation and 19 obviousness) of nine references, covering 29 claims, with one of the Grounds incorporating five references. With this many references and Grounds, Petitioner has left it to the Board to hunt through the references to determine whether they actually support Petitioner’s assertions, contrary to 35 U.S.C. § 312(a)(3). *Inter-Partes* Review should be denied.

## **II. MANDATORY NOTICES (37 C.F.R. § 42.8)**

### **A. Real Party in Interest**

Patent Owner BoardActive Corporation is the real party-in-interest.

### **B. Related Matters**

There are two related matters. On May 3, 2022, BoardActive filed a litigation against Foursquare asserting five patents, one of which was U.S. Patent No. 10,692,108 (the “’108 patent”) and one of which was the ’620 patent. *BoardActive Corp. v. Foursquare Labs., Inc.*, 22-cv-00597 (D. Del. 2022). The case was dismissed without prejudice on May 5, 2023. Concurrent with this petition, Foursquare filed IPR2023-00919 challenging BoardActive’s ’108 patent.

**C. Counsel and Service Information**

| <b>Counsel for BoardActive Corporation, Inc.</b>                                                                                                                                                             |                                                                                                                                                                                                                                                                                                                                                       |
|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>Lead Counsel</b>                                                                                                                                                                                          | <b>Back-Up Counsel</b>                                                                                                                                                                                                                                                                                                                                |
| <p>Meredith Martin Addy<br/>Reg. No. 37,883<br/>meredith@addyhart.com</p> <p><b>ADDYHART P.C.</b><br/>10 Glenlake Parkway<br/>Suite 130<br/>Atlanta, Georgia 30328<br/>312.320.4200 T<br/>312.254.2547 F</p> | <p>Robert Hart<br/>Reg. No. 35,184<br/>robert@addyhart.com</p> <p>Gregory B. Gulliver<br/>Reg. No. 44,138<br/>gbgulliver@addyhart.com</p> <p>Brandon C. Helms<br/>Reg. No. 61,742<br/>bhelms@addyhart.com</p> <p><b>ADDYHART P.C.</b><br/>401 N. Michigan Ave.<br/>Suite 1200-1<br/>Chicago, Illinois 60611<br/>312.834.7701 T<br/>312.264.2547 F</p> |

| <b>Counsel for Foursquare Labs, Inc.</b>                                                                                                                                                                     |                                                                                                                                                                                                        |
|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>Lead Counsel</b>                                                                                                                                                                                          | <b>Back-Up Counsel</b>                                                                                                                                                                                 |
| Michael A. Carrillo<br>Reg. No. 44,595<br>michael.carrillo@btlaw.com<br><br><b>BARNES &amp; THORNBURG, LLP</b><br>One North Wacker Drive Suite 4400<br>Chicago, IL 60606<br>312.214.4817 T<br>312.759.5646 F | Steven D. Shipe<br>Reg. No. 71,944<br>steven.shipe@btlaw.com<br><br><b>BARNES &amp; THORNBURG, LLP</b><br>555 12th Street, NW Suite 1200<br>Washington, D.C. 20006<br>202.408.6924 T<br>202.289.1330 F |

**D. 37 C.F.R. § 42.28(b)(4): Service Information**

BoardActive submitted its Mandatory Notices, Paper 4, and Power of Attorney, Paper 5. BoardActive consents to electronic service directed to the following email address:

BoardActive-IPRs@addyhart.com.

**III. DISCRETIONARY DENIAL IS APPROPRIATE**

**A. The Petition lacks Particularity.**

Petitioner has grouped the grounds into thirteen grounds, but when all the permutations are identified, there are nineteen unique groupings of obviousness references along with two anticipation Grounds, for a total of 21 Grounds covering 29 claims—with one of the Grounds requiring a staggering combination of five of the nine references. Less than half of the claims are included in each of the Grounds.

The Petition's lack of particularity has resulted in voluminous and excessive Grounds, including duplicated Grounds addressing different sets of claims. The excessive and duplicative Grounds are the result of Petitioner using "and/or," "or," and "or also" in numerous Grounds; Petitioner has failed to state precise grounds of unpatentability and has adversely affected Patent Owner's ability to present a reasoned response.<sup>1</sup>

The Petition also fails to show any motivation to combine the provided references. Rather, any discussion on using combinations is limited to discrete claim elements (and not the motivation regarding the actual references themselves), resulting in a hunt through string cites and multiple paragraphs in the Petition and Declarations in an attempt to identify the possible motivation to combine the references. Many of the Petition's assertions are supported without adequate explanation by only providing string cites.

The Board may exercise its discretion under 35 U.S.C. § 314(a) to deny institution of a petition for *inter partes* review. *Adaptics Ltd. v. Perfect Co.*,

---

<sup>1</sup> The numerosity of arguments in the Petition also calls to mind the oft-quoted statement from former Third Circuit Judge Aldisert that when a brief "contains ten or twelve points, a presumption arises that there is no merit to *any* of them." *Gary v. Braddock Cemetery*, 517 F.3d 195, 199 n.1 (3d Cir. 2008) (citation omitted).

IPR2018-01596, Paper No. 20, 2019 Pat. App. LEXIS 4775, \*24 (PTAB Mar. 6, 2019). In *Adaptics*, the Board found that the petition failed to meet the particularity requirement of 35 U.S.C. § 312(a)(3) because of the numerosity of issues provided. *Adaptics* at \*33. The use of “and/or” to connect the references resulted in a multiplicity of grounds that Petitioner did not present with sufficient particularity, yielding “an unduly burdensome number of combinations.” *Id.* at \*24. Accordingly, the Panel in *Adaptics* denied the petition “in the interests of efficient administration of the Office and integrity of the patent system.” *Id.* While the instant Petition’s use of “and/or” may not result in literally “hundreds of possible combinations,” it does result in over twenty (20), and just as in *Adaptics*, those combinations fail to meet the particularity requirement of 35 U.S.C. § 312(a)(3); *see also Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2019) (“It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” (quoting 35 U.S.C. §312(a)(3))).

The Board must make “a binary choice—either institute review or don’t.” *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018). The institution of an IPR remains discretionary even if a petitioner demonstrates a reasonable likelihood of success as to at least one claim. *See* 35 U.S.C. § 312(a)(3) requires an IPR petition

to identify “with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” Furthermore, the PTAB’s Trial Practice Guide advises petitioners to “avoid submitting a repository of all the information that a judge could possibly consider, and instead focus on concise, well-organized, easy-to-follow arguments supported by readily identifiable evidence of record.” 77 Fed. Reg. 48,756, 48,763 (Aug. 14, 2012). As set forth in Section IX, *infra*, the Petition here is merely a “repository of all information” as criticized in the Trial Practice Guide.

**B. The Petition must specify where each element of the claim is found in the prior art.**

The Petition fails to meet the requirements of 35 U.S.C. § 312(a) and 37 C.F.R. § 42.104(b)(4), because it lacks specificity as to where each element of the claims of the ’620 patent is found in the prior art relied upon. String cites to multiple paragraphs in the references and Declaration are relied on throughout the Petition with little or no explanation of what those paragraphs teach or explain, and no quoted sections of the references identify where and what is being relied on in a reference. *See e.g.*, Pet. 22 (Element 1(b)(ii)); Pet. 10 (Element 28(c)(ii)); Pet. 13 (Element 28(g)); Pet. 15 (Geer discussion); Pet. 28 (Claim 12); Pet. 30 (Claim 16); Pet. 32 (Claim 20); Pet. 33 (Claim 22).

Additionally, in its discussion of Ground I, claim 28, Petitioner fails to explain how it is parsing the elements. Petitioner lists heading: “2. Element 28(a), 28(a)(i)-

(ii),” Pet. 6, without explanation for what those sub elements cover. This is further complicated because Petitioner’s parsing under Ground I is different than in its Appendix of Claims, which sets forth elements 28(a), 28(a)(i), 28(a)(i)(1), 28(a)(i)(2). Pet. x-xi. Petitioner fails to explain not only how the subdivision on page 6 of the Petition should be made, much less why it has one less subsection than set forth in the Appendix of Claims. Petitioner also fails to explain what subsection was excluded from discussion in Ground I. *See* Pet. 6. *Accord* Pet. 16-17 (setting forth only “1. Element 29(a),” without explanation for what it covers); *but see* Appendix of Claims xi-xii (setting forth Elements 29(a), 29(a)(i), 29(a)(i)(1), and 29(a)(i)(2)).

Even assuming Petitioner has a viable theory, which it does not, Petitioner should have explained that theory in its Petition—a mere string citation is insufficient. *See, e.g., Trading Techs. Int’l, Inc. v. IBG LLC*, 921 F.3d 1378, 1385 (Fed. Cir. 2019) (holding that a conclusory assertion with no analysis was not adequately developed); *Novartis AG v. Torrent Pharms.*, 853 F.3d 1316, 1326 n.2 (Fed. Cir. 2017) (finding that an argument presented in one conclusory sentence and a string cite was “far from sufficient to raise a meaningful challenge” and “amount[ed] to little more than a request that the Board peruse the cited evidence and piece together a coherent argument on Novartis’ behalf”).

Further, the Board has ruled in similar situations that “a string citation lacking any explanation whatsoever is imprecise and vague ... they are presented without explanation or further direction ... Judges are not like pigs, hunting for truffles buried in briefs; nor will we hunt for truffles buried in string citations, offered in briefs.” *Apple Inc. v. Qualcomm Inc.*, IPR2018-01276, Paper No. 32, 2020 Pat. App. LEXIS 7895, \*15-16 (PTAB Feb. 3, 2020) (citing *Anderson v. Eppstein*, 59 USPQ2d 1280, 1287 (BPAI 2001) and *United States v. Dunkel*, 927 F.2d 955, 956 (7th Cir. 1991)).

Finally, vague and conclusory expert declarations are entitled to little or no weight under 37 C.F.R. § 42.65(a). A recent precedential opinion issued from a *sua sponte* Director Review emphasizes this requirement. *See Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper No. 12, at 4 (PTAB Feb. 10, 2023) (the expert declaration “merely repeats, *verbatim*, the conclusory assertion for which it is offered to support” and therefore it is “entitled to little weight”) (citing 37 C.F.R. § 42.65(a)). Such is the case here; the expert declaration (Exh. 1002) parrots the same string cites and unsupported assertions found in the Petition. Patent Owner specifically identifies the claim elements where Petitioner relies on conclusory statements in expert declarations in Section IX, *infra*.

#### **IV. BACKGROUND OF U.S. PATENT NO. 10,621,620**

The '620 Patent, titled “Platform for Location and Time Based Advertising,” issued on April 14, 2020, is a continuation-in-part of U.S. application 15/483,790, filed on April 10, 2017, titled “A Platform for Location and Time Based Advertising,” which issued on December 31, 2019, as U.S. Patent 10,521,822. Exh. 1001, Related U.S. Application Data.

The '620 patent relates generally to digital advertising and provides a stand-alone application, API (application programming interface), or SDK (software development kit), configured to: i) register digital assets, physical assets, virtual assets, brand assets, media assets, and mobile assets, ii) associate content to be delivered in response to an activation of those assets, iii) specify triggers for delivering content to targeted consumer profiles, iv) engage the consumer at the right time/place with the targeted profile, and v) track user engagement and provide analytics on consumer engagement. *See* Exh. 1001, Abstract.

#### **V. PERSON OF ORDINARY SKILL IN THE ART**

A person with ordinary skill in the relevant art at the time of invention—April 10, 2017<sup>2</sup>—would have a bachelor’s degree in computer science, electrical engineering, computer engineering, or an equivalent field and three years of

---

<sup>2</sup> Using date from Exh. 1002, ¶25.

experience working with digital advertising and geofencing. Additional education might compensate for less experience and vice-versa, but at a minimum, a bachelor's degree is required.

## VI. THE CHALLENGED CLAIMS

Petitioner challenges claims 1-29 of the '620 patent. Of those, claims 1, 28, and 29 are independent. Each claim recites features distinguishing the '620 patent from the asserted prior art, either directly or via dependency.

## VII. CLAIM CONSTRUCTION

In an *inter partes* review proceeding, “a claim of a patent ... shall be construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b), including construing the claim in accordance with the ordinary and customary meaning of such 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).

### C. The term “Consumer” should be construed as a “user or person to whom an advertisement is sent to elicit engagement.”

The Abstract of the '620 patent itself uses the term “consumer” in reference to engagement:

- iii) specify triggers for delivering the AdDrop™ (e.g., space/time/event) and target **consumer** profiles for receiving the AdDrop™ (e.g., Gender/Demographic/

Propensity/Interest/Behavior/Etc.), iv) transmit interactive AdDrop™ for engaging the **consumer** at the right time/place, with the targeted profile, and v) track user engagement and provide analytics on **consumer** engagement.

Ex. 1001, Abstract (emphasis added). The consumer is the user to whom the advertisements are directed and from whom an action is elicited.

This definition is further supported in the body of the patent:

The platform may enable a platform user (e.g., an Administrator or “Admin”) to interact with its target content consumers based on, for example, but not limited to, the location of the consumer in time and space, the actions the consumer takes within the time and space, the characteristics of the consumer, and the characteristics of their technical devices. Accordingly, the various embodiments disclosed herein provide a new medium of communication with consumers.

Exh. 1001, 8:35-57 (emphasis added).

The file history of the '620 Patent also supports this definition of “consumer.” The Examiner, in the Notice of Allowance, found that “[a]llowed claims are narrower...[i]n addition, applicant has already further narrowed claim 1 by checking for **consumer** qualification for targeting by advertiser in 8<sup>th</sup> step of claim 1 by having a delivery rule corresponding to at least one element of PROFILE data, shown in

claims 1 (limitation 8 and 14), and claims 12, and 30.” Exh. 2001, p.52. Hence, the reason for allowance explicitly referenced engagement with a consumer or user.

**D. Petitioner has waived its right to make new claim construction arguments by failing to include them in its Petition.**

Rather than propose its own claim constructions, Petitioner improperly attempts to reserve the right to challenge claim construction at a later time under 35 U.S.C. § 112(b). Pet. at p.4, n.1. To the extent Petitioner states that no express construction is required and then later advocates for a specific interpretation during the course of any instituted IPR, Petitioner’s reservation would be contrary to federal regulation, this Board’s guidelines, and settled law. *See* 37 C.F.R. § 41.104(b)(3) (“The statement [of relief requested] must identify ... [h]ow the challenged claim is to be construed.”); *Microsoft Corp. v. Uniloc*, IPR2019-01188, Paper 27 at 19, 2020 Pat. App. LEXIS 12698 (PTAB Nov. 4, 2020) (on reply, petitioner “cannot raise new claim construction issues that were not previously raised in its petition”) (quoting Consolidated Trial Practice Guide 44-45 (Nov. 2019) *available at* <https://www.uspto.gov/TrialPracticeGuide>).

Moreover, the Petition seems to suggest that it may apply a claim construction approach that is contrary to law, i.e., “Petitioner believes that the constructions of terms can be appreciated from their overall discussion herein and application of the prior art ....” Pet., 4. However, claims must be construed “in accordance with the ordinary and customary meaning of such 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) (emphasis added) (citing 35 U.S.C. § 282(b)).

Hence, all other claim terms should be given their plain and ordinary meaning as used in the ’620 patent specification and file history. If the Board does construe any other claim terms, Patent Owner reserves the right to provide constructions for those terms or other terms, if they become material to the Board’s decision.

## **VIII. OVERVIEW OF THE PRIOR ART**

### **A. Verizon (Exh. 1004).**

Unlike the ’620 patent, Verizon—a U.S. patent application, published on April 2, 2015, and subsequently abandoned in 2017—is directed to systems and methods “for displaying marketing content at a predetermined location and at a predetermined time.” Ex. 1004, Abstract. That is, rather than being directed to delivering personalized content to a consumer and evaluating the efficacy of that messaging, as claimed by the ’620 patent, Verizon provides advertising content based solely on characteristics concerning the advertisement itself (particular location or time of day) and a potential customer’s proximity to the advertisement. *Id.* at [0018].

Verizon also describes two distinct embodiments to delivering content, and as described below, the Petition selectively, and improperly, combines components from both embodiments when it suits Petitioner to do so. For example, one

embodiment in Verizon sends advertising content to non-consumers such as billboards, vehicular displays, subway cars, trolley cars, and signs. *Id.* at [0021]. Such systems do not involve delivering advertisements to “consumers” as required by the ’620 patent.

A second embodiment is to send advertising content directly to a consumer’s mobile device. *See, e.g., id.* at [0044]. However, in this embodiment, rather than target a user based on their course of travel or their previously known preferences, a consumer receives content solely because of their proximity to a display (e.g., a billboard or a vehicular display). *Id.*

Further, there is nothing in either of Verizon’s approaches that would permit a company to evaluate the efficacy of its advertising content.

**B. Kerr (Exh. 1005).**

Kerr is an October 20, 2016 publication of U.S. Patent Application 15/099,855, and it claims priority back to October 3, 2011. Exh. 1005, 1. Kerr describes itself as “a system for delivering targeted content to a wireless handset ... that is communicatively coupled to a network.” Exh. 1005, Abstract. Specifically, the system transmits content to a handset based on an associated user profile having at least one user attribute. *Id.*; *see also* [0019].

Although Kerr mentions sending text advertisements to a user based on the user's profile preferences, *id.* at [0133], there is no discussion of tracking a user and updating content based on the changing locations of the user.

**C. Geer (Exh. 1006).**

Geer, patent application publication number US 2015/0262214, claims priority to March 2014, and is directed to a system for social networking at a specific event or venue. Exh. 1005, ¶2. For example, fans attending a sporting event can use an application on a cellular phone to message each other. *Id.*, ¶6. The users of Geer's system are already present at an event or venue. *See id.*, ¶¶6–7; *see also id.*, ¶50 (“After the start [], fan [] registers ... to participate in the FNS [] at the event.”) Thus, unlike the '620 patent, the system of Geer is not attempting to influence users to drive to a certain location, nor is it evaluating how successful any advertisements are at steering users to desired locations. In short, Geer is only tenuously related to the field of advertising, and it is wholly unrelated to the invention disclosed in the '620 patent.

**D. Muhire (Exh. 1007)**

Muhire is an international publication, dated May 18, 2017 with a priority date of November 10, 2015. The field of the invention and background sections describe Muhire as systems and methods for helping consumers “save, manage their time and maintain a healthy budget.” Exh. 1007, [0001-0002]. One embodiment discloses

“an electronic touchscreen device attachable by magnet or other methods, and/or integrated to a refrigerator or other surfaces” that is designed to receive media from a cloud computing server related to saving and budgeting tools. *Id.* at [0007-0008]. There is no description of personalizing content based on a user’s real-time location and travel; rather a user must manually select a location to receive content regarding nearby stores. *Id.* at [0041], [0064], [0079], & Fig. 11.

**E. Sehn (Exh. 1008)**

Sehn, U.S. Patent No. 9,094,137, titled “Priority Based Placement of Messages in a Geo-Location Based Event Gallery,” issued on July 28, 2015, and was filed on October 24, 2014. *See* Exh. 1008. The Abstract describes a digital “event gallery” in which devices located in a geolocation fence can send messages to the gallery. *Id.*

The event gallery is created “from messages from users within a geo-location fence associated with an event” or from “individuals following an event.” *Id.* at 6:27-30. Thus, Sehn is not directed to delivering personalized advertisements to consumers based on their profiles or their direction of travel. In short, Sehn bears little relation to the claimed invention of the ’620 patent.

**F. Alcatel (Exh. 1009)**

Alcatel is a European patent application that claims priority back to 2010. Ex. 1008. Alcatel relies on storing and using “the mobility history” of a mobile device.

*Id.*, Abstract & ¶6. When a user passes by a “base station,” and has opted to receive content delivery, the system sends a message like “Road X closed for construction....” *Id.*, ¶¶15-18. Nothing in Alcatel discloses tracking multiple positions of a user, or comparing those positions to a predicted course of travel. Moreover, while Alcatel mentions that the content may be advertisements, *id.* at ¶16, there is no disclosure of personalizing the content based on the user’s expected course of travel or their proximity to a specific billboard or store. Nor is there any mention of evaluating the effectiveness of any advertisement sent to the user.

**G. Cellco (Exh. 1010)**

Cellco, U.S. Patent No. 8,391,886, is titled “Systems and Methods for Providing Mobile Handset Position to Software Applications.” Exh. 1010. It issued on March 5, 2013, but was filed back on July 14, 2010. As the name suggests, Cellco is directed to methods for providing location information of a mobile device (e.g., smartphones) to software applications on the device. *Id.* at Abstract.

As an example of prior art software that Cellco claims to improve upon, it describes applications that permit parents to keep tabs on their children’s locations or friends and family members to monitor each other’s locations. *Id.* at 1:39-59. Cellco makes no disclosures or references concerning digital advertising, let alone the personalization of digital advertising, and thus it bears no relevance to the claimed invention of the ’620 patent.

## **IX. RESPONSE TO SPECIFIC IPR GROUNDS**

In addition to the reasons for discretionary denial and procedural flaws outlined in Section III *supra*, Foursquare’s Petition should be denied for failing to show that there is a reasonable likelihood that the challenged claims are unpatentable.

### **H. GROUND I: Anticipation of Claims 28 and 29 under 35 U.S.C. § 102 by Verizon.**

For anticipation, a prior art reference must show each and every element of the claimed invention, arranged as in the claim. *See Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983). Thus, a rejection based on anticipation is overcome by pointing out at least one difference between the claimed invention and the prior art reference.

Verizon describes two different and distinct embodiments to delivering content. The first is delivery of content to a consumer, and the second is delivery of content to a non-consumer. The Petition cherry-picks elements from the different embodiments, while ignoring the actual teachings and description contained in Verizon, as well as ignoring or misconstruing the actual elements of the claims. *See BlephEx, LLC v. Myco Indus., Inc.*, 24 F.4th 1391, 1400–02 (Fed. Cir. 2022) (“[I]t is not enough that the prior art reference includes multiple, distinct teachings that the artisan might somehow combine to achieve the claimed invention to show anticipation.”).

**1. Independent Claim 28—“A method comprising:”**

- a. “registering asset data, wherein registering the asset data comprises at least one of the following:**  
**registering a first geolocation associated with one of the following:**  
**a physical asset, and**  
**a virtual asset;**

The Petitioner has failed to meet its burden of establishing that this element is present in Verizon, and claim 28 is therefore not anticipated by Verizon.

The Petition’s labels from Section VI.A.1 are different from its labels in the Appendix of Claims. The Petition lumps together elements 28(a) and 28(a)(i)-(iii), without explanation of what they cover. *See* Pet. 6.<sup>3</sup> Thus, it is impossible to know how the Petition is partitioning the claim, requiring Patent Owner and the Board to search through the Petition and use deduction or divination to ascertain the Petition’s arguments.

---

<sup>3</sup> The Petition Appendix sets out four elements under the heading 28(a): 28(a), 28(a)(i), 28(a)(i)(1), and 28(a)(i)(2). By Contrast, Section VI.A.1. refers without description to only three elements under 28(a): 28(a), 28(a)(i), and 28(a)(ii). Petitioner does not specify which element it has excluded, but the Petition provides no explanation of a “virtual asset,” other than stating that “Verizon’s components generally can be virtual.” Pet. 6. The Declaration provides no further detail. Exh. 1002, ¶97, citing to a single paragraph of Verizon.

Compounding this significant problem, the Petition relies on string cites with little or no explanation to compare portions of Verizon to these mystery claim elements. *See, e.g.*, Pet. 7-8 (citing paragraphs 0026, 0028, 0032, 0036, 0046 of Exh. 1004). This is legally insufficient to meet the burden of showing unpatentability. *See Apple Inc. v. Qualcomm Inc.*, IPR2018-01276, Paper No. 32, 2020 Pat. App. LEXIS 7895, \*15-16 (PTAB Feb. 3, 2020) (“a string citation lacking any explanation whatsoever is imprecise and vague” and judges “‘are not like pigs, hunting for truffles buried in briefs’; nor will [judges] hunt for truffles buried in string citations, offered in briefs”) (citing *Anderson*, 59 U.S.P.Q.2d at 1287 and *Dunkel*, 927 F.2d at 956).

Upon reviewing paragraph [0026], no mention of registering asset data is found. In paragraph [0028], no mention of registering assets is described. A discussion occurs that “marketing content may be categorized or assigned criteria by ad agencies.” Exh.1004, ¶0028. Categorizing or assigning criteria to marketing content is not registering an asset. The Petition makes no explanation of how it could be. Further, it is asserted that a cropped statement in Verizon about “geographical locations of, for example, businesses, parks, institutions, or [...] mobile units 124, mobile devices 120, or even displays 114,” somehow satisfies registration, Pet. 7-8, but when the missing portions of Verizon are read in context, it is clear that the alleged assets are assigned criteria not being registered:

The marketing content may be further categorized or assigned criteria based on preferred location of display, time of display, proximity to known geographical locations of, for example, businesses, parks, institutions, or proximity to other mobile unit 124, mobile devices 120, or even displays 114.

*Id.* Thus, marketing content is categorized—not registered—based upon the proximity to known geographical locations of businesses, parks, institutions, or proximity to another mobile unit 124, mobile device 120, or even display 114. The other cited paragraphs do not describe registering assets.

Paragraph 0036 of Verizon mentions tracking the location of different devices, but identifying a geolocation of a device, such as non-consumer device mobile unit 124 is not registering the device. If it is an asset, how was it registered?

It is asserted that Verizon discloses such registration by its acknowledgement that ads are provided by third party agencies, and categorized according to location/proximity, followed by a string cite of four paragraphs of Verizon and a paragraph in the declaration. There is no identification as to what is actually being cited in those paragraphs or to what element is being addressed; a physical asset or a virtual asset, or just making an unsupported assertion that third party information is always registered. After searching through the string cites, paragraphs 0034-0036 describe categorization and storage of marketing content, but no registration is

described. Paragraph 0028 of Verizon mentions ad agencies storing marketing content to ad server 107 that may be stored in ads bank 108. *See* Exh. 1004, 0028. Storing content is not registering an asset as claimed in the '620 patent.

In summary, as best as Patent Owner can decipher Petitioner's arguments concerning this portion of claim 28, Petitioner has not met its burden of showing that Verizon teaches this claim element of claim 28 of the '620 patent.

**b. “receiving media content to be associated with at least one registered asset;”**

The Petition relies on the same paragraphs in Verizon as the previous element, including similar unexplained string cites. Pet. 9. To begin, the Petition states, “Verizon discloses receiving media...to be associated with at least one registered asset.” *Id.* A brief reference to categorizing and assigning criteria is made, before the Petition states that “Verizon’s display itself can be a business marketing display, and further associates the content with the Business.” *Id.* Such media content from Verizon cannot be the “media content” required by the claim, because claim 28’s media content must be “associated with at least one registered asset.” Exh. 1001, 40:11-12. The Petition makes no effort to identify what the associated registered asset in Verizon is or could be; rather, it is improperly left up to the Board and Patent Owner to identify.

The Declaration provides no further guidance, reiterating the conclusory assertion that, based on the expert’s “understanding,” “the display itself can be a

business marketing display, and further demonstrates the association of the content with the business itself.” Exh. 1002, ¶98 (citing Exh. 1004, [0036] & [0046]). However, this brief argument, unsupported by evidence as to how the expert reached his “understanding,” misconstrues the language of the claim. Nor does the expert actually identify any purported registered asset. *See id.* Such conclusory expert opinions, which merely repeat verbatim unsupported claims in the Petition, are not sufficient to show a reasonable likelihood of unpatentability and should be given little weight. *See Bytemark*, Paper No. 12, at 4 (the expert declaration “merely repeats, *verbatim*, the conclusory assertion for which it is offered to support” and therefore it is “entitled to little weight”) (citing 37 C.F.R. § 42.65(a)).

**c. “specifying a plurality of rules for delivering the media content, wherein specifying the plurality of rules comprises specifying:**

**a first delivery rule associated with at least one element of profile data corresponding with a recipient of the media content, and**

**a second delivery rule associated with a second geolocation at which the recipient is tracked.”**

Petitioner has failed to meet its burden of establishing this element is present in Verizon, and for this reason as well, claim 28 is therefore not anticipated by Verizon.

For example, the Petition states, “Verizon discloses specifying rules at least by its criteria/requirements for delivery of tailored content” for the first rule, and

“Verizon discloses rules for delivery of ad content also based on a second location as recited” for the second rule. *See* Pet. 9. But that is not what is claimed. Rather, the plurality of rules must consider “a second geolocation at which the recipient is tracked.” Exh. 1001, 40:13-20. There is nothing in Verizon describing a second rule being employed at a second delivery location. The only description is a first rule employed at a location to deliver content. Pet. 10. However, the Petition again the first delivery rule in Verizon at a second location, but not for Verizon’s consumer’s mobile unit 120. Instead, without explanation, the Petition inserts Verizon’s network client mobile unit 124 is at location 1, location 2, location 3. *See* Pet. 10; Exh. 1002, ¶100. Verizon’s network client mobile unit 124 is a vehicle, which is not a consumer. Exh. 1004, Fig. 1. Therefore, not only is Petitioner erroneously mixing embodiments of Verizon, but Petitioner incorrectly assumes without explanation that the network client mobile unit 124 is a consumer.

Hence, Petitioner has failed to meet its burden of establishing that these elements of claim 28, and for these reasons as well, the ’620 Patent is not anticipated by Verizon.

- d. “receiving an indication that the recipient is proximate to the first geolocation, comparing the first delivery rule and the at least one element of profile data associated with the recipient;”**

Once again, the Petition mixes embodiments of Verizon. Pet. at 10. Further, the Petition makes general statements of the teachings of Verizon with no text

directly cited in Verizon or the '620 patent. It is left up to Patent Owner and the Board to read the string sites in an attempt to discern Petitioner's argument *id.* at 10-11, and thus the Petition has failed to show how Verizon anticipates this element of claim 28. *See Apple*, IPR2018-01276, 2020 Pat. App. LEXIS 7895, \*15-16 (judges “are not like pigs, hunting for truffles buried in briefs”).

- e. **“tracking a location that the recipient in response to a matching comparison; comparing the second delivery rule and the location in order to determine whether the recipient is proximate to the second geolocation; and delivering, upon fulfillment of the first deliver rule and the second delivery rule, the media content to the recipient.”**

Continuing the trend, the Petition's two-paragraph argument for claim element 28(e) and its one paragraph arguments for 28(f) and 28(g) rely solely on generalities and unexplained string cites. Pet. 11-13. The expert declaration provides no further clarity. Exh. 1002, ¶¶ 102-06. Therefore, the Petition has failed to establish that these claim elements are anticipated by Verizon. *See Apple*, IPR2018-01276, 2020 Pat. App. LEXIS 7895, \*15-16; *Bytemark, Inc.*, IPR2022-00624, Paper No. 12, at 4 (conclusory expert declarations are entitled to little weight).

**2. Independent Claim 29: “A computer-readable medium comprising a set of instructions which when executed perform a method, the method comprising:”**

- a. “registering asset data, wherein registering the asset data comprises at least one of the following:**

**registering a first geolocation associated with one of the following:**

**a physical asset, and**

**a virtual asset**

- b. “media content to be associated with at least one registered asset;”**

- c. “specifying a plurality of rules for delivering the media content, wherein specifying the plurality of rules comprises specifying:**

**a first delivery rule associated with a period of time, and**

**a second delivery rule associated with a second geolocation at which a recipient is tracked during the period of time;”**

- d. “receiving an indication that the recipient is proximate to the first geolocation;”**

- e. “tracking a location associated with the recipient in response to a matching comparison;”**

- f. “comparing the second delivery rule and the location in order to determine whether the recipient is proximate to the second geolocation; and”**

- g. “delivering, upon fulfillment of the first delivery rule and the second delivery rule, the media content to the recipient.”**

Despite asserting in its Identification of Challenges that claim 29 was anticipated by Verizon, (Pet. 1), Petitioner fails to provide any discussion about the purported anticipation of claim 29 by Verizon. After presenting a bare bones argument for anticipation of claim element 28(g) under Ground I, (Pet. 13), the Petition turns to obviousness of claims 28 and 29, which is Ground II. Pet. 13. The expert Declaration does the same. Exh. 1002, pp. 53-54.

What is perplexing, however, is that on page 16, under the heading “OBVIOUSNESS,” in view of Verizon, Kerr, and Geer, the Petition incorporates the “evidence and arguments regarding Verizon, and Verizon with Kerr as to claim 28” as to the allegedly “identical” claim 29. Pet. 16. Then out of left field, the Petition concludes its combined section on Grounds I and II anticipation and/or obviousness by proclaiming “Verizon anticipates claims 28 & 29.” Pet. 18. This is the metaphorical definition of phoning it in, because the Petition does not discuss its allegations of anticipation of Claim 29 at all.

Patent Owner refuses to be Foursquare’s pig hunting for truffles, and the Board should do the same. Simply put, the Petition has not presented an anticipation argument for any element of claim 29.

**I. GROUND II, III-XI, and XIII: Obviousness under 35 U.S.C. § 103 with two or more references. GROUND II, III-XI, and XIII: Obviousness under 35 U.S.C. § 103 with two or more references.**

The Petition is devoid of any section addressing the motivation to combine Verizon or Alcatel in view of one or more of Kerr, Geer, Muhire, Sehn, Alcatel, and Verizon. *See generally* Pet. Instead, it is left up to the Patent Owner and Board to search through the Petition and Declaration to attempt to piece together such motivation from general statements and general cites. Making this undertaking even more difficult, multiple Grounds are lumped together with no direction as to where the different references are being relied on. Ground III is also alleged to be a single reference obviousness Ground, but in reality, it is the combination of Verizon and Cellco (Exh. 1010). *See* Pet. 26-27. The Patent Owner and the Board should not have to use word searches and clairvoyance to discern any motivations to combine references.

**1. Motivation to Combine**

**a. No motivation to combine Verizon (Exh. 1004) and Kerr (Exh. 1005) (Ground II)**

The Petitioner asserts the purpose of combining the reference is that Verizon (Exh. 1004) has a “lack of express or elaborate discussion of certain terms,” like registering asset data, but Kerr, “in the same [alleged] technology area” “teaches robust administrator controls and/or access in targeted ads.” Pet. 13. But no explicit reason is given for why a POSITA would need or want to look to Kerr to modify

Verizon to arrive at the claimed invention, and the Petition follows its general statement with a string cite to over fifty-five (55) paragraphs in Kerr, as well as Figures 4-9, 15, 19-25 and 30-35 of Kerr, all without providing a single attempt to paraphrase or explain those string cites. Pet., 14; *see Apple*, IPR2018-01276, Paper No. 32, 2020 Pat. App. LEXIS 7895, \*15-16 (“a string citation lacking any explanation whatsoever is imprecise and vague”).

The Petition then vaguely asserts that a “POSITA would have implemented ... aspects of Kerr into Verizon to promote ease of implementing/adjusting requirements, ease of understanding distribution and location schemes, and/or for effectiveness in human-machine interfacing in support of targeted content.” Pet. 14-15 (citing Dec. ¶109). In circular fashion, the Declaration makes a parallel conclusory statement: “a POSITA would have implemented such registration aspects of Kerr into Verizon to promote ease of implementing of and adjusting requirements, ease of understanding distribution and location schemes of various sorts. Again, generally these interfaces like Kerr’s, can be improve effectiveness in human-machine interfacing.” Exh. 1002, ¶109. No reference or support is cited for this verbatim opinion. *See Bytemark, Inc.*, IPR2022-00624, Paper No. 12, at 4 (conclusory expert declarations are entitled to little weight).

Additionally, Verizon fails to teach or describe multiple elements of claims 29 and 30 of the ’620 patent, and alleged POSITA knowledge and/or general

references to Kerr do not shore up those deficiencies. *See* § IX.A.1-2, *supra*. Because the combined references fail to teach or describe all the elements of independent claims 28 and 29, there can be no motivation to combine. *Univ. of Strathclyde v. Clear-Vu Lighting LLC*, 17 F.4th 155, 160-62 (Fed. Cir. 2021) (reversing Board’s finding that claims were unpatentable for obviousness when the prior art failed to disclose or suggest a key limitation).

**b. No motivation to combine Verizon (Exh. 1004), Kerr (Exh. 1005), and Geer (Exh. 1006) (Ground II).**

*See* § IX.B.1(a), *supra*, (no motivation to combine Verizon & Kerr, also Ground II).

Geer is a “fan networking system (FNS)” that can be installed on portable smart devices (like smartphones) and offers event-customized services to fans at events or venues, “such as messaging, fan groups, friends networking, mementos, coupons, and contests.” Exh. 1005, Abstract & ¶6. The field of the invention is described as “social networking at an event in a venue.” *Id.*, ¶2.

Thus, the first issue undermining a motivation to combine is that the Petition did not address why Geer, a patent directed at social media, would be utilized by a POSITA to develop a personalized, location-based advertising campaign, nor is there any explanation as to whether the teachings of Geer could even be successfully combined with Verizon. *See generally*, Pet. Indeed, Geer deals with a situation where like-minded people are already at an event, while Verizon attempts to

influence purchases; there is no reason to combine the references. And the expert Declaration falsely claims that Geer is “focused on the same sector of location-based advertising....” Exh. 1002, ¶ 110.

Second, Petitioner asserts that “Geer discloses activation of high-resolution tracking (‘HIRES’) for increased precision,” but it can also be turned off to “preserve energy when unneeded.” Pet. 15. However, many of Verizon’s devices (114, 112, 124 of FIG. 1) are non-consumer devices, and the Petition provides no evidence that battery power was an issue in Verizon. Nor is conserving battery power an issue in the ’620 patent. *See Axonics, Inc. v. Medtronic, Inc.*, 73 F.4th 950, 957 (Fed. Cir. 2023) (motivation to combine must focus on achieving the claimed invention, not on combining references for some reason unrelated to the claims).

Third, no evidence is provided that precision was lacking in Verizon or that combining Geer’s teachings to it would result in a different or improved result.

Fourth, a fan/user in Geer is at an event and has a general predetermined location. Because the general location is known, higher resolution could be helpful. In Verizon, mobile units and mobile devices are moving around a city or state, so their locations are changing. No explanation is provided as to why, when passing through a geofence, it would be advantageous in Verizon to reduce the power to save battery life using Geer’s teachings when that geofence area is not the destination. The mobile device or mobile unit 120 of the consumer would be affected when in a

geofenced area that is not the final destination if the approach of Geer was incorporated into Verizon.

For at least these reasons, a POSITA would not have been motivated to combine the teachings of Verizon with Geer to arrive at the claimed invention in the '620 patent, nor would a POSITA have any reasonable expectation of success if Verizon were combined with Geer.

Additionally, Verizon fails to teach or describe all the elements of the '620 claims 29 and 30 as multiple elements are missing. *See* § IX.A.1-2, *supra*. If the combined references fail to teach or describe all the elements of independent claims 28 and 29, there can be no motivation to combine. *Univ. of Strathclyde*, 17 F.4th at 160-62 (reversing Board's finding that claims were unpatentable for obviousness when the prior art failed to disclose or suggest a key limitation).

**c. No motivation to combine Verizon (Exh. 1004) in view of Geer (Ex. 1006) (Ground II)**

*See* § IX.B.1(b), *supra* (no motivation to combine Verizon, Kerr, & Geer, also Ground II).

**d. No motivation to combine Verizon (Exh. 1004) and Muhire (Exh. 1007) (Ground IV).**

Muhire is non-analogous art. A reference is analogous art to the claimed invention if: (1) the reference is “from the same field of endeavor” as the claimed invention (even if it addresses a different problem); or (2) the reference is reasonably

pertinent to the problem faced by the inventor (even if it is not in the same field of endeavor as the claimed invention). *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). Under any stretch of the imagination, tools to save money accessible on a touchscreen being held to a refrigerator by a magnet is not analogous art. *See* § VIII.D, *supra* (Muhire). The Petition provides no evidence why a POSITA would look to making such a combination with the location tracking of Verizon; rather only a discussion of using separate layers is provided. Pet., 35; *see also* Exh. 1002, ¶163. Yet no discussion of why or how the teachings of Muhire's layers could be successfully combined with the teachings of Verizon is given. The general statement provided in the Declaration, Exh. 1002, ¶164, could be applied to any reference—  
analogous or not.

**e. No motivation to combine Verizon (Exh. 1007) in view of Kerr (Exh. 1005) (Ground V).**

The Petition improperly asserts the same references against different claims in different grounds, which compounds what is already a confusing and misleading petition. For example, Verizon and Kerr are asserted against claims 28 and 29 in Ground 2 and then the same references are asserted against claims 1-6 and 11-27 in Ground 5, with arguments incorporated by reference, even though the Petition specifies that Ground V includes Verizon, Muhire, and Kerr. Pet. 1.

*See* § IX.B.1(a), *supra*, (no motivation to combine Verizon & Kerr, Ground II)).

**f. No motivation to combine Verizon (Exh. 1004),  
Muhire (Exh.1007) in view of Kerr (Exh. 1005)  
(Ground V).**

*See* §§IX.B.1(a), (no motivation to combine Verizon & Kerr, Ground II) and IX.B.1(d) (no motivation to combine Verizon & Muhire, Ground IV) *supra*.

**g. No motivation to combine Verizon (Exh. 1004) with  
Kerr (Exh. 1005), in view of Sehn (Exh. 1008)  
(Ground VI).**

*See* § IX.B.1(a), *supra* (no motivation to combine Verizon & Kerr, Ground II).

Sehn (Exh. 1008) has nothing to do with advertising, let alone digital advertising. Instead, it describes a digital “event gallery” in which devices located in a geolocation fence can send messages, like pictures, to the gallery. The extreme dissimilarity between it and the ’620 patent—and between Sehn and Verizon or Kerr—begs for a thorough explanation of why a POSITA would combine Verizon or Kerr with Sehn for any purpose, let alone to achieve the patented invention of the ’620 patent. Yet the Petition offers no answers, except a terse clause that “Shen’s [sic] teaching for recognizing business names and logos” could somehow help create “tailored content.” *See* Pet., 40.

Suffice it to say, the Petition provides no real motivation to combine these references.

**h. No motivation to combine Verizon (Exh. 1004) with Kerr (Exh. 1005) and Muhire (Exh. 1007), in view of Sehn (Exh. 1008) (Ground VI).**

*See* §§ IX.B.1(d) (no motivation to combine Verizon & Muhire, Ground IV) and IX.B.1(g) (no motivation to combine Verizon, Kerr & Sehn, also Ground VI), *supra*.

**i. No motivation to combine Alcatel (Exh. 1009) in view of Kerr (Exh. 1005) (Ground VII).**

The only motivation to combine that the Patent Owner could discern in the Petition is “[t]o the extent that Alcatel does not elaborately discuss particular features such as profile data, a POSITA would have implemented these features based on Alcatel’s suggestions, Kerr’s disclosure, and/or POSITA’s skill and/or knowledge.” Pet., 41 (citing Exh. 1002, ¶175). This is not a motivation to combine the references. On the contrary, it is merely a statement that it may be possible to combine the references, supported by nothing more than a verbatim recitation of the same by Petitioner’s expert. *See Axonics*, 73 F.4th at 957 (motivation to combine must focus on achieving the claimed invention, not on combining references for some reason unrelated to the claims).

**j. No motivation to combine Alcatel (Exh. 1009), Kerr (1005) in view of Muhire (Exh. 1007) (Ground VIII).**

*See* § IX.B.1(i), *supra* (no motivation to combine Alcatel & Kerr, Ground VII). If there is no motivation to combine Alcatel and Kerr, there can be no motivation of Alcatel, Kerr in view of Muhire.

- k. No motivation to combine Alcatel (Exh. 1009), and Kerr (Exh. 1005) in view of Verizon (Exh. 1004) (Ground IX).**

*See* §§ IX.B.1(a) (no motivation to combine Verizon & Kerr, Ground II) and IX.B.1(i) (no motivation to combine Alcatel, Kerr & Muhire, Ground VIII), *supra*.

- l. No motivation to combine Alcatel (Exh. 1009), Kerr (Exh. 1005), and Muhire (Exh. 1007) in view of Verizon (Exh. 1004) (Ground X).**

*See* §§ IX.B.1(a) (no motivation to combine Verizon & Kerr, Ground II) and IX.B.1(i) (no motivation to combine Alcatel, Kerr & Muhire, Ground VIII), *supra*

- m. No motivation to combine Alcatel (Exh. 1009), Kerr (Exh. 1005), and Verizon (Exh. 1004) in view of Sehn (Ground XI).**

*See* §§ IX.B.1(a) (no motivation to combine Verizon & Kerr, Ground II) and IX.B.1(i), *supra*.

- n. No motivation to combine Alcatel (Exh. 1009), Muhire (Exh. 1007), and Verizon (Exh. 1004) in view of Sehn (Ground XI).**

*See* §§ X.B.1(a) (no motivation to combine Verizon & Kerr, Ground II) and X.B.1(i), *supra*.

- o. No motivation to combine Alcatel (Exh. 1009), Kerr (Exh. 1005), Muhire (Exh. 1007), and Verizon (Exh. 1004) in view of Sehn (Ground XI).**

*See* §§ X.B.1(a) (no motivation to combine Verizon & Kerr, Ground II) and X.B.1(i), *supra*.

**p. No motivation to combine Alcatel (Exh. 1009) with Kerr (Exh. 1005) (Ground XIII).**

No motivation to combine Alcatel and Kerr in Ground XIII for the same reasons as in Ground VII. *See* § IX.B.1(i), *supra* (no motivation to combine Alcatel & Kerr, Ground VII).

**q. No motivation to combine Alcatel (Exh. 1009) with Geer (Exh. 1006) (Ground XIII).**

With respect to Geer, *see* § IX.B.1(b), *supra* (no motivation to combine Verizon, Kerr & Geer, Ground II). Geer is a non-analogous reference. For the same reasons, the Petition does not provide a motivation to combine Alcatel with Geer.

**r. No motivation to combine Alcatel (Exh. 1009) in view of Kerr (Exh. 1005) in view of Geer (Exh. 1006) (Ground XIII).**

*See* § IX.B.1(q), *supra* (no motivation to combine Alcatel & Geer).

Alcatel (Exh. 1009) is an approach for determining the location of a mobile device using its stored “mobility history.” Exh. 1009, Abstract & ¶ 6. The approach is based on using a cellular network’s base stations, MSCs, HLR, and SMPP gateways. *See* Exh. 1009, Fig. 1. Determining geographic notification is network resource intensive. *See* Exh. 1010, Fig. 5 & 3:47-49.

**s. No motivation to combine Verizon (Exh. 1004) with Cellco (Exh. 1010) to reach the claimed invention. (Ground III).**

Cellco is directed to methods for providing location information of a mobile device (e.g., smartphones) to software applications on the device. Ex. 1010,

Abstract. Thus, it is directed to a network-intensive approach, i.e., requiring cellular towers, for locating a mobile device.

In the Petition, the only possible explanation given for combining Verizon with Cellco is that “Verizon’s suggestion for database storage (including via Cellco)” could “facilitate use of location data and/or for analysis of historical locations in providing tailored content.” Pet., 26-27. But Verizon uses geofencing. A POSITA would not be motivated to look to Cellco’s network-intensive approach to improve Verizon. Further, Cellco’s use of a database of location history for determining geographic notification is not required in Verizon. Thus, the Petition’s meager assertion on pages 26-27, even if true, would not motivate a POSITA to combine Verizon with Cellco to arrive at the claimed invention of the ’620 patent.

## **2. Obviousness claim analysis.**

As there is not motivations to combine the reference, an element by element analysis is not required at this time.

### **J. GROUND XII: Anticipation of Claims 28 and 29 under 35 U.S.C. § 102 by Alcatel.**

For anticipation, a prior art reference must show each and every element of the claimed invention, arranged as in the claim. *See Connell*, 722 F.2d at 1548. Thus, Anticipation is overcome by pointing out at least one difference between the claimed invention and the prior art reference.

**3. Independent Claim 28—“A method comprising:”**

- a. “registering asset data, wherein registering the asset data comprises at least one of the following:**

**registering a first geolocation associated with one of the following:**

**a physical asset, and**

**a virtual asset;**

The Petitioner has failed to meet its burden of establishing this element is present in Alcatel (Exh. 1009), and therefore claim 28 is therefore not anticipated by Alcatel. Specifically, in one paragraph containing only three sentences, the Petition cites to twelve paragraphs in Alcatel with no explanation as to how those string cites supposedly disclose registering asset data that includes a geolocation. *See* Pet., 61. This skeletal attempt does not satisfy Petitioner’s burdens under 35 U.S.C. § 312(a) and 37 C.F.R. § 42.104(b) to show unpatentability with particularity. Therefore, the Board may exercise its discretion under 35 U.S.C. § 314(a) to deny *inter partes* review. *Adaptics*, IPR2018-01596, Paper No. 20, 2019 Pat. App. LEXIS 4775, at \*33-34; *see also Intelligent Bio-Sys.*, 821 F.3d at 1369.

However, should the Board consider the merits of Petitioner’s Ground XII, the only paragraph in Alcatel that even uses the word register is paragraph 18. First, the paragraph notes that “tracker base stations in every location register the mobile device.” Exh. 1009, ¶ 18. The paragraph then goes on to say that the “location of the tracker base stations 105 which register the mobile device 107 gives the location

and direction of movement of the mobile device 107.” *Id.* “The mobile service provider network 103 has a mobility manager 104 which keeps track of location [base station location] and direction of all the mobile devices 107 through base stations, where the subscriber has enabled the content delivery based on direction of mobility service.” Exh. 1009, ¶0015. When all the claim elements of claim 28 of the ’620 patent are viewed together, delivery of content is based upon location in the ’620 patent, not direction as in Alcatel.

For these reasons, Petitioner has not shown that claim 28 is anticipated by Alcatel.

**b. “receiving media content to be associated with at least one registered asset;”**

With two blithe statements sandwiched around yet another string cite, the Petition claims that Alcatel discloses this claim element—placing the burden on Patent Owner to flesh out what it is the Petition is trying to say. This result is the exact reason that 35 U.S.C. § 312(a) and 37 C.F.R. § 42.104(b) exist.

Petitioner has failed to meet its burden.

- c. **“Specifying a plurality of rules for delivering the media content, wherein specifying the plurality of rules comprises specifying:**
- d. **a first delivery rule associated with at least one element of profile data corresponding with a recipient of the media content, and**
- e. **a second delivery rule associated with a second geolocation at which the recipient is tracked”**

Petitioner first cites to paragraph 0017 of Alcatel for teaching these elements.

Pet., 61. But paragraph 0017 states:

The mobile service provider then configures the content in a format which can be sent to the mobile device. The mobile service provider then configures a set of rules based on the days specified, time specified and the location of the tracker base stations near the road. Information saying “Road X closed for construction every Sunday from 6AM-3PM till August 2010” will be sent to all the mobile devices that are in the vicinity of the road and have subscriber to the content delivery based on mobility service.

Exh. 1009, 0017. The rule is based upon the location of the tracker base station and is sent to all the mobile devices that are in the vicinity. It is not the “recipient” that is being tracked, as required by this element of claim 28.

The Petition also references paragraph 0018, (Pet., 62), but paragraph 0018 states that “[a] path illustrating the location and direction of the movement of a

subscribed mobile device 107 user *can be inferred* drawn using the location of tracker base stations stored in the mobility history.” Exh. 1009, ¶0018 (emphasis added). Inferring a location of a user is not the same as tracking a user.

Petitioner has failed to meet its burden of showing that Alcatel anticipates this claim element.

**f. “receiving an indication that the recipient is proximate to the first geolocation, comparing the first delivery rule and the at least one element of profile data associated with the recipient;”**

The Petition asserts that “Alcatel receives location information from the mobile device traveling along, and determines proximity to a first geolocation such as near a closed road 6AM-3PM.” Pet., 62 (citing Exh. 1009, 0017). First, Alcatel does not determine proximity to a closed road; it only knows the location of tracker base stations. Exh. 1009, 0018. The base station sends out the message to the mobile devices it is in contact with (not based on a geofenced location).

Hence, Petitioner has failed to show how Alcatel discloses this limitation.

As to the remainder of claim 28, because of Petitioner’s repeated string cites and lack of identification as to specifically where and how limitations are taught by Alcatel, Patent Owner will not address the remaining limitations.

**4. Independent Claim 29: “A computer-readable medium comprising a set of instructions which when executed perform a method, the method comprising:”**

**g. “registering asset data, wherein registering the asset data comprises at least one of the following:**

**registering a first geolocation associated with one of the following:**

**a physical asset, and**

**a virtual asset”**

*See* § IX.C.1(a), *supra* (registering asset data ....).

Petitioner has failed to meet its burden of showing with particularity how Alcatel discloses this limitation. *See* Pet., 63-64.

**h. “media content to be associated with at least one registered asset;”**

*See* § IX.C.1(b), *supra* (receiving media content ....).

Petitioner has failed to meet its burden of showing with particularity how Alcatel discloses this limitation. *See* Pet., 64.

As to the remainder of claim 29, because of Petitioner’s repeated string cites and lack of identification as to specifically where and how limitations are taught by Alcatel, Patent Owner will not address the remaining limitations.

**X. SECONDARY CONSIDERATIONS**

As the Petitioner has failed to meet its burden of establishing a *prima facie* case for any of the claims of the ’620 patent, much less identify a motivation to

modify Verizon in Ground I or Alcatel in Ground XII, or a motivation to combine the references contained in Grounds II-XI, and XIII, Patent Owner reserves the right to address secondary considerations, if needed, later in these proceedings.

## CONCLUSION

Petitioner Foursquare has failed to establish that claims 28 and 29 are anticipated by Verizon or Alcatel or that claims 1-29 are rendered obvious by any combination of the asserted prior art references. Therefore, institution by the Board of *inter partes* review is not appropriate, and the Board should deny the Petition.

August 30, 2023

Respectfully submitted,

/s/ Meredith Martin Addy

Meredith Martin Addy  
Reg. No. 37,883  
meredith@addyhart.com

**ADDYHART P.C.**  
10 Glenlake Parkway, Suite 130  
Atlanta, Georgia 30328  
312.320.4200

Robert Hart  
Reg. No. 35,184  
robert@addyhart.com

Gregory B. Gulliver  
Reg. No. 44,138  
gbgulliver@addyhart.com

Brandon C. Helms  
bhelms@addyhart.com  
Reg. No. 61,742

**ADDYHART P.C.**  
401 N. Michigan Ave., Suite 1200-1  
Chicago, Illinois 60611  
312.834.7701

**Counsel for Patent Owner  
BoardActive Corporation.**

### **CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies service of Patent Owner BoardActive served this Patent Owner's Preliminary Response on the counsel of record for Petitioner Foursquare, Inc. by filing this document through the P-TACTS, as well as delivering a copy via electronic mail to the following:

michael.carrillo@btlaw.com

steven.shipe@btlaw.com

Date: August 30, 2023

By: /s/ *Meredith Martin Addy*  
Meredith Martin Addy

### **CERTIFICATE OF COMPLIANCE**

This Petition complies with the type-volume limitations as mandated in 37 C.F.R. § 42.24, totaling 9,340 words. Counsel has relied upon the word count feature provided in Microsoft® Word for Mac Version 16.661.

Dated: August 30, 2023

By: /s/ Meredith Martin Addy